

RESOLUTION INPI/PR No. 240 OF 3 JULY, 2019

Subject: Regulates the preliminary requirements for a patent deposit for an invention whose examination is pending and for which no searches were carried out by patent offices of other countries, international or regional 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 power granted to them by Articles 17, XI and 19 of the INPI Regimental Structure, approved by the Decree No. 8.854 of September 22, 2016, and item XII of Article 152 of the internal by-laws, approved by Portaria MDIC No. 11 of January 27, 2017,

CONSIDERING the urgency in decisions of patent applications filed more than ten (10) 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);

DECIDE:

Art. 1. This Resolution regulates the analysis of patent applications pending examination for which no prior art searches in Patent Offices of other countries and International or Regional Organizations was carried out.

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 in INPI;

III - not containing third-party or ANVISA observations;

IV – not having a corresponding application with prior art searches carried out by patent 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 by 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; and

II - requirement for the applicant to amend the application and/or present arguments regarding to the patentability requirements (Article 8 of 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 must comply with the provisions of national legislation, of INPI/PR Normative Instructions N°. 30 and 31 of 4 December 2013, and the 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. In cases in which the search report mentioned in Article 3 refers only to documents that are not considered relevant to the patentability, the preliminary report will not be published, and the technical examination will be carried out.

Art. 5. 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. 6. The examination of the request shall be limited to the documents cited in the search report referred to in Article 3 of this Resolution.

§ 1° 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.

§ 2° In case of refusal of the claims based on Article 32 of the LPI, the examiner shall 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 the INPI, item 2.5.

Art. 7. This Resolution comes into effect as of August 1st, 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**