


**MADRID PROTOCOL**

**Total Provisional Refusal of Protection  
(Rule 17(1) of the Regulations)**

I. Office:	<b>Instituto Nacional da Propriedade Industrial - INPI (The Brazilian National Institute of Industrial Property)</b>
II. International registration number:	<b>1664726</b>
III. National application number:	<b>501664726</b>
IV. Holder:	<b>Solera Global Technology Limited [GB]</b>
V. Mark:	
VI. Information concerning the type of provisional refusal:	<b>Total provisional refusal based on an ex officio examination.</b>
VII. Information concerning the scope of the provisional refusal:	<b>The provisional refusal affects all the goods and services.</b>

VIII. Grounds for refusal:

**Notification of Total Provisional Refusal according to Rule 17(1)**

We would like to inform you that your trademark has been provisionally refused in Brazil. Please find enclosed our report on the examination of your trademark.

Date of publication on the Brazilian gazette (RPI): **13 Dec, 2022**

Time limit to file a response: **11 Feb, 2023**

The Brazilian gazette (RPI) may be accessed at: [revistas.inpi.gov.br/rpi](http://revistas.inpi.gov.br/rpi)

**EXAMINATION REPORT**

The lawfulness, distinctiveness, veracity and availability of the sign required as a trademark were analyzed as part of the examination of the trademark application, including searches of previous third party rights and the examination of possible oppositions and other submitted documents.

**Grounds for refusal**

Upon completion of the examination, the application for registration is provisionally refused based on the following legal grounds.

Regarding classes 9, 35, 36, 37 and 42:

In our examination, we have found that your trademark infringes the Brazilian Industrial Property Law, article 124 (XIX) because it reproduces in whole other persons' earlier trademark(s) rights for identifying goods/ services identical/ similar to the ones covered by your application.

IX. Information related to an earlier mark:

**Where applicable the details of earlier trademarks are informed as an attachment to this form.**

X. Provisions of the applicable law:

**Extract of the Brazilian Industrial Property Law attached.**

XI. Additional information concerning the decision:

**Your further action**

If you want to appeal against the decision, reasons and any documents must be submitted to the Coordination of Appeals and Administrative Nullities of INPI within 60 calendar days of the publication of the notification in the Brazilian Gazette (RPI).

**What happens if we do not hear from you?**

Failure to file an appeal implies in the future issuance of a partial grant of protection only for the goods and services for which the trademark is registrable, in accordance with Rule 18ter(2) and Resolução INPI/PR 247/2019, article 20, §2, II.

**Important!**

When performing acts directly at the INPI, the holder of an international registration domiciled abroad shall constitute and maintain a duly qualified attorney domiciled in Brazil. The power of attorney shall be presented within 60 (sixty) calendar days from the practice of the act, regardless of notification or requirement, under penalty of definitive dismissal of the petition or application. All documents concerning Brazilian designations submitted directly to the INPI must be written in Portuguese. Documents submitted in a foreign language must be accompanied by simple translation. Chapter 3 of the Trademark Manual contains information on all services relating to a trademark application or registration. The provisions of this chapter regarding the service to be filed with the INPI must be observed.

Instituto Nacional da Propriedade Industrial - INPI  
Rua Mayrink Veiga, 9 - Centro, Rio de Janeiro - RJ, 20090-910, Brazil  
[www.gov.br/inpi/en](http://www.gov.br/inpi/en)

**EARLIER TRADEMARKS DATA**

Reproduction of the mark:

**SOLERA**National number: **910316864**Filing date: **24 Nov, 2015**Registration date: **20 Mar, 2018**Name of the holder: **(1) SOLERA HOLDINGS, INC.**Address of the holder: **(1) 1301 Solana Blvd., Bldg. #2 Suite 2100 Westlake TEXAS 76262  
[US]**

List of goods and services:

**NCL(10) 9: Aplicativos e programas de computador para download em aparelhos móveis para uso na indústria automotiva, de veículos, de combate a incêndios e nas áreas da saúde para identificação de veículos e para avaliação de veículo e perda estrutural, perícia, estimativa de dano, inspeção, reparo, fluxo de trabalho e acompanhamento de reparo, acompanhamento da satisfação do cliente para interface com sistema de software de estimativa inteligente; aplicativos para programas de computador para download para análise e controle de fluxo de trabalho, lucros e crescimento comercial, para alocação de funcionários; aplicativos e programas de computador para download para acompanhamentos de performances; aplicativos e programas de computador para download para controle de estoque de peças de veículo; aplicativos e programas de computador para download para gerenciamento de bases de dados para pedidos de peças de veículo, para compartilhar dados de clientes e para processamento, conciliação e reconciliação de transações financeiras entre seguradoras, locais para reparos de veículos e estruturas, peritos, socorristas, recicladores na indústria automotiva, de veículos, de combate a incêndio e na área da saúde, e proprietários de veículos e estruturas; publicações eletrônicas para download na forma de informativos nas áreas de seguro de veículos, reparos por colisão, resgate e reciclagem de veículos; manuais para download e manuais gravados nas áreas de peças de veículos automotivos; manuais de instrução para download e manuais de instrução gravados nas áreas de reparo de veículos automotivos e reparo por colisão de veículo.**

Reproduction of the mark:

**SOLERA**National number: **910316945**Filing date: **24 Nov, 2015**Registration date: **27 Mar, 2018**Name of the holder: **(1) SOLERA HOLDINGS, INC.**Address of the holder: **(1) 1301 Solana Blvd., Bldg. #2 Suite 2100 Westlake TEXAS 76262  
[US]**

List of goods and services:

**NCL(10) 35: Serviços de avaliação de custos, a saber, estimativa de dano à automóveis e estruturas; provimento de informações comerciais relacionadas à localização de peças de veículos usados; provimento de base de dados de pesquisa online apresentando listas de informações sobre a localização e custo de peças de veículos usadas e recicladas; gerenciamento de base de dados online; coleta e análise de dados métricos qualitativos para medição de utilização, satisfação, qualidade e custos de fornecedores e consumidores na área de reparo de propriedades e veículos; contenção de custos, serviços de recomendação e auditoria para a compra, cobrança e instalação de produtos ou prestação de serviços por terceiros nas áreas automotiva, de construção e de seguros; serviços de publicidade, marketing, mala direta e promoção para vendedores varejistas de automóveis, a saber, provimento de serviços de publicidade, marketing, mala direta e promoção durante a venda, pós-venda, serviços, manutenção e recompra de automóveis; provimento de informações de avaliação de risco comercial de seguradoras; provimento de base de dados de pesquisa online apresentando listas das localizações e custos de peças de veículo usadas e recicladas para compra de terceiros; controle financeiro de dados de pagamento eletrônico; serviços de suporte de pagamento eletrônico na forma de processamento de faturamento eletrônico; auditoria sobre pedidos de seguro para terceiros por danos a veículos; serviços de suporte de pagamento eletrônico na forma de processamento de faturamento eletrônico; processamento de faturas eletrônicas referente ao faturamento nas áreas automotiva, de construção e de seguros; auditoria sobre pedidos de seguro para terceiros por danos a veículos; serviços de auditoria relacionados a pedidos de seguro por danos a veículos e estruturas; provimento de informações comerciais para mecânicos; coleta e análise de dados métricos qualitativos, gestão de relacionamento com o cliente na forma de provimento de informações, serviços de informações comerciais na forma de provimento de informações sobre a satisfação do cliente, todos relacionados a pedidos de seguros e fornecedores que realizam o trabalho em conformidade com os pedidos nas áreas de reparação de veículos e reconstrução e restauração de prédios, através de uma rede global de computadores.  
[Incluídos nesta classe].**

Reproduction of the mark:

**SOLERA**

National number: **910317020**

Filing date: **24 Nov, 2015**

Registration date: **13 Mar, 2018**

Name of the holder: **(1) SOLERA HOLDINGS, INC.**

Address of the holder: **(1) 1301 Solana Blvd., Bldg. #2 Suite 2100 Westlake TEXAS 76262  
[US]**

List of goods and services:

**NCL(10) 36: Serviços financeiros nas áreas automotiva, de construção e de seguros, a saber, processamento eletrônico de pedidos de seguro e dados de pagamento relacionados a danos a veículos e estruturas; consultoria em seguros, a saber, consultoria nas áreas de processamento e gerenciamento de pedidos de reparo por colisão de veículos e reparo de estruturas; administração e processamento de pedidos de seguros, a saber, revisão, gerenciamento e processamento de pedidos de seguro para terceiros por danos a veículos e estruturas; avaliação financeira, a saber, serviços de avaliação de danos a veículo e estruturas, avaliação de custo de reparo e estimativa em dólar dos danos a veículos e estruturas; provimento de informações financeiras relacionadas aos pedidos de seguro e fornecedores que realizam o trabalho em conformidade com os pedidos nas áreas de reparação de veículos e reconstrução e restauração de prédios, através de uma rede global de computadores; serviços de consultoria em seguros, a saber, provimento de análise de avaliação de risco relacionada à subscrição de seguros; provimento de informações e bases de dados de computador online para fins de verificação, avaliação e relato de riscos envolvendo seguros relacionados à subscrição de seguro de propriedades e seguros por acidentes; avaliação de risco financeiro e serviços de gerenciamento, a saber, provimento de previsão de análise de risco financeiro e informações relacionadas às seguradoras baseadas em uma base de dados de registros públicos relacionados a acidentes, apreensão e outras violações de habilitação para gerenciamento de risco e provimento de previsão de análise de risco financeiro e informações relacionadas às seguradoras baseadas em uma base de dados pesquisável por código postal e regiões geográficas, contendo dados utilizados para avaliar variáveis de risco para gerenciar e valorar o risco; serviços de seguro, a saber, verificação de apólice de seguro para determinar se uma pessoa ou empresa dispõe ou dispunha de seguro em uma data específica; provimento de análise de avaliação de risco financeiro relacionada à subscrição de seguros; serviços de subscrição de seguros para automóvele contra incêndio; provimento de informações relacionadas à subscrição de seguro de propriedades e seguro por acidentes e provimento de bases de dados de computador online no campo da subscrição de seguro de propriedades e seguros por acidentes para fins de verificação, avaliação e relato de riscos envolvendo seguros; análise e compilação de dados na forma de registros de habilitação, informações de veículos e informações relacionadas a condutores de veículos motorizados para uso na determinação dos riscos financeiros das seguradoras; serviços de faturamento e serviços de processamento de pagamento eletrônico relacionados a dados de pagamento de contas. [Incluídos nesta classe].**

Reproduction of the mark:

**SOLERA**

National number: **910317143**

Filing date: **24 Nov, 2015**

Registration date: **13 Mar, 2018**

Name of the holder: **(1) SOLERA HOLDINGS, INC.**

Address of the holder: **(1) 1301 Solana Blvd., Bldg. #2 Suite 2100 Westlake TEXAS 76262 [US]**

List of goods and services:

**NCL(10) 37: Provimento de base de dados de computador online na área de diagnóstico de danos a veículos, reparação e manutenção para uso por mecânicos de automóvel.**

Reproduction of the mark:

**SOLERA**

National number: **910317186**

Filing date: **24 Nov, 2015**

Registration date: **20 Mar, 2018**

Name of the holder: **(1) SOLERA HOLDINGS, INC.**

Address of the holder: **(1) 1301 Solana Blvd., Bldg. #2 Suite 2100 Westlake TEXAS 76262 [US]**

List of goods and services:

**NCL(10) 42: Programa de computador não descarregável para uso na indústria automotiva, de veículos, de combate a incêndios e na área da saúde para identificação de veículos e para avaliação de veículos e danos a estruturas, perícias, estimativa de danos, inspeção, reparos, fluxo de trabalho e acompanhamento de reparos, acompanhamento da satisfação do cliente e para processamento, conciliação e reconciliação de transações financeiras entre seguradoras, locais de reparo de estruturas e veículos, peritos, socorristas, recicladores na indústria automotiva, de veículos, de combate a incêndio e na área da saúde, e proprietários de veículos e estruturas; provimento de programa de computador online não descarregável de uso temporário nas áreas de seguro de automóvel e reparo de automóvel para coleta e análise de dados de indicadores críticos de desempenho comercial para aumentar a eficiência dos funcionários e melhorar o desempenho e a lucratividade geral; provimento de programa de computador não descarregável para o acompanhamento e relatório do status dos reparos de veículos entre os fornecedores de serviço de reparo de veículo e proprietários de veículo; plataforma como serviço (paas) apresentando plataformas de programa de computador para acompanhamento, atualização e produção de relatórios relacionados ao status dos reparos de veículos entre os fornecedores de serviço de reparo de veículo e proprietários de veículo; provimento de um website apresentando uma tecnologia que permite aos usuários recuperarem informações relacionadas a veículos motorizados, motoristas e passageiros de veículos motorizados, registros de habilitação e informações sobre veículos; serviços de computador, a saber, armazenamento eletrônico de informações relacionadas a veículos motorizados, motoristas de veículos motorizados e registros de habilitação.**

## EXTRACT FROM THE BRAZILIAN INDUSTRIAL PROPERTY LAW (LPI)

### TITLE III TRADEMARKS

#### CHAPTER I ELIGIBILITY FOR REGISTRATION

##### Section I - Signs Eligible for Registration as Trademark

Article 122. Are considered eligible for registration as trademarks visually perceptible distinctive signs which do not fall under any legal prohibitions.

Article 123. For the purposes of this code, the following definitions shall apply:

I – product or service trademark: that which is used to distinguish goods or services from others that are identical or similar, from a different origin;

II – certification mark: that which is used for certifying a product or a service meets certain standards or technical specifications, especially as to their quality, nature, and material and methodology used; and

III – collective mark: that which is used to identify products or services provide by members of certain entity.

##### Section II - Signs not Eligible for Registration as Trademark

Article 124. The following are not subject to trademark registration:

I – official, public, national, foreign, or international coats of arms, medals, flags, emblems, badges, and monuments, as well as their respective designation, image, or imitation;

II – single letters, numbers, and dates, except when represented in a sufficiently distinctive manner;

III – expressions, images, drawings, or any other signs which are contrary to morals and good customs or which offends the honor or image of people or which attacks the freedom of conscience, belief, worship or ideas and feelings which are deemed worthy of respect and veneration;

IV – title or acronym of a public entity or agency, if registration is not sought by that entity or agency;

V – reproduction or imitation of a characteristic or differentiating element of a trade name or a third-party's company name, which may cause confusion or association with these distinctive signs;

VI – Generic, necessary, common, ordinary, or simply descriptive signs, which are related to the products or services to be distinguished, or those commonly employed to identify a characteristic of the products or services, as to their nature, national origin, weight, value, quality, and time of production or service provision, except when represented in a sufficiently distinctive manner;

VII – signs or slogans used only as a mean of advertising;

VIII – colors and their names, unless arranged or combined in a peculiar and distinctive way;

IX – geographic indications, their imitations which may cause confusion, or signs that could falsely induce geographical indication;

X – signs which induce a false indication as to the origin, source, nature, quality, or usefulness of the products or services to which the trademark is intended;

XI – reproduction or imitation of official signs regularly adopted to guarantee standards of any kind or nature;

XII – reproduction or imitation of signs that have been registered as collective or certification marks by third parties, pursuant to the provisions established in article 154;

XIII – title, award, or symbol of sporting, artistic, cultural, social, political, economic, or technical events, official or officially recognized, as well as imitations which may cause confusion with the former, except when authorized by the competent authority or entity promoting the event;

XIV – reproduction or imitation of title, policy, currency, and banknote of the Federal Government, States, Federal District, Territories, Municipalities, or countries;

XV – birth name or signature, family name or patronymic, and image of third parties, except with the consent of the owner, heirs, or successors;

XVI – well-known pseudonym or nickname, singular or collective artistic name, except with the consent of the owner, heirs, or successors;

XVII – literary, artistic, or scientific work, as well as titles protected by copyright and likely to cause confusion or association, except with the consent of the author or the right's owner;

XVIII – technical terms used in the industry, science and art, which are related to the products or services to be distinguished;

XIX – reproduction or imitation, in whole or in part, even if with addition, of other persons' registered trademark to distinguish or certify an identical, similar, or related product or service, which is liable to cause confusion or association with the trademark of others.

XX – duality of trademarks by a single owner for the same products or services, except when, in the case of trademarks of the same nature, they are sufficiently distinctive;

XXI – the necessary, common, or ordinary shape of the product or packaging or, also, one that cannot be dissociated from a technical effect;

XXII – objects which are protected by a third party's industrial design registration; and

XXIII – sign that imitates or reproduces, in whole or in part, a trademark that the applicant evidently knows as a result of its activity, in which its owner is based or domiciled in national territory or in a country with which Brazil has an agreement or ensures reciprocal treatment, if that trademark distinguishes or certifies identical, similar, or related products or services which are liable to cause confusion or association with such trademark.

### **Section III - Highly-Renowned Mark**

Article 125. The registered trademark in Brazil regarded as highly renowned shall be ensured special protection in all commercial activity fields.

### **Section IV- Well-Known Mark**

Article 126. The trademark well-known in its field of commercial activity is especially protected pursuant to art. 6 bis (I) of the Paris Union Convention for the Protection of Industrial Property, regardless of being previously filed or registered in Brazil.

Paragraph 1. The protection referred to in this article is also applicable to service marks.

Paragraph 2. INPI may, on its own volition, deny the application for registration of trademark that reproduces or imitates, in whole or in part, a well-known mark.

## **CHAPTER II PRIORITY**

Article 127. To the application for registration of a trademark filed in a country which maintains an agreement with Brazil, or in an international organization which produces the effect of a national application, the right to priority, within the terms established in that agreement, shall be ensured, and that application shall not be invalidated or impaired by facts occurred within these terms.

Paragraph 1. The priority claim shall be made upon filing, and it may be supplemented within sixty (60) days by other priorities prior to the date of submission in Brazil.

Paragraph 2. The priority claim shall be supported through a proper document from the origin, containing the number, date, and reproduction of the application or the registration, accompanied by a simple translation, in which the content shall be the full responsibility of the applicant.

Paragraph 3. If the evidence is not submitted upon filing, it shall occur within four (4) months of the filing, under penalty of loss of the priority.

Paragraph 4. In case of a priority obtained through assignment, the relevant document shall be submitted in addition to the proper priority evidence.

## **CHAPTER III APPLICANTS**

Article 128. Individuals or legal entities of public law or private law may apply for trademark registration.

Paragraph 1. Individuals or legal entities of private law may only apply for the registration of a trademark related to the activity effectively and legally carried out either directly or through companies direct or indirectly controlled, and such condition shall be declared in the trademark application, under penalty of law.

Paragraph 2. The registration of a collective mark may only be requested by a legal entity representing a party, which may carry out a different activity than its members.

Paragraph 3. The registration of a certification mark may only be requested by an individual or entity without any direct commercial or industrial interest in the certified product or service.

Paragraph 4. A priority claim does not exempt a trademark application from the enforcement of the provisions included in this Title.

## **CHAPTER IV TRADEMARK RIGHTS**

### **Section I - Acquisition**

Article 129. The ownership of the trademark is acquired through the validly issued registration, pursuant to the provisions of this Law, and its exclusive use throughout the national territory is ensured to its holder and, regarding collective and certification marks, the provisions in arts. 147 and 148 shall be complied with.

Paragraph 1. Every individual or entity who, on good faith, used within the country for at least six (6) months prior to the date of the priority or filing an identical or similar trademark to distinguish or certify an identical, similar, or related product or service, shall be entitled the right to take precedence in the registration.

Paragraph 2. The right to take precedence may only be assigned together with the company's business or portion thereof with direct relation to the use of the trademark, through disposal or lease.

### **Section II - Protection Granted by Registration**

Article 130. The owner of the trademark or its applicant is also ensured the right to:

I – assign its registration or application;

II – license its use;

III – protect its material integrity or reputation.

Article 131. The protection addressed in this Law encompasses the use of the trademark in papers, printed materials, advertisement, and documents related to the owner's activity.

Article 132. The trademark owner may not:

I – prevent merchants or distributors from using distinctive signs owned thereby together with the product's trademark for its promotion and marketing;

II – prevent manufacturers of accessories from using the trademark to indicate the product's purpose, as long as the fair competition practices are respected;

III – prevent free circulation of products placed in the domestic market, by itself or third parties with consent, except for the provisions in paragraphs 3 and 4 of art. 68; and

IV – prevent quoting of the trademark in a speech, scientific or literary work, or any other publication, as long as there is no commercial connotation or prejudice to its distinctive character.

## **CHAPTER V EFFECTIVE PERIOD, ASSIGNMENT, AND ANNOTATIONS**

### **Section I - Effective Period**

Article 133. The registration of the trademark shall be effective for ten (10) years from the date when the registration was granted, extendable for equal and consecutive periods.

Paragraph 1. The request for extension shall be filed within the last year of the term of the registration, accompanied by the proof of payment of the corresponding fee.

Paragraph 2. If the request for extension of the registration is not made until the end of its term, the owner may request it within the subsequent six (6) months, upon payment of an additional fee.

Paragraph 3. The extension shall not be granted if the provisions of art. 128 are not complied with.

### **Section II - Assignment**

Article 134. The application for registration and the registration may be assigned, provided that the assignee meets the legal requirements in order to request such registration.

Article 135. The assignment shall include all registrations or applications, on behalf of the assignor, of equal or similar trademarks, related to an identical, similar, or related product or service, under penalty of cancellation of the registrations or dismissal of the applications that were not assigned.

### **Section III - Records**

Article 136. INPI shall make the following records:

I – the assignment, including the full identification of the assignee;

II – any limitations or burdens that may be imposed upon the application or registration; and

III – changes of name, principal place of business, or address of the applicant or owner.

Article 137. The annotations shall take effect with respect to third parties from their publication date.

Article 138. The following decisions are appealable:

I – denial of assignment annotation;

II – cancellation of registration or dismissal of application, pursuant to art. 135.

#### **Section IV - License to Use**

Art. 139. The owner of a registration or the applicant thereof may sign a license agreement for the use of a trademark, without any prejudice to its right to exercise effective control over the specifications, nature, and quality of the respective products or services.

Sole paragraph. The licensee may be vested all powers to act in the defense of the trademarks, without prejudice to his/her own rights.

Article 140. The license agreement shall be recorded in INPI so that it has effects with respect to third parties.

Paragraph 1. The recording shall take effects with respect with third parties from its publication date.

Paragraph 2. For purposes of validity of proof of use, the license agreement does not have to be recorded in INPI.

Article 141. The decision that denies the recording of the license agreement is appealable.

### **CHAPTER VI FORFEITURE OF THE RIGHTS**

Article 142. The registration of the trademark shall be extinguished:

I – due to the expiry of its term;

II – as a result of waiver, which may happen in whole or in part with respect to the products or services of the trademark;

III – due to a revocation brought by lack of use; or

IV – due to failure to comply with the provisions in article 217.

Article 143 – A trademark registration will be revoked upon request of any person with legitimate interest if, after five (5) years of its granting, on the date of such request:

I – the trademark use has not been initiated in Brazil; or

II – the trademark has ceased to be used for more than five (5) consecutive years or, within the same term, the trademark has been used with alterations which result in a modification of its original distinctive nature, as provided for in the registration certificate.

Paragraph 1. The registration shall not be revoked if the owner provides legitimate reasons for the disuse of the trademark.

Paragraph 2. The owner shall be summoned to respond within sixty (60) days, being responsible for evidencing the use of the trademark or providing legitimate reasons for its disuse for.

Article 144. The use of the trademark shall cover products or services included in the certificate, under penalty of causing the registration to be partially revoked in respect to those which are dissimilar and unrelated to the ones for which the trademark was provenly used.

Article 145. There shall be no request for revocation if the trademark is provenly used or its disuse has been justified in a previous proceeding, filed no more than five (5) years.

Article 146. A decision for revoking the registration or denying it shall be subject to appeal.

### **CHAPTER VII COLLECTIVE AND CERTIFICATION MARKS**

Article 147. The collective mark application shall include its regulation of use, providing for conditions and prohibitions for using the trademark.

Sole paragraph. The regulation of use, if not annexed with the application, shall be filed within sixty (60) days of the submission, under penalty of final dismissal of the application.

Article 148. The certification mark application shall include:

I – the characteristics of the product or service which are subject to certification; and

II – the control measures to be adopted by the owner.

Sole paragraph. The documents specified on items I and II of this article, if not annexed with the application, shall be filed within sixty (60) days, under penalty of final dismissal of the application.

Article 149. Any changes to the regulation of use shall be informed to INPI, upon filed petition, including all conditions changed, under penalty of being disregarded.

Article 150. The trademark can be used regardless of license, and its authorization in the regulation of use shall be sufficient.

Article 151. In addition to the causes of extinguishment established in article 142, the collective and certification trademark registration are extinguished when:

I – the owner ceases to exist; or

II – the trademark is used under conditions other than those provided for in the regulation of use.

Article 152. A waiver to the collective mark registration shall only be accepted when required under the articles of association or bylaws of the entity itself or even pursuant to the regulation of use.

Article 153. A collective mark shall be liable to revocation if is not used by more than one authorized person, pursuant to the provisions in articles 143 to 146.

Article 154. The collective and certification marks that have already been used and which registrations have been extinguished may not be registered on behalf of third parties, before expiration of the five (5)-year term from the date of the extinguishment.

## **CHAPTER VIII SUBMISSION**

Article 155. The application shall be made for a single distinctive sign and, under the conditions established by INPI, shall include:

I – request;

II – images, when applicable; and

III – a proof of payment of the fee related to the submission.

Sole paragraph. The application and any document accompanying it shall be submitted in Portuguese and, in case of a foreign document, its simple translation shall be annexed upon submission or submitted within the subsequent sixty (60) days, under penalty of those documents being disregarded.

Article 156. After submission of the application, it shall be subject to a preliminary formal examination and, if duly documented, it shall be recorded, and the date of application shall be the date of submission.

Article 157. The application that does not formally comply with the provisions in art. 155 but has enough data related to the applicant, the sign applied for, and its classification shall be accepted for admission, upon dated proof of submission, by INPI, which shall establish the requirements to be met by the applicant, within five (5) days, under penalty of dismissal.

Sole paragraph. Once the requirements are met, the application shall be deemed filed on the date of submission of the application.

## **CHAPTER IX EXAMINATION**

Article 158. Once the application has been recorded, it shall be published for objections within sixty (60) days.

Paragraph 1. The applicant shall be notified of the objections, and it shall be allowed to present its arguments within sixty (60) days.

Paragraph 2. The objection, administrative invalidity, or invalidity action shall be disregarded if, based on item XXIII of art. 124 or art. 126, the submission of the application for registration of the trademark pursuant to this law is not evidenced within sixty (60) days after filing.

Article 159. Once the objection term has elapsed or, in case it is filed, once the term for submitting arguments, the examination shall be carried out, during which time additional requirements may be requested, which shall be answered within sixty (60) days.

Paragraph 1. Upon failure to answer the requirement, the application shall be finally dismissed.

Paragraph 2. Once the requirement has been answered, even if it has not been met, or once its request has been challenged, the examination shall continue.

Article 160. Once the examination is completed, a decision shall be rendered, accepting or denying the application for registration.

## **CHAPTER X ISSUANCE OF THE REGISTRATION CERTIFICATE**

Article 161. The registration certificate shall be granted after the application has been accepted and the proof of payment of the corresponding fees has been submitted.

Article 162. The payment of the fees, and the proof of payment, related to the issuance of the registration certificate and to the first decade of its term, shall be made within sixty (60) days of

acceptance.

Sole paragraph. The fee may also be paid, and the proof of payment submitted, within thirty (30) days from the end of the term set forth in this article, regardless of notice, through payment of a specific fee, under penalty of final dismissal of the application.

Article 163. The registration certificate is deemed to have been granted on the date of publication of the respective instrument.

Article 164. The certificate shall include the trademark, number, and date of registration, name, nationality, and domicile of the owner, the products or services, the characteristics of the registration, and the foreign priority.

## **CHAPTER XI INVALIDITY OF THE REGISTRATION**

### **Section I - Miscellaneous**

Article 165. Registrations granted contrary to the provisions of this Law are invalid.

Sole paragraph. The invalidity of the registration may be total or partial, and the condition for partial invalidity is that the remaining part may be considered eligible for registration.

Article 166. The owner of a registered trademark in a country that is a party to the Paris Union Convention for the Protection of Industrial Property may, alternatively, claim, through a lawsuit, the adjudication of the registration, pursuant to the terms set forth in art. 6 septies (1) of such Convention.

Article 167. The declaration of invalidity shall take effect as of the date when the application was submitted.

### **Section II - Administrative Invalidation Proceeding**

Article 168. Invalidation of the registration shall be administratively declared when it has been granted contrary to the provisions in this Law.

Article 169. The invalidation proceeding may be initiated by INPI's own volition or at the request of any person with a legitimate interest, within one hundred and eighty (180) days of the date of issuance of the registration certificate.

Article 170. The owner shall be summoned to present its arguments in up to sixty (60) days.

Article 171. Once the term established in the preceding article has elapsed, even if there is no response, the proceeding shall be decided upon by the President of INPI, and this shall constitute the conclusion of the proceeding at the administrative level.

Article 172. The invalidation proceeding shall continue even if the registration is extinguished.

### **Section III - Invalidation Action**

Article 173. The invalidation action may be filed by INPI or by any person with legitimate interest.

Sole paragraph. The judge may, in the records of the invalidation action, determine, by an injunction, the discontinuation of the effects of the registration and the use of the trademark, provided that the specific procedural requirements are met.

Article 174. The term for filing an invalidation action expires after five (5) years counted from the date of granting.

Article 175. The registration invalidation action shall be filed in the jurisdiction of the Federal Courts and, whenever INPI is not the claimant, it shall intervene in the case.

Paragraph 1. The term for response of the respondent, the owner of the trademark, shall be of sixty (60) days.

Paragraph 2. Once the decision on the invalidation action becomes final and unappealable, INPI shall publish a note for third parties' knowledge.

(...)

## **TITLE VII MISCELLANEOUS**

## **CHAPTER I APPEALS**

Article 212. Except if there is an express provision determining otherwise, the decisions addressed in this Law are appealable, which shall be filed within sixty (60) days.

Paragraph 1. The appeals shall be received with non-staying effect and stay of proceedings, and all relevant provisions shall apply to the first instance examination, as appropriate.

Paragraph 2. Decisions determining the final dismissal of the patent or registration application shall be unappealable, as well as decisions that accept the application for patent, certificate of addition, or trademark registration.

Paragraph 3. The appeals shall be decided upon by the President of INPI, which shall constitute the conclusion of the administrative level.

Article 213. The interested parties shall be summoned to counter-argument the appeal within sixty (60) days.

Article 214. In order to complement the arguments presented as appeals, INPI may prepare requirements, which shall be met within sixty (60) days.

Sole paragraph. Once the term in the main section has elapsed, the appeal shall be decided upon.

Article 215. The decision of the appeal is final and unappealable at the administrative level.

## **CHAPTER II ACTS OF THE PARTIES**

Article 216. The acts set forth in this Law shall be performed by the parties or by their duly identified attorneys-in-fact.

Paragraph 1. The original power of attorney, or an official transcript or certified copy thereof, shall be in Portuguese, and consular legalization and signature notarization are waived.

Paragraph 2. The power of attorney shall be submitted within sixty (60) days of the party's first act in the proceeding, regardless of notice or requirement, under penalty of final dismissal of the patent application, the application for registration of industrial design and trademark.

Article 217. The person domiciled abroad shall appoint and keep an attorney-in-fact duly identified and domiciled in the Country, with powers to represent him/her administratively and judicially, including to be served process.

Article 218. There will be no petition:

I – if it is filed after expiration of the legal term; or

II – if fails to include the proof of payment of the relevant fee, at the amount in effect on the date it is filed.

Article 219. There will be no petition, objection, and appeal if they:

I – are filed after expiration of the term provided by Law;

II – fail to include the legal basis; or

III – fail to include the proof of payment of the corresponding fee.

Article 220. INPI shall use the acts performed by the parties, whenever possible, making the applicable requirements.

## **CHAPTER III TERMS**

Article 221. The terms established in this Law are continuous, automatically removing the right to perform the act after its expiration, unless the party evidences that it has failed to perform it for cause.

Paragraph 1. Cause is deemed to be an unforeseen event, beyond the party's will, and preventing him/her to act.

Paragraph 2. Upon recognition of cause, the party shall act within the term granted by INPI.

Article 222. When establishing the terms, their start day is to be removed and the expiration day is to be included.

Article 223. The terms only became effective as of the first business day after summons are served, which shall be made upon publication in INPI official body.

Article 224. If no expressly determined by this Law, the term for performing the act shall be sixty (60) days.

**CHAPTER IV  
PRESCRIPTION**

Article 225. The suit for damages caused to the industrial property right prescribes in five (5) years.

**CHAPTER V  
ACTS PERFORMED BY INPI**

Article 226. The acts performed by INPI in the administrative proceedings regarding the industrial property only have effects as of its publication in the relevant official body, except for:

- I – those expressly not depending on notice or publication by virtue of the provisions in this Law;
- II – the administrative decisions, upon notice by mail or acknowledgement to the party interested in the proceeding; and
- III – the internal opinions and orders that the parties do not have the need to know.

**CHAPTER VI  
CLASSIFICATIONS**

Article 227. The classifications related to the matters of Titles I, II, and III of this Law shall be established by INPI, if not set in international agreements or contracts in effect in Brazil.

**CHAPTER VII  
FEE**

Article 228. A fee shall be charged for the services set forth in this Law, which amount and collection process shall be established by the person responsible for the federal public administration body to which INPI is bound.

**Notice**

Only the original Portuguese text of the Law has legal effect.