



BPTO eliminates the “disclaimer” in Trademark Registrations

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On February 18, 2016 the Brazilian Patent & Trademark Office - BPTO enacted Resolution No. 161, regarding the disclaimer adopted in trademark registrations, in an attempt to standardize and bring transparency to the decisions rendered in the trademark application procedures.

The disclaimer of a mark is nothing more than a way to define the scope of protection granted by the registration. As an example of disclaimer, we could mention the hypothetical registration for trademark “EYE CLINIC SEROPÉDICA”, to identify medical services. In this case, the BPTO granted the registration with the disclaimer “without the exclusive right of use for the expression 'eye clinic’”. For more than 30 years, the BPTO has debated with IP specialists the possibility of no longer making this kind of disclaimer on the registrations, but there was always the fear that the absence of the disclaimer would cause more harm than benefit.

Trademark infringement actions can be proposed in any state civil court, in all Brazilian territory, but the unfamiliarity of the judges with IP Law could make the Courts unduly grant preliminary injunctions to cease the use of signs or expressions of common use, as it has already happened in the past, in cases in which the correct disclaimer was not made. The new Resolution tries to find a creative solution to this problem, but it seems to us that this might not be the right path to follow.

From now on, as foreseen on art. 2 of the new Resolution, the BPTO will stop inserting the traditional case by case basis disclaimers, and will adopt a standard disclaimer, that will be inserted in all trademark certificates, in order to teach to anyone who reads the certificate, didactically, the correct scope of protection of the mark. As a positive aspect of the new system we could point out that, with this new rule, the BPTO will avoid the risk of making discrepant decisions in similar cases, and we hope that it will also accelerate the analysis of trademark applications.

Accordingly, the following standard disclaimer will be inserted in all trademark certificates, as foreseen on art. 3 of this Resolution:

“The protection granted by this trademark registration, taking into consideration what is foreseen on Section 124, items II, VI, VII, XVIII e XXI, of Law No. 9.279, of May 14, 1996, will not forbid third parties to use the following terms, that may be part of this trademark, in their real meaning or in the composition of other marks that differ from this one in their entirety:

- a) a letter, a digit or a date;*
- b) sign of a generic, necessary, common, usual or simply descriptive character, when related to the product or service specified on the registration;*

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c) sign commonly used to designate a characteristic of the product or service specified in the registration, with respect to its nature, nationality, weight, value, quality and time of production or of giving a service;

d) colors and its names;

e) a technical term used in the industry, science and art, when related to the products or services to be distinguished; and

f) the necessary, common or usual shapes of a product or of its packaging, or, furthermore, shapes that cannot be disassociated from a technical effect.”

As this long explanatory text will be inserted in the certificates of all trademark registrations granted by the BPTO, this Office is in fact avoiding a more thorough analysis of each case and a clear designation of the scope of protection granted by each registration. In other words, instead of what is said in the Resolution, the BPTO is not adopting a standard disclaimer but in fact, it is stopping to make such disclaimers at all. The issues that, up to now, were discussed in the administrative sphere before that Office will, from now on, be settled by the Courts, on a case by case basis. Therefore, we fear that a disclaimer that says a lot and, at the same time, does not say anything, will bring more legal uncertainty.

Resolution No. 161/2016 is in force as from the date of its publication on Official Gazette No. 2355 of February 23, 2016.