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Mediation procedure to facilitate trademark disputes pending before the INPI

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Since July 15, 2013, the Brazilian Patent and Trademark Office (INPI) started offering a voluntary mediation service for administrative disputes arisen from trademark proceedings. Such alternative may help decreasing the number of current disputes as well as the time for their solution and backlog. Moreover, it may facilitate international parties seeking to settle related disputes in multiple jurisdictions.

Parties to a trademark dispute pending before the INPI may submit it to mediation at any stage of the administrative proceeding, which shall be suspended by the INPI for at least 90 (ninety) days as from the beginning of the mediation procedure. Nonetheless, mediation can only be taken with the agreement of both parties.

According to the Mediation Rules (Resolution n. 084/2013 and Normative Instruction n. 23/2013), if both parties to the dispute are headquartered or reside in Brazil, the mediation will be held by the INPI Center for Defense of Intellectual Property (CEDPI), in accordance with the INPI Mediation rules. In cases where at least one of the parties is domiciled outside Brazil, on the other hand, the request for mediation shall be filed to both the WIPO Arbitration and Mediation Center (WIPO Center) and CEDPI, thus in accordance with the WIPO Mediation Rules.

As regards the alternative dispute procedure, parties will be able to appoint and mutually consent their mediator, who will establish his fees to be agreed upon by the parties, apart from the official INPI's fees (R\$ 500.00 – approximately US\$ 230.00). Additionally, parties can adapt the process to their needs by agreeing on, e.g., the scope of the dispute and the time set aside for the mediation.

Please note that the INPI will not be bound by the mediation decision. Therefore, even though a mediation agreement is reached by the parties, INPI's examiners will use it as a mean to support their final decision regarding the administrative proceeding dispute.

At last, we emphasize that our senior partner Gabriel Leonardos was selected by the WIPO Center as one of the few qualified experts in Intellectual Property rights, to be suggested as a mediator to the parties with a dispute pending before the INPI.

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