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The Madrid Protocol implementation in Brazil and its procedural changes in each office

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In the last two years, the trademark practice in Brazil has had a considerable change of scenario with the implementation of the Madrid Protocol, back in 2019.

New measures and formalities were introduced, thus changing multiple procedures with which Brazilian trademark practitioners, as well as clients overseas, were all familiar.

Among the many changes, one deserves an extra attention: the shift of competence from the BPTO to WIPO in a couple procedures, namely:

- Change of name and/or address.
- Ownership assignment.
- Withdrawal of trademark applications or registrations.
- Amendments to the list of goods and services.
- Payment of the registration and certificate issuance fees.
- Renewal of the trademark registration.

For such reason, procedures such as those above, which were traditionally initiated and requested at the Office of Origin, will have to be directly submitted to WIPO, which will communicate to the BPTO in due time.

It is quite important to have that in mind since many of these procedures are made in connection with a deadline, which if not met could lead to the loss of the trademark registration/application in Brazil.

Other changes are yet to be introduced, such as the multiclass system for national applications and the division of classes for both national and international trademark applications. Currently, there is no forecast of the time when these measures will be implemented, as the BPTO is still trying to solve some technical issues to make that possible.

Further technical adjustments were needed for the issuance of the registration certificates. In fact, for many months, the granting decisions were not being published and only recently were they made available by the BPTO.

Another relevant point to remember is that the Brazilian IP Law, in its Article 217, provides that “*A person domiciled abroad must maintain permanently a duly qualified representative resident in the country, with powers to represent him administratively and judicially, including for receiving the summons*“. So, even though

according to the Madrid Protocol rules it may not be mandatory to appoint a local representative, the Brazilian IP Law currently states otherwise, reason why it is advisable to maintain a conservative position on this matter.

Surely there are still many steps to be taken regarding the Madrid Protocol in Brazil, but the process of its implementation has already resulted in various changes that require due diligence of the trademark practitioners.

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