

Brazil  
in English

Report Q. 191  
by the Brazilian Group

Relationship between trademarks and geographical indications

Questions

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

**I) Analysis of current legislation and case law**

- 1) Do your country's laws have enactments or systems dealing specifically with GIs, e.g. a registration system for GIs? If so, what are the criteria of registrability? To which national authority must an application for protection be made? Does the applicant have the right to appeal against the refusal of the national authority to register a GI? If so, to which entity?**

Yes, Brazil does have a specific registration system for GI's, in accordance with chapter XI, title IV, of the Brazilian Industrial Property Law in force, Law n. 9.279/96, sections 176 to 182 (please refer to the WIPO Collection of laws for electronic access at [http://www.wipo.int/clea/docs\\_new/en/br/br003en.html](http://www.wipo.int/clea/docs_new/en/br/br003en.html)).

There are two main institutions foreseen in the statute. The first, "indication of source" (in Portuguese, "*indicação de procedência*") requires the presentation of elements that prove that a geographical name has become known as a center of extraction, production or manufacture of the good; the presentation of evidence concerning a control system over the producers who are legitimated to use the referred "indication of source", as well as over the products distinguished by them; the presentation of elements that prove that the producers are established in the delimited geographical area and are, effectively, producing the good.

A second kind of GI "*denomination of origin*" ("*denominação de origem*" in Portuguese) requires, in addition to the two conditions mentioned above, the description of the quality and characteristics of which are due exclusively or essentially by geographical environment, including natural and human factors.

An application for protection of a GI has to be filed before the Brazilian Patent and Trademark Office, INPI, if an application is refused, the applicant may appeal against this decision, addressing a reconsideration request to the President of the INPI.

- 2) What is the status of a GI in your country? Does the registration of a GI confer a property right? Who would be the rightholder of a GI? Can GIs be the subject of dealings such as assignment, mortgage and licensing?**

In Brazil, the register of a GI does not confer a strict sense property right, but it may be considered a collective good (being important to stress that the Brazilian law does recognize the existence of collective marks). The difference between a collective mark and a GI derives from the recognition of quality arisen from the production originated from that geographic region, previously to and independently from any formal and official GI recognition.

The rightholders of the GI are the producers from that delimited geographic area, who produce the goods designated by the GI in a homogeneous way and should be affiliated to an organization that controls the production compliance. Such organization may represent the producers and act as the GI rightholder. Exceptionally, if there is only one producer legitimated to use the geographical name, he is authorized to require the register of the GI in his own name.

As the right to use a GI has a strong public component, it is likely that it may not be subject of a dealing such as assignments and mortgages, as it could interfere in the use of that name by the collective.

Concerning licensing, the Brazilian group understands that there is a public policy component in the GI that forbids the licensing of a GI to related goods. However there is no case law in Brazil to support its understanding.

**3) Is the application for or registration of a GI made public in your country? Is it possible to oppose such application or registration or cancel such registration of a GI? If so, by whom and on what (absolute or relative) grounds (e.g. generic or descriptive term or prior trademark)?**

Yes, the application for or a registration of a GI is made public in Brazil. The application is published in the Brazilian Industrial Property Official Gazette so third parties may oppose it. Any person may oppose a GI application, and argue that it has become a generic term, or it is descriptive of a product or service, or even the existence of a prior trademark may be considered a valid ground for an opposition. However there is also no relevant case law on this subject.

**4) Must use requirements be satisfied in order to maintain GI protection? If so, is there any definition of what constitutes use? Are the legal rules established for appraising the maintenance of a trademark registration applicable to the appraising of the maintenance of GI protection?**

According to INPI Resolution n. 75/2000, section 7, paragraphs 1, "c" and 2, "d", the applicant of a GI must present elements that prove that the producers are established in the delimited geographical area and are, effectively, producing the good. Based on such requirement it is possible to consider that "use" is somehow equivalent to "effective production" of the good.

The legal rules established for appraising the maintenance of a trademark registration are not directly applicable to the appraising of the maintenance of GI protection.

Under the opinion of the Brazilian Group, based on the collective and public nature of the GI, the consideration of use of a GI must be more relevant than the use of a trademark.

- 5) What is the scope of protection of a GI? Is it only protected against use of the name or also against use of elements of the specification of the GI (e.g. slicing, grating) or any other practice liable to mislead the public as to the origin of the product (e.g. use of same trade dress)? Are the legal rules established for determining the scope of trademark protection applicable to determining the scope of GI protection (e.g. in relation to reputed or well-known GIs, likelihood of confusion, infringing and non-infringing acts)? May rights in a GI be enforced even where a product which allegedly infringes those rights has been made purely for export?**

The scope of protection of a GI in Brazil is heavily based on the unfair competition rules and, therefore, similar to the trademark protection, aiming the protection of producers and consumers, avoiding confusion concerning false and unfair indication of source or denomination of origin.

Brazilian Law does not provide guidance for specific use of elements of the GI, as well as does not provide a guideline for the differentiation between the scope of trademark and GI.

There is a decision from the Brazilian Superior Court of Justice (infra constitutional Court) that establishes, *in dicta*, that the production of a good made purely for export does not infringe the local trademarks (the reasoning of the decision is based on the argument that competition and/or consumer relation must be inferred in the final jurisdiction and market). However, there is no case law considering this argument *per se* or in a GI case.

- 6) Can a GI be registered as individual trademark? If so, under what conditions?**

It is important to differentiate protected GI from GI that was not officially recognized as such by the Brazilian INPI. In the case of a protected GI, it is possible that the GI may not be registered as a trademark as it could be considered barred under section 124, IX of the Brazilian Industrial Property Law.

Even though some scholars and practitioners argue that a GI shall not be registered, a GI may be registered as individual trademark since the owner is the collective entity legally able to apply for the GI itself.

- 7) Do your country's laws provide for collective or certification marks? If so, under what conditions can a GI be registered as a collective mark or a certification mark?**

Brazilian law provides for collective and certification marks. As the applicant of a certification mark must not have direct commercial or industrial interests on the

product or service designated by the mark, a GI may never be suitable for a certification mark registration.

A collective mark may be considered for the registration of a GI, under the circumstances and conditions specified in question 6, above, and also considering that the organization owner of such hypothetical collective trademark registration linked to a GI must comply with the geographic boundaries (as a collective mark, per se, is not bound to any geographic area).

**8) Does inclusion of a protected GI as part of a trademark qualify as legal bar to the registration of such trademark?**

Even though there are opinions against such possibility, if a trademark is not misleading about its real source or origin, may be registered with the inclusion of a GI as a part of it.

**9) Do your country's laws, e.g. trade or merchandise legislation, require the application of correct designations of origin / source on agricultural products and food-stuffs?**

At the same time that producers are not obliged to indicate the source/origin of their products, they are prohibited to apply any signal on the product that may induce false indication of its source/origin, even if the false indication does not have relation with a protected GI.

**10) How are conflicts between trademarks and GIs resolved under your country's laws? Do they co-exist or does either the trademark or GI prevail? Is there a rule for determining whether the trademark or GI should prevail, and what are the criteria to take into account (e.g. the "first in time, first in right"-rule, the reputation of the geographic region or the reputation of the trademark, the length of time that the name has been used to indicate the geographic region and the extent of such usage, the length of time that the trademark has been used and the extent of such usage)?**

In Brazil, the general rule to resolve conflicts related to Industrial Property is the "first in time, first in right". Thus, if there is conflict between a GI and a pre existent trademark, the trademark may prevail.

However, if a geographical name has become notorious as an indication of source or appellation of origin, before the filing of it as a trademark application by someone, the register of the geographical name as a GI shall prevail, even if it has not happened yet and the trademark application has been already filed.

## **II) Proposals for adoption of uniform rules**

The Groups are invited to put forward any proposals for adoption of uniform rules regarding the relationship between trademarks and GIs. More specifically, the Groups are invited to respond to the following questions:

- 11) Should countries provide for registration systems dealing specifically with GIs? If so, what should the key features of such system be? Should a multilateral system of registration of GIs be established? If so, what should the key features of such multilateral system be? Specifically, which international body should be tasked with establishing such system? How should the application for or registration of a GI be notified / made public (either in your country or at a multilateral level) in order to avoid that a trademark may conflict with a GI previously unknown to the trademark owner?**

The Brazilian group believes that the adoption of a multilateral system is positive. Every State should have a specific registration system for GIs and, in addition, the local offices should be connected to a multilateral organization, responsible for centralizing the information concerning the existing GIs. This organization shall have the limited function of providing information concerning existing GIs, and the World Trade Organization could be considered as the organization in charge of this task.

- 12) *Do you have any suggestions as to the acquisition, maintenance, scope and enforcement of GI protection? What should the scope of protection of a GI be? Should the legal rules established for appraising the acquisition, maintenance, scope and enforcement of trademark protection apply to the appraising of the acquisition, maintenance, scope and enforcement of GI protection?***

The main difference between trademarks and GIs concerns the increased public characteristics of the GI (as the *de facto* previously distinctiveness of the GI sign), thereafter it is unlikely that the legal rules should be the same. The rules considering acquisition and maintenance must be much more strict and demanding for the official recognition of a GI than a trademark. Based on such fact, as well as the public interest and public characteristics, scope of a GI protection and its enforcement must be higher.

- 13) Should a protection of GIs by individual and / or collective or certification marks be possible?**

Yes, since they are owned by a legitimate representative of the persons involved in the GI, and the geographic characteristics are preserved whenever a denomination of origin is concerned.

- 14) How should conflicts between trademarks and GIs be resolved? Please propose a specific rule for determining whether trademark or GI should prevail, which is likely to be broadly accepted. If co-existence is contemplated, should such co-existence be limited to the country of origin or relate to the relevant markets?**

Conflicts between trademarks and GIs, shall be reasonable solved by the adoption of the “first in time, first in right” criterion, with the exceptions of a notorious GI.