

## Areas of convergence and administrative practices of INPI-Brazil


### Area of convergence 1 - Notion of State name


The documents prepared by the SCT point to the definition of what would be "State name", which would include the official name of the country, its variations and abbreviations and the use of adjectives related to the nationality.

In Brazil, the Industrial Property Law (Law No. 9.279 / 1996) does not discuss definitions of such concepts. However, the Trademark Manual of INPI (instituted by Resolution INPI / PR No. 142/2014) defines nationality as the "distinctive character of a nation or state of that which belongs to a nation".

From the administrative practice of the Institute, there is a clear difference in the treatment given to official country names and adjectives which designate nationality. While state names and their variations are considered to be potentially registrable (if not misleading or descriptive), adjectives relating to nationality are usually considered to be unenforceable because they describe the origin of the goods or services.

Examples:

Sign	Specification of products and services	Observations
	Medical services	<b>Registration granted</b> with reservation for non-exclusive use of the expression "CLINIC OF EYES". In this case, the variation of the country name "UNITED STATES" (commonly used to describe the United States of America) was considered distinctive to indicate the services claimed.
<b>CAFÉ ITALIANO</b>	Coffee and coffee drinks	<b>Rejected</b> for lack of distinctiveness (item VI of article 124 of the LPI). The expression "CAFÉ ITALIANO" was considered non-distinctive since it identifies the product that the sign is intended to indicate and describes its nationality.

	<p>Perfumes</p>	<p><b>Rejected</b> by the misleading character of the sign (item X of article 124 of the LPI). The presence of the state name "FRANCE" as a trademark for "perfumes" was considered potentially misleading, since the country in question is recognized as a producer of perfumery products and the applicant for the sign is Brazilian.</p>
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### Area of convergence 2 - Irregistrability of a State name considered descriptive

Another point of convergence pointed out by the study elaborated by the SCT would be the irregularity of marks constituted by country name, when descriptive of the origin of products or services.

As explained above, the Brazilian rules establish different treatment of official country names (and their variations) and adjectives related to nationality. The official names of countries (and their variations) are considered potentially registrable, as long as they do not induce false indication of origin, as provided in art. 181 of the LPI, which provides:

181. A geographical name that does not constitute an indication of source or denomination of origin may serve as a characteristic element of a product or service mark, provided that it is not inducing to a false source.

Example:

Sign	Specification of products and services	Observations
	<p>Insurance Brokerage</p>	<p><b>Registration granted</b> with reservation for non-exclusivity of use of the expression "CORRETORA DE SEGUROS". In this case, the country name "ITALY" was considered to be distinctive to mark the services claimed.</p>

However, State names may be considered as non-distinctive as part of adjective phrases in terms of descriptive character in relation to goods or services that the sign aims to indicate.

Example:

Sign	Specification of products and services	Observations
<b>ALFAFA DO CHILE</b>	Alfalfa in pellets for animal feed	<b>Rejected</b> for lack of distinctiveness (item VI of article 124 of the LPI). The term "ALFAFA DO CHILE" identifies the product that the sign is intended to indicate, as well as its origin, with the use of an adjective equivalent of Gentile ("CHILE").

Regarding the adjectives of nationality, as mentioned previously, there is a convergence of the Brazilian rules with the point in question, in relation to the provisions of art. 124, inc. VI, of LPI:

124. The following are not registrable as marks:

(...)

VI. signs of generic, necessary, common, ordinary or simply descriptive character, when related to the product or service to be distinguished, or those commonly employed to designate a characteristic of the product or service regarding its nature, nationality, weight, value, quality and time of production or rendering of the service, except when endowed with a sufficiently distinctive form;


Example:

Sign	Specification of products and services	Observations
<b>PASTA ALEMÃ</b>	Sweet creamy, sweet chocolate, milk jam.	<b>Rejected</b> for lack of distinctiveness (item VI of article 124 of the LPI). The expression "GERMAN PASTE" identifies the nature of the product that the sign is intended to indicate, as well as its origin.

### Area of convergence 3 - Procedure for annulment of registration and opposition to trademark application

The documents present as a point of convergence the possibility of substantiating the annulment of trademark registrations or opposition to applications for trademark registrations in prohibitions concerning names of States. In this respect, there is convergence in relation to Brazilian rules, since such claims can serve as a basis both for administrative invalidity proceedings and for third party oppositions on the application for trademark registration.

Example:

Sign	Specification of products and services	Observations
	<p style="text-align: center;">Coffee</p>	<p>The application was the subject of <b>opposition</b> filed by the Colombian National Coffee Growers Federation, in which it was alleged that the sign in question would be misleading because it identified a false indication as to the origin of the product, since its applicant was not Colombian. The allegations were considered by the INPI, who rejected the application because of its misleading nature (item X of article 124 of the LPI).</p>

### Area of convergence 4 - Use as trademark

The last point of convergence mentioned refers to the legal means of restricting the use of a trademark in the market containing official country names (and variations) or nationality that are misleading in relation to the nature, quality, geographical origin of the products and services and of provenience.

In this matter, INPI-Brasil has no interference on the matter, since the claims related to the improper use of the trademark in the market must be proposed directly to the Judiciary.

## **Conclusion**

With regard to the points of convergence discussed above, it is verified that, regarding national legislation and administrative rules in force, INPI-Brazil considers country names as signs that are potentially registrable as a trademark, provided that they respect the principles of distinctiveness and truthfulness.

Impugnation for the nullity of trademark registrations or the rejection of applications containing country names are duly accepted, if timely, and may be successful if they prove the violation of legal provisions related to distinctiveness, veracity, public order or availability.

Finally, as regards the repression of the misuse of trademarks containing States names, such demands must be submitted to the Judiciary, which may possibly summon INPI-Brazil to express its opinion on specific cases.