

CIRCULAR LETTER No. 0087

Re.: BPTO actions by aiming at to reduce its patent backlog

Dear Clients/Associates,

On July 3, 2019, the Brazilian Patent and Trademark Office (BPTO) published the actions to be adopted to fight patent backlog in two Resolutions: N° 240/2019 and N° 241/2019. BPTO's goal is to reduce, within up to two years, 80% of the total number of patent applications filed more than ten years ago, still outstanding their final decision.

In a first concrete action to face the accumulation of outstanding applications awaiting technical examination, BPTO had already started a pilot project in 2018 (Resolution n° 227, dated October 25, 2018), by establishing the analysis of Brazilian applications for patents of invention using the result of state-of-the-art searches performed by patent offices in other countries – for patent applications of the same family of the Brazilian application. Therefore, a Brazilian patent application having one or more equivalent applications already analyzed in other countries would be examined by BPTO based on state-of-the-art documents as already indicated in searches performed abroad, thus speeding up examination procedures.

The results reached by BPTO with this pilot project have been positive, causing the Office to decide to publish its Resolution n° 241/2019, transforming this initiative of using the results of searches performed by patent offices from other countries and international and regional organizations into regulated practice. Resolution N° 241/2019 entered into force on July 22, 2019 and, in practice, BPTO will publish on its Industrial Property Magazine (RPI) a preliminary requirement indicating the existence of search reports issued abroad for equivalent cases to the Brazilian application under examination and requiring the adaptation of claims and the presentation of arguments proving the existence of the novelty, inventive step and industrial application requirements.

The deadline for the presentation of a reply to that requirement is 90 days, otherwise the application will go to dead file, i. e. with no possibility of an administrative appeal. On the other hand, Resolution N° 240/2019 will enter into



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force on August 1, 2019 and is related to applications for patents of invention also awaiting technical examination for a long time, but which do not have searches performed by patent offices in other countries or international or regional organizations.

For patent applications in that situation, BPTO has decided to adopt a step already being undertaken for a few years by the European Patent Office (EPO), i. e. the issuance of a preliminary search report and a requirement to be fulfilled before the technical examination of the application starts. Therefore, the owner is required to adapt the application and/or present arguments on the patentability requirements within a deadline, otherwise resulting in the application going to dead file.

In this case, the object is to identify the owners who are still interested in the patent applications which are outstanding for a long time with BPTO and give continuity to the examination of these cases only. It is important to highlight that, for both Resolutions mentioned herein, eligible patent applications should fulfill the following requirements: a. *not having been submitted to the technical examination performed by BPTO*; b. *not being an object of a requirement of any kind for priority examination with BPTO*; c. *not being the object of background to examination as filed by third parties or by the National Sanitary Vigilance Agency – ANVISA*; and c. *having been filed until December 31, 2016*.

Now we must follow the issuance of the requirements and, especially, BPTO's reply to the requirements fulfilled in due time, to then verify if, in fact, the proposed decisions will result in faster and more attractive patent application proceedings for the protection of investments in technology and innovation in Brazil.

We will be closely following the development of these actions, and will be available for any doubts you may have on this issue.

Very truly yours,

/Carlos E. Fernandes/CEO



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