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Brazilian Patent and Trademark Office published a new resolution regarding the assignment of priority rights as well as the assignment of the application in connection with PCT applications

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A Resolution No. 174 published by the Brazilian Patent and Trademark Office on 6 December 2016 established new rules for Brazilian National Phases of PCT applications regarding assignment of priority rights and the assignment of the application.

As can be noted in the attached English version of said Resolution, in case the applicant of the PCT application is different from the one indicated in the priority document, an assignment of priority document must be submitted within a period of 60 days counted from the Entry date of the National Phase in Brazil and such document must be dated prior to the international filing date of the application.

Additionally, in case the ownership of the PCT application has been changed during the international phase of the PCT application and such change in the person of the applicant has not been recorded at WIPO, it will be necessary to submit a simple copy of the assignment deed.

In case the change in the person of applicant is carried out after the entry date of the National Phase in Brazil, the application must be filed in the name of the applicant indicated in the PCT application and subsequently an assignment shall be filed before the Brazilian Patent and Trademark Office following the administrative proceedings of the Brazilian Patent Office.

It is also stated in this Resolution that the same applies to all cases that are undergoing the acceptance stage at the patent office. However, it is additionally stated that, during a period of 90 days counted from the publishing date of the present Resolution, assignment of priority rights signed after the international filing date will be accepted if they contain a clause stating that the same has retroactive effects. Such transitory acceptance is unclear and we believe that the Patent and Trademark Office shall provide further clarification.

Our local IP associations will most likely contest such Resolution formally, since there are reasons to question the Resolution's legality.

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 NO. 174, OF NOVEMBER 30, 2016

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** and the **PATENT DIRECTOR**, in the use of the legal and regimental attributions provided for in Decree 8.854, dated September 22, 2016,

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 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 assignment document must be accompanied by a simple translation, a declaration of the assignment or equivalent document.

Paragraph 3 - The assignment document must have been signed prior to the filing date of the international application filed under the PCT.

Paragraph 4 - The submittal of the assignment document shall occur within a period of up to 60 (sixty) days from the date of filing the request for entry into the Brazilian national phase, and shall not depend on notification or requirement.

Paragraph 5 - 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 5 - 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 this assignment upon the submission of the application for entry

into the Brazilian national phase, 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.

Paragraph 3 - The transfer document must be accompanied by a simple translation, a declaration of the assignment or equivalent document.

Paragraph 4 - The assignment document must have been signed prior to the date of submission of the application for entry into the Brazilian national phase.

Article 6 - In case the application for entry into the national phase does not comply with the provisions of art. 5 of this Resolution, an office action 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 7 - 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 requested in an appropriate form accompanied by the confirmation of payment of the appropriate fees (GRU) related to the change and transfer.

Article 8 - The provisions of this Resolutions are applied to the international patent applications filed under the PCT rules whose admissibility examination of the Brazilian national phase entry is in progress on the date of its publication in the Electronic Journal of Industrial Property - RPI.

Sole Paragraph - Within a period of ninety (90) days, the petition signed by the assignor of the priority to ratify the assignment whose proof is later than the date of the international filing shall be accepted.

Article 9 - Articles 17, 28 and 32 of Resolution No. 77 of March 18, 2013 are hereby revoked.

Article 10 - 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).

LUIZ OTÁVIO PIMENTEL
President

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Patent Director