

Guest Post

## The Difference Between Well-Known and Famous Trademarks in the Jurisprudence of the Andean Community Court of Justice

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**Hugo R. Gómez Apac**  
Court of Justice of the  
Andean Community  
Quito, Ecuador

The jurisprudence of the Andean Community Court of Justice (ACCJ) distinguishes between the well-known trademark—which is regulated in the Andean industrial property law (in force in Bolivia, Colombia, Ecuador, and Peru)—and the famous (or renowned) trademark—which is not considered in said law. The distinction lies in the fact that the latter is more widely recognized than the former, and this greater recognition leads to stronger legal protection.

This distinction was made from the outset, when the ACCJ issued its first preliminary ruling on interpretation in December 1987, and it was upheld in Preliminary Ruling 50-IP-2017 (July 2017). The ACCJ noted that a well-known trademark is recognized by the relevant sector of consumers, producers, distributors, or sellers, whereas a famous trademark is known beyond that sector: by almost the entire general public.

Examples of famous trademarks include brands that are known by billions of people around the world and must be recognized by trademark offices within the Andean Community, such as COCA-COLA, DISNEY, FACEBOOK, GOOGLE, TOYOTA, and WHATSAPP.

“ A well-known trademark is recognized by the relevant sector of consumers, producers, distributors, or sellers, whereas a famous trademark is known beyond that sector, by almost the entire general public. ”

Both well-known and famous marks break the principles of territoriality, registration, and real and effective use. Therefore, if a trademark is well-known in one member jurisdiction of the Andean Community (e.g., Colombia), it is protected in the other three member jurisdictions (Bolivia, Ecuador, and Peru), even if, in those jurisdictions, the trademark: (i) is not registered; (ii) is registered but not used; or (iii) is neither registered nor used. This reasoning applies, even more so, to the famous trademark.

Third, both trademarks break the principle of specialty but in different ways. A well-known trademark breaks it *relatively*, meaning the mark is protected from:

1. Identical or similar products or services and those with a competitive connection;
2. Different products or services recognized within the relevant sector; and
3. Any type of product or service whose use would be likely to cause a risk of confusion or association with the owner of the well-known trademark or with the owner’s products or services, an unfair use of the prestige of the well-known sign, or the dilution of its distinctive force or its commercial or advertising value.

The famous trademark breaks said principle in an *absolute* sense, meaning it is protected with respect to **all** products or services. Thus, it is impossible to register FACEBOOK, GOOGLE, or WHATSAPP for sausages or sewing thread, even though these products are unrelated to a social network or an Internet search engine.

The two types of trademarks also differ in terms of proof. The well-known status of a trademark must be proven through evidence of sales, revenue, or advertising expenses; the duration, breadth, and geographic reach of its use; or surveys regarding its recognition among members of the relevant sector—among other evidence.

“ If the national authority considers that a trademark is not famous, it must allow its owner to prove its well-known status in any member jurisdiction of the Andean Community. ”

The famous status of a trademark does not need to be proven because it is what general procedural theory calls a “notorious fact,” which does not require evidentiary support (*notoria non egent probatione*). Notorious facts are not subject to proof and may be recognized *ex officio* by administrative and judicial authorities.

For example, just as it is unnecessary to prove in an administrative or judicial proceeding in Peru that its capital is Lima (a notorious fact), there is no need to prove the fame of trademarks like GOOGLE or WHATSAPP, which are known and used by practically all administrative and judicial authorities in Peru.

If the national authority considers that a trademark is not famous, it must allow its owner to prove its well-known status in any member jurisdiction of the Andean Community. For instance, while it is clear that the trademark TOYOTA is famous for automobiles, the authority might not be convinced of the same regarding the BUGATTI trademark, which identifies ultra-luxury sports cars. If this is the case, the authority must allow the BUGATTI trademark owner to prove its well-known status in at least one member jurisdiction.

“ Due to their nature, famous trademarks cannot have their registration canceled for non-use. ”

It is not possible to cancel the registration of a trademark on the grounds of non-use of the distinctive sign in a member jurisdiction of the Andean Community if that sign is well-known in another member jurisdiction.

Due to their nature, famous trademarks cannot have their registration canceled for non-use. If a trademark is famous, it means it is known by nearly the entire public in the four member jurisdictions of the Andean Community. Consequently, if cancellation of registration is requested due to alleged lack of use in a member jurisdiction, it will simply be necessary to verify that the trademark is widely known in that jurisdiction and in the other three jurisdictions, in order to reject said request.

*This is a guest article by Hugo R. Gómez Apac, a judge at the Court of Justice of the Andean Community (since March 2016) and a professor at the Master’s Program in Intellectual Property and Competition Law at the Pontifical Catholic University of Peru, at the Master’s Program in Economic Administration Law at the University of the Pacific (Peru), and at the Postgraduate School of the Peruvian Law of Applied Sciences. He is a visiting professor at the Master’s Program in Intellectual Property and New Technologies at the Austral University (Argentina). He is a member of the Advisory Board of Judges of the World Intellectual Property Organization (WIPO) for the 2023–2025 term. Judge Gómez served as a judge in INTA’s [2024 Latin America Moot Court Competition](#).*

*Although every effort has been made to verify the accuracy of this article, readers are urged to check independently on matters of specific concern or interest.*

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