



MINISTRY OF DEVELOPMENT, INDUSTRY, TRADE AND SERVICES

NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

ORDINANCE/INPI/PR No. 25, JULY 03, 2023

Discusses the registration of industrial designs under the Hague Agreement.

The **PRESIDENT** and the **DIRECTOR OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS** of the **NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY**, in use of its legal attributions provided for in item XII of article 152 and in item XIII of article 156 of the Internal Regulations of INPI approved by MDIC Ordinance No. 11, of January 27, 2017, and in view of the discussed in process No. 52402.006815/2023-78,

DECIDE:

Art. 1 This Ordinance regulates the prosecution of designations and design registrations under the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs.

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

CHAPTER I

DEFINITIONS

Art. 2 For the purposes and effects of this Ordinance the following concepts and definitions are adopted:

I - INPI: National Institute of Industrial Property;

II - Agreement: 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 of Industrial Designs, adopted in Geneva on July 2, 1999;

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

V - Contracting Party: country or intergovernmental organization that is a signatory to the Geneva Act;

VI - International Bureau: International Bureau of the World Intellectual Property Organization;

VII - International Register: official collection of data relating to international registers mandated by the International Bureau;

VIII - International registration: registration of an industrial design under the Geneva Act, containing the data of the industrial design 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 substantial shape or set of lines and colors that is the object of an international registration;

XII – Holder: a person or legal entity in whose name an international registration has been granted in the international register; and

XIII – Designated Contracting Party: Contracting Party for which protection has been requested for the industrial design at the time of the protocol filing of the international application.

CHAPTER II

INTERNATIONAL REGISTRATIONS DESIGNATING BRAZIL

Section I

Language

Art. 3 Communications between the International Bureau and INPI, relating to Brazilian designations, will be written in English.

Art. 4 The requirements regarding the Brazilian designation, as well as any accompanying documents, if submitted directly to INPI, must be written in Portuguese.

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

Section II

Acts taken directly at INPI

Art. 5 When acting directly at INPI, the holder of an international registration domiciled abroad shall constitute and maintain a duly qualified attorney domiciled in the country, with powers to represent him administratively and judicially, including to receive summonses.

§1 The power of attorney must be submitted within 60 (sixty) days from the date of the first act, regardless of notice or office action, under penalty of shelving of the petition.

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

Section III

Examination, granting, and effects

Art. 6 The international registration designating Brazil shall produce the same effects as an application for registration of industrial design filed in the country, as of the date of this designation.

Art. 7 The industrial designs subject to Brazilian designations will be examined in compliance with the provisions of Law No. 9,279, of May 14, 1996, and with the conditions established by INPI.

Art. 8 Any industrial design that is the subject of Brazilian designation shall benefit from the same protection granted to an industrial design registered directly with INPI, under the terms of Law No. 9,279, of May 14, 1996, provided that INPI:

I - notified the International Bureau on the declaration granting protection to the industrial design;

II - has not notified the International Bureau within 6 (six) months of the notification of the Brazilian designation, on a refusal of the effects of the international registration of that industrial design; or

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

Art. 9 For the recognition of the right of priority provided for in article 99 of Law No. 9,279, of May 14, 1996, the holder of the international registration must submit to INPI, within ninety (90) days from the date of publication of the registration by the International Bureau, a copy of the document of origin, which must contain the date, number, and figures of the corresponding application, accompanied by its simple translation.

§1 In the case of an international registration, in which Brazil is a designated Contracting Party, being faithfully contained in the origin document, a declaration by the holder in this regard will suffice to replace the simple translation.

§2 INPI shall examine the origin document available in the digital library of the Digital Access Service to Priority Documents of the World Intellectual Property Organization (DAS) by means of an access code informed in the international registration, which exempts the holder of the international registration from the presentation referred to in the **caption**.

§3 The information of the access code to the origin document in the digital library of the Service of Digital Access to Priority Documents of the World Intellectual Property Organization (DAS) provides a tacit declaration by the holder pursuant to paragraph 2, exempting the presentation of the simple translation.

§4 If the origin document is not presented within the prescribed period, the date of priority will be disregarded and the date of filing of the international registration will be considered.

§5 INPI shall accept presentation, by the holder, of documents proving the publication and the date of publication of the industrial design to prove the non-harmful disclosure of the industrial design that is the subject of the international registration.

§6 Documents of proof of non-harmful disclosure that exceed 180 (one hundred and eighty) days prior to the date of filing of the international application or the priority claimed, if promoted in the situations provided for in items I to III of article 12 of Law No. 9,279, of May 14, 1996, shall not be accepted.

Art. 10. INPI shall send to the International Bureau, within 6 (six) months from the notification of the Brazilian designation:

I - notification of refusal of protection; or

II - declaration of granting of protection, referring to the granting of the designation.

§1 Notifications of refusal shall be sent to communicate:

I - the formulation of requirements during the examination;

II - the suspension of the examination due to legal action; or

III - the decision to reject the designation.

§2 The refusals sent to communicate the formulation of a requirement during the examination, of which deals with item I of paragraph 1, shall inform:

I - the legal provisions on which the requirement is based; and

II - guidance on compliance with the requirement within the legal deadline.

§3 The refusals sent to communicate the decision rejecting the designation, which deals with item III of paragraph 1, shall inform:

I - the legal provisions on which the rejection is based; and

II - guidance on the filing of an administrative appeal within the legal time limit.

§4 If notification of refusal is not sent by the INPI within the period provided for in the **caption**, the protection of Brazil's designation will be granted.

§5 The declaration granting the protection of the designation and the communications referred to in Items I, II and III of paragraph 1 shall be published by means of an official communication by INPI.

Art. 11. INPI may refuse the effects of an international registration on the grounds that:

I - the reproductions contained in the international registration do not represent clear and sufficiently the industrial design and its variations, if any, to enable its reproduction by a skilled person, contrary to the provisions of the sole paragraph of article 104 of Law No. 9,279, of May 14, 1996;

II - the international registration includes more than one object, contrary to the provisions of the **caption** of Article 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 provided for in Law No. 9,279, of May 14, 1996.

Sole paragraph. INPI will not refuse the effects of an international registration with the grounds that the requirements relating to the form or content of the international application provided for in the Geneva Act or the Common Regulations, or which are additional to or different from these requirements, have not been fulfilled in accordance with Law No. 9,279 of May 14, 1996, and with the conditions established by the INPI.

Art. 12. The refusal of an international registration that includes more than one object, under the terms of Article 104 of Law No. 9,279, of May 14, 1996, provides for indication, by the holder, of an industrial design to be maintained in the designation.

§1 The holder of the designation is entitled to file divisional applications for industrial designs excluded from the designation.

§2 The indication of the industrial design to be maintained in the designation and the filing of the divisional applications referred to in paragraph 1 shall be filed directly before the INPI within

60 (sixty) days after the publication, in the official communication of INPI, of the technical requirement for the division of the designation.

Art. 13. If deemed appropriate, at any time, to grant protection to an industrial design that is the subject of an international registration in respect to which INPI has not refused its effects in accordance with Article 11, the INPI shall notify the International Bureau:

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

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

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

§2 The refusals sent to communicate the matters referred to in items I and III of paragraph 1 of article 10 shall inform the term of 60 (sixty) days for the submission of a statement directly to INPI.

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

Art. 14. After the notification of refusal and completed the procedures before the INPI, a declaration granting protection after 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 paragraph 1 of article 10;

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

III - the reform of the rejection of the designation at the appeal stage.

Art. 15. After a declaration granting protection or a declaration granting protection after a notification of refusal, when issuing or becoming aware of any decisions affecting the protection of an industrial design subject to a Brazilian designation, INPI will communicate the fact directly to the holder through official publication.

§1 In the case provided for in the **caption**, a communication shall be sent to the International Bureau indicating the situation of the industrial design.

§2 The decisions referred to in the **caption** include:

I - the extinction of the designation due to the absence of renewal, pursuant to item I of article 119 of Law No. 9,279, of May 14, 1996;

II - the proposition of administrative proceedings for the nullity of the effects of the international registration, pursuant to articles 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, pursuant to article 112 of Law No. 9,279, of May 14, 1996;

Section IV

Validity and renewal

Art. 16. The international registration of a Brazilian designation shall be renewed every five years upon payment to the International Bureau with a maximum duration of protection in Brazil of

twenty-five (25) years, counted from the date of filing of the international registration, pursuant to Articles 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 shall be extinguished at the end of its validity, as well as the designations pending examination.

§2 Industrial design registrations resulting from the division of the designation, referred to in §1 of article 12, shall be renewed upon payment directly to the INPI, pursuant to articles 108 and 120 of Law No. 9,279, of May 14, 1996.

Section V

Annotations

Subsection I

Application

Art. 17. Requests for annotations referring to an international registration designating Brazil shall be sent by the holder directly to the International Bureau.

Subsection II

Effects of annotations

Art. 18. The following annotations, when made in the international register about an international registration and applicable to Brazil as a designated contracting party, will produce the same effects as an annotation made directly with INPI:

I - change of name and address of the holder;

II - change of ownership;

III - waiver of designation; and

IV - cancellation of the international registration;

§1 The annotation provided for in item II shall take effect in Brazil only if accompanied by supporting documentation.

§2 Within 6 (six) months from the notification, based on article 16(2) of the Geneva Act, INPI may inform 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 presentation of an appeal against said decision.

§3 INPI shall communicate to the International Bureau 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 Brazilian designation or the renunciation of registration in the country.

Section VI

Resources and demonstrations

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

Art. 20. There will be no appeal:

I – to the declaration granting protection; and

II – to the refusal referred to in items I and II of §1 of article 10.

Section VII

Corrections

Art. 21. When the International Bureau does not request a rectification relating to an international registration, INPI may re-examine the designation.

Sole paragraph. INPI may send to the International Bureau, within 6 (six) months from the receipt of the notification of rectification, a refusal of the protection resulting from the review, and the validation or annulment of the acts may occur, respecting the acquired rights of third parties.

Art. 22. The designation shall be deemed non-existent when the INPI is not required by the International Bureau to rectify that:

I - the international registration does not designate Brazil;

II - there was no payment of the individual fee related to the Brazilian designation; or

III - the Brazilian designation should not be considered.

CHAPTER III

GENERAL PROVISIONS

Art. 23. INPI shall republish, in its official means of communication, the information relating to international registrations having effect in Brazil, published by the International Bureau, at no cost to the holder of the international registration.

Art. 24. Unless expressly provided otherwise, the deadlines established in this Ordinance are continuous and counted alongside the first day after publication in the official communication of INPI.

CHAPTER IV

VALIDITY

Art. 25. This Ordinance takes effect on August 1, 2023.

JULIO CESAR CASTELO BRANCO REIS MOREIRA

Substitute President

Personnel Ordinance No. 1, of 01/17/2023 - DOU of 01/18/2023