

A New Chapter on Football Spray - an off-field dispute - the Brazilian spray patent battle with FIFA

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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.

Following the Brazilian Civil Procedure Code, there are two simultaneous lawsuits taking place, one before the State Court of Rio de Janeiro regarding the supposed infringement by FIFA of the spray patent owned by a Brazilian inventor and his company (the patent owner). The second one before the Federal Court of Rio de Janeiro filed by FIFA seeking the invalidation of the patent.

Brazilian Patent PI0004962-0 title "*foamy spray composition to demarcate and limit regulatory distances in sports*" was filed on October 20, 2000, and granted by the Brazilian Patent Office on February 09, 2010. Before the cited invalidation judicial claim, an administrative nullity procedure was filed against the grant of this patent. However, the Brazilian Patent Office issued a decision on November 16, 2016, maintaining the validity of the patent.

The infringement lawsuit is currently pending examination by the Brazilian Superior Court (STJ) in view of a Special Appeal filed by FIFA, as the second circuit judges of the Rio de Janeiro State court ordered FIFA to cease the infringement and pay damages to the patent owner.

FIFA seeks 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.

Amidst the turmoil, during the invalidity lawsuit before the Federal Court, the Brazilian Patent Office changed its previous understanding and filed a response and subsidies agreeing with FIFA's arguments that the patent must be considered invalid.

However, last October an important event occurred in which the court-appointed expert issued a technical report supporting the validity of the patent. Such technical report indicated that the spray meets all the necessary requirements to be considered a valid invention.

With the technical report issued and all parties' arguments answered by the court-appointed expert, it seems that the federal judge in charge has sufficient grounds to rule on the case within the next few months. Nonetheless, Brazilian legislation allows for challenges to the presented technical report.

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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