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Newsletter

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INPI NEWS

Brazilian Patent and Trademark Office (BPTO) News

- **Procedure for technical examination of patent applications at appeal level:** published by the BPTO, the procedure aims at providing instructions on the draft of technical opinions at appeal level for patent applications of invention, utility model and certificate of addition that were rejected in the first instance. Check out the procedure [here](#).
- **BPTO clarifications on procedures for changes in ownership/name/address of patents:** in order to clarify and update the rules regarding the procedures for recording changes in name, address and ownership of patents, the BPTO published Ordinance INPI/DIRPA No. 20 of September 13, 2024. The Ordinance can be found [here](#).
- **Brazilian National Directory for combating counterfeiting of geographical indications (GI):** it was pre-launched by the BPTO. On the platform, available on BPTO's portal, producers will be able to register information about their products, including main characteristics, packaging descriptions, and distribution routes. Access the Directory [here](#).



COURT DECISIONS

Use of trademarks in electoral propaganda is prohibited

In July this year, the Superior Electoral Court (TSE in Portuguese) upheld the prohibition on the use of trademarks in electoral propaganda, according to the decision of [inquiry \(11551\) No. 0600188-95.2024.6.00.0000](#):

“the prohibition to expose trademarks or place propaganda carried out with the intention, even if disguised or subliminal, to promote a brand or product covers all types of electoral propaganda.”

Grupo Soma sues Shein for copying Animale’s clothing and seeks compensation

Grupo Soma has filed a lawsuit against Shein, accusing the company of copying clothing from the Animale brand and selling it at significantly lower prices. According to Grupo Soma, Shein allegedly approached its suppliers to reproduce the pieces, which would constitute a violation of copyrights. The case is currently pending before the 1st Business Court and Arbitration Conflicts of São Paulo Court of Justice, and Soma is seeking compensation for the alleged infringement.

During the proceedings, it was revealed that Shein had a document indicating the types of clothing to be reproduced from Animale’s

summer 2024 collection, including images and details from the brand’s campaigns. Shein, in turn, claimed that the use of the Animale brand was merely a reference for market analysis and that the document had been improperly sent by an employee.

Discussions like this have become increasingly common, demonstrating the power of e-commerce platforms and the importance of actively, and not reactively, monitoring the market. As holders of rights, companies must try to understand the tools they can use to assist them in this battle and the strategies they should follow to protect their creative works and intellectual property.

Prior knowledge of a foreign trademark leads to the nullity of trademark “Deus Brasil Ex Machina” in Brazil

As ruled by the Regional Federal Appellate Court of the 2nd Region (TRF2 in Portuguese), the registration of Brazilian trademark “Deus Brasil Ex Machina” was declared null due to graphic identity and commercial segments with Australian trademark “Deus Ex Machina.” The nullity was motivated by the proof that the owner of Brazilian trademark “Deus Brasil Ex Machina” had prior knowledge of the trademark registered abroad, pursuant to article 124, XXIII, of the Brazilian Industrial Property Law (LPI).

According to TRF2, the rights provided for in the LPI extend to owners based in a country

that is a signatory to the Paris Convention (CUP) and, in the case in question, trademark “Deus Ex Machina” was registered in Australia, a signatory country of the CUP.

This action is one of the examples of measures that can be taken by trademark owners from foreign countries in Brazil to prevent third parties from exploiting, in bad faith, their trademark improperly. In addition to bring the case to court, it is also possible to file an Opposition and Administrative Nullity Action before the BPTO.

Process No. [5076368-92.2020.4.02.5101](#).

Reserva must indemnify Tim Maia’s estate for the improper use of songs on T-shirts

On September 10, the Third Panel of the Superior Court of Justice (STJ) unanimously ruled that the clothing company Reserva should indemnify Tim Maia’s heirs for the improper use of lyrics from his songs on T-shirts. Phrases such as “*Guaraná & suco de caju & goiabada & sobremesa*,” from the song “Do Leme ao Pontal,” and “*Você & eu & eu & você*,” from the song “*Você e Eu, Eu e Você*,” were used without authorization, which led the court to increase the compensation determined by the Court of Justice of Rio de Janeiro to BRL 50,000 for pain and suffering damages, in addition to the reimbursement of profits obtained by the company and an

amount that would have been charged if the authorization had been requested.

The rapporteur of the case, justice Marco Aurélio Bellizze, emphasized that the appropriation of lyrics, even with minor changes, represents illicit reproduction, underlining the importance of legal protection for musical compositions under the Copyrights Law. This decision highlights the need for authorization for the use of artistic works and stands as a warning about commercial limits, stressing the importance of respecting authors’ rights.

Action for nullity of trademark registration: it is only imprescriptible if the trademark is notoriously famous and if there is bad faith

As a rule, the action to cancel the registration of a trademark is subject to a five-year statute of limitations. However, due to an exception provided under the Paris Convention of 1883, if **(i)** there is bad faith of the applicant; and **(ii)** the trademark is considered well-known at the time of registration, as long as these conditions are duly proven, the nullity action becomes imprescriptible. The Superior Court of Justice denied the request of Speedo Internacional to cancel the Brazilian trademarks registrations filed by another company, from a former Brazilian athlete with whom Speedo Internacional maintained commercial relations for over 30 years, considering that, at the time of registration, the trademark had no notoriety before the general public.

On the other hand, upon termination of the business agreement and commercial relationship between these parties, the renewal of the trademark registration by the Brazilian company is prohibited, allowing the Speedo trademark and its figurative symbol (arrow device) to gradually return to their true owners.

Although this case has its own specificities, similar cases are not rare and should be a warning to foreign companies, which must have **(i)** clear clauses in their contracts with suppliers and distributors in order to ensure that their intellectual property is not

registered by third parties; **(ii)** the care of registering their trademark in the country in which the company intends to enter; and **(iii)** an active conduct, by monitoring and protecting their trademark.



Amazon wins injunction in lawsuit regarding video encoding technology patent

Amazon has recently obtained a favorable injunction in a lawsuit involving video encoding technology registered by Divx in Brazil. Divx had sued Amazon, claiming that the company was using its patent without authorization and initially secured a ruling prohibiting Amazon from using the High-Efficiency Video Coding technology standard (HECV, a high-efficiency video compression standard), under penalty of a daily fine of BRL 300,000. Amazon, in turn, argued that the technology was already registered internationally and that the Brazilian patent should not be considered valid. The judge accepted the argument and temporarily suspended the patent until the final ruling of the case.

The case also involves a history of lawsuits, as Divx had previously sued Netflix for using the same technology. Furthermore, the judge ordered the appointment of a new expert to review the case. It is worth noting that the decision was overturned by the Regional Federal Appellate Court of the 1st Region, in Brasília, on July 12, 2024, adding a layer of complexity to the case.

This case highlights the importance of harmonizing patents across different jurisdictions, especially in the technology sector, where international registrations may conflict with national protections. The initial decision in favor of Amazon underscores the relevance of dialogue between court systems and institutions like BPTO to ensure patents are not misused or improperly enforced.





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