

Co-ownership: a new tool in the management of Brazilian trademarks

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The ability to register a trademark in co-ownership was a long-standing complaint by users of the IP system in Brazil, which in many cases were led to constitute a new corporate entity for the sole purpose of sharing ownership over a trademark. Although the law does not prohibit co-ownership of industrial property assets, the Brazilian PTO (INPI) did not provide the mechanisms needed to allow the registration of a trademark in the name of more than one owner.

Nevertheless, in view of Brazil's recent adherence to the Madrid Protocol¹, the INPI was requested to review this matter in order to comply with the Protocol, which permits co-ownership of trademarks.

Therefore, INPI issued Resolution 245/2019, expressly providing for co-ownership of marks. Although the resolution came into effect in 2019, the INPI's system was only able to process co-ownership applications and co-ownership registrations on September 15, 2020. Since that date, it is possible to file trademark applications in the name of more than one applicant, as long as all the co-owners effectively and licitly engage in activities related to the products and services covered by the application.

Co-ownership is not restricted to new applications, and co-owners can be added to existing registrations and applications by submitting a request for transfer of ownership. Transfers to include co-owners should cover all identical or similar marks, because the marks not included would be cancelled by the INPI.

Once registered, co-owners must act jointly before the INPI with respect to the co-owned mark, with the exception of certain acts which may be performed separately by the co-owners (filing oppositions, administrative nullity requests or non-use cancellation requests, for example).

Co-ownership is, without a doubt, an important mechanism for trademark owners, since it recognizes a legal scenario that already exist and cannot be disregarded by the INPI.

NOTES:

¹International treaty that facilitates the registration of marks in various countries around the world.

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