

Kluwer Patent Blog

Double patenting and the Brazilian patent practice

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The Brazilian Patent Statute (Law #9,279/96) does not explicitly prohibit double patenting *per se*. However, as shown in the statistics set out below, the BRPTO regularly considers double patenting. This is based on the BRPTO's interpretation of Article 6 of the Patent Statute (as set out below). In particular, the BRPTO interprets Article 6 as implementing a “*single property*” approach.

“Article 6. To the author of an invention or of a utility model will be assured the right to obtain a patent that guarantees to him the property, under the terms established by this statute.”

According to the BRPTO, under this local legislation, two or more patents cannot be granted for the same invention. Since article 7[1] of the Brazilian Patent Statute implements the “*first to file*” rule, the BRPTO usually issues objections grounded on double patenting for: (i) two or more applications filed on the same date; or (ii) parent and divisional applications.

Having said this, a closer look into a few cases decided by the BRPTO reveals that most of the double patenting objections raised by the BRPTO are based on factor (ii), *i.e.*, an overlap between the sets of claims of a parent application and its divisional(s).

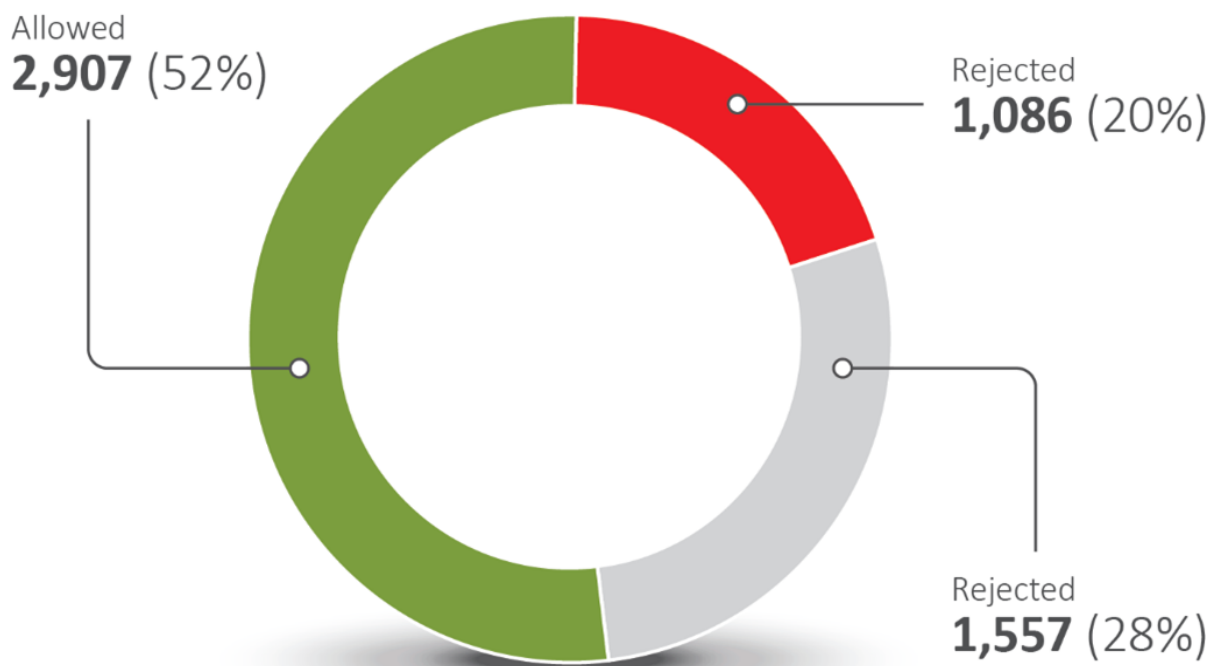
According to the BRPTO's rules, the procedure of dividing a patent application must consist of removing part of the subject matter of the parent application to be claimed in a divisional application. The simple replication of the matter claimed in the parent application to compose a divisional is considered a multiplication of the original application and not its division.

Hence, during the analysis of the parent and the divisional applications, the BRPTO compares the sets of claims thereof in order to analyze if there is any overlap. When an overlap is identified, objections grounded on double patenting are issued for both applications. Obviously, when a patent has already been granted for the parent application, the objection is issued only for the divisional application.

As for item (i), although there are no internal guidelines concerning double patenting on applications filed on the same date, in which one does not derive from a division of the other, the BRPTO takes the position that article 6 of the Brazilian Patent Statute would still apply.

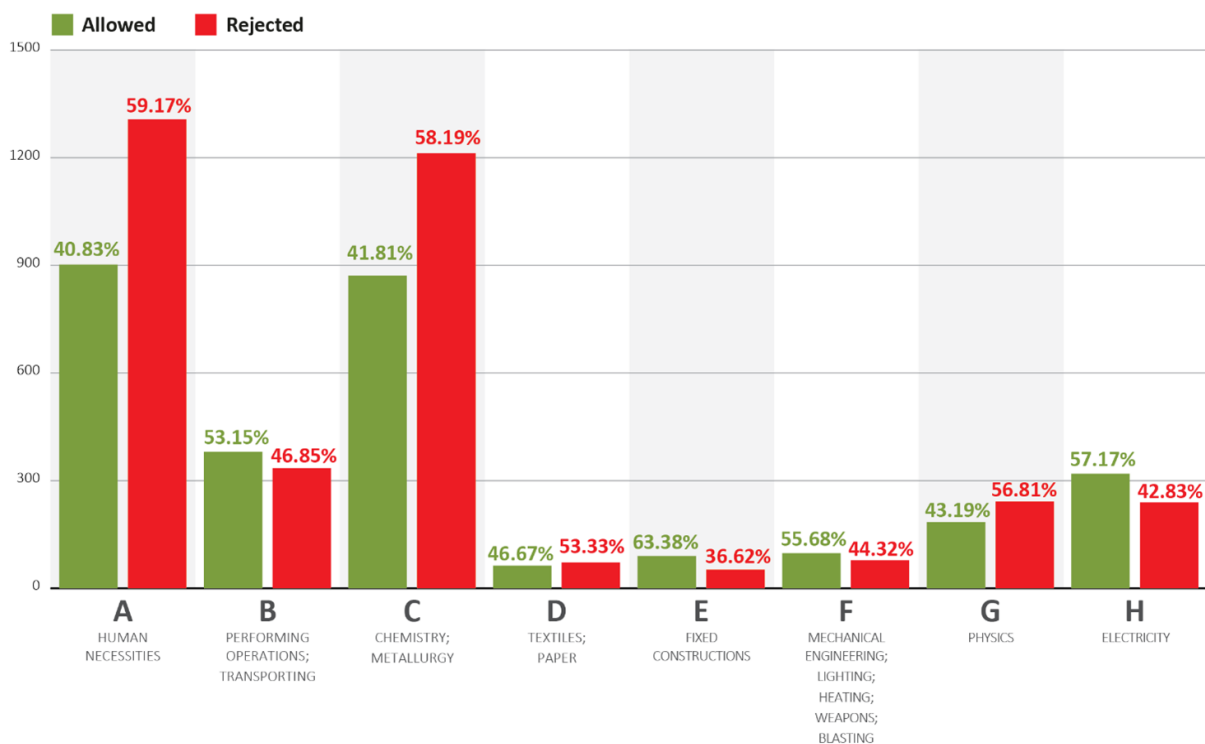
As shown in the diagram below, from the 5550 applications for which an office action grounded on double patenting was issued between 2018 and 2022, 2907 were allowed and 1086 were denied:

Applications for which an objection grounded on article 6 of the Brazilian Patent Statute was issued between 2018 and 2022



Extending this analysis to each technical field, it is possible to observe that applications of the Human Necessities and Chemistry and Metallurgy fields have the highest rate of rejection decisions, as can be seen below:

Allowance and rejection decisions issued by the BRPTO for each technical field based on WIPO's international patent classification



An effective way to deal with double patenting objections in Brazil during examination is by submitting arguments demonstrating the differences between the supposed overlapping matter and/or amending the sets of claims to exclude any overlap between them. In some cases, the simple inclusion of a disclaimer suffices.

The BRPTO has adopted its own practice essentially based on the “single property” approach and conducts a detailed analysis, based on its guidelines, whereby it compares the sets of claims in order to identify any existing overlap between two or more applications directed to the same matter and filed on the same day, regardless of whether one application is a divisional of the other.

Considering that the BRPTO is obliged to issue an office action when double patenting is observed, there is always a chance for the applicant to overcome the objection. In such a scenario, the most effective strategy is: *(i)* to amend the claims to remove any overlap; and/or *(ii)* to submit arguments showing that there is no such overlap, for example, by demonstrating the differences in the scope of protection claimed in each application/patent.

[1] Article 7 of the Brazilian Patent Statute states that “[i]f two or more authors have developed the same invention, independently, the right to obtain a patent will be assured to the one who proves the oldest filing date, regardless of the dates of invention or creation”.

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