

# **Industrial Property Gazette<sup>1</sup>**

**No. 2548  
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**ORDINANCE / INPI / PR NO. 252, OF OCTOBER  
18TH, 2019**

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<sup>1</sup> Unofficial translation by Eduardo Santos (from Alpha Translations) and made publicly available on LinkedIn by Interfarma.

**MINISTRY OF ECONOMY  
NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY**

**ORDINANCE/INPI/PR NO. 252, OF OCTOBER 18TH, 2019**

**Subject:** Institutes the PPH Pilot Project.

The **PRESIDENT** and the **DIRECTOR OF PATENTS, COMPUTER PROGRAMS AND TOPOGRAPHIES OF INTEGRATED CIRCUITS** of the **NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY**, in the use of the duties provided for in arts. 17, item XI, and 19 of the INPI Regimental Structure, approved by Decree No. 8,854, of September 22th, 2016, in item XII of the article 152 of the Internal Regulations, approved by MDIC Ordinance No. 11, of January 27th, 2017,

RESOLVES:

Art. 1º This Resolution establishes the *Patent Prosecution Highway* (PPH) Shared Examination Pilot Project under the National Institute of Industrial Property (INPI), called the PPH Pilot Project.

Art. 2º For the purposes of this Resolution, the following definitions shall be adopted:

I - international patent application: patent application filed under the Patent Cooperation Treaty (PCT);

II - patent process: INPI's administrative process for the protection of industrial property rights by granting a patent for an invention or utility model, from the filing of the patent application or, in the case of an international application, its communication or referral, until the close of the administrative instance;

III - patent family: set of patents and/or patent applications, nationals or in effect of regular nationals, directly related to each other by claiming domestic or unionist priority and/or sharing the same international filling;

IV - Office of Earlier Examination: Institute responsible for the examination of patent applications with which the INPI has a signed and existing PPH type cooperation instrument, which carried out the technical examination of a patent application of the same family prior to the INPI; and

V - material considered patentable: material that the Office of Earlier Examination has technically examined and found to meet at least the requirements of novelty, inventive act / inventive activity and industrial application.

Art. 3º The patent process must meet the following requirements:

I - be filed for at least eighteen (18) months or with advance publication requirement or, in the case of international applications, published by the World Industrial Property Organization (WIPO);

II - have collected the consideration for the technical examination;

III - not have priority of processing granted and published in RPI;

IV - not have the technical exam started;

V - there is no voluntarily division or modification of the patent application by the

applicant between the application and the decision of the priority process;

VI - belong to a patent family whose at least older patent application has been filed with the INPI or the Office of Earlier Examination, acting as a national or regional office or, within the scope of the PCT, acting as a Receiver Body (RO);

VII - belong to a patent family in which the Office of Earlier Examination, acting as a national patent office, has examined a request from this family, and has considered that there is a subject considered patentable in a technical, substantive or merit examination;

VIII - belong to a patent family in which the Office of Earlier Examination, acting as a national patent office, has issued a decision of approval or granting;

IX - claim subject matter equal to or more restricted than that considered by the Office of Earlier Examination to be patentable for the same patent family application, even considering differences due to translations, being prohibited the inclusion of matters for which the Office of Earlier Examination has not made search and/or technical examination, even if there is restriction of the subject of the claim.

Sole paragraph. Addition certificates that meet the requirements set out in the caput are subject to prioritization after granting the patent for the application to which they relate.

Art. 4º Participation requirements must meet the following requirements:

I - be made by any applicant, either alone or jointly, or their duly qualified attorney in the patent process;

II - be the sole requirement in this Pilot Project of any applicant within the monthly cycle.

III - to be performed after payment of the Union Collection Guide (Guia de Recolhimento da União - GRU), according to the Remuneration Table of the Services provided by INPI;

IV - be performed by electronic form;

V - submit attached the following documents:

a) copy of the cover page of the document proving that the patent application meets the definitions of article 3, item VI, of this Resolution;

b) copy of document proving that the patent application of the same family complies with that described in article 3, item VII, of this Resolution;

c) copy of document proving that the patent application of the same family complies with that described in article 3, item VIII, of this Resolution;

d) copy of non-patenting prior art documents cited in any technical examination report of the Office of Earlier Examination, or statement that the Office of Earlier Examination has not cited non-patenting documents in any technical examination report;

f) copy of the claim chart as approved by the Office of Earlier Examination;

g) modified patent application, in order to comply with the provisions of article 3, item IX, of this Resolution, respecting the current legislation regarding the alteration of INPI patent applications, or declaration that the patent application complies with the provision of item; and

h) correspondence table of the claim charts, according to the model of Annex I of this Resolution, evidencing the correlation between the claims considered patentable by the Office of Earlier Examination and the new claims presented to the INPI, or declaration that the claims presented to the INPI constitute a mere translation of the claims of the request considered patentable by the Office of Earlier Examination; and

VI - be made between 12/1/2019 and 11/31/2022.

§ 1º The monthly cycle provided for in item II of the caput of the article begins on the

1st day of the month and ends on the last day of the month, and no extension is allowed.

§ 2° The consideration provided for in item III of the caput corresponds to the rate of evaluation of the participation request.

§ 3° If the copies of the documents required by item V of the caput are in a language other than Portuguese, English or Spanish, the translation into one of these languages must also be presented.

§ 4° The presentation of document, certificate or its copy is not required, when issued by the INPI.

§ 5° The application for priority processing shall be deemed to be the express request of the applicant to process or examine the international application before the 30 (thirty) month deadline in accordance with Article 23.2 of the PCT Treaty.

Art. 5° The PPH Pilot Project may receive up to 400 (four hundred) applications per annual cycle, regardless of the priority procedure, and will extend until the termination of the administrative instance of all priority patent processes.

§ 1° The filling of the vacancies provided for in the caput of this article will obey the order of the priority application protocol date.

§ 2° The annual cycle provided for in the caput of the article begins on the 1st day and ends on the last day of the year, and no extension is allowed.

§ 3° The Directorate of Patents, Computer Programs and Topographies of Integrated Circuits (DIRPA) may temporarily suspend all or part of the receipt of PPH applications for patent processes.

§ 4° DIRPA shall notify the suspension described in the caput of § 3 at least 30 (thirty) days in advance.

Art. 6° It will be up to DIRPA to define the procedure for evaluating priority applications, to verify that the applications and processes meet the criteria established in this Resolution and to publish its decision in the Industrial Property Electronic Gazzete (RPI).

§ 1 INPI will prioritize the expedient acts necessary for the assessment of the priority application.

§ 2 Omitted cases are decided by the senior executive officer of the Directorate responsible for the processing of patent proceedings at 1st instance.

Art. 7° Petitions will not be recognized when:

I - not refer to a patent procedure in the form of the item II of the article 2;

II - the patent process does not meet the requirements of the items III, IV or V of the article 3;

III - the application is filed in disagreement with the items I, II, III, IV or VI of article 4;  
or

IV - the request exceeds the limit stipulated in the caput of article 5 or the reception is suspended according to § 3 of the same article.

Art. 8° A single requirement will be made to be met within 60 (sixty) days when:

I - the applicant and/or his attorney are not properly qualified;

II - the formal procedural conditions set out in the items I or II of the article 3 are not met:

III - the formal conditions of the application stipulated in any point of the item V, or § 3 of the article 4 are not met; or

IV - additional documents need to be submitted during the examination of the participation requirements or during the technical examination.

§ 1º Proof by the person concerned of the information referred to in points a), b), e), d) and e), of item 3 of the article 4, may be waived in the event that DERPA has access to the information through an public electronic database in Portuguese, English or Spanish.

§ 2º The applicant must provide clarification on the fulfillment of the requirement within the period stipulated in the caput.

§ 3º If the requirement described in item I of the caput is not met, the petition will not be recognized and, in the cases described in items II, III and IV, the priority procedure will be denied.

Art 9º The granting of the priority procedure will imply prioritization of all acts in the INPI administrative level.

Art. 10. The priority procedure will be withdrawn when:

I - the patent process no longer meets the conditions stipulated in article 3 of this Resolution by action of the applicant; or

II - there is a voluntary division or modification of the patent application by the applicant prior to the publication of the first technical examination opinion.

Art. 11. Decisions that deny the priority process of the patent process cannot be appealed when:

I - failure to comply, prior to the examination of the application by DIRPA, of the conditions provided for in items I or II of Article 3; or

II - the decision is based on the absence of documentation, including incomplete, invalid or untimely submission of documents.

Art. 12. Pending evaluation applications submitted for participation in the PPH INPI-USPTO, PPH INPI-JPO, PPH PROSUL, PPH INPI-EPO, PPH INPISIPO, PPH INPI-USPTO II, PPH INPEDKPTO, PPH INPI-UKIPO, PPH INPI-PROSUL II, PPH INPI-JPO II e PPH PROSUL III Pilot Projects, will be evaluated in accordance with the procedures set forth in this Resolution, as provided for in Articles 6, 7, 8, 9, 10 and 11.

Sole paragraph. The requirements provided for in the caput should meet the formal and substantive requirements defined in the normative act in force at the time of the petition protocol, and will be accounted for the corresponding Pilot Project.

Art. 13. The following Resolutions are repealed:

I- Resolution INPI PR no 202, of October 30, 2017, published in the RPI no. 2444, of November 7, 2017;

II - Resolution INPI PR no 209, of January 26, 2018, published in the RPI no. 2456, of January 30, 2018;

III - Resolution INPI PR no 218, of May 7, 2018, published in the RPI no. 2470, of May 8, 2018;

IV - Resolution INPI PR no 222, of July 20, 2018, published in the RPI no. 2481, of

July 24, 2018;

V - Resolution INPI PR no 223, of August 9, 2018, published in the RPI no. 2485, of August 21, 2018;

VI - Resolution INPI PR no 235, of February 8, 2019, published in the RPI no. 2510, of February 12, 2019;

VII - Resolution INPI PR no 237, of March 28, 2019, published in the RPI no. 2517, of April 2, 2019; and

VIII - Resolution INPI PR no 242, of June 27, 2019, published in the RPI no. 2530, of June 2, 2019.

Art. 14. This Resolution takes effect on December 1st, 2019.

Rio de Janeiro, October 18, 2019.

**CLAUDIO VILAR FURTADO**

President

**LIANE ELIZABETE CALDEIRA LAGE**

Director of Patents, Computer Programs and Topographies of Integrated Circuits

**ANNEX I OF THE ORDINANCE/INPI/PR NO. 252, OF OCTOBER 18TH, 2019**

**CLAIMS CORRESPONDENCE TABLE**

<b>Claims Correspondence Table</b>		
<b>No. of claim required at INPI</b>	<b>No. of claim considered patentable by the partner Institute</b>	<b>Comment about the correspondence</b>