Colombia: gateway to South America's Patent Prosecution Highway

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Colombia has reached an agreement with the USPTO to participate in the Patent Prosecution Highway, becoming the first South American country to gain such status. With Colombia’s sturdy economy and confident move into the global marketplace, this agreement could not come at a better time. Understanding the need for more robust patent laws, the Colombian government is aggressively reshaping its IP system.

The authors had the opportunity to meet with Jose Luis Londoño Fernández, Superintendent of Industrial Property (Colombia’s equivalent to the USPTO). He was enthusiastic about the Colombian patent system and the Patent Prosecution Highway and is eagerly seeking to educate Colombians and the global public about the mechanisms available for protecting their ideas and innovations.

Mr. Londoño believes so strongly in patent protection that he is in the process of separating the patent office from the trademark and copyright office to allow the patent department to rapidly expand. Mr. Londoño’s staff provided us with statistics indicating that United States companies rank first among those seeking protection in Colombia, followed by Germany and Colombia, then Switzerland in fourth place.

Overview of Colombia’s patent system

Colombia patent law was implemented under the Andean Community Decision 486 of 2000, incorporating the Agreement on Trade-Related Aspects of Intellectual Property Rights, the Patent Cooperation Treaty, the Paris Convention on Industrial Property and the UPOV Convention. Since these laws and treaties were enacted, Colombia has shrunk patent examination times from 54 months to 48 months and is aiming for further reductions.

Types of patents

Colombia patent law offers two major types of protection – the invention patent (patente de invención, similar to US utility patents) and the utility model patent (patente de modelo de utilidad, similar to US design patents). All rights are granted to the inventor. There is no protection for new uses of previously known items. Also non-patentable are scientific theories or mathematical methods; living things found in nature; aesthetic creations; rules and methods for pursuit of intellectual, economic or business activities; computer programs and software; methods for presenting information; and diagnostic, therapeutic and surgical methods for treatment of humans or animals.

Formal requirements

All applications must be filed, in Spanish, with the Patent Office (División de Nuevas Creaciones) of the
Superintendent of Industry and Commerce (SIC). The date of receipt by the Patent Office constitutes the filing date. Complete applications are published 18 months after filing in the Gaceta de Propiedad Industrial. An opposition may be filed by anyone within 60 days of publication. The applicant may reply to this opposition.

**Patentability and examination standards**

All inventions must be new, involve an inventive step and be industrially applicable. A new invention is one not previously made available to the public by written or oral description. An invention is inventive when it is neither obvious nor obviously derived from the state of the art.

The application is examined by an examiner, who is a licensed attorney. Typically, examiners handle about 20 applications at a time. Examiners only search public databases, like the USPTO and Escape databases, for potential prior art, and may consult with experts or request additional documentation from the applicant. If such a request is made, the applicant has 60 days from notification to provide the required documentation; otherwise, the application will be abandoned. Final decisions of patentability are made within 48 months from filing. If a patent application is granted, the patent will be in force within five working days.

If some or all of the application’s claims are rejected and the applicant disagrees, the applicant has five working days to file a Motion for Reconsideration (Recurso de Reposición). These requests are reviewed by the Superintendent of SIC, and the decision is final.

**Protection and enforcement**

An invention patent confers protection for 20 years; a utility design is protected for 10 years. The scope of protection is defined by the claims. This time period is not extendable and continuations are not available. As in the US, a strong presumption of validity exists.

Infringement in Colombia happens when one unlawfully makes, offers for sale, uses, imports or carries out the acts of a patented invention or process. Patents are enforced by filing an infringement action to seek injunctive relief and/or damages with the Colombian Circuit Court or the criminal system. In civil actions, a plaintiff may request a preliminary injunction that is in place for the duration of the litigation. The request must be supported by a showing of infringement. Damages include lost profits and actual damages, unjust enrichment and reasonable royalty.

In Colombia, a patent infringer may also be subject to criminal penalties, among them a three- to eight-year jail sentence and fines. This remedy, almost unique to Colombia, can be quite an effective tool against counterfeiters.

**Closing observations**

Colombia’s economy is quickly growing and globalizing. As a member of the WTO and a member state of the PCT, it will become even more active in the world’s IP market. Companies such as Chevron, Sumitomo, Abbott and Bayer have already sought patent protection in Colombia. Applications are quickly examined and infringement can involve both civil and criminal actions. Thus, Colombia is a potentially valuable venue when seeking patent protection.

For more information about patent applications in Colombia, please contact Tiffany Nichols, Eduardo Blanco or Pamela Bechtel.

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