

Court Decision Regarding Invalidity Action Against Football Spray Patent in Brazil - the Brazilian spray patent battle with FIFA

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Brazil | March 27 2024

Since 2017, there has been an off-field football dispute over the patent infringement of the spray used to mark the distance between the barrier's position and the ball for free kicks in football matches (see [Off-field football dispute: Brazilian spray patent battle](#) , [Turnaround in off-field football dispute: Brazilian spray patent battle](#) , and [A New Chapter on Football Spray - an off-field dispute - the Brazilian spray patent battle with FIFA](#)).

It is important to point out that there are two simultaneous lawsuits regarding this invention: (i) one before the State Court of Rio de Janeiro regarding FIFA's alleged infringement of the spray patent owned by a Brazilian inventor and his company (the patent owner); and (ii) the second one before the Federal Court of Rio de Janeiro filed by FIFA seeking the invalidation of the patent.

As a defense strategy against patent infringement allegations, FIFA filed an Invalidity action before Rio de Janeiro Federal Courts against the granting of Brazilian Patent PI0004962-0 titled "*foamy spray composition to demarcate and limit regulatory distances in sports*" seeking the patent's invalidation based on (i) lack of descriptive sufficiency and clear characterization/grounds and lack of inventive activity – non-compliance with articles 24 and 25 of Brazilian Industrial Property Law[1]; and (ii) lack of inventive activity.

Last March 21, 2024, a new chapter unfolded in this judicial battle, with the first circuit judge's decision supporting the validity of the patent, based on the court-appointed expert technical report. Such technical report indicated that the spray meets all the necessary requirements under the Brazilian Patent Law and Brazilian Patent Office guidelines to be considered a valid invention.

With the technical report issued and all parties' arguments addressed by the court-appointed expert, the federal judge in charge had sufficient grounds to rule on the case in favor of the inventor, with the technical report being crucial to the judge's decision. However, FIFA can appeal against this unfavorable decision to the Second Region Federal Court of Appeals.

As for the infringement lawsuit, the parties are currently awaiting examination by the Brazilian Superior Court (STJ) in view of a Special Appeal filed by FIFA, as the appellate court judges of the Rio de Janeiro State court ordered FIFA to cease the infringement and pay damages to the patent owner.

Although the patent in dispute has already expired in most countries where the inventor sought protection, this matter is far from coming to an end. Meanwhile, all football and patent fans will have to stay tuned to keep track of this interesting battle.

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