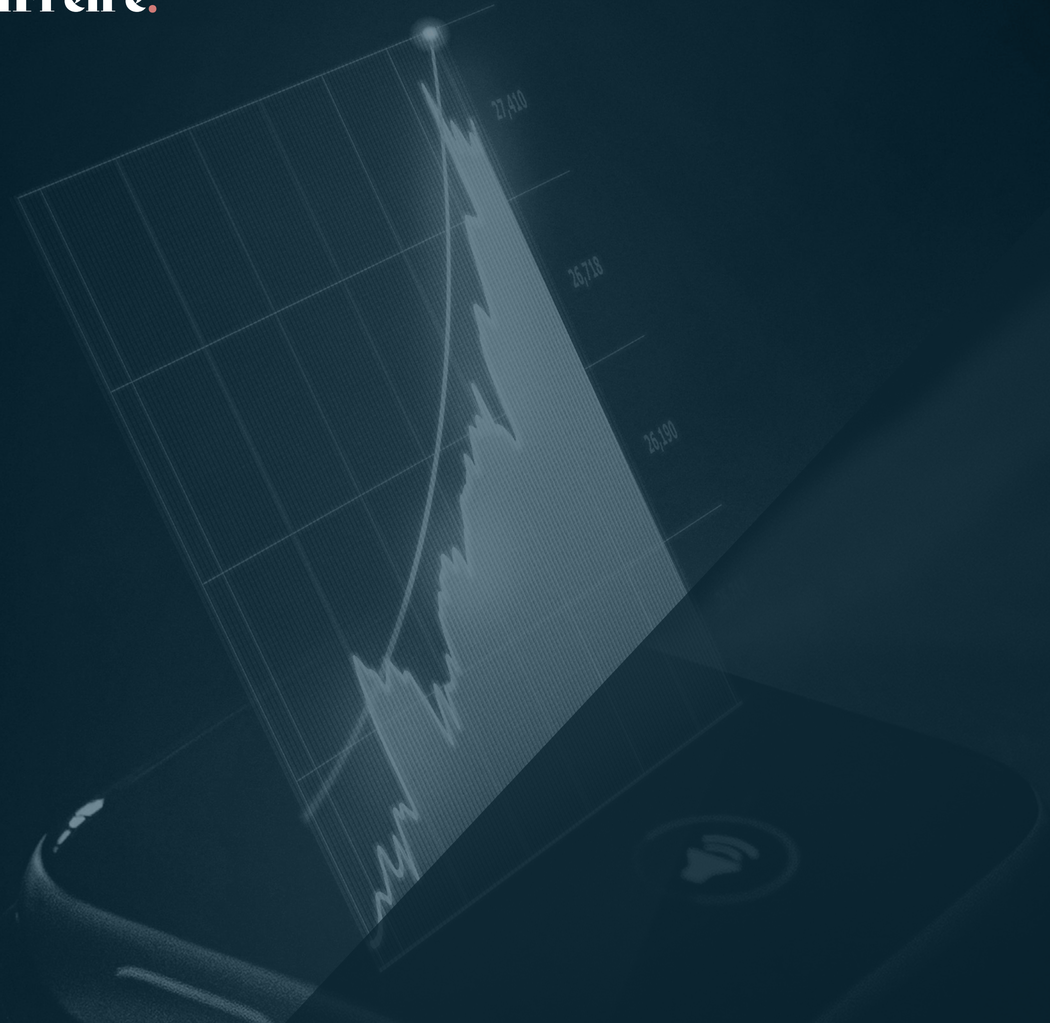

Intellectual Property

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

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BRAZILIAN REALITY

PIX receives protection as a highly renowned trademark in Brazil

PIX, an instant payment system developed by the Brazilian Central Bank, now benefits from enhanced trademark protection in Brazil after the Brazilian Patent and Trademark Office (BPTO) recognized its trademark as highly renowned. The Brazilian government announced the measure amid recent international discussions about the payment system and its growing relevance in the financial market.

Recognition as a highly renowned trademark is one of the broadest forms of protection afforded to trademarks under Brazilian law. Unlike ordinary protection, which is generally limited to the goods or services covered by registration, a trademark recognized as highly renowned receives special protection across all fields of activity. This type of protection seeks to prevent third parties from unduly taking advantage of a trademark reputation, prestige, or distinctiveness, even if they operate in different sectors.

The case shows how intellectual property assets can play a strategic role in protecting initiatives with broad economic and social impact. As PIX has become one of the country's major payment methods and gains increasing international visibility, the recognition of its trademark as highly renowned underscores the importance of trademark protection to preserve the identity, reputation, and distinctiveness of signs that have achieved great public recognition.

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COURT CASES

TJSP upholds prohibition of Érick Jacquin's restaurant from using trademark "Les Présidents"

The 2nd Reserved Chamber of Business Law of São Paulo State Court of Appeals (TJSP) denied the appeal filed by Président Restaurante (now Les Présidents), operated by chef Érick Jacquin. The Court upheld the prohibition against the use of trademark "Les Présidents" because it reproduces trademark "Président"—a line of butter and dairy products owned by the Lactalis group—and its visual identity.

The judge-rapporteur relied on the following grounds: (i) priority of Lactalis's trademark, registered with the BPTO since 1980; (ii) the restaurant's unlawful reproduction of the trademark and its visual identity; (iii) the parties' related business sectors, as both operate in the food industry and target the same consumer base; (iv) a market survey demonstrating actual confusion among consumers; (v) the BPTO's prior rejection of the restaurant's trademark applications due to conflict with Président trademark; and (vi) Jacquin's prior knowledge of the trademark, evidenced by his professional career in France and participation in MasterChef Brasil, a show in which "Président" products were advertised.

On these grounds, the Court upheld the finding of unfair competition and parasitic exploitation, awarded non-pecuniary damages, and ordered pecuniary damages to be calculated in liquidation proceedings. The decision reinforces the importance of monitoring trademark use in adjacent markets and maintaining a proactive trademark protection strategy.

Case No. 1165431-60.2023.8.26.0100

São Paulo court recognizes trade dress protection for acrylic handbags regardless of registration with BPTO

The 1st Business and Arbitration Disputes Court of São Paulo held a company liable for unfair competition after it reproduced acrylic handbags designed by Estilé. The judge held that protection of trade dress—the set of visual elements that make up a product's identity—does not depend on formal registration with the BPTO. The decision was grounded in the unfair competition provisions of Law No. 9,279/1996 (Brazilian Industrial Property Law) and in general principles of civil law.

The court relied on an expert report that confirmed the distinctiveness of one model and identified a risk of undue association among consumers. It ordered the defendant to pay BRL 25,000 in non-pecuniary damages and lost profits to be calculated in liquidation proceedings. The case also reinforces that time overlap in the reproduction of communication and marketing strategies can serve as evidence of deliberate copying of the overall trade dress, making causality less plausible.

Brazil does not have a single doctrine for protection of trade dress, since trade dress comprises several elements, such as trademark, colors, positioning of elements, among others, and some of these elements can be registered and others cannot. Therefore, this decision only reinforces the principle that Brazilian law protects trade dress without requiring registration with the BPTO. It also highlights that expert evidence is essential to identify sufficient distinctiveness and risk of confusion, although courts must assess these elements on a case-by-case basis.

Case No. 1120940-02.2022.8.26.0100

Court limits exclusivity on the term "Petit Gattone"

São Paulo Court, at first instance, rejected the claim for exclusive use of the expression "Petit Gattone," which is registered with the BPTO to identify a panettone with a flavor based on petit gâteau. Fant Alimentos brought the lawsuit against Marilan, holder of Casa Suíça trademark. The plaintiff alleged that using a similar expression on Marilan's panettone could confuse consumers and amount to unfair competition and parasitic use of the trademark.

In its defense, Marilan argued that different manufacturers use the expression to indicate panettone flavors, and that the products have distinct visual identities. The court found that "Petit Gattone" is evocative because it refers more directly to the product's flavor and characteristics than to its commercial identity. It therefore concluded that granting broad exclusivity over the term could restrict the use of expressions needed to identify similar products. The court also rejected the risk of confusion based on the differences between the parties' respective trademark sets.

The decision forms part of the broader discussion about the scope of protection afforded to evocative or low-distinctiveness trademarks. Although such marks may be registered, they tend to have a narrower scope of exclusivity.

The case reinforces that trademark registration does not, by itself, guarantee unrestricted exclusivity over elements related to a product's characteristics or attributes, particularly when the marks' overall presentation is sufficiently distinct to rule out any undue association among consumers.

São Paulo court suspends use of trademark “Frutaria São Paulo” for failure to meet quality standards

The 2nd Business and Arbitration Disputes Court of São Paulo ordered that stores belonging to the Focas corporate group, controlled by partner Eduardo Landim, suspend the use of trademark “Frutaria São Paulo.” The measure followed a breach of a contractual obligation requiring the exclusive sale of “Açaí Frutaria,” supplied by Frutaria Bebidas e Alimentos Ltda. The dispute between Landim and partner Cláudio Carotta has lasted nearly a decade. In an earlier ruling, the TJSP had already found that Carotta infringed the trademark and engaged in unfair competition, and ordered his exclusion from the partnership. That decision remains pending before Brazil’s Superior Court of Justice (STJ).

In the latest development, Carotta alleged that Focas-operated locations had undermined the trademark by replacing the contractually required açaí with a product from another brand. The court accepted the claim and concluded that the obligation to exclusively sell “Açaí Frutaria” had been breached. The product was described as having up to 80% more pulp and 70% less sugar than competing products. Focas responded that it had already resumed using Açaí Frutaria and appealed the decision. On another aspect of the dispute, the TJSP upheld the resolution suspending Carotta’s voting rights after finding indications that his conduct was inconsistent with the company’s corporate purpose.

The case reinforces the importance of complying with contractual obligations tied to trademark use, particularly for companies that share a trademark. The precedent also underscores the need to document and monitor compliance with agreed contractual conditions.

L'Occitane is ordered to pay damages for unauthorized use of Marisa Monte's song and image

L'Occitane Brazil was ordered by Rio de Janeiro State Court of Appeals (TJRJ) to pay BRL 100,000 in non-pecuniary damages, plus pecuniary damages to be calculated in liquidation proceedings. The lawsuit was brought by singer Marisa Monte and publisher Monte Songs Edições Musicais and concerns the posting, on the company's Instagram account, of a video featuring an excerpt from song "Pra Melhorar" and the artist's image without prior authorization. The lower court applied article 109 of Brazil's Copyright Law (Law No. 9,610/1998), under which compensation may reach up to 20 times the amount that would have been due if the use had been licensed.

On appeal to the 20th Chamber of Private Law of TJRJ, L'Occitane argues that it acted in good faith by sharing content originally posted by a third party and that it removed the post approximately 16 hours after receiving an extrajudicial notice. The company also argues that there was no direct commercial exploitation of the work or the artist's image. It seeks a reduction in non-pecuniary damages and dismissal of the pecuniary damages award, arguing that the awards are disproportionate in light of the specific circumstances.

Case: 0913004-71.2023.8.19.0001

IP ABROAD

Peloton ordered to pay USD 20.5 million to NEC for streaming patent infringement

A federal jury in the U.S. District Court for the District of Delaware ordered Peloton Interactive to pay USD 20.5 million to NEC Corporation, a Japanese company, for infringing a patent related to adaptive video streaming technology. The ruling found that Peloton's Bike and Tread equipment incorporated third-party video players that infringed the patented technology.

The lawsuit was filed in 2022 based on three patents, but only one reached trial. Peloton succeeded in invalidating one of them by means of administrative review and in obtaining summary judgment of non-infringement on another. It did not, however, successfully challenge the validity of the remaining patent before the jury.

The case illustrates the risk of incorporating widely used, off-the-shelf third-party components without a prior freedom-to-operate analysis. The infringement did not stem from Peloton's own technology, but from the integration of third-party video players into its equipment, underscoring that risk assessments must extend to all components embedded in a product, not only to proprietary technology.

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