

**Presidency of the Republic**  
**Ministry of Civil Affairs**  
**Sub-office of Legal Affairs**

**LAW NO. 9,279 OF MAY 14, 1996.**

Regulating rights and obligations related to  
industrial property.

**I, THE PRESIDENT OF THE REPUBLIC**, hereby declare that the National Congress decrees and I sanction the following Law:

PRELIMINARY PROVISIONS

Article 1. This Law regulates rights and obligations related to industrial property.

Article 2. The protection of the rights related to industrial property, considering their social interest and the technological and economic development of the Country, shall be effected by:

- I – the grant of patents of invention and patents of utility models;
- II – the grant of registration of industrial designs;
- III – the grant of registration of trademarks;
- 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 from abroad and filed in this Country by anyone who is ensured protection pursuant to a treaty or convention in force in Brazil; and

II – to nationals or persons domiciled in a country which guarantees that Brazilians or persons domiciled in Brazil have reciprocity of equal or equivalent rights.

Article 4. The provisions of the treaties in force in Brazil are applicable, under equal conditions, to natural and legal persons that are nationals or domiciled in the Country.

Article 5. The industrial property rights are considered, for all legal effects, chattels.

TITLE I  
PATENTS

## CHAPTER I OWNERSHIP

Article 6. The author of an invention or utility model shall be assured the right to obtain a patent guaranteeing ownership, under the terms established by this Law.

Paragraph 1. Except for when there is evidence proving otherwise, the applicant is presumed to be allowed to obtain the patent.

Paragraph 2. A patent may be applied for by the author, by the author's heirs or successors, by the assignee, or by whoever has ownership, as determined by the law, or by the employment or service contract.

Paragraph 3. Whenever an invention or utility model is created collectively by two or more persons, the patent may be applied for by any or all of them, upon designation and qualification of the other to guarantee their respective rights.

Paragraph 4. The inventor shall be named and qualified, and may request non-disclosure of his authorship.

Article 7. If two or more authors have created the same invention or utility model independently, the right to a patent shall be ensured to the one who proves the oldest filing, regardless of the dates of invention or creation.

Sole paragraph. The withdrawal of a previous filing without producing any effects will give priority to the immediately subsequent filing.

## CHAPTER II PATENTABILITY

### **Section I PATENTABLE INVENTIONS AND UTILITY MODELS**

Article 8. The invention that meets the requirements of novelty, inventive step, and industrial application is patentable.

Article 9. An object of practical use, or part thereof, susceptible to industrial application, which includes a new form or arrangement, involving an inventive act resulting in a functional improvement to the use or manufacture, is patentable as a utility model.

Article 10. The following are not considered to be an invention or utility model:

I – discoveries, scientific theories, and mathematical methods;

II – purely abstract conceptions;

III – schemes, plans, principles, or methods of commercial, accounting, financial, educational, advertising, lottery, and inspection nature;

IV – literary, architectural, artistic, and scientific works, or any aesthetic creation;

V – computer programs per se;

VI – presentation of information;

VII – game rules;

VIII – operation or surgical techniques and methods, as well as therapeutic or diagnostic methods, for use in human or animal body; and

IX – the whole or part of natural living beings and biological materials found in the nature, or even isolated therefrom, including the genome or germplasm of any natural living being and the natural biological processes.

Article 11. The invention and utility model are deemed new whenever it is not included in state of the art.

Paragraph 1. The state of the art includes everything accessible to the public before the date of filing of patent application, by a written or verbal description, by use or any other means, in Brazil or abroad, except as provided for in arts. 12, 16, and 17.

Paragraph 2. For purposes of assessment of novelty, the full content of the application filed in Brazil, but not yet published, shall be deemed state of the art from the date of filing or from the date of the priority claimed, as long as it is published, even if subsequently.

Paragraph 3. The provisions in the paragraph above shall apply to an international patent application filed pursuant to a treaty or a convention in force in Brazil, as long as there is a national process therefor.

Article 12. The disclosure of an invention or utility model, when occurred during the twelve (12) months preceding the date of filing or priority of the patent application shall not be deemed state of the art if promoted:

I – by the inventor;

II – by the Brazilian National Institute of Industrial Property – INPI, through an official publication of the patent application filed with no consent of the inventor, based on information obtained therefrom or as a result of acts performed thereby; or

III – by third parties, based on information obtained directly or indirectly from the inventor or as a result of acts performed thereby.

Sole paragraph. INPI might require, from the inventor, a statement related to the disclosure, whether accompanied by proof or not, under the conditions established in a regulation.

Article 13. An invention shall be taken to involve an inventive step whenever it does not evidently or obviously arise from the state of the art for a person skilled in the art.

Article 14. A utility model shall be taken to involve an inventive act whenever it does not commonly or regularly arise from state of the art for a person skilled in the art.

Article 15. The invention and the utility model are deemed susceptible to industrial application whenever they can be used or produced in any type of industry.

## **Section II Priority**

Article 16. The priority rights shall be guaranteed to the patent application filed in a country that maintain agreements with Brazil or in an international organization with the effect of a national filing, within the terms established in the agreement, and the filing shall not be invalidated or impaired by facts occurred within these terms.

Paragraph 1. The priority claim shall be made upon filing, and it may be supplemented within 60(sixty) days by other priorities preceding the date of filing in Brazil.

Paragraph 2. The priority claim shall be proved by a proper document on the origin, containing the number, date, title, specification, and, as the case may be, claims and drawings, accompanied by a simple translation of the filing certificate or equivalent document with data identifying the application, which content shall be of the entire responsibility of the applicant.

Paragraph 3. The proof, if not made upon filing, shall occur within 180 (one hundred and eighty) days of filing.

Paragraph 4. For international applications filed as a result of a treaty in force in Brazil, the translation provided for in paragraph 2 shall be submitted within 60 (sixty) days from the date of entry in the national processing.

Paragraph 5. If the application submitted in Brazil is truthfully included in the original document, a statement from the applicant with respect thereto shall be sufficient to replace the simple translation.

Paragraph 6. In case of priority obtained through assignment, the corresponding document shall be submitted within 180 (one hundred and eighty) days from the date of filing or, as the case may be, within 60 (sixty)

days from the date of entry in the national processing, and consular legalization in the country of origin is not required.

Paragraph 7. Lack of proof within the terms established in this article shall result in loss of priority.

Paragraph 8. In case of application filed with priority claim, the request for early publication shall be accompanied by the proof of priority.

Article 17. The patent application for an invention or utility model originally filed in Brazil with no priority claim and not yet published shall guarantee right to priority to the subsequent application regarding the same matter filed in Brazil by the same applicant or any successors within one (1) year.

Paragraph 1. Priority shall be accepted only for matters in the previous application, not extending to new matters added.

Paragraph 2. The previous application still pending shall be deemed definitely dismissed.

Paragraph 3. The patent application originated from a division of a previous application may not be the basis for a priority claim.

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

Article 18. The following are not patentable:

I – whatever is against morals, good moral principles, and public security, order and health;

II – substances, matters, mixtures, elements, or products of any kind, as well as the modification of their physical and chemical properties and the respective processes of obtaining or modifying them, when they result from a transformation of the atomic nucleus; and

III – the whole or any portion of living beings, except transgenic microorganisms that meet the three requirements for patentability – novelty, inventive step, and industrial application – provided for in art. 8 and that are not a mere discovery.

Sole paragraph. For purposes of this Law, transgenic microorganisms are the organisms, except for the whole or part of plants or animals that exhibit, upon direct human intervention in their genetic composition, a characteristic not usually attainable by the species in natural conditions.

## **CHAPTER III PATENT APPLICATION**

## **Section I Filing of Application**

Article 19. The patent application, under the conditions established by INPI, shall include:

- I – request;
- II – specification;
- III – claims;
- IV – drawings, if any;
- V – abstract; and
- VI – proof of payment of the fee related to the filing.

Article 20. After filing of the application, it shall be subject to a preliminary formal examination and, if in due, it shall be protocolled, and the date of presentation shall be the filing date of.

Article 21. The application that does not formally meet the requirements of art. 101 but has enough data related to the subject matter, the applicant and the inventor shall be delivered to INPI, upon dated proof of delivery, which will establish the requirements to be met, within 30 (thirty) days, under penalty of returning or dismissal of the documentation.

Sole paragraph. Once the requirements have been met, the filing shall be deemed to have been effected on the date of receipt.

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

Article 22. The patent of invention application shall refer to a single invention or to a set of interrelated inventions that include a single inventive concept.

Article 23. The patent of utility model application shall refer to a single main model, which may include a plurality of different constructive or additional elements or structural or configurative variations, provided that the technical-functional and corporeal unity of the object is maintained.

Article 24. The specification shall describe the subject matter clearly and sufficiently, 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. If there are biological materials essential for the practical implementation of the subject matter of the application, which cannot be described pursuant to this article and are not accessible to the public, the

specification shall be supplemented by a deposit of the material in an institution authorized by INPI or indicated in an international agreement.

Article 25. The claims shall be based on the specification, characterizing the particularities of the application and defining, clearly and precisely, the subject matter to be protected.

Article 26. The patent application may be divided into two or more, ex officio or at the request of the applicant, until the end of the examination, provided that divisional application:

I – specifically refer to the original application; and

II – do not exceed the matter of the original application.

Sole paragraph. The divisional request contrary to the provisions in this article shall be dismissed.

Article 27. The date of the divisional applications shall be the filing date of the original application and shall be granted its priority benefit, as the case may be.

Article 28. Each divisional application shall be subject to the payment of the corresponding fees.

Article 29. The patent application that is withdrawn or abandoned shall be mandatorily published.

Paragraph 1. The request for withdrawal shall be submitted within 16 (sixteen) months of the filing date or the older priority.

Paragraph 2. The withdrawal of a previous application without having any effects will confer priority on the immediately subsequent application.

### **Section III Prosecution and Examination of the Application**

Article 30. The patent application shall be kept confidential for 18 (eighteen) months of the filing date or the older priority, if any, after which it shall be published, except for the case provided for in article 75.

Paragraph 1. The publication of the application may be anticipated at the request of the applicant.

Paragraph 2. The publication shall include data identifying the patent application, and a copy of the specification, claims, abstract, and drawings is publicly available at INPI.

Paragraph 3. In the case provided for in the sole paragraph of article 24, the biological material shall become available to the public with the publication refer to which this article refers.

Article 31. Upon publication of the patent application and up to the end of the examination, documents and information to support the examination may be filed by interested parties.

Sole paragraph. The examination shall not begin before 60 (sixty)days of the publication of the application.

Article 32. To better clarify or define the patent application, the applicant may make changes until the request for examination, as long as they are limited to the matter initially disclosed in the application.

Article 33. The request for examination of the patent application shall be made by the applicant or any interested party within thirty-six (36) months of the filing date, under penalty of dismissal of the application.

Sole paragraph. The patent application may be reinstated, if so requested by the applicant, within 60 (sixty) days of dismissal, upon payment of a specific fee, under penalty of definitive dismissal.

Article 34. Upon request for examination, the following shall be submitted within 60 (sixty) days, and whenever requested, under penalty of dismissal of the application:

I – objections, prior art searches, and examination results for granting a corresponding application in other countries, when priority is claimed;

II – documents required to regularize the process and examination of the application; and

III – simple translation of the proper document referred to in paragraph 2 of article 16, in case it has been replaced by the statement provided for in paragraph 5 of the same article.

Article 35. Upon technical examination, a search report and an opinion will be prepared related to:

I – the patentability of the application;

II – adjustment of the application to the nature of the protection claimed;

III – reformulation division of the application; or

IV – technical requirements.

Article 36. When the office action is for the non-patentability, or inadequacy of the application to the nature of protection claimed, or formulates any requirement, the applicant shall be notified to respond within 90 (ninety) days.

Paragraph 1. Upon failure to meet the requirement, the application shall be definitively dismissed.

Paragraph 2. In case the requirement is responded, even though not met, or its formulation is reconsidered and independently of arguments being filed regarding the patentability or suitability, the examination shall continue.

Article 37. Upon completion of the examination, a decision shall be issued, allowing or rejecting the patent application.

## CHAPTER IV PATENT GRANT AND TERM

### **Section I Patent Grant**

Article 38. The patent shall be granted upon allowance of the application and confirmation of the payment of the corresponding fee, issuing the respective letters patent.

Paragraph 1. The fee shall be paid and the respective proof of payment shall be submitted within 60 (sixty) days of the allowance.

Paragraph 2. The fee provided for in this article may be also paid and proved within 30 (thirty) days of the term provided for in the preceding paragraph, regardless of notification, upon payment of a specific fee, under penalty of definitive dismissal of the application.

Paragraph 3. The patent is deemed to be granted on the date of publication of the respective act.

Article 39. The letters patent shall include the respective number, title, and nature of protection, the name of the inventor, pursuant to the provisions in paragraph 4 of article 6, the qualification and domicile of the patentee, term, specification, claims, and drawings, as well as data related to the priority.

### **Section II Patent Term**

Article 40. The term of the patent of invention will be of 20 twenty years and the term of the patent of utility model of 15 (fifteen) years of the filing date.

Sole paragraph. The term shall not be less than 10 (ten) years for the patent of invention and 7 (seven) years for the patent of utility model counted from the date of grant, unless INPI is prevented from examining the merits of the application, due to evidenced pending litigation or force majeure.

CHAPTER V  
PROTECTION CONFERRED BY THE PATENT

**Section I**  
**Rights**

Article 41. The extension of the protection assigned by the patent shall be determined by the content of the claims, construed based on the specification and the drawings.

Article 42. The patent assigns to its owner the right to prevent a third party, without his consent, from producing, using, offering for sale, selling, or importing with the following purposes:

I – a product subject to patent;

II – a process or a product obtained directly by a patented process.

Paragraph 1. The right to prevent third parties from contributing so others perform the acts referred to in this article is also guaranteed to the owner.

Paragraph 2. Whenever the owner or holder does not prove, upon a specific court order, that the product has been obtained from a process other than the one protected by the patent, the rights of a process patent shall be violated, insofar as item II is concerned.

Article 43. The provisions in the previous article do not apply to:

I – the acts performed by unauthorized third parties privately and with no commercial purpose, as long as they do not entail loss to the economic interest of the patent owner;

II – the acts performed by unauthorized third parties, with experimental purposes, related to scientific or technological studies or researches;

III – the preparation of a drug according to a medical prescription for specific cases, made by a qualified professional, as well as the drug prepared as a result thereof;

IV – a product manufactured according to a process or product patent placed in the domestic market directly by the patent owner or with his consent;

V – third parties that, in case of patents related to living matters, use the patented product with no economic purposes as an initial source of variation or propagation to obtain other products; and

VI – third parties that in case of patents related to living matters, use, place in circulation, or commercialize a patented product that has been legally

introduced to the commerce by the patent owner or a license owner, as long as the patented product is not used for commercial multiplication or propagation of the living matter at stake.

VII –acts performed by unauthorized third parties with respect to the invention protected by a patent and exclusively intended the production of information, data, and test results, aiming at obtaining the registration for commercialization, in Brazil or in another country, for the exploitation and commercialization of the product patented after the expiration of the terms established in art. 40. (Added by Law No. 10,196 of 2001)

Article 44. The right to obtain a compensation for the unauthorized exploration of the subject matter of a patent, including regarding the exploitation between the date of publication of the application and the granting of the patent, is guaranteed to the patent owner.

Paragraph 1. If the offender has obtained, through any means, knowledge on the content of the application filed, prior to the publication, the period of the improper exploitation shall be counted from the date of beginning of the exploitation for purposes of compensation.

Paragraph 2. Whenever the subject matter of a patent application refers to a biological matter, deposited under the terms of the sole paragraph of art. 24, the right to compensation shall only be granted when the biological matter has become accessible to the public.

Paragraph 3. The right to compensation for improper exploitation, including with respect to the period preceding the granting of the patent, is limited to the content of its subject matter pursuant to art. 41.

## **Section II Prior User**

Article 45. The right to continue the exploitation, without any cost, in the previous form and conditions, shall be guaranteed to the person who, in good faith, exploited the subject matter within the Country before the date of filing or priority of a patent application.

Paragraph 1. The right conferred under this article shall only be ceded together with the business or company, or part thereof with a direct relationship with the exploitation of the subject matter of the patent, through transfer or leasing.

Paragraph 2. The right addressed in this article shall not be guaranteed to a person with knowledge on the subject matter of the patent due to disclosure under the terms of art. 12, as long as the application has been filed within 1 (one) year of the disclosure.

## **CHAPTER VI PATENT NULLITY**

## **Section I Miscellaneous**

Article 46. A patent is null when granted contrary to the provisions of this Law.

Article 47. The nullity may not apply to all claims, and the condition for partial nullity is that the remaining claims are patentable matters on their own.

Article 48. The nullity of the patent shall produce effects from the filing date of the application.

Article 49. In case of failure to comply with the provisions in art. 6, the inventor may, alternatively, claim, through a lawsuit, the adjudication of the patent.

## **Section II Administrative Nullity Procedure**

Article 50. Nullity of the patent shall be administratively declared when:

I – any of the legal requirements have not been met;

II – the specification and the claims do not comply with the provisions of arts. 24 and 25, respectively;

III – the subject matter of the patent surpasses the content of the application originally filed; or

IV – during prosecution, any of the essential formalities, required for granting the patent, have been omitted.

Article 51. The nullity procedure may be initiated ex officio or at the request of any person with a legitimate interest, within 6 (six) months of the granting of the patent.

Sole paragraph. The nullity procedure shall continue even if the patent is extinct.

Article 52. The owner shall be notified to answer in up to 60 (sixty) days.

Article 53. Independently of a response having been filed, once the term established in the preceding article has elapsed, INPI shall issue its opinion, notifying the owner and the applicant to answer within the regular term of 60 60 (sixty)days.

Article 54. Once the term established in the preceding article has elapsed, even if there is no response, the prosecution shall be decided upon by the President of INPI, and this shall constitute the conclusion of the administrative level.

Article 55. The provisions of this Section apply, as appropriate, to the certificates of addition.

### **Section III Nullity Actions**

Article 56. The nullity action may be filed at any time of the effective period of the patent, by INPI or by any person with legitimate interest.

Paragraph 1. The nullity of the patent may be argued, at any time, as a matter of defense.

Paragraph 2. The judge may, preventively or incidentally, determine the discontinuation of the effects of the patent, provided that the specific procedural requirements are met.

Article 57. The patent nullity action shall be filed in the jurisdiction of the Federal Courts and, whenever INPI is not plaintiff, it shall intervene in the case.

Paragraph 1. The period for response of the defendant, the owner of the patent, shall be of 60 (sixty) days.

Paragraph 2. Once the decision on the nullity action becomes res judicata, INPI shall publish a note for third parties' knowledge.

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

Article 58. The patent application or the patent, both with indivisible contents, may be assigned, in whole or in part.

Article 59. INPI shall make the following notations:

I – the assignment, including the full qualification of the assignee;

II – any limitations or onus that may be imposed on the application or patent; and

III – changes of name, principal place of business, or address of the applicant or owner.

Article 60. The notations shall have an effect with respect to third parties from their publication date.

### **CHAPTER VII LICENSES**

## **Section I Voluntary License**

Article 61. The owner of a patent or the applicant may execute a license agreement for exploitation.

Sole paragraph. The licensee may be vested all powers to act in the defense of the patent by the owner.

Article 62. The license contract shall be recorded in INPI so that it has effects with respect to third parties.

Paragraph 1. The recording shall have effects with respect with third parties from its publication date.

Paragraph 2. For purposes of validity of proof of use, the license contract does not have to be recorded in INPI.

Article 63. Improvements made in a licensed patent belong to the person who made them, and the other contracting party is guaranteed the right of preference for its licensing.

## **Section II Offer to License**

Article 64. The patent owner may request INPI to offer it for purposes of exploitation.

Paragraph 1. INPI shall publish the offer.

Paragraph 2. No exclusive voluntary license contract shall be recorded by INPI, unless the patent owner has withdrawn the offer.

Paragraph 3. The patent subject to an exclusive voluntary license may not be made the subject matter of an offer.

Paragraph 4. The patent owner may, at any time prior to the express acceptance of its terms by an interested party, withdraw the offer, whereby the provisions of article 66 shall not apply.

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

Paragraph 1. For purposes of this article, INPI shall observe the provisions in paragraph 4 of article 73.

Paragraph 2. The remuneration may be reviewed after 1 (one) year of its establishment.

Article 66. The patent on offer shall have its annuities reduced by one half during the period between the offer and the grant of the first license at any title.

Article 67. The patent owner may request cancellation of the license, in case 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, also, if the conditions for exploitation are not satisfied.

### **Section III Compulsory License**

Article 68. The owner shall be subject to have his patent compulsorily licensed in case he exercises the rights resulting therefrom in an abusive manner or abuses of the economic power through it, proven as provided by law, by an administrative or court decision.

Paragraph 1. The following may also result in compulsory license:

I – failure to exploit the subject matter of the patent in the Brazilian territory due to lack of manufacturing or incomplete manufacturing of the product or, further, lack of full use of the process patented, except for the events of economic infeasibility, in which case importation shall be accepted; or

II – commercialization failing to meet the needs of the market.

Paragraph 2. The license may only be requested by a person with legitimate interest and technical and economic capacity to efficiently exploit the subject matter of the patent, which shall predominantly be directed to the domestic market, removing, in this case, the exceptionality provided for in item I of the preceding paragraph.

Paragraph 3. In case the compulsory license is granted by virtue of abuse of economic power, to a licensee, offering local manufacturing, a term, limited to that established in article 74, shall be guaranteed to proceed to the importation of the subject matter of the license; provided that it has been placed in the market directly by the owner or upon his consent.

Paragraph 4. In case of importation to exploitation of the patent and in case of the importation provided for in the preceding paragraph, importation, by third parties, of a product manufactured pursuant to the process or product patent shall also be allowed; provided that it has been placed in the market directly by the owner or upon his consent.

Paragraph 5. The compulsory license referred to in paragraph 1 shall only be requested after 3 (three) years of grant of the patent.

Article 69. The compulsory license shall not be granted if, on the date of the request, the owner:

I – justifies non-use for legitimate reasons;

II – proves serious and effective procedures for the exploitation; or

III – justifies lack of manufacturing or commercialization due to legal obstacles.

Article 70. The compulsory license shall also be granted when, cumulatively, the following hypothesis are shown to exist:

I – a dependency situation of a patent to other;

II – the subject matter of a dependent patent constitutes substantially technical progress in relation to the previous patent; and

III – the owner fails to reach an agreement with the owner of the dependent patent for exploitation of the previous patent.

Paragraph 1. For purposes of this article, a dependent patent is that which exploitation mandatorily depends on the use of the subject matter of the previous patent.

Paragraph 2. For purpose of this article, a process patent may be deemed a dependent patent of the relevant product, as well as a product patent may depend on a process patent.

Paragraph 3. The owner of a licensed patent, pursuant to this article, shall have the right to a compulsory cross-license of the dependent patent.

Article 71. In cases of national emergency or public interest, declared in an act of the Federal Executive Authorities, as long as the owner of the patent or his licensee fails to meet this need, a temporary ex officio non-exclusive compulsory license may be granted for exploitation of the patent, without prejudice to the rights of the respective owner. (Regulation)

Sole paragraph. The act of grant of the license shall establish its term and the possibility of extension.

Article 72. The compulsory licenses shall always be granted without exclusive rights, and sublicensing is not allowed.

Article 73. The compulsory license application shall be prepared as to indicate the conditions offered to the patent owner.

Paragraph 1. Upon filing of the license application, the owner shall be notified to respond within 60 (sixty) days, upon the end of which, in the absence of a response, the offer shall be accepted under the conditions offered.

Paragraph 2. The license applicant invoking abuse of patent rights or abuse of economic power shall file documentary proof:

Paragraph 3. In case the compulsory license is required based on lack of exploitation, the owner of the patent shall be responsible for proving the exploitation.

Paragraph 4. If there is a request for reconsideration, INPI may use the necessary efforts, as well as appoint a commission, which may include experts that are not part of the staff of the agency, aiming at determining the remuneration to be paid to the owner.

Paragraph 5. The organs and entities of direct or indirect public administration, in the federal, state, and municipal levels, shall provide INPI with the information requested in order to subsidize the arbitration regarding the remuneration.

Paragraph 6. In the arbitration about the remuneration, the circumstances of each case shall be taken into account, mandatorily, the economic value of the license granted.

Paragraph 7. Once the process is duly filed, INPI shall decide upon the granting and the conditions of the compulsory license in up to 60 (sixty) days.

Paragraph 8. The appeal against the decision that grants the compulsory license shall not have staying effects.

Article 74. Except for legitimate reasons, the licensee shall begin to exploit the subject matter of the patent within 1 (one) year from the grant of the license, and it is permitted to interrupt the exploitation for the same term.

Paragraph 1. The owner may request revocation of the license whenever the provisions under this article are not complied with.

Paragraph 2. The licensee shall be vested all powers to act in the defense of the patent.

Paragraph 3. Once the compulsory license has been granted, its assignment shall only be permitted when it is carried out together with the assignment, transfer, or leasing of part of the undertaking that exploits it.

## CHAPTER IX PATENT OF INTEREST TO NATIONAL DEFENSE

Article 75. Patent applications originated from Brazil with a subject matter that is of interest to national defense shall be processed in secrecy, and shall not be subject to the publications established in this Law. (Regulation)

Paragraph 1. INPI shall forward the application, promptly, to the applicable organ of the Executive Authorities for its opinion, within 60 (sixty) days, regarding the confidential nature. If the term elapses with no opinion by the competent organ, the application shall be processed as usual.

Paragraph 2. It is prohibited to file a patent application abroad when its subject matter is considered of interest to national defense, as well as to disclose it in any form, except with an express authorization of the competent organ.

Paragraph 3. The exploitation and assignment of the application of the patent of interest to national defense are conditional on prior authorization of the competent organ, and compensation is guaranteed whenever there are restrictions on the rights of the applicant or owner. (See Decree No. 2,553 of 1998)

## CHAPTER X CERTIFICATE OF ADDITION OF INVENTION

Article 76. The applicant or the owner of a patent of invention may request, upon payment of a specific fee, a certificate of addition to protect any improvement or development introduced in the subject matter of the invention, even if with no inventive step, as long as the matter is included in the same inventive concept.

Paragraph 1. Upon publication of the main application, the application for certificate of addition shall be immediately published.

Paragraph 2. The examination of the application for certificate of addition shall follow the provisions in articles 30 to 37, except for the provisions in the preceding paragraph.

Paragraph 3. The application for certificate of addition shall be rejected if the subject matter does not have the same inventive concept.

Paragraph 4. The applicant may, during the term of the process, request for the transformation of the application for certificate of addition into a patent application, benefitting from the date of filing of the application for certificate of addition upon payment of the applicable fee.

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

Sole paragraph. During the nullity process, the owner may request that the matter in the certificate of addition be analyzed to verify the possibility of survival with no prejudice to the term of protection of the patent.

## CHAPTER XI EXTINCTION OF THE PATENT

Article 78. The patent shall be extinct:

I – on expiration of the term of protection;

II – as a result of waiver by the owner, except for third-party rights;

III – due to forfeiture;

IV – in case of lack of payment of the annual fee within the terms set forth in paragraph 2 of art. 84 and in art. 87; and

V – as a result of failure to comply with the provisions in art. 217.

Sole paragraph. Once the patent becomes extinct, the subject matter becomes public domain.

Article 79. Waiver shall only be accepted as long as no third-party rights are hindered.

Article 80. The patent shall become forfeit ex officio or at the request of any person with legitimate interest if, after 2 (two) years of the granting of the first compulsory license, this term was not sufficient to prevent or remedy the abuse or disuse, except for justifiable reasons.

Paragraph 1. The patent shall become forfeit when, on the date of application for forfeiture or the ex officio commencement of the relevant process, the exploitation has not been initiated.

Paragraph 2. During the process of forfeiture upon request, INPI may proceed in case of waiver by the applicant.

Article 81. The owner shall be notified, upon publication, to respond, within 60 (sixty) days, and the owner shall be responsible for the onus of proof regarding exploitation.

Article 82. The decision shall be pronounced within 60 (sixty) days of the end of the term mentioned in the preceding article.

Article 83. The decision of forfeiture shall have effects as of the date of the request or publication of the commencement of the ex officio process.

## CHAPTER XII ANNUAL FEE

Article 84. The applicant and the patent owner are subject to the payment of an annual fee, starting from the beginning of the third year of the date of filing.

Paragraph 1. The early payment of the annual fee shall be regulated by INPI.

Paragraph 2. The payment shall be made within the first three (3) months of each annual period; and it may also be made, regardless of notification, within the 6 (six) subsequent months, upon payment of an additional fee.

Article 85. The provisions in the preceding article apply to the international applications filed as a result of a treaty in force in Brazil, and the payment of the annual fees payable before that date of entry into national processing shall be made within 3 (three) months thereof.

Article 86. Failure to pay the annual fee, pursuant to arts. 84 and 85, shall entail dismissal of the application or extinction of the patent.

### Chapter XIII RESTORATION

Article 87. The patent application and the patent may be restored, at the request of the applicant or the owner, within 3 (three) months of the notification about dismissal of the application or extinction of the patent, through payment of a specific fee.

### CHAPTER XIV INVENTION AND UTILITY MODEL MADE BY AN EMPLOYEE OR SERVICE PROVIDER

Article 88. Inventions and utility models belong exclusively to the employer whenever they result from a work contract executed in Brazil with the purpose of research or inventive activities, or whenever they result from the nature of the services for which the employee was hired.

Paragraph 1. Except with an express contract provision determining otherwise, the remuneration for the work referred to in this article is limited to the salary agreed upon.

Paragraph 2. Except if there is evidence proving otherwise, inventions or utility models whose patent is applied for by the employee within 1 (one) year after termination of the employment bond are considered to have been developed during the effectiveness of the contract.

Article 89. The employer, owner of the patent, may grant the employee, author of an invention or improvement, a share of the economic gains resulting from the exploitation of the patent, as a result of a negotiation with the interested party or as provided for in the company rules. (Regulation)

Sole paragraph. The share referred to in this article does not form part, at any title, of the employee's salary.

Article 90. Inventions or utility models developed by the employee shall belong exclusively to him, provided that it is not connected to the work contract and that they did not arise from the use of resources, means, data, materials, facilities, or equipment owned by the employer. (Regulation)

Article 91. Ownership of inventions or utility models shall be shared, in equal parts, whenever they are a result of personal contribution by the employee and of resources, means, data, materials, facilities, or equipment

owned by the employer, except if there is an express contract provision determining otherwise. (Regulation)

Paragraph 1. In case there is more than one employee involved, the share that belongs to them shall be equally divided into all of them, except if agreed upon otherwise.

Paragraph 2. The employer is guaranteed the exclusive right to the exploitation license and the employee is guaranteed fair remuneration.

Paragraph 3. The exploitation of the subject matter of the patent, in case there is no agreement, shall be initiated by the employer within 1 (one) year of the date of grant, under penalty of the employee being granted exclusive ownership of the entitlement of the patent, except for cases of lack of exploitation due to legitimate reasons.

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

Article 92. The provisions of the preceding articles apply, as appropriate, to the relations between independent contractors or trainees and the contracting company and between contracting and contracted companies. (Regulation)

Article 93. The provisions of this Chapter apply, as appropriate, to the entities of direct, indirect and foundational Public Administration, in the, federal, state, or municipal levels. (Regulation)

Sole paragraph. In the hypothesis described in art. 88, the inventor shall be guaranteed, in the way and under the conditions set forth in the statutes or internal regulations of the entity referred to in this article, a reward of an installment in the amount of the advantages earned with the application or with the patent, as an incentive.

## TITLE II

### INDUSTRIAL DESIGNS

#### CHAPTER I

#### OWNERSHIP

Article 94. The author shall be ensured the right to obtain a registration of industrial design granting him/her ownership, under the conditions established in this Law.

Sole paragraph. The provisions of arts. 6 and 7 apply to the registration of industrial designs, as applicable.

## CHAPTER II

### ELIGIBILITY FOR REGISTRATION

#### SECTION I

##### **INDUSTRIAL DESIGNS ELIGIBLE FOR REGISTRATION**

Article 95. An industrial design is considered to be the ornamental plastic form of an object or the ornamental set of lines and colors that may be applied to a product, providing a new and original visual result in its external configuration, and which may be used as an industrial manufacturing type.

Article 96. The industrial design is deemed new whenever it is not included in state-of-the-art.

Paragraph 1. State-of-the-art includes whatever is made accessible to the public before the date of submission of application, by use or any other means, in Brazil or abroad, except as provided for in paragraph 3 of this article and in art. 99.

Paragraph 2. For the sole purpose of assessment of novelty, the full content of the patent or registration application filed in Brazil and not yet published, shall be deemed state-of-the-art as of the date of application or priority claimed, as long as it comes to be published, even if at a later time.

Paragraph 3. The industrial design of which publication occurred during one hundred and eighty (180) days before the date of application or claim of priority shall not be deemed state-of-the-art if such publication has been promoted in the events provided for in items I to III of art. 12.

Article 97. The industrial design is deemed original when it results in a distinct visual configuration when compared to previous objects.

Sole paragraph. The original visual result may arise from the combination of known elements.

Article 98. No purely artistic work is deemed industrial design.

#### **Section II**

##### **Priority**

Article 99. As far as they are suitable, the provisions of art. 16, apply to the application for registration, except for the term provided for in its paragraph 3, which shall be ninety (90) days,

### **Section III**

#### **Non-Patentable Industrial Designs**

Article 100. The following are not registrable as industrial design:

I – whatever is against morals, good customs, or offends people’s honor or image, or attempts against free thinking, freedom of belief, worship, or ideas and feelings worthy of respect and reverence;

II – the regular or common form of the object or even the form determined essentially due to technical or functional considerations.

### CHAPTER III

#### APPLICATION FOR REGISTRATION

### **Section I**

#### **Filing the Application**

Article 101. The application for registration, under the conditions established by INPI, shall include:

I – request;

II – descriptive report, if applicable;

III – claims, if applicable;

IV – drawings or pictures;

V – field of application of the object; and

VI – proof of payment of the fee related to the application.

Sole paragraph. The documents that are integral parts of the application for registration shall be submitted in Portuguese.

Article 102. Once submitted, the application shall be subject to a preliminary formal examination and, if duly documented, it shall be filed, and the date of submission shall be considered as the date of application.

Article 103. The application that does not formally comply with the provisions in art. 101 but has enough data related to the applicant, the industrial design, and the author may be delivered to INPI, upon dated proof of delivery, which shall establish the requirements to be met, within five (5) days, under penalty of being deemed non-existent.

Sole paragraph. Once the requirements are met, the application shall be deemed filed on the date of submission of the application.

## **Section II**

### **Application Conditions**

Article 104. The application for registration of industrial design shall refer to a single object, being permitted several variations, as long as they are intended for the same purpose and share the same major distinctive characteristic, and each application is limited to a maximum of twenty (20) variations.

Sole paragraph. The design shall clearly and sufficiently represent the object and its variations, if any, in order to enable reproduction by a technically skilled individual. I

Article 105. If secrecy is requested pursuant to paragraph 1 of art. 106, the application may be withdrawn within ninety (90) days of the date of submission.

Sole paragraph. Withdrawal of a previous application with no effects shall favor the immediately subsequent application.

## **Section III**

### **Application Process and Examination**

Article 106. Upon submission of the application for registration of industrial design and pursuant to the provisions in articles 100, 101, and 104, the registration shall be automatically published and simultaneously granted and the relevant certificate shall be issued.

Paragraph 1. At the applicant's request, upon submission, the application can be kept confidential for the period of one hundred and eighty (180) days counted from the filing date, after which it shall be processed.

Paragraph 2. If the applicant benefits from the provisions in article 99, the processing of the application shall await the presentation of the priority document.

Paragraph 3. Upon failure to comply with the provisions in articles 101 and 104, the requirement for amendment shall be reformulated, which shall be answered within sixty (60) days, under penalty of final dismissal.

Paragraph 4. Upon failure to comply with the provisions in article 100, the application for registration shall be rejected.

## CHAPTER IV

### REGISTRATION GRANT AND TERM

Article 107. The certificate shall include the number and title, name of the author – pursuant to the provisions in paragraph 4 of article 6, name, nationality, and domicile of the owner, term, drawings, data related to foreign priority, and, if any, descriptive report and claims.

Article 108. The registration shall be effective for ten (10) years of the filing date, extendable for three (3) consecutive periods of five (5) years each.

Paragraph 1. The request for extension shall be submitted within the last year of the term of the registration, accompanied by the proof of payment of the relevant fee.

Paragraph 2. If the request for extension of the registration is not submitted until the end of its term, the owner may do so within the subsequent one hundred and eighty (180) days, upon payment of an additional fee.

## CHAPTER V

### PROTECTION ASSIGNED BY THE REGISTRATION

Article 109. The ownership of the industrial design is acquired through a validly granted registration.

Sole paragraph. The provisions of article 42 and items I, II, and IV of article 43 apply, as appropriate, to the industrial design registration.

Article 110. A person who, in good faith, before the date of the application for registration or its priority, exploited its object in the Country, will be ensured the right to continue with the exploitation, without any cost, pursuant to the previous form and condition.

Paragraph 1. The right referred to in this article may only be assigned together with the business or company, or part thereof, being directly related to the exploitation of the object of the registration, by disposal or lease.

Paragraph 2. The right referred to in this article is not ensured to a person that becomes aware of the object of the registration through the publication under paragraph 3 of article 96, as long as the application has been filed within six (6) months of the publication.

## CHAPTER VI

### EXAMINATION

Article 111. The owner of the industrial design may request for examination of the object of the registration, at any time during the term, as to the novelty and originality requirements.

Sole paragraph. INPI shall issue an opinion on the merits of the registration that will serve as grounds for initiating the proceedings to invalidate the registration, if it is concluded that at least one of the requirements defined in articles 95 to 98 is absent.

## CHAPTER VII

### INVALIDITY OF THE REGISTRATION

#### **Section I**

#### **Miscellaneous**

Article 112. A registration granted contrary to the provisions in this Law is invalid.

Paragraph 1. The invalidation of the registration shall have effects as of the filing date of the application.

Paragraph 2. In case of failure to comply with the provisions in article 94, the author may alternatively claim the adjudication of the registration.

#### **Section II**

#### **Administrative Invalidity Proceeding**

Article 113. Invalidity of the registration shall be administratively declared when it has been granted by failing to comply with articles 94 to 98.

Paragraph 1. The invalidity proceeding may be initiated voluntarily or at the request of any person with a legitimate interest, within five (5) years of the granting of the registration, except for the hypothesis provided for in the sole paragraph of article 111.

Paragraph 2. The request or voluntary initiation shall suspend the effects granted by the registration if submitted or published within sixty (60) days of the granting.

Article 114. The owner shall be summoned to respond within sixty (60) days of the date of publication.

Article 115. Whether or not there is a response, once the term established in the preceding article has elapsed, INPI shall issue its opinion, summoning the owner and the applicant to answer within the regular term of sixty (60) days.

Article 116. Once the term established in the preceding article has elapsed, even if there is no response, the proceedings shall be decided upon by the President of INPI, and this shall constitute the conclusion of the administrative level.

Article 117. The invalidity proceedings shall progress, even if the registration has been extinguished.

### **Section III**

#### **Invalidity Action**

Article 118. The provisions in articles 56 and 57 apply to the industrial design registration invalidity action as appropriate.

### CHAPTER VIII

#### EXTINCTION OF THE REGISTRATION

Article 119. The registration shall be extinguished:

I – on expiry of the term of protection;

II – as a result of waiver by the owner, without prejudice to third-party rights;

III – in case of lack of payment of the fee provided for in articles 108 and 120; or

IV – due to failure to comply with the provisions in article 217.

### CHAPTER IX

#### QUINQUENNIAL FEE

Article 120. The owner of the registration is subject to the payment of a quinquennial fee, as of the second period of five years of the filing date.

Paragraph 1. The payment of the second quinquennial period shall be made within the fifth (5<sup>th</sup>) year of the term of registration.

Paragraph 2. The payment of other five-year periods shall be submitted together with the request for extension referred to in article 108.

Paragraph 3. The payment of the five-year period may be made within six (6) months after the term established in the preceding paragraph, upon payment of an additional fee.

## CHAPTER X

### FINAL PROVISIONS

Article 121. The provisions in articles 58 to 63 apply, as appropriate, to the matter addressing this Title, governing the right of an employee or service provider pursuant to the provisions in articles 88 to 93.

## TITTLE III TRADEMARKS

### CHAPTER I ELIGIBILITY FOR REGISTRATION

#### **Section I Signs Eligible for Registration as Trademark**

Article 122. Are considered eligible for registration as trademarks visually perceptible distinctive signs which do not fall under any legal prohibitions.

Article 123. For the purposes of this code, the following definitions shall apply:

I – product or service trademark: that which is used to distinguish goods or services from others that are identical or similar, from a different origin;

II – certification mark: that which is used for certifying a product or a service meets certain standards or technical specifications, especially as to their quality, nature, and material and methodology used; and

III – collective mark: that which is used to identify products or services provide by members of certain entity.

#### **Section II Signs not Eligible for Registration as Trademark**

Article 124. The following are not subject to trademark registration:

I – official, public, national, foreign, or international coats of arms, medals, flags, emblems, badges, and monuments, as well as their respective designation, image, or imitation;

II – single letters, numbers, and dates, except when represented in a sufficiently distinctive manner;

III – expressions, images, drawings, or any other signs which are contrary to morals and good customs or which offends the honor or image of people or which attacks the freedom of conscience, belief, worship or ideas and feelings which are deemed worthy of respect and veneration;

IV – title or acronym of a public entity or agency, if registration is not sought by that entity or agency;

V – reproduction or imitation of a characteristic or differentiating element of a trade name or a third-party's company name, which may cause confusion or association with these distinctive signs;

VI – Generic, necessary, common, ordinary, or simply descriptive signs, which are related to the products or services to be distinguished, or those commonly employed to identify a characteristic of the products or services, as to their nature, national origin, weight, value, quality, and time of production or service provision, except when represented in a sufficiently distinctive manner;

VII – signs or slogans used only as a mean of advertising;

VIII – colors and their names, unless arranged or combined in a peculiar and distinctive way;

IX – geographic indications, their imitations which may cause confusion, or signs that could falsely induce geographical indication;

X – signs which induce a false indication as to the origin, source, nature, quality, or usefulness of the products or services to which the trademark is intended;

XI –reproduction or imitation of official signs regularly adopted to guarantee standards of any kind or nature;

XII – reproduction or imitation of signs that have been registered as collective or certification marks by third parties, pursuant to the provisions established in article 154;

XIII – title, award, or symbol of sporting, artistic, cultural, social, political, economic, or technical events, official or officially recognized, as well as imitations which may cause confusion with the former, except when authorized by the competent authority or entity promoting the event;

XIV – reproduction or imitation of title, policy, currency, and banknote of the Federal Government, States, Federal District, Territories, Municipalities, or countries;

XV – birth name or signature, family name or patronymic, and image of third parties, except with the consent of the owner, heirs, or successors;

XVI – well-known pseudonym or nickname, singular or collective artistic name, except with the consent of the owner, heirs, or successors;

XVII – literary, artistic, or scientific work, as well as titles protected by copyright and likely to cause confusion or association, except with the consent of the author or the right's owner;

XVIII – technical terms used in the industry, science and art, which are related to the products or services to be distinguished;

XIX – reproduction or imitation, in whole or in part, even if with addition, of other persons' registered trademark to distinguish or certify an identical, similar, or related product or service, which is liable to cause confusion or association with the trademark of others.

XX – duality of trademarks by a single owner for the same products or services, except when, in the case of trademarks of the same nature, they are sufficiently distinctive;

XXI – the necessary, common, or ordinary shape of the product or packaging or, also, one that cannot be dissociated from a technical effect;

XXII – objects which are protected by a third party's industrial design registration; and

XXIII – sign that imitates or reproduces, in whole or in part, a trademark that the applicant evidently knows as a result of its activity, in which its owner is based or domiciled in national territory or in a country with which Brazil has an agreement or ensures reciprocal treatment, if that trademark distinguishes or certifies identical, similar, or related products or services which are liable to cause confusion or association with such trademark.

### **Section III Highly-Renowned Mark**

Article 125. The registered trademark in Brazil regarded as highly renowned shall be ensured special protection in all commercial activity fields.

### **Section IV Well-Known Mark**

Article 126. The trademark well-known in its field of commercial activity is especially protected pursuant to art. 6 *bis* (I) of the Paris Union Convention for

the Protection of Industrial Property, regardless of being previously filed or registered in Brazil.

Paragraph 1. The protection referred to in this article is also applicable to service marks.

Paragraph 2. INPI may, on its own volition, deny the application for registration of trademark that reproduces or imitates, in whole or in part, a well-known mark.

## CHAPTER II PRIORITY

Article 127. To the application for registration of a trademark filed in a country which maintains an agreement with Brazil, or in an international organization which produces the effect of a national application, the right to priority, within the terms established in that agreement, shall be ensured, and that application shall not be invalidated or impaired by facts occurred within these terms.

Paragraph 1. The priority claim of shall be made upon filing, and it may be supplemented within sixty (60) days by other priorities prior to the date of submission in Brazil.

Paragraph 2. The priority claim shall be supported through a proper document from the origin, containing the number, date, and reproduction of the application or the registration, accompanied by a simple translation, in which the content shall be the full responsibility of the applicant.

Paragraph 3. If the evidence is not submitted upon filing, it shall occur within four (4) months of the filing, under penalty of loss of the priority.

Paragraph 4. In case of a priority obtained through assignment, the relevant document shall be submitted in addition to the proper priority evidence.

## CHAPTER III APPLICANTS

Article 128. Individuals or legal entities of public law or private law may apply for trademark registration.

Paragraph 1. Individuals or legal entities of private law may only apply for the registration of a trademark related to the activity effectively and legally carried out either directly or through companies direct or indirectly controlled, and such condition shall be declared in the trademark application, under penalty of law.

Paragraph 2. The registration of a collective mark may only be requested by a legal entity representing a party, which may carry out a different activity than its members.

Paragraph 3. The registration of a certification mark may only be requested by an individual or entity without any direct commercial or industrial interest in the certified product or service.

Paragraph 4. A priority claim does not exempt a trademark application from the enforcement of the provisions included in this Title.

## CHAPTER IV TRADEMARK RIGHTS

### **Section I Acquisition**

Article 129. The ownership of the trademark is acquired through the validly issued registration, pursuant to the provisions of this Law, and its exclusive use throughout the national territory is ensured to its holder and, regarding collective and certification marks, the provisions in arts. 147 and 148 shall be complied with.

Paragraph 1. Every individual or entity who, on good faith, used within the country for at least six (6) months prior to the date of the priority or filing an identical or similar trademark to distinguish or certify an identical, similar, or related product or service, shall be entitled the right to take precedence in the registration.

Paragraph 2. The right to take precedence may only be assigned together with the company's business or portion thereof with direct relation to the use of the trademark, through disposal or lease.

### **Section II Protection Granted by Registration**

Article 130. The owner of the trademark or its applicant is also ensured the right to:

- I – assign its registration or application;
- II – license its use;
- III – protect its material integrity or reputation.

Article 131. The protection addressed in this Law encompasses the use of the trademark in papers, printed materials, advertisement, and documents related to the owner's activity.

Article 132. The trademark owner may not:

- I – prevent merchants or distributors from using distinctive signs owned thereby together with the product's trademark for its promotion and marketing;

II – prevent manufacturers of accessories from using the trademark to indicate the product's purpose, as long as the fair competition practices are respected;

III – prevent free circulation of products placed in the domestic market, by itself or third parties with consent, except for the provisions in paragraphs 3 and 4 of art. 68; and

IV – prevent quoting of the trademark in a speech, scientific or literary work, or any other publication, as long as there is no commercial connotation or prejudice to its distinctive character.

## CHAPTER V EFFECTIVE PERIOD, ASSIGNMENT, AND ANNOTATIONS

### **Section I Effective Period**

Article 133. The registration of the trademark shall be effective for ten (10) years from the date when the registration was granted, extendable for equal and consecutive periods.

Paragraph 1. The request for extension shall be filed within the last year of the term of the registration, accompanied by the proof of payment of the corresponding fee.

Paragraph 2. If the request for extension of the registration is not made until the end of its term, the owner may request it within the subsequent six (6) months, upon payment of an additional fee.

Paragraph 3. The extension shall not be granted if the provisions of art. 128 are not complied with.

### **Section II Assignment**

Article 134. The application for registration and the registration may be assigned, provided that the assignee meets the legal requirements in order to request such registration.

Article 135. The assignment shall include all registrations or applications, on behalf of the assignor, of equal or similar trademarks, related to an identical, similar, or related product or service, under penalty of cancellation of the registrations or dismissal of the applications that were not assigned.

### **Section III Records**

Article 136. INPI shall make the following records:

I – the assignment, including the full identification of the assignee;

II – any limitations or burdens that may be imposed upon the application or registration; and

III – changes of name, principal place of business, or address of the applicant or owner.

Article 137. The annotations shall take effect with respect to third parties from their publication date.

Article 138. The following decisions are appealable:

I – denial of assignment annotation;

II – cancellation of registration or dismissal of application, pursuant to art. 135.

#### **Section IV License to Use**

Art. 139. The owner of a registration or the applicant thereof may sign a license agreement for the use of a trademark, without any prejudice to its right to exercise effective control over the specifications, nature, and quality of the respective products or services.

Sole paragraph. The licensee may be vested all powers to act in the defense of the trademarks, without prejudice to his/her own rights.

Article 140. The license agreement shall be recorded in INPI so that it has effects with respect to third parties.

Paragraph 1. The recording shall take effects with respect with third parties from its publication date.

Paragraph 2. For purposes of validity of proof of use, the license agreement does not have to be recorded in INPI.

Article 141. The decision that denies the recording of the license agreement is appealable.

#### **CHAPTER VI FORFEITURE OF THE RIGHTS**

Article 142. The registration of the trademark shall be extinguished:

I – due to the expiry of its term;

II – as a result of waiver, which may happen in whole or in part with respect to the products or services of the trademark;

III – due to a revocation brought by lack of use; or

IV – due to failure to comply with the provisions in article 217.

Article 143 – A trademark registration will be revoked upon request of any person with legitimate interest if, after five (5) years of its granting, on the date of such request:

I – the trademark use has not been initiated in Brazil; or

II – the trademark has ceased to be used for more than five (5) consecutive years or, within the same term, the trademark has been used with alterations which result in a modification of its original distinctive nature, as provided for in the registration certificate.

Paragraph 1. The registration shall not be revoked if the owner provides legitimate reasons for the disuse of the trademark.

Paragraph 2. The owner shall be summoned to respond within sixty (60) days, being responsible for evidencing the use of the trademark or providing legitimate reasons for its disuse for.

Article 144. The use of the trademark shall cover products or services included in the certificate, under penalty of causing the registration to be partially revoked in respect to those which are dissimilar and unrelated to the ones for which the trademark was provenly used.

Article 145. There shall be no request for revocation if the trademark is provenly used or its disuse has been justified in a previous proceeding, filed no more than five (5) years.

Article 146. A decision for revoking the registration or denying it shall be subject to appeal.

## CHAPTER VII COLLECTIVE AND CERTIFICATION MARKS

Article 147. The collective mark application shall include its regulation of use, providing for conditions and prohibitions for using the trademark.

Sole paragraph. The regulation of use, if not annexed with the application, shall be filed within sixty (60) days of the submission, under penalty of final dismissal of the application.

Article 148. The certification mark application shall include:

I – the characteristics of the product or service which are subject to certification; and

II – the control measures to be adopted by the owner.

Sole paragraph. The documents specified on items I and II of this article, if not annexed with the application, shall be filed within sixty (60) days, under penalty of final dismissal of the application.

Article 149. Any changes to the regulation of use shall be informed to INPI, upon filed petition, including all conditions changed, under penalty of being disregarded.

Article 150. The trademark can be used regardless of license, and its authorization in the regulation of use shall be sufficient.

Article 151. In addition to the causes of extinguishment established in article 142, the collective and certification trademark registration are extinguished when:

I – the owner ceases to exist; or

II – the trademark is used under conditions other than those provided for in the regulation of use.

Article 152. A waiver to the collective mark registration shall only be accepted when required under the articles of association or bylaws of the entity itself or even pursuant to the regulation of use.

Article 153. A collective mark shall be liable to revocation if is not used by more than one authorized person, pursuant to the provisions in articles 143 to 146.

Article 154. The collective and certification marks that have already been used and which registrations have been extinguished may not be registered on behalf of third parties, before expiration of the five (5)-year term from the date of the extinguishment.

## CHAPTER VIII SUBMISSION

Article 155. The application shall be made for a single distinctive sign and, under the conditions established by INPI, shall include:

I – request;

II – images, when applicable; and

III – a proof of payment of the fee related to the submission.

Sole paragraph. The application and any document accompanying it shall be submitted in Portuguese and, in case of a foreign document, its simple translation shall be annexed upon submission or submitted within the subsequent sixty (60) days, under penalty of those documents being disregarded.

Article 156. After submission of the application, it shall be subject to a preliminary formal examination and, if duly documented, it shall be recorded, and the date of application shall be the date of submission.

Article 157. The application that does not formally comply with the provisions in art. 155 but has enough data related to the applicant, the sign applied for, and its classification shall be accepted for admission, upon dated proof of submission, by INPI, which shall establish the requirements to be met by the applicant, within five (5) days, under penalty of dismissal.

Sole paragraph. Once the requirements are met, the application shall be deemed filed on the date of submission of the application.

## CHAPTER IX EXAMINATION

Article 158. Once the application has been recorded, it shall be published for objections within sixty (60) days.

Paragraph 1. The applicant shall be notified of the objections, and it shall be allowed to present its arguments within sixty (60) days.

Paragraph 2. The objection, administrative invalidity, or invalidity action shall be disregarded if, based on item XXIII of art. 124 or art. 126, the submission of the application for registration of the trademark pursuant to this law is not evidenced within sixty (60) days after filing.

Article 159. Once the objection term has elapsed or, in case it is filed, once the term for submitting arguments, the examination shall be carried out, during which time additional requirements may be requested, which shall be answered within sixty (60) days.

Paragraph 1. Upon failure to answer the requirement, the application shall be finally dismissed.

Paragraph 2. Once the requirement has been answered, even if it has not been met, or once its request has been challenged, the examination shall continue.

Article 160. Once the examination is completed, a decision shall be rendered, accepting or denying the application for registration.

## CHAPTER X ISSUANCE OF THE REGISTRATION CERTIFICATE

Article 161. The registration certificate shall be granted after the application has been accepted and the proof of payment of the corresponding fees has been submitted.

Article 162. The payment of the fees, and the proof of payment, related to the issuance of the registration certificate and to the first decade of its term, shall be made within sixty (60) days of acceptance.

Sole paragraph. The fee may also be paid, and the proof of payment submitted, within thirty (30) days from the end the term set forth in this article, regardless of notice, through payment of a specific fee, under penalty of final dismissal of the application.

Article 163. The registration certificate is deemed to have been granted on the date of publication of the respective instrument.

Article 164. The certificate shall include the trademark, number, and date of registration, name, nationality, and domicile of the owner, the products or services, the characteristics of the registration, and the foreign priority.

## CHAPTER XI INVALIDITY OF THE REGISTRATION

### **Section I Miscellaneous**

Article 165. Registrations granted contrary to the provisions of this Law are invalid.

Sole paragraph. The invalidity of the registration may be total or partial, and the condition for partial invalidity is that the remaining part may be considered eligible for registration.

Article 166. The owner of a registered trademark in a country that is a party to the Paris Union Convention for the Protection of Industrial Property may, alternatively, claim, through a lawsuit, the adjudication of the registration, pursuant to the terms set forth in art. 6 *septies* (1) of such Convention.

Article 167. The declaration of invalidity shall take effect as of the date when the application was submitted.

### **Section II Administrative Invalidity Proceeding**

Article 168. Invalidity of the registration shall be administratively declared when it has been granted contrary to the provisions in this Law.

Article 169. The invalidity proceeding may be initiated by INPI's own volition or at the request of any person with a legitimate interest, within one hundred and eighty (180) days of the date of issuance of the registration certificate.

Article 170. The owner shall be summoned to present its arguments in up to sixty (60) days.

Article 171. Once the term established in the preceding article has elapsed, even if there is no response, the proceeding shall be decided upon by the President of INPI, and this shall constitute the conclusion of the proceeding at the administrative level.

Article 172. The invalidity proceeding shall continue even if the registration is extinguished.

### **Section III Invalidity Action**

Article 173. The invalidity action may be filed by INPI or by any person with legitimate interest.

Sole paragraph. The judge may, in the records of the invalidity action, determine, by an injunction, the discontinuation of the effects of the registration and the use of the trademark, provided that the specific procedural requirements are met.

Article 174. The term for filing an invalidity action expires after five (5) years counted from the date of granting.

Article 175. The registration invalidity action shall be filed in the jurisdiction of the Federal Courts and, whenever INPI is not the claimant, it shall intervene in the case.

Paragraph 1. The term for response of the respondent, the owner of the trademark, shall be of sixty (60) days.

Paragraph 2. Once the decision on the invalidity action becomes final and unappealable, INPI shall publish a note for third parties' knowledge.

## **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 center 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. Whoever performs the following acts commits a crime against an invention or utility model patent:

I – manufacture of a product that is the subject matter of an invention or utility model patent without authorization of the owner; or

II – use of a means or process that is the subject matter of an invention patent without authorization of the owner.

Penalty – detention, from three (3) months to one (1) year, or fine.

Article 184. Whoever performs the following acts commits a crime against an invention or utility model patent:

I – export, sale, exhibition or offer for sale, stock, concealment, or receipt, for use for economic purposes, of a product manufactured with a violation of an invention or utility model patent, or obtained through a patented process; or

II – import of a product that is the subject matter of an invention or utility model patent, or obtained through a process patented in the Country, for the

purposes mentioned in the item above, and which has not been placed in the foreign market directly by the patent owner or with his/her/its consent.

Penalty – detention, from one (1) to three (3) months, or fine.

Article 185. Supplying a component of a patented product or any material or equipment to carry out a patented process, as long as the final application of the component, material, or equipment necessarily induces the exploitation of the subject matter of the patent.

Penalty – detention, from one (1) to three (3) months, or fine.

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

## CHAPTER II CRIMES AGAINST INDUSTRIAL DESIGNS

Article 187. Manufacturing, with no authorization of the owner, a product that incorporates a registered industrial design or a substantial imitation that may induce an error or confusion.

Penalty – detention, from three (3) months to one (1) year, or fine.

Article 188. Whoever performs the following acts commits a crime against a registered industrial design:

I – export, sale, exhibition or offer for sale, stock, concealment, or receipt, for use for economic purposes, of an object that illegally incorporates a registered industrial design or a substantial imitation that may induce an error or confusion; or

II – import of a product that incorporates an industrial design registered in the Country, or a substantial imitation that may induce an error or confusion, for the purposes mentioned in the item above, and which has not been placed in the foreign market directly by the owner or with his/her/its consent.

Penalty – detention, from one (1) to three (3) months, or fine.

## CHAPTER III CRIMES AGAINST TRADEMARKS

Article 189. The following are crimes against trademark registration:

I – to reproduce, without authorization of the owner, in whole or in part, a registered trademark, or to imitate it as to cause confusion; or

II – to alter a registered trademark of others which has already been in use in a product in the market.

Penalty – detention, from three (3) months up to one (1) year, or fine.

Article 190. It is a crime against a trademark registration to import, export, sell, offer or exhibit for sale, hide, or have in stock the following:

I – a product marked with a trademark that was illicitly reproduced or imitated, in whole or in part;

II – a product of one's own company or business, in a container, recipient, or package bearing a lawful trademark owned by others.

Penalty – detention, from one (1) up to three (3) months, or fine.

#### CHAPTER IV CRIMES COMMITTED USING TRADEMARKS, FICTITIOUS NAMES, AND SLOGANS

Article 191. To reproduce or imitate, in a way that may be deceiving or confusing, official national, foreign, or international arms, shields, or badges, without the required authorization, in whole or in part, in a trademark, fictitious name, trade name, icon, or slogan, or to use such reproductions and imitations with economic purposes.

Penalty – detention, from one (1) up to three (3) months, or fine.

Sole paragraph. Anyone who sells, exhibits, or offers for sale products with such marks is also 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  
UNFAIR COMPETITION CRIMES

Article 195. Whoever performs the following act commits crime of unfair competition:

I – publication, through any means, of false statement to the prejudice of a competitor, for the purpose of obtaining an advantage;

II – provision or disclosure of false information about a competitor for the purpose of obtaining an advantage;

III – use of fraudulent means to divert, for its own benefit or to the benefit of a third party, someone else's clients;

IV – use of third-party advertising sign or slogan, or an imitation thereof, in order to create confusion among products or establishments;

V – misuse of third-party trade name, fictitious name, or insignia or sale, exhibition or offer for sale, or stock of a product with such references;

VI – replacement of a third-party fictitious or corporate name with its own fictitious or corporate name in a third-party product with no consent;

VII – attribution of an unattained reward or distinction as means of advertisement;

VII – sale or exhibition or offer for sale, in a third-party package or container, of an adulterated or counterfeit product, or use thereof to negotiate a product of the same nature, although not adulterated or counterfeit, if this action is not a more severe crime;

IX – provision or promise to provide cash or another value to a competitor's employee so this employee, not complying with his/her duties, provides an advantage;

X – receipt of cash or other utilities, or acceptance of a promise of payment or compensation to an employee so he/she, not complying with his/her duties, provides an advantage to the employer's competitor;

XI – unauthorized disclosure, exploitation, or use of confidential knowledge, information, or data used in the industry, commerce, or service provision, except for the ones that are public or evident for an expert who has had access thereto upon contract or employment, even after the end of such contract or employment;

XII – unauthorized disclosure, exploitation, or use of confidential knowledge or information referred to in the item above, obtained illegally or accessed through fraud; or

XII – sale, exhibition, or offer for sale of a product, stating that it is the subject matter of a patent submitted or granted or a registered industrial design, or mention thereof in an advertisement or leaflet, when such statement is untrue;

XIV – unauthorized publication, exploitation, or use of test results or other undisclosed data, which preparation entails substantial efforts, submitted to governmental entities as a condition for approval of the marketing of products.

Penalty – detention, from three (3) months to one (1) year, or fine.

Paragraph 1. The employer, partner, or manager of the company that commit the crimes established in items XI and XII above are included in such provisions.

Paragraph 2. The provisions in item XIV do not apply to the publication by a competent government agency to authorize the marketing of a product, whenever necessary to protect the public.

## CHAPTER VII MISCELLANEOUS

Article 196. Detention penalties provided for in Chapters I, II, and III of this Title shall be increased by one third if:

I – the agent is or has been a representative, proxy, agent, partner, or employee of the owner of the patent or the registration, or even the licensed trademark; or

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

Article 197. The fines provided for in this Title shall be fixed a minimum of ten (10) and a maximum of three hundred sixty (360) day-fines, pursuant to the Brazilian Penal Code system.

Sole paragraph. The fine may be increased or reduced in up to ten (10) times in light of the personal conditions of the agent and the magnitude of the advantage obtained, regardless of the rule established in the previous article.

Article 198. The products signaled with counterfeit, changed, or imitated trademarks, or products with a false indication of provenance may be seized, voluntarily or at the request of the interested party, by the customs authorities upon checking.

Article 199. The crimes provided for in this Title are only characterized upon complaint, except for the crime provided for in article 191, in which the criminal action shall be public.

Article 200. The criminal action and the preliminary measures of search and seizure, related to the crimes against the industrial property, are governed by the provisions in the Brazilian Code of Criminal Procedure, with changes included in the articles of this Chapter.

Article 201. In the search and seizure measure, related to the crime against an invention, which subject matter is a process invention, the official court official shall be escorted by an expert, who shall preliminarily verify the existence of the illegal act, and the judge may order the products obtained by the forger by using the patented process to be seized.

Article 202. In addition to the preliminary measures of search and seizure, the interested party may require:

I – seizure of a counterfeit, changed, or imitated trademark, wherever it is prepared or found, before being used for criminal purposes; or

II – destruction of a counterfeit trademark on the volumes or products containing it, before their distribution, even though the packaging or the products themselves are destroyed.

Article 203. In case of industrial or commercial facilities legally organized and publicly in operation, the preliminary measures shall be limited to inspection and seizure of the products, if ordered by the judge, and their activities illegally conducted may not be shut down.

Article 204. Upon search and seizure measure, the party who requested it in bad faith, out of spirit of emulation, on a whim, or gross error shall be held liable for losses and damages.

Article 205. An allegation of nullity of the patent or registration on which the action is based may constitute defense in the criminal action. The acquittal of the respondent, however, shall not constitute nullity of the patent or registration, which can only be required in the competent action.

Article 206. In the event of disclosure, in court, of information classified as confidential, whether as industry or trade secret, to defend the interests of either party, the judge shall determine that the process should proceed in judicial secrecy, and the use of such information by the other party for other purposes is also prohibited.

Article 207. Notwithstanding the criminal action, the adversely affected party may procure the civil actions he/she deems appropriate under the Brazilian Code of Civil Procedure.

Article 208. The compensation shall be determined based on the benefits that the adversely affected party would earn had the infringement not occurred.

Article 209. It is hereby ensured to the adversely affected party the right to losses and damages as compensation for losses caused by

infringement of industrial property rights and by acts of unfair competition not provided by this Law that tend to tarnish the reputation or hinder the businesses of others and to create confusion between business facilities, industrial facilities, or service providers, or between the products and services commercialized.

Paragraph 1. The judge may, in the records of the action itself, in order to avoid irreparable damage or damage that is difficult to be repaired, determine by an injunction the interruption of the infringement or of the act that enables it, before the defendant is served process, requesting, if deemed necessary, escrow or personal guarantee.

Paragraph 2. In the cases of flagrant reproduction or imitation of a registered trademark, the judge may determine the seizure of all goods, products, objects, packages, labels, and others containing the counterfeit or imitated trademark.

Article 210. Loss of profits shall be determined according to the criterion most favorable to the adversely affected party, among which:

I – the benefits that the adversely affected party would have earned if the infringement had not occurred; or

II – the benefits earned by the author of the infringement of the right; or

III – the compensation that the defaulting party would have paid to the person entitled to the violated right for granting of a license that would allow it to exploit the property.

## TITLE VI TRANSFER OF TECHNOLOGY AND FRANCHISE

Article 211. INPI shall register contracts that entail transfer of technology, franchise agreements, and similar instruments so that they have effects for third parties.

Sole paragraph. The decision related to the applications for registration of contracts addressed in this article shall be rendered within thirty (30) days of the date of application for registration.

## TITLE VII MISCELLANEOUS

### CHAPTER I APPEALS

Article 212. Except if there is an express provision determining otherwise, the decisions addressed in this Law are appealable, which shall be filed within sixty (60) days.

Paragraph 1. The appeals shall be received with non-staying effect and stay of proceedings, and all relevant provisions shall apply to the first instance examination, as appropriate.

Paragraph 2. Decisions determining the final dismissal of the patent or registration application shall be unappealable, as well as decisions that accept the application for patent, certificate of addition, or trademark registration.

Paragraph 3. The appeals shall be decided upon by the President of INPI, which shall constitute the conclusion of the administrative level.

Article 213. The interested parties shall be summoned to counter-argue the appeal within sixty (60) days.

Article 214. In order to complement the arguments presented as appeals, INPI may prepare requirements, which shall be met within sixty (60) days.

Sole paragraph. Once the term in the main section has elapsed, the appeal shall be decided upon.

Article 215. The decision of the appeal is final and unappealable at the administrative level.

## CHAPTER II ACTS OF THE PARTIES

Article 216. The acts set forth in this Law shall be performed by the parties or by their duly identified attorneys-in-fact.

Paragraph 1. The original power of attorney, or an official transcript or certified copy thereof, shall be in Portuguese, and consular legalization and signature notarization are waived.

Paragraph 2. The power of attorney shall be submitted within sixty (60) days of the party's first act in the proceeding, regardless of notice or requirement, under penalty of final dismissal of the patent application, the application for registration of industrial design and trademark.

Article 217. The person domiciled abroad shall appoint and keep an attorney-in-fact duly identified and domiciled in the Country, with powers to represent him/her administratively and judicially, including to be served process.

Article 218. There will be no petition:

I – if it is filed after expiration of the legal term; or

II – if fails to include the proof of payment of the relevant fee, at the amount in effect on the date it is filed.

Article 219. There will be no petition, objection, and appeal if they:

I – are filed after expiration of the term provided by Law;

II – fail to include the legal basis; or

III – fail to include the proof of payment of the corresponding fee.

Article 220. INPI shall use the acts performed by the parties, whenever possible, making the applicable requirements.

### CHAPTER III TERMS

Article 221. The terms established in this Law are continuous, automatically removing the right to perform the act after its expiration, unless the party evidences that it has failed to perform it for cause.

Paragraph 1. Cause is deemed to be an unforeseen event, beyond the party's will, and preventing him/her to act.

Paragraph 2. Upon recognition of cause, the party shall act within the term granted by INPI.

Article 222. When establishing the terms, their start day is to be removed and the expiration day is to be included.

Article 223. The terms only became effective as of the first business day after summons are served, which shall be made upon publication in INPI official body.

Article 224. If no expressly determined by this Law, the term for performing the act shall be sixty (60) days.

### CHAPTER IV PRESCRIPTION

Article 225. The suit for damages caused to the industrial property right prescribes in five (5) years.

### CHAPTER V ACTS PERFORMED BY INPI

Article 226. The acts performed by INPI in the administrative proceedings regarding the industrial property only have effects as of its publication in the relevant official body, except for:

I – those expressly not depending on notice or publication by virtue of the provisions in this Law;

II – the administrative decisions, upon notice by mail or acknowledgement to the party interested in the proceeding; and

III – the internal opinions and orders that the parties do not have the need to know.

## CHAPTER VI CLASSIFICATIONS

Article 227. The classifications related to the matters of Titles I, II, and III of this Law shall be established by INPI, if not set in international agreements or contracts in effect in Brazil.

## CHAPTER VII FEE

Article 228. A fee shall be charged for the services set forth in this Law, which amount and collection process shall be established by the person responsible for the federal public administration body to which INPI is bound.

## TITLE VIII TRANSITIONAL AND FINAL PROVISIONS

Article 229. The provisions of this Law shall apply to the ongoing applications, except for the patentability of the applications filed until December 31, 1994, which subject matter of protection are substances, matters, or products obtained through chemical means or processes or substances, matters, mixtures, or food products, chemical pharmaceuticals, and medicines of any type, as well as the relevant procurement or modification processes and whose applicants have failed to exercise the right provided for in articles 230 and 231 of this Law, which shall be deemed rejected for all purposes, and INPI shall publish such rejections. [\(Wording by Law No.10,196 of 2001\)](#)

Sole paragraph. The patentability criteria of this Law apply, on the actual filing date of the application in Brazil or the date of priority, if any, to the applications related to pharmaceuticals and agricultural chemicals that were filed between January 1, 1995 and May 14, 1997, ensuring protection as of the date on which the patent was granted, for the remaining term of the filing day in Brazil, limited to the term provided for in the main section of article 40. [\(Included by Law No. 10,196 of 2001\)](#)

Article 229-A. Process patent applications submitted between January 1, 1995 and May 14, 1997 are considered rejected, to which [article 9, item "c", of Lei No. 5,772 of December 21, 1971](#) failed to cover, and INPI shall publish such rejections. [\(Included by Law No. 10,196 of 2001\)](#)

Article 229-B. Product patent applications submitted between January 1, 1995 and May 14, 1997, to which [article 9, item "b" and "c", of Law No. 5,772 of 1971](#) failed to cover and which applicants have failed to exercise the right provided for in articles 230 and 231, shall be decided until December 31, 2004 pursuant to this Law. [\(Included by Law No. 10,196 of 2001\)](#)

Article 229-C. Grant of patents for pharmaceutical products and processes will depend on the prior consent of the Brazilian Health Surveillance Agency – ANVISA. (Included by Law No. 10,196 of 2001)

Article 230. Patent applications related to substances, matters, or products obtained from chemical means and processes and substances, matters, mixtures, or food products, chemical pharmaceuticals, and medicines of any type, as well as the relevant procurement or modification processes, which are ensured protection pursuant to a treaty or covenant in effect in Brazil, may be filed, ensuring the date of the first submission abroad, as long as their subject matter has not been placed in any market, by direct initiative of the owner or third party with his/her consent, or solid and effective preparations for exploitation of the subject matter of the application or patent have not been made by third parties in the Country.

Paragraph 1. The submission shall be made within one (1) year of publication of this Law and shall indicate the date of the first submission abroad.

Paragraph 2. Patent applications filed based on this article shall be automatically published, and any interested party may answer, within ninety (90) days, as to compliance with the provisions in the main section of this article.

Paragraph 3. Pursuant to articles 10 and 18 of this Law, and once the conditions established in this article are met and the patent granted is evidenced in the country where the first application was filed, the patent shall be granted in Brazil, as granted in the country of origin.

Paragraph 4. Patents granted based on this article are ensured the remaining protection term in the country where the first application was filed, of the filing date in Brazil and limited to the term provided for in article 40, and the provisions in its sole paragraph do not apply.

Paragraph 5. The applicant with an ongoing patent application related to substances, matters, or products obtained from chemical means or processes and substances, matters, mixtures, or food products, chemical pharmaceuticals, and medicines of any type, as well as the relevant procurement or modification processes, may file a new application, within the term and under the conditions established in this article, attaching a document supporting waiver of the ongoing application.

Paragraph 6. The provisions in this Law apply, as appropriate, to patents submitted and patents granted based on this article.

Art. 231. Patent applications related to the matters referred to in the preceding article, by a citizen or a person domiciled in the Country, may be filed, and the date of publication of the invention shall be ensured, as long as its subject matter has not been placed in any market, by direct initiative of the owner or third party with his/her consent, or solid and effective preparations for exploitation of the subject matter of the application.

Paragraph 1. Submissions shall be made within one (1) year of publication of this Law.

Paragraph 2. Patent applications filed based on this article shall be processed under this Law.

Paragraph 3. Patents granted based on this article are ensured the remaining protection term of twenty (20) years of the date of publication of the event, as of submission in Brazil.

Paragraph 4. Applicants with an ongoing patent application related to the matters referred to in the preceding article may file a new application, within the term and under the conditions established in this article, attaching a document supporting waiver of the ongoing application.

Article 232. Production or use, under the preceding laws and regulations, of substances, matters, or products obtained from chemical means or processes and substances, matters, mixtures, or food products, chemical pharmaceuticals, and medicines of any type, as well as the relevant procurement or modification processes, even though protected by a product or process patent in another country, under agreement or contract in effect in Brazil, may continue, under the same conditions prior to the approval of this Law.

Paragraph 1. No retroactive or future charge of any amount, at any title, related to the products manufactured or processes used in Brazil pursuant to this article will be allowed.

Paragraph 2. Additionally, no charge pursuant to the preceding paragraph will be allowed if, during the period prior to this Law become effective, significant investments have been made to exploit the product or process referred to in this article, even though they are protected by a product or process patent in another country.

Article 233. Applications for registration of advertising slogans and signs and for declaration of notoriety shall be finally submitted, and the registrations and declaration shall remain in place for the remaining term; provided that they may not be extended.

Article 234. The applicant is ensured the priority guarantee referred to in article 7 of Law No. 5,772 of December 21, 1971, until the end of the term in progress.

Article 235. The term in progress granted pursuant to Law No. 5,772 of December 21, 1971 is ensured.

Article 236. Model or industrial design patent applications filed pursuant to Law No. 5,772 of December 21, 1971 shall be automatically referred to as application for registration of industrial design, and the publication shall be deemed made for all legal effects.

Sole paragraph. Adjusted applications shall be deemed payments made for purposes of calculating a five-year fee payable.

Article 237. The provisions in article 111 shall not apply to patent applications for models or industrial designs that were examined as provided by Law No. 5,772 of December 21, 1971.

Article 238. Appeals filed pursuant to Law No. 5,772 of December 21, 1971 shall be decided as provided for thereon.

Article 239. The Executive Branch is hereby authorized to promote the necessary changes in INPI, as to ensure financial and administrative autonomy to the Independent Agency, and it may:

I – hire technical and administrative staff through public sector recruitment examination;

II – establish the wages to be paid to its employees, subject to the approval of the Ministry to which INPI is bound; and

III – provide for the basic structure and internal regulations that shall be approved by the Ministry to which INPI is bound.

Sole paragraph. The expenses resulting from the application of this article shall be borne by INPI, using its own funds.

Article 240. Article 2 of Law No. 5,648 of December 11, 1970 is amended to read as follows:

“Article 2 INPI’s main purpose is to implement, at the national level, the rules regulating industrial property, bearing in mind its social, economic, legal, and technical function, as well as to issue opinions on the convenience of signature, ratification, and termination of conventions, treaties, contracts, and agreements on industrial property”.

Article 241. The Judiciary Branch is hereby authorized to create special courts to settle issues related to intellectual property.

Article 242. The Executive Branch shall submit, to the National Congress, a bill directed to adjust, whenever necessary, this Law to the industrial property policy adopted by other countries composing Mercosur.

Article 243. This Law becomes effective on the date of its publication as to the matters provide for in articles 230, 231, 232, and 239 and one (1) year after its publication as to other articles.

Article 244. Law No. 5,772 of December 21, 1971, Law No. 6,348 of July 7, 1976, articles 187 to 196 of Decree-Law 2,848 of December 7, 1940, articles 169 to 189 of Decree-Law No. 7,903 of August 7, 1945, and other provisions in contrary are hereby revoked.

Brasília, May 14, 1996; 175<sup>th</sup> year of the Independence and 108<sup>th</sup> year of the Republic.

FERNANDO HENRIQUE CARDOSO

*Nelson A. Jobim*

*Sebastião do Rego Barros Neto*

*Pedro Malan*

*Francisco Dornelles*

*José Israel Vargas*

This text does not replace the one published in the Federal Official Gazette (DOU) of May 15, 1996

Brasília, May 14, 1996; 175<sup>th</sup> year of the Independence and 108<sup>th</sup> year of the Republic.

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