



Turnaround on a football dispute off the field - the Brazilian spray patent battle

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Comeback wins are specially celebrated by their winners. Recently a turnaround occurred in an off-field dispute for the patent infringement of the spray used to mark the distance between the barrier's position and the ball, to take a free kick in football matches.

In July 2020, the first circuit judge rejected a claim in the infringement lawsuit filed by the Brazilian inventor and his company (patent owner) against Fédération Internationale de Football Association – FIFA, deeming that the inventor was unable to prove that the products used by FIFA correspond to infringed copies of his products and failed to prove any kind of damage.

However, the Brazilian inventor appealed this decision to higher courts, and there was a turnaround in this case, as Rio de Janeiro's Court of Appeals reversed the decision, in view of the evident and flagrant breach of good faith in the pre-contractual sphere, practiced by FIFA, condemning FIFA to indemnify the inventor on material and moral damages.

Upon reanalyzing the evidence presented by the inventor and his narrative, the Court of Appeals held that FIFA used its advantageous position in the football scenario to detain the powers and economic conditions in this sector, in a flagrant act of abuse of right, by making unfounded promises of legal negotiations in exchange for receiving expertise and free uses of the equipment, offering a non-compatible value proposal to finally terminate the negotiations, aiming to remove the Brazilian inventor from the business and establish a partnership with other international companies.

The Court of Appeals held that FIFA, after reiterated free use of the product, transfer of expertise and promises to purchase the patent, was acting in flagrant business malfeasance, violating the name of the Brazilian inventor and remaining inert in the completion of the legal transaction.

Thus, the Court of Appeals sentenced FIFA to pay material damages arising from the use of the invention, loss of profits for damage to image and sponsorship, as well as moral damages to the inventor. May 2012 was the initial term, as it was considered the start of business negotiations and subsequent use of the spray cans, limited to the national territory, covering not only the tournaments organized by FIFA, but also all football matches played within official competitions held in Brazil, organized by entities belonging to FIFA's hierarchical structure (CONMEBOL, Brazilian Football Confederation and State Football Federations), until the period in which the exclusivity of the Brazilian inventor's patent in the national territory ends.

Also, taking FIFA's behavior into consideration, the Brazilian inventor failed to publicize his image and executing television association contracts and other gains subject to this type of unearned contracting. Therefore, the Court of Appeals accepted such claim, considering the amounts the Brazilian inventor failed to earn through sponsorship and appearances in the media due to the omission of the Brazilian inventor's trademark when using the spray in the 2014 World Cup and other tournaments. The absence of publicity on a world stage evented prevented the execution of sponsorship contracts, in addition to the natural losses of image and television association damage to the Brazilian inventor and his company.

Finally, FIFA was also sentenced to pay moral damages to the Brazilian inventor and patent owner, in the amount of R\$ 50.000,00 (fifty thousand reais), approximately USD 9.000,00 (nine thousand dollars).

This matter is far from coming to an end, as FIFA can appeal this decision to higher courts, leaving a final decision likely after the Qatar 2022 World Cup. Meanwhile, all football and patent fans will have to stay tuned to keep track of this battle.

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