

# CASE STUDY

## Industrial designs in Brazil



**MERCOSUR**  
IPR SME Helpdesk

### ✓ Background

An Italian furniture designer produced and sold a limited edition (only for Brazil) to a single store in Rio de Janeiro: the Papparazzi collection.

Following his lawyer's advice, he protected every piece as industrial designs in Brazil.

At the end of the season, the collection was removed from the catalogue.

Nine years later, a local celebrity confessed publicly that she was a fan of his work. Immediately, the designer became hot topic, which caused an explosion on the demand, particularly for his first creations.

Taking advantage of the situation, a Brazilian company located in Sao Paulo commercialized a chair that was almost identical to the Pararazzi's star piece.

### ⚙️ Actions taken

When the Italian designer found it out, he requested his new Brazilian IP lawyer to start legal actions against the infringing enterprise.

The latter studied the case and discovered that the Italian designer had a printed copy of an old article of a very modest fashion magazine published 11 years ago that contained a photo reportage about the prototype version of the Papparazzi's chair. The magazine disappeared shortly thereafter.

Although it was not likely that the Brazilian company was aware of it, the publication evidenced that the industrial design did not comply with the novelty requirement, since it was part of the state of the art before the filing date. Additionally, the grace period could not be applied, given that the article was published more than 6 months before the filing date.

On the other hand, the said EU SME could also claim that there was a copyright infringement or start an unfair competition action against the local business.

### 📊 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.