

# Noli IP Newsletter

NOLI IP Solutions, PC

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## *Exclusive Right to Use a Trademark in Argentina: Sonrisas vs. Dale Alegria Case* By Luciana Eugenia Noli and Monica Hernandez

Registering a trademark for goods and/ or services is of a remarkably importance. A trademark certificate of Registration empowers the owner with legal rights to prevent a trademark's unauthorized use by third parties. In Argentina we

company in National food industry, specialized in exporting candies worldwide and producing hard candy. Dilexis S.A. is a factory that mainly produces Cookies and it was incorporated by Pepsico Food in Argentina

*The Court in First Instance found the trade dress of the marks to be confusingly similar and ordered Dilexis to cease using such [smiling face] shape for its goods and granted damages recovery to Bagley.*

found an interesting and recent case that describes and reinforces this aforementioned concept.



Bagley S.A is an Argentine company that belongs to Grupo Arcor, a leading

2011.

When BAGLEY ARGENTINA S.A. has been known for year for their cookies SONRISAS and the distinctive shape of those.

Bagley Argentina S.A. discovered that DILEXIS S.A. wanted to launch a cookie under the name of "DALE ALEGRIA"

## *Latin-American Tour*

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Ms. Mariana Noli attended the **2016 Global Entrepreneurship Congress** which took place in the city of Medellin, Colombia from March 14 to 17, 2016.



For more information about the activities of this organization, please visit [www.gec.co](http://www.gec.co).

containing an identical shape of Bagley's popular cookie SONRISAS, Bagley asserted its rights and claimed that Dilexis must stop the use of the mark as well as its commercialization in the market.

However, due to a lack of agreement between the parties, BAGLEY ARGENTINA S.A. decided to submit the case to the judicial court by filing a pleading alleging that Dilexis was passing off its mark by using Bagley's unique shape, causing a confusion to consumers as to the source of the company of such cookie.



The defendant DILEXIS claimed that Bagley had no exclusive rights on the design "because [the smiling face

*design] was widespread on numerous food products."* Dilexis further argued that the cookies of the plaintiff could not confuse consumers because Dilexis distinguished its goods with a different packaging, thus, the trade dress of the two products were clearly dissimilar.



The Court in First Instance found the trade dress of the marks to be confusingly similar and ordered Dilexis to cease using such shape for its goods and granted damages recovery to Bagley.

The Court stated that while it is true that both products have different name, both have the same nature and they belong to the same consumer's target. The Court of Appeals confirmed first instance decision.

In conclusion, the firm DILEXIS S.A. was ordered to stop the use of the SONRISAS trade dress and to pay for the damages caused to the Plaintiff's company.

It is important to remember that trademark rights vary from country to country, including the right to use a mark. So, before using a mark or asserting rights in any country, take steps to verify what these rights are and conform your use to any requirements of local trademark law. Marking should be in the local language(s) or otherwise be meaningful to the people in the country in which the products or services are advertised and sold. Different countries have different rules about when to use such symbols (and what happens if these symbols are misused). As such, it is a good idea to consult a qualified attorney in those countries where you plan to use a mark.

## The Women of our Noli IP Team

By Mariana Paula Noli

Better late than never: Happy International Women's Day. After several conversations with the members of the NOLI IP team, I came to the conclusion that we would not be who we are if there would not have been these amazing

women in our lives. Faced with the decision on what articles and topics to include in our monthly newsletter for March and given the fact that we celebrated International Women's Day a few days ago, I wanted to devote a section of

our newsletter to honor the wonderful women who inspire us to strive to be the professionals we are today. Let me start by saying that while our team would not be the same without the participation of Raouf, Karim,

Sergio, Lou, David, truth be told, I realize that the ones involved in the day-to-day operations of the office, from billing and bookkeeping to docketing and filing are mainly females. Even the wonderful men associated with us, will tell you that they would not be who they are if it wasn't for the incredible women in their lives.



AllPosters

Personally, I take much pride in the women of my family and their strengths and accomplishments. I venture to say my sister Luciana will agree with me on this even if we don't always see things the same way. Our great grandmother was a principal of an elementary school in Buenos Aires, Argentina in the 1940s. Our grandmother raised six children while operating a small family business. Our grandmother

on our father's side was one of the first females admitted to the Universidad de Buenos Aires to study to become a dentist. I know I am who I am today because of the unconditional love and support of my mother, who decided in her late 50s, after having a career in education and having raised her kids, to become an intellectual property agent in Argentina and take the exam at the INPI to understand her daughter (me)'s passion for this area of law. That tells you a lot about the women who inspire me, I want to honor them in this edition.

There is not one day that goes by at the office with Erica not sharing her grandmother's wisdom, a lady who unfortunately I have not yet had an opportunity to meet. A woman who was and is more than a grandmother and role model, always giving her advice on how to improve her performance and do her job better. Trust me managing the office of a start-up law firm is not easy, there are many

challenges and multi-tasking on any given day.

When I ask Monica to share about the female role models in her family, she shared her admiration for her grandmother, founder and principal of an elementary school in Cartagena, Colombia. Today, Monica's mother runs the operations of the school and is the woman that supports her goals and dreams unconditionally.



I would also like to honor another woman in our work family, Judit's mother, a hard-working doctor in Budapest Hungary who raised a strong, equally hard-working and independent professional woman. We want to take this moment to honor all of the amazing women in our families and thank them for helping us model after them.

*Our Founder, together with MyBrandLegal, continued to spread her passion and knowledge for entrepreneurship and startup businesses by giving educational workshops on the legal aspects any business owner and entrepreneur needs to know at HubBog earlier this month. We thank Rene Rojas for this invite.*

