

Brazil: updated news on trademark daily practice

The Trademark Manual issued by the Brazilian PTO with the purpose of providing guidelines related to the trademark examination is an important tool with detailed and enlightening information to Examiners and users in general.

While some topics concerning trademark examination and proceeding are polemic and represent real challenges on the trademark daily practice, on the other hand, other topics show that the PTO has done a detailed and careful job in providing explanations on the criteria adopted by that Agency.

Aspects relating to trademark examination itself are carefully explained in the Manual. For example, the PTO elucidates the criteria adopted in connection with analysis of trademark conflict and examination of market affinity, which are very helpful to trademark users. Also, the Trademark Manual contains a special item within the topic entitled "specific cases in the examination of trademark availability", which encompasses three themes: names of places; patronimic, family name and civil name; and abbreviations (initials). This specific item also reveals how the PTO deals with these specific issues.

On the other hand, there are troublesome topics resulting from recent changes in the PTO's internal policy regarding analysis of specification of goods/services, recordals of changes of address and acceptance of documents attesting that companies belong to the same economic group.

The specification of goods/services has undergone a more rigorous analysis by Trademark Examiners. As a consequence, different different decisions have been rendered with regard to specification of goods/services that need amendments or explanations, according to the PTO's understanding: in some cases the PTO has issued office actions requesting that the applicant submit explanations and/or clarifications regarding the specification. In other cases, the PTO has decided to exclude, *ex officio*, items of the specification, thus allowing the application with amendments in the original specification of goods/services (in this case, a partial appeal can be filed but it may take several years to be decided).

The adoption of such a rigorous criteria has caused delay in the examination of applications and it seems that the best way to avoid issuance of office actions or

withdrawal of goods/services, *ex officio*, by the PTO, is to avoid generic specifications. Moreover, in cases where the goods or services claimed contain technical terms that require specific knowledge in a particular market segment, it is advisable to provide the Examiner with detailed information on such goods/services upon filing the application.

With regard to recordals of address changes, the PTO had abolished for many years, the need to submit documents attesting to the address change. The submission of an updated Power of Attorney with the trademark owner's new address was sufficient to apply for the recordal of an address change. However, the PTO has recently changed its policy and now requires that whenever a recordal of an address change is applied for, a document attesting to the change be submitted.

As a result of this policy change, the PTO has issued office actions in many proceedings relating to recordals of address changes, requesting that the trademark owner submit a document attesting to the change (which should be translated into Portuguese). Needless to say, this has caused an additional delay in the examination of recordals of address changes, as well as additional expenses to trademark owners.

Finally, a topic that remains polemic is the type of document accepted by the Brazilian PTO in order to evidence that companies belong to the same economic group. The Trademark Manual states that "*the relationship of economic group between companies must be evidenced by appropriate document; a mere declaration or authorization or, furthermore, the fact that both companies have the same partners, is not acceptable*".

The main concern is that the Brazilian PTO does not indicate precisely the type of documents that are accepted and sometimes it can be difficult to adequately comply with an office action raised in connection with this matter.

In summary, the purpose of this short piece is to share a few aspects of what is new in Brazil in terms of trademark daily practice, and in doing so one must necessarily mention the Trademark Manual. Hopefully the Trademark Manual will continue to be updated and improved in such a way to facilitate the life of trademark users.

Patrícia Aragão Lusoli