

RESOLUTION INPI/PR No. 241 OF 3 JULY, 2019

Subject: Regulates the preliminary requirement of patent applications of inventions pending examination with prior art searches carried out by patent offices of other countries, as well as regional or international organizations.

The PRESIDENT and the DIRECTOR OF PATENTS, COMPUTER PROGRAMS and TOPOGRAPHIES OF INTEGRATED CIRCUITS of the NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY, in accordance with the legal powers granted to them by Articles 17, item XI, and 19 of INPI's governance structure, approved by Decree No. 8,854 of 22 September 2016, and item XII of Article 152 of internal by-laws, approved by Ordinance MDIC No. 11, of 27 January 2017,

CONSIDERING the urgency in deciding on patent applications filed more than 10 (ten) years ago as a means of reducing losses to society resulting from the extension of the patent term provided for in Article 40, single paragraph, of Law No. 9.279 of 1996 (LPI);

CONSIDERING that the search results held by patent offices in other countries and by international or regional organizations can be used to expedite INPI's technical decision-making;

DECIDE:

Art. 1. This resolution regulates the analysis of patent applications for inventions pending examination with prior art searches carried out by patent offices of other countries and international or regional organizations.

Art. 2. The preliminary report regulated by this Resolution applies to the patent application:

- I - not submitted to the first technical examination carried out by INPI;
- II – not subject to any type of priority examination by INPI;
- III – not containing third-party or ANVISA's observations;
- IV – having corresponding application with searches of prior art carried out by patents offices of other countries and international or regional organizations;
- V - with filing date up to 31/12/2016.

Single paragraph. Once the patent application has been exempted from the preliminary report regulated in this Resolution, such exemption will also fall upon its divided applications.

Art. 3. Once the requirements of Article 2 of this Resolution have been fulfilled, the Patent, Computer Programs and Topography of Integrated Circuits Board (DIRPA) will publish the preliminary report with the following content:

I - search report limited to prior art documents cited in the searches and/or technical examination carried out by patent offices of other countries and of international or regional organizations; and

II - requirement for the applicant to amend the application and/or present arguments regarding to the patentability requirements (Article 8, Law 9.279 of May 14, 1996, LPI), according to the documents cited in the search report.

§1 – The answer to the preliminary report presenting amendments to the claims filed must comply with the provisions of national legislation, of the INPI/PR Normative Instructions No. 30 and No. 31 of December 4, 2013, and applicable examination guidelines.

§ 2° If the amendment leads to an increase in the number of claims in relation to those for which the examination was requested, the examination fee shall be supplemented.

Art. 4. The applicant will have 90 (ninety) days to respond to the preliminary report referred to in Article 3 of this Resolution, counted from the date of publication in the RPI.

§ 1° If the applicant does not respond to the preliminary report in said period, the application will be definitively shelved in accordance with Article 36 of the LPI.

§ 2° Once the preliminary report is responded, the INPI will continue the technical examination.

Art. 5. The examination of the application shall be limited to the documents cited in the search report referred to in Article 3 of this Resolution.

§ 1° The examination conducted by Patent Offices of other countries and International or Regional Organizations shall be deemed as a subsidy to the INPI examination.

§ 2° The patent shall be granted once the claims presented are adequate to the prior art cited as impeditive to patentability, and the application is in accordance with national legislation.

§ 3° The application shall be rejected, if the claims are not adequate to the prior art cited as impeditive to the patentability and if arguments regarding the patentability requirements are not presented.

§ 4° In case of refusal of the claims based on Article 32 of the LPI, the examiner should assess whether the rejected claims contain patentable subject matter which can be used as a subsidy for the technical examination, according to the Guidelines on the applicability of provisions of Article 32, of Law 9279/96, in the patent applications, under INPI, item 2.5.

Art. 6. Resolution INPI/PR No. 227 of October 25, 2018 is hereby revoked.

Art. 7. The INPI/DIRPA Normative Instruction No. 2 is suspended as of June 6, 2016.

Art. 8. This Resolution will come into effect as of July 22, 2019.

Rio de Janeiro, 3 July 2019

CLÁUDIO VILAR FURTADO

President

LIANE ELIZABETH CALDEIRA LAGE

Director of Patents, Computer Programs and Topographies of Integrated
Circuits