

COLOMBIA

(Unofficial Translation provided by the International Bureau of WIPO)

Bogota D.C.

2000

Ms. WANG BINYING
Deputy Director General
World Intellectual Property Organization –WIPO
34 Chemin des Colombettes, P.O. Box 18 CH -1211 Geneva 20

Dear Ms. Binying

Further to Circular No. 8467 in which you kindly requested comments on document SCT/34/2 Prov., in order to obtain more detailed descriptions of the current practices of Intellectual Property offices with regard to the protection of country names so that said practices could be discussed at the next session of the SCT, please find below the comments of the Department of Trade and Industry on the above-mentioned topic:

1. The Paris Convention makes a clear distinction between two distinct situations:
 - i) It is impossible to register marks that are devoid of any distinctive character or which infringe upon or violate the rights of third parties. This reasoning is based upon the notion of protection of individuals as trademark holders and as consumers who have the right to purchase goods in total transparency.
 - ii) It is impossible to register marks that reproduce official seals and country names. Understandably, the basis or purpose of this rule has nothing to do with protecting individual or private rights. Its sole aim is to ensure in writing that the names of companies or official seals cannot become a mark and hence cannot be included in a registered trademark. There are no attenuating circumstances that can be applied with respect to the veracity or fantasy aspect of the sign.
 - iii) The obligation of veracity when indications of origin are used.

The Paris Convention does not grant indications of source the same scope as other industrial property rights but considered in the light of the *raison d'être* for the existence of Convention (which was the distortion of the commercial origin or geographical origin of certain products) and in view of its aim to prevent unfair competition, the only restrictions on indications of source is that they must not be false, i.e. they can be used by all. In compliance with international agreements on that matter, indications of source were not created in order to register the name of a country or to grant exclusive rights to individuals with regard to such names. As a result, we cannot compare the two situations as being equivalent.

Nevertheless, they cannot be considered to be a general exception to the inclusion of the name of a country in a registered trademark unless, as TRIPS has pointed out, there is an exceptional situation whereby the name of a country is a geographical indication, collective mark or certification mark, geographical indication or appellation of origin.

2. Applicable Procedures in Colombia

Prior to an application for the registration of a trademark and the proceedings before the Department of Trade and Industry, there are no procedures that are applicable from an industrial property perspective for the defense or protection of a country name. However, we have legal provisions that govern the protection and use of national symbols and can entail the criminal prosecution of acts that violate national integrity.

Decision 486 of the Common Industrial Property Regime of Member Countries of the Andean Community stipulates in Article 135 (m) that the following signs cannot be registered as marks or elements of marks without the permission of the competent authorities: signs that reproduce or imitate coats of arms, flags, emblems, official signs or hallmarks indicating control or guarantee by a State and all imitations from a heraldic point of view; in addition to coats of arms, flags and other emblems and signs or names of any international organizations.

The legal basis for this provision is Article 6^{ter} of the Paris Convention, especially Article 6^{ter} 1(a) of which Colombia had been a member since 1994 (Law 178 approving the Convention).

However, during the trademark registration procedure, the Office orders the publication of the application if it meets the formal legal requirements for a period of 30 days following the date of publication. Third parties can oppose the registration of such a trademark and anyone can formulate an opposition by alleging that deceit has occurred with regard to the geographic indication of products or services for which the trademark is intended to be used. The Department of Trade and Industry can also make a similar declaration *ex officio* in the administrative act that decides upon the application for registration as a trademark and thereby reject the application. After registration as a trademark, if it is considered that registration has been granted counter to Decision 486, it is possible to request that the corresponding administrative act be completely nullified before the Council of State, which is the highest Court of Appeal for administrative matters in Colombia.

The Department of Trade and Industry has expressed its position with regard to the scale of protection for country names and national symbols in the following manner:

*"... The expression COLOMBIA, like the national symbols of our country, can be part of a brand name if (i) it is not deceptive, (ii) if it does not mislead consumers with regard to origin or patronage, (iii) if it does not run the risk of confusion or association with a protected appellation of origin, or iv) if it does not imply unfair taking advantage of its notoriety, (v) if it does not exclusively consist of a sign or indication which could be used in trade to describe its geographical origin, or (vi) if it does not observe the duty of respect and honor as required by Article 14 of Decree No. 1967 from 1991..."*¹

To conclude:

1. We consider that the names of countries should not be included in registered trademarks, independent of whether or not the products or services to be identified by the mark have origin originated in the country whose name is thus reproduced. The reason for exclusion is not, *inter alia*, veracity of information, since the mark can be sold or transferred to somebody who is not a national of the country whose name is thus reproduced and the products may not come from there. Perhaps the only exceptions can be collective marks, certification marks or appellations of origin.

¹ Legal Advisor's Office of the Department of Trade and Industry, No. 12-1444177 of October 8, 2012.

2. Protection of country names should be strengthened to ensure that they are not included in registered trademarks. It is not viable to establish permission in the form of a disclaimer from the applicant since, as a first measure, no individual person will ever be able to legitimately claim this right, even if renunciation would make it possible to apply a country name to commercialized products by way of a geographical indication. As a result, it is not understood why this should be included in a registered trademark.
3. We believe that it is important to make it obligatory for each National Registration Office to check on a semi-official basis whether the logo in the application contains or constitutes the name of a country and therefore make it obligatory not just to check against Article 6*ter* but to ensure that countries have a list of country names that can be used for the purposes of comparison during the examination.
4. Finally, we consider that a sign which includes a country name is not distinctive since a country name does not identify the commercial origin of a product or service and it is impossible not only to indicate the official name of the country but also its initials.

Yours sincerely

Maria José Lamus Becerra
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