



The Legal 500 Country Comparative Guides

Portugal: Intellectual property

This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in Portugal.

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Contributing Firm



VdA

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The authors would also like to thank Catarina Seidenader de Almeida (Associate at the ICT department) for her invaluable contribution for the chapter.

1. **What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).**

- Patents
- Supplementary Protection Certificates
- Utility models
- Trade secrets

a)

- Trademarks
- Logotypes
- Company names

b)

- Appellations of origin and Geographical indications
- Copyright and related rights
- Rights to prevent unfair competition

c)

- Copyright and related rights
- Database rights
- Topography of semiconductor products
- Designs or models
- Domain names
- Plant varieties
- Trade secrets

2. **What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?**

- Patents: patents expire **20 years** as from date of application.
- Supplementary Protection Certificates: the provisions of article 13 of the Regulation (EC) no 469/2009 are entirely applicable.
- Utility models: **6 years** as from date of application. Renewable twice for 2-year periods (total term shall not exceed **10 years**).
- Trademarks: **10 years** as from date of application. Renewable for equal periods without

limitation.

- Logotypes: **Same as trademarks.**
- Company names: **Unlimited**, subject to the effective use of the company name.
- Appellations of origin and Geographical indications: **Unlimited.**
- Topography of semiconductor products: **10 years** as from date of application, or the date in which the topography was, in the first time, exploited in any territory, if this occurred before.
- Design or model: **5 years** as from date of application; renewable totally or partially, by equal periods of 5 years, up to a total term of **25 years.**
- Domain names: Registered for periods of 1, 3 or 5 years and renewable for equal periods without limitation.
- Copyrights: In general terms, the author's rights expire **70 years** after the author's death, despite the work having been published or disclosed posthumously.
- Related Rights: In general terms, **50 years** after the first public execution or transmission;
- Trade secrets: **Unlimited.**

3. **Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?**

Apart from the general provisions referred to in point 5. below, and with reference to **Patents**, there are special rules which apply to employment contracts wherein inventiveness is covered. In such case, the right to the invention belongs to the employer. In case inventiveness is not specifically compensated in the contract, the employee has the right to be remunerated according to the importance of the invention. Such regime is also applicable, *mutatis mutandis*, to inventions made through a commission and to Public Administration and its employees.

The Industrial Property Code ("IPC") also sets specific provisions regarding the ownership of patent rights with reference to R&D activities included in the scope of activity of public legal bodies. The general rule is that the ownership of inventions carried out by employees as a consequence of such research activities belongs to such public legal body. We note that the IPC extends this regime to **utility models, topography of semiconductor products and designs or models.**

As a general rule for **Copyright**, the rightsholder shall be the corresponding intellectual creator, unless agreed otherwise. Regarding exceptional cases, i.e. work created by order or by employees, the copyright holder might be agreed on by contract and, lacking any agreement, the rights regarding a work created by order or by employees are presumed to be held by its intellectual creator.

4. **Which of the intellectual property rights described above are registered rights?**

Patents, SPCs, utility models, trademarks, designs or models, topographies of semiconductor

products, awards, logotypes, appellations of origin and geographic indications.

5. **Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?**

The right to **patents** and **utility models** shall belong to the inventor or his/her successors.

Regarding **topographies and designs or models**, in principle the right to registration belongs to the creator or designer, or his successors.

Relating to **trademarks**, the right to register belongs to those with a legitimate interest.

Relating to **logotypes**, any natural or legal person may apply for registration, provided they have a legitimate interest.

Finally, regarding **appellations of origin and geographic indications**, the right to register belongs to natural or legal persons, public or private, who are given the capacity to acquire the registration.

The **registration procedure** usually involves submitting the application, followed by a formal examination by National Industrial Property Institute ("INPI"), and publication in the Industrial Property Bulletin. Then, INPI's decision of grant or refusal, which follows a substantive examination, is also published. If there is opposition or submission of observations (only for trademark and logotype applications) by a third party, the substantive examination which precedes grant or refusal is only done after the applicant's defence/reply to opposition and/or third-party observations or the end of the term to file such defence/reply.

Copyright and related rights may also be subject to registration (which does not have a constitutive nature), leading to the presumption that the registered rightsholder is entitled to the relevant right.

6. **How long does the registration procedure usually take?**

The registration procedure for a **patent** or **utility model** usually takes around 2 years, if there is no opposition. The procedure regarding the remaining I.P. rights usually takes around 4–6 months (if there is no opposition, in the case of trademarks and logotypes). Registration procedures for copyright and related rights take about one month.

7. **Do third parties have the right to take part in or comment on the registration process?**

Regarding **patent, utility model, trademark and logotype applications**, interested third

parties may file oppositions, within two months following the publication of the application. Regarding **trademark and logotype** applications, third-party observations may also be submitted within the same deadline.

8. What (if any) steps can the applicant take if registration is refused?

INPI's decisions may be appealed to the Intellectual Property Court ("I.P. Court), within two months of publication of the decision. The decisions from the I.P. Court may be further appealed to the higher courts under the general civil procedure regime.

9. What are the current application and renewal fees for each of these intellectual property rights?

The current application and renewal fees for industrial property rights can be consulted in the following link:

<https://inpi.justica.gov.pt/Portals/6/PDF%20INPI/Taxas/Tabelas%20de%20taxas/Tabela%20de%20Taxas%20-%202019.pdf?ver=2019-07-04-203527-320>

Submissions on paper always cost twice as much as submissions on-line.

Copyright and related rights registration's price is 80€ on paper and 60€ if online.

10. What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?

As regards industrial property rights, failure to pay any renewal fees leads to expiry of the correspondent registration. However, an application for revalidation, which is subject to the payment of three times the fees due, can be filed within one year as from the publication of the notice of expiry.

11. What are the requirements to assign ownership of each of the intellectual property rights described above?

The IPC contains a general provision regarding the assignment of **Industrial Property rights**, with the following particularities:

1. Assignments can be total or partial, except for the rights emerging from patents, utility models and semiconductor topography registries, which can only be subject to a total assignment;
2. This regime is also applicable to rights emerging from applications;
3. Assignment must be made in writing;

Concerning the assignment of **copyright**, the Copyright and Related Rights Code (“CRRC”) determines that total assignment of copyright must be performed by a public notarial deed, mentioning the transmitted work and the price (if applicable).

Partial assignment of copyright demands a written document with a notarial certification, which shall refer the specific assigned faculties of use and the agreed conditions.

12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?

As regards **Industrial Property rights**, assignments must be recorded before INPI to be effective against third parties.

13. What are the requirements to licence a third party to use each of the intellectual property rights described above?

Concerning **Industrial Property rights**, a license can cover the entirety or part of the rights, can be either free of charge or onerous, can cover the entirety or part of the Portuguese territory and can last for the entire term of the right or a shorter period.

License agreements must be made in writing.

There are some specific mentions that should be included in the agreement, even though some presumptions are applicable in this context. In particular, the following aspects should be highlighted:

1. Licenses are presumed to be non-exclusive. Unless stated otherwise, the grant of an exclusive license does not prevent the holder from exploiting the licensed right;
2. Unless stated otherwise, the right acquired through a license may not be assigned without the holder’s written consent;
3. If the grant of sub-licenses is not expressly authorized, it shall be subject to the holder’s written consent;

Regarding **copyright**, the CRRC establishes that the rightsholder may license third parties with rights of e.g. use, publication, distribution, exploring of the work, namely specific faculties inherent to copyright. Such license shall be made in writing, mention its term, territorial scope and price (if applicable), being presumed to be onerous and non-exclusive.

14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?

As regards Industrial Property rights, licenses must be recorded before INPI to be effective against third parties.

15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

The right to enforcement does not depend on the license's nature, but rather on the specific terms of the corresponding agreement.

16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?

There are various infringing actions which are punishable by criminal sanctions, such as (i) prison sentence of up to 3 years or a fine of up to 360 days (applicable to e.g. counterfeiting and violation of patent exclusivity), (ii) prison sentence of up to 3 years and a fine of up to 150 to 250 days (applicable to e.g. counterfeiting in infringement of copyright) and (iii) prison sentence of up to 18 months or a fine of up to 120 days (applicable to e.g. concealment of counterfeit products).

Due to the semi-public nature of the crimes foreseen in the IPC, the investigation of such crimes depends on a complaint being filed by the offended party. Regarding copyright, the proceedings do not depend on a complaint by the rightsholder, depending on the case.

17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.

In general, civil enforcement options available are preliminary and definitive injunctions prohibiting the infringing conduct or the continuation thereof, subject to the imposition of a fine and/or damages.

Damages claims for infringement are also allowed in case of negligent or wilful infringement.

Arbitration proceedings are also available in relation to disputes concerning intellectual property rights.

In relation to some actions, administrative proceedings are also available. These begin with filing of a complaint before the Authority for Economic and Food Safety, with INPI being the competent authority to apply the fines and ancillary sanctions that might result therefrom.

18. What is the length and cost of such procedures?

A civil main action takes typically one to three years, depending on the case's complexity and the number of pending cases in the I.P. Court. Preliminary injunction proceedings may take between six and eighteen months.

Filing a civil action before the I.P. Court requires payment of court fees which vary in accordance with the action's (e.g., these are fixed in 612 € by reference to an action's value of 30.000 to 40.000 €). Initiating preliminary injunction proceedings requires payment of court fees amounted to 306 €, unless the proceedings' value is over 300.000 € - in such case, the court fees increase up to 816 €.

As regards arbitration, costs are usually agreed between the Tribunal and the Parties and also vary in accordance with the value of the proceedings. Arbitration proceedings usually last between six months and two years, depending on the case's complexity.

19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.

The I.P. Court, with seat in Lisbon, has exclusive jurisdiction to decide cases of IP enforcement.

Preliminary injunctions may be granted based on threat of infringement or actual infringement of IP rights. These proceedings are of urgent nature and usually include only two written pleadings prior to the hearing. Civil main actions follow the general regime provided for in the Civil Procedural Code and usually include three written pleadings: statement of claims, defence and, whenever a counterclaim is formulated in the defence, a reply. However, courts have, under the adversarial principle, been accepting the claimant's reply to objections raised by the defendant in its defence, like, for instance, the objection of invalidity of the IP title.

The parties must list, in their initial pleadings, the evidence intended to be used during the proceedings (the 'probationary application'). The initial written procedural phase may last up to four-five months.

The hearing phase may be divided into two different periods: preliminary hearing and final hearing. The preliminary hearing, which may be omitted in some cases, mainly serve the purpose of conciliating the parties and preparing the final hearing.

During the final hearing, the court, presided over by a single judge, hears the testimonies of both the parties and the witnesses, as well as final oral arguments. The hearing is audio recorded. The decision should then be rendered within 30 days as of conclusion of the hearing. Depending on the length and technical complexity of the pleadings, the amount of evidence submitted and the amount of cases pending before the IP Court at that time, the hearing phase may last up to seven months.

IP Court's decisions can be appealed to higher courts (Lisbon Court of Appeal and Supreme

Court of Justice).

20. What customs procedures are available to stop the import and/or export of infringing goods?

Customs procedures follow Regulation (EU) no. 608/2013 concerning customs enforcement of IP rights, being the offended parties entitled to complaint before the Customs Authority, the Authority for Economic and Food Safety or any criminal police body.

21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.

No, non-court dispute resolution mechanisms regarding intellectual property rights are always voluntary.

22. What options are available to settle intellectual property disputes?

Settlement of IP disputes may occur before legal actions are initiated or while these are pending and are subject to a vast margin of discretion by the Parties, as long as the settlement terms do not contradict imperative legal rules nor offend principles of antitrust laws.

23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?

The protection granted to all IP rights revolves around preventing unauthorized third parties from utilising, producing, manufacturing, selling or otherwise economically exploiting the subject-matter protected by the relevant rights, thus infringing the holder's exclusive or the one of licensees.

In general terms, for evidentiary purposes, the right holder must allege and prove that the alleged infringer has performed any actions which invade the exclusive granted by the right at stake in any form provided by law.

Portuguese law also provides for contributory infringement, since the entry into force of the new IPC in 2019.

24. How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are available

for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

In Portugal, there are no technical judges adjudicating on IP related cases.

Experts usually intervene in court actions in the following ways:

1. As technical advisors to assist the court;
2. As technical advisors to assist the parties;
3. Deposing in trial as expert witnesses;
4. Providing written opinions on behalf of the parties;
5. Providing written expertise, conducted by a single expert or a team of experts, by decision of the court.

The IPC and the CRRC provide for measures to obtain and preserve evidence of infringement.

These diplomas establish that, whenever elements of evidence are under control of the counterparty or a third party, the interested party may request the court to compel them to provide such evidence.

Also, with regards to preservation of evidence, whenever there is a violation or a founded fear of serious and hardly reparable harm to an IP right or trade secret, the interested party may request the court to impose urgent effective measures to protect evidence from the alleged harm.

Further to these measures, the interested Party may also request the provision of detailed information regarding the origin and the distribution network of goods or services over which there is a suspect of infringement of IP rights or trade secrets.

Discovery proceedings are not available.

25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?

Witness depositions are subject to the judge's free evaluation.

As a rule, witnesses appointed by the Claimant are heard in the first place.

Witnesses are firstly examined by the appointing party's counsel and cross-examined by the other party's lawyer. The scope of cross-examination is limited to the facts on which said witness has deposed.

Although testimonial evidence is generally provided orally before the judge (in presence or through videoconference), there is also the possibility to provide written deposition, but only in cases of impossibility or severe difficulty to attend the hearing, and subject to the Parties' agreement. Therefore, written depositions are not common, especially in judicial proceedings.

Written depositions (i.e. witness evidence provided in written) differ from written technical opinions, which are perceived as documentary evidence and can be submitted before first instance Courts at any procedural stage.

26. What defences to infringement are available?

Non-infringement and invalidity are the most common grounds of defence.

Interested parties can also invoke (apart from general procedural objections):

1. Legal limitations of the rights;
2. Exhaustion of rights;
3. Non-opposability; or
4. Existence of a license.

27. Who can challenge each of the intellectual property rights described above?

Declarations of nullity or annulment of patents, SPCs, utility models and topographies of semiconductor products may be requested by the Public Prosecutor or any interested party. Declarations of nullity or annulment of designs or models, trademarks, logotypes, appellations of origin, geographic indications and awards may also be requested by any interested party.

28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

Interested parties may submit opposition to patents, utility models, trademarks, logotypes and designs and models applications within two months as of publication of the applications.

Nullity of an IP title can be invoked in court at any time, as a defence or as claim or counterclaim. Judicial actions or requests filed before INPI seeking for annulment of the administrative acts granting patents, utility models, trademarks, logotypes, designs or models, topographies of semiconductor products, awards, appellations of origin and geographic indications should be filed within five years as from the order which granted the respective right.

29. Briefly, what is the forum and the procedure for challenging each of these

intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?

Declarations of nullity or annulment of **designs or models, trademarks and logotypes' registrations, appellations of origin and geographic indications** shall result from an INPI's decision (which has an administrative, and non-judicial, nature), except when it results from a claim or a counterclaim filed in the context of judicial proceedings. INPI's decisions referred to above may be appealed to the I.P. Court.

Designs or models may be found invalid if they are not novel (i.e. if an identical design or model has been disclosed to the public before the application or the claimed priority date) or if they are not distinctive in character (i.e. if the overall impression to an informed user does not differ from the overall impression caused by any earlier design or model).

Trademarks may be annulled, for instance, if **(i)** they are confusingly similar with all or part of a trademark or logotype previously registered by another person for, respectively, identical or similar products or services, or to distinguish an entity whose activity is identical or similar to the products or services for which the trademark is registered, or **(ii)** if it consists of signs devoid of any distinctive character and **(iii)** if it unauthorizedly reproduces or imitates a business or corporate name, or merely a characteristic part thereof, if it is likely to mislead or confuse the consumer. The same grounds of invalidity apply, *mutatis mutandis*, to **logotypes**.

Appellations of origin and geographic indications may be annulled, for instance, if the application was made by a person without the capacity to acquire them, if they constitute a reproduction or imitation of an already registered appellation of origin or geographic indication, if they infringe other industrial property rights or copyright or if they may favour unfair competition.

A declaration of nullity or annulment of **patents, SPCs, utility models and topographies of semiconductor products** may only result from an IP Court's decision.

Patents and utility models may be declared invalid if the covered invention is not novel (i.e. it was already part of the state of the art), if it is considered obvious for the skilled person of the field, if they fail to have an industrial use or if they are not disclosed in a way which enables the skilled person to put the invention into practice.

SPCs may be found invalid for failing to comply with the requirements established in Regulation (EC) no. 469/2009 of 6 May 2009, particularly those set forth in article 3, which establishes the legal conditions for obtaining a SPC.

30. **Are there any other methods to remove or limit the effect of any of the intellectual**

property rights described above, for example, declaratory relief or licences of right?

Any interested party may request the declaration of expiry of a trademark registration if the trademark has not been subject to serious use for a period of five consecutive years, unless there are just grounds for the non-use. In such case, the burden to demonstrate serious use lies with the trademark owner.

While non-infringement declarations are procedurally possible, these are extremely scarce.

31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

The remedies set out in the IPC and the CRRC are mostly in line with Directive 2004/48/EC on the enforcement of IP rights. Accordingly, apart from injunctions (preliminary or otherwise, and those associated with a penalty payment in cases of non-compliance) and orders for compensation for damages, the court may order three further types of measure, subject to a standard of necessity and proportionality: (1) recall, (2) removal from the channels of commerce and distribution, or (3) destruction of the infringing goods.

The Court's decision may also include inhibitory measures, notably a temporary prohibition to perform certain professional activities, or to participate in fairs or markets, and a temporary or definitive closure of the business.

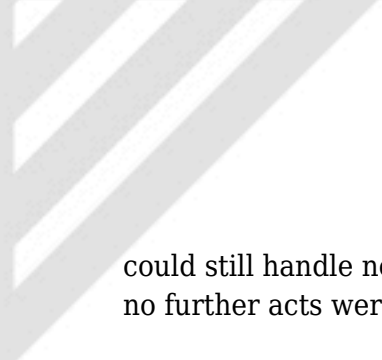
32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?

Filing enforcement proceedings is subject to the payment of court fees which vary in accordance with the action's value.

Either in declaratory or enforcement proceedings, the winning party may ask the counterparty to proceed with reimbursement of all court fees paid by the winning party, plus 50% of all legal fees paid by the Parties to compensate attorney's fees, as well as the costs incurred in with translations, witnesses' displacement, court's advisor, experts (when expertise is ordered by the court) and certificate fees (when ordered by the court).

33. Has the COVID-19 pandemic caused any changes (temporary or permanent) to the protection or enforcement of intellectual property? For example, changes to deadlines, filing or evidence requirements or court processes.

The Covid-19 pandemic had an impact mostly on pending litigation. The Parliament enacted laws to regulate provisional and exceptional measures governing the epidemiologic situation. Courts continued to work in relation to some urgent proceedings, to the extent possible, and



could still handle non-urgent proceedings and issue final decisions on such proceedings when no further acts were necessary for such purpose.

All deadlines for procedural acts which had to be performed in main actions pending before judicial, administrative and arbitral courts were stayed while the exceptional situation lasted, with its termination (and the consequent end of the mentioned regime) being determined by another legal diploma.

Regarding IP protection, INPI remained in operation but suspended, for a certain period, all procedures and procedural deadlines. Then, it was established that all acts should be submitted exclusively through INPI's online services. In result of this limitation, deadlines for any acts before INPI that were stayed due to the exceptional legal measures in force resumed its normal counting.