

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



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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

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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"> <li>• Paris Convention (1884)</li> <li>• Nairobi Treaty (1984)</li> <li>• TRIPS (1995)</li> </ul>	<ul style="list-style-type: none"> <li>• Paris Convention (1965)</li> <li>• Nice Agreement (1971)</li> <li>• Madrid Agreement (1984)</li> <li>• Nairobi Treaty (1986)</li> <li>• Madrid Protocol (1997)</li> <li>• TLT (1998)</li> <li>• Singapore Treaty (2009)</li> <li>• TRIPS (2012)</li> </ul>	<ul style="list-style-type: none"> <li>• Nairobi Treaty (1983)</li> <li>• TRIPS (1995)</li> <li>• Paris Convention (1998)</li> <li>• Madrid Protocol (2013)</li> </ul>	<ul style="list-style-type: none"> <li>• Paris Convention (1985)</li> <li>• Madrid Agreement (1989)</li> <li>• Nice Agreement (1994)</li> <li>• Madrid Protocol (1995)</li> <li>• TRIPS (2001)</li> </ul>	<ul style="list-style-type: none"> <li>• Paris Convention (1947)</li> <li>• TRIPS (1995)</li> </ul>

members. The Madrid Agreement has 55 members [6].

The Madrid Protocol came into force in 1995 and currently has 98 contracting states members [6]. The Protocol is administered by the WIPO that is responsible for international registration and the publication of applications in *WIPO Gazette of International Marks*. The protocol is an alternative way to request registration of trademarks in any of the countries or organizations members of the treaty. Following a single set of formal procedures, in one language, the user can choose any of the three official languages of WIPO (English, French or Spanish) and paying fees at once. The system of international registration of trademarks is intended to facilitate the registration procedure since it reduces the bureaucracy and is more accessible; however, there are some criticisms about some aspects of such protocol, which possibly make some countries reluctant to accede it [8]. This will be discussed in the next sections.

### 2.5. Nice Agreement

Nice Agreement (NCL) was created in 1957 and currently there are 84 members. It establishes a common classification of goods and services for the purposes of registering trademarks and service marks (the Nice Classification) [6]. The Classification consists of a list of 45 classes, 34 for goods and 11 for services. The eleventh edition of the NCL came into force on January 1, 2017.

### 2.6. Trademark Law Treaty

The Trademark Law Treaty (TLT) was created in 1994 and currently there are 54 members. It was designed in order to simplify, standardize and streamline administrative procedures related to national and regional trademark applications. The Treaty allows countries and intergovernmental organizations become part of this [6].

### 2.7. Singapore Treaty

The Singapore Treaty is based on the TLT, incorporating new norms and introducing some enhancements to harmonize the procedure for registration of trademarks in order to make it more dynamic and modern. It represents an evolution in the field of communication technologies since the contracting parties are free to choose the most appropriate form of communication, such as electronic media. In addition to these innovations, it highlights the establishment of a council to discuss possible further changes in the text, provisions on trademark license and for relief measure with respect to missed deadlines, in order to protect the holder's rights of marks [9]. There are 45 Contracting Parties [6].

## 3. The main aspects of trademarks law in BRICS

### 3.1. Brazil

Brazil was the fourth country in the world to establish a IP Law, under Emperor Dom João VI, in 1809 and it was not long before when Brazil has become one of the eleven first signatories of the Paris convention of 1884. Brazil was also a signatory of Madrid Agreement, approved by Decree No. 5685 of 1929. However, the agreement was denounced by the country and it was repealed by Decree No. 196 of 1934. Such denunciation was considered of a patriotic and nationalist character and was the result of a sustained campaign by trade associations, who claimed injury to merchants and industrialists due to the unfair competition with foreign products [10].

In the 1980's, after suffering a series of trade sanctions by the United States due to supposedly violating intellectual property

rights of American corporations, Brazil, amid a backdrop of political democratization and economic liberalization, emended its legal framework and promulgated a new Industrial Property Law No. 9279 on May 14, 1996 to comply with the TRIPS provisions.

A lot of attention is paid to the fact that Brazil has not yet acceded to the Madrid Protocol. On the other hand, there are some criticisms about such Protocol. Among other factors, like the implementation of a multiclass applications and the strong “dependency” with respect to the basic registration, is the fact that once the International Bureau notifies a national office that a party seeks trademark rights, the national office has 18 months in which to refuse or grant protection to the party's mark. However, if the national office misses the 18 months deadline for communicating its refusal, the office cannot deny protection to the party's mark [8]. Nevertheless, on April 9, 2013, the Council of Ministers of the Brazilian Chamber of Foreign Trade (CAMEX) has recommended Brazil's adherence to the Madrid Protocol, however the treaty has not yet been submitted to Congress [2].

In Brazil, the trademark registration is filed at the National Institute of Industrial Property (INPI) under the Ministry of the Industry, Foreign Trade and Services, in which the main office is located in Rio de Janeiro [11]. The office is responsible not only for the trademark registration, but also for the registration of industrial designs, technology transfer, franchise contracts and computer programs and granting of patents of invention and utility models, besides the protection against false geographical indications [12]. Brazilian trademark law is regulated currently by law No. 9279 of 1996 (LPI), besides internal resolutions addressing to the procedures for analyzing trademarks with the aim of harmonize the decisions of the Office.

The trademarks registration system adopted in Brazil are attributive by law. So, its property and the exclusive right are acquired by registration, as defined by Article 129 of the LPI. With respect to its nature, the trademark may be a goods mark, a services mark, a collective mark or a certification mark. Such provision is set forth in Article 123 of the LPI. Concerning to his form presentation, the trademark may be nominative, figurative, mixed or three-dimensional mark [12]. The trademark registration includes not only the trademarks applied to goods or services, but also collectives and certifications trademark and well known trademarks.

A peculiarity of Brazilian's law is the recognition of the “famous mark”, a highly reputed brand (Article 125 of the LPI), which differs from the well-known trademark of article 126. The latter is protected by the article 6 *bis* of the Paris Convention and it was also incorporated by the countries under study in their national laws. The “famous mark” is an exception to the principle of specialty. The recent INPI Resolution No. 107 of 2013 has conceptualized “famous mark” as the one which extrapolates the trademark's function of distinguishing goods and services, exceeding the principle of specialty due to its distinctiveness and by the recognition of a large portion of the public of its quality, reputation and prestige. Prior to that resolution, the protection of a “famous mark” was only recognized by way of defense. On November 27, 2014, through Resolution No. 142 it was publicized the Brazilian Guidelines for Trademark Registration [13], a trademark manual which helps those who wants to register a mark before the INPI. The LPI states that are eligible to register “visually perceptible signs not prohibited by law” [11], such as registration of products, services, collective, certification and three-dimensional marks. The prohibitions are listed in Article No. 124 of LPI throughout its twenty-three items. In Brazil, there is no division between relative and absolute grounds of refusal. The prohibitions are arranged alternately throughout the twenty-three provisions of Article No. 124 [14].

Basically, Brazilian IP law does not allow the registration as a

mark; I - crests, armorial bearings, medals, flags, emblems, official public distinctions and monuments, be they national, foreign or international, as well as any respective designations, figures or imitations; II - an isolated letter, digit or date; III - expressions, figures, drawings or any other sign contrary to morals and good customs or which offend a person's honor or image or are an attempt to the freedom of conscience, beliefs, religious cults or to ideas and feelings worthy of respect and veneration; IV - designations or acronyms of a public entity or establishment, V - reproductions or imitations of a characteristic or differentiating element of a title of establishment or the name of an undertaking belonging to a third party, VI - signs of a generic, common, usual or simply descriptive character, when related to the product or service to be distinguished, VII - signs or expressions used only as a means of advertising, VIII - colors and their names, IX - geographic indications, imitations thereof likely to cause confusion or signs that might falsely suggest a geographic indication, X - signs that suggest a false indication with respect to origin, source, nature, quality or utility of the product or service to which the mark is directed, XI - reproductions or imitations of official seals, normally adopted for the guarantee of a standard of any type or nature, XII - reproductions or imitations of signs that have been registered as a collective or a certification mark by a third party, without prejudice to the provisions of Article No. 154. Are also not registrable as mark; XIII - names, prizes or symbols of sporting, artistic, cultural, social, political, economic or technical official or officially recognized events, XIV - reproductions or imitations of titles, bonds, coins and bank notes of the Union, the States, the Federal District, the Territories, the Municipalities or of any country; XV - personal names or signatures thereof, family or patronymic names and images of third parties, XVI - well-known pseudonyms or nicknames and singular or collective artistic names, XVII - literary, artistic or scientific works, as well as titles protected by copyright, XVIII - technical terms used in the industry, science or art that is related to the product or service to be distinguished, XIX - reproductions or imitations, in whole or in part, even with additions, of a mark registered by a third party, to distinguish or certify a product or service that is identical, similar or akin, XX - duplications of marks of a single proprietor for the same product or service, XXI - necessary, common or usual shapes of a product or of its packaging, or, furthermore, shapes that cannot be disassociated from a technical effect, XXII - objects that are protected by industrial design registrations in the name of third parties, and XXIII - signs that imitate or reproduce, wholly or in part, a mark of which the applicant could obviously not fail to have knowledge in view of his activity, and of which the proprietor is established or domiciled in the national territory or in a country in which Brazil maintains an agreement or guarantees reciprocity of treatment, if the mark is intended to distinguish a product or service that is identical, similar or akin [12]. Therefore, is possible to conclude that if a mark is not among the items of the prohibition list, it is registrable.

Another requirement based on Article 128, paragraph 1 of the abovementioned Law is that private persons can only apply for trademark registration on the activity he/she is effectively and lawfully engaged. The application to register a collective mark may only be filed by a legal person who represents the collectivity, which may engage in a different activity from that of its members. The application to register a certification mark may only be filed by a person that has no direct commercial or industrial interest in the certified products or services [12], [11].

### 3.2. Russia

In Russia, the concept of intellectual property rights has been drastically changed over the twentieth century. In 1931, there was a

policy where the state had the rights and the inventor only earned a nominal salary and a "certificate of invention". From 2006, the recognition as an inventor's intellectual property right was recognized by the IV Civil Code [15].

The trademark registration in Russia is done before the *Federal Service for Intellectual Property (Rospatent)* under the Ministry of Economic Development of the Russian Federation. The *Rospatent* is a federal executive authority performing functions of controlling and supervision in the field of legal protection and exploitation of intellectual property rights, including trademarks [16].

The regulation of intellectual property rights is set forth in Part IV of the Civil Code of the Russian Federation and has been in effect since December 1st, 2007. The registration of trademarks is regulated by Chapter 76, §2° of the Civil Code, in the Guidelines regarding the Trademarks Applications and in Regulations regarding the Fees. The trademark registration in Russia includes the trademarks of goods and services, as well as the collective trademarks. There is no provision in the Russian legislation regarding the certification trademarks. The Russian legislation provides that can be registered as trademarks nominative, figurative, three-dimensional signs and other signs or combination of them. A trademark can be registered in any color or combination of colors [17].

The provision of the Russian Civil Code that "other signs or combination of them" can be registered as trademarks implies that there is no limitation on the type of mark subject to registration, since the applicant complies with the requirements for protection. Therefore, the legal definition of protectable signs enables registration of both traditional and non-traditional trademarks in Russia, such as; sound, smell and motion trademarks [18].

In Russia Federation the first set of absolute prohibitions are referred to those signs which are not capable of distinguishing or consisting only by elements that have entered into public domain to indicate the goods of a certain kind. They are generally accepted symbols and terms, which characterize goods, including indication of their type, quality, quantity, properties, purpose, or value and also the time, place, or means of production or sale; and represent the configuration of goods that is determined exclusively or mainly by the properties or purpose of the goods. These elements may be incorporated in the trademark as non-protected elements if they do not prevail [17]. The Russian statute also provides the possibility that a sign can acquire distinctiveness as a result of its use, the so-called "acquired distinctiveness." In these cases, the applicant must provide evidence that the sign has acquired distinctive character as well as information concerning the duration and intensity of use of its sign.

The second set of absolute prohibitions refers to those signs unable of being registered, in view of Art. 6 *ter* of the Paris Convention. In this set, it is included the signs which consist only of elements that are state armorial bearings, flags, or other state symbols and marks; abbreviations or full names of international and intergovernmental organizations, their armorial bearings, flags, or other symbols and marks; official signs or hallmarks of control and warranty, seals, awards, and other distinguishing signs; and the signs confusingly similar to the elements indicated thereof. Such elements may be included in a trademark as non-protected elements provided there is consent of the appropriate competent authority. Trademarks applications can also be refused based on absolute grounds if the signs that are or contain elements that are false or capable of misleading a consumer in respect of goods or their producer, as well as the those that are contrary to public interests, or to principles of humanity or morality [17]. Notwithstanding to this provision authorizing the rejection of trademark applications which violate the public interest in accordance with Article 6 *quinquies* of CUP, Art. No. 1483 of the Russian Civil Code

also includes a special provision establishing additional obstacles to such registration. The obstacles are related to the signs identical or confusingly similar to the official names and images of particularly valuable objects of the cultural heritage of peoples of the Russian Federation or objects of world cultural or natural heritage. And, also the signs with images of cultural values stored in special, general, and reserve collections shall not be registered as trademarks if registration is sought in the name of persons who are not their owners, without the consent of their owners or of the persons authorized by the owners for the registration of such signs as trademarks.

The final sets of absolute prohibitions are those set forth in the provisions of Art. 23 of the TRIPS Agreement. Indeed, it cannot be registered as trademarks signs that are or contain elements which are protected in one of the States party to the mentioned international treaty as signs identifying wines or spirits as originating from its territory and have a particular quality, reputation, or other characteristics that are mainly determined by its origin.

The relative grounds for the register consider if the trademark application conflicts with any existing third party right for an identical or similar sign or related rights. In this sense, a sign cannot be registered, unless with the consent of the right holder, if it is identical or confusingly similar to: (i) trademarks of other persons applied for registration with respect to similar goods with an earlier priority; (ii) trademarks of other persons protected in the Russian Federation, including by virtue of an international Treaty of the Russian Federation with respect to similar goods; (iii) trademarks of other persons recognized, according to the trademark legislation, as being well known mark in the Russian Federation with respect to similar goods with an earlier priority [17]. The Civil Code also establishes that the signs identical or confusingly similar to an appellation of origin protected under the Russian legislation shall not be registered as trademarks with respect to any goods except for the case when such a sign is included as a non-protected element in a trademark registered in the name of a person having the exclusive right to use such an appellation. The signs identical or confusingly similar to a trade name or commercial name previously protected in the Russian Federation shall not be registered as trademarks with respect to similar goods.

The Russian legislation also provides legal protection of well-known trademarks by decision of the *Rospatent*, on the request of a person considering that the trademark used by him or the sign used as a trademark is well-known in the Russian Federation - as a result of intensive use on the date indicated in the application - have become widely known in Russia among the corresponding consumers with respect to goods of this applicant. It can also be recognized as being well-known the trademark protected within the territory of the Russian Federation on the ground of its official registration or by virtue of an international treaty of the Russian Federation or a sign used as a trademark but not enjoying legal protection within the territory of the Russian Federation by a decision of the federal executive authority for intellectual property. A trademark and a sign used as a trademark shall not be considered as being well-known if they have become widely known after the priority date of an identical or confusingly similar trademark of another person, intended to be used with respect to similar goods. The legal protection of a well-known trademark shall also extend to goods non-similar to those with respect to which it was considered as well-known, provided that the use by another person of the trademark with respect to the aforesaid goods will be associated by consumers with the right holder of the exclusive right to the well-known mark and infringe the lawful interests of such a holder. A well-known trademark enjoys the same legal protection from any

other trademark, but unlike those that have a term of protection of 10 years from filing, legal protection of well-known trademark in Russia is valid for an indefinite period of time [17].

In Russia, any person or entity can apply for a trademark. There is no explicit mention in the Russian Civil Code, in the part relating to trademarks, about the possibility of co-ownership.

### 3.3. India

The Law of Intellectual Property (IP) in India has accompanied the technological evolution and the changing of IP laws of other countries. Currently, in India, the law relating to trade marks has been active since 1999 [4].

The trademark registration in India is done before the Controller of Patents, Designs and Trademarks under the Department of Industrial Policy and Promotions of the Ministry of Commerce and Industry of India. The headquarters of the Department of Trademarks is in Mumbai. However, the Office has branches in New Delhi, Kolkata, Chennai and Ahmedabad [19]. The trademark register is regulated by a specific law, The Trade Marks Act of 1999, which came into force in September 2003, replacing the former law The Trade and Merchandise Act of 1958 in view of the TRIPS provisions. The Trade Marks Act, which was amended in 2010, contains 159 articles governing the procedural and substantive aspects of trademark protection and it is observed regarding also the Trade Marks Rules 2002, which was last amended in 2013 [20].

The trademark law system is based on the first-to-file that does not require the prior use of the mark in commerce. The most significant changes include the expansion of the trademark concept that currently allows the trademark registration of design, such as the shape of goods, their packaging and combination of colors, and the term of protection, expanded from seven to ten years renewable for equal periods subsequently. Another highlight was the possibility of registration of collective marks, certification and service marks. In the former law it was only allowed the registration of trademarks for products [21].

The new law also recognizes the well-known marks, allowing the holders to enforce its rights in addition to products or services not covered by the register, if there are evidences of possible unfair competition due to the possibility to occur a connection between two marks. The current Indian law also expanded the protection of the mark concerning to the likelihood of confusion. In the past, the infringer only violated the law who used the mark for identical goods or services to the owner. Today the holder can claim their rights not only when the marks are similar and likely to cause confusion, but when they may cause confusion and mislead the public [21]. In India, a trademark is one that can be represented graphically and also capable of distinguishing equally goods and services. After TRIPS, it is also eligible to register, collective and certifications trademarks, shape of goods, packaging and combination of colors.

The Trademarks Act expressly divides the eligibility of signs in absolute and relative prohibitions. The absolute prohibitions consist of marks devoid of any distinctive character, which does not fulfill the function of distinguishing goods and services. Are those that serve to designate the kind, quality, quantity, value, geographical origin and the brands that have become common use in everyday language [20]. The Indian law also prohibits, without exception, the register of misleading marks or signs that are likely to cause confusion among the public; that go against the religion of any Indian citizen; scandalous or obscene signs; prohibited emblems; signs consisting solely required in order to achieve a technical effect, in the form that results from the nature of the products

themselves and the products that confers substantial value.

With respect to the relatives prohibitions, is not allowed to register identical or similar signs to an earlier mark which point out to identical or similar products or services and are likely to cause confusion or undue association signs [20]. It is also prohibited the register of chemical elements or chemical compounds isolated; identical or similar register to the INN, International Non-proprietary Names, declared by the World Health Organization - WHO and notified to the Trademark Office; the registration of names of others, except with their consent and deceased persons with the consent of legal representatives. Finally, a trademark shall not be registered if its use in India is liable to be prevented; by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or by virtue of law of copyright.

According to chapter III, Article 18 (1) of the Trade Marks Act, Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark [20].

### 3.4. China

In recent years, People's Republic of China has made a revolutionary change concerning intellectual property, from a country without any protection to another with a broader vision. A transformation occurred when, in 1980, China became a member of the World Intellectual Property Organization - WIPO, and continuing became also membership of several international treaties and conventions in the 80's and 90's. It was not long before China had made impressive progress in the protection and enforcement of intellectual property rights [22].

After the foundation of the People's Republic of China, the nationwide trademark registration was in the charge of the Central Bureau for Private Enterprises and the Central Administration for Industry and Commerce successively. With the resumption of State Administration for Industry and Commerce (SAIC) in 1978, Trademark Office was established directly under SAIC [23]. The Trademark Law of the People's Republic of China (the 'PRC Trademark Law') was first adopted by the Standing Committee of the National People's Congress (the 'NPC Standing Committee') on August 23, 1982, and entered into force on March 1, 1983. The Law was revised in 1993, in 2001, and in 2013 by the NPC Standing Committee.

The Trademark aforementioned law aims to protect the exclusive right to use of the trademark, according to Article 1 thereof, protect the exclusive right to use the trademark, encouraging manufacturers and retailers to ensure the quality of its goods and services, to preserve the credibility of the trademark, protect the interests of consumers, producers and traders, and promote the development of socialist market economy. The registration of trademarks includes not only the trademarks for goods and services, but also the collective and certification trademarks. It should be noted that the law focuses not only in the distinctive feature of the trademark, but also the quality role, determining that the one who makes use of the trademark shall be responsible for the quality of the goods, not allowing any practice that can mislead consumers. Chinese law provides that any signs, visually perceptible, that serve to distinguish goods, including any work, design, letter of the alphabet, numerals, three-dimensional symbol, color combination or combinations of the signs described above, can be registrable as trademarks. The trademark should have visible features easily distinguishable and cannot conflict with prior rights of third parties [24].

China makes a distinction between signs that cannot be 'used' as a trademark from those who cannot be "registered" as a trademark. It is not eligible as a trademark signs identical or similar to the name of State, flag, national emblem and military signals, not only from China but also from other countries; signs with names of Central State Agencies, as well as those names identical to the names or drawings of landmarks in the country; signs identical or similar to official trademarks or stamps indicating control and warranty, except with authorization; those likely to discriminate nationalities; those constituting exaggerated and misleading advertisements; signs that attempt to the customs and ethics; geographical names of administrative divisions or foreign geographical names known to the public. It is not allowed also generic names, designs or marked goods model, as well as signs that indicate quality, material, function, weight, quantity or other characteristics of goods or when there is lack of distinctiveness, except when the sign has acquired distinctiveness through use. Three-dimensional signs which only indicate the inherent nature of the required goods or the necessary form to obtain a technical effect are not eligible also as trademarks.

Chinese law also recognizes the protection for well-known trademarks without the need of registration, upon which a separate regulation to rule these marks were established, namely, *Provisions on the Determination and Protection of Well-Known Marks*. The well-known trademarks are defined as those marks widely known in relevant sectors of the public, so that enjoy a high reputation. The law emphasizes, among other factors which indicate whether a trademark is well-known or not, the degree of public recognition, the duration of the trademark use, the sales volume of the goods, the duration and extent of the geographical area covered by the promotion and trademark advertising. Finally, any natural or legal person can register a trademark for goods or services and the co-ownership are allowed [23], [24].

### 3.5. South Africa

South Africa, between 1948 and 1994 has witnessed the establishment, strengthening, endurance and, ultimately, the dismantling of *apartheid*, segregationist regime that ruled the country for years. The end of the *apartheid* regime, therefore, has resulted in a gradual revision of the national legal bases at the end of the last century. In the field of intellectual property, specifically the brands, this trend it was also observed.

The new trademark law in South Africa, the Trade Marks Act 194, was enacted in 1993 and came into force on May 1, 1995. It was amended by the Property Laws Amendment Act No. 38 of 1997 and lastly by the Property Laws Amendment Act No. 28 of 2013 [25]. The competent authority to proceed with the registration of trademarks in South Africa is the *Companies and Intellectual Property Commission* (CIPC). The Commission was established through the amalgamation of the *Office of Companies and Intellectual Property Enforcement* (OCIPE) and the *Companies and Intellectual Property Registration Office* (CIPRO). The Commission is a juristic person and has jurisdiction throughout the Republic. It is independent and subject only to the Constitution, to the law or to any policy statement, directive or request issued by the Minister of Trade and Industry. The Commission must be impartial and perform its functions without fear, favor or prejudice and must exercise the functions in the most cost-efficient and effective manner and in accordance with the values and principles mentioned in section 195 of the South African Constitution [26].

With respect to the South African trademark legislation, the most important aspect of the eligibility of a sign as a trade mark is

its distinctiveness, according to section 9, Part III of the South African Law. It is also laid down the register for collective and certification marks, in accordance with Sections 42 and 43 of Part XII [25].

Another important aspect is those related to the recognition of pre-use as a requirement for evaluating the distinctiveness. Accordingly, the mark shall be considered to be capable of distinguishing within the meaning of subsection (1) if, at the date of application for registration, it is inherently capable of distinguishing or so it is capable of distinguishing by reason of prior use thereof. An interesting and peculiar aspect of South African law is that a mark can be protected, as such, only if the sign is already registered under the Trade Marks Act, 1993. Unregistered trademarks are under the auspices of the common law [25].

The South African law has seventeen 17 cases in which a sign is not eligible to be registered as a trademark. Some of them are listed in section 10 of the Trade Marks Act [25]. Yet, according to the Trade Marks Act, it is not considered as registrable a mark, which consists exclusively of a sign or an indication which may serve, in trade, to designate a kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services. It is important to note that the South African statute includes, on the same provision, the reference signs called descriptive or of common use and those that mimic or reproduce geographical indications. Another aspect it is noteworthy is the protection of commonly used expressions in trade. Therefore, it is not registrable the mark, which consists exclusively of a sign or an indication which has become customary in the current language or in the *bona fide* and established practices of the trade. Also, there are expressed provisions reinforcing the principle of veracity. Thus, it is not registerable the mark, which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be against *boni mores*, or be likely to offend any class of persons [25].

The South African law, like most national laws, prohibits coexistence of identical or similar trademarks belonging to different holders due to the possibility of confusion. However, there is an exception in the rule in which is laid down the eligibility of the sign through authorization of the first holder. The South African law also expressly protects well-known marks and has a provision that prohibits the registration of a sign identical or similar to a mark that is already registered and which is well known in the Republic.

Finally, it should be noted that, although the South African law states that cannot be registered the mark, which contains the coat of arms, seal or national flag of the Republic or of any Convention country, if authorized by the authority Country of competent Convention in reference, the signal can be register.

According to South African law, item 2, section 8, The registrar shall permit an agent to perform on behalf of the person for whom he is agent, any act in connection with registration under this Act or any proceedings relating thereto, and shall not permit a person other than an agent so to act [25].

#### 4. Final considerations

The five legislations under study are in accordance with TRIPS Agreement and provide that the term of a trademark registration should not be less than seven years. In Brazil, Russia, India, China and South Africa as well, the term of a trademark registration is ten years, renewable indefinitely for the same period, through payment of fees and annuities. Table 2 correlates the five countries under study and the main characteristics have described throughout the discussion. The markings refer to the existence of regulations in those countries.

According to Article 15.1 of TRIPS: "Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible".

It is noteworthy that after TRIPS come into force in 1995, when the countries under investigation had to amend their Intellectual Property legal framework, the Laws of these countries have become closer on several points. TRIPS and trademark laws of Brazil, Russia, India, China and South Africa have adopted the distinctive function as an essential requirement of the registration process. Thus, the requirement of distinctiveness of the sign must be an essential condition for the registration of a mark in those countries. The distinctive function must be intrinsic to the trademark, in order to distinguish products and services in the market. On the other hand, only Russia, India and China allow the distinctiveness acquired through use (secondary meaning), which is also provided in the TRIPS Agreement.

Among other points in common, Brazil, India and China have incorporated the possibility of registering service, collective and certification marks into their legislation. On the other hand, in Russia there are provisions for the registration of collective and services trademarks, but there is no provision for certification marks.

Regarding the differences among the BRICS legislation, India and China are different from Brazil with respect to the ownership of the trademark. The first two have admitted co-owned trademarks, which are not allowed in Brazil. Likewise, Russian and South African legislations do not have provisions regarding co-ownership.

The concept and criteria for the protection of well-known marks indicate peculiarities among the BRICS Legislation. In Brazil, in addition to the protection of well-known trademarks, a trademark can receive an even broader protection that goes beyond the principle of specialty. In Brazil, the protection for "Famous Marks" is set forth in Article 125 of the Brazilian IP Law. The examination of such trademark is carried out by a committee of examiners in the

**Table 2**

Trademark main characteristics among BRICS countries.

	Brazil	Russia	India	China	South Africa
Collective Mark	✓	✓	✓	✓	✓
Certification Mark	✓		✓	✓	✓
Service Mark	✓	✓	✓	✓	✓
Well-Known Marks	✓	✓	✓	✓	✓
Famous Mark	✓				
Distinctiveness acquired by use		✓	✓	✓	
Term of 10 years protection, renewable	✓	✓	✓	✓	✓
Co-ownership of trademarks			✓	✓	

Brazilian office that, in finding that the mark is a “famous mark”, it may be protected in all branches of activity, constituting an exception to the principle of specialty.

The trademark law in India has developed criteria to determine whether or not a mark is considered to be well-known. It shall be known in India for a significant part of the public due to the result of the promotion of the brand as well as the duration and extent of the geographical area of the trademark. In the People's Republic of China, besides the provisions of a well-known trademark in its law, there is an own legislation dealing with this matter, the *Provisions on the Determination and Protection of Well-Known Marks*. The trademark law in Russian provides a special protection for well-known marks, which must be requested by the holder and is valid for an indefinite period of time. Ultimately, in South Africa, it is not allowed the registration of a sign identical or similar to a registered well-known brand in the Republic, if the use of such trademark is likely to take unfair advantage of, or detrimental to the distinctive character or the repute of the mark registered, even if there is no potential for confusion.

## 5. Conclusions

Besides being considered as countries listed in the top ten positions on the ranking concerning the extension of geographical area and population, Brazil, Russia, India, China, and South Africa are in a similar level of socio-economic development. Currently, the five countries seek the search for international integration, trying to adapt to the demands of the global order. Thus, regarding intellectual property, it seems to be possible for the BRICS countries embracing the international standards without, however, confronting their national laws.

Considering the number of treaties signed, Russia is the one has joined to a largest number of treaties, in a total of eight, followed by China with five treaties, probably to nurture the idea they are willing to get in tune with the international standards with respect to IP. Further, China has not joined the Nairobi Treaty and has acceded the TRIPS in 2001 and Russia only in 2012. It is noteworthy that India has joined the Paris Convention only after to sign TRIPS, although the Paris Convention has been created more than one hundred years before.

Regarding the registration of trademarks, in China the responsibility for the trademark examination, registration and administration lies with the State Trademark Office (TMO), under the State Administration of Industry and Commerce (SAIC), which is separate from the other IP offices. On the other hand, in India, Brazil, South Africa and Russia the registration is done before the respective office of industrial property that encompasses not only the registration of trademarks, but the granting of patents, industrial design, and other categories of industrial property rights.

In terms of legislation, in Brazil there is a more comprehensive law, which includes not only trademarks, but also patents, utility models, industrial designs, geographical indications and repression of unfair competition. India, China and South Africa have a specific law for trademarks.

With respect to the categories of marks (product, service, certification, collective and three-dimensional), it was observed that the Brazilian, Indian and Chinese laws governing the registration of trademarks are nearby and in accordance with TRIPS and, while India and China have advanced to expressly allow the registration of packaging, in Brazil it can only be protected via three-dimensional trademark. As for the eligibility of a sign, the aforementioned countries are unanimous with regard to the absolute prohibitions. Basically, the absolute prohibitions are the register of signs that attempt against morality; misleading signs; emblems, official coat of arms and signs devoid of distinctive character. China

and India have also extended the protection to allow the registration of marks that have acquired distinctiveness during prolonged use over time (secondary meaning), as provided in TRIPS.

Ultimately, there are some requirements in the Madrid Protocol that possibly make some countries delay their accession. One of the central arguments, besides the implementation of a multiclass applications and the strong “dependency” with respect to the basic registration, lies in the fact that once the International Bureau notifies a national office that a party seeks trademark rights, the national office has 18 months in which to refuse or grant protection to the party's mark. However, if the national office misses the 18 months deadline for communicating its refusal, the office cannot deny protection to the party's mark. Therefore, to comply with these provisions the national offices would have to undertake efforts to upgrade its infrastructure and procedures, like India did in 2013 [2]. However, despite the controversy, there is no doubt to believe that Brazil and South Africa will adhere to the Madrid Protocol soon.

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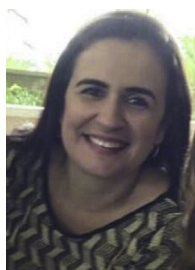
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