

BRAZIL

Industrial Design Ordinance

MINISTRY OF DEVELOPMENT, INDUSTRY, COMMERCE AND SERVICES

NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

ORDINANCE/INPI/PR No.25, OF JULY 3, 2023

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Art. 1

This Ordinance regulates the procedure of international registrations of industrial design under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

The application for international registration of industrial design under the The Geneva Act of the Hague Agreement shall be deposited with the International Bureau of the World Intellectual Property Organization or the offices of Contracting Parties able to receive such requests.

CHAPTER I DEFINITIONS

Art. 2

For the purposes and effects of this Ordinance, the following are concepts and Definitions:

- I - INPI: National Institute of Industrial Property;
- II - Agreement: the Hague Agreement Concerning the International Registration of Industrial Designs of November 6, 1925;
- III - Geneva Act: The Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, adopted in Geneva on 2 July 1999;
- IV - Common Regulation: Common Regulations Under the Hague Act and the Geneva Act of the Hague Agreement;
- V - Contracting Party: Any State or intergovernmental organization party to the Geneva Act;
- VI - International Bureau: International Bureau of the World Intellectual Property Organization;
- VII - International Register: the official collection of data concerning international registrations maintained by the International Bureau;
- VIII - International registration: registration of an industrial design carried out within the scope of the Geneva Act, containing data on the industrial design and its status before the Contracting Parties;
- IX - International application: application for international registration filed within the scope of the Agreement;
- X - Designation: request for an international registration to take effect in Brazil;
- XI - Configuration: each shape or set of lines and colors that is the object of an international registration;
- XII - Holder: natural or legal person in whose name an international registration is recorded in the International Register;
- XIII - Designated Contracting Party: Contracting Party for which protection was requested of industrial design when filing the international application.

CHAPTER II OF INTERNATIONAL REGISTRATION DESIGNATING BRAZIL

Section I Language

Art. 3

Communications between the International Bureau and INPI, relating to designating Brazil, will be written in English.

Art. 4

The application designating Brazil, as well as any document accompanying them, if filing directly to INPI, must be written in Portuguese.

Documents written in a foreign language must be accompanied by a translation.

Section II Filing directly to INPI

Art. 5

When filing directly to the INPI, the holder of an international registration domiciled abroad must appoint and maintain a duly qualified proxy domiciled in Brazil, empowered to represent it in administrative and judicial terms, including to receive summonses.

(1) The power of attorney must be presented within 60 (sixty) days from the date of the first filing action, regardless of notification or requirement, under penalty of the filing.

(2) The application designating Brazil for the registration of industrial design under the Hague Agreement will be carried out exclusively electronically.

Section III Examination, grant and effects

Art. 6

The international registration designating Brazil will produce the same effects as an application for registration of an industrial design filed in Brazil, from the date of the registration.

Art. 7

Industrial designs designating Brazil will be examined in compliance with the provisions of Industrial Property Law (Law No.9279 of May 14, 1996), and with the conditions established by the INPI.

Art. 8

Any industrial designs designating Brazil will enjoy the same protection granted to an industrial design registered directly with the INPI, under the terms of Industrial Property Law (Law No.9279, of May 14, 1996), provided that INPI-

I - has informed the International Bureau of the declaration granting protection to the industrial design;

II - has not informed the International Bureau, within 6 (six) months of the notification of Brazil's designation, of a refusal of the effects of the international registration of the industrial design; or

III - has refused the effects of the international registration of the industrial design.

Art. 9

For the recognition of the priority right provided for in Art. 99 of Law No.9279 of May 14, 1996, the holder of the international registration must present to the INPI, within 90 (ninety) days from the date of publication of the registration by the International Bureau, a copy of the appropriate original documents, which must include the date, the number and figures of the corresponding order, accompanied by its translation.

(1) In the event that the international registration in which Brazil is a designated Contracting Party is actually contained in the appropriate document of origin, a declaration by the holder in this regard will suffice to replace the simple translation.

(2) INPI will carry out the examination of the appropriate original documents available in the digital library of the World Intellectual Property Organization's Digital Access Service to Priority Documents (DAS) using an access code informed in the international registration, which exempts the holder of the international registration from the presentation referred to in the caput.

(3) Information about the access code to the original document in the digital library of the World Intellectual Property Organization's Digital Access Service to Priority Documents (DAS) entails a tacit declaration by the owner under (2), dispensing with the presentation of a translation.

(4) If the appropriate original documents is not presented within the prescribed period, it will be disregarding the priority date and considering the date of deposit of the international registration.

(5) INPI will accept the presentation, by the owner, of documents

that prove the publication and the date of publication of the industrial design with the aim of proving the non-harmful disclosure of the industrial design that is the subject of international registration.

(6) Documents proving non-harmful disclosure that exceed 180 (one hundred and eighty) days prior to the date of filing of the international application or claimed priority will not be accepted, if promoted in the situations provided for in items I to III of Art. 12 of Law No.9279 of May 14, 1996.

Art. 10.

INPI will send to the International Bureau, within 6 (six) months from the date of designating Brazil:

I - notification of refusal of protection; or

II - declaration granting protection, referring to the granting of the designation.

(1) Refusal notifications will be sent to notify:

I - the formulation of requirements during the examination;

II - suspension of the examination due to legal action; or

III - the decision to refuse the application.

(2) Refusal notifications sent to notify the formulation of requirements during the examination, in referred to I of (1), they will inform:

I - the legal provisions that support the formulated requirement;

II - guidance regarding compliance with the requirement within the legal deadline.

(3) Refusal notifications sent to notify the decision to refuse the application, referred to III of (1), they will inform:

I - the legal provisions that justify the refusal;

II - guidance regarding the presentation of an administrative appeal within the legal deadline.

(4) If the refusal notification is not sent by INPI within the period provided for in the caput, the protection for designating Brazil will be granted.

(5) The declaration granting the protection of the designation and the notification referred to I, II and III of (1) will be published in INPI's official means of communication.

Art. 11.

INPI may refuse the effects of an international registration on the grounds that:

I - the reproductions contained in the international registration do not clearly and sufficiently represent the industrial design and its variations, if any, so as to allow its reproduction by a person skilled in the Art, contrary to the provisions of Art. 104 of Law No. 9279, of May 14, 1996;

II - the international registration includes more than one object, contrary to the provisions of the Art. 104 of Law No.9279 of May 14, 1996; or

III - the International Registration of Industrial Designs does not correspond to the other provisions provided for in Law No.9279 of May 14, 1996.

The INPI will not refuse the effects of an international registration on the grounds that the requirements relating to the form or content of the international application provided for in the Geneva Act or the Common Regulations or are additional to, or different from, those requirements have not been satisfied under Law No. 9279 of May 14, 1996 and the conditions established by the INPI

Art. 12.

Refusal of an international registration that includes more than one object, under Art. 104 of Law No.9279 of May 14, 1996, owner is requested to indicate an industrial design to be sent in the application.

(1) The applicant is entitled to file dividing application for industrial designs excluded from the application.

(2) The indication of the industrial design to be maintained in the application and the dividing application referred to in (1) will be filed directly with the INPI within 60 (sixty) days after the publication of the technical requirement for dividing application in the INPI's official means of communication.

Art. 13.

If it is appropriate, at any time, to grant protection to an industrial design that is the subject of an international registration in respect of which the INPI has refused its effects in accordance with Art. 11, the INPI shall notify the International Bureau:

I - the withdrawal of such refusal, in whole or part, with an indication of the configurations to which it refers; or

II - a declaration granting protection, in whole or in part, after notification of a refusal, indicating, where appropriate, the

configurations to which it refers.

(1) When the application is amended in the procedure before the INPI, the notice referred to in I must also contain or indicate all amendments.

(2) Refusal notifications sent to communicate the matters referred to in items I and III of (1) of Art. 10 will inform the deadline of 60 (sixty) days for submitting a statement directly to INPI.

(3) Where appropriate, the INPI will withdraw any notice of refusal considered irregular, sending a new communication to the International Bureau.

Art. 14.

After notification of refusal and completion of the procedures before the INPI, it will be declaration of granting of protection sent to the International Bureau following a notification of refusal to communicate:

I - the granting of protection after sending a Refusal notifications based on the hypotheses provided for in the items I and II of (1) of Art. 10;

II - the granting of protection after an appeal decision; or

III - the reform of the rejection of the application at appeal level.

Art. 15.

After a declaration granting protection or a declaration of granting protection subsequent to a notification of refusal, the INPI, when making or becoming aware of any decisions that affect the protection of an industrial design subject to designating Brazil, will communicate the fact directly to the owner through an official INPI publication .

(1) In the hypothesis provided for in the caput, a communication will be sent to the International Bureau indicating the status of the industrial design.

(2) The decisions referred to in the caput include :

I - the exclusion of the application due to the lack of renewal, under the terms of I of Art. 119 of Law No.9279 of May 14, 1996;

II - the proposal of an administrative process to nullify the effects of the international registration, in accordance with Arts. 112 to 117 of Law No.9279 of May 14, 1996;

III - the judicial declaration of nullity of the effects of the international registration, under the terms of Art. 112 of Law

No.9279 of May 14, 1996;

Section IV Term and renewal

Art. 16.

The international registration designating Brazil will be renewed every five years upon payment at the International Bureau with a maximum duration of protection in Brazil of 25 (twenty-five) years, counting from the date of filing of the international registration, in accordance with Arts. 108 and 120 of Law No.9279 of May 14, 1996.

(1) The application that is not renewed in relation to Brazil with the International Bureau will be terminated at the end of its term, as well as the application which is pending examination.

(2) Industrial design records resulting from the divisional application, referred to in (1) of Art. 12, will be renewed upon payment directly to INPI, in accordance with Arts. 108 and 120 of Law No.9279 of May 14, 1996.

Section V Notes

Subsection I Request

Art. 17.

Requests for annotations referring to an international registration that designate Brazil must be sent by the holder directly to the International Bureau.

Subsection II Effects of annotations

Art. 18.

The following annotations, when made in the international register about an international registration and applicable to Brazil as the designated contracting party, will produce the same effects as an annotation made directly with the INPI:

I - change of name and address of the owner;

II - change of ownership;

III - renunciation of the application;

IV - cancellation of international registration;

(1) The annotation provided for in II will produce effects in Brazil only if accompanied by the supporting documentation.

(2) Within 6 (six) months from the notification, pursuant to Art

16(2) of the Geneva Act, the INPI may notify the International Bureau that the annotation provided for in II will not produce effects in Brazil, indicating the reasons for the refusal and the conditions for filing an appeal against said decision.

(3) The INPI will communicate to the International Bureau the final decision on the refusal of annotation.

(4) The cancellation of the international registration, provided for in IV, will result in the withdrawal of the application designating Brazil or renunciation of registration in Brazil.

Section VI Appeals and Manifest

Art. 19.

By holding the international registration designating Brazil, the same means and deadlines for appeal and manifestation provided for in Law No.9279 of May 14, 1996.

Art. 20.

There will be no appeal:

I - the declaration granting protection;

II - the Refusal notifications referred to in I and II of (1) of Art. 10.

Section VII Rectification

Art. 21.

When the International Bureau notified a rectification relating to an international registration, the INPI may re-examine the application.

INPI may send to the International Bureau within 6 (six) months counting from the receipt of the notification of rectification, a refusal of the protection resulting from the re-examination, which may result in the validation or annulment of the Acts, respecting the acquired rights of third parties.

Art. 22.

The application will be considered non-existent when the INPI is notified by the International Bureau of a rectification stating that:

I - the international registration does not designate Brazil;

II - there was no payment of the individual remuneration related to

the designating Brazil; or

III - the designation of Brazil should not be considered.

CHAPTER III GENERAL PROVISIONS

Art. 23.

INPI will republish, in its official means of communication, the related information to international registrations that have effect in Brazil, published by the International Bureau, at no cost to the holder of the international registration.

Art. 24.

Unless expressly provided otherwise, the deadlines established in this Ordinance are continuous and counted from the first business day after publication in INPI's official media outlet.

CHAPTER IV TERM

Art. 25.

This Ordinance comes into force on August 1, 2023.