

Brief comments on the new Normative Instruction regarding Geographical Indications

By Liz Starling and Carolina Caetano

This February 26, 2019 entered into force Normative Instruction No. 95/2018 [NI 95/2018] published on December 28, 2018, which rules registration of Geographical Indications. In addition, on February 21, 2019 the BPTO made available the electronic filings for Geographical Indications “e-IG”, as approved by Resolution / INPI / PR No. 233 of January 18, 2019.

The Brazilian Industrial Property Law defines that Geographical Indications can be an Indication of Source or an Appellation of Origin, being:

- Indication of Source: the name of the place that has become known as the center of extraction, production or manufacture of a certain product or the provision of a service. For example: Franca for footwear; and
- Appellation of Origin: the name of the place that designates product or service whose qualities or characteristics are due to the geographical environment it is inserted, including natural and human factors. For example: Champagne for sparkling wines.

NI 95/2018 is quite more detailed and brings important changes to the rules of NI 25/2013, formerly in force.

NI 95/2018 brings definitions of terms and graphical or figurative representations that can be used to describe an Indication of Source and an Appellation of Origin, which was not done by the previous text.

NI 95/2018 details the terms not susceptible to registration, adding to the previous list of non-registrable Geographical Indications the names of varieties of vegetables, animal race names of current use, and homonyms of registered Geographical Indications, except when sufficiently different from the previous one.

As for Applicants and Users of Geographical Indications, NI 95/2018 refers to the “Substitute” who can be an Association, Union or any other entity that may act as such, provided that it is established in the respective territory and is the representative of the legitimate collective group to apply for registration. Collective membership must be composed of participants in the production chain of the respective product or service.

NI 95/2018 itemizes the documents necessary for each Geographical Indication:

- For applications of Appellation of Origin:
 - Document with the description of qualities or characteristics of the products or services, resulting from the geographical environment, as well as of process for obtainment or provision.
 - Document proving the influence of the geographical environment in the qualities and characteristics of the products or services, containing the descriptive elements of the place, including natural and human factors, qualities or characteristics of the products or services and the causal link between them.
- For applications of Indication of Source:
 - Description of the process of extraction, production or manufacture of products or provision of services.
- For both Appellation of Origin and Indication of Source:
 - Description of control over producers or service providers that have the right to use the Geographical Indications, conditions and prohibitions of use, as well as applicable penalties for infringement.

The chapter that deals with Examination of the Applications is divided into two stages: the Preliminary Examination and the Examination on the merits. The difference from the previous norm is the provision of the BPTO to recommend, through an office action, the alteration of the Geographical Indication in order to better fit the contents of the application, and also the provision of abeyance in case of any impediment. The two measures are foreseen in both examination stages.

Among the changes brought by the NI 095/2018 is the possibility to amend contents of the registration after its issuance, such as the geographical name and its graphic representation, delimitation of the area, technical specifications and the kind of Geographical Indication. Amendments can be applied for after 24 months from the date of registration, being forbidden alteration of characteristic elements that have justified the issuance of the Geographical Indication. In these cases, the BPTO may reject the alteration request.

Amendments must be requested by the Substitute that filed the application or by its successor. A request for amendment must be submitted along with several documents, including justified reasons. A second amendment for the same content of the Geographical Indication registration can only be requested after 24 months from acceptance or rejection of the previous one.

In the event of alteration of the Geographical Indication, it will not be possible to exclude or prejudice producers or service providers already established in the geographical area, nor will be allowed the coexistence of a prior registration with a later one arising from the first. For requesting alteration of the kind of Geographical Indication it will also be necessary to submit the specific documents required for that kind of Geographical Indication.

Given that the possibility of altering Geographical Indications and amending contents of Geographical Indications registrations was not possible previously, the transitional provisions provide that, for Geographical Indications issued before **February 26, 2019**, date of entrance into force of NI 095/2018, the inclusion of a product or service name, as well as the change of graphic or figurative representation, may be required at any time. However, for Geographical Indication applications filed before **February 26, 2019**, such changes shall be requested before the date of issuance of registration. Thereafter, it will only be possible to request changes after 24 months from the issuance date of the Geographical Indication.

Finally, NI 095/2018 brings more bureaucracy to the registration process of Foreign Geographical Indications that are already recognized outside Brazil. From now on they will need to submit the same documents and information required for National Applicants, except in cases of reciprocity of rights for which proof of legitimacy and documents specifically required for a kind of Geographical Indications will be waived.

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