



**STANDING COMMITTEE ON GEOGRAPHICAL INDICATIONS
QUESTIONNAIRE TO NATIONAL GROUPS**

Name of your National/Regional Group

National Group Brazil

Questions

Your Group is invited to submit a Report addressing the questions below. If your Group considers that the answer to a question has already been given in its report on Question Q191, and that nothing has changed since then, a cross-reference to the specific paragraph in your Group's report on Q191 is sufficient.

In each case please specify whether your answer differs:

- (a) as between GIs and AOs; and
- (b) depending on whether the GI or AO is foreign or domestic.

I. Analysis of current legislation and case law

1. Are GIs and/or AOs protected under your Group's current law?

Yes. GIs are protected under Title IV of the current Brazilian IP Law.

2. If yes, please briefly describe the following:
 - a. How AOs and GIs are defined and the prerequisites (in particular the type, nature and intensity of link with a territory).

According to the Brazilian IP Law, there are two types of GIs: Indications of Source and Denominations of Origin. As for their respective natures and links with a territory, Art. 177 sets forth that "Indication of source shall mean the geographic name of a country, city, region or locality in its territory, which has become known as a center of extraction, production or manufacture of a given product or of provision of a given service". On the other hand, Art. 178 establishes that "Denomination of origin shall be the geographical name of a country, city, region or locality in its territory, that designates a product or service whose qualities or characteristics are due exclusively or essentially to the geographical environment, including natural and human factors."

- b. Whether that protection is provided by sui generis laws; solely as aspects of other laws, such as by registration as collective or certification marks; or by other (and if so, what) means.

The protection of GIs is provided for by the Brazilian Industrial Property Law – Law 9279 of May 14th, 1996.

- c. If GIs and/or AOs are protected by sui generis laws, whether your Group's laws provide for a system of registration. If so, what are the steps of this procedure including the content of the application and the possibility of opposition by third parties.

GIs have a specific system of registration, that is conducted at the Brazilian National Institute of Industrial Property (INPI-BR). The applicant shall file a specific GI application form and pay the applicable fees. The required documents to be attached to the application are: a) Instrument proving the legitimacy of the requesting entity; b) Documents establishing and regulating the requesting entity; c) Document identifying the legal representative of the requesting entity; d) Power of Attorney, if applicable; e) Regulation of use of the geographical name; f) Official instrument that delimits the geographical area; g) Description of the product or service; h) Characteristics of the product or service; i) Graphic or figurative representation of the Geographical Indication, if it exists; j) Proof that the producers or service providers are established in the demarcated geographical area and carrying out the economic activity in the place that they seek to protect; k) Existence of a control structure over producers or suppliers that have the right to use the Geographical Indication, as well as the product or service provided by the GI.

For Indications of Origin, it is also necessary to present elements proving that the geographical name has become known as a center of extraction, production of the product or service. In case of a Designation of Origin, it is necessary to present elements showing that the qualities and/or characteristics of the product or service are due exclusively or essentially to the geographical environment, including natural and human factors.

After the application is submitted, a preliminary analysis is conducted by INPI-BR. An Office Action will be issued in case any formality needs to be adjusted.

The application will then be published at the INPI-BR Official Gazette. Third parties may present oppositions in a 60-day term.

The next step is the analysis of the application by INPI-BR examiners.

In case of denial, the applicant may appeal against the decision within 60 days counted from publication.

Third parties may also appeal against a decision by INPI-BR within 60 days counted from publication.

Applicants are not barred from filing new GI applications in the case of a final denial decision.

3. If your country does not protect GIs and/or AOs, was this a deliberate decision and, if so, why?

N/A

4. What are the grounds of invalidity/loss of rights for GIs and/or AOs under your Group's law (e.g. becoming generic, lack of use, not paying fees) and where can such be invoked (which court, office etc.)? Please specify the applicable test, how such is proven (e.g. consumer surveys, expert advice, dictionaries, etc.) and who bears the burden of proof.

GIs that are already of common use in Brazil cannot be registered, as per Art. 180 of the IP Law. Nevertheless, there is no legal provision regarding invalidation/loss of rights.

5. What is the scope of protection of GIs/AOs under your Group's current law?

In Brazil, GIs/AOs are recognised by Brazilian Industrial Property Law No.9279 and also by international treaties, as TRIPS and the Paris Convention, to which Brazil is signatory. Brazilian legislation protects both appellations of origin and geographical indications against any form of usurpation or imitation.

Geographical indications protect not only the owners' rights but also the consumers' rights, by means of the identification of the origin of the products or services as well as their quality. Indeed, the consumer benefits from the geographical indications by obtaining information about the products and / or services.

The Brazilian Consumers Law provides protection against false or misleading indication of source of products and services as well as against unfair competition and misuse of industrial inventions and creations, trademarks and distinctive signs that may cause damage to consumers.

6. Against what kind of conduct are GIs/AOs protected? For example, against use misleading consumers, parasitism and free riding.

GIs/AOs are protected against uses misleading the public or constituting an act of unfair competition and parasitism.

7. Who has legal standing to protect a GI/AO. For example, individual producers, consortiums and associations, public bodies.

As a general rule, the registration request of a geographical indication can be filed by associations, institutes and legal entities representative of the community, as legal substitutes, provided that they are established in the territory they intend to identify.

However, the producer or independent service provider, whether an individual or a legal entity, may request the registration of a geographical indication itself if all requirements are fulfilled (if they are entitled to the exclusive use of the geographical name).

Finally, in case a foreign geographical name has already been recognized as a Geographical Indication in its country of origin or recognized by competent entities or international offices, the registration in Brazil must be requested by the owner of such right.

8. What remedies are available in the case of violation of rights in a GI/AO?

There are different remedies according to the violation. If a trademark imitates a GI/AO, a lawsuit may be filed to claim the nullity of this trademark.

If an unauthorized party, without any kind of IP right, infringes the rights over a GI/AO, it is possible to file a lawsuit for stopping the undue use.

9. How does your Group's law regulate the conflict between a GI/AO and a prior trademark? Does the GI/AO or the trademark prevail or do they coexist? Under what conditions?

This kind of conflict is not regulated by Brazilian IP Law. On the other hand, there is no legal prohibition to register a prior trademark as a GI.

10. Is there any specific provision or practice concerning the inclusion of a GI/AO in a domain name?

There is no specific provision about the inclusion of a GI/AO in a domain name. It is necessary to emphasize that in Brazil domain names are protected according to the attributive system. This means that the registrar will register the domain in the name of the first party that applies for it.

11. Is there anybody that administers GIs/AOs in your country and/or is responsible for the verification of compliance of goods bearing a GI/AO? Please briefly describe the relevant processes, e.g. the process by which compliance with

product specifications is verified before such goods are put on the market and/or the subsequent market controls on such goods?

In Brazil, only the GI owner is responsible for verifying compliance of goods bearing the GI/AO and the quality control, according to the regulations of use of the GI/AO. It is a private control. There is no public authority involved.

12. Please describe any other developments in your country in relation to GIs or AOs which you consider relevant, including any proposals for reform. For example, to the extent that your country has been involved in any negotiations or discussions regarding the protection of GIs and AOs in any fora, such as multilateral, regional or bilateral agreements, please specify whether your country is negotiating or has signed any agreement with other countries that includes provisions on AOs/GIs and whether it was necessary to amend domestic legislation as a result of such agreements.

At present, we are not aware of any proposals for reform of the legislation regulating GIs. Apart from the Paris Convention, TRIPS and the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, our country has not signed any other agreement that involves AOs/GIs and is not negotiating any bilateral, multilateral or regional agreement that contains provisions on AOs/GIs.

II. PROPOSALS FOR IMPROVEMENTS AND FOR HARMONISATION

13. Should there be harmonised definitions of AOs and GIs? If so, please propose appropriate definitions and prerequisites.

In our opinion, there should be harmonised definitions of AOs and GIs. Brazil, for example, adopts a sui generis classification in its IP Law by dividing the general concept of GIs into two categories: indications of source (ISs) and appellations of origin (AOs). According to the Brazilian law, an IS is the geographical name of a country, city, region or locality that has become known as a center of extraction, production or manufacture of a given product or provision of a given service. This concept is interesting because it includes services, whereas the TRIPS definition of GIs only refers to goods. On the other hand, the definition of AOs under the Brazilian law is identical to that of most countries, i.e., a name that indicates that a product originates in a specific region or locality, but the characteristics of such product are essentially due to the geographical environment of that region or locality, including natural and human factors.

Appropriate definitions for AOs and GIs should make it clear that a product protected under an AO has characteristics that are essentially and exclusively due to natural (environmental) and human factors of the locality where the product is extracted or

manufactured, while GIs do not require such strong link with or dependence on the environment.

Besides harmonized definitions, countries should provide for protection of both AOs and GIs.

14. Should there be a registration procedure for AOs and GIs? If so, what should its key features be? For example, content of the application; examination by competent bodies; possibility of opposition by third parties.

Yes, because a registration provides the owner with more certainty about its rights. Furthermore, by having a material proof of such rights (for example, a certificate) it will be easier for the owner to enforce its rights against third parties.

The application should be very specific, providing as many details as possible about:

- *the product to be protected;*
- *the regulations of use of the GI;*
- *an official document that identifies and limits the geographical area.*

In relation to AOs, the application should also include:

- *document(s) proving that the characteristics or quality of the product are essentially due to the geographical area in question, including natural and human factors;*
- *detailed description of the process or method of obtaining or producing the product to be protected;*
- *document(s) proving the existence of a structure to control the producers that are entitled to make use of the GI;*
- *document(s) proving that the producers are established in the demarcated geographical area and that they are effectively engaged in the production of the good to be protected.*

As to competent bodies, they may vary, but it is advisable that the body in charge of granting GI registrations employs technically qualified personnel in its staff or works in cooperation with technical bodies that may provide input to the analysis of the application, for example, in the field of agronomy, wine production, etc.

Regarding the possibility of an opposition, the Brazilian regulations on GIs provide this possibility, and we believe it is helpful, as it may prevent further judicial disputes.

15. What should the grounds of invalidity/loss of rights for GIs and/or AOs be? For example, becoming generic, lack of use, not paying fees. Please specify what the applicable test should be, how such should be proven and who should bear the burden of proof.

According to the 4th article of the Normative Instruction n° 25/2013, GIs/AOs that have become generic are not allowed to registration.

16. How should conflicts between GIs/AOs and prior trademark rights be regulated?

N/A

17. What scope of protection should GIs/AOs have and should it matter if these are domestic or foreign? Against which conduct by third parties should they be protected?

Art. 10. In the case of a foreign geographical name being already recognized as Geographical Indication in your country of origin or recognized by an entity or international competent bodies and/or international competent organizations, it will be waived the presentation of the information required by Articles 6 to 9 provided that such information are duly described in the official document which Recognized the Geographical Indication, which must be presented in an official certified copy, along its sworn version.

Sole paragraph - The information referred to in articles 6 to 9 that are not described in the official document which recognizes the IG, should be presented in a complementary document along with the Filing/Application form.

18. Who should have legal standing to protect a GI/AO and which remedies are appropriate?

Art. 5 They may require registration of Geographical Indications: associations, institutes and legal entities representative of the collective legitimized to the exclusive use of the geographical name Established in their territory.

§ 1. In the event that a single producer or service provider is legitimated to the exclusive use of the geographical name, an individual or legal entity, will be authorized to request the registration of the Geographical Indication in its own name.

§ 2. In the case of a foreign geographical name already recognized as Geographical Indication in their country of origin or recognized by entities or Competent international bodies, registration shall be required by the holder of the IG's rights.

19. Should there be a specific provision or practice concerning the inclusion of a GI/AO in a domain name?

There should exist a specific provision about the inclusion of GI/AO in a domain name. At least, the rules for domain name should protect GI/AO registered in the originating country.

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