

BRAZIL

Resolution INPI/PR No.245/2019, of August 27, 2019

To correct the shared ownership system for trademark registration.

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RESOLUTION No 256, OF 09 OF MARCH OF 2020

BRAZIL

Resolution INPI/PR No.245/2019, of August 27, 2019

THE DIRECTOR OF PATENTS, COMPUTER PROGRAMS, AND TOPOGRAPHIES OF INTEGRATED CIRCUITS, IN THE EXERCISE OF HER POWERS, and the DIRECTOR OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS of the NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY, in the use of his legal powers provided for in section XII or Article 152 and section XIII of Article 156 of the Internal Regulations of the INPI approved by Ministerial Directive MDIC No. 11, of January 27, 2017,

CONSIDERING

the pending adhesion of Brazil to the Madrid System for the International Registration of Trademarks by means of its adhesion to the international treaty named the Protocol Relating to the Madrid Agreement Concerning the International Registration of Trademarks;

CONSIDERING

the standardization of trademark registration procedures between national applications and assignments received under the Madrid Protocol;

CONSIDERING

the need for enhancing the efficiency and uniformity in the processing of registrations and trademark registration applications; and

CONSIDERING

the development of the means that facilitate the INPI's processing of registrations and trademark registration applications under the shared ownership system.

AGREE:

Article 1

To correct the shared ownership system for trademark registration.

Article 2

The shared ownership system for trademark registration allows for the inclusion of one or more owner or applicant per registration or trademark registration application.

Sole paragraph. The application process under the shared ownership system for trademark registration may only be done electronically, except when system downtime for an extended period may cause significant damage to the preservation of rights.

GENERAL PROVISIONS

Article 3

INPI publications concerning registrations or trademark registration applications containing ownership information shall contain the details of all shared owners or applicants.

APPLICANTS

Article 4

The authors of trademark registration applications under the shared ownership system shall exercise legal and effective control over the claimed products or services, directly or through companies they have direct or indirect control over, indicating this status in the application for registration.

Article 5

The authors of applications for certification mark registrations under the shared ownership system.

Article 6

The shared ownership system shall not be allowed for collective mark registrations.

UNION PRIORITY RIGHT

Article 7

Trademark registration applications shall be guaranteed the priority right when submitted by the same number of owners as the foreign priority right.

Sole paragraph. Concerning applications filed by a number of different applicants, an assignment document shall be submitted concerning the priority.

REGISTRABILITY

Article 8

For the purposes of analyzing the registrability of a sign as a mark, the previous right shall be considered a third-party right when the owners are not exactly the same as the authors of the application in question.

1. The provisions above shall be applied even when a number of the applicants are the owners of the right in question.

2. When the registrability of a sign as a mark depends on consent, the applicants must be authorized by the owner of the right to register the sign as a mark.

Article 9

Any opposition, applications for administrative nullification, or forfeiture requirements shall be made known, even if only submitted by one of the shared owners of the registration or registration application on which the allegations are based.

Sole paragraph. Any opposition based on Article 129.1 of Law No. 9279 of 1996, and any opposition or administrative nullification based on Section XXIII of Article 124 or Article 126 of Law No. 9279 of 1996, will only be made known when it is demonstrated, within a period of 60 (sixty) days from it being filed, that the trademark registration application was deposited on behalf of all the owners of the alleged right.

PRIORITY RIGHT OVER THE APPLICATION

Article 10

The priority right over the trademark registration shall be recognized when one of the applicants satisfies the requirements established in Law 9279 of 1996.

TRANSFER OF RIGHTS

Article 11

The assignees shall satisfy the legal requirements for requesting the registration or applying for the trademark registration subject to the transfer.

Sole paragraph. If the provisions in the header are not met, the transfer shall be rejected.

Article 12

The transfer shall consist of all registrations or applications made on behalf of the same group of shared owners or applicants, of the same or similar marks, relative to the same or similar product or service, on pain of the cancellation of the registrations or filing of applications yet to be transferred with the same owners.

Article 13

The annotation concerning the inclusion or exclusion of shared owners or applicants for registrations or trademark registration applications shall be made as part of an ownership transfer application.

Article 14

The transfer of rights corresponding to registrations or trademark registration applications shall only be made when authorization from all shared owners, applicants, or their representatives is provided, unless the transfer is requested as part of court or arbitration proceedings or on the grounds of distribution by public deed.

FORFEITURE

Article 15

There shall be no grounds for forfeiture provided at least one of the shared owners demonstrates that they are using the mark.

Sole paragraph. If there are legitimate reasons for claiming the mark is no longer in use, the reasons submitted must demonstrate that it is no longer used by any shared owner.

INSTRUMENTS ISSUED BY THE PARTIES

Article 16

Unless under the conditions provided for in Article 9, the instruments set out in Law No. 9279, of May 14, 1996, concerning registrations or trademark registration applications, must be issued jointly by all shared owners, applicants, or their representatives, or by a sole proxy with duly qualified powers to represent all parties.

1. When not taken by a sole proxy, instruments shall be signed by all shared owners, applicants, or their representatives.

2. In terms of representations, for official purposes and registration before the INPI, only the representative filing the application shall be annotated.

Article 17

Shared owners or applicants residing abroad must satisfy the conditions set out in Article 217 of Law 9279 of 1996.

FINAL PROVISIONS

Article 18

Requests for the use of the shared ownership system in trademark applications shall be available on the e-INPI System from March 9, 2020.

Article 19 T

his Resolution shall come into force on October 2, 2019.

Rio de Janeiro, August 27, 2019

RESOLUTION No 256 , OF 09 OF MARCH OF 2020

Revokes provisions of Resolution INPI/PR No.245/2019, of August 27, 2019, and other measures.

RESOLVE:

Article 1

The date for making the petition related to the co-ownership regime in trademark registration in the e-INPI System shall be stipulated in a specific act.

Article 2

Article 18 of Resolution INPI / PR No.245/2019, of August 27, 2019, is hereby revoked.

Article 3

This Resolution enters into force on the date of its signature.

Rio de Janeiro, March 9, 2020