

Brazilian Patent Office issues a **new Resolution** addressing the **assignment of priority rights and assignment of PCT applications**

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Further to our newsletter 12/16, please be informed that the Brazilian Patent Office issued on 1.March 2017 the Resolution No. 179 revoking Resolution 174, which was addressed in said previous newsletter.

According to this new Resolution, the Brazilian Patent Office confirmed that assignment of priority documents signed after the filing date of the PCT application are acceptable. Therefore, the date when the assignment has been signed is not relevant for the acceptance of the document. However, it is still mandatory to submit such document within a period of 60 days counted from the entry date in Brazil together with a simple translation thereof into Portuguese language.

Additionally, in case the change of ownership of the PCT application has not been recorded at the International Bureau of WIPO, upon entering the national phase in Brazil, it will be necessary to submit a simple copy of the assignment document or similar document attesting the assignment of the PCT application, together with a simple translation thereof into Portuguese language.

For the last, if the assignment of ownership takes place after the entry date of the National Phase in Brazil, then the person of the applicant must be the same of the one indicated in the PCT application. In order to change the person of the applicant it will be necessary to follow the current assignment formalities for the recordal of the assignment. Namely, it will be necessary to submit the power of attorney in the name of the new owner as well as the transfer contract executed between the parties, duly signed by their representatives, having their signatures notarized and further legalized.

Please find attached hereto the English translation of Resolution 179. Should you require further information in this regard, please do not hesitate to contact us mail@kasznarleonardos.com.

MINISTRY OF INDUSTRY, FOREIGN TRADE AND SERVICES
BRAZILIAN PATENT AND TRADEMARK OFFICE

RESOLUTION/INPI/NO. 179, OF FEBRUARY 21, 2017

Subject: To improve the procedures for the entry into the national phase of international patent applications filed under the Patent Cooperation Treaty (PCT), with the INPI (Brazilian Patent and Trademark Office), as Designated or Elected Office.

SYNOPSIS OF THE DECISION

The PRESIDENT OF THE BRAZILIAN PATENT AND TRADEMARK OFFICE in the use of the legal and regimental attributions provided for in Decree 8.854, dated September 22, 2016, and by Ordinance No. 11 dated January 27, 2017.

DECIDE:

Article 1 – To improve the procedures for the national phase entry of international patent applications filed under the Patent Cooperation Treaty (PCT), with the INPI (Brazilian Patent and Trademark Office), as Designated or Elected Body.

Article 2 - If the interested party/applicant contained in the filing application for the national phase entry is different from the one who filed the previous application, whose priority is being claimed, a copy of the corresponding assignment document regarding the prior application or declaration of assignment or equivalent document, hereinafter, accompanied by a simple translation should be presented, without the need of notarization/consular legalization in the country of origin.

Paragraph 1 - The assignment document must contain identifying data of the previous application, which gives rise to the priority right, as well as the assignor(s) and assignee(s) data.

Paragraph 2 - The presentation of the assignment document shall occur within a period of up to 60 (sixty) days from the date of delivery of the filing application for entry into the Brazilian national phase, and shall not depend on notification or requirement.

Paragraph 3 - The assignment document may be replaced by the declaration presented on the PCT international application filing form (PCT/RO/101 - Table VIII (iii)) according to Rule 4.17 (iii), as provided for in Rule 51 *bis* 1 to (iii) of the PCT Execution Regulation.

Article 3 - If there has been an assignment of the rights regarding the filing of the PCT international application in the international phase of the Treaty, and if this assignment has not been regularized with the International Bureau (IB) of the PCT still in the international phase, the interested party of the application for entry in the Brazilian national phase must present the document of assignment, declaration of assignment or equivalent document upon the submission of the application for entry into the Brazilian national phase,

accompanied by a simple translation, without the need of notarization/consular legalization in the country where the assignment was signed.

Paragraph 1 - The interested party of the application for entry into the Brazilian national phase must be the assignor(s) and the assignee(s), when the assignment is partial and only the assignee(s) when assignment is total.

Paragraph 2 - The assignment document shall contain identifying data of the PCT international application, as well as the assignor(s) and assignee(s) data.

Article 4 - The right of filing and the right of priority shall be presumed to be granted in the case of patent applications where the inventor is an employer or contractor of the inventor, provided that the document proving such relationship or equivalent document is presented.

Article 5 - In case the application for entry into the national phase does not comply with the provisions of art. 3 of this Resolution, a requirement will be formulated so that the defect will be remedied within 60 (sixty) days, otherwise the PCT international application will be considered withdrawn in relation to Brazil.

Article 6 - If the assignment of the rights regarding the filing of the PCT international application occurs after the submission of the application for entry into the national phase, the interested party of the application for entry into the Brazilian national phase must be the applicant of the international PCT application.

Sole Paragraph - The assignment must be application in an appropriate form accompanied by the confirmation of payment of the appropriate fees (GRU) related to the change and transfer.

Article 7 - The provisions of this Resolution are applied to applications in progress.

Article 8 - Articles 28 and 32 of Resolution No. 77 of March 18, 2013 are hereby revoked.

Article 9 - Article 13 of Normative Instruction No. 31 of December 4, 2013 is hereby revoked.

Article 10 - Resolution No. 174 of December 6, 2016 is hereby revoked.

Article 11 - This Resolution enters into force on the date of its publication in the Electronic Journal of Industrial Property of INPI (Brazilian Patent and Trademark Office).

Rio de Janeiro, February 21, 2017.

LUIZ OTÁVIO PIMENTEL
President