

Law No. 7978

LEGISLATIVE ASSEMBLY OF THE REPUBLIC OF COSTA RICA

HEREBY DECREES:

LAW ON TRADEMARKS AND OTHER DISTINCTIVE SIGNS

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TITLE I

General provisions

Article 1.– Purpose. The purpose of this Law shall be to protect effectively the lawful rights and interests of the owners of trademarks and other distinctive signs, and to guard against the indirect effects that acts of unfair competition may have on consumers' lawful rights and interests. It is also intended to help promote technological innovation and the transfer and dissemination of technology, of mutual benefit for producers and users of technological knowledge, in a way that fosters social and economic well-being and a balance between rights and obligations.

It further develops the procedures needed to guarantee the effective application of the commitments established in existing international treaties, where necessary, failing such an explicit procedure therein, in all matters not opposed to and compatible with the said treaties." (as amended by Law No. 8632).

Article 2.– Definitions. For the purposes of this Law, the following concepts are defined:

Person: natural person or legal entity.

Trademark: any sign or combination of signs that makes it possible to distinguish the goods or services of one person from those of another, because they are deemed sufficiently distinctive or capable of identifying the goods or services to which they are applied compared to those of the same kind or class.

Collective trademark: a sign or combination of signs whose owner is a collective entity which groups together persons authorized by the owner to use the trademark.

Certification trademark: a sign or combination of signs applied to products or services whose characteristics or quality have been checked and certified by the owner of the trademark.

Trade name: a denominative or mixed sign which identifies and distinguishes a given company or business establishment.

Emblem: a figurative sign which identifies and distinguishes a company or establishment.

Distinctive sign: any sign that consists of a trademark, trade name or emblem.

Well-known mark: a sign or combination of signs that is known in international trade, the relevant sector of the public or corporate circles.

Expression or sign of commercial advertising: any caption, announcement, slogan, phrase, combination of words, design, recording or any other similar medium, provided that it is original, characteristic and used to attract the attention of consumers or users as to the given good, service, company, establishment or commercial premises.

Appellation of origin: a geographical appellation, designation, expression, image or sign of a country, region or locality used to designate a good as originating from the territory of a country, region or locality of that territory, whose quality or characteristics are due exclusively to the geographical medium, including natural and human factors.

Geographical indication: an indication which identifies a good as originating from the territory of a country or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin. Any sign or combination of signs, in any form, shall be capable of constituting a geographical indication (as amended by Law No. 8632).

Industrial Property Registry: The competent national administrative department for the grant and registration of industrial property rights, which is attached to the National Registry.

TITLE II

Trademarks

CHAPTER I

Trademarks in general

Article 3.– Signs which may constitute a trademark. Marks which refer, in general, to any sign or combination of signs capable of distinguishing goods or services, especially words or groups of words – including the names of persons–, letters, numbers, figurative elements, figures, monograms, portraits, labels, coats of arms, stamps, stickers, logos, lines or borders, combinations and arrangements of colors as well as sounds. Similarly, they may

consist of the form, presentation or packaging of products, their wrapping or cover or the channels or outlets for distributing the corresponding goods or services (as amended by Law 8632).

Without prejudice to the provisions relating to geographical indications contained in this Law, marks may refer to geographical names, national or foreign, provided that they are sufficiently distinctive and that their use is not likely to create confusion in respect of the origin, source and qualities or characteristics of the goods or services for which such marks are to be used or applied.

The nature of the goods or services to which the mark is to be applied shall not under any circumstances constitute an obstacle to its registration.

Article 4.- Claim for acquiring rights flowing from trademark registration. Claims to the right to obtain trademark registration shall be regulated by the following rules:

- (a) a person who has been using the mark in good faith and in trade since the earliest date shall enjoy priority for obtaining registration, provided that such use has lasted more than three months or the right of priority of the earliest date has been invoked;
- (b) where a mark has not been used in trade or has been used for less than three months, registration shall be granted to the person who first submitted the corresponding application or invokes the right of priority at the earliest date, provided that he meets the requirements set.

Questions which arise in respect of the claim in the filing of two or more applications shall be settled according to the date and time of filing of each application.

The use and registration of marks to market goods or services shall be optional.

Article 5.- Right of priority. Any person who has properly filed a trademark registration application in a Contracting State of the Paris Convention for the Protection of Industrial Property or in another country which grants reciprocity for such purposes to persons holding the nationality of any of the Contracting States, or who has a domicile or a real and effective establishment in any of them, as well as the successors in title of such a person, shall enjoy a right of priority to file, in Costa Rica, one or more applications for the registration of the trademark in question, for the same goods or services.

The right of priority shall last six months, beginning from the day following the filing of the priority application. A trademark registration application which has already been filed and which invokes a right of priority may not be rejected, revoked or cancelled due to events which have occurred during the period of priority, due to the applicant himself or a third party. Such acts shall not give rise to the acquisition of any third party rights in the trademark.

The right of priority shall be invoked by means of an explicit statement, which shall be made with the application for registration or within a period of two months, beginning from the date of filing of the application.

When the application is filed or within the following three months, an authenticated copy of the priority application shall be attached, together with the authorization of the Industrial Property Office that has received the said application. This authentication requirement shall be waived for that document, which shall be accompanied by the corresponding translation, as the case may be.

With a single application, multiple or partial priorities which have originated in two or more different offices may be invoked. In this case, the period of priority shall begin from the earliest priority date.

The right of priority may be based on an earlier application filed with the Industrial Property Registry, provided that it does not invoke an earlier right of priority. The grant of the registration applied for with the benefit of the right of priority shall lead to the cessation of the effects of the earlier application in respect of those elements which are common to both. The periods and conditions stipulated in this Article shall apply, as appropriate.

Article 6.- Co-ownership. Co-ownership of applications for the purposes of the corresponding registration, where there is no agreement to the contrary, shall be regulated by the following rules:

- (a) the amendment, limitation or withdrawal of a pending application shall be made jointly;
- (b) each co-owner may personally use the distinctive sign that is the subject of the application or registration, but shall provide fair compensation to the co-owners who do not work or use the sign or have not granted a license for the use thereof. Failing agreement, compensation shall be fixed by the competent court;
- (c) the application or registration may be assigned by joint agreement, but each co-owner may assign his share separately; the other co-owners shall enjoy a right of pre-emption for a period of three months, beginning from the date on which the co-owner notifies them of his intention to assign his share;
- (d) each co-owner may grant third parties a non-exclusive license for use of the distinctive sign which is the subject of the application or registration, but shall pay fair compensation to the co-owners who do not use the sign or have not granted a license for its use. Failing agreement, compensation shall be fixed by the competent court;
- (e) an exclusive license for working or use may only be granted by joint agreement;
- (f) the renunciation, limitation or voluntary cancellation, in full or in part, of a registration shall be made by joint agreement;
- (g) any co-owner may notify the other co-owners that he waives his share of the application or registration for their benefit, in which case he shall be free of any obligation with regard to them, as from the recording of

the waiver in the corresponding registry or, in the case of an application, as from notification of the waiver in the Industrial Property Registry. The waived share shall be divided up between the remaining co-owners, proportionate to their rights in the application or registration;

(h) any co-owner may initiate the corresponding proceedings for infringement of a right.

Common law provisions concerning co-ownership shall apply to cases not covered by this Article.

Article 7.– Trademarks which are inadmissible for intrinsic reasons. A sign which has any of the following features may not be registered as a trademark:

- (a) it has the usual or common form of the good or wrapping to which it is applied or a form that is necessary or imposed by the nature of the good or service in question;
- (b) it has a form which grants a functional or technical advantage to the good or service to which it is applied;
- (c) it is exclusively a sign or indication which, in the everyday language or commercial practice of the country, is a common or usual name for the good or service to which it applies;
- (d) it consists solely of a sign or indication which, in trade, can serve to qualify or describe any characteristic of the good or service to which it is applied;
- (e) it consists of a simple color considered on its own;
- (f) it consists of a letter or figure considered on its own, except where it is presented in a special and distinctive fashion;
- (g) it is insufficiently distinctive in respect of the good or service to which it applies;
- (h) it is contrary to public order or morality;
- (i) it contains an element which offends or ridicules persons, ideas, religions or national symbols of any country or international entity;
- (j) it may mislead or cause confusion as to the geographical origin, nature, manufacturing method, qualities, suitability for use or consumption, quantity or any other characteristic of the good or service in question;
- (k) it is identical or similar, in such a way as to cause confusion, to a trademark whose registration has expired or was not renewed during the six-month priority period following its expiration, or was cancelled at the request of its owner and was used in trade for the same goods or services or others which, owing to their nature, may be associated with them, unless one to three years have passed after expiration or cancellation; in the case of a collective trademark, from the expiry date to cancellation. This prohibition shall not apply where the person filing for registration is the same as the owner of the expired or cancelled registration or his successor in title;
- (l) it consists of a geographical indication that does not meet the requirements of Article 3.2 of this Law;
- (m) it reproduces or imitates, in full or in part, the coat of arms, flag or other emblem, logo, name or abbreviated name of any State or international organization, without the authorization of the competent authority of the State or organization;
- (n) it reproduces or imitates, in full or in part, an official sign of control or guarantee adopted by a State or a public entity, without the authorization of the competent authority of that State;
- (o) it reproduces coins or banknotes which have the status of legal tender in the territory of any country, securities or other commercial documents, seals, stamps or tax stamps in general;
- (p) it includes or reproduces medals, prizes, diplomas or other elements indicating the obtaining of awards in respect of the corresponding good or service, except where such awards have actually been granted to the applicant for registration or his agent and can be proven at the time of filing;
- (q) it consists of the name of a plant variety which is protected in Costa Rica or in any foreign country with which a treaty or agreement relating to the protection of plant varieties has been signed;
- (r) it falls under the prohibition stipulated in Article 60 of this Law.

Where the trademark consists of a label or other sign composed of a series of elements and states the name of a good or service, registration shall be granted solely for that good or service.

Article 8.– Trademarks which are inadmissible owing to third party rights. No sign may be registered as a trademark where this affects any rights of third parties, in the following cases, *inter alia*:

- (a) where the sign is identical or similar to a trademark, geographical indication or appellation of origin, which was or was being registered by a third party at an earlier date, and distinguishes the same goods or services and others related thereto, which may cause confusion among public consumers;
- (b) where use of the sign is likely to cause confusion because it is identical or similar to a mark, geographical indication or appellation of origin, which was or was being registered by a third party at an earlier date, and distinguishes the same goods or services or goods and services which are different but are likely to be associated with those distinguished by the earlier mark, geographical indication or appellation of origin;
- (c) where use of the sign is likely to create confusion because it is identical or similar to a mark, geographical indication or appellation of origin used, from an earlier date, by a third party with a better right to obtain registration thereof, according to Article 17 of this Law, for the same goods or services or for goods or services which are different but are likely to be associated with those which distinguish the respective mark, geographical indication or appellation of origin in use;

- (d) where use of the sign is likely to create confusion because it is identical or similar to a trade name or emblem used in the country by a third party since an earlier date;
- (e) where the sign constitutes a reproduction, imitation, translation or transcription, in full or in part, of a distinctive sign that is well known in any Contracting State of the Paris Convention by the relevant segment of the public, in relevant business circles or in international trade, and which belongs to a third party, regardless of the goods or services to which such sign applies, where its use is likely to confuse or leads to a risk of association with this third party or undue benefit from the repute of the sign.
- (f) where use of the sign affects the rights attaching to the personality of a third party, especially in respect of a given name, signature, title, nickname, pseudonym, image or portrait of a person different from the one applying for registration, unless he can prove that he has obtained the consent of that person or where that person is deceased, in which case the person must obtain the consent of those who are legally declared to be the heirs of the deceased. If consent is given abroad, it shall be attested and authenticated by the respective Costa Rican consul;
- (g) where the use of the sign affects the right to the name, image or prestige of a local, regional or national community, unless proof is provided that the competent authority of that community has given its explicit consent;
- (h) Where the use of the sign is likely to be confused with a protected appellation of origin (**repealed by Law No. 8632**);
- (i) where the sign constitutes a reproduction or imitation, in full or in part, of a protected certification trademark from an earlier date (**as repealed by Law No. 8632**);
- (j) where the sign is likely to infringe the copyright or industrial property right of a third party;
- (k) where registration of the sign is sought to perpetrate or consolidate an act of unfair competition.

CHAPTER II

Procedure for trademark registration

Article 9.- Applications for registration. Applications for trademark registration shall be filed with the Industrial Property Registry and shall contain the following:

- (a) the applicant's name and address;
- (b) the applicant's place of incorporation and residence, in the case of a legal entity;
- (c) the name of the legal representative, as applicable;
- (d) the name and address of the agent in the country, where the applicant has neither a domicile nor a real and effective commercial establishment in the country;
- (e) the mark applied for, in the case of a word mark, without graphics, form or special color;
- (f) a reproduction of the mark in the number of copies determined by the Regulations under this Law, in the case of word marks with special graphics, form or color, or figurative, mixed or three-dimensional marks with or without color;
- (g) a translation of the mark, where it is composed of any word component with meaning in a language other than Spanish;
- (h) a list of the names of the goods or services for which the mark is used or will be used, grouped together by class according to the Nice International Classification of Goods and Services, with an indication of the number of class;
- (i) the documents or authorizations required for the cases provided for in Article 7(m), (n) and (p) and Article 8(f) and (g) of this Law, as appropriate;
- (j) proof of payment of the basic fee set.

Applicants may file with the Registry in person, with the help of a lawyer and notary, or through an agent. Where agents handle filing, they shall present the corresponding power of attorney, in accordance with the requirements of Article 82*bis* of this Law. If an entry is made in the Industrial Property Registry concerning said power of attorney, it shall indicate the trademark file, its number and the application or registration number where it is to be found; agents may act up to the limits of the powers initially granted.

Where applicants wish to claim the priority of an earlier application, they shall submit the declaration of priority and the documents referred to in paragraphs three and four of Article 5 of this Law, together with the application for registration and within the periods set. Declarations of priority shall contain the following information:

- (a) the name of the country or the regional office where the priority application was filed;
- (b) the filing date of the priority application;
- (c) the number of the priority application, if a number was assigned.

Article 10.- Admission for processing of filed applications. The Industrial Property Registry shall assign a date and time of filing to applications for registration, and shall accept them for processing if they meet the following requirements:

- (a) they contain indications making it possible to identify the applicant;
- (b) they indicate an address or appoint a representative in the country;
- (c) they show the trademark applied for or, in the case of word marks with graphics or a special form or color or figurative, mixed or three-dimensional marks with or without color, they contain a reproduction of the mark;

- (d) they contain the names of the goods or services for which the mark is or will be used, as well as indicating the class;
- (e) they include proof of full payment of the basic fee **(as amended by Law No. 8632)**.

Article 11.– Amendment and division of applications. Applicants may amend or correct their applications at any time during processing. No amendments or corrections shall be accepted if they entail an essential change to the mark or a broadening of the list of goods or services submitted in the initial application. However, the list may be shortened or limited.

Applicants may divide their application at any time during the processing, with a view to separating the goods or services contained in the list from the initial application into two or more applications. No division shall be accepted if it entails a broadening of the list of goods or services presented in the initial application, but the list may be shortened or limited. Each divisional application shall retain the filing date of the initial application and the right of priority, as appropriate.

The amendment, correction or division of applications shall be subject to payment of the set fee.

Article 12.– Withdrawal of applications. Applicants may withdraw their application at any time during processing. If they do so, they shall not be entitled to the reimbursement of the fees paid.

Article 13.– Examination of form. The Industrial Property Registry shall ascertain whether applications meet the requirements set out in Article 9 of this Law and the corresponding regulatory provisions, for which it shall have a period of 15 working days beginning from the date of receipt of an application.

In the event of non-compliance with any of the requirements listed in Article 9 of this Law or the corresponding regulatory provisions, the Registry shall notify the applicant so that he may remedy the error or omission within a period of 15 working days, beginning from the corresponding notification, failing which the application shall be deemed abandoned.

Article 14.– Substantive examination. The Industrial Property Registry shall ascertain whether the mark is subject to any of the prohibitions provided for in Articles 7 and 8 of this Law.

If the mark is subject to one of the above-mentioned prohibitions, the Registry shall notify the applicant, indicating the reasons which preclude registration and giving the applicant a period of 30 working days, beginning from the corresponding notification, to answer. If this period elapses without an answer from the applicant or if he answers but the Registry considers that the objections raised still persist, the registration shall be rejected by means of a reasoned decision.

Article 15.– Publication of applications. Once the examinations provided for in Articles 13 and 14 of this Law have been carried out, the Industrial Property Registry shall order that applications be announced via the publication, on three occasions and at the interested party's expense, of a notice in the Official Gazette, within a period of 15 days following notification.

The notice to be published shall contain the following:

- (a) the applicant's name and address;
- (b) the name of the representative or agent, as applicable;
- (c) the filing date of the application;
- (d) the application number;
- (e) the mark applied for;
- (f) a list of the goods or services to which the mark will apply and the corresponding classes.

Article 16.– Opposition to registration. Any interested party may file an opposition to a trademark registration within a period of two months, beginning from the first publication of the notice announcing the application. The opposition shall be filed with the reasons *de facto* and *de jure*, and shall be accompanied by the relevant proof which is available.

In the event that the proof is not submitted with the opposition, it shall be submitted within a period of 30 calendar days following the filing date of the opposition.

The opposition shall be notified to the applicant, who shall have two months to answer, beginning from the date of notification. Once this period expires, the Industrial Property Registry shall decide on the application, even if there has been no reply to the opposition.

Article 17.– Opposition based on an unregistered trademark. A substantiated opposition to the prior use of a trademark shall be declared inadmissible if the party opposing registration fails to prove to the Industrial Property Registry that he has registered the mark used. The Registry shall group together the files relating to the application for registration which forms the subject matter of the opposition and to the application for registration of the mark used, with a view to deciding on them together.

Parties opposing registration shall file an opposition within 15 days beginning from the filing of the application. Where the prior use of the mark by the party opposing registration has been proven and the trademark registration requirements stipulated in this Law have been met, registration shall be granted. Registration may also be granted for a mark which is likely to create confusion; in this case, the Registry may limit

or reduce the list of goods and services for which each of the marks may be used, and set other conditions relating to their use, where this is necessary to avoid a risk of confusion.

Article 18.– Decisions. If one or more oppositions have been filed, they shall be resolved, together with the main features of the application, in a single act, through a reasoned decision.

Where the complete rejection of the registration applied for is not warranted or where the opposition filed is limited and the coexistence of both marks is not likely to create confusion, registration may be granted solely for any of the goods or services indicated in the application, or granted with an explicit limitation for specific goods or services.

A trademark registration shall not be rejected owing to the existence of a prior registration if the defense provided for in the second paragraph of Article 39 of this Law is invoked and proves to be well-founded.

If no opposition is filed within the period set, the Industrial Property Registry shall register the mark.” **(as amended by Law 8632)**

Article 19.– Registration certificates. The Industrial Property Registry shall send owners a trademark registration certificate containing the information included in the corresponding registration and the information required by regulatory provisions.

CHAPTER III

Term, renewal and amendment of registration

Article 20.– Term and renewal of registration. Registration of a mark shall be valid for a period of ten years, beginning from the date of its grant. The mark may be renewed indefinitely for further periods of ten years, beginning from the previous date of expiry.

Article 21.– Procedure for registration renewals. Registrations shall be renewed through the filing, with the Industrial Property Registry, of the corresponding request, which shall contain:

- (a) the owner's name and address;
- (b) the number of the registration being renewed;
- (c) the name and address of the agent in the country, as applicable, but only where this is necessary to accredit the agent if he is different from the one appointed for the registration that is being renewed or for the previous renewal; if the agent is the same, it shall be necessary to indicate the file, the name of the mark and the number of the filing or registration where the power of attorney is to be found;
- (d) a list of goods or services in accordance with the reduction or limitation sought, where the aim is to reduce or limit the goods or services covered by the registration that is being renewed. The goods or services shall be grouped together by classes, in accordance with the International Classification of Goods and Services, with an indication of the number of each class;
- (e) proof of payment of the fee set.

Requests for renewal may only refer to a registration and shall be filed during the year preceding the date of expiry of the registration that is being renewed. Such requests may also be filed during the grace period of six months following the date of expiry; in this case, however, a given surcharge must be paid, in addition to the corresponding renewal fee. Registrations shall remain fully in force during the grace period.

Renewal of trademark registrations shall be valid from the date of expiry of the previous registration, even if renewal was requested during the grace period.

Once the requirements stipulated in the first and second paragraphs of this Article have been met, the Industrial Property Registry shall record the renewal without further formalities. Renewal shall not give rise to substantive examination or publication.

Article 22.– Amendment of renewal. Renewals may not contain any change to the mark or broadening of the list of goods or services covered by the registration.

Renewal entries shall indicate any reduction or limitation placed on the list of goods or services distinguished by the mark.

Article 23.– Correction and limitation of registrations. Owners of registrations may at any time request that their registration be amended to correct an error. The correction shall not be accepted if it involves an essential change to the mark or a broadening of the list of goods or services covered by the registration.

Owners of registrations may at any time request a reduction or limitation in the list of goods or services covered by their registration. If there is an entry of any right relating to the mark in respect of third parties, only the reduction or limitation shall be entered, subject to submission of a written statement by the third party, signed before a notary, to the effect that he is aware that the list is reduced or limited.

Requests for correction, reduction or limitation of registration shall be subject to the set fee.

Article 24.– Division of registrations. Owners of registrations may at any time request a division of a trademark registration with a view to separating the goods or services listed in the initial registration into two or more registrations. Each divisional registration shall retain the initial registration date.

Requests for division shall be subject to payment of the set fee.

CHAPTER IV **Rights, obligations and limitations relating to registration**

Article 25.– Rights conferred by registration. Owners of a factory mark or trademark that has already been registered shall enjoy an exclusive right to prevent third parties from using identical or similar signs in trade without their consent, including geographical indications and appellations of origin, for goods or services which are identical or similar to those registered for the mark, where use gives rise to the likelihood of confusion. In the case of use of an identical sign, including geographical indications and appellations of origin, for identical goods or services, it shall be assumed that there is a likelihood of confusion. Consequently, trademark registration shall confer on owners or their rightful claimants the right to take action against third parties who perform any of the following acts without their consent: **(as amended by Law No. 8632)**:

- (a) applying or affixing the mark or an identical or similar distinctive sign to goods or services for which the mark has been registered or to goods, wrapping, envelopes, packaging or conditioning for those goods in relation to the goods or services for which the mark has been registered; **(as amended by Law No. 8632)**
- (b) deleting or changing the mark for commercial purposes after having applied or affixed it to the goods or services referred to in the preceding subparagraph;
- (c) producing labels, packaging, packing, wrapping or other similar materials which reproduce or contain the mark, as well as marketing or holding such materials;
- (d) filling or reusing, for commercial purposes, wrapping, packaging or packing identified by the mark;
- (e) using in trade a sign that is identical or similar to the mark for goods or services where such use may create confusion or a risk of association with the owner of the registration;
- (f) using in trade a sign that is identical or similar to the mark for goods or services where such use may cause unfair economic or commercial damage to the owner or rightful claimant of the registration, by diminishing the distinctiveness or commercial value of the mark, or by taking unfair advantage of the repute of the mark or the customer base created for its use.

For the purposes of this Law, the act of using a sign in trade, either inside or outside the country, shall be defined *inter alia* by the following uses:

- (a) introducing into trade, selling, offering for sale or distributing goods or services bearing the sign, in the conditions determined by the said sign;
- (b) importing, exporting, storing or transporting goods bearing the sign;
- (c) using the sign in advertising, publications, business documents and written or oral communications, without prejudice to the applicable rules on advertising.

Article 26.– Limitations on the right in a mark. Trademark registration shall not confer the right to prevent a third party from using the following in respect of goods or services in trade:

- (a) his name or address or that of his business establishments;
- (b) indications or information on the characteristics of his goods or services, *inter alia* those referring to quantity, quality, use, geographical origin or price;
- (c) indications or information in respect of the availability, use, application or suitability of his goods or services, particularly in relation to spare parts or accessories.

The limitation referred to in the preceding subparagraph shall apply provided that use has been in good faith, does not constitute an act of unfair competition and is not likely to create confusion as to the undertaking from which the goods or services have originated.

Article 27.– Exhaustion of rights. Trademark registration shall not give owners the right to prevent a third party from using the mark for legitimately marked goods which have been introduced into trade, in the country or abroad, provided that those goods and the wrappings or packaging in immediate contact with them have not been changed, altered or damaged in any way that could harm the interests of the owners or their rightful claimants.

Article 28.– Unprotected elements in complex marks. Where trademarks consist of a label or other sign composed of a series of elements, protection shall not extend to the elements contained therein which are in everyday or necessary use in trade.

Article 29.– Adoption of foreign trademarks as company names. Legal entities may not establish or enter themselves in a public registry with a business name or company name which includes a mark registered to a third party where use of such a name may cause confusion, unless said third party gives his written consent.

Article 30.– Indication of the origin of goods. All goods marketed in the country shall clearly indicate the production or manufacturing site for the goods, the name of the producer or manufacturer, the relationship between said producer or manufacturer and the owner of the mark used on the product, where this is not the same person, without prejudice to the rules applicable to labeling or consumer information.

CHAPTER V
Assignments and licensing for trademark use

Article 31.– Trademark assignments. Rights in trademarks which are registered or applied for may be assigned *inter vivos* or transferred by succession. Assignments shall be evidenced in writing and shall be recorded to be binding on third parties. Recording shall be subject to payment of the fee established in this Law.

Any request for trademark assignment shall contain the information referred to in subparagraphs (a), (b), (c), (d) and (e) below, and shall be accompanied by the documents mentioned in subparagraphs (f), (g) and (h).

- (a) the name and address of the parties;
- (b) an indication of the mark;
- (c) an indication of trademark classification;
- (d) an indication of the goods or services protected by the mark;
- (e) the valuation of transfer posting;
- (f) the transfer document signed by both parties and, as applicable, the document legalized and authenticated by the Consul of Costa Rica;
- (g) a power of attorney for any of the parties which, as applicable, has been duly legalized and authenticated by the Consul of Costa Rica. Where the agent is already acting on behalf of any of the parties, the power of attorney shall be accompanied by the name of the mark and the application or registration number where it may be found;
- (h) proof of payment of the respective fee.

Article 32.– Change in owner's name. Persons who have changed or modified their name, trade name or company name in accordance with the law shall ask the Industrial Property Registry to note the change or modification in the particulars of the distinctive signs held in their name.

A request for such change or modification shall include:

- (a) the applicant's name and address;
- (b) an indication of the signs and the application or registration number;
- (c) an indication of whether a change in name or a merger between companies is involved, *inter alia*;
- (d) an indication of the applicant's new name;
- (e) the power of attorney for the company arising from the change, duly legalized and authenticated;
- (f) the document evidencing the change, duly legalized and authenticated;
- (g) proof of payment of the respective fee.

Once this change has been examined, the Industrial Property Registry shall issue the person concerned with a decree which shall be published, at his expense and once only, in the Official Gazette.

Once such publication has been made, the Industrial Property Registry shall issue the certificate corresponding to the change or modification.

Article 33.– Free assignment of trademarks. Rights in trademarks may be assigned separately from the right holder's company or share of the company, and in respect of one, several or all of the goods or services for which the mark is registered. Where assignment is limited to a good or service or to some of them, the registration shall be divided and a new registration shall be opened on behalf of the acquirer.

Assignments and the corresponding entries shall be annulled where the change in the ownership of a right is likely to cause a risk of confusion.

Article 34.– Assignments of trademarks together with the company. Owners of registered trademarks shall be entitled to assign them with or without the transfer of the company to which they belong.

Trademarks which consist of their holder's business name may only be assigned with the company or establishment identifying the said name.

Article 35.– Licensing for trademark use. Holders of rights in trademarks which are registered or applied for may grant a license for use. Registration of such licenses shall not be a requirement for their validity, for asserting any right in a trademark, or for other purposes as well. However, such licenses may be registered for the purposes of certainty and registration publicity. If a transferee decides to record his right, the entry sought shall be subject to payment of the fee established in Article 94 of this Law. **(as amended by Law No. 8632).**

Requests for licenses for trademark use shall contain information on the type of license, the duration and the territory covered, in addition to meeting the requirements laid down in the second paragraph of Article 31 of this Law.

Requests for licenses for trademark use shall be accompanied by the licensing documents signed by both parties and duly authenticated. They shall also be accompanied by the documents referred to in subparagraphs (b), (c), (g) and (h) of Article 31 of this Law. **(as amended by Law No. 8632).**

Unless stipulated otherwise, the following rules shall apply in a licensing contract:

- (a) the licensee shall be entitled to use the mark during the entire period of registration, including its renewals, throughout the national territory and in respect of all goods and services for which the mark is registered;
- (b) the licensee may not assign the license or grant sublicenses;

(c) where an exclusive license has been granted, the licensor may not grant other licenses in respect of the same mark or the same goods or services. Nor may he use the mark in the country for himself in relation to those goods or services.

CHAPTER VI **Termination of trademark registration**

Article 36.– Quality control. Provided that the principles of due process are respected, at the request of any party with a legitimate interest and subject to a hearing of the owner of the trademark registration, the Registry may annul the registration of the licensing contract and prevent the licensee from using a mark where, due to a lack of adequate quality control or any other misuse of the license, serious confusion, deception or grave prejudice occurs or is likely to occur for public consumers.
The Regulations under this Law shall establish the corresponding procedure while respecting due process.

Article 37.– Invalidation of registration. Provided that the principles of due process are respected, at the request of any party with a legitimate interest or *ex officio*, the Industrial Property Registry shall invalidate the registration of a mark if it infringes any of the prohibitions provided for in Articles 7 and 8 of this Law. It may not invalidate a trademark registration on grounds that have ceased to be applicable at the time of the invalidation proceedings. Where the grounds for invalidation have only applied to some of the goods or services for which the mark is registered, invalidation shall apply only to those goods or services, which shall be deleted from the respective list in the registration of the mark.

Invalidation proceedings shall lapse after four years, beginning from the date on which registration is granted.

Trademark registration may not be invalidated owing to a prior registration, if the defense provided for in the second paragraph of Article 39 of this Law is invoked and substantiated.

A request for invalidation may be filed as a defense or as a counterclaim, in any proceedings for infringement of a trademark registration.

The declaration of invalidation shall be of a purely declarative nature and shall be back dated to the time of the act, without prejudice to any rights acquired in good faith.

Invalidations declared *ex officio* shall be governed by the provisions of Article 173 (1) and (3) of Law No. 6227 of May 2, 1978, the General Law of Public Administration.

Article 38.– Cancellation because a mark has become widespread. At the request of any party with a legitimate interest and provided that due process is respected, the Industrial Property Registry may cancel a trademark registration or limit its scope where the owner has caused or allowed the trademark to become the generic name for one or more of the goods or services for which it is registered.

A trademark shall be deemed to have become a generic name where, in business circles and for the public, it has lost its distinctive character as an indicator or the corporate origin of the good or service to which it applies. For these purposes, the following circumstances must apply in respect of the trademark:

- (a) the lack of another suitable name to designate, in trade, the good or service to which the trademark applies;
- (b) widespread use of the trademark, by the public and in business circles, as a common or generic name for the respective good or service;
- (c) the public's lack of knowledge of the trademark as a distinctive sign of a given corporate origin.

Article 39.– Cancellation of trademark registrations due to lack of use. At the request of any interested party and provided that the owner of the trademark registration is heard, the Industrial Property Registry shall cancel the registration of a trademark which has not been used in Costa Rica for the five years prior to the date on which cancellation proceedings are initiated. Requests for cancellation shall not be entertained until five years have passed, beginning from the date of trademark registration.

Cancellation of registrations due to failure to use the trademark may also be requested as a defense against an objection by the Industrial Property Registry, an opposition by a third party to the trademark registration, a request for invalidation of a trademark registration, or proceedings for infringement of a registered trademark. In such cases, cancellation shall be decided by the Industrial Property Registry.

Where trademark use has been initiated after five years have passed, beginning from the date of grant of the respective registration, such use shall only prevent cancellation of the registration if it were initiated at least three months before the date on which the request for cancellation is filed.

Where failure to use affects only one or some of the goods or services for which the mark has been registered, the cancellation of registration shall take the form of a reduction or limitation of the list of goods or services covered by the registration and shall eliminate those in respect of which the trademark has not been used.

Article 40.– Definition of trademark use. Trademarks shall be deemed to be in use where the goods or services that they distinguish have been placed on sale with the trademarks, in the quantity and the way in which this is normally done, taking into consideration the size of the market, the nature of the goods or services involved and the conditions under which they are marketed. "Trademark use" shall further be defined as its utilization in

respect of goods intended for export from the national territory or with services offered abroad from the national territory.

Registered trademarks shall be used in trade as they appear in the registration; however, use of trademarks in a manner that is different from the way in which they appear in the registration in respect only of details or elements which are not essential or do not alter the identity of the trademark shall not provide grounds for canceling the registration or diminishing the protection it affords.

Use of trademarks by a licensee or any other party authorized to use them shall be considered to be effected by the owner of the registration, for all purposes relating to trademark use.

Article 41.– Provisions relating to trademark use. A trademark registration may not be canceled due to failure to use where there are justified reasons for such failure.

Justified reasons for failure to use shall be defined as circumstances which occur independently of the will of the trademark owner and which constitute an obstacle to its use, such as import restrictions or other official requirements imposed on the goods or services protected by the trademark.

Article 42.– Proof of trademark use. The burden of proof in respect of trademark use shall be placed on the party alleging the grounds for invalidation.

Trademark use shall be evidenced by any means of proof accepted by the law showing that a trademark has actually been used.

Article 43.– Renunciation of registration at the owner's request. Owners of trademark registrations may at any time request the Industrial Property Registry to cancel their registration. Requests for cancellation shall be subject to payment of the fee set in Article 94 of this Law.

Where a third party right has been entered in respect of the trademark, cancellation shall only be recorded following submission of a written statement by the third party signed before a notary and attesting that he is aware of cancellation.

TITLE III Well-known trademarks

Article 44.– Protection of well-known trademarks. The provisions of Title II shall be applicable in the matter at hand to well-known trademarks, subject to the special provisions contained in this Title.

This Law recognizes the right, for owners of a well-known mark, as defined by Joint Recommendation No. 833, of September 1999, of WIPO and the Assembly of the Paris Union, to prevent unauthorized third parties from taking unfair advantage of the repute of a trademark or diminishing its distinctiveness or commercial or advertising value. The Industrial Property Registry may, *ex officio* or at the request of the interested party, reject or cancel the registration and prohibit the use of a factory mark or trademark or service mark which constitutes a written reproduction, imitation or translation of a well-known mark, registered or not, and is used for identical or similar goods, which is likely to create confusion. **(as amended by Law No. 8632)**

The Industrial Property Registry may not register as trademarks signs which are identical or similar to a well-known trademark, registered or not, to be applied to any good or service, where trademark use by the applicant for registration may create confusion or a risk of association with the goods or services of the person who uses that trademark, take unfair advantage of the repute of the trademark or suggest a connection with it, and where its use may harm the interests of that person. **(as amended by Law No. 8632)**

The provisions of the third paragraph of this Article shall not apply where the applicant is the owner of the well-known trademark.

All means of proof may be used to demonstrate the repute of the trademark.

Article 45.– Criteria for recognizing repute. To determine whether a trademark is well known, the following criteria shall, *inter alia*, be taken into consideration:

- (a) the degree of recognition by the relevant sector of the public, as a distinctive sign of the goods or services for which it was granted;
- (b) the intensity and scope of dissemination and advertising or promotion of the trademark;
- (c) the age of the trademark and its constant use;
- (d) an analysis of production and the market for the goods distinguished by the trademark.

TITLE IV Collective trademarks

Article 46. – Applicable provisions. The provisions of Title II shall apply to collective trademarks, subject to the special provisions contained in this Title.

Article 47. – Applications for registration of collective trademarks. Applications for registration of collective trademarks shall indicate that the subject matter is a collective trademark and include three copies of the regulations for its use.

Regulations for use of a collective trademark shall specify the common characteristics or qualities of the goods or services for which the trademark is to be used, the conditions and arrangements under which the trademark may be used, and the persons authorized to use it. They shall also contain provisions designed to ensure and monitor that the trademark is used in accordance with the regulations for use and provide for sanctions in case of non-compliance with the regulations.

Article 48. – Examination of applications for collective trademarks. The examination of applications for registration of collective trademarks shall include verification that the requirements of Article 47 of this Law have been met.

Article 49. – Registration and publication of collective trademarks. Collective trademarks shall be recorded in the trademark registry, along with a copy of the regulations for use of the trademark.

Article 50. – Changes to the regulations for use of a collective trademark. The changes made to the regulations for use of a collective trademark shall be communicated by its owner to the Industrial Property Registry, and shall be recorded following payment of the fee established in Article 94 of this Law.

Article 51. – Licenses for collective trademarks. Collective trademarks may not be licensed for use to persons other than those authorized to use such trademarks in accordance with the regulations for their use.

Article 52. – Use of collective trademarks. The holder of a collective trademark may use the trademark for himself, provided that it is also used by the persons authorized, in accordance with the regulations for use of the trademark.

Use of collective trademarks by authorized persons shall be considered to have been made by the owner.

Article 53. – Invalidation of registration of collective trademarks. At the request of any interested party and provided that the owner of the trademark registration is heard, the Registry may invalidate the registration of a collective trademark in any of the following cases:

- (a) where the mark was registered in violation of Articles 7 or 8 of this Law;
- (b) where the regulations for use of the trademark are contrary to morality or public order;
- (c) where, for more than one year, the collective trademark has been used only by its owner and not by the persons authorized in accordance with the regulations for use of the trademark;
- (d) where the owner of the collective trademark uses it or permits its use in a way that contravenes the provisions of its regulations for use or in a way which is likely to mislead business circles or the public, as to the origin or any other characteristic of the goods or services for which the trademark is used.

The Registry shall act on its own initiative and declare invalidation if a trademark were registered in violation of Articles 7 or 47 of this Law. In any event, it shall ensure the application of the principles of due process and the provisions of Article 173 (1) to (3) of Law No. 6227 of May 2, 1978, the General Law of Public Administration.

Title V Certification marks

Article 54. – Applicable provisions. The provisions of Title II shall apply to certification marks, subject to the special provisions contained in this Title.

Article 55. – Ownership of certification marks. The following may hold a certification mark: a company or institution under private or public law, or a State or para-State, national, regional or international body which is competent to conduct quality certification activities.

Article 56.– Registration formalities. Registration applications for certification marks shall be accompanied by regulations for use of the mark, which shall fix the characteristics guaranteed by the presence of the mark and the

way in which quality is to be controlled before and after authorization is granted for its use. The regulations shall be adopted by the competent administrative authority, depending on the good or service in question, and shall be registered along with the mark.

Article 57.– Term of registration. Where the owner of the registration of a certification mark is a State or para-State body, registration shall be of indefinite duration and shall expire with the dissolution or disappearance of the owner. In other cases, mark registration shall be for ten years, and may be renewed. Registration of a certification mark may be cancelled at any time at the owner's request.

Article 58.– Use of certification marks. The owner of a certification mark shall authorize use of the mark for any party whose good or service, as the case may be, meets the conditions stipulated in the regulations for use of the trademark. Certification marks may not be used for goods or services produced, provided or marketed by the mark owner himself.

Article 59.– Encumbrances and assignments in respect of certification marks. Certification marks may not be the subject of any charges or encumbrances, embargoes or other precautionary or judicial enforcement measures. Certification marks may only be assigned with the entity which owns the registration. In the event of the dissolution or disappearance of said entity, a certification mark may be assigned to another suitable entity, subject to authorization by the competent government authority.

Article 60.– Reservation concerning expired certification marks. A certification mark whose registration is cancelled or is no longer used owing to the dissolution or disappearance of its owner may not be used or registered as a distinctive sign for a period of 10 years, beginning from cancellation, dissolution or disappearance, as the case may be.

TITLE VI

Expressions or signs of commercial advertising

Article 61.– Application of the provisions concerning marks. Except for the provisions contained in this Title, the rules concerning marks which are contained in this Law shall apply to expressions or signs of commercial advertising.

Article 62.– Prohibitions on registration. Expressions or signs of commercial advertising that include any of the following cases may not be registered as trademarks:

- (a) one which is covered by any of the prohibitions laid down in Article 7 (c), (d), (h), (i), (j), (l), (m), (n), (o) or (p) of this Law;
- (b) one which is identical or similar to another which is already registered, applied for or in use by a third party;
- (c) one which includes the distinctive sign of another, without due authorization;
- (d) one whose use in trade is likely to cause confusion in respect of the goods, services, companies or establishments of a third party;
- (e) one which is covered by any of the prohibitions laid down in Article 8 (e), (f), (g), (h), (i), (j) or (k) of this Law;
- (f) one whose use in trade constitutes an act of unfair competition.

Article 63.– Scope of protection. The protection conferred by the registration of expressions or signs of commercial advertising shall cover the expressions or signs as a whole and shall not extend to the parts or elements thereof considered separately.

Once registered, expressions or signs of commercial advertising shall enjoy protection indefinitely; however, their existence shall depend, as the case may be, on the trademark or business name to which they refer.

TITLE VII

Trade names and emblems

CHAPTER I

Trade names

Article 64.– Acquisition of the right in a trade name. Exclusive rights in a trade name shall be acquired through its first use in trade, and shall end with the closure of the company or establishment which uses it.

Article 65.– Unacceptable trade names. Trade names may not consist, in full or in part, of a designation or other sign which is contrary to morality and public order or likely to cause confusion, in business circles or among the public, as to the identity, nature, activities, line of business or any other matter relating to the company or establishment identified with the trade name or as to the corporate source, origin or other characteristics of the goods or services produced or marketed by the company.

Article 66.– Protection of trade names. Owners of trade names shall be entitled to initiate proceedings against any third party who, without their consent, uses a distinctive sign in trade which is identical to the protected trade name or a similar distinctive sign, where this is likely to cause confusion or a risk of association with the owner's company or its goods or services.

The provisions of Articles 26 and 27 of this Law shall apply to trade names, as appropriate.

Article 67.– Registration of trade names. Owners of trade names may apply for entry in the Industrial Property Register.

Registration of trade names shall be indefinite and shall expire with the company or establishment which uses a trade name. It may be cancelled at any time, at the owner's request.

Trade names shall be entered in the Industrial Property Register, without prejudice to the provisions relating to the recording of traders and civil and commercial companies in the corresponding public registers, without prejudice to the rights arising therefrom.

Article 68.– Procedure for registration of trade names. Trade names and the modification or cancellation thereof shall be registered as appropriate, according to the procedures established for trademark registration, and shall be subject to the payment of the fee set. The Industrial Property Registry shall ascertain whether a trade name violates Article 66 of this Law.

The classification of goods and services used for trademarks shall not apply to the registration of trade names.

Article 69.– Assignment of trade names. Trade names may only be assigned together with the company or establishment which uses them or with the part of the company or establishment which uses them.

Assignment of trade names which are registered or applied for shall be recorded in the Industrial Property Register, according to the procedure applicable to the assignment of trademarks, as appropriate, and shall be subject to payment of the same fee.

CHAPTER II Emblems

Article 70.– Protection of emblems. The protection and registration of emblems shall be regulated by the provisions relating to trade names.

TITLE VIII Geographical indications in general

CHAPTER I Geographical indications in general

Article 71.– Use of geographical indications. Geographical indications may not be used in trade for any means related to the designation or presentation of a good or service where such indication is false or, even though it is literally true for the territory, region or locality of origin of the goods or services, indicates or suggests to the public a false or misleading idea of the origin of such goods or services, or where use may mislead or cause confusion among the public as to the origin, source, characteristics or qualities of the goods or services.

Nor may geographical indications be used in a way that constitutes an act of unfair competition, as defined by Article 10*bis* of the Paris Convention.

Article 72.– Use of advertising. It shall be prohibited to use in advertising or in commercial documentation relating to the sale, display or offering of goods or services an indication likely to mislead or cause confusion as to the geographical source of the goods, because they do not originate in the place designated by the geographical indication, or where, even if the true origin of the good or service is indicated, this is also likely to create confusion among the public. Nor shall expressions such as "class", "type", "style", "imitation" or similar be accepted for trademark registration.

Article 73.– Indications relating to traders. Any trader may indicate his name or address on the goods or services he sells, even where they come from abroad, provided that the name or address is accompanied by a specific reference, in sufficiently prominent characters, of the country or place of manufacture or production of the goods or another reference which is sufficient to avoid any error as to their true origin.

CHAPTER II

Appellations of origin and geographical indications (as amended by Law No. 8632)

“Article 74.– Registration of appellations of origin and geographical indications

The Industrial Property Registry shall keep a register of appellations of origin and geographical indications. National or foreign appellations of origin and geographical indications shall be registered at the request of one or more producers, manufacturers or craftsmen, whose establishment for production or manufacture is located in the region or locality to which the appellation of origin or geographical indication corresponds, or at the request of any competent public authority.

In the case of homonymous geographical indications or appellations of origin, protection shall be granted to each one, subject to the provisions of the first paragraph of Article 71 of this Law. The Regulations shall set out the conditions for differentiating the homonymous indications or appellations in question, taking into consideration the need to ensure that the goods concerned receive equal treatment and consumers are not misled.” **(as amended by Law No. 8632)**

Article 75.– Prohibitions on registration

Following a request by a party with a legitimate interest or *ex officio*, the Industrial Property Registry may not register any sign as an appellation of origin or a geographical indication which:

- (a) does not comply with the definition of appellation of origin or geographical indication contained in Article 2 of this Law;
- (b) is contrary to good practices or public order or could mislead the public as to the geographical origin, nature, manufacturing method, characteristics or qualities or suitability for use or consumption of the respective goods;
- (c) is the common or generic name for a good. A name shall be deemed common or generic where it is considered as such by those familiar with this type of product and by the public in general;
- (d) is likely to cause confusion with a trademark, geographical indication or appellation of origin which is the subject of a pending application or registration filed in good faith;
- (e) is likely to cause confusion with a trademark or geographical indication or appellation of origin used from an earlier date by a third party with a better right to obtain registration thereof, in accordance with Article 17 of this Law, for the same goods or services or for goods or services which, albeit different, are likely to be associated with those distinguished by the respective trademark, geographical indication or appellation of origin in use.

Appellations of origin or geographical indications may be registered together with the generic name of the respective good or an expression related to this good, but protection shall not extend to the generic name or to the expression used. **(as amended by Law No. 8632)**

Article 76.– Applications for registration

Applications for registration of appellations of origin or geographical indications shall indicate:

- (a) the name, address and nationality of the applicants and the place where their establishments of production or manufacture are located;
- (b) the appellation of origin or geographical indication applied for;
- (c) the geographical area of production to which the appellation of origin or geographical indication refers;
- (d) the goods or services for which the appellation of origin or geographical indication is used;
- (e) an overview of the essential qualities or characteristics of the goods or services for which the appellation of origin or geographical indication is used.

Applications for registration of a geographical indication or appellation of origin shall be subject to the payment of the fee set, except where registration is sought by a public authority. In the case of foreign public authorities, this exemption shall be subject to reciprocity. **(as amended by Law No. 8632)**

Article 77.– Registration procedure

Applications for registration of appellations of origin or geographical indications shall be examined to ascertain whether:

- (a) they meet the requirements of Article 76 of this Law and the corresponding regulatory provisions;
- (b) the appellations of origin or geographical indications applied for are not subject to any of the prohibitions provided for in the first paragraph of Article 75 of this Law.

Procedures relating to the examination and registration of appellations of origin and geographical indications shall be governed, as appropriate, by the provisions concerning the registration of trademarks. **(as amended by Law No. 8632)**

Article 78.— Grant of registration

Decisions to grant the registration of an appellation of origin or geographical indication and the corresponding entry shall indicate:

- (a) the delimited geographical area of production whose producers, manufacturers or craftsmen shall be entitled to use the appellation or geographical indication;
- (b) the goods or services to which the appellation of origin or geographical indication applies;
- (c) the essential qualities or characteristics of the goods or services to which the appellation of origin or geographical indication shall apply, except where, owing to the nature of the good or service or other circumstances, it is not possible to specify such characteristics.

Registration of appellations of origin and geographical indications shall be published in the Official Gazette *La Gaceta*. **(as amended by Law No. 8632)**

Article 79.— Term and amendment of registration

Registration of appellations of origin or geographical indications shall be of indefinite duration. They may be amended at any time if there is a change in any of the points referred to in the first paragraph of Article 78 of this Law. Amendments of registration shall be subject to payment of the required fee and shall be subject, as appropriate, to the procedure laid down for the registration of appellations of origin and geographical indications. **(as amended by Law No. 8632)**

Article 80.—Right to use appellations of origin or geographical indications

Only those producers, manufacturers or craftsmen who have been authorized to use commercially a registered appellation of origin or geographical indication may use, next to it, the expression “appellation of origin” or “geographical indication”.

Proceedings relating to the right to use a registered appellation of origin or geographical indication shall be brought before the courts.

The provisions of Articles 26 and 73 of this Law shall apply, as appropriate, to registered appellations of origin and geographical indications. **(as amended by Law No. 8632)**

Article 81.— Cancellation of registration

At the request of any party with a legitimate interest, the Registry shall invalidate the registration of an appellation of origin or geographical indication where it is proven to be subject to any of the prohibitions laid down in Article 75 of this Law, or where the appellation of origin or geographical indication is used in trade in a way that does not correspond to that which is indicated in the respective entry, in accordance with the first paragraph of Article 78 of this Law.” **(as amended by Law No. 8632)**

**TITLE IX
Common rules**

**CHAPTER I
Procedures**

Article 82.— Representation. Where the applicant or the holder of an industrial property right has his domicile or headquarters outside Costa Rica, he shall be represented by an agent domiciled in the country.

Applicants may deal with the Registry in person, with the help of a lawyer or notary, or through an agent. Agents shall present the corresponding power of attorney, in accordance with the requirements of Article 82bis of this Law. If the said power of attorney is recorded in the Industrial Property Register, it shall indicate the trademark file, the name thereof and the number of the application or registration in which it is to be found; agents may act to the limit of the powers initially authorized. **(as amended by Law No. 8632)**

In serious and urgent cases, which have been so characterized by the Industrial Property Registrar, representation may be ensured by an unofficial agent who is a lawyer and provides sufficient guarantees, also characterized by the said official, to follow the case, if the interested party does not agree to the agent’s acting on his behalf.

“Article 82bis.— Powers of attorney for intellectual property

The requirement for acting on behalf of a natural person or legal entity in respect of any of the acts related to intellectual property shall be the authorization of the principal, in an authenticated mandate with minimum formality, which in any case shall not require registration.

Where the power of attorney covers other countries, it may be formalized in accordance with the domestic law of the country granting it, and shall be authenticated.

Unless otherwise stipulated, any agent shall be deemed to have sufficient authorization to carry out all of the acts authorized by law for the specific holder of the respective intellectual or industrial property rights, in respect of any authority, office or public registry, for recording, registration, renewal, transfer, licensing and other

applicable acts, the conservation or defense of his rights, both at the administrative headquarters and in court, in all of their bodies and authorities.” **(as amended by Law No. 8632)**

Article 83.– Combining of requests. It shall be possible to request, in a single petition, the amendment or correction of two or more applications applied for or two or more registrations, where the amendment or correction is the same for all.

It shall be possible to request, in a single petition, the recording of transfers of ownership of two or more applications pending or two or more registrations, where the transferor and the acquirer are the same for all. This provision shall apply, as appropriate, to the recording of licenses for the use of distinctive signs which are registered or applied for.

In accordance with the provisions of the two preceding paragraphs of this Article, applicants shall identify each of the registrations or applications in which the amendment, correction or entry is to be made. The corresponding fees shall be paid based on the number of applications or registrations involved.

Article 84.– Effects of declarations of invalidity. Declarations of invalidity of a registration shall be backdated to the date of the respective grant, without prejudice to the conditions or exceptions provided in the declarations concerned.

Where the invalidity of a registration is declared in respect of which a license for use has been granted, the licensor shall not be obliged to refund the payment made by the licensee, unless the licensee has not benefited from the license.

Article 85.– Abandonment.– Applications for registration and actions taken by virtue of this Law shall be deemed abandoned and shall lapse by operation of the law if they have not been taken within a period of six months, beginning from the last notification to the parties concerned.

CHAPTER II Registries and publication

Article 86.– Recording and publication of decisions. The Industrial Property Registry shall enter, in the corresponding register, decisions relating to the invalidation, withdrawal, renunciation or cancellation of any registration and shall publish them in the Official Gazette once only, at the expense of the interested party.

Article 87. Consultation of registries. Industrial property registers shall be public. Anyone may obtain copies thereof upon payment of the fee set in Article 94 of this Law.

Article 88.– Consultation of files. Any one may consult, on the premises of the Industrial Property Registry, the file for a registration application. Likewise, he may obtain copies of the documents contained in the file for an application, upon payment of the fee set.

CHAPTER III Classifications

Article 89.– Classification of goods and services. For the purposes of classifying the goods and services for which the marks are registered, the World Intellectual Property Organization International Classification of Goods and Services for the Purposes of the Registration of Marks shall be applied.

Any issues relating to the class in which a good or service is to be placed shall be resolved by the Industrial Property Registry.

Goods and services shall not be considered similar if, in any register or publication of the Industrial Property Registry, they are in the same classification class referred to in the first paragraph of this Article.

Goods and services shall not be considered different if, in any register or publication of the Industrial Property Registry, they are in different classes of the classification referred to in the first paragraph of this Article.

Article 90.– Classification of figurative elements. When classifying the figurative elements of marks, the Industrial Property Registry shall apply the World Intellectual Property Organization International Classification of the Figurative Elements of Marks, the Convention Establishing the World Intellectual Property Organization, WIPO, Law, No. 6468 of September 18, 1980.

TITLE X Industrial Property Registry

Article 91.– Competence of the Industrial Property Registry. For the purposes of this Law, the administration of intellectual property shall be the responsibility of the Industrial Property Registry, which forms part of the National Registry.

Article 92.— Impediments to the office of Registrar. It shall be prohibited for the Registrar and for the staff under his orders to handle matters directly or indirectly, on his own behalf or that of third parties, with the Industrial Property Registry.

The officials and employees of the Industrial Property Registry shall observe strict impartiality in all their dealings.

Any violations of the provisions of this Article shall be punished in accordance with the corresponding laws and regulations.

Article 93.— Access to Registry documents. The files, books, registries and other documents which are found in the Industrial Property Registry may not be taken out of the Registry Office. All judicial or administrative proceedings or those relating to administrative disputes shall be executed in that same Office, under the responsibility of the Registrar. Any exceptions to the foregoing circumstances shall require a court order duly substantiated in a trial, as need be.

At the request of any interested party, the Registrar may return any document submitted by that person to the Industrial Property Registry in any proceedings that does not have to be kept. It shall be returned and an authenticated photocopy of the document shall be made at the expense of the interested party.

Article 94.— Fees. The fees charged by the Industrial Property Registry shall be as follows:

- (a) for recording a mark in each nomenclature class: fifty US dollars (US\$ 50.00);
- (b) for recording each trade name: fifty US dollars (US\$ 50.00);
- (c) for recording each expression or sign of advertising: fifty US dollars (US\$ 50.00);
- (d) for renewing each mark: fifty US dollars (US\$ 50.00);
- (e) for transferring, licensing for use, changing the name of or cancelling marks: twenty-five US dollars (US\$ 25.00) for each international nomenclature **(as amended by Law, No. 8632)**;
- (f) for transferring, changing the name of or cancelling each trade name, expression or sign for advertising: twenty-five US dollars (US\$ 25.00);
- (g) for registering or duplicating a Register certificate for renewal or any other similar document: twenty-five US dollars (US\$ 25.00) **(as amended by Law No. 8020, of September 6, 2000)**.
- (h) for each opposition filed: twenty-five US dollars (US\$ 25.00) **(as amended by Law No. 8632)**;
- (i) for each amendment or correction of an application: twenty-five US dollars (US\$ 25.00) **(as added by Law, No. 8632)**;
- (j) for each divisional application: fifty US dollars (US\$ 50.00) **(as added by Law No. 8632)**;
- (k) for each application for an appellation of origin or a geographical indication: fifty US dollars (US\$ 50.00) **(as added by Law No. 8632)**;
- (l) as a surcharge for renewal during the grace period of six months: twenty-five US dollars (US\$ 25.00) **(as added by Law No. 8632)**;
- (m) for applications for the invalidation or cancellation of each distinctive sign in each class: twenty-five US dollars (US\$ 25.00) **(as added by Law No. 8632)**.

Article 95.— Use of the amounts received as fees. The amounts received annually by the Industrial Property Registry in the form of fees shall be distributed as follows:

- (a) forty per cent (40%) for the Costa Rican Publishing Office, which shall be earmarked in accordance with the provisions of Law No. 2366 of June 10, 1959 and the amendments thereto, as a State subsidy;
- (b) ten per cent (10%) for the Publishing Office of the Technological Institute of Costa Rica, for the production of works on science and technology;
- (c) thirty per cent (30%) to cover all of the annual costs of the Industrial Property Registry of the National Registry. This Registry shall submit a corresponding annual budget to the Administrative Board of the National Registry for its approval and due implementation;
- (d) twenty per cent (20%) for intellectual property research and training, allocated to the Administrative Board of the National Registry. For budgetary purposes, these investments shall be excluded from the limits and guidelines for effective annual expenditure which the Ministry of Finance allocates for the National Registry, and the Registry shall budget it separately from the ordinary budget of the Administrative Board of the National Registry, without it being subject to any budget ceiling by the Budget Authority.” **(as amended by Law No. 8020, of September 6, 2000)**.

In addition to the functions laid down by this Law, the Industrial Property Registry, in the form of its Director, may order precautionary measures under the terms and conditions established in the Law on Proceedings for Enforcement of Intellectual Property Rights.

(This last paragraph was added in Article 72(b) of Law No. 8039, of October 27, 2000).

TITLE XII
Final and transitional provisions

Article 96.– Regulations. The Executive shall issue Regulations under this Law within one month following its publication.

Transitional Article I.– Pending trademark applications. Applications for registration or renewal of marks that were pending at the date of the entry into force of this Law shall continue to be processed in accordance with the previous system. However, the registrations and renewals granted shall be subject to the provisions of this instrument. In respect of the use of trademarks, the period for which the trademark has been registered, according to Article 39, shall begin from the entry into force of this Law.

Transitional Article II.– Existing registrations. Trademarks and other distinctive signs registered under the previous system shall be governed by the provisions of this instrument and the corresponding Regulations, which shall be applicable starting from the date of the entry into force of this Law. Notwithstanding, proceedings for cancellation due to failure to use a trademark may not be initiated until five years have passed, beginning from such date.

Transitional Article III.– Proceedings initiated. Any proceedings which had already been initiated prior to the entry into force of this Law shall be prosecuted until they are settled, in accordance with the provisions under which they were initiated.

Transitional Article IV.– Instruments of Article 89. The classification rules indicated in the first and fourth paragraphs of the foregoing Article 89 shall be *ad referendum*; they shall come into full force with the fulfillment of the constitutional steps for the adoption of international instruments.

In force from the time of its publication.

To be communicated to the Executive

Legislative Assembly.– San José, December 22, 1999.

CARLOS VARGAS PAGÁN, President.

MANUEL ANT. BOLAÑOS SALAS, First Secretary.
RAFAEL ANGEL VILLALTA LOAIZA, Second Secretary.

Presidency of the Republic.– San José, January 6, 2000.

To be executed and published

MIGUEL ANGEL RODRIGUEZ ECHEVERRIA

The Minister of Foreign Trade,
SAMUEL GUZOWSKI ROSE