



**MINISTRY OF DEVELOPMENT, INDUSTRY, TRADE AND
SERVICES NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY**
PRESIDENCY

Rua Mayrink Veiga, 9 - Centro, Rio de Janeiro/RJ,
CEP 20090-910 Telephone: (21)3037-4784

DECISION ORDER

Ref.

INPI Process No. 52402.010705/2023-19

Subject: **Industrial Property - Industrial Property Law - Article 212, § 1 - Full Return Effect - Application - Limits.**

In view of the publications in the Industrial Property Magazines No. 2762, of December 12, 2023 and No. 2764, of December 26, 2023, regarding the legal guidance of the Specialized Federal Attorney's Office at the National Institute of Industrial Property - INPI, on the limits and scope of the full devolutive effect, established in art. 212, § 1, of Law 9279/1996 - LPI, as well as the manifestation embodied in OPINION no. 00003/2024/CGPI/PFE-INPI/PGF/AGU, **DECIDE:**

1. Grant normative effects to OPINION No. 00003/2024/CGPI/PFE-INPI/PGF/AGU, complementary to OPINION No. 00019/2023/CGPI/PFE-INPI/PGF/AGU;

2. Explain the scope and limits of the systematic interpretation of OPINION No. 00019/2023/CGPI/PFE-INPI/PGF/AGU, in comparison with OPINION No. 00003/2024/CGPI/PFE-INPI/PGF/AGU, as follows.

2.1. Regarding the claims framework, item 34 of OPINION No. 00019/2023/CGPI/PFE-INPI/PGF/AGU stated the following:

"It is understood that it is not possible to innovate within the scope of an IPL appeal, above all to include a new claim, even if it is to reduce the scope of the patent application's claim framework, due to administrative estoppel"

2.2. In this regard, after further consultation with the Attorney General's Office, a supplement to OPINION No. 00019/2023/CGPI/PFE-INPI/PGF/AGU was drawn up, resulting in OPINION No. 00003/2024/CGPI/PFE-INPI/PGF/AGU, which highlighted the following:

- "1. New consultation on the devolutive effect in appeals. Clarifications regarding OPINION no. 00019/2023/CGPI/PFE-INPI/PGF/AGU.
2. The competence to assess whether or not there is innovation or a "new request" on appeal lies with the appellate body. Technical examination.
3. Requirements that have not been satisfactorily met in the first instance (in whole or in part) cannot be met on appeal, due to administrative estoppel.
4. Exceptionally, if just cause is proven, under the terms of art. 221 of the IPL, it is possible to accept the attachment of such documents at the appeal level, with the second instance deciding either (i) to refer the matter to the first instance, or (ii) to make a direct assessment based on the theory of ripe cause."

2.3. Thus, it appears that it will be up to the second instance of the INPI, when analyzing the restrictive amendments made to the Table of Claims in the appeal phase, to assess whether they imply a new claim on appeal.

2.4. With regard to modifications to the claim framework that was the subject of the rejection, the appellant will be allowed to submit restrictive amendments in order to circumvent the objections raised in the 1+ instance examination, provided that they comply with the following conditions:

1. Need to present a causal link between the changes in the claim and the obstacle pointed out by the lower court
2. Modifications can only be submitted if they are logical restrictive derivations of the framework that was the object of the rejection;
3. Restrictions will only be accepted if they are expressly provided for in dependent claims, or if they arise from a combination of independent/related claims. In this sense, restrictions arising from the descriptive report and which are not expressed in the contested claim framework will not be accepted.
4. Requests for a change of nature will not be admitted at second

instance, unless the change has already been requested by the applicant at first instance and has been unduly denied.

2.5. It should also be clarified that data or documents submitted solely to substantiate the argument of inventive step may be admitted at the appeal stage.

2.6. Finally, in cases where the requirement has not been met or has not been met properly, preclusion applies as a rule. Therefore, in order to avoid this, it is imperative that the appellant demonstrates, supported by evidence, the impossibility of complying with the requirement in 1st instance.

3. The Decisional Orders published in the Industrial Property Magazines No. 2762, of December 12, 2023 and No. 2764, of December 26, 2023 are hereby maintained in their entirety, with the addition of the normative effect granted to the complementary manifestation embodied in the OPINION. n. 00003/2024/CGPI/PFE-INPI/PGF/AGU, observing the parameters set out in item 2 of this Decision Order.

**Julio Cesar Castelo
Branco Reis Moreira**

President



Document signed electronically by **JULIO CESAR CASTELO BRANCO REIS MOREIRA**, President, on 23/02/2024, at 15:18, according to Brasília official time, based on art. 60, § 1, of Decree No. 8.539, of October 8, 2015.
