

# Colombia

Contributing firm  
**Cavelier Abogados**



## Authors

**Emilio Ferrero and Felipe Serrano**

## Legal framework

The core regulation for trademarks in Colombia is Andean Community Decision 486 of 2000 on a Common Industrial Property Regime, supranational legislation applicable in Colombia, Bolivia, Ecuador and Peru. This body of rules:

- removed all contradicting internal laws for trademarks;
- established the legal framework for civil proceedings and enforcement actions;
- provided for general border measures; and
- compelled member states of the Andean Community of Nations (ACN) to implement criminal procedures and sanctions for the counterfeiting of trademarks.

In recognition of the substantial increase in the amount of counterfeit goods on the Colombian market (especially

imported goods), Congress and the government have taken important steps towards establishing and implementing an effective anti-counterfeiting policy. These efforts were codified in the Colombian Criminal Code (599/2000, modified by Law 890/2004). Under Articles 306 and 307 of the code, trademark infringement is subject to a range of penalties. In addition, Decree 4540/2006, which specifically regulates border measures and complements Decision 486, creates a procedure that allows trademark owners to request that customs authorities suspend the import, export or transit of goods suspected of infringing IP rights.

Colombia has also ratified several international instruments dealing with trademarks, such as:

- the Paris Convention for the Protection of Industrial Property (approved by Law 178 of December 20 1994); and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (approved by Law 170/1994);

In addition, Colombia is a party to the Inter-American Convention on Protection of Marks and Trade Names (approved by Law 59 of March 25 1936) and the Colombian-French Convention on Industrial Property (approved by Decree 597 of July 7 1904).

Colombia grants protection to trademark owners on the basis that the trademark is effectively registered before the Colombian Trademark Office (Superintendence of Industry and Commerce). Registration entitles the trademark owner to enforce its rights through administrative (border measures), criminal or civil proceedings.

## Border measures

Articles 250 to 256 of Decision 486 and Decree 4540/2006 regulate the application and execution of border measures in Colombia. Under the decree, the import, export or transit of suspected infringing goods may be suspended *ex officio* by customs authorities or *ex parte* at the request of the trademark owner. For the purposes of notifying trademark owners,

Decree 4540/2006 authorized Customs to create and maintain a directory of IP rights holders, in which trademark owners can record their rights. With this mechanism, IP rights holders can be notified of the introduction of fake merchandise into Colombia before it enters the country. Once the trademark owner has been notified, it has the right to:

- ask permission from the Colombian Division of Foreign Trade to inspect the goods; or
- file a request for immediate suspension of the import, export or transit of the goods without inspecting the merchandise first.

The interested party must prove that it owns a trademark registration. In addition, it must provide the authorities with a detailed description of the original merchandise, as well as a description of the infringing goods (if possible). Moreover, the interested party must submit evidence of the existence of an indication of infringement.

The customs authorities must accept or reject the application within a period of three days following the filing date of the application. Once an application has been accepted, the main consequences are as follows:

- The customs authorities will order the suspension of the import, export or transit of the suspected infringing goods.
- The applicant must bring a civil action for infringement of an IP right before a circuit civil judge and/or file a criminal report of infringement before the Office of the Prosecutor General within 10 days of the service of the writ. A civil action for trademark infringement usually takes approximately three to five years in the first instance. A criminal action may last approximately two to four years.
- The suspected infringing goods will remain stored until the civil or criminal court decides whether infringement has occurred. If so, the counterfeit goods will be put at the disposition of the judicial authority and the trademark owner may request the destruction of the goods. However, if it is established that no infringement has taken place, the goods will be returned to their owner and the latter will be compensated.

The trademark owner must request damages and/or the imposition of penalties on the infringer when filing the civil action for infringement or the criminal report of infringement.

### Criminal prosecution

Under Decision 486, ACN member states must impose criminal penalties on any party that infringes an IP right. In order to comply with this mandate, Article 306 of the Colombian Criminal Code establishes that whoever unlawfully uses a trademark that is legally protected (ie, registered before the Trademark Office) or whoever uses a trademark that is confusingly similar to a registered mark will be liable to a term of imprisonment and a fine that will be proportional to the seriousness of the infringement.

The main features of criminal proceedings for trademark infringement are as follows:

- Criminal proceedings may be initiated *ex officio* by the authorities or *ex parte* at the request of any interested party.
- The action may be directed against any party which uses a trademark that is identical or confusingly similar to a registered mark. The action may also be directed against any party that finances, provides, distributes, markets, commercializes, transports or acquires for commercial purposes any products bearing signs that are identical or confusingly similar to registered trademarks.
- Criminal proceedings may take place only where the infringer was aware that it was violating an IP right – that is, the infringement must be intentional. Any indication that the infringer was aware that its actions violated an IP right may help to prove that the infringement was intentional.
- The expression ‘use of a registered trademark’ covers, but is not limited to, the manufacture, offer for sale, sale, distribution, commercialization, import and export of goods bearing the mark.

Criminal proceedings for trademark infringement take place as follows:

- The interested party files a complaint or the authorities initiate proceedings on their own initiative.
- Once the procedure has commenced, a preliminary investigation is carried out. During the investigation phase, the Office of the Attorney General collects evidence of the infringement (eg, it conducts interviews and gathers documents and any other evidence that may be relevant during the proceedings). At this stage of the proceedings, the Office of the Attorney General works in coordination and collaboration with the police and the owner of the trademark.

- Once the investigation phase has been completed, the Office of the Attorney General will declare whether infringement has occurred. If so, a notice of proceedings will be served on the infringer.
- After the formal declaration, the Office of the Attorney General may, within a period of 30 days, file an action against the infringer before a criminal court or put an end to the investigation. This decision depends on whether the evidence before the office is sufficient to prove the infringement.
- If the office decides to file a criminal action, there will be a first hearing during which the court will examine the evidence and both parties will make comments.
- The judgment hearing will then take place. During this hearing, the court will decide whether the defendant is guilty. If the defendant is found guilty, the trademark owner or the Prosecutor’s Office will have the opportunity to request an additional hearing to determine the damage caused to the trademark owner.
- In practice, the trademark owner may collaborate with the Prosecutor’s Office from the beginning of the procedure.

Colombian criminal law establishes the following penalties for the unlawful use of trademarks:

- a term of imprisonment of four to eight years; and
- a fine of 26.66 to 1,500 times the minimum monthly wage (approximately \$6,000 to \$337,000).

### Civil enforcement

Decision 486 regulates civil actions for infringement of trademark rights. According to the decision, civil actions must be brought before the Colombian civil circuit courts. Moreover, Decision 486 establishes that the statute of limitations for such actions is:

- two years from the date on which the IP rights owner became aware of the infringement; or
- in any case, five years from the date on which the infringement ceased.

Civil actions for infringement in Colombia cannot be initiated by national authorities on their own initiative.

A civil action for infringement must be conducted as an ordinary procedure under the Colombian Procedural Law. The key steps of the procedure are as follows:

- The trademark owner must file a complaint before a civil circuit court. It must submit evidence of its trademark rights, as well as any evidence that it may consider necessary to prove the infringement.
- The defendant has 20 business days to answer the complaint, and submit or request evidence.
- The court then conducts a conciliation hearing during which the parties will attempt to reach an agreement. If no agreement can be reached, the court will define the relevant facts and issues of the case. The parties have an opportunity to file additional evidence within the three-day period following the hearing.
- The court then examines the documentary evidence, hears the testimonies of the parties, conducts interrogatories and analyzes all relevant evidence.
- The parties file a brief in which they present their conclusions.
- The court makes a decision.
- Both parties may file an appeal against the court's decision.

During the proceedings, the trademark owner may request:

- an order that the defendant cease the infringing acts;
- compensation for damages;
- withdrawal from the market of any products resulting from the infringement (eg, containers, crates, labels, and advertising and other material), as well as any materials or equipment used to commit the infringement;
- an order prohibiting the import or export of the infringing goods, and of the materials or equipment used to commit the infringement; and
- an order assigning ownership of the counterfeit goods to it; the value of the goods will count as part of the total amount of damages awarded by the court to the trademark owner.

This list is not exhaustive; the trademark owner may request any measures that it deems necessary to protect its rights.

In order to assess the damages caused by the infringer, the courts take the following elements into account:

- the loss of profits of the trademark owner;
- the benefits obtained by the infringer as a result of the infringement (based on net profits); and

- the amount that the infringer would have paid in order to obtain a contractual licence from the trademark owner.

The trademark owner may also request precautionary measures before, during or after the civil action. To request precautionary measures, the trademark owner must demonstrate its entitlement to act and the existence of its trademark rights. In addition, the trademark owner must file evidence that may allow the court reasonably to assume that an infringement has occurred or is about to occur. The court may request that the trademark owner deposit a bond to compensate the defendant for potential damage before issuing the precautionary measures.

Under Decision 486, a trademark owner may request the following precautionary measures, among others:

- the immediate cessation of the infringing acts;
- the withdrawal from the market of the products resulting from the alleged infringement (eg, containers, crates, labels, and advertising and other material), as well as other materials and equipment used to commit the infringement;
- the suspension of the import or export of the infringing goods, or of the materials or equipment used to commit the infringement;
- the deposit of an adequate guarantee by the alleged infringer; and
- the temporary closure of the establishment of the defendant (if necessary to avoid the continuation or repetition of the alleged infringement).

If the trademark owner has requested the precautionary measures before initiating the action for infringement, it must file such action within 10 business days of the execution of the precautionary measures. If the trademark owner fails to initiate an action during this time limit, the precautionary measures will be lifted.

#### Anti-counterfeiting online

There are no specific provisions on online trademark infringement. However, as Decision 486 prohibits the unauthorized use of a trademark on the market, the unauthorized use of a trademark on the Internet is also prohibited in Colombia. Accordingly, trademark owners may bring civil and criminal proceedings in case of online infringement of their marks.

In addition, the legislation establishes that where a well-known trademark is registered in any of the member countries of the ACN as part of a domain name or email address by an unauthorized third party, the national competent authority shall order the cancellation or modification of the domain name or email address at the request of the mark owner.

Moreover, as Colombia is a party to the Domain Name System, NIC-Colombia – which administers the '.co' country-code top-level domain – has adopted the Uniform Domain Dispute Resolution Policy, which was approved by the Internet Corporation for Assigned Names and Numbers on August 26 1999 as the mechanism for resolving disputes in connection with domain names. Through this mechanism, trademark owners may obtain the cancellation or transfer of a domain name that has been unlawfully registered by a third party.

#### Preventive measures/strategies

Rights holders should monitor the market frequently through Colombian branches, or local counsel or investigators. The most effective way is to investigate the companies registered with the Chamber of Commerce of each city. Such chambers handle the registration of all companies operating in a specific geographical area.

In addition, cooperation with national authorities is essential in criminal and border-measure enforcement matters. It is recommended to provide the authorities with the necessary tools (eg, specialized brochures) to distinguish between counterfeit and authentic goods. This will also ensure the effective prosecution of counterfeiting cases by the national authorities.

Finally, it is important to control contractual relationships with third parties, especially with regard to the appropriate use of trademarks on the market. Appropriate use – and evidence of such use – is key to avoiding the cancellation of a trademark on the grounds of non-use and to prove the well-known status of a mark. [WTR](#)

Biographies  
**Cavelier Abogados**

**Cavelier Abogados**

Edificio Siski, Carrera 4 No 72-35,  
Bogota 8, Colombia

**Tel** +57 1 347 3611

**Fax** +571 211 8650

**Fax (US)** +1 305 381 96 60

**Web** [www.cavelier.com](http://www.cavelier.com)



**Emilio Ferrero**

Director

[emilioferrero@cavelier.com](mailto:emilioferrero@cavelier.com)

Emilio Ferrero has been a director of Cavelier Abogados since 1998. He graduated from the Universidad de Nuestra Señora del Rosario of Bogota, Colombia in 1980. He was admitted at the firm as a partner and head of practice area in 1985 and specializes in the field of trademark registrations in Colombia.

In 25 years of practice, he has advised clients on industrial property rights and has handled cases before both the administrative and the judicial authorities in Colombia, as well as before the World Intellectual Property Organization. He also represents the firm in national and international associations of which the firm is a member and has participated as a speaker on his topics of expertise.



**Felipe Serrano**

Attorney

[felipeserrano@cavelier.com](mailto:felipeserrano@cavelier.com)

Felipe Serrano obtained his JD degree from Pontificia Universidad Javeriana, Bogota, Colombia in 2006 and his diploma as a specialist in commercial law from the same university in 2008.

He was admitted to practice in 2007.

Mr Serrano holds a diploma on negotiation tactics from Harvard Law School and a diploma on the US legal system from Yale University.

As associate lawyer in the litigation department of Cavelier Abogados, Mr Serrano has worked as a legal consultant and attorney for several national and foreign companies. He represents clients before judicial and administrative authorities in the areas of industrial property, antitrust, competition and international trade law. He is also a professor of World Trade Organization law at Pontificia Universidad Javeriana, and has published papers on international trade law in several academic publications.