

Bogota, D.C. January 19, 2016

**Ms. Wang Binying**

Deputy Director General  
World Intellectual Property Organization (WIPO)  
Geneva, Switzerland

**Subject:** Observations on document SCT/35/4

Dear Ms. Binying,

Following your kind invitation to submit observations on various areas of convergence listed in document SCT/35/4, firstly, regarding areas of convergence no.1 “Notion of Country Name”, no. 2 “Non-registrable if Considered Descriptive”, no. 5 “Invalidation and Opposition Procedures” and no. 6 “Use as a Mark”, with the purpose of explaining the application of these areas in each of the jurisdictions of Member States, we are pleased to provide the Secretariat with the comments of the Superintendency of Industry and Commerce (SIC), set forth below.

**Possible area of convergence no. 1: “Notion of Country Name”**

Colombian legislation does not contain specific references to whether the protection covers only official names or also encompasses the name of the State that is in common use or an abbreviated version. We therefore agree that for the purpose of the examination of marks, it should be understood that a country name may cover the forms proposed in area of convergence no. 1.

**Possible area of convergence no. 2: “Non-registrable if Considered Descriptive”**

Decision No. 486 of 2000, which governs the common industrial property regime of member countries of the Andean Community of Nations (CAN), contains a set of assumptions that fulfill the mandate established in Article 6 *quinquies* of the Paris Convention, in that they prohibit the registration of signs that do not meet the requirement of distinctiveness, which can be found in descriptiveness, genericity and common use.

However, the descriptiveness of a sign, a cause of irregularity cited in Article 135(e) of Decision 486, can occur when the sign to be registered consists exclusively of a geographical name that is known to the public as the one from which the product quality originates. But in fact, it is not sufficient for the sign to be of a geographical origin or place to conclude that it is descriptive, since the consumer does not necessarily associate that origin with the quality of the product and, moreover, where there is no link between the origin and the quality of the product, the mark may be granted.

This office considers that any sign that lacks distinctiveness may or may not be descriptive and this is independently assessed. However, if the sign is not distinctive, it cannot be regarded as a valid mark. Where the trade mark consists solely of a country name which relates to products, this would be an issue more appropriately addressed under geographical indications. It is therefore necessary to draw a distinction in area of convergence no. 2 between, on the one hand, the descriptive character of the mark and the confusion that can arise if the product does not come from the named country and, on the other, a case in which there is a total lack of distinctiveness.

**Possible areas of convergence no. 3: “Non-registrable if Considered Misleading, Deceptive or False”**

Article 135(i) of Decision 486 also prohibits the registration as a mark of signs which “*may mislead the business community or the public, in particular as to geographical origin [...]*”.

In order for a sign to be considered misleading, the above rule does not require that it be so in its entirety; it is sufficient that a part of the sign may mislead the business community or the public as to the origin of the product or its characteristics, among other factors. Refusal of registration of a sign for this reason does not require the misleading to have occurred; the requirement is that it may occur.

In this light, a mark should not indicate a false provenance that attributes characteristics or positive connotations to the product if this is not consistent with reality.

Thus, if the SIC were to examine “D’RICARDOS THE SWISS WATCH”, which is manufactured in Bogota with Colombian technology, it would find this type of product misleading because the quality of Swiss watches is recognized.

The SIC would therefore agree with area of convergence no. 3.

**Possible area of convergence no. 4: “Consideration of Other Elements of the Mark”**

As mentioned in areas of convergence nos. 2 and 3, Decision 486 of 2000 provides that other elements must be taken into account to find that a sign containing a country name may be considered descriptive or misleading. Examples include the link that the consumer finds to exist between the characteristics of the product and its origin or provenance, or the potential of the sign to deceive the business community or the public as to the provenance of the product or its characteristics.

The SIC would therefore agree with area of convergence no. 4.

### **Possible area of convergence no. 5: “Invalidation and Opposition Procedures”**

During the process of registration of a trademark, the industrial property office, in this case the SIC, orders the publication of the application if it fully meets the legal requirements as to form. For a period of 30 days after publication, interested third parties may oppose the registration, alleging that the sign is descriptive or misleading as to the geographical provenance of the products or services for which it is to be used. Likewise, the SIC may *proprio motu* so declare in the administrative decision on the application for trademark registration and thus refuse registration.

Subsequent to the registration of the trademark, if it is considered that it has been granted in violation of the provisions of Decision No. 486, the absolute nullity of the corresponding administrative decision may be argued before the Council of State, the highest court for administrative disputes in Colombia.

Hence, the conclusion is that Andean legislation has mechanisms for invalidation and opposition of a trademark registration during and after the registration process. We would therefore agree with area of convergence no. 5.

### **Possible area of convergence no. 6: “Use as a Mark”**

Article 11 of Law No. 256 of 1996, which regulates acts of unfair competition in Colombia, in accordance with Article 10 *bis* (3)(iii) of the Paris Convention, states: “*The use or dissemination of incorrect or false statements or assertions, the omission of true ones and any other type of practice which, by virtue of the circumstances in which it occurs, is liable to mislead the persons to whom it is directed or reaches as regards the activity, the commercial services or establishments of others and as regards the nature, the method of manufacture, the characteristics, suitability in use or the quantity of the products shall be prohibited.*”

Moreover, Article 31 of the same law provides for the measures that may be taken by a court to prevent or stop act of unfair competition, such as acts of deception, thus: “[...] *on proof the commission of an act of unfair competition or the imminence thereof, the court, on application by a person with locus standi and under the responsibility of such person, may order the temporary cessation of such act and institute other appropriate precautionary measures.*”

“*The measures provided for by the court shall be processed preferentially. In case of serious and imminent danger, they may be adopted without hearing the opposing party and may be issued within twenty-four hours following the filing of the application. If the measures are requested before the application is filed, the judge at the place in which the act of unfair competition produces or is liable to produce its effects shall also have jurisdiction.*”

A reading of articles 11 and 31, supports the conclusion that Colombian legislation has the appropriate legal means to prevent or cause the cessation of the use of country names, where

such use is intended to mislead the persons to whom it is directed, regarding the characteristics or qualities of the product.

Best regards,

**Cecilia Isabel Nieto Porto**  
**Superintendent Delegate for Industrial Property**