

The power behind notoriety
Colombia - Triana Uribe & Michelsen

Examination/opposition
Confusion

October 27 2017

- **CTO denied registration of MONSIEUR PERRUNÉ for confusing similarity to unregistered mark MONSIEUR PERINÉ**
- **Concluded that it diminished the distinctive force and commercial value of MONSIEUR PERINÉ**
- **Decision demonstrates the power of notoriety**

Colombian trademark protection is based on registration; therefore, trademark rights are not granted to unregistered marks. However, unregistered marks are recognised and protected and can be an obstacle to a trademark application. This was the case for the trademark application for MONSIEUR PERRUNÉ (SD2016/0037470) for services in international Class 41, which was suspiciously similar to the name of the famous Colombian band MONSIEUR PERINÉ, which had no trademark registrations.

The owners of MONSIEUR PERINÉ filed an opposition to the MONSIEUR PERRUNÉ mark. Decision 486 of the Andean Community (applicable trademark law for Colombia and the Andean Community), establishes several grounds of opposition to an undesired application that might affect a third party's sign (even if unregistered).

The opposition was based on the following two grounds:

- previous use of a trade name; and
- notoriety of a distinctive sign.

The opponent demonstrated the three elements to be proven when filing an opposition based on a trade name – its continuous, public and repeated use. Moreover, this use was initiated in 2007, which predated the trademark application.

Once the trade name was duly proven and the period of use established, the signs underwent an examination for confusing similarity. In this case the difference between the signs was limited to two letters located in the middle of the second word, while the services overlapped as both referred to entertainment activities.

Concerning notoriety, the Colombian Trademark Office (CTO) held that the MONSIEUR PERINÉ mark had both a national and international presence in the music business. It had also been extensively advertised and was well known for entertainment-related activities.

Given the notoriety of MONSIEUR PERINÉ, the CTO concluded that the trademark application for MONSIEUR PERRUNÉ diminished the distinctive force and commercial value of the previous sign due to the similarity between them.

The registration of trademark application MONSIEUR PERRUNÉ was therefore denied.

This is only one of the many functions of the declaration of notoriety, which has also been useful when trying to avoid the cancellation of a trademark for non-use.

In Colombia, the mark WAL-MART (94-024997) was registered in 1994. However, its use was disputed in 2006 by a claim of cancellation for non-use. Even if in Colombia use is not an obligation *per se*, a trademark might be cancelled if, when requested by a third party, its owner cannot prove use for the last three years.

However, proven use of the trademark must be qualified – it must refer to the mark as it was registered in the mode and quantity that corresponds to the nature of the goods or services identified with the sign.

In the WAL-MART case, the CTO held that the trademark may have fulfilled its purpose (identifying goods or services in the market), even when the goods or services were not actually available to consumers, since by being widely recognised in the market (in which it has no commercial presence), it satisfied its distinctive purpose.

However, the trademark must be well known regarding the goods or services covered by the registration to be effective against a cancellation for non-use, as the trademark function would only be extended to the said

goods or services.

Therefore, there is great value within a declaration of notoriety, as it allows signs to be protected beyond regular protection, even without registration or use.

Sandra Ávila-González, Triana Uribe & Michelsen, Bogota

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.