

ANNEX: Law 9279, of May 14, 1996

as amended by Law 10196, of February 14, 2001*

THE EXECUTIVE BRANCH OF THE PRESIDENCY OF THE REPUBLIC

Civilian Household
Department for Legal Matters
Law No. 9,279, of May 14, 1996
Regulating Industrial Property
Rights and Obligations

THE PRESIDENT OF THE REPUBLIC

Let it be known that the National
Congress has enacted and I ap-
prove the following Law:

PRELIMINARY PROVISIONS

Art. 1 – This law regulates rights
and obligations relating to indus-
trial property.

Art. 2 – In view of the interest of
society and the technological and
economic development of the
country, the protection of rights
relating to industrial property
shall be assured by means of:

- I – the grant of patents for inven-
tions and utility models;
- II – the grant of industrial design
registrations;
- III – the grant of trademark regis-
trations;
- IV – the suppression of false geo-
graphical indications; and
- V – the suppression of unfair
competition.

Art. 3 – The provisions of this law
shall apply to:

- I – applications for patents or reg-
istrations filed in Brazil by a per-
son holding protection under a
treaty or convention in force in
Brazil; and
- II – nationals of, or persons resi-
dent in a country that affords the
same or equivalent rights, in a re-
ciprocal manner, to Brazilians or
persons resident in Brazil.

Art. 4 – The provisions of treaties
in force in Brazil shall apply, un-
der the same conditions, to natural

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and legal persons who are nationals of, or resident in Brazil.

Art. 5 – For all legal effects, industrial property rights shall be deemed movable property.

TITLE I – PATENTS

CHAPTER I – OWNERSHIP

Art. 6 – The author of an invention or utility model shall be afforded the right to obtain a patent securing him or her the property, under the terms set out by this Law.

§ 1 – Unless otherwise proven, the applicant shall be presumed to be entitled to obtain a patent.

§ 2 – A patent may be applied for by the author, his or her heirs or successors, by an assignee or by any person designated the owner by law or a contract of either employment or provision of services.

§ 3 – If an invention or utility model is created jointly by two or more persons, a patent may be applied for by all or any one of such persons, safeguarding the rights of the others by providing their names and particulars.

§ 4 – The inventor shall be named and his or her particulars given, but he or she may request that his or her name not be disclosed.

Art. 7 – If two or more authors created the same invention or util-

ity model independently of each other, the right to obtain a patent shall belong to the person proving the earliest filing date, irrespective of the invention or creation date.

Sole Paragraph – The withdrawal of an earlier filing that has not had any effect shall give priority to the filing that immediately follows.

CHAPTER II – PATENTABILITY

SECTION I – Patentable Inventions and Utility Models

Art. 8 – An invention shall be patentable if it meets the requirements of novelty, inventive step and industrial application.

Art. 9 – An object of practical use, or part thereof, susceptible of industrial application, that presents a new form or arrangement and involves inventive step that results in functional improvement in its use or manufacture shall be patentable as a utility model.

Art. 10 – The following shall not be considered inventions or utility models:

- I – discoveries, scientific theories and mathematical models;
- II – purely abstract concepts;

III – schemes, plans, principles or methods of commerce, accountancy, finance, education, advertising, lotteries or inspection;
IV – literary, architectural, artistic and scientific works or any aesthetic creation;
V – computer programs in themselves;
VI – presentations of information;
VII – rules for games;
VIII – techniques and methods for operations and surgery or therapeutic or diagnostic methods for application to the human or animal body; and
IX – all or part of natural living beings and biological materials found in nature, even if isolated therefrom, including the genome or germplasm of any natural living being or natural biological processes.

Art. 11 – An invention or utility model shall be considered to be new if it does not form part of the prior art.

§ 1 – Prior art shall constitute everything made available to the public by written or verbal description, use or any other means, before the filing date of the patent application, in Brazil or abroad, except as provided for in articles 12, 16 and 17.

§ 2 – For the purposes of determining novelty, the full contents

of an application filed but not yet published in Brazil shall be deemed part of the prior art from the filing or claimed priority date, provided that it is published, even if this happens subsequently.

§ 3 – The provisions of the previous paragraph shall apply to an international patent application filed in accordance with the provisions of a treaty or convention in force in Brazil, provided that there is a national phase.

Art. 12 – The disclosure of an invention or utility model occurring during the 12 (twelve) months preceding the application filing date, or priority date, shall not be deemed to be part of the prior art if made by:

- I – the inventor;
- II – the Brazilian Patent and Trademark Office (BPTO), through the official publication of an application filed without the consent of the inventor, based on information obtained from the inventor or as a result of his or her acts; or
- III – third parties on the basis of information obtained directly or indirectly from the inventor or as a result of his or her acts.

Sole Paragraph – The BPTO may require a statement from the inventor relating to the disclosure,

accompanied by evidence or not, under the requirements established in the regulations.

Art. 13 – An invention shall be considered as involving inventive step if, to a person skilled in the area, it does not derive evidently or obviously from prior art.

Art. 14 – A utility model shall be considered as involving inventive step if, to a person skilled in the area, it does not derive in a common or usual way from prior art.

Art. 15 – Inventions or utility models shall be considered as susceptible of industrial application if they can be used or made in any kind of industry.

SECTION II – Priority

Art. 16 – Priority rights shall be assured, within the time limits set out in the agreement, for a patent filed in a country that has an agreement with Brazil or with an international organization that has the effect of a national filing, and the filing shall neither be invalidated nor prejudiced by events occurring within such time limits.

§ 1 – A priority claim shall be made at the time of filing, and may be supplemented within sixty (60) days by other priorities that precede the filing date in Brazil.

§ 2 – A priority claim shall be supported by a legal document of origin with number, date, title, description and, where appropriate, claims and drawings together with an uncertified translation of the filing certificate or equivalent document containing data identifying the application, the contents of which shall be under the full responsibility of the applicant.

§ 3 – If not submitted on filing, evidence shall be submitted within one hundred and eighty (180) days from the filing date.

§ 4 – For international applications filed under a treaty in force in Brazil, the translation referred to in § 2 shall be filed within 60 (sixty) days from the entry date into the national phase

§ 5 – If an application filed in Brazil is faithfully reproduced in the document of origin, a statement to this effect by the applicant shall suffice to replace the uncertified translation.

§ 6 – If priority is obtained by assignment, the corresponding document shall be filed within one hundred and eighty (180) days of the filing date or within sixty (60) days of the entry date into the national phase, where appropriate, consular legalization in the country of origin not being required.

§ 7 – Failure to provide evidence within the time limits set out in this article shall result in the loss

of the priority.

§ 8 – If an application has been filed with priority claim, any request for early publication shall be made with evidence of the priority.

Art. 17 – An application for a patent for an invention or a utility model originally filed in Brazil without priority claim and not yet published shall afford a priority right to a subsequent application on the same subject matter filed in Brazil by the same applicant, or his or her successors, within a period of one (1) year.

§ 1 – Priority shall be granted only for the subject matter that is disclosed in the earlier application, and shall not be extended to any matter newly introduced.

§ 2 – The pending earlier application shall be deemed definitively withdrawn.

§ 3 – An application resulting from the division of an earlier application shall not serve as the basis for a priority claim.

SECTION III – Non-patentable Inventions and Utility Models

Art. 18 The following shall not be patentable:

I – anything contrary to morality, decency, and public safety, order and health;

II – substances, materials, compounds, elements or products of any kind, including the modification of their respective physical-chemical properties and the respective processes for obtaining or modifying them, when they result from the transformation of the atomic nucleus; and

III – living beings, in whole or in part, except for transgenic microorganisms meeting the three requirements for patentability – novelty, inventive step and industrial application – listed in

Art. 8 and which are not mere discoveries.

Sole Paragraph – For the purposes of this law, transgenic microorganisms are organisms, except for plants and animals, in whole or in part, that due to direct human intervention in their genetic composition express a characteristic that cannot normally be achieved by the species under natural conditions.

CHAPTER III- PATENT APPLI- CATIONS

SECTION I – Application Filing

Art. 19 – In accordance with the requirements established by the BPTO, patent applications shall contain:

- I – a request;
- II – a specification (descriptive report);
- III – claims;
- IV – drawings, where applicable;
- V – an abstract;
- VI – proof of payment of the filing fee.

Art. 20 – Once the application has been submitted, it shall be subject to a formal preliminary examination, and if found in order shall be recorded and the filing date shall be taken as the submission date.

Art. 21 – An application that does not formally meet the requirements of article 19, but which contains data relating to the subject matter, the applicant and the inventor, may be submitted to the BPTO in return for a dated receipt which sets out the requirements to be met within a period of 30 (thirty) days, failing which the documentation shall be returned or withdrawn.

Sole Paragraph – Once the requirements have been met, the filing shall be considered to have been made on the receipt date.

SECTION II – Application Re- quirements

Art. 22 – A patent application for an invention shall relate to a single invention or to a group of inventions linked in such a way as to form a single inventive concept.

Art. 23 – A patent application for a utility model shall relate to a single principle model which may include a plurality of distinct, additional elements or structural or configurative variations, provided that the technical-functional and material unity of the object is maintained.

Art. 24 – The specification shall clearly and sufficiently describe the subject matter thus enabling a person skilled in that area to be able to carry it out and, where appropriate, to indicate the best way to execute it.

Sole Paragraph – In the case of biological material essential for the practical execution of the application subject matter, which cannot be described in accordance with this article and which is not acces-

sible to the public, the specification shall be supplemented by depositing the material at an institution authorized by the BPTO or determined in an international agreement.

Art. 25 – The claims shall be based on the specification, characterizing the special features of the application and clearly and precisely defining the subject matter for which protection is sought.

Art. 26 – An application may be divided into two or more applications until the end of the examination, ex officio or at the request of the applicant, provided that the divided application:

I – makes specific reference to the original application; and
II – does not extend beyond the subject matter contained in the original application.

Sole Paragraph – Divisional applications that do not meet the requirements of this article shall be deemed withdrawn.

Art. 27 – Divisional applications shall have the filing date of and, where applicable, enjoy any benefit of priority of the original application.

Art. 28 – Each divisional application shall be subject to the pay-

ment of the corresponding fees.

Art. 29 – A withdrawn or abandoned patent application must be published.

§ 1 – Withdrawal requests shall be filed within 16 (sixteen) months from the filing date or that of earliest priority.

§ 2 – Withdrawal of an earlier filing that has not produced any effect shall give priority to the immediately subsequent filing.

SECTION III – Application Prosecution and Examination

Art. 30 – Patent Applications shall be kept secret for a period of 18 (eighteen) months from the filing date or that of the earliest priority, where applicable, at which time they shall be published, except as provided for in article 75.

§ 1 – If requested by the applicant, the application may be published early.

§ 2 – Publication shall include data identifying the application, a copy of the specification, the claims, the abstract and the drawings shall be available to the public at the BPTO.

§ 3 – In the case referred to in the sole paragraph of article 24, the biological material shall be made available to the public at the time

of the publication referred to in this article.

Art. 31 – Documents and information supporting the examination may be submitted by interested parties from the time of application publication until the end of examination.

Sole Paragraph – Examination shall not begin earlier than 60 (sixty) days from application publication.

Art. 32 – In order to better clarify or define his or her application, an applicant may make amendments up to the time of the request for examination, provided that the amendments are limited to the subject matter initially disclosed in the application.

Art. 33 – Examination of a patent application shall be requested by the applicant or by any interested person within 36 (thirty six) months from the filing date, under penalty of the application being deemed withdrawn.

Sole Paragraph – A patent application may be reinstated, at the request of the applicant, within 60 (sixty) days from having been withdrawn and upon payment of a specific fee, under penalty of the application being deemed definitively withdrawn.

Art. 34 – Once examination has been requested, the following documents shall be filed within 60 (sixty) days, whenever requested, under penalty of the application being deemed withdrawn.

- I – objections, prior art searches and results of examination for the grant of corresponding applications in other countries, where there is a priority claim;
- II – documents necessary to regularize the application procedure and examination; and
- III – an uncertified translation of the legal document referred to in § 2 of article 16 in those cases where the translation has been replaced by the statement referred to in § 5 of the same article.

Art. 35 – During the technical examination a search report and an opinion shall be prepared with respect to:

- I – the patentability of the application;
- II – suitability of the application to the claimed nature;
- III – amendment or division of the application; or
- IV – technical requirements.

Art. 36 – When the opinion is that the application is non-patentable or not suitable for the claimed nature or if the opinion sets any requirements, the applicant shall be

notified to reply within a period of 90 (ninety) days.

§ 1 – Failing a reply to a requirement, the application shall be deemed definitively withdrawn.

§ 2 – In the event of a reply to a requirement, even if the requirement is not met, or if its formulation is contested, the examination shall be continued irrespective of the submission or arguments concerning patentability or suitability.

Art. 37 – On conclusion of the examination a decision to allow or deny the application shall be issued.

CHAPTER IV – PATENT GRANT AND TERM

SECTION I – Patent Grant

Art. 38 – A patent shall be granted upon approval of the application and, on supply of proof of payment of the corresponding fee, the respective patent certificate shall be issued.

§ 1 – Payment of the fee and proof of payment shall be supplied within 60 (sixty) days from the approval of the application.

§ 2 – The fee referred to in this article may be paid and proof of payment supplied within the time limit specified in the previous paragraph, regardless of any no-

tice, on payment of a specified fee, on penalty of the application being deemed definitively withdrawn.

§ 3 – A patent shall be deemed granted from the publication date of the relevant decision.

Art. 39 – The patent certificate shall contain the relevant number, title and nature, inventor name, in accordance with the provision § 4 of article 6, and the particulars and place of residence of the patent owner, the term of validity, specification, the claims and the drawings, as well as any data relating to priority.

SECTION II – Patent Term

Art. 40 – The patent term for an invention shall be 20 (twenty) years and for a utility model 15 (fifteen) years from the filing date.

Sole Paragraph – The term shall be not less than 10 (ten) years for inventions and 7 (seven) years for utility models from the grant date, except where the BPTO is prevented from carrying out the application substantive examination due to pending litigation or for reasons beyond its control.

CHAPTER V PROTECTION CONFERRED BY PATENT

SECTION I – Rights

Art. 41 – The scope of the protection conferred by the patent shall be determined by the contents of the claims interpreted on the basis of the specification and drawings.

Art. 42 – A patent shall afford to its owner the right to prevent others from producing, using, offering for sale or importing for such purposes without his or her consent:

- I – a product that is the subject matter of a patent;
- II – a process or a product directly obtained by a patented process.

§ 1 – A patent owner shall further enjoy the right to prevent others from assisting other parties from carrying out the acts referred to in this article.

§ 2 – The rights in a process patent, as referred to in item II, shall be deemed to have been infringed if the holder or owner of a product fails to prove, by a specific judicial ruling, that his product was obtained by a manufacturing process different from the process protected by the patent.

Art. 43 – The provision of the previous article shall not apply to:

I – acts carried out privately and without commercial purposes by unauthorized third parties, provided that these acts do not prejudice the economic interests of the patent owner;

II – acts carried out by unauthorized third parties for experimental purposes, related to studies or scientific or technological research;

III – the preparation of a medicine in accordance with a medical prescription in individual cases and carried out by qualified professional, as well as the medicine thus prepared;

IV – a product manufactured in accordance with a process or product patent that has been placed on the internal market directly by the patent holder or with his or her consent;

V – third parties who, in the case of patents related to living matter, use the patented product, without economic purpose, as an initial source of variation or propagation in order to obtain other products; and

VI – third parties who, in the case of patents related to living matter, use, place in circulation, or market a patented product that has been lawfully introduced into the market by the patent owner or his

or her licensee, provided that patented product is not used for the commercial multiplication or propagation of the living matter concerned.

VII – acts practiced by unauthorized third parties, related to the invention protected by a patent, for the sole purpose of producing test information, data and results in order to obtain a marketing registration, in Brazil or abroad, for the exploitation and marketing of the product that is the subject matter of the patent, following expiry of the time limits set out in article 40. (Item included by Law 10,196 of 14/02/2001).

Art. 44 – A patent owner shall be entitled to compensation for the unauthorized exploitation of the subject matter of the patent, including exploitation that occurs between the application publication date and the patent grant date.

§ 1 – If an infringer becomes aware, by any means, of the contents of a filed application prior to the publication, the period of unlawful exploitation for compensation purposes shall be from the date on which exploitation began.

§ 2 – If the subject matter of a patent application relates to biological material, deposited in accordance the sole paragraph of article 24, the right to compensation

shall be granted only when the biological material has been made available to the public.

§ 3 – The right to compensation for unlawful exploitation, including that relating to the period before the patent grant, shall be limited to the subject matter of the patent, in accordance with article 41.

SECTION II – Prior User

Art. 45 – A person who, in good faith, prior to the filing or priority date of a patent application, exploits its subject matter in Brazil, shall be entitled to continue such exploitation in the same way and condition without any liability.

§ 1 – The right conferred by this article may only be assigned together with the business or company, or part thereof that is directly related to the exploitation of the subject matter of the patent, by transfer or leasing.

§ 2 – The right conferred by the article shall not be enjoyed by a person who obtained knowledge of the subject matter of the patent as a result of disclosure, in accordance with article 12, provided that the application was filed within 1 (one) year from the disclosure.

CHAPTER VI – NULLITY OF PATENT

SECTION I – General Provisions

Art. 46 – A patent granted contrary to the provisions of this Law shall be null and void.

Art. 47 – Nullity may apply to only some claims, a condition for partial nullity being that the remaining claims constitute patentable subject matter in themselves.

Art. 48 – Patent nullity shall become effective from the application filing date.

Art. 49 – Where the provisions of article 6 have not been complied with, the inventor may, alternatively, commence proceedings to decide patent ownership.

SECTION II – Administrative Procedure for Nullity

Art. 50 – Administrative nullity of a patent shall be declared if:

- I – any of the statutory requirements have not been met;
- II – the specification and claims do not meet the requirements of articles 24 and 25, respectively;
- III – the subject matter of the patent extends beyond the con-

tents of the application as originally filed; or

IV – any of the essential formalities that are indispensable for grant were omitted during prosecution.

Art. 51 – Proceedings for nullity may be instituted ex officio or at the request of any person having a legitimate interest, within 6 (six) months from the patent grant.

Sole Paragraph – Proceedings for nullity shall continue even if the patent has lapsed.

Art. 52 – The patent owner shall be notified to make his or her comments within a period of 60 (sixty) days.

Art. 53 – Irrespective of a response having been filed, on expiry of the time limit specified in the previous article, the BPTO shall issue an opinion and notify the patent owner and the applicant to submit within a common time limit of 60 (sixty) days.

Art. 54 – On expiry of the time limit set out in the previous article, even if no responses have been received, the procedure will be decided by the President of the BPTO, and the administrative procedure shall be concluded.

Art. 55 – The provisions of this Section shall apply, as appropriate, to certificates of addition.

SECTION III – Nullity Proceedings

Art. 56 – Nullity proceedings may be instituted at any time during the term of a patent by the BPTO or any party with a legitimate interest.

§ 1 – Patent nullity may be alleged at any time as a defense plea.

§ 2 – As a preventive or incidental measure, the judge may decide to suspend the effects of a patent, provided that the relevant procedural requirements are met.

Art. 57 – Nullity proceedings shall be heard by Federal Courts and the BPTO shall participate in the proceedings when the BPTO is not the plaintiff.

§ 1 – The time limit for the defendant patent owner to reply shall be 60 (sixty) days.

§ 2 – Once the final decision on nullity proceedings has been made, the BPTO shall publish a notification to inform third parties.

CHAPTER VII – ASSIGNMENT AND ENTRIES

Art. 58 – A patent application or a patent, the contents of which are indivisible, may be assigned in whole or in part.

Art. 59 – The BPTO shall make the following entries:

- I – assignment, stating the full particulars of the assignee;
- II – any limitations or requirements placed on the application or patent; and
- III – changes to the name, headquarters or address of the applicant or owner.

Art. 60 – The entries shall have an effect in relation to third parties from the publication date.

CHAPTER VIII- LICENSES

SECTION I – Voluntary Licenses

Art. 61 – A patent owner or applicant may enter into a licensing agreement for exploitation.

Sole Paragraph – The patent owner may afford on the licensee full powers to act in the defense of the patent.

Art. 62 – The licensing agreement shall be recorded at the BPTO in

order to produce an effect in relation to third parties.

§ 1 – The record shall become effective with regard to third parties from its publication date.

§ 2 – The record of the licensing agreement at the BPTO is not needed for the purposes of validity of proof of use.

Art. 63 – An improvement to a licensed patent shall belong to the person who has made the improvement and the other contracting party shall be afforded a preferential right to license.

SECTION II – License Offer

Art. 64 – A patent owner may request the BPTO put his patent up for offer with a view to its exploitation.

§ 1 – the BPTO shall publish the offer.

§ 2 – No exclusive voluntary license shall be recorded at the BPTO unless the patent owner has withdrawn his or her offer.

§ 3 – No patent under an exclusive voluntary license may be put up for offer.

§ 4 – A patent owner may withdraw his or her offer at any time, prior to the express acceptance of its terms by the interested party, in which case the provisions of article 66 shall not apply.

Art. 65 – In the absence of an agreement between the patent holder and the licensee, the parties may request that the BPTO arbitrate the remuneration.

§ 1 – For the purposes of this article, the BPTO shall comply with the provisions of § 4 of article 73.

§ 2 – The remuneration may be reviewed 1 (one) year after it has been determined.

Art. 66 – The renewal fees for a patent subject to offer shall be reduced by one-half during the time between the offer being made and the first license granted.

Art. 67 – The patent owner may request cancellation of a license if the licenses does not begin effective exploitation within 1 (one) year from the license being granted, if exploitation is interrupted for more than 1 (one) year or if he or she does not comply with the conditions for exploitation.

SECTION III – Compulsory Licenses

Art. 68 – A patent owner shall be subject to compulsory licensing of his patent if he exercises his or her rights thereof in an abusive manner or uses it to abuse economic power, as evidenced under

the terms of the law by an administrative or court decision.

§ 1 – The following may also be the grounds for compulsory licensing:

I – failure to exploit the subject matter of the patent within Brazilian territory or failure to manufacture the product or failure to use a fully patented process, except in the case of economic unfeasibility, in which case import shall be permitted; or

II – marketing that does not satisfy the needs of the market.

§ 2 – A license may only be requested by a party having a legitimate interest and having the technical and economic capability to exploit effectively the subject matter of the patent, which should predominantly be intended for the internal market, in which case the exception contained in item I of the previous paragraph shall not apply.

§ 3 – If a compulsory license is granted on the grounds of abuse of economic power, a time limit, set out in the provisions of article 74, shall be guaranteed to a licensee to import the subject matter of the license, provided that it has been placed on the market directly by the patent owner or with his or her consent.

§ 4 – In the event of an import to exploit a patent or an import as set out in the previous paragraph, third parties shall also be allowed to import a product manufactured according to a process or a product patent, provided it has been placed on the market by the patent owner or with his or her consent.

§ 5 – A compulsory license as described in § 1 may only be requested 3 (three) years after patent grant.

Art. 69 – A compulsory license shall not be granted if, on the request date, the patent owner:

I – justifies failure to use for legitimate reasons;

II – proves that serious and effective preparations for exploitation have been made;

III – justifies the failure to manufacture or to market on the grounds of legal obstacles.

Art. 70 – A compulsory license shall also be granted when the following conditions are cumulatively met:

I – there is a situation of dependency of one patent on another;

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

III – the owner fails to reach agreement with the owner of the

dependent patent on the exploitation of the earlier patent.

§ 1 – For the purposes of this article, a patent is dependent if its exploitation absolutely depends on the use of the subject matter of a previous patent.

§ 2 – For the purposes of this article, a process patent may be deemed dependent on a patent for the relevant product, and likewise a product patent may be dependent on a process patent.

§ 3 – The owner of a patent subject to a license according to the provisions of this article shall have the right to a compulsory license of the dependent patent.

Art. 71 – In cases of national emergency or of public interest, declared in an act by the Federal Executive Department, provided that the patent holder or licensee does not satisfy such a need, a temporary non-exclusive compulsory license to exploit the patent may be granted *ex officio* without prejudicing the rights of the patent owner.

Sole Paragraph – The instrument granting the license shall set out its term of validity and the possibility of extension.

Art. 72 – Compulsory licenses shall always be non-exclusive and

sub-licensing shall not be permitted.

Art. 73 – An application for a compulsory license shall set forth the conditions offered to the patent owner.

§ 1 – On filing of the license application, the patent owner shall be notified to reply within the time limit of 60 (sixty) days, on expiry of which, in the absence of a reply from the patent owner, the proposal shall be deemed accepted under the conditions offered.

§ 2 – An applicant for a license who alleges abuse of patent rights or the abuse of economic power shall be required to submit documentary proof.

§ 3 – If a compulsory license is applied for on the grounds of failure to exploit, the patent owner shall prove the exploitation of the patent

§ 4 – If contested, the BPTO may take necessary measures, as well as appoint a committee that may include independent experts, in order to arbitrate the remuneration to be paid to the patent owner.

§ 5 – The bodies and entities of direct and indirect federal, state and municipal public administration shall provide the BPTO with such information as requested to assist in the arbitration of the remuneration.

§ 6 – In the arbitration of remuneration, the circumstances of each case shall be taken into consideration, the inclusion of the economic value of the granted license being compulsory.

§ 7 – Once the case has been examined, the BPTO shall decide on the grant and on the conditions of a compulsory license within a time limit of 60 (sixty) days.

§ 8 – Appeals against decisions granting a compulsory license shall not have a suspensive effect.

Art. 74 – In the absence of legitimate reasons, the licensee shall begin exploitation of the subject matter of the patent within a time limit of one (1) year from the grant of the license, interruption for an equal period of time being permitted.

§ 1 – A patent owner may request cancellation of the license if the provisions of this article are not complied with.

§ 2 – The licensee shall have full powers to defend the patent.

§ 3 – Once a compulsory license has been granted, assignment thereof shall only be permitted together with the assignment, transfer or leasing of that part of the enterprise that exploits it.

CHAPTER IX – PATENT OF INTEREST TO NATIONAL DEFENSE

Art. 75 – A patent application originating in Brazil, the subject matter of which is of interest to national defense shall be prosecuted subject to secrecy and shall not be subject to the publications provided for in this Law.

§ 1 – the BPTO shall promptly forward the application to the competent Executive Power body, which shall issue a decision on secrecy within a time limit of 60 (sixty) days. If such a period of time expires without the competent body giving a decision, the application shall be prosecuted normally.

§ 2 – Filing of a patent application of which the subject matter is deemed to be of interest to national defense shall not be made abroad, nor shall any disclosure thereof be allowed, except if previous consent is given by the competent body.

§ 3 – Exploitation and assignment of the application or patent of interest to national defense shall be subject to prior authorization from the competent body, compensation being guaranteed whenever this implies a restriction to the rights of the applicant or patent owner.

CHAPTER X – CERTIFICATE OF ADDITION

Art. 76 – On payment of a specific fee, the applicant or patent owner may request a certificate of addition to protect an improvement in or development of the invention subject matter, even if it lacks inventive step, provided that the matter is included in the same inventive concept.

§ 1 – Where the main application has already been published, the application for a certificate of addition shall be published at once.

§ 2 – An application for a certificate of addition shall be examined in accordance with the provisions of articles 30 to 37, except where provided for in the previous paragraph.

§ 3 – An application for a certificate of addition shall be rejected if its subject matter does not share the same inventive concept.

§ 4 – An applicant may, within the time limit for appeal and on payment of the applicable fees, request the conversion of an application for a certificate of addition to a patent application, enjoying the filing date of the certificate application.

Art. 77 – The certificate of addition shall be accessory to the patent, shall have the same expiry

date and shall accompany it for all legal effects.

Sole Paragraph – In nullity proceedings, the patent holder may request that the subject matter contained in the certificate of addition be examined to verify if it may subsist without prejudice to the protection term of the patent.

CHAPTER XI – PATENT LAPSE

Art. 78 – A patent shall lapse on:

I – expiry of the protection term;

II – waiver by the patent owner, without prejudice to the rights of other parties;

III – cancellation;

IV – failure to pay the annual fee, within the time limits set out in article 84, § 2, and article 87; and

V – failure to comply with the provisions of article 217.

Sole Paragraph – On patent lapse, its subject matter shall fall into the public domain.

Art. 79 – Waiver shall only be allowed if it does not prejudice the rights of third parties.

Art. 80 A patent shall be canceled, ex officio or at the request of any party with a legitimate interest if, after 2 (two) years from the grant

of a first compulsory license, this time limit has not been sufficient to prevent or remedy abuse or misuse, except for legitimate reasons.

§ 1 – A patent shall be canceled if, on the date of application for cancellation or on that of the *ex officio* commencement of the relevant proceedings, its exploitation has not yet begun.

§ 2 – In cancellation proceedings initiated by request, the BPTO may pursue the proceedings if the applicant desists.

Art. 81 – The patent owner shall be notified by publication to respond within a 60 (sixty) day period, and shall bear the burden of proof of exploitation.

Art. 82 – A decision shall be issued within 60 (sixty) days from the end of the time limit referred to in the preceding article.

Art. 83 – A decision in proceedings for forfeiture shall take effect as from the day of the request or of the publication of *ex officio* institution of proceedings.

CHAPTER XII – ANNUAL FEES

Art. 84 – The applicant and patent owner shall be required to pay an-

nual fees from the beginning of the third year after the filing date.

§ 1 – Advance payment of annual fees shall be regulated by the BP-TO.

§ 2 – Payment shall be made within the first 3 (three) months of each annual period, but it may also be made within the following 6 (six) months, independently of any notification, on payment of an additional fee.

Art. 85 – The provisions of the previous article shall apply to international applications filed under a treaty in force in Brazil, and payment of annual fees due prior to the entry date into the national phase shall be made within a time limit of 3 (three) months from that date.

Art. 86 – Failure to make payment of the annual fee, in accordance with the provisions of articles 84 and 85, shall result in the application being deemed withdrawn or patent being deemed lapsed.

CHAPTER XIII – RESTORATION

Art. 87 – A patent application or a patent may be restored on request by the applicant or patent owner within 3 (three) months from notification of having been deemed withdrawn or the patent having

lapsed, on payment of a specific fee.

CHAPTER XIV – INVENTIONS OR UTILITY MODELS MADE BY EMPLOYEES OR SERVICE PROVIDERS

Art. 88 – An invention or utility model shall belong exclusively to the employer when it results from a contract of work being performed in Brazil and whose subject matter is the research or inventive activity or if such results from the nature of the services for which the employee was contracted.

§ 1 – Except as otherwise stipulated by contract, the remuneration for the work this article refers to shall be limited to the agreed salary.

§ 2 – In the absence of proof to the contrary, an invention or utility model for which a patent is sought by an employee within 1 (one) year from termination of the employment contract shall be deemed to have been developed during the term of the contract.

Art. 89 – An employer who is the patent owner may award the employee who is the author of the invention or improvement, participation in the economic gain resulting from the exploitation of the patent, by negotiating with the

interested party or as provided for by the rules of the company.

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

Art. 90 – An invention or utility model developed by an employee shall belong exclusively to the employee, provided that it is in no way connected to his employment contract and if it does not result from the use of resources, means, data, materials, facilities or equipment of the employer.

Art. 91 – An invention or utility model shall be joint property, in equal shares, if it results from the personal contribution of the employee and from the resources, data, means, data, materials, facilities or equipment of the employer, without prejudice to express contrary contractual provisions.

§ 1 – If more than one employee is involved, the part due to each shall be divided equally between all of them, except as agreed to the contrary.

§ 2 – The employer shall be entitled to exclusive right to the exploitation license and the employee shall be entitled to fair remuneration.

§ 3 – The exploitation of the patent subject matter, if agreement has not been reached on the issue, shall be started by the employer within 1 (one) year from the grant date, failing which the patent ownership shall be transferred as an exclusive right to the employee, except where there are legitimate reasons for the failure to exploit.

§ 4 – In the event of an assignment, any of the joint owners, under the same conditions, may exercise preference rights.

Art. 92 – The provisions of the preceding articles shall apply, as appropriate, to the relationship between an independent worker or a trainee and the contracting company and between contracting and contracted companies.

Art. 93 – The provisions of this Chapter shall apply, as appropriate, to entities of Public Authorities, whether direct, indirect or foundational and federal, state or municipal.

Sole Paragraph – Under the terms of article 88, the inventor shall be entitled to an award corresponding to a share of the value of the benefits obtained due to the application, subject to the terms and conditions set out by the statutes

and internal regulations of the entity to which this article refers.

TITLE II – INDUSTRIAL DESIGNS

CHAPTER I – OWNERSHIP

Art. 94 – The author shall be afforded the right to obtain an industrial design registration securing him or her the ownership of the design, under the terms set out by this Law.

Sole Paragraph – The provisions of articles 6 and 7 shall apply, as appropriate, to industrial design registrations.

CHAPTER II – REGISTRABILITY

SECTION I – REGISTRABLE INDUSTRIAL DESIGNS

Art. 95 – An industrial design shall be deemed to be any ornamental 3-dimensional form of an object or any ornamental arrangement of lines and colours which may be applied to a product, resulting in a new and original appearance in its external configuration and that may serve as a model for industrial manufacture.

Art. 96 – An industrial design is deemed new if it is not comprised in the prior art.

§ 1 – The prior art shall comprise everything made available to the public before the application filing date, in Brazil or abroad, by use or by any other means, without prejudice to the provisions of § 3 of this article and of article 99.

§ 2 – For the sole purpose of determining novelty, the full contents of a patent application or registration filed but not yet published in Brazil shall be deemed part of the prior art from the filing or claimed priority date, provided that it is published, even if this happens subsequently.

§ 3 – An industrial design that is published during the 180 (one hundred and eighty) days preceding the application filing date or claimed priority date shall not be deemed part of the prior art, provided publication was made in the situations referred to in items I and III of article 12.

Art. 97 – An industrial design is deemed to be original if it results in a visual configuration that is distinctive in relation to existing objects.

Sole Paragraph – The original visual result may be the result of a combination of known elements.

Art. 98 – Works of a purely artistic nature shall not be considered industrial designs.

SECTION II – Priority

Art. 99 – The provisions of article 16, except for the time limit referred to in § 3 of that article which shall be 90 (ninety) days, shall apply, as appropriate, to registration applications.

SECTION III – Non-registrable Industrial Designs

Art. 100 – An industrial design shall not be registrable if:

- I – it is contrary to morality and decency or if it offends the honor or image of persons, threatens the freedom of conscience, belief, religions or ideas and feelings deserving respect and veneration;
- II – it is the necessary common or ordinary shape of the object or even, a shape that is essentially determined by technical or functional considerations.

CHAPTER III – REGISTRATION APPLICATIONS

SECTION I – Application Filing

Art. 101 – A registration application, in accordance with the conditions set out by the BPTO, shall contain:

- I – a request;
- II – a specification (descriptive report), where applicable;
- III – claims, where appropriate;

IV – drawings or photographs;
V – the field of application of the object; and
VI – proof of payment of the filing fee.

Sole Paragraph – Documents comprised in a registration application shall be filed in Portuguese.

Art. 102 – On submission, an application shall be subject to a formal preliminary examination and, if found in order, shall be recorded and the submission date shall be taken to be the filing date.

Art. 103 – An application that does not formally meet the requirements of article 101, but which contains sufficient data relating to the applicant, industrial design and the author, may be submitted to the BPTO in return for a dated receipt which sets out the requirements to be met within a period of 5 (five) days, failing which the documentation shall be deemed non-existent.

Sole Paragraph – Once the requirements have been met, the filing shall be considered to have been made on the application submission date.

SECTION II – Application Requirements

Art. 104 – An application for an industrial design registration shall

refer to a single object, of which a plurality of variations shall be permitted, provided that they are intended for the same purpose and all possess the same distinctive characteristic, each being limited to a maximum of twenty (20) variations.

Sole Paragraph – The drawing shall clearly and adequately represent the object and its variations, where applicable, in such a manner as to enable its reproduction by a person skilled in the art.

Art. 105 – Where secrecy is requested under § 1 of article 106, the application may be withdrawn within a period of up to 90 (ninety) days from the filing date.

Sole Paragraph – Withdrawal of an earlier application that produces no effect, shall confer priority to the first subsequent application.

SECTION III – Application Prosecution and Examination

Art. 106 – Once the application for an industrial design has been filed and the provisions of articles 100, 101 and 104 have been met, it shall automatically be published, registration shall be simultaneously granted and the relevant certificate shall be issued.

§ 1 – At the request of the applicant at the time of filing, an application may be kept secret for a period of 180 (one hundred and eighty) days from the filing date, following which it shall be prosecuted.

§ 2 – If an applicant avails himself of the provisions of article 99, the application shall not be prosecuted until the priority document is filed.

§ 3 – If the provisions of 101 and 104 are not met, a notification shall be issued, and the applicant shall be given 60 (sixty) days to submit his or her reply, on penalty of which the application shall be deemed definitively withdrawn.

§ 4 – If the provisions of article 100 are not complied with, the registration application shall be rejected.

CHAPTER IV – REGISTRATION GRANT AND TERM

Art. 107 – The certificate shall contain the number and title, author name, in accordance with the provision of § 4 of article 6, the name, nationality and country of residence of the owner, the term of validity, the drawings, data relating to foreign priority, and where applicable, the specification and claims.

Art. 108 – Registrations shall have a term of 10 (ten) years from the filing date. This term shall be renewable for 3 (three) successive 5 (five) year periods.

§ 1 – Applications for renewal shall be made during the last year of the registration term and shall be accompanied by proof of payment of the corresponding fee.

§ 2 – If renewal has not been applied for before the end of the registration term, the owner may request renewal within the following 180 (one hundred and eighty) days, on payment of an additional fee.

CHAPTER V – PROTECTION CONFERRED BY REGISTRATION

Art. 109 – Ownership of an industrial design shall be acquired by means of a valid registration.

Sole Paragraph – The provisions of article 42 and § 1, 2 and 4 of article 43 shall apply, as appropriate, to an industrial design registration.

Art. 110 – Any person who, in good faith, prior to the filing date or priority date of a registration application used to exploit the subject matter in Brazil, shall be entitled to continue such exploita-

tion in the same way and condition without any liability.

§ 1 – The right conferred by this article may only be assigned together with the business or company, or part thereof that is directly related to the exploitation of the subject matter of the registration, by transfer or leasing.

§ 2 – The right conferred by the article shall not be enjoyed by a person who obtained knowledge of the subject matter of the registration as a result of publication, in accordance with § 3 of article 96, provided that the application was filed within 6 (six) months from the publication.

CHAPTER VI – SUBSTANTIVE EXAMINATION

Art. 111 – The owner of an industrial design may at any time during the registration term request the examination as to novelty and originality of the subject matter of the registration.

Sole paragraph – the BPTO shall issue a substantive opinion which, if it is established by the absence of at least one of the requirements referred to in articles 95 to 98, shall serve as a basis for the commencement of ex officio nullity proceedings for registration.

CHAPTER VII – REGISTRATION NULLITY

SECTION I – General Provisions

Art. 112 – A registration shall be deemed null and void if granted contrary to the provisions of this Law.

§ 1 – Registration nullity shall take effect from the application filing date.

§ 2 – When the provisions of article 94 have not been complied with, the author may, alternatively, institute proceedings to decide registration ownership.

SECTION II – Administrative Procedure for Nullity

Art. 113 – Registration nullity shall be declared administratively if it has been granted contrary to the provisions of articles 94 to 98.

§ 1 – Registration nullity may be instituted ex officio or at the request of any person having a legitimate interest, within 5 (five) years from the registration grant date, without prejudice to the case referred to in the sole paragraph of article 111.

§ 2 – Commencement of proceedings on request or ex officio shall suspend the effects of the registration grant if submitted or pub-

lished within 60 (sixty) days from the grant.

Art. 114 – The owner of the registration shall be notified to submit his or her comments within 60 (sixty) days from the publication date.

Art. 115 – Irrespective of a response having been filed, on expiry of the time limit specified in the previous article, the BPTO shall issue an opinion and notify the owner and the applicant to submit a reply within 60 (sixty) days.

Art. 116 – On expiry of the time limit set out in the previous article, even if no responses have been received, the procedure will be decided by the President of the BPTO, and the administrative procedure shall be concluded.

Art. 117 – Nullity proceedings shall continue even if the registration has lapsed.

SECTION III – Nullity Proceedings

Art. 118 – The provisions of articles 56 and 57 shall apply, as appropriate, to nullity proceedings of an industrial design registration.

CHAPTER VIII – REGISTRATION LAPSE

Art. 119 – A registration shall lapse on:

- I – expiry of the protection term;
- II – waiver by the owner, without prejudice to the rights of third parties;”
- III – failure to pay the fee referred to in articles 108 and 120; or
- IV – failure to comply with the provisions of article 217.

CHAPTER IX – FIVE-YEAR FEE

Art. 120 – The registration owner shall be required to pay a five-year fee from the second five-year period after the filing date.

§ 1 – Payment for the second five-year period shall be made during the fifth year of the registration term.

§ 2 – Payment for all other five-year periods shall be made at the time of application submission for renewal referred to in article 108.

§ 3 – Payment of five-year fees may also be made subsequently within 6 (six) months following the period set out in the preceding paragraph, on payment of an additional fee.

CHAPTER X – FINAL PROVISIONS

Art. 121 – The provisions of articles 58 to 63 shall apply, as appropriate, to the subject matter covered by this Title and employee and service provider rights shall be governed by articles 88 to 93.

TITLE III – TRADEMARKS

CHAPTER I – REGISTRABILITY

SECTION I – Signs Registrable as Trademarks

Art. 122 – Any distinctive visually perceivable signs, if not prohibited by law, shall be eligible for trademark registration.

Art. 123 – For the purposes of this Law the following definitions shall apply:

I – product or service mark: a mark used to distinguish a product or service from an identical, similar or related product or service of different origin;

II – certification mark: a mark used to attest that a product or service complies with established standards or specifications, particularly regarding its quality, material used and methodology employed; and

III – collective mark: a mark used to identify goods or services produced by members of a certain entity.

SECTION II – Signs Non-registrable as Trademarks

Art. 124 – The following shall be non-registrable as trademarks:

I – official, public, national, foreign or international coats of arms, armorial bearings, medals, flags, emblems, decorations or monuments, as well as any designations, figures or imitations thereof;

II – an individual letter, number or date, on its own, except when sufficiently distinctive;

III – expressions, figures, drawings or any other sign contrary to morality and decency or which offends the honor or image of a person or which offends freedom of conscience, belief, religions or ideas and feelings that deserve respect and veneration;

IV – designations or initials of public entities or bodies, where registration is not required by the public entity or body;

V – reproductions or imitations of a characteristic or differentiating element of a third party establishment name or company name, likely to mislead or cause confusion with such distinctive signs;

VI – signs of a generic, necessary, common, ordinary or simply descriptive nature when related to the product or service to be distinguished, or those commonly used to designate a characteristic of a product or service with respect to its nature, nationality, weight, value, quality and period of production or provision of a service, except where presented in a sufficiently distinctive form;

VII – signs or expressions used merely as a means of advertising;

VIII – colours and their names, except where arranged or combined in an unusual and distinctive way;

IX – geographical indications, or their imitations likely to mislead or signs that might wrongly suggest a geographical indication;

X – signs that induce a false indication of their origin, source, nature, quality or usefulness of the product or service to which the trademark is applied;

XI – reproductions or imitations of official seals normally used to guarantee a standard of any type or nature;

XII – reproductions or imitations of signs registered as collective or certification marks by a third party, without prejudice to the provisions of article 154;

XIII – names, prizes or symbols of official or officially recognized sporting, artistic, cultural, social,

political, economic or technical events, or imitations likely to cause confusion, except when authorized by the competent authority or entity promoting the event;

XIV – reproductions or imitations of securities, bonds, coins or bank notes of the Union, States, Federal District, Territories, Municipalities or any other country;

XV – personal names or signatures, family names and surnames and images of third parties, except with consent of the owner, or his or her heirs or successors;

XVI – widely known pseudonyms or nicknames, singular or collective artistic names, except with the consent of the owner, or his or her heirs or successors;

XVII – literary, artistic or scientific work, as well as titles protected by copyrights and likely to mislead or cause confusion, except with the consent of the author or owner;

XVIII – technical terms used in industry, science and art that are related to the product or service to be distinguished;

XIX – reproductions or imitations, in whole or in part, even with additions, of a trademark registered by a third party, to distinguish or certify an identical, similar or related product or service, which is likely to cause confusion or association with a third party's trademark;

XX – duplication of trademarks of a single owner for the same product or service, except where, in the case of trademarks of the same nature, they are presented in a sufficiently distinctive manner;

XXI – the necessary, common or usual shape of a product or packaging, or even, shapes that cannot be dissociated from a technical effect;

XXII – objects that are protected by an industrial design registration owned by a third party; an

XXIII – signs that imitate or reproduce, in whole or in part, a trademark which the applicant could not fail to have knowledge of in view of his or her activities and of which the owner is established or resident in Brazil or in a country with which Brazil has an agreement or affords reciprocal treatment, if the trademark is intended to distinguish a product or service that is identical, similar or related, and likely to cause confusion or association with such a third party's trademark.

SECTION III – Famous Trademarks

Art. – 125 – Trademarks registered in Brazil and deemed to be famous shall be afforded special protection in all fields of activity.

SECTION IV – Well-known Trademarks

Art. 126 – Trademarks that are well-known in their field of activity in accordance with article 6 bis (I) of the Paris Convention for the Protection of Industrial Property shall enjoy special protection, irrespective of whether they have been previously filed or registered in Brazil.

§ 1 – The protection afforded by this article shall apply also to service marks.

§ 2 – the BPTO may reject ex officio an application for a trademark registration that, in whole or in part, reproduces or imitates a well-known trademark.

CHAPTER II – PRIORITY

Art. 127 – Priority rights shall be afforded to a trademark registration application filed in a country with which Brazil has signed an agreement or with an international organization that has the effect of a national filing, within the time limits set out in such an agreement, the filing not being invalidated or prejudiced by events occurring within such periods of time.

§ 1 – A priority claim shall be made at the time of filing and may be supplemented within 60 (sixty)

days by other priorities that precede the filing date in Brazil.

§ 2 – A priority claim shall be supported by means of a suitable document of origin containing the number, date and reproduction of the registration application or registration, together with a simple translation, the contents of which shall be the full responsibility of the applicant.

§ 3 – If not provided at the time of filing, proof shall be provided within 4 (four) months from the filing date, under penalty of losing priority.

§ 4 – Where priority is obtained under an assignment, the relevant document shall be submitted together with the actual priority document.

CHAPTER III – REGISTRATION APPLICANTS

Art. 128 – Public law or private law natural or legal persons may apply for a trademark registration.

§ 1- Private law persons may only apply for trademark registrations relating to the activity they effectively and lawfully exercise, either directly or through companies they directly or indirectly control, and they shall state such fact on the actual request, under penalty of the law.

§ 2 – A collective mark registration may only be applied for by a legal person representing a group who may exercise an activity different from that of its members.

§ 3 – A certification mark registration shall only be applied for by a person with no direct commercial or industrial interest in the certified product or service.

§ 4 – A priority claim shall not exempt an application from being subject to the provisions of this Title.

CHAPTER IV – TRADEMARK RIGHTS

SECTION I – Acquisition

Art. 129 – Ownership of a trademark shall be acquired by a valid registration, according to the provision of this Law, the owner having exclusive use of the trademark throughout national territory, without prejudice to the provisions of articles 147 and 148 with respect to collective and certification marks.

§ 1 – Any person who, in good faith, at the priority or application date, has been using an identical or similar trademark for at least 6 (six) months in Brazil to distinguish or certify an identical, similar or related product or service, shall have preferential rights to registration.

§ 2 – Preferential rights shall only be assigned, together with the business of the company, or part thereof that is directly related to the use of the trademark, by transfer or leasing.

SECTION II – Protection Afforded by the Registration

Art. 130 – The owner of a trademark shall also enjoy the right to:

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

Art. 131 – The protection afforded by this Law includes the use of the trademark on papers, printed matter, in advertising and in documents related to the activities of the owner.

Art. 132 – The owner of a trademark shall not prevent:

- I – traders or distributors from using their own distinctive signs, together with the trademark of the product, for the purposes of promotion and marketing.
- II – manufacturers of accessories from using the trademark to indicate the use of the product, provided they comply with the principles of fair competition.

III – free circulation of products placed on the internal market, by the owner or with his or her consent, without prejudice to the provisions of § 3 and 4 of article 68; and

IV – mention of the trademark in speeches, scientific or literary works or in any other publication, provided it is done without any commercial connotation and in no way prejudices its distinctive character.

CHAPTER V – TERM, ASSIGNMENT AND ENTRIES

SECTION I – Term

Art. 133 – A trademark registration shall have a term of 10 (ten) years, as from the grant date, and may be renewed for successive and similar periods.

§ 1 – A renewal application shall be filed during the last year of the registration term and shall be accompanied by proof of payment of the corresponding fee.

§ 2 – If no renewal request has been made by the end of the registration term, the owner may request renewal within the following 6 (six) months, on payment of an additional fee.

§ 3 – Renewals shall not be granted if the provisions of article 128 are not complied with.

SECTION II – Assignment

Art. 134 – Registration applications and registrations may be assigned provided that the assignee meets the statutory requirements for requesting such registration.

Art. 135 – An assignment shall include all registrations or registration applications, in the name of the assignor for identical or similar trademarks with respect to a product or service that is identical, similar or related, under penalty of the registrations being canceled or the applications not assigned being withdrawn.

SECTION III – Entries

Art. 136 – The BPTO shall make the following entries:

I – of the assignment, giving the full particulars of the assignee;
II – of any limitation or burden on the application or registration; and
III – of changes in the name, headquarters or address of the applicant or the owner.

Art. 137 – Entries shall become effective with respect to other persons on their publication date.

Art. 138 – An appeal may be lodged against any decision which:

I – rejects assignment entries; or
II – cancels the registration or withdraws the application, according to the provisions of article 135.

SECTION IV – Use License

Art. 139 – A registration owner or applicant may enter into a licensing agreement for the trademark use, without prejudice to his or her rights, to exercise effective control over the specification, nature and quality of the respective products or services.

Sole Paragraph – The owner may afford the licensee full powers to take action to defend the trademark, without prejudice to his or her own rights.

Art. 140 – The licensing agreement shall be recorded at the BPTO in order to be effective in relation to third parties.

§ 1 – The record shall become effective with regard to third parties from its publication date.

§ 2 – The record of the licensing agreement at the BPTO is not needed for the purposes of validity of proof of use.

Art. 141 – Appeals may be lodged against any decisions rejecting the record of a licensing agreement.

CHAPTER VI – LOSS OR RIGHTS

Art. 142 – The trademark registration shall lapse on:

- I – expiry of the protection term;
- II – waiver, either in whole or in part, of the products or services to which the trademark applies;
- III – cancellation;
- IV – failure to comply with the provisions of article 217.

Art. 143 – A registration shall be canceled, at the request of any person having a legitimate interest, if, on the actual request date:

- I – trademark use has not begun in Brazil within 5 years of its grant;
- II – trademark use has been interrupted for more than 5 (five) consecutive years, or if, within the same period, the mark has been used in a modified form that involves alteration to its original character in accordance with the registration certificate.

§ 1 – A trademark shall not be canceled if the owner gives legitimate reasons for failure to use it.

§ 2 – The owner shall be notified to reply within a time limit of 60 (sixty) days, and shall prove that the trademark has been used or justify failure to use it for legitimate reasons.

Art. 144 – Trademark use shall comprise the products or services referred to in the certificate, under penalty of partial cancellation of the registration with respect to those products or services which are not similar or related to those for which the trademark use was proven.

Art. 145 – Requests for cancellation shall not be admitted if the trademark use has been proven or if failure to use it has been justified in an earlier proceeding filed less than 5 (five) years previously.

Art. 146 – Appeals may be lodged against decisions which declare or deny cancellation.

CHAPTER VII – COLLECTIVE AND CERTIFICATION MARKS

Art. 147 – Registration applications for collective marks shall include the regulations for use, determining conditions and prohibitions regarding the mark use.

Sole Paragraph – If the regulations for use do not accompany the application, these regulations shall be filed within 60 (sixty) days from the filing date, under penalty of the application being deemed definitively withdrawn.

Art. 148 – Applications for a certification mark registration shall contain:

- I – the product or service characteristics to be certified; and
- II – control measures to be adopted by the owner.

Sole Paragraph – If the documents referred to in items I and II of this article do not accompany the application, these documents shall be filed within 60 (sixty) days, under penalty of the application being deemed definitively withdrawn.

Art. 149 – Any changes in the regulations for use shall be notified to the BPTO by means of a duly filed request, stating the provisions that have been changed, under penalty of the changes being disregarded.

Art. 150 – Mark use shall not be dependent on a license and it shall be sufficient to have authorization in the regulations for use.

Art. 151 – In addition to the grounds for lapse referred to in article 142, collective and certification mark registration shall lapse if:

- I – the entity ceases to exist; or
- II – the mark is used under condi-

tions that differ from those laid down in the regulations for use.

Art. 152 – Waiver of a collective mark registration shall only be accepted if requested in accordance with the articles of incorporation or statutes of the entity itself, or even the regulations for use.

Art. 153 – A registration shall be declared canceled if the collective mark is not used by more than one authorized person, without prejudice to the provisions of articles 143 and 146.

Art. 154 – Collective or certification marks which have already been used and the registrations of which have lapsed may not be registered in the name of another party before the 5 (five) year time limit from the registration lapse has expired.

CHAPTER VIII – FILING

Art. 155 – Applications shall refer to a single distinctive sign and, according to the conditions established by the BPTO, shall contain:

- I – the application;
- II – labels, where appropriate; and
- III – proof of payment of the filing fee.

Sole Paragraph – The request and any supporting documents shall

be filed in Portuguese and any document filed in a foreign language shall have an uncertified translation submitted at the time the application is filed or within the following 60 (sixty) days under penalty of the document not being taken into consideration.

Art. 156 – Once the application has been filed it shall be subject to a formal preliminary examination, and if found in order, the application shall be recorded and the submission date shall be taken to be the filing date.

Art. 157 – Applications that do not comply with the requirements of article 155, but which contain sufficient data about the applicant, the trademark sign and the class, may be filed with the BPTO in return for a dated receipt which shall establish the conditions to be complied with by the applicant within 5 (five) days, under penalty of not being taken into consideration.

Sole Paragraph – Once the conditions have been complied with, the filing date shall be taken to be that of the application submission date.

CHAPTER IX – EXAMINATION

Art. 158 – Once recorded, the application shall be published to enable oppositions to be filed within a time limit of 60 (sixty) days.

§ 1 – The applicant shall be notified of any opposition and shall be notified to reply within 60 (sixty) days.

§ 2 – Oppositions, the administrative procedure for nullity or nullity proceedings based on the provisions of item XXIII of article 124 or 126 shall not be admitted unless proof of registration application filing is supplied, in accordance with this Law, within the time limit of 60 (sixty) days from the opposition, administrative procedure for nullity or nullity proceedings filing date.

Art. 159 – On expiry of the opposition period, or if an opposition has been lodged, on expiry of the period for submitting comments, the examination shall be carried out during which conditions may be established which shall be complied with within 60 (sixty) days.

§ 1 – If no answer is received to the conditions, the application

shall be deemed definitively withdrawn.

§ 2 – Once the reply to the conditions has been filed, even if the conditions have not been met, or if its formulation has been contested, the examination shall be continued.

Art. 160 – On completion of the examination, a decision shall be issued approving or rejecting the registration application.

CHAPTER X – ISSUE OF REGISTRATION CERTIFICATES

Art. 161 – A registration shall be issued once the application has been approved and proof of payment of the appropriate fees has been supplied.

Art. 162 – The payment of fees and proof of payment in respect of the issue of the registration certificate and to the first 10(ten) years of protection shall be made within the time limit of 60 (sixty) days from approval.

Sole Paragraph – The fees may also be paid and proof supplied within 30 (thirty) days from the time limit referred to in this article, independent of notification, on payment of a specific fee, under penalty of the application being definitively withdrawn.

Art. 163 – A registration certificate shall be deemed to have been issued on the publication date of the relevant decision.

Art. 164 – The certificate shall mention the trademark, the registration number and date, name, nationality and country of residence of the owner, the products and services, the registration characteristics and foreign priority.

CHAPTER XI – REGISTRATION NULLITY

SECTION I – General Provisions

Art. 165 – A registration granted contrary to the provisions of this Law shall be null and void.

Sole Paragraph – Registration nullity may be total or partial, and a condition for partial nullity shall be the fact that the remaining part is registrable.

Art. 166 – A trademark owner registered in a country that is a signatory of the Paris Convention for the Protection of Industrial Property may, alternatively, commence legal proceedings to claim registration ownership, in accordance with the provisions of article 6 septies (1) of that Convention.

Art. 167 – A nullity declaration shall be effective from the filing date.

SECTION II – Administrative Procedure for Nullity

Art 168 – Registration nullity shall be declared administratively if the registration has been granted contrary to the provisions of this Law.

Art 169 – A nullity procedure may be instituted ex officio or at the request of any person with a legitimate interest within a time limit of 180 (one hundred ad eighty) days from the registration certificate issue date.

Art. 170 – The owner shall be notified to reply within a time limit of 60 (sixty) days.

Art. 171- After the time limit referred to in the previous article, even if no response has been submitted, the procedure shall be decided by the president of the BPTO, and the administrative procedure shall be closed.

Art. 172 – Nullity proceedings shall continue even if the registration has lapsed.

SECTION III – Nullity Proceedings

Art. 173 – Nullity proceedings may be commenced by the BPTO or by any person having a legitimate interest.

Sole Paragraph – During the course of the proceedings, the judge may grant an injunction suspending the registration effects and the trademark use, provided that the relevant procedural requirements are complied with.

Art. 174 – Proceedings to declare registration nullity shall prescribe in 5 (five) years from the registration date.

Art. 175 – Nullity proceedings shall be brought before the Federal Justice Courts and the BPTO shall participate in the proceedings when it is not the plaintiff.

§ 1 – A defendant owner of a registration shall have a time limit of 60 (sixty) days to reply.

§ 2 – When the final decision on nullity proceedings has been made, the BPTO shall publish a notification to inform third parties.

TITLE IV GEOGRAPHICAL INDICATIONS

Art. 176 – A geographical indication shall be an indication of the source or origin denomination.

Art. 177 – Indication of the source shall mean the geographic name of a country, city, region or location in its territory, which has become known as the center of extraction, production or manufacture of a given product or of the provision of a given service.

Art. 178 – Denomination of origin shall be the geographical name of a country, city, region or locality in its territory, used to designate a product or service of which the qualities or characteristics are exclusively or essentially due to the geographical environment, including natural and human factors.

Art. 179 Protection shall extend to the graphical or figurative representation of a geographical indication, as well as the geographic representation of the country, city, region or location of which the name is a geographical indication.

Art. 180 – Where the geographical name has entered into everyday use designating a given product or service, it shall not be deemed a geographical indication.

Art. 181 – A geographical name that is not an indication of source or denomination of origin may be used as a characteristic element of a product or service mark provided it does not suggest a false origin.

Art. 182 – The use the geographic indication shall be reserved to the producers and service providers established in that locality and, regarding denominations of origin, quality requirements shall also be complied with.

Sole Paragraph – The BPTO shall establish the conditions for registration of geographic indications.

TITLE V – INDUSTRIAL PROPERTY INFRINGEMENT

CHAPTER I – PATENT INFRINGEMENT

Art. 183 – An infringement of a patent for an invention or utility model is committed by any person who:

- I- manufactures a product which is the subject matter of a patent for an invention or utility model patent without the authorization of the patent owner; or
- II – uses a means or a process that is the subject matter of a patent for an invention, without the authorization of the patent owner.

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

Art. 184 – An infringement of a patent for an invention or utility model is committed by any person who:

I – exports, sells, exhibits or offers for sale, holds in stock, conceals or receives for use for commercial purposes, a product manufactured in infringement of a patent for an invention or utility model, or that was obtained by a patented means or process; or
II – imports a product that is the subject matter of a patent for an invention or utility model or which is obtained by a means or a process patented in Brazil, for the purposes referred to in the previous item, and that has not been placed on the external market directly by the patent owner or with his or her consent.

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

Art. 185 – Supplying a component of a patented product, or material or equipment for carrying out a patented process, where the end use of the component, material or equipment necessarily implies exploitation of the subject matter of the patent.

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

Art. 186 – The acts referred to in this Chapter shall constitute infringement even if they do not affect all claims of the patent or if they are limited to the use of means equivalent to the subject matter of the patent

CHAPTER II – INDUSTRIAL DESIGN INFRINGEMENT

Art. 187 – Manufacturing, without authorization of the owner, a product that incorporates a registered industrial design, or a substantial imitation thereof that is likely to mislead or cause customer confusion.

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

Art. 188 – An infringement of an industrial design registration is committed by any person who:

I – exports, sells, exhibits or offers for sale, holds in stock, conceals or receives for use for commercial purposes, a product manufactured in infringement of a patent for an invention or utility model, or that was obtained by a patented means or process; or
II – imports a product that is the subject matter of a patent for an

invention or utility model or which is obtained by a means or a process patented in Brazil, for the purposes referred to in the previous item, and that has not been placed on the external market directly by the patent owner or with his or her consent.

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

CHAPTER III – TRADEMARK INFRINGEMENT

Art. 189 – An infringement of a registered trademark is committed by any person who:

I – reproduces, in whole or in part, a registered trademark, without the authorization of the owner, or imitates it in a manner that may cause confusion; or

II – alters the registered trademark of another person already affixed to a product on the market.

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

Art. 190 – An infringement of a registered trademark is committed by any person who imports, exports, sells, offers or exhibits for sale, conceals or keeps in stock:

I- a product bearing a trademark of another party which is unlaw-

fully reproduced or imitated, in whole or in part; or

II – a product of his or her industry of commerce, held in a vessel, container or packaging bearing the legitimate trademark of another person.

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

CHAPTER IV – INFRINGEMENTS COMMITTED BY MEANS OF TRADEMARKS, ESTABLISHMENT NAMES AND ADVERTISING SIGNS

Art. 191- Reproducing or imitating, in whole or in part, in a manner that may mislead or cause confusion, official armorial bearings, coats of arms or decorations whether national, foreign or international without the necessary authorization, in a trademark, establishment name, trade name, insignia or advertising sign, or using such reproductions or imitations for commercial purposes.

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

Sole paragraph – Any person who sells, exhibits or offers for sale products branded with such marks shall be subject to the same penalty.

CHAPTER V – INFRINGE- MENT OF GEOGRAPHICAL AND OTHER INDICATIONS

Art. 192 – Manufacturing, importing, exporting, selling, exhibiting or offering for sale or having in stock a product that bears a false geographical indication.

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

Art. 193 – Using on a product, container, case, wrapper, label, invoice, circular, poster, or any other form of publicity or advertising, indicative terms such as “type”, “sort”, “kind”, “system”, “similar”, “substitute”, “identical”, or the like, failing to clearly state the true source of the product.

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

Art. 194 – Using a trademark, commercial name, establishment name, insignia, advertising sign or expression or any other form that suggests a source other than the true source, or selling or exhibiting for sale a product bearing such signs.

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

CHAPTER VI – ACTS OF UN- FAIR COMPETITION

Art. 195 – An act of unfair competition is committed by any person who:

- I – publishes, by any means, a false statement, detrimental to a competitor, with the aim of obtaining an advantage;
- II – supplies or publishes false information with respect to a competitor with the aim of obtaining an advantage;
- III – uses fraudulent means to divert the customers of another party, for his or her own profit or that of another party;
- IV – uses the advertising expression or sign of another party, or imitates it, in a manner liable to cause confusion between products or establishments;
- V – makes undue use of another party’s commercial name, establishment name or insignia or sells, exhibits, offers for sale or has in stock a product bearing those references;
- VI – substitutes on the product of another party the name or company name of such party, without his or her consent, with his or her own name or company name;
- VII – claims, by way of advertising, to have received a prize or distinction that he or she has not actually been awarded;

VIII – sells, exhibits or offers for sale, in the container or packaging of another, an adulterated or counterfeit product, or uses such container or packaging to trade with a product of the same type, even if not adulterated or counterfeit, if such does not constitute a more serious offense;

IX – gives or promises money or other consideration to an employee of a competitor in return for which the employee, failing in his or her duties of employment, provides him or her with an advantage;

X – receives money or other consideration, or accepts a promise of payment or reward in return for providing an advantage to a competitor, thereby failing in his or her duties of employment;

XI – publishes, exploits or uses, without authorization, confidential knowledge, information or data which may be used in industry, commerce or service provision, except where such confidential knowledge, information or data are in the public domain or are obvious to a person skilled in the art, to which he or she has had access due to a contractual or employment relationship, even after termination of the contract;

XII – publishes, exploits or uses, without authorization, such knowledge or information referred to in the previous item, ob-

tained by illicit means or to which he or she has had access by fraud;

XIII – sells, exhibits or offers for sale a product that he or she wrongly states to be subject of a patent filed or granted or of a registered industrial design or who wrongly states in a commercial announcement or paper that such product has been filed, patented or registered; or

XIV – publishes, exploits or uses without authorization, the results of tests or other undisclosed data that have been developed involving a considerable effort and which has been submitted to government entities as a condition for the approval of the marketing of products (Included by Law no. 10,1966 of 14/02/2001).

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

§ 1 – The situations referred to in XI and XII include the employer, partner or administrator of a company who commits an act described in those items.

§ 2 – The provisions of item XIV shall not apply to the publication by a government agency competent to authorize the marketing of a product, where necessary to protect the public.

CHAPTER VII – GENERAL PROVISIONS

Art. 196 – The terms of imprisonment provided for in Chapters I, II and III of this Title shall be increased by between one third and one half if:

I – the person is or was a representative, proxy, agent, partner or employee of the patent or registration owner or also of his licensee; or

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

Art. 197 – The fines provided for in this Title shall range between a minimum of 10 (ten) and maximum of 360 (three hundred and sixty) daily fines, in accordance with the provisions of the Penal Code.

Sole paragraph – The fines may be increased or reduced by up to ten (10) times, taking into consideration the personal situation of the agent and the size of the advantage obtained, regardless of the provisions set out in the previous article.

Art. 198 – At the time of clearance, customs authorities may seize, *ex officio* or at the request of an interested party, any prod-

ucts bearing falsified, altered or imitated marks or a false indication of source.

Art. 199 – Proceedings with respect to offenses referred to in this Title are only commenced upon complaint, except in the case of the offense referred to in article 191 which shall bring about public criminal proceedings.

Art. 200 – Criminal proceedings and preliminary measures of search and seizure, in cases of industrial property infringement, shall be governed by the provisions of the Code of Criminal Procedure, with the alterations provided for in the articles of this Chapter.

Art. 201 – During the execution of a search and seizure measure relating to a patent infringement of which the subject matter is a process invention, the bailiff shall be accompanied by an expert who shall make a preliminary verification of the existence of the unlawful act, enabling the judge to order seizure of the products obtained by the infringer using the patented process.

Art. 202 – In addition to the preliminary measures of search and seizure, the party interested party may request:

I – seizure of a counterfeit, altered or imitated trademark where it is prepared or found, prior to use for criminal purposes; or
II – destruction of the counterfeit trademark on packaging or products that contain it, before distribution, even if this implies the destruction of the packaging or products themselves.

Art. 203 – In the case of a lawful constituted industrial or commercial establishment operating in public, the preliminary measures shall be limited to inspection and seizure of the products as ordered by the judge, the lawful activity not being brought to a halt.

Art. 204 – If a search and seizure procedure was requested in bad faith, for reasons of competition, a mere whim or gross error, the person who requested the measure shall be liable for loss and damages.

Art. 205 – An allegation of a patent or registration nullity on which the proceedings are based may constitute a plea of defense in criminal proceedings. Acquittal of the defendant, however, shall not imply patent or registration nullity which may only be claimed in competent proceedings.

Art. 206 – If information that is of a confidential nature, either an industrial or trade secret, is disclosed during proceedings, the judge shall decide whether the proceedings should continue in secret, the other party being prohibited from using such information for other purposes.

Art. 207 – Independently of criminal proceedings, the injured party may commence civil proceedings as he considers necessary in accordance with the Code of Civil Procedure.

Art. 208 – Compensation shall be determined on the basis of the benefit that the injured party would have obtained if the infringement had not taken place.

Art. 209 – The injured party shall be entitled to compensation for loss or damages in respect of industrial property rights infringement and acts of unfair competition not provided for in this Law, but which are liable to prejudice one's reputation or business or to lead to confusion between commercial or industrial establishments or service providers, or between products and services placed onto the market.

§ 1 The judge may, in the record of the same proceedings, in order

to avoid irreparable damages or damage that would be difficult to recover, grant an injunction to cease the infringement or act concerned, before summoning the defendant, subject to bail or other security where necessary.

§ 2 – In the case of flagrant reproduction or imitation of a registered trademark, the judge may order the seizure of all merchandise, products, articles, packaging, labels or other objects bearing the counterfeit or imitated trademark.

Art. 210 – Loss of profits shall be determined by the most favourable of the following criteria to the injured party:

- I – the benefits the injured party would have obtained if the infringement had not taken place;
- II – the benefits received by the infringer; or
- III – the remuneration the infringer would have paid to the owner of the infringed rights for a license that would have permitted the lawful exploitation of the subject matter of the rights.

TITLE VI – TECHNOLOGY TRANSFER AND FRANCHISING

Art. 211 – The BPTO shall register the contracts that involve technology transfer, franchising agreements and the like in order that

they may be effective with respect to third parties.

Sole Paragraph – Decisions regarding the application for the record of contracts of the type referred to in this article shall be issued within 30 (thirty) days from the record application date.

TITLE VII – GENERAL PROVISIONS

CHAPTER I – APPEALS

Art. 212 – Unless explicitly stipulated to the contrary, appeals may be lodged against decisions referred to in this Law within a time limit of 60 (sixty) days.

§ 1 – Appeals shall have suspensive and full devolutive effect and all provisions concerning first instance hearing shall be applied, where applicable.

§ 2 – No appeal may be lodged against a decision ordering the final refusal of a patent or design registration application or a decision granting a patent, certification of addition or a trademark registration application.

§ 3 – The president of the BPTO shall decide on appeals, and the administrative procedure shall be closed.

Art. 213 – The interested parties shall be notified to file counter-

claims within a time limit of 60 (sixty) days.

Art. 214 – In order to supplement the appeal claims, the BPTO may formulate conditions that shall be complied with, within a time limit of 60 (sixty) days.

Sole Paragraph – On expiry of the time limit in the head of this article, a decision shall be taken on the appeal.

Art. 215 – An appeal decision shall be final and there shall be no appeal from the administrative procedure.

CHAPTER II – ACTS OF THE PARTIES

Art. 216 – The acts referred to in this Law shall be performed by the parties or their duly qualified attorneys.

§ 1 – Power of attorney in its original form, an official copy or a certified photocopy shall be in Portuguese, consular legalization and certification by a notary public not being required.

§ 2 – A power of attorney shall be filed within 60 (sixty) days from the performance of the first act by the party in the proceedings, irrespective of notification or requirement, under penalty of withdrawal, the withdrawal of a patent, in-

dustrial design registration or trademark registration application being final.

Art. 217 – A person resident abroad shall be required to appoint and maintain an attorney duly qualified and resident in Brazil, with powers to represent such person administratively and legally, and shall also be empowered to receive summons.

Art. 218 – Petitions shall not be taken into consideration if:

- I – they are submitted after the statutory deadline;
- II – they are not accompanied by proof of payment of the relevant fee applicable on submission.

Art. 219 – Petitions, oppositions and appeals shall not be taken into consideration if:

- I – they are submitted after the time limit set out by this Law;
- II – they are not based on legal grounds;
- III – they are not accompanied by proof of payment of the relevant fee.

Art. 220 – Whenever possible, the BPTO shall take into account the acts of the parties and may impose any befitting requirements.

CHAPTER III – TIME LIMITS

Art. 221 – The time limits laid down by this Law shall be continuous, and the right to perform an act shall automatically lapse on termination of the time limit unless the party concerned proves that the act was not performed for legitimate reasons.

§ 1 – Legitimate reasons mean an unforeseeable event, beyond the control of the party concerned which has prevented the party from carrying out the act.

§ 2 – Where legitimate reasons are accepted, the party concerned shall perform the act within the time limit determined by the BP-TO.

Art. 222 – In calculating the time limits, the first day shall be excluded and the last day included.

Art. 223 – Time limits shall only begin to run on the first working day after legal notification is made by publication in the official BPTO communication.

Art. 224 – In the absence of express provision in this Law, the time limit for a party to perform an act shall be 60 (sixty) days.

CHAPTER IV – LIMITATION

Art. 225 – Proceedings for damages suffered by industrial property rights shall become prescribed after 5 (five) years.

CHAPTER V – ACTS of the BP-TO

Art. 226 – Acts of the BPTO in administrative procedures relating to industrial property shall take effect only after publication in the respective official communication, except:

I – those which, under the provisions of this Law, expressly do not require notification or publication;

II – administrative decisions, where notification is made in the post or the interested party is made aware through the proceedings; and

III – internal opinions and decisions of which notification of the parties is not required.

CHAPTER VI – CLASSIFICATIONS

Art. 227 – Classifications relating to the subject matter of Titles I, II and III of this Law, shall be established by BPTO, in those cases where they were not laid down by an international treaty or agreement in force in Brazil.

CHAPTER VII – FEES

Art. 228 – Fees shall be charged for the services provided in accordance with the provisions of this Law, the amounts of such fees and the form of collection shall be established by a decision made by the head of federal public administration body to which the BPTO is linked.

TITLE VIII – TRANSITIONAL AND FINAL PROVISIONS

Art. 229 – The provisions of this Law shall apply to all applications pending, except with regard to the patentability of applications filed until December 31, 1994, whose subject matter for protection are substances, materials or products obtained through chemical means or processes or foodstuff or chemical-pharmaceutical substances, materials, compounds or products and medicines of any kind, as well as to the respective processes for obtaining or modifying them and whose applicants have not been exercising their rights as set out in articles 230 and 231 of this Law which shall be considered rejected, for all effects, it being necessary for the BPTO to publish the communication of the said rejections. (Text given by Law no. 10,196 of 14/02/2001).

Sole paragraph – The criteria of patentability in this Law, on the effective application filing date or priority date, where applicable, shall apply to applications related to pharmaceutical and chemical products for agriculture filed between January 1, 1995 and May 14, 1997, thus ensuring protection from the patent grant date for the remaining term from the filing date in Brazil, limited to the term provided for in the heading of article 40. (Sole paragraph included by Law no. 10,196 of 14/02/2001).

Art. 229-A – Applications for process patents filed between January 1, 1995 and May 14, 1997, which enjoyed no protection under article 9, item “c” of Law no. 5,772 of December 21, 1971, shall be deemed rejected, and the BPTO shall publish the communication of the said rejections. (Article included by Law no. 10,196 of 14/02/2001).

Art. 229-B – Applications for product patents filed between January 1, 1995 and May 14, 1997, which enjoyed no protection under article 9, items “b” and “c” of Law no. 5,772 of December 21, 1971, and whose applicants have not been exercising their rights as set out in articles 230 and 231, shall be decided on by December 31, 2004, in accordance with this

Law. (Article included by Law no. 10,196 of 14/02/2001).

Art. 229-C – Patent grants for pharmaceutical products and processes shall depend on the prior consent of the National Agency for Sanitary Inspection (Agência Nacional de Vigilância Sanitária – ANVISA). (Article included by Law no. 10,196 of 14/02/2001).

Art. 230 – A patent application may be filed with respect to substances, materials or products obtained through chemical means or processes or foodstuff or chemical-pharmaceutical substances, materials, compounds or products and medicines of any kind, as well as to the respective processes for obtaining or modifying them, by any person entitled to protection under a treaty or convention in force in Brazil, the initial filing date abroad being recognized, provided that the subject matter thereof has not been placed on any market by direct initiative of the owner or by third parties with his or her consent, nor have third parties carried out serious and effective preparations in Brazil for exploiting the subject matter of the application or patent.

§ 1 – Applications shall be filed within a time limit of 1 (one) year from the publication date of this

Law, and shall state the first filing date abroad.

§ 2 – Patent applications filed in accordance with the provisions of this article shall be automatically published, and the interested parties shall be entitled to submit comments within a time limit of 90 (ninety) days on whether the conditions set out in the head of this article have been met.

§ 3 – Without prejudice to articles 10 and 18 of this Law, and once the conditions set out in this article have been met and patent grant in the country where the initial application has been proved, the patent shall be granted in Brazil exactly as granted in the country of origin.

§ 4 – A patent granted on the basis of this article shall enjoy the remaining protection term of that granted in the country of first application from the filing date in Brazil and limited to the term set out in article 40, and the provision of the sole paragraph shall not apply.

§ 5 – An applicant that has filed a pending application with respect to substances, materials or products obtained through chemical means or processes or foodstuff or chemical-pharmaceutical substances, materials, compounds or products and medicines of any kind, as well as to the respective processes for obtaining or modify-

ing them, may file a new application within the time limit and under the provisions of this article, submitting proof of withdrawal of the pending application.

§ 6 – The provisions of this Law shall apply where appropriate, to applications filed and to patents granted in accordance with the provisions of this article

Art. 231 – A patent application may be filed for the subject matters referred to in the previous article by a national or person resident in Brazil, and the invention publication date shall be guaranteed, provided that its subject matter has not been placed on any market on the direct initiative of the owner or by a third party with his or her consent, nor have third parties carried out serious and effective preparations in Brazil for exploiting the subject matter of the application.

§ 1 – The application shall be filed within 1 (one) year from the publication of this Law.

§ 2 – Patent applications filed in accordance with the provisions of this article shall be prosecuted under the terms of this Law.

§ 3 – A patent granted on the basis of this article shall enjoy the remaining protection term of 20 (twenty) years from the invention

publication date, from the filing in Brazil.

§ 4 – An applicant with a pending application for a patent relating to a subject matter to which the previous article refers may file a new application within the time limit and under the conditions set out in this article, submitting proof of withdrawal of the pending application.

Art. 232 – The production or use, in accordance with the provisions of the previous legislation, of substances, materials or products obtained through chemical means or processes or foodstuff or chemical-pharmaceutical substances, materials, compounds or products and medicines of any kind, as well as the respective processes for obtaining or modifying them, even if protected by a product or a process patent in another country in accordance with a treaty or convention in force in Brazil, may continue under the same conditions that existed prior to the approval of this Law.

§ 1 – No retroactive or future claim of any value shall be admitted with respect to products manufactured or processes used in Brazil, in accordance with this article.

§ 2 – In the same way, no claim under the terms of the previous

paragraph shall be admitted if, during the period prior to the entry into force of this Law, significant investment has been made for the exploitation of a product or a process as referred to in this article, even if protected by product or process patents in another country.

Art. 233 – Applications for the registration of advertising slogans and signs and declarations of novelty shall be definitively rejected and the registrations and declarations already granted shall remain in force for the remainder of their term, but may not be renewed.

Art. 234 – Priority guarantees, in accordance with article 7 of Law no. 5,772 of December 21, 1971, shall be enjoyed by the applicants up to the expiry of the current time limit.

Art. 235 – Time limits granted under Law no. 5,772 of December 21, 1971 shall be guaranteed.

Art. 236 – Applications for industrial model and design patents filed under Law no. 5,772 of December 21, 1971, shall be automatically designated as industrial design registration applications, for all legal effects being deemed to have been published.

Sole paragraph – Payments made with respect to such adapted applications shall be taken into account in order to calculate the due five-year fee.

Art. 237 – The provisions of article 111 shall not apply to industrial model or design patent applications that have been examined in accordance with the provisions of Law no. 5,772 of December 21, 1971.

Art. 238 – Appeals filed under Law no. 5,772 of December 21, 1971, shall be decided in accordance with the provisions therein.

Art. 239 – The Executive Branch is authorized to carry out any changes within the BPTO necessary to ensure its financial and administrative autonomy, the BPTO being able to:

- I – contract technical and administrative staff by way of public examination;
- II – establish salaries for its employees, subject to the approval by the Government Department to which the BPTO is linked; and
- III – propose a basic structure and internal regulations subject to the approval of the Government Department to which the BPTO is linked.

Sole paragraph – Expenses resulting from the enforcement of this article shall be paid from the BPTO's own resources.

Art. 240 – Article 2 of Law no. 5,648 of December 11, 1970 shall be reworded as follows:

“Article 2 – The principal task of the BPTO shall be to execute at a national level the statutes that govern industrial property, taking into account its social, economic, legal and technical functions, as well as making pronouncements on the advisability of signing, ratifying and terminating conventions, treaties, and agreements about industrial property.”

Art. 241 – The Judiciary is hereby authorized to establish special courts to hear matters relating to industrial property.

Art. 242 – The Executive Branch shall submit to the National Congress a bill intended to promote, where necessary, the harmonization of this Law with the industrial property policy adopted by other MERCOSUR member countries.

Art. 243 – This Law shall enter into force on its publication date with respect to the matters contained in articles 230, 231, 232

and 239, and 1 (one) year after its publication with respect to the remaining articles.

Art. 244 – Law no. 5,772 of December 21, 1971, Law no. 6,348 of July 7, 1976, articles 187 to 196 of Decree-Law no. 2,848 of December, 1940, articles 169 to 189 of Decree-Law no. 7,903, of August 27, 1945, and any other contrary provisions are hereby repealed.

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

FERNANDO HENRIQUE CARDOSO

Nelson A. Jobim
Sebastião do Rego Barros Neto
Pedro Malan
Francisco Dornelles
José Israel Vargas