
Costa Rica: New Procedure for Declaration of Notoriety

By [Robin N. Baydurcan](#)

In August 2019, the Costa Rican Trademark Office announced a new independent procedure to request a declaration of notoriety of a trademark, outside the context of any particular opposition or invalidity case. The full name is the *Procedure for Declaration of Brand Notoriety*, [More](#)

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In August 2019, the Costa Rican Trademark Office announced a new independent procedure to request a declaration of notoriety of a trademark, outside the context of any particular opposition or invalidity case. The full name is the *Procedure for Declaration of Brand Notoriety*, and here are the steps:

1. Request the declaration.
2. The request is examined for form and substance, including an analysis of the evidence.
3. The request is published in the Official Gazette, so that third parties may oppose.
4. Absent opposition, within approximately 3-6 months of filing the request, a decision is issued.
5. The decision is appealable, first to the IP Registry and then to the Administrative Appeals Tribunal.

Useful evidence, which must be submitted together with the petition, includes:

- Decisions or declarations of notoriety from other Paris Convention member countries.
- Declarations of marketing/advertising spend, both in Costa Rica and internationally.
- Independent reports or industry rankings.
- Market studies to show consumer recognition.
- Registration certificates from Costa Rica and internationally.

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- Press coverage, references in pop culture.
 - Advertising examples.
 - Sales accounting statements.
 - An affidavit is helpful but not mandatory, as the Trademark Office gives more weight to objective or neutral evidence.
 - Documents issued outside of Costa Rica need to be legalized. However, evidence issued within Costa Rica will carry the most weight.

The official fee is US \$50 along with publication fees of US \$200. Professional fees will vary depending on the volume of evidence and translations or certifications needed.

It is important to note that an application for declaration of notoriety is publicly available in the Trademark Office database, even before publication in the Official Gazette.

It is not known at this time whether the declarations will be issued for a limited period or will last in perpetuity, as this is a very new procedure.

Once issued, a declaration may be used to overcome Office Actions, to oppose third-party applications, as evidence in nullity actions, and as evidence in infringement proceedings and other Court actions.

This new independent procedure is a welcome change, as the only way to obtain a declaration of notoriety previously was to do so within the context of another proceeding.

Primary Contacts

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