

**Brazil Industrial Property Law**  
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**PRELIMINARY PROVISIONS**

**Article 1** - This law regulates rights and obligations relating to industrial property.

**Article 2** - The protection of rights relating to industrial property, taking into account the interests of society and the technological and economic development of the country, is effected by means of:

- I - the grant of patents of invention and utility model patents;
- II - the grant of industrial design registrations;
- III - the grant of trademark registrations;
- IV - the repression of false geographical indications; and
- V - the repression of unfair competition.

**Article 3** - The provisions of this law also apply:

- I - to an application for a patent or registration originating from abroad and filed in this country by a person having protection guaranteed by a treaty or convention in force in Brazil; and
- II - to nationals or persons domiciled in a country that guarantees reciprocity of identical or equivalent rights to Brazilians or persons domiciled in Brazil.

**Article 4** - The provisions of treaties in force in Brazil, are applicable, in equal conditions, to natural and legal persons that are nationals or domiciled in this country.

**Article 5** - For all legal effects, industrial property rights are considered to be chattels.

**TITLE I - PATENTS**

**CHAPTER I - OWNERSHIP**

**Article 6** - The author of an invention or of a utility model will be assured the right to obtain a patent that guarantees to him the property, under the terms established by this law.

§ 1 - In the absence of proof to the contrary, the applicant is presumed to have the right to obtain a patent.

§ 2 - A patent may be applied for by the author, his heirs or successors, by the assignee or by whoever the law or a work or service contract determines to be the owner.

§ 3 - When an invention or utility model is created jointly by two or more persons, the patent may be applied for by all or any one of them, by naming and qualifying the others to guarantee their respective rights.

§ 4 - The author will be named and qualified, but may request his authorship not to be divulged.

**Article 7** - If two or more authors have independently devised the same invention or utility model, the right to obtain a patent will be assured to whoever proves the earliest filing, independently of the dates of invention or creation.

**Sole Paragraph** - The withdrawal of an earlier filing without producing any effects will give priority to the first later filing.

## **CHAPTER II - PATENTABILITY**

### ***Section I - Patentable Inventions and Utility Models***

**Article 8** - To be patentable an invention must meet the requirements of novelty, inventive activity and industrial application.

**Article 9** - An object of practical use, or part thereof, is patentable as a utility model, when it is susceptible of industrial application, presents a new shape or arrangement and involves an inventive act that results in a functional improvement in its use or manufacture.

**Article 10** - The following are not considered to be inventions or utility models:

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;

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;

VIII - operating or surgical techniques and therapeutic or diagnostic methods, for use on the human or animal body; and

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.

**Article 11** - Inventions and utility models are considered to be new when not included in the state of the art.

§ 1 - The state of the art comprises everything made accessible to the public before the date of filing of a patent application, by written or oral description, by use or any other means, in Brazil or abroad, without prejudice to the provisions of articles 12, 16 and 17.

§ 2 - For the purpose of determining novelty, the whole contents of an application filed in Brazil, but not yet published, will be considered as state of the art from the date of filing, or from the priority claimed, provided that it is published, even though subsequently.

§ 3 - The provisions of the previous paragraph will be applied to an international patent application filed in accordance with a treaty or convention in force in Brazil, provided that there is national processing.

**Article 12** - The disclosure of an invention or utility model which occurs during the twelve months preceding the date of filing or priority of the patent application will not be considered as part of the state of the art, provided such disclosure is made:

I - by the inventor;

II - by the National Institute of Industrial Property - INPI, by means of the official publication of a patent application filed without the consent of the inventor and based on information obtained from him or as a result of his acts; or

III - by third parties, on the basis of information received directly or indirectly from the inventor or as the result of his acts.

**Sole Paragraph** - INPI may require the inventor to provide a declaration relating to the disclosure, accompanied or not by proof, under the conditions established in the rules.

**Article 13** - An invention shall be taken to involve inventive activity when, for a person skilled in the art, it does not derive in an evident or obvious manner from the state of the art.

**Article 14** - A utility model shall be taken to involve an inventive act when, for a person skilled in the art, it does not derive in a common or usual manner from the state of the art.

**Article 15** - Inventions and utility models are considered to be susceptible of industrial application when they can be made or used in any kind of industry.

### ***Section II Priority***

**Article 16** - Priority rights will be guaranteed to a patent application filed in a country that maintains an agreement with Brazil or in an international organisation, that produces the effect of a national filing, within the time limits established in the agreement, the filing not being invalidated nor prejudiced by facts that occur within such time limits.

§ 1 - Priority claims must be made at the time of filing, but may be supplemented within 60 (sixty) days by other priorities earlier than the date of filing in Brazil.

§ 2 - A priority claim must be proved by means of a suitable document of origin, containing the number, date, title, specification and, when they exist, claims and drawings, accompanied by a simple translation of the certificate of filing or equivalent document containing data identifying the application, the contents of which will be of the entire responsibility of the applicant.

§ 3 - If not effected at the time of filing, the proof must be presented within 180 (one hundred and eighty) days from filing.

§ 4 - For international applications filed in virtue of a treaty in force in Brazil, the translation provided for in § 2 must be filed within the period of 60 (sixty) days from the date of entry into national processing.

§ 5 - When the application filed in Brazil is completely contained in the document of origin, a declaration by the applicant in this respect will be sufficient to substitute the simple translation.

§ 6 - When the priority is obtained by virtue of assignment, the corresponding document must be filed within 180 (one hundred and eighty) days from filing or, in the case of entry into national processing, within 60 (sixty) days from the date of such entry, consular legalisation in the country of origin not being required.

§ 7 - Failure to file proof within the time limits established in this article will result in loss of the priority.

§ 8 - In the case of an application filed with a priority claim, any request for early publication must be made with proof of the priority having been filed.

**Article 17** - An application for a patent of invention or for a utility model originally filed in Brazil, without a priority claim and not yet published, will guarantee a right of priority to a later application in respect of the same subject matter filed in Brazil by the same applicant or by his successors, within the period of 1 (one) year.

§ 1 - Priority will only be recognised for subject matter that is disclosed in the earlier application and will not extend to any new matter that is introduced.

§ 2 - The pending earlier application will be considered as definitively shelved.

§ 3 - A patent application resulting from the division of an earlier application cannot serve as the basis for a priority claim.

### ***Section III - Non-patentable Inventions and Utility Models***

**Article 18** - The following are 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; and

III - living beings, in whole or in part, except transgenic micro-organisms meeting the three patentability requirements - novelty, inventive activity and industrial application - provided for in article 8 and which are not mere discoveries;

**Sole Paragraph** - For the purposes of this law, transgenic micro-organisms are organisms, except the whole or part of plants or animals, that exhibit, due to direct human intervention in their genetic composition, a characteristic that can not normally be attained by the species under natural conditions.

## **CHAPTER III - PATENT APPLICATIONS**

### ***Section I - Filing of the Application***

**Article 19** - A patent application, in accordance with the conditions established by INPI, will contain:

I - a request;

II - a specification;

III - claims;

IV- drawings, if any;

V - an abstract; and

VI - proof of payment of the filing fee.

**Article 20** - Once presented, the application will be submitted to a formal preliminary examination and, if in due order, will be protocolled, the date of presentation being considered as the filing date.

**Article 21** - An application that does not formally meet the requirements of article 19, but which does contain data relating to the subject matter, the applicant and the inventor, may be delivered to INPI against a dated receipt which will establish the requirements to be met within a period of 30 (thirty) days, on pain of return or shelving of the documentation.

**Sole Paragraph** - Once the requirements have been met, filing will be considered to have been made on the date of the receipt.

## ***Section II - Conditions of the Application***

**Article 22** - An application for a patent of invention must refer to a single invention or to a group of inventions so interrelated as to comprise a single inventive concept.

**Article 23** - An application for a utility model must refer to a single principal model that may include a plurality of distinct additional elements or structural or configurative variations, provided that technical-functional and corporeal unity of the object is maintained.

**Article 24** - The specification must describe the subject matter clearly and sufficiently so as to enable a person skilled in the art to carry it out and to indicate, when applicable, the best mode of execution.

**Sole Paragraph** - In the case of biological material essential for the practical execution of the subject matter of the application, which cannot be described in the form of this article and which has not been accessible to the public, the specification will be supplemented by a deposit of the material in an institution authorised by INPI or indicated in an international agreement.

**Article 25** - The claims must be based on the specification, characterising the particularities of the application and defining clearly and precisely the subject matter to be protected.

**Article 26** - A patent application may, until the end of examination, be divided, *ex officio* or on request of the applicant, into two or more applications, provided that the divisional application:

I - makes specific reference to the original application; and

II - does not exceed the matter disclosed in the original application.

**Sole Paragraph** - A request for division not in accordance with the provisions of this article will be shelved.

**Article 27** - Divisional applications will have the filing date of the original application and the benefit of the priority of the latter, if any.

**Article 28** - Each divisional application will be subject to payment of the corresponding fees.

**Article 29** - A patent application which is withdrawn or abandoned will be published.

§ 1 - A request for withdrawal must be filed within 16 (sixteen) months counted from the date of filing or of the earliest priority.

§ 2 - Withdrawal of an earlier application without producing any effect will confer priority on the first later application.

### ***Section III - Prosecution and examination of an application***

**Article 30** - A patent application will be kept secret during 18 (eighteen) months counted from the date of filing or of the earliest priority, if any, after which it will be published, with the exception of the case provided for in article 75.

§ 1 - Publication of the application may be anticipated on request by the applicant.

§ 2 - The publication must include data identifying the patent application, a copy of the specification, claims, abstract and drawings being made available to the public at INPI.

§ 3 - In the case provided for in the sole paragraph of article 24, the biological material will be made available to the public at the time of the publication to which this article refers.

**Article 31** - Documents and information for aiding examination may be filed by interested parties between the publication of the application and the termination of examination.

**Sole Paragraph** - Examination will not be initiated prior to 60 (sixty) days from publication of the application.

**Article 32** - In order better to clarify or define a patent application, the applicant may effect alterations up to the request for examination, provided that they be limited to the subject matter initially disclosed in the application.

**Article 33** - Examination of a patent application must be requested by the applicant or by any interested party, within 36 (thirty six) months counted from the date of filing, under pain of shelving of the application.

**Sole Paragraph** - The patent application may be reinstated, on request by the applicant, within 60 (sixty) days counted from the shelving, on payment of a specific fee, under pain of definitive shelving.

**Article 34** - Once examination has been requested and whenever so requested, the following should be filed within 60 (sixty) days, on pain of shelving of the application:

I - objections, prior art searches and the results of examination for the grant of corresponding applications in other countries, when there is a priority claim;

II - documents necessary to regularise the proceedings and examination of the application; and

III - a simple translation of the suitable document mentioned in § 2 of article 16, should it have been substituted by the declaration provided for in § 5 of that same article.

**Article 35** - At the time of the technical examination, a search report and an opinion will be prepared with respect to:

I - the patentability of the application;

II - the adaptation of the application to the nature of protection claimed;

III - the reformulation of the application or the division thereof; or

IV - technical requirements.

**Article 36** - When the opinion is for non-patentability or for the inadequacy of the application for the nature of protection claimed or formulates any requirement, the applicant will be notified to reply within a period of 90 (ninety) days.

§ 1 - If no reply to a requirement is filed, the application will be definitively shelved.

§ 2 - If a reply to a requirement is filed, but the latter is not met or its formulation is contested, and independently of arguments being filed regarding patentability or adequacy, examination will be continued.

**Article 37** - Once examination is concluded, a decision will be issued, allowing or rejecting the patent application.

## **CHAPTER IV - PATENT GRANT AND TERM**

### ***Section I - Patent Grant***

**Article 38** - A Patent will be granted after the application is allowed and, after proving payment of the corresponding fee, the respective letters-patent will be issued.

§ 1 - Payment of the fee and the respective proof thereof must be effected within 60 (sixty) days from allowance.

§ 2 - The fee provided for in this article may also be paid and proved within 30 (thirty) days after the time limit provided for in the previous paragraph, independently of any notification, by payment of a specific fee, on pain of definitive shelving of the application.

§ 3 - The patent will be considered granted as of the date of publication of the respective act.

**Article 39** - The letters-patent will include the respective number, title and nature of protection, the name of the inventor, observing the provisions of article 6, § 4, the qualification and domicile of the patentee, the term, the specification, the claims and the drawings, as well as data relating to the priority.

### ***Section II - Patent Term***

**Article 40** - A Patent of invention will have a term of 20 (twenty) years and a utility model patent a term of 15 (fifteen) years, counted from the filing date.

***Sole Paragraph*** - The term will not be less than 10 (ten) years for patents of invention and 7 (seven) years for utility model patents, counted from grant, except when INPI is prevented from proceeding with the examination as to the merit of the application, due to a proven *pendente lite* or for reasons of "force majeure".

## **CHAPTER V - PROTECTION CONFERRED BY A PATENT**

### ***Section I - The Rights***

**Article 41** - The extension of the protection conferred by a patent will be determined by the content of the claims, interpreted in the light of the specification and drawings.

**Article 42** - A patent confers on its proprietor the right to prevent third parties from manufacturing, using, offering for sale, selling or importing for such purposes without his consent:

I - a product that is the subject of a patent;

II - a process, or product directly obtained by a patented process;

§ 1 - The patentee is further guaranteed the right to prevent third parties from contributing to the practice by other parties of the acts referred to in this article.

§ 2 - The rights in a process patent will be violated, insofar as item II is concerned, when the holder or owner of a product fails to prove, through specific judicial ruling, that it was obtained by a manufacturing process different from that protected by the patent.

**Article 43** - The provisions of the previous article do not apply:

I - to acts practised by unauthorised third parties privately and without commercial ends, provided they do not result in prejudice to the economic interests of the patentee;

II - to acts practised by unauthorised third parties for experimental purposes, related to studies or to scientific or technological research;

III - to the preparation of a medicine according to a medical prescription for individual cases, executed by a qualified professional, as well as to a medicine thus prepared;

IV - to a product manufactured in accordance with a process or product patent that has been placed on the internal market directly by the patentee or with his consent;

V - to third parties who, in the case of patents related to living matter, use, without economic ends, the patented product as the initial source of variation or propagation for obtaining other products; and

VI - to third parties who, in the case of patents related to living matter, use, place in circulation or commercialise a patented product that has been introduced lawfully onto the market by the patentee or his licensee, provided that the patented product is not used for commercial multiplication or propagation of the living matter in question.

**Article 44** - A patentee is guaranteed the right to obtain compensation for the unauthorised exploitation of the subject matter of the patent, including exploitation that occurred between the date of publication of the application and that of grant of the patent.

§ 1 - If the infringer obtains, by any means, knowledge of the contents of a filed application, prior to publication, the period of undue exploitation, for the effect of compensation, will be counted from the date of commencement of the exploitation.

§ 2 - When the subject matter of a patent application relates to biological material, deposited under the terms of the sole paragraph of article 24, the right to compensation will only be conferred when the biological material has been made available to the public.

§ 3 - The right to obtain compensation for unauthorised exploitation, including with respect to the period prior to grant of the patent, is limited to the contents of the subject matter of the patent, under the terms of article 41.

### ***Section II - Prior User***

**Article 45** - A person who in good faith, prior to the date of filing or of priority of a patent application, exploits its object in this country, will be guaranteed without onus the right to continue the exploitation, in the previous form and conditions.

§ 1 - The right conferred under the terms of this article can only be ceded by transfer or leasing, together with the business of the undertaking, or the part thereof that has direct relation with the exploitation of the subject matter of the patent.



§ 2 - The right to which this article refers will not be guaranteed to a person who had knowledge of the subject of the patent due to disclosure under the terms of article 12, provided that the application was filed within 1 (one) year from the disclosure.

## **CHAPTER VI - PATENT NULLITY**

### ***Section I - General Provisions***

**Article 46** - A patent is null when granted contrary to the provisions of this law.

**Article 47** - Nullity may not be applicable to all of the claims, a condition for partial nullity being that the subsisting claims constitute subject matter that is patentable per se.

**Article 48** - Nullity of a patent will produce effects as from the filing date of the application.

**Article 49** - In the case of the provisions of article 6 not having been observed, the inventor may alternatively claim, in a court action, the adjudication of the patent.

### ***Section II - Administrative Nullity Procedure***

**Article 50** - Nullity of a patent will be declared administratively when:

I - any of the legal requisites have not been met;

II - the specification and the claims do not meet the provisions of articles 24 and 25, respectively;

III - the subject of protection of the patent extends beyond the contents of the application as originally filed; or

IV - any of the essential formalities indispensable for grant were omitted during prosecution.

**Article 51** - The nullity procedure may be instituted *ex officio* or at the request of any person having legitimate interest, within 6 (six) months counted from the grant of the patent.

***Sole Paragraph*** - The nullity procedure will continue even if the patent is extinct.

**Article 52** - The patentee will be notified to respond within a period of 60 (sixty) days.

**Article 53** - Independently of a reply having been filed, once the period determined in the previous article has passed, INPI will issue an opinion, notifying the patentee and the applicant to reply within a common period of 60 (sixty) days.

**Article 54** - Once the period determined in the previous article has passed, even if no replies have been presented, the process will be decided by the President of INPI, terminating the administrative instance.

**Article 55** - The provisions of this Section apply, where appropriate, to certificates of addition.

### *Section III - Nullity Actions*

**Article 56** - A nullity action can be filed at any time during the term of a patent by INPI or by any legitimately interested party.

§ 1 - Nullity of a patent may be argued, at any time, as matter for defence.

§ 2 - The judge may, as a preventive or incidental measure, determine the suspension of the effects of a patent, provided the relevant procedural requirements are met.

**Article 57** - Nullity actions will be adjudged in the forum of the Federal Courts, and INPI, when not plaintiff, will participate in the action.

§ 1 - The period for the defendant to reply will be 60 (sixty) days.

§ 2 - Once the decision on a nullity action becomes *res judicata*, INPI will publish a notice to inform third parties.

## **CHAPTER VII - ASSIGNMENT AND NOTATIONS**

**Article 58** - A patent application or patent, the contents of which are indivisible, may be assigned in whole or in part.

**Article 59** - INPI will make the following notations:

I - assignments, mentioning the complete qualification of the assignee;

II - any limitation or onus applied to the application or patent; and

III - alterations of name, headquarters or address of the applicant or patentee.

**Article 60** - Notations will produce effect with regard to third parties as from the date of their publication.

## **CHAPTER VIII - LICENSES**

### *Section I - Voluntary Licenses*

**Article 61** - A patentee or applicant may execute a license contract for exploitation.

**Sole Paragraph** - The licensee may be invested by the patentee with all powers to act in defence of the patent.

**Article 62** - A license contract must be recorded at INPI to produce effect with regard to third parties.

§ 1 - The recordal will produce effect with regard to third parties as from the date of its publication.

§2 - A license contract need not be recorded at INPI for it to have effect for validating proof of use.

**Article 63** - Any improvement to a licensed patent belongs to the person who made it, the other contracting party being guaranteed the right of preference with respect to a license.

### *Section II - Offer to License*

**Article 64** - A patentee may request INPI to place his patent under offer with a view to its exploitation.

§ 1 - INPI will promote publication of the offer.

§ 2 - No exclusive voluntary license contract will be recorded by INPI without the patentee having withdrawn the offer.

§ 3 - No patent subject to an exclusive voluntary license may be made the subject of an offer.

§ 4 - The patentee may withdraw the offer at any time prior to the express acceptance of its terms by an interested party, whereby the provisions of article 66 will not apply.

**Article 65** - In the absence of an agreement between the patentee and the licensee, the parties may request INPI to arbitrate the remuneration.

§ 1 - For the effects of this article, INPI will observe the provisions of § 4 of article 73.

§ 2 - The remuneration may be reviewed after 1 (one) year of it being established.

**Article 66** - A patent under offer will have its annuities reduced by one half during the period between the offer and the grant of the first license of any type.

**Article 67** - The patentee may request cancellation of the license if the licensee does not initiate effective exploitation within 1 (one) year of the grant of the license, interrupts exploitation for a period longer than 1 (one) year or, further, if the conditions for exploitation are not obeyed.

### *Section III - Compulsory Licenses*

**Article 68** - A patentee will be subject to have his patent licensed compulsorily if he exercises the rights resulting therefrom in an abusive manner or by means of it practices abuse of economic power that is proven under the terms of the law by an administrative or court decision.

§ 1 - The following may also result in a compulsory license:

I - the non-exploitation of the subject matter of the patent in the territory of Brazil, by lack of manufacture or incomplete manufacture of the product or, furthermore, by lack of complete use of a patented process, except in the case of non-exploitation due to economic inviability, when importation will be admitted; or

II - commercialisation that does not meet the needs of the market.

§ 2 - The license can only be requested by a party with legitimate interest and that has the technical and economic capacity to carry out the efficient exploitation of the subject matter of the patent, that should be destined predominantly for the internal market, suppressing, in this case, the exception provided for in item I of the previous paragraph.

§ 3 - In the case that a compulsory license is granted due to abuse of economic power, a period of time, limited to that provided for in article 74, will be guaranteed to the licensee proposing to manufacture locally, to proceed with the importation of the subject matter of the license, provided it has been placed on the market directly by the patentee or with his consent

§ 4 - In the case of importation for exploitation of a patent and in the case of importation provided for in the previous paragraph, the importation by third parties of a product

manufactured according to a process or product patent will equally be allowed, provided it has been placed on the market directly by the patentee or with his consent.

§ 5 - A compulsory license, to which § 1 relates, may only be requested after 3 (three) years from grant of the patent.

**Article 69** - A compulsory license will not be granted if, at the date of the request, the patentee:

I - justifies non-use for legitimate reasons;

II - proves that serious and effective preparations for exploitation have been carried out; or

III - justifies lack of manufacture or commercialisation due to legal obstacles.

**Article 70** - A compulsory license will also be granted when the following hypotheses are shown to exist cumulatively:

I - a situation of dependency of one patent on another is characterised;

II - the subject matter of the dependent patent constitutes a substantial technical advance in relation to the earlier patent; and

III - the patentee does not come to an agreement with the patentee of the dependent patent for the exploitation of the earlier patent.

§ 1 - For the purposes of this article, a dependent patent is considered to be one the exploitation of which depends obligatorily on the use of the subject matter of the earlier patent.

§ 2 - For the purposes of this article, a process patent may be considered as dependent on a patent for the respective product, as also a product patent may be dependent upon a process patent.

§ 3 - The proprietor of a patent licensed under the terms of this article will have the right to a compulsory cross license under the dependent patent.

**Article 71** - In cases of national emergency or public interest, declared in an act of the Federal Executive Authorities, insofar as the patentee or his licensee does not meet such necessity, a temporary *ex officio* non-exclusive compulsory license for the exploitation of the patent may be granted, without prejudice to the rights of the respective patentee.

**Sole Paragraph** - The act of grant of the license will establish its term of validity and the possibility of extension.

**Article 72** - Compulsory licenses will always be granted without exclusivity, sublicensing not being permitted.

**Article 73** - An application for a compulsory license must be formulated by indicating the conditions offered to the patentee.

§ 1 - Once the application for a license has been filed, the patentee will be notified to respond within a period of 60 (sixty) days, at the end of which, in the absence of a response from the patentee, the proposal will be considered as accepted under the conditions offered.

§ 2 - An applicant for a license who alleges abuse of patent rights or abuse of economic power must file documentary proof.

§ 3 - If a compulsory license is requested on the basis of lack of exploitation, it will rest with the patentee to prove exploitation.

§ 4 - If there is a contestation, INPI may take the necessary steps, including the establishment of a committee that may include specialists that are not part of INPI, with a view to arbitrating the remuneration that will be paid to the patentee.

§ 5 - The organs and entities of the direct or indirect, federal, state and municipal public administration will provide INPI with such information as is requested with a view to assisting the arbitration of remuneration.

§ 6 - In arbitrating remuneration, the circumstances of each case will be considered, taking into account obligatorily the economic value of the license granted.

§ 7 - Once the process is duly filed, INPI will come to a decision regarding the grant and the conditions of the compulsory license within a period of 60 (sixty) days.

§ 8 - Appeals against decisions granting a compulsory license will not have suspensive effects.

**Article 74** - In the absence of legitimate reasons, the licensee must initiate exploitation of the subject matter of the patent within a period of 1 (one) year from the grant of the license, interruption for an equal period being permitted.

§ 1 - The patentee may request revocation of the license if the provisions of this article are not met.

§ 2 - The licensee will be vested with all powers to act in defence of the patent.

§ 3 - After grant of a compulsory license, the assignment thereof will only be permitted when effected together with the assignment, transfer or leasing of that part of the undertaking that exploits it.

## **CHAPTER IX - PATENTS OF INTEREST TO NATIONAL DEFENCE**

**Article 75** - A patent application originated in Brazil the object of which is of interest to national defence will be processed in secrecy and will not be subject to the publications provided for in this law.

§ 1 - INPI will send the application immediately to the competent organ of the Executive Authorities for the purpose of providing, within 60 (sixty) days, an opinion regarding secrecy. After such period has passed without any opinion by the competent organ, the application will be processed normally.

§ 2 - Excepting express authorisation by the competent organ, the filing abroad of a patent application the subject matter of which is considered to be of interest to national defence, as well as any disclosure thereof, is prohibited.

§ 3 - The exploitation and the assignment of an application or patent of interest to national defence are conditioned to prior authorisation by the competent organ, due compensation being guaranteed whenever this implies a restriction to the rights of the applicant or patentee.

## **CHAPTER X - CERTIFICATE OF ADDITION OF AN INVENTION**

**Article 76** - On payment of a specific fee, the applicant or patentee of a patent of invention may request a certificate of addition to protect an improvement or development introduced in the subject matter of the invention, even if lacking inventive activity, provided that it shares the same inventive concept.

§ 1 - If publication of the main application has already taken place, the application for the certificate of addition will be published immediately.

§ 2 - Examination of the application for a certificate of addition will be in accordance with the provisions of articles 30 to 37, without prejudice to the provisions of the previous paragraph.

§ 3 - An application for a certificate of addition will be rejected if its subject matter does not involve the same inventive concept.

§ 4 - The applicant may, within the period for appeal, by payment of the corresponding fee, request the conversion of an application for a certificate of addition into a patent application benefiting from the date of filing of the application for the certificate.

**Article 77** - A certificate of addition is accessory to the patent, has the same expiry date and accompanies it for all legal effects.

**Sole Paragraph** - In a nullity process, the patentee may request that the subject matter contained in the certificate of addition be examined to verify the possibility of its subsistence, without prejudice to the term of protection of the patent.

## CHAPTER XI - EXTINCTION OF PATENTS

**Article 78** - A patent shall become extinct:

I - on expiry of the term of protection;

II - on waiver by the patentee, without prejudice to the rights of third parties;

III - on forfeiture;

IV - on non-payment of the annual fee, within the periods provided for in § 2 of article 84 and in article 87; and

V - on non-observance of the provisions of article 217.

**Sole Paragraph** - Once a patent becomes extinct, its object falls within the public domain.

**Article 79** - Waiver will only be permitted if it does not prejudice the rights of third parties.

**Article 80** - A patent becomes forfeit, *ex officio*, or at the request of any party with a legitimate interest if, after 2 (two) years from the grant of the first compulsory license, such period has not been sufficient to prevent or correct abuse or disuse, excepting legitimate reasons.

§ 1 - A patent will become forfeit when, on the date of application for forfeiture or of the *ex officio* commencement of the respective process, its exploitation has not been initiated.

§ 2 - In the process for forfeiture commenced at the request of any party with a legitimate interest, INPI may continue the process on desistment by that party.

**Article 81** - The patentee will be notified to respond to the forfeiture request within a period of 60 (sixty) days, the onus of proof regarding exploitation falling on him.

**Article 82** - A decision will be pronounced within 60 (sixty) days counted from the end of the period mentioned in the previous article.

**Article 83** - A decision of the forfeiture process will produce effect as from the day of the request or of the publication of the commencement of the *ex officio* process.

#### **CHAPTER XII - ANNUAL FEES**

**Article 84** - The applicant and patentee are subject to the payment of annual fees, as from the beginning of the third year from the date of filing.

§ 1 - Advance payment of the annual fees will be regulated by INPI.

§ 2 - The payment should be effected within the first 3 (three) months of each annual period, but may still be effected within the following 6 (six) months, independently of notification, by payment of an additional fee.

**Article 85** - The provisions of the previous article apply to international applications filed in virtue of a treaty in force in Brazil, the payment of annual fees due before the date of entry into national processing having to be effected within a period of 3 (three) months from that date.

**Article 86** - Failure to pay an annual fee, under the terms of articles 84 and 85, will result in the shelving of the application or extinction of the patent.

#### **CHAPTER XIII - RESTORATION**

**Article 87** - A patent application and patent may be restored, if the applicant or patentee so requests, within 3 (three) months counted from notification of shelving of the application or extinction of the patent, on payment of a specific fee.

#### **CHAPTER XIV - INVENTIONS AND UTILITY MODELS MADE BY EMPLOYEES OR SUPPLIERS OF SERVICES**

**Article 88** - An invention or utility model will belong exclusively to the employer when it results from a work contract being executed in Brazil and the object of which is research or the exercise of inventive activity or when such results from the nature of the services for which the employee was contracted.

§1 - Except when there are express contractual provisions to the contrary, remuneration for the work to which this article refers will be limited to the salary agreed upon.

§ 2 - In the absence of proof to the contrary, an invention or utility model for which a patent is requested by an employee within 1 (one) year from the extinction of the contract of employment will be considered as having been developed while the contract was in force.

**Article 89** - An employer, who is the proprietor of a patent, may grant the employee, who is the author of the invention or improvement, participation in the economic gains resulting from the exploitation of the patent, as a result of negotiation with the interested party or as provided for by a norm of the undertaking.

**Sole Paragraph** - The participation referred to in this article will not in any way be incorporated into the salary of the employee.

**Article 90** - An invention or utility model developed by an employee will belong exclusively to the employee provided that it is unconnected to his work contract and when it does not result from the use of resources, means, data, materials, installations or equipment of the employer.

**Article 91** - The ownership of an invention or utility model will be common, in equal parts, when it results from the personal contribution of the employee and from resources, data, means, materials, installations or equipment of the employer, without prejudice to express contractual provisions to the contrary.

§ 1 - When there is more than one employee, the part due to them will be divided equally between all of them, except when agreed to the contrary.

§ 2 - The employer will be guaranteed the right to an exclusive license for exploitation and the employee will be guaranteed fair remuneration.

§ 3 - Exploitation of the subject matter of the patent, in the absence of an agreement, must be initiated by the employer within 1 (one) year counted from the date of grant, under pain of the property in the patent being transferred to the exclusive ownership of the employee, without prejudice to the hypothesis of lack of exploitation for legitimate reasons.

§ 4 - In the case of assignment, any of the co-owners may exercise the right of preference under identical conditions.

**Article 92** - The provisions of the preceding articles, as far as they are applicable, apply to the relationship between an autonomous worker or a trainee and the contracting undertaking and between contracting and contracted undertakings.

**Article 93** - The provisions of this Chapter, as far as they are applicable, apply to entities of the direct or indirect and foundational, federal, state or municipal, Public Administration.

**Sole Paragraph** - In the hypothesis of article 88, a reward corresponding to part of the value of the advantages obtained as a result of the application or the patent will be guaranteed to the inventor, under the terms and conditions provided for in the statutes or internal regulations of the entity to which this article refers.

## **TITLE II - INDUSTRIAL DESIGNS**

### **CHAPTER I - OWNERSHIP**

**Article 94** - The author is assured the right to obtain a registration of an industrial design that guarantees to him the property, under the terms established by this law.

**Sole Paragraph** - As far as they are applicable, the provisions of articles 6 and 7 will apply to the registration of industrial designs.

### **CHAPTER II - REGISTRABILITY**

#### ***Section I - Registrable Industrial Designs***

**Article 95** - An industrial design is considered to be any ornamental plastic form of an object or any ornamental arrangement of lines and colours that may be applied to a product, that provides a new and original visual result in its external configuration, and that may serve as a type for industrial manufacture.



**Article 96** - An industrial design is considered to be new when not comprised by the state of the art.

§ 1 - The state of the art comprises everything made accessible to the public before the date of filing of the application, in Brazil or abroad, by use or any other means, without prejudice to the provisions of § 3 of this article and of article 99.

§ 2 - For the sole purpose of determining novelty, the whole contents of an application for a patent or a registration filed in Brazil, but not yet published, will be considered as included in the state of the art from the date of filing, or from the priority claimed, provided that it is published, even though subsequently.

§ 3 - An industrial design of which disclosure occurred within the 180 (one hundred and eighty) days preceding the date of filing the application or of the priority claimed will not be considered as included in the state of the art, provided such disclosure is made in accordance with the situations provided for in items I to III of article 12.

**Article 97** - An industrial design is considered original when it results in a distinctive visual configuration in relation to other prior objects.

**Sole Paragraph** - The original visual result may be the result of the combination of known elements.

**Article 98** - Works of a purely artistic nature are not considered to be industrial designs.

### ***Section II – Priority***

**Article 99** - As far as they are applicable, the provisions of article 16, except for the time limit provided for in § 3 of that article, which will be 90 (ninety) days, apply to applications for registration.

### ***Section III - Non-Registrable Industrial Designs***

**Article 100** - An industrial design is not registrable for:

I - that which is contrary to morals and good customs or which offends the honour or image of people or is contrary to the liberty of conscience, belief, religious cults or ideas and feelings worthy of respect and veneration.

II - the necessary common or ordinary shape of an object or, further, that which is determined essentially by technical or functional considerations.

## **CHAPTER III - APPLICATIONS FOR REGISTRATION**

### ***Section I - Filing of the application***

**Article 101** - An application for registration, in accordance with conditions established by INPI, will contain:

I - a request;

II - a specification, if applicable;;

III - claims, if applicable;

IV - drawings or photographs;

V - the field of application of the object; and

VI - proof of payment of the filing fee.

**Sole Paragraph** - The documents that comprise an application for registration must be filed in the Portuguese language.

**Article 102** - Once presented, the application will be submitted to a formal preliminary examination and, if in due order, will be protocolled, the filing date being considered to be the date of presentation.

**Article 103** - An application that does not formally meet the requirements of article 101, but which does contain sufficient data relating to the applicant, to the industrial design and to the author, may be delivered to INPI against a dated receipt which will establish the requirements to be met within a period of 5 (five) days, on pain of being considered non-existent.

**Sole Paragraph** - Once the requirements have been met, filing will be considered to have been made on the date of presentation of the application.

### ***Section II - Conditions of the Application***

**Article 104** - An application for an industrial design registration must refer to a single object, a plurality of variations being permitted, provided that they are destined for the same purpose and maintain between them the same preponderant distinctive characteristic, each application being limited to a maximum of 20 (twenty) variations.

**Sole Paragraph** - The drawing must clearly and sufficiently represent the object and its variations, if they exist, so as to allow its reproduction by a person skilled in the art.

**Article 105** - When secrecy is requested under the terms of article 106, § 1, the application may be withdrawn up to 90 (ninety) days counted from the date of filing.

**Sole Paragraph** - Withdrawal of an earlier application without producing any effect will confer priority on the first later application.

### ***Section III - Prosecution and examination of an application***

**Article 106** - Once an application for an industrial design registration has been filed and the provisions of articles 100, 101 and 104 have been observed, it will be published automatically and the registration will be simultaneously granted, the respective certificate being issued.

§ 1 - On request by the applicant at the time of filing, the application may be kept secret for a period of 180 (one hundred and eighty) days counted from the filing date, after which it will be processed.

§ 2 - If the applicant avails himself of the provisions of article 99, processing of the application will await presentation of the priority document.

§ 3 - If the provisions of articles 101 and 104 are not met, a requirement will be made to which a response should be filed within 60 (sixty) days, on pain of definitive shelving.

§ 4 - If the provisions of article 100 are not met, the application for registration will be rejected.

## CHAPTER IV - GRANT AND TERM OF THE REGISTRATION

**Article 107** - The certificate must include the number and title, the name of the author, observing the provisions of § 4 of article 6, the name, nationality and domicile of the registrant, the term, the drawings, data relating to any foreign priority and, when applicable, the specification and claims.

**Article 108** - The registration will have a term of 10 (ten) years counted from the date of filing and will be renewable for three successive periods of 5 (five) years each.

§ 1 - An application for renewal must be made during the last year of the term of the registration and be accompanied by proof of payment of the respective fee.

§ 2 - If an application for renewal has not been requested prior to the end of the term of the registration, the registrant may make such request within the subsequent 180 (one hundred and eighty) days, on payment of an additional fee.

## CHAPTER V - PROTECTION CONFERRED BY A REGISTRATION

**Article 109** - The property in an industrial design is acquired by a validly granted registration.

**Sole Paragraph** - As far as applicable, the provisions of article 42 and of items I, II and IV of article 43, will apply.

**Article 110** - A person who in good faith, prior to the date of filing or of the priority of an application for registration, exploited the subject matter in this country, will be guaranteed the right to continue the exploitation in the previous manner and conditions, without onus.

§ 1 - The right conferred under the terms of this article can only be ceded, by transfer or leasing, together with the business or undertaking, or part thereof that has direct relation with the exploitation of the object of the registration.

§ 2 - The right to which this article refers will not be guaranteed to a person who had knowledge of the object of the registration due to disclosure under the terms of § 3 of article 96, provided that the application was filed within 6 (six) months from the disclosure.

## CHAPTER VI - EXAMINATION ON MERIT

**Article 111** - A registrant of an industrial design may, at any time during the term of registration, request examination as to novelty and originality of the object of the registration.

**Sole Paragraph** - INPI will issue an opinion on merit that will serve as the basis for the *ex officio* institution of nullity proceedings of the registration if it is concluded that at least one of the requirements provided for in articles 95 to 98 are absent.

## CHAPTER VII - NULLITY OF REGISTRATIONS

### *Section I - General Provisions*

**Article 112** - A registration is null if granted contrary to the provisions of this law.

§ 1 - Nullity of a registration will produce effects as from the date of filing of the application.

§ 2 - In the case of inobservance of the provisions of article 94, the author may alternatively claim adjudication of the registration.

### ***Section II***

#### ***Administrative Nullity Proceedings***

**Article 113** - Nullity of a registration will be declared administratively when it has been granted contrary to articles 94 to 98.

§ 1 - Nullity proceedings may be instituted *ex officio* or at the request of any person having a legitimate interest within 5 (five) years from grant of the registration, without prejudice to the hypothesis provided for in the sole paragraph of article 111.

§ 2 - A request or *ex officio* institution will suspend the effects of grant of a registration if presented or published within 60 (sixty) days from grant.

**Article 114** - The registrant will be notified to respond within 60 (sixty) days counted from the date of the publication.

**Article 115** - INPI will issue an opinion after the period specified in the previous article, whether there is a response or not, notifying the registrant and the applicant to respond within 60 (sixty) days.

**Article 116** - After the period specified in the previous article, even if no responses have been made, the process will be decided by the president of INPI, thereby bringing to a close the administrative instance.

**Article 117** - Nullity proceedings will be continued even when the registration is extinct.

### ***Section III - Nullity Action***

**Article 118** - As far as they are applicable, the provisions of articles 56 and 57 will apply to actions for nullity of a registration for an industrial design.

## **CHAPTER VIII - EXTINCTION OF REGISTRATIONS**

**Article 119** - A registration will become extinct:

I - on expiry of the term of protection;

II - on waiver by the registrant, without prejudice to the rights of third parties;

III - on non-payment of the fee, provided for in articles 108 and 120; or

IV - on non-observance of the provisions of article 217.

## **CHAPTER IX - QUINQUENNIAL FEE**

**Article 120** - The proprietor of a registration is subject to the payment of a quinquennial fee as of the second quinquennium from the filing date.

§ 1 - Payment of the second quinquennium will be made during the 5th (fifth) year of the term of the registration.

§ 2 - Payment of the following quinquennial fees will be presented together with the application for renewal referred to in article 108.

§ 3 - Payment of quinquennial fees may still be made within the 6 (six) months following the period established in the previous paragraph, by payment of an additional fee.

## **CHAPTER X - FINAL PROVISIONS**

**Article 121** - As far as they are applicable, the provisions of articles 58 to 63 apply to subject matter covered by the present Title, the rights of the employee or supplier of services being governed by the provisions of articles 88 to 93.

### **TITLE III - MARKS**

#### **CHAPTER I - REGISTRABILITY**

##### ***Section I - Signs Registrable as Marks***

**Article 122** - Any visually perceptible distinctive sign, when not prohibited under law, is susceptible of registration as a mark.

**Article 123** - For the effects of this law, the following definitions apply:

I - product or service mark: that used to distinguish a product or service from one having a different origin, that is identical, similar or akin;

II - certification mark: that used to attest that a product or service conforms with determined technical norms or specifications, notably with reference to its quality, its nature, the material used and the methodology employed; and

III - collective mark: that used to identify products or services originated by members of a given entity.

##### ***Section II - Signs Not Registrable as Marks***

**Article 124** - The following are not registrable as marks:

I - crests, armorial bearings, medals, flags, emblems, official public distinctions and monuments, be they national, foreign or international, as well as any respective designations, figures or imitations;

II - an isolated letter, digit or date, except when sufficiently distinctive;

III - expressions, figures, drawings or any other sign contrary to morals and good customs or which offend a person's honour or image or are an affront to the liberty of conscience, beliefs, religious cults or to ideas and sentiments worthy of respect and veneration;

IV - designations or acronyms of a public entity or establishment, when registration is not requested by that public entity or establishment;

V - reproductions or imitations of a characteristic or differentiating element of a title of establishment or the name of an undertaking belonging to a third party, which are likely to cause confusion or association with such distinctive signs;

VI - signs of a generic, necessary, common, usual or simply descriptive character, when related to the product or service to be distinguished, or those commonly used to designate a characteristic of the product or service with respect to its nature, nationality, weight, value, quality and moment of production or of giving a service, except when presented in a sufficiently distinctive manner;

- VII - signs or expressions used only as a means of advertising;
- VIII - colours and their names, except when arranged or combined in an unusual and distinctive manner;
- IX - geographic indications, imitations thereof likely to cause confusion or signs that might falsely suggest a geographic indication;
- X - signs that suggest a false indication with respect to origin, source, nature, quality or utility of the product or service to which the mark is directed;
- XI - reproductions or imitations of official seals, normally adopted for the guarantee of a standard of any type or nature;
- XII - reproductions or imitations of signs that have been registered as a collective or a certification mark by a third party, without prejudice to the provisions of article 154;
- XIII - names, prizes or symbols of sporting, artistic, cultural, social, political, economic or technical official or officially recognised events, as well as imitations likely to cause confusion, except when authorised by the competent authority or entity promoting the event;
- XIV - reproductions or imitations of titles, bonds, coins and bank notes of the Union, the States, the Federal District, the Territories, the Municipalities or of any country;
- XV - personal names or signatures thereof, family or patronymic names and images of third parties, except with the consent of the owner, his heirs or his successors;
- XVI - well-known pseudonyms or nicknames and singular or collective artistic names, except with the consent of the owner, his heirs or his successors;
- XVII - literary, artistic or scientific works, as well as titles protected by copyright and likely to cause confusion or association, except with the consent of the author or owner;
- XVIII - technical terms used in the industry, science or art that is related to the product or service to be distinguished;
- XIX - reproductions or imitations, in whole or in part, even with additions, of a mark registered by a third party, to distinguish or certify a product or service that is identical, similar or akin, and which are likely to cause confusion or association with the third party's mark;
- XX - duplications of marks of a single proprietor for the same product or service, except when, in the case of marks of the same nature, they are presented in a sufficiently distinctive manner;
- XXI - necessary, common or usual shapes of a product or of its packaging, or, furthermore, shapes that cannot be disassociated from a technical effect;
- XXII - objects that are protected by industrial design registrations in the name of third parties; and
- XXIII - signs that imitate or reproduce, wholly or in part, a mark of which the applicant could obviously not fail to have knowledge in view of his activity, and of which the proprietor is established or domiciled in the national territory or in a country with which Brazil maintains an agreement or guarantees reciprocity of treatment, if the mark is intended to distinguish a product or service that is identical, similar or akin, and is likely to cause confusion or association with such third party mark.

### *Section III - Famous Marks*

**Article 125** - Marks registered in Brazil and considered to be famous will be guaranteed special protection, in all fields of activity.

### ***Section IV - Well-Known Marks***

**Article 126** - Marks that are well-known in their field of activity in the terms of article 6 bis (1) of the Paris Convention for the Protection of Industrial Property will enjoy special protection, independently of whether they have been previously filed or registered in Brazil.

§ 1 - The protection to which this article refers is also applicable to service marks.

§ 2 - INPI may reject *ex officio* an application to register a mark that wholly or partially reproduces or imitates a well-known mark.

## **CHAPTER II -PRIORITY**

**Article 127** - Priority rights will be guaranteed to an application for the registration of a mark filed in a country that maintains an agreement with Brazil or in an international organisation, that produces the effect of a national filing, within the time limits established in the agreement, the filing not being invalidated nor prejudiced by facts that occur within such time limits.

§ 1 - The priority claim must be made at the time of filing, but may be supplemented within 60 (sixty) days by other priorities earlier than the date of filing in Brazil.

§ 2 - A priority claim must be proved by means of a suitable document of origin, containing the number, date and reproduction of the application or of the registration, accompanied by a simple translation, the contents of which will be of the entire responsibility of the applicant.

§ 3 - If not effected at the time of filing, the proof must be presented within 4 (four) months from filing, under pain of loss of the priority.

§ 4 - When the priority is obtained by virtue of assignment, the corresponding document must be filed together with the priority document itself.

## **CHAPTER III - APPLICANTS FOR REGISTRATION**

**Article 128** - Private individuals or private or public legal entities may apply for the registration of a mark.

§1 - Private legal entities may only request the registration of a mark relating to the activity that they effectively and licitly exercise directly or through undertakings that they control directly or indirectly, such condition having to be declared on the actual request, subject to the penalties of the law.

§2- The registration of a collective mark may only be requested by a legal entity representing a group and able to exercise an activity different from that of its members.

§3 - The registration of a certification mark can only be requested by a person without any direct commercial or industrial interest in the product or service being certified.

§4 - A priority claim does not exempt the application from the provisions of this Title.

## **CHAPTER IV - RIGHTS RELATING TO A MARK**

### ***Section I – Acquisition***

**Article 129** - The property in a mark is acquired by a validly granted registration, in accordance with the provisions of this law, the owner being guaranteed exclusive use thereof throughout the national territory, without prejudice to the provisions of articles 147 and 148 with respect to collective and certification marks.

§1 - Any person who in good faith at the date of priority or of the application was using an identical or similar mark for at least 6 (six) months in the country, to distinguish or certify a product or service that is identical, similar or akin, will have preferential right to registration.

§2 - The preferential right can only be ceded, by transfer or leasing, together with the business of an undertaking, or part thereof, that has a direct relation to the use of the mark.

### ***Section II - Protection afforded by a Registration***

**Article 130** - The registrant of, or applicant for, a mark is also guaranteed the right to:

I - assign his registration or application for registration;

II - license its use;

III - care for its material integrity or reputation.

**Article 131** - The protection afforded by this law extends to the use of the mark on papers, printed matter, advertisements and documents related to the activity of the owner.

**Article 132** - The owner of a mark may not:

I - prevent tradesmen or distributors from using distinctive signs that belong to them, together with the mark of the product for its promotion and commercialisation;

II - prevent manufacturers of accessories from using the mark to indicate the use of the product, provided they obey fair competition practices;

III - prevent the free circulation of products placed on the internal market by himself or by another with his consent, without prejudice to the provisions of §§ 3 and 4 of article 68; and

IV - prevent the mention of the mark in speeches, scientific or literary works or in any other type of publication, provided that it is without any commercial connotation and without prejudice to its distinctive character.

## **CHAPTER V - TERM, ASSIGNMENT AND NOTATIONS**

### ***Section I - Term***

**Article 133** - The registration of a mark will have a term of 10 (ten) years counted from the date of its grant, it being renewable for equal and successive periods.

§ 1 - An application for renewal must be made during the last year of the term of the registration and must be accompanied by proof of payment of the respective fee.

§ 2 - If the request for renewal has not been made by the end of the registration, the proprietor may make such request within the following 6 (six) months on payment of an additional fee.

§ 3 - Renewal will not be granted if the provisions of article 128 are not met.



### *Section II - Assignment*

**Article 134** - Applications for registration and registrations may be assigned, provided that the assignee meets the legal requirements for requesting such registration.

**Article 135** - An assignment must include all the registrations or applications, in the name of the assignor, for identical or similar marks relating to a product or service that is identical, similar or akin, on the pain of cancellation of the registrations or shelving of the unassigned applications.

### *Section III – Notations*

**Article 136** - INPI will make a note of the following:

- I - assignments, indicating the complete qualification of the assignee;
- II - any limitation or onus on the application or registration; and
- III - alterations of the name, headquarters or address of the applicant or registrant.

**Article 137** - Notations will produce effect with respect to third parties as from the date of their publication.

**Article 138** - Appeals may be filed against a decision which:

- I - rejects the notation of assignment; and
- II - cancels the registration or shelves the application under the terms of article 135.

### *Section IV - Licence of Use*

**Article 139** - The proprietor of a registration or the applicant of an application for registration may enter into a licence contract for use of the mark, without prejudice to his right to exercise effective control over the specifications, nature and quality of the respective products or services.

**Sole Paragraph** - The licensee may be invested by the registrant with full powers to act in defence of the mark, without prejudice to his own rights.

**Article 140** - Licence contracts must be recorded at INPI in order to produce effect with respect to third parties.

§ 1 - Recordals will produce effect with respect to third parties as from the date of their publication.

§ 2 - In order to validate proof of use, licence contracts need not be recorded at INPI.

**Article 141** - An appeal may be filed against a decision rejecting the recordal of a license agreement.

## **CHAPTER VI - LOSS OF RIGHTS**

**Article 142** - The registration of a mark will become extinct:

- I - on expiry of the term of protection;

- II - on waiver, which may be total or partial with respect to the products or services indicated by the mark;
- III - by forfeiture; or
- IV - for failure to observe the provisions of article 217.

**Article 143** - A registration will become forfeit, on the request of any person with a legitimate interest, if, after 5 (five) years from its grant, on the date of such request:

I - use of the mark in Brazil has not been initiated; or

II - use of the mark has been interrupted for more than 5 (five) consecutive years or if, within that time, the mark has been used in a modified form that implies alteration in its original distinctive character, as found on the certificate of registration.

§ 1 - The mark will not become forfeit if the registrant justifies the lack of use for legitimate reasons.

§ 2 - The registrant will be notified to reply within a period of 60 (sixty) days, the onus falling on him to prove the use of the mark or justify its lack of use for legitimate reasons.

**Article 144** - Use of the mark must include products or services mentioned on the certificate, under penalty of partial forfeiture of the registration with respect to those products or services not similar or akin to those for which use of the mark has been proved.

**Article 145** - No recognition will be given to requests for forfeiture if use of the mark has been proved or if its lack of use has been justified in an earlier procedure requested less than 5 (five) years previously.

**Article 146** - An appeal may be filed against a decision which either declares or rejects forfeiture.

## **CHAPTER VII - COLLECTIVE AND CERTIFICATION MARKS**

**Article 147** - An application for the registration of a collective mark must include regulations of use, determining the conditions and prohibitions for use of the mark.

**Sole Paragraph** - The regulations of use, when they do not accompany the application, must be protocolled within a period of 60 (sixty) days from filing, under pain of definitive shelving of the application.

**Article 148** - An application for the registration of a certification mark must include:

I - the characteristics of the product or the service to be certified; and

II - the measures of control that are to be adopted by the registrant.

**Sole Paragraph** - The documentation foreseen in items I and II of this article, when not accompanying the application, must be protocolled within a period of 60 (sixty) days, under pain of definitive shelving of the application.

**Article 149** - Any alteration in the regulations of use must be communicated to INPI, by means of a duly protocolled petition, containing all the altered conditions, under pain of it not being considered.

**Article 150** - Use of the mark will be independent of a license, it being sufficient for its authorisation to be contained in the regulations of use.

**Article 151** - Apart from the grounds for extinction established in article 142, registrations for collective and certification marks will become extinct when:

I - the entity ceases to exist; or

II - the mark is used under conditions that differ from those foreseen in the regulations of use.

**Article 152** - Waiver of a registration for a collective mark will only be admitted when requested in accordance with the terms of the articles of association or statutes of the entity itself or, further, in accordance with the regulations of use.

**Article 153** - Forfeiture of the registration will be declared if the collective mark is not used by more than one authorised person, without prejudice to the provisions of articles 143 to 146.

**Article 154** - Collective marks and certification marks that have already been used and the registrations of which have become extinct may not be registered in the name of a third party, prior to the expiry of a period of 5 (five) years counted from the extinction of the registration.

## CHAPTER VIII -FILING

**Article 155** - The application must refer to a single distinctive sign and, in accordance with the conditions established by INPI, must contain:

I - a request

II - prints, when applicable; and

III - proof of payment of the filing fee.

**Sole Paragraph** - the request and any documents that accompany it must be presented in the Portuguese language and, whenever there is a document in a foreign language, a simple translation must be presented at the time of filing the application or within the following 60 (sixty) days, on pain of the document not being taken into consideration.

**Article 156** - Once the application has been filed, it will be submitted to a preliminary formal examination and, if in due order, will be protocolled, the filing date being considered to be the date of its presentation.

**Article 157** - Applications that do not formally meet the provisions of article 155, but which contain sufficient data relating to the applicant, the sign of the mark and the class, may be delivered to INPI, against a dated receipt which will establish the requirements to be met by the applicant within 5 (five) days, on pain of being considered non-existent.

**Sole Paragraph** - Once the requirements have been met, the filing will be considered as having been made on the date of presentation of the application.

## CHAPTER IX - EXAMINATION

**Article 158-** Once protocolled, the application will be published for the filing of oppositions within a period of 60 (sixty) days.

§ 1 - The applicant will be notified of the opposition and may respond within a period of 60 (sixty) days.

§ 2 - Oppositions, administrative nullity procedures and nullity actions based on item XXIII of article 124, or article 126 will not be recognised if proof of the filing of an application for the registration of the mark in accordance with this law is not provided within 60 (sixty) days after filing the opposition or nullity procedure or action.

**Article 159** - Once the period for opposition has passed or, if such has been filed, after the period for reply, examination will be conducted during which requirements may be formulated, which must be responded to within a period of 60 (sixty) days.

§ 1 - If no response to a requirement is filed, the application will be definitively shelved.

§ 2 - Once a response has been filed, even if the requirement has not been met or the formulation thereof has been contested, examination will continue.

**Article 160** - Once examination has been concluded, a decision will be issued, allowing or rejecting the application for registration.

## CHAPTER X - ISSUANCE OF CERTIFICATES OF REGISTRATIONS

**Article 161** - A certificate of registration will be granted after the application has been allowed and payment of the corresponding fees has been proved.

**Article 162** - The payment of the fees and the respective proof thereof, relating to the issuance of the certificate of registration and the first ten year period of protection, must be effected within 60 (sixty) days counted from allowance.

**Sole Paragraph** - The fees may still be paid and proved within 30 (thirty) days after the period mentioned in this article, independently of notification, by payment of a specific fee, on pain of definitive shelving of the application.

**Article 163** - The certificate of registration will be considered to have been granted on the date of publication of the corresponding act.

**Article 164** - The certificate will mention the mark, the number and date of the registration, the name, nationality and domicile of the registrant, the products or services, the characteristics of the registration and the foreign priority.

## CHAPTER XI - NULLITY OF REGISTRATIONS

### *Section I - General Provisions*

**Article 165** - A registration is null if granted contrary to the provisions of this law.

**Sole Paragraph** - Nullity of a registration may be total or partial, it being a condition for partial nullity that the remaining part can be considered registrable.

**Article 166** - The proprietor of a mark registered in a country that is signatory to the Paris Convention for the Protection of Industrial Property may, alternatively, by means of a court action, claim adjudication of the registration, in accordance with the terms of article 6 "septies"(1) of the Convention.

**Article 167** - A declaration of nullity will produce effect as from the date of filing of the application.

### ***Section II - Administrative Nullity Procedure***

**Article 168** - Nullity of a registration may be declared administratively if it was granted in conflict with the provisions of this law.

**Article 169** - A nullity procedure may be commenced *ex officio* or on the request of any person with a legitimate interest, within 180 (one hundred and eighty) days counted from the date of issuance of the certificate of registration.

**Article 170** - The registrant will be notified to respond within a period of 60 (sixty) days.

**Article 171** - Once the period referred to in the previous article has passed and even if no response has been presented, the procedure will be decided by the President of INPI, thereby terminating the administrative instance.

**Article 172** - The nullity proceedings will be continued even if the registration is extinct.

### **Section III - Nullity Actions**

**Article 173** - A nullity action may be filed by INPI or by any person with a legitimate interest.

***Sole Paragraph*** - The judge may, in the course of the proceedings, grant an injunction suspending the effects of the registration and of the use of the mark, provided the appropriate procedural requirements are met.

**Article 174** - The limitation for bringing an action for declaring the nullity of a registration is 5 (five) years counted from the date of registration.

**Article 175** - Nullity actions must be brought before the Federal Courts of Justice and INPI, when it is not the plaintiff, will participate in the action.

§ 1 - The period for reply by a defendant that is a registrant will be 60 (sixty) days.

§ 2 - Once the decision in a nullity action is *res judicata*, INPI will publish a note for the information of third parties.

## **TITLE IV - GEOGRAPHICAL INDICATIONS**

**Article 176** - A geographical indication is constituted by an indication of source or an appellation of origin.

**Article 177** - An indication of source is considered to be the geographical name of a country, city, region or locality of its territory, which has become known as a centre of extraction, production or manufacture of a determined product or for providing a determined service.

**Article 178** - An appellation of origin is considered to be the geographical name of a country, city, region or locality of its territory, which designates a product or service, the qualities or characteristics of which are exclusively or essentially due to the geographical environment, including natural and human factors.

**Article 179** - Protection is extended to the graphical or figurative representation of a geographical indication, as well as to the geographical representation of the country, city, region or locality of its territory of which the name is a geographical indication.

**Article 180** - When a geographical name comes into common use, with respect to a given product or service, it will not be considered as a geographical indication.

**Article 181** - A geographical name that does not constitute an indication of source or an appellation of origin may serve as a characteristic element of a product or service mark, provided that it does not suggest a false source.

**Article 182** - The use of a geographical indication is restricted to the producers and providers of services established in the locality, quality requirements also having to be met in relation to appellations of origin.

**Sole Paragraph** - INPI will establish the conditions of registration for geographical indications.

## **TITLE V - CRIMES AGAINST INDUSTRIAL PROPERTY**

### **CHAPTER I - CRIMES AGAINST PATENTS**

**Article 183** - A crime is committed against a patent of invention or a utility model patent by he who:

I - manufactures a product that is the subject matter of a patent of invention or a utility model patent, without authorisation of the patentee; or

II - uses a means or process that is the subject matter of a patent of invention, without authorisation of the patentee.

Penalty - detention of 3 (three) months to 1 (one) year, or a fine.

**Article 184** - A crime is committed against a patent of invention or a utility model patent by he who:

I - exports, sells, exhibits or offers for sale, maintains in stock, hides or receives, with a view to use for economic purposes, a product manufactured in violation of a patent of invention or of a utility model patent, or that is obtained by a patented means or process; or

II - imports a product that is the subject matter of a patent of invention or of a utility model patent or is obtained by a means or process patented in this country, for the purposes mentioned in the previous item, and that has not been placed on the external market directly by the proprietor or with his consent.

Penalty - detention of 1 (one) to 3 (three) months, or a fine.

**Article 185** - Supplying a component of a patented product, or material or equipment for carrying out a patented process, provided that the final application of the component, material or equipment necessarily leads to the exploitation of the subject matter of the patent.

Penalty - detention of 1 (one) to 3 (three) months or a fine.

**Article 186**- The crimes of this Chapter are committed even if the violation does not affect all the claims of the patent or if it is restricted to the use of means equivalent to the subject matter of the patent.

## **CHAPTER II - CRIMES AGAINST INDUSTRIAL DESIGNS**

**Article 187** - Manufacturing, without the authorisation of the registrant, a product that incorporates a registered industrial design, or a substantial imitation thereof that may lead to error or confusion.

Penalty - detention of 3 (three) months to 1 (one) year, or a fine.

**Article 188** - A crime is committed against an industrial design registration by he who:

I - exports, sells, exhibits or offers for sale, maintains in stock, hides or receives, with a view to use for economic purposes, an object that illicitly incorporates a registered industrial design, or a substantial imitation thereof that may lead to error or confusion; or  
 II - imports a product that incorporates an industrial design registered in this country, or a substantial imitation thereof that may lead to error or confusion, for the purposes provided for in the previous item, and which was not placed on the external market directly by the registrant or with his consent.

Penalty - detention of 1 (one) to 3 (three) months, or a fine.

## **CHAPTER III - CRIMES AGAINST MARKS**

**Article 189** - A crime is committed against the registration of a mark by he who:

I - reproduces a registered mark wholly or in part, without the authorisation of the registrant, or imitates it in a manner that may induce confusion; or  
 II - alters the registered mark of a third party already applied to a product placed on the market.

Penalty - detention of 3 (three) months to 1 (one) year, or a fine.

**Article 190** - A crime is committed against the registration of a mark by he who imports, exports, sells, offers or exhibits for sale, hides or maintains in stock:

I - a product branded with an illicitly, wholly or partially, reproduced or imitated mark of a third party; or  
 II - a product from his industry or commerce, held in a vessel, container or package carrying a legitimate mark of a third party.

Penalty - detention of 1 (one) to 3 (three) months, or a fine.

#### **CHAPTER IV - CRIMES COMMITTED BY MEANS OF MARKS, TITLES OF ESTABLISHMENT AND ADVERTISING SIGNS**

**Article 191** - Reproducing or imitating wholly or in part, in a manner that may lead to error or confusion, armorial bearings, crests or official public distinctions, be they national, foreign or international, without the necessary authorisation, in a mark, title of establishment, commercial name, insignia or advertising sign, or using such reproductions or imitations for economic purposes.

Penalty - detention of 1 (one) to 3 (three) months, or a fine.

**Sole Paragraph** - He who sells or exhibits or offers for sale products branded with such marks are subject to the same penalty.

#### **CHAPTER V - CRIMES AGAINST GEOGRAPHICAL AND OTHER INDICATIONS**

**Article 192** - Manufacturing, importing, exporting, selling, exhibiting or offering for sale or maintaining in stock a product that presents a false geographical indication.

Penalty - detention of 1 (one) to 3 (three) months, or a fine.

**Article 193** - Using, on a product, container, casing, belt, label, invoice, circular, poster or on any other means of disclosure or advertisement, indicative terms, such as "type", "species", "kind", "system", "similar", "substitute", "identical", or the equivalent, without making clear the true source of the product.

Penalty - detention of 1 (one) to 3 (three) months, or a fine.

**Article 194** - Using a mark, commercial name, title of establishment, insignia, advertising expression or sign or any other form that indicates a source other than the true one, or selling or exhibiting for sale a product carrying such signs.

Penalty - detention of 1 (one) to 3 (three) months, or a fine.

#### **CHAPTER VI - CRIMES OF UNFAIR COMPETITION**

**Article 195** - A crime of unfair competition is committed by he who:

I - publishes, by any means, a false affirmation, in detriment to a competitor, with a view to obtaining advantage;

II - provides or divulges, with respect to a competitor, false information, with a view to obtaining advantage;

III - uses fraudulent means to divert, for his own or a third party's benefit, another's clientele;

IV - uses another's advertising expression or sign, or imitates it, in a manner to cause confusion between the products or establishments;

V - unduly uses another's commercial name, title of establishment or insignia or sells, exhibits or offers for sale or maintains in stock a product with such references;

VI - substitutes, with his own name or company name, on a product of another party, the name or company name of such other party, without his consent.

VII - claims, as a means of advertising, to have received a prize or distinction that he did not obtain;



VIII - sells, exhibits or offers for sale, in another's container or package, an adulterated or falsified product, or uses it to do business with a product of the same type, even if not adulterated or falsified, if the fact does not constitute a more serious crime;

IX - gives or promises money or other utility to the employee of a competitor, whereby that employee, in failing in his duty in his employment, provides him with an advantage;

X - receives money or other utility, or accepts a promise of payment or reward, for, in failing in his duty in his employment, providing a competitor with an advantage;

XI - discloses, exploits or uses, without authorisation, confidential knowledge, information or data, usable in industry, commerce or the providing of services, excepting that which is of public knowledge or which is obvious to a person skilled in the art, to which he has had access by means of a contractual or employment relationship, even after the termination of the contract;

XII - discloses, exploits or uses, without authorisation, knowledge or information as mentioned in the previous item, when obtained directly or indirectly by illicit means or to which he has had access by fraud;

XIII - sells, exhibits or offers for sale a product which he declares to be subject of a patent filed or granted or of a registered industrial design, when it is not, or mention it, in a commercial announcement or paper, as filed or patented or registered, when it is not; or

XIV - divulges, exploits or uses, without authorisation, the results of tests or other undisclosed data the elaboration of which involved considerable effort and which has been presented to government entities as a condition for approving the commercialisation of products.

Penalty - detention of 3 (three) months to 1 (one) year, or a fine.

§ 1 - The employer, partner or administrator of an undertaking that commits an act falling within the types of crime established in items XI and XII of this article are included in the hypotheses to which such items refer.

§ 2 - The provisions of item XIV do not apply with respect to disclosure by a government entity competent to authorise commercialisation of a product, when necessary to protect the public.

## **CHAPTER VII - GENERAL PROVISIONS**

**Article 196** - The penalties of detention provided for in Chapters I, II and III of this Title will be increased by one third to one half when:

I - the party is or was a representative, proxy, agent, partner or employee of the patentee or registrant or, further, of his licensee; or

II - the altered, reproduced or imitated mark is famous, is well-known or is a certification or collective mark.

**Article 197** - The penalties of fines provided for in this Title will be fixed at a minimum of 10 (ten) and a maximum of 360 (three hundred and sixty) days-fine, in accordance with the Criminal Code system.

**Sole Paragraph** - The fine may be increased or reduced by up to 10 (ten) times in view of the personal conditions of the agent and of the magnitude of the advantage obtained, independently of the provisions established in the previous article.

**Article 198** - The customs authorities, *ex officio* or at the request of an interested party, may seize, at the time of checking, any products carrying falsified, altered or imitated marks or a false indication of source.

**Article 199** - An action against crimes provided for in this Title will be brought through the filing of a complaint, except in the case of the crime of article 191, in which case the criminal action will be public.

**Article 200** - Criminal actions and preliminary measures of search and seizure, in the case of crimes against industrial property, will be regulated by the provisions of the Criminal Process Code, with the modifications present in the articles of this Chapter.

**Article 201** - During execution of a search and seizure measure, with respect to a crime against a patent relating to a process, the baliff will be accompanied by an expert who will verify, preliminarily, the existence of the illicit act, the judge being able to order the seizure of products obtained by the infringer using the patented process.

**Article 202** - Apart from the preliminary measures of search and seizure, the interested party may request:

I - seizure of a falsified, altered or imitated mark at its place of preparation or where it is found, prior to use for criminal purposes; or

II - destruction of a falsified mark on packets or products that contain it, before they are distributed, even if the packages or even the products themselves are destroyed.

**Article 203** - In the case of legally organised and publicly functioning industrial or commercial establishments, the preliminary measures will be limited to the inspection and seizure of the products, when so ordered by the judge, it not being permitted to paralyse their legally exercised activity.

**Article 204** - Once a search and seizure measure has been carried out, he who requested it in bad faith, in a spirit of rivalry, mere caprice or gross error will be liable for losses and damages.

**Article 205** - An allegation of nullity of the patent or registration on which the action is based may constitute matter of defence in a criminal action. Absolution of the defendant, however, will not signify nullity of the patent or registration which can only be requested in an action before the competent courts.

**Article 206** - If, in the course of a court action, information is revealed that is of a confidential nature, be it an industrial or a trade secret, the judge must determine that the action continues "in camera", the use of such information by the other party for other purposes also being forbidden.

**Article 207** - Independently of the criminal action, the aggrieved party may file civil actions that he considers suitable, as laid down in the Civil Process Code.

**Article 208** - Compensation will be determined by the benefits that the injured party would have gained had the violation not occurred.

**Article 209** - The aggrieved party is reserved the right to receive losses and damages in compensation for losses caused by acts of violation of industrial property rights and acts of unfair competition that are not provided for in this law but which tend to prejudice another's reputation or business or to cause confusion between commercial or industrial establishments or providers of services, or between products and services placed on the market.

§ 1 - The judge may, in the formal record of the same action, so as to avoid irreparable damages or damages that would be difficult to recover, grant an injunctive order to suspend the violation or act that has such in view, before summoning the defendant, against, if he judges necessary, monetary caution or a fiduciary guarantee.

§ 2 - In the case of flagrant reproduction or imitation of a registered mark, the judge may determine the seizure of all the merchandise, products, objects, packages, labels and others that carry the falsified or imitated mark.

**Article 210** - Loss of profits will be determined by the most favourable to the injured party of the following criteria.

I - The benefits that would have been gained by the injured party if the violation had not occurred;

II - The benefits gained by the author of the violation of the rights; or

III - The remuneration that the author of the violation would have paid to the proprietor of the violated rights for a granted license which would have legally permitted him to exploit the subject of the rights.

## **TITLE VI - TRANSFER OF TECHNOLOGY AND FRANCHISING**

**Article 211**- INPI will effect the recordal of contracts that involve transfer of technology, franchising contracts and the like so that they may produce effect with respect to third parties.

**Sole Paragraph** - A decision with respect to applications for the recordal of contracts of the type to which this article refers will be given within a period of 30 (thirty) days counted from the date of the application for recordal.

## **TITLE VII - GENERAL PROVISIONS**

### **CHAPTER I - APPEALS**

**Article 212** - In the absence of express provisions to the contrary, appeals may be filed against decisions provided for in this law, within a period of 60 (sixty) days.

§ 1 - Appeals will be received with suspensive and full devolutive effects, all provisions pertinent to examination in the first instance, in so far as they are applicable, being applied.

§ 2 - An appeal can not be filed against a decision which determines the definitive shelving of an application for a patent or for a design registration or against that which allows an application for a patent, a certificate of addition or the registration of a mark.

§ 3 - The appeals will be decided by the President of INPI, thus ending the administrative instance.

**Article 213** - Interested parties will be notified to file counter-arguments to the appeal, within a period of 60 (sixty) days.

**Article 214** - For the purposes of complementing the arguments of the appeal brief, INPI can make requirements, which should be met within the period of 60 (sixty) days.

**Sole paragraph** - Once the period defined in the "caput" has passed, a decision on the appeal will be given.

**Article 215** - An appeal decision is final with no right to appeal in the administrative instance.

## CHAPTER II - ACTS OF THE PARTIES

**Article 216**- The acts provided for in this law will be practised by the parties or by their attorneys who should be duly qualified.

§ 1 - Powers of attorney, in the form of an original, an official copy or an authenticated photocopy, must be in the Portuguese language, consular legalisation and notarial recognition being waived.

§ 2 - The power of attorney must be filed within 60 (sixty) days counted from the practice of the first act by the party in the process, independently of notification or requirement, on pain of shelving, the shelving of a patent application, an application for registration of an industrial design or an application for the registration of a mark being definitive.

**Article 217** - A person domiciled abroad must maintain permanently a duly qualified attorney resident in the country, with powers to represent him administratively and judicially, including for receiving summons.

**Article 218** - Petitions will not be recognised:

I - when presented after the legal deadline; or

II - when they are not accompanied by proof of payment of the respective fee having the value in force at the date of their presentation.

**Article 219** - Petitions, oppositions and appeals shall not be recognised when:

I - presented after the period provided for in this law;

II - not having legal basis; or

III - not accompanied by proof of payment of the respective fee.

**Article 220** - INPI will make use of the acts of the parties, whenever possible, making any applicable requirements.

## CHAPTER III - TIME LIMITS

**Article 221** - The time limits established in this law are continuous, the right to carry out the act becoming automatically extinct on their termination, unless the party proves that it was not carried out for legitimate reasons.

§ 1 - A legitimate reason is considered to be an unforeseen event, outside the control of the party and which prevented the party from carrying out the act.

§ 2 - When legitimate reasons are recognised, the party will carry out the act within the period granted by INPI.

**Article 222** - In calculating time limits, the first day should be excluded and the last day included.

**Article 223** - Time limits only begin to run from the first working day after notification which will be made by publication in the official means of communication of INPI.

**Article 224** - In the absence of express stipulation in this law, time limits for practising acts will be 60 (sixty) days.

#### **CHAPTER IV - LIMITATIONS**

**Article 225** - The limitation for actions for repairing damages caused to industrial property rights is 5 (five) years.

#### **CHAPTER V - ACTS OF INPI**

**Article 226** - Acts of INPI in administrative processes relating to industrial property will only produce effect as from their publication in the respective official means of communication, except:

I - those which expressly do not depend on notification or publication by virtue of the provisions of this law;

II - administrative decisions when notification is made by post or knowledge is given to the party interested in the process; and

III - internal opinions and despatches that do not need to be known by the parties.

#### **CHAPTER VI - CLASSIFICATIONS**

**Article 227** - Classifications relative to the subject matter of Titles I, II and III of this law will be established by INPI, when they are not determined in an international treaty or agreement in force in Brazil.

#### **CHAPTER VII - FEES**

**Article 228** - Fees will be charged for the services provided for in this law, the values and manner of collection of which will be established by act of the head officer of the federal public administrative entity to which INPI is bound.

#### **TITLE VIII - TRANSITORY AND FINAL PROVISIONS**

**Article 229** - To the application in progress it will be applied the disposals of this Law, except to the patentability of the application filled until December 31st, 1994, whose object of protection be substances, products or substances that result from chemical processes or

substances, products, mixtures or nourishing, pharmaceutical-chemistry and medicine products of any kind, as well as the respective obtaining or modifying processes and whose applicants have not exerted the faculty foreseen on articles 230 and 231 of this Law, which will be considered dismissed for all effects, having the INPI communicated the information on the mentioned dismissals.<sup>1</sup>

Sole paragraph. To the application related to pharmaceutical products and chemical products to agriculture that have been filed between January 1<sup>st</sup>, 1995, and May 14<sup>th</sup>, 1997, it will be applied the patentability criteria of this Law, on the date accomplished the deposited application in Brazil or priority, if there is, assuring the protection from the date of the patent granting, for the remaining term to be counted from the day of the deposit in Brazil, limited to the term foreseen in the caption on article 40.

Article 229 – A. The patent filling of processes presented between January 1<sup>st</sup>, 1995, and May 14<sup>th</sup>, 1997, to which article 9, item “c”, of Law n° 5.772, of December 21<sup>st</sup>, 1971, did not grant protection are considered not granted, having the INPI communicated the information on the mentioned dismissals.

Article 229 – B. The patent filling of products presented between January 1<sup>st</sup>, 1995, and May 14<sup>th</sup>, 1997, to which article 9, items “b” and “c” of Law n° 5.772, 1971, did not grant protection and whose applicants have not exerted the faculty foreseen on articles 230 and 231, will be decided until December 31<sup>st</sup>, 2004, according to this Law.

Article 229 – C. The patent granting to pharmaceutical products and processes will depend on previous allowance of the National Agency on Sanitarian Surveillance – ANVISA.<sup>2</sup>

**Article 230** - A patent application may be filed relating to substances, matter or products obtained by chemical means or processes and alimentary and chemical-pharmaceutical substances, matter, mixtures or products and medicaments of any type, as well as the respective processes of obtaining or modifying them, by he who has protection guaranteed by treaty or convention in force in Brazil, the date of the first foreign filing being recognized, provided that its subject matter has not been placed on any market on the direct initiative of the proprietor or by third parties with his consent, nor have third parties carried out, in this country, serious and effective preparations for exploiting the subject matter of the application or patent.

§ 1 - The application must be filed within the period of 1 (one) year from the publication of this law and must indicate the date of the first application filed abroad.

§ 2 - Patent applications filed on the basis of this article will be published automatically, interested parties having the right to intervene, within a period of 90 (ninety) days, with respect to whether the conditions of the "caput" of this article have been met.

§ 3 - Without prejudice to articles 10 and 18 of this law, and once the conditions established in this article have been met and grant of a patent in the country where the first

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<sup>1</sup> Changes made by Law n° 10.196, of January 14th, 2001.

<sup>2</sup> Sole paragraph, articles 229 A, B and C included by Law n° 10.196, of January 14<sup>th</sup>, 2001.

application was filed has been proved, the patent will be granted in Brazil, exactly as granted in the country of origin.

§ 4 - A patent granted on the basis of this article will be guaranteed the remainder of the term of protection in the country where the first application was filed, counted from the date of filing in Brazil and limited to the term defined in article 40, the provisions of the sole paragraph thereof not being applicable.

§ 5 - An applicant that has a pending application, relating to substances, matter or products obtained by chemical means or processes and alimentary and chemical-pharmaceutical substances, matter, mixtures or products and medicaments of any type, as well as the respective processes of obtaining or modifying them, may file a new application, within the time period and under the conditions established in this article, submitting proof of desistance of the pending application.

§ 6 - The provisions of this law will apply, where applicable, to applications filed and to patents granted in accordance with this article.

**Article 231** - A patent application may be filed relating to the matter to which the previous article refers by a national or a person domiciled in the country, the date of disclosure of the invention being guaranteed, provided that its subject matter has not been placed on any market on the direct initiative of the owner or by third parties with his consent, nor have third parties carried out, in this country, serious and effective preparations for exploiting the subject matter of the application.

§ 1 - The application must be filed within the period of 1 (one) year from the publication of this law.

§ 2 - Patent applications filed on the basis of this article will be processed in accordance with the terms of this law.

§ 3 - A patent granted on the basis of this article will be guaranteed the remainder of the term of protection of 20 (twenty) years from the date of disclosure of the invention, counted from the date of filing in Brazil.

§ 4 - An applicant that has a pending application, relating to the matter to which the previous article refers, may file a new application, within the time period and under the conditions established in this article, submitting proof of desistance of the pending application.

**Article 232** - The production or use, under the terms of the previous legislation, of substances, matter or products obtained by chemical means or processes and alimentary and chemical-pharmaceutical substances, matter, mixtures or products and medicaments of any type, as well as the respective processes of obtaining or modifying them, even when protected by product or process patents in another country, in accordance with a treaty or convention in force in Brazil, may continue under the same conditions existing prior to the approval of this law.

§ 1 - No retroactive or future claim, of any value or on any grounds, will be admitted relating to products produced or processes used in Brazil in conformity with this article.

§ 2 - Equally, no claim in the terms of the previous paragraph will be admitted when, during the period prior to the entry into force of this law, significant investments have been made for the exploitation of a product or of a process as referred to in this article, even if they are protected by product or process patents in another country.

**Article 233** - Applications for the registration of advertising expressions and signs and for declarations of notoriety will be definitively shelved whereas such registrations and declarations will remain in force for the remainder of their terms but may not be renewed.

**Article 234** - Guarantees of priority, as provided for in article 7 of Law N° 5772 of 21st December 1971, are guaranteed to the applicant until the end of any current time limit.

**Article 235** - All current time limits granted under Law N° 5772 of 21st December 1971 are guaranteed.

**Article 236** - Applications for industrial model and industrial design patents that were filed when Law N° 5772 of 21st December 1971 was in force, will automatically be named as applications for the registration of an industrial design and, for all legal effects, publication will be considered as already having been effected.

**Sole Paragraph** - In such adapted applications, payments will be considered for the effect of calculation of the quinquennial fee.

**Article 237** - The provisions of article 111 will not apply to applications for industrial model or industrial design patents that have already been examined in accordance with Law N° 5772 of 21st December 1971.

**Article 238** - Appeals filed when Law N° 5772 of 21st December 1971 was in force, will be decided in accordance therewith.

**Article 239** - The Government is authorised to promote any changes in INPI that are necessary to ensure financial and administrative autonomy thereto, INPI being able to:

I - contract technical and administrative personnel by way of public competition;

II - establish a table of salaries for its employees, which will be subject to approval by the ministry to which INPI is bound; and

III - propose a basic structure and internal regulations that will be subject to approval by the ministry to which INPI is bound.

**Sole Paragraph** - Expenses resulting from the application of this article will be at the cost of the funds of INPI itself.

**Article 240** - Article 2 of Law N° 5.648 of 11th December 1970 will be altered to have the following wording:

"Article 2 - The principal purpose of INPI is the execution, nationally, of the norms that regulate industrial property, taking into account its social, economic, juridical and technical function, as well as making pronouncements regarding the convenience of signature, ratification and termination of conventions, treaties, pacts and agreements relating to industrial property".

**Article 241** - The Judiciary is authorised to create special courts to settle questions relating to intellectual property.



**Article 242** - The Government will submit to the National Congress a bill with a view to promoting, whenever necessary, the harmonisation of this law with the policy for industrial property adopted by the other countries that are members of the MERCOSUL.

**Article 243**- This law will enter into force on the date of its publication with respect to the matter contained in articles 230, 231 and 239, and 1 (one) year after its publication with respect to the remaining articles.

**Article 244** - Law N° 5,772 of 21st December 1971, Law N° 6,348 of 7th July 1976, articles 187 to 196 of Decree-Law N° 2,848 of 7th December 1940, articles 169 to 189 of Decree-Law N° 7,903 of 27th August 1945 and other contrary provisions are repealed.