

Off-field football dispute: Brazilian spray patent battle



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Introduction

In recent years a patent dispute about a spray used in football matches has persisted in Brazil. The spray is used to mark the distance between the defenders and the ball when a free kick is taken. When introduced, it was considered a game changer because it:

- helped players to comply with the distance rule;
- strengthened referees' authority; and
- reduced the time needed to take a free kick after a foul, thus making matches more dynamic.

The spray's inventor is Brazilian. He founded a company to exploit and market the products derived from his patents, which covered the spray's composition in Brazil and in many other countries.

At the end of October 2020, the spray patent expired in Brazil. However, the disputes over the spray continued.

Disputes

There have been two court actions on this matter:

- an infringement action filed by the inventor's company against the International Federation of Association Football (FIFA); and
- a nullity action filed by FIFA to contest the patent's validity.

Filing a nullity action is a common strategy adopted by infringement lawsuit defendants.

A third party in Brazil also requested the administrative nullity of the patent. However, in 2016 the Brazilian Patent Office (BRPTO) maintained the patent on the grounds that the arguments submitted against it were insufficient to invalidate the patentability requirements.

Inventor's arguments

Before the Rio de Janeiro State Court, the inventor stated that the Brazilian Football Confederation (CBF) had approved his invention in 2002 and that the use of the spray had become mandatory in all football games organised by the CBF. The spray had also been tested in several football championships throughout Latin America.

The inventor further affirmed that he had tried to negotiate the use and sale of the patent with FIFA, but that the negotiations had been unsuccessful, despite numerous tests performed in different championships. However, the inventor stated that during the negotiation process, he had learned that a third party had been copying his invention since 2009, allegedly with FIFA's endorsement.

FIFA's arguments

FIFA stated that the inventor's allegations were unfounded and that he had attempted to force the sale of the patents. Further, the inventor had failed to technically and commercially develop his product, resulting in the spray having been surpassed by other innovative sprays produced by third parties.

FIFA also stated that patent holders in several other countries had created sprays that were more appealing to consumers due to various attributes, including:

- a less greasy composition;
- better visibility on the field;
- a faster disappearance; and
- an ecologically friendlier composition.

There was no indication that such products infringed the inventor's patent.

Decision

In June 2020 a first circuit judge rejected the inventor's claims in the infringement action on the grounds that the inventor had not proved that the products used by FIFA corresponded to infringed copies of his products or that any damage had been caused.

The inventor appealed this decision before the higher courts, but the appeal is still pending examination.

The nullity action is awaiting the conclusion of expert evidence, particularly regarding the product's inventiveness and whether the patent granted by the BRPTO sufficiently fulfils the disclosure requirement.

Comment

Prior to this dispute the spray had been used in all official matches in Brazil since 2002. However, football fans may have observed the effects of the dispute already, as referees were not allowed to use the spray in any official match in 2020, including the Brazilian Football Championship matches which started in August 2020.

Considering the extent of the legal dispute, the next football world cup champion is likely to be known long before the winner of the lawsuit. Football and patent fans should stay tuned to keep track of both battles.

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