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Brazil: how to successfully amend claims during patent examination

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In Brazil amendments to claims are possible if the patent applicant can show the changes are limited to the matter initially disclosed in the patent application (Article 32 of Patent Statute 9,279 of 1996). Thus, like most other countries, Brazilian patent law contains a prohibition against added matter.

However, in a separate provision, the Brazilian Patent Office (BRPTO) establishes the date of the examination request as a limitation to the filing of amendments aiming to broaden the scope of protection. According to Rule #93/2013, after the filing of the request for examination petition, only modifications intended to better define, correct translation errors, or restrict the claimed scope of protection are acceptable. The BRPTO usually doesn't allow amendments that could be considered as broadening or changing the claimed scope of protection.

Interestingly, the BRPTO accepts changes **when the original set of claims presents, by a huge mistake (in Portuguese: , a claim drafted in an incorrect category** (item 2.4 (iii) of Rule #93/2013). As can be seen below, there is a lot of discretion when applying the meaning of "huge mistake". For instance, the BRPTO doesn't accept the change from therapeutic method or EPC2000 claims to Swiss-type, which is the currently acceptable format for claiming medical uses in Brazil.

Examples of accepted changes:

"A process, according to claim 1, characterized in that the modified essential oil from Curcuma aromatica is useful in perfumery, fragrance, pharmaceutical (...)"

"Use of the modified essential oil from Curcuma aromatica obtained by the process defined in claim 1, characterized by being for perfumery, fragrance, pharmaceutical (...)". (BR 11 2013 023705 8)

"Collagenase for use in a method for treating or reducing edematous fibrosclerotic panniculopathy (EFP) in a patient characterized in that it comprises administering at least one subdermal injection of said collagenase (...)"

"A cosmetic method for treating or reducing edematous fibrosclerotic panniculopathy EFP in a patient characterized in that it comprises the administration of at least one injection of a pharmaceutical composition comprising collagenase (...)". (BR 11 2014 009785 2)

“A serum cholesterol-lowering agent or preventive or therapeutic agent for atherosclerosis, characterized by being formed by a kit for simple packaging of a container containing a compound represented by the following general formula (I) above or pharmaceutically acceptable salts (...).”

“A kit for simple packaging of a serum cholesterol-lowering agent or preventive or therapeutic agent for atherosclerosis, characterized in that it comprises: a container containing said compound represented by the above formula I or pharmaceutically acceptable salts (...).” (PI 0411723-9)

Examples of denied changes:

“A composition characterized by being used in the manufacture of a nutraceutical or medicament for the improvement of cognitive function in an animal or human, which comprises a cognitive function-improving amount of a compound selected from the group consisting of: steviol (...).”

“Use of a composition comprising a cognitive function-improving amount of steviol, characterized by being in the manufacture of a nutraceutical or medicament for the improvement of cognitive function in an animal or human.” (PI 0820009-2)

After analyzing the amendment made to patent application PI 0820009-2, the examiner stated that *“[i]n the case of the present application, the set of claims presents composition claims that are defined by their constituents (...). That is, the original claim already presented composition features, so that it cannot be considered a huge mistake (...). Thus, it is concluded that the amendments performed in the set of claims (...) cannot be accepted, as they were presented after the date of request for examination of the original application and change the scope of protection initially claimed in the valid set of claims, which is contrary to Article 32 of the Brazilian Patent Statute in force”*.

“A METHOD FOR THE TREATMENT OF ACUTE OR CHRONIC OTITIS IN PETS, notably dogs and cats, characterized by comprising the application of an effective amount of the pharmaceutical association defined in any one of claims 1 to 10”

“USE OF A VETERINARY COMPOSITION OF TOPIC USE, as defined in any one of claims 1 to 12, characterized by being in the preparation of a medicament for treating acute or chronic otitis notably in pets”. (PI 0806095-9)

After analyzing the amendment made to patent application PI 0806095-9, the examiner stated that *“(...) the change of method of treatment original claim 19 to use in the form of the so-called ‘Swiss formula’ described in new claim 17 changes the category of claim, which is not accepted according to Rule #93/2013 (...). It should be noted that a method of treatment is a completely different matter from ‘use of a composition to prepare a medicament to treat a certain disease’”*.

Those examples show that the “request for examination” is the right time to define the scope of protection sought in Brazil. It is of paramount relevance that patent applicants double check their claims when filing examination requests, considering further discussing the cases with patent attorneys with experience in litigation can be useful to get claims granted in Brazil.

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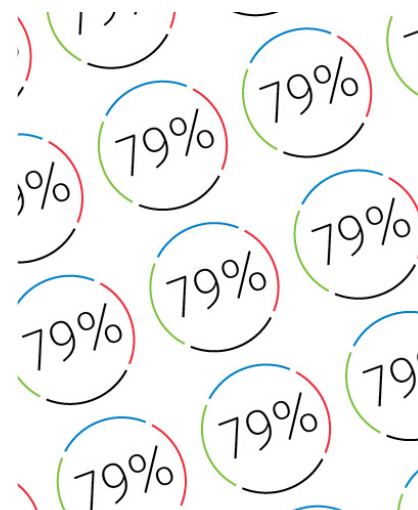
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This entry was posted on Thursday, September 7th, 2023 at 10:47 am and is filed under [Art. 123\(2\) of the European Patent Convention \(EPC\)](#), a European patent (application) may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. Adding subject-matter which is not disclosed would give an applicant an unwarranted advantage and could be damaging to the legal security of third parties. ([G 1/93](#), OJ 1994, 541) The ‘gold standard’ of the European Patent Office’s Board of Appeal is that “any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed” ([G 3/89](#), OJ 1993, 117; [G 11/91](#), OJ 1993, 125).“>Added matter, [Brazil](#)

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