

# WORLD TRADE ORGANIZATION

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**Council for Trade-Related Aspects  
of Intellectual Property Rights**

Original: Spanish

## CHECKLIST OF ISSUES ON ENFORCEMENT

### Responses from Colombia

#### Addendum

By a communication from its Permanent Mission, dated 20 November 2000, Colombia has notified a series of corrections to its responses to the Checklist of Issues on Enforcement so as to bring them into line with the recently issued Decision 486 of the Commission of the Andean Community.<sup>1</sup>

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<sup>1</sup> See document IP/N/1/COL/1/3.

**THE TEXT BELOW REPLACES THE RESPECTIVE RESPONSES  
GIVEN IN DOCUMENT IP/N/6/COL/1**

**4. What means exist to identify and protect confidential information brought forward as evidence?**

The Code of Civil Procedure provides as follows:

"Article 127. Examination of the files. The files may only be examined by:

1. The parties;
2. the accredited lawyers;
3. duly authorized agents of the latter, but only in relation to matters in which they intervene;
4. officers of the court;
5. civil servants by reason of their duties;
6. persons authorized by the court, for teaching or scientific research purposes.

As long as any notification to be effected personally to a party or his/her representative remains pending, neither the former nor the latter, nor an agent of the latter, may examine the proceedings until such notification has been effected."

In positive law, there are rules dealing with information which is not confidential in nature and is accessible to the public.<sup>2</sup> Moreover, Article 61 of the Commercial Code states that a merchant's books and papers may not be examined by persons other than their owners or the persons authorized by the latter, except by virtue of an order by the competent authority.

Furthermore, in respect of information provided as evidence and involving a trade secret, Article 262 of Decision 486 is applicable.

At the same time, the law establishes mechanisms for the protection of confidential information, by prohibiting its disclosure and providing for the punishment of conduct which infringes the right to keep such information confidential. Article 16 of Law 256 of 1992 describes as unfair the "disclosure or exploitation of industrial secrets or any other type of business secrets without authorization from the holder, to persons legitimately granted access but subject to an obligation to exercise reserve". Further, pursuant to Article 38 of Law 200 of 1995, failure to perform official duties, the abuse or improper exercise of rights or functions or engagement in prohibited conduct constitutes a disciplinary offence on the part of civil servants, giving rise to the imposition of the corresponding sanctions.

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<sup>2</sup> For example, books and archives contained in the Commercial Registry, in accordance with Article 26 of the Commercial Code.

**5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:**

- **Injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

Injunctions

In the context of proceedings concerned with copyright and related rights, the court may, in addition to other measures, order penalization of the infringing activity.

- Legislation on unfair competition

Inasmuch as violation of industrial property rights may involve misleading acts<sup>3</sup>, deception<sup>4</sup> and/or exploitation of the reputation of others<sup>5</sup>, which constitute unfair competition under the terms of Law 256 of 1996, such violation is punishable by means of the corresponding remedies provided for in the above-mentioned law.

Article 20 of Law 256 of 1996 regulates actions that may be brought (before the competent courts<sup>6</sup> or the Supervisory Authority for Industry and Trade, in accordance with the provisions of Articles 143 and 144 of Law 448 of 1998) as a result of conduct constituting unfair competition. The law states that such actions may be of two kinds: declaratory actions to obtain a conviction, involving a request that the acts performed be declared unlawful by the court and that the infringer consequently be ordered to terminate the effects produced by those acts and provide compensation for the injury caused; and preventive actions or proceedings for interdiction, whereby the court is requested to prevent the performance of an act of unfair competition that has not yet been carried out or to prohibit the act even though it has not yet caused any injury.

- Prohibition on the use of a mark, logo, trade name or commercial sign

Under the terms of Articles 607 and 609 of the Commercial Code, a party injured by the use of a mark, logo, trade name or commercial sign, may apply to the circuit civil courts to prevent such use and claim the corresponding damages in an action which, if successful, entails the relevant prohibition of use and order to pay damages.

Damages, including recovery of profits, and expenses, including attorney's fees

The claim for damages may form part of a declaratory civil action, pursuant to Articles 242 and 243 of Law 23 of 1982. Although Article 45 of the TRIPS Agreement is covered by Section 2 ("Civil and administrative procedures and remedies"), it should be pointed out that the criminal law

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<sup>3</sup> Article 10, Law 256 of 1996.

<sup>4</sup> Article 11, Law 256 of 1996.

<sup>5</sup> Article 15, Law 256 of 1996.

<sup>6</sup> Article 17 of the Code of Civil Procedure provides that the specialized circuit civil courts have original jurisdiction over proceedings relating to "patents, industrial designs, marks, commercial signs and trade names and other industrial property assets", which are not assigned to the administrative authorities or the administrative courts, and that the precautionary measures provided for in Articles 678, 681, 682 and 690 of the Code of Civil Procedure may be requested for the purpose of preventing continued violation of such rights.

also provides for the possibility of obtaining compensation for damage caused by an infringement of copyright, which is classified as an offence. Indeed, Article 13 of the Code of Criminal Procedure establishes the restoration of rights as one of its guiding principles. Under this Article, the judicial authorities shall, wherever possible, adopt the measures necessary to ensure cessation of the effects produced by perpetration of the punishable act and a return to the status quo ante, so that the violated rights are restored.

Andean Decision 351 of 1993 provides as follows:

"Article 57. The competent national authority may likewise order the following:

- (a) Payment to the owner of the infringed rights of adequate compensation or indemnification for damage and injury sustained as a result of the infringement".

The same Andean Decision 351 of 1993 also provides:

"Article 57. The competent national authority may likewise order the following:"

(...)

- "(b) That the infringer shall bear the cost of the proceedings incurred by the owner of the infringed right".

At the same time, the Code of Civil Procedure provides:

"Article 304. Amended. D.E. 2282/89, Article 1 paragraph 134. Content of the judgement.

(...)

The part of the judgement containing the verdict shall be placed under the heading "Administering justice on behalf of the Republic of Colombia and by authority of the law"; it shall contain specific and clear decisions on each of the claims made, any pleas which call for decision, the costs and damages to be borne by the parties and their authorized representatives, and other subjects on which a decision is required under the terms of this Code." (No added emphasis in the text).

Article 571 of the Commercial Code, in accordance with the provisions of Articles 238, 239, 240, 241, 242, 243 and 244 of Title XV of Decision 486 of the Commission of the Cartagena Agreement – "On Actions for Infringement of Rights - provides that the owner or licensee of a patent, utility model, industrial design, mark, logo, trade name or commercial sign may take action for damages resulting from their usurpation without the need to request the corresponding precautionary measures, or in cases where such measures have been refused.

Moreover, the costs relating to the proceedings (stamp duties, fees for officers of the court, formalities and legal agency<sup>7</sup>)<sup>8</sup> must be ordered ex officio by the court against the losing party.

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<sup>7</sup> Legal agency refers to fees for legal representation ... they constitute consideration for the expenses incurred by the party in the judicial defence of his/her interests ... The order for costs does not necessarily correspond to the fees actually paid by the successful party to his/her representative". Constitutional Court, Judgement C-539 of 28 July 1999. Reporting Judge Eduardo Cifuentes Muñoz.

<sup>8</sup> Paragraph 2, Article 393, Code of Civil Procedure.

Destruction or other disposal of infringing goods and materials/implements for their production

Law 44 of 1993 provides as follows:

"Article 55. Impounded publications, copies, reproductions, moulds, plates, printing blocks, negatives, tapes, covers or labels shall be subject to judicial inspection with the assistance of the expert, and once shown to be illegal by this means, shall be destroyed by the criminal investigation authorities, in the presence of the court officer, with notification to the defence and the party claiming damages."

"Article 56. Impounded goods intended directly or indirectly for the production, reproduction, distribution, transport or marketing of illegal copies shall be attached or seized ex officio, and following valuation, those that are not to be destroyed shall be awarded under the adverse judgement to the parties injured by the punishable act, by way of damages, or shall be put up for auction for that purpose."

Bearing in mind that there is no exhaustive list of the precautionary measures that may be requested in the course of civil proceedings, application may be made for the implementation of precautionary measures which, while not expressly provided for in civil legislation, are not excluded thereby. They include the following:

Confiscation<sup>9</sup> of the implements and effects used to commit a fraudulent punishable act or derived from its perpetration and not available on the open market, which shall be placed under the control of the State prosecuting authority or the entity appointed by the latter, unless the law requires that they be destroyed in accordance with the provisions of Article 338 of the Code of Criminal Procedure.

The new Code of Criminal Procedures provides for the confiscation<sup>10</sup> of products or merchandise, publications, copies, reproductions, moulds, plates, printing blocks, negatives, tapes, covers or labels seized in the investigation of intellectual property offences and, provided that they are shown to be illegal, for their destruction in accordance with the provisions of Article 67.

Confiscation of substances, appliances and other objects intended for the performance of acts connected with the description of goods with distinctive marks which are misleading in respect of their origin or content<sup>11</sup>, in accordance with the provisions of Article 43<sup>12</sup> of Decree 1355 of 1970 and Article 42 which provides that, if the act is performed by traders personally or through the action of persons in establishments owned by them, the closure of the establishment concerned for up to six months shall be ordered.

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<sup>9</sup> Article 338 of the Code of Criminal Procedure provides that, if payment for damages has not been effected or guaranteed, where an order for such payment is applicable, the court officer may order seizure of the implements or effects used for performance of the fraudulent punishable act or derived from its perpetration, for purposes of appropriate compensation.

<sup>10</sup> Article 67 of the Code of Criminal Procedures, Law 600 of 2000.

<sup>11</sup> The aforementioned conduct constitutes a specific violation affecting the national economy, as provided in Article 41 of Decree 522 of 1971.

<sup>12</sup> Article 194 of Decree 1355 of 1970 states with respect to confiscated goods that their sale by public auction or handing over to a public welfare institution must be ordered, unless they belong to a third party not involved in the facts constituting the offence, in which case they must be handed over to that party. The same Article provides that, in the case of beverages, foodstuffs and provisions in general that are in bad condition, they must be destroyed by the police in the presence of their owner.

Confiscation of material intended for the perpetration of the infringement, or which are the subject of the infringement, may be requested in proceedings brought before the circuit civil courts and the Supervisory Authority for Industry and Trade, on the grounds that, although provision is made for this measure under criminal and police legislation, its application may be requested in civil proceedings since no exhaustive list exists of the precautionary measures which may be requested.

**9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.**

Article 267 of the Administrative Litigation Code provides as follows:

"Article 267. Unregulated matters. In matters not covered by this Code, the Code of Civil Procedure shall be followed insofar as it is compatible with the nature of the proceedings applicable in the administrative courts."

Administrative authority responsible for processing the registration and deposit of industrial property rights

Since enforcement procedures are meant to permit effective action against any act of infringement of intellectual property rights, in accordance with the provisions of Article 41 of the 1995 Agreement between WIPO and WTO, provision must be made within this type of procedure for the possibility of challenging acts which violate property rights through conduct originating even as early as the stage of processing of an application for registration.

The administrative procedure for the registration of marks and patents conducted by the Supervisory Authority for Industry and Trade normally consists of three rulings which may be reduced to one or two, as follows: a substantive ruling is issued, either granting or refusing the application, and further decisions are delivered in the event that applications for review and/or appeals are lodged, where admissible, by the party challenging the original decision.

In addition, direct revocation of administrative industrial property decisions by the Supervisory Authority for Industry and Trade may, where appropriate, be requested in accordance with the provisions of Article 69 of the Administrative Litigation Code.

Following completion of the administrative stage or the stage of application to the Supervisory Authority for Industry and Trade, a party seeking to challenge the final decision may apply to the administrative court – the Council of State – in order to obtain a favourable ruling to reverse the administrative decision, by bringing actions to establish nullity or absolute nullity and to restore rights, as provided in Article 85 of the Administrative Litigation Code.

Which persons have standing to assert intellectual property rights? How may they be represented?

Applicants for and holders of industrial property rights who seek to oppose the granting of rights to third parties may apply to the administration directly or through a duly accredited representative, in accordance with the provisions of Article 63 of the Code of Civil Procedure.

Are there requirements for mandatory personal appearances before the court by the right holder?

There are no provisions requiring the holder of or applicant for industrial property rights to appear personally before the administrative court – the Supervisory Authority for Industry and Trade. However, as a rule, for the purpose of appearing before the courts (Council of State), the person

concerned must be represented by a duly accredited representative, in accordance with the provisions of Article 63 of the Code of Civil Procedure.

What authority do the administrative or judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?

Pursuant to Article 283 of the Code of Civil Procedure, a party which seeks to use documents in the possession of the other party shall apply for their disclosure to be ordered at the stage of calling evidence. Similarly, Article 288 provides that partial discovery of the books and papers of a trader which bear a necessary relationship to the subject of the proceedings may be ordered ex officio or at the request of a party.<sup>13</sup>

Article 285<sup>14</sup> of the same statute provides that, if the party ordered to make disclosure objects to doing so, the court shall assess the grounds for such objection and, if it does not find them justified, shall consider as established the facts which the party requesting disclosure intended to prove, unless the submission of evidence by deposition is not admissible in respect of such facts, in which case the objection shall be counted against the party by which it was made. The Article in question also provides that the same procedure will be followed when a party which has not filed an objection fails to produce the document, unless it establishes timely justification for such failure and subsequently produces the document when called upon to do so by the court.

What means exist to identify and protect confidential information brought forward as evidence?

We refer to the points made in the reply to question 4 in this document.

Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use.

The Council of State monitors the lawfulness of decisions taken by the Supervisory Authority for Industry and Trade and may accordingly uphold them as long as they are in conformity with the law, or declare them to be totally or partially void if they are contrary to the law. In such cases, the administrative authority may be ordered to act in a specified manner, for example by cancelling registration of a mark or certification of a patent, carrying out a new study on the registrability of a sign or the patentability of an invention, etc.

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<sup>13</sup> In line with Article 65 of the Commercial Code.

<sup>14</sup> In conformity with Article 67 of the commercial code which provides: "if the trader does not submit the books and papers ordered to be produced, conceals any of them or obstructs their examination, the facts alleged against him/her by the opposing party shall be taken to be established, if deposition is admissible for those facts" (...).

**Provisional measures**

(a) Judicial measures

**10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.**

Andean Decision 351 of 1993 provides as follows:

"Article 56. The competent national authority may order the following precautionary measures:

- (a) Immediate cessation of the unlawful activity;
- (b) the seizure, impoundment, sequestration or preventive attachment, as appropriate, of copies produced in violation of any of the rights recognized in this decision;
- (c) the seizure, impoundment, sequestration or attachment of the apparatus or materials used for the commission of the unlawful act.

Precautionary measures shall not be applicable to a copy acquired in good faith for exclusively personal use."

In connection with authorization to apply for precautionary measures, Decree 266<sup>15</sup> of 2000 provides as follows:

"Article 77. Preventive attachment. Article 224 of Law 23 of 1982 is amended to read as follows:

Article 224. Authors, publishers, producers of phonograms, computer programs or audiovisual works, performers, broadcasting organizations or their successors in title, and anyone responsible for their legal or conventional representation, may apply to the court for the preventive attachment of:

- 1. Any work, production, publication and copies;
- 2. the proceeds of the sale or rental of such works, productions, publications or copies; and,
- 3. the proceeds of the sale or rental of theatrical, cinematographic, musical and other similar shows or entertainments."

Law 23 of 1982 provides as follows:

"Article 245. The persons referred to in the first subparagraph of the preceding Article may request the court to prohibit or suspend the performance or display of a theatrical, musical or cinematographic work and of similar works that are to be performed or displayed in public without the necessary authorization of the copyright owner or owners."

Law 44 of 1993 provides:

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<sup>15</sup> Decree 266 of 2000, amending Decrees 2150 and 1122.



"Article 54. The law enforcement authorities shall put a stop to the illegal activity by means of:

1. Suspension of the infringing activity;
2. seizure of illegal copies, moulds, plates, printing blocks, negatives, carrier media, tapes, covers, diskettes, telecommunication equipment, machinery and other elements intended for the production or reproduction of illegal copies or their marketing;
3. immediate closure of the establishment, if the premises concerned are open to the public, and suspension or cancellation of the operating licence."

Law 44 of 1993 provides:

"Article 55. Impounded publications, copies, reproductions, moulds, plates, printing blocks, negatives, tapes, covers or labels shall be submitted for judicial inspection with the assistance of the expert, and once they have been shown by these means to be illegal, shall be destroyed by the criminal investigation authorities, in the presence of the Court officer, and with notification to the defence and the party claiming damages."

Similarly, Law 44 of 1993 provides as follows:

"Article 56. Impounded goods intended directly or indirectly for the production, reproduction, distribution, transport or marketing of illegal copies shall be attached or seized ex officio, and following valuation, those that are not to be destroyed shall be awarded under the adverse judgement to the parties injured by the punishable act, by way of damages, or shall be put up for auction for that purpose."

The Code of Criminal Procedure provides as follows:

"Article 52. Seizure and attachment of goods. In the decision imposing the impoundment measure, or subsequently, the prosecutor or the court shall order the seizure and preventive attachment of goods that are the property of the accused, in a quantity deemed sufficient to guarantee payment for the injury caused, and shall appoint a custodian."  
(...)

"If no goods are specifically known to exist, or the attached goods are not sufficient in quantity, the party claiming damages may report the existence of goods at any time and the court officer shall order the seizure and attachment in the amount deemed necessary, subject to deposit of a security. The security shall be cancelled once the claimant pays the value of the injury caused by the precautionary measures, or remits the monetary worth of the security ordered by the court or that of the said injury, whichever amount is less."  
(...)

The new Code of Criminal Procedure (Law 600 of 2000), which will enter into force on 25 July 2001, provides as follows in this connection:

"Article 60. Seizure and attachment of goods. At the time of the decision in which an impoundment measure is ordered, or subsequently, the court officer shall order the seizure and attachment of goods that are the property of the accused.

In the event that it is not necessary to resolve the legal situation, the court officer, subsequent to the laying of charges (*vinculación*), shall ex officio or at the request of the complaining

party order the seizure and attachment of goods owned by the accused when the evidence referred to in Article 356 of this Code is taken in the proceedings.

Seizure and attachment of the goods shall be ordered in an amount sufficient to guarantee payment for the injury caused, subject to the requirement of lodging a security in accordance with the rules laid down in the Code of Civil Procedure. This decision shall take the form of a writ of enforcement.

Both the application and the order to impose and implement substantive precautionary measures shall be treated as confidential until they are implemented and give rise to the opening of a record separate from the main proceedings.

"Once the seizure and attachment has been ordered, the court officer shall appoint a custodian and conduct the subsequent procedure in accordance with the relevant rules contained in the Code of Civil Procedure.

Where the measures affect immovable property held or occupied by the accused, it shall be left in his possession by way of free security, subject to his undertaking to surrender it to the custodian or to any party specified by the court officer if an adverse ruling is issued against him.

A decision to revoke precautionary measures is appealable delayed effect.

Paragraph. In proceedings where the injured parties are minors or persons lacking legal capacity, the public prosecutor may request the seizure and attachment of goods belonging to the accused under the conditions set out earlier in this Article, except for the obligation to provide security."

Precautionary measures of an evidentiary nature, concerned with the need to preserve evidence that may be destroyed or simply disappear, would under Colombian civil procedural law be covered by the possibility of requesting and examining advance evidence, as regulated by Articles 294 et seq. of the Code of Civil Procedure, including the evidence referred to in Article 300 set out below.

In this connection, the Code of Civil Procedure provides as follows:

"Article 300. Amendment. D.E. 2282/89, Article 1, paragraph 131. Judicial examinations and expert appraisals. With or without personal service to the opposing party, a request may be made for the production of advance evidence through the judicial examination of persons, places, objects or documents that are to be the subject of proceedings, where a well-founded fear exists that the passage of time may alter their status or make it difficult to identify them."

Pursuant to Articles 568, 581 and 597 of the Commercial Code, taken together with Articles 245, 246, 247, 248 and 249 of Decision 486 of the Commission of the Cartagena Agreement, the owner or licensee of a patent, utility model, industrial design, mark, logo, appellation of origin, trade name or commercial sign may request the competent courts to impose the precautionary measures necessary to protect their industrial property rights, whenever such rights are usurped or infringed.

Such precautionary measures, in accordance with the above-mentioned Article 568, may involve requiring infringers to provide security as a guarantee for refraining from performance of the acts alleged against them, seizure of articles manufactured in violation of the industrial property right and prohibition on advertising them, attachment of machinery or materials used to manufacture the articles infringing the industrial property right, or any other equivalent measure. The precautionary

measures provided for in Articles 678, 681, 682 and 690 of the Code of Civil Procedure include seizure and attachment of goods, whether or not subject to registration, entry of the claim in the official list and seizure and attachment of funds, among other things.

The above-mentioned measures may also be requested in the course of proceedings brought before the competent courts or the Supervisory Authority for Industry and Trade on the grounds of unfair competition or infringement of industrial property rights.

**11. In what circumstances may such measures be ordered *inaudita altera parte*?**

The Code of Civil Procedure contains the following provisions on this subject:

"Article 327. Amendment. D.E. 2282/89 Article 1, paragraph 154. Implementation and notification of precautionary measures. Precautionary measures shall be implemented immediately, prior to notification to the opposing party of the order by which they are imposed. If they were imposed prior to the proceedings, the party concerned shall be notified on the day on which he/she appears in the proceedings or acts in them or signs the appropriate submission."

"Letters and documents for implementation of the above-mentioned measures shall be sent to the interested party only following notification of the order by which the claim was allowed or the writ of execution was issued."

Article 690. Amendment. D.E. 2282/89, Article 1, paragraph 346. Precautionary measures in ordinary proceedings. The rules set out below shall be applied in ordinary proceedings.

1. In the order allowing a claim which deals with title or another independent right in rem over movable or immovable property, either directly or as a consequence of a separate claim or incidentally to such claim, or with a comprehensive group of assets, *de facto* or *de jure*, at the request of the plaintiff, the court shall order the following precautionary measures:  
(...)
- (b) Attachment of movable property, appointment of a custodian and indication of the date and time of the procedure, which may be conducted prior to notification to the respondent of the order allowing the claim if so requested by the plaintiff, who in order to have the measure imposed shall furnish a security to guarantee any damage that might be caused thereby". (No added emphasis in the text)

**15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?**

According to Administrative Instruction 0022 of 1998 of the National Taxation and Customs Directorate (DIAN), goods for which it is possible to apply for the suspension by the customs authorities of the release into free circulation are goods protected by copyright and related rights, in

particular cassettes and compact discs, and phonograms, videograms, software and cinematographic works in general.

This procedure is not applicable to the entry of goods which does not constitute an international trade transaction (e.g. passengers' personal luggage).

Pursuant to the right of importation recognized in Article 13, subparagraph (d), of Andean Decision 351 of 1993, a copyright owner has the right to prevent the importation into the territory of any member country of the Andean Community of copies made without the authorization of the right holder. Conversely, it is not possible to oppose the importation of copies that have been reproduced in another country under an authorization from the right holder.

The procedure enshrined in the above-mentioned administrative instruction is applicable to both import and export transactions.

Articles 250 and 256 respectively of Decision 486 of The Commission of the Cartagena Agreement provide that "The owner of a registered trademark who has valid grounds for suspecting that the importation or exportation of counterfeit trademark goods will take place may request the competent national authority to suspend this customs operation". Small quantities of goods of a non-commercial nature contained in traveller's luggage or sent in small consignments shall be excluded.

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