

BPTO publishes resolutions that will initiate the “Patent Backlog-fighting Project”

By Priscila Kashiwabara, Caio França and Patrícia Lopes

As part of the “Patent Backlog-fighting Project”, the Brazilian Patent and Trademark Office (BPTO) published Resolutions INPI Nos. [240/19](#) and [241/19](#) on July 09, 2019 which will become fully effective upon August 01, 2019 and July 22, 2019, respectively. Both measures are intended to dramatically reduce the number of patent applications pending of a decision within the next two years.

Resolutions 240/19 and 241/19 establish preliminary official actions which shall be published under codes 6.21 and 6.22, respectively. The 6.21-type actions shall be issued on Brazilian patent applications that **have** a corresponding foreign patent application on which a prior art search has already been carried out by another Patent Office. On the other hand, official actions 6.22 will be issued only on those patent applications that **do not have** the said corresponding prior art search.

Official actions 6.21 and 6.22 are applicable to patent applications that:

- I - have not yet undergone a first technical examination,
- II - have not requested any type of expedited examination before the BPO,
- III - have not suffered third party oppositions and/or have not received subsidies from ANVISA, and
- IV - have been filed on or before December 31, 2016.

Both official actions feature a search report and requirements so that the Applicant adapt the application and/or present technical arguments in favor of the patentability of the claimed subject matter in light of the prior art documents cited therein.

The BPTO will grant a period of 90 (ninety) days, counted as from the publication date of the preliminary office action, to file a response. Failing to respond thereto will result in the definitive shelving decision of the application, closing the administrative sphere of discussions. It is also worth mentioning that increasing the total number of claims when responding to the official action will entail a complementary payment of the examination official fees, which increases remarkably above the 15th claim.

The response must comply with the BPTO Normative Instructions Nos. 30 and 31, both of 2013, the Guidelines for examination in force, as well as the rules set forth in the Industrial Property Law 9,279/96, especially those regarding (i) subject matter not considered to be an invention, (ii) unpatentable subject matter, (iii) unity of invention issues, (iv) clarity & preciseness, and (v) descriptive sufficiency. Additionally, the amendments must be limited to the subject matter which formed the basis of the examination request so that the scope of protection cannot be broadened.

After receiving Applicant's response, the BPTO will proceed with the examination of the application. If the resulting application complies with the local rules and overcomes the prior art documents cited, the application shall be allowed. Otherwise, the application shall be rejected.

Should you wish to receive more information on this subject, please do not hesitate to contact us by telephone (+55 21 2113-1919) or by email at mail@kasznarleonardos.com.