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BRAZILIAN CONTEXT

20TH Edition of the NICE Classification

The 2025 edition of the International Classification of Goods and Services for the Purposes of Registration of Marks (Nice Classification) will take effect on January 1st,

2025. You can find the twentieth version on the World Intellectual Property Organization (WIPO) [website](#).

Recent Actions Against Digital Piracy

At the end of September, an operation conducted by the Ministry of Justice and Public Security (MJSP in Portuguese) blocked and suspended about 675 websites and 14 illegal streaming apps, in addition to removing illegal audio and video content, including games and music. This operation aimed to combat crimes against intellectual property in the virtual environment and counted on foreign intellectual property agencies and associations.

Meanwhile, the Public Prosecutor's Office of São Paulo (MPSP in Portuguese) promoted, in early October, an event on measures to repress the sale of counterfeit products on the internet, with consular authorities from the United States, the United Kingdom and Japan.

The initiatives implemented by the MJSP and MPSP highlight the relevance of intellectual property protection in the digital environment, where the unauthorized reproduction and copy of films, series and music, as well as the sale of counterfeit products, are recurrent practices. Such actions, in addition to being crimes, inflict significant losses to the cultural sector and all its agents, especially authors and other holders of intellectual property rights. Therefore, it is crucial to strengthen awareness and action in this field to safeguard creativity and innovation.

COURT DECISIONS

Validity of a Trademark with Advertising Nature is Recognized by the Brazilian Superior Court of Justice

In the ruling of Special Appeal No. 2,105,557/RJ, the Brazilian Superior Court of Justice (STJ in Portuguese) recognized the registrability of composite trademarks “THERASKIN HARMONIA NA PELE,” whose applications had been rejected by the Brazilian PTO on the grounds that a trademark constituted by an advertising sign or expression is unregistrable under item VII of Article 124 of the Brazilian Industrial Property Law (LPI in Portuguese).

According to the STJ, the inclusion of an advertising element in the trademark (expression “HARMONIA NA PELE / HARMONY IN THE SKIN”) is not sufficient to classify the trademark solely as an advertising sign. This is mainly due to the presence of other nominative and figurative elements that give the trademark the distinctiveness required by the Brazilian IP Law.

By recognizing the validity of “THERASKIN HARMONIA NA PELE” trademarks, STJ emphasizes the importance of a complete analysis of the trademark, taking into account not only the non-registrable elements, such as advertising signs, but also the distinctiveness that is conferred by other nominative and figurative

aspects. This decision sets a relevant precedent that can open the door to several discussions on the subject. There are indeed slogans that evolve into brands – like Nike’s slogan, “Just Do It.” However, questions arise when slogans do not show so much distinctiveness. At what point does a trademark set, composed of an expression with an advertising nature, acquire sufficient distinctiveness to qualify for trademark registration?



Federal Court Overturns BPTO's Decision and Authorizes Registration of Trademark "YOUW"

The Regional Federal Appellate Court of the 2nd Region (TRF2) overturned the BPTO's decision which had denied the registration of trademark "YOUW" due to an alleged conflict with trademark "YOO" (please see the decision [here](#)). The BPTO based its decision on Article 124, XIX, of the Brazilian IP Law, which prevents the registration of trademarks likely to cause confusion with previously registered ones. However, the appellant argued that, despite the similarities between the names, the graphical and nominative compositions of the trademarks were distinct enough to avoid confusion.

The case's rapporteur concluded that the differences between the trademarks, both in graphical and nominative terms, reduced the risk of consumer confusion. He also pointed out

that the widespread use of the term "you" in the market weakens any claim to exclusivity. Based on these factors and similar case precedents, the Court ruled in favor of the appeal, annulling the BPTO's denial and ordering the registration of "YOUW" trademark.

This ruling shows that a trademark registration analysis must go beyond a simple nominative comparison. It should take into account the context of the mark's usage and the visual and semantic characteristics that can differentiate products in the market. The case emphasizes that exclusivity over certain terms may be limited, especially in highly competitive markets where innovation and the coexistence of similar trademarks are inevitable.



Vert to be Compensated for Unauthorized Use of its Trademark by Competitors

Veja Fair Trade Shoes, formerly known as “Vert” in Brazil, will receive R\$ 20,000 in moral damages after the unauthorized use of its “V” trademark by competitors. The decision was rendered by Judge Eduardo Palma Pellegrinelli, from the 2nd Business Court and Arbitration Conflicts of São Paulo, who concluded that there was a violation of the company’s industrial property rights. The lawsuit was filed against Fork Calçados, Hyard Calçados, and Fromshoes, accusing them of using the Vert brand without authorization on websites and social media to advertise similar products, thus engaging in unfair competition.

The defendants denied the allegations, claiming they have not sold Veja-branded products nor operated in the same segment. However, the judge did not accept these defenses, finding that the use of the “V” trademark in association with similar products

could confuse consumers and lead to unfair competition. In addition to the moral damages compensation, the companies were ordered to remove the infringing content and cease using the “Vert” trademark on any online platform. The compensation for pecuniary damages will be determined in the enforcement phase, as provided for in the Brazilian IP Law.

This case highlights the significant impact that the unauthorized use of trademarks can have, not only on a company’s business but also on its credibility and market value. The court’s decision serves as a reminder for companies to remain vigilant about protecting their trademark rights, particularly in digital environments where enforcement is more challenging, and violations can substantially harm a brand’s competitiveness and image in the marketplace.

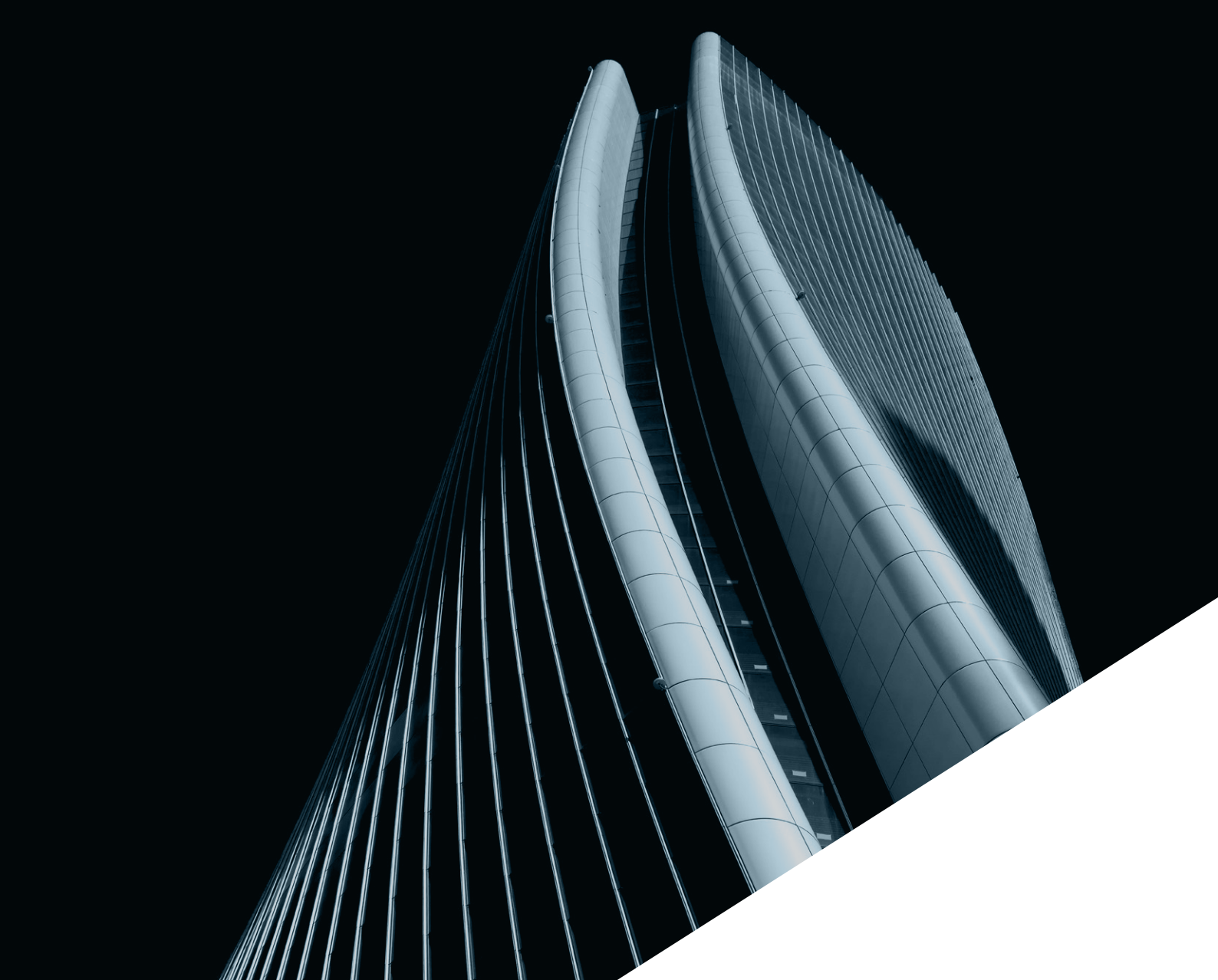


New Developments from TRF2 regarding iPhone Trademark Dispute between Gradiante and Apple





The legal dispute between IGB Eletrônica S/A (Gradiante) and Apple Inc. (Apple) over the ownership of trademark “iPhone” in Brazil has progressed in the TRF2 (Regional Federal Appellate Court of the 2nd Region). Gradiante, the Brazilian company that filed trademark application “G Gradiante iPhone” in 2000, prior to Apple’s “iPhone” launch in 2007, seeks to annul Apple’s “iPhone” trademark registration, claiming that it has a prior right to use it. However, TRF2 has decided to uphold the first instance ruling that denied Gradiante’s claim, determining that the trademarks have sufficient distinctive elements to avoid confusion in the market. The court also reassigned a second lawsuit, in which Apple requested the forfeiture of Gradiante’s trademark registration to a specialized federal court.

In addition to the developments in the TRF2, the case is under examination by the Federal Supreme Court (STF), which will evaluate the exclusivity of the use of the “iPhone” trademark in Brazil. For more details on the case, click [here](#). The TRF2 ruling in favor of Apple is in line with the initial score of the STF judgment, which had 5 votes in favor of Apple against 3 votes in favor of Gradiante. However, the score was reset late last year, and the case is now awaiting a new ruling from STF. The STF’s ruling will have general repercussions and may establish new standards for industrial property and the validity of trademark registrations involving prior use rights, influencing not only this dispute but also other similar cases in the future.





Partners responsible for the newsletter

-  Marcela Waksman Ejnisman
-  Carla do Couto Hellu Battilana
-  Luiza Sato
-  Stephanie Consonni de Schryver

Contributed to this newsletter

- Igor Baden Powell
- Isabella de Freitas Moraes Sampaio Pereira
- Julia Parizotto Menzel
- Julie Lissa Kagawa
- Maria Eugênia Geve de Moraes Lacerda
- Miguel Lima Carneiro