

Madrid Protocol takes effect in Brazil

By Flávia Tremura

The Brazilian Patent and Trademark Office (BPTO) is finishing the last adjustments for starting Madrid Protocol procedures in Brazil. In the last weeks, 4 new Resolutions were published to standardize the Brazilian trademark registration procedure to the one established by the World Industrial Property Organization (WIPO).

Among the main changes, the following improvements stand out:

a) Co-ownership of trademarks (Resolution 245/2019): new trademark applications may be filed indicating more than one holder. Just as it already exists for the current system, it is necessary that all holders practice effectively and lawfully the activities related to the claimed products/services. The acts before the BPTO to obtain the registration and its defense shall be performed jointly by all the holders. Attacks on third party applications or registrations based on past rights of joint holders may be practiced by at least one of them. It will be possible to include other holder(s) in existing applications and records.

b) Multi-class Regime (Resolution 248/2019): a single registration application may cover more than one class of products or services. Although given a unique number, the analysis will be done class by class, and the final decision may be different for each class. Despite the convenience of grouping, fees shall be paid according to the number of classes stated. The multiclass system can only be adopted for new registration applications, not for existing ones.

Although these two resolutions take effect on October 2, 2019, electronic requests for these new procedures will only be available at INPI as of March 9, 2020, when it will be possible to be effectively used.

c) Division of requests and registrations in multi-class regime (Resolution 244/2019): provides for the possibility of requiring the division of a request or registration in two by segregating the classes originally grouped in multi-class system. The division may be required only in two cases: in the event of a withdrawal of the request in relation to one or some of the classes or for transfer purposes. It will also be possible to require the division of goods and services in a single class trademark, provided that all the requirements for transfer record, in accordance with the Industrial Property Law, are met. This resolution takes effect on March 9, 2020.

d) Madrid Protocol (Resolution 247/2019): it stipulates the procedure for obtaining registration of marks under the Madrid Protocol. Holders resident or headquartered in Brazil may use the Madrid Protocol to obtain trademark registrations in other countries. Likewise, holders from other countries will also be able to appoint Brazil as one of the designated countries in their International Registrations before WIPO. It will not be possible to extend to Brazil an International Registration existing before October 2, 2019, only the new ones. The designation request will be redirected to the BPTO and it will be processed similarly to any local application. The substantive analysis will be performed in all cases, independently of any Opposition presented by third parties. Brazil will charge an additional fee for granting the registration, to be paid directly in WIPO. The BPTO will not communicate WIPO on the existence of Oppositions. Therefore, it is highly recommended to have a local office monitoring the designation request in Brazil. For the practice of any act before the BPTO, it will be mandatory to have a proxy resident in Brazil with legal powers. This resolution takes effect on October 2, 2019.

INPI has also published the new version of the Trademark Guidelines, modifying and including procedures in accordance with the new Resolutions.

These new Resolutions introduce important and strategic major changes to the trademark registration procedure in Brazil. Ongoing processes or existing records will not undergo any automatic changes, but it may be possible to require joint ownership or division of existing requests or records.

We can assess the appropriateness or suitability of changes in your cases upon request. For further information or clarification, please contact our partner and Coordinator of the Madrid Protocol team, Flávia Tremura Polli Rodrigues (flavia.rodrigues@kasznarleonardos.com).