

Trademark Office Practice - Grounds for Refusal

The Brazilian Industrial Property Law (Law 9,279) states that any visually perceptible distinctive sign or combination of signs, when not prohibited by law, shall be registered as trademark. In Brazil, this definition excludes the registration of taste, smell and sound marks, even if they can be graphically represented (e.g. a musical score).

The Brazilian law establishes a set for grounds of refusal of signs not registrable as marks, such as those which are not distinctive, descriptive, generic, deceptive, lawful, as well as rights of third parties, signs contrary to public order and morality, intellectual property rights, personality rights and others legal prohibitions, which can be argued in the opposition stage or, in some cases, applied *ex officio*. The following is a list of grounds for refusal under the Brazilian Industrial Property Law, with specific examples of the office's practice.

Lack of distinctiveness, descriptiveness and genericness

Distinctiveness is the inherent capacity of a sign to differentiate goods and services offered by a producer or service provider from those similar goods and services offered by others. Thus, the lack of distinctiveness is a important ground for refusal.

The following grounds for refusal of Brazilian law forbid the registration of signs devoid of distinctive character and must be applied *ex officio* by the examiner:

The item VI of article 124 states that generic, necessary, common, ordinary or simply descriptive signs, when related to the product or service to be distinguished can not be registered as trademark. This includes signs that designate characteristics of the product or service, such as nature, nationality, quality, quantity and value.

Signs that *describe* the product or service to be distinguished can not be registered. This includes both words and graphic representations of products or services:

COFFEE MACHINE

Goods & Services: Electric home appliance, namely, electric coffee machines

“COFFEE MACHINE” indicates the product itself.
Refused under item VI of article 124.



Goods & Services: Fish (live)

The sign is a photographic reproduction of the product itself.
Refused under item VI of article 124.

The prohibition stated in the item VI includes signs that indicate the *quality, quantity or value* of products or services to be distinguished:

BEST FOOD

Goods & Services: Fruits and vegetables

The expression “BEST FOOD” denotes supposed superior quality of the products to be distinguished.

MAIS BARATO

Goods & Services: Meat, poultry and fruits

The expression “MAIS BARATO” (“cheaper”) indicates the value of the products to be distinguished.

PIZZA LIGHT

Goods & Services: Pizza, pasta, bread and cake

The word “PIZZA” indicates the product itself and the adjective “LIGHT” suggests that it contains a relatively small amount of fat.

Refused under item VI of article 124.

DIET COOKIE

Goods & Services: Cookies, cream cracker, bread, sandwiches and biscuits

The word “COOKIE” means the product itself and the adjective “DIET” suggests that it contains fewer calories or is sweetened with a non caloric sugar substitute.

Refused under item VI of article 124.

When the sign includes a non-distinctive element, the examiner may grant the mark with a disclaimer for that word or image. In the example below, although the name “Adriano” is a distinctive sign, the expression “restaurante italiano” (Italian restaurant) indicates both the kind of business establishment (“restaurant”) and the variety of food served (“Italian” food). In the other case, the examiner applied a disclaimer for the word “light” and for the descriptive expressions “0% gordura” (“0% fat”) and “60% menos calorias” (“60% less calories”).



Goods & Services: Restaurant

Disclaimer: No claim is made to the exclusive right to use “RESTAURANTE ITALIANO”



Goods & Services: Milk beverages

Disclaimer: No claim is made to the exclusive right to use “LIGHT”, “0% GORDURA” and “60% MENOS CALORIAS”.

The item VI of article 124 explicitly forbids the registration of signs that indicate the nationality of the products or services to be distinguished.

BALAS FRANCESAS

Goods & Services: Candies, chocolate, honey and ice cream

The expression “BALAS FRANCESAS” (“French candies”) describes the product itself and indicates its national origin.

POMADA E BÁLSAMO CHINÊS

Goods & Services: pharmaceutical preparations.

The expression “POMADA E BÁLSAMO CHINÊS” (“Chinese ointment and balm”) indicates the product itself and its nationality.

Some verbal elements, in spite of being not descriptive or necessary, have lost any ability to distinguish goods and services due to its frequent and generic usage, such as top-level domain endings :



Goods & Services: Gymnastic and sporting articles

Disclaimer: No claim is made to the exclusive right to use “.COM.BR”

The slight misspelling of a descriptive word or expression does not turn it into a distinctive mark. In the following example, although the word “banco” (“bank”) is misspelled as “banko”, it is phonetically identical to the original word. Consequently, it can not be registered.

BANKO

Goods & Services: Banking services, factoring

Refused under item VI of article 124.

Even if the descriptive word or expression is not widespread but used only in specialized terminologies, it can not be registered. The reproduction or imitation of technical terms used in the industry, science and arts, if related to the products or services to be distinguish, constitute a ground for refusal under the item XVIII of article 124. This applies, for example, to International Nonproprietary Names for Pharmaceutical Substances and zoological and botanical scientific names.

METFORMIN

Goods & Services: Anti-diabetic pharmaceutical preparations.

“METFORMIN” is an International Nonproprietary Name of a hypoglycemic agent used in treatment of diabetes mellitus.

Refused under item XVIII of article 124.

FUROSEMIDE

Goods & Services: Pharmaceutical preparations.

“FUROSEMIDE” is an International Nonproprietary Name of a diuretic agent used in treatment of renal insufficiency.

Refused under item XVIII of article 124.

According to item II of article 124, single letters, numerals or complete dates may not be registered. Exception is made when these terms are rendered in a sufficiently distinctive form. In these cases, the examiner may apply a disclaimer for the unregistrable elements.

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Goods & Services: Watches and chronometrical instruments

Refusal under item II of article 124

Goods & Services: Health insurance

Disclaimer: No claim is made to the exclusive right to use “SAÚDE” (“health”) and “13 SETEMBRO 1859” (“September 13th, 1859”)

Signs composed exclusively by colors and their names may not be registered according to item VIII of article 124. This prohibition is not applied if the color or its name is disposed in a peculiar and distinctive way. However, when the color describes a characteristic of the product to be distinguished, the sign will be refused under the item VI of article 124.

VERDE

Goods & Services: Preparations for destroying vermin, fungicides, herbicides.

“VERDE” (“green”) is the name of a color. Refused under the item VIII of article 124.



Goods & Services: Clothes, shoe and hats

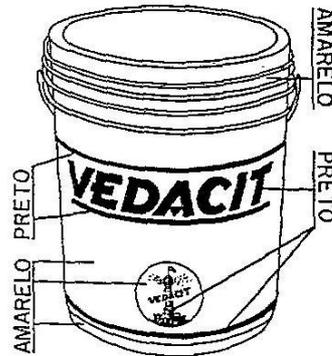
Disclaimer: No claim is made to the exclusive right to use “VERDE” (“green”) and “AZUL” (“blue”). The elements describe the colors of the products to be distinguished.

The item XXI of article 124 deals with the lack of distinctiveness of tridimensional marks. It clearly prohibits the registration of signs consisting exclusively of the necessary, common or ordinary form of the product or its packing and also signs that can not be dissociated from a technical effect or function. The following are examples of refusals based on this particular ground:



Goods & Services: Toothbrush, toothpick and dental floss

This sign is basically the shape of the product to be distinguished and can not be dissociated from the technical effect.



Goods & Services: Glue for industrial purposes, chemical compounds for curing concrete and artificial resins (unprocessed)

The sign consists exclusively of the common shape of packaging of the product to be distinguished.

Public order and morality

According to the item III of article 124, applications for registration may be refused if the trademark contains expressions, figures, drawings or any other sign contrary to morality and decency or which offend the person's honor or image or a person or which offend freedom of conscience, belief, religious cult or ideas and feelings worthy of respect and veneration.

The examiner must verify if the words, expressions, figures or drawings are, by themselves, contrary to morality and decency, independent of the goods or services they are associated to or if they assume this condition when associated to certain goods or services.

Examples of refusals under item III of article 124:



Goods & Services: clothes in general

SAINT PETER

Goods & Services: toilet paper

However, the trademark "Saint Peter" can be registered for other goods or services as candles or wines, for example.

Deceptiveness

The item X of article 124 states that signs that suggest a false designation of the origin, source, nature, quality or usefulness of the goods or service to which the mark is applied” can not be registered.

The examiner has to verify if the mark misdescribes the characteristics of the goods or services, and if the misdescription is capable of leading the consumers to believe in the false designation. Besides, the false designation can induce the decision of the consumer when purchasing goods or services.

Examples of refusals under item X of article 124:

SWISS CHOCOLATE QUALITY

Goods & Services: Chocolate

As the applicant is from Brazil, the chocolate can not be Swiss.

IN NATURA

Goods & Services: Pasta

No industrialized good can be natural.



Goods & Services: perfume, soap, shampoo

There is no good that is insuperable (“INSUPERÁVEL”).

CURATUDO

Goods & Services: herbs for medicine use

“CURATUDO”: cure for everything

There is no medicine that can cure every disease.

Protection of Official Symbols

The item I of article 124 states that crests, armorial bearings, medals, flags, emblems, official public distinctions and monuments, whether national, foreign or international, or any respective designations, figures or imitations can not be registered as a trademark.

If a trademark involves or encompasses any of the items above the application must be refused. That is an absolute prohibition against registration of a trademark.

Examples of refusals under item I of article 124:

Regarding to flags



The graphic sign reproduces the American flag

Regarding to monuments



The Christ Redeemer is a public monument, symbol of the city of Rio de Janeiro

The expression “CRISTO REDENTOR” means Christ Redeemer

If the sign is just an imitation of the official symbol or consists of the own name of the symbol it has to be denied. Nevertheless, if the drawing or its elements are sufficiently stylized and merely suggest an official symbol, the mark can be registered.

Protection of abbreviations and names of international intergovernmental organizations

The item IV of article 124 states that designations or acronyms of a public entity or organizations, where registration is not requested by that public entity or establishment” can not be registered as a trademark.

Examples of refusals under item IV of article 124:



Goods & Services: clothes

ONU (“UN”) is an international intergovernmental organization.

The expression “ONU MULTIMARCAS” means “UN Multimarks”.

It is necessary to evaluate if there is a possibility of association between the sign and the

abbreviation or name of the organization. If not, the rule is not applied.

Specially protected emblems and symbols

Besides flags, coat of arms, medals, emblems and other elements protected by the article 6^{ter} of the Paris Convention, Brazilian Industrial Property Law includes the protection of other official or officially recognized signs. For example, the reproduction or imitation of official seals normally adopted as a guarantee of standard for the product or service to be distinguished is a ground of refusal under the item XI of article 124.



Goods & Services: Meat

This sign is a reproduction of the seal of Brazilian Federal Inspection Service, used to certify compliance with Brazilian food sanitary standards.

Refusal under the item XI of article 124.



Goods & Services: Jewellery

The sign is a reproduction of a hallmark used to certify the purity of gold in France.

Refusal under the item XI of article 124.

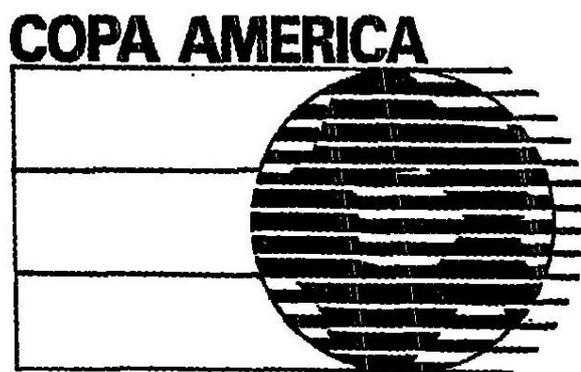
The item XIII of article 124 forbids the registration of reproductions or imitations of names, prizes or symbols of sporting, artistic, cultural, social, political, economical or technical events, official or officially recognized, except when authorized by the competent authority or entity promoting the event.



Goods & Services: Organization of sporting competitions, organization of exhibitions for cultural or entertainment purposes

The word "OLIMPIADAS" ("Olympics") is the name of a international event of summer and winter sports. Besides, the sign includes a stylized reproduction of the Olympic Symbol (five rings).

Refused under the item XIII of article 124.



Goods & Services: Telecommunications services, television broadcasting

"COPA AMÉRICA" ("America Cup") is a soccer championship promoted by South American Football Confederation.

Refused under the item XIII of article 124.

Finally, the reproduction or imitation of titles, bonds, coins and bank notes of the Union, the States, the Federal District, the Territories, the Municipalities or of any country constitutes a ground for refusal under the item XIV or article 124. This prohibition may only be applied if the title, bond, coin or bank note is still in circulation. However, this item does not forbid the registration of currency denominations (as long as they are distinctive enough).



Goods & Services: Life insurance underwriting

The sign reproduces a side of the € 1 coin.
Refused under the item XIV of article 124.

Goods & Services: Frying pans and non-electric kettles

In this case, the word “EURO” is eligible for registration because it does not describe the products themselves or any of their characteristics.

Geographical Indications

According to the item IX of article 124: geographical indications or imitations of such indications likely to cause mislead or signs that might wrongly suggest a geographical indication are not eligible to be registered as trademarks.

The examiner has to verify if the sign consists of an indication of source or an appellation of origin. That means that if the trademark contains a geographical indication, being it false or not, applied by someone that is established in that specific area or not, the trademark can not be registered.

Examples of refusals under item IX of article 124:

**CA' del SACRAMENTO
FRANCIACORTA**

Goods & Services: beverages

The expression above is a wine appellation of origin in Italy

VAL DEL VIÑEDOS

Goods & Services: sparkling wine

Consists of an imitation of the Brazilian geographical indication for wines “Vale dos Vinhedos”

However, if the sign consists of a geographical name constituted by a name of a location, city, region or country that does not induces an idea of false geographical indication, it can be registered as a trademark. Example:

PARIS

Goods & Services: ice cream

Registrable.

Prior trademark rights

The protection of prior trademark rights is a standard in all trademark systems, with slight differences among them. It is not different in Brazil, where the law provides a set of grounds for refusal based on trademark rights of third parties. The item XIX of article 124 forbids the registration of reproductions or imitations, in whole or in part, even with addition, of a mark registered by another party to distinguish or certify an identical or similar product or service. This item can be applied *ex officio* or through opposition proceedings.

When looking at a potential case of reproduction or imitation, the examiner must evaluate if the applying sign may cause confusion or association with third parties registered trademarks. The item XIX of article 124 must be applied if both signs are identical, or if they differ only in minor ways or are deceptively similar, being resemblant enough to cause confusion among consumers. The cases below show some refusals based on this ground:

Applying sign



Goods & Services: Marketing research, advertising agency, office machines and equipment rental

The sign is a reproduction of the distinctive sign “JMC” registered by a third party.

Refused under the item XIX of article 124.

Prior registration



Goods & Services: Advertising agency, publication of publicity texts, computerized file management, commercial and industrial management assistance

Applying sign



Goods & Services: Meat, poultry and eggs

The word "CRYSTAL" is phonetically identical to the trademark "CRISTAL" registered by a third party.

Refused under the item XIX of article 124.

Prior registration



Goods & Services: Spices, sauces and essences for foodstuff.

Applying sign



Goods & Services: Cleaning preparations, preparations for laundry use

The word "DOMINO" is a partial reproduction of the sign "SPUMA DOMINÓ", registered by a third party.

Refused under the item XIX of article 124.

Prior registration

SPUMA DOMINÓ

Goods & Services: Cleaning preparations

Applying sign

SHARK

Goods & Services: Fabrics for textile use

The word "SHARK" means "TUBARÃO" in Portuguese, so both signs have the same meaning

Refused under the item XIX of article 124.

Prior registration

TUBARÃO

Goods & Services: Fabrics for textile use, bed and table covers.

Applying sign



Goods & Services: Transport

In spite of the addition of the prefix “trans”, the word “TRANSMaeda” is confusingly similar to the trademark “MAEDA” registered by a third party.

Refused under the item XIX of article 124.

Prior registration



Goods & Services: Storage and transport services

There is a special exception to the item XIX of article 124. Signs that are identical or confusingly similar to prior trademarks may be registered if the owner of the previous mark consents to such registration. However, the examiner may ignore such consent if there is a risk of harmful confusion among consumers.

Well-known marks are given special protection under both the article 126 of the Brazilian Industrial Property Law and the article *6bis* of the Paris Convention, regardless of registration in Brazil. In most cases these grounds are argued through oppositions filed by third parties. The examiner must evaluate if the mark is well-known in Brazil based on the evidences brought by the opposition and if there is likelihood of confusion between both signs.

Applying sign



Goods & Services: Import-export agency

“KONICA” is the trademark of a well-known international manufacturer of photographic equipment and the applicant, as a import-export agency, could not be unaware of that fact.

Refused under the article *6bis* of the Paris Convention.

Well-known mark

KONICA

Goods & Services: Photographic equipment

Famous marks registered in Brazil are granted a broader protection. The article 125 of the Brazilian Industrial Law states that registered famous trademarks enjoy protection in all fields of activity, regardless of the similarity of products and services to be distinguished. A group of senior examiners will analyze these claims (argued by opposition or cancellation procedures) and will decide if to that trademark will be afforded this special level of protection.

Applying sign

GERAÇÃO COCA-COLA

Goods & Services: Entertainment services

Notwithstanding the addition of the word “GERAÇÃO” (“generation”), the expression above is confusingly similar to the famous trademark “COCA COLA”, registered by a third party. As stated under the article 125, this prohibition must be applied regardless of the similarity of products and services.

Refused under the article 125.

Famous mark



Famous trademark, recognized as such in September 21, 2006.

Finally, marks not yet registered but previously used in Brazil in good faith for at least 6 months prior to the filing or priority date of a similar trademark may constitute a ground for refusal under the article 129, paragraph 1st, of the Brazilian Industrial Property Law. This claim must be made through opposition and has to be supported by solid evidence.

Protection of industrial designs

The article 95 of the Brazilian industrial property law defines the industrial design as any ornamental plastic form of an object or any ornamental arrangement of lines and colors that may be applied to a product, that provides a new and original visual result in its external configuration, and that may serve as a type for industrial manufacture.

According to the item XXII of the article 124 objects that are protected by industrial design registrations in the name of third parties are not eligible to registration as trademarks. So, if the sign consists of an industrial design already registered by someone, regardless the applied goods or services, it can not be registered as a trademark, except if the applicant is the owner of the industrial design itself. Example of refusal under the item XXII of article 124:



Goods & Services: anyone

If a third part proves that owns the register of the industrial design the appliance for the trademark shall be refused

Copyright

The item XVII of article 124 states that literary, artistic or scientific works, as well as titles protected by copyright and likely to cause confusion or association, except with the consent of the author or owner, can not be registered as trademark.

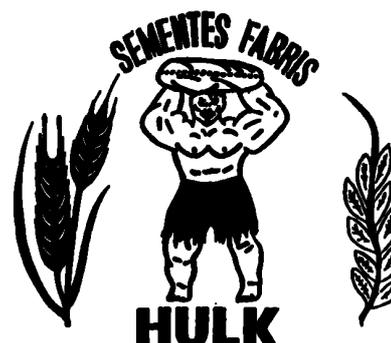
The copyright law establishes some rules to protect the intellectual creations, exempting the need of a previous register to guarantee the rights of the author of the creation. So, as the register of the copyright is optional, the examiner is not supposed to make a demand concerning to this. Nevertheless, the examiner can make a demand requiring the applicant evidences that he is the real owner of the copyright or an authorization of the owner shall be presented in order to allow the registration of the copyright as trademark.

Example of refusal under the item XVII of article 124:



Goods & Services: electronic equipment

The Hanna Barbera Productions is the copyright owner of “Scooby-Doo” and not the applicant of this requirement, as proved on an opposition procedure



Goods & Services: seeds, plants and flowers

The mark contains a drawing that imitates the character “The Incredible Hulk” that belongs to the Marvel Characters, INC

The expression “SEMENTES FABRIS HULK” means manufacturing seeds Hulk)

It should be noted that the name of characters are not protected through the item XVII, although the drawing of the character, as an artistic creation, is protected, associated or not to his name.

Personality rights

According to the item XV of article 124, personal names or signatures thereof, family names or patronymic and images of third parties, except with the consent of the owner, his heirs or his successors are not eligible to be registered as trademark. The examiner shall make a demand for the requirements of names, signatures or images of people (famous or not), except if the applicant is the holder of the personality right.

In the cases of requirements of family names or patronymic of famous people, the examiner shall make a demand to the applicant to present an authorization of the personality right owner to register that family name or patronymic as trademark.

If the owner of the personality right is dead, the examiner shall make a demand to the applicant to present an authorization of the heirs or legal successors, considering the established on the Brazilian civil law.

Examples

Name

JOSÉ GOMES MACHADO

Goods & Services: Accounting

A demand shall be made to present an authorization from the owner of the personality rights to register the name. If the applicant is the owner of the personality right to the name or if he presents an authorization, the trademark is granted. If not, existing an opposition required by the real owner of the personality right, the application shall be refused under the item XV of article 124. Besides, it is necessary to verify if there is any prior trademark rights involving the name.

Signature



Goods&Services: Accessories for vehicles

A demand shall be made to present an authorization from the owner of the personality rights to register the signature. If the applicant is the owner of the personality right to the signature or if he presents an authorization, the trademark is granted. If not, existing an opposition required by the real owner of the personality right, the application shall be refused under the item XV of article 124.

Furthermore, the item XVI of article 124 states that a trademark can not be registered if contains well-known pseudonyms or nicknames and singular or collective artistic names, except with the consent of the owner, his heirs or his successors.

In the cases that the applicant is not the owner of the personality right, the examiner must make a demand to present an authorization to register the pseudonym, nickname or artistic name as trademark (for any goods or services)

Famous name

GIORGIO ARMANI

Goods & Services: Clothes

A demand shall be made to present an authorization from the owner of the personality rights to register the famous name. If the applicant is the owner of the personality right to the famous name or if he presents an authorization, the trademark is granted. If not, existing an opposition required by the real owner of the personality right, the application shall be refused under the item XV of article 124. Besides, it is necessary to verify if there is any prior trademark rights involving the famous name.

Image of third parties



Goods&Services: Cosmetics

A demand shall be made to present an authorization from the owner of the personality rights to register the image. If the applicant presents an authorization, the trademark is granted. If not, existing an opposition filed by the owner of the personality right, the application shall be refused under the item XV of article 124.

Examples:

Well-known pseudonym



WOODY ALLEN
Pseudonym of Allan
Stewart Konigsberg

Well-known nickname



PELÉ
Nickname of the famous
Brazilian soccer player
Edson Arantes do
Nascimento

Artistic name



MADONNA
Artistic name of Madonna
Louise Veronica Ciccone