



**International  
Trademark  
Association**

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# **THE INTERNATIONAL TRADEMARK ASSOCIATION**

## **COMMENTS ON**

### **THE COLOMBIAN TRADEMARK EXAMINATION GUIDELINES**

**May 9, 2016**

New York | Shanghai | Brussels | Washington, D.C.

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## **INTA Recommendations on Famous and Well-Known Marks-related Amendments to the Colombian Trademark Examination Guidelines**

*For the Superintendency of Industry and Commerce of Colombia (SIC)*

May 9, 2016

### **Introduction**

INTA greatly appreciates this opportunity to provide comments to the draft Trademark Examination Guidelines of the SIC, of which were produced by the Famous and Well-Known Marks Committee – Latin American Subcommittee.

This submission constitutes the comments of the International Trademark Association (“INTA”) concerning the Famous and Well-Known Marks-related amendments to the Trademark Examination Guidelines of the Superintendencia de Industria y Comercio (SIC). These comments are based on INTA’s “Guidelines for Trademark Examination,” which are referenced in the comments

INTA also would welcome any further dialogue on the proposed recommendations, and would be pleased to share resources on regulations and practices in other countries. Please direct questions regarding this submission to Gabrielle Doyle, Associate, External Relations – Latin America at [gdoyle@inta.org](mailto:gdoyle@inta.org).

### **About INTA**

The International Trademark Association (INTA) is a global association of trademark owners and professionals dedicated to supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce. Members include more than 6,700 trademark owners, professionals and academics from more than 190 countries, who benefit from the Association’s global trademark research, policy development, education and training, and international network. Founded in 1878, INTA is headquartered in New York City, with offices in Shanghai, Brussels and Washington, D.C., and representatives in Geneva and Mumbai.

INTA currently has 42 member firms and corporations in Colombia. Further information about our Association can be found at [www.inta.org](http://www.inta.org).

## **Considerations**

### **1. INTA Model Guidelines for Protection of Famous and Well-Known Marks**

INTA has developed model guidelines for the protection of famous and well-known marks, which provide for the following recommendations:

- There should be protection for famous and well-known marks without requiring registration and/or actual use in the form of sales of goods or services under the mark in the jurisdiction in question provided that such mark has sufficient local reputation to be considered well-known.
- In determining whether a mark is a well-known mark, any circumstances from which it may be inferred that the mark is well-known should be taken into account including, but not limited to, information concerning the following:
  - the degree of knowledge or recognition of the mark in the relevant sector of the public;
  - the duration, extent and geographical area of any use of the mark;
  - the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
  - the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
  - the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well-known by competent authorities;
  - the value associated with the mark.
- The above factors, which are guidelines in determining whether a mark is a well-known mark, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases, all of the factors may be relevant; in other cases, only some of them may be relevant; in still others, none of them may be relevant and the decision may be based on additional factors not listed above.
- Well-known marks shall also be protected against conflicting marks, business identifiers, and domain names – at least with effect from the time when the mark has become well-known – and one of the factors to be considered in assessing any competing interests in this regard shall be bad faith of the party adopting the conflicting marks, business identifiers, or domain names.
  - By ‘business identifiers’ is meant any sign used to identify a business of a natural person, a legal person, an organization or an association.

- By 'domain name' is meant an alphanumeric string that corresponds to a numerical address on the Internet.
- There should be provision for a mark to be declared a well-known mark by a court or by a registry, at its discretion, where the court or registry is satisfied that the relevant criteria for establishing well-known status have been met.

## **2. General Recommendations**

INTA encourages the adoption of the following criteria as a minimum standard of protection for famous and well-known marks.

### Adoption of WIPO Joint Recommendations

The "Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks" adopted by the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organization provides member states, such as Colombia, with guidelines for implementing the well-known mark provisions of international agreements. INTA supports the Joint Recommendation and recommends that the SIC expressly provides that well-known marks be protected in accordance with its provisions.

### Differences between famous and well-known marks

INTA does not take a position on whether there should be a particular terminology or a legal distinction between famous and well-known marks (e.g., the former for trademarks known by the public at large and the latter for trademarks known by a particular sector of the public).

However, INTA recommends that regardless of any distinction, both be given a higher standard of protection.

### Higher standard of protection

Famous and well-known marks are a frequent target of unauthorized uses by third parties, who may not necessarily seek to confuse consumers but to benefit from positive associations that such marks carry.

It is therefore necessary to provide a higher standard of protection, which should apply in two perspectives:

- (1) acknowledging that if a mark is famous or well-known, there is a greater risk of confusion; and
- (2) protecting against dilution.

### Protection of famous and well-known marks in the analysis of the likelihood of confusion

INTA supports the express recognition in the guidelines that, when assessing the likelihood of confusion with a well-known mark, there is an increased risk of confusion, whether or not the goods and services of the parties are identical or similar.

This acknowledgment should apply to marks that are well-known by the public at large, as well as marks that are only well-known in relevant sectors of the public.

### Protection against dilution

INTA supports the inclusion of differentiated statements for protection against risk of dilution, regardless of the presence or absence of likelihood of confusion.

Dilution should be included as an individual ground for opposition, cancellation or infringement when there is a risk that the famous or well-known mark is diluted by a junior use.

### Geographical scope of protection of famous and well-known marks

In the context of a global economy, INTA believes that famous and well-known marks should be protected regardless of the use in Colombia or the Andean Community. For this purpose, evidence from foreign jurisdictions and from all means (including evidence of use on the Internet) should be taken into account for the consideration of famous and well-known character and the corresponding higher standard of protection.

### Conclusion

INTA is pleased to have the opportunity to submit recommendations to SIC as you update the Trademark Examination Guidelines. INTA would be pleased to answer any questions that your office may have and is available to discuss our recommendations in more detail.

Please contact the following INTA representatives:

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INTA thanks SIC in advance for its consideration of these recommendations.