

The co-ownership system of trademarks will be in force on September 15, 2020

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The BPTO (Brazilian Patent and Trademark Office) published on September 08, 2020, a communication informing the new date for co-ownership in trademark processes to be available in new applications filed directly with the BPTO: September 15. It means that, from such date 2 (two) or more applicants, together, can be owners of the same trademark process.

The co-ownership system was one of the innovations in the national trademark system, resulting from Brazil's accession to the Madrid Protocol. The system's provision and regulation are inserted in Resolution 245/2019, which was the subject of another newsletter ([access here](#)) and was originally scheduled to come into force in March 2020. The system was already available to holders who had been designating Brazil in international registrations via the Madrid Protocol.

However, due to IT problems, the BPTO suspended the entry into force of the co-ownership system for holders who made new applications directly at the BPTO, without estimating its implementation, until this publication announced the new date.

According to the communication, to make the co-ownership system feasible, several areas of the BPTO were involved.

The use of the co-ownership system can be done through new applications, or even through assignment process of an existing application or registration in the name of a single holder. We highlight below, some points of attention that must be observed to use the new system:

- Co-ownership will not be available in collective trademark registrations;

- The percentage of each co-holder on ownership of the registration or application will not be noted by the BPTO;
- The declaration of activity in compliance with article 128 §1 of the Brazilian IP Law, must refer to all co-holders;
- For the purposes of examining conflict between trademarks, it is necessary to have all the co-holders in common so that the priority is not considered an impediment;
- For the purposes of defense against forfeiture, proof of use of the mark by only one of the co-holders is enough. However, when justifying legitimate reasons for disuse, it is necessary that the reasons apply to all co-holders;
- In assignment procedures, it is necessary to have the authorization of all co-holders, except for judicial determinations;
- For procedures of attack against third party processes, the measures may be filed by only one of the co-holders. As for measures to defend against attacks by third parties, it is necessary to have the signature from all co-holders or its appointed representatives.

The use of the co-ownership system is not so simple and incurs some possible complications and incidents in the trademark registration process. Thus, the choice for the co-ownership system must be analyzed on a case-by-case basis according to the interests of the holders.

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