

PATENT PROSECUTION **GUIDE IN BRAZIL**

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PATENT PROSECUTION GUIDE

for *foreign* patent applicants

(valid for 2024)

Introduction

The Brazilian patent system has its peculiarities. Mastering the rules, exceptions, and best practices of this system greatly benefits the patent applicant who files their patent document in our jurisdiction.

The first factor every patent applicant in Brazil must consider is that, according to Article 32 of Law 9279 of 1996 (the Brazilian Industrial Property Law, BIPL), the applicant can only make broad amendments to their patent document until the examination request is filed. In Brazil, the examination request must be made within 36 months after the document is filed (Article 33 of the BIPL).

After the examination request is made, the conditions and situations that allow for amendments are much more limited.

The second factor to consider when filing a patent application in Brazil is the limitations imposed by Articles 10 and 18 of the BIPL. These articles prohibit, for example, the patenting of discoveries, business plans, computer programs, therapeutic, diagnostic, and surgical methods, atomic nucleus transformations, and parts of living beings.

But to what extent can the use of a drug for a particular treatment be considered a therapeutic method or the creation of a new industrial product? To what extent can a diagnostic method be considered as falling under Article 10, thus not being allowed by BIPL? And to what extent is this method considered an industrial activity, carried out within a machine by a service provider positioned far away from the patient's body?

All these particularities of national law are briefly and illustratively addressed below, providing a better understanding of these issues and avoiding potential frustration for the applicant with the patent prosecution process in Brazil.



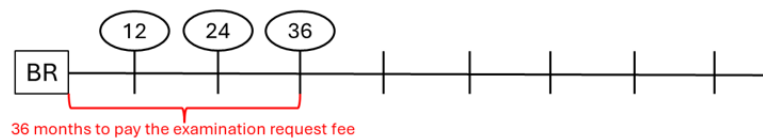


When can I request examination and what can I amend before and after the examination request?

After filing a patent application, the applicant has up to 36 months to request examination.

Reminder: When a patent application originates from the PCT (Patent Cooperation Treaty), the Brazilian filing date, for any purpose, will be the date of entry into the PCT (the International Filing Date). See the following diagram:

Brazilian document with no priority



Document originating from PCT



Document originating from Paris Convention



It is possible to request the examination at the time of filing, provided that the applicant submits a petition for the early publication of the document. In Brazil, the examination cannot occur before the document is published by the Brazilian Patent and Trademark Office (BPTO).

Is it worth requesting examination at the time of filing?

It depends. **After the examination request, no amendments that alter the subject matter or broaden the scope of the claims may be made.** Voluntary amendments to the claim set (CS) may be made before the examination request or in response to an office action issued by the BPTO. However, these amendments must not introduce new matter or alter the scope of protection, as per Articles 32 of the BIPL and BPTO Resolution 093/2013.

The earlier the examination is requested, the sooner the document will be analyzed.





Amendments to correct or reduce the scope may be made at any time without the limitation of Article 32, according to Resolution 093/2013, limited to the matter previously revealed at the claim set.

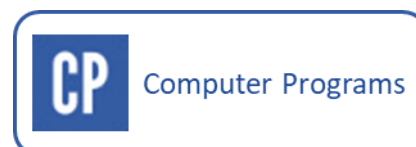
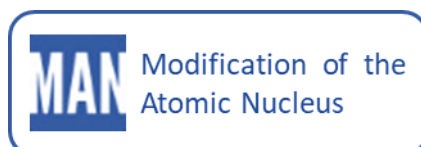
In short:

1. After the examination request, voluntary amendments that broaden the claimed subject matter are not permitted. Only restrictions of the protection scope are accepted, considering that they do not alter the subject matter.
2. Before the examination request, it is possible to amend the description, claims, abstract, and drawings, **considering that the amendments adhere to the matter originally disclosed.**
3. Corrections of material errors (such as translation errors) may be made at any stage of the examination, if they are based on the documents already submitted such as the priority document.
4. **Amendments to adjust the claims to Resolution No. 17/2013**, such as dependency corrections or inclusion of numerical references, **are accepted**, as defined by Article 220 of the BIPL.

Some examples of modifications that are not accepted, as they may constitute the addition of new subject matter, include:

- i) the elimination of an element of the invention described in series;
- ii) the addition of an element in an alternative form;
- iii) the transfer of a feature originally present in an independent claim to a dependent claim.

Objects not eligible for patent protection:





Therapeutic Method



According to Article 10 of the BIPL, surgical, therapeutic, and diagnostic methods applied to the human or animal body are not patentable in Brazil, as is the case in most countries. However, diagnostic methods performed outside the body, such as in a laboratory, can be patented, as well as devices related to these procedures.

Surgical devices, diagnostic devices, medicines, and *in vitro* diagnostic methods are considered patentable, according to the administrative case law of the BPTO. It is essential to note that processes involving surgical or therapeutic steps can be patented, provided the steps performed on the body are excluded from the claim.

Additionally, according to item 3.73 of Resolution 124/2013, a "use" claim, such as "use of substance X as an insecticide," should be treated equivalently to a "process" claim, like "a process of killing insects using substance X" or "use of alloy X to manufacture a specific part." These claims do not refer to the substance itself but to the specific defined use, such as insecticide or for manufacturing a part. Therefore, in this case, use claims are equivalent to process claims.

It is important to emphasize that a patent for an invention of new-use grants exclusivity only over the new use claimed, without restricting previously known uses. As Denis Borges Barbosa (a Brazilian famous) explains, use claims must balance constitutional interests, preventing them from becoming an undue extension of the patent privilege or hindering the free use of technical knowledge. (Tratado da Propriedade Intelectual: patentes. Rio de Janeiro: Lumen Juris, 2010. p. 1272.)

New-use inventions that reveal a new practical and technical application of an already known object will not be considered mere discoveries. However, focusing solely on new properties of an element, without demonstrating a practical use, will be treated as a discovery without patentable value.

Second-use inventions, a specific category within new-use inventions, involve the application of chemical-pharmaceutical products for the treatment of new diseases using the so-called "Swiss-





type claim," as per item 1.29 of Resolution 169/16. Several companies, universities, and research institutes hold patents in this area.

Formats such as "treatment of medical condition Y by administering substance X," "use of substance X to treat medical condition Y," or "substance X for use in the treatment of Y" are considered therapeutic methods and, therefore, not patentable. However, the Swiss-type claim format, such as "use of a compound of formula X to prepare a medicament for treating disease Y," is not classified as a therapeutic method and is considered patentable matter in Brazil for the time being.

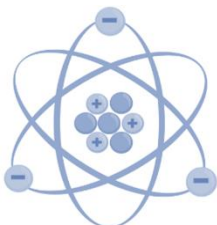
The Swiss-type claim protects the use of the compound in the process of manufacturing a medicament, with the compound preferably defined by its chemical structure or IUPAC nomenclature. Unlike compound claims, which protect the compound itself, the Swiss-type claim limits protection to the process of preparing the medicament.

According to item 3.76 of Resolution 124/2013, this type of claim protects the use of the compound in the process but not the therapeutic method, which is not considered an invention under Article 10, item VIII, of the BIPL. Claims such as "use for treatment", "process/method for treatment" or "administration for treatment" are classified as therapeutic methods and, therefore, are not patentable under Brazilian law.

However, it is important to emphasize that, considering the provisions of Resolution 93/13 and Article 32 of the BIPL, after the examination request date, it is not permitted to change therapeutic method claims to Swiss-type claims, as this would alter the subject matter in the CS.



Modification of the Atomic Nucleus



Not all techniques in the nuclear field involve the transformation of the atomic nucleus, and therefore, such techniques are not included in the exception to patentability. However, those that do involve nuclear transformation are not patentable. (Art 18 of BIPL)

This prohibition aims to protect public safety and prevent private individuals or researchers from experimenting with nuclear processes, as highlighted by Pedro Marcos Nunes Barbosa and Denis Borges Barbosa:



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"There is a clear danger to sovereignty if private parties handle atomic fission, which could lead to catastrophic consequences, especially when scientific research relies on trial and error methodology." (O Código da Propriedade Industrial Conforme os Tribunais. Rio de Janeiro: Lumen Juris, 2018. p. 258)

It is possible, in some cases, to circumvent these limitations through patents that protect the means and accessories used in the process of atomic nucleus transformation.



Living Organisms



According to Article 10 of the BIPL, whole or parts of living organisms are not patentable. But Article 18 opens an exception for transgenic microorganisms that meet the patentability requirements—novelty, inventive step, and industrial application. Transgenic microorganisms are defined as organisms, excluding plants and animals, that express characteristics not achievable naturally due to direct human intervention.

This requirement of human intervention essentially reiterates what is stated in items I and IX of Article 10, which do not consider scientific discoveries and the whole or parts of natural living organisms and biological materials found in nature as patentable.

However, the BIPL does not specify the techniques that constitute direct human intervention explicitly, such as the Biosafety Law, which defines transgenic microorganisms as those obtained specifically through genetic engineering. Therefore, for the purposes of the BIPL, any technique resulting in the direct alteration of a microorganism's genetic composition to acquire a characteristic not achievable under natural conditions can result in a transgenic microorganism.

On the other hand, while transgenic microorganisms are patentable, protecting transgenic plants is more complex. Creating these plants requires specific technologies, such as genetic constructs and methods for inserting these constructs into the genome. Thus, indirect protection for transgenic plants is achieved by patenting these processes, ensuring exclusive rights over the economic exploitation of these plants.





According to Article 42 of the BIPL, the patent holder has the right to prevent others from producing, using, selling, or importing the patented product or products directly obtained through a patented process. Therefore, in process patents, the product resulting from the process is also protected. In the context of transgenic plants, examples of patentable technologies include: genetic constructs, modified microorganisms (such as *Agrobacterium* strains or plant viruses), and methods of genetic engineering for gene insertion or deletion.

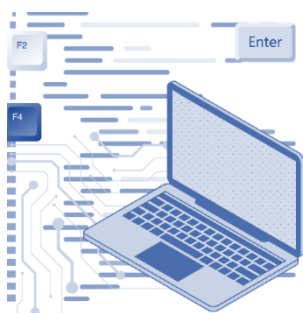
These technologies must meet the patentability criteria of the BIPL. However, the BIPL also establishes exceptions to the right of exclusivity, according to Article 43. The patent holder cannot prevent:

- Private acts without commercial intent that do not harm the economic interests of the holder;
- Experimental acts for scientific or technological research purposes;
- Preparation of medicines based on medical prescriptions;
- Use of patented products legally introduced into the market;
- Use of patented living matter for variation or propagation purposes, without economic intent;
- Acts for obtaining commercial registration after the patent expires.

Especially in the case of patents related to living matter, commercial use for multiplication or propagation of this living matter is not allowed without authorization, as specified in item VI of Article 43.



Computer Programs



Resolution 158 of 2016 from BPTO is perhaps the most comprehensive document available today that addresses the patentability of software in Brazil. Key excerpts from this document include:





"A creation is considered an invention when the resources used to solve the problem being addressed are not found in a field included in the items of Article 10 of the BIPL. According to current understanding, the invention must be in a technical field, solve technical problems, provide a solution to such problems, and have a technical effect. Thus, the application must demonstrate the technical character of the problem to be solved, the proposed solution, and the effects achieved." (Paragraph 2, item 2, Resolution 158).

"The computer program itself, as mentioned in item V of Article 10 of the BIPL, refers to the literal elements of the creation, such as the source code, understood as an organized set of instructions written in natural or coded language. The computer program itself is not considered an invention and, therefore, is not subject to patent protection as it is merely an expression of a technical solution, being intrinsically dependent on the programming language. [...] The computer program, in terms of copyright, is not considered an invention and, therefore, is excluded from patentability." (Paragraph 2, item 2.1, Resolution 158).

Additionally, according to BPTO's understanding, creations involving algorithms, embedded software, and text processors, among others, may be patentable, provided they meet patentability requirements.

This understanding aligns with international jurisprudence and Article 10 of TRIPS, which stipulates that computer programs, in source or object code, should be protected similarly to literary works. However, "software inventions," which combine process or product characteristics with steps performed by a computer program, are patentable if they provide a technical solution to a problem and result in a technical effect that goes beyond normal interactions between software and hardware.

Decisions from the European Patent Office reinforce this approach, such as in case T 1173/97, where a computer program product is not excluded from patentability if, when executed on a computer, it produces an additional technical effect that goes beyond the normal physical interactions between the program and the computer.

These principles highlight that while simple programming is not patentable, innovations associated with a specific technical problem, when applied to a concrete system and resulting in a technical effect, can be protected by patents in Brazil.





Procedures for the Application of Article 32 of the BIPL

Below are two diagrams, as outlined in Resolution 93/13, intended to guide the applicant regarding the procedures adopted by the BPTO in the event of an article 32 occurrence.

Diagram 1 presents the process followed by the examiner in the case of an article 32 occurrence during the first technical examination, while Diagram 2 refers to its occurrence during the second and subsequent technical examinations.

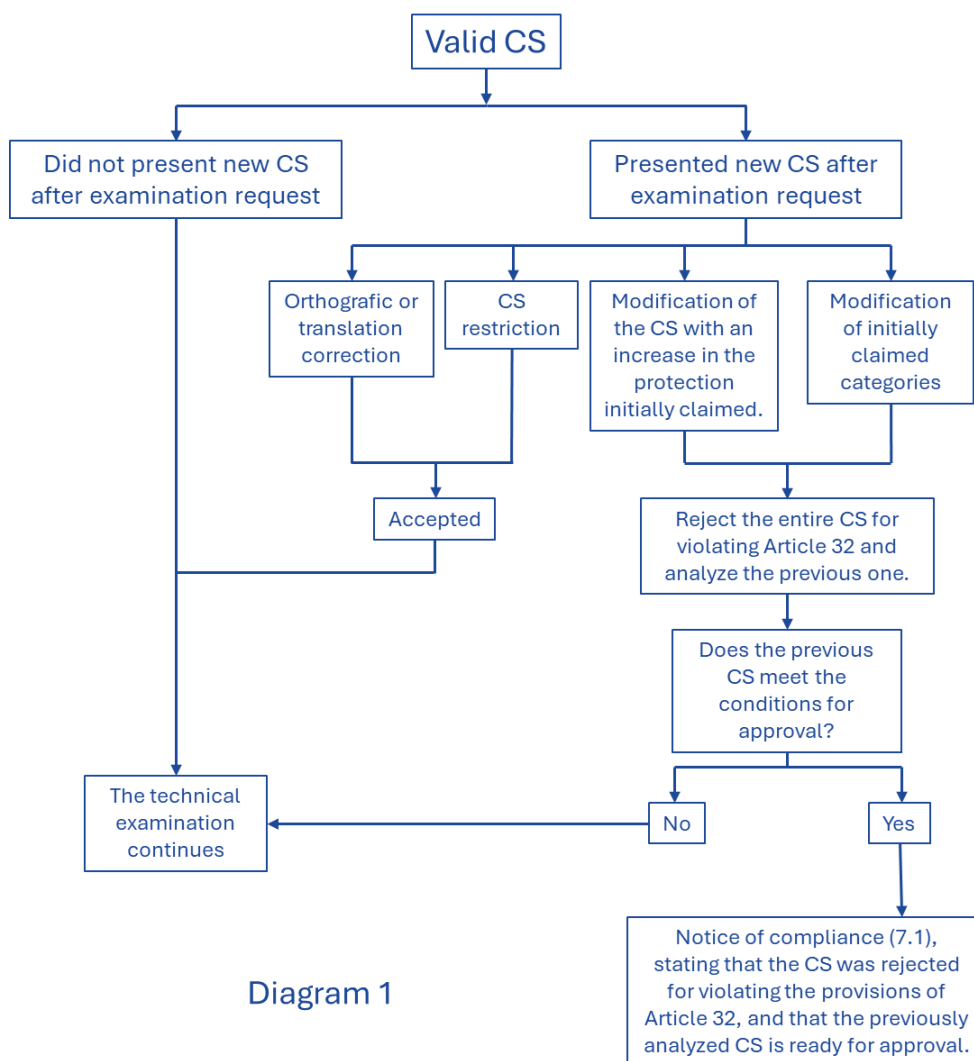


Diagram 1

CS = "CLAIM SET"



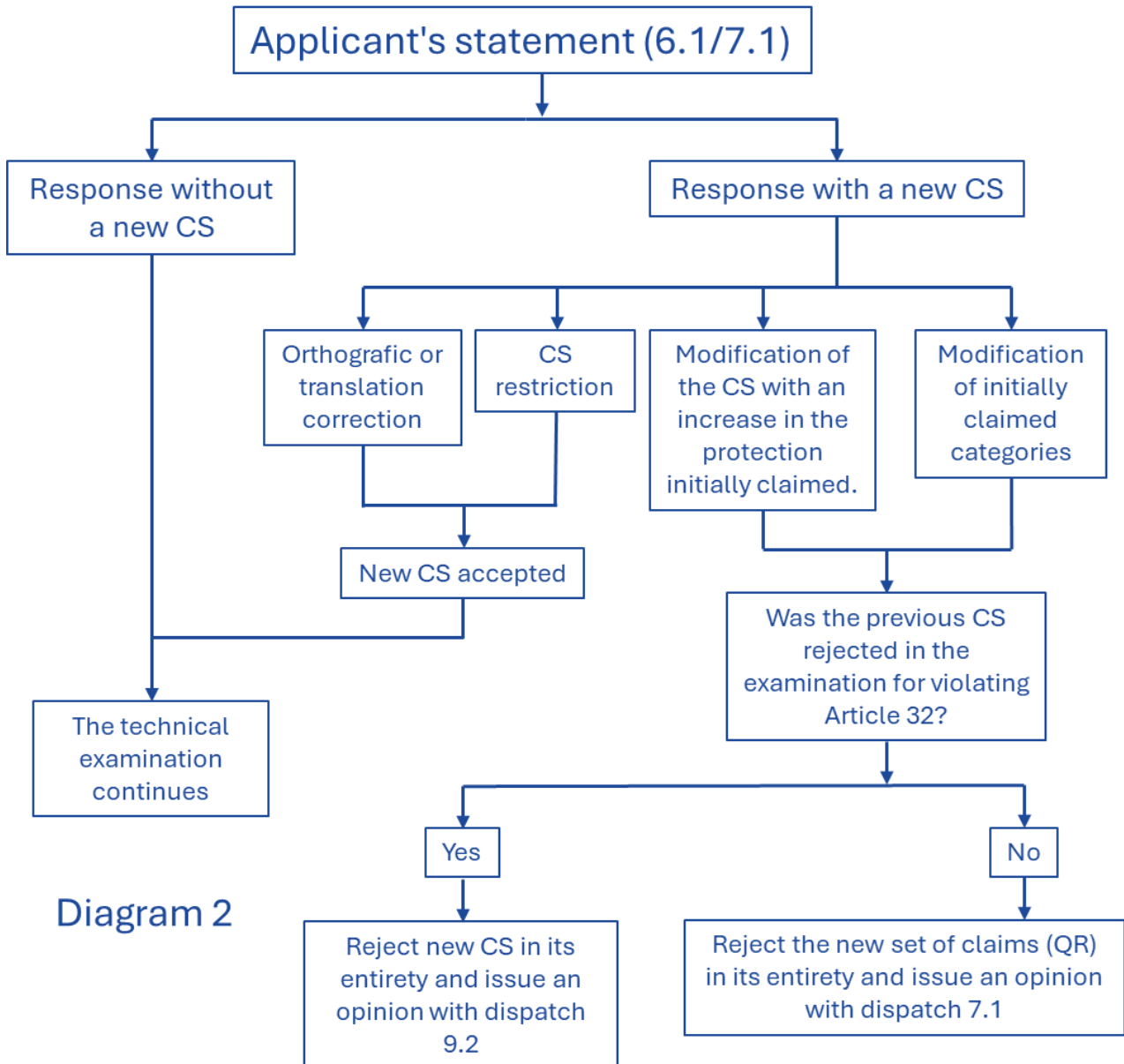


Diagram 2

CS = "CLAIM SET"

Final Comments

If your patent application claims something like any of the items mentioned above, schedule a meeting with our team to explore possible ways to address these objections.

It is important to note that Article 32 of the Brazilian Industrial Property Law (BIPL) stipulates that amendments to the claims of a patent document are much more restricted after the request for examination has been made. Additionally, keep in mind that the deadline for filing the examination request is 36 months after the application is filed.



This guide is intended for informational purposes only and does not constitute legal advice. The content is based on current Brazilian intellectual property laws and practices, which are subject to change. Resolutions of the Brazilian Patent and Trademark Office (BPTO) may be amended at any time, the Brazilian Industrial Property Law is subject to modification, and new judicial precedents may introduce new interpretations to the matters discussed in this guide. The authors and publishers of this guide disclaim any liability for actions taken based on its contents.

Best Regards,

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