

The controversy regarding amendments to patent applications in Brazil is approaching to a possible end

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I. Brief History of the Controversy

As reported in our **Newsletter #22**, [sent in October 2018](#), the Public Civil Action filed in 2002 by the Federal Public Prosecution Office (PPO) generated heated debates around the interpretation of Article 32 of the Industrial Property Act (IPA – Law #9,279/1996) concerning the examination of patent applications.

In summary, the PPO argues that voluntary changes to the scope of the claims of a patent application, by (restrict) interpretation of Article 32 of the IPA, could only be submitted until the examination request. Even so, this amendment request should be limited to the matter initially revealed in the application. On the other hand, the Brazilian Patent and Trademark Office (BPTO), based on their Opinion PROC / DICONs #07/2002, argues that Article 32 of the IPA would not prevent from including matter into the scope of the claims of a patent application after the request for the technical examination, provided that it had already been disclosed in the original application.

Rejected at first instance, the PPO's request to limit the application of Article 32 was granted by the Court of Appeals. The Appellate Judges ordered the BPTO to refrain from allowing amendments in the application after the examination request (in the terms of article 32) with exception only to the hypotheses set forth in article 70.7 of the TRIPS Agreement. The decision became final and unappealable in 2008.

After almost ten years of the deliverance of such decision, the PPO filed a request for the enforcement of this decision against the BPTO. The PPO seeks the invalidation of the BPTO's Resolution #93 (published on June 10, 2013), which allows voluntary amendments to the patent application after the examination request only to reduce the scope of the set of claims originally filed. The PPO argues that this resolution infringes Article 32 and the aforementioned decision rendered in 2008 by the Federal Court of Appeals.

II. Understanding Federal Justice

On January 16, 2019 the 25th Federal Trial Court has finally rendered a decision in relation to the PPO's request for the enforcement of 2008 decision. The trial judge rejected it based on the understanding that BPTO Resolution #93/2013 is legal and compatible with the grounds of 2008 decision.

According to Honorable Judge André Brandão, the new BPTO resolution is reasonable and faces a practical reality of the patent application process before the Agency: the delay in the analysis of applications (i.e. the so-called *backlog*). According to the decision, the BPTO – as the agency responsible for implementing, supervising and promoting industrial property matters in the form of Article 174 of the Federal Constitution – has a more accurate view of the problems involving patent applications. In this regard, the BPTO – through the issuance of Resolution #93/2013 – decided that it was important to allow voluntary changes in applications only to reduce the scope of protection of the set of claims originally filed.

The decision took into consideration the arguments of protecting the applicant's rights and, on the other hand, the free competition principle (bearing in mind the hindrance to the development of new technologies by third parties based on the elements excluded from a given application). The trial judge concluded that allowing amendments on the application to reduce the scope of protection does not infringe Article 32, but it actually gives practical effectiveness to face the terrible delay in such analysis, the well-known *backlog*.

Despite of the fact of having a short reasoning, this decision represents an important outcome for the discussion around this controversial issue, ensuring greater security for patent applicants. We understand that this outcome guarantees the maintenance of an efficient processing system of patent application in Brazil, since the possibility of voluntary modifications to the applications to reduce its scope of protection benefits not only the applicant, but the society as a whole. This decision is appealable, so the Rio de Janeiro Federal Court of Appeals may still have to give their say on the matter within the next few months.