

The “Green Patent” fast track

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Demand is growing for sustainable technologies that preserve the environment, and investors are likewise paying more attention than ever to companies that concern themselves with the environmental, social and governance aspects of their business.

The "Green Patents" program implemented by Brazil's PTO (INPI - Instituto Nacional da Propriedade Industrial) is designed to reduce the time spent in examining technologies that have less environmental impact and so contribute to fighting climate change. To be eligible for the fast track, patent applications must contemplate inventions related, for example, to alternative energy generation technologies (biofuels), transportation (hybrid/ electric vehicles), energy conservation, waste management, or sustainable agriculture (fertilizers/irrigation techniques, etc.).

From January 2020 to March 2021, the INPI received 118 requests for accelerated examination involving green technologies. Of these, 32 applications have already been decided, with an approval rate of 65%. The average length of time from the request for accelerated examination to grant of the patente can be as little as eight months.

Along with its priority green patent program, the INPI has a number of other projects to speed up examination and review, as in cases of patent-pending infringement. In such cases, the applicant can request accelerated examination, with the cease-and-desist letter sent to the suspected infringer serving as proof of the infringement.

Examiners in the INPI's Patent Division are working more closely than ever with patente offices in other countries, such as the USPTO, the EPO and the JPO, to propose new methods for shared examinations and to move on to the new phase of the backlog reduction program, focused on patent applications filed since January 2017.

The National Intellectual Property Strategy, the National Innovation Policy, and the patente backlog reduction program are just some examples of Brazil's commitment to attracting investment to this country and making it a center of innovation, creating a virtuous circle with protection of intellectual property assets as a keystone for attracting the interest of investors.

18 Months with the Madrid Agreement

The Madrid Protocol is an international treaty that facilitates registration of trademarks in more than 100 countries. Brazil acceded to the treaty in October 2019, joining 120 other countries that represent more than 72% of the world's population and 81% of the global GDP. Through filing a single application in a single office, such as Brazil's INPI, directed to the World Intellectual Property Organization – WIPO, the Madrid Protocol makes it possible for individuals and businesses to request protection for their marks in multiple countries at the same time, reducing bureaucracy and costs, both

for Brazilians looking for protection of their marks in other countries, and for foreign nationals who wish to register their marks in Brazil.

On receiving a new application, WIPO sends it to each country named in the application, which will examine the mark in accordance with local law.

According to the latest update of the INPI's "Madrid Protocol Dashboard", which compiles data from October 2, 2019 to April 8, 2021, the number of international applications filed by Brazilian individuals and companies (in other words, Brazilian marks being "exported") was 189. In contrast, the number of times Brazil was designated by foreign individuals and companies (i.e. foreign marks "entering" Brazil) was 13,840.

It is interesting to compare the data on the first 18 months of the Madrid Protocol with the annual forecasts made by the INPI and WIPO when the treaty was implemented in Brazil. In the first year, it was expected that Brazil would originate between 98 and 308 applications

(reflecting the 2018 numbers for Mexico and India, respectively). As for designations of Brazil in foreign applications, Brazil was expected to receive something in the range of 8100 designations (which falls between the 2018 numbers for New Zealand and Norway).

To implement the Madrid Protocol, the INPI has made significant changes in how it processes trademark registration applications. The most important are the multiclass system, which allows more than one class of products or services to be included in a single application, and co-ownership, which allows two or more individuals/businesses to own the same mark.

Trademark co-ownership is now a reality in Brazil

Co-ownership of registered marks by two or more businesses or individuals had been a longstanding demand by market agents, which often found themselves solving the shared ownership problem by forming a company solely for the purpose of holding the trademark registration. Although Brazilian law does not prohibit coownership in intellectual property assets, the INPI did not provide the mechanisms needed to allow more than one owner of a mark to be registered in its database.

With Brazil's recent adherence to the Madrid Protocol, the INPI had to reconsider the matter and develop new procedures.

To that end, the INPI issued Resolution 245/2019, expressly providing for co-ownership of marks. Although the resolution came into effect in 2019, only since September 15, 2020 has the INPI's system be able to process co-ownership applications for registration and co-ownership registrations. Now, however, it is possible to apply to the INPI for registration of a trademark under more than one name, which in turn makes it easier for trademarks to be used by more than one person or legal entity, as long as all the co-owners effectively engage in activities compatible with the products or services covered by the trademark's registration.

Co-owners can be added to existing registrations by submitting an application to the INPI to have a transfer of ownership entered on record. Transfers made to include co-owners

should cover all identical or similar marks, because registration proceedings for marks not included in the transfer may be cancelled.

There can be no doubt that co-ownership is an important mechanism for management of trademark ownership, since it acknowledges a legal situation that effectively exists in the market and that is now – finally – recognized by the INPI.

These sustained, focused efforts show that Brazil has grasped central importance of intellectual property to the economy – an importance that will only increase in the future.

**This content is part of the e-book "A Post-Covid World, the ESG Agenda and Other Trends in 2021: Insights for Foreign Investors in Brazil". [Click here to view all the articles.](#)*

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