

Legal Alert

February 21, 2013

New Procedure for Recognition of Highly Renowned Trademarks Comes Into Force

On August 19, 2013 the Brazilian Patent and Trademark Office (“INPI”) issued Resolution No. 107/13, which regulates the new procedure for recognition of highly renowned trademarks in Brazil. Upon publication of Ordinance No. 27/14 of the Brazilian Ministry of Development, Industry and Foreign Trade on February 6, 2014, establishing the specific official fee that will be charged by INPI for the analysis of the high-renown status, Resolution No. 107/13 finally comes into force.

Ordinance No. 27/14 sets forth that the official fee for the request of high-renown status will be R\$ 37,500.00 in electronic form, and R\$ 41,300.00 in paper form. Oppositions, replies to oppositions and administrative nullity requests based on highly renowned trademarks will also be subject to specific official fees.

In order to be recognized as highly renowned, trademarks must comply with three requirements: (i) recognition of the trademark by a significant portion of the public in general; (ii) quality, reputation and prestige that the public in general associates with the trademark and its goods or services; and (iii) degree of distinctiveness and exclusivity of the trademark. Item (i) should be evidenced preferably through market surveys, and item (ii) through a trademark image survey of national coverage, without prejudice of other evidence.

If the high-renown status request was filed within an opposition or administrative nullity proceeding prior to Resolution No. 107/13 and is still pending analysis, the trademark owner must file a petition confirming its interest in the recognition of the high-renown status within ninety (90) days as of March 10, 2014, when the official fees determined by Ordinance No. 27/14 will come into force. In such cases, the trademark owner may also file new evidence and will be excused from paying the specific official fee.

Highly Renowned Trademarks in Brazil

The Brazilian Industrial Property Law (Law No. 9,279/96) sets forth in article 125 that special protection shall be afforded to registered trademarks deemed as highly renowned in Brazil in all fields of activity. Nevertheless, until Resolution No. 107/13 the request for recognition as a highly renowned trademark was only possible in the realm of oppositions or administrative nullity proceedings against applications or registrations for

For more information,
please contact:

Esther Flesch
Partner - São Paulo
+55 (11) 3048 6940

Flavia Rebello
Partner - São Paulo
+55 (11) 3048 6851

Flavia Vasconcelos
Partner - Rio de Janeiro
+55 (21) 2206 4918

Regina Neves
Associate - São Paulo
+55 (11) 3048 6833

Stephanie Elfering
Associate - São Paulo
+55 (11) 5091 5905

WARNING

This Legal Alert is an informative publication of Trench, Rossi e Watanabe.

Its purpose is to highlight relevant issues in the legal area and should not be considered as a legal opinion on any subject.

For legal opinion and further information, please, do not hesitate to contact us.

allegedly conflicting trademarks.

Under Resolution No. 107/13 it is now possible to request the high-renown status of trademarks through an autonomous proceeding. Trademark owners may request such recognition at any moment of the trademark's validity, submitting the necessary evidence of such status and upon payment of the specific official fee.

The high-renown status will encompass all fields of activity (i.e. all classes will be covered) and will be valid for a 10-year term as of the publication of INPI's decision in the Official Gazette. By the end of such term the trademark owner may request the renewal of the high-renown status by submitting a new request.

We will be pleased to provide any further information upon request.