

Colombian Trademark Office breaks new ground for non-traditional trademarks
Colombia - Triana Uribe & Michelsen

Registration
Non-traditional marks
National

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On June 2 2016 the Colombian Trademark Office (CTO) granted the first ever tactile trademark registration for the surface of the Old Parr bottle to identify “alcoholic beverages (except beers)” in Class 33.



Although it is the first registration, it was not the first application for a tactile trademark in Colombia. Team Foods Colombia SA had applied for a trademark registration consisting of a bottle with spiral carving, a tactile characteristic to identify “edible oils and fats” in Class 29. In that case, the CTO found that even if the carving was a spiral, or as understood by the CTO, transversal, most of the bottles containing “edible oils and fats” had some sort of horizontal carving. Therefore, the mere change of orientation was found to be irrelevant as the consumer does not usually focus on such small details.



However, the present case was different as the texture of most bottles in Class 33 is flat. Furthermore, the CTO decided to request from the Tribunal of Justice of the Andean Community (TJAC) a Prejudicial Interpretation (PI) of the case.

The PI recognised the existence of the Singapore Treaty on the Law of Trademarks (2006), which has been the standard for non-traditional trademarks and has been referenced by trademark applicants when applying for non-traditional trademarks, even though the treaty has not been ratified by any country of the Andean Community.

As with all non-traditional trademarks, the requirement for a graphical representation is a challenge, especially since the trademark has to be published and all third parties have to understand exactly the extent of the protection of the trademark.

One of the TJAC magistrates, in a non-traditional trademark conference in Bogotá on August 27 2015, joked that if you close your eyes and try to imagine what is being described:

It consists of a texture (surface) with embossed crackled appearance, chapped or cracked, created from the agglomeration of irregular geometric shapes which include mostly pentagons, rhomboids and hexagons,

which is part of the description included in the trademark application for the Old Parr bottle, you would have to think that it was wrinkled skin.

Besides the joke, it was clear that it is not easy by means of a graphic to display what is supposed to be felt. To that end, the TJAC held that in order to satisfy the requirement of a graphical representation, a clear, accurate and complete description of the sign, including a three-dimensional drawing or photograph was needed, and disregarding the practicality for any modern trademark office, a physical sample of the product. The treaty contrarily refers to this requirement only in case the description and the drawing or photograph were not sufficient.

During the trademark application proceedings, the CTO required a higher resolution three-dimensional photograph and a sample of the bottle in order to determine whether or not it would convey the tactile feeling of the trademark application.

As mentioned above, not all bottles are crackedled, indeed most bottles in Class 33 are flat. Therefore, the distinctiveness of the outside of the bottle was accepted and the first tactile trademark was born.

We are a long way from some of the most discussed non-traditional trademarks but the way has been made a little easier for innovative and creative entrepreneurs to obtain non-traditional trademark registrations.

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