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FEDERAL PUBLIC MINISTRY
FEDERAL PUBLIC MINISTRY SPECIALIZED AT THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY
GENERAL COORDINATION OF LEGAL PROPERTY INDUSTRIAL
MAYRINK VEIGA, 9 - CENTRO - RI - CEP: 20090-910

TECHNICAL OPINION No. 00019/2023/CGPI/PFE-INPI/PGF/AGU

NUP: 52402.010705/2023-19

INTERESTED PARTIES: NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY - INPI

SUBJECTS: ADMINISTRATIVE ACTS

1. Consultation on the limits and scope of the full devolutive effect, inscribed in article 212, § 1º, of Law No. 9.279/1996.
2. Opinion that deals with procedural aspects in appeals relating to patent applications procedures.
3. Time limit for changing the claims framework established in art. 32 of Law No. 9.279/96.
4. Administrative preclusion. Stability and security of administrative decisions. Intelligence of art. 62, § 2º, of Law No. 9.784/99.

I. Report.

1. The General Coordination of Resources and Administrative Nullity Processes forwarded to the Prosecution, through NOTA TÉCNICA/SEI Nº 182/2023/INPI/CGREC/PR (0891724), a consultation on the limits and scope of the effect of the full devolutive enshrined in article article 212, § 1º, of Law No. 9.279/1996.
2. In the aforementioned technical manifestation, procedural situations were reported, with which the Coordination is faced, due to the full devolutive effect of appeals. The CGREC then separated the procedural situations into specific topics and formulated questions, according to each matter: general procedural formal issues, issues of patents, of trademarks and industrial designs. For this reason, this Prosecution understood it more appropriate to analyze each matter separately.
3. Opinion No. 0016/2023/CGPI/PFE-INPI/PGF/AGU, present in the files, analyzed the procedural formal issues common to all appeals in processes for the examination of industrial property rights.
4. Opinion No. 0017/2023/CGPI/PFE-INPI/PGF/AGU addressed the technical area's inquiries regarding trademarks.
5. Opinion No. 0018/2023/CGPI/PFE-INPI/PGF analyzed the questions about industrial designs.
6. Finally, this legal manifestation concludes the response to the consultation by answering the questions related to the topic of patents. On this matter, the CGREC reported the following:

“1. Situation in which the presentation of new elements of conviction is allowed, such as new data to support technical effects, modifications to the descriptive report, modifications to the claim chart, always with a view to greater precision and clarity of the matter claimed. The second administrative instance accepts that the appellant may present clarifications and even modifications to the matter initially claimed, in order to overcome the objections of the first instance.”

“2. Situation in which the interested party is unable to comply with a requirement made in the first instance, either fully or partially. The CGREC accepts that it may be

complied with in the appeal process, which may result in the reversal of the decision with the granting of the appeal. Example: when there is a requirement to exclude a claim due to non-compliance with Article 8 together with Article 13 of the LPI, and the application is rejected. If the interested party agrees to exclude the claim in the appeal process, there is a high probability that the rejection decision will be overturned.”

7. Then, the CGREC asked the following questions::

“1. Does the CGREC have jurisdiction to hear and grant appeals that include new elements, such as modifications to the claim chart? Or must such elements be presented in the appeal exactly as they were presented in the first instance, without modifications?”

“2. Does the CGREC have jurisdiction to accept appeals in which requirements that were not satisfactorily met in the first instance (either fully or partially) can be met in the appeal process? If so, what are the recommended procedures for handling these appeals?”

8. The case file was also sent by this Office, through Office SEI No. 12/2023/PFE/PR (0893428), to the Directorate of Patents for technical comments on the point raised by the CGREC.

9. In response to the aforementioned request, the DIRPA, by means of the Dispatch (0914062), took the following position:

“This Directorate understands that the devolutive effect in the appeal phase simply transfers the reexamination of the decision from a unit with lower hierarchy to a unit with higher hierarchy. And that the reexamination involves again the appreciation of all the matter subject to the contested decision in the appeal, added to the manifestations of the appellant. Hence the provision for the application of all the provisions pertinent to the examination of first instance, as appropriate, provided for in paragraph 1 of Article 212 of the LPL. According to the understanding of this Directorate, this means that, in the case of an appeal against the rejection of a patent application, a new search report and a new opinion regarding the patentability of the application (characteristics of the examination in first instance), as established in Article 35 of the LPL, may be prepared. It is even possible that this reexamination will point out issues not addressed in the decision that is the subject of the appeal, which guarantees the possibility of manifestation by the appellant. However, this reexamination is limited to the documentation already contained in the application at the time of the contested decision.”

“The DIRPA's understanding is that the devolutive effect does not, for example, allow the presentation of documents that were not submitted on time during the proceedings in the first instance. Therefore, it does not constitute a possibility of extending deadlines established by law. It also does not seem to allow the presentation of new documents to the appeal, such as the components of the application, whether they are the descriptive report, claims, or drawings, especially when they represent a change in the scope of protection, and when they do not explicitly derive from a requirement made in the appeal phase. This understanding does not take into account arguments presented by the appellant to support the request for reexamination of the matter and that do not constitute part of the patent application.”

10. It is noted, upon first reading, that the CGREC's question relates to the time limit for submitting changes to the claim set, a topic covered by Article 32 of Law No. 9,279/1996. On the interpretation of this legal provision, this Office has already expressed itself on several occasions. Among the most recent statements, the following are cited:

1. Opinion/INPI/PROC/CJCONS/No. 012/2008 on the interpretation of Article 32 of the LPI.
2. Opinion No. 0005-2013-AGU/PGF/PFE/INPI/COOPI-LBC-1.0, approved by the Order No. 0064/2013-AGU/PGF/PFE/INPI/COOPI-MSM-3.2.3, on the application of Article 32 of the LPI.

3. Note No. 0013-2015-AGU/PGF/PFE/INPI/COOPI-LBC-2.2, approved by the Order No. 0059/2015-AGU/PGF/PFE/INPI/COOPI-ALB-3.2.3, on the withdrawal of a patent application examination request.
4. Note No. 0051-2017-AGU/PGF/PFE/INPI/COOPI-DJT-2.2, approved by the Order No. 0105/2017-AGU-PGF/PFE/INPI/COOAD-LBC-3.3, on the improvement of the guidelines for applying Article 32 of Law No. 9,279/96.
5. Opinion No. 0033-2017-AGU/PGF/PFE/INPI/COOPI-DJT-1.0, approved by the Order No. 0520/2017-AGU/PGF/PFE/INPI/COOPI-LBC-3.2.3, on the application of Article 32 of the Industrial Property Law to a divided application.
6. Opinion No. 00046/2019/CGPI/PFE-INPI/PGF/AGU on the Bill No. 10.920/2018.

11. It is also worth noting that the topic of administrative preclusion is directly related to the questions raised in the consultation, a topic that has already been the subject of several statements by this Office, among which the following can be cited:

1. OPINION/INPI/PROC/CJCONS/No. 10/07, which analyzed the reasons for the appeal that archived a request for the division of a patent application.
2. Opinion No. 00010-2014-AGU/PGF/PFE/INPI/COOPI-LBC-1.0, approved by the Order No. 0896/2014-AGU/PGF/PFE/INPI/COOPI-MSM-3.2.3, regarding the draft ordinance on the ideal staffing at the CGREC and the draft ordinance on the processes within the CGREC.
3. Note No. 0035-2017-AGU/PGF/PFE/INPI/CGPI-DJT-2.1, approved by the Order No. 0248/2017-AGU/PGF/PFE/INPI/COOPI-LBC-3.2.3, on the analysis of the power of attorney and the application of Article 216, § 2º, of Law No. 9,279/1996.
4. Opinion No. 0007-2017-AGU/PGF/PFE/INPI/COOPI-LBC-1.0 regarding the definitive archiving of a trademark registration application when the power of attorney was submitted late.
5. Note No. 0276-2017-AGU/PGF/PFE/INPI/COOPI-DJT-2.1, approved by the Order No. 0614/2017-AGU/PGF/PFE/INPI/COOPI-LBC, on inconsistencies in the payment of the fee in the payment of a trademark registration application

12. This is the report.

II. Analysis.

13. The first question presented was:

" 1. Situation in which the presentation of new elements of conviction is allowed, such as new data to support technical effects, modifications to the descriptive report, modifications to the claim chart, always with a view to greater precision and clarity of the matter claimed. The second administrative instance accepts that the appellant may present clarifications and even modifications to the matter initially claimed, in order to overcome the objections of the first Instance. The CGREC inquires *whether it should know and eventually provide for appeals that include these new elements as modifications to the claim chart, or if such elements can only be presented in the appeal exactly as they were presented in first instance, that is, without modifications*"."

14. In the transcribed question, CGREC consults on the limits of the knowledge of an appeal against the decision to refuse a patent application, in which the appellant adds new elements, such as modifications to the claim set, which were not presented in first instance.

15. The answer to the formulated consultation will require the analysis of two incidental issues, namely, i) the temporal limit for the alteration of the claim set of patent applications and ii) the limits themselves of the knowledge of the appeal.

16. On the temporal limit for alterations of the claim set of patent applications, there is the prescription of Article 32 of Law No. 9,279/1996, which determines that the alteration of the application may occur until the request for examination, being that these are limited to the matter initially revealed in the application. See its wording:

“Art. 32. To better clarify or define the patent application, the depositor may make

alterations **until the request for examination**, provided that these are limited to the matter initially revealed in the application. (emphasis added)

17. In Opinion No. 0005-2013-AGU/PGF/PFE/INPI/COOPI-LBC-1.0, this office analyzed the scope of Article 32 of Law No. 9,279/1996 with support from Opinion/INPI/PROC/CJCONS/No. 012/2008. See the following excerpt:

“3. 0 Opinion/INPI/PROC/CJCONS/No. 012/2008 resolved a doubt that existed at the time regarding the application of Article 32 of Law No. 9,279/96. According to the Opinion, written by Dr. Mauro Sodré Maia, Article 32 provides a temporal limitation on changes to the claims of a patent application. Changes to a patent application are not possible after the request for technical examination.

4. The request for technical examination constitutes the temporal/circumstances milestone that hinders the change of a patent application. This is an interpretation arising from the literality of the legal provision.

5. In addition to the temporal/circumstances limit provided for in Article 32 of the LPI, the provision provides for two other limits, namely, one relating to the purpose and the other to the object. These limits are here treated as requirements for the change of a patent application.

6. A change to the application is not permitted to expand the scope of protection sought in the filing. The expression contained in Article 32 of the LPI ('provided that they are limited to the matter initially disclosed in the application') indicates this material limit.

7. The change to the application is intended to clarify the original application. This assertion refers to what is here called teleological. This requirement arises from the expression 'to better clarify or define the patent application', present in Law No. 9,279/1996.

8. In summary, from the reading of Opinion/INPI/PROC/CJCONS/No. 012/2008, three requirements for the admissibility of the change to the application can be inferred, namely:

- a) circumstantial/temporal requirement: the change can occur up to the request for technical examination;
- b) material requirement: the change must be adapted to the object of the original patent application;
- c) teleological requirement: the purpose of the change is to clarify the original patent application."

18. In Opinion No. 0005-2013-AGU/PGF/PFE/INPI/COOPI-LBC-1.0, a distinction is made between the addition and the reduction of the scope of protection required. Changes to the claims, with the objective of reducing the scope, would not be temporally limited by the request for technical examination. See:

"13. The material requirement of the claims prevents the expansion of the object of the patent application, but does not prevent the reduction of the original application. The change to the patent application to reduce the one originally made does not cause harm to third parties or to the public interest. Thus, the autarchy was instructed to accept changes to the claims intended to reduce the original patent application, even if they exceed the temporal limit.

By the way, we believe that a reduction in the scope of the claims meets the public interest, as the part removed from what was initially claimed if it will be incorporated into the public domain, free competition [..]

In this step, it seems to us to be absolutely reasonable that such changes may be admitted even after the request for examination, when they intend to restrict the protection previously claimed.'

14. Corrections of errors of a purely material nature do not constitute changes in the claim, the requested change may be admitted, even if the time limit has been exceeded, provided that it does not expand the scope of protection requested in the original application".

19. It is possible to verify from the aforementioned manifestations that there is an **established understanding within the Brazilian National Institute of Industrial Property (BRPTO)** that the date on which the technical examination of the patent application is requested is the final temporal term for voluntarily requesting changes to the claims, provided that the changes are intended to clarify or better define the application and are limited to the matter initially revealed.

20. It is also observed that there is a consolidated understanding within the INPI that after the date on which the technical examination of the patent application is requested, the reduction of scope of the claims is allowed because it "meets the public interest, since the part removed from what was initially claimed will be integrated into the public domain, free competition"

21. Therefore, these are the limits already consolidated within the INPI for the alteration of the claims of patent applications.

22. Regarding the scope of review of appeals, within the scope of processes governed by Law No. 9,279/1996, it is important to note that this topic was the subject of the OPINION No. 00016/2023/CGPI/PFE-INPI/PGF/AGU, from which the following excerpts are transcribed:

"12. Starting with the limits of the knowledge of appeals, it is observed that Law No. 9,279/1996 provided for broad mechanisms for the review of administrative decisions. Appeals, as requests for review of the challenged administrative act, have suspensive and devolutive effect. Law No. 9,279/1996

Article 212. Except for express provision to the contrary, appeals may be filed from decisions covered by this Law, which shall be filed within 60 (sixty) days. § 1. Appeals shall be received with suspensive and full devolutive effect, applying all the pertinent provisions for the examination of first instance, as appropriate. (emphasis added)

[...]

However, it is important to clarify, regarding the content of paragraph 1 of the above-mentioned article - appeals **shall be received with suspensive and full devolutive effect - that all issues subject to the appeal shall be returned for re-examination by the appellate court, however, not the deadline for submitting any other request, due precisely to the exhaustion of the instruction stage of the case, once the preclusive effect has been produced, that is, the closure or impediment to doing something** (in Legal Dictionary, De Plácido e Silva).

As is known, appeals, in general, may have devolutive and suspensive effects. Devolutive effect means that the matter decided in the first instance is returned to the knowledge and decision of the hierarchically superior authority. This return may be full, covering both the matter of fact and of law, or only partial, restricted to the matter of law. Suspensive effect means that the decision appealed against has its effectiveness suspended, and cannot be executed, until the decision of the appeal.

The general rule in administrative proceedings is that the devolutive effect is full, that is, it admits reexamination of the facts and law of the challenged act, not the examination of an innovation of the object initially claimed."

14. Therefore, it is understood that the limits of the knowledge of the appeal in the Industrial Property Law (LPI) are determined by its devolutive effect, which under the terms of article 212, paragraph 1, is full, meaning that "all issues subject to the appeal shall be returned for re-examination by the appellate court". In other words, by express legal provision, everything that was questioned in the appeal must be known by the reviewing body.

15. However, as noted in the cited opinion, "all issues subject to the appeal will be returned for reexamination by the appellate court, but not the deadline to present any other claim, given precisely the exhaustion of the instruction stage of the case," that is, administrative preclusion limits the scope of the matters to be analyzed on appeal.

16. Therefore, it is understood that administrative preclusion is a relevant limit to the effect of the appeal and, therefore, a limit to what would be covered by full knowledge, because it will prevent innovations in the appeal phase, that is, restrict the appellant from presenting a new request in the appeal phase, especially when the deadline to present such request has already expired.

17. And the rationale for this restriction is very simple, it is the need to perform the acts in the proper legal opportunities and the need for the process to move towards a conclusion, without incurring in endless interruptions and renewals of requests"

23. As stated above, the limits of the appeal in the LPI are determined in a significant part by **administrative preclusion**, since it prevents the presentation of a new claim in the appeal phase. Now, if a claim should have been presented at a certain procedural opportunity and was not, such claim cannot be presented anymore. And more, such claim, even if it has been presented in appeal, cannot be known in the appeal instance, by **force of preclusion**.

24. Therefore, it is clear that both the temporal limitation for the alteration of the claim framework of patent applications, as well as the limits of the appeal itself in the LPI, can be considered as relevant guidelines for the understanding of the consultation presented. That is, both limits will restrict both the conduct of the applicant, as well as the conduct of the INPI.

25. Returning to the consultation, it is understood that innovation is not appropriate within the scope of the LPI appeal, especially to include a **new claim**, even if to reduce the scope of the claim framework of the patent application. by **force of administrative preclusion**.

26. In relation to the second question formulated, here is its formulation::

"Situation in which the interested party is unable to fulfill totally or partially a requirement carried out in the first instance. The CGREC accepts that it be fulfilled, on appeal, which can result in the reversal of the decision with the granting of the appeal. Example: when there is a requirement to exclude a claim for non-compliance with Article 8 together with Article 13 of the LPI, and the application is rejected. If the interested party agrees to exclude the claim on appeal, there is a high likelihood that the rejection decision will be reformed. The CGREC inquires if it should accept that requirements that were not satisfactorily fulfilled in the first instance (totally or partially) can be fulfilled on appeal. And what procedures are recommended for the treatment of these appeals"

27. Here, it is verified that the issue refers to the theme of **administrative preclusion** and is very similar to the first question analyzed and very similar to the other issues faced in previous opinions in these same files.

28. As was carefully addressed in OPINION No. 00016/2023/CGPI/PFE-INPI/PGF/AGU, the process is the chaining of acts aimed at an end and it is essential to carry out the acts in the appropriate legal opportunities, so that the process moves towards a conclusion, without incurring in endless interruptions and renewals of requests.

29. It is not redundant to reiterate what I already said there, by force of preclusion, if a request should have been submitted in a certain procedural opportunity and was not, such request cannot be presented anymore. And more, such request, even if it has been presented in appeal, cannot be known in the appeal instance, by force of preclusion.

30. In the same sense, Dirpa (0914062) argues that "the devolutive effect does not allow, for example, the presentation of documents not submitted on time, during the course in the first instance, not constituting, therefore, a possibility of increasing legally established deadlines; it does not seem to allow the presentation of new documents to the appeal filed, such as the parts that make up the request, whether they are descriptive report, claims or drawings, mainly when they represent a change in the scope of protection, and when they do not explicitly derive from a requirement made in the appeal phase."

31. Therefore, and in direct response to the question posed, it is understood that the facts reported fall within the hypothesis of **administrative preclusion**, not giving the party any more right to produce the act outside the deadline, nor giving the knowledge of the claim in the context of appeal. Now, if the requirements were not met within the deadline indicated, the opportunity for the depositor to comply with them has lapsed. And, it should be noted, innovation is not admissible in the context of appeal, therefore, there is no room in appeal for the presentation of a new claim.

III. Conclusion

32. In light of the foregoing, in strict accordance with the law, and in response to the consultation submitted, this Office presents the following responses:

33. Regarding the first question:

The CGREC inquires whether it should accept appeals that introduce new elements, such as modifications to the claim set, or whether such elements can only be presented in the appeal exactly as they were presented in the first instance, that is, without modifications.

34. It is understood that innovation is not admissible within the scope of an appeal under the LPI, especially to include a new claim, even if to reduce the scope of the claim chart of the patent application, due to **administrative preclusion**.

35. Regarding the second question:

The CGREC inquires whether it should accept that requirements that were not satisfactorily met in the first instance (in whole or in part) may be met on appeal. And what procedures are recommended for the handling of these appeals?

36. It is understood that the facts reported fall under a case of administrative preclusion, with no further right for the party to produce the act outside of the deadline, nor is it appropriate to consider a new claim in an appeal.

For the superior consideration,

ADALBERTO DO REGO MACIEL NETO

Federal Prosecutor

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