

**PTO refuses to recognise that BRAHMA and MASTERCARD are highly renowned**  
**Brazil - Guerra IP**

**Examination/opposition  
National procedures**

July 06 2015

On August 19 2013 the [Brazilian Patent and Trademark Office](#) (PTO) issued [Resolution No 107](#), which governs the examination of highly renowned trademarks.

One of the main points of Resolution No 107 is that a 'highly renowned mark' is defined as:

*“a registered mark whose performance in distinguishing goods or services and whose symbolic efficacy leads it to exceed its original goal, thereby going beyond the so-called principle of 'speciality', in view of its distinctiveness, of its recognition by a wide portion of the public, of the quality, reputation and prestige related to it, and of its flagrant capacity to attract consumers by its mere presence.”*

Following the issuance of the resolution, the PTO issued several decisions either recognising that a trademark was highly renowned or denying such recognition. Amongst these decisions, two of them, in which the PTO refused to recognise that the famous marks BRAHMA and MASTERCARD were highly renowned, stood out.

With regard to the trademark BRAHMA (for beer), the PTO mentioned in its opinion that, although [Ambev](#) (the owner) had submitted documents evidencing the marketing investments associated with the mark in traditional and electronic media (including social networks, cultural and sports events and packaging), such documents did not contain information relating to the profile and geographic range of consumers, the impact of the marketing campaigns on consumers or the effect that the mark had on consumers. The PTO further stated that certificates of registration of the mark BRAHMA, issued in all five continents, neither attested to the extensive recognition of the mark in Brazil, nor evidenced the prestige achieved by this mark among a wide and differentiated range of Brazilian consumers.

Another peculiar reason mentioned by the PTO was that Ambev had failed to submit a survey “or other elements” objectively attesting to the perception of quality, reputation and prestige of this mark among a wide range of Brazilian consumers (besides consumers of beer).

The second decision concerned [Mastercard International Incorporated's](#) request for the recognition of the highly renowned status of the composite mark depicted below:



The PTO rejected the request.

One of the reasons given by the PTO was that part of the evidence submitted by the trademark owner referred to the mark MASTERCARD generally, but did specifically refer to the composite mark which was the object of the request.

Interestingly, the PTO also pointed to failures in the surveys attached to Mastercard's request. For instance, according to the PTO's opinion, the surveys failed to indicate in which cities or regions they had been conducted, and the questions posed to the respondents were not indicated.

Moreover, the PTO stated that the other documents submitted by Mastercard - namely, brochures, advertising material, a list of trademark applications/registrations and certificates of registration issued in other jurisdictions - did not prove that the mark was known by a wide range of Brazilian consumers in general.

Finally, another issue raised by the PTO was that the word element of the mark was formed by the evocative term 'master' and the descriptive term 'card' and, therefore, the mark had a low degree of distinctiveness.

It is important to mention that, in addition to these two decisions, other cases relating to the recognition of highly renowned marks have shown that the PTO has been very strict when examining such requests. The PTO has demanded detailed evidence attesting that the mark is recognised by a wide portion of the

Brazilian public, and that it enjoys an image of quality and prestige in Brazil. In addition, in certain cases the PTO has analysed the degree of distinctiveness of the mark.

Discussions are currently underway in Brazil in order to try to improve the quality of such decisions and the examination of this type of request.

*Patrícia Lusoli, Guerra IP, Rio de Janeiro*

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