

# The Trademark

GLOBAL REACH, LOCAL KNOWLEDGE

[www.trademarklawyermagazine.com](http://www.trademarklawyermagazine.com)

## Lawyer

### Annual 2024

**The American IDEA Act**

Page 14

**An interview with Exotec's Head of IP**

Page 18

**Changing Landscapes: Mexico**

Page 22

**Geographic indication in China**

Page 27

**2023 in review: *The Trademark Lawyer* Editorial Board provide jurisdictional overviews that will influence IP in 2024 and beyond**

# Brand strategy and protection: trademark registration



---

**Igor Simoes and Amanda Rojas of Simoes IP outline the importance of a solid trademark and marketing strategy for the creation and development of a strong brand to attract consumer respect and retention.**

---

Information is key in the process of modern globalization. It is undeniable that technological advances, especially the internet, have transformed the way societies around the world live. Access to information and technologies has given people the opportunity not only to interact with different cultures but also to make new choices.

This world filled with options can be challenging for entrepreneurs trying to consolidate their businesses and trademarks. However, we should not be mistaken that those challenges are exclusive to new trademark owners. Stakeholders owning renowned brands must also plan strategies to understand consumers, align

the company's mission, and keep their own companies fresh and on the rise. The truth is that the branding process lives with the brand itself, and, for that reason, trademark management should be brought to the table in all cases.

However, addressing branding strategies without giving the proper attention to protection is a common mistake. Many businesspeople leave trademark applications in second place or are even unaware of the procedures to file their trademarks before the Brazilian Patent and Trademark Office (BRPTO) and International Offices. Such mistakes can easily disrupt the branding strategies of a company in countries like Brazil.

### Branding and strategy for strengthening trademarks

Researchers point out how digital marketing earns more and more of the attention of stakeholders. In Brazil, for example, IAB Brasil, in partnership with Kantar Ibope Media, collected data highlighting that the investment in digital advertising reached R\$ 32.4 billion in 2022<sup>1</sup>.

Moreover, according to Forrester's 2022 Marketing Investment Forecast, the expectation is that marketing investments will grow 30% by 2025<sup>2</sup>.

The numbers confirm that entrepreneurs are aware of the importance of directing investments to marketing and maintaining a relevant digital presence. Moreover, the ease of finding information from all sources, the deep connection that new generations seek to establish with brands, and the need to capture public attention in an increasingly globalized market demands new branding plans and a lot of work to enhance brand equity.

Branding refers to the set of strategies used to consolidate the brand identity before the public and the market. It is a complex management process, which requires a lot of research. To start planning branding strategies, the company needs to establish what it seeks to communicate through its trademarks, as well as its mission, values, and target audience.

Designing a meaningful logo, building the trademark story, and establishing how the brand should make consumers feel is part of the branding process. By establishing such points and other supporting materials (a tagline, the images appearing in advertisements, and more), the company can consciously plan brand management, seeking to perpetuate a trademark image and message in consumers' minds.



Igor Simoes



Amanda Rojas

Many companies have been doing their brand management for years, creating identity bonds with their audiences. That is one of the keys to business longevity, and to influencing consumers' decisions. For example, some brands build their trademarks to pass positivity, hope, and an idea of unity. Others rely on more modern approaches, seeking to speak to younger generations.

In marketing and communication fields, professionals always point out strategies for strengthening the business through trademarks. The Tone of Voice is one of those strategies, and it refers to the way a trademark communicates

- <sup>1</sup> Investimento em publicidade digital cresce 7% em 2022 e atinge R\$ 32.4 bilhões. IAB Brasil. São Paulo. 10/04/2023. Releases. Available (in Portuguese) at <https://iabbrasil.com.br/investimento-em-publicidade-digital-cresce-7-em-2022-e-atinge-r-324-bilhoes/#:~:text=abril%20de%202023-.Investimento%20em%20publicidade%20digital%20cresce%207%25%20em%202022%20e%20atinge,em%20publicidade%20digital%20no%20Brasil>.
- <sup>2</sup> VERBLOW, Brandon et al. 2022 Marketing Investment Forecast, Global. Forrester, Cambridge, MA, 30/03/2022. Forecast Report. Available at <https://www.forrester.com/report/2022-marketing-investment-forecast-global/RES177171> (requires subscription)

## Résumés

### Igor Simoes, Managing Partner

With over 25 years of experience, Igor is the Managing Partner of Simoes Intellectual Property, having graduated in Chemical Engineering from Fluminense Federal University (UFF) and in Law from Candido Mendes University. He is also an Industrial Property Agent, registered before the Brazilian Patent and Trademark Office (BRPTO) since 2001.

Igor has knowledge in all areas of Intellectual Property, demonstrating extensive experience in litigation before Brazilian State and Federal Courts, as well as in all administrative petitions before the BRPTO. His practice also involves prior art searches, technical and legal consultancy in IP, focusing on patents, industrial designs, trademarks, copyrights, and software.

### Amanda Rojas, Marketing and Institutional Relations Coordinator

Amanda holds a degree in Languages from Fluminense Federal University (UFF) and a postgraduate degree in Marketing and Branding. She has completed courses focused on Intellectual Property, in addition to an academic exchange in Italian Language and Culture at the University for Foreigners of Perugia, in Italy, and extension courses in Marketing.

Amanda has been working with Intellectual Property since 2015, focusing on the administrative field and communication with clients. She has been working with Marketing for three years, focusing on the legal area, specializing in social media, user experience, strategic negotiation, and brand strengthening.

(basically, its “personality”). Netflix (an online streaming service), for example, communicates casually and playfully through social media. Medium (an online tool for writers and readers of diverse topics), on the other hand, connects with young generations but communicates more formally than Netflix.

Knowing the company’s purpose is also crucial for consolidating the brand. Moreover, law and communication should meet at the very first steps of the trademark, namely, when stakeholders create the brand name and its visual identity. The reason for the connection between such fields being so important is simple: protecting the company’s trademark is protecting the company itself, preventing monetary losses, and securing the team’s work.

## Trademark search as a branding ally

Article 122 of the Brazilian Industrial Property Law (LPI 9,279/96) establishes that trademarks are any visually perceptible distinctive signs, when not prohibited under law. Legal prohibitions are present in Article 124 of the LPI and define the main requirements that trademarks must follow to be eligible for registration, namely: legality, distinctiveness, veracity, and availability.

According to the Brazilian Trademarks Manual, legality concerns the non-prohibition for reasons of public order or reasons of morality and good customs. Veracity prohibits misleading signs regarding the origin, provenance, nature, purpose, or usefulness of products or services.

Distinctiveness refers to the function of the trademark to distinguish a product or service, making it possible to individualize it from others of the same gender, nature, or kind. Finally, to be available, a trademark must not find obstacles in previous registrations or other distinctive signs protected under any circumstances, not just those protected by the LPI.

Availability is protected by items IV, V, IX, XII, XIII, XV, XVI, XVII, XIX, XX, XXII, and XXIII of article 124, and articles 125 and 126 of the Brazilian IP Law. Article 125 establishes special protection for highly renowned marks. Meanwhile, article 126 is aligned with Article 6 bis (1) of the Paris Convention which provides protection to well-known marks.

For a trademark to be aligned with the provisions of Brazilian IP legislation, a professional analysis and trademark search, before filing, are highly recommended. The search is essential for guiding trademark owners and preventing unnecessary expenses with possible appeals against rejections.

Furthermore, trademark search is important for market analysis and brand building. Through it, it is possible to identify terms, presentations,



**According to Forrester’s 2022 Marketing Investment Forecast, the expectation is that marketing investments will grow 30% by 2025.**



and trends specific to a given scope of activity in a particular country, and that opens the opportunities to draw differentiation and competitiveness plans. In certain situations, this research points to the need to adapt the brand’s presentation, and this directly impacts branding strategies.

The examination of trademark applications in Brazil is territorial. This means that the trademark registration is only obtained before the BRPTO. For that reason, many international trademarks require presentation and branding adaptation.

Around the world, there are several examples of brands that changed their names to commercialize products or services in a specific country. This is the case, for example, of the North American brand Burger King, which has existed since 1954, and was renamed “Hungry Jack’s” in Australia, as there was already a previous registration for the trademark “Burger King” in the country.

It is natural that international franchises adapt their strategies according to local realities, and this already raises the need for different brand management strategies. However, changing the brand sign will likely imply a branding redirection. Trademark presentation is an essential communication factor, which must be aligned with the other brand positioning strategies. Given this, the professional trademark search should also be prioritized whenever the company wishes to protect its own mark.

## Trademark registration in Brazil

According to data from BRPTO’s 2022 Management Report, the filing of trademarks in Brazil has been growing year on year, when looking at the comparison of numbers from 2019 to 2022. Last year, application numbers reached almost 400,000, an increase of 3% compared to 2021.

Such an increase was possible not only because of BRPTO’s efforts to eliminate the backlog in trademark examination but also because of projects for the dissemination of intellectual property in our country.

Furthermore, it is important to highlight that, in 2019, Brazil took a big step towards international cooperation related to trademark protection, as it became a signatory to the Madrid Protocol. One year after Brazil adhered to the Protocol, 109 international applications were filed before the BRPTO by Brazilian trademark owners. At the same time, 7,896 applications were filed by owners from different countries, indicating Brazil as the filing designation.

Further data from the Institute pointed out that from October 2019 to March 2023, 474 International Applications were filed by Brazilian applicants. Meanwhile, Brazil received 34,257 international trademark designations. The United States and the

European Union are the main filing destinations for Brazilian trademarks, and the main regions trying to protect brands in Brazil as well.

Moreover, in 2021, the BRPTO started accepting position marks. In practice, this represented a major progress for owners of non-traditional trademarks who, for years, had been trying to register position marks in Brazil by claiming other presentations (figurative or three-dimensional marks).

As trademark registration is important to branding, a recent case of position marks in Brazil showed the importance of branding for claiming trademark registration as well. This year, the BRPTO rejected Louboutin's application for protecting the red sole of its shoes as a position mark, based on Art. 122 and Art. 124, item VIII, of the Brazilian IP Law, and on the Brazilian Trademarks Manual.

Louboutin's legal representatives in Brazil promptly took the case to the judiciary sphere, and, recently, Judge Marcia Maria Nunes de Barros, from the 13th Federal Court of Rio de Janeiro, issued an injunction suspending the BRPTO's decision.

In this case, one of the many arguments the Judge used for suspending BRPTO's decision was that the red sole has been widely used for years as a visual identity by Christian Louboutin, and it is recognized by consumers of luxury articles and people interested in the fashion and accessories industries. The impossibility of affirming that the designer has been the first one applying the red sole in its shoes was also highlighted, however, according to the Judge, the consistent use of this signature through the years is undeniable.

### Importance of trademark registration

Brazil adopts the attributive system for brand protection, which establishes that trademark exclusivity and property are only granted by means of registration.

The general rule established by LPI and the Brazilian Trademark Manual, states that the trademark registration priority relies on the first applicant. The exception to this rule is provided by §1 of Article 129 of the LPI, which states the following:

"Any person who in good faith at the date of priority or of the application was using an identical or similar mark for at least 6 (six) months in the country, to distinguish or certify a product or service that is identical, similar or akin, will have preferential right to registration."

Considering the rules established by Brazilian legislation, trademark registration before the BRPTO should also be included in the branding strategy. Many stakeholders and businesspeople have already found themselves in the situation

“

**To start planning branding strategies, the company needs to establish what it seeks to communicate through its trademark, as well as its mission, values, and target audience.**

”

of having to change their brand because of a late filing before the BRPTO.

Some cases of trademark rejection in Brazil also highlight the importance of looking out for brand protection. In 2021 and 2022, Brazilian singer, Ludmilla, faced the trademark rejection of her biggest musical project, called "Numanice".

Her legal team filed two composite applications for "Numanice," in class 41. However, the BRPTO rejected both applications based on the previous existence of the registration "NUMA NYCE", in the same class, covering similar services.

In this situation, Ludmilla would have to obtain a useage license from the owner of the registered brand or buy the trademark in case the owner wishes to sell it to the singer. In any case, the late registration of the brand put the



name of one of Brazil's most famous musical projects of recent years at risk.

The worst-case scenario, when a trademark is not registered, is for a company to be accused of being an infringer. Usually, companies receive a warning letter sent by the trademark owner and a reply is required. Whenever a company receives such a cease-and-desist letter, the first recommendation is to analyze whether the sender of the letter is in fact the owner of the trademark or a licensor in Brazil. In the affirmative, the second recommendation is to analyze whether the trademark application/registration may be challenged (either before the BRPTO or in court). The third recommendation is to prepare a reply to the warning letter. There are no provisions in the Brazilian rules demanding the company to reply to the warning letter. However, it is always recommended to do so; otherwise, the sender of the letter may use the lack of reply to request and obtain a preliminary injunction (in court) based on the infringement activity.

### Conclusion

Branding strategies are set to strengthen the company, allowing a trademark to go beyond its name. This set of strategies is built with persuasion purposes, not only to commercialize

products or services but to make a mark memorable and credible.

However, it is essential that a trademark does not infringe third parties' rights to maintain its longevity and credibility. The loss of brand exclusivity in such a competitive market, which is constantly changing, can jeopardize the entire company. Therefore, it is essential that brand protection is prioritized from its inception, and that branding strategies include careful analysis into trademark legislation in each country.

## Contact

### Simoes Intellectual Property

#### Rio De Janeiro Office HQ

Rua Mal. Raul de Albuquerque, 02, 3rd, 4th, 6th, and 7th Floors – 24370-025, Niteroi/RJ – Brazil

**Tel:** +55 21 99498 8126

#### Sao Paulo Office

Av. Pres. Juscelino Kubitschek, 1455, Suite 406 – 04543-011, Sao Paulo/SP – Brazil

[international@simoes-ip.com](mailto:international@simoes-ip.com)

[www.simoes-ip.com/en](http://www.simoes-ip.com/en)

**Simões**  
IP Law Firm

Your ideas have  
rights, not limits.

**RIO DE JANEIRO OFFICE HQ**  
Rua Mal. Raul de Albuquerque, 02  
3rd, 4th, 6th, and 7th Floors - 24370-025  
Niteroi/RJ - Brazil  
Tel: +55 (21) 99498-8126

**SAO PAULO OFFICE**  
Av. Pres. Juscelino Kubitschek, 1455  
Suite 406 - 04543-011  
Sao Paulo/SP - Brazil

[international@simoes-ip.com](mailto:international@simoes-ip.com)  
[www.simoes-ip.com/en](http://www.simoes-ip.com/en)

