FEDERAL ATTORNEY GENERAL'S
OFFICE
SPECIALIZED FEDERAL PROSECUTOR'S OFFICE AT THE NATIONAL INDUSTRIAL PROPERTY INSTITUTE
LEGAL-GENERAL COORDINATION OF INDUSTRIAL PROPERTY RUA
MAYRINK VEIGA, 9 - CENTRO - RJ - CEP: 20090-910

OPINION No. 00003/2024/CGPFPFE-INPI/PGF/AGU

NUP: 52402.010705/2023-19
INTERESTED PARTIES: NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY - INPI
SUBJECTS: ADMINISTRATIVE ACTS

1. New consultation on the return effect in appeals. Clarifications regarding OPINION no. 00019/2023 'CGPT/PFE-INPI PGF/AGU.

2. The competence to assess whether or not there is innovation or a "new request" in an appeal lies with the

appeal body. Technical examination.

3. Requirements that were not met satisfactorily 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.

I. Report

I. The General Coordination of Appeals and Administrative Nullity Proceedings (CGREC), by means of TECHNICAL NOTE/SEI No. 2/2024 INPI /COREP 'CGREC /PR (09509b3), submits to the Attorney General's Office a query regarding the OPINION
n. 00019/2023/CGPI/PFE-INPI/PGF/AGU (0915615), approved by APPROVAL ORDER n . 00083/2023/PROCGAB/PFE-INPI/PGF/AGU (091516).

2. In the aforementioned technical note, CGREC reports:

"Considering the decision of the President of the INPI published in RPI No. 2.764, of December 26, 2023. which dealt with the normative character conferred on Opinions No. 00016/2023/CGPI/PFE-INPI/PGF.'AGU. No. 000I7/2023/CGPI/PFE-INPI/PGF/AGU, No. 0018/2023/CGPI/PFE-INPI PGF'AGL and N o . 00019/2023/CGPI/PFE-INPI/PGF/AGU, and established a new deadline for its full applicability to begin on April 2, 2024. This date was set as the deadline for submitting amendments to the appeals filed and announced the possibility of re-examining specific points of the aforementioned legal statements. For this reason, the case file is returned to the INPI's Specialized Federal Prosecutor's Office in order to clarify any doubts that have arisen regarding the understanding established in items 34 and 36 of the Opinion
n° 00019/2023/CGPI/PFE-INPIWGF/AGU.

3. With regard to item 34 of the legal statement, the technical area maintains that:

"With regard to item 34 of opinion no." 1 9/2023 CGPI/PFF.-I.¥PI'PGF/AGU.' Wording. "34. It is understood that it is not permissible to innovate within the scope of a Ja LPI appeal, especially in order to include a new claim, even if it is to re--clude the scope of the patent application's claim area. by
force of the aditional decision."

As this is a concept with an extreme degree of technicality, we believe that it is reasonable for the examiner, a researcher with *expertise* in the area of knowledge required, to be given the task of assessing whether the appeal implies a change in the scope initially requested in the application or whether it is merely a reduction that allows the decision to be reformed in order to grant the application."

4. Regarding the item 36 of OPINION no. 00019/2023/CGPI/PFE-INPI/PGF. AGU, the Coordination states that:

"of item 36 of opinion No 19/2023 CGPIWFE-INPI/PGF/AGU: Wording. *"36. It is understood that the facts reported fall under the hypothesis of admiitistratis'a preclusion, with no further right for the purtee to produce the act [now of the pru--o, nor to be aware of the new plea on appeal."*

However, this Coordination cannot fail to express its disagreement with the Board's understanding regarding the statement that "...the *effect of 'olutii'o' does not make it possible, for example, to present documents* that were *carried out* by UO *pl-az-o. Jta before the procedure in the first instance..."* In COREP/CGREC's opinion, the guidelines for examining patent applications set out in Resolution 124'20l 3, item 3.59, and Resolution 169'2016, item 5.16, allow evidence to be presented to convince the e x a m i n e r during the examination."

5. CGREC then submitted the following questions to the Public Prosecutor's Office:

1 - The restriction of the scope of the claim can be admitted on appeal, if it is limited to the matter initially claimed and does not result in an addition of matter, since, in this case, it would not be a new claim?

2 - When considering an appeal against a rejection of a patent application, caused by the failure to properly comply with a requirement formulated by the first instance and the inability of the applicant to convince the first instance of the objections raised in the technical examination, can the second administrative instance accept and appreciate reasons aimed at clarifying and proving the technical effect of the invention applied for, since they are inherent to the matter initially disclosed?

6. This is the report.

II. Analysis

7. The Coordination's first question related to whether a request to reduce the scope of the claim could be accepted on appeal, on the grounds that it was not a new claim. Here are CGREC's arguments:

"During the examination of patent applications by the first instance, requirements are formulated that form part of the administrative stage, and it is therefore the patent applicant's free choice whether or not to comply with these technical requirements. The applicant is free to comply or not with the requirement. Failure to comply will result in a rejection decision. In this way, the applicant is guaranteed by law the possibility of appealing **against** the rejection to the second instance.

The Applicant appeals to the second administrative instance to request a new technical analysis of the claimed invention, and may present a new, narrower claim framework (QR) or the same claim framework denied in the first instance with the appropriate appeal reasons.

> Therefore, we are dealing with the same claimed invention, which was denied at first instance. There is no need to talk about a new claim in the appeal. According to COREP/CGREC, there is no estoppel, as this is just a new administrative step aimed at reversing the rejection of the application.
>
> This is because, with the opening of the period for lodging an appeal, under the terms of article 212 of the LPl, it is possible for the matter to be re-discussed by the higher hierarchical authority, in this case the President of the INPI, and a new decision on the merits to be issued in order to replace the decision previously handed down. This is the very essence of the appeal instrument.
>
> Reducing the scope of the claim is part of what was initially claimed, so a modification to restrict the claimed invention is not considered a "new claim", nor is there a logical, temporal or consummative conclusion, since it is only a new administrative stage in the processing of the application.
>
> The guidelines established by Resolution 93/2013, in item 2.5, make it possible to modify the claim framework. Items 3.88 and 3.89 of Resolution 124/2013 allow the Applicant to try to convince the examiner. Furthermore, in an attempt to convince, the Applicant may bring results/tests or similar, which may be presented during the technical examination and even after the request for examination, as provided for in item 5.16 of the guidelines established by Resolution 169/2016.
>
> As stated in Opinion 0005-2013-AGU PGF/PFE/INPI COOPI-LBC-1.0, mentioned in Opinion No. 19/2023 'CGPI-PFE-INPI/PGF/AGU. we have that the reduction of the scope claimed serves the primary public interest, as well as giving prestige to the inventor, whose fundamental right is the temporary privilege for the use of industrial inventions, under the terms guaranteed by law - article 5, item XXIX, of the CRFB/88.
>
> We stress that COREP'CGREC does not disagree with the fact that a "new claim" is prohibited, but rather with the concept of a "new claim" set out in Opinion N o . 00019/2023/CGPI/PFE-INPI/PGF AGU, since *"reducing the scope of the patent application's claim framework"* does not characterize a "new claim", i.e. it does not have the power to alter the object initially claimed. It is merely an attempt to make the invention more precise and clear".

S. It emerges from the arguments presented that **CGREC** fundamentally disagrees with the classification of a request to reduce the scope of the claim formulated in the appeal as a "new claim", given that the reduction in scope "does not have the power to alter the object initially claimed. It is merely an attempt to make the invention more precise and clear".

9. The arguments put f o r w a r d by CGREC involve eminently technical issues because they involve the analysis and judgment of what is considered to be the invention itself and the possible scope of the claims. This judgment, it should be noted, is the exclusive competence of the INPI's technical areas, whether at first instance or on appeal, u n d e r t h e terms of Law No. 9.279/1996 and Decree 11.207/2022, and therefore falls outside the competence of this legal advisory unit.

10. In this sense, **it is recognized that it is up to** the **appellate body to evaluate the request for a reduction in** scope and **make** the consequent judgment as to whether **or not the** case is one of **appellate** innovation. If it decides that the request for a reduction in scope is not innovative, the appellate body must analyze and rule on the appeal.

11. On the other hand, if CGREC considers that there has been innovation or a "new claim" in the appeal, it is strictly necessary to apply the conclusion of OPINION No. 00016/2023/CGPI/PFE-INPI/PGF/AGU, which prevents new claims from **being heard** in appeals due to **administrative estoppel.**

12. The above understanding stems from the following reasoning. In OPINION No. 00019/2023/CGPI/PFE-INPI/PGF/AGU, it was noted that the INPI has a consolidated understanding of the differences between alterations that increase the scope of **the** claim, which can only be made up **to the request for technical examination, under the** terms of art. 32 of the Law, and those that reduce the scope of the claim, which **can exceed this time limit.**

> "From the statements mentioned above, it can be seen that there is an established understanding within the INPI that the date on which the technical examination of the patent application is requested is the date on which the technical examination of the patent application is requested.

> tinal time limit for voluntarily requesting changes to the claim framework, provided that the changes are intended to clarify or better define the claim and *are* limited to the matter initially disclosed.
>
> 20. There is also a well-established position within the INPI according to which it is permissible after the date on which the technical examination of the patent application is requested to alter the claim for a reduction in scope because "it serves the public interest, since the part removed from what was initially claimed will be integrated into the public domain, into free competition".
>
> 21. These are, therefore, the limits already consolidated within the INPI for altering the claim framework of patent applications".

13. Later on, in the same opinion, it was argued that administrative estoppel would be an obstacle preventing changes to claims in the appeal sphere, even if they were to reduce the scope of the claims, in t h e following terms: "innovation is not allowed in the appeal sphere of the IPL, especially to include a new claim, even if it is to reduce the scope of the patent application's claims, due to administrative estoppel".

14. This is exactly where the controversy lies between the position of the appellate body and this legal advisory unit. In the aforementioned opinion, it was argued that the request for a reduction in scope would imply innovation in the application, but the appellate body takes a different view. CGREC argues that the issue is eminently technical and involves judging the invention itself and the possible scope of the claims applied for, in order to determine whether or not there is innovation in a request for a reduction in scope.

15. In its argument, CGREC maintains that the analysis of the specific case will require an extreme degree of technicality, and that it will only be up to the examiner, a researcher with *expertise* in the area of knowledge required, to assess whether the appeal implies a change in the scope initially requested in the application or whether it is merely a reduction that would allow t h e decision to b e reformed in order to grant the application.

16. In view of this argument, it is recognized that the content of the aforementioned evaluation is eminently technical and the exclusive competence of the INPI bodies, under the terms of Law n* 9.279/1996 and Decree 11.207/2022. Thus, it is the appellate body that must irremediably assess and judge whether or not there is innovation or a "new claim" in the scope reduction request under appeal.

17. Consequently, as this is a sphere of competence, the controversy must be settled precisely by whoever has the competence to define whether or not the request for a reduction in scope constitutes an innovation or a "new claim". And undoubtedly, as has already been shown, this competence lies with the appellate body when the request for a reduction in scope is formulated in the context of an appeal against a first instance decision.

18. Finally, it is suggested that CGREC assess the relevance of regulating the issue by means of a normative administrative act, in order to facilitate communication, legal certainty and predictability for all actors and users of the intellectual property rights protection system.

19. CGREC's second question refers to cases of appeals against the rejection of a patent application, caused by the failure to properly comply with a requirement formulated by the 1st instance and the applicant's inability to convince the 1st instance of the objections raised in the technical examination.

20. CGREC argues, in summary, that:

> "The guidelines established by Resolution 93,'2013, in its item 2.5, determine that in the examination of the claim chart (QR) presented by the applicant there can **be** no addition of matter, as it is contrary to article 32 of the IPL. The QR must therefore be rejected in its entirety.
>
> If the QR is rejected, it is possible to use the previous QR to continue the examination, and the conclusions of the examination on the merits will be based on the previous QR. Furthermore, in cases where the QR is rejected on the basis of Article 32 of the IPL, the examiner can also indicate which subject matter is to be examined.

> is suitable for granting so that the applicant can make changes, in the interests of procedural economy (art. 220 of the IPL), which is why a demand is made.
>
> It is important to note that these guidelines, in their item 2.5, also establish that the 2nd administrative instance must follow the same procedures as the 1st instance in analyzing the claim framework, to determine whether or not there has been an addition of matter, in accordance with article 32 of the IPL. The guidelines for examining patent applications established by Resolution 124/2013 prohibit undue experimentation (item 2.15) and establish that the matter claimed must be precise enough to avoid undue experimentation, item 3.39, requiring that the generic claim be restricted to the forms of execution mentioned in the descriptive report.
>
> This resolution makes it possible, during examination, to object to the claimed subject matter when the examiner considers that the information is insufficient for it to be implemented. In this case, the examiner must allow the applicant to present arguments to the effect that the invention can in fact be readily applied on the basis of the information given in the descriptive report or, in the absence of such information, restrict the claim in this sense".

21. The Coordination therefore argues that it is possible, in accordance with current regulations (Resolution 124/2013 and Resolution 169/2016) "that results/tests/assays or similar can be presented during the technical examination, even after the examination request, with the aim of proving the technical effect of the invention".

22. In short, CGREC questions whether the second administrative instance will accept and appreciate reasons aimed at clarifying and proving the technical effect of the invention applied for, since they are inherent to the matter initially disclosed?

23. In direct response, **it is understood that yes.** CGREC can accept and appreciate reasons aimed at clarifying and proving the technical effect of the invention applied for, in line with all the analysis guidelines and with the broad devolutive effect of the appeal within the scope of the IPL, as was carefully delimited in OPINION no. 00016/2023/CGPI/PFE-INPI/PGF/AGU.

24. However, it is understood that it is not appropriate, on the grounds of accepting and appreciating reasons aimed at clarifying and proving the technical effect of the invention, to allow the production of acts, such as the presentation of documents, after the appropriate procedural moment, by **virtue** of **administrative preclusion.** In other words, the depositary must meet and comply with the requirements within the deadlines set, otherwise the opportunity will be lost. And the opportunity cannot be reopened on appeal, due to **administrative preclusion.**

25, It should be reiterated that once the technical examination phase has ended at first instance, administrative preclusion occurs, in accordance with art. 63, § 2, of Law no. 9.7S4,'99, as explained in OPINION no. 00019/2023/CGPI/PFE-INPI/PGF AGU:

> "28. As was discussed at length in OPINION no. 00016/2023/CGPl/PFE-INPI/PGF/AGU, the process is a chain of acts aimed at an end and it is essential that the acts are carried out at the appropriate legal opportunities, so that the process moves towards an outcome, without incurring in endless intercurrences and renewals of claims. 29 It is worth reiterating what I have already said: by virtue of preclusion, if a claim should have been presented at a certain procedural opportunity and was not, that claim can no longer be presented. What's more, even if such a claim has been presented on appeal, it cannot be heard on appeal due to estoppel. [...]
> 31. In this way, and in direct response to the question posed, it is understood that the facts reported fall under the hypothesis of administrative preclusion, with the party no longer having the right to produce the act after the deadline, nor can the claim be heard on appeal. Now, if the requirements were not met within the deadline, the applicant's opportunity to comply with them has expired. And, it should be emphasized, it is not possible to innovate on appeal, so there is no room on appeal to present a new claim."

26. Therefore, we reiterate the understanding set out in OPINION No. 00016/2023/CGPI/PFE-INPI/PGF/AGU, that requirements that were not satisfactorily met at first instance (in whole or in part) cannot be met on appeal, due to administrative esto p p e l .

27. To be even more specific, the example raised by CGREC to disagree with Dirpa's position, "...the *devolutive effect does not **make** it possible, for example, to present* documents *that were not submitted **within the** time limit during the proceedings in the first instance..." fits precisely into the situation described above, which is that according to the conclusion of OPINION No. 00016.'2023/CGPI 'PFE-INPI/PGF/AGG."* fits precisely into the situation described above, i.e., according to the conclusion of OPINION No. 00016.'2023/CGPI 'PFE-INPI/PGF/AGU. administrative estoppel prevents the inclusion or production of acts that should have been carried out at the appropriate procedural moment.

28. Exceptionally, if the appellant (applicant) **proves** that it was unable to produce the documents due to just cause, under the terms of art. 221 of the IPL, it is possible to accept the attachment of such documents on appeal, 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 ripe cause theory, in accordance with the guidance established in OPINION no. 00016/2023/CGPI/PFE- INPI/PGF'AGU.

III. Conclusion

29. In view of the above, in a judgment of strict legality, and in response to the query formulated, this Public Prosecutor's Office presents the following answers:

30. Regarding the first question:

> Can a restriction of the scope of the claim be admitted on appeal if it is limited to the matter initially claimed and does not result in an addition of matter, since, in this case, it would not be a new claim?

31. It is understood **that it is up to** the appellate **body to** assess **the request for a reduction in scope and** make **the consequent judgment as to whether or not the case** is **one of appellate innovation.** If the appellate body decides that the request for a reduction in scope is not innovative, it must analyze and decide on the appeal. If it decides that the request is innovative or a "new claim", the conclusion of OPINION No. 00016/2023 CGPI/PFE- INPIiPGF.'AGU should be applied, which prevents new claims from being heard on appeal due to **administrative estoppel.**

32. It is also suggested that CGREC assess the relevance of regulating the issue by means of a normative administrative act, in order to facilitate communication, legal certainty and predictability for all actors and users of the intellectual property rights protection system.

33. As for the second question:

> When considering an appeal against a rejection of a patent application, caused by the failure to properly comply with a requirement formulated by the first instance and the applicant's inability to convince the first instance of the objections raised in the technical examination, can the second administrative instance accept and appreciate reasons aimed at clarifying and proving the technical effect of the requested application, since they are inherent to the matter initially appealed?

34. **It is understood that sin.** CGREC can accept and appreciate reasons aimed at clarifying and proving the technical effect of the invention applied for, in line with all the analysis guidelines and with the broad devolutive effect of the appeal within the scope of the IPL, as carefully delimited in OPINION no. 00016 2023/CGPI'PFE-INPI PGF/AGU.

35. However, it is understood that it is not **appropriate,** on the grounds of accepting and appreciating reasons aimed at clarifying and proving the technical effect of the invention, to **allow the performance of acts,** such as the presentation of documents, after the appropriate procedural moment, by virtue of administrative preclusion. In other words, the depositary must meet and comply with the 5 requirements within the deadlines set, otherwise the

opportunity will be lost. And it is not possible to open up the opportunity on appeal, due to administrative preclusion, as set out in OPINION no. 00016/2023 CGPI/PFE- INPI/PGF/AGU.

36. Exceptionally, if the appellant (applicant) **proves** that it was unable to produce the documents due to **just cause**, under the terms of art. 221 of the IPL, it is possible to accept the attachment of such documents on appeal, with the second instance deciding either (i) to refer the matter back to the first instance, or (ii) to make a direct assessment based on the ripe cause theory. in accordance with the guidance set out in OPINION no. 00016/2023/CGPI/PFE-íNPI/PGF'AGU.

For your consideration.

ADALBERTO DO REGO MACIEL NETO
Attorney General

Please note that consultation of the electronic process is available at https://supersapiens.agu.gov.br by providing the Unique Protocol Number (NUP) 52402010705202319 and the access key cd6460eb.

Document signed electronically by ADALBERTO DO REGO MACIEL NETO, with an institutional Al certificate (*.agu.gov.br), in accordance with the applicable legal regulations. Verification of the document's authenticity is available with the code 1389538028 and access key ed6460eb at the electronic address https: /sapiens.agu.gov.br. Additional information: Signatory: ADALBERTO DO REGO MACIEL NETO, with institutional Al certificate (*.agu.gov.br). Date and Time: 07-02-2024 15:12. Serial Number: 654372557451877645764062110 80. Issuer: SERPRO SSLv l Certificate Authority.
