

PANORAMIC

PATENTS

Colombia

 LEXOLOGY

Patents

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PATENT ENFORCEMENT PROCEEDINGS

Lawsuits and courts

What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

A patent holder may pursue civil or criminal actions either to stop or to prevent infringing acts. The Superintendence of Industry and Commerce (SIC) has jurisdiction over infringement cases through an independent judicial division. The SIC is also where the Colombian Patent Office resides.

Civil actions may be pursued before the SIC or the civil circuit courts present in the larger cities. Criminal actions may be pursued before a specialised unit for intellectual property affairs (according to articles 306 and 307 of the Criminal Code); however, criminal infringement actions are extremely rare. If the infringer is a public servant or a government entity, the patent holder must file a 'direct reparation' lawsuit before the contentious administrative jurisdiction.

The SIC has become the principal venue to litigate infringements. However, over the past year, civil circuit judges and the Superior Tribunal (for appeals) have proven to be an effective and faster choice for patent infringement cases.

According to the SIC 2023 Annual Report, complaints filed before the SIC decreased by 27 per cent (a total of 416 cases, including unfair competition, trademark and patent infringement cases compared with 428 complaints in 2022). There are no statistics related to IP infringement cases before Civil Circuit Judges. However, with two recent SEP litigation campaigns patent litigation has increased over the past two years including both venues (the SIC and civil circuit judges).

Law stated - 28 febrero 2024

Trial format and timing

What is the format of a patent infringement trial?

Civil patent infringement trials may start with the filing of a request for preliminary injunctive relief, along with or before the filing of a complaint (injunctive relief can, however, be sought at any time during the process). It is possible to request and obtain preliminary injunctive relief without serving or hearing the counterpart.

The SIC may serve notice on the defendant in some cases involving a preliminary injunction, while civil circuit judges tend to resolve this type of preliminary injunction request ex parte. Considering that invalidity cannot be contested during the infringement process, cases are typically settled once a preliminary injunction is issued.

Outside of the complaint and reply, the procedure is mostly oral and follows these stages:

- preliminary injunction request (optional) and decision;
- filing of the complaint;

- admission and service of the complaint to the defendant;
- reply by the defendant;
- conciliation hearing, evidence-gathering process and oral closing arguments;
- prejudicial interpretation of applicable Andean law before the Andean Court of Justice (the prejudicial interpretation is optional in a first-instance stage; however, it will become mandatory during an appeal); and
- a final ruling.

A standard infringement case before the SIC may take anywhere between one and two years to reach a final ruling. The following types of evidence are admissible:

- expert opinions and testimony provided by the parties (which can be cross-examined);
- court-appointed expert opinions;
- site inspections; and
- requests for the production of documents.

Affidavits are admissible, but witnesses will most probably be ordered to provide oral testimony to provide the defendant with the opportunity to cross-examine the witness and controvert its conclusions. Party experts may be local or foreign, academic or professional. They may also be employees, but the judge will question credibility owing to bias.

In addition, Colombian procedural law provides pre-litigation discovery motions for site inspections, document production, depositions, and witness or expert testimony.

The parties may appeal an adverse decision from the SIC before the Bogota Superior Tribunal, and an adverse decision from a civil circuit court before a superior tribunal from the city in which the complaint was filed. The appeal procedure can take one to two years.

Law stated - 28 febrero 2024

Proof requirements

What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

The burden of proof to demonstrate infringement for product claims lies on the plaintiff, and the standard is similar to the US 'clear and convincing' standard. This burden may be reversed for method claims if the plaintiff can show:

- a substantial likelihood that the process is being infringed; and
- either:
 - the product obtained by means of the patented process is a new product, or
 - reasonable steps were taken to determine if infringement was taking place.

If the reversal is triggered, to avoid a holding of infringement, the defendant must demonstrate that its accused method is different from the patented one.

Grounds for patent unenforceability must be proven by the defendant, based on the clear and convincing standard.

The burden of proof to demonstrate invalidity is carried by the plaintiff (the party seeking to invalidate the patent), who must show that the patent office erred when granting the patent, based on the clear and convincing standard.

Law stated - 28 febrero 2024

Standing to sue

Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

Legal standing to sue for patent infringement cases is limited to:

- any of the co-owners of the patent (individually and severally) unless otherwise agreed; or
- under article 564 of the Commerce Code, the licensee.

Although extremely rare and not specifically contemplated under Colombian practice, if a patent infringement action has not yet been filed by the patent holder, a potential infringer may request a declaration of non-infringement. Beyond a perceived threat (eg, a cease-and-desist letter or a warning letter to customers), there is no specific conduct that must be alleged or shown in order to have standing for such declaratory action. There may be some forum-shopping advantages for a potential defendant if there is a benefit to removing the case from the SIC to a civil court.

Law stated - 28 febrero 2024

Inducement, and contributory and multiple party infringement

To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

Colombian IP law (Andean Decision 486 (Decision 486)) does not specifically contemplate the figure of inducement or contributory infringement. There is likewise no case law on this point; however, article 238 of Decision 486 provides that a patent holder may seek protection against acts that present the imminence of infringement. Under a broad interpretation of 'imminence', a patent holder could argue that acts of inducement present a high risk of infringement and hence could be stopped.

Multiparty infringement of a single claim is not specifically contemplated, nor is there case law on point; however, it is possible that a broad interpretation of article 238 may also allow

the patent holder to pursue different actors that may be contributing in a concerted fashion to materialise the infringement.

Law stated - 28 febrero 2024

Joinder of multiple defendants

Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing all of the same patents?

The plaintiff may join different infringers in a single complaint if they hold a responsibility in the infringing conduct (eg, offer for sale, sale, use, manufacture or importation) and the conduct is related to the violation of the same patent or patents.

Although there is limited precedent, there are four recent cases (2015, 2019, 2020 and 2022) where plaintiffs filed patent infringement lawsuits against various companies comprising a joint venture that collectively used a patent-protected invention. The lawsuit and preliminary injunction request named all the companies as defendants. The lawsuits were successfully admitted by the SIC and a civil circuit judge of Bogotá.

Law stated - 28 febrero 2024

Infringement by foreign activities

To what extent can activities that take place outside the jurisdiction support a charge of patent infringement?

Under the general territoriality rule applicable under Decision 486, the scope of patent protection is limited to acts that take place in Colombia, including importation; however, a Colombian court may prevent the importation of a product directly resulting from a process patented in Colombia, even where the process took place outside Colombia.

Law stated - 28 febrero 2024

Infringement by equivalents

To what extent can 'equivalents' of the claimed subject matter be shown to infringe?

Decision 486 does not specifically contemplate the doctrine of equivalents, nor does it preclude such a possibility. However, On 23 February 2023, the Superior Court of Bogotá issued a second instance decision, which applied for the first time the doctrine of equivalents. Within the ruling, the Court applied the triple substantial identity test, which affirms that there is a patent infringement by equivalents if the infringing product incorporates an element that, although it is different from that covered in the claim, fulfils the same function, operates in the same way, and complies with the same technical result of the claimed element.

A plaintiff may seek a broad interpretation of the terms in the claims. The patent specification, drawings and examples may be used to interpret the scope of the claims

as granted. Additionally, prosecution history and closely related prior art could be used persuasively by the defendant to limit any broad interpretation.

Law stated - 28 febrero 2024

Discovery of evidence

What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

Colombian procedural law provides for quick and broad pre-litigation discovery motions (PDMs) for site inspections, document production, depositions, and witness and expert witness testimony. There are also broader evidence-gathering requests that can be made once a complaint is filed.

Both pre-litigation and post-complaint evidence gathering may be requested outside Colombia and against third parties. Failure to comply in certain cases will allow the court to draw adverse inferences.

PDMs may be requested by anyone who is a potential plaintiff or defendant in future judicial proceedings. For patent infringement actions, the SIC also has jurisdiction over PDMs and has become the principal venue for doing so since it has proven to be very effective.

Typically, orders for PDMs can be issued as quickly as three weeks from filing the request.

Law stated - 28 febrero 2024

Litigation timetable

What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

According to the General Procedural Code, a first-instance decision on a standard patent infringement case may take one year from the service of the complaint to the defendant, with a six-month extension available. The SIC tends to respect this deadline.

A second-instance decision may take approximately two more years.

Preliminary injunctions are available and may be obtained at any time between three weeks and two months if it is requested before the SIC. After a preliminary injunction request is made, it may take civil circuit judges between one and three months to reach a decision.

Law stated - 28 febrero 2024

Litigation costs

What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal? Are contingency fees permitted?

The costs of prosecuting an infringement lawsuit vary depending on the complexity of the case and are normally invoiced on an hourly basis. Excluding the invalidity portion, in terms of an average case, it is reasonable to budget anywhere between US\$75,000 and US\$250,000 for a period of one to three years for a single patent, covering pre-litigation and the first instance. Reaching a settlement could significantly reduce costs.

For the second instance, it would be prudent to budget US\$50,000 to US\$100,000 over a one- to two-year period.

The cost of an invalidity suit will vary greatly, depending on the amount of evidence that requires processing and the complexity of the case. A prudent budget would range between US\$75,000 and US\$250,000 over four years.

Contingency fees are permitted and vary depending on the complexity of each case. They range between 10 per cent and 30 per cent of the amount of damages recovered. The National Bar prohibits contingency fees that exceed 50 per cent.

Law stated - 28 febrero 2024

Court appeals

What avenues of appeal are available following an adverse decision in a patent infringement lawsuit? Is new evidence allowed at the appellate stage?

The parties may appeal an adverse infringement decision from the SIC before the Bogota Superior Tribunal, while an adverse decision from a civil circuit judge may be appealed before a superior tribunal from the city in which the complaint was filed. Infringement cases, by petition of a party, may eventually be selected to be heard by the Supreme Court.

A second-instance decision may take approximately an additional one to two years to obtain a final decision.

New evidence at the second instance is allowed in the following cases:

- when all parties agree on the request for new evidence;
- when the evidence was requested and accepted by the judge at the first instance but, through no fault of the requesting party, the evidence was not presented;
- when it proves facts that occurred after the request of evidence at the proper opportunity during the first instance; and
- when it relates to documentary evidence that was not able to be provided at first instance because of unforeseen circumstances or force majeure.

In addition, the judge has the discretion to request any additional evidence that is considered useful to issue a final ruling.

As of 25 January 2022, invalidity suits (annulment actions) became double-instance procedures. The first instance must be brought before the Administrative Tribunal of Cundinamarca, while the second instance will fall to the Council of State. This venue change is expected to expedite procedures. Law 2220 of 2022 (in force since 30 December 2022) indicates that before filing an annulment action, the plaintiff must request an extrajudicial

conciliation hearing with the SIC (defendant). However, in practice, some judges from the administrative tribunal have indicated that it is not required to request the extrajudicial conciliation hearing while others apply this provision.

Law stated - 28 febrero 2024

Competition considerations

To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition or a business-related tort?

IP rights are a legitimate exception to free market rights. Patent rights, however, are not absolute rights and are limited to the scope of the claims as granted.

In that sense, for example, making an unduly broad interpretation of the granted claims could be interpreted by the defendant as an abuse of IP rights, providing an alleged infringer with legal standing to seek relief relying on unfair competition arguments.

From an antitrust perspective, if the patent holder has a dominant position in the relevant market, an abusive exercise of its patent rights could be taken as an abuse of a dominant position. To the best of our knowledge, neither the courts nor the antitrust authorities have issued a decision on this issue; however, one case was recently decided by the SIC and confirmed in an appeal before the Superior Tribunal, in which a patent owner was sued by a potential infringer before the SIC alleging acts of unfair competition for sending letters requesting assurances of non-infringement. All claims of the potential infringer (the plaintiff) were rejected, as sending letters and using mechanisms to obtain information to perform a patent infringement analysis is not considered an unfair competition act.

Law stated - 28 febrero 2024

Alternative dispute resolution

To what extent are alternative dispute resolution techniques available to resolve patent disputes?

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were rejected, as sending letters and using mechanisms to obtain information to perform a patent infringement analysis is not considered an unfair competition act.

Law stated - 28 febrero 2024

SCOPE AND OWNERSHIP OF PATENTS

Types of protectable inventions

Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

As a general rule and pursuant to the Agreement on Trade-Related Aspects of Intellectual Property Rights, Colombian authorities have to provide patent protection for inventions in all fields of technology (article 14 of Decision 486); however, there are certain limited exceptions to that rule, either in the form of subject matter that is not considered an invention (article 15 of Decision 486) or that is excluded from patentability (article 20 of Decision 486). For example, business methods are not considered inventions, and methods of treatment, surgery or diagnosis are expressly excluded from patentability. Software as such (lines of code in a programming language) is not considered an invention; however, computer-implemented inventions are patentable insofar as they provide a technical contribution.

According to the position of the Andean Court of Justice and article 21 of Decision 486, use and second-use claims are not patentable subject matter, not even if they are drafted in the Swiss-type format.

Law stated - 28 febrero 2024

Patent ownership

Who owns the patent on an invention made by a company employee, an independent contractor, multiple inventors or a joint venture? How is patent ownership officially recorded and transferred?

The right to a patent belongs to the inventor (individual) and may be transferred to third parties by written assignment or succession in title (to an individual or a corporation). There is a presumption of assignment for inventions developed within the framework of an employment relationship or performed by an independent contractor (article 539 of the Commercial Code and article 29 of Law 1450 of 2011). A copy of the employment contract will suffice.

Multiple inventors share the right to patent the invention in the same proportion unless otherwise agreed.

For joint ventures, the patent can be assigned jointly to each company constituting the joint venture in the proportion previously agreed. As a joint venture is not considered a legal person, it may not be the holder of a patent right (article 22 of Decision 486). Any of the companies in a joint venture or co-owners may initiate a patent infringement lawsuit against third parties, regardless of the percentage of the patent held (article 238 of Decision 486).

Patent ownership is officially recorded when the assignment document from the inventor to the applicant is filed with the patent application before the Patent Office. Ownership is transferred upon execution of the assignment documents.

Law stated - 28 febrero 2024

DEFENCES

Patent invalidity

How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

Invalidity does not provide grounds for a defence within an infringement case (Colombia has a bifurcated system); instead, the defendant in an infringement action seeking to invalidate the patent must bring a separate lawsuit (an annulment action) against the Colombian Patent Office (CPO) and request the joinder of the patent holder as an interested third party.

As of 25 January 2022, an annulment action must be brought before the Administrative Tribunal of Cundinamarca at the first instance stage and is now a double instance procedure. Prior to 25 January 2022, annulment actions were prosecuted in a single-instance procedure before the Council of State (the highest court in charge of reviewing the legality of administrative acts).

The purpose of an invalidity complaint is to demonstrate that the resolution that granted the patent was issued in violation of the Constitution, Andean Decision 486 (Decision 486) or any procedural or substantive Colombian law.

According to the Administrative Procedural Code (Law 1437 of 2011, in force from 2 July 2012), a typical annulment action for a patent case involves:

- filing of the complaint;
- admission and service on the defendant (CPO) and the interested third party (the patent holder);
- formal reply by the CPO and the patent holder;
- preliminary hearing, comprising the agreement on the facts to be litigated and the opening of the evidence-gathering stage;
- evidence-gathering process;
- evidence hearing (up to 15 consecutive days);
- closing arguments hearing;
- mandatory prejudicial interpretation of applicable Andean law before the Andean Court of Justice;
- final ruling; and
- appeal, if applicable.

With the exception of the complaint and reply, the foregoing procedure is almost completely oral and intended to last less than two years; however, a reasonable expectation is that in reality the procedure to reach a first instance decision will take anywhere between three and

five years, depending on the complexity of the case, the amount of evidence that has to be gathered and the court backlog.

The annulment action will not automatically stay the infringement proceedings, and it is practically impossible to obtain such a stay or suspend the effects of the patent until the annulment action is decided. In practice, this situation generates an enormous presumption of validity for any patent and effectively removes invalidity as a viable defence.

Law stated - 28 febrero 2024

Absolute novelty requirement

Is there an 'absolute novelty' requirement for patentability, and if so, are there any exceptions?

There is an absolute novelty requirement. An invention is novel when it is not disclosed in the prior art. The prior art includes any public worldwide disclosure, including any written or oral description, use, offer for sale or sale before the claimed priority date. Solely for the purpose of determining novelty, the content of an earlier patent application pending before the CPO shall also be considered part of the prior art provided that the content is included in the earlier application when published or after 18 months from the filing or priority date passes.

The applicant has a 12-month novelty grace period counted from the priority date for any disclosure of the contents of the patent, providing that the disclosure was attributable to:

- the inventor or the inventor's assignee;
- a competent national office that publishes the contents of a patent application filed by the inventor or the inventor's assignee in contravention of the applicable law; or
- a third party who obtained the information directly or indirectly from the inventor or the inventor's assignee.

Law stated - 28 febrero 2024

Obviousness or inventiveness test

What is the legal standard for determining whether a patent is 'obvious' or 'inventive' in view of the prior art?

A patentable invention must involve an inventive step (ie, it cannot be deemed obvious or evidently derived from the prior art by a person ordinarily skilled in the art). An inventive step in Colombia is usually assessed by means of the problem-solution approach.

Additionally, evidence of unexpected or surprising results, as well as secondary indicia of non-obviousness (eg, the solution of an unresolved need in the art or the existence of contrary teachings in the art) may be persuasive to rebut a prima facie case of obviousness. Experimental results (which need not be in the specification and may even be generated after the priority date and could include inventor's declarations –which are not required to be legalised – comparative results, papers demonstrating the established knowledge in a field or additional data) may be submitted in response to inventive step objections during prosecution.

Patent unenforceability

Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

No, there are no grounds to consider that a patent is unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason; however, there are certain situations, mostly categorised as defences, that may, in practice, render a patent unenforceable, such as acts carried out privately and for non-commercial purposes, exclusively for experimentation and exclusively for the purpose of teaching or scientific or academic research (a complete list is contained in article 53 of Decision 486).

International exhaustion of rights operates under article 54 of Decision 486. Accordingly, parallel imports are legal in Colombia.

Colombia implemented a regulatory submission exception (Decree No. 729 of 2012), also known as a Bolar exemption. It allows third parties to use the claimed subject matter to generate the information necessary to support an application for the marketing approval of a pharmaceutical or agrochemical product under the condition that it will not be made, used, sold, offered for sale or imported into the territory, other than for the purposes of meeting marketing approval requirements before the patent expires.

Finally, compulsory licensing is available under Decision 486. Two of the grounds relate to patent owner conduct or omission, specifically non-working and abuse of dominant position. Although a compulsory licence is not properly grounds for unenforceability, and notwithstanding the due compensation obligations, having a compulsory licence granted will, in practice, greatly limit a patent owner's capability to effectively enjoy its full rights afforded by a patent.

Prior user defence

Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

The rights conferred by a patent may not be asserted against a third party that, in good faith and before the priority date or the filing date of the application on which the patent was granted, was already using or exploiting the invention (publicly or privately), or had already made effective and serious preparation for such use or exploitation.

This defence covers all types of inventions, and the third party has the right to start or continue using or exploiting the invention without encumbrance; however, that right may only be assigned or transferred together with the business or company in which that use or exploitation is taking place (article 55 of Decision 486).

REMEDIES

Monetary remedies for infringement

What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature? How are royalties calculated?

Article 243 of Andean Decision 486 (Decision 486) provides the plaintiff with a variety of alternatives to calculate the compensation to be paid for damages, including:

- lost profits and actual damages;
- unjust enrichment; or
- reasonable royalty.

Very few cases get to the damages stage; a preliminary injunction is often enough. Punitive damages are not available. Damages and causation must be proven through discovered evidence and expert testimony. There is little case law available on how royalties should be calculated (eg, what the royalty base should be and the percentage of the royalty).

- Attorney fees as set by the National Bar are available for the winning parties (ie, the actual attorney invoices cannot be submitted, and often the National Bar fees are far below the actual billable fees).
- A patent holder may recover damages for acts of infringement occurring after the date of grant, plus pre- and post-judgment interest. The patent holder may also, additionally and once the patent is granted, recover damages for pre-issuance acts of infringement occurring after the date of publication (article 239 of Decision 486).
- The Administrative Procedure Code has a provision whereby a plaintiff seeking to be granted monetary remedies must include a reasonable estimate of the amount of the damages with the complaint. The Administrative Procedure Code provides a penalty against the plaintiff when it is proven that the calculated damages estimate was unreasonable. The penalty will be equivalent to 10 per cent of the difference between the estimated amount and the final proven amount ordered within the final ruling.

Law stated - 28 febrero 2024

Injunctions against infringement

To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

The patent holder may request a court to grant injunctive relief to stop or prevent an infringement from occurring. This relief may comprise, among other things, the following:

- an order to stop all infringing activities;
- the seizure of all infringing products;
- the suspension of the importation or exportation of the infringing products;
- the establishment of a bond; and
- the temporary closure of the business belonging to the defendant, if necessary, to avoid the continuation or repetition of the alleged infringement.

According to the applicable law, a preliminary injunction may be requested and granted *ex parte*; however, in practice, the Superintendence of Industry and Commerce (SIC) serves the defendant in approximately 90 per cent of patent cases and provides the opportunity to file counterarguments to the request prior to issuing a decision, while before the civil courts usually the defendant does not participate.

The preliminary injunction requires the plaintiff to show ownership of the patent, the existence of the patent and summary evidence of the infringement (normally an expert attesting to the fact the allegedly infringing product or process reads on the claims); however, in a recent case related to a pharma patent, a judge from the SIC required a higher standard of evidence for an injunctive relief request: it requested additional evidence from the expert opinion to grant a preliminary injunction, specifically requiring sample testing of the alleged infringing product.

A bond must be offered and posted to cover potential damages caused by the injunction should the plaintiff eventually lose the case on the merits. A plaintiff does not need to show that it is working the patent in order to qualify for preliminary or permanent injunctive relief.

The defendant may eventually file a reconsideration action against the grant of a preliminary injunction. Further, depending on the necessity, reasonableness and proportionality of an injunction, the judge may decide to suspend or modify it at any time. In most cases, a preliminary injunction will become final if the plaintiff wins on the merits. Injunctive relief, if properly requested, may extend to the infringer's suppliers and customers.

A decision on a preliminary injunction request may take between one and three months and an additional three months for a final decision on appeal.

Law stated - 28 febrero 2024

Banning importation of infringing products

To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

Importation is an act of infringement. Accordingly, it is possible to block the importation of infringing products by requesting a preliminary injunction. In contrast, there are no border measures for patents in Colombia. These measures apply only for trademark and copyright infringement.

Law stated - 28 febrero 2024

Attorneys' fees

Under what conditions can a successful litigant recover costs and attorneys' fees?

Successful litigants may recover attorneys' fees by simply requesting the judge to order the losing party to pay; however, in practice, the amount recognised by the judge does not correspond to the actual invoiced fees but rather to predetermined fees set by the National Bar.

The National Bar has regulated that the attorneys' fees in first-instance rulings must be between 3 per cent and 7.5 per cent of the amount claimed as damages and, for the appeal, between one and six times the Colombian monthly minimum salaries.

Law stated - 28 febrero 2024

Wilful infringement

Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate? Are opinions of counsel used as a defence to a charge of wilful infringement?

No, there are no additional remedies available against deliberate or wilful infringement. Opinions of counsel may be useful in rare criminal cases to rebut criminal intent.

Law stated - 28 febrero 2024

Time limits for lawsuits

What is the time limit for seeking a remedy for patent infringement?

The time limit for seeking a remedy for patent infringement is two years counted from the date the patent holder had knowledge of the infringement or, in any case, five years counted from the date the last act of infringement occurred.

According to Prejudicial Interpretation No. 205-IP-2018 issued by the Andean Court of Justice, the two-year limit should be counted from the date the plaintiff had knowledge of the infringing act, regardless of whether the infringement is instantaneous, continuous, permanent or complex. The five-year limit should be calculated from the time the last act of infringement occurred, which varies depending on the type of infringement.

Law stated - 28 febrero 2024

Patent marking

Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

Neither Decision 486 nor local regulations provide any regulation in relation to patent marking. In any case, it is possible to include markings in products, such as 'patent pending' or 'patented'. False patent marking can easily lead to an unfair competition or antitrust claim by a competitor or other affected party.

Law stated - 28 febrero 2024

LICENSING

Voluntary licensing

Are there any restrictions on the contractual terms by which a patent owner may license a patent?

Technology transfer agreements involving voluntary patent licences must not include provisions limiting the right of experimentation, research and development of the licensee. These types of restrictions fall within the unenforceable clause types contemplated in the Common Regime for the Treatment of Foreign Capital. Attempting to enforce such a clause could also run afoul of local antitrust legislation (Decree No. 2153 of 1992), forbidding, in general, any sort of illegal restriction of access to a given market.

Law stated - 28 febrero 2024

Compulsory licences

Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

The Colombian Patent Office (CPO) may declare compulsory licences (CLs) for the following reasons (article 61 et seq Decision 486):

- lack of working;
- public interest, emergency and national security reasons;
- abuse of dominant position; and
- patent dependence (compulsory cross-licensing).

Lack of working

The standard for granting a CL under these grounds is unjustified lack of working after three years following grant, or four years counted from the filing date, whichever is the longest. Potential licensees must first contact the patent owner and attempt to obtain a voluntary licence under reasonable commercial terms. In the framework of a CL procedure, the patent owner will have a 60-day term, counted from the notice of the CL procedure, to file a statement evidencing the working of the patent or a viable excuse justifying non-working.

Public interest, emergency and national security reasons

Whenever public interest, emergency or national security reasons are declared by the government, the CPO may open a CL public bid over those patents subject to the prior declaration. Interested third parties meeting the terms of reference established by the CPO may subsequently submit offerings to obtain CLs.

On 13 November 2008, the Ministry of Trade (MoT) issued Decree No. 4,302, modified by Decree No. 4,966/2009 (the two decrees were later compiled in Decree No. 1,074/2015), establishing a procedure for the declaration of public interest, providing the applicable ministry with the authority to declare, after an investigation, the existence of a public interest related to the subject matter under its jurisdiction. The declaration of public interest (DPI) may also take place upon the request of interested parties.

On 25 April 2017, the MoT issued Decree No. 670/2017, which modified Decree No. 1,074/2015. The decree created the Interinstitutional Technical Committee, comprising a delegate of the competent authority, a delegate of the MoT and a delegate of the director of the National Planning Department, which has the faculty to evaluate the arguments and evidence provided during the procedure and issue a recommendation to the competent authority to issue a final decision regarding a DPI request; and eliminated the possibility of ordering alternative measures to overcome a DPI situation.

According to the Prejudicial Interpretation No. 144-IP-2019 issued by the Andean Court of Justice (ACJ) (as part of an infringement action in Ecuador that addressed the CL regime under Decision 486 in the Andean Community (Bolivia, Colombia, Ecuador and Peru)), public interest must be assessed on a case-by-case basis, wherein general declarations are not acceptable, and the competent authority must analyze and demonstrate based on evidence the existence of particular public interest reasons. Furthermore, the granted CL term should be directly related to the existence of public interest reasons (not taking the expiration of the patent as a limit).

Finally, the interpretation stated that challenging a CL does not suspend its effects; thus, a CL beneficiary may exploit the patent despite the owner appealing or challenging the decision, provided the beneficiary complies with its obligations, including paying royalties determined in the CL.

Abuse of dominant position

The Colombian antitrust authority, either ex officio or at the request of a party, may grant CLs to correct practices previously declared as contrary to the exercise of free competition, especially where they constitute an abuse by the patent owner of a dominant position in the market.

Patent dependence

The CPO shall grant a CL, upon request by the owner, of a patent whose exploitation necessarily requires the use of another patent and where the right holder has been unable to secure a contractual licence to the other patent on reasonable commercial terms. The

dependent patent must claim an invention that constitutes an important technical advance and of considerable economic importance over the senior patent.

To date, although various investigations have been opened seeking a declaration of public interest against pharmaceutical patents, no CLs have been granted in Colombia.

Law stated - 28 febrero 2024

PATENT OFFICE PROCEEDINGS

Patenting timetable and costs

How long does it typically take, and how much does it typically cost, to obtain a patent?

In practice, the Colombian Patent Office (CPO) averages between 24 and 36 months to issue a non-final decision after filing.

The costs of filing, prosecuting and obtaining a patent, including official and professional fees, range between US\$2,500 and US\$8,000 over the course of prosecution, depending on the complexity of the case and the number of office actions.

Law stated - 28 febrero 2024

Expedited patent prosecution

Are there any procedures to expedite patent prosecution?

Neither Andean Decision 486 nor local regulations provide accelerated procedure options; however, diligent prosecution practice may reduce the timeline of the application significantly, for example, by modifying the application excluding use claims, method of treatment claims or any other non-patentable subject matter.

It is also convenient to interview examiners in charge of the case and discuss alternatives to expedite prosecution and avoid additional examinations. For PCT cases filed in Colombia, publication typically occurs less than one month after it is filed (provided no formal examinations are issued).

Several Patent Prosecution Highway (PPH) options exist to speed up examination based on counterpart applications filed in participating intellectual property offices. As for bilateral PPH agreements, the CPO has signed agreements with the United States Patent and Trademark Office (USPTO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KPO), the European Patent Office (EPO) and the Spanish Patent and Trademark Office (OEPM).

The CPO is also part of multilateral PPH agreements in Latin America, such as PROSUR-PROSUL (including Argentina, Brazil, Costa Rica, Chile, Ecuador, Paraguay, Peru and Uruguay – Panama, the Dominican Republic and Nicaragua have joined this agreement but the particular PPH Guidelines have not been issued yet), the Pacific Alliance (including Chile, Peru and Mexico) and the Global PPH (including 26 other patent offices).

Law stated - 28 febrero 2024

Patent application contents

What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

Decision 486 requires the specification to include sufficient disclosure of the invention to allow a skilled artisan to reproduce the invention and make clear the inventor was in possession of the invention at the time the application was filed. Additionally, the specification must contain the best mode to produce the invention (it does not need to be identified as the best mode within the specification).

As a general rule, specifications that comply with European Patent Office (EPO) standards will usually not face disclosure issues before the CPO.

Law stated - 28 febrero 2024

Prior art disclosure obligations

Must an inventor disclose prior art to the patent office examiner?

Applicants are obligated to include in the specification of patent applications the prior technology known to the applicant that would help the invention to be understood and examined, as well as references to previous documents and publications that discuss the technology involved (article 28(b) of Decision 486). The foregoing has not been interpreted by the CPO as a specific duty to disclose prior art that may be materially relevant to the patentability of the invention. Nevertheless, the applicant can disclose this information when the application is filed in Colombia in a specific section of the CPO's database.

Additionally, according to article 46 of Decision 486, the CPO may request search results and examination reports of counterpart applications in other patent offices.

Law stated - 28 febrero 2024

Pursuit of additional claims

May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier-filed application? If so, what are the applicable requirements or limitations?

No, if the earlier application is not claimed as priority, a later filed application cannot claim aspects or features of an invention previously disclosed in an earlier filed application (novelty issues would arise).

At best, the only way to pursue additional claims is through divisionals (article 36 of Decision 486), which legally have the same filing date as the parent application. Such divisionals should be directed to material split out from the parent application and must be filed before a final decision is issued. The only requirement for filing a divisional is that the claimed subject matter be different from the one recited in the parent case. Finally, voluntarily splitting out

divisionals from divisionals is not allowed; however, such divisionals can be filed if there is a unity of invention objection raised in an office action for the first-generation divisional.

Amendments to the specification or claims in the parent case are possible at any time during prosecution before the issuance of a final resolution, as long as said amendments do not extend the original scope of the invention and find support in the specification (article 34 of Decision 486). Post-grant amendments to the specification that alter the claimed scope are not possible (only corrections of evident typos are acceptable). However, the applicant may limit the scope of one or more granted claims or divide them (articles 70 and 72 of Decision 486).

Law stated - 28 febrero 2024

Patent office appeals

Is it possible to appeal an adverse decision by the patent office in a court of law?

Yes. Before seeking judicial review, the applicant may file a reconsideration action to revoke, clarify or modify the rejection of one or more claims (the reconsideration action is optional and is not required to exhaust administrative remedies). This action must be filed before the CPO against the adverse decision within 10 business days. If no reconsideration action is filed, the CPO's rejection will be considered final.

If the CPO confirms its decision (or no reconsideration action is filed), the applicant may additionally seek judicial review by filing an annulment action within four months of the notification of the final resolution from the CPO.

Law stated - 28 febrero 2024

Oppositions or protests to patents

Does the patent office provide any mechanism for opposing the grant of a patent?

Yes. Decision 486 provides a pre-grant opposition system. Interested third parties may file an opposition within 60 days following the publication of the application, which can be extended for an additional 60-day term upon request. The CPO will consider the relevance of the opposition in the framework of the examination (ie, there is no separate opposition procedure to delay prosecution of the application).

Opponents may file reconsideration actions against a resolution granting a patent. Filing a reconsideration action automatically suspends the effect of the granted patent until it is resolved.

In theory, the patent owner should be notified of an opponent's reconsideration action and will be allowed to file arguments in response. Nevertheless, in practice, the CPO states that there is no legal obligation to inform the patent owner and provide a term to submit arguments unless the opponent includes new evidence (eg, new prior art documents) within the reconsideration action. If so, the CPO typically provides a five-day term to submit arguments in response to new evidence cited by the opponent.

In addition, third parties may also file observations providing arguments and evidence to the CPO at any time (eg, even after the time to file an opposition has expired); however, unlike an opposition, the CPO is not compelled to take this information into consideration.

Law stated - 28 febrero 2024

Priority of invention

Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

Article 22 of Decision 486 establishes that whoever has an earlier priority date wins in a priority dispute.

The affected party may seek the annulment of the patent (article 77 of Decision 486) or the transfer of the pending application or the patent (article 237 of Decision 486).

Law stated - 28 febrero 2024

Modification and re-examination of patents

Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

Post-grant limitations to the claims may be made before the CPO (article 70 of Decision 486). Additionally, division of granted claims is possible (article 72, *ibid*). No re-examination procedure is available.

A patent grant can be challenged at any time via judicial review through an annulment action. It is not possible for a court to modify patent claims during an infringement lawsuit.

Additionally, the direct revocation of a patent by the CPO is theoretically possible whenever it is contrary to the law, contrary to the public interest or causes unjustified harm; however, for the CPO to revoke a granted right, the patent owner must also authorise such revocation. This makes the direct revocation impractical when seeking invalidation, making the annulment action the proper route.

Law stated - 28 febrero 2024

Patent duration

How is the duration of patent protection determined?

A patent is granted for a 20-year period from the date on which the application was filed (article 50 of Decision 486 for conventional applications) or from the international filing date (article 11.3 of the Patent Cooperation Treaty (PCT) for PCT national phase applications).

Term restoration is available for patent holders for unreasonable delays (excluding pharmaceutical products) wherein prosecution has lasted more than five years from the

filing date or three years counted from the date of the examination request, according to the established compensation standards listed in Decree No. 1873 of 2014. In 2023, for the first time, the CPO rejected a request for term restoration made by a patent owner that obtained the granting of its patent after it had been rejected by the CPO and after several years of litigation before the Council of State. The CPO explained that term restoration only applies to delays made by the CPO during the administrative process (ie, before a decision is made) and does not compensate for judicial delays, even if they are unreasonable (as in that case). The CPO also highlighted that any term restoration requests should follow the process and requirements defined in Decree No. 1873 of 2014.

Law stated - 28 febrero 2024

UPDATE AND TRENDS

Key developments of the past year

What are the most significant developing or emerging trends in the country's patent law?

SEP Litigation

Colombia was, once again, a venue for SEP litigation with the present dispute between Ericsson and Lenovo. In this case, Ericsson was granted preliminary injunctions in the country prohibiting Lenovo (through its subsidiary in Colombia), Motorola Colombia (a branch of Lenovo) and two other local distributors, to advertise and commercialise its 5G-compliant products.

To date, the campaign has demonstrated that in Colombia: early preliminary injunctions are available and have been granted in a fast and agile manner, respecting principles such as procedural economy and celerity. In addition, it has innovated insofar as judges have recognised infringement based on the essentiality of a patent; and has ensured anew that there is also early and broad discovery available in Colombia. This serves as a basis for further strengthening Colombia's position as an important forum for litigation of SEPs and telecommunications matters.

First declaration of public interest for compulsory licensing purposes in Colombia

Since June 2023, the Colombian Ministry of Health and Social Protection (MinSalud) promoted a declaration of public interest (DPI) procedure that consists of subjecting to compulsory licensing patents of drugs of which the active ingredient is dolutegravir, which is used for the treatment and prevention of HIV/Aids. The DPI was issued in October 2023 for the following reasons:

- an increase in the number of reported cases;
- pharmaceutical benefits;
- the need for treatment for targeted populations;
- allegedly high prices;and

- alignment with international standards.

After the DPI, now the process is in the second stage before the Colombian Patent Office (CPO), where third interested parties may apply for compulsory licences. It is still yet to be determined the conditions of the compulsory licence such as the price and term.

Colombian justice applies for the first time the doctrine of equivalence

This doctrine seeks to establish features that can be considered equal to those defined within the literal language of the claims. The doctrine was applied in the dispute between Telemetrik and Excelec, which concerned Telemetrik's utility model patent.

Telemetrik decided to file a lawsuit against Excelec, considering that its industrial property rights were being infringed since 'the characteristics of the product marketed by Excelec, matched to the degree of identity with those of its utility model patent'. Given that in the first instance judgment concluded that from a restrictive interpretation criterion of literal infringement, there was no infringement since the defendant product did not incorporate each one of the elements claimed in Telemetrik's utility model patent. The second instance proceeding was initiated in the Superior Court of Bogotá (TSB), where a prejudicial interpretation from the Andean Court of Justice was issued (475-IP-2019).

This IP established the first precedent with respect to the applicability of the doctrine of equivalents in the Andean Community framework by stating that the judge may, if he or she so considers, carry out an equivalence assessment with respect to the elements of the product or process alleged to be infringed, and suggested that this decision should be taken after applying the triple substantial identity test.

The Tribunal finally decided that there was no infringement in this case. However, the prejudicial interpretation from the ACJ is considered a precedent having the way for the application of the doctrine of equivalents in the context of patent infringement litigation, whilst showing the technical difficulties and challenges that national judges must face in analysing infringement by equivalents.

Law stated - 28 febrero 2024