

**COURT OF JUSTICE OF THE ANDEAN
COMMUNITY CONFIRMS COLOMBIAN
DECISION TO GRANT COLOR TRADEMARK:
PROCESS 01-AI-2017**

DIEGO GUZMÁN*

ABSTRACT

The Court of Justice of the Andean Community decided the Non-compliance Action filed against Colombia for granting two color trademarks. The case was part of the plaintiff's strategy, Acava Limited, to prevent its competitor, Postobón, from using pantone color 183C to have an exclusive right to identify their soft drinks. The decision rejected Acava's arguments, confirming Colombia's position to grant color trademarks delimited by shapes.

Keywords: Trademarks, Color trademarks, Non-traditional trademarks, Trade dress, Industrial property.

* Lawyer of the Universidad Externado de Colombia. He holds a Master's Degree in Law (LLM) in Intellectual Property from Benjamin N. Cardozo School of Law, New York, and a specialization in Industrial Property, Copyright and New Technologies from the Universidad Externado de Colombia. Throughout his career, he has worked as Director of Intellectual Property and Data Protection for the firm Grupo Legal Andino. He has also been a consultant to the Superintendence of Industry and Commerce on trademark matters with the Delegation of Industrial Property and consumer protection in telecommunications with the Consumer Protection Delegation. He currently directs the firm Diego Guzmán Abogados and works as research professor of Copyrights and New Technologies for the Universidad Externado de Colombia. He is also the Editorial Coordinator of the journal *La Propiedad Inmaterial* of the Intellectual Property Department of the same university. Contacto: diego.guzman@uexternado.edu.co. Bogotá D. C. (Colombia). Para citar el artículo: GUZMÁN, D. "Court of Justice of the Andean Community confirms Colombian Decision to Grant Color Trademark: Process 01-AI-2017", *Revista La Propiedad Inmaterial* n.º 27, Universidad Externado de Colombia, enero-junio 2019, pp.213-215. doi: <https://doi.org/10.18601/16571959.n27.08>

TRIBUNAL DE JUSTICIA DE LA COMUNIDAD ANDINA CONFIRMA LA DECISIÓN
DE COLOMBIA DE RECONOCER MARCAS DE COLOR: PROCESO OI-AI-2017

RESUMEN

El Tribunal de Justicia de la Comunidad Andina decidió sobre la Acción de Incumplimiento presentada en contra de Colombia por otorgar dos marcas de color. El caso fue parte de la estrategia del demandante, Acava Limited, para evitar que su competidor, Postobón, usara el de forma exclusiva el color pantone 183C para de identificar sus bebidas. La decisión rechazó los argumentos de Acava, confirmando así la posición de Colombia para otorgar marcas de color delimitadas por formas.

Palabras clave: marcas, marcas de color, marcas no tradicionales, Trade dress, propiedad industrial.

On May 16, 2019, the Court of Justice of the Andean Community (TJCA) decided the Non-compliance Action filed against Colombia. The case was brought to the TJCA as a strategy by Acava Limited, to attack the decisions made by the Colombian Patents and Trademarks Office (PTO), the Superintendence of Industry and Commerce (SIC), granting two trademarks to the Colombian soft drinks giant Postobón. The decision rejected Acava's arguments, which in the end confirms Colombia's position to grant color trademarks delimited by shapes.

The Non-compliance Action was filed in January 11, 2017, by the soft drinks company Acava Limited. The company argued “that Colombia, through the . . . SIC . . . would cause an infringement [against the Andean Decision 486 of 2000] by having granted in favor of POSTOBÓN, the registration of two trademarks made up of the pink color in a non-particular and an usual shape”. Acava also claimed that the pink color lacked distinctiveness as it is the ordinary result of the oxidation process of an apple.

In response, the SIC denied infringing Decision 486. The Colombian PTO contested the allegations by justifying its decision to grant both trademarks was based on article 134.e.¹ of Decision 486, which establishes that colors delimited by shapes may constitute trademarks. Therefore, the distinctiveness of the sign is based on the delimitations of the pink pantone color 183C—in one case— by the form of a glass and—in the second case— by the form of a bottle. The SIC

1 Andean Decision 486 of 2000. Article 134. For the purposes of these Provisions, any sign capable of distinguishing goods or services on the market shall constitute a mark. Signs that are susceptible of graphic representation may be registered as marks. The nature of the product or service to which a mark is to be affixed shall in no case be an obstacle to the registration thereof.

The following signs, among others, may constitute marks:

(...)

(e) a color within an outline, or a color combination;

also argued that the pink color identifying Postobón's soft drinks had acquired a secondary meaning, which justified the decision to grant a trademark right.

In its reasoning to decide the case, the TJCA considered "the Resolutions adopted by the SIC are not acts contrary to what is regulated in the Andean regulations or obstruct its application". The Andean Court also explained its lack of competence to decide whether a sign is distinctive enough to be granted with a trademark right, stating that it "cannot go to analyze whether the assessment of distinctiveness was correct or not, that is clearly a competence of the SIC so there is no breach of the rules invoked by the applicant."

In addition, the TJCA referred to the secondary meaning argument justifying the grant of a non-traditional trademark such as a color. It clarified that even though signs can acquire distinctiveness through use, "this does not mean that the only way to acquire the right with respect to a non-traditional trademark is through the figure of acquired distinctiveness or secondary meaning, because the Community norm also provides the possibility for the sign to acquire the trademark category by the simple fact of enjoying distinctiveness *ab initio*."

As a result, the TJCA concluded that the arguments presented by Acava regarding the Colombian PTO infringement of Decision 486 by granting two color trademarks were not accepted. As the SIC's decision did not go against the Andean regulation, the Andean Court declared the claim to be unfounded. Hence, the Colombian position about the requirements to grant non-traditional trademarks such as color trademarks was confirmed. This might be understood by commerce as a green light to filing more trademark registrations to happen in the near future.