

BRAZIL:
**TRADEMARK
TRENDS FOR 2023**

January, 2023



Think out of the box: Position Marks



A position mark is formed by the application of a sign at a singular and specific position in a support, resulting in a distinctive set, provided that the application of the sign in said position can be dissociated from a technical or functional effect.



It is possible to file position marks in Brazil since 2021, but only in November 2022 has the Brazilian Patent and Trademark Office (BPTO) created a specific form for the filing of position marks as well as implemented system updates to receive and process such applications.

The mark applied to the support can be formed by any visually perceptible elements or their combinations, such as: words, letters, numbers, ideograms, symbols, drawings, images, figures, colors, patterns and forms, as long as they are not included in the legal prohibitions.

New glimpse for the future: Secondary Meaning



A large company in the dairy market recently succeeded in a lawsuit to revert the BPTO's decisions that rejected its three-dimensional yogurt pots trademark applications on the grounds that they lack distinctiveness.

The Plaintiff's main argument was a market survey to attest the recognition of distinctiveness of such yogurt pots before the consumer.

*"Although the shape of the three-dimensional mark in question is not differentiated and conspicuous, which in fact makes it difficult to recognize the inherent distinctiveness, **it cannot be denied that the pot created by the Plaintiff reached a degree of distinctiveness that is sufficient to be recognized as a mark before the public, thus acquiring sufficient distinctiveness.**"*

*"The investments in quality and dissemination of the trademark created a factual circumstance in the market, in which consumers began to identify the pots in question as trademarks of the Plaintiff's yogurt product, **acquiring distinctiveness by secondary meaning.**"*

Lawsuit No. 0115937-93.2017.4.02.5101 - Federal Court of the Rio de Janeiro State

The Plaintiff carried out a market survey in which, in a sample of 500 people, **more than 70% of the interviewees recognized the yogurt trademark only by the shape of its pot**, thus demonstrating its distinctiveness in the market.

This decision reinforces that the Court has been open to accepting the theory of secondary meaning. In that sense, we draw the company's attention to the relevance of (1) conducting market surveys to attest to the recognition of trademark distinctiveness, and (2) gathering evidence of publicity and marketing investments.

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