

Krispy Kreme scores sweet victory in nullity action Colombia - Triana Uribe & Michelsen

Cancellation National procedures

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On February 16 2017 the Council of State issued its decision in a nullity action against the registration for the figurative trademark KRISPY KREME:



The case itself was fairly simple: it involved the trademark KRISPY KREME and the word mark KROSPY, whose owners had initiated the nullity action before the Council of State.

The Council of State first stressed the importance of comparing the marks as a whole - that is, taking into account all the elements of the trademarks, which is how consumers perceive them. Second, it elaborated on cases where the comparison involves compound trademarks, which are trademarks that contain more than one element. In those cases, the examiner must pay more attention to the part of the trademark that is the most distinctive. Finally, the Council of State held that there were no visual, phonetic and conceptual similarities between the marks at issues. Therefore, it decided that the registration for the trademark KRISPY KREME had been duly granted.

This case is noteworthy not because of the decision itself, but because it evidences the change of pace in the filing of nullity actions in Colombia.

In 2012 the legislation applicable to nullity actions was modified. Thus, all proceedings initiated before July 2 2012 are governed by the previous legislation, while all proceedings filed after that date are governed by the new oral proceedings.

Indeed, nullity actions in Colombia changed from written to oral proceedings. This change, however, was not without obstacles, despite the speediness resulting from oral proceedings. For the Council of State, the issue was the fact that there was no space for court rooms - with one courtroom for over 20 magistrates and thousands of cases.

In comparison, written proceedings involving trademarks take approximately 10 years to be resolved, which is the lifespan of a trademark if it is not renewed. Therefore, many cases are decided after the trademarks in question have already lapsed, or have already been cancelled for non-use following administrative proceedings before the Colombian Trademark Office. Nullity actions were thus a rather ineffective resource.

Despite the obstacles to oral proceedings, some magistrates have become creative and have managed to reduce the decision time from 10 to four years. This was the case for the proceedings involving KRISPY KREME, which was resolved in less than four years. This shows that the new proceedings, despite their impediments, have a distinct advantage in terms of speed.

Consequently, it seems that nullity actions might become a very good option when it comes to remedying the Trademark Office's mistakes.

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