

Protection of IP

Brazil

I. TRADEMARKS**I.1 INTRODUCTION**

The juridical system of intellectual property in Brazil is rather complex. The rights stemming from intellectual property are protected within the scope of the Civil and Commercial Rights.

Creations for industrial and commercial use such as inventions, utility models, industrial designs and trademarks are protected by the so-called “Industrial Property Law” no. 9.279 of 1996.

“Inventors’ rights”, which cover industrial creations, are included in the Commercial Law. The rights regarding inventions must be registered to be acknowledged and protected by the State. The registration procedure for patents, utility designs and trademarks are processed by the National Industrial Property Institute (“INPI”).

The INPI is a federal body, linked to the Ministry of Industry and Trade, whose purpose it is to execute the norms relating to industrial property, to regulate technology transfer and to observe and give opinions on the international treaties in this respect.

I.2 REGISTERED TRADEMARKS

As defined in the Industrial Property Law, distinctive signs are capable of being registered as trademarks.

A trade mark may be registered if it is distinctive and novel.

The Industrial Property Law differentiates between three types of trademarks, namely: (i) trade marks for products and services – used to differentiate products or services of other identical, similar or related products or services; (ii) certification marks – employed to certify the compliance of a product or service with certain technical norms or specifications, notably concerning quality, nature, material used and methodology employed; and (iii) collective marks – used to identify products or services of members of a certain entity.

The Industrial Property Law determines various signs that may not be registered as a trade mark, such as:

- immoral figures;
- a reproduction or imitation of commercial establishments of third parties where this may cause confusion; and
- a total or partial reproduction or imitation of a trade mark registered by another in relation to a product or service where this may cause confusion or association with that trademark.

The registration of an industrial design is granted by INPI after a previous analysis. It is important to emphasize that the application will not be subjected to a technical and/or priority analysis.

In case any third party is prejudiced by the registration, it shall request the nullification of the registration before the INPI, through an administrative procedure. The INPI decisions may be appealed to the courts.

The Law also provides protection for famous trademarks where the mark is known by a large number of people in all Federal States of the Federative Republic of Brazil. The mark is protected in all areas and not only in the areas where its owner operates.

Registered trademarks may be protected in certain classes of products or services which relate to the activities that the applicant carries out. The rights granted to the owner of the trade mark, or to the applicant of a trade mark registration, include the right to assign the registration or application of the registration, license its usage or warrant the material integrity or reputation of the mark.

In Brazil, a registered trade mark is valid for 10 years and may be renewed for equal and successive periods of time.

A registered trade mark may be revoked for non-use for a period of 5 years and may also be revoked where the owner of the trade mark is a foreigner not residing in Brazil, and does not have a person domiciled in Brazil who represents him before the administrative authorities and at court.

2. PATENTS

2.1 INTRODUCTION

In Brazil, patents are also protected by the Industrial Property Law.

Inventions that meet the requirements of novelty, inventive activity and industrial application may be patentable.

The Industrial Property Law provides that the invention and the utility model are considered new when they do not form part of the state of the art. Therefore, the invention must be totally unknown to the public before the date the application is filed and the inventor must keep the patent confidential until the application for registration.

Certain inventions are not patentable, for example:

- discoveries, scientific theories and mathematical methods;
purely abstract concepts;
- computer programs per se;
- rules of games;
- operation or surgical techniques and methods, as well as therapeutic or diagnostic methods applicable in the human or animal body; and
- the whole or parts of natural beings and biological material found in nature.

The patent grants its owner the right to prevent third parties from producing, using, offering for sale, selling or importing products that are the object of the patent without his consent.

An invention patent is granted for a period of 20 years from the date of filing. A utility model patent is issued for a period of 15 years.

2.2 DISTANCE SELLING AND E-COMMERCE

In Brazil, there is no specific regulation regarding sales carried out via the internet or distance sales made by telephone, mail or another means of communication.

The provisions of the Consumer Act (Law 8.078 of 1990) shall therefore be applied to sales made via the internet or at a distance. For example, the seller must:

- provide adequate and clear information on the different products and services, with the correct specification regarding quantity, characteristics, composition, quality and price, as well as a warning of the risks that they feature;
- provide protection against misleading and abusive advertising, or unfair commercial methods, as well as against abusive or imposed practices and clauses; and
- modify any clauses of the agreement that are disproportionate.

Foreign businesses which supply products or services in Brazil must therefore observe the Brazilian consumer protection rules, which may not be avoided.

2.3 CONFIDENTIAL INFORMATION

Under the Industrial Property Law, there is an offence of unfair competition, which is committed by using confidential information of third parties in industry, commerce or the provision of services.

The law states that a person, who discloses, explores or uses such confidential information or data without consent, which he acquires due to an employment relationship, or which he obtains through unlawful means, commits the offence of unfair competition.

The penalty for a breach of this provision is imprisonment for 3 months to 1 year, or the imposition of a fine.

2.4 COPYRIGHT

Intellectual works stemming from creations of the mind, such literary, artistic or scientific works, conferences, speeches, theatre works, musical composition and other such works are protected by Law no. 9.610 of 1998, the so-called "Copyright Law". Copyright is protected for a period of 70 years without the need for registration.

The so-called Copyright Law is also applicable to computer programs; however, these are specifically governed by Law 9.609 of 1998, known as "Computer Program Law" or "Software Law" as set out below.

Software

The copyright and ownership of the computer programs is protected by the Copyright Law and by the so-called Computer Program Law.

Software is protected by copyright without registration.

Copyright is protected for a period of 70 years from the beginning of the year following the date of its publication or, if there is no such date, of its creation.

The computer program may be registered with the INPI and shall contain the following information:

- information regarding the author of the computer program and its owner;
- the functional description of the computer program; and
- the parts of the program that are considered sufficient to characterize its independent creation.

The information relating to the program is secret and shall not be published by the INPI.

The Computer Program Law also regulates license agreements on technology transfer, use and commercialization.

2.5 DESIGN RIGHTS

Industrial designs are also protected under Industrial Property Law. Industrial designs must have a characteristic of novelty, i.e. they must not part of the state of the art. The visual configuration of the design must be distinctive in relation to other previously existing designs.

Examples of designs which may be registered are the ornamental plastic form of an ornamental object or the composition of lines and colors that may be applied to a product, thereby providing a new and original look on its external configuration and that may serve as a type of industrial manufacturing.

3. PROTECTION OF IP RIGHTS

3.1 REGISTRARS

Patents

The patent application may contain a descriptive report, claims (in respect of colours, quantities etc, as the case may be), and designs, if appropriate.

The application will undergo a preliminary formal examination and, if it meets the application requirements, it will be recorded and sent for formal examination.

Trademarks

In order to register a trade mark with the INPI, it is necessary to submit with the application a power of attorney and proof of corporate activity, which is compatible with the products or services for which it is to be registered. In order to fulfil these requirements, Brazilian companies need to submit an authenticated copy of the articles of association of the company, whereas foreign companies must submit a certificate with a brief report containing a description

of the corporate activity, issued by the registering body in the place where the headquarters of the company are located. Such document shall be notarized and certified by the Brazilian consulate and be translated into Portuguese by a sworn public translator. In the case of mixed trademarks (composed by name and logo) or trademarks in only figurative classes, it is necessary to submit labels together with the logos, in the formats indicated by the INPI.

The INPI will publish the application in the Industrial Property Journal for a period of 60 days, during which time, third parties submit objections against the application, which will be analyzed and judged by the INPI.

Registered Designs

A design application must be submitted to the INPI and shall contain a descriptive report, as the case may be, claims, if appropriate, designs or photos, and the field of application of the design.

Author

Alberto Murray

Paulo Roberto Murray - Advogados
São Paul, Brazil

E-mail amurray@prmurray.com.br

Tel. +55 11 2198 7400

To contact PLG

Julienne Laveaux
PLG Secretariat
PANNONE LAW GROUP E.E.I.G.
avenue de Sumatra 41
1180 Brussels
Belgium

Tel. +32 2 374 88 46

Fax: +32 2 374 90 61

E-mail plg@plg.be

www.plg.eu.com

Disclaimer

The contents of this article are intended to provide guidance only and should not be taken to constitute legal advice on specific problems. PLG cannot accept responsibility for this information or matters affected by subsequent changes in the law.

Readers are requested to direct their enquiries to the author(s) of the article.

© 2012 Pannone Law Group