

ROUNDTABLE: IP IN LATIN AMERICA

MANAGING INTELLECTUAL PROPERTY, JUNE 2010

AS LATIN AMERICA BECOMES AN INCREASINGLY IMPORTANT MARKET, RIGHTS OWNERS MUST BE AWARE OF THE EVOLVING LAWS AROUND ISSUES SUCH AS DIGITAL RIGHTS AND NON-TRADITIONAL TRADE MARKS IN THE REGION. *MANAGING IP* DISCUSSED THE KEY CHALLENGES WITH SEVERAL PROMINENT MEMBERS OF THE LATIN AMERICAN IP COMMUNITY.

Participants:

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EM: IS THERE CASE LAW OR LEGISLATION REGARDING THE PROTECTION OF COPYRIGHTED CONTENT AND TRADE MARKS ON THE INTERNET IN YOUR REGION?

LS: In Mexico there is no ad hoc legislation, such as the US Digital Millennium Copyright Act (DMCA). Protection for copyrighted works or trade marks triggers from the Copyright Law and the Law on Industrial Property, respectively. The Copyright Law contemplates provisions which accommodate concepts such as fixation, reproduction or communication to the public in the digital

environment. It also grants a right of access to works disseminated in digital networks. Finally, the Copyright Law provides certain limited protection to Technological Protection Measures (TPM) and Digital Rights Management (DRM) systems against illegal circumscriptio.

On the other hand, the Copyright Law does not make internet service providers (ISPs) liable or provide any safe harbours excluding liability in specific situations like caching, mere conduit, search engine or routing. The exceptions and limitations imposed by the Copyright Law are so restrictive in scope that it would be difficult to invoke in connection with digital rights.

As to trade mark rights, the general provisions of the Law on Industrial Property are adequate to protect trade mark rights in a digital environment. Likewise, the domain name dispute resolution policy system of Mexico is aligned with WIPO/ICANN standards, and is managed either by WIPO/ICANN – in connection with the Uniform Domain – Name Dispute – Resolution Policy (UDRP) – or WIPO/NIC Mexico – in connection with the local dispute resolution policy (LDRP). Accordingly, the Mexican UDRP and LDRP systems have been regarded among the most effective in the world.

DZ: In Argentina, there is neither specific case law about conflicts related to the use of works on the internet, nor specific legislation, since Intellectual Property Law No. 11,723/33 regulates all author's rights, regardless of the means by which a civil or criminal unlawful act is committed.

NILS, WHAT ADVICE DO YOU HAVE FOR IP OWNERS SEEKING TO ENFORCE THEIR RIGHTS TO COPYRIGHTED CONTENT OR TRADE MARKS ON THE INTERNET IN COUNTRIES WHERE THERE IS NO CASE LAW OF SPECIFIC LEGISLATION ADDRESSING THE ISSUE?

NM: Pick the best lawyer for the job. This is always fundamental. Not every lawyer or law firm who knows how to register trade marks in Latin America is knowledgeable and equipped to advise on digital piracy, which has its own discrete set of challenges.

The law of trade marks and copyright is not that different in the context of the internet. Of course, because trade marks are territorial, it is imperative that the IP owner comply with the requirements of the local jurisdiction in order to protect the mark. This will normally require that the mark be registered before protection can be obtained. Copyrighted material normally be protected under

the local law for nationals and through the provisions of the Berne Convention for non-nationals.

The complex part of digital piracy is the investigation of the location of the infringers and the forum that may be used to stop the piracy or infringement once the infringer has been located, assuming that a simple cease and desist letter is not sufficient to stop the infringement.

EM: HOW LARGE IS THE ONLINE PIRACY/COUNTERFEITING PROBLEM?

DZ: In Argentina, online piracy is becoming a major problem and, depending on the sector, it is causing almost irreversible damage to the creative industries.

NM: Online piracy is quite widespread throughout Latin America. This is due to the fact that the internet inherently has no boundaries, so that pirates and infringers can be located anywhere in the world and the infringing activity can be beamed, so to speak, into any location. The widespread use of pharmaceutical pirates in Asia, for example, of advertising the sale of their counterfeit products and drop shipping orders is widespread in Latin America as it is in North America and in Europe. In other industries, such as the music industry, digital content is downloaded directly by consumers from unauthorised sites.

WHICH TYPES OF GOODS AND SERVICES ARE MOST AT RISK?

NM: The most vulnerable goods to online piracy and counterfeiting are, first, any good that may be reduced to a digital format. This includes at the moment music, film and books. The music industry worldwide has been decimated by online piracy. The lack of fast internet connections and relatively small bandwidth has saved the motion picture industry from the same fate, but it is only a technological matter of time before movies and television shows suffer the same fate. Book piracy will be a growing phenomenon with the spread of e-readers in Latin America over the next two to three years. The next most vulnerable goods are high value hard goods, such as pharmaceuticals. The counterfeit goods in these cases are not transferred through the internet, but the internet is used as a mechanism to facilitate their promotion and sale.

DZ: Based on data provided by the CAPIF (Argentine Chamber of Phonogram

and Videogram Producers and Industrials), online piracy related to the unlawful use of musical file exchange programs, caused a loss of more than 21% in CD sales in the last few years. A search conducted by the Chamber estimates that, during 2006, Argentines unloaded more than 600 million songs from the internet through programs that allow the exchange of unauthorized music files, thereby infringing, in most of the cases, intellectual property laws. The film industry has also been damaged by the illegal reproduction of movies.

LS: Music and film have suffered the most in Mexico, but other industries, such as software and videogames, have also been affected.

EM: HOW HAVE THESE INDUSTRIES RESPONDED LOCALLY?

LS: They have made efforts on various fronts: they have lobbied Congress for changes to the law and before the Attorney General's Office (PGR) and other enforcement agencies or authorities.

A landmark case for the film industry was *MPAA v SigloX.com*, relating to an illegal online video service. In 2008, PGR took actions in the city of Culiacán, Sinaloa, where the business was traced, and a server was seized holding thousands of movies and TV programmes. As a result of that, APCM — an alliance formed by the motion picture and music industries.

NM: The industries suffering from online piracy have major antipiracy and anti-counterfeiting programmes in Latin America. This includes the music and film industries, the pharmaceutical industry and book publishers. Generally, there will be a regional head of the programme located in a major city in Latin America, such as Mexico City or Rio de Janeiro, who will oversee the activities of country managers.

DZ: At the local level, there have been very important advertising campaigns to educate the public about the damage caused by piracy, mainly in the music and movie industries.

Regarding civil legal actions, in 2005, in the framework of a world campaign against piracy on the internet, CAPIF sent around 500 formal notices to individuals who were found to upload and download large amounts of phonograms containing musical works (more than 5000) without proper authorisation. The campaign resulted in the filing of 20 civil legal actions; most of them have been settled by agreement between the parties.

MARCO, HAS THE MEXICAN COPYRIGHT OFFICE (INDAUTOR) BEEN INVOLVED IN ANY EFFORTS TO CURB ONLINE PIRACY?

MM: Yes, the Office has taken several steps in this respect. These include providing legal advice by email, telephone and in writing; amending the copyright and IP law to provide for the persecution of most types of digital infringement; reaching agreement with the Federal Institute of Public Defense, in order to assist users who require legal representation for the defence of their copyrights; and maintaining relationships with the collecting societies in charge of protecting authors and owners of related rights, both national and foreign.

SHOULD LEGISLATION BE PASSED TO HELP ENFORCE DIGITAL RIGHTS IN MEXICO?

MM: No, because the copyright law already accounts for defence mechanisms against digital infringement.

EM: WHAT MECHANISMS ARE IN PLACE TO FIGHT THE PROBLEM IN OTHER COUNTRIES? DO ISPS HAVE ANY LIABILITY IN LATIN AMERICA?

NM: Every country in Latin America has laws that make the piracy of copyrighted and counterfeiting of goods protected by trade marks a crime. I am unaware of any cases that have held an ISP liable in any way for the hosting of websites in the region.

DZ: There is really no useful mechanism in Argentina to fight online piracy. ISPs have no specific liability, but they may eventually be held liable for damages for providing a means to commit unlawful acts. However, there is still no evidence of positive results in combating online piracy.

EM: WHICH AGENCIES ARE RESPONSIBLE FOR ENFORCEMENT AND INVESTIGATION PROCEDURES REGARDING ONLINE INFRINGEMENT IN YOUR COUNTRIES?

DZ: Since piracy of both intellectual and trade mark works is a public offence, security agencies can intervene at their own will in the investigations of such infringements. In Argentina, the security agencies that frequently intervene are

the Argentine Federal Police within the City of Buenos Aires, and the National Gendarmerie and Coast Guard in the rest of the country. In the crime under investigation is only an infringement to the Intellectual Property Law, the entity authorised to intervene in the investigation is the provincial police. However, most of the procedures are directed by prosecutors or judges who are in charge of the judicial investigation of piracy.

LS: The Attorney General's Office (PGR) and the Mexican Institute of Industrial Property (IMPI), principally. Civil courts, the Copyright Office and Customs have additional jurisdiction, but to a lesser degree than PGR and IMPI.

EM: NILS, HOW EFFECTIVE WOULD YOU SAY SUCH AGENCIES GENERALLY ARE?

NM: The effectiveness of the agencies responsible for enforcement in Latin America varies tremendously from country to country. This is no different in the digital realm than in the world of the concrete enforcement of goods. Most government agencies in Latin America are not sophisticated in the area of digital piracy and counterfeiting and it will require the local counsel of the IP owner in question to do most of the heavy lifting to get cases to court.

EM: ARE THE COURTS GENERALLY EFFECTIVE?

NM: No. Latin America, as a general proposition, has a relatively poorly trained judiciary and overtaxed court system. Once cases are filed, they often languish for years before a resolution is reached. This is a problem that faces almost all courts in developing countries and Latin America as a rule is no different.

EM: IN WHICH COURTS CAN RIGHT HOLDERS TAKE ACTION TO ENFORCE DIGITAL RIGHTS? ARE THEY EFFECTIVE?

LS: In Mexico, actions are generally handled by PGR and IMPI. They have proven to be effective, particularly PGR.

DZ: According to the most recent case law, when the crime is committed by means of the Internet, federal courts have jurisdiction over the case because the effects of the unlawful act are spread throughout the country. The effectiveness of the measures depends mainly on the knowledge of the judges

and prosecutors. In Argentina, the answer may vary, particularly in criminal cases.

EM: HOW CAN RIGHT OWNERS MAXIMISE THEIR CHANCES OF SUCCESS ENFORCING DIGITAL RIGHTS?

DZ: Due to the general lack of social knowledge on this matter, rights owners affected by piracy should explain carefully to the judge the extent of the infringement and damage to his rights and to all of society. It is advisable to be especially careful when filing preliminary injunctions or obtaining anticipated evidence.

NM: The best way for IP owners to maximise their chance of success in court is to hire a lawyer who is an expert in piracy and counterfeiting and one who has excellent relationships with local government authorities. The case must be very well prepared and the prosecutors trained and closely monitored.

LS: By making thorough investigations, collecting sufficient evidence and assisting the district attorneys with good technical and legal support, as not every IP attorney in Mexico is qualified to work on online piracy matters. Establishing good channels of communication with enforcement agencies is essential as well.

EM: HAVE THERE BEEN ANY SIGNIFICANT RECENT CASES ADDRESSING THESE ISSUES?

LS: The most significant in Mexico has been *MPAA y SigloX.com*. As a result of that case, the site was dismantled, the server seized and one employee convicted. The owner fled and continues to be searched for by Interpol.

EM: WHAT ROLE DO FREE TRADE AGREEMENTS PLAY WITH RESPECT TO THIS ISSUE IN YOUR COUNTRY, IF ANY?

DZ: At the national level, the major free trade agreement in which Argentina participates is Mercosur. This instrument does not contain tools for fighting piracy, so it does not play a relevant role.

LS: Neither NAFTA or the TRIPs Agreement address digital rights expressly.

However, they have been relevant in creating the IP enforcement structure of their member states. That general framework works in connection with digital rights as it applies in connection with more basic copyright or trade mark rights. **NM:** Free trade agreements with the US tend to have requirements which seek to ensure that intellectual property is protected in a manner that mirrors the way it is protected in the US. As mentioned already, however, it is not the law that is the problem in the case of digital piracy and counterfeiting. The problem is first one of investigation and detection, and second one of poorly trained and funded government agencies.

EM: WHAT ROLE WILL ACTA PLAY?

DZ: The purpose of the Anti-Counterfeiting Trade Agreement (ACTA) is to establish new standards for the enforcement of IP rights, so as to efficiently fight the prolific growth of pirated and counterfeited goods trade. I think it can become a useful tool as long as it is subscribed to by many countries. This is the only way a treaty can be efficient, as happened with the Berne Agreement and the WIPO agreements on the internet, which have been signed by many countries.

NM: ACTA is designed to upgrade TRIPs by compelling signatories to the agreement to live up to stronger levels of enforcement than TRIPs presently requires. This is fine as far as it goes, but we have had two decades of a number of Latin American countries, for example, being put on the USTR's 301 list of countries that don't live up to TRIPs requirements. Simply making those treaty obligations stronger will not necessarily make the situation on the ground in Latin America better. Countries need to see that it is in their best interest to protect intellectual property and they have to have the resources available to do so.

LS: ACTA is very specific about the protection of digital rights, even more so than the WIPO treaties. I believe ACTA will majorly contribute to a better digital rights system in copyright. The discussions about liability for ISPs and other topics addressed in ACTA are not new. However, that discussion has taken place mostly in the US and Europe so far. ACTA will take the discussion to a truly global level, and the developing world may have something different to say. Additionally, ACTA will motivate new discussions about these topics, which will

be beneficial as far as striving toward a global IP system.

EM: MARCO, WHAT MAJOR CHALLENGES HAS THE INTERNET POSED TO THE OFFICE'S GOAL OF PROTECTING AUTHORS' WORKS?

MM: Technological advances have made it quite urgent that we update our internal systems in order to maintain the databases, as well as make them interoperable with external media. This is true not only for purposes of processing registrations, classification and searches, but for sufficiently maintaining information and data and speeding up the registration process. For this reason, we are working toward implementing new technologies for processing registrations, as well as for the management of data and information access. This includes digitising documents, better management of online processes and exchanging information online and in real time.

EM: HAS THE INTERNET MADE IT HARDER FOR AUTHORS AND ARTISTS TO PROTECT THEIR ORIGINAL WORKS IN YOUR OPINION?

MM: In some respects it has been beneficial, since authors' works are now easily disseminated around the world. However, the problem has become out of control with respect to unauthorised reproduction.

EM: HOW SHOULD THE PROBLEM BE ADDRESSED?

MM: By amending the Mexican copyright law to allow for the integration of measures relating to new technologies, as foreseen in the WIPO Treaty on copyrights, which Mexico has been part of since March 6 2002.

EM: DANIEL, WHAT KEY STRATEGIES SHOULD RIGHT HOLDERS EMPLOY TO PROTECT THEIR IP ONLINE IN YOUR REGION IN THE MEANTIME?

DZ: In the first place, right holders should hold periodic meetings organised by

their respective chambers to share which is the most successful local experience. This should be also accompanied by formal requirements to governmental and judicial authorities asking for training campaigns, mainly directed to judges and prosecutors. Regarding judges, it is important that they constantly update their knowledge, not only on specific legal matters, but also on the types of technologies that are the means for committing these types of infringements. It is particularly useful to promote regional workshops and seminars for judges in order to share methods of investigation, evidence assessment, and any other experience on this issue.

Furthermore, it is important to promote meetings among the main law enforcement authorities (such as the police, customs officers and municipal inspectors) so that they receive training on how to identify pirated and counterfeited products, secure evidence, and file formal complaints with the corresponding jurisdictional authorities.

Before resorting to technological measures for curbing the illegal use of works on the internet, it is important to insist on creating public awareness. For example, making users aware that if piracy levels continue, many families will lose their jobs; making governments aware, so that they respond with efficient policies to avoid tax evasion and the consequent unlawful competition; and making judges aware, so they take into consideration, when issuing a decision, not only the economic value of the intellectual work, but also the understanding that piracy damages the whole cultural heritage of a society.

NON-TRADITIONAL MARKS

EM: WHAT TYPES OF NON-TRADITIONAL MARKS CAN BE REGISTERED IN YOUR COUNTRY?

JA: Traditionally, trade marks are signs detected by sight. However, non-traditional trade marks, or marks pertaining to other senses, like smell, hearing, touch, and taste, can obtain trade mark protection in the Argentine legal system under certain circumstances.

If the smells, sounds, flavours, tastes, and textures have distinctive capacity, they can obtain trade mark protection because under the Argentine legal system, unlike other law systems, it is not necessary to comply with the

requirements of visual perception and graphic representation.

GG: Under Mexican Law, colours that are isolated shall not be registrable "unless they are combined or accompanied by elements such as symbols, designs or denominations that give them a distinctive character". Thus, combination of two or more colours can be subject to trade mark protection and registration, regardless of the form or surface to which they are applied. Furthermore, Article 89 of the IP law expressly establishes that three-dimensional signs can constitute a trade mark and can be registered with the Mexican Trademark Office as long as they are not part of the public domain; have not become of common use; do not lack sufficient originality to be easily distinguished; represent the shape of the product or that imposed by their nature or industrial function.

Motion marks are not only not protected by our IP law, but are expressly considered as a sign that cannot constitute a mark based on Section I of Article 90 of the law, which establishes that changing names, figures or forms expressed in a dynamic way regardless of whether they are visible, shall not be registered as trade marks.

Finally, registration of sound, smells, texture and taste marks is not allowed in accordance with our IP law.

EM: WHAT ARE THE CHIEF OBSTACLES FOR COMPANIES SEEKING TO OBTAIN PROTECTION FOR THESE MARKS?

JA: Although the Argentine laws allow the registration of these trade marks, there have not been many prior cases of non-traditional registered trade marks. For example, in the case of motion trade marks, the first application was filed in November 2001 and granted in July 2002. In the case of sound trade marks, the first application was filed in 1997 and granted in June 2000. At present, there are many other sound trade marks which are pending or have been already granted. However, it is important to note that in all these cases, the applications are for sounds represented in musical pentagrams.

NM: An underlying problem with protecting non-traditional marks in Latin America above is purely financial in nature. The industrial property offices in Latin America tend to be underfunded and the staff under trained. The court systems are very slow and the judges not particularly sensitive to IP issues. Having better laws on the books is a good start, but will ultimately be relatively

meaningless if IP owners are not able to get timely protection of their IP.

GG: The prohibitions established in our IP law, as well as the strict criteria applied by the Trademark Office for non-traditional marks that are registrable.

EM: ARE THERE OTHER WAYS OF PROTECTING THOSE MARKS THAT CANNOT BE REGISTERED?

JA: One way is through the law of unfair competition. Even though the protection offered by the trade mark law is stronger and more efficient than the protection that can be obtained by the unfair competition legal regime, the imitation of distinctive elements which are not registered is likely to result in an unfair advantage, which is precisely the kind of conduct that the unfair competition law seeks to avoid and punish.

GG: With respect to sound marks, it is possible to seek copyright protection through Federal Copyright Law, as it grants protection over musical works. Although a sound mark might not comply with the requirements to be considered a song. Article 13 of the law establishes that copyright protects those works that can be considered artistic works. So as long as a sound mark shares a similar nature to a musical work, sounds with a harmonic composition and that can be identically reproduced each time, might be considered within the scope of protection of the copyright law. However, the decision on whether this premise applies for a word mark relies on the Mexican Copyright office's interpretation.

As far as smells, tastes and textures, there is no specific law or provision that recognises such marks as trade marks, since they do not fulfil the requirement of being visible signs. However, Section IX of Article 213 of the Mexican Trademark Law establishes an administrative infringement to be one committed "in the exercise of an industrial or commercial activity acts, which deceive or induces the public to confusion, error or deceit", based on several criteria. Therefore, one option for obtaining a favourable resolution regarding the use of a non-traditional mark that is not recognized and protected under the Mexican IP law is to file evidence that proves that consumers have become confused by the unauthorized use of such signs. This might imply an act of unfair competition. However, there are no pending or resolved cases involving these types of marks.

EM: WHAT EFFORTS ARE UNDERWAY TO CONVINCING THE TRADE MARK OFFICES TO ALLOW THESE MARKS?

JA: Improvements must be made in connection with the substantive examination process of these signs to determine if they are registrable, since at present, the Trademark Office is not technically equipped to accurately perform a comparative analysis between different non-traditional trade marks in order to raise objections. A short-term solution is unlikely.

GG: An initiative to amend the Mexican Trademark Law including, among other issues, the recognition of non-traditional trade marks, was proposed before the Congress, but was sent back without being approved. However, it has opened the door for future amendments on this important issue, as there is no doubt that non-traditional trade marks are signs used by companies to distinguish their products or services from the ones of their competitors on the marketplace. As modern marketing strategies continue to evolve, trade mark protection will have to be adjusted.

EM: WHAT IS STOPPING THE OFFICES FROM ALLOWING PROTECTION FOR THESE MARKS?

JA: In Argentina, the only limitation on non-traditional registrations is the specific prohibition of the law regarding 3D trade marks. This issue was resolved by the courts, which determined that the traditional shape of a product does not constitute a trade mark. Therefore, shapes can be registered as trade marks, as long as they are non-traditional shapes of known products.

Another important problem lies in the fact that the law does not allow the registration of a single colour applied to a product, but it does allow the registration of a combination of colours. In this sense, the Trademark Office has admitted the registration of a single colour applied to a product, as long as it is combined with other elements forming a distinctive set. For example, Pfizer obtained the registration of the Viagra pill in light blue colour as a 3D trade mark.

EM: HAVE THERE BEEN ANY SIGNIFICANT RECENT CASES REGARDING NON-TRADITIONAL MARKS IN YOUR COUNTRY?

JA: On January 30 2009, the National Institute of Industrial Property (INPI) registered the first scent trade mark to be applied to the container of a product in Argentina. They are owned by L'Oreal and registered in International Class 3. The registrations were granted by Resolution 131/09. In all the cases, the scents comprised a "Fragrance of... [different fruits in each case]... applied to the Containers".

If the fragrances had been applied to the product rather than to the container, then INPI's criteria would surely have been different, since in certain cases the application of the fragrance to the product itself would have been objected by parties which manufacture such products in the public domain.

L'Oreal's applications for the scent trade mark registrations date back many years, following a third party opposition when they were first published. When legal action was brought for the withdrawal of such opposition, the court emphasised that in order to determine the registration of a sign, it is not a "substantial requirement" under the Argentine trade mark legislation that such sign be "visually perceptible" or "graphically represented". Subsequently, the intervening court notified INPI about the withdrawal of the third party opposition.

The final decision to deny or grant registration of the trade marks in question fell to INPI. By means of a brief report, INPI evaluated the marks' intrinsic and extrinsic distinctive capacity (compared to other identical or similar signs in the same class), and reached the above conclusion, permitting registration of the scent trade marks.

It is important to highlight the criteria adopted by the INPI when it originally accepted the registration applications and ordered the corresponding Publications, and now proceeds to grant such non-traditional trade marks without requesting that they fulfil impossible requirements.

GG: The Mexican Trademark Office's criteria makes it very difficult to transcend the limitations in the law, as already mentioned. However, the Federal Court of Tax and Administrative Affairs (FCTAA) has issued several decisions reversing denials of registrations by the Mexican Trademark Office. With the creation of the FCTAA, we expect an increase in these favourable resolutions and that new criteria will be established eventually changing the Office's perception regarding

distinctiveness of three dimensional marks.

EM: WHAT KEY STRATEGIES SHOULD RIGHT HOLDERS EMPLOY TO PROTECT NON-TRADITIONAL MARKS IN THE MEANTIME?

GG: Apply for protection of a sound mark through copyright registration.

JA: In Argentina, in order to register a motion mark, for example, it is essential to describe in detail the sequence of the complete movement sought to be protected, attaching, for such purposes, the media that reproduce that sequence. In this way, the description can be included with the certificate of trade mark registration in case it should be used in a possible legal action. In the case of sound trade marks, if the trade mark applied for cannot be represented in a pentagram, it would be necessary to provide a written description of the sound and also the filing of a material medium containing the recorded sound in question.

Considering the Trademarks Office's inability to compare and analyse similar non-traditional trade marks, it is important that the owners of these types of rights take a proactive attitude and defend their rights by challenging the trade marks they consider similar; this is presently the only available way of mitigating the problem.

Source: Roundtable - IP in Latin America, Managing Intellectual Property Magazine, Jun 2010.