

DOLBY:

Actions against non-authorized trademark use.

Importance of the trademark

DOLBY LABORATORIES is a technology company founded in 1965 by Ray M. Dolby, an entrepreneur and scientist. At the time, movies and television featured only one channel of sound, and record producers were limited to a handful of audio tracks. Much of what happened since then to improve the sound of entertainment can be traced to the efforts of Dolby — not just their technical innovations but the impact they had on artists.

Today, Dolby's innovations in audio, video and voice technologies continue to transform entertainment and communications in the cinema, in the home, and on the go. Dolby revolutionizes the science and engineering of sight and sound, empowering creatives to elevate their stories, and offering fans compelling, immersive experiences in Dolby.

Dolby licenses technologies to manufacturers of consumer entertainment products. Dolby also sells products and related services to creators, distributors and exhibitors of entertainment content. It is important to note that Dolby trademarks are registered in international class 9. Therefore, any party manufacturing, selling, or offering products or services for sale bearing any of the trademarks owned by Dolby Laboratories with no license or authorization in writing would be in violation of Dolby's IP rights.

After becoming aware of some cases in Latam, we were able to file claims and send warnings to those using the brand "Dolby" on unlicensed products and also to advertise in brick and mortar and online stores, and on internet platforms.

Client

DOLBY

Various versions of
Dolby Trademarks

FIRST GENERATION



SECOND GENERATION



THIRD GENERATION



FOURTH GENERATION



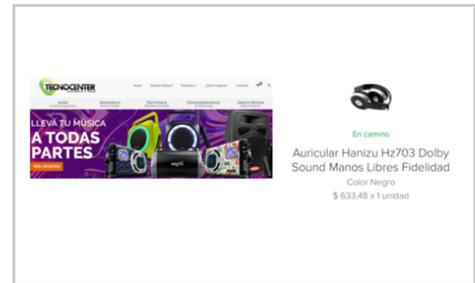
Fifth Generation
Dolby Trademark



CASE 1 / COMMERCIAL STORE “T.C.”

Backgrounds

During an investigation in the City of Buenos Aires, we found a physical formal store called “T.C.” which commercialized headphones manufactured in China by the producer “HANIZU” which boasted to have DOLBY technology. The product was being sold at a suspicious low price respect to the average retail price of DOLBY licensed products, which called our attention.



After some investigations, we discovered that “T.C.” was a direct importer that sold a variety of technologic products imported in Argentina not only at a physical store, but also at an online plataforma.



Having analized the suspicious product, we discovered that its packaging stated that the product had DOLBY technology, and it used a very lookalike logo in comparison to the one registered as a trademark, as well as the word DOLBY next to the description of the product.



The importance of this case is based on the fact that, despite the product beared the DOLBY logo trying to copy the original logo, its packaging also included the word DOLBY pretending to have the technology with the aim of causing confusion on the consumers, who think they are buying a premium product, when there is a total lack of any technology of this kind on the product as its Chinese manufacturer does not have a license to that.

An investigation was started and upon results, we purached a sample in order to have some evidence. After that, we were able to start an extrajudicial action and sent a notary notice to the infringer requesting him to immediately cease and desist on the use and commercialization of these products.

The owner of the store contacted us and after some negotiations with his lawyers that took several weeks, he expressly acknowledged the commercialization of the infringing products and in February 2020, an agreement was signed through which he undertakes:

- ▶ Not to use counterfeit “DOLBY” trademarks or any other brand or design owned by DOLBY by any means, neither physical nor on online plataforms and/or on social networks;

- ▶ Not to manufacture, to make third parties to manufacture, import, export, commercialize, provide, distribute, sell and/or offer products infringing any brand owned by “DOLBY”;
- ▶ Not to request the registration, or to register any brand owned by DOLBY, or any other brand or design that causes confusion in the future;
- ▶ Include a penalty clause in case of non-compliance by the infringer in the future.

CASE 2 / DECODERS MSAT

Backgrounds

In the context of an inspection performed by officers from the National Customs Direction in Carrasco Airport, Uruguay, 11 bulks containing decoders which contained decoders identified under the name of TV MSAT Converters, coming from Shenzhen, China with final destination to Ciudad del Este, Paraguay were found.

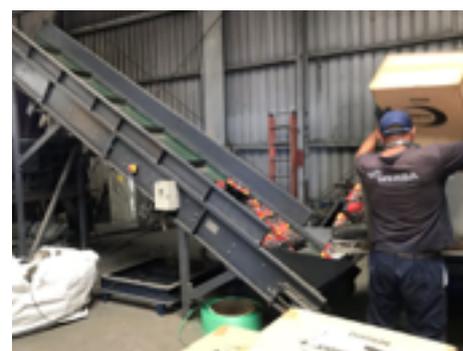
After a detailed verification of the products, Customs officers discovered that devices beared the word DOLBY, so they contacted the legal representatives of the company in Uruguay in order to make them review the products and to confirm if there was an infringement of the brand owner’s trademark.

Cervieri Monsuarez, as local DOLBY legal representatives, confirmed the existence of 1500 digital TV signal receptors MSAT model M9000 bearing the brand DOLBY, licence for its commercialization or distribution with no authorization to use the brand infringing the Law 17.011.

A criminal claim was filed before the Criminal Court 9 under record 94-703/2016.

The criminal trial concluded with the judicial decision of destroying the seized goods in accordance to article 84 Law 17.011.

Having fulfilled the corresponding proceedings before the National Environmental Direction (DINAMA) and the National Customs Direction, the goods were destroyed in March 2020.



Conclusions

- 1) Protection of IP rights owned by a company which is an icon in developing technology for the reproduction of audio and video as DOLBY was achieved.
- 2) Misuse of the word DOLBY as a trademark, and the copy of its logo with the aim of causing confusion on consumers were acknowledged.
- 3) Information on the origin of the products was obtained in order to perform a direct investigation from where the goods are manufactured and distributed.
- 4) Infringing products were destroyed preventing future risk for consumers.

by:



**Dr.
Anabel Frachia**

Partner
afrachia@cmlawyers.com.uy



**Dr.
Lucía Cantera**

Senior Associate
lcantera@cmlawyers.com.uy



**Mg.
María Laura Perna**

Brand Protection Manager
mlperna@cmlawyers.com.uy