



THE RELEVANCE OF HIGHLY RENOWNED TRADEMARKS IN BRAZIL

Introduction

In today's competitive global market, trademark protection is crucial for maintaining a brand's identity and reputation. Among the various forms of trademark protection, the concept of highly renowned trademarks stands out due to its extensive legal advantages. In Brazil, obtaining the status of a highly renowned trademark not only fortifies a brand's position within its industry but also provides broader protection against misuse and dilution across all market segments.

UNDERSTANDING HIGHLY RENOUNDED TRADEMARKS

Highly renowned trademarks in Brazil are those that enjoy widespread recognition and prestige among the general public. Governed by Article 125 of the Industrial Property Law No. 9,279/1996, these trademarks receive protection beyond their specific market sectors. This means that a highly renowned trademark is safeguarded against any unauthorized use, irrespective of the product or service category, thus preventing confusion and protecting the brand's integrity.

BENEFITS OF HIGHLY RENOWNED TRADEMARKS

The primary benefit of a highly renowned trademark is the extensive legal protection it affords. Unlike ordinary trademarks, which are protected only within their registered categories, highly renowned trademarks are shielded across all classes of goods and services. This broad protection helps in preventing trademark dilution, where the distinctiveness of a brand could be weakened through unauthorized use in unrelated markets.

Additionally, the status of a highly renowned trademark enhances the brand's market value and equity. It positions the brand as a leader within its industry, recognized for its quality and reputation. This recognition not only deters potential infringers but also strengthens consumer trust and loyalty.

Other advantages of highly renowned status include:

- 1. Rejection of Pending and Future Third-Party Applications:** Obtaining highly renowned status allows for the rejection of conflicting applications, thus protecting the brand from potential infringers.
- 2. Exception to the Specialty Principle:** Highly renowned trademarks are enforceable against all classes, even those without any kind of affinity, offering broader protection.
- 3. Ripple Effect on Lawsuits:** The recognition of high renown can significantly impact ongoing or future lawsuits, providing a stronger legal basis to contest unauthorized use across all classes or market segments.
- 4. Prevention of Dilution and Free Riding:** This status helps avoid the dilution of the trademark's distinctive capacity and prevents third parties from benefiting unfairly from the brand's reputation.
- 5. Clear Path to New Registrations:** During the 10-year protection period, owners can clear the path to new registrations in different classes, ensuring comprehensive brand protection.

THE PROCESS OF OBTAINING HIGHLY RENOWNED TRADEMARK STATUS IN BRAZIL

Securing the status of a highly renowned trademark in Brazil involves a rigorous process overseen by the Brazilian National Institute of Industrial Property (INPI). The key steps include:

- 1. Evidence of Broad Recognition:** The applicant must demonstrate that the trademark is widely recognized by a significant portion of the Brazilian public. This is typically achieved through comprehensive market surveys that highlight the brand's visibility and reputation.
- 2. Association with Quality and Prestige:** The trademark must be associated with high-quality products or services. This association can be substantiated through nationwide brand image surveys and other supporting documentation that reflect the brand's reputation.
- 3. Distinctiveness and Exclusivity:** The trademark should possess a clear degree of distinctiveness and exclusivity. Evidence must be provided to show that the trademark stands out from others in the market and maintains a unique position.

Once these requirements are met, the INPI grants the highly renowned status, which is valid for ten years and can be renewed upon demonstrating continued recognition and prestige.

According to the INPI, as of February 2023, several trademarks have been recognized as highly renowned in Brazil (a complete list can be found on the INPI website).

CHALLENGES AND CONSIDERATIONS

While the benefits of obtaining a highly renowned trademark are significant, the process is not without its challenges. Proving broad public recognition and maintaining extensive documentation can be demanding. Moreover, continuous investment in marketing and brand management is essential to uphold the trademark's status and prevent dilution.

Brands must also be vigilant against potential infringements and unauthorized uses. Despite the comprehensive protection offered, monitoring and enforcement actions are crucial to safeguard the trademark's integrity.

LOSING HIGHLY RENOWNED STATUS

Maintaining highly renowned status requires diligence. Trademark owners may lose this status if they:

- 1. Forget to Renew the Original Registration:** The fame status is linked to the original registration, and failing to renew it can result in loss of the status.
- 2. Face Cancellation of the Registration:** If the registration used to record the status is cancelled by the INPI or the courts, the status is also lost.
- 3. Encounter Contestation:** If the recognition of the highly reputed status is contested and overturned by the courts, the trademark owner will lose the enhanced protection.

CONCLUSION

The recognition of a highly renowned trademark in Brazil offers unparalleled advantages in terms of legal protection and market positioning. By securing this status, brands can protect their identity and reputation more effectively, ensuring long-term success and consumer trust.

A leading firm in this field, and with a remarkable track record, Daniel has consistently achieved 100% success in obtaining highly renowned status for our clients.

For businesses aiming to achieve this prestigious recognition, consulting with experienced legal experts, such as our team at Daniel, can provide the necessary guidance and support throughout the process.



Get in touch with us!

Our experts at Daniel are at your disposal to answer any of your questions. Do not hesitate to get in touch with us.

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