

## Question Q181

### Conditions for registration and scope of protection of non-conventional trademarks

#### V. Questions:

Groups are invited to answer the following questions under their national laws.

1. How is the scope of what constitutes a registrable trademark defined? Does that definition list specific examples of permissible types of trademark?

Article 122 of the Brazilian Industrial Property Law (LPI No. 9.279/96) foresees that all distinctive visible signs that are not comprehended on the legal prohibitions can be registered as a trademark. Article 124 of the LPI establishes what is not registrable as a trademark. Therefore, everything that is visible and is not comprehended in the prohibitions of Article 124 is registrable as a trademark.

**2. *What categories of signs are capable of registration as a trademark? Are any categories of signs excluded from registrability as a trademark?***

Only the visible signs are capable of registration as a trademark, as foreseen on Article 122 of the LPI, therefore all other signs are excluded from registrability as a trademark.

**3. *Where applications to register a colour per se or a combination of colours per se may be accepted for registration:***

In Brazil applications to register a colour *per se* or a combination of colours *per se* are not accepted for registration. Article 124 of the LPI foresees that colours or their names are not registrable as a trademark, except if disposed or combined in a peculiar and distinctive manner. Therefore, the only way to register a colour or a combination of colours is not *per se* and only if, when applied in relation to goods, it is identifiable as a logo or drawing. The colours cannot be claimed to specify the outline, contours or proportions in which, or the shape or object to which, the colour is to be applied.

**3.1 *in relation to goods, is such an application acceptable if it does not specify the outline, contours or proportions in which, or the shape or object to which, the colour is to be applied;***

**3.2 is such an application registrable in relation to services and, if so, under what conditions;**

**3.3 is an applicant required to file a sample of the colour(s) applied for and/or a colorimetric reference or other colour code;**

**3.4 can the mark be considered inherently distinctive in relation to certain goods or services;**

**3.5 will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown;**

**3.6 are certain colours denied registration on the basis that there is a need to keep them free for general use; and**

**3.7 to what extent do other visual aspects of the way the mark is used affect the assessment of the distinctiveness of the mark?**

**4. Where applications to register three-dimensional signs may be accepted for registration:**

The applications to register three-dimensional signs were only accepted for registration as from May 15, 1997, when the new trademark law (LPI) entered into force. Since this is a new provision in the Brazilian legislation there is no case law yet to enable us to define with certainty the scope of protection of such signs.

**4.1 what form of representation of the three-dimensional sign is accepted as part of the application for registration;**

According to the Brazilian Patent and Trademark Office (INPI) Normative Act No. 154/99, that establishes the Users Manual, the three-dimensional sign has to be presented in the application for registration with a brief description of its essential characteristics, with the presentation of the device of the sign in frontal, lateral, superior, inferior views and in perspective, if it is the case.

**4.2 what are the criteria for assessing whether the three-dimensional sign can be considered capable of distinguishing the goods or services of one undertaking from those of another;**

The criteria are the same as for any other trademark. It has to fulfil its primary function as a trademark, that is to identify the origin or source of the goods or services in respect of which it is registered.

**4.3 what are the criteria for assessing whether the three-dimensional sign can be considered inherently distinctive in relation to certain goods or services;**

The only prohibition provided for in the Brazilian legislation is the one foreseen on paragraph XXI of Article 124, of the LPI, that establishes that the necessary, common or usual shape of

a product or packaging, or also, shapes that cannot be dissociated from a technical effect, are not registrable as a trademark.

***4.4 will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown;***

In Brazil there is no absolute need to prove the distinctiveness acquired through use, it means that in Brazil we do not require a secondary meaning to register three-dimensional signs and such signs are examined under the same conditions as two-dimensional signs. The duration and extension of the use of all trademarks is an element to be taken into account at the moment of deciding whether they may or may not be registered in accordance with Article 6 *quinquies*, C, 1 of the Paris Convention that is fully enforceable in Brazil.

***4.5 are certain shapes denied registration on the basis that there is a need to keep them free for general use;***

Only the ones foreseen on paragraph XXI of Article 124 of the LPI, as mentioned on question 4.3 above.

***4.6 to what extent do other visual aspects of the way the mark is used affect the assessment of the distinctiveness of the mark; and***

The assessment of the distinctiveness of the mark is affected to the extent that the lines of the feature have to be far from its function or the common lines of the goods in respect of which it is registered. It does not matter if the three-dimensional mark is used in conjunction with additional, distinctive material such as a product name or house mark. The Brazilian Patent and Trademark Office (INPI) accepts the application for registration of a three-dimensional mark even though it will be used in connection with this other visual material.

***4.7 to what extent do technical or functional considerations prevent registration?***

As mentioned on item 4.3 above, paragraph XXI of Article 124 of the LPI establishes that the necessary, common or usual shape of a product or packaging, or also, shapes that cannot be dissociated from a technical effect, are not registrable as a trademark.

***5. Where applications to register smells may be accepted for registration:***

In Brazil applications to register smells are not accepted for registration.

**5.1 what form of representation or description of the smell is accepted as part of the application for registration;**

**5.2 how is the capacity of the smell to function as a trademark and/or its distinctiveness assessed; and**

**5.3 how is the mark made available to the public on publication of the trademark application and thereafter?**

**6. Where applications to register a sound mark may be accepted for registration:**

In Brazil applications to register sounds are not accepted for registration. The only way to register a sound mark in Brazil is through an onomatopoeic or other description of the sound in words. That way it would be visually perceptible as established on Article 122 of the LPI. It must be mentioned that it remains an important issue before the Brazilian Patent and Trademark Office (INPI) the question of prove of use of an onomatopoeic mark. Since it is a description of the sound, it seems that the INPI understanding is that the only way to prove use is by using it in the written form and not as a sound, a solution that is not considered to be the ideal one, but in accordance with INPI the only possible solution in accordance with the current law.

**6.1 what form of graphical representation of the mark applied for is required as part of the application for registration;**

**6.2 can audio recordings of a sound mark be filed as part of the application for registration; and**

**6.3 if such audio recordings are filed as part of the application for registration, how are these recordings made available to the public on publication of the trademark application and thereafter?**

**7. Where applications to register moving images or holograms may be accepted for registration:**

Although it is not expressly provided for in the LPI nor in INPI's regulations it seems that moving images may be accepted for registration since they are visually perceptible as foreseen on the Brazilian Legislation.

**7.1 what form of representation of the moving image or hologram is accepted as part of the application for registration; and**

Since this signs are not foreseen in the Brazilian Legislation, and there is no case law indicating how to proceed in these cases, it seems that the way to present the application for

registration of a moving image or hologram is in an image-by-image bases, as in Copyright Law.

**7.2 how is the moving image or hologram made available to the public on publication of the trademark application and thereafter?**

Until now, there are no cases of applications to register moving images or holograms. Since it is not provided for in the LPI or the INPI's Users Manual the Group cannot inform how the moving image or hologram would be made available to the public on publication of the trademark application and thereafter. Notwithstanding, the Group understands that if the applicant applied for the registration showing it in an image-by-image bases, all the images should be published, but it must be examined the best way to publish it in each case.

**8. How is the scope of protection of "non-conventional" trademarks assessed? In particular, are registrations for "non-conventional" trademarks treated any differently than registrations for "traditional" forms of trademark either in substantive or procedural terms?**

The scope of protection of non-conventional trademarks is assessed the same way as in any other trademark.

**9. To what extent is assessment of the registrability of "non-conventional" trademarks influenced by issues relating to enforcement and the scope of protection which should be afforded to those marks?**

It must be analysed if there will be risk of confusion or association between that non-conventional trademark and any other trademark. The *de facto* circumstances must be taking into consideration.

**10. To what extent is the assessment of the registrability of "non-conventional" trademarks influenced by the fact that there may be a limited number of certain "non-conventional" marks (such as colours or shapes) available for general use?**

In Brazil, the colour *per se* or a combination of colours *per se* and the necessary, common or usual shape of a product or packaging, or also, shapes that cannot be dissociated from a technical effect, will not be registered as per absolute prohibitions in Brazilian law and it is irrelevant whether they have acquired secondary meaning.

**11. To what extent is the assessment of the registrability of "non-conventional" trademarks influenced by the fact that consumers may be less used to understanding "non-conventional" marks as an indicator of origin?**

The Group understands that it is the duty of the businesspersons, the owner of the trademarks, to educate the consumers so that they recognise such non-conventional trademarks as an indicator of origin. That way those trademarks will not lose their distinctiveness and become synonyms or common features of the products.

**As well as stating the laws of their respective countries on the above-listed questions, Groups are invited to make any proposals for harmonisation of national laws which they consider desirable and to offer any further comments or observations of interest.**