



ASOCIACIÓN COLOMBIANA DE LA PROPIEDAD INTELECTUAL

Plain Packaging Questionnaire

Questions

Please answer the following questions. For each of questions 1) – 10) below, please answer in relation to your country's national laws including any constitutional law.

- 1) If the general conditions of registrability are met, does the product or service in relation to which a trade mark is used or proposed to be used have any affect on the ability to:
- (a) register the trademark; and
 - (b) use it once so registered?

The product or service in relation to which the trademark is sought to be registered or registered does not affect the ability to use or register the trademark. Although, there is a general prohibition in our legislation that establishes that a trademark may be rejected if it is against the law. This prohibition is nonetheless related to the sign itself, and not to the products to which the sign is sought for registration.

- 2) What rights are derived from trademark registration?

The right to use the sign with exclusivity is acquired by the registration.

- 3) What rights exist in relation to a sign used as a trademark but not registered? What is the basis of any such right?

A sign used as a trademark but not registered in Colombia, does not acquire exclusive rights. On the contrary, a notorious trademark not registered in Colombia, can be protected against use or registration by a third party.

- 4) Is it possible to:

- (a) obtain; or
- (b) maintain;

registration for a trademark that is not:



ASOCIACIÓN COLOMBIANA DE LA PROPIEDAD INTELECTUAL

- (i) used; or
- (ii) intended to be used?

Yes, it is possible to obtain the registration of a trademark that is not used, nor intended to be used. Although this trademark, once registered, has to be used within the three years after registration or it could be subject of a cancellation action due to non-use. As well, any registered trademark stopped to be used for three consecutive years, could be subject of cancellation due to non-use.

- 5) If yes to 4) above, are the rights derived from such trademark registration the same or different to registered trademarks that are used?

The rights are the same. Although the right holder of a trademark that is not in use, could lose its rights after three years of non-use.

- 6) Are rights in unregistered trademarks dependent on use? Whether yes or no, please explain the basis for your answer.

There are no rights on unregistered trademarks, except for the case of notorious signs. Rights on notorious signs do not depend on use in Colombia.

- 7) Is there any basis to restrict the use of:

- (a) a registered trademark; or
- (b) a sign used as a trademark?

If yes, please explain any relevant laws or precedents.

There are no precedents in the restriction of use of registered trademarks over products in Colombia.

However, our constitution establishes in article 58 the following: “whenever from the application of a law issued by public utility or social interest, it may result in conflict with the rights of citizens in respect to the necessity recognized by the law; the private interest shall yield to the public or social interest”

- 8) Is there any basis for the state or any state-controlled body to expropriate?

- (a) a registered trademark;



ASOCIACIÓN COLOMBIANA DE LA PROPIEDAD INTELECTUAL

- (b) a sign used as a trademark; or
- (c) the rights deriving from either (a) or (b)?

If yes, please explain any relevant laws or precedents.

As mentioned above, article 58 of the Colombian Constitution establishes the possibility for the law in public utility or social interest to disregard private rights.

It is established as well within the same article 58, that there can be expropriation with basis on public utility or social interest by judicial decision and previous compensation.

Therefore, our conclusion is that a law in public interest, may restrict the use of a trademark over a product, but shall not be able to expropriate the registration. For the trademark registration to be expropriated there shall be judicial decision and previous compensation.

- 9) If yes to 7) or 8) above, do public interest considerations provide any basis for such restriction or expropriation ("Restriction/Expropriation")? If yes, please explain any applicable public interest considerations, and any relevant laws or precedents.

Expropriation can operate by the law in recognition of public utility or social interest. The difference between those two concepts is that the public utility is established by the authorities and the recognition of a social interest can be requested by an individual with the basis on a social need. Nevertheless, the reasons of public utility or social interest must be recognized by the law.

Ever since in Colombia there is no precedent of restriction and/or expropriation of trademark rights, there are not recognized public interest considerations for that.

Nevertheless, the constitution leaves it opened to the legislative power to establish at any time any public utility or social interest consideration. Public health could be protected as a social interest and so the law could regulate on the use of a trademark over a product that might damage public health. Although, it is my opinion, that there should be a direct relation between the use of the trademark and the consideration of public interest, which in the case of trademark use is not evident.

- 10) If yes to 7) or 8) above, are trademarks different from other intellectual property



ASOCIACIÓN COLOMBIANA DE LA PROPIEDAD INTELECTUAL

rights in this regard?

Registered trademarks as Intellectual Property rights are not different from other intellectual property rights in terms of property that can be subject of restriction or expropriation.

- 1) If yes to 7) or 8) above, are any treaty or other international obligations relied on to provide a basis for such Restriction/Expropriation (as applicable)? If yes, please explain the international obligations, and how those obligations are reflected in or received into your country's law.

International Treaties does not need to be the basis for private property restrictions. This possibility as previously stated is established in our Constitution, so as long as the legislative power considers it, it can legislate over public interest. Although, obligations derived by international Treaties such as the WHO, could be the basis for measures taken in favor or public health and involving restriction on the use of trademarks.

- 12) Is your country a signatory to the WHO Framework Convention on Tobacco Control ("FCTC")? If yes, has your country ratified the FCTC?

Yes

- 13) If yes to 12) above, has the FCTC been implemented in your country? If yes, please explain its legal impact, if any, including by reference to the Guidelines for Implementation of Articles 11 and 13 of the FCTC.

Articles 11 and 13 have been implemented in Colombia by the Law 1335 of 2009. There is absolute prohibition of advertisement of tobacco products, as well as packaging and labeling obligations as per established by the FCTC.

- 14) Is the FCTC received directly into your country's domestic law or is domestic legislation required to give it effect in your country's law?

The treaty has been ratified by internal law and further implemented by Law 1335 of 2009, as per established above.

- 15) If there is presently a legal basis in your country for permitting any Restriction/Expropriation, please answer the following questions in relation to both registered trademarks and unregistered trademarks (if your country



ASOCIACIÓN COLOMBIANA DE LA PROPIEDAD INTELECTUAL

recognizes/protects the latter).

- (a) What are the parameters for such Restriction/Expropriation? For example, the nature of any stated public interest considerations, the proportionality of the proposed measure to the Restriction/Expropriation.

The possibility of expropriation in general is established by the constitution. The legislative power shall decide and legislate over the public utility or social interest involved in the expropriation. Particular expropriation shall operate by judicial order and previous compensation. Exceptionally it can operate by administrative decision which can be controverted before the contentious administrative tribunals. There is no precedent of a law that involves the restriction on use or expropriation of trademark rights.

- (b) Is it relevant that such Restriction/Expropriation only applies in relation to a particular class of products, eg tobacco products, foods deemed to be unhealthy or alcohol?

Restriction or expropriation of private property is regarded in general. Although, considering Public health reasons understood as of public utility or social interest, products like alcohol, tobacco or unhealthy foods could be the subject of governmental measures involving restrictions of trademark rights over these products.

- (c) What are the financial consequences for the state and the trademark rights holder respectively? For example, is a rights holder entitled to or eligible for any compensation in respect of the Restriction/Expropriation? If yes, what type of rights holders are so entitled or eligible? If not, why is no compensation available?

As mentioned above, there is no precedent in Colombia for this type of restriction, but according to Colombian constitution, there shall be previous compensation (indemnization) for expropriation. On the contrary, the constitution does not establish compensation for the restriction on the rights.

- (d) If compensation is available, how is it calculated?

In summary, within the expropriation process there is a stage of negotiations between the parties for establishing the price of compensation. If there is not agreement, the judicial expropriation process itself starts. The judge uses the



ASOCIACIÓN COLOMBIANA DE LA PROPIEDAD INTELECTUAL

valuation of experts of the good in question and of the interests of the community, in order to establish the price of compensation. The property is transferred when the established price is paid to the former proprietor.

- (e) Does a trademark rights holder affected by Restriction/Expropriation have any other claims or remedies against the state? If yes, please explain the basis and nature of any claims or remedies.

There are legal remedies available against the judicial decision of expropriation as per established by law for the corresponding judicial decision. In case of administrative expropriation, there is the possibility of starting a contentious administrative complaint against the administrative decision, including the decision over established compensation.

- (f) In the event of Restriction/Expropriation, could a trademark remain registered?

In case of restriction of use of the trademark, the trademark registration can remain in force, taking into consideration that the lack of use in this case would be due to force majeure, which is an excuse to the lack of use within a cancellation action. In the case of expropriation of the trademark, the registration could remain in force in the name of a different entity.

- (g) If yes, what is the consequence of any Restriction/Expropriation on a well known trademark that was registered prior to the Restriction/Expropriation?

Well known trademarks can lose its status because of lack of use evolving in lack of knowledge by consumers. Therefore, in the case of well-known marks, a restriction of use or of promotion, can lead to the loss of notorious character.

- 16)** If there is presently no legal framework in your country permitting Restriction/Expropriation, please answer the following questions in relation to both registered trademarks and unregistered trademarks (if your country recognizes/protects the latter).

- (a) What legislative changes would be necessary in your country to implement a plain packaging regime for a specific class or classes of products such as those previously mentioned? For example, amendments to existing domestic trademark legislation, changes to your country's constitution, multilateral or supranational treaty obligations.



ASOCIACIÓN COLOMBIANA DE LA PROPIEDAD INTELECTUAL

- (b) Could a plain packaging regime be implemented in your country without providing compensation to affected trademark rights holders? If no, what type of rights holders would be entitled to or eligible for compensation? If yes, why would no compensation be payable?
- (c) Would a trademark rights holder affected by Restriction/Expropriation have any other claims or remedies against the state? If yes, please explain the basis and nature of any claims or remedies.