

Uruguay: Use of Trademarks Now Mandatory – Update

In our [March](#)

[2014 Information Letter](#), we reported that Uruguay passed legislation

establishing a use requirement for registered trademarks (Section 187-Act No.

19149, October 24, 2013; see also Decree No. 277/2014 of October 7, 2014). We now report that,

effective January 1, [More](#)

In our [March 2014 Information Letter](#), we reported that Uruguay passed legislation establishing a use requirement for registered trademarks (Section 187-Act No. 19149, October 24, 2013; see also Decree No. 277/2014 of October 7, 2014). We now report that, effective January 1, 2019, any physical person or legal entity “with a direct, personal and legitimate interest” may seek to cancel a registered mark that has not been used for five years from its date of registration or approval of the last renewal. Such actions are to be filed before the Trademark Office. The burden of proof of use rests with the trademark owner, who must demonstrate that the mark has been used during the requisite period by the trademark owner, a licensee, or an authorized person. There is no provision for partial cancellation of a mark. Accordingly, use of the mark on any goods or services covered by the registration will suffice to prevent cancellation. A cancellation action may also be rejected if the trademark owner can demonstrate “force majeure” reasons for non-use.

Use in this context must be “public and actual” (not “token”). In particular, proof of use will be deemed sufficient when:

“any of the goods or services listed in the trademark registration are available in the Uruguayan market, in reasonable quantities and in a usual manner, depending on the market dimension, the nature of goods or services involved and the marketing modalities. Further, the use of a trademark in connection with goods intended for export from national territory or with services provided abroad from national territory is considered use of the trademark. Using trademarks as brand names maintains the registration provided that it is used on goods or packaging thereof or indirect relationship with the services protected by the trademark registration.”

Given the proximity of the effective date of this law, trademark owners are advised to review their Uruguay portfolios and take steps to effectuate use and/or refresh their coverage. We note that proof of use is not, however, required in order to register or renew a trademark.

Primary Contacts

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