



TRADEMARK  
INFORMATION  
SHEET

**DANIEL**

# 1 - TRADEMARK IN BRAZIL:

## 1.1 - GENERAL INFORMATION



Multiclass and divisional trademark applications/registrations are not in force yet. For each **class of interest an individual application is required.**



Co-ownership has been implemented as of **September 15, 2020.**



In case of a **priority claim**, the specification of products and services must be identical or narrower than those claimed in the basic application. On the other hand, it is possible to use more than one application, in the same class, as basis for one priority claim.



Brazil is a first to file country and trademark rights are only acquired upon registration, which means that the **filing date is of main importance.**



Trademarks filed **without a claim of colors**, once granted, can be used with **any color** or combination of colors. Trademarks filed with claim of colors, once granted, must be used exactly as filed.



Current applications are taking on **average six to twelve months to be examined** (allowed or rejected) if no oppositions or office actions are raised. If the application is allowed, once the final issuance fees are paid, the grant of the corresponding **registration** should **occur a month later** and the issuance of the certificate of registration a couple of months after that.



**YEARS**

No proof of use is required either for the filing of an application or for the granting of the corresponding registration. However, a **registration does become vulnerable for cancellation** on the grounds of non-use if use is not initiated **within 5 years** of its grant or is discontinued for more than five years afterwards.



**Generic or descriptive signs**, which do not carry enough distinctiveness, are **not registrable** as trademarks **in Brazil**. Advertising expression may be registered but only if they are also used as trademarks. Nonetheless, in both cases, the criteria of analysis of the Brazilian PTO is very restrictive.

## 2 - BRAZIL DESIGNATIONS THROUGH THE MADRID PROTOCOL SYSTEM:

### 2.1 - GENERAL INFORMATION

The **Madrid System is in force in Brazil** since **October 2, 2019**.

The first Brazilian designations started being published for opposition purposes on **May 12, 2020**.

**Madrid simplified** the proceedings, so it is quite **easy to extend** an existing **international registration** to Brazil, besides managing renewals.

The use of a **local counsel** will be **necessary** if the mark suffers a **provisional refusal**, otherwise in a straightforward proceeding there is in principle no need to hire anyone to act in the case locally (\*)

**Nice classification** has been widely used in Brazil for over **20 years** it is unlikely that the BPTO will be more stringent when analyzing international filings towards wording and classification than it is in a regular national filing (though no international filings have been published yet);

The **Office** will notify the International Bureau of the decisions concerning provisional refusals and **decisions on nullity** or **revocation** actions.

Additionally to the above, we wish to address essential aspects regarding the future developments of the Brazilian designations through the Madrid System.

When implementing the **Madrid system**, the **Brazilian PTO** elected **not to give notice** to the international bureau of particular briefs filed by third parties in Brazil, such as notices **of oppositions or ordinary petitions, which may impact**

Daniel Law has developed a proprietary software capable of reading WIPO's database to seamlessly monitor all the developments of an international registration as it is prosecuted by the Brazilian PTO.

In order to preserve the applicant' rights, we are disposal to include, without charge, our clients' BR Designations in our online monitoring to ensure they are properly informed of the relevant developments during the local examination that are not communicated through WIPO.

If you have an interest in obtaining further information on how our communication system works, please do not hesitate to reach us out at **[daniel.madrid@daniel-ip.com](mailto:daniel.madrid@daniel-ip.com)**

We are also at your disposal to clarify any questions regarding the designation of Brazil under the Madrid Protocol.



## 2.2 BRAZIL REGISTRATION PROCEEDINGS:



For domestic applications, foreign applicants need a local agent or lawyer to represent him/her and receive citations. The local representative must state that applicant is engaged in the field of commerce or industry related to the products or services claimed in the application.

A simply signed power of attorney in PDF format suffices for all trademark filings in the name of the same owner.

The application process includes a formal examination, an examination of distinctiveness and a search for prior trademarks. The processing time from filing to registration is approx. 18 months, in case of a smooth procedure.

A trademark search with a local attorney or agent is highly recommended.

The application is filed at the National Intellectual Property Institute (INPI) or through WIPO as an international application through the Madrid Protocol System.

For international applications from the Madrid Protocol, the designated process and registration in Brazil will not need a representative, however, it will be necessary for any act than the ones made through WIPO and it is highly recommended to have a local representative to avoid loss of rights.

Foreign applicants do not need a domestic registration nor domestic company incorporation.

Prior to registration, the trademark application is published some weeks after the application date in the weekly gazette "Revista da Propriedade Industrial" (RPI).



## 2 - BRAZIL DESIGNATIONS THROUGH THE MADRID PROTOCOL SYSTEM:

### 2.1 - GENERAL INFORMATION



The Brazilian PTO is currently taking until two months, counted from the filing date of the request to render a decision on records of assignment and co-ownership.



Until the allowance of the recordal of the assignment, any document issued by the Brazilian PTO will reflect the previous trademark owner's information.



According to Article 135 of the Brazilian Trademark Law, assignments and co-ownership records must include all registrations or applications in the name of the assignor/current owner that cover identical or similar trademarks, which identify identical, similar or related goods or services, under penalty of the not assigned registrations or applications being respectively cancelled or ordered abandoned.



In Brazil, the records of merger are applied as records of assignment.



The assignee must be engaged, directly or indirectly, in business activities that encompass the goods/services identified by the marks to be assigned.



The PTO no longer issues supplemental petitions attesting the recordal of assignments. Therefore, the recordal can be confirmed through the corresponding publication on the PTO's official bulletin, or upon request of an updated copy of the certificates of registration, which will disclose the new owner's information.



Due to the adherence in the Madrid Protocol, as of October 2nd, the Brazilian PTO adopted a new procedure in which we need to indicate in the assignment petition that the business activity is conducted by the Assignee itself or by other companies directly or indirectly controlled by the Assignee, and whether the Assignee is Controller of the Assignor. Thus, we only need your confirming such information.

## 2.1 - REQUIRED DOCUMENTS

The standard documents necessary to proceed with a petition applying for the recordal of an assignment are:

- Copy of a General Power of Attorney on behalf of the Assignee.
- Copy of the Assignment Document (containing the name, signature, title and address of both the Assignor and Assignee, as well as a list of all trademarks to be assigned) and must be signed by officers in the capacity of CEO, CFO, director, president, secretary or alike. Notarization and legalization are not necessary to record the assignment of trademarks.

The standard documents necessary to proceed with a petition applying for the recordal of co-ownership are:

- Copy of a General Power of Attorney duly signed by all parties involved on the co-ownership.
- Copy of the Assignment Document stating all co-owners (containing the name, signature, title and address of all parties, as well as a list of all trademarks involved) and must be signed by officers in the capacity of CEO, CFO, director, president, secretary or alike. Notarization and legalization are not necessary to record co-ownerships.

We would need, however, to secure a translation of said documents as the Brazilian PTO does not accept documents which are not in Portuguese or translated to Portuguese. Alternatively, we can draft an Assignment/co-ownership document specifically to Brazil already in Portuguese/ English.

This would avoid the need to proceed with the translation. Additionally, in this option we would be sure that all the requirements of the Brazilian Law are met. Please let us know if you would like to receive the drafts.

## 4 - TRADEMARK RENEWALS

### 4.1 - GENERAL INFORMATION

· A trademark registration is valid for ten years and can be renewed for equal and successive periods.

· A renewal request should be filed in the last year of validity of a registration, within the ordinary term, or up until 6 months after the expiration date, within the extraordinary term at additional costs.

· The date on which the renewal is filed does not shorten or extend the new ten-year term of validity. It, however, expedites the allowance of the renewal request.

· No proof of use is required for renewal purposes.

· The PTO is taking approximately a month, counted from the payment of the renewal fees, to publish the allowance of the renewal request.

· Once the renewal publication takes place, the time lapse for the issuance of the corresponding certificate of renewal is approximately from 2 to 6 months. This document is now secured electronically and there is no original to be sent.

· The filing of a renewal request by a different attorney than the one listed as attorney of record for the case does not necessarily change the responsibility over the prosecution of the renewed trademark.



## 4.2 - RENEWALS SERVICE

A full explanation of our Renewals service:

To facilitate the handling of renewals for our clients, our team is able to preview all upcoming deadlines

in any given year and provide a full-scope renewal estimate based on the **client budget** for that period. That means we are able to:



(i) provide an estimative early in the year of the number of cases to be renewed based on the approaching deadlines and assist with budget planning (coordinate payments at once/in advance or spread out in different periods based on client preference).



(ii) centralize your renewal instructions and payments to save on costs and time by preventing the need of communicating with various attorneys of record throughout the year, of executing new or multiple PoA for such agents, or using intermediaries with non-approved vendors.



(iii) secure control of all the renewal deadlines in our proprietary system, which includes programmed reminders until there are definite instructions as to how to proceed with any given renewal; and



(iv) all the data verification based on the BPTO's database to guarantee that the applicant's name and address as well all the particulars of the registration are accurate in order to avoid inconsistencies which often take place.

### Our Renewals team

is efficiency-driven and for that purpose we can offer competitive fees while being supported by a robust IP practice in Brazil. Nevertheless, we are willing to **offer discount policies for special projects** as well as for the concentration of portfolios with us and to confer a special schedule for renewals. If you are interested, you are welcome to request more information about our policies.

Our fees include the filing of the renewal, the report of the allowance of the renewal, as well as the maintenance of the case for the subsequent ten-year period in our control

system, per case. Regarding the Certificates of Renewal, once they are issued we charge separately, per case, for revising and forwarding them.

Additionally to the above, we also inform that we may be instructed to proceed with the payment of renewals without being the legal representative of all cases. If, however, you would like is to monitor the developments of certain registration after the renewal process is complete, we would be happy to do so without any added costs.

## 4.3 - REQUIRED INFORMATION

**OWNER'S DATA:** We must be informed of the current name and address of the registration's owner. If a change of name/address or an assignment has occurred within the last ten years of the validity of a registration, we must receive complete information in this connection. We also need to know if this change of name/address or assignment has already been applied for before the Brazilian PTO.

If a request for the recordal of these changes has not been filed or has been filed but has not yet been allowed by the Brazilian PTO, we can file the renewal request using the old or the current owner's information.

Please note that even if we file the renewal request using the current data of the registration's owner, if our renewal request is allowed before the allowance of the change of name/address or the assignment, the corresponding certificate of Renewal will be issued according to the Owner's data recorded currently at the BPTO.

### **CLASS AND PRODUCTS OR SERVICES COVERED BY THE REGISTRATION:**

For registrations that are not under our responsibility, we do not have the original filing particulars. Accordingly, if we receive detailed information of the class and of the products or services which are identified by the registration and we detect a discrepancy with the information recorded at the PTO's database we can get back to you and request clarification. On the other hand, if we do not receive this information, we will file the renewal request following the information which is recorded in the PTO's database.

## 4.4 - REQUIRED DOCUMENTS

If we are already the attorneys of record for the case, no further documents will be required. In the contrary and the client wishes us to become the responsible Agents we will require a General Power of Attorney, to be filed per case. In case the client does not wish us to take over the case, no further documents would be required, as the presentation of powers of attorneys in renewal processes is unnecessary according to the BPTO's present understanding. However, if the Owner requests us to, we can use a Power of Attorney specific for renewals in order to submit a supplemental petition in support of the renewal.

In relation to the Powers of Attorney, they can be simply signed by an authorized officer of the Owner, whose name and title must be typed below the signature, no notarization or legalization are required and a scanned copy will suffice as all proceedings at the BPTO are currently electronic.

Due to the fact the renewals are requested on each ten years, it is important for us to have your contact information updated in relation to the registrations under our care. Please note that the absence of an updated contact information may prevent us from sending reports or even complying with future deadlines in connection with said registrations.

It is also very important for us to have your complete billing information. Accordingly, please explicitly indicate the complete debtor information, as well as your reference and financial reference (if applicable), and any specific billing instructions that should be complied with (for ex. a specific billing e-mail).