

# Colombia

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### 1. Legal framework

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Applicable industrial property law in Colombia includes:

- Andean Community Decision 486 on a Common Industrial Property Regime, effective since December 1 2000;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs);
- the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Trademarks (1979), eighth edition;
- the Paris Convention for the Protection of Industrial Property (1967), ratified by Colombia on September 3 1996;
- the General Inter-American Convention for Trademark and Commercial Protection (Washington, 1929), ratified by Colombia on February 20 1929;
- the Industrial Property Convention, signed with France (1901);
- the Colombian Commerce Code; and
- the Cooperation Treaty to create a free trade area between Colombia, Mexico and Venezuela.

### 2. Unregistered marks

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#### Protection

In Colombia and other Andean Community member countries, the use of unregistered trademarks does not give rise to any rights. Article 154 of Decision 486/2000 states: "Registration of a trademark with the competent national office shall confer the exclusive right to its use."

Nevertheless, Decision 486/2000 provides an exception and recognizes the well-known nature of a sign. This means that the owner of a well-known sign has the right to take action against third parties in order to prevent use of the sign,

even if the sign is not registered. The owner must be able to prove that its sign is well known in the Andean Community.

On the other hand, conflicts may arise between trade names and trademarks. Decision 486/2000 defines a 'trade name' as any sign that identifies an economic activity, a business or a commercial establishment. Conflicts arise because, unlike trademarks, the exclusive right to a trade name is acquired through first use in commerce.

#### Use requirement

To establish rights in a trade name, one must prove first use, and significant and continuous use in commerce.

There is no rule regarding the amount of time of use that has to be proven to establish rights in well-known marks. In order to prohibit third parties from using the well-known mark, the owner has to demonstrate that the mark is renowned and prove that its distinctiveness was acquired before the third party applied for the mark.

### 3. Registered marks

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#### Ownership

Any individual or legal entity, private or public, can apply for and own a trademark in Colombia.

#### Scope of protection

**Protected:** Trademark registration may be granted to signs that are sufficiently distinctive and capable of being graphically represented. Generic and/or descriptive names and other words that may be misleading cannot be protected as trademarks. Decision 486 provides that the following are capable of constituting a trademark:

- words or a combination of words;

- pictures, figures, symbols, graphic elements, logotypes, monograms, portraits, labels and emblems;
- sounds and smells;
- letters and numbers;
- a colour enclosed in a specific shape or a combination of colours;
- the shape of a product, its packaging or wrappings; and
- any combination of the signs or means indicated in the items above.

**Not protected:** Article 135 provides that a trademark cannot be registered if:

- it lacks distinctiveness;
- it consists solely of the everyday shapes of goods or their packaging, or of shapes or characteristics dictated by the nature or particular function of the product or service in question;
- it consists exclusively of shapes or other elements that attribute a functional or technical advantage to the product or service to which they are applied;
- it consists solely of a sign or statement that may serve in commerce to designate or describe, in respect of the goods or services for which they are to be used, their quality, quantity, purpose, value, geographical origin or time of production, or that impart other details, characteristics or information, including expressions of praise for those goods or services;
- it consists exclusively of a sign or statement that is the common or technical name of the product or service concerned;
- it consists solely of, or has become, a sign or statement that, in everyday language or normal use within the country, is the common or usual designation for the goods or services in question;
- it consists of a colour in isolation, without any demarcation to give it a specific shape;
- it is liable to create confusion in business circles or the public, in particular as to the geographical origin, nature, manufacturing methods, characteristics or qualities of the goods or services concerned, or their suitability for use;
- it reproduces, imitates or contains a protected indication of origin that is liable to create confusion or a mistaken association with the indication in relation to the goods themselves or different goods, or that involves taking unfair advantage of the well-known character of that appellation among the public;
- it contains a protected appellation of origin for wines and spirits;
- it consists of a national or foreign geographical reference that is liable to create confusion in respect of its application to products or services;
- it consists of or contains a reproduction or imitation, without the permission of the competent authority of the state or international organization concerned, of heraldic elements such as coats of arms, flags and emblems, or the official signs and stamps used for the purposes of government control and guarantee, or the coats of arms, flags and other emblems, initials or designations of any international organization;
- it reproduces or imitates signs denoting conformity with technical standards, except where the registration thereof is applied for by the national body responsible for standards and quality requirements in member countries;
- it reproduces, imitates or includes the indication of a plant species protected in a member country or any other country, where application of the sign to goods or services relating to that species or its use is likely to cause confusion or a mistaken association with that variety; or
- it is contrary to law, morality, public order or good manners.

## 4. Procedures

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### Examination

Trademark applications are filed before the Colombian Trademark Office (CTO). The application shall contain the following documents:

- the petition form;
- a reproduction of the trademark when it contains graphic elements, a shape or a colour, or a figurative, mixed or three-dimensional trademark with or without the use of colour;
- power of attorney;
- proof of payment of the prescribed fees;
- the authorizations required for the cases stipulated; and
- if priority is claimed, the certificate of registration issued by the granting authority in the country of origin and, if so stipulated in domestic legislation, the receipt for payment of the prescribed fee.

The registrar conducts a formal examination of the application within 15 working days of filing; he notifies the applicant of any modification needed. The applicant then has 60 working days from the date of notice to make the required changes. If the application satisfies the formal requirements, it is published in the *Official Gazette*.

### Opposition

Any interested third party may file an opposition within 30 days of publication in the *Official Gazette*. The opposition is notified to the applicant, which has 30 days to answer. Upon expiration of the answer period, the CTO will examine the opposition.

### Registration

An unopposed application proceeds to a substantive examination. The CTO issues its decision by means of an administrative resolution. Where the CTO grants registration, a period of around three months passes before the

official registration certificate is granted. If the CTO decides to reject the registration, the applicant may file an appeal for the decision to be reviewed by the examining officer, and, if the rejection is confirmed, by the chief of the registration office.

CTO decisions may be challenged before the Council of State, the highest administrative court in Colombia.

### Removal from register

**Cancellation:** An interested third party may file a cancellation request for a trademark that has not been used in Colombia or another member country of the Andean Community for a period of three consecutive years. Upon receipt of such a petition, the CTO shall request the owner of the trademark at issue to assert its arguments and submit evidence of use during the prescribed period within 60 working days of the date of notification. Upon expiration of the answer period, the CTO will examine the evidence and issue a resolution that either cancels or denies cancellation of the mark.

**Nullity:** The CTO, acting either *ex officio* or *ex parte*, can at any time declare the registration of a trademark null and void where it has been granted in contravention of the provisions of Articles 134(1) and 135 of Decision 486 (Article 172 of Decision 486/2000).

**Invalidation:** The CTO, either *ex officio* or *ex parte*, shall declare the relative invalidation of a trademark registration where granted in contravention of the provisions of Article 136 of Decision 486/2000 or obtained in bad faith. This action is available only within five years of a trademark being granted registration (Article 172 of Decision 486/2000).

### Timeframe

Unopposed applications take eight months to mature to registration; opposition procedures

take one to two years; renewal takes one month; recordal of merger takes one month; and recordal of change of name takes one month.

### Searches

Applicants can search for:

- figurative and design marks (cost: \$9 plus attorneys' fees);
- trademarks, slogans and words (cost: attorneys' fees of \$137); and
- owners (attorneys' fees of \$158 for one to 15 marks reported and \$10 for each additional mark).

## 5. Enforcement

Registration confers on the owner exclusive rights to use the mark. Accordingly, the owner can prohibit unauthorized third parties from engaging in the following acts:

- using or affixing the trademark or a similar or identical distinctive sign to products in respect of which it is registered, or onto the packaging of such goods;
- removing or changing the trademark, once it has been placed on or affixed to the products in respect of which it is registered, for commercial purposes to products connected with the services for which it is registered, or to the packaging of such goods;
- manufacturing labels, packages, wrappings, packing or such other materials as may reproduce or contain the trademark, and selling or storing such materials;
- using, in the course of trade, identical or similar signs to the trademark for goods or services, where such use would result in a likelihood of confusion or mistaken association with the registration owner. In the case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed;

- using in the course of trade identical or similar signs to a well-known trademark with respect to any goods or services, where such use, by weakening the distinctive force or the value of that trademark for commercial or advertising purposes or by taking unfair advantage of the prestige of the trademark or of its owner, could unjustly damage the registered owner's economic or commercial interests; and
- making public use of identical or similar signs to a well-known trademark, even for purposes that are non-commercial, where such use could weaken the distinctive force or value of that trademark for commercial or advertising purposes or take unfair advantage of its prestige.

If infringement continues after a cease and desist request, the mark owner can take administrative actions under consumer protection and unfair competition legislation, or judicial actions. In either case the mark owner can request that the competent authority or court order the infringer to do one or more of the following:

- cease all acts that constitute the infringement;
- compensate damages arising from the infringement; and
- withdraw from commercial channels all of the products resulting from the infringement, including packaging, wrappings, labels, printed materials and advertising, together with the materials and implements the predominant use of which has been the commission of the infringement.

Administrative actions take one to eight months; civil actions take one to four months; and criminal actions take one to two years.

The competent court may issue the following decisions:

- prohibition against the import or export of the products, materials or implements, the predominant use of which has been the commission of the infringement;

- adjudication of the ownership of the products or materials or implements in connection with the infringement, in which case the value of such goods shall be charged to the amount of compensation due for damages;
- adoption of the necessary measures to avoid continuation or repetition of the infringement, including destruction of the products, materials or implements used in connection with the infringement, or the temporary or definitive closure of the business belonging to the defendant or the accused; and
- publication of the decision and notification of interested parties at the infringer's expense.

In the case of counterfeit trademarked goods, the elimination or removal of the trademark shall be accompanied by actions to prevent the introduction of these products into commerce. Furthermore, such goods shall not be allowed to be re-exported in an unaltered state or to be subjected to a different customs procedure.

**Damages:** Decision 486 provides that the following criteria shall be used, among others, to calculate the amount of compensation to be paid for damages:

- the consequential damage and lost profits suffered by the right holder as a result of the infringement;
- the amount of profit obtained by the infringer as a result of the acts of infringement; or
- based on the commercial value of the infringed right and such contractual licences as may have already been granted, the price the infringer would have paid for a contractual licence.

**Precautionary measures:** In addition to the legal actions for trademark infringement in the civil jurisdiction, precautionary measures can be requested in order for the infringer to cease immediately the infringing acts.

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## 6. Ownership changes – legalization requirements

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**Right transfers:** A trademark (registered or filed) may be assigned by its owner to any third party, or transferred by succession. Assignments must be made in writing and the agreement must be registered with the CTO.

**Licence:** The owner of a registered trademark may grant licences to one or more parties in order to authorize the use of a trademark. Any licence that is granted for use of a trademark shall be registered (in writing) with the competent national office in order for it to have effects with respect to/against third parties.

The owner of the registered trademark shall report to the CTO, during the licence's period of effectiveness, any change in the name or address of the registered trademark owner.

**Legalization of documents:** All documents issued abroad must be legalized as follows to be valid in Colombia:

- If the country of origin of the document is a party to the Hague Convention, it must carry the apostille of the competent authority; and
- If the country of origin of the document is not a party to the Hague Convention, the document must be legalized before a notary public; moreover, the local competent authority (ie, secretary of state) must legalize the signature of the notary public, which in turn must be legalized by the Colombian consul.

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## 7. Areas of overlap with related rights

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To benefit from overlap IP protection, the object of protection must comply with each of the respective requirements set forth by the

applicable regulations. A cartoon character can be protected under both copyright and trademark law.

## 8. Online issues

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The use of registered trademarks on the Internet involves the same IP rights as in offline commerce. NIC Colombia, the administrator of the '.co' domain, applies the Uniform Dispute Resolution Policy (UDRP) of the Internet Corporation for Assigned Names and Numbers.

Under NIC Colombia's domain name registration rules, all applicants agree that:

- registration of a domain name in Colombia does not constitute a trademark registration; therefore, a domain name registration does not interfere with IP rights legitimately acquired in Colombia;
- the requested domain name does not violate any trademark rights in Colombia, or is not identical or similar to a trademark or trade name or any distinctive sign in Colombia;
- the domain name will be used in connection with a licit cause;
- third parties will not be allowed to use the domain name;
- all information included in the domain name application is true and accurate; and
- applicants will submit any disputes that arise from the ownership and use of their domain names to arbitration panels of the World Trade Organization applying the UDRP.

