

On the last week of 2022, BPTO published Technical Note No. 03/2022 (attached) with updates on administrative procedures for the cancellation based on the non-use of trademark registrations. ([INPI publica nota técnica sobre procedimentos de caducidade de marcas – Português \(Brasil\) \(www.gov.br\)](https://www.inpi.gov.br/publicacoes/03-2022)).

According to this guideline, new wording is established for Article 6.5 of the Trademark Manual concerning legitimate interest; admissibility requirements; new rules for analysis of the trademark proofs of use; and the criteria that will be considered to exam the cases of modification of the trademark.

We highlight below some of the updates provided by the Technical Note recently published:

- The applicant for the forfeiture procedure must justify his legitimate interest, which must be verified at the moment of the filing, not being recognized the request for declaration of forfeiture if, on such date, at least five years have elapsed from the date of the filing, grant of registration or disuse of the mark has been proven or justified by legitimate reasons, in a previous process, requested less than five years ago;
- Requirement for the owner to prove the use or justify the disuse of the trademark in the investigation period that is contained in the first five years of the grant of the registration;
- For the purposes of proof, it must be considered their public and effective character to identify the products and services for which it was registered, not being accepted the use in a private and strictly internal sphere, that is, the simple preparation for the use of the trademark, such as printing labels, developing packaging, creating a visual identity, etc. - constitutes internal use and not use in commercial activities;
- Images of products, packages, wrappers, containers, tags, and stickers affixed to the products are accepted as proof of use, provided they contain the date or expiration date of the products within the investigated period;
- A wider range of acceptance of documents proving the use, such as digital documents and those obtained from the internet, leading to a global assessment of all circumstances and elements of each specific case. In the case of digital documents, it is important to provide evidence that they were externalized, that is, sent to potential customers or consumers, or that they were taken for public disclosure;
- Documents in a foreign language must be accompanied by a simple translation, with consular legalization being waived;

- The use of the trademark in advertising, in general, is considered effective use if the volume of documents presented is sufficient, provided that the number of intervals compatible with the commercial characteristics of the products or services indicated;
- The images or pages published on the internet must be duly dated, within the investigation period, and demonstrate the use of the trademark as granted. In this sense, the registration of a domain is not enough to prove the effective use of the trademark;
- Admission of evidence with the joint use of several trademarks registered in the name of the same owner, if it is possible to identify the products or services that are intended to mark each one individually through complementary documentation;
- Statements by third parties, such as customers and suppliers, may reinforce the evidentiary set, but will not be considered suitable as evidence apart;
- Commercials and Television Programs (soap operas, series, auditorium programs, etc.), streaming platforms, and other exhibition channels, which demonstrate the trademark of the program itself, must demonstrate the date of the program's exhibition within the period of investigation;
- Non-acceptance of documents from the owner, although they demonstrate the commercial activity, such as CNPJ card, social contract, water, electricity, and telephone bills;
- Acceptance of documents that prove the use of the trademark in plural or singular forms that do not substantially affect the original meaning, such as: Menina da Cabana and Meninas das Cabanas;
- Addition of generic, descriptive, or unregistrable nominative elements, prepositions and irrelevant articles, as well as addition, omission and substitution of letters and figurative elements will be considered valid, since they maintain the core of the trademarks, if there is no substantial change in the distinctive terms;

The non-use cancellation procedure is an important way to ensure the social function of the use of a registered trademark that is in disuse by its holder, and the updates brought by Technical Note 03/2022 are the result of BPTO's analysis in several procedures established throughout time.

In this way, such guidelines should be considered both in the search for proof of use of a certain registered sign, to those who intend the registration cancellation due to disuse, as well as to the holders of registrations, as a means of producing proof of use throughout the

period to which their brands are subject to such procedure.