

Kluwer Patent Blog

Brazil: The Patent Office is Considering Changing Terms for Requesting Examination and Amending Patent Applications

Roberto Rodrigues Pinho, Brenno Telles, Tatiana Machado (RNA Law) · Tuesday, September 26th, 2023

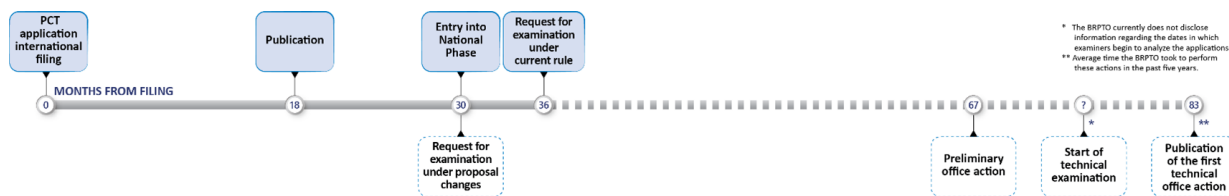
The BRPTO published on September 14 an invitation for interested parties to comment on a proposal to review the provisions of the Brazilian IP Statute regarding two relevant timeframes for patent owners filing applications in Brazil. The first concerns the term for requesting examination (currently 36 months from filing, per Section 33), and the second regards the claim amendment practice (currently the date of the request for examination, Section 32).

The Patent Office's goal with the proposed change is to substantially reduce the backlog and examination pendency. Accordingly, the BRPTO is trying to hit a target of deciding cases within 24 months from filing "*on par with the best international practices and will benefit its users*". The BRPTO believes that the current rule (36 months to request examination) is one of the reasons for additional delays in the granting of patents and proposes that the request for examination be automatic for a PCT patent application when entering the national phase in Brazil, 30 months after its international filing.

For PCT applications (about 70% of all applications filed in Brazil), in particular, the BRPTO suggests that the automatic request for examination would have a low impact, as the applicants will have had the opportunity to amend and define claims during the prosecution of the case at the original patent office or during the 30 months of the PCT international phase, i.e., before entering national phase in Brazil.

On a final note, the BRPTO highlights that reducing or eliminating the term outlined in Section 33 of the Brazilian IP Statute for requesting examination would also require a change to Section 32, as it currently establishes the date of the request for examination as the term for voluntary amendments to patent applications.

With this change, a new milestone would need to be established for patent applicants to be able to file claim amendments. The BRPTO leaves plenty of room for suggestions. Still, its initial proposals are to allow amendments (see timeline below): (i) until the first technical action taken during the prosecution of the patent application (usually a preliminary office action citing prior art documents raised against its counterparts, most commonly in the US and EU); (ii) the publication of the first technical office action in the BRPTO's Gazette; or (iii) the start of the technical examination (the date that the designated examiner begins to analyze the applicant's reply to the preliminary office action, which is currently not disclosed by the BRPTO).



The BRPTO concludes that patent applicants lack any incentive to request examination before the 36-month deadline from Section 32. The proposed changes would make patent applicants adopt a proactive and expeditious approach regarding substantive examination, aiming at having the applications ready for the technical examination sooner and, consequently, reducing the time required for a final decision.

Interested parties will have a 45-day term to file comments. The deadline expires on October 29, 2023.

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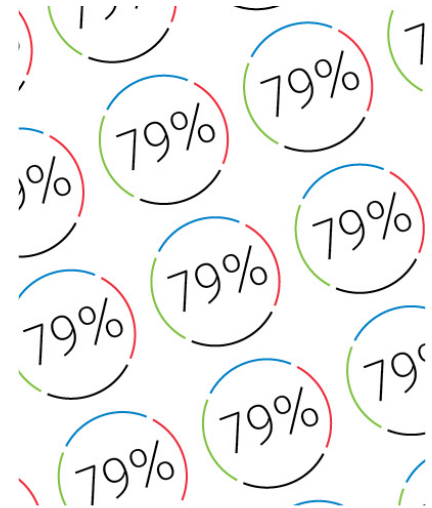
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This entry was posted on Tuesday, September 26th, 2023 at 12:11 pm and is filed under [G 1/93](#), [OJ 1994, 541](#)) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what 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).*“>Amendments, [Brazil](#)

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