

SECONDARY MEANING IN INTELLECTUAL PROPERTY: A CRITICAL ANALYSIS FROM A CULTURAL PERSPECTIVE AND MEANS OF PROOF

CAMILA LÓPEZ

I. INTRODUCTION

The purpose of this essay is to analyze the practical relevance of the doctrine of secondary meaning in trademarks, with a special emphasis on its empirical relationship with the culture and idiosyncrasies of certain countries. This essay reviews the doctrine's application in Argentina, Brazil, Chile, and Uruguay.

The doctrine of secondary meaning was developed by the Anglo-American legal system and has been incorporated in the legislation of many Latin American countries, although it has not yet achieved full integration or development in these jurisdictions. In this context, there is a need to explore and develop the concept of secondary meaning through emblematic cases that expose the difficulties and the need of a greater practical application of this institute in the region, along with legislation that encompasses its principles.

This paper will highlight the vulnerability often experienced by certain trademarks which, in the search for recognition and resignification, face obstacles that are difficult to overcome due to evaluation parameters that are often not in line with the commercial reality. As a result, these trademarks are left unprotected in today's hostile and competitive market.

The institute of secondary meaning plays a crucial role in the protection of some trademarks, allowing the owners of distinctive trademarks containing generic or

descriptive terms to acquire exclusivity and monopolistic use of these terms. This allows the trademark owner to capitalize on the investments that led to this consumer recognition and, in turn, to protect consumers from deceitful attempts by third parties.

This tool also allows owners to rectify an inappropriate choice of a trademark, as the use of terms that merely describe products or services for trademarks is generally not recommended. This is the general view because of the complex nature of obtaining an exclusive right over such expressions. This essay will expose this underlying issue, while emphasizing the importance of tools provided by technology to move towards a more effective solution.

II. A CULTURAL AND SOCIOLOGICAL PHENOMENON

As defined by the Peruvian National Institute for the Defense of Competition and Protection of Intellectual Property:

Secondary meaning or resignification is the phenomenon whereby a sign originally devoid of distinctive capacity becomes—mainly as a result of use—an identifier of the goods or services of a given business. Thus, in certain cases, as a result of an extensive advertising campaign and prolonged use in trade, a trademark that was initially non-distinctive, i.e., that did not allow the goods or services to which it referred to be identified with a specific business origin, may acquire a secondary meaning for the public, i.e., a special meaning that goes beyond the primary, generic or descriptive meaning that this sign normally has, which serves to indicate the business origin of a particular product or service as regards products or services of the same category.

From the above definition, it can be inferred that secondary meaning means that a trademark must be perceived as an indicator of a certain business origin and not simply as information about the product or its characteristics. This may be achieved by vast advertising campaigns and prolonged use.

This essay will show that secondary meaning or resignification can be built, most importantly, by consumers in a given community. Through consistent use of a trademark, consumers give the mark new meaning, thereby introducing a new language of interaction and perception of an intangible concept. This phenomenon, rooted in social psychology, significantly influences culture.

Thus, since language reflects the values, beliefs, and standards of a culture through vocabulary, the resignification of a trademark is also part of a culture of a given country. Consequently, assessing the meaning of a sign from the perspective of quantitative advertising campaigns or its lifespan can lead to biased conclusions and unfair outcomes, as this does not always reflect reality. Likewise, denying protection to a resignification of the language by consumers in a community is something that cannot be negotiated, as it is inherent to the idiosyncrasy of a place.

The vulgarization of a trademark is another phenomenon that occurs due to consumers' assigned meanings to a trademark over time. In this context, while acquired distinctiveness implies the transformation of a trademark from not distinctive to acquiring a new meaning, vulgarization implies the transformation of a trademark from a distinctive sign to merely a usual designation of a product or service.

Although these two phenomena appear opposed, there is a common thread: the risk and danger stemming from the possible loss of protection of a distinctive

trademark. Both trends reflect societal evolution, underscoring the necessity for legislative intervention. It is precisely for this reason that this phenomenon is not granted or applied uniformly in all countries, even regarding the same trademark.

In some cases, these parameters are used to measure trademark awareness. Although they are important in driving social change, there is no direct cause-and-effect relationship between a business decision and the outcome of shaping secondary meaning.

For secondary meaning to be incorporated, there must be what the Anglo-Saxon doctrine calls a real “mental association” between the sign and the product or service, rather than a mere presumption of it.

Ultimately, the close connection between secondary meaning and a country’s idiosyncrasy is based on the fact that the allocation of a meaning does not occur in a cultural vacuum. A country’s culture, values, traditions, and collective psychology are multi-causal and conclusive factors that can explain why a specific sign is assigned a secondary meaning.

Recently, we have witnessed a marketing trend in the use of common expressions to identify certain services. This is true especially in the technological field where we find platforms such as Booking.com, Mercado Libre, PedidosYa, or expressions such as Prime (associated with trademarks like Amazon). Startups, which chose frequently used domains such as DESPEGAR, HOTELES.COM, and BOOKING.COM became technological giants in their respective fields, generating consumer identification. This trend highlights the need for further analysis of the doctrine of secondary meaning and how this phenomenon can be demonstrated when consumers adopt a commonly used term as a trademark.

III. LEGAL FRAMEWORK AND EMBLEMATIC CASES

The shortcomings of the application of the secondary meaning doctrine in the countries reviewed (Uruguay, Argentina, Brazil, and Chile) is evidenced by a scant legislation, which results in decisions that are sometimes insufficiently grounded. The following will illustrate emblematic cases that recognize the secondary meaning of signs, while exposing interesting considerations in connection with exclusive rights and means of proof.

AMERICAN AIRLINES V. AMÉRICA AIR - SUPREME COURT OF JUSTICE - SPECIAL APPEAL NO. 1773244 - RJ (2018/0049055-9) (BRAZIL)

This Judgment highlights American Airlines' continuous use, advertising, investments, and leadership in the market as evidence of the resignification of its trademark, but it limits the exclusivity of the rights under the pretext of the trademark's weakness. American Airlines is described as descriptive but having achieved outstanding consumer distinctiveness. However, it is mentioned that "acquisition of distinctiveness guarantees the right to exclusivity, but within the limits granted to weak trademarks."

SUAVE - ISSUE SHAMPOO SUAVE - JUDGMENT DATED JULY 1, 2010 - CHAMBER I OF THE FEDERAL CIVIL AND COMMERCIAL APPEALS COURT - CASE No. 1135 (ARGENTINA)

The Court concluded that the trademark "SUAVE" (soft) is distinctive and able to be considered a trademark for toiletry products (shampoos). However, it is mentioned

that the term is inherently weak, allowing its coexistence with other trademarks using the same word.

**TELEFÓNICA - JUDGMENT NO. 243/2003 OF THE
CONTENTIOUS ADMINISTRATIVE COURT (URUGUAY)**

The Court recognized that the trademark “TELEFÓNICA” is distinctive, particularly in relation to the associated goods or services. As a result, the judgment annuls the contested act, considering that the imposed limitation, which denies exclusive rights to TELEFÓNICA, is illegitimate under Section 8 of Law No. 17.011.

**MULTI COISAS - CHAMBER OF CIVIL APPEALS -
SPECIALIZED PANEL I - PENAL, SOCIAL SECURITY, AND
INDUSTRIAL PROPERTY (BRAZIL)**

The Court found that the trademark “MULTI COISAS” lacks sufficient distinctiveness under Article 124, VI of Law No. 9.279/96. The decision highlighted that while the appellant has the right to register the trademark, they do not hold exclusive rights to the nominative elements, which implies they must endure the coexistence with similar trademarks in the market. This underscores the understanding that signs of this nature must tolerate the presence of similar marks or trade names.

**OUTLET PREMIUM - CIVIL APPEAL - SPECIALIZED
CHAMBER I - CRIMINAL, SOCIAL SECURITY, AND
INDUSTRIAL PROPERTY NO. CNJ:
010402502.2017.4.02.5101 (2017.51.01.104025-5)
(BRAZIL)**

The judgment correctly underlined the relevance of consumer perception and cultural connection in secondary meaning:

As for the opinion research herein mentioned, it is important to note, as my colleague has mentioned, that we have also conducted an opinion research on our side. It has been argued that it focused on specific regions and a specific audience. It is important to remember that the registrations have national validity and we are dealing with a segment widely used by Brazilian consumers in shopping malls, so our research showed precisely that, to a greater extent, at the time of the first deposits for “Outlet Premium”, the plaintiff was not even known to exist in Brazil, and that today, the term “Outlet Premium” is directly associated with our client, the appellee.

**DEBOLS!LLO - JUDGMENT DATED SEPTEMBER 11, 2019,
FROM THE INDUSTRIAL PROPERTY COURT - CASE NO.
TDPI No. 1544-2019 (CHILE)**

This judgment emphasized dissemination and the long-standing presence of “Debols!llo” in the market as evidence of secondary meaning. Registration was granted in recognition of the trademark’s acquired distinctiveness.

**AUTOMATIC - JUDGMENT DATED JANUARY 27, 2022,
FROM THE INDUSTRIAL PROPERTY COURT - CASE NO.
TDPI No. 000019-2022 (CHILE)**

Invoices and documents were submitted as evidence of secondary meaning. The registration was granted in recognition of secondary meaning based on market use.

Finally, we outline some cases where secondary meaning has been rejected, possibly due to an incorrect assessment of the tool's implications or a lack of evidence clearly demonstrating the existence of secondary meaning.

**AMAZON PRIME - JUDGMENT NO. 403/2022 OF THE
CONTENTIOUS-ADMINISTRATIVE COURT (URUGUAY)**

The applicant requested exclusive rights over the term "PRIME." However, the Court argued that descriptive words must be available for frequent use. The Court dismissed the secondary meaning of "PRIME" based on the argument that the direct association between the term and the business origin was not proven.

**MERCADO LIBRE - JUDGMENT No. 335/2023 OF THE
CONTENTIOUS ADMINISTRATIVE COURT (URUGUAY)**

The claim was rejected on the grounds that, in the opinion of the Court, the terms "Mercado" and "Libre" lacked distinctiveness, being frequent and usual. It mentioned the prohibition to register generic or descriptive words and that a claim to attribute a single meaning to any term is insufficient to overcome the legal prohibition.

The rulings in cases such as Amazon Prime and Mercado Libre (the Latin American equivalent of eBay) underscore a common misconception regarding secondary meaning. Although courts admit the registration of these trademarks, they simultaneously advocate for terms to remain available for use by other competitors, dismissing the trademarks' distinctiveness because of their generic nature. This approach fails to recognize the underlying purpose of secondary meaning, which arises when a term becomes associated with a specific business origin in the minds of consumers. Therefore, while the courts acknowledge the concept of secondary meaning, they overlook the need to grant exclusive rights to trademarks.

The shortcomings of these rulings lie in their failure to examine the true value and intentions of the consumer, who is the one who ultimately assigns significance. This can be achieved by applying new methods of evidence that unveil the reality of consumer perceptions.

IV. IMPLEMENTATION ISSUES AND CHALLENGES

It is essential to review the legislative criteria to reflect on the current reality and latest trends, taking advantage of the new means of proof available in this age of information technology. This allows for immediate and direct access to consumer feedback through their interactions with trademarks across various platforms, such as social media, product reviews on shopping sites, YouTube tutorials, and more. By recognizing and addressing societal perception as a central criterion in evaluating secondary meaning, legislation can better safeguard against unfair competition and foster a more dynamic marketplace. By using innovative means of proof and a holistic approach to trademark protection, effective

solutions can be achieved to address the evolving challenges of the market.

In the context of digital age economies, the connection between secondary meaning and the market is the reward for an ability to interpret and connect with the audience. Businesses can capitalize on the changes in language that occur as a social phenomenon to turn them into trademarks. In many cases, social perceptions influence business strategies, rather than the other way around. Thus, the need for strong legal protection becomes even more imperative in dynamic economies and changing societies, where innovation, perspective, and competition are key drivers of sustained growth.

A. Means of Proof and Current Trends

Each of the means of proof herein mentioned can make a significant contribution to the search for a recognition of secondary meaning.

B. Surveys

These are research tools that collect data and opinions from a representative sample. They are conducted through structured questions with predefined options. Surveys help to understand the public's perception of a specific sign, assessing its associations.

C. Focus groups

These are discussion meetings where a moderator facilitates the interaction of a chosen group of participants. These participants express their opinions, perceptions, and experiences on a specific topic, such as the resignification of a trademark. Focus groups provide qualitative insights.

D. Interviews

These involve direct conversations with key people, such as industry experts, opinion leaders, or those who play a significant role in the context of a trademark.

E. Data on consumer use of a term on the internet

Currently, consumers are interacting with trademarks in new ways, such as through product or service reviews on shopping portals, social media comments and complaints, blogs, user-generated content referring to trademarks, and product review videos on YouTube, among others. Technological tools that enable tracking the digital behavior between consumers and trademarks may reveal, in real time, how a community perceives a trademark and predominant trends. Probing these interactions reveals general perceptions on the knowledge of the trademark, secondary meaning, and trademark image.

F. Data of the use of a term by mass media

The way in which an expression is used by mass media provides valuable insights, reflecting the meaning that public opinion assigns to those terms and, at the same time, indirectly influencing the perception of that trademark in a geographical area. Consequently, where a certain term is used by mass media in an unambiguous manner to designate a particular undertaking, this may be highly relevant evidence for establishing the existence of secondary meaning.

G. Witnesses

Oral evidence could come from employees, customers, or industry experts who can provide valuable insights on the perception of a trademark by the consumers.

H. Expert witnesses

This involves the testimony of a qualified expert which could come from a marketing professional, a sociologist specialized in consumer behavior, or even an intellectual property expert.

Hence, remarkable technological advances and sophisticated survey techniques enable an array of means of proof that can accurately reflect a community's way of thinking.

V. CONCLUSION: TOWARDS A MORE EFFECTIVE PROTECTION

Throughout this essay, emblematic cases were explored from different countries in the region, revealing similarities and differences that underscore the importance of secondary meaning and the need for legislation to adapt to the particularities of each context.

A change in perspective is required for assessing secondary meaning, with an emphasis on the above-mentioned sociological aspects, to safeguard the interests of consumers and companies in cases where it is possible to prove the mental association between a generic term and a specific business origin with respect to certain products or services. Thus, preventing unfair competition from third parties who, under the pretext of using common terms, attempt to benefit from the prestige and recognition of the original trademark. To this end, it is also necessary to

conceptualize the use of these terms as trademarks, thus dispelling the false belief that granting a trademark with secondary meaning only results in inhibiting competitors from using the term as part of common language.

This essay has demonstrated multiple weaknesses in trademark law. More specifically, this essay has revealed that: i) the inherent difficulties in seeking recognition and redefinition of certain signs reflect the vulnerability of trademarks striving to stand out in a hostile and competitive market; ii) the correlation between evaluation parameters and market reality has emerged as a determining factor in the protection of these trademarks; and iii) the analyzed judgments have highlighted the disconnect between jurisprudential practices and societal perception, emphasizing the need to reevaluate the criteria used in determining secondary meaning.

These conclusions reinforce the relevance and urgency of revising current practices to ensure effective trademark protection in an increasingly challenging environment. This holistic approach not only safeguards against unfair competition but also fosters a more dynamic and equitable marketplace.

REFERENCES

- Resolution No. 1497-2000/TPI-INDECOPI dated November 21, 2000.
- Juan Manuel Gutiérrez Carrau, *Manual Teórico - Práctico de Marcas* (Technical-Practical Trademark Manual), Universidad de Montevideo, Facultad de Derecho, Third Edition, Montevideo, 2009, ps. 110/116.
- Section 8 of Uruguayan Trademark Act No.17011.
- Section 2 of Argentinian Executive Order No. 242/2019.
- Section 124 of Brazilian Trademark Act No. 9.279
- Section 19 of Chilean Industrial Property Act.
- Distinctiveness Acquired / Secondary Meaning. ASIPI Podcast* <https://perma.cc/43J9-FGY>.
- Citizen Commission on Transparency and Probity of Quetzaltenango, *Research Methods: Surveys, Interviews, and Focus Groups*.
<https://perma.cc/2T6B-B3M4>.
- Gutiérrez Carrau, J. M., *Theoretical-Practical Manual of Trademarks* (3rd ed.) pg. 110-116.
- National Directorate of Industrial Property. *Industrial Property Magazine*, (Dec. 15, 2005).
- Osorio, N. *Registration of generic signs as trademarks*, <https://perma.cc/C6YL-RC9H>.
- Trademark Committee of the Inter-American Association of Intellectual Property. *Acquired distinctiveness: Comparative study in different legislations*, <https://perma.cc/2TQF-9V57>.
- WIPO Lex. Search results in the WIPO judgments collection <https://perma.cc/4L2Z-7TZH>.
- Outlet Premium - Civil Appeal - Specialized Chamber I - Criminal, Social Security, and Industrial Property No.

CNJ: 010402502.2017.4.02.5101 (2017.51.01.104025-5)
(Brazil).

Debolsillo - Judgment dated September 11, 2019, from
the Industrial Property Court - Case No. TDPI No. 1544-
2019 (Chile).

Automatica - Judgment dated January 27, 2022, from
the Industrial Property Court - Case No. TDPI No. 000019-
2022 (Chile).

Amazon Prime - Judgment No. 403/2022 of the
Contentious- Administrative Court (Uruguay).

Mercado Libre - Judgment No. 335/2023 of the
Contentious- Administrative Court (Uruguay).