

## The Brazilian Patent Office (BPO) defines the administrative proceedings of the PPH Pilot Program in cooperation with the European Patent Office (EPO)

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**A**s an alternative to accelerate examination of applications in the areas of Chemistry and Medical Technology (excluding pharmaceutical area), the Brazilian Patent Office has now published Resolution INPI/PR N°202/2017. This Resolution defines the administrative proceedings and the technical scope of the Patent Prosecution Highway (PPH) Pilot Program in cooperation with the European Patent Office (EPO).

The PPH BR-EPO Pilot Program starts on December 1st 2017, and shall be kept in force for 2 years. The BPO will accept up to 300 applications each year, thereby potentially resulting in the accelerated analysis of 600 patent applications within the proposed 2-year term.

The applications within the scope of the program shall belong to a patent family firstly filed in the BPO or in the EPO. In case of applications filed under the PCT, the filing should have been done in the respective Receiving Offices.

As already highlighted above, this pilot program is limited to patent applications directed to chemical and medical technologies, except for those in the pharmaceutical area. The resolution sets forth a list of the classes of the International Patent Classification that will be accepted, to wit:

	Technical Area	IPC Code
1	Basic chemistry	A01N, A01P, C05#, C06#, C09B, C09C, C09F, C09G, C09H, C09K, C09D, C09J, C10B, C10C, C10F, C10G, C10H, C10J, C10K, C10L, C10M, C10N, C11B, C11C, C11D, C99Z
2	Organic chemistry and fine chemicals	C07B, C07C, C07D, C07F, C07H, C07J, C40B, A61K8*, A61Q
3	Macromolecular chemistry and polymers	C08B, C08C, C08F, C08G, C08H, C08K, C08L
4	Medical technology	A61B, A61C, A61D, A61F, A61G, A61H, A61J, A61L, A61M, A61N, H05G

*\*Applications classified under A61K8 can join the program, provided that they do not have another A61K classification.*

To join the PPH Pilot Program, the following requirements must be met:

- I The notice of filing must have been published
- II The application must have been disclosed to the public;
- III Examination must have been requested;
- IV A response to a previous office action issued by the BRPTO cannot be pending;
- V The annuity fees must be in good order;
- VI The application cannot have had any other prioritized examination request granted and published in the Official Gazette;
- VII The application cannot be the object of judicial litigation in Brazil;
- VIII The application cannot be a divisional application, except for those originated from the direct division of the original application and originated from a lack of unity of invention objection by the Office of Earlier Examination (OEE)

For your further reference, attached to this newsletter you may find an English translation of the Resolution INPI/PR N°202. Should you wish to receive more information on the program or to indicate a patent application to join it, please do not hesitate to contact us by phone (+55 21 2113-1919) or via e-mail: [mail@kasznarleonardos.com](mailto:mail@kasznarleonardos.com)

MINISTRY OF INDUSTRY, FOREIGN TRADE AND SERVICES  
NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

RESOLUTION INPI/PR No. 202, OF OCTOBER 30, 2017

**Subject:** Institutes the Pilot Project of  
Shared Examination PPH INPI-EPO.

The **PRESIDENT** and the **DIRECTOR OF PATENTS, COMPUTER PROGRAMS AND TOPOGRAPHY OF INTEGRATED CIRCUITS** of the **NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY** [*Brazilian Patent and Trademark Office*], pursuant to the authority granted thereto as provided in Decree No. 8,854, dated September 22, 2016, and in light of the provisions of Article 152 of Administrative Ruling No. 11, dated January 27, 2017, and of Law No. 9,279 of May 14, 1996, [*Brazilian*] Industrial Property Law – LPI [*our I. P. Law*],

**DECIDE AS FOLLOWS:**

Article 1. This Resolution establishes the administrative procedure of the Pilot Project of Shared Examination *Patent Prosecution Highway* – PPH, agreed between the Brazilian Patent and Trademark Office (BPTO) and the *European Patent Office* - EPO, hereinafter designated as the Pilot Project PPH INPI-EPO.

Article 2. For the purposes of the provisions of this Resolution, the following definitions are adopted:

I - LPI: Law No. 9,279, of May 14, 1996;

II - CIP: International Patent Classification;

III - CUP: Paris [*Union*] Convention;

IV - PCT: Patent Cooperation Treaty;

V - RO: Receiving Office within the scope of the PCT;

VI - ISA - International Search Authority within the scope of the PCT;

VII - IPEA: International Preliminary Examination Authority within the scope of the PCT;

VIII - First Patent Application: a patent application with a priority right warranted for filing in another national patent office or international organization, as established by the CUP [*PUC*]; or international filing, within the scope of the PCT, without priority claim;

IX - Second Patent Application: a patent application, including an international one, which claims as priority the first patent application within the scope of the CUP [*PUC*]; or national phase of the first patent application within the scope of the PCT;

X - Patent Family; a set of patents and patent applications filed in more than one national patent office or international organization, wherein all such patents or patent applications claim at least the First Patent Application as constituting priority under the Paris Union Convention;

- XI - OFF: Office of First Filing - the patent office where the First Patent Application is filed;
- XII - OSF: Office of Second Filing - the patent office where the Second patent Application is filed;
- XIII - OEE: Office of Earlier Examination - the patent office that first notifies the decision of granting of a patent to an application of a patent family, irrespective of such office being the OFF or the OSF;
- XIV - OLE: Office of Later Examination - the remaining patent offices where there was filed a patent application of the same family of that which was decided by the OEE, and this patent application remains pending examination;
- XV – Suitable patent application: a patent application that fulfills the eligibility conditions established in this Resolution;
- XVI - Date of request: the date when was filed a petition of request of the shared examination exclusively by means of an electronic form;
- XVII - Sufficiently corresponding application: an application which subject matter described in the application filed at the OLE neither adds nor modifies the subject matter deemed patentable at the OEE, even taking into account differences resulting from translations, both belonging to the same patent family;
- XVIII - Sufficiently corresponding claim: a claim in which the subject matter claimed at the OLE has the same scope or a more restricted scope in terms of the subject matter deemed patentable at the OEE, even taking into account differences arising from translations of the claim;
- XIX - More restricted scope of claim: the scope of a claim is more restricted when it is limited, pursuant to Article 32 of the LPI [*our I. P. Law*] and to Resolution INPI PR No. 93, dated June 10, 2013; and
- XX - RPI: Revista da Propriedade Industrial [*Brazilian Industrial Property Gazette*].
- XXI - LPI: Law No. 9,279, dated May 14, 1996, named [*in Brazil*] Lei da Propriedade Industrial [*Industrial Property Law*].

Article 3. For the purposes of this Resolution, the following steps take place in the Pilot Project PPH INPI-EPO:

- I - the filing Applicant files the first patent application, causing the national office or international organization to become the OFF;
- II - the filing Applicant files the second patent application claiming the first patent application as priority, causing the national office or international organization to become the OSF;
- III - the national office or international organization that notifies the first decision granting a patent, either of the first or of the second patent application, becomes the OEE;
- IV - the filing Applicant requests the participation in the PPH of the application of the same family at the OLE, complying with the requisites and submitting the results of the decision of the OEE; and
- V - if the application is deemed suitable, the OLE prioritizes the patent application of the same family in all subsequent stages, up to the final decision.

Sole paragraph: The eventual abandonment of the First Patent Application that served as priority document for international filing, within the scope of the PCT, does not exclude the participation of the respective national phases in the Pilot Project PPH INPI-EPO.

Article 4. There may participate in the Pilot Project PPH INPI-EPO applications for patents of invention that simultaneously:

- I - belong to a patent family whereof, at least, the first patent application was filed at the BPTO or at the EPO or, within the scope of the PCT, at the BR/RO or at the EP/RO;
- II - the EPO, acting as OEE, allowed a patent application of the same patent family;

Article 5. There may participate in the Pilot Project patent applications belonging to the technical field of chemistry and technologies applied to medical science, with the exception of pharmaceuticals, thus understood as those classified by the BPTO with any of the symbols included in Attachment I of this Resolution, including their respective lower hierarchical levels of classification.

Article 6. The granting of priority of examination of a patent application will be conditional on fulfillment of the following requisites:

- I - Patent application in which respect there was published a decision "*Patent Application or Certificate of Addition of Invention filed*" or the decision "*Notification – National Phase – PCT*";
- II - patent application that was published, including the international publication when applicable;
- III - patent application with the request for examination, as provided in Article 33 of the LPI [*Brazilian IP Law*];
- IV - patent application which examination is not suspended awaiting compliance with an official action requirement previously formulated by the BPTO;
- V - patent application that is compliant with the obligations of payment of the annuities fees as provided in Article 84 of the LPI [*Brazilian IP Law*];
- VI - patent application for which a request of priority of examination has not been granted and published in the RPI [*Brazilian IP Gazette*];
- VII - patent application that is not undergoing legal litigation in Brazil;
- VIII - A patent application that is not a divisional application, with the exception of those resulting from the direct division of the original application and arising from an allegation of lack of unity of invention from the part of the OEE, in the sufficiently corresponding application;

Article 7. The filing Applicant should submit the request for priority of examination.

§ 1 When the acts contemplated in this Resolution were not performed by the filing Applicant itself, the acts pursuant to this Resolution should be submitted together with a power of attorney, as set forth in § 1 of Article 216 of the LPI [*Brazilian IP Law*].

§ 2 If there is more than one filing Applicant, the request of priority of examination may be filed by any one of the parties, by itself or jointly with the other party/parties.

Article 8. The appraisal of the request of participation is subject to payment of the corresponding fee.

Article 9. Together with the request of participation there should be submitted, as a minimum, the following documents and information:

I - electronic form of request of priority of examination PPH of a patent application;

II - evidence that it is a patent application according to the definitions of Article 4 of this Resolution;

III - indication of the page, paragraph and line of the set of claims that explicitly establishes the relationship between the claimed subject matter and the technical field having been specified, preferably with a transcription of the respective passage of text;

IV - patent application altered to correspond to the subject matter previously allowed by the EPO for the application of the same family, as stipulated in Item XVII of Article 1 of this Resolution, and with due regard to the normative instructions in effect, relative to alteration of patent applications at the BPTO;

V - table of correspondences of the sets of claims, evidencing the correlation between the new claims submitted to the BPTO and the claims deemed patentable by the EPO as OEE, pursuant to the model of Attachment II to this Resolution, or a statement to the effect that the claims submitted to the BPTO constitute a mere translation of the claims of the application of the same family that were allowed by the EPO; and

VI - a statement to the effect that the patent application is not subject to legal litigation in Brazil.

Article 10. In the event that the technical examination report of the OEE cites non-patent documents of the prior art, it will be necessary to submit a copy or copies thereof, together with the request of participation.

Article 11. In the event that the object of the patent application results from an access to a sample of a component of the Brazilian national genetic assets or associated traditional knowledge, the patent application process should be complemented with the information required by the legislation in effect.

Article 12. The request of priority of examination may be submitted at any time after the filing, exclusively by means of an electronic form.

Article 13. During the analysis of the request of participation or of the technical examination, the BPTO may request from the filing Applicant:

I - copy/copies of one or more search reports, reports of technical examinations conducted by the OEE;

II - copy/copies of the prior art documents cited by the OEE in its technical examination reports;

III - copy of the act performed by the EPO, acting as OEE, determining the subject matter that is entitled to patent protection;

IV - copy of the set of claims deemed patentable by the OEE;  
V - copy of eventual statements submitted by the filing applicant to the OEE; and  
VI - copy of the act performed by the EPO, acting as OEE, allowing the corresponding patent application.

Article 14. In the event of submission of copies of documents, Applicant is due to declare that the same are faithful to the original documents, reproducing the form and content thereof.

Sole paragraph. In the case that the documents described in the caput of the article are written in a language other than Portuguese, English or Spanish, the Applicant shall be due to also submit the respective simple translation into Portuguese, reproducing the content thereof.

Article 15. The verification of the requests of priority of examination and of the eligibility of the patent applications that qualify to participate in the Pilot Project PPH INPI-EPO is the responsibility of the Office of the Director of Patents, Computer Programs and Topography of Integrated Circuits - DIRPA.

§ 1<sup>st</sup> The DIRPA delegates to the Technical Committee of the Cooperative Examination Group the responsibility for the analysis and selection of the applications submitted for the Pilot Project.

§ 2<sup>nd</sup> The Cooperative Examination Group summons the Technical Committee.

§ 3<sup>rd</sup> The appraisal of the requests referred to in the caput of this article follows the chronological order of the date of the last request of participation in the Pilot Project PPH INPI-EPO.

Article 16. At the time of the analysis and selection of the requests submitted to the pilot project, the Technical Committee prepares the report relative to:

I - suggestion in favor of the possibility of participation;

II - indication of the existence of correctable irregular aspects; or

III - suggestion of denial of participation.

Article 17. In the cases where the BPTO points out correctable irregular aspects, the filing Applicant shall be able to resubmit the request of priority of examination PPH, within the term of sixty (60) days, as provided in Article 224 of the LPI [*BR IP Law*], correcting the eventual irregular aspects, and will be dispensed from resubmitting eventual documents in which regard no irregular aspects will have been pointed out to exist.

Article 18. The requests of participation are subject to the decision of the Director of Patents.

Article 19. The BPTO shall perform the technical examination of up to three hundred (300) patent applications in the function of OLE, per year, totaling six hundred (600) patent applications in the period.

Article 20. When the submitted patent application is deemed suitable to participate in the Pilot Project PPH INPI-EPO, the BPTO shall notify the granting of priority of examination of the patent application, by means of publication of a notice in the RPI [*BR Industrial Property Gazette*].

Article 21. When the patent application is not deemed suitable to participate in the Pilot Project or exceeds the available number of allowances to that effect, the BPTO shall notify the denial of priority of examination of the patent application, by means of publication of a notice to that effect in the RPI [*Brazilian Industrial Property Gazette*].

§ 1<sup>st</sup> The priority of examination that is denied shall maintain the patent application in normal examination prosecution.

Article 22. The petitions of appeal of decisions that denied the participation of the patent application will not be admitted when:

- I - they disregard the provisions of Article 219 of the LPI [*BR I. P. Law*];
- II - the decision was based on the failure to submit or the submission of documentation outside of the term provided in this Resolution;
- III - the decision was based on incomplete or incorrect submission of one or more documents and information required pursuant to this Resolution; and
- IV - the requisites provided in Article 6 of this Resolution were not met prior to the evaluation by the Technical Committee.

Article 23. The Pilot Project PPH INPI-EPO does not change the principle of independence of the rights established by Article 4bis of the CUP [*PUC*], and therefore:

- I - the filing applicant is due to comply with the provisions of the LPI [*BR I. P. Law*] with regard to the patent applications filed at the INPI [*BR PTO*];
- II - the filing applicant is not exempt from the remaining fees pertinent to the prosecution flow of the patent application;
- III - the examination of the patent application is conducted in accordance with the Brazilian legislation, with due regard to the remaining procedures in effect at the time of examination.

Article 24. The Pilot Project PPH INPI-EPO will receive requests of participation, for up to two years, and shall extend until all applications deemed qualified are decided.

Article 25. This Resolution is published in the RPI [*Brazilian Industrial Property Gazette*] and becomes effective on the 1<sup>st</sup> of December of 2017.

Rio de Janeiro, October 30, 2017

**LUIZ OTÁVIO PIMENTEL**  
President

**JÚLIO CÉSAR CASTELO BRANCO REIS MOREIRA**  
Director of Patents, Computer Programs and Topography of Integrated Circuits

**ATTACHMENT I TO RESOLUTION INPI/PR No. 202, OF OCTOBER 30, 2017**

**TECHNICAL FIELDS ACCEPTED IN THE PPH INPI-EPO**

The patent applications classified with the following CIP [*IPC*] symbols, including their respective lower hierarchical levels of classification shall be able to participate in the Pilot Project PPH INPI-EPO. In any case, there is vetoed the participation of patent applications which main or secondary classification has the symbols A61K, including their respective lower hierarchical levels of classification, with the exception of the symbol A61K8 without another A61K classification.

	Technical Field	CIP [ <i>IPC</i> ] Code
1	Basic chemistry	A01N, A01P, C05#, C06#, C09B, C09C, C09F, C09G, C09H, C09K, C09D, C09J, C10B, C10C, C10F, C10G, C10H, C10J, C10K, C10L, C10M, C10N, C11B, C11C, C11D, C99Z
2	Organic chemistry and fine chemicals	C07B, C07C, C07D, C07F, C07H, C07J, C40B, A61K8*, A61Q
3	Macromolecular chemistry and polymers	C08B, C08C, C08F, C08G, C08H, C08K, C08L
4	Medical technology	A61B, A61C, A61D, A61F, A61G, A61H, A61J, A61L, A61M, A61N, H05G

\* The applications classified as A61K8 may participate in the program, provided that they do not have another A61K classification.



**ATTACHMENT II TO RESOLUTION INPI/PR No. 202, OF OCTOBER 30, 2017**

**TABLE OF CORRESPONDENCE OF CLAIMS**

Table of Correspondence of Claims		
Claim claimed at the BPTO	Claim patented at the EPO	Comment on the correspondence