



**FEDERAL PUBLIC SERVICE  
MINISTRY OF INDUSTRY, FOREIGN TRADE AND SERVICES  
BRAZILIAN PATENT AND TRADEMARK OFFICE**

ORDINANCE/BPTO/PR No. 25, OF JULY 03<sup>rd</sup>, 2023

Provides for the design registration industry under the Hague Agreement.

The PRESIDENT and the DIRECTOR OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS of the NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY, in the exercise of their attributions legal provisions provided for in item XII of art. 152 and item XIII of art. 156 of the BPTO Internal Regulations approved by MDIC (Ministry of Development, Industry, Trade and Services ??) Ordinance No. 11, of January 27, 2017 and in view of what is contained in Process No. 52402.006815/2023-78,

RESOLVE:

Art. 1<sup>st</sup> This Ordinance governs the processing of design designations and registrations industrial under the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs.

Single paragraph. The application for international registration of an industrial design under the Geneva Act of the Hague Agreement shall be filed with the International Bureau of the Organization World Intellectual Property Office or at the offices of Contracting Parties able to receive such requests.

Chapter I

Definitions

Art. 2<sup>nd</sup> For the purposes and effects of this Ordinance, the following concepts and definitions:

I - BPTO: **BRAZILIAN PATENT AND TRADEMARK OFFICE**;

II - Agreement: The Hague Agreement concerning the International Registration of Industrial Designs of November 6, 1925;

III - Geneva Act: Geneva Act of the Hague Agreement concerning International Registration on Industrial Designs, adopted in Geneva on 2 July 1999;

IV - Common Regulations: Common Implementing Regulations of the Hague Act and the Geneva of the Hague Agreement;

V - Contracting Party: country or intergovernmental organization signatory to the Act of Geneva;

VI - International Bureau: International Bureau of the World Health Organization Intellectual property;

VII - International Register: official collection of data related to international registers maintained by the International Bureau;  
VIII - International registration: registration of an industrial design carried out under the Act of Geneva, containing the industrial design data and its situation before the Contracting Parties;  
IX - International application: application for international registration filed under the Agreement;  
X - Designation: request for an international registration to take effect in Brazil;  
XI - Configuration: each plastic form or set of lines and colors that is the subject of an international registration;  
XII - Owner: individual or legal entity in whose name an international registration was made in the international registry; and  
XIII - Designated Contracting Party: Contracting Party for which protection of the industrial design was requested when filing the international application.

## Chapter II

### International filings that designate Brazil

#### Section I Language

Art. 3<sup>rd</sup> The communications between the International Bureau and the BPTO, regarding the designations of Brazil, will be written in English.

Art. 4<sup>th</sup> The applications referring to the designation of Brazil, as well as any accompanying document, if submitted directly to the BPTO, must be written in Portuguese.

Single paragraph. Documents written in a foreign language must be accompanied by a simple translation.

#### Section II Acts performed directly at the BPTO

Art. 5<sup>th</sup> When carrying out acts directly at the BPTO, the owner of an international registration domiciled abroad must appoint and maintain a duly qualified attorney domiciled in the Country, with powers to represent it administratively and judicially, including to receive citations.

§1 The power of attorney must be presented within 60 (sixty) days from the performance of the first act, regardless of notification or demand, under penalty of dismissal of the petition.

§2 The petition relating to the designation of Brazil or the registration of an industrial design under the Hague Agreement will be carried out exclusively by electronic means.

### Section III Examination, grant and effects

Art. 6<sup>th</sup> The international registration that designates Brazil will produce the same effects as an application for registration of an industrial design filed in the country, as of the date of this designation.

Art. 7<sup>th</sup> The industrial designs subject to designations in Brazil will be examined in accordance with the provisions of Law No. 9.279, of May 14, 1996, and with the conditions established by BPTO.

Art. 8<sup>th</sup> Any industrial design that is the object of designation by Brazil will enjoy the same protection conferred to an industrial design registered directly with the BPTO, under the terms of Law No. 9,279, of May 14, 1996, provided that the BPTO:

I - has notified the International Bureau of the declaration granting protection industrial design;

II - has not notified the International Bureau, within a period of 6 (six) months from the date of notification of the designation of Brazil, on a refusal of the effects of the international registration of that Industrial draw; or

III - has withdrawn a refusal of the effects of the international registration of that industrial design.

Art. 9<sup>th</sup> For the recognition of the right of priority provided for in art. 99 of Law No. 9.279, of May 14, 1996, the owner of the international registration must submit to the BPTO, within 90 (ninety) days from the date of publication of the registration by the International Bureau, a copy of the valid document of origin, which must contain the date, number and figures of the request correspondent, accompanied by its simple translation.

§1° In the case of international registration in which Brazil is a designated Contracting Party be faithfully contained in the appropriate document of origin, a statement from the owner to this will be sufficient respect to replace the simple translation.

§2° The BPTO will examine the valid document of origin available in the library World Property Organization Digital Access Service to Priority Documents Intellectual Property (DAS) by means of an access code informed in the international registration, which exempts the owner of the international registration of the presentation referred to in the caput.

§3° The information of the access code to the document of origin in the digital library World Property Organization Digital Access Service to Priority Documents Intellectual Property (DAS) entails a tacit declaration by the owner under the terms of §2, waiving the presentation of the simple translation.

§4° If the appropriate document of origin is not presented within the prescribed period, it will be disregarding the priority date and considering the date of filed of the international registration.

§5° The BPTO will accept the presentation, by the owner, of documents that prove the publication and date of publication of the industrial design for the purpose of proving non-disclosure harmful effect of the industrial design that is the subject of international registration.

§6° Documents proving non-harmful disclosure that exceed the 180 (one hundred and eighty) days prior to the filing date of the international or priority application claimed, if promoted in the situations provided for in items I to III of art. 12 of Law No. 9.279, of 14th of May 1996.

Art. 10<sup>th</sup> The BPTO will send to the International Bureau, within 6 (six) months from the

notification of the designation of Brazil:

- I - notification of refusal of protection; or
- II - declaration granting protection, referring to the approval of the designation.

§1° The notifications of refusal will be sent to communicate:

- I - the formulation of requirements during the examination;
- II - the suspension of the exam due to a lawsuit; or
- III - the decision rejecting the designation.

§2° The refusals sent to communicate the formulation of the requirement during the examination, of referred to in item I of paragraph 1, shall inform:

- I - the legal provisions that support the formulated requirement; and
- II - guidance on compliance with the requirement within the legal term.

§3° Refusals sent to communicate the decision to reject the designation, referred to in item III of paragraph 1, shall inform:

- I - the legal provisions on which the refusal is based; and
- II - guidance regarding the presentation of an administrative appeal within the legal deadline.

§4° If a notification of refusal is not sent by the BPTO within the period provided for in the caput, the protection to the designation of Brazil will be granted.

§5° The declaration granting the protection of the designation and the communications that deal with items I, II and III of §1 will be published in the BPTO's official means of communication.

Art. 11<sup>th</sup> The BPTO may refuse the effects of an international registration based on that:

- I - the reproductions contained in the international registration do not represent a clear and the industrial design and its variations, if any, sufficiently to enable its reproduction by a specialist in the subject, contrary to the provisions of the sole paragraph of art. 104 of Law No. 9.279, of 14th of May 1996;

- II - the international registration includes more than one object, contrary to the provisions of the caput of the art. 104 of Law No. 9.279, of May 14, 1996; or

- III - the industrial design object of the international registration does not correspond to the other provisions set forth in Law No. 9.279, of May 14, 1996.

Single paragraph. The BPTO will not refuse the effects of an international registration with the on the ground that the requirements relating to the form or content of the international application set out in the Act of Geneva or the Common Regulations, or which are additional to or different from these requirements, shall not were complied with in accordance with Law No. 9,279, of May 14, 1996 and with the conditions established by BPTO.

Art. 12<sup>th</sup> Refusal of an international registration that includes more than one object, under the terms of art. 104 of Law No. 9,279, of May 14, 1996, requires the owner to indicate an industrial design to be kept in the designation.

§1 The owner of the designation is allowed to filing orders divided for designs industries excluded from the designation.

§2 The indication of the industrial design to be kept in the designation and filing of the

divided applications referred to in §1 will be filed directly with the BPTO within 60 (sixty) days after the publication, in the BPTO's official communication medium, of the technical requirement for the division of designation.

Art. 13<sup>th</sup> If it is appropriate at any time to grant protection to an industry design that is the subject of an international registration in relation to which the BPTO has notified a denial of its effects in accordance with art. 11, the BPTO must notify the International Bureau:

I - the withdrawal of such refusal, in whole or in part, with an indication of the configurations to which refers to; or

II - a declaration granting protection, in whole or in part, after notification of a refusal, indicating, where appropriate, the settings to which it refers.

§1 When the designation has been amended in the procedure before the BPTO, the notice referred to in item I shall also contain or indicate all amendments.

§2 The refusals sent to communicate the matters dealt with in items I and III of the §1 of art. 10 will inform the deadline of 60 (sixty) days for the presentation of a manifestation directly to the BPTO.

§3 When appropriate, the BPTO will rectify any notification of refusal considered irregular, sending a new communication to the International Bureau.

Art. 14<sup>th</sup> After the notification of refusal and conclusion of the procedures before the BPTO, a declaration granting the protection subsequent to a notification of refusal will be sent to the International Bureau to communicate:

I - the granting of protection after sending a refusal based on the hypotheses provided for in items I and II of §1 of art. 10;

II - the granting of protection after a decision at the appeal level; or

III - the reform of the rejection of the designation on appeal.

Art. 15<sup>th</sup> After a declaration granting protection or a declaration granting protection subsequent to a notification of refusal, the BPTO, when issuing or becoming aware of any decisions that affect the protection of an industrial design object of a designation from Brazil, communicate the fact directly to the owner through an official publication by the BPTO.

§1° In the event provided for in the caput, a communication will be sent to the International Bureau indicating the status of industrial design.

§2° The decisions referred to in the caput include:

I - the termination of the designation due to the lack of renewal, under the terms of item I of art. 119 of Law No. 9,279, of May 14, 1996;

II - the proposition of an administrative procedure for nullity of the effects of the registration internationally, pursuant to art. 112 to 117 of Law No. 9,279, of May 14, 1996; and

III - the judicial declaration of nullity of the effects of the international registration, under the terms of art. 112 of Law No. 9,279, of May 14, 1996;

#### Section IV Validity and renewal

Art. 16<sup>th</sup> The international registration designating Brazil will be renewed every five years upon payment at the International Bureau with a maximum duration of protection in Brazil of 25 (twenty and five) years, counted from the date of filing of the international

registration, pursuant to arts. 108 and 120 of Law No. 9.279, of May 14, 1996.

§1° The designation that is not renewed in relation to Brazil with the International Bureau will be extinguished at the end of its term, as well as the designations pending examination.

§2° Industrial design registrations resulting from the division of the designation, dealt with in the §1° of art. 12, will be renewed upon payment directly to the BPTO, pursuant to arts. 108 and 120 of Law No. 9.279, of May 14, 1996.

## Section V Annotations

### Subsection I Application

Art. 17<sup>th</sup> Requests for annotations referring to an international registration that designate Brazil must be sent by the owner directly to the International Bureau.

### Subsection II The effects of annotations

Art. 18<sup>th</sup> The following notes, when made in the international register about an international registration and applicable to Brazil as a designated contracting party, will produce the same effects of an annotation made directly with the BPTO:

- I - change of name and address of the owner;
- II - change of ownership;
- III - resignation of designation; and
- IV - cancellation of the international registration;

§1° The annotation provided for in item II will produce effects in Brazil only if accompanied by the supporting documentation.

§2° Within a period of 6 (six) months from the notification, based on art. 16(2) of Act of Geneva, the BPTO may communicate to the International Bureau that the annotation provided for in item II will not produce effects in Brazil, indicating the reasons for the refusal and the conditions for the submission of appeal against the said decision.

§3° The BPTO shall inform the International Bureau of the final decision on the refusal of the annotation.

§4° The cancellation of the international registration, provided for in item IV, will result in the withdrawal of the designation of Brazil or the renunciation of registration in the country.

## Section VI Resources and manifestations

Art. 19<sup>th</sup> The owner of the international registration that designates Brazil will be assured the same means and deadlines for appeal and manifestation provided for in Law No. 9,279, of May 14, 1996.

Art. 20<sup>th</sup> There will be no appeal:

- I - the declaration granting protection; and
- II - the refusal dealt with in items I and II of §1 of art. 10.

## Section VII Adjustment

Art. 21<sup>th</sup> When notified by the International Bureau of a adjustment relating to an international registration, the BPTO may re-examine the designation.

Single paragraph. The BPTO may send to the International Bureau, within 6 (six) months, the from receipt of notice of rectification, a refusal of protection arising from the review, the validation or annulment of the acts may occur, respecting acquired rights of third parties.

Art. 22<sup>th</sup> The designation will be considered non-existent when the BPTO is notified by the International Bureau of a adjustment stating that:

- I - the international registration does not designate Brazil;
- II - there was no payment of the individual remuneration related to the designation of Brazil; or
- III - the designation of Brazil should not be considered.

## CHAPTER III GENERAL PROVISIONS

Art. 23<sup>th</sup> The BPTO will republish, in its official means of communication, the information regarding to international registrations having effect in Brazil, published by the International Bureau, without no cost to the international registration owner.

Art. 24<sup>th</sup> Unless expressly provided otherwise, the deadlines established in this Ordinance are continuous and counted from the first business day after the publication in the official means of communication of the BPTO.

## CHAPTER IV VALIDITY

Art. 25<sup>th</sup> This Ordinance takes effect on August 1<sup>st</sup>, 2023.