



**REVIEW UNDER ARTICLE 24.2 OF THE APPLICATION OF THE
PROVISIONS OF THE SECTION OF THE TRIPS AGREEMENT
ON GEOGRAPHICAL INDICATIONS**

RESPONSES TO THE CHECKLIST OF QUESTIONS¹

Addendum

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1 SECTION A: GENERAL

1. Is protection for geographical indications provided through unfair competition law, e.g. passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?

Geographical indications are protected under the provisions governing unfair competition, pursuant to Art. 101.2(c)², (e)³ in relation with Art. 8(i)⁴, (f)⁵ in relation with Art. 9(h) and (f)⁶, and Art. 64⁷ of the Law on Trademarks and Other Distinctive Signs.

¹ Documents IP/C/13 and IP/C/13/Add.1.

² Art. 101.- The acts or behaviour defined by this Law shall not be deemed exhaustive, and any act or behaviour which, even though it is not included in this Law, is deemed unfair in accordance with the previous Article shall be prohibited.

The following shall *inter alia* constitute acts of unfair competition:

(...)

(c) the use or spreading of indications or allegations, or the omission of true information, when this is liable to be misleading as to the origin, nature, method of manufacture, suitability for use or consumption, quantity or other characteristics of one's own goods or services or those of a competitor;

(...)

³ Art. 101.- (...)

The following shall *inter alia* constitute acts of unfair competition:

(...)

(e) use as a trademark of a sign whose registration is prohibited under Article 8(g), (h), (i), (j), (k), (l), (m), (n), or (o) of this Law;

⁴ Art. 8.- A sign covered by any of the following cases may not be registered or used as a trademark or a part thereof:

(...)

(i) It can cause deliberate misrepresentation or confusion as to the geographical source, nature, mode of production, qualities, suitability for use or consumption, quantity or other characteristic of the good or service in question; (...)

⁵ Art. 101.- (...)

The following shall *inter alia* constitute acts of unfair competition:

(...)

⁶ Art. 9.- Any sign that affects a third party right may not be registered or used as a trademark or element thereof in the following cases:

(...)

(h) It is liable to cause confusion with a geographical indication or appellation of origin which is protected or for which the application for protection was filed prior to the application for the trademark;

(...)

(j) The application filed to register the sign was made to perpetrate or consolidate an act of unfair competition.

The right of protection against unfair competition is exercised before the competent courts, namely the civil and commercial courts (Art. 102 of the Law on Trademarks and Other Distinctive Signs). Nonetheless, it may also be exercised before the administrative authority, by opposing registration and invoking the relevant subparagraphs of Arts. 8 and 9, in accordance with Art. 16 of the Law on Trademarks and Other Distinctive Signs; these provisions may also be applied ex officio in the substantive examination of an application without any need to invoke them, if they are already known to the examining authority.

In addition to the provisions governing unfair competition, the right of protection may also be exercised under Art. 64 of the Law on Trademarks and Other Distinctive Signs.

Our legislation does not specifically provide for "recognition" of geographical indications. A geographical indication must be registered in accordance with national legislation (Art. 67 of the Law on Trademarks and Other Distinctive Signs) in order for protection to be conferred. In the case of foreign geographical indications, the documents issued by the competent authorities in the country of origin are recognized (Art. 69 of the Law on Trademarks and Other Distinctive Signs).

2. Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.

Our legislation provides that geographical indications may be protected under the following two regimes:

- a. A geographical indication may be protected as a trademark (individual, collective or certification mark) under Art. 4 of the Law on Trademarks and Other Distinctive Signs.
- b. Procedure for registration of a geographical indication: Arts. 64 ff. of the Law on Trademarks and Other Distinctive Signs.

3. Do(es) the regime(s) of protection of geographical indications also extend to services?

No.

4. What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.

The Law on Trademarks and Other Distinctive Signs⁸, specifically the provisions mentioned in response No. 1 above. The Law and amendments thereto have been notified to the WTO.

5. If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.

N/A.

⁷ Art. 64.- A geographical indication or appellation of origin may not be used in trade to designate a good or service if such indication is false or misleading with regard to the geographical origin or setting of the good or service, or if its use would result in a likelihood of confusion among the public with respect to the origin, source, characteristics or qualities of the good or service. Nor shall its use be permitted in trade, even where the true origin of the good is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.

⁸ Legislative Decree (LD) No. 868 of 6 June 2002, published in Official Journal (OJ) No. 125, Vol. No. 356, of 8 July 2002, and the following amendments thereto:

- (1) LD No. 913 of 14 December 2005; OJ No. 8, Vol. No. 370, of 12 January 2006.
- (2) LD No. 986 of 17 March 2006; OJ No. 58, Vol. No. 370, of 23 March 2006.
- (3) LD No. 358 of 19 April 2013; OJ No. 81, Vol. No. 399, of 6 May 2013.

6. Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.

CAFÉ APANECA ILAMATEPEC, registered as No. 00003, Appellations of Origin Book 00001.

Collective marks, such as Pupusas 100% Olocuilta and logo, and San Lorenzo jocote and loroco, and logos.

7. Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.

Yes, any kind of product that meets the requirements laid down in national legislation is accorded the same level of protection as a geographical indication or appellation of origin.

2 SECTION B: DEFINITION AND CRITERIA FOR RECOGNITION

8. How are geographical indications defined?

Geographical Indication: Any geographical name, designation, picture or sign which identifies or evokes a good originating in a particular country, group of countries, region, locality or place, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin (Art. 2(j) of the Law on Trademarks and Other Distinctive Signs).

9. Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?

Not in the preceding definition, but in the definition of the term appellation of origin, which reads as follows:

According to the notion of appellation of origin set forth in national legislation, the constituent elements of an appellation which, without being from a particular country, region or place, refers to a particular geographical area when used in conjunction with products originating from the said area, shall also be deemed to be an appellation of origin.

10. In determining whether recognition should be given a geographical indication, what criteria are considered?

The registration criteria are laid down in Art. 68 of the Law on Trademarks and Other Distinctive Signs.

11. Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?

Our legislation provides that human creativity and human factors are involved. There is no mechanism for establishing the level of human creativity in products protected by geographical indications.

12. Are there any other intellectual property rights involved, such as patents for example?

No other intellectual property rights are involved.

13. What authority, if any, may define the geographical region or area for which rights are claimed and on what basis is such definition made?

The Intellectual Property Registry, through the registration process, and the definition is based on the application filed by the requesting producers or authorities.

14. Does your legislation contain criteria for homonymous geographical indications for wines?

The legislation applicable to homonymous geographical indications is consistent with the provisions of the TRIPS Agreement.

15. Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?

Yes, recognition is provided for under Art. 67 of the Law on Trademarks and Other Distinctive Signs.

16. Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.

Art. 67.4 of the Law on Trademarks and Other Distinctive Signs links the protection of foreign geographical indications in El Salvador with their protection in the country of origin: "Foreign producers, manufacturers or craftsmen, as well as the competent authorities of foreign countries, may apply for registration of foreign appellations of origin or geographical indications, provided that these are protected in the country of origin". Likewise, Art. 73-E provides that: "Geographical indications and appellations of origin protected under the provisions of this Law shall not be considered common or generic to distinguish the product identified by them, as long as such protection obtains in the country of origin".

2.1 SECTION C: PROCEDURE FOR RECOGNITION

17. With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?

Producers, manufacturers or craftsmen established in the relevant geographical area, as well as the competent public authorities, may apply for registration of national geographical indications.

Producers, manufacturers or craftsmen and the competent authorities in the country of origin may apply for registration of foreign geographical indications.

Art. 67.2-4 of the Law on Trademarks and Other Distinctive Signs.

18. What are the competent authorities where the protection of a geographical indication can be obtained?

The National Registration Centre's Intellectual Property Register is the administrative authority responsible for administering intellectual property rights.

19. Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?

An application has to be filed by the interested party, pursuant to Art. 67 of the Law on Trademarks and Other Distinctive Signs.

20. What, if any, fees are involved in the application and maintenance of rights in a geographical indication?

The fees are set out in Art. 109 of the Law on Trademarks and Other Distinctive Signs.

21. If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?

No, they are not exclusively geographic in nature.

22. What other criteria, if any, must be set out in an application for recognition of a geographical indication?

They are laid down in Arts. 68 and 69 of the Law on Trademarks and Other Distinctive Signs.

23. What information must be supplied in an application for rights in a geographical indication?

See Arts. 69 and 73-A of the Law on Trademarks and Other Distinctive Signs.

24. Must the goods or services with respect to which a geographical indication is claimed be set out?

Yes, the goods must be indicated (Art. 69(f) of the Law on Trademarks and Other Distinctive Signs).

25. What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?

The procedure for opposition follows the rules laid down in Arts. 16 and 17 of the Law on Trademarks and Other Distinctive Signs.

Once registration has been granted, any complaints are heard by the civil and commercial courts; there is no investigation, but the evidence submitted by the parties is appraised. In the event of a criminal complaint, the investigation is conducted by the Office of the Attorney-General of the Republic.

26. Who can oppose the recognition of a geographical indication?

Any party claiming a legitimate interest, pursuant to Art. 16.1 of the Law on Trademarks and Other Distinctive Signs.

27. If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?

To obtain protection for a foreign geographical indication or appellation of origin, it is necessary to follow the procedure for registration laid down in Arts. 68 and 69 of the Law on Trademarks and Other Distinctive Signs, which begins with the filing of an application with the National Registration Centre's Intellectual Property Registry. The main steps of the procedure are as follows:

- Application
- Examination
- Publication (Opposition where necessary)
- Payment of fees
- Registration

3 SECTION D: MAINTENANCE**28. How long does recognition for a geographical indication continue?**

The term of registration of a geographical indication or appellation of origin is indefinite, as long as the conditions that gave rise to the protection obtain, in accordance with Art. 72 of the Law on Trademarks and Other Distinctive Signs.

The term of recognition of a geographical indication as a trademark (individual, collective or certification mark) is ten years, renewable for further ten-year periods.

29. If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in the renewal or reaffirmation.

In the case of trademark (individual, collective or certification mark) protection, it is necessary to file an application for renewal that meets all the requirements laid down in Art. 22 of the Law on Trademarks and Other Distinctive Signs, and to pay the fee prescribed in Art. 109 of the Law.

30. Must a geographical indication be used in order to maintain rights? If so, how is such use determined?

No.

31. Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?

There is no limit on use in the case of a registered geographical indication or appellation of origin.

In the case of a geographical indication protected as an individual mark, protection is not forfeited for failure to use it, except if an interested party requests that it be cancelled on grounds of non-use (Art. 41-A of the Law on Trademarks and Other Distinctive Signs) and, in the case of collective marks, cancellation may be sought under Art. 51 of the Law on Trademarks and Other Distinctive Signs. In either case, a petition for cancellation may be filed with a civil or commercial court, in the first instance after five years of failure to use the mark in El Salvador, and in the second, after one year of exclusive use by the owner but not by the authorized persons.

32. Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?

There is no mechanism for ascertaining continued compliance with the conditions that gave rise to the registration or use of geographical indications or appellations of origin; on the other hand, in the case of geographical indications or appellations of origin, any interested party may file a petition for cancellation with a civil or commercial court on grounds of failure to comply with the criteria set out in the application, pursuant to Art. 74.2 of the Law on Trademarks and Other Distinctive Signs.

33. If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?

N/A.

34. Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.

In the case of a geographical indication or appellation of origin, any interested party may file a petition for cancellation with a civil or commercial court on grounds of failure to comply with the criteria set out in the application, pursuant to Art. 74.2 of the Law on Trademarks and Other Distinctive Signs.

The ordinary declarative procedure before a civil or commercial court is used for the purposes of cancellation, pursuant to Arts. 41-A and 74.2 of the Law on Trademarks and Other Distinctive Signs and Art. 240 of the Code of Civil and Commercial Procedure.

35. Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?

Such procedures are not conducted ex officio but on the initiative of any interested party.

4 SECTION E: SCOPE OF RIGHTS AND USE

36. May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?

Use of a geographical indication or appellation of origin is subject to an authorization of use being granted by the administering body, in accordance with the registered rules of administration or use. A foreign geographical indication or appellation of origin is governed by the applicable legislation in the country of origin.

Use of a geographical indication registered as a collective or certification mark is subject to compliance with the requirements and procedures laid down in the rules of use registered together with the mark.

Use of an individual mark is an exclusive right of its owner, except where a license for use has been granted, in accordance with Arts. 5, 26 and 35 of the Law on Trademarks and Other Distinctive Signs.

37. Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?

The entity holding the registration or the administrative body, depending on whether the determination concerns a trademark or a geographical indication or appellation of origin.

38. Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?

The relevant rules of use and administration determine whether an authorization of use is issued free of charge or for a fee.

39. If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?

In the case of a geographical indication or appellation of origin: Art. 73-D of the Law on Trademarks and Other Distinctive Signs.

In the case of an individual mark: during the term of registration or the term stipulated in the licence (Art. 35 of the Law on Trademarks and Other Distinctive Signs).

In the case of a collective mark or certification mark: as established in the rules of use registered together with the mark.

40. Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?

As laid down in the relevant rules of use.

41. If there is a dispute over continuity of use by a particular party, how is it resolved?

Depending on the relevant rules of use, the response to question 39 applies.

42. Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licences? If such conditions are not met, what is the effect on the geographical indication?

Licensing of geographical indications, appellations of origin, collective marks or certification marks is not allowed. Only individual marks may be licensed.

43. How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?

See Art. 64.3 of the Law on Trademarks and Other Distinctive Signs:

"Nothing shall prevent continued and similar use of a particular geographical indication in connection with goods or services by any Salvadoran national or person domiciled in the country that has used that geographical indication in good faith and in a continuous manner with regard to the same or related goods or services in the territory of the Republic on the date established by international treaties to which El Salvador is party".

5 SECTION F: RELATIONSHIP TO TRADEMARKS

44. What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?

Arts. 8 and 9 of the Law on Trademarks and Other Distinctive Signs.

45. What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?

Arts. 68(d) and Art. 9 of the Law on Trademarks and Other Distinctive Signs.

46. What procedures are foreseen in case of a conflict of a geographical indication with a trademark?

Administrative jurisdiction (registration process) for the purposes of opposition: Art. 16 of the Law on Trademarks and Other Distinctive Signs.

Judicial jurisdiction:

- Administrative courts
 - a. Administrative dispute
- Civil and commercial courts
 - a. Invalidation of a distinctive sign: Art. 39 of the Law on Trademarks and Other Distinctive Signs
 - b. Cancellation on grounds of non-use: Art. 41-A of the Law on Trademarks and Other Distinctive Signs

6 SECTION G: ENFORCEMENT

47. How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.

Art. 101 of the Law on Trademarks and Other Distinctive Signs: Acts of unfair competition involving industrial property.

Art. 102 of the Law on Trademarks and Other Distinctive Signs: Action against acts of unfair competition.

48. Who has the right to enforce a geographical indication?

The administering body (Art. 73-B of the Law on Trademarks and Other Distinctive Signs).

49. What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?

The civil and commercial courts, pursuant to Art. 113 of the Law on Trademarks and Other Distinctive Signs. There are no fees involved.

50. Must the public be notified of the existence of a geographical indication and, if so, how and how often?

Once an application for a distinctive sign, including geographical indications and appellations of origin, has been filed and declared admissible for processing, the respective notifications must be made public by means of publication in the Official Journal and a national newspaper, in accordance with Art. 15 of the Law on Trademarks and Other Distinctive Signs.

51. Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.

Criminal Code: Title IX, Offences/Offences against the socioeconomic order/Chapter I on offences relating to industrial property.

"Art. 229: The reproduction, imitation, modification or use of any kind of a mark, trade name, expression, advertising sign or any other distinctive commercial sign for industrial or commercial purposes and without the consent of the holder, in violation of the rights appertaining to the industrial property registered in conformity with the law, shall be punished by two to four years' imprisonment. (30)

The same penalty shall apply to those who export, import or possess for the purposes of sale or placing on the market, products or services bearing marks or distinctive commercial signs which, in accordance with the preceding paragraph, constitute an infringement of the exclusive rights of the holder. (30)"

7 SECTION H: INTERNATIONAL AGREEMENTS

52. Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.

El Salvador has signed the following free trade agreements containing specific intellectual property-related provisions or chapters that also provide for the protection of geographical indications:

- Dominican Republic-Central America-United States FTA (DR-CAFTA)
- FTA between Chile and Central America
- FTA between El Salvador and Panama
- Association Agreement between Central America and the European Union
- FTA with Mexico

53. What other international agreements, if any, have been entered into? What do those agreements provide?

None.

Addendum

The following questions should be added to the Checklist of Questions annexed to document IP/C/13.

Section A

Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like?

Art. 64.3 of the Law on Trademarks and Other Distinctive Signs.

Section B

Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms? Does your legislation contain criteria for homonymous geographical indications for wines and spirits?

The Trademark Law does not cover indications of source, but it does distinguish between geographical indications and appellations of origin.

Definitions of geographical indications and appellations of origin: Art. 2(j) and (k), respectively, establishing the relevant criteria for distinguishing these terms.

Our legislation does not contain any criteria for distinguishing between homonymous geographical indications.

Section F

Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trademark registration, which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?

Arts. 8(i), 9(h) and 64 of the Law on Trademarks and Other Distinctive Signs.
