

ENGLISH VERSION TRANSLATED BY OUTSOURCED TRANSLATION
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Trademark Manual

Office of Trademarks, Industrial Designs, and
Geographical Indications of the Brazilian Patent and
Trademark Office – INPI

3rd Edition

1st review
(10/2/2019)

Chapter 11 Madrid Protocol

This manual represents the correction of the rules and guidelines of different origins: Guidelines for Trademark Analysis, Manual of Trademark Analysis Procedures, User Manual for the E-Marcas System, User Manual for Submission of Applications and Petitions in Hard Copies, Regulatory opinions, resolutions and regulatory instructions, Technical Notes, Implicit procedures used in the routine of trademark examination. The gathering of such sources in a single structure entailed reorganizing the content, including adjusting the formal nature, the addition, and the edition of excerpts in the text.

THIS TEXT DOES NOT REPLACE THE PUBLICATION IN INPI'S PORTAL

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11 Madrid Protocol

The Madrid Protocol is an international treaty that enables trademark filing and registration in over 120 countries. The treaty, managed by the World Intellectual Property Organization – WIPO, was adopted on June 27, 1989.

Brazil's joinder agreement to the Madrid Protocol was signed by the President of the Republic on June 25, 2019 and filed with WIPO on July 2, 2019. The Protocol becomes effective three months after accession, pursuant to article 14(4)(b) of the treaty.

This means that, as of October 2, 2019, Brazil may act as the Office of origin and as designated Contracting Party, sending and receiving international applications within the scope of the Protocol. The procedures adopted by INPI in both situations are detailed in this chapter of the Trademark Manual.

For further details on the general aspects of the procedures, such as the substantive examination, please consult other relevant chapters of the Trademark Manual.

The following rules are applicable to the examination of international applications:

- The **Protocol relating to the Madrid agreement concerning the international registration of marks**

The Madrid Protocol outlines the general steps of the processing of international applications and defines entitlement criteria for the filing by such means. The version in Portuguese of the treaty may be accessed in the **References**.

- The **Common Regulations under the Madrid Protocol**

The Common Regulations regulate and complement the Madrid Protocol through operational rules including the form, the conditions, and the deadlines for the performance of acts. The version in Portuguese of the Common Regulations may be accessed in the References.

- The **Legislative Decree No. 98/2019**

Legislative Decree No. 98/2019 changes the Madrid Protocol and the Common Regulations into national legal rules and specifies, among others, statements regarding periods, individual fees and languages applicable to the international applications and registrations.

- INPI/PR Resolution No 247/2019

INPI/PR Resolution No 247/2019 provides for the registration of a trademark within the scope of the Madrid Protocol and applies the practices to the context of national laws and regulations.

- Law No. 9,279 of May 14, 1996

The Industrial Property Law (LPI) regulates the rights and obligations related to Industrial Property in Brazil.

11.1 Overview

The Madrid Protocol aims at facilitating, for applicants, filing and management of applications for registration of marks in several countries, through centralized management of these registrations. The applicants may seek protection for their trademarks in several countries by filing one single international application form, in only one language, and with centralized payment of fees.

In order to do so, the interested parties send an international trademark application to the International Bureau (IB) – an entity managed by the World Intellectual Property Organization – WIPO.

The international application is mandatorily filed with the IB through an Office of origin (in Brazil, INPI) and must be based on one or more active applications or registrations in the Office of origin. The international application must only contain goods and services within the scope of this/these basic application(s) or registration(s). In the international application, the holders must designate the Contracting Parties for which they desire to obtain extension of protection for the mark (designated Contracting Parties).

The Office of origin will proceed with the certification of the international application, and, during this stage, the information in INPI's database is compared to the information provided by the applicants. Upon receipt of the international application by the IB and its favorable decision, the application becomes an international registration which is forwarded to the designated Contracting Parties. Note that, although the international registration allows centralized management of the information related to the designated Contracting Parties, it has no effects related thereto whatsoever.

From this moment on, the designation is received by the designated Contracting Parties and will be examined as an application filed directly with the Offices of such parties, based on local laws and regulations and within the time limit stipulated by the Protocol. The designation may be granted or refused upon analysis by the local Office. If there is no refusal within the stipulated term, the application is considered tacitly granted.

Once the mark is registered in the International Register, a collection of data related to the international registrations maintained by the IB, the holder of this registration may designate, at any time, other Contracting Parties through a subsequent designation.

Within the context of the Protocol, INPI may act: (a) as Office of origin, receiving and forwarding international applications to the IB; or (b) as designated Contracting Party, when the holder of an international registration seeks protection of their trademark in Brazil.

11.2 International applications originated in Brazil

11.2.1 How to prepare an international application

The international applications must be based on an application or registration filed directly with INPI. Therefore, in order to file an international application with INPI, the applicant must hold a national application or registration, which will be used as a basic application or registration for the international application.

It is important to note that the applicant who wishes to apply for an international application must comply with the provisions of item **11.2.2.1 Entitlement to file an international application with INPI**.

According to INPI/PR Resolution No. 247/2019, any application related to trademark registration within the scope of the Madrid Protocol **must take place by electronic means only (e-Marcas system), except in situations where prolonged unavailability of the electronic means causes a material damage in the preservation of rights.**

In this section, it is possible to find necessary information to file international applications and the protocol of petitions related to these applications, in addition to instructions about following up on them.

11.2.1.1 Registration in e-INPI

The first step to file an international trademark application or a petition related thereto is the registration in the e-INPI system, which enables access to the services of the Office of Trademarks, Industrial Designs, and Geographical Indications.

This registration is mandatory for all individuals and legal entities who want to apply for INPI services, and it works for all offices in the Institute. The interested party itself or its attorney, legal representative, or industrial property agent (IPA) may register an electronic identification, composed of login and password, in order to allow its access to the system.

Detailed information about registration in the e-INPI system can be found in item **3.1 Registration in e-INPI**.

11.2.1.2 Payments

The applicant for an international application must pay fees both to INPI and to the International Bureau.

Payments to the International Bureau

With respect to the payments due to the International Bureau, we highlight that the applicant of the international application is responsible for calculating the amount to be paid, as well as for filling the applicable forms and for informing the payment method. Any proceeding related to such payments must be made with the International Bureau itself.

It is recommended that the applicant pay the fees to the International Bureau before filing an international application through INPI in order to avoid notifications of irregularities regarding payment issued by the International Bureau.

For an overview of basic, complementary, supplementary, and individual amounts, the applicant should refer to WIPO's Schedule of Fees, available at:

<https://www.wipo.int/madrid/en/fees/sched.html> (English)

<https://www.wipo.int/madrid/es/fees/sched.html> (Spanish)

It is important to highlight that all fees payable to the WIPO must be paid in Swiss francs. The International Bureau also provides a Fee Calculator, available at:

<https://www.wipo.int/madrid/en/fees/calculator.jsp> (English)

<https://www.wipo.int/madrid/es/fees/calculator.jsp> (Spanish)

The results of the Fee Calculator are based on information provided by the applicant (such as the indication that the mark is colored, for example) and by WIPO Fee Schedule in effect at the moment the estimate is generated. Thus, in order to obtain the most accurate estimate, it is recommended to consult to the Fee Calculator immediately before filing an application.

The fees payable related to an international application within the scope of the Madrid Protocol include:

- A basic fee;
- A complementary fee for each designated Contracting Party;
- In case of more than three classes of goods and services, a supplementary fee for each additional class; and
- An individual fee for the designated Contracting Parties that chose to receive it, as a replacement for the complementary and supplementary fees.

Pursuant to article 8(7) of the Madrid Protocol, the designated Contracting Parties may choose to receive, instead of a portion of the complementary and supplementary fees, an individual fee. In order to confirm whether a Contracting Party chose the individual fee and the amount of such fee, the list of Individual Fees, available at the links below, should be consulted:

https://www.wipo.int/madrid/en/fees/ind_taxes.html (English)

https://www.wipo.int/madrid/es/fees/ind_taxes.html (Spanish)

Failure to fully pay the fees will result in the issuance of a notice of irregularity by the International Bureau. The notification includes a deadline for the applicant to make the payment, under penalty of having the application deemed abandoned.

Payments to INPI

The fee payable to INPI refers to the service of certification of the international application and filing with the International Bureau or the processing of petitions related to international applications.

Payments to INPI should be collected through a Federal Government Payment Form (GRU)

The schedule of fees for services provided by the Office of Trademarks, Industrial Designs, and Geographical Indications is available at [INPI's portal](#), and users should consult it before filing the international application or the petition related to such application in order to check the amounts of each service.

Issuance and payment of the GRU:

Upon registering in the [e-INPI](#) system, the user must access the GRU module in order to issue the Federal Government Payment Form related to the service requested to the Office of Trademarks, Industrial Designs, and Geographical Indications.

In case of issuance of a GRU related to the filing of an international trademark application (service code No. **3004**), there should be indicated only one of the basic applications or registrations. The other basic applications or registrations, if any, must be indicated when completing the international application form, in the e-Marcas system. The number of classes to be informed in the filing of the international application must also be indicated.

In case of issuance of a GRU related to other petitions concerning an international application, the number of the petition corresponding to the filing of the international application must be indicated.

The user must pay the GRU before sending the international application form or petitions related thereto before sending the international application form or petitions related thereto, under penalty of the application being deemed nonexistent and the petitions being deemed ignored.

Detailed information about issuance and payment of the GRU can be found in items **3.3 Issuance of the GRU** and **3.4 Payment of the GRU**.

11.2.1.3 Electronic petition using the e-Marcas

Access to the electronic form

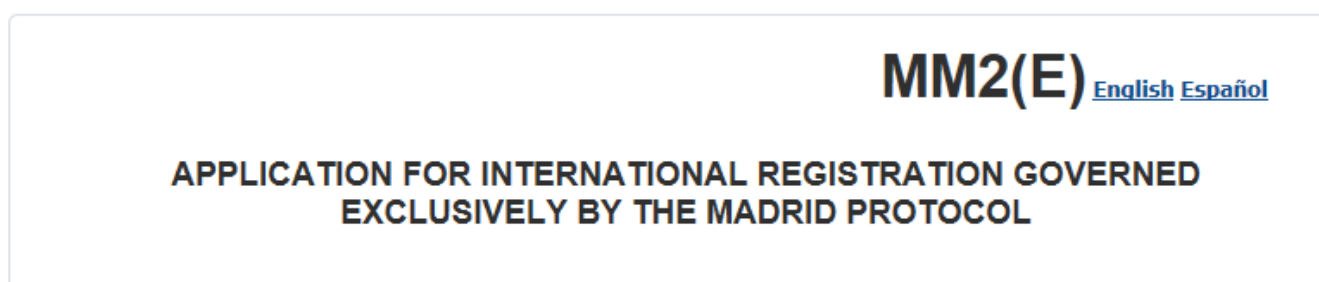
The user will have access to the electronic form when he/she joins the [e-Marcas](#), entering his/her login and password and clicking on **Acessar**. In the system, the user must enter the number of the duly paid GRU (also referred to as “nosso número”) in the corresponding field, clicking, then, on **Avançar**.

Detailed information about the access to the electronic form can be found in item **3.5.1 Access to the electronic form**.

Completing the electronic form

Once the user has entered the GRU number in the proper field, he/she has access to the international application electronic form. In the form, not only information related to the applicant and the representative (if the latter is the one completing the form) is migrated from the GRU, but also some data related to the basic application or registration indicated in the issuance of the GRU: file number, date of filing, date of grant, and mark representation.

The electronic form **Certificate of International application for transmission to the International Bureau (Article 2 - Madrid Protocol)** must be completed either in Spanish or in English. The user may change the language he/she wishes to fill it in by clicking on the icons in the upper right corner of the page of the form, according to the following figure.



Instructions for completing the electronic form:

The electronic form for filing an international application for trademark registration is divided into modules:

Modules		The module refers to
Spanish	English	
Solicitud de Base o Registro de Base	Basic Application or Basic Registration	Basic Application or Basic Registration
Solicitante y Derecho a Presentar la Solicitud	Applicant and Entitlement to File	Applicant and Entitlement to File
Información de correspondencia de la OMPI	WIPO Correspondence Information	WIPO Correspondence Information
Mandatario ante la OMPI	WIPO Representative	WIPO Representative


Partes Contratantes Designadas	Designated Contracting Parties	Designated Contracting Parties
Detalles de la marca internacional	International Mark Details	International Mark Details
Productos y servicios	Goods and Services	Goods and services
Prioridades	Priorities	Priorities
Cálculo de tasas	Fee Calculation	Fee Calculation

Solicitud de Base o Registro de Base / Basic Application or Basic Registration:

In this module, the user must enter information related to the applications or registrations that will be used as a basis for the international application.

Initially, the form will include only the basic application or registration indicated upon issuance of the GRU. The user may add new basic applications or registrations by clicking on **Añadir Solicitud o Registro de Base / Add Basic Application or Registration**.

BASIC APPLICATION OR BASIC REGISTRATION

Application / Registration number	Filing date	Registration date	Mark representation	File status
111111111 ✓	12/09/2016	24/07/2018		Registro de marca em vigor

In case the user chooses to add new basic applications or registrations, the system will open a new window where the user must inform the number of the application or registration that he/she wishes to include as a basis for the international application.

In this new window, the user may also access the **BuscaWeb** system by clicking on the available link, in order to search for information about the basic applications or registrations, before he/she includes them in the international application.

In order to enter a new application or registration in the list of basic applications and registrations, the user must inform the file number in the field **Número / File number** and click on **Buscar / Search**.

Add Basic Application or Registration

Search Mark (BuscaWeb)

File Number:

22222222

Search

Import

The following information related to the indicated application or registration will be displayed so that the applicant may check it:

Information		The information refers to
Spanish	English	
Número de la solicitud o registro de base	Application / Registration number	Application/Registration number
Fecha de la solicitud o registro de base	Filing date	Filing date of the application/registration
Fecha del registro de base	Registration date	Date of grant of the registration, if applicable
Representación de la marca	Mark representation	Mark representation
Situación	File status	File status
Titular	Holder	Holder of the application/registration

Once the user has confirmed the data related to the selected application or registration, he/she must click on **Importar / Import** to add the informed application or registration to the list of basic applications or registrations.

✕

Add Basic Application or Registration

[Search Mark \(BuscaWeb\)](#)

File Number:

22222222

Search

Application / Registration number: 22222222


Filing date: 12/09/2016

Registration date: 24/07/2018

Mark representation: Allabaster construction

File status: Registro de marca em vigor

Holder: USUÁRIO TESTE



Allabaster
construction

Import

Note: the application or registration indicated upon issuance of the GRU cannot be removed from the list of basic applications and registrations. Moreover, it is worth mentioning that there must be a correspondence between the mark submitted in the international application and the mark(s) included in the basic application(s) or registration(s), according to the **certification requirements** described in item **11.2.2.2 Certification stage**.

Solicitante y Derecho a Presentar la Solicitud / Applicant and Entitlement to File:

This module includes data of the applicant(s) of the international application.

Only the applicant's data (Name, Individual Taxpayer's Register (CPF)/National Corporate Taxpayers Register (CNPJ), Address, City, Zip Code, and Country) which had been indicated upon issuance of the GRU will be migrated into the form, even if the basic application or registration is under a co-ownership system. This data may be amended, except for the CPF/CNPJ, by clicking on the icon for editing the applicant's data, located in the lower right corner of the image below.

APPLICANT AND ENTITLEMENT TO FILE	
<input type="button" value="Add Applicant"/>	
Name: USUÁRIO TESTE Street Address: Rua XXXXX, nº 111 Zip Code: 11111111	CNPJ: 11111111111111 City: Brasília Country: Brasil

Note that information related to the applicant's entitlement must be mandatorily indicated. Therefore, the topic **Derecho a Presentar la Solicitud / Entitlement to File**, which may be accessed by clicking on the icon for editing the applicant's data, must be filled out. The user must choose an option that describes the applicant's entitlement to file an international application for registration of trademarks.

The form also includes the option **Añadir Solicitante / Add Applicant** for the user to add new applicants to the application, as the case may be. The automatically migrated new applicants' data may be edited, except for the CPF/CNPJ.

The name(s) and address(es) of the applicant(s) indicated in the international application form must be identical to those included in the basic application(s) or registration(s), as provided for in item **11.2.2.2 Certification stage**, sub-item **Applicant's name and address**. It is recommended that the applicant updates the registration data with INPI, as required and when applicable.

The user may, optionally, inform the legal nature of the applicant(s). In order to do so, he/she must select the legal nature in the drop-down list **Seleccione la naturaleza jurídica del solicitante (opcional) / Select the legal nature of the applicant (optional)**.

-- Select the legal nature of the applicant (optional) -- ?

It is not mandatory to inform the legal nature. However, it is recommended that the legal nature is informed when it is required by the designated Contracting Parties, as it is in the case of designation of the United States.

When the user selects the legal nature **Persona Natural / Natural person**, the form will display the field **Nacionalidad del solicitante / Nationality of the applicant**, so that he/she can inform the nationality of the applicant.

Natural person
▼ ?

Nationality of the applicant:

In case the user selects the legal nature **Persona jurídica / Legal entity**, the form will display the fields **Forma jurídica de dicha persona / Legal nature of the legal entity** and **Estado (país) y, en su caso, unidad territorial dentro de ese Estado (cantón, provincia, estado, etc.), al amparo de cuya legislación se ha constituido dicha persona jurídica / State (country) and, where applicable, territorial unit within that State (canton, province, state, etc.), under the law of which the said legal entity has been organized**, so that the user may, optionally, fill out the legal nature and the country or state of the applicant, respectively. It is worth mentioning that the information on legal nature, when required by the designated Contracting Parties, must be filled out for each applicant.

Legal entity
▼ ?

Legal nature of the legal entity:

State (country) and, where applicable, territorial unit within that State (canton, province, state, etc.), under the law of which the said legal entity has been organized:

In the topic **Derecho a Presentar la Solicitud / Entitlement to File**, the user must mandatorily choose an option that describes the applicant's entitlement to file an international application for registration of trademarks. In case of co-ownership, this information must be indicated for each co-owner, separately. The rules in item **11.2.2.1 Entitlement to file an international application with INPI** must be complied with.

Entitlement to File ?

Choose the appropriate option

- ☒ The applicant is a national of Brazil.
- ☐ The applicant is domiciled in Brazil.
- ☐ The applicant has a real and effective industrial or commercial establishment in Brazil.

Upon selection of the option **El solicitante está domiciliado en Brasil / The applicant is domiciled in Brazil**, in case the address of the applicant migrated into the form is not in Brazil, the user must inform a domicile address in Brazil.

Provide a Brazil domicile address if the address of the applicant is not in Brazil.

Street Address:

City:

Country:

Zip Code:

In case the user selects the option **El solicitante tiene un establecimiento industrial o comercial real y efectivo en Brasil / The applicant has a real and effective industrial or commercial establishment in Brazil**, if the applicant's address migrated into the form is not in Brazil, the user must inform an address of an real and effective industrial or commercial establishment in Brazil.

Provide a Brazil address of the applicant's real and effective industrial or commercial establishment if the address of the applicant is not in Brazil.

Street Address:

City:

Country:

Zip Code:

Información de Correspondencia de la OMPI / WIPO Correspondence Information:

This module includes data for the International Bureau to send correspondence to the applicant. Completing this module is optional.

In the topic **Dirección para la Correspondencia / Address for correspondence**, the fields may be completed if the user does not have a representative and the correspondence address is different from the applicant's address. If the user appoints a representative for the international application, the communications will only be sent to such representative.

Address for correspondence

The fields below may be completed if you do not have a representative and the correspondence address differs to the applicant's address.

Street Address:

City:

Country:

Zip Code:

In case the user wishes to choose other means of communication with the International Bureau, the fields of the topic **Otros medios de comunicación / Other means of communication** may be completed with the information required.

Other means of communication

Telephone:

Fax:

The user must inform an e-mail in the field **Dirección de correo electrónico / E-mail address** for the communications between the International Bureau and the applicant to be made by e-mail. In case an e-mail address is provided, all communications of the International Bureau related to this international registration will be sent exclusively to this e-mail and, hence, there will be no correspondence sent by other means. Therefore, it is recommended that the user keeps his/her records updated with the International Bureau.

If you would prefer WIPO to contact you by e-mail fill in the following field.

E-mail address: ?

It is worth mentioning, also, that the tool *Madrid Portfolio Manager*, provided by WIPO to the holders of international registrations, uses the e-mail registered to gather the international applications. We suggest, therefore, that the user informs the same e-mail for his/her international registrations. You can find further information in WIPO's website:

<https://www.wipo.int/madrid/en/manage/> (English)

<https://www.wipo.int/madrid/es/manage/> (Spanish)

Note: for purposes of electronic communication, only one e-mail address is allowed to be registered for each international registration.

In the topic **Idioma preferido para la correspondencia con la OMPI / Preferred language for correspondence with WIPO**, the user may indicate only one preferred language (English, French, or Spanish) for the communications sent by the International Bureau. In case the user does not complete this field, the communications will be made by the International Bureau in the language used to complete the form.

Preferred language for correspondence with WIPO

☐ English

☐ French

☐ Spanish

Mandatario ante la OMPI / WIPO Representative:

This module contains the personal data and address of the representative that will represent the applicant before the International Bureau. In this module, whose filling is optional, only one representative may be informed.

As mentioned in the module **Información de correspondencia de la OMPI / WIPO Correspondence Information**, if the user informs data of a representative for the international application, communications will be sent only to such representative based on such data. Thus, for communications with the applicant, the International Bureau will take into account only information provided in the field related to the representative.

It is worth mentioning that, in order for communications to be made only by e-mail, the user must inform the e-mail address in the field **Dirección de correo electrónico / E-mail address**.

Note: if the user wishes to inform a representative, he/she must mandatorily fill out all fields (Name, CPF/CNPJ, Address, City, Country, and Zip Code) for personal data and address.

WIPO REPRESENTATIVE

If a representative is appointed, all WIPO communications will be sent only to that representative.

Name:

Street Address:

City:

Country:

Zip Code:

Other means of communication.

Telephone:

Fax:

If you would prefer WIPO to contact you by e-mail fill in the following field.

E-mail address: ?

Partes Contratantes Designadas/ Designated Contracting Parties:

In this module, the Contracting Parties should be designated. Completing this module is mandatory, indicating at least one designated Contracting Party.

In **Añadir las partes contratantes / Add Contracting Parties**, the user must choose a Contracting Party and click **+Añadir / +Add** to add new Contracting Parties.

DESIGNATED CONTRACTING PARTIES

(Information on the procedures in the national or regional Offices of the members of the Madrid System may be found at the following website: www.wipo.int/madrid/en/members/ipoffices_info.html. Additional information may be found in the information notices available at: www.wipo.int/madrid/en/notices/.) ?

Add contracting parties:

 Add

☐ Designate member of the Madrid System non-existent in the list of options. [\[list of members\]](#)

DESIGNATED CONTRACTING PARTIES

(Information on the procedures in the national or regional Offices of the members of the Madrid System may be found at the following website: www.wipo.int/madrid/en/members/ipoffices_info.html. Additional information may be found in the information notices available at: www.wipo.int/madrid/en/notices/.) ?

Add contracting parties:

--Select--
+ Add

✓	CA - Canada	🗑
✓	CH - Switzerland	🗑
✓	ZW - Zimbabwe	🗑

☐ Designate member of the Madrid System non-existent in the list of options. [\[list of members\]](#)

It is advisable that users search for specific information about the trademark registration with each Contracting Party. The International Bureau provides general information regarding the Contracting Parties in the website below:

<https://www.wipo.int/madrid/memberprofiles/>

The applicant should pay attention to the following guidelines:

1. The European Union designation encompasses the following Member States: Germany, Austria, Belgium, Bulgaria, Cyprus, Croatia, Denmark, Slovakia, Slovenia, Spain, Estonia, Finland, France, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxemburg, Malta, Netherlands, Poland, Portugal, the United Kingdom, Czech Republic, Romania, and Sweden.

If the European Union is designated, it is mandatory to indicate a second language, other than the one chosen in the international application before the European Union Office.

Additionally, if the applicant intends to claim the seniority of a previous mark registered in or for a Member State of the European Union, official form MM17 must be attached to the international application.

2. By designating Brunei Darussalam, Singapore, India, Ireland, Lesotho, Malawi, Mozambique, New Zealand, or the United Kingdom, the applicant represents that he/she intends that the mark is used thereby or with his/her consent in that country with respect to the goods and services specified in the application.
3. The African Regional Intellectual Property Organization designation encompasses the following Member States: Benin, Burkina Faso, Cameroon, Chad, Comoros, Congo, Ivory Coast, Gabon, Guinea, Guinea-Bissau, Equatorial Guinea, Mali, Mauritania, Niger, Central African Republic, Senegal, and Togo.
4. If the United States is designated, it is mandatory to attach official form MM18 to the international application with the statement of intention to use the mark required for this Contracting Party.

If the United States is designated, information about the legal nature of the applicant must be filled out. Thus, items related to the topic **Seleccione la naturaleza jurídica del solicitante / Select the legal nature of the applicant**, in the module **Solicitantes y Derecho a Presentar la Solicitud / Applicants and Entitlement to File**, of the electronic form, must be filled out.

5. Cuba and Japan drafted a notification pursuant to Rule 34(3)(a) of the Common Regulations. Their relevant individual fees are paid in two installments. Therefore, if Cuba or Japan are designated, only the first installment of the individual fee must be paid upon filing of this international application. The second installment must only be paid if the Administration of the Contracting Party at stake considers that the mark subject to international registration meets the requirements for protection. The date on which the second installment of the fee must be paid and the amount payable must be notified to the holder of the international registration in a further stage.
6. Saint Martin (Dutch portion) is a territory that formerly belonged to the Netherlands Antilles.
7. When BQ (Bonaire, Saint-Eustache, and Saba) is designated, protection in these territories is automatically granted (see Notification of Information No. 27/2011).

Detalles de la marca internacional / International Mark Details:

This module includes the international application trademark data. Filling out some fields in this module is mandatory.

In this portion of the form, the following non-editable fields will be presented: **Tipo de marca / Type of mark (presentation of the mark)**, **Naturaleza de la marca / Kind of mark (nature of the mark)**, **Representación de la marca / Mark representation**, and **Elementos Verbales / Verbal Elements (verbal elements of the mark)**.

INTERNATIONAL MARK DETAILS


Type of mark: ?

Figurative with word elements

Kind of mark: ?

Individual

Mark representation ? Edit ?



Verbal elements ?

Allabaster construction

For figurative marks, the field **Elementos Verbales / Verbal elements** will not be shown, as figurative marks have no verbal elements. Since the three-dimensional mark may occasionally present a verbal element, the field **Elementos Verbales / Verbal elements** will be shown when applicable. As to mixed and word marks, the field **Elementos Verbales / Verbal elements** will always show, because they mandatorily have a verbal element.

The field **Representación de la marca / Mark representation** will exhibit the image of the mark, which can be changed by the user. We point out that the international mark must correspond to the mark included in the basic application(s) or registration(s).

For three-dimensional trademarks, only one (1) image of the mark must be submitted, which can show more than one perspective.

At this point, the **requirements for certification** regarding the correspondence of the mark, included in item **11.2.2.2 Certification stage** must be met.

In order to edit this field, the user must mandatorily meet the technical specifications regarding the transmission of images through the electronic form:

Valid file format	JPG
--------------------------	-----

Minimum size	945 x 945 pixels (8 cm x 8 cm)
Minimum resolution	300 dpis
Maximum file size	2 MB

More information on the digital image of the mark can be found in item **3.5.2 Completion of the electronic form.**

In the field **Transcripción de la marca / Transliteration of the mark**, the user must insert the transliteration of the mark. Transliteration should not be confused with translation. Transliteration is a phonetic representation of the mark in Latin characters, following the phonetics of the language of the international application. When the mark consists of, or contains characters other than Latin characters, or numbers other than Arabic or Roman numerals, there must mandatorily be a transliteration for Latin characters or Arabic numerals.

Transliteration of the mark ?

Text of the mark in Latin characters

On the other hand, the check box **Las palabras contenidas en la marca pueden ser traducidas / The words contained in the mark can be translated** must be selected when the user wishes to inform the translation of the mark consisting of or containing words that can be translated. By selecting this box, the fields for translation into English, French, and Spanish will show. Translation may be provided in any of these languages, regardless of the language in which the form for international application will be completed; and it may be translated into more than one language.

☒ **The words contained in the mark can be translated.** ?

Translation in English

Translation in French

Translation in Spanish

The translation of a mark may be requested by a designated Contracting Party. As such, it is recommended that the user seek information regarding the need for completing this field

The field **Descripción voluntaria / Voluntary description** is available for the user to submit a voluntary description of the mark. Similarly to the translation, the voluntary description may be requested by a designated Contracting Party, such as, for example, the United States.

Voluntary description ?

When the user wishes to inform that he/she does not claim protection for certain elements of the mark, he/she must complete the field **Renuncia / Disclaimer**.

Disclaimer ?

In the international applications for registration of figurative marks, the form will provide the check box **La marca consiste exclusivamente en un color o en una combinación de colores como tal, sin ningún elemento figurativo / The mark consists exclusively of a colour or combination of colours as such, without any figurative element** under item **Marca de combinación de colores / Color combination Mark**, which must be checked if the user wishes to inform that the mark is exclusively composed of a color or a combination of colors, with no figurative elements.

Color combination Mark

- ☐ The mark consists exclusively of a colour or combination of colours as such, without any figurative element.

When the user considers that color(s) is(are) an integral or essential part of the mark, the field **Reivindicación de colores / Color(s) claimed** must be completed with information on the color(s) claimed for the mark. For certain designated Contracting Parties, the fact that the reproduction of the mark is colored will automatically require that the color(s) can be expressly claimed. It is advisable that users who seek protection for a colored mark complete this field.

Color(s) claimed ?

The field **Indicación de color(es) / Color(s) indication** may be used to indicate, for each color, the main portions of the mark in such color(s).

Color(s) indication ?

When the user checks the item **Marca de combinación de colores / Color combination Mark**, he/she must mandatorily claim the colors in the field **Reivindicación de colores / Color(s) claimed**. Accordingly, when the user checks the item **Indicación de color(es) / Color(s) indication**, he/she must mandatorily claim the colors in the field **Reivindicación de colores / Color(s) claimed**.

Productos y servicios / Goods and Services:

This module contains data on the specification of goods and services, including any restrictions to be applied regarding any Contracting Parties designated. Completing this module is mandatory.

The item **Productos y servicios contenidos en la(s) solicitud(es) / registro(s) de base [solamente para referencia] / Goods and services contained in the basic application(s)/registration(s) [for reference only]** will inform the list of goods and services included in the basic application or registration.

GOODS AND SERVICES			
Goods and services contained in the basic application(s)/registration(s) [for reference only] ?			
Application/Registration Number	Classes	Goods and Services	Class Status ?
911612785	NCL (10) 42	Serviços científicos e tecnológicos, pesquisa e desenho relacionados a estes; serviços de análise industrial e pesquisa; concepção, projeto e desenvolvimento de hardware e software de computador; serviços jurídicos.	Registro de marca em vigor

It is worth mentioning that the list of goods and services claimed in the international application may be more restrictive regarding the goods and services included in the basic applications or registrations. However, such list cannot be more comprehensive or contain different goods and services. This does not mean that the exact same terms should be used. However, the terms used in the international application should be equivalent to or within the scope of the ones used in the basic application(s) or registration(s).

In the item **Productos y servicios de la solicitud internacional / International Application goods and services**, the user can freely complete the specification of goods and services of the international application. In order to do so,

the user must click **Añadir / Add**, thus opening a new window to inform the class and specification of goods and services of the international application.

The user must pay attention to the number of classes added to the international application, since the number of classes should correspond to the one informed when the GRU is issued. This information is available in the field **Número de clases solicitadas / Number of classes required**.

International Application goods and services ?
 Number of classes required: 2

Add

In the window **Agregar productos y servicios / Add goods and services**, the user may indicate, in the field **Número de la clase / Class number**, the number of the class and, in the field **Indicación de productos y servicios / Indication of goods and services**, the goods and services, subsequently clicking **+Salvar / +Save**.

Add goods and services



Class number: 42

Indication of goods and services ?

Legal services; Development of computer software.

Save

Cancel

It is worth mentioning that some guidelines may be followed in order to avoid notification of potential irregularities concerning the indication or classification of goods and services:

- The indicated items must mandatorily be separated by a semi-colon;
- The goods and services must be indicated in accurate terms, preferably using the words included in the International Classification of Goods and Services for purposes of registration of trademarks (Nice Classification); and

- The heading of each class will be accepted by the International Bureau, but not necessarily by the designated Contracting Parties. The indication “all goods in class 9”, for example, will not be accepted by the International Bureau.

Other information on the indications of goods and services accepted by the International Bureau can be found in the Madrid Goods & Services Manager (MGS) system database, available at:

<https://webaccess.wipo.int/mgs/> (Portuguese)

<https://webaccess.wipo.int/mgs/?lang=en> (English)

<https://webaccess.wipo.int/mgs/?lang=es> (Spanish)

The module **Productos y servicios / Goods and Services** also enables the restriction of the specification of goods and services with respect to one or more designated Contracting Parties. In order to do so, in the topic **Limitación(es) de la lista de productos y servicios / Limitation(s) of the List of Goods and Services**, the user must check the box **El solicitante desea limitar la lista de productos y servicios con respecto a una o más Partes Contratantes designadas / The applicant wishes to limit the list of goods and services in respect of one or more designated Contracting Parties**.

Limitation(s) of the List of Goods and Services ?

☐ The applicant wishes to limit the list of goods and services in respect of one or more designated Contracting Parties.

Once the option is checked, the user must select the designated Contracting Parties affected by the restriction and click **Añadir / Add**.

Designated Contracting Parties affected by the limitation :

Then, the user must inform the classes and the goods and services for which protection is sought in relation to the Contracting Parties selected. In the example below, protection for legal services is being sought in the United States.

Add limitation

Designated Contracting Parties affected by the limitation :
US - United States of America
Add

US - United States of America
X

NCL(42)
☒
Legal services;

Save
Cancel

Notes:

A restriction to the list of goods and services is effectively a reduction in the scope of the protection, in terms of the list of goods and services, with respect to certain designated Contracting Party(ies).

It will not be possible to indicate more than one restriction for the same designated Contracting Party.

Prioridades / Priorities:

This module contains data on claimed unionist priority(ies) in the international application. Filling this module is optional.

In case of interest in claiming unionist priority(ies), the user must check the box **El solicitante desea reivindicar la prioridad de una solicitud anterior/ The applicant wishes to claim priority of an earlier filing**.

PRIORITIES

☐ The applicant wishes to claim priority of an earlier filing. ?

When the option for claimed priority option is checked, the user must inform the priority data by clicking **Añadir Prioridad / Add Priority**.

PRIORITIES

☒ The applicant wishes to claim priority of an earlier filing. ?

Filing Office	Filing Number	Filing Date	Classes Number	Good and Services
Add Priority				

It will be necessary to enter the priority data in the fields in the fields **Fecha de la solicitud / Filing Date** (date of filing), **Número de la solicitud / Filing Number** (process number), and **Oficina en que se efectuó la solicitud / Filing Office** (country or organization with which the application was filed).

Add Priority
✕

Filing Date

mm/dd/aaaa

Filing Number

Filing Office

▼

During the filling out of the priority data, the user must indicate the classes and items of the specification related to the priority claimed in the topic **La reivindicación de prioridad se refiere a / The priority claimed relates to**. If the user wants the priority to cover all classes, he/she must click **Todas las clases / Mark all**. If the user wishes to restrict the priority to some classes and items in the specification, the user must select the class(es) specified and indicate the items of the specification for which he/she wishes to claim priority. Then, he/she must click **Salvar / Save**. Then, he/she must click **Salvar / Save**.

Add Priority
✕

Filing Date

mm/dd/aaaa

Filing Number

Filing Office

▼

The priority claimed relates to:

☐ **All Classes**

Classes Number

42

Good and Services

Legal services;

Save

It is possible to claim more than one priority in the international application, and the goods and services related to each priority must be informed. It is also possible to claim priority for only some goods and services included in the international application. In this case, the goods and services for which priority is claimed must be indicated.

Note: claim of priority must not be confused with claim of seniority in case of designation of the European Union.

Cálculo de las tasas / Fee Calculation:

This module contains data on the payment of fees to the International Bureau. Non-completion of information on the payment will entail notification of irregularity by the International Bureau.

it is worth mentioning that the verification of the amounts paid to the International Bureau will be carried out exclusively by this organization.

In this portion of the form, in the topic **Cuantía de las tasas / Amount of fees**, the user must indicate the total amount of fees payable to the International Bureau in the item **Gran total (francos suizos): / Grand total: (Swiss francs)**.

FEE CALCULATION

Amount of fees

The information concerning the International fees payable to WIPO can be consulted [here](#).

Grand total (Swiss francs)

Fee Calculation

To simulate the amount payable, the user may use WIPO's Fee Calculator, available at:

www.wipo.int/madrid/en/fees/calculator.jsp (English)

www.wipo.int/madrid/es/fees/calculator.jsp (Spanish)

If the user wishes that the International Bureau debits the amount of fees payable from a checking account previously opened with WIPO, he/she must select the item **Por la presente se autoriza a la Oficina Internacional a cargar el importe de las tasas a una cuenta corriente abierta en la Oficina Internacional / The International Bureau is hereby instructed to debit the required amount of fees from a current account opened with the International Bureau**, inform the name of the holder of the current account, the number of the current account, and the name of who authorizes the debit.

- ☒ The International Bureau is hereby instructed to debit the required amount of fees from a current account opened with the International Bureau.

Holder of the account:

Account number:

Identity of the party giving instructions:

If the user has not chosen to debit the amount payable from an account previous opened with WIPO, the user must inform who is making the payment, in the item **Identidad de la parte que efectúa el pago / Identity of the party effecting the payment** of the topic **Método de pago / Payment method**, and select the payment method of choice.

Payment method

Identity of the party effecting the payment:

Select method of payment:

- ☐ Payment received and acknowledged by WIPO
- ☐ Payment made to WIPO bank account
- ☐ Payment made to WIPO postal account (within Europe only)

If the method selected is **Pago recibido y confirmado por la OMPI / Payment received and acknowledged by WIPO**, the user must inform the receipt number provided by WIPO.

Select method of payment:

- ☒ Payment received and acknowledged by WIPO
- ☐ Payment made to WIPO bank account
- ☐ Payment made to WIPO postal account (within Europe only)

WIPO receipt number:

In case the method selected is **Pago realizado a la cuenta bancaria de la OMPI / Payment made to WIPO bank account** or the method **Pago realizado a la cuenta postal de la OMPI (solo en Europa) / Payment made to WIPO**

postal account (within Europe only), the user must inform the payment identification and the payment date for the fee related to the international application.

Select method of payment:

- ☐ Payment received and acknowledged by WIPO
- ☒ Payment made to WIPO bank account
- ☐ Payment made to WIPO postal account (within Europe only)

Payment identification:

Payment date:

Additionally, WIPO accepts the payment by credit card related to the following fees:

- Correction to irregularities notified by the International Bureau;
- Designation of additional Contracting Parties after registration of the international registration; and
- Renewal of international registrations.

For more information, see the following website:

<https://www.wipo.int/finance/en/madrid.html> (English)

<https://www.wipo.int/finance/es/madrid.html> (Spanish)

<https://www.wipo.int/finance/fr/madrid.html> (French)

At the end of the form, the user may send documents attached, such as the Statement of intention to use the mark Form (MM18), the Claim of seniority Form (MM17), and the power of attorney with powers to file international applications.

11.2.2 Certification of the international application by INPI

As Office of origin, INPI is responsible for the certification of the international application, a stage during which the information included in the database of the Institute is compared to the information in the international application form completed by the applicants. Once the certification has been made by INPI, the International Bureau will receive the international application and verify its compliance. After a favorable decision, the

international application becomes an international registration, which is forwarded to the designated Contracting Parties.

The application certification stage encompasses:

- The analysis of legitimacy of the applicant;
- The analysis of requirements for certification provided for in Rule 9(5)(d) of the Common Regulations;
- The notification to applicants of any inconsistencies in the completion of the form;
- The applicants' response on the notified inconsistencies; and
- The certification of the application and submission to the International Bureau.

The actual payment of the fee related to the service of certification of the international application will be verified, and the notification of inconsistencies to complement the fee in case of under payment, shall be carried out within sixty (60) calendar days of the date of publication in *Revista da Propriedade Industrial* (INPI's Gazette), under penalty of the international application being deemed non-existent under sole paragraph of article 5 of INPI/PR Resolution No. 247/2019.

In order to complement the payment, the Federal Government Payment Form (GRU) must be issued for the service "complementação de retribuição (complement of fee)" (code **800**), making reference to the number of the previous GRU. After payment of the complement, the proof of complementary payment must be forwarded through the service of "cumprimento de exigência decorrente de exame de conformidade em petição (amendments arising from the examination of conformity of a petition)" (code **382**), referring to the petition of the corresponding international application.

The GRU for the complement must be issued in the exact amount required to complement the fee determined in the current table on the date of the protocol of the service "cumprimento de exigência decorrente de exame de conformidade em petição (amendments arising from the examination of conformity of a petition)" (code **382**).

It is highlighted that the mere payment of the GRU for the service of "complementação de retribuição" (code **800**) is not sufficient to correct the inconsistency.

11.2.2.1 Legitimacy to file the international application with INPI

Individuals or legal entities national or domiciled in Brazil or which have a real and effective industrial or commercial establishment in the Country under article 4 of INPI/PR Resolution No. 247/2019 and article 2(1)(i) of the Madrid Protocol may apply for an international registration of trademark through INPI.

In addition to being a citizen, domiciled, or having a real and effective industrial or commercial establishment in Brazil, the applicant must hold registration(s) or application(s) for the registration of national trademark(s), which will be the basis for the international application.

International applications may be filed under a co-ownership system as long as all co-owners are citizens, domiciled, or have a commercial or industrial facility in Brazil. All co-owners must equally be co-owners of the basic registration(s) or application(s) for the international applications, pursuant to Rule 8(2) of the Common Regulations of the Madrid Agreement and the Madrid Protocol.

11.2.2.2 Certification stage

Upon receiving the international application form, INPI is responsible for proceeding with the certification of the international application. INPI must sign and certify the international application, pursuant to article 3(1) of the Madrid Protocol, with Rule 9(5)(d) of the Common Regulations and article 5 of INPI/PR Resolution No. 247/2019. Certification consists in the verification of information indicated by the applicant in the international application form in comparison with information contained in the basic application(s) or registration(s) upon certification.

The international application may be based on more than one basic application or registration, notwithstanding their status, as long as they are active in INPI's database and as long as the **trademark signs** in all basic applications or registrations are equal to that included in the international application. The following applications or registrations are considered active: those that have not been finally dismissed, extinguished, cancelled, or invalidated. In such cases, the verification of the information for purposes of certification will consider the information included in all basic registrations or applications indicated in the international application form.

The following **certification requirements** will be verified:

- i. the **date of receipt** of the international application by INPI;
- ii. the **number(s) and date(s)** of the basic application(s) or registration(s) for the international application;
- iii. the **correspondence** between the **holder(s)** of the basic application(s) or registration(s) and the **applicant(s)** of the international application;
- iv. the **correspondence** between the **address(es)** of the applicant(s) and the address(es) included in the basic application(s) or registration(s);
- v. the **correspondence between the mark** presented in the international application and that/those included in the basic application(s) or registration(s);
- vi. the **correspondence between the goods and services** presented in the international application and that/those included in the basic application(s) or registration(s);

- vii. the **correspondence between** the color indication included in the international application and that/those included in the basic application(s) or registration(s), if any;
- viii. the **correspondence between the indication, if any, that the mark consists exclusively of a color or combination of colors as such, without any figurative element** made in the international application and the image of the mark included in the basic application(s) or registration(s);
- ix. the **correspondence between any indication that the mark is three-dimensional, collective, or a certification mark** made in the international application and that/those included in the basic application(s) or registration(s); and
- x. the **correspondence between the color claim** of the mark included in the basic application(s) or registration(s) and the claim made in the international application, if any.

With respect to item “vi” above, it is highlighted that the list of goods and services claimed in the international application must be contained in the list(s) of the goods and services of the basic application(s) or registration(s), and it is not necessary that the lists are identical.

INPI will verify only the **certification requirements** listed above, pursuant to Rule 9(5)(d) of the Common Regulations. The other elements of the international application, as well as the verification of the due completion of the form, do not hinder the certification of the application and will be subject to analysis by the International Bureau.

Furthermore, INPI will not carry out any verification related to payments made directly to the International Bureau, considering that the failure to pay by the applicant is an irregularity that must be assessed by the International Bureau itself during its examination.

In the filing of the international application, at least one Contracting Party must be designated, **provided that it may not be the Contracting Party where the international application was received**, that is, Brazil. Later, the holder of the international registration may carry out subsequent designations, which must be forwarded directly to the International Bureau, pursuant to art. 11 of INPI/PR Resolution No. 247/2019 and Rule 24(2)(a) of the Common Regulations.

Once the **certification requirements** have been met, INPI will forward the international application to the International Bureau and notify the user by publishing it in *Revista da Propriedade Industrial* (INPI’s Gazette).

Inconsistencies will be notified so that the applicant provides the necessary corrections in case the **certification requirements** have not been met. If the inconsistency notification is not answered within sixty (60) calendar days, the international application will be deemed non-existent. Once the inconsistency notification is answered, if the necessary corrections are not provided, the certification of the international application will be denied.

Date of receipt

The date of the international registration will be the date on which the application was filed with INPI, as long as the international application is received by the International Bureau within two (2) months of such date, pursuant to article 6 of INPI/PR Resolution No. 247/2019 and article 3(4) of the Madrid Protocol.

Pursuant to paragraph 2 of article 6 above, the certification and the sending of the international application to the International Bureau within such period will be ensured only when no inconsistencies are identified in the application; therefore, the verification of information subject to certification by the applicant before filing with INPI is recommended..

In the cases in which receipt of the international application by the International Bureau occurs after two (2) months, the date of filing will be the date on which the international application is effectively received by the International Bureau.

Numbers and dates of national applications and/or registrations

During certification, it will be verified whether the number(s) and date(s) of the basic application(s) or registration(s) listed by the applicant in the international application form refer(s) to the same trademark and the same holder(s) indicated in the international application.

Name and address of the applicant

The name(s) and address(es) of the applicant(s) indicated in the international application form must be identical to those included in the basic application(s) or registration(s). It is recommended that the applicant makes the required registration updates before INPI, as the case may be, before the filing of the international application and the address(es) provided is(are) sufficiently complete for purposes of postal communication by the International Bureau if necessary.

For the cases of co-ownership, the name and address of each co-owner must be indicated separately. Nonetheless, it is noted that any communications sent by the International Bureau will be forwarded only to the first co-owner mentioned.

Correspondence of the Trademark

In the certification, INPI will verify whether the trademark included in the international application corresponds to the trademark included in the basic application(s) or registration(s) at the moment INPI carries out the certification.

After certification, there is no obstacle for the trademark object of the basic application(s) or registration(s) to be changed if necessary, as in the cases of withdrawal of the non-registrable portion of the trademark sign. In these cases, INPI does not have to inform the International Bureau about the change in the mark.

Goods and Services

The goods and services listed in the international application must be included in the basic application(s) or registration(s), i.e., the international application may contemplate all goods and services included in the basic application(s) or registration or just a portion of these goods and services.

The expansion of goods and services included in the basic application(s) or registration(s) is not allowed, whether through the inclusion of new items, the use of broader terms in the international application, or the elimination of restrictive terms included in the basic application(s) or registration(s).

It is not necessary that the terms used in the international application be identical to the ones in the basic application(s) or registration(s), as long as they are clear and that the use of different terms does not result in the expansion of the scope of the goods and services of the basic application(s) or registration(s).

During the completion of the international application, the applicant may restrict the list of goods and services of the international application for each designated Contracting Party, and it may indicate specific goods and services per designated Contracting Party. That is, it is permitted to withdraw certain goods and services or use a more detailed wording, as long as there is no expansion of the list of main goods and services of the international application.

The goods and services must be specified by class, and it is recommended to use the terms found in the International Classification of Goods and Services for purposes of Registration of Trademarks (Nice Classification) and the Madrid Goods & Services Manager (MGS), in order to avoid notification of irregularities related to goods and services sent by the International Bureau. For more information, please refer to item **11.2.3.1 Irregularities in the international application**.

Link to access the Nice Classification:

<https://www.wipo.int/classifications/nice/en/index.html> (English)

<https://www.wipo.int/classifications/nice/es/index.html> (Spanish)

Link to access the MGS:

<https://webaccess.wipo.int/mgs/?lang=pt> (Portuguese)

<https://webaccess.wipo.int/mgs/?lang=en> (English)

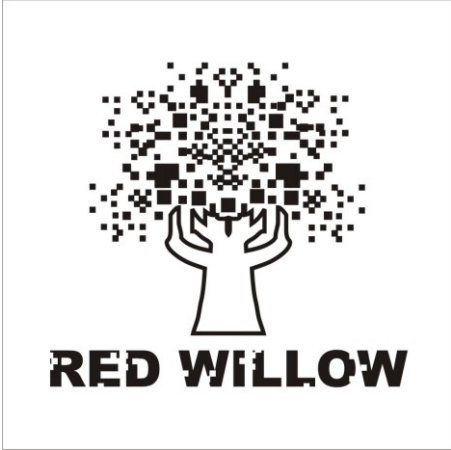

<https://webaccess.wipo.int/mgs/?lang=es> (Spanish)

Colors

The indication that the international mark consists exclusively of a color or combination of colors as such, without any figurative element, should comply with the image of the mark included in the basic application or registration.

Moreover, there will be a verification of whether the colors of the image of the mark included in the basic applications or registrations match the colors claimed in the international application. In the case of basic applications or registrations where the figure of the mark is black and white, the applicant may request the international application with color. It is important to note that the opposite is not possible, that is to say, if the basic applications or registrations are related to a colored mark, there must be a corresponding color description in the international application.

Example:

Mark in the basic application or registration	Mark in the international application	Notes
		<p>The colored mark in the international application is regarded as corresponding for purposes of certification, as the mark in the basic application or registration is black and white.</p>

After the International Bureau receives the international registration, the data related to color claims, color indications, and indications of marks composed exclusively of a color or combination of colors may not be modified in the international registration.

Three-dimensional, collective, or certification mark

The indications that the mark is three-dimensional, collective, or a certification mark included in the basic applications or registrations must match those in the international registration, and it is not possible to change it in the international registration after it is sent to the International Bureau.

Additional information

INPI will not send supporting documents attached to the International Bureau. The applicant must check the necessity and the term for sending documents directly to the Offices of each designated Contracting Party.

Only the requirements listed above will be subject to certification by INPI. Nonetheless, in addition to mandatory information, the International Bureau recommends that some information is provided in advance in order to avoid the need for future clarification. This additional information includes:

Indication of language to receive communications:

In the international application form, the applicant may indicate a preferred language (English, Spanish, or French) for the communications sent by the International Bureau. In case the applicant does not complete the corresponding field in the form, the communications will be sent by the International Bureau in the language used to complete the form.

Other information about the applicant(s):

Whenever the designated Contracting Parties require, the information related to the applicant in field 2(f) of form MM2 must be completed.

Translation of the mark:

Translation of the mark is optional, pursuant to Rule 9(4)(b)(iii) of the Common Regulations, and it may be done in the language of the form and in the other languages accepted by the International Bureau, that is to say, English, Spanish, and French. It is intended for the Office of the designated Contracting Parties, and its correction is not assessed by the Office of origin or by the International Bureau.

Transliteration of the trademark:

Unlike translation, **transliteration of a trademark is compulsory**, as the case may be, pursuant to Rule 9(4)(a)(xii) of the Common Regulations, and must be presented in the language in which the international application has been completed. Thus, when the trademark object of the international application is composed of or contains non-Latin characters or non-Arabic or non-Roman numerals, the applicant must present the transliteration to Latin characters by using the phonetic reference of the language in which the international application has been filed.

Voluntary description of the trademark:

The applicant may indicate, in the international application form, a voluntary description of the trademark.

It is possible to note that the description of the trademark must always be voluntary, since it is not a requirement of INPI for national applications or registrations of trademark.

It is recommended that the mark description is completed when it is required by the designated Contracting Parties.

Element of the mark for which protection is not claimed:

The applicant may inform that he/she is not claiming protection for certain elements of the mark. Nonetheless, it must be observed that failure to claim protection in the international application will be taken into account for all designated Contracting Parties.

Indication of a second language – Designation of the European Union:

For the cases in which the European Union is designated, a second language other than the one in the international application must be indicated.

Claim of seniority – Designation of the European Union:

Additionally, when designating the European Union, the applicant may submit the Claim of seniority by submitting the relevant form (MM17) pursuant to Rule 9(5)(g)(i) of the Common Regulations.

Statement of intention to use the mark – Designation of the United States:

For the cases in which the United States is indicated as designated Contracting Party, the applicant must submit, with the international application form (MM2), the Statement of intention to use the mark Form (MM18), which must be mandatorily in English and duly signed, pursuant to Rule 9(5)(f) of the Common Regulations.

Form MM18 may also be sent directly to the International Bureau. The applicant must pay attention to the term for submission of the form to the International Bureau.

If the Intention to use the mark form is not duly completed or sent to the International Bureau, the designation of the United States may be disregarded, pursuant to Rule 11(6)(c) of the Common Regulations.

Priority

The applicant may submit a claim of priority pursuant to Rule 9(4)(a)(iv) of the Common Regulations, informing, **through a statement in the international application form**: (1) the number of the previous application, (2) the date of filing, (3) the Office in which the registration was requested, and (4) when not applicable to all goods and services of the international application, the corresponding goods and services.

The applicant will be exclusively responsible for all information regarding priority and any irregularities and must provide clarifications directly to the International Bureau. We reiterate that data on priority are not a requirement for certification of the international application.

Within the period of priority provided for in article 4 of the Paris Convention, priority may be formed by the basic applications or registrations, or even by applications for registration of trademarks filed in other countries signatories of the Paris Convention (CUP).

The applicant may list several priorities, indicating the goods and services corresponding to each priority date. In case of priority for only certain goods and services, the applicant must indicate the goods and services that correspond to the priority claimed.

During certification, INPI will not require or analyze documents supporting the priority. Also, no priority documents will be forwarded to the International Bureau.

In cases in which the International Bureau identifies irregularities related to the dates of priorities, they will be disregarded and will not be included in the international registration. In such cases, the International Bureau will inform the applicant and INPI.

11.2.2.3 Notification of inconsistencies in the international application

During certification, whenever inconsistencies related to the **certification requirements** listed in item **11.2.2.2 Certification stage** are identified, INPI will not make changes *ex-officio*. In such cases, the inconsistencies will be notified in *Revista da Propriedade Industrial* (INPI's Gazette) so that the applicant provides the necessary corrections within sixty (60) calendar days, under penalty of the application being deemed nonexistent, pursuant to art. 5, sole paragraph, of INPI/PR Resolution No. 247/2019.

If the applicant himself/herself identifies inconsistencies in his/her international application, he/she may also request the necessary corrections, even if he/she has not been notified of inconsistencies by INPI.

In both cases, the applicant must use the “*Correção de inconsistências em certificação de pedido internacional (Regra 9 – Regulamento do Protocolo de Madri)* / Correction of inconsistencies in the certification of an international application (Rule 9 – Regulations of the Madrid Protocol)” (3005) service, make all necessary changes in the international application form (MM2), and send it back to INPI.

In order to use such service, the applicant must pay the corresponding GRU and inform the number of the petition of the international application to be corrected.

How to request the service	
Service	<i>Correção de inconsistências em certificação de pedido internacional (Regra 9 – Regulamento do Protocolo de Madri)</i> / Correction of inconsistencies in the certification of an international application (Rule 9 – Regulations of the Madrid Protocol)
Code	3005

We reiterate that, in case of inconsistencies identified in the certification stage, the two (2)-month period for the international application to be sent by INPI to the International Bureau will not be guaranteed. Nonetheless, INPI may certify and submit the international application within such period in the cases in which the inconsistencies identified are corrected by the applicant in a timely manner. In this regard, the corrections presented may be analyzed within sixty (60) calendar days pursuant to article 5, sole paragraph, of INPI/PR Resolution No. 247/2019.

When the applicant does not submit a correction of an inconsistency and a new form within sixty (60) calendar days after notification in *Revista da Propriedade Industrial* (INPI's Gazette), the application will be deemed non-existent pursuant to sole paragraph of article 5 of INPI/PR Resolution No. 247/2019.

Once the notification of inconsistency is replied, if no due corrections are promoted, the certification of the international application will be denied.

INPI will not carry out any verification as to payments made directly to the International Bureau, considering that the lack of payment by the applicant is an irregularity to be assessed by the International Bureau itself in its verification.

11.2.3 Examination by the International Bureau

After Certification, INPI will forward the international application to the International Bureau and notify the user through a publication in *Revista da Propriedade Industrial* (INPI's Gazette). Receipt of the international application by the International Bureau starts the Formal Examination of the international registration.

At this stage, the International Bureau analyzes the international application form and any forms attached (MM17 or MM18).

In cases where irregularities are identified, the International Bureau will directly and simultaneously communicate to the applicant and to INPI, regardless of who is responsible for the correction of the irregularity.

It is possible to note that, within the scope of the Madrid Protocol the term “notify” is used to refer to the communication sent by the International Bureau to the party responsible for the correction of the irregularity, and the term “inform” is reserved for the communication sent to the party with no obligation to reply.

Depending on the type of irregularity identified by the International Bureau, if it is not corrected within the specified term, the application will be deemed abandoned.

When there are no irregularities or after those are corrected, the International Bureau will promote the relevant registration in the International Register and communicate the fact to INPI, to the designated parties and to applicants.

11.2.3.1 Irregularities in the international application

During the Formal Examination of the international registration by the International Bureau, three (3) types of irregularities may be identified:

- i. Irregularities in the Classification of Goods and Services;
- ii. Irregularities in the Indication of Goods and Services;
- iii. Other irregularities.

The “Examination guidelines concerning the classification of goods and services” is available in WIPO’s website, and it aims at informing users and Offices of origin about the practices of the International Bureau, assisting users in completing the international application form, in addition to increasing the predictability of the analysis of classification by the International Bureau and the consistency of the classification among different Offices of the Contracting Parties. This guide can be found in the link below:

https://www.wipo.int/madrid/en/how_to/file/file.html (English)

https://www.wipo.int/madrid/es/how_to/file/file.html (Spanish)

When communicating INPI about an irregularity, the International Bureau will specify the type of irregularity, the remedy therefor, and the applicable term, in addition to indicating the person responsible for the correction (INPI or the applicant).

Pursuant to article 8 of INPI/PR Resolution No. 247/2019, when the applicant is directly notified by the International Bureau about an irregularity in the international application, he/she will be responsible for promoting the due corrections before the International Bureau. **Therefore, it is highlighted that, in the event of an irregularity that may be corrected both by the applicant and by INPI, the applicant will be responsible for promoting the due corrections before the International Bureau.**

Irregularities in the Classification of Goods and Services

The irregularities in the Classification of goods and services are provided for in Rule 12 of the Common Regulations and are related to the grouping of goods and services submitted to the International Bureau according to the appropriate classes of the International Classification of Goods and Services in effect on the date of filing of the international application.

When the International Bureau understands that the goods and services listed are in classes other than those indicated in the international application, it will inform the applicant and notify INPI, also pointing out any need for payment of an additional amount when the goods and services listed belong to a number of classes higher than the one indicated in the international application pursuant to Rule 12 (1)(b) of the Common Regulations.

The final decision as to the classification of goods and services in the international registration will be rendered by the International Bureau.

Responses on the irregularities in the classification of goods and services must be sent exclusively by INPI within three (3) months of the notification by the International Bureau, pursuant to Rule 12(2) of the Common Regulations. After two (2) months of the communication of irregularity to INPI and the user, the International Bureau will send a reminder in order to ensure that the three (3)-month period is complied with.

It is highlighted that **INPI will not express a response *ex-officio* about irregularities in the classification of goods and services**, and, upon notification by the International Bureau, it will communicate the applicant about the irregularity through a publication in *Revista da Propriedade Industrial* (INPI's Gazette). If the applicant wants to send to the International Bureau through INPI a response promoting the necessary corrections or challenging the irregularity pointed out, he/she must submit it within thirty (30) calendar days of the date of publication of the communication in *Revista da Propriedade Industrial* (INPI's Gazette). Alternatively, the applicant may choose to make the additional payment related to the inclusion of new classes, as pointed out by the International Bureau.

The responses regarding irregularities must be sent through the service “**Manifestação sobre irregularidade em pedido internacional comunicada pela Secretaria Internacional** (Opinion on irregularities in an international application communicated by the International Bureau)” (3006). The user must inform the number of the petition of the related international application and submit the petition in Spanish or English.

How to request the service	
Service	Manifestação sobre irregularidade em pedido internacional comunicada pela Secretaria Internacional (Opinion on irregularities in an international application communicated by the International Bureau)
Code	3006

If the applicant wants to make the additional payment related to the inclusion of new classes, he/she must make it directly with the International Bureau.

In case the applicant sends a response, INPI will verify whether, upon correction, the goods and services are within the scope of the basic application(s) or registration(s). If yes, INPI will sent the applicant's answer to the

International Bureau, exactly as received and without assessing whether the items are correctly classified and inform the applicant, through a publication in *Revista da Propriedade Industrial* (INPI's Gazette). If the correction expands the scope of protection in comparison to the basic application(s) or registration(s), the applicant's response will not be sent to the International Bureau and the applicant will be informed, through a publication in *Revista da Propriedade Industrial* (INPI's Gazette).

When the International Bureau informs the need for payment of an additional amount and the response is not sent to the International Bureau within the established term, such payment must be made within four (4) months of the notification of irregularity. If the payment has been made, the International Bureau will register the mark in the classes and with the specification it deems correct.

When a response is sent challenging the need for payment of an additional amount to the International Bureau and it confirms the need for an additional amount by the applicant, such payment must be made within three (3) months of the communication of such confirmation by the International Bureau.

If there is no payment, the international application will be deemed abandoned and, pursuant to Rule 12(7) and (8) of the Common Regulations, the applicant will be entitled to a reimbursement of a portion of the amount paid, which must be requested from the International Bureau.

Irregularities in the Indication of Goods and Services

The irregularities in the Indication of goods and services are set forth in Rule 13 of the Common Regulations, and are related to the cases where the International Bureau deems a certain term in the international application as overly vague for purposes of classification, incomprehensible, or linguistically incorrect.

The final decision regarding the indication of goods and services in the international registration will be made by the International Bureau.

Responses on the irregularities in the indication of goods and services must be sent exclusively by INPI within three (3) months of the notification by the International Bureau, pursuant to Rule 13(2) of the Common Regulations. It is possible to note that, unlike for irregularities in the classification of goods and services, in the case of irregularities related to the indication, the International Bureau will not send a reminder about the period for submission.

It is highlighted that **INPI will not express a response *ex-officio* about irregularities in the indication of goods and services**, and, upon notification by the International Bureau, it will communicate the applicant about the irregularity through a publication in *Revista da Propriedade Industrial* (INPI's Gazette). If the applicant wants to send to the International Bureau through INPI a response promoting the necessary corrections or challenging the irregularity pointed out, he/she must submit it within thirty (30) calendar days of the date of publication of the communication in *Revista da Propriedade Industrial* (INPI's Gazette).

The responses regarding irregularities must be sent through the service “*Manifestação sobre irregularidade em pedido internacional comunicada pela Secretaria Internacional*” (Opinion on irregularities in an international application communicated by the International Bureau)” (3006). The user must inform the number of the petition of the related international application and submit the petition in Spanish or English.

How to request the service	
Service	Opinion on irregularities in an international application communicated by the International Bureau
Code	3006

In case the applicant sends his/her response, INPI will verify whether, upon correction, the goods and services are within the scope of the basic application(s) or registration(s). If yes, INPI will sent the applicant’s answer to the International Bureau, exactly as received and without assessing whether the items are correctly classified and inform the applicant, through a publication in *Revista da Propriedade Industrial* (INPI’s Gazette). If the correction expands the scope of protection in comparison to the basic application(s) or registration(s), the applicant’s opinion will not be sent to the International Bureau and the applicant will be informed, through a publication in *Revista da Propriedade Industrial* (INPI’s Gazette).

When the response is not forwarded or accepted, the International Bureau will include an indication that the term is vague for purposes of classification – incomprehensible or linguistically incorrect, as the case may be. The International Bureau will inform INPI and the applicant.

When the response forwarded is accepted by the International Bureau, the term in the international registration will be changed.

In the cases in which the response is acceptable but results in the inadequacy to the originally indicated class, the international application will follow the steps for irregularities related to the Classification, pursuant to item **11.2.3.1 Irregularities in the international application**, sub-item **Irregularities in the Classification of Goods and Services**.

Other irregularities

In addition to the irregularities related to the classification and indication of goods and services, other irregularities may be pointed out by the International Bureau, pursuant to Rule 11 of the Common Regulations. The irregularities are usually related to ownership, image of the mark, payment of fees to the International Bureau, among others.

The term for correction of such irregularities is three (3) months and there is no reminder by the International Bureau.

Some of these irregularities must be corrected directly by the applicant, with no need for any intermediation by INPI. In these cases, communication is made directly between the notified applicant and the International Bureau, and INPI is only informed about the irregularity.

Irregularities that must be corrected by the applicant:

Among the irregularities which correction is the sole responsibility of the applicant, we emphasize the ones related to:

- Incomplete data on the applicant or representative, but enough to identify them and contact them;
- Insufficient data on the priority claimed;
- Illegible reproduction of the mark;
- Presence of any claim of colors whenever the reproduction of the mark is not colored or there is no indication of the colors claimed;
- Absence of transliteration of the mark when it includes non-Latin characters or non-Arabic numerals; and
- Non-payment or smaller payment of the fee to the International Bureau

Failure to correct the irregularities pointed out by the International Bureau entails, pursuant to Rule 11(2)(b) of the Common Regulations, the abandonment of the international application, except for irregularities related to the unionist priority(ies), which are not taken into account by the International Bureau if the correction is not made within the period established.

Irregularities that must be corrected by INPI:

The irregularities that must be corrected by INPI are listed in Rule 11(4) of the Common Regulations and are related to:

- An application that has not been presented in the correct official form or not signed by INPI;
- An irregularity regarding the applicant's entitlement requirements, namely, "to be a citizen, domiciled, or to have a company or industry in the country of origin";
- A lack or insufficiency of the following elements:

- Information that allows the identification of the applicant or representative which are sufficient to contact them;
- Indication of the applicant's relation with INPI for purposes of entitlement;
- Date and number of the basic application(s) or registration(s);
- Reproduction of the mark;
- List of goods and services;
- Indications of the designated Contracting Parties; or
- Statement of Certification by the Office of origin.

When the International Bureau notifies INPI of other irregularities in the international application, the latter will inform the applicant of the irregularity through a publication in the *Revista da Propriedade Industrial* (INPI's Gazette). If the applicant wishes to send his/her response, with INPI, about the irregularity indicated, he/she must do it within thirty (30) calendar days of the date of publication of the communication in the *Revista da Propriedade Industrial* (INPI's Gazette).

INPI will assess the applicant's response and send its answer to the International Bureau. In case no opinion is expressed within the established term, the answer will be sent to the International Bureau based on information available in INPI's database.

The responses regarding irregularities must be sent through the service "**Manifestação sobre irregularidade em pedido internacional comunicada pela Secretaria Internacional** (Opinion on irregularities in an international application communicated by the International Bureau)" (3006). The user must inform the number of the petition of the related international application and submit the petition in English or Spanish.

How to request the service	
Service	Manifestação sobre irregularidade em pedido internacional comunicada pela Secretaria Internacional (Opinion on irregularities in an international application communicated by the International Bureau)
Code	3006

When INPI sends an answer to the International Bureau about irregularities that must be corrected by this Office, the applicant will be informed through a publication in the *Revista da Propriedade Industrial* (INPI's Gazette).

11.2.3.2 Registration by the International Bureau

When, after any irregularity notifications, responses, and adjustments, the International Bureau considers that the international application is in compliance with the applicable requirements, it will attest the compliance, publish the international registration in WIPO Gazette and inform INPI, the applicant, and the designated Contracting Parties, pursuant to Rule 14(1) of the Common Regulations.

The International Bureau will send directly to the holder the certification of international registration in the language of the international application.

Upon receipt of the communication from the International Bureau, INPI will update its database with the number of the international registration.

11.2.3.3 Examination by the Offices of the designated Contracting Parties

Upon receipt of the notification of designation in an international registration, the Office of the designated Contracting Party will proceed with the examination of the mark based on its laws and regulations, and it may refuse protection in its territory or grant it in whole or in part.

11.2.4 Dependency period

11.2.4.1 Ceasing of effects of the basic application or registration

Pursuant to article 6(3) and 6(4) of the Madrid Protocol, for five (5) years after the date of the international registration, the changes in the situation of the basic application(s) or registration(s) that cease their effects, in whole or in part, affect the international registration and must be communicated to the International Bureau.

Accordingly, during this period, known as the “dependency period”, pursuant to article 9 of INPI/PR Resolution No. 247/2019, INPI will inform the International Bureau and request cancellation of the international registration in these events:

- Definitive dismissal of the basic application;
- Dismissal of the basic application due to total or partial withdrawal;
- Refusal of the basic application without filing of an appeal;
- Refusal of the basic application maintained on appeal;
- Partial approval of the basic application without filing of an appeal;
- Partial approval of the basic application maintained as an appeal;
- Invalidation of the basic registration;

- *Ex-officio* dismissal or cancellation of the basic application or registration, in whole or in part, without filing of an appeal;
- *Ex-officio* dismissal or cancellation of the basic application or registration, in whole or in part, maintained on appeal;
- Expiry of the basic registration, when not renewed;
- Expiration of the basic registration for total or partial surrender;
- Cancellation of the basic registration due to non-use, without filing of an appeal;
- Cancellation of the basic registration due to non-use, maintained on appeal;
- Expiration of the basic registration for failure to comply with the provisions in article 217.

The proceedings beginning at the dependency period and completed after such period that cease, in whole or in part, the effects of the basic application(s) or registration(s) also affect the international registration. Thus, when there is an administrative or legal proceeding filed during the dependency period but not completed before the end of such period and that may result in the ceasing of effects of the basic application(s) or registration(s), INPI will inform the International Bureau about the existence of such proceeding, as well as inform about the final situation of the basic application(s) or registration(s) after its definitive conclusion, requesting cancellation of the international registration when applicable.

In this regard, at the end of the dependency period, INPI will inform the International Bureau, for example, about any partial refusal or approval pending administrative appeal, lawsuit, or administrative proceeding for nullity, informing the final result of such proceedings in a later moment and requesting cancellation of the international registration only when applicable.

The cancellation of the international registration will also be requested for cases in which, in the event of an administrative or legal proceeding filed but not completed during the dependency period, the holder of the international application files a withdrawal or surrender of the basic application or registration after the dependency period.

The cancellation of the international registration will be requested to the International Bureau only when it becomes definitive and, especially regarding lawsuits, only after the decisions became final and unappealable.

The situations of cessation of effects in the basic application or registration will be informed to the International Bureau, and the name of the holder, the number of the international registration, the facts and decisions that affected the situation of the basic application or registration, as well as all affected and unaffected goods and services, must be indicated. Indication of the grounds for the decision is not necessary.

It is possible to note that the goods and services affected and unaffected by the cessation of effects must be informed to the International Bureau based on the list of goods and services included in the international registration, rather than based on the specification included in the basic application(s) or registration(s). When all goods and services included in a certain class are affected, there must be an indication of “all goods/services in class X”.

It is important to note that the dependency period is a single timeframe, counted starting on the date of the international registration, i.e., there will be no new dependency period in the events of subsequent designation.

11.2.4.2 Lawsuits

At the end of the dependency period, when INPI is aware of the existence of a lawsuit that may result in total or partial cessation of effects of the basic application or registration, it will inform the International Bureau.

When, after the dependency period, INPI becomes aware of the existence of a lawsuit filed during such period, it shall inform the International Bureau, regardless of the period elapsed. In this event, INPI will also communicate the International Bureau about the final decision of the lawsuit, requesting cancellation of the international registration only when applicable.

11.2.4.3 Transformation of the international registration into a national application or registration

When the international registration is cancelled as a result of the ceasing of effects of the basic application(s) or registration(s) during the dependency period, the holder of the international registration may request the transformation of an international application into a national application or registration directly with the designated Contracting Parties within three (3) months of the cancellation, pursuant to article 9 *quinquies* of the Madrid Protocol.

After the five (5)-year dependency period, the international registration and all designations become independent, and they are no longer affected by changes in the situation of the basic application(s) or registration(s).

11.2.4.4 Change in ownership during the dependency period

During the dependency period, there is no obstacle to the change in ownership of the international registration or the basic application(s) or registration(s). For the certification stage, it is essential that the applicant for the international application and the holder of the basic application(s) or registration(s) are identical. Nonetheless, once the international application is certified, it is possible to transfer the ownership.

Nonetheless, it can be observed that the international registration continues to depend on the basic application(s) or registration(s) during the dependency period, even in the event of a change in ownership to any of these application(s) or registration(s). The holder is responsible for verifying the convenience of the change in ownership,

since any cessation of effects of the basic application(s) or registration(s) will result in the cancellation of the international registration.

11.2.4.5 Communication of division of the basic application or registration

In case of division of the basic application(s) or registration(s) during the dependency period, INPI will inform the International Bureau, pursuant to article 10 of INPI/PR Resolution No. 247/2019.

This information does not affect the international registration; it only aims at the registration update referring to the basic application(s) or registration(s).

11.2.5 Requests for an international registration originated in Brazil

Renewals, subsequent designations, and recordings related to the international registration originated from Brazil must be requested by the holder directly to the International Bureau, pursuant to article 11 of INPI/PR Resolution No. 247/2019. For more information, please refer to item **11.4.2 Miscellaneous requests**.

The International Bureau provides instructions at the following addresses:

https://www.wipo.int/madrid/en/how_to/manage/ (English)

https://www.wipo.int/madrid/es/how_to/manage/ (Spanish)

Exceptionally, INPI will receive requests for change in ownership of an international registration in the event provided for in article 35 of INPI/PR Resolution No. 247/2019.

For more information, see item **11.4.2.2 Annotations**, sub-item **Change in ownership**.

11.2.6 Corrections in international applications from Brazil

The International Bureau may make corrections *ex-officio* or at the request of the holder or an Office pursuant to Rule 28 of the Common Regulations.

When the applicant or holder identifies the existence of an error in the application or the international registration, he/she may request its correction pursuant to the orientations below.

The corrections related to international applications originated from Brazil that have not yet been certified must be requested by the applicant to INPI, pursuant to article 13 of INPI/PR Resolution No. 247/2019.

When the international application has already been certified, the holder must request correction directly to the International Bureau, pursuant to article 12 of INPI/PR Resolution No. 247/2019, except for the case in which the error is attributable to INPI and affects the rights arising from the international registration.

In these events, in case of discrepancy between the international registration and the documents forwarded by INPI and if such error is attributable to the International Bureau, there must be a correction, *ex-officio* or at the

request of the interested party at any time. Nonetheless, when the error is attributable to the applicant, the holder or his/her representative, correction will not be possible. Therefore, we recommend attention in completing and submitting documents, as well as in verifying them.

When the error is attributable to INPI and affects the rights arising from the international registration, the request for correction must be submitted by INPI to the International Bureau within nine (9) months of the publication of the information subject to correction by the International Bureau. In order for the submission to be ensured within this term, the holder must request correction from INPI within seven (7) months of the publication of the information subject to correction by the International Bureau, pursuant to sole paragraph of article 12 of INPI/PR Resolution No. 247/2019.

In order to request corrections related to international applications before INPI, the holder must use the service of “Correção de dados em pedido internacional devido a falhas na certificação (Regra 28 – Regulamento do Protocolo de Madri)” (3010). The user must inform the number of the petition of the related international application and submit the petition in Portuguese.

How to request the service	
Service	Correção de dados em pedido internacional devido a falhas na certificação (Regra 28 – Regulamento do Protocolo de Madri)
Code	3010

11.3 International registrations that designate Brazil

As an office of a designated Contracting Party, INPI is responsible for examining the eligibility for registration of marks subject to designations of Brazil which, pursuant to art. 17 of INPI/PR Resolution No. 247/2019, will have the same effects as an application for trademark registration filed directly in Brazil, as of the date of designation. The marks subject to designations of Brazil will be examined pursuant to the provisions of the LPI (Brazilian IP Law), as provided for in art. 18 of INPI/PR Resolution No. 247/2019. If granted, the protection to a Designation of Brazil will be identical to one granted to a trademark registration filed directly with INPI.

11.3.1 How to prepare the application

The Designation of Brazil must be applied for directly with the International Bureau. It is worth mentioning that, during designation, the first installment of the individual fee for the Designation of Brazil must be paid to the International Bureau, and it must be calculated using the following website:

<https://www.wipo.int/madrid/en/fees/calculator.jsp> (English)

<https://www.wipo.int/madrid/es/fees/calculator.jsp> (Spanish)

<https://www.wipo.int/madrid/fr/fees/calculator.jsp> (French)

When designating Brazil for territorial extension of the protection of the international registration, the applicant must declare that he/she performs, in Brazilian territory, the activity related to the mark effectively and legally, directly or through companies that he/she controls directly or indirectly, under penalty of law, pursuant to Art. 128, Paragraph 1, of the LPI (Brazilian IP Law). Such statement is in the footnotes of the designation form, which can be found in the following website:

<https://www.wipo.int/madrid/en/forms/> (English)

<https://www.wipo.int/madrid/es/forms/> (Spanish)

<https://www.wipo.int/madrid/fr/forms/> (French)

11.3.2 Acts performed directly in INPI

When performing acts directly in INPI, the holder of an international registration domiciled abroad must appoint and maintain a representative duly identified and domiciled in the Country. The power of attorney must be submitted within sixty (60) calendar days of the performance of the act, regardless of notification or amendment, under penalty of dismissal of the petition.

The requests related to designations of Brazil submitted directly to INPI, as well as any document that follows them, must be written in Portuguese. Documents submitted in a foreign language must be followed by a simple translation.

Chapter **3 How to formulate an application for registration or petition of a trademark** contains information on all services related to an application or registration of trademark. The provisions in this chapter regarding the service to be filed with INPI must be complied with.

It is highlighted that, pursuant to sole paragraph of article 1 of Resolution No. 247/2019, the petition related to the registration of a trademark within the scope of the Madrid Protocol must be submitted exclusively electronically, except when the sustained unavailability of the system may cause relevant damages to the preservation of rights.

11.3.3 Examination

Based on an international application, the applicant may designate Contracting Parties, and the request for territorial extension of the protection of the international registration is sent to the Offices of the designated Contracting Parties.

The designations received by Brazil are subject to the conditions of examination and processing provided for in the LPI (Brazilian IP Law) and to the examination criteria described in chapter **5 Substantive examination**.

11.3.3.1 Order in examination lines

The designations received by Brazil will be organized in the same lines of applications filed directly with INPI, defined in item **5.1 Order in examination lines**.

11.3.3.2 Examination deadlines

Pursuant to the provisions of Legislative Decree No. 98 of 2019 and article 5(2)(b) of the Madrid Protocol, the deadline of eighteen (18) months for INPI to notify any refusal of the protection of the mark subject to international registration will be counted starting from the date of notification of the Designation of Brazil.

The refusal submitted within the deadline is not necessarily a final decision. Thus, INPI may notify a provisional refusal, which may be confirmed or withdrawn in the future. Therefore, the substantive examination of the Designation of Brazil must occur within eighteen (18) months of the date of designation, and all potential grounds for refusal to the protection of the mark subject to international registration must be taken into account.

If no refusal is timely notified, the extension of the protection to Brazil will be granted as provided for in article 5(5) of the Madrid Protocol, as long as the payment of the second installment of the individual fee is related to the Designation of Brazil is made. More information can be found in item **11.3.4.1 Grant of Protection**.

The events of refusal of mark protection are detailed in sub-item **Applicable notifications** in items **11.3.3.5 Substantive examination** and **11.3.3.6 Appeals**.

11.3.3.3 Formal examination

The formal examination is the stage in which the formal conditions necessary to continue the process are verified. If these conditions are met, the Designation of Brazil will be published in *Revista da Propriedade Industrial* (INPI's Gazette). Since the international registrations designating Brazil are received in a foreign language, before the publication of the application in *Revista da Propriedade Industrial* (INPI's Gazette), the following information will be translated into Portuguese:

- a) List of goods and services;
- b) List of goods and services for which there has been a claim of priority, as the case may be; and
- c) Description of three-dimensional marks, as the case may be.

After the translation of such information, there will be a formal examination, in which the following procedures must be observed.

Form of presentation

With respect to the form of presentation, it will be analyzed whether the mark was classified correctly. The following changes may occur:

a) Word marks in non-Latin characters:

If the mark is composed of words written in alphabets other than the vernacular language (as is the case of Hebrew, Cyrillic, and Arabic) or ideograms (such as Japanese and Chinese), the form of presentation will be changed to mixed or figurative, consistent with the definitions of item **2.3 Forms of presentation**. In such cases, the mark will be classified according to the International Vienna Classification.

b) Marks without classification:

In the designations arising from the international registration, only the word marks and the tridimensional marks are classified regarding the form of presentation, so the formal examination will be responsible for correctly identifying figurative and mixed marks.

If the designation is related to a mark with a different form of presentation, as in the case of sound marks, the sign will be classified as such and the merits examination will be responsible for deciding whether it is eligible for registration. In case the designation received is not related to a visually perceptible distinctive sign, the Designation of Brazil will be rejected for infringement of art. 122 of the Industrial Property Law.

Image of the Mark

It is not possible to change the image of the mark subject to a Designation of Brazil, as it must be identical to the image of the mark in the international registration. For this reason, the following situations will not give rise to formal requirements of amendment:

- a) Image sharpness issues;
- b) Presentation of duplicates or variations of the mark;
- c) Erasures in the image of the mark;
- d) Several perspectives of a three-dimensional mark in the same image.

The marks arising from the international registration which are classified, regarding the form of presentation, as word marks, are accompanied by an image with the word(s) claimed in common typology. In the stage of formal examination, these images will be removed, as well as the indications related to the International Vienna Classification, and only the verbal element of the mark will remain.

Nature

In the designations arising from the international registration, collective marks and certification marks are identified under the nature “Collective mark, certification mark, or guarantee mark,” and the formal examination will be responsible for proceeding with the correct identification of collective and certification marks.

Documents supporting priority

In the formal examination stage, documents supporting priority will not be examined, since they are not forwarded to the designated Contracting Parties.

Mandatory documents for collective marks and certification marks

If the designation received refers to a collective or certification mark, a notification of total provisional refusal of protection will be forwarded to the International Bureau, informing that the mandatory documents provided for in articles 147 and 148 of LPI (Brazilian IP Law) and described in items **5.14 Analysis of collective mark applications** and **5.15 Analysis of certification mark applications** must be submitted in Portuguese within sixty (60) calendar days of the respective publication in RPI. The examination of the designation received will be pending until such period.

The obligation to submit the documents at stake within the mentioned period is a specific requirement of the Brazilian laws and regulations. As such, they must be directly submitted to INPI through the proper electronic form (submission of documents, code **381**), according to the provisions in item **11.3.2 Acts performed directly in INPI**. Upon expiration of the period and if the documents are not submitted, the designation received by Brazil will be dismissed pursuant to sole paragraph of articles 147 and 148 of LPI (Brazilian IP Law), and a confirmation of total provisional refusal will be notified to the International Bureau.

How to request the service	
Service	Submission of documents
Code	381

Classification of goods and services

Since the International Bureau analyzes the specification of goods and services and makes the required adjustments to Nice International Classification before submitting data to the designated Contracting Parties, there will be no formal exam as to the classification of goods and services.

11.3.3.4 Publication for opposition

After formal examination, the designations will be published in *Revista da Propriedade Industrial* (INPI’s Gazette), and the sixty (60)-calendar day period for filing of oppositions starts. If an opposition is filed, the applicant will be

notified and may submit an opinion on the opposition within sixty (60) calendar days of the publication of the existence of an opposition in *Revista da Propriedade Industrial* (INPI's Gazette).

It is worth mentioning that the notification of an opposition to a Designation of Brazil will only be published in *Revista da Propriedade Industrial* (INPI's Gazette), and no communication will be sent to the holder of the international registration through the International Bureau. Therefore, it is recommended that the holder of the international registration monitor the publications in *Revista da Propriedade Industrial* (INPI's Gazette) in order to acknowledge any opposition and submit an opinion if he/she so wishes.

The opinion on the opposition must be directly submitted to INPI, and the provisions in item **11.3.2 Acts performed directly in INPI** must be complied with.

It is worth mentioning that opinions on the opposition are not mandatory. The claims submitted in the oppositions will be evaluated during the examination of the sign's eligibility for registration and, if deemed valid, will be pointed out as a legal basis for the provisional refusal notified to the International Bureau, against which the holder of the international registration may file an appeal.

The designations of Brazil for which an opposition has been filed will be analyzed based on the provisions in item **5.12 Analysis of applications with oppositions.**

11.3.3.5 Substantive examination

In the substantive examination stage, the designations received by Brazil will be examined according to the requirements related to legality, distinctiveness, veracity, and availability of the sign. Oppositions will also be examined, as well as the responses filed by the holder of the international registration, and the documents which are mandatory in view of the nature and form of presentation of the sign.

As established by art. 5(2)(a) of the Madrid Protocol, any notification related to the refusal of the protection must inform all legal bases hindering the grant of the protection of the mark.

In this regard, when a notification of provisional refusal is necessary to inform the amendment required, halt or suspension of the examination, the refusal must indicate all violations of legal provisions, listing all prior rights, if any, and the respective lists of goods and services.

After the eighteen-month term (18), no other legal provision or prior right infringement may be indicated as obstacles for registration. However, it is possible that new provisional refusals be notified, even if they indicate other provisions or prior rights, provided that such notice happens within the abovementioned term.

Analysis of the specification

The examination of the specification will not verify whether the goods and services are consistent with the classes to which they were attributed in the Nice International Classification, as the International Bureau analyzes the

specification of goods and services and makes the necessary adjustments before sending the data to the designated Contracting Parties.

However, the other criteria of item **5.4 Analysis of the specification of goods and services** are also applicable to the examination of the specification, including the amendments related to generic items and to the removal of terms equivalent to goods and services considered illegal.

The removal or change of items of the specification are a partial approval of the designation, and will be communicated through a total provisional refusal notice, pursuant to the provisions of paragraph 1 of art. 20 of INPI/PR Resolution No. 247/2019.

Analysis of legitimacy

In order to assess the legitimacy of the holder of the international registration that designates Brazil, the provisions included in item **5.5 Analysis of the applicant's legitimacy**, applicable to all owners in the events of designations as co-ownerships, must be complied with. Regarding collective and certification marks, the provisions in items **5.5.5 Collective marks** and **5.5.6 certification marks** must be complied with.

Examination of priority claims

The International Bureau does not receive or send the priority documents, and the applications arising from the Madrid Protocol are exempted from submitting them, as provided for in article 4(2) of such treaty. Therefore, priority documents will not be examined.

Analysis of the legality, distinctiveness, truthfulness, and availability of the trademark sign

All criteria detailed in items **5.8 Analysis of the requirement of legality of the trademark sign**, **5.9 Analysis of the requirement of distinctiveness of the trademark sign**, **5.10 Analysis of the requirement of truthfulness of the trademark sign**, and **5.11 Analysis of the requirement of availability of the trademark sign** are applicable to the substantive examination of the designations received.

However, no amendments will be issued for the exclusion of non-registrable elements of the trademark, since it is not possible to change the image of a designation, which should be identical to the international registration image. In these cases, a provisional refusal will be sent in order to communicate the refusal or partial approval of the designation, including the applicable legal instrument.

As to the examination of availability of the trademark sign, it is worth mentioning that, when the designation received is identical to the previous trademark registered in Brazil in the name of the same holder for the same goods and services, the provisions in article 124, item XX, of the Industrial Property Law will not apply to the designation.

Examination of designations with oppositions

All criteria detailed in item **5.12 Analysis of applications with oppositions** are applicable to the substantive examination of the designations received. Nonetheless, since it is not possible to change the image of a Designation of Brazil trademark, which should be identical to the image of the international registration trademark, withdrawal of the non-registrable portion of the mark will not be accepted, not even for defense purposes from third party's oppositions.

Examination of designations related to three-dimensional marks

In the analysis of designations received with respect to three-dimensional marks, the criteria in item **5.13 Analysis of three-dimensional mark applications** are applicable. However, note that it is not possible to change the image of Designation of Brazil trademark, since it has to be identical to the image of the mark included in the international registration. Therefore, if the designation received by Brazil refers to parts of a three-dimensional trademark, such as a bottle lid, no amendment will be issued for the shape to be presented as a whole, and the examination will continue, pursuant to all applicable rules and guidelines for eligibility for registration.

Examination of designations related to collective marks

In the examination of designations received with respect to collective marks, the criteria in item **5.14 Examination of applications related to collective marks** are applicable.

Examination of designations related to certification marks

In the examination of designations received with respect to certification marks, the criteria in item **5.15 Examination of applications related to certification marks** are applicable.

Examination of designations related to signs not visually perceptible

In case the designation received is not related to a visually perceptible distinctive sign, the Designation of Brazil will be rejected for infringement of article 122 of the Industrial Property Law.

Applicable notifications

During the substantive examination of a Designation of Brazil, the same decisions applicable to the examination of an appeal for trademark applications filed directly with INPI will be published in the *Revista da Propriedade Industrial* (INPI's Gazette). Simultaneously, the following notifications will be forwarded to the International Bureau:

Notification of total provisional refusal of protection:

The notifications of total provisional refusal, pursuant to Rule 17(1) of the Common Regulations of the Madrid Protocol, will be sent to communicate:

- a) Amendments required during examination;

- b) Discontinuation of the examination due to a lawsuit;
- c) Suspension of the examination;
- d) Decision of refusal of the designation;
- e) Decision of partial approval of the designation; or
- f) *Ex-officio* dismissal of the designation pending examination in light of the provisions of art. 135 of the LPI (Brazilian IP Law).

The total provisional refusal arising from the partial approval of the designation will inform:

- that the statement of grant of protection will only be sent after the decision issued by the administrative board of appeal concerning a possible appeal; and
- that, in case an appeal is not filed, a statement of grant of protection regarding the goods and services for which the sign was eligible for registration will be sent.

The total provisional refusal sent to notify about the suspension of examination due to a lawsuit or to prior rights pending final decision will inform the term of sixty (60) calendar days for the holder of the international registration which designates Brazil to express his/her opinion about the refusal.

Statement of grant of total protection:

The statements of approval of protection will be communicated upon grant of the designation, pursuant to Rule 18^{ter}(1) of the Common Regulations of the Madrid Protocol.

It is highlighted that the grant of the designation will take place when the sign under examination does not violate any legal provisions and satisfies the conditions for eligibility of registration set forth with respect to the entire scope of protection claimed.

Together with the statement of grant of total protection, a notification will be sent to the International Bureau for the payment of the second installment of the individual fee for the Designation of Brazil. For more information, please refer to item **11.3.4.1 Grant**.

Statement of grant of protection following a provisional refusal:

During the substantive examination of the Designation of Brazil, the statement of grant of protection following a provisional refusal will be sent pursuant to Rule 18^{ter}(2) of the Common Regulations of the Madrid Protocol, to communicate:

- a) The decision of approval of the designations, in the cases where a notification of a total provisional refusal of protection has been sent; or
- b) Confirmation of the partial approval of the designation once no appeal was filed.

Regarding item “a” above, we emphasize that the statement of grant must inform that provisional refusals previously sent have been withdrawn.

Together with the statement of grant of protection, a notification for payment of the second installment of the individual fee related to the Designation of Brazil must be sent to the International Bureau. For more information, please refer to item **11.3.4.1 Grant**.

Confirmation of total provisional refusal:

During the substantive examination of the Designation of Brazil, the notifications of confirmation of total provisional refusal will be sent pursuant to Rule 18ter(3) of the Common Regulations of the Madrid Protocol, to communicate:

- a) Definitive dismissal of the designation as a result of a failure to meet requests made by the Office;
- b) Confirmation of the decision to refuse protection to the designation once no appeal was filed; or
- c) Confirmation of the *ex-officio* dismissal of the designation pending examination pursuant to article 135 of the LPI (Brazilian IP Law) since no appeal was filed.

11.3.3.6 Appeals

The same rights to filing responses and appeals ensured to applicants of trademark applications filed directly with INPI are ensured to international registrations. Therefore, the same criteria, conditions, and remedies described in the LPI (Brazilian IP Law) and in chapter **7 Appeals and administrative processes of nullity** apply to the examination of matter. Note that the appeal must be lodged directly to INPI, pursuant to the provisions indicated in item **11.3.2 Acts performed directly in INPI**.

Analysis of the appeal

If the eighteen (18)-month period established by article 5(2)(b) of the Madrid Protocol lapsed, it will not be possible to point out, in the stage of analysis of appeal, other grounds that have not been listed in provisional refusals previously sent.

Additionally, since it is not possible to change the image of Designation of Brazil trademark, which must be identical to the international registration trademark, withdrawal of the non-registrable portion of the mark will not be accepted, even for appeal purposes.

Applicable notifications

During the examination of a Designation of Brazil, the same decisions applicable to the examination of an appeal for trademark applications filed directly with INPI will be published in *Revista da Propriedade Industrial* (INPI's Gazette). Simultaneously, the following notifications will be forwarded to the International Bureau:

Statement of grant of total protection subsequent to a notification of provisional refusal:

During the substantive examination of the Designation of Brazil, the statement of grant subsequent to a notification of provisional refusal will be sent pursuant to Rule 18^{ter}(2) of the Common Regulations of the Madrid Protocol, to communicate the total reversal of the refusal or of the partial approval of the designation, on appeal.

In these cases, the statement of grant must inform that provisional refusals previously sent have been withdrawn.

Together with the statement of grant of total protection subsequent to a notification of provisional refusal, a notification will be sent to the International Bureau for the payment of the second installment of the individual fee for the Designation of Brazil. For more information, please refer to item **11.3.4.1 Grant**.

Statement of grant of partial protection subsequent to a notification of provisional refusal:

During examination of the appeal of the Designation of Brazil, the statement of grant of protection following a provisional refusal will be sent, pursuant to Rule 18^{ter}(2) of the Common Regulations of the Madrid Protocol, in the following cases:

- a) Confirmation on appeal of the partial approval of the designation; or
- b) Partial withdrawal of refusal or partial approval of the designation on appeal.

In such cases, the statement of grant will not inform that the provisional refusals sent previously were withdrawn.

Together with the statement of grant of partial protection subsequent to a notification of provisional refusal, a notification will be sent to the International Bureau for the payment of the second installment of the individual fee for the Designation of Brazil. For more information, please refer to item **11.3.4.1 Grant**.

Confirmation of total provisional refusal:

During examination of the appeal of Designation of Brazil, the notifications of confirmation of total provisional refusal will happen, pursuant to Rule 18^{ter}(3) of the Common Regulations of the Madrid Protocol, upon the following events:

- a) Confirmation on appeal of the partial approval of the designation; or
- b) Confirmation of the *ex-officio* dismissal of the designation pending examination pursuant to article 135 of the LPI (Brazilian IP Law) since no appeal was filed.

11.3.3.7 Notification of further decisions

Once the examination of eligibility for registration of a Designation of Brazil trademark is completed, including appeals, INPI shall communicate to the International Bureau any administrative or judicial decisions that affect the protection of a Designation of Brazil, pursuant to Rule 18~~ter~~(4) of the Common Regulations of the Madrid Protocol. The communication will inform the situation of the mark and the goods and services protected in Brazil, if any.

Therefore, INPI will communicate, through a notification of subsequent decision, the following situations, among others:

- a) statement of total or partial cancellation of the designation due to non-use, pursuant to item III of art. 142 of the LPI (Brazilian IP Law), or its reversal on appeal;
- b) the statement of invalidation of a designation;
- c) the total or partial *ex-officio* cancellation of the designation, pursuant to art. 135 of the LPI (Brazilian IP Law), or its reversal on appeal; and
- d) the cancellation of the designation related to a collective or certification mark, pursuant to art. 151 of the LPI (Brazilian IP Law) of 1996.

Note that INPI will communicate further decisions that affect a Designation of Brazil even if such decision is appealable. In these cases, with total or partial grant of the appeal, INPI will communicate this new further decision to the International Bureau, informing the situation of the mark and the goods and services protected in Brazil, if any.

11.3.3.8 Irregularities in notifications

Pursuant to Rule 17(2) of the Common Regulations of the Madrid Protocol, the notifications of provisional refusal must indicate:

- a) The number of the international registration and, as the case may be, other indications that enable identification, such as the verbal elements of the mark;
- b) All legal grounds that prevent grant of the protection to the mark object of the designation;
- c) If the refusal affects all goods and services, or the goods and services affected; and
- d) The deadline for filing of an appeal or a response, as well as the conditions to do so.

Still pursuant to Rule 17(2) of the Common Regulations of the Madrid Protocol, when the grounds for refusal mention a previous registration, the following must be informed: the number of the application or registration; the dates of filing, of priority (if any), and registration (if any); the name and address of the applicant or owner; and the reproduction of prior rights and the relevant list of goods and services, which may be submitted in Portuguese.

The provisional refusals are recorded and published in WIPO Gazette. The recordal will inform whether the refers to total or partial refusal, as well as the number of classes affected.

Pursuant to Rule 18(1)(a) of the Common Regulations of the Madrid Protocol, the notification of provisional refusal will not be regarded as such if:

- a) The document does not include the number of the international registration or indications that enable identification of the international application;
- b) The document does not inform the reason(s) for the provisional refusal; or
- c) The document is submitted after the eighteen (18)-month period.

Pursuant to Rule 18(1)(b) of the Common Regulations, upon verification of any of the irregularities described, the International Bureau will not proceed with the annotation, but will send a copy of the provisional refusal to the holder of the international registration. The International Bureau will inform INPI and the applicant that the refusal has not been regarded as such. If the eighteen (18)-month period has not elapsed yet, a new notification of provisional refusal may be sent.

The provisional refusal that does not provide information on the possibility of an appeal or response, as well as the periods to do so, will not be regarded as such, unless a rectification is forwarded by INPI within two (2) months of the notification of irregularity by the International Bureau. Once the irregularity is rectified, the date of provisional refusal previously sent will be maintained, pursuant to Rule 18(1)(d) of the Common Regulations.

In case of other irregularities, the International Bureau will record the provisional refusal and invite INPI to rectify it within two (2) months, as guided by Rule 18(1)(c) of the Common Regulations.

After receipt of a notification of refusal, the holder of the international registration is entitled to the same rights of filing appeals and responses as granted to applicants for trademark registration filed directly with INPI. It is worth mentioning that the International Bureau has no say regarding the grounds for refusal, nor does it interfere with merits decisions.

11.3.4 Grant, renewal, and cancellation

11.3.4.1 Grant

When a statement of approval of the protection or a statement of grant of protection following a provisional refusal is sent to the International Bureau, INPI will send a notification for payment of the second installment of the individual fee for the Designation of Brazil, pursuant to art. 8(7) of the Madrid Protocol and to Rule 34(3)(a) of the Common Regulations. This notification will indicate that the payment must be made within sixty (60) calendar days of the publication of the grant of the designation in *Revista da Propriedade Industrial* (INPI's Gazette).

In case the payment is not made within the term set forth, the designation will be deemed abandoned, except for in case of continued processing, set forth in the Common Regulations. Additional information can be found in item

11.4.3.2 Terms with the International Bureau.

11.3.4.2 Renewal

The renewal of the international registration for Brazil, so that it continues to have effect in the country, must be applied for by the holder with the International Bureau through Form MM11. It is important to note that, for purposes of renewal, the subsequent designations of Brazil follow the period of validity of the international registration, regardless of the date on which the subsequent designation was notified or examined by INPI.

The designations of international registrations pending examination which are not renewed for Brazil at the end of their validity will be deemed abandoned, and those which have been granted will be cancelled.

The payment of the fees related to the renewal may be made in the six (6) months following the final term of the period of validity of the international registration, through payment of an additional fee, pursuant to Rule 30(1)(a) of the Common Regulations.

If the holder does not want to extend the international registration for a designated Contracting Party, the payment of the fees must be accompanied by a statement informing the International Bureau about that, pursuant to Rule 30(2)(a) of the Common Regulations.

11.3.4.3 Cancellation

The Designation of Brazil is cancelled, in whole or in part:

- a) Due to expiry of the validity of the international registration, when not renewed with respect to the Designation of Brazil;
- b) Due to the restriction to the list of goods and services regarding the Designation of Brazil;
- c) Due to the renunciation of an international registration regarding the Designation of Brazil;
- d) Due to the total or partial cancellation of the international registration; or

e) Due to cancellation for non-use.

As to item “a” above, we inform that the renewal of international applications must be requested before the International Bureau, and INPI will only cancel the designation after receiving the notification that the Designation of Brazil was not renewed, pursuant to Rule 31(4) of the Common Regulations.

Regarding item “d” above, we emphasize that, when the cancellation of the international registration has been requested by the Office of origin, the holder of the international application may request that the Designation of Brazil be transformed into a national application or registration. More information can be found in item **11.3.7 Transformation**.

Regarding item “e” above, we emphasize that the petitions for cancellation for non-use of designations of Brazil will be analyzed as provided for in item **6.5 Cancellation**. More information on restriction, relinquishment, and cancellation may be obtained in item **11.3.5 Recordals**.

11.3.5 Recordals

Pursuant to article 28 of INPI/PR Resolution No. 247/2019, the following annotations, when made in the International Register regarding an international registration and applicable to Brazil as designated Contracting Party, will produce the same effects as an annotation made directly before INPI:

- change in name and address of the owner;
- change in ownership;
- restriction to the list of goods and services;
- renunciation of designation;
- cancellation of the international registration;
- division of international applications arising from recordals of change in ownership; and
- merger of international applications, as long as it arises from a division due to the change in ownership.

11.3.5.1 Change in name and address of the owner

Upon receipt of the notification of change of name or address of the holder by the International Bureau, INPI will proceed with the applicable changes in its database, and it cannot declare that such recordal has no effects in Brazil.

The request for change in name and address of the holder regarding a Designation of Brazil must be submitted by the holder directly to the International Bureau, pursuant to article 27 of INPI/PR Resolution No. 247/2019.

More information can be found in item **11.4.2 Miscellaneous requests**.

11.3.5.2 Change in ownership

Note that the change in ownership of an international registration will only be recorded regarding a specific Contracting Party if said change is in accordance with the laws and regulations applicable to such Contracting Party.

In this context, whenever the national legal requirements are deemed not met, INPI, upon notification of a request for change in ownership, may send a statement that the change has no effects in Brazil within eighteen (18) months of the notification of annotation of change in ownership. Such statement must indicate the reasons for refusal of the annotation and the conditions for filing of an appeal, pursuant to Rule 27(4) of the Common Regulations and article 28, paragraph 1, of INPI/PR Resolution No. 247/2019.

The statement that the change in ownership has no effects in Brazil must indicate the goods and services affected.

The statement that the change in ownership does not have effects is appealable, pursuant to art. 212 of the LPI (Brazilian IP Law), within sixty (60) calendar days of the publication of the refusal of the petition in the *Revista da Propriedade Industrial* (INPI's Gazette). INPI will inform the International Bureau of the final decision about the change in ownership.

If an appeal is filed, it will be examined and INPI will inform the International Bureau of the final decision confirming or reversing, partially or totally, the previous statement.

If no appeal is filed during the abovementioned term, INPI will inform the International Bureau of the final decision confirming that the change in ownership will not have effects in Brazil.

The statement that the change in ownership does not have effects in Brazil or any final decisions with respect to this statement will be annotated in the international registration.

The provisions in art. 135 of the LPI (Brazilian IP Law) apply to the designations of Brazil. Accordingly, if the change in ownership requested is accepted, the designations of Brazil, applications, or registrations held by the assignor, for equal or similar marks regarding an identical, similar or related good or service which have not been transferred, will be dismissed or cancelled *ex-officio*. For more information, please refer to chapter **8 Transfer of rights**, item **8.7. Analysis of the petition for transfer**.

The request for recordal of change in ownership related to a Designation of Brazil must be submitted by the holder directly to the International Bureau, pursuant to art. 27 of INPI/PR Resolution No. 247/2019. Exceptionally, INPI will receive requests for recordal of change in ownership of international registration in the event set forth in art. 35 of INPI/PR Resolution No. 247/2019. More information can be found in item **11.4.2.2 Records**, sub-item **Change in ownership**.

Recordal of change in ownership in case of restriction of holder's right of disposal:

When INPI is notified of a request for change in ownership related to a Designation of Brazil where there is a recordal of limitation or **burden**, a statement that the change in ownership does not have effects in Brazil will be sent to inform the suspension of the examination of this change in ownership, until the end of such unavailability. A response about such discontinuation may be expressed within sixty (60) calendar days of its publication in *Revista da Propriedade Industrial* (INPI's Gazette).

Once the unavailability at stake is finished, INPI will examine the change in ownership and publish the decision in *Revista da Propriedade Industrial* (INPI's Gazette). After the examination of any appeals, INPI will communicate the final decision about the change in ownership to the International Bureau, fully or partially confirming or reversing the previous statement.

It is worth mentioning that, in case of suspension of the examination of change in ownership as a result of limitation or burden, INPI will only send the communication to the International Bureau after the final decision on the recordal. Therefore, it is recommended that the holder of the international registration monitors the progress through *Revista da Propriedade Industrial* (INPI's Gazette), so that he/she becomes aware of any refusal of the petition.

11.3.5.3 Limitation, Renunciation, and Cancellation

Pursuant to Rule 25(1)(a), the holder may request to the International Bureau the recordal, in the international registration, of a limitation, renunciation, or cancellation.

Limitation may affect some or all designated Contracting Parties and refers to the limitation of the list of goods and services related to these Parties.

The request for renunciation of designation affects the entire list of goods and services regarding some, but not all, the designated Contracting Parties.

The recordal of cancellation may be in whole or in part, referring to all or some goods and services, affecting the scope of protection with respect to all designated Contracting Parties.

The records of restriction to the list of goods and services, renunciation of designation, and cancellation of the international registration entail the abandonment of the Designation of Brazil that has not yet been examined, or renunciation thereof, when the protection has already been granted.

Restriction to the list of goods and services

When notified by the International Bureau about a restriction to the list of goods and services, INPI may declare that the restriction has no effects in Brazil for understanding that the change requested is not actually a restriction, but an expansion of the scope of protection, within eighteen (18) months of the notification of recordal of restriction. Such statement must indicate the reasons for refusal of the recordal and the conditions for the filing of

an appeal, pursuant to Rule 27(4) of the Common Regulations and article 28, paragraph 1, of INPI/PR Resolution No. 247/2019.

The statement that the change in ownership does not have effects is appealable, pursuant to art. 212 of the LPI (Brazilian IP Law), within sixty (60) calendar days of the publication of the rejection of the petition in the *Revista da Propriedade Industrial* (INPI's Gazette). INPI will communicate to the International Bureau the final decision regarding the restriction on the goods and services.

In case of an appeal, it will be analyzed, and INPI will communicate to the International Bureau the final decision confirming or refusing, whether in whole or in part, the previous statement.

If there is no appeal within such term, INPI will communicate to the International Bureau the final decision confirming that the restriction to the list of goods and services has no effects in Brazil.

The statement that the restriction has no effects in Brazil or any other final decision regarding such statement will be annotated in the international registration.

The request for restriction to the list of goods and services regarding a Designation of Brazil must be submitted by the holder directly to the International Bureau pursuant to article 27 of INPI/PR Resolution No. 247/2019. More information can be found in item **11.4.2 Miscellaneous requests**.

Renunciation of designation

Upon receipt of notification of renunciation of designation by the International Bureau, INPI will proceed with the proper changes in its database, and it cannot declare that such recordal has no effects in Brazil.

The request for restriction to the list of goods and services regarding a Designation of Brazil must be submitted by the holder directly to the International Bureau pursuant to article 27 of INPI/PR Resolution No. 247/2019. More information can be found in item **11.4.2 Miscellaneous requests**.

Cancellation of the international registration

When INPI receives the notification of cancellation of the international registration by the International Bureau, INPI will make the applicable changes to its database, and it may not declare that this recordal does not have effects in Brazil.

The request for cancellation of the international registration must be submitted by the holder directly to the International Bureau, pursuant to art. 27 of INPI/PR Resolution No. 247/2019. Additional information can be found in item **11.4.2 Miscellaneous requests**.

11.3.5.1 Division

When INPI receives a notification by the International Bureau about the division of international registrations resulting from an recordal of partial change in ownership, it will perform the examination of the change in ownership and, if the requirements set forth in item 11.4.2.2 Recordals, sub-item Change in ownership, are met, it will proceed with the division in its database.

It is highlighted that the division referred to in Rule 27bis(1) of the Common Regulations does not apply to Brazil.

11.3.5.2 Merger

When INPI receives a notification by the International Bureau about the merger of international registrations arising from a division resulting from a change in ownership, it will perform the examination of the change in ownership and, if the requirements set forth in item 11.4.2.2 Recordals, sub-item Change in ownership, are met, it will proceed with the merger in its database.

It is highlighted that the merger referred to in Rule 27ter(2) of the Common Regulations does not apply to Brazil.

11.3.6 Replacement recordal

As provided for in art. 4bis(2) of the Madrid Protocol, the holder of an international registration may request recordal, in the Designation of Brazil, of the *replacement* of the national registration of his/her ownership for the international registration. The following will be verified:

- Whether the national registration and the international registration are in the name of the same holder;
- Whether the protection of the international registration includes Brazil;
- Whether all products and services listed in the national registration are also listed in the international registration with respect to Brazil;
- Whether the Designation of Brazil will have effects after the date of the national registration; and
- Whether the national registration is in effect.

In case the conditions for replacement are satisfied, INPI will record the replacement in its database and inform the International Bureau. The request will be denied if the conditions are not satisfied. The decision about the replacement will be published in *Revista da Propriedade Industrial* (INPI's Gazette).

The decision refusing the replacement recordal will be appealable, pursuant to art. 212 of the LPI (Brazilian IP Law), within sixty (60) calendar days of the publication of the refusal of the request in *Revista da Propriedade Industrial* (INPI's Gazette).

If the national registration is **in an extraordinary renewal term**, the examination of the recordal will only be carried out after the end of such term or after the renewal has been paid.

11.3.7 Transformation

As provided for in art. 9 *quinquies* of the Madrid Protocol, whenever an international registration designating Brazil is cancelled in whole or in part at the request of the Office of origin, the holder of the international registration may, within three (3) months of the cancellation date in the International Register, request from INPI the *transformation* of the designation into a national application or registration of the same mark.

The transformation will be processed for all cancelled goods and services, and only in the cases where the cancellation was requested by the Office of origin.

The filing date and, if applicable, the priority date of the designation will be maintained in the processes arising from a transformation. If the designation has already been granted, the validity period of the designation will also be maintained in the registration arising from the transformation. If the designation has not been granted yet, its effectiveness will begin after the grant of the application arising from the transformation.

Acts performed with respect to the designation will be used, provided that they have been performed until the date of cancellation of the international registration. Any communications sent by INPI, but not received by the International Bureau, will be notified again, and any applicable terms will be **reopened**.

Upon having been notified by the International Bureau about the cancellation of an international registration at the request of the Office of origin, INPI will publish the cancellation of the Designation of Brazil in *Revista da Propriedade Industrial* (INPI's Gazette), informing the cancelled goods and services, as well as the term, of three (3) months of the cancellation date in the International Register, for requesting transformation of the designation.

If the transformation is not requested within such term, the total or partial cancellation or dismissal of the Designation of Brazil will be published.

If a request is made within such term, INPI will proceed with the transformation of the designation for **all cancelled goods and services**. After the transformation, the applicant may file a partial or total renunciation or withdrawal, as the case may be.

The Designation of Brazil will be transformed into a national application, if it has not been examined yet, or into a national registration, if the protection of the designation has already been granted.

The transformation application will not be accepted when it is filed after the applicable term or when it is not related to an international registration cancelled at the request of the Office of origin.

11.3.8 Correction of errors by the International Bureau

The International Bureau may correct errors *ex-officio* or at the request of the holder or an Office pursuant to Rule 28 of the Common Regulations.

Upon making the due corrections, the International Bureau will notify the holder and the Administrations of the designated Contracting Parties, pursuant to Rule 28(2) of the Common Regulations.

Pursuant to Rule 28(3) of the Common Regulations and article 32 of the INPI/PR Resolution No. 247/2019, upon being notified by the International Bureau about corrections made in an international registration designating Brazil, INPI may reexamine the Designation of Brazil, and it may annul or confirm the acts, always respecting third parties' rights.

Also pursuant to Rule 28(3) of the Common regulations, INPI may send a provisional refusal within eighteen (18) months of the date of notification, if, after the correction, the protection cannot be granted to the Designation of Brazil.

The Designation of Brazil will be deemed inexistent when INPI is notified by the International Bureau about a correction, informing that the international registration does not designate Brazil, that there has been no payment of the first installment of the individual fee, or that such designation must not be taken into account.

11.4 Means of communication, requests, deadlines, and fees

11.4.1 Means of communication

Language of communication

Pursuant to article 3 of INPI/PR Resolution No. 247/2019, the international applications originated in Brazil or the petitions and communications with respect thereto sent to the International Bureau through INPI must be in Spanish or English.

Pursuant to article 14 of INPI/PR Resolution No. 247/2019, the communications between INPI and the International Bureau, regarding a Designation of Brazil, must be in English. However, the list of goods and services regarding third parties' rights indicated in a provisional refusal may be sent in Portuguese.

Pursuant to article 15 of INPI/PR Resolution No. 247/2019, the requests regarding the designations of Brazil submitted by the holder of the international registration directly to INPI, as well as any accompanying document, must be in Portuguese. Documents submitted in a foreign language must be filed with a simple translation.

INPI's official means of communication

INPI's official means of communication is *Revista da Propriedade Industrial* (INPI's Gazette), available in the Institute's portal in PDF. The publication of *Revista da Propriedade Industrial* (INPI's Gazette) occurs every Tuesday,

except in holidays, when it is published in the first immediately subsequent business day. The publication date of the *Revista da Propriedade Industrial* (INPI's Gazette) is important, as it initiates the count of legal deadlines applicable to trademark applications, registrations, and petitions, as well as the deadlines referring to designations of Brazil.

More information can be found in item **1.2 Official means of communication**.

International Bureau's official means of communication

The International Bureau's official means of communication is WIPO Gazette, published weekly in WIPO's website, available at:

<https://www.wipo.int/madrid/monitor/en/> (English)

<https://www.wipo.int/madrid/monitor/es/> (Spanish)

<https://www.wipo.int/madrid/monitor/fr/> (French)

WIPO Gazette contains all relevant data on new international applications, renovations (renewals), designations, changes, and other occurrences that affect international application.

Additionally, WIPO Gazette contains information of general interest, such as statements and notifications submitted by the Contracting Parties within the scope of the Agreement or the Protocol or information about the days on which the International Bureau is not open to the public.

Means of protocol before INPI

Within the scope of the Madrid Protocol, any petition related to international applications originated in Brazil or designations of Brazil will be submitted electronically, except in situations in which the sustained unavailability of the electronic means causes relevant damage to the preservation of rights.

11.4.2 Miscellaneous requests

11.4.2.1 Corrections in the international registration

Whenever the applicant or holder identifies an error in the application or in the international registration, he/she may request its correction. As a general rule, the holder must request the corrections of errors related to an international application or registration directly to the International Bureau. Exceptionally, INPI will receive correction requests for the application or in the international registration from Brazil, according to guidelines provided for in item **11.2.6 Corrections in international applications from Brazil**.

In case of discrepancy between the international registration and the documents forwarded by INPI, and if such error is attributable to the International Bureau, it will be possible to correct it at the request of the interested party at any time. Nonetheless, when the error is attributable to the applicant, the holder or his/her

representative, correction will not be possible. Therefore, we recommend attention in completing and submitting documents, as well as in verifying them.

11.4.2.2 Recordals

As a general rule, the holder must request any recordals related to an international registration directly from the International Bureau. Among such recordals, attention is called to:

- change in name and address of the holder or his/her representative;
- change in ownership;
- restriction to the list of goods and services;
- renunciation of designation;
- cancellation of the international registration;
- division of the international registration; and
- merger of the international registration.

Changes in name and address of the holder or his/her representative

The holder of the international registration may request change in his/her name and address or in the name and address of his/her representative in the International Register, pursuant to Rule 25(1)(a)(iv) and (vi) of the Common Regulations.

The request for change in name and address of the holder must be submitted by the holder directly to the International Bureau, and form MM9 must be used. Note that such form must be used only to change the name or address, rather than to record change in ownership. For more information, please refer to WIPO's website:

https://www.wipo.int/madrid/en/how_to/manage/change.html (English)

https://www.wipo.int/madrid/es/how_to/manage/change.html (Spanish)

https://www.wipo.int/madrid/fr/how_to/manage/change.html (French)

The request for change in name and address of the representative must be submitted by the holder directly to the International Bureau, and optional form MM10 may be used. It is possible to note that such form may only be used for changes related to representatives who are already registered, and it must not be used to annotate a new representative.

For more information, you may see WIPO's website:

https://www.wipo.int/madrid/en/how_to/manage/representation.html (English)

https://www.wipo.int/madrid/es/how_to/manage/representation.html (Spanish)

https://www.wipo.int/madrid/fr/how_to/manage/representation.html (French)

If the request for change in name and address of the holder or of his/her representative meets the applicable requirements, the International Bureau will record the changes, with the date of receipt of the request, publish the applicable data in WIPO Gazette, notify the Offices of the designated Contracting Parties and inform the holder.

If the request for change in name and address of the holder or of his/her representative does not meet the applicable requirements, the International Bureau will notify the holder about the circumstances so that the irregularity is adjusted within three (3) months of the date of notification. If the irregularity is not adjusted within such term, the request will be deemed abandoned and any fees may be reimbursed with the proper deductions.

Change in ownership

The change in ownership of an international registration is provided for in Rule 25(1)(a)(i) of the Common Regulations and may be made with respect to all goods and services of the application or to a portion thereof. The change in ownership may also reach all designated Contracting Parties or a portion thereof.

In order for the change in ownership to be annotated by the International Bureau, the new holder must meet the requirements to file international applications, i.e., be a citizen, resident, or have an actual, effective commercial or industrial facility in the country or territory corresponding to each Contracting Party for which the change in ownership is required.

The new holder must indicate the Contracting Parties in which it meets the requirements of entitlement to be the holder of the international registration.

If the request for recordal of change in ownership does not meet the applicable requirements, the International Bureau must notify the circumstances to the holder and, if the request has been made through an Administration, to such Administration.

For more information, the holder may consult WIPO's website:

https://www.wipo.int/madrid/en/how_to/manage/ownership.html (English)

https://www.wipo.int/madrid/es/how_to/manage/ownership.html (Spanish)

https://www.wipo.int/madrid/fr/how_to/manage/ownership.html (French)

The request for recordal of change in ownership of an international registration must be submitted by the holder directly to the International Bureau. Exceptionally, INPI will receive, for purposes of forwarding to the International

Bureau, requests of recordal of change in ownership of an international registration, as long as the conditions below are cumulatively satisfied:

- I – there is an impossibility to lawfully obtain the signature of the assignor of the international registration, evidenced by an appropriate document;
- II – the assignor or assignee is an individual or legal entity, citizen or resident in Brazil or owner of a real and effective industrial or commercial establishment in the Country; and
- III – the change in ownership refers to an international registration originated in Brazil or to a designation of Brazil.

The request of referral of the recordal of change in ownership, when submitted to INPI, will be analyzed pursuant to the rules applicable to the change in ownership of national applications or registrations and, once the requirements are met, will be granted and forwarded to the International Bureau. More information on the requests applicable to the change in ownership may be found in chapter **8 Transfer of rights**.

INPI will communicate, in the Trademark Gazette the decision on forwarding to the International Bureau of the recordal of change in ownership.

How to request the service	
Service	Validation and transmission of the request of transfer of International Registration to the International Bureau (Article 9 – Madrid Protocol)
Code	3007

Restriction to the list of goods and services

The request of restriction to the list of goods and services must be submitted by the holder directly to the International Bureau, and form MM6 must be used. For more information, the holder may consult WIPO's website:

https://www.wipo.int/madrid/en/how_to/manage/limitation.html (English)

https://www.wipo.int/madrid/es/how_to/manage/limitation.html (Spanish)

https://www.wipo.int/madrid/fr/how_to/manage/limitation.html (French)

The recordal of restriction does not entail the exclusion of goods and services from the international registration; it affects only a portion of the scope of protection with respect to some or all designated Contracting Parties.

Renunciation of designation

The request for renunciation must be submitted by the holder directly to the International Bureau, and form MM7 must be used. For more information, the holder may consult WIPO's website:

https://www.wipo.int/madrid/en/how_to/manage/renunciation.html (English)

https://www.wipo.int/madrid/es/how_to/manage/renunciation.html (Spanish)

https://www.wipo.int/madrid/fr/how_to/manage/renunciation.html (French)

The request for renunciation of designation affects the entire list of goods and services regarding some, but not all, the designated Contracting Parties, and it does not entail the exclusion of these goods and services from the international registration.

Cancellation of the international registration

The request for cancellation of the international registration must be submitted by the holder directly to the International Bureau, and form MM8 must be used. For more information, the holder may consult WIPO's website:

https://www.wipo.int/madrid/en/how_to/manage/cancellation.html (English)

https://www.wipo.int/madrid/es/how_to/manage/cancellation.html (Spanish)

https://www.wipo.int/madrid/fr/how_to/manage/cancellation.html (French)

The recordal of cancellation may be total or partial, related to all or some of the goods and services, which will be removed from the international registration, affecting the protection scope for all designated Contracting Parties. Thus, cancelled goods and services may not be object of subsequent designations. Finally, we highlight that total cancellation results in the cancellation of the international registration itself.

11.4.2.3 Renewal

The request for renewal of the international registration must be submitted by the holder directly to the International Bureau, and form MM11 must be used. It is important to note that, for renewal purposes, the subsequent designations will be in force for the same validity term as the international registration.

The payment of the renewal fees may be made within six (6) months from expiry date of the international registration with the payment of an additional fee, pursuant to Rule 30(1)(a) of the Common Regulations.

If the holder does not want to renew the international registration for a designated Contracting Party, the payment of the fees must be accompanied by a statement informing the International Bureau about that, pursuant to Rule 30(2)(a) of the Common Regulations.

For more information, the holder may consult WIPO's website:

https://www.wipo.int/madrid/en/how_to/manage/renewal.html (English)

https://www.wipo.int/madrid/es/how_to/manage/renewal.html (Spanish)

https://www.wipo.int/madrid/fr/how_to/manage/renewal.html (French)

11.4.2.4 Subsequent designations

The requests for subsequent designations must be submitted by the holder directly to the International Bureau.

For more information, the holder may consult WIPO's website:

https://www.wipo.int/madrid/en/how_to/manage/designation.html (English)

https://www.wipo.int/madrid/es/how_to/manage/designation.html (Spanish)

https://www.wipo.int/madrid/fr/how_to/manage/designation.html (French)

11.4.3 Terms

11.4.3.1 Terms with INPI

The terms established in the LPI (Brazilian IP Law), as a general rule, are counted of the date of publishing in *Revista da Propriedade Industrial* (INPI's Gazette). It starts on the first business day after publication and is counted on a calendar day basis. After the time limit has elapsed, the right to perform the act is extinguished, except when a correction of term is applicable, pursuant to art. 221 of the LPI (Brazilian IP Law) and to INPI/PR Resolution No. 178/2017, due to an unexpected event, beyond the party's will, which prevents it from practicing the act.

11.4.3.2 Terms with the International Bureau

The terms for the performance of acts with the International Bureau may be counted in years, in months, or in days.

The period counted in years shall expire on the same day and month of the event from which the period starts to run, except when the period starts on February 29 and ends on a year where such date does not exist. In this case, the final date will be February 28.

The period counted in months shall expire on the day with the same number as the event from which the period starts to run, except when there is no day with the same number. In these cases, the term shall expire on the last day of that month. For example, a three (3)-month-term starting on January 31 will end on April 30.

Finally, the period counted in days will start on the day following the event which initiated the count.

As a rule, the date when a communication is sent by INPI will be considered as the date of performance of a certain act. In the cases where the international application and the notifications of refusals of protection are forwarded, the date of receipt by the International Bureau will be considered.

If the date when a communication is sent by INPI is different from the date of receipt by the International Bureau, by virtue of different time zones between INPI's headquarters and the International Bureau's headquarters, the date when the communication is forwarded will be considered, for purposes of counting the term, based on the time zone in INPI's headquarters.

Continued Processing

In the cases provided for in Rule 5*bis* of the Common Regulations, when the applicant or holder of the international registration does not meet a certain deadline with the International Bureau, he/she may request, within two (2) months from the date of expiry of that time limit the continued processing with the International Bureau.

Pursuant to Rule 5*bis* of the Common Regulations, the deadlines for which the request for continued processing is permitted are related to:

- Corrections of irregularities related to the international application to be corrected by the applicant pursuant to Rule 11(2) of the Common Regulations;
- Corrections of irregularities related to the international application to be corrected by the applicant or INPI pursuant to Rule 11(3) of the Common Regulations, regarding the payment of fee in an amount smaller than required by the International Bureau;
- Corrections of irregularities related to the requests of recordal of licenses provided for in Rule 20*bis*(2) of the Common Regulations, regarding the mandatory requirements to be included in the recordal;
- Corrections of irregularities related to subsequent designations provided for in Rule 24(5)(b) of the Common Regulations;
- Corrections of irregularities related to subsequent requests for recordals provided for in Rule 25 of the Common Regulations;
- Payment of the second installment of the individual fee (concession fee) provided for in Rule 34(3)(c)(iii) of the Common Regulations; and
- Requests for an international registration to maintain its effects on a successor State and the payment of the applicable fees provided for in Rule 39(1) of the Common Regulations.

The continued process must be requested by the holder directly to the International Bureau, through form MM20, available at

<https://www.wipo.int/madrid/en/forms/> (English)

<https://www.wipo.int/madrid/es/forms/> (Spanish)

<https://www.wipo.int/madrid/fr/forms/> (French)

The request must be accompanied by the corrections, payments or requests object of the continued processing and may only be requested after lapse of the applicable term.

When the request is received pursuant to the provisions in Rule 5*bis* of the Common Regulations, the International Bureau will proceed with the action at stake, annotate the continued processing in the international application, and notify the holder.

The request for continued processing that does not comply with the provisions in Rule 5*bis* of the Common Regulations will not be taken into account, and the International Bureau will notify the holder.

In case of continued processing of corrections of irregularities related to recordal of licenses provided for in Rule 20*bis*(2) and to the recordals provided for in Rule 25 of the Common Regulations, the recordal date will be deemed the final deadline object of the continued processing.

It is important to note that the International Bureau will only communicate non-compliance of an act after the end of the two (2)-month term for request of continued processing, when applicable. As an example, INPI will only be notified that there has not been a payment of the second installment of the individual fee related to the Designation of Brazil after the end of such term.

11.4.4 Fees

When related to the acts performed before INPI, the fees must be paid through the Federal Government Payment Form (GRU).

The fees for INPI's services are included in the Schedule of Fees, available at [INPI's Portal](#). More information can be found in item [1.7 Fees](#).

Regarding the fees paid directly to the International Bureau, it is the applicant's responsibility to calculate the amount to be paid. WIPO's Fee Calculator is available at:

www.wipo.int/madrid/en/fees/calculator.jsp (English)

www.wipo.int/madrid/es/fees/calculator.jsp (Spanish)

www.wipo.int/madrid/fr/fees/calculator.jsp (French)