
WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

Luiz Edgard MONTAURY PIMENTA
Montaury Pimenta, Machado & Vieira de Mello
Rio de Janeiro
Brazil



Nationality: Brazilian

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

Law Degree, Candido Mendes University of Law, 1982.

LANGUAGES

English, Spanish and Portuguese.

PRESENT POSITION

Trial lawyer, Industrial Property Agent and Montaury Pimenta, Machado & Vieira de Mello's senior partner. With over 30 years of experience in the Intellectual Property field, heads the firm's Litigation team, as well as coordinates different departments within the firm. Currently Vice President of the international association The Global Network of National IP Practitioner Associations (GNIPA), and was the president of ABPI (Brazilian Association of Intellectual Property) from 2018 to 2021.

Advises and represents domestic and international clients in a wide range of medium and high complexity IP disputes, covering several technologies and areas in the Federal and State Courts of Brazil, including the Superior Courts. Among the cases represented, are those related to patents, trademarks, copyrights, domain names and unfair competition. Is a member of the Intellectual Property Task Force of AMCHAM (American Chamber of Commerce in Brazil) and is a panelist at the domain names dispute resolution centers of WIPO (World Intellectual Property Organization), NAF (National Arbitration Forum) and ABPI and, as such, has been responsible for several important decisions involving crossborder IP disputes.

Recognized by the highest international rankings, is an active speaker at IP events in Brazil, USA, Latin America and Europe and is the author of numerous publications in area of expertise. In 2021, was awarded by the Rio de Janeiro State School of Judiciary, the EMERJ MEDAL OF MERIT in recognition of the relevant services provided to the legal practice.

June 14, 2022

PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Intellectual Property Lawyer since 1982.

MEMBERSHIP IN PROFESSIONAL BODIES

Brazilian Association of Industrial Property Agents (ABAPI);
 Brazilian Association of Industrial Property (ABPI);
 Brazilian Bar Association (OAB/RJ ; OAB/SP);
 Brazilian Association of Lawyers in São Paulo (AASP);
 International Trademark Association (INTA) ;
 Intellectual Property Owners Association (IPO);
 American Chamber of Commerce in Brazil (AMCHAM);
 International Association for the Protection of Intellectual Property (AIPPI).

AREAS OF SPECIALIZATION

IP Litigation, Patent Litigation, Trademark Litigation, Unfair Competition Litigation, Software Litigation, Copyright Litigation, Life Sciences Litigation, Trade Dress, Trademarks, Domain Name Disputes, Fashion Law, Advertising Law, Anti-Piracy Programs, Entertainment Disputes.

EXPERIENCE IN INTELLECTUAL PROPERTY

Intellectual Property Lawyer since 1982.
 Member of OAB/RJ Fashion Law Committee.
 IP Extension Course – Professor at EMERJ – (Oct / 21).
 President of the Brazilian Intellectual Property Association (ABPI)- (2018-2019/2020-2021).
 Attorney General for the Brazilian Intellectual Property Association (ABPI) (2014-2015).
 Member, INTA International Panel of Neutrals and International Committee - Counterfeiting & Enforcement Group.
 Member, IP Committee of the American Chamber of Commerce (AMCHAM).
 Counselor, Brazilian Intellectual Property Association (ABPI), (2000-2001, 2005-2007 and 2010-2011).
 Attorney General, Brazilian Industrial Property Agents Association (ABAPI), (1996-2001 and 2005-2007).
 Member, INTA Committee on Trade Dress (2003-2005).
 Member, INTA International Committee – Famous & Well Known Marks (2014-2015).
 Vice-President, Brazilian Industrial Property Agents Association (ABAPI) (2002-2005).
 Member, INTA International Committee, Anti-Counterfeiting Enforcement Group (1994-1998 and 2000-2001).
 WIPO Panelist for Domain Names Disputes.
 Arbitrator, National Arbitration Forum (NAF), USA.
 Panelist, Chamber of Dispute Resolution (CASD-ND), ABPI.
 Professor, Postgraduate Program on IP, Centro Federal de Educação Tecnológica (CEFET), (2001).
 Professor, Postgraduate Course on Intellectual Property Law, Fundação Getúlio Vargas (FGV), (1999-2000).
 Member, ABPI Trademarks committee(1996-99) and Domain Names Disputes Committee (1999-2000).

EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Was responsible for handling the first domain name dispute case in Brazil in court and since then has been representing one of the parties involved in a wide range of disputes in court and different chambers.

Also a panelist at the domain names dispute resolution centers of WIPO (World Intellectual Property Organization), NAF (National Arbitration Forum) and ABPI and, as such, has been responsible for several important decisions involving crossborder IP disputes.

MAJOR PUBLICATIONS

"Young people and innovation is the theme of the World Intellectual Property Day", Lexology, April 2022.
 "Brazilian Central Government is sentenced to secure resources for the Brazilian Patent and Trademark Office", Lexology, April 2022.
 "2021 highlights in Brazil: BPTO", ILO – International Law Office, January 2022.
 "Luxury Law Comparative Book 2022", Author of chapter for jurisdiction - Brazil, December 2021.
 "The Effects and Consequences of the Brazilian Supreme Court Decision to Abolish the Minimum 10-Year Term for Patents", IPO (Intellectual Property Owners Association), July 2021.
 "Brazilian National Strategy for Intellectual Property (ENPI)", IPLink Asia, February 2021.
 "Legislative overview – Brazil", ILO – International Law Office, February 2021.
 "Brazilian National Strategy for Intellectual Property (ENPI)", Lexology/ILO, December 2020.
 "The Brazilian Patent: A Soap Opera or Novel", Lexology, August 2019.
 "Intellectual Property is the key to Brazilian development", ABPI Newsletter, May 2019.
 "Disclaimers in Trademark Examination", Expert Guides, May 2016.
 "New procedural rules in Brazil and their impact on IP litigation", World Trademark Review, March 2016.
 "The Changing Face of IP Law in Brazil", Inside the Minds: IP Client Strategies in Central and South America, 2009.
 "Trademark Cancellations: International Practice and Procedures ", INTA (International Trademark Association)- Content Contributor since 2007.
 "How to Protect Famous Trademarks in Brazil", Managing Intellectual Property Magazine – Américas IP Focus 2006, October 2006.
 "Domain Name Piracy", Trademark World, April 1999.
 "Using Criminal Procedures for Trademark Piracy in Brazil", Trademark World, March 1996.

EXPERIENCE IN COURT LITIGATION

More than 25 years in IP Litigation in Federal and State courts in Brazil, including superior courts, and coordinating court cases in other countries for Brazilian clients.
 Luiz's experience includes patent, trademark, copyright, trade dress, infringement, and invalidity lawsuits in various areas including pharma, telecon, fashion, entertainment, etc.

Also, experience includes litigation regarding license agreements, franchising agreements, transfer of technology agreements and domain names disputes.

PROFESSIONAL TRAINING IN ARBITRATION

Attended several arbitration courses in Brazil and is an arbitrator for ABPI (Brazilian Intellectual Property Association) Arbitration Center for IP Disputes.

EXPERIENCE IN ARBITRATION

Has handled several IP arbitration disputes, representing one of the parties involved in the dispute.

PROFESSIONAL TRAINING IN MEDIATION

Attended a mediation training course at INTA.

EXPERIENCE IN MEDIATION

Has conducted some mediation cases representing one of the parties involved.

ARBITRATION EXPERIENCE
SUMMARY TABLE

Type	Administering Institution		Role			
	Name	Number of Arbitrations	Presiding Arbitrator	Sole Arbitrator	Co-Arbitrator	Counsel
International Arbitrations	National Arbitration Forum (NAF)	15		12		3
	Ad Hoc					
	Others					
Number of Cases: Sub-Total		15		12		3
Domestic Arbitrations	Ciesp (Center of Industries in the State of São Paulo)	1				1
	CCI (Corte Internacional de Arbitragem da Câmara de Comércio Internacional)	1				1
	ABPI (Brazilian Association of Intellectual Property)	2				2
Number of Cases: Sub-total		4				4
TOTAL		19		12		7

MEDIATION EXPERIENCE
SUMMARY TABLE

Type	Administering Institution		Role			
	Name	Number of Mediations	Mediator		Counsel	
International Mediations						
	Ad Hoc					
	Others					
Number of Cases :						
Sub-Total						
Domestic Mediations	State Court of Rio de Janeiro	4			4	
	Court Annexed					
	Ad Hoc					
Number of Cases		4			4	
Sub-total						
TOTAL		4			4	