

# Trademarks

In 54 jurisdictions worldwide

*Contributing editor*  
**Michelle Mancino Marsh**



2015

GETTING THE  
DEAL THROUGH 

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DEAL THROUGH 

# Trademarks 2015

*Contributing editor*  
**Michelle Mancino Marsh**  
**Kenyon & Kenyon LLP**

Publisher  
Gideon Robertson  
gideon.roberton@lbresearch.com

Subscriptions  
Sophie Pallier  
subscriptions@gettingthedealthrough.com

Business development managers  
George Ingledeu  
george.ingledew@lbresearch.com

Alan Lee  
alan.lee@lbresearch.com

Dan White  
dan.white@lbresearch.com

**Law**  
**Business**  
**Research**



Published by  
Law Business Research Ltd  
87 Lancaster Road  
London, W11 1QQ, UK  
Tel: +44 20 7908 1188  
Fax: +44 20 7229 6910

© Law Business Research Ltd 2014  
No photocopying: copyright licences do not apply.  
First published 2005  
Eleventh edition  
ISSN 1745-4638

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Printed and distributed by  
Encompass Print Solutions  
Tel: 0844 2480 112



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# Colombia

Juan Guillermo Moure, Juan Felipe Acosta and María Clara Calderón

OlarteMoure

## 1 Ownership of marks

### Who may apply?

Any natural or legal person, either public or private, or national or foreign may apply for and be the title holder of a trademark registration in Colombia. Registrations may be co-owned by two or more persons.

## 2 Scope of trademark

### What may and may not be protected and registered as a trademark?

According to Colombian trademark law (Andean Decision 486), a trademark is a distinctive sign capable of graphic representation. According to article 134 of Decision 486 the following signs, among others, may constitute a trademark:

- words or combination of words;
- pictures, figures, symbols, graphic elements, logotypes, monograms, portraits, labels, and emblems;
- sounds and smells;
- letters and numbers;
- a colour with borders to generate 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.

Decision 486 allows for the registration of service marks and 'non-traditional' marks, such as sounds, smells and textures.

Decision 486 establishes absolute and relative prohibitions. Absolute prohibitions are included in article 135, and include, mainly, prohibitions concerning lack of inherent distinctiveness and signs that may mislead consumers. Relative prohibitions are included in article 136 and article 137 and include the likelihood of confusion with prior registered or applied-for marks, trade names, copyrighted material, geographical indications and well-known signs.

There are no common law trademark rights derived from mere use. Trademark rights can only be obtained via registration in the country (with the exception of notoriously well-known marks).

## 3 Common law trademarks

### Can trademark rights be established without registration?

No trademark rights can be acquired without registration (with the exception of notoriously well-known marks). Notwithstanding, it is possible to protect non-registered signs by other means such as unfair competition.

## 4 Registration time frame and cost

### How long does it typically take, and how much does it typically cost, to obtain a trademark registration? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration? What additional documentation is needed to file a trademark application?

In Colombia the trademark registration process before the Superintendency of Industry and Commerce (SIC) typically (statistically, in about 80 per cent of cases) takes between six and nine months. Deviations may include a failure to meet formal requirements or if third parties file oppositions

which can extend the process up to 18 months. If the decision is appealed, the process can be delayed another six months.

The approximate cost of a typical trademark registration process, including government fees, is US\$1,000. Deviations such as oppositions or rejections could increase the amount markedly, particularly, when the grounds of such oppositions or rejections involve analysing evidence and it is necessary to design and deploy a specific strategy to overcome obstacles.

## 5 Classification system

### What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

Colombia has adopted the International Nice Classification. The SIC had traditionally allowed coverage consisting of the entire class heading. However, this practice was recently modified and now the applicants must specify the products or services to be identified.

Colombia has also adopted the Vienna Classification for figurative trademarks. Multi-class applications are available and represent a 50 per cent cost saving in official fees (for each class after the first) and between 10 and 20 per cent in professional fees.

## 6 Examination procedure

### What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

The Trademark Office initially verifies compliance with formal requirements. Formal office actions requesting the completion or clarification of the application are quite common. Once formality requirements are met, the application proceeds to publication in the Official IP Gazette for opposition purposes. If no oppositions are filed, a decision on the merits will be issued. Nevertheless, this decision is never adopted before six months from the filing date, as the Trademark Office wishes to avoid possible conflicts with third parties that might claim priority rights on the grounds of the Paris Convention.

Regardless of whether an opposition has been filed or not, the Trademark Office must, ex officio, perform an examination by comparing the application with previously applied or registered trademarks. Finally, if the Trademark Office's decision is to deny registration for the trademark application, the applicant may appeal. The appeal exhausts all administrative remedies. Judicial review is available.

## 7 Use of a trademark and registration

### Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Proof of use is not required to obtain a registration. Nonetheless, after three years have elapsed from registration, any third party may file a non-use cancellation action. In this case, the title holder has the burden of proof to

show use of the trademark and must accredit that the trademark has been effectively used to identify the goods or services specified in its coverage.

Regarding priority rights granted to foreign registrations, the Inter-American Convention for Trademark and Trade Name provides the opportunity to oppose and block a trademark application on the grounds of a foreign registration obtained in another member country and by demonstrating that the applicant knew of the existence of such trademark right.

Additionally, Decision 486 states that an applicant or a title holder of another Andean country (ie, Ecuador, Peru and Bolivia) may file an Andean opposition against a later trademark application in Colombia.

As for priority rights granted to foreign applications, as a member of the Paris Convention, Colombia allows for claiming article 4 foreign-filing priority when there is a previous application in another member country. Additionally, priority may be also claimed based on Decision 486 of the Andean Community on the basis of a previous application in Bolivia, Peru or Ecuador.

## 8 **Appealing a denied application**

### **Is there an appeal process if the application is denied?**

The applicant can administratively appeal an initial resolution before the Deputy Superintendent for Industrial Property Matters. Appeals are typically resolved in approximately three to six months. In the appeal, the applicant may request and submit evidence. If the decision is confirmed, the only remaining option is to file an annulment action before the Council of State (the Supreme Court for contentious administrative matters), which normally takes between three to six years (although this may be shortened under the newly issued administrative code).

## 9 **Third-party opposition**

### **Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?**

Applications are published for oppositions before registration, whether filed locally or result of an International application through the Madrid System. A third party may file an opposition within the 30 working days following the publication of the application in the IP Gazette. Grounds may be absolute or relative prohibitions; the opposing party may argue that the requested trademark lacks inherent (eg, the mark is generic, descriptive, deceiving, commonly used) or extrinsic distinctiveness (eg, the trademark is confusingly similar to a prior applied-for or registered mark, a trade name, a copyrighted material or a well-known sign). The basis of the opposition may also be the fact that the applicant was a former distributor of the opposing party or that the application is being made to facilitate an unfair competition act.

As noted above, grounds for opposition may also be found in the Inter-American Convention for Trademark and Trade Name protection and the Andean opposition.

Any trademark application filed in bad faith can be denied preceded by an opposition of the affected party. Registering a trademark that has a different owner in another country is not necessarily deemed an act of bad faith, as the Trademark Office or the court (if the context is an annulment action) will evaluate the matter on a case-by-case basis considering the principle of territoriality and any knowledge the applicant had of the foreign trademark. Proving bad faith carries a heavy evidentiary burden, which will increase costs markedly.

Once the opposition is filed, a formal study is made and if it is accepted for prosecution it will be notified to the applicant, which will have 30 working days to file a reply. The reply can include evidence, and may also request a 30-working-day extension to submit additional evidence. If evidence is filed, the parties will have a period to submit arguments concerning the validity and relevance of the evidence. Finally, the Trademark Office may call the parties to a conciliation hearing if it deems that there is a possibility of facilitating the registration of the applied mark by reaching an amicable agreement. In any case, it will issue a decision on the merits of the case or, if the parties reach an acceptable agreement, it will decide whether such

agreement provides appropriate guarantees to avoid the likelihood of confusion and protect the interests of consumers.

Any decision proffered may be appealed.

Once a trademark is registered, registration may be cancelled or annulled. Cancelled because it has become commonly used or generic, it infringed a well-known trademark or has not been effectively used during the three years counted as of the date of the cancellations' filing date. Annulled because it was registered in bad faith or in violation of absolute or relative prohibitions. A cancellation or opposition proceeding may entail investments that vary between a range of US\$1,000 to US\$5,000 including professional and official fees. Nullity actions entail a longer process and therefore a more important investment.

## 10 **Duration and maintenance of registration**

### **How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?**

The registration remains in force during 10 years from the grant date. The owner is not required to present evidence of use to maintain the registration, but a third party may file a cancellation action for non-use, in which case the title holder will be required to demonstrate use.

The applicant may file a renewal (for an additional 10-year period) six months before the expiration date. The applicant has a grace period of six months to file a late renewal but must pay approximately US\$200 in late fees.

## 11 **The benefits of registration**

### **What are the benefits of registration?**

Registration of a trademark provides the owner with the exclusive right to use the trademark and to prevent others from using confusingly similar signs. The only way to obtain trademark rights is via registration (with the exception of notoriously well-known marks).

Specific benefits from having a registration include:

- use of the mark without the risk of being sued for infringement;
- excluding others from using identical or confusingly similar trademarks;
- including the trademark as an intangible asset;
- licensing the trademark;
- filing oppositions on the grounds of likelihood of confusion;
- access to the Trademark Office as a specialised court; and,
- access to border measures.

## 12 **Licences**

### **May a licence be recorded against a mark in the jurisdiction?**

### **Are there any benefits to doing so or detriments to not doing so?**

Licence agreements are consensual; hence, they do not need to comply with formal requirements. Recordal is completely optional according to Decree 729 of 2012. Previously, applicable law provided that registration was mandatory in order to enforce the licence against third parties.

## 13 **Assignment**

### **What can be assigned?**

The trademark can be assigned with or without goodwill. The assignment must be for all the goods or services if it is a single-class registration. If it is a multi-class registration, the trademark may be assigned for some goods or services, by dividing the registration. The Trademark Office may refuse to record the assignment if it deems that the division of ownership over the trademark is likely to cause confusion.

Business assets may or may not be part of the transaction.

## 14 **Assignment documentation**

### **What documents are required for assignment and what form must they take?**

The assignment has to be recorded in the trademark register in order to be valid. Therefore, it needs to be in writing. No notarisation or legalisation is

required. The Trademark Office currently requires the recordal to be made using an official format provided by the Office through its web page.

## 15 Validity of assignment

### Must the assignment be recorded for purposes of its validity?

Yes. Although the assignment agreement is binding between the signatories, in order to be perfected it has to be recorded.

## 16 Security interests

### Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

Yes, trademarks may be the subject of a secured interest. Trademarks are considered assets and therefore subject to liens. To place a lien on a trademark, the involved parties have to agree on the secured interest by means of a contract that needs to be recorded before the Trademark Office.

The contract or agreement defining the secured interest does not need legalisation or notarisation.

## 17 Markings

### What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

Marking is not mandatory. There are no prohibitions preferring or encouraging marking. Failure to mark will not generate any consequences for claiming damages or requesting injunctions. Notification is considered perfected for all third parties with the notification of the resolution granting the trademark.

As regards false marking, Consumer Law case law has held that using the <sup>®</sup> or any other symbol indicating that a mark is registered, when it is not, as misleading and may be sanctioned.

## 18 Trademark enforcement proceedings

### What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

A trademark owner can pursue a civil action or may file a criminal complaint (if the infringement is wilful). Prior to mid-2012 there were no specialised courts. However, Congress recently issued a new procedural code assigning judicial powers to the Trademark Office to decide infringement cases. However, such powers are going to be gradually assumed and once they are, civil actions would be pursued before civil circuit courts or before the Trademark Office, while criminal complaints would continue before the Attorney General's Office, which has a specialised unit for IP matters. If the infringer is a public servant or a government entity the trademark owner must file a lawsuit before the contentious administrative jurisdiction.

Border measures are also available; they may be requested before the Customs and Tax Authority, which maintains a registry of trademarks to prevent the importation of infringing products by stopping the merchandise and informing the interested party so it may request border measures.

## 19 Procedural format and timing

### What is the format of the infringement proceeding?

Discovery is allowed. Colombian procedural law provides pre-litigation evidence preservation and granting mechanisms such as preliminary injunctions seeking to preserve a given document or the seizure of a given goods that may serve as further evidence of any sort of illegal conduct. It is also possible to request pre-litigation discovery motions for on-site inspections, document production or depositions. There are also broader evidence-gathering requests that can be made once a complaint is filed. Both pre-litigation and post-complaint evidence gathering may be requested outside Colombia. Failure to comply will allow the court to draw adverse inferences from such failure.

Civil trademark infringement trials start by filing the complaint, normally, seeking preliminary injunctive relief.

To obtain injunctive relief the plaintiff has to submit prima facie evidence of the infringement, evidence of its right (eg, certificate of trademark registration) and offer to post a bond. The plaintiff may also request a court to recover evidence prior to filing a lawsuit. Within the respective hearing the trademark owner may ask for injunctive relief. According to Andean Decision 486, the plaintiff has 10 working days following the application of the injunctive relief to file the lawsuit if it has not been filed.

Colombia is currently transitioning between a written procedure to an expedited oral procedure. Depending on the court that is assigned to the case, the procedure may be oral or written. Depending on whether the court is applying the new oral procedure or the old written procedure, the trial may have the following stages in the following order.

### Oral procedure

- Preliminary injunctive relief;
- lawsuit;
- service of notice;
- reply to the lawsuit by the defendant; and
- judgment hearing (includes conciliation, gathering of evidence, request of prejudicial interpretation of applicable Andean law before the Andean Court of Justice (ACJ), closing arguments and final ruling).

### Written procedure

- Preliminary injunctive relief;
- lawsuit;
- service of notice;
- reply to the lawsuit by the defendant;
- conciliation and delimitation of factual controversy hearing;
- evidence-gathering period;
- closing arguments;
- prejudicial interpretation of applicable Andean law before the ACJ; and,
- final ruling.

All in all, an average infringement suit can take anywhere between four and six years if it follows the written procedure, and up to one or two years following the oral procedure. Plaintiffs cannot currently choose the type of procedure. However, it is expected that by 2014 the oral system will be fully implemented.

The following types of evidence are admissible:

- examination;
- witness testimony;
- expert opinions;
- surveys;
- site inspections; and
- requests for production of documents.

Affidavits are admissible, but the witness will most probably be ordered to provide oral testimony in order to provide the defendant with the opportunity to cross-examine the witness and controvert its conclusions.

Criminal trials are restricted to natural persons, are essentially accusatorial and almost completely oral in nature, which makes them substantially quicker (a criminal case could be over in less than 18 months).

## 20 Burden of proof

What is the burden of proof to establish infringement or dilution?

The plaintiff carries the burden of proof. Such burden is met by demonstrating the infringing use and the likelihood of confusion.

Dilution cases are quite rare. However, the Trademark Office has been consistently stricter requesting the party alleging dilution in an opposition proceeding to surpass a threshold on the quantity and quality of the evidence submitted to demonstrate dilution.

## 21 Standing

### Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

Only the trademark owner or co-owner may file the civil action. Anyone may file a criminal complaint as the violation of trademark rights is a crime

that may be prosecuted ex officio. However, in practice the attorney general will almost always require the owner's participation.

## 22 Foreign activities

### Can activities that take place outside the country of registration support a charge of infringement or dilution?

No, as a general rule, foreign activities are not considered infringement. However, border measures may be requested against merchandise that is about to enter the Colombian territory.

## 23 Discovery

### What discovery/disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

Colombian procedural law provides pre-litigation evidence gathering and preservation mechanisms such as preliminary injunctions seeking to preserve a given document or the seizure of given goods that may serve as further evidence of any sort of illegal conduct. It is also possible to request pre-litigation discovery/disclosure motions for on-site inspections, document production or depositions. There are also broader evidence-gathering requests that can be made once a complaint is filed. Both pre-litigation and post-complaint evidence gathering may be requested outside Colombia. Failure to comply will allow the court to draw adverse inferences from a failure to comply with the request.

## 24 Timing

### What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

The typical time frame to obtain a preliminary injunction during a civil action is two to three months. An infringement or dilution action may take anywhere from four to six years using the old written procedure. The oral procedure may reduce this to one to two years. Appeals normally take six to seven months.

## 25 Litigation costs

### What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The costs of prosecuting an infringement lawsuit vary depending on the complexity of the case and are normally invoiced on an hourly basis. It is reasonable to budget for an average case anywhere between US\$30,000 and US\$60,000 over a four-year period, including an appeal. If the case is settled after a preliminary injunction, the amount could be reduced to approximately US\$15,000 spread out over a year. The plaintiff is usually

awarded with attorney's fees if it succeeds, which may amount to a maximum of 20 per cent of its compensation claim.

## 26 Appeals

### What avenues of appeal are available?

Parties may appeal several court orders issued within the course of the civil process; they may also appeal the final ruling. The appeal will be resolved by a Superior Tribunal of District (a court of appeals).

The Supreme Court of Justice may review the case in exceptional circumstances. The Supreme Court has discretion to decide whether the appeal needs to be studied.

If the Court or the Superior Tribunal of District violates a fundamental constitutional right of a party, the affected party may file a tutela before a court of higher hierarchy seeking protection of its fundamental rights. These decisions are reviewed by the Constitutional Court, which may choose a case due to its importance or by the luck of the draw.

## 27 Defences

### What defences are available to a charge of infringement or dilution, or any related action?

Defences will usually include:

- prior rights to use the respective sign (eg, trade names which are acquired by first use);
- fair use of the respective sign (eg, the sign is being used for informative purposes);
- the action was not filed within the limitation period for bringing (five years counted as of the date on which the infringement ceased);
- absence of legal standing (eg, the lawsuit is filed by a licensee);
- existence of a registration (eg, the infringer holds a trademark registration that allows him to use the sign; this may happen because of a Trademark Office error);
- the similarity between the registered mark and the supposedly infringing sign is over a generic or descriptive term (eg, the owner of the mark 'NUTRISALT' to distinguish 'salt' files a lawsuit against someone for using the sign 'ECOSALT' to distinguish 'salt');
- prior conciliation between the parties; and,
- existence of a licence.

## 28 Remedies

### What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The successful party may be awarded damages, which are meant to act as compensation. The court may take into consideration the profits obtained by the infringer, unjust enrichment by the defendant or reasonable royalties that an infringer would have to pay for a licence. Punitive damages are forbidden in Colombia. Injunctive relief is available, either preliminary or permanently. While preliminary injunctive relief is granted based on

# OlarteMoure

Juan Guillermo Moure  
Juan Felipe Acosta  
María Clara Calderón

juan.moure@olartemoure.com  
felipe.acosta@olartemoure.com  
maria.calderon@olartemoure.com

Carrera 5 No. 34-03  
Bogotá 110311  
Colombia

Tel: +57 1 601 7700  
Fax: +57 1 601 7799  
www.olartemoure.com



prima facie evidence of a trademark right and the substantial possibility of infringement or dilution, permanent injunctive relief is awarded only after the final ruling declaring the existence of the infringement or dilution. The remedies must be awarded in accordance with the claims of the lawsuit; the court is forbidden from granting more than requested.

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## 29 ADR

### **Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?**

Disputes regarding trademark infringement or dilution may be resolved by conciliation, amicable composition or arbitration. ADR is not commonly used because infringement cases do not usually arise from contracts containing arbitration clauses. Other types of arbitration are not common as the infringing party prefers the delay of a civil action.

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## 30 Famous foreign trademarks

### **Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?**

In order for a famous trademark to be protected it must be well known in Colombia or in any country of the Andean Community (Peru, Ecuador,

Bolivia and Colombia). Famous marks are protected against their use and registration irrespective of whether they are registered (articles 225 and 231 of Decision 486). Demonstrating that a trademark is well known is complex and may include direct or circumstantial evidence of the knowledge that consumers may have. The only type of evidence admissible during the administrative process is documentary. If we are dealing with a judicial matter, other types of evidence will be admitted such as testimonies. Documents are not required in original, nor notarised nor legalised if they are filed within the administrative process before the Trademark Office, but will require legalisation if they are submitted before the courts. Ideal evidence should include top of mind and other marketing research studies, but client's certificates, accounting evidence, and proof of the amount and scope of advertisement campaigns may also be useful. Evidence must refer specifically to the respective trademark and the period during which the well-known nature of the mark is sought to be proven. Affidavits to demonstrate that a trademark is famous are normally considered biased, and as such evidence prepared or coming from a third party is normally preferred and considered more persuasive.

## Getting the Deal Through

Acquisition Finance	Dispute Resolution	Licensing	Public-Private Partnerships
Advertising & Marketing	Domains and Domain Names	Life Sciences	Public Procurement
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Asset Recovery	Environment	Oil Regulation	Ship Finance
Aviation Finance & Leasing	Foreign Investment Review	Outsourcing	Shipbuilding
Banking Regulation	Franchise	Patents	Shipping
Cartel Regulation	Gas Regulation	Pensions & Retirement Plans	State Aid
Climate Regulation	Government Investigations	Pharmaceutical Antitrust	Tax Controversy
Construction	Insurance & Reinsurance	Private Antitrust Litigation	Tax on Inbound Investment
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Corporate Governance	Intellectual Property & Antitrust	Private Equity	Trade & Customs
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Trademarks  
ISSN 1745-4638



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