

## Resolution 212/09 of the Brazilian Patent Office

### Regulates The Possibility of belatedly entering the national phase on an international application

By Gustavo Barbosa | [gustavo.barbosa@kasznarleonardos.com](mailto:gustavo.barbosa@kasznarleonardos.com)

**T**he Brazilian Patent Office has finally regulated the procedures concerning the possibility of entering the national phase of international applications after the expiry of the 30-month term foreseen in the PCT.

As you may know, the PCT has suffered many recent changes. One of them was the introduction of Rule 49.6 which allows a designated office to accept an application after the end of the 30-month term. The applicant must show that the failure to meet the deadline was unintentional or occurred in spite of due care required by the circumstances. This rule has been in force since 01 January 2003, and each office may apply either criterion or both.

In Resolution 212/09, dated 14 May 2009, the Brazilian Patent Office did not specifically mention these two criteria, but rather defined fortuitous case and force majeure as the two reasons that may justify the delay by the applicant. The definition given to these two criteria is one and the same: "the forthcoming unpredictable and unavoidable event, natural or deriving from human action, superior and extraneous to the applicant's will that, by the influence thereof, prevented him from carrying out the act that he was supposed to"

In either situation, a request must be presented describing the facts that caused the delay, and evidence of such facts must be submitted. A tax must also be paid. The request will be examined by the Patent Office and a decision will be made as to either accept the application or not. If the request is denied, the application will be considered as withdrawn in respect of Brazil. An appeal may be lodged against such a rejecting decision.

This resolution is still very recent and we are not aware of any decision that might reveal the interpretation that will be given by the Patent Office to the two criteria in view of actual situations. In any way, we expect that normal force majeure reasons such as a postal strike, fire, etc will be accepted.

One point of special concern to us is the extensive use by our clients of electronic messages for transmitting filing instructions. We understand that, although extremely practical, electronic messages are not foolproof and sometimes, even if very rarely, they may go astray or simply not reach the intended addressee. This may happen for various reasons; the message being sent to an invalid address or filtered out by our spam filter are just two examples.

We receive tens of thousands of electronic messages every day. The crushing majority is garbage, and the sheer figures make it impossible to check. Furthermore, given the huge quantity of messages that arrive, records must be transient. This means that we may not be able to produce the necessary evidence showing that a given message was not received by us.

For all these reasons, and as we cannot foretell how the Patent Office will judge situations in which an electronic message is sent, but not received at our end, we strongly advise you to ensure that any message sent to us was properly acknowledged by the intended addressee in advance to a deadline, as we may not accept responsibility over any order for which this does not happen.

We are at your disposal for any assistance regarding this matter. Please write to your regular contact in our firm or to [mail@kasznarleonardos.com](mailto:mail@kasznarleonardos.com)

A translation into English of Resolution 212/09 is attached hereto for your reference.

#### RESOLUTION N. 212/09 14 May 2009

*Regulates the procedures for entering the national phase of international patent applications filed in accordance with the provisions of the Patent Cooperation Treaty (PCT), before the INPI, as Designated Office, after the time limit under article 22 of the Treaty.*

THE PRESIDENT OF THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY - INPI and the DIRECTOR OF PATENTS, making use of their regimential attributions, RESOLVE:

**Art. 1** This Resolution regulates the procedures for entering the national phase of international patent applications filed in accordance with the provisions of the Patent

Cooperation Treaty (PCT), before the INPI, as Designated Office, after the time limit under article 22 of the Treaty.

**Art. 2** The Applicant of an international patent application filed in accordance with the provisions of PCT, that, due to forthcoming fortuitous case or force majeure, failed to enter the national phase before the INPI within the time limit of 30 (thirty) months, counted from the priority date, may do it by means of a specific request together with evidence of the facts characterizing the fortuitous case or the force majeure, as alleged, as well as the tax receipt of the corresponding payment made in the amount in force at the time, and further legally required documents.

**Parag. 1** Fortuitous case, or force majeure, is deemed to be the forthcoming unpredictable and unavoidable event, natural or deriving from human action, superior and extraneous to the applicant's will, that, by the influence thereof, prevented him from carrying out the act that he was supposed to.

**Parag. 2** Priority date, for the purpose of computing the deadline of 30 (thirty) months referred to in the caput, under the provisions of Article 2, xi, of the PCT, is deemed to be:

- a) if the international patent application comprises one priority claim, in accordance with article 8 of PCT, the priority date will be the filing date of the patent application of which priority is claimed thereby;
- b) if the international patent application comprises more than one priority claim according to article 8 of PCT, the priority date will be the filing date of the earliest patent application, of which priority was claimed thereby; and
- c) if the international patent application does not comprise priority claim, according to article 8 of PCT, the priority date will be the filing date on the international patent application itself.

**Parag. 3** The time limit for entering the national phase of patent applications before the INPI referred to in the caput is of 2 (two) months, counted from the date of removal of the cause of the failure to meet the time limit under article 22 of the PCT, or of 12 (twelve) months, counted from the date of the expiration of the applicable time limit under the same article of the PCT, whichever expires first.

**Art. 3** The failure to comply with the time limit under Paragraph 3 of Article 2 of this Resolution will result in the withdrawal of the international patent application in Brazil, by virtue of article 24, (1), iii, of PCT.

**Art. 4** Once the request for entering the national phase of an international patent application after the time limit under article 22 of PCT is presented, it will be submitted to examination and, if it is suitably grounded and the facts characterizing the fortuitous cause, or force majeure alleged by the applicant are duly proved, the request will be accepted by INPI and the national phase of the patent application will be started.

**Art. 5** When the request for entering the national phase of a patent application after the time limit under article 22 of PCT is not suitably grounded or the facts characterizing fortuitous case, or force majeure alleged by the applicant are not duly proved, the request will be rejected, and the entry in the national phase of the patent application will be denied.

**Sole Paragraph.** It is possible to appeal from the decision that rejects the request and denies the entry in the national phase of the patent application, within the period of 60 (sixty) days, counted from the publication date of the decision of INPI, in accordance with the provisions of articles 212 to 215 of Law N. 9,279, of 14 May 1996.

**Art. 6** The appeals will be decided by the President of the INPI, closing the administrative proceedings.

**Art. 7** The present Resolution will enter in force on the date of its publication.

Jorge de Paula Costa Ávila  
President  
Carlos Pazos Rodriguez  
Director of Patents