

COMMENTS OF THE BRAZILIAN GROUP ABOUT THE SUMMARY REPORT Q 155 (Final Version)

1. In the 2nd paragraph, trade name is defined as follows:

“By trade name, the AIPPI understands a sign which distinguishes any enterprise engaged in the manufacture or sale of products, or in providing services and may include surnames, fanciful denominations, designations of business activities, a characteristic component, an abbreviation of the trade name, a symbol or any other identifying sign of the enterprise”.

However, the words “a symbol or any other identifying sign of the enterprise” might lead to the wrong impression that devices are also encompassed by the definition. This would give rise to a confusion with the concept of device trademarks. Thus, the Brazilian Group suggests the following definition:

“By trade name, the AIPPI understands a sign which distinguishes any enterprise engaged in the manufacture or sale of products, or in providing services and may include surnames, fanciful denominations, designations of business activities, a characteristic component or an abbreviation of the trade name”.

2. The 35th paragraph states the following:

“However, when company names need to be recorded in a special Register of companies, it is not possible to object the adoption of a specific company name on the grounds of earlier trade mark rights”.

The text deals with the conflict of trade names and trade marks, suggesting that an earlier trade mark right is not a valid ground for objection. However, this comment should actually only apply when referring to proceedings before the Register of Companies. Before the courts, claims based on earlier trade mark rights are generally accepted. This matter has been extensively addressed by Brazilian courts and the prevailing view is that under certain circumstances a senior trade mark right serves as valid grounds for a claim of cessation of a conflicting company name. Thus, the Brazilian Group suggests the following text:

“However, when company names need to be recorded in a special Register of companies, it is not possible, at least before the Register of companies, to object the adoption of a specific company name on the grounds of earlier trade mark rights”.

3. The 36th paragraph reports that “according to all the Group Reports, it is not possible to object the use of a company or trade name on the ground of an earlier trade mark application”.

However, we do not believe that this is a unanimous view. The Brazilian report has stated that such issue is controversial, because there are some Courts in Brazil who accept conflicts between trade marks and trade names based on an earlier trade mark application. The unfair competition rules are the grounds of such case law. Thus, we suggest the following text:

“According to the majority of the Group Reports, it is not possible to object the use of a company or trade name on the ground of an earlier trade mark application. To do so the earlier trade mark has to be registered. The German report points out that this possibility derives from the 1st European Trade Mark Harmonisation Directive and from article 16.1 of TRIPS. The exception is Brazil, where some Courts, based on unfair competition rules, accept an earlier trade mark application as a valid ground of objection”.

4. In the 45th paragraph, the Venezuelan position seems to have been indicated as an isolated one. Such citation is in contrast with the 44th paragraph, where the British position was invoked as a general feeling, evidenced by the expression “some countries, like the United Kingdom”. The opinion given by the Brazilian Group is the same expressed by Venezuela. Thus, to endorse what appears to be an isolated position, we suggest the following text:

“In Venezuela and Brazil, a person is authorised to use his/her family name as a company name, if additional elements to differentiate it from earlier rights (company/business names or trade marks) are added, by the use, for example, of his/her full name”.

5. In the 50th paragraph, the draft reports that “ in general there is no possibility of opposition proceedings against the registration of company/business names”. The Brazilian report, however, has indicated that such opposition proceedings are available. Thus, to express clearly such contrast, we suggest the following text:

“In general there is no possibility of opposition proceedings against the registration of company/business names. One exception is Brazil, where such proceedings are provided by law (specially regarding identical trade names), without preventing the direct access to Justice. The remedy that is generally available is to start infringement proceedings...”.

6. In the 57th paragraph, we suggest that the second “when” be substituted by “that”, as follows:

“it is only when a specific company starts to use the company name in a specific field of activity that the real conflicts arise”.

7. In the 90th paragraph, we suggest the inclusion of the expression “in conflict”, as follows:

“A mechanism should be provided for invalidating or cancelling the registration of a trade mark, company name, business name or domain name in conflict with an earlier right after registration”.

END