

## New Procedure for Securing Well-known Declaration in Brazil

Last August, Brazil's National Institute of Industrial Property (INPI) published Resolution No. 107/2013 which established new procedures for securing Well-known Declaration for marks in Brazil.

The new rules substantially changed and improved former rules for securing Well-known Declaration for Marks in Brazil. Recognition of the well-known status of a mark is provided for in Article 125 of the Brazilian Industrial Property Law (Law no. the 9,279/1996).

The resolution empowers the President of the Brazilian PTO to analyze and decide whether a registered mark has fame and reputation that goes beyond that of its original market segment. According to the law, a registered mark declared well-known in Brazil will have protection in relation to any goods and services, although there is no legal obligation to use the mark directly in relation to said goods and services. The declaration is dependent upon the mark's fame, reputation and its recognition by a significant number of consumers and the population in general.

Former interpretation of Article 125 of Law No. 9,279/96 led the experts of the Brazilian PTO to believe that such a declaration could only be obtained by the owner of the mark if and when the famous mark was cited as basis for an opposition or an administrative nullity action filed against third parties' marks. This interpretation was very restrictive and, in practical terms, only allowed a chance for a mark to be declared well-known if a conflicting mark was filed by third parties. This unfortunately caused problems for mark owners, as counterfeiters and pirates do not file marks.

Therefore, a new interpretation of the same provision (Article 125) was used to establish an autonomous administrative process by which owners of famous marks could request and obtain a declaration of their well-known status.

According to the new rules, owners of famous marks seeking to obtain a declaration of their well-known status may now file a request in this regard, so long as it is supported by substantial evidence of the fame and reputation of the mark, as well as the applicable official fees, which they themselves are very substantial.

According to the Brazilian PTO's new schedule of fees (published on February 07, 2014 and effective from March 09, 2014), the official fees for requesting a Well-known Status Declaration for a registered mark in Brazil are 37,575.00 REAIS (approximately USD 16,000.00).

Evidence that a registered mark is well-known in Brazil must meet the following requirements:

- Show the level of knowledge of the mark by a huge portion of the public in general, and not only consumers of the corresponding branded products or services;
- Show the higher standards of quality, reputation and prestige associated by the public to the mark and the corresponding branded goods and services; and
- Show the level of distinctiveness and exclusiveness of the mark.

It is recommended (by the provisions themselves) that evidence of fame and reputation of the mark is made by means of public polls, marketing and media materials, citations in the press and magazines, volume of sales and any other means of proof capable to evidence recognition of the mark in Brazil.

Requests for declaration of well-known status will be examined by a specific group of examiners directly appointed by the President of the Brazilian PTO. Once granted, the well-known declaration will be valid for a ten-year period. Renewals of the declaration after such term will not be automatic, which means that the owner of the mark will have to restart the process all over again by filing a new request supported by updated evidence of the fame and reputation of the mark.

The new resolution also provides relief for trademark owners which had already requested the well-known declaration within an opposition or administrative nullity action against third parties' marks and have not yet obtained a decision on their request. The resolution allows such trademark owners to request, within 90 days of the resolution entering into force, that the application for well-known status to be reviewed under the new proceedings and for the owner to pay substantially reduced official fees (of approximately USD 400.00). The deadline for applying for this change is May 9, 2014.

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