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POSITION TRADEMARKS – A NEW FORM OF PRESENTATION

On September 21, BPTO published, on the Industrial Property Magazine (RPI) 2646, the Decree N° 37/2021, regulating the registration of trademarks under the presentation form of position trademarks.

According to the Decree, to be liable for registration, a position trademark should have a distinctive set, able to identify a product or service and make it unique against its competition, and said set should be formed by the application of a visual element on a given support, in a specific unique position, and the signal application should be dissociated from a technical or functional effect by the support.

But what is a position trademark after all?

The position trademark is just the application of a distinctive sign in a unique, single and specific position of a given support, dissociated from a technical and/or functional effect. BPTO defines it as *“formed by the application of a sign in a unique, specific and invariable position of a given support object, resulting in a set able to identify the corporate origin and distinguish products or services from others, similar or associated”*. Said signals may, in fact, be constituted by new and common elements, distinct or not, and should always appear in the same position to be easily recognized by the consumers as the unique aspect of that product/company, by immediate association.

Position trademarks had already been included within trademarks technically known as “non-traditional”, i. e. those considered as atypical signs in comparison with the classical bi or tridimensional forms, in terms of application. We should remind that this context includes sound trademarks (TV GLOBO’s PLIM-PLIM), flavors, tastes, textures and all visually perceptible signs, such as: isolated colors, *trade-dress*, etc. – which protection regulations have so far been granted to the unfaithful competition institution, which is the only one to offer protection against the gap in the current industrial property law concerning its scope of regulation.

To whom is the POSITION TRADEMARK intended?

Generally speaking, we believe that the position trademark may be more quickly assimilated by the fashion/perfume industry, but may be extended to other fields very soon.

A few requirements: the pure and simple choice of a position trademark is not enough. It should gather all characteristics required by Law, i. e. it should be applied for by following the guidelines expressly established by the rules of art. 122 of Law N° 9,279/96 – *“visually perceptible distinctive signs not included in legal prohibitions are liable for registration as trademarks”* – in other words, they should mandatorily have: (i) legitimacy; (ii) novelty; and (iii) be liable for protection, to then be able to identify products and/or services, in a unique way to be made identified/visually perceived.

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The regulation of this form of presentation is aligned to the new market trends concerning the incentive to more and more creative and effective means for entrepreneurs to better attract his/her consumers' attention. And, in fact, many companies, especially well-known brands in the clothing, footwear, drinks and other fields, have chosen, not for mere marketing strategies, to apply their trademarks and/or brands to given specific positions of their products, thus allowing the public to recognize them in that exact position besides the intrinsic support already given by the trademark per se. It is also a very smart way to consolidate the identity rate of the trademark beyond its name.

In other words, when visualizing the sign, the logo (or the fixed position) immediately identifies not only the trademark, but also the company holding it, and consequently the trademark/family to which it belongs, not only adding financial value but also emotional and/or philosophic value to the product being shown by the use of said application.



An example of a position trademark today is the famous “Louboutin”, which owner Cristian LOUBOUTIN has required protection for the red color applied to the sole of that envied women’s shoe. In this case, the trademark perception from the consumer’s point of view is clear, which enables it to be distinctive and recognized. Other classic trademarks, such as KEDS, ADIDAS, PRADA, TACO BLUE JEANS and others are also included in the class of position trademarks by establishing themselves due to their figurative elements – always in good fixed positions characterizing them.

For better understanding: what was regulated by law until now:

Our law already established, as we know, the four (4) classic forms of application presentations – nominative, figurative, mixed and tridimensional. Now, this “new” class has also been established, but in fact it already existed informally, taking its affinity to the then called emblematic (Law 5,772/71) or tridimensional (Law 9,279/96) trademarks. It is now called “position trademark”, in adaptation to the new world agenda for industrial property asset protection – especially after the Protocol of Madrid entered into force, bringing together unique tools and proceedings for the internationalization of trademark registrations, aiming to reduce costs and paperwork in the long term.

The four (4) trademark presentation forms existing so far are as follows:

Nominative Trademark

A nominative or verbal trademark is the sign constituted by one or more words, in the wide sense of the Roman alphabet, also comprising neologisms and combinations of letters and/or Roman and/or Arabic numbers, as long as these elements are not presented in a fanciful or figurative form.

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Figurative trademark

A figurative or emblematic trademark is the sign constituted by:

a drawing, image, figure and/or symbol;

any fanciful or figurative form of a letter or number, be it isolated or followed by a drawing, image, figure or symbol;

words constituted by letters of alphabets different from our official one, such as Hebrew, Cyrillic, Arabic, etc; and

ideograms, such as Japanese and Chinese.



Mixed Trademark

A mixed or composed trademark is a sign constituted by the combination of nominative and figurative elements, or even just by nominative elements which wording is presented under a fanciful or stylized form.



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Tridimensional Trademark

A tridimensional trademark is the sign constituted by the distinctive plastic form itself, able to individualize the products or services to which it is applied. To enable its registration, the distinctive tridimensional form of a product or service should be dissociated from its technical effect.



source: www.inpi.gov.br

Therefore, with the regulation of POSITION TRADEMARKS, there are now five (5) presentation forms of trademark registration applications in Brazil.

It is important to highlight that the ultimate object of a position trademark registration is not to protect creativity per se, but rather to avoid confusion between products/services, and this is the importance of the protection to be assured, firstly to the entrepreneurs and investors, and finally to the consumers themselves.

In conclusion, it is always advisable to remind that previous searches are required before the applications, so to assure the existence of full novelty, forecasting an application with no disturbances for maturing into the registration approval.

Very truly yours,
PATCORP INTELLECTUAL PROPERTY PROTECTION SERVICE

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