




**Legal Framework**

- Federal Constitution
- International Treaties:
 - Industrial Property:
 - Paris Convention
 - Trips
 - PCT
 - Upov 1978 - PVP
 - Copyright:
 - Bern Convention
 - Universal Convention

**Industrial Property**

- Law 9,279 May 14, 1996
 - Patents
 - Industrial Designs
 - Trademarks
 - Transfer of Technology
 - Franchising & Licenses
 - Geographical Indications
 - Infringements and Enforcement
 - Unfair competition

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Copyright

- Law 9,609 1998
 - Software Protection under Copyright
 - Registration at Patent and Trademark Office - INPI
- Law 9,610 Feb. 19, 1998
 - Rights of authorship and neighboring rights
 - Moral rights and economic rights

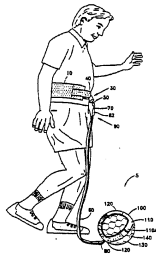
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Patentability Requirements

- Novelty
 - subject matter of unpublished Brazilian applications is considered only for novelty analysis
- Inventive Activity
- Industrial Applicability
- Sufficiency

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Exemplo prático da inventividade humana

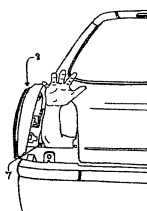


(21) PI 9910254-4 (22) 06/05/1999
(30) 06/05/1998 US 06/073,903
(51) A63B 36/00; A63B 69/00
(54) APARELHO PARA O TREINAMENTO DE FUTEBOL
(57) "APARELHO PARA O TREINAMENTO DE FUTEBOL" Uma bola esportiva (130) presa a uma pessoa (40) por meio de um corpo (110) com múltiplos braços envolvendo a bola. Os braços são fixados usando-se prendedores de graveto e tipo (140) que ficam presos a uma linha de pele flexível (50) presa à cintura de uma pessoa (40). A bola (130) é capaz de ser chutada ou socada pelo jogador e ser retornada à área por meio de uma elástica (60).
(71) DMO Sports, Inc. (US)
(72) Darryl Kilgus
(74) Daniel & Cia
(85) 06/11/2000
(86) PCT US98/10055 de 06/05/1999
(87) WVO 98/06036 de 11/11/1999

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Exemplo prático da inventividade humana

(21) PI 0302544-6 (22) 05/08/2003
(51) B60J 9/00
(54) JANELA DO COMPARTIMENTO DE BAGAGEM DE VEÍCULOS AUTOMOTORES DITA JANELA DE EMERGÊNCIA DO COMPARTIMENTO DE BAGAGEM
(57) "JANELA DO COMPARTIMENTO DE BAGAGEM DE VEÍCULOS AUTOMOTORES DITA JANELA DE EMERGÊNCIA DO COMPARTIMENTO DE BAGAGEM". Janela localizada no compartimento de bagagem de veículos automotores, dita janela de emergência do compartimento de bagagem, composta de abertura da janela, tampa, batente, borracha de vedação, dobradiça, puxador e fecho, que pode ser aberta e fechada pelo lado de dentro, só numa emergência, para o pedido de socorro por parte de pessoas que se encontram presas dentro desses compartimentos.
(71) Emerson Deusdará Valente de Miranda (BR/DPI)
(72) Emerson Deusdará Valente de Miranda



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Not considered inventions (1)

- I - discoveries, scientific theories and mathematical methods;
- II - purely abstract concepts;
- III - schemes, plans, principles or methods of a commercial, accounting, financial, educational, publishing, lottery or fiscal nature;

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Not considered inventions (2)

- IV - literary, architectural, artistic and scientific works or any aesthetic creation;
- V - computer programmes per se;
- VI - the presentation of information;
- VII - rules of games;

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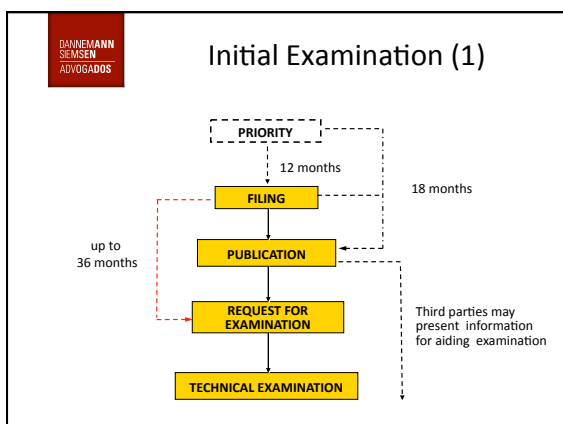
Not considered inventions (3)

- VIII - operating or surgical techniques and therapeutic or diagnostic methods, for use on the human or animal body;
- IX - natural living beings, in whole or in part, and biological material, including the genome or germ plasm of any natural living being, when found in nature or isolated therefrom, and natural biological processes.

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Not patentable

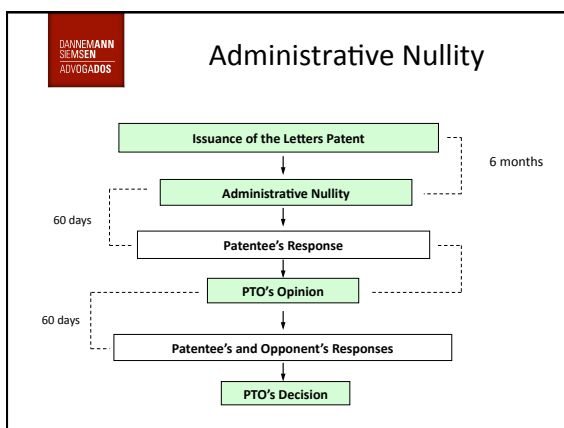
- I - that which is contrary to morals, good customs and public security, order and health;
- II - substances, matter, mixtures, elements or products of any kind, as well as the modification of their physical-chemical properties and the respective processes of obtaining or modifying them, when they result from the transformation of the atomic nucleus;
- III - living beings, in whole or in part, except transgenic micro-organisms meeting the three patentability requirements (...) and which are not mere discoveries



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Issuance

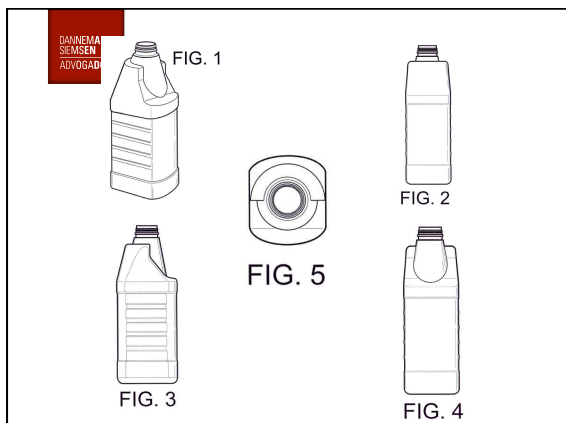
- Patent term – 20 years from filing or 10 years from grant, whichever is longer
Divisional: it has the same expiry date and filing date of the original application
- Certificate of Addition: it has the same expiry date of the original application/patent; however the filing date is different from the original application/patent
- After issuance, interested parties may request administrative nullity of the patent within 6 months of issue
- Patentee is notified to reply the nullity request
- Intermediary report is issued; both parties may submit additional comments
- A decision is issued maintaining or cancelling the patent

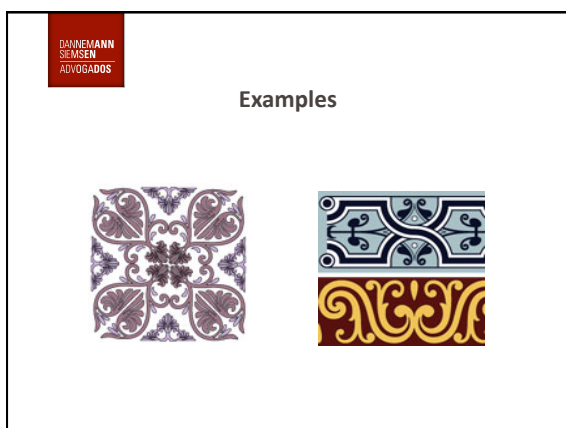


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Industrial Designs

- Term: 10 years of protection, plus three extensions of 5 years possible, totaling 25 years;
- Requirements: absolute novelty, originality, possibility of industrial manufacture.
- Automatic registration after formalities examination. Examination on merits is possible under request by the applicant.
- Nullity proceedings may be instituted *ex officio* (when contrary to the legal requirements) or at the request of any person having a legitimate interest within **5 years** from grant of the registration



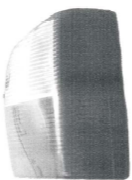








**Exemplos de
desenho
industrial na
área
automobilística**

(11) DI 6303893-S (22) 24/10/2003 39
(18) 06/04/2004
(45) 06/04/2004
(51) 26-08.1.0038, 26-06.C.0618
(54) CONFIGURAÇÃO APLICADA EM LANTERNA DE AUTOMÓVEL
(73) FIAT AUTOMÓVEIS S.A. (BR/MG)
(72) PAULO FRANCISCO NAKAMURA
(74) Marcos Antonio Salles
Prazo de validade: 10 (dez) anos contados a partir de 24/10/2003, observadas as condições legais.



GENERAL CURRENT ISSUES





“Fast-Track” Examination

- Resolution # 191/2008
- (i) the applicant is an **individual** over 60 (sixty) years old (evidence: identification document);
- (ii) the subject matter of the application is being reproduced by unauthorized parties (*prima facie proof of infringement*) and a copy of the cease and desist letter sent to and duly received by the unauthorized third party);
- (iii) grant of the patent is a condition for obtaining financial loans from official credit institutions (evidence: copy of the request made to the agency/institution and a copy of the document that requires the grant of the patent as a condition for the release of the resources).

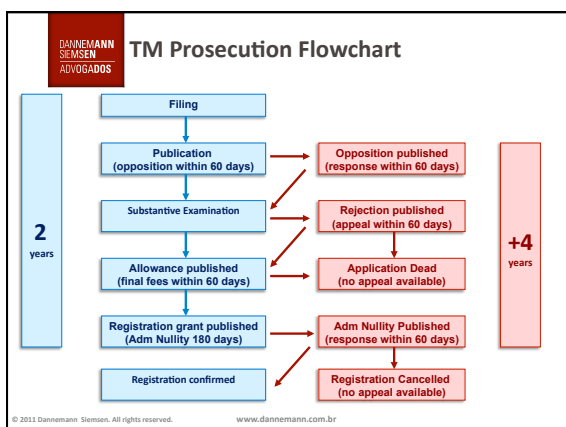


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TM Prosecution Highlights

- First to file system.
- Multiclass applications not allowed.
- Japanese characters are considered “device marks”.
 - Tip: search for “device mark”, “meaning” and “transliteration”

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TM Prosecution Backlog

- Measures against backlog
 - Electronic filing
 - New examiners
 - Reclassification temporarily suspended
- Electronic filing
 - Advantage: reduction of official fees in approx 25%
 - Disadvantage: description of products or services must match with WIPO list

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Special protection: highly renown marks


- Special protection in all classes (art. 125, IP Law)
- Duration: five years
- Requisites:
 - Registration in Brazil
 - Fame in Brazil to general public


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
Special protection: highly renown marks


- Examples:














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Special protection: well-known marks

- Special protection without prior registration in Brazil (art. 126)
- Requisites:
 - Fame in Brazil to specialized consumers
 - Application filed in Brazil (within 60 days if not yet filed)
 - Use in Brazil is not a requisite

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Special protection: dilution

- Protection of reputation and distinctive power (art. 130)
- Requisites:
 - Registration or application in Brazil
 - Risk against reputation or distinctive power

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Special protection: prior use


- Protection of marks which are in use but have not been applied for registration (art. 129)
- Requisites:
 - Use for more than 6 months prior to the opposition
 - Likelihood of confusion
- Controversy: when these rights may be enforced?

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Non-traditional marks

Registrable (visually perceptible)



Non-Registrable (not visual)

Sound	Smell
Touch	Taste

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Trademarks on the Internet

- Domain names
 - trademark violation
 - Administrative procedure
- Liability of Internet Service Providers
 - Before knowledge: no (major caselaw).
 - After cease and desist letter: yes.

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Infringement Litigation in Brazil

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- IP infringement
 - Criminal offense and tort
- Criminal remedies
 - Search and seizure
 - Criminal complaint against representatives of defendant
 - Prison terms

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- Civil remedies
 - Search and seizure
 - Preliminary and permanent injunctions
 - Damages
 - Plaintiff's lost profits
 - Infringer's profits
 - Reasonable royalty

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**Patent infringement action
Typical procedure**

- No discovery
- Possible prior criminal search and seizure
 - Seizure of samples
 - Expert report by judge-appointed experts
- Complaint filed at state court
- Preliminary injunction request
- Expert examination
- Trial decision on the merits
- Appeal

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Patent infringement action

- Preliminary injunctions
 - Possibly ex parte
 - Generally enjoins defendant of performing offending acts on penalty of paying daily fee
 - Possible search and seizure of all infringing articles
- Main criteria
 - Urgency – risk of irreparable harm
 - Delay in filing complaint
 - Likelihood of success
 - Technical opinion(s) grounding complaint
- Bond
 - Foreign plaintiff
 - Offer

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Patent Infringement Litigation in Brazil

- Process patents - reversal of burden of proof
- Statutory infringement by equivalency and contributory infringement
- Imported product manufactured by patented process is an infringement
- Patent applications – collecting damages for acts between publication and grant or prior to publication if infringer duly notified.

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Litigation overview – Brazilian court system

- Dual structure
 - IP rights infringement – State courts
 - IP validity – Federal courts

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Infringement actions – State courts

- Venue
 - Generally defendant seat
 - Where infringement occurs
- No IP specialized courts except in Rio de Janeiro
- IP specialized Court of Appeals in São Paulo
- State appeal courts at the capital of each state

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Patent enforcement

- Myths and truths
 - Difficult to obtain legal remedies
 - Easy to design around
 - Broad claim interpretation
 - Statutory infringement by equivalence
- Slow court procedure
- Lack of expertise of the judges
- Bias against foreigners

TRADEMARK LITIGATION IN BRAZIL: AN OVERVIEW

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Nullity actions

- Administrative: Patent and Trademark Office
 - Deadline: 6 months from granting notice
- Judicial: Federal Courts
 - Deadline: 5 years from granting notice (trademarks)

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Nullity actions

- Possibility to stop use of the mark in same action.
- Injunction available.
- Damages available.

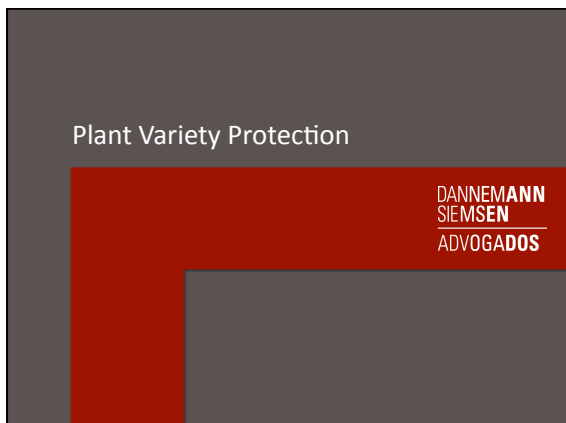
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Tips for enforcement

- Where to litigate?
- General rule: defendant's domicile or place of damages
- Tip: exceptions
 - i) place of the infringement;
 - ii) possibility of including retailers as co-defendants;
 - iii) Internet (widespread infringement).

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PLANT VARIETY PROTECTION

The International Union for the Protection of New Varieties of Plants (UPOV) is an intergovernmental organization with headquarters in Geneva (Switzerland).

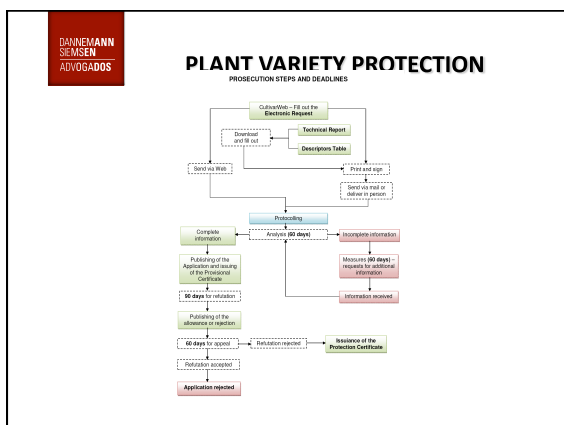
UPOV was established by the International Convention for the Protection of New Varieties of Plants. The Convention was adopted in Paris in 1961 and it was revised in 1972, 1978 and 1991. The objective of the Convention is the protection of new varieties of plants by an intellectual property right.

Brazil is a member of UPOV since May 23, 1999 and adopted the UPOV's 1978 Act (Decree # 3,109 of June 30, 1999).

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PLANT VARIETY PROTECTION

- UPOV's 1978 Act X 1991 Act:
- 1978 - The rights of the holder reaches only the material of reproduction or vegetative multiplication of the whole plant.
- 1991 - The rights of the holder reaches the commercial harvest product (the grain that goes to industry / trade). Also, the protection extends to all plants (plant kingdom).
- Brazilian Plant Variety Protection Law # 9,456 of April 25, 1997 adopted the provisions of UPOV's 1978 Act.
- The obtainer is required to apply for registration of its variety in the National Plant Variety Service (SNPC).



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PLANT VARIETY PROTECTION

Term of Protection (Plant Variety Law # 9,456/97 – PVP Law)

15 years counted from the grant of the Provisional Protection Certificate, except for grapevines, fruit trees, forestal trees, ornamental trees (including graft-holder), for which their term will be **18 years**.

Protectable Plant Varieties in Brazil

Cotton, Rice, Oat, Tobacco, Wheat, Soybean, Sugar Cane, Sorgho, etc.

See full list at: <http://www.agricultura.gov.br/vegetal/registros-autorizacoes/protecao-cultivares/formularios-protecao-cultivares>

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EXCLUSIONS FROM PROTECTION

- a) when a producer saves seeds for his own use in his land (“non-limited saving seeds exemption”);
- b) when a producer uses or sells the product of his plantation as foodstuff or raw material, EXCEPT for reproductive purposes;
- c) when a producer uses the plant variety as a source of variation for the purpose of genetic improvement or in scientific research (“breeding exemption”), EXCEPT if the original plant variety must be repeatedly used or in case of essentially derived varieties.



ENFORCEMENT OF A PVP RIGHT

- article 37 of the PVP Law - whoever sells, offers for sale, reproduces, imports, exports, including packing or storing for these purposes, or assigns in any way, a propagating material of a protected plant variety, with or without the correct denomination, without the authorizations of its owner.
- PVP Law provides for civil remedies (seizure, damages and fee payment), but no criminal penalties (article 37).



Unfair Competition

- Trade secrets;
- Trade Dress;
- Fraudulent means to obtain third party's clientele;
- Confidential Data submitted to government bodies;
- Employees breach of loyalty;



Penalty for unfair competition



- Crime : prison up to one years;
- Civil tort : damages, injunctive relief, court orders and attachment of assets.



Protection of Trade Secrets

- Patents x Trade secrets
- Industrial espionage
- Counter-measures
- Legal remedies available



Transfer of Technology & Licenses

- Agreements recordable with INPI
- Production of effects;
- Remittance of royalties
- Fiscal deduction;
- Review “prima facie” of competition rules;
- Visa and labor effects.



Transfer of Technology

- Non-patented know-how agreements;
- Patent license;
- Trademark or design licenses;
- Technical services;
- Franchising;
- Cost sharing agreements;



Transfer of Technology

- Term of the patent or trademark registration license;
- Know-how – up to 5 years, renewable for another 5 year term;
- Technical services – invoices or agreements – billing time or effective cost



Software

- Copyright Law Principles
- 50 years protection.
- Protection irrespective of registration
- Registration at INPI.



Software

- Limitation of moral rights;
- Ownership by employers or contracting party;



Copyright

- **Moral rights:**
 - non-waivable, unassignable
- Economic rights:**
 - 70 year protection as of Jan after death
-
- Legal entities
- Data base protection
- Selection of content

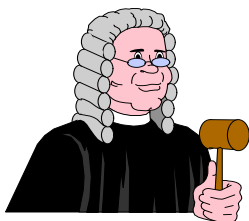


Copyright

- Collective Works – ownership by specific contract;
- Assignment of rights – Labor contract and specific contract.



Penalty



- Crime : up to 4 years in prison.
- Damages : minimum of 3.000 items plus the seizure.