



Industrial Property National Institute  
Marks Directorate

January 9, 2008

**Grounds for refusal of all types of marks, and technical and procedural aspects relating to the registration of certification and collective marks, submitted by Brazil**

Reference: SCT/20/4

**Grounds for refusal of all types of marks**

1. Brazilian Industrial Property Law (Law n.º 9279) provides for the following grounds for refusal of mark registration applications, under article 124:

- i. official, public, national, foreign or international escutcheons, coats of arms, medals, flags, emblems, badges and monuments, as well as the respective designations, figures, or imitations;
- ii. letters, numerals and dates, standing alone, except when rendered in a sufficiently distinctive form;
- iii. expressions, figures, drawings or any other signs that are contrary to morals and standards of respectability or that offend the honor or image of persons or attack against freedom of conscience, belief, religious cult or ideas and feelings worthy of respect and veneration;
- iv. designations or initials of public entities or agencies, when registration is not requested by the public entity or agency itself;
- v. reproductions or imitations of a characteristic or differentiating element of a title of an establishment or a name of a company belonging to third parties, likely to cause confusion or association with such distinctive signs;
- vi. signs of generic, necessary, common, ordinary or simply descriptive character, when related to the product or service to be distinguished, or those commonly employed to designate a characteristic of the product or service regarding its nature, nationality, weight, value, quality and time of production or rendering of the service, except when rendered in a sufficiently distinctive form;
- vii. signs or expressions employed only as a means of advertising;
- viii. colors and their names, except when arranged or combined in a peculiar and distinctive manner;
- ix. geographical indications, imitations thereof likely to cause confusion, or signs that may falsely induce a geographical indication;

- x. signs that induce a false indication regarding the origin, source, nature, quality or usefulness of the product or service to which the mark is applied;
- xi. reproductions or imitations of an official seal regularly used to guarantee a standard of any kind or nature;
- xii. reproductions or imitations of a sign that has been registered as a collective or certification mark by a third party, with due regard to the provisions of Article 154;<sup>1</sup>
- xiii. names, awards, or symbol of a sports, art, cultural, social, political, economic or technical event that is official or officially recognized, as well as an imitation likely to create confusion, unless authorized by the competent authority or entity that promotes the event;
- xiv. reproductions or imitations of titles, policies, coins and paper currency of the Union, the States, the Federal District, the Territories, the Municipalities, or of a country;
- xv. personal names or signatures thereof, family names and patronymics, or the image of third parties, except with the consent of the titleholder, his heirs or successors;
- xvi. well-known pseudonyms or nicknames, individual or collective artistic names, except with the consent of the titleholder, his heirs or successors;
- xvii. literary, artistic or scientific work, as well as the titles protected by copyright and likely to cause confusion or association, except with the consent of the author or titleholder;
- xviii. technical terms used in the industry, science and arts, that are related to the product or service to be distinguished;
- xix. reproductions or imitations, in whole or in part, even with an addition, of a mark registered by another party, to distinguish or certify an identical, similar, or alike product or service, likely to cause confusion or association with the other party's mark;
- xx. duality of marks of a single titleholder for the same product or service, except when, in the case of marks of the same nature, they are rendered in a sufficiently distinctive form;
- xxi. the necessary, common, or ordinary form of the product or packing, or also that one which cannot be dissociated from a technical effect;
- xxii. an object that is protected by a third party industrial design registration; and
- xxiii. signs that imitate or reproduce, wholly or in part, a mark which the applicant could not be unaware of because of his activity, and whose titleholder is headquartered or domiciled in national territory or in a country with which Brazil has an agreement or that assures reciprocity of treatment, if the mark is intended to distinguish an identical, similar or alike product or service likely to cause confusion or association with that other party's mark.

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1. Article 154 establishes that certification and collective marks that have been used and registered in Brazil, cannot be registered by third parties within the 5 years following the expiration of the respective registrations.

2. All aforementioned grounds for refusal can be argued at the opposition stage — which takes place before any substantive examination is undergone — and can then be applied by the examiner in his decision. Additional grounds for refusal can be argued by means of an opposition based on the protection of:

- a. Well-known marks not yet registered in Brazil — under article 6bis of the Paris Convention and article 126 of the Brazilian Industrial Property Law;
- b. Famous marks registered in Brazil — under article 125 of the Brazilian Law, regardless of the similarity of products and services or the risk of confusion; and
- c. Marks not yet registered but previously used in Brazil in good faith for at least 6 months prior to the opposed application's filing or priority date — under article 129, paragraph 1, of the Brazilian Law.

3. However, if no opposition is filed, the examiner only investigates the applicability of prohibitions i, ii, iii, vi, vii, viii, ix, x, xii, xviii, xix, xx and xxi, and will apply any of them in his decision.

4. As to prohibitions iv, xi, xiii, xiv, xv, xvi, xvii, these are applied *ex officio* as grounds for refusal insofar as the best of the examiner's knowledge can identify such cases. And in the cases of prohibitions which allow registration with consent of the respective titleholder, if such consent has not already been filed it is requested by the Institute prior to refusal.

5. Therefore, prohibitions v, xxii and xxiii are applied only when argued through opposition, for these require documented evidence that can only be supplied by the interested parties.

6. Examination further includes checking the appropriate declaration or submitted documented evidence that the products or services specified in the application are related to activities effectively and lawfully conducted by the applicant, under article 128, paragraph 1. Where noncompliance under this paragraph isn't clear, additional proof or explanations can be required by the Institute.

#### **Technical and procedural aspects relating to the registration of certification and collective marks**

7. Certification mark registrations can be applied for by any entity that has no direct commercial or industrial interest in the certification of the product or service specified. Such requirement is subject to examination and may establish grounds for refusal under article 128, paragraph 3.

8. Such applications must also be accompanied by the specifications to which the distinguished products or services must comply with and the measures of control to be employed by the applicant. The absence of these documents ensues the shelving of the application. While deficiencies in the provided documents may be subject to supplementation requirements made by the Institute.

9. Collective mark registrations can be applied for by entities that represent collectives. Such capability is subject to examination and can establish grounds for refusal under article 128, paragraph 2.

10. Such applications must also be accompanied by the regulations regarding the use of the collective mark. The absence of the said regulations ensues the shelving of the application, and any deficiency in the provided documents may be subject to supplementation requirements made by the Institute.

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