

2-1-1976

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Recommended Citation

Procedure for Registration of Trademarks in Colombia, 8 U. Miami Inter-Am. L. Rev. 241 (1976)

Available at: <http://repository.law.miami.edu/umialr/vol8/iss1/13>

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LEGAL MEMORANDA

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PROCEDURE FOR REGISTRATION OF TRADEMARKS IN COLOMBIA

The Colombian Trade Mark Law (Code of Commerce) has adopted the system of prior examination with a call for oppositions, which is carried out in the following manner:

1. *PRIOR EXAMINATION*

The prior examination is made by the Trade Mark Office (or Industrial Property Division) and includes the following:

- A. *Conditions governing the form of applications.* This refers to the requirements governing the form in which applications must be made. Under Art. 587 and in conformity with Art. 597 and 544, these requirements are the following:
 1. Indication of applicant's name and address,
 2. description of the trademark with a precise and complete enumeration of the products or services in respect of which application is being made for registration of the trademark,
 3. reproductions of the trademark,
 4. the power of attorney or duly certified copy thereof, or certification that it has been officially recorded with the Trade Mark Office,
 5. evidence of the existence and representation of the applicant, where the applicant is a corporate body,

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6. where the applicant is domiciled abroad, evidence that a representative has been appointed in Bogotá and is empowered to receive notifications and to appoint attorneys in and out of Court, and the address of said representative, and
7. evidence of payment of the Government taxes and fees for publication of the application.

Should any of the requirements be wanting, the Trade Mark Office so advises the applicant and abstains from processing the application until such time as the applicant makes good the deficiency. If the requirements are not completed within six months, the application is automatically considered as abandoned, without there being need for a statement to this effect.

- B. *Conditions governing the substance of applications.* This refers to the conditions which govern the validity of the symbol for which application is being made as a trademark, or rather the registrability of the mark from a legal point of view. The rules determining the registrability of trademarks are laid down in Art. 584 and 585.

Art. 584 gives the following general rule:

any symbol whatever that is distinctive may be used as a trademark.

According to Art. 585 the signs that are not distinctive and can not be registered as trademarks are the following:

1. Those consisting of forms imposed by the very nature of the product or service, or by its industrial function,
2. those consisting exclusively of a symbol which is used in commerce or industry to denote the kind, species, quality, quantity, function, value, place of origin or time of production of the goods or supply of services in question,
3. those consisting exclusively of a symbol which in the everyday language or commercial usage of the country has become the common designation for the products or services in question, or
4. those which for other reasons do not permit distinguishing between the products or services of one enterprise and those of another.

Art. 585 also lists the following symbols which may not be registered as trademarks by reason of being illegal or deceptive:

1. Those which are contrary to good morals or public order,
2. those which could deceive the commercial world or the public as to the nature, origin, manufacturing process, characteristics, or utilization capacity of the products or services in question,
3. those which reproduce or imitate the coat of arms or other emblems, initials, or name of any state or international organization, without permission from the competent authorities,
4. those which, without permission from the competent authorities, reproduce or imitate the symbols or seals of control or guarantee adopted by a state,
5. those which resemble, in such a way as to induce the public to error, a collective mark whose registration has expired within the three years preceding the new application, or whose abandonment, cancellation, or nullity has been recorded within this same period.

Art. 585 enjoins the Trade Mark Office from registering trademarks which lack speciality (i.e., which may be confused with others that have been previously registered or that have priority over it) and which are liable to impair the specific rights of third parties. This article lists various grounds of unregistrability. However, in our opinion, in the prior examination, the Trade Mark Office may only consider whether the trademark under application falls within the first category, i.e., whether it resembles, in such a way as to induce the public to error, a trademark registered or applied for with priority by a third party for the same or similar products or services. It would be absurd to suppose that the Trade Mark Office is obliged to check whether the trademark under application resembles a trademark, commercial name, or symbol that has previously been used in Colombia; among other reasons it is practically impossible to make a search of all the trademarks, names, or symbols used in Colombia. And if such is the case with respect to trademarks, names, and symbols, it is more so, where the trademark applied for violates other rights of third parties, or where it

belongs to a third party owner of the same in another country. As may be appreciated, in such cases it is imperative to have the cooperation of third parties to inform the Trade Mark Office of the existence of a priority in the name of a person other than the applicant, or whether said trademark violates third party rights. Hence the necessity for the "call for opposition."

If, as a result of said examination, the Trade Mark Office considers that the trademark applied for can not be registered, it shall so advise the applicant, who shall have thirty days to expound the grounds supporting his application. Upon expiration of this time limit, the Trade Mark Office shall decide the matter on the basis of the facts contained in the file (Art. 589). If the application is accepted, orders are given to proceed with the appropriate formalities through a command to publish a summary thereof in the Industrial Property Gazette. If the application is rejected, the applicant may have recourse to an appeal to set aside and to a subsequent remedy of appeal from the judgment in question. The resolution deciding on the remedy of appeal may be contested before the Council of State by instituting an action for restitution of rights.

2. *CALL FOR OPPOSITION*

- A. Once the application has been accepted by the Trade Mark Office, a call for opposition is made by publishing an extract of the application for registration in the Industrial Property Gazette. Within 30 days after publication *any person* may oppose registration of the trademark (Art. 590).
- B. As a general rule, opposition can be based on one or more grounds of unregistrability mentioned in Art. 586. If the opposing party succeeds in proving that the trademark under application falls within one or more of the grounds contemplated in Article 586, the Trade Mark Office shall abstain from granting the registration.

The grounds of unregistrability referred to above are the following:

- 1) That the trademark under application resembles, in such a way as to induce the public to error, a trademark which has

already been registered or for which prior application has been made by a third party, or for which a subsequent application is made with a valid claim of priority, for the same or similar products or services (Art. 586, paragraph 1),

- 2) that the trademark under application resembles a trademark used publicly in Colombia by another person for identical or similar products, where the applicant of the trademark has known or could not have been unaware of the use thereof (Art. 586, paragraph 2),
- 3) that the trademark under application resembles, in such a way as to induce the public to error, a commercial name or symbol previously used in Colombia by another person for the same activity for which the name or symbol is intended (Art. 586 paragraph 3),
- 4) that the trademark under application resembles, in such a way as to induce the public to error, a trademark commercial name or symbol which belongs to another person and is commonly known in Colombia (Art. 586, paragraph 4), or
- 5) that the trademark under application violates other rights of third parties or is in contravention of the regulations pertaining to the suppression of unfair competition (Art. 586, paragraph 5).

C. *Conditions governing the form of oppositions.* The form should list the requirements governing the form of identification of the application for registration of the trademark, subject of the opposition; the fact that opposition is being made to its registration; and the grounds on which the opposition is based. Where action is being taken on behalf of a third party, the power of attorney must be attached to the opposition and, where necessary, evidence given of existence and representation. Moreover, it is advisable that oppositions contain, insofar as may be applicable, the requirements listed in Art. 75 of the Code of Civil Procedure in respect of the content of petitions.

D. *Admittance of oppositions.* Oppositions filed within the statutory term are admitted by the Trade Mark Office through a writ, notified by a statement. This writ is made up of two parts: (i) the admittance or rejection of the opposition, depending on whether

or not it was filed within the statutory time-limit; and (ii) where action has been taken on behalf of a third party, acknowledgement of the power of attorney, or of the lack thereof (in which case an amount is fixed for a bond to guarantee ratification of the opposition by the opposing party within the following two months, in conformity with Art. 47 of the Code of Civil Procedure).

- E. *Evidence term.* On the date the opposition is filed and admitted, the Trade Mark Office—through a writ notified by a statement—sets a ten-day time limit during which interested parties may petition for the evidence which they intend to present (Art. 590, paragraph 2). Art. 590 must be understood in light of the second paragraph of Art. 822, which stipulates that evidence in commercial law shall be governed by the rules laid down in the Code of Civil Procedure, except where special rules are established under the law. There is a twenty-day limit for submitting the decreed evidence.
- F. *Final observations.* The procedure for opposition that is established in the Code of Commerce does not provide the interested parties with an opportunity to make a summing-up. However, the Trade Mark Office has considered it expedient that the interested parties submit their summing-up after expiration of the evidence period, and has partially accepted the thesis put forward by some lawyers that opposition proceedings should include the same fundamental stages as court suits. Hence it arises that in practice the Trade Mark Office divides opposition proceedings into the following stages:
- 1) The stage included between the filing of opposition and issuance of the writ admitting or rejecting it (in the court suit this corresponds to the admission and notification of the complaint),
 - 2) petition for evidence,
 - 3) submission of the decreed evidence,
 - 4) summing-up (corresponding to concluding statements), and
 - 5) decision of the opposition.
- G. *Administrative decision of the opposition.* If the opposition is rejected and the registration is granted, the opposing party may

have recourse to administrative measures; having exhausted these, he may bring an action of nullity before the Council of State as provided in Art. 596.

If the opposition is successful, the applicant of the registration may have recourse to administrative remedies; and, having exhausted these, he may bring an action for restitution of rights where he considers the administrative action to be illegal or in violation of his rights.

3. *THE GRANTING OF REGISTRATION*

If no opposition is made or if it is rejected, registration of the trademark is granted. Art. 591 does not differentiate with sufficient clarity between the granting of the registration and the act of registering or recording. However, although Art. 591 does not make this distinction, Art. 616 does so where it states that:

In order to become effective in respect to third parties, the granting of patents, models and designs, trademarks, names, symbols . . . shall be recorded with the Industrial Property Office, without prejudice to the provisions regarding the mercantile register.

4. *REGISTRATION OR RECORDING*

The recording of the granting of a trademark with the Trade Mark Office is what strictly constitutes "registration" and is the means whereby the applicant acquires the right to the exclusive use of the trademark and the right to prevent the use of any other trademark that is liable to cause confusion between the respective products or services. These rights become effective in respect to third parties through registration.

A certificate of registration is issued as evidence of the right to a trademark and an extract of this certificate is published once in the Industrial Property Gazette.

Trademark registrations are divided up into classes, i.e., they protect products included in a given class of the international classification which was adopted by Decree 755 of 1972.

Trademark registrations are valid for a period of ten years as from the date of being granted and may be renewed indefinitely for five-year periods.

CAVELIER, PERDOMO & CAVELIER
Bogotá, September 1975

**COMMENTS ON NORMATIVE ACT. NO. 15 ESTABLISHING
BASIC PRINCIPLES FOR REGISTRATION OF
TECHNOLOGY AND OTHER AGREEMENTS
IN BRAZIL**

1. — On September 11, 1975, an Act was signed in Brasilia giving the regulations of the National Institute of Industrial Property (INPI) for the contracting of the transfer of technology and the licensing of trademarks and patents in Brazil.

1.1. — Establishing the basic principles and the new norms for the registration of agreements for the transfer of technology, the INPI defines the five contractual categories which must now be submitted to its appreciation in order to legalize the payments, make tax deductions possible and, where applicable, prove the actual exploitation of the patent or use of the trademark in Brazil.

1.2. — Hence, the Normative Act (NA) governs the contracting of:

- (a) licences to exploit patents;
- (b) licences to use industrial technology;
- (c) the supply of industrial technology;
- (d) technical-industrial co-operation; and
- (e) specialized technical services.

1.3. — These comments are only intended to give readers an initial reaction to the Normative Act, pursuant to an examination of the same, since its very recent publication does not at this stage allow an analysis of how it will be applied in practice.

1.4. — As the act itself makes clear in Art. 1, the registration of these agreements is still tied to other legal provisions. We therefore understand that the NA should not be viewed as an isolated document, since