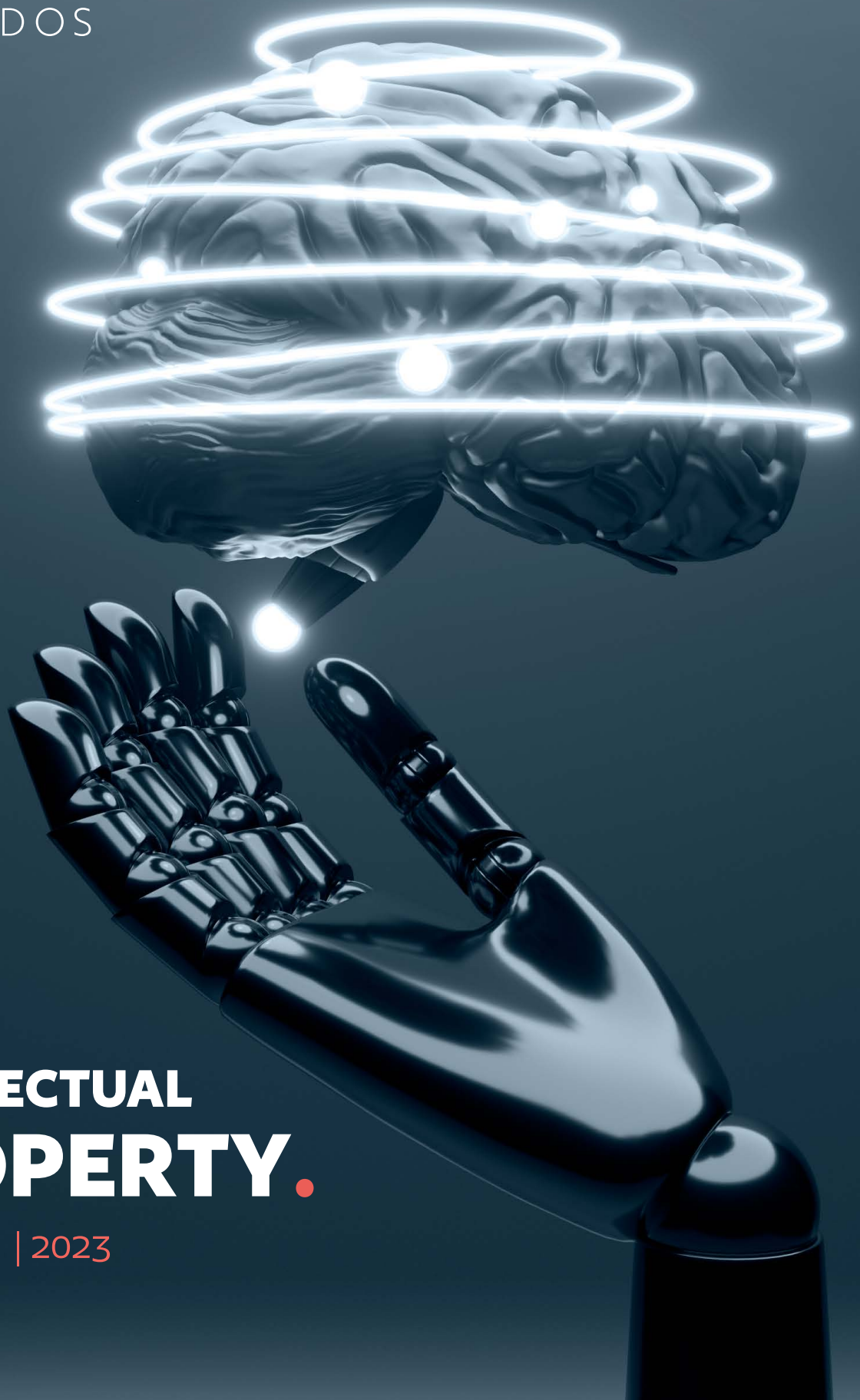


**Tozzini
Freire.**

ADVOGADOS



**INTELLECTUAL
PROPERTY.**

14th Edition | 2023



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01 Brazilian Context.

Senate approves agreement to protect Geographical Indications in Mercosur

The Senate approved a bill for a legislative decree related to an agreement in Mercosur to protect original geographical indications.

The purpose of the legislative text is to respect the designations of origin of each country, allowing the coexistence of geographical indications for the same product or service. In addition, this will serve as an incentive for the protection of intellectual property rights arising from geographic indications and harmonization of trade between countries of Mercosur.





Coffee from Canastra is recognized as the first Denomination of Origin of 2023

The Brazilian Patent and Trademark Office (BPTO) published, in its Official Gazette No. 2750 of September 19, 2023, that it has recognized the Geographical Indication, in the Denomination of Origin modality, for the coffee from the region of Canastra, in the state of Minas Gerais.

The request was made by the Canastra Coffee Growers Association, which reported that the variation in altitude and temperature in the region give Canastra coffee specific attributes related to aroma, flavor, density, and creaminess.

With this recognition, the BPTO reaches the number of 117 Geographical Indications granted.



Greenwashing practices associated with intellectual property

The adoption of sustainable practices in managing a business, environmental compliance, reports and audits are certainly some of the characteristics that enhance a company's credibility. However, some companies use techniques to create a false image of sustainable products or services, either by using advertising strategies or by putting false information on labels to mislead consumers, which is commonly referred to as greenwashing.

The discussion on greenwashing practices and how to identify them was one of the topics discussed at the XV Academic Meeting on Intellectual Property, Innovation and Development (ENAPID), held on September 15 in Rio de Janeiro. In this panel, professors from the BPTO Academy emphasized that this debate is related to industrial property topics, such as trade dress and certification trademarks, since suggestive elements placed on product packaging can mislead consumers about sustainability issues.

02 Court Orders.

The Courts of Ribeirão Preto prohibit Carreta Furacão from using Fofão doll

The Courts of Ribeirão Preto, São Paulo, prohibited the company F. de S. C. Dameto Eventos Turísticos (S.C. Dameto), which is the owner of Carreta Furacão “little train,” from using the image of character Fofão, because of a lawsuit filed by Agência Artística S/S Ltda., legal representative of the son of Fofão’s creator. The decision determined that the company which owns Carreta Furacão train must pay damages to the plaintiff in the amount of BRL 70,000.00 for pain and suffering, and BRL 2,000.00 per day if the company does not comply with the decision.

S.C. Dameto defense claims that the use of the artistic expression in this case was a tribute and a parody and, once there are subtle differences in the character’s looks, there would be no copyright infringement.

The judge understood that the explicit and extravagant imitation distorts the original character of the deceased creator and does not admit any possibility of removing the necessity of previous authorization. See the full ruling [here](#).

3x2 in the litigation between Apple and Gradiente involving “iPhone” trademark

In the latest developments related to the litigation over the ownership of the “iPhone” trademark by companies Apple Inc. and IGB Eletrônica S.A. (Gradiente), which started in 2013, justice Alexandre de Moraes, from the Superior Federal Court, announced his vote in favor of Apple.

With the resumption of the trial on the case, with 3 votes in favor of Apple and 2 votes in favor of Gradiente, Moraes highlighted the relevance of the social role of a trademark and the principle of free competition, recognizing the North American company’s high investments in the trademark and its consequent notoriety in the market. In this sense, the justice understands that there is no constitutional prohibition on the “isolated use of a term that constitutes an element of a registered trademark, in view of its globally recognized association with a product manufactured by a competitor.”

To understand more about the context of this litigation, please click [here](#) to access the content produced by TozziniFreire on the topic.

Parish will pay copyright to the author of an anthem that became famous on masses

A catholic parish in Joinville and the diocesan chancery of the town will pay damages for pain and suffering to a composer because of the unauthorized use of his work. The composer authorized the use of the anthem created by him only one day in celebration of the parish, but he claims that his song started being played regularly and without his permission. The composer got fired after trying to negotiate the payment of copyrights.

The parish reiterated that the claim for admitting an employment relationship with the composer was denied and that his job as a composer was voluntary. Nevertheless, despite the defendant’s appeal, the judge recognized the unauthorized use of the composer’s intellectual work. The damages for it have not been determined yet. See the complete decision [here](#).

ISS not levied on exports of services in copyright licensing agreements

The judge of the 9th Tax Court of São Paulo Court of Justice granted a writ of mandamus to recognize that municipal services tax (ISS, in Portuguese) is not levied on amounts received due to copyright licensing agreements executed with foreign countries.

Considering that the purpose of the agreement was the license of artistic work and other creative elements specifically associated with the names and images entitled “Hello Kitty®”, and other characters, the payment of ISS by Sanrio do Brasil Comércio e Representações Ltda. was irregular. After all, the licensing of copyrights is not on the list of services attached to Complementary Law 116/2003, which lists services that, if provided, give rise to ISS taxable event.

STJ ruling on dismissal of res judicata on the collection of fees related to copyrights

The 4th Panel of the Superior Court of Justice (STJ) is once again judging whether the Brazilian Copyright Law would be able to dismiss the effects of a previous decision that prohibited the Central Office for Collection and Distribution (Ecad) from collecting fees related to copyrights on songs played by movie theater chain Cinemark.

In 2018, the 3rd Panel of the Superior Court of Justice partially granted the appeal filed by Ecad in its attempt to reverse the decision preventing the collection of fees on music played in movies shown at movie theaters. At the time, STJ only accepted the request to dismiss the decision against Ecad for malicious prosecution.

See the complete ruling [here](#).

03 IP Abroad.

Law firm Morgan & Morgan convinces USPTO to revive '#LAW' trademark bid

Morgan & Morgan announces the end of a lawsuit to register the #LAW trademark. The lawsuit was filed against United States Patent and Trademark Office's (USPTO) Trademark Trial and Appeal Board, which claimed that the #LAW trademark could not be registered because it was in public domain.

The law firm appealed, showing the amount invested in #LAW and how the trademark was associated with the company, which had spent years fighting for the registration. The PTO's Trademark Trial and Appeal Board admitted the existence of association between the trademark and the company. Now the USPTO will publish the trademark again, which may be challenged by third parties.

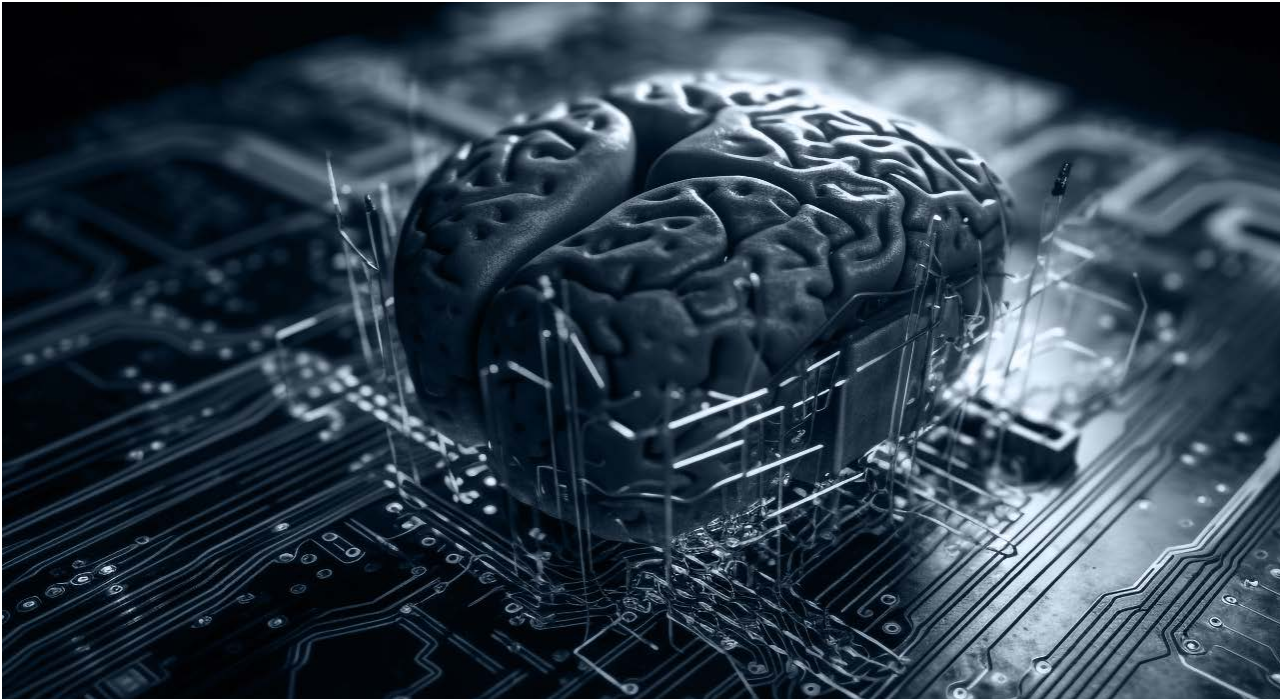
US Supreme Court spurns copyright fight over concert recordings

The US Supreme Court has refused to hear a proposal by major record labels such as Warner Music, Sony Music, among others, to hold the owner of Wolfgang's Vault directly liable for copyright infringement on recordings by bands such as the Rolling Stones and The Who, published by Wolfgang's Vault online.

Wolfgang's Vault is an American company dedicated to restoring and digitizing live recordings and selling music-related souvenirs. The company's website distributed unauthorized interpretations of songs by several artists well-known on the market. As a result, the US film and music industries supported the record companies' petition against Sagan, Wolfgang's creator. The 2nd Circuit, however, opposed the petition, since there was insufficient evidence that Sagan himself had pushed the button for distributing the content.

Motion Picture Association affirmed that the decision opens the door to avoidance of liability and to copyright infringement. Sagan, on the other hand, replied that there was, in fact, a failure in the record companies' legal reasoning.

The ruling was upheld, and Sagan will not be punished personally by his company.



Resumption of the trial on infringement of rights to “Impossible” trademark

Impossible X is an individual company that sells clothing and nutritional supplements, through its website and social media, and which claims that it has been using the trademark “Impossible” to identify its products and services since 2010. In 2020, the company filed an opposition with the USPTO and sent a notice to the company Impossible Foods, which manufactures plant-based meat substitutes, to desist from using the trademark “Impossible” in connection with “recipes and cooking information,” and asking the trademark to be used only to identify “plant-based food substitutes.”

In 2021, Impossible Foods filed a declaratory judgement action in California against Impossible X to obtain a declaration that it has rights related to the trademark “Impossible” and does not infringe Impossible X’s trademarks. At the time, the California District Court dismissed the case for lack of jurisdiction but, on September 12, 2023, Impossible Foods convinced the US Court of Appeals of the 9th Circuit to revive the trial of this case because this Court now has jurisdiction to do so.

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