

FEDERAL PUBLIC SERVICE

MINISTRY OF THE DEVELOPMENT, INDUSTRY AND FOREIGN AFFAIRS

BRAZILIAN PATENT AND TRADEMARK OFFICE

RESOLUTION #154/2015.

Subject: Provides for the Administrative Procedure of the Patent Prosecution Highway (PPH) Pilot Program.

THE PRESIDENT OF THE BRAZILIAN PATENT AND TRADEMARK OFFICE – BRPTO AND THE PATENT DIRECTOR, in the use of their attributions and in terms of the provisions under law no. 9,279 of the 14th May 1996, Industrial Property Law – IPL and under articles 159, item IV and 106 of the internal statute of the BRPTO, attached to the Ordinance #149 of the Ministry of the Development, Industry and Foreign Affairs of the 15th May 2013, and

Taking into consideration the Joint Statement between the Brazilian Government and the United States of America on the Sharing of Patent Examination between Offices, signed in Washington on the 30th June 2015

Taking into consideration the Memorandum of Understanding between the BRPTO and the United States Patent and Trademark Office – USPTO, of the 19th November 2015 and the respective Work Plan agreed upon at the same occasion; and

Taking into consideration the Principles of Territoriality and the independence of the industrial priority rights

DECIDE

Article 1 – This Resolution provides for the administrative procedure of the Patent Prosecution Highway (PPH) Pilot Program agreed upon between the BRPTO and the USPTO, hereafter called PPH BRPTO-USPTO Pilot Project in the ambit of the BRPTO;

Article 2 - For the purposes of the provision laid down in this Resolution, the following definitions shall be adopted:

I - First patent application: Patent application filed with the BRPTO or with the USPTO, without claiming priority, suitable as a priority document for a second filing of patent application in another National Patent Office or International Organization and capable of originating a patent family or international filing, in the ambit of the Patent Cooperation Treaty – PCT - without claiming priority, wherein the BRPTO or the USPTO have been indicated as a Receiving Office, able to enter the National Phase giving rise to a family of patents:

II - Second Patent Application: patent application filed with the BRPTO or with the USPTO and which is part of the patent family of the first patent application; or patent application which entered the National Phase in the BRPTO or in the USPTO and which is part of the family of patents of the first patent application;

III - Patent Family: group of patents filed with more than one national patent office or international organization in which all the cases claim, at least, the earliest priority document;

IV - Office of First Filing - OFF: the patent office wherein the first patent application has been filed;

V - Office of Second Filing - OSF: The Patent Office wherein the second patent filing has been filed;

VI - Office of Earlier Examination – OEE: The National Patent Office, BRPTO or USPTO, which first notifies the grant decision of patent application of a patent family, either the OFF or OSF;

VII - Office of Later Examination - OLE: The National Patent Office , BRPTO or USPTO, in which it is requested the PPH, which prioritizes the prosecution and which makes the examination of a patent application of the same family of patents, on the basis of the results from the OEE;

VIII - Suitable Patent Application: A Patent application which complied with the conditions of eligibility, established under article 7th of this Resolution;

IX - Application Date: Date of filing of the requirement of the priority shared examination at the BRPTO's registered office or at the respective regional division and/or representations of each Federative State or through the electronic form or the posting date in the event of forwarding by post;

X- Sufficiently corresponding application: Application whose matter described in the application filed with the OLE does not add or modify the matter considered patentable at the OEE, even considering differences, in view of translations, both belonging to the same patent family;

XI - Sufficiently corresponding claim: claim which the matter claimed at the OLE bears an equal scope or more restricted than the matter considered patentable at the OEE, even considering differences, in view of translations of the claim; and

XII - Scope of a more restricted claim: the scope of a claim is more restricted when it is limited, in terms of article 32 of the Industrial property law and of Resolution INPI PR no. 93, of June 10, 2013.

Article 3 - For the effects of this Resolution, the PPH presents the following steps:

I - The Applicant files the first patent application, making the national office or international organization the OFF:

II - The Applicant files the second patent application claiming the first patent application as a priority or enters national phase, making the national office the OSF;

III - The national office which notifies the first patent grant decision, either of the first or the second patent application becomes the OEE;

IV - The applicant requests the participation in the PPH BRPTO-USPTO Pilot Project in the other national office, which becomes the OLE, satisfying the requirements and submitting the results of the first grant decision of patent; and

V - If considered suitable, OLE prioritizes the patent application of a same family in all the subsequent steps, up to the final decision.

Sole paragraph - The possible abandonment of the First Patent Application which served as a priority document for international filing, in the ambit of the PCT, does not exclude the participation of the respective entries in the national phase of the PPH BRPTO-USPTO Pilot Project.

Article 4 - The applicant of a patent application allowed at the USPTO may apply for the prioritization of the examination of a patent application of the same patent family at the BRPTO, if it satisfies the requirements of this Resolution.

Article 5 – The PPH BRPTO-USPTO Pilot Project is valid for a two-year time period for the receipt of applications for participation or the Pilot Project will extend until a decision is rendered for all the applications considered suitable.

Article 6 – The BRPTO will examine up to 150 (one hundred fifty) applications in terms of OLE.

§ 1 – The examination dealt with in the head of this article shall comply with the chronological Order of the application for the participation of the PPH BRPTO-USPTO Pilot Project.

§ 2 - The applications in condition of participating in the PPH BRPTO-USPTO Pilot Project exceeding the limit defined on the head of this article will not be incorporated into the Project.

- I - Patent application should have been filed in the BRPTO as of the 1st January 2013;
- II - It should be related to patent of invention;
- III - Patent application should have been published in the Industrial Property Gazette under terms of provisions of article 30 of the IPL or a request for early publication must have been filed, in terms of § 1 of article 30 of the IPL, or which has been accepted in the examination of eligibility for entry into the national phase of the applications filed via PCT;
- IV - Patent application whose examination has already been requested, in terms of article 33 of the Industrial Property Law;
- V - Patent application whose examination is not suspended for the fulfillment of a requirement previously raised by the BRPTO;
- VI - Patent application whose annuities are settled according to the provisions of article 84 of the IPL;
- VII - Patent application which does not have a fast track examination granted and published in the Industrial Property Gazette;
- VIII - Patent application which is not involved in a court action in Brazil;
- IX - Patent application which is not divided, except those resulting from the direct division of the original application and resulted from the allegations of lack of unit of invention by the OEE in the sufficiently corresponding application;
- X - Patent application, which has not undergone a regular technical examination properly published in the Industrial Property Gazette;
- XI - Patent application, whose claimed matter is explicitly connected to the industry of oil, gas and petrochemistry and classified with any of the symbols of the International Classification of Patents - IPC, including its respective lower hierarchic levels of classification, as shown in Appendix I of this Resolution;

XII - Patent Application belonging to a family of patents, according to the provisions of article 2 of this Resolution;

XIII - Patent application whose family member has been allowed in the USPTO (“Notice of Allowance”);

XIV - Patent application whose family has at least the first patent application filed at the BRPTO or USPTO.

§ 1 - Patent applications of utility model and industrial design are excluded from the PPH BRPTO-USPTO Pilot Project.

§ 2 - Plant patent applications, reexamination applications, reissue applications and industrial design applications cannot be used for applying for the participation in the PPH BRPTO-USPTO Pilot Project.

Article 8 - The request of admission into the PPH BRPTO-USPTO Pilot Project, cited in this Resolution shall be applied for by means of Service Code no. 277 of the Table of Fees of the Services Relative to Patents rendered by the BRPTO, however it does not exempt the applicant from any other fees of the prosecution of the patent application.

Article 9 - In the event that the BRPTO act as OEE of a patent application having a family member in the USPTO, the applicant is entitled to apply for a participation in the PPH BRPTO-USPTO Pilot Project in the USPTO, in compliance with provisions established by the USPTO.

Article 10 - For enabling the patent application to be admitted into the PPH BRPTO-USPTO Pilot Project, only the applicant of the case is entitled to request it, by using the Application Form of Participation in the Patent Prosecution Highway Pilot Project – PPH.

Sole paragraph - There being more than one applicant for the patent application, all of them must authorize the participating request.

Article 11 - The acts dealt with in this Resolution, when not performed by the own applicant, must be accompanied by the Power of Attorney, under terms of § 1 of article 216 of the IPL.

Article 12 - The Applicant shall submit the following documents and information in Portuguese at the BRPTO at the moment of the admission request in the PPH

I - Application Form of Participation in the Patent Prosecution Highway Pilot Project – PPH;

II - New pages of the patent application, adapted for sufficiently correspond to the matter previously stipulated as allowed by the OEE, in compliance with the regulatory instructions in force, which refer to the presentation of patent applications at the BRPTO;

III - Table of correspondences of the claim sets, demonstrating the correlation between the new claims submitted to the BRPTO and the claims considered patentable by the USPTO as OEE, according to the model of Appendix II of this Resolution;

IV - Evidence that the application falls within the technological sector able to participate in the Pilot Project, according to item XI, article 7 of this Resolution;

V - In the event the object of the patent application results from the access to a sample of a component of the Brazilian genetic heritage or an associated traditional knowledge, it becomes necessary to submit, along with the application of the PPH BRPTO-USPTO Pilot Project, the information required by the legislation in force;

VI - In the event the report of the technical examination of the OEE had cited non patentable documents as prior art, it is necessary to submit these documents, together with the application of PPH BRPTO-USPTO Pilot Project.

Sole paragraph - In the event the claims submitted to the BRPTO are a mere translation of the claims allowed by the USPTO as OEE, the table of the correspondence cited in the item III of this article may be replaced by a simple declaration of this condition.

Article 13 - The applicant shall submit the following documents, along with the following declarations in Portuguese to the BRPTO, at the moment of the request of participation in the PPH BRPTO-USPTO Pilot Project or declare in the Application Form that:

I - The copies of the actions from the OEE, if submitted to the BRPTO are faithful to the original applications, reproducing their forms and contents;

II - The translations, if submitted to the BRPTO, are faithful to the contents of the original documents;

III - The patent application is not involved in court actions in Brazil; and

IV - The patent application is not resulted from a voluntary division of the Patent application.

Article 14 - The analysis of the priority examination request and eligibility of the applications, which may participate in the PPH BRPTO-USPTO Pilot Project, is under responsibility of the Patent Board of Directors - DIRPA, through the Work Group of the Project of Priority Shared examination.

Article 15 - When the submitted Patent Application is considered able to participate in the PPH BRPTO-USPTO Pilot Project, the BRPTO will notify the grant of the fast track examination of the patent application in a specific publication in the Industrial Property Gazette.

Article 16 - When the patent application is not considered able to participate in the Pilot Project or the limit of vacancies are exceeded, the BRPTO will notify the denial of the priority examination of the patent application in a specific publication in the Industrial Property Gazette.

§ 1 - The denied fast track examination returns the patent application to the ordinary procedure.

§ 2 - In the event the BRPTO indicates that the application contains irregularities, a single additional request of fast track examination may be filed within a 60-day term, as

provided under article 224 of the Industrial Property Law, so as to correct any possible errors, being dispensed to re-submit possible documents for which no irregularities have been pointed out.

Article 17 - The decisions provided in this Resolution cannot be appealed from, under article 212 of the Industrial Property Law;

Article 18 - Even if the fast track examination request is granted, the examination of the patent application shall not be initiated prior to the expiration of a 60(sixty)-day term, as of its publication, as provided in article 31 of the Industrial Property Law.

Article 19 - The PPH BRPTO-USPTO Pilot Project does not alter the principle of the independence of the rights set down under article 4bis of the Paris Union Convention.

Article 20 - The PPH BRPTO-USPTO Pilot Project does not exempt the applicant from complying with what is set down in the IPL for patent applications filed at the BRPTO.

Article 21 – The examination of patent application through the PPH BRPTO-USPTO Pilot Project shall be carried out as per the Brazilian Legislation and complying with any other procedures in force on the date of the examination.

Article 22 - Over the time period of the technical examination, the BRPTO may request to the applicant the following documents:

- I - Copy of the Search Reports; Technical Examination Opinions performed by OEE and applicant's responses to said opinions;
- II - Copy of the set of claims considered patentable by the OEE;
- III - Copies of the prior art documents cited by the OEE in its reports of technical examination.

Sole Paragraph: The documents requested by the BRPTO, which are not originally in Portuguese, English or Spanish shall be submitted to the BRPTO in the form of a simple translation into one of these languages, at the discretion of the Applicant.

Article 23 - This Resolution will become effective on the 11th January 2016.

LUIZ OTÁVIO PIMENTEL

President

JÚLIO CÉSAR CASTELO BRANCO REIS MOREIRA

Patent Director