

TozziniFreire.  
ADVOGADOS


# Intellectual Property.

Newsletter

29<sup>th</sup> Edition | 2024

This is an informative newsletter  
produced by the **Intellectual Property**  
practice of TozziniFreire Advogados.

# INDEX

Click at the topic of your interest and browse through the content 

## 01 | Brazilian Context

---

/What's new at BPTO for 2025

/New Presidential Order establishes Screen Quota for Brazilian films in 2025

## 02 | Case Law

---

/Dispute between trademarks "QUANTI CAFEH" and "QUANTO CAFÉ"

/Franchise agreement terminated in court due to lack of support from franchisor

/TJSP: examination of unfair competition lawsuit should not be suspended due to ongoing lawsuit to nullify BPTO's decision

## 03 | IP Abroad

---

/CEO focuses on artificial intelligence and support for creators to boost YouTube

/Spanish court orders pirate streaming website "Roja Directa" to pay a multimillion-euro fine for broadcasting La Liga games

# BRAZILIAN CONTEXT

## What's new at BPTO for 2025

The Brazilian Patent and Trademark Office (BPTO) has made important announcements for 2025:

- **PPH with China:** the Patent Prosecution Highway (PPH) pilot program with China has been extended and is now expected to run from 2025 to 2029. PPH is an international collaborative initiative between several IP offices to reduce the processing time of patent applications.
- **2025 Action Plan:** the BPTO's action plan has an agenda of indicators and strategic initiatives aimed at promoting innovation by means of industrial property. The strategic objectives outlined in the plan

include optimizing quality and efficiency in granting and registering industrial property rights to meet international benchmark performance standards; promoting the culture and strategic use of industrial property to enhance competitiveness, innovation and development in Brazil, among other goals. Check out the complete 2025 Action Plan [here](#).

The extension of the PPH with China and the publication of the Action Plan for 2025 reflect the BPTO's intention to continuously improve the instruments and processes for the protection of intellectual property assets in Brazil, with the purpose of positioning the country as a reference in the subject matter.

## New Presidential Order establishes Screen Quota for Brazilian films in 2025

On December 20, 2024, Order No. 12,323/2024 was published (access [here](#)), establishing the mandatory "Screen Quota" for the exhibition of Brazilian films in movie theaters starting in 2025. This initiative aims to promote the diversity of titles and strengthen national

production. The presidential order sets minimum percentages for the number of screenings and Brazilian films that must be shown, based on the number of screens available in each exhibition complex.

# CASE LAW

## Dispute between trademarks “QUANTI CAFEH” and “QUANTO CAFÉ”

In December 2024, the 25<sup>th</sup> Civil Court of Brasília issued an interlocutory decision ordering that a coffee shop ceased using trademark “QUANTI CAFEH,” or any variation that reproduces or imitates trademark “QUANTO CAFÉ,” on its shopfront and social media, under penalty of daily fine for non-compliance.

The owner of trademark “QUANTO CAFÉ,” duly registered with the BPTO, filed the lawsuit on the grounds that trademark “QUANTI CAFÉ” infringes their intellectual property rights. They provided evidence of commercial confusion between establishments – both coffee shops - particularly through online

search engines. This likelihood of confusion posed a risk of damage or ineffectiveness of the final decision if the request for relief was not granted.

The decision highlights the importance of registering trademarks with the BPTO, not only to guarantee the owner the right of exclusive use of a trademark, but also to ensure protection against misuse by third parties, especially in the context of provisional remedy, that is, before the final judgment.

Access the full decision [here](#). Case No. 0753996-57.2024.8.07.0001.



## Franchise agreement terminated in court due to lack of support from franchisor

In a decision by the Court of Justice of the State of São Paulo (TJSP in Portuguese), a franchise agreement was terminated due to the franchisor's failure to comply with its obligations to transfer know-how and provide appropriate support to the franchisee.

The lack of evidence demonstrating the franchisor's compliance with essential obligations under the franchise agreement supported the understanding that there was an inadequate administrative structure, which negatively impacted the necessary guidance for the franchisee's activities.

In addition to the nullity of the agreement upon its termination, the court also ordered the franchisor to reimburse the franchisee for the amounts invested (namely, the initial franchise fee, marketing fund and royalties)

and to pay a contractual fine of BRL 100, thousand. This was due to the fact that the franchisee's complaint was not an isolated case, as there were other similar cases.

The decision underscores the importance for franchisees, before signing a contract, to conduct an economic and legal assessment of whether the franchisor has a well-structured franchise system and adequate means for transferring know-how and other intangible assets. This can help avoid conflicts like the one detailed above and prevent losses from investments made by the franchisee. Likewise, the decision is a reminder to franchisors of the courts understanding about franchising operations in Brazil, in which franchisees are seen as the disadvantaged party of the contractual relationship. Brazil has a specific franchise law, Federal Law No. 13,966/2019.



## TJSP: examination of unfair competition lawsuit should not be suspended due to ongoing lawsuit to nullify BPTO's decision

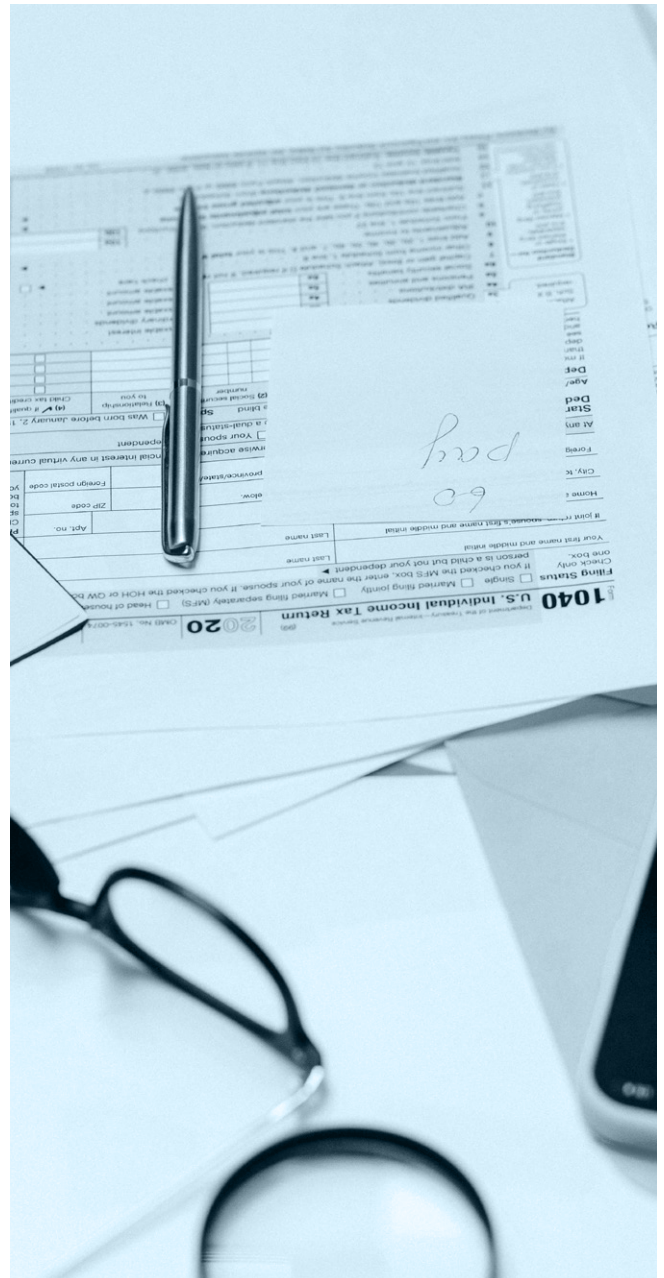
The TJSP decided that an ongoing Lawsuit for the Nullity of an Administrative Act by the BPTO does not preclude the consideration of an Action for an Injunction to Cease Activities due to Intellectual Property Violation and Unfair Competition.

According to the decision in Interlocutory Appeal No. 2132011-22.2024.8.26.0000, the court understood that while Lawsuits for the Nullity of an Administrative Act by the BPTO are not analyzed, the trademark registrations are valid and produce their effects.

Thus, in the court's understanding and considering the specific case, the possible nullity of these trademark registrations does not rule out the occurrence of unfair competition practices and parasitic exploitation.

This decision is relevant in terms of procedural strategy, as the mere existence of a lawsuit related to an action discussing an alleged infringement is not, by itself, sufficient to justify the automatic suspension of this action.

Please see the ruling [here](#).



# IP ABROAD

## CEO focuses on artificial intelligence and support for creators to boost YouTube

YouTube's new CEO, Neal Mohan, is focused on boosting the platform through investments in artificial intelligence (AI) and supporting content creators. Mohan believes that AI can revolutionize video and music production, as well as facilitate machine translations, allowing creators to reach global audiences.

However, Mohan faces significant challenges, such as content moderation and the controversy surrounding Donald Trump's temporary ban on the platform. While he advocates for freedom of expression, he recognizes the need for clear guidelines to ensure a safe and respectful environment.

The initiatives adopted by Neal Mohan as the head of YouTube highlight the importance of balancing technological innovation, especially AI, with social responsibility in the digital environment. The use of AI can facilitate content creation and machine translation, but it is important that this technology is seen as a tool at the service of creators, and not just as a substitute. Additionally, collaboration with creators and the implementation of clear guidelines are key to addressing issues

of moderation and freedom of expression, preventing abuse, and ensuring that creativity can thrive. Thus, it is essential to strengthen these practices to promote a digital ecosystem that values both innovation and the protection of creators' rights.



## Spanish court orders pirate streaming website “Roja Directa” to pay a multimillion-euro fine for broadcasting La Liga games

The Spanish justice system has ordered the football piracy website “Roja Directa” to pay a fine of € 31.6 million (approximately US\$ 32.8 million) in a lawsuit filed by the audiovisual group Mediapro. The website was deemed liable for damages arising from the illegal broadcasting of *LaLiga* matches worldwide and across different categories and formats, whose intellectual property rights were owned by Mediapro during the 2014-2015 season.

In previous decisions, the Supreme Court had recognized the responsibility of the website’s administrators for illegal activities, which, in addition to financially benefiting from the illegal distribution of *LaLiga* matches, also profited from advertising and

commissions obtained by redirecting traffic to sports betting houses, ultimately leading to the website permanent closure following the issuance of several rulings. Despite offering free services to users, “Roja Directa” generated revenues exceeding € 11 million from a single account, according to forensic reports from 2022.

The court’s decision reflects a greater commitment to fight piracy in the sports sector, reinforcing not only the protection of copyright but also the pursuit of preserving the integrity of the sports entertainment industry, which relies on legitimate revenue collection for its continuity.







## Partners responsible for the newsletter

- ⑧ Marcela Waksman Ejnisman
- ⑧ Carla do Couto Hellu Battilana
- ⑧ Luiza Sato
- ⑧ Stephanie Consonni de Schryver

## Contributed to this newsletter

- Bianca Patrinhani Okuma
- Igor Baden Powell
- Isabella de Freitas Moraes Sampaio Pereira
- Julia Parizotto Menzel
- Julie Lissa Kagawa
- Maria Eugênia Geve de Moraes Lacerda
- Miguel Lima Carneiro
- Nathalia Yu Lin