



Intellectual property and trademark legal framework in BRICS countries: A comparative study



Adriana Brigante Deorsola ^{a,*}, Marcia Cristiane Martins Ribeiro Leal ^a,
Milene Dantas Cavalcante ^a, Ingrid Jensen Schmidt ^a, Edimilson Junqueira Braga ^{a, b}

^a INPI – Brazilian National Institute of Industrial Property, Mayrink Veiga 9, Rio de Janeiro, RJ, CEP 20090-910, Brazil

^b Academy of Intellectual Property, Innovation and Development, INPI

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ABSTRACT

Given the importance of the economic group called BRICS, a group of five of the fastest-growing emerging markets in the world, a better understanding of their Intellectual Property legal framework becomes critical for many stakeholders and innovators. The aim of this work is to carry out a comparative analysis of the Trademarks Laws from the BRICS countries. Possible similarities and differences between their normative frameworks for the protection of intellectual property, specifically with respect to trademarks, are investigated. Ultimately, a comparative approach about the BRICS major conventions, treaties and international agreements and its consequences are discussed.

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1. Introduction

In 2001, Goldman Sachs Global Economic Research, through its economist and former chairman Jim O'Neil, coined the acronym BRIC (Brazil, Russia, India and China) in a publication entitled *Building Better Global Economic BRICs* to refer to the most prominent group between new emerging world market. In 2011, at the *Third Summit of BRIC*, South Africa became part of the group, who adopted the acronym BRICS. The transformation that BRICS goes by currently is quite significant and they are no longer a simple acronym of a financial analysis tool, it becomes a forum for political negotiations among their five member countries.

Once the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) came into force in 1995, the BRICS countries have undertaken significant amendments in their intellectual property systems, changed their laws and become signatories to various conventions, treaties and agreements. There are some reasons to focus on these countries. Firstly, all BRICS countries seems to have some ability to contribute to the management of

international order in regional or global terms, in addition to some degree of internal cohesion and capacity for effective state action [1]. Further, BRICS countries believe in their right to play a more influential role in world affairs and, therefore, to effectively participate in the proposal of new international regulatory framework on intellectual property, including also those related, for example, to trademarks.

In March 2013, the 5th meeting of Heads of State Summit of BRICS took place in Durban, South Africa. Alongside of the above mentioned meeting, it were held the *Third Meeting of the BRICS Trade Ministers* when the *Contact Group on Economic and Trade Issues (CGETI)* has established that one of the work areas to be covered by the BRICS would be the cooperation in the field of intellectual property [2].

On the other hand, in assessing the future of BRICS intellectual property regimes, many authors choose to focus on copyright and trademark piracy. Accordingly, it is the area that is subject to most scrutiny and is easily followed as a measure of progress [3], [4]. Much has been said about BRICS economies; however, there is a lack of investigation regarding the legal framework with respect to trademark in those countries.

In light of the mentioned above, a better understanding about

* Corresponding author.

E-mail address: adrianad@inpi.gov.br (A.B. Deorsola).

the scope of the intellectual property rights, as well as the trademarks in BRICS countries becomes critical for many stakeholders and also a strategic objective for most major international corporations interested in investing in those markets. It can be assumed that the economies of the BRICS will increasingly influence the balance of political, economic and military power in the world. Likewise, the rise of the BRICS will have significant implications for the corporate environment and international legal [3].

2. Main international treaties on matters of trademarks

Since the advent of the Paris Convention in 1883 and the Berne Convention in 1886, there have been an increasing number of international treaties regulating intellectual property rights. Table 1 summarizes the countries in study and the treaties in force with respect to trademarks [2]. Most of treaties are administrated by WIPO, except for the TRIPS Agreement, which are of responsibility to the World Trade Organization - WTO.

2.1. Paris convention

The Paris Convention (CUP) was concluded in Paris in 1883, and is one of the oldest international multilateral treaties in the world. It was also the first international convention established for the specific protection of industrial property (patents, utility models, industrial designs, trademarks or trade, indications of source or appellations of origin) as well as trade names and repression unfair competition, not including in its scope the copyrights, which are protected by the Berne Convention Union, 1886.

The Paris Convention also provides some specific treatments that should be observed for the registration of trademarks. They are trademark protection *telle-quelle*, which ensures the protection of the mark in any other country of the Union as was registered in their country of origin, the possibility of registration of service trademarks and collective trademarks and protection of well-known trademark [5], [6]. The Convention does not aim to harmonize national laws by providing, instead, broad legislative freedom for each country to use some discretion in choosing their levels of protection of industrial property rights.

2.2. Trade-related aspects of intellectual property rights

The Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) is a result of the 1986–94 Uruguay Round

negotiations, signed at the Marrakesh ministerial meeting in April 1994, which culminated in the creation of the World Trade Organization (WTO), currently with 164 members [7]. It is one of the most important agreements with respect to IP, since it sets up on minimum basis of protection for intellectual property that must be observed by the contracting states. Due to the *Single Undertaking* principle, all WTO members have to adhere to all agreements that compose the General Agreement on Trade and Tariffs (GATT), including TRIPS. Unlike CUP, which has no type of dispute in case of noncompliance of their articles, the WTO has procedures for resolving quarrels under the Dispute Settlement Understanding, mechanism considered vital for enforcing the rules and ensuring that trade and intellectual property rights flow smoothly.

In the specific area of trademarks, TRIPS adopts the distinctive function as essential criterion for a sign being capable of constituting a trademark. The agreement has brought also the extension of the term of trademark protection, which cannot be less than seven years, it may be renewable indefinitely. Moreover, it has expanded the Article 6 *bis* of the Paris Convention, which protects only the well-known trademarks for goods, protecting also well-known trademarks for services and make explicit the recognition about the theory of distinctiveness acquired through use (secondary meaning) for countries wishing to adopt it. Ultimately, the agreement allows that countries may require that signs be visually perceivable as well as the prior use of the trademark before filing.

2.3. Nairobi treaty for protection of Olympic symbol

The Nairobi Treaty was created in 1981 and currently there are 52 contractors. The signatories have an obligation to protect the Olympic Symbol as the five interlocking rings against the use for commercial purposes such as use in brands or advertising of any kind without permission from the International Olympic Committee (IOC). An important effect of this treaty is if the IOC authorizes the use of the Olympic symbol for a Contracting State, it shall be entitled to a share of revenue from its economic exploitation [6].

2.4. Madrid system

2.4.1. Madrid Agreement and Madrid Protocol

The Madrid Agreement, signed in 1891, is part of the Madrid System for the International Registration of trademarks, which makes it possible to protect it in a number of countries through a single International Registration valid in each of the designated

Table 1
Summary of International Treaties in force with respect to trademarks in BRICS countries.

Country	Brazil	Russia	India	China	South Africa
Trademark Office	National Institute of Industrial Property (INPI)	Federal Service for Intellectual Property (ROSPATENT)	Office of the Controller-General of Patents, designs and Trademarks	State Administration for Industry and Commerce of the People's Republic of China (SAIC)	Department of Trade and Industry, Companies and Intellectual Property Commission (CIPC)
Statute Followed	Industrial property Law N. 9279, May 14, 1996	Russian Civil Law, Part IV, Dec. 18, 2006	Trademarks Act, 1999 (Last amended in 2010)	Trademark Law of the PRC (Last amended in 2103)	Trademark Act, 1993 (Last amended in 2013)
Filling Basis	First-to-File	First-to-File	First-to-File	First-to-File	First-to-File
Removal of Trademark on Basis of Non-use	5 years	3 years	5 years 3 months	3 years	5 years
International Treaties in Force	<ul style="list-style-type: none"> • Paris Convention (1884) • Nairobi Treaty (1984) • TRIPS (1995) 	<ul style="list-style-type: none"> • Paris Convention (1965) • Nice Agreement (1971) • Madrid Agreement (1984) • Nairobi Treaty (1986) • Madrid Protocol (1997) • TLT (1998) • Singapore Treaty (2009) • TRIPS (2012) 	<ul style="list-style-type: none"> • Nairobi Treaty (1983) • TRIPS (1995) • Paris Convention (1998) • Madrid Protocol (2013) 	<ul style="list-style-type: none"> • Paris Convention (1985) • Madrid Agreement (1989) • Nice Agreement (1994) • Madrid Protocol (1995) • TRIPS (2001) 	<ul style="list-style-type: none"> • Paris Convention (1947) • TRIPS (1995)

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