Outcome

The case was brought to Court. Unfortunately, the Industrial design was declared null and void. On the other hand, the Court rejected the copyright action, since Brazilian Courts do not usually favor such a protection strategy and do not tend to apply copyright protection on a product over which an industrial design has been granted.

As a result, the Italian SME lost protection over the Industrial Design and had to bear the costs of the proceedings.

Lessons learned

Seek for legal advice before commercializing your products and services and let your IP professional know any relevant information from the beginning.

Do not disclose your creations before protecting them. Otherwise, your interests could be jeopardized. Regarding Industrial Designs, it could handicap its registration for lack of novelty, except in special cases.

When analyzing the novelty requirement, the Brazilian Intellectual Property Office (INPI) takes into account all the previous designs that have been made public in any place of the world and by any means (state of the art) before the filing date.

As many other countries, Brazil provides for a grace period (6 months for Industrial Designs). This mechanism can help you prevent loss of your IP Rights. Nonetheless, you must be well informed in advance to know if it may be applicable to your situation.

The mere formal registration does not guarantee that your IPRs are strong and that they will be respected. A thorough analysis and a realistic protection strategy will be of help. The INPI does not conduct a substantial examination of the chair, unless requested by the applicant. Hence, it is recommended it to be conducted by an IP professional prior to the application.

Many IPRs are compatible with other rights. The chair’s protection could be reinforced via copyright or trademarks.

Litigation is not always the answer. Alternative dispute resolution mechanisms are very useful. In fact, negotiation could be the best option.