

World Trademark Review Daily

Superior Tribunal of Justice refuses to apply Article 6bis of Paris Convention
Brazil - Guerra Propriedade Industrial

Cancellation
International procedures
National procedures

October 23 2013

On August 13 2013 the Superior Tribunal of Justice issued an interesting decision in a special appeal filed by [James River Paper Company](#) against an unfavourable decision of the Second Federal Regional Tribunal, in a court action filed by James River against the [Brazilian Patent and Trademark Office \(PTO\)](#) and [Dixie Toga SA](#). James River sought try to reverse a PTO decision cancelling the registration on the composite mark DIXIE on the grounds of non-use.

The circumstances of the case are peculiar, as James River had previously been authorised by Dixie Toga to use and register the mark DIXIE in Brazil. After a few years, Dixie Toga filed an action for the cancellation of James River's registration on the grounds of non-use and the PTO cancelled the registration. Dixie Toga then filed applications for the same mark in its own name and obtained registrations.

The Superior Tribunal of Justice decided - following the decision of the Second Federal Regional Tribunal and, previously, of the first instance judge - that the court action was statute barred because it had been filed more than five years after the date of publication of the final PTO decision cancelling James River's registration on the grounds of non-use.

A few important issues were raised by the Superior Tribunal of Justice in its decision.

First, the tribunal stated that Article 6bis of the [Paris Convention](#), which James River relied on in its appeal, confers special protection to internationally well-known marks, by stating that member countries should prohibit the registration of well-known marks by third parties or cancel registrations obtained by third parties. The owner of the internationally well-known trademark has five years to request the cancellation of a registration obtained by a third party (Article 6bis, item 2), except in cases of bad faith where the cancellation of the registration can be requested at any time (Article 6bis, item 3).

However, the tribunal went to state that the [Brazilian Industrial Property Law](#) (under which the term for filing a cancellation action is five years from the date of the grant of the registration) does not expressly refer to the cancellation of a registration obtained in bad faith, as is foreseen by Article 6bis, item 3, of the Paris Convention. The tribunal mentioned that there is a legal doctrine defending the position that Article 6bis, item 3, is not applicable in the country.

Second, the tribunal also stated that, regardless of whether the mark DIXIE is internationally well-known, the purpose of the court action filed by James River was to reverse the PTO decision cancelling the registration on the mark on the grounds of non-use. Therefore, the court action did not seek to obtain the cancellation of an internationally well-known trademark allegedly obtained by a third party - Dixie Toga - in bad faith.

The tribunal noted that James River could have argued that Dixie Toga's registration for the mark DIXIE was obtained in bad faith, but stressed that this argument was not the object of the court action. The decision made it clear that Article 6bis, items 2 and 3 of the Paris Convention do not refer to the reversal of the administrative act cancelling a trademark registration on the grounds of non-use. Therefore, these provisions were not applicable in this case.

Finally, the tribunal stated that, even if Article 6bis, item 3 of the Paris Convention was applicable to cases where the third party's bad faith lies in the lack of use of the mark, instead of in its use, the argument that the cancellation of a trademark registration obtained in bad faith can be requested at any time was not convincing, because the Industrial Property Law provides a term of five years to request the cancellation of a trademark registration.

The decision of the Superior Tribunal of Justice is interesting in view of the reasons which led the tribunal not to apply Article 6bis of the Paris Convention in this case.

Patricia Lusoli, Guerra Propriedade Industrial, Rio de Janeiro

World Trademark Review *Daily*

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.