# Life and death: protecting legacy through IP rights

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Intellectual Property, Brazil



In November 2020 the world lost the football legend Diego Maradona. His death brought up various issues regarding post mortem trademark rights. This article discusses the registration of proper names as trademarks in Brazil and explores the measures that parties can take to ensure that the legacy and goodwill associated with their intellectual property is preserved after their death.

**Registration of MARADONA trademark**

According to the Argentinean Trademark Office database, all trademarks connected to Maradona are registered to the company Sattvica SA. Maradona was not a partner of Sattvica, nor did he have any co-ownership of the trademarks. Thus, in principle, Sattvica owns all of Maradona's trademark rights and has the exclusive right to use, license and merchandise any trademark relating to Maradona's name in relation to the goods or services covered by those registrations.

Sattvica also filed applications to register the trademark MARADONA in several classes in Brazil, but was unsuccessful. The Brazilian Patents and Trademarks Office (BPTO) raised office actions which requested that Sattvica submit documents to prove that Maradona had formally authorised its registration of his name. Sattvica did not comply with the requests.

**Key legislative issues**

The BPTO raised the office actions based on Articles 124(XV) and (XVI) of the Trademark Law, which state that:

> *The following are not registrable as marks:...*
>
> *XV - personal names or signatures thereof, family or patronymic names and images of third parties, except with the consent of the owner, his heirs or his successors;*
>
> *XVI - well-known pseudonyms or nicknames and singular or collective artistic names, except with the consent of the owner, his heirs or his successors.*

Therefore, to file a trademark application for a well-known name in Brazil, parties must submit to the BPTO a formal authorisation that allows the registration of the name as a mark and is signed by the name holder or their heirs or successors, even if the applicant is a company owned by that person.

The purpose of this legal provision is to prevent third parties from appropriating someone else's name without proper consent. It is particularly relevant in cases where the individual has died and is therefore unable to enforce their rights directly. This obligation passes to their heirs or successors.

A similar case in Brazil concerned the registration of ALBERT EINSTEIN as a trademark by the Albert Einstein Israelite Hospital. In this case, the Superior Court of Justice (Special Appeal 1,715,806 – RJ (2017/0181938-5)) decided that although the entity had received consent for the use of the scientist's name, the documentation did not cover the right to register the name as a trademark. Therefore, the courts confirmed the BPTO's decision to accept the administrative nullity action filed by the Hebrew University of Jerusalem, which holds the rights to all of the scientist's immaterial legacy.

**Registration of proper names as trademarks**

Intellectual property – including personal names that are used or registered as trademarks – is not only a valuable asset, but also represents an individual's legacy. Therefore, parties should take all necessary measures to ensure its protection.

Cases involving well-known names are more common than may be expected. This is particularly the case in the fashion and cosmetics industry, where personal names are widely used to identify goods and services.

Issues usually arise where there is a change in control of a business. For example, the former chief designer of Gucci, Paulo Gucci, could use his name only when it was placed after a different brand name in smaller letters. Similarly, Jo Malone, the founder of the famous British perfume and scented candle brand, could no longer use her name for such goods after a business buyout.

The value and reputation associated with IP assets cannot be underestimated. Therefore, business owners, well-known personalities, authors, artists and inventors should duly protect their intellectual property (eg, trademarks, inventions, creations and artwork) prior to their death and establish a protection plan for posterity.

**Protecting IP rights after death**

First, parties interested in protecting their IP rights after death should seek registration for all of their trademarks and creations to prevent third-party misuse or misappropriation.

If personal names are used as trademarks, the registration should be owned either by the person themselves – and licensed to companies that wish to use the mark – or by their own company. However, it is important to note that business changes may impair their rights over the use of their name. Therefore, parties should consider the long-term consequences of their decisions and any agreements made.

Parties should also establish a proper estate plan which considers:

- the value of the assets, which will affect inheritance tax;
- whether the assets should be left to a particular person, institution or charity (different assets can go to different heirs or successors); and
- how the assets should be handled – here, it is important to indicate clear instructions and compile proper documentation.

These measures will ensure that the legacy and goodwill associated with intellectual property will be preserved after the death of its original owner.

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