
Brazil: Co-Ownership of Trademarks Now Available

By [Maritza Schaeffer](#)

One of several important changes resulting from Brazil's accession to the Madrid Protocol is the availability of co-ownership of trademarks under a new regime that came into force on September 15, 2020, under Resolution 245/2019 (the "Resolution") passed by the Brazilian Patent and Trademark Office ("BPTO"). [More](#)

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Co-ownership of trademarks is now available for national Brazilian applications as well as those filed pursuant to the Madrid Protocol, and the option applies to both new trademark filings as well as trademarks that were filed or registered before the implementation of the Resolution.

There are several relevant factors to keep in mind when practicing under the new regime, including:

- **Co-Ownership Achieved by Assignment:** Trademarks filed before the Resolution with a single owner can be amended to co-ownership by way of an assignment. Partial assignment (in which the original owner assigns only part of its specification and retains sole ownership of the remaining goods/services) will also be an option under the new measure through the filing of a divisional request, but this option will not come into effect until July 2021.
- **Non-Use Cancellations:** If a non-use cancellation action is filed against a co-owned trademark registration, proof of use by just one of the holders will suffice to maintain the registration. However, where the non-use is due to legitimate reasons, all co-owners will be required to justify the non-use during the relevant time period.

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- **Actions before the BPTO:** Responses to office actions and similar statements must be signed by all co-owners, while oppositions, administrative nullity actions, and non-use cancellation actions may be filed by only one of the owners.
 - **Priority claim:** If a co-owned trademark application filed under the new measures has a priority claim, the owners must all be identical to those in the priority application or registration. Otherwise, a priority assignment document will need to be filed with the BPTO.
 - **Conflicting Trademarks During Examination:** Identical or similar prior trademark applications or registrations with owner(s) that are not identical to the co-owners of the application under examination may be cited as obstacles during the course of examination, even if there is some overlap among owners.

While co-ownership was already available for patents, software, Industrial designs, and copyright in Brazil, the availability of co-ownership for trademarks for the first time is an important development.

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