

Kluwer Patent Blog

Patent filings and divisionals in Brazil: The challenge to obtain IP protection

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Divisional filings are one of the most controversial topics in patent prosecution in Brazil. The Patent Office (BRPTO) severely limits the ability of patent applicants to file divisionals. For instance, the BRPTO rejects divisionals filed after receiving a notice of allowance, after receiving a denial or during the appeal stage.

Article 26 of the Brazilian Patent Statute provides the grounds for the filing of divisional applications. According to this provision, a divisional application shall not exceed the matter of the original application, must make specific reference to the original application, and have to be filed until the **end of examination**. Despite the broad wording of article 26, the BRPTO limits the filing of divisional applications based on the following:

- Divisional applications can be filed until the “*end of examination*” of the original application, which, according to the BRPTO’s understanding (article 32 of BRPTO’s Normative Instruction #30/2013), is deemed to be the date of the conclusive opinion report regarding patentability (allowance/rejection), or thirty days prior to the publication of such decision by the BRPTO, whichever is the last to occur. Also, divisional applications filed in the appeal stage would not be acceptable;
- After the request for examination of the original application, the set of claims of the divisional application must be limited to the matter claimed in the set of claims of the original application for which examination was requested (BRPTO’s Rule #93/2013); and
- The BRPTO system does not allow cascade filing, *e.* a divisional application from another divisional application (BRPTO’s Normative Instruction #30/2013).

The BRPTO practice of rejecting divisionals has on several occasions jeopardized the ability of patent applicants to understand the commercial aspects of the product covered by the pending patent application during patent prosecution, impacting on decisions of how to properly draft/obtain useful sets of claims.

Between 2018 and 2023, patent applicants filed around 8,966 divisionals in several technological areas, such as biotechnology, pharmaceutical, telecommunications, and agrochemical, as can be seen from Figure 1 below.

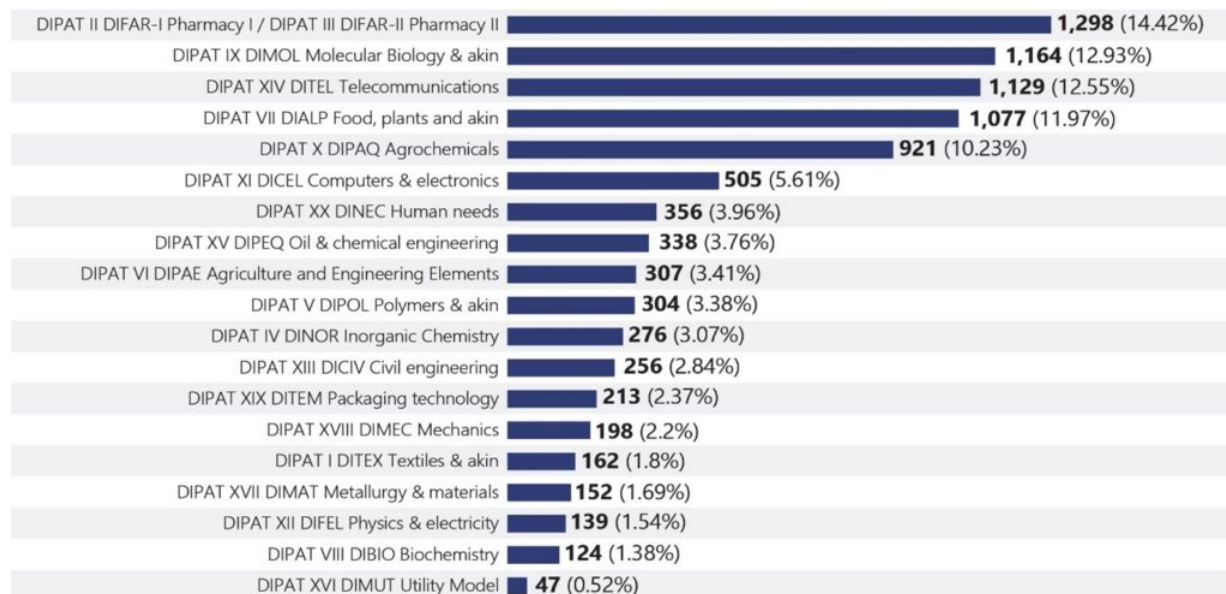


Figure 1: Divisional applications filed per BRPTO's technical division in the period of 2018 to 2023.

Of this total of divisional applications, 133 were filed after the “end of the examination” of the original application, with 132 being denied by the BRPTO by the end of 2023 (the divisional that has not yet been denied by the BRPTO was filed in the last days of 2023 and a denial is also expected in the beginning of 2024). Figure 2 below shows a breakdown of the divisionals filed after a non-final decision of the original patent application (*i.e.*, after the allowance, rejection or in the appeal stage) for each BRPTO's technical division.

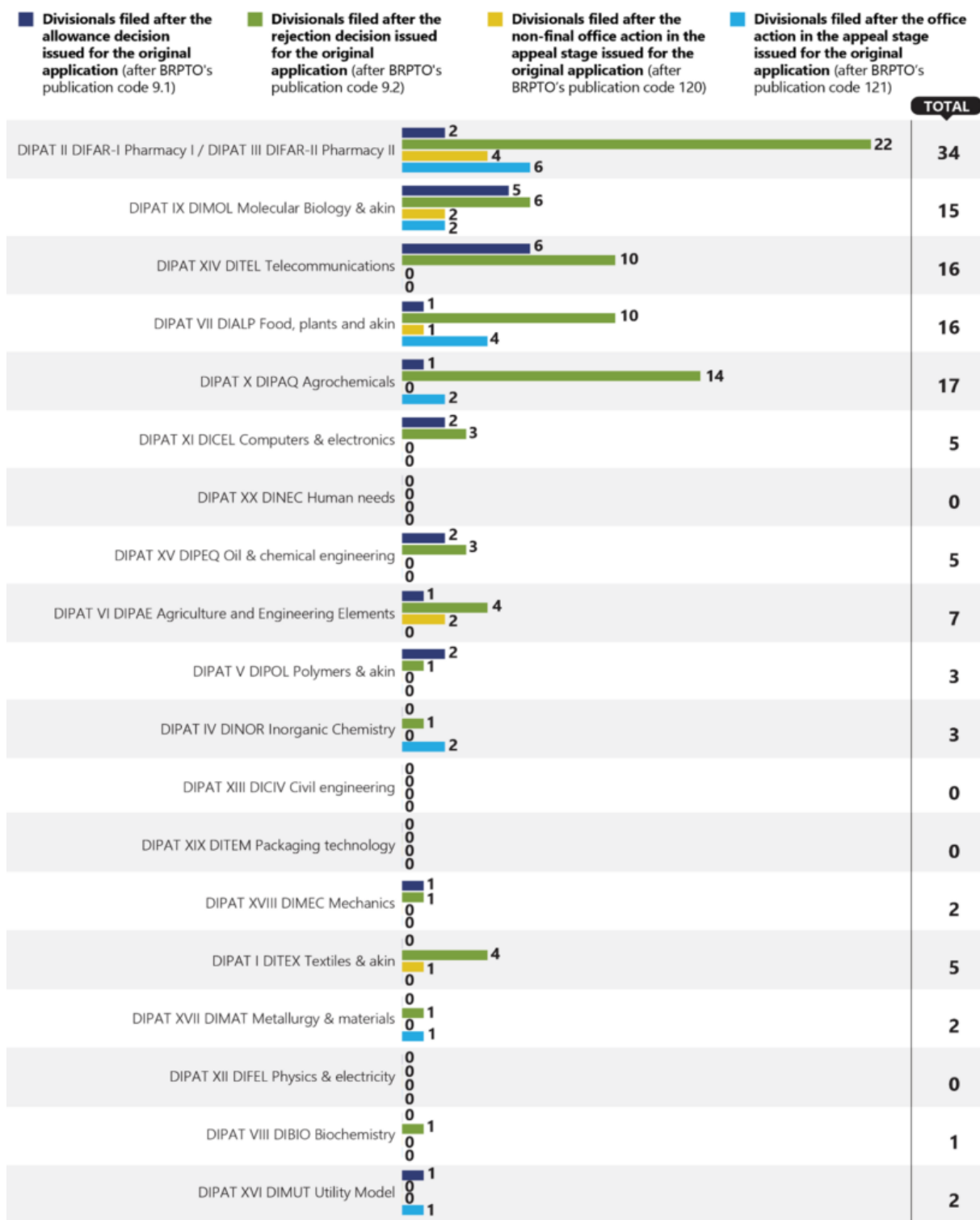


Figure 2: Divisional applications filed after a non-final decision of the original patent application (*i.e.*, after the allowance, rejection or in the appeal stage) per BRPTO's technical division in the period of 2018 to 2023.

As for the divisionals denied by the BRPTO for being filed in disagreement with the provisions of article 26 of the Brazilian Patent Law, five challenged its non-acceptance before the Brazilian courts (Figure 3) in the period of 2018 to 2023, one of which had an unfavorable decision published by the BRPTO on February 8, 2022.

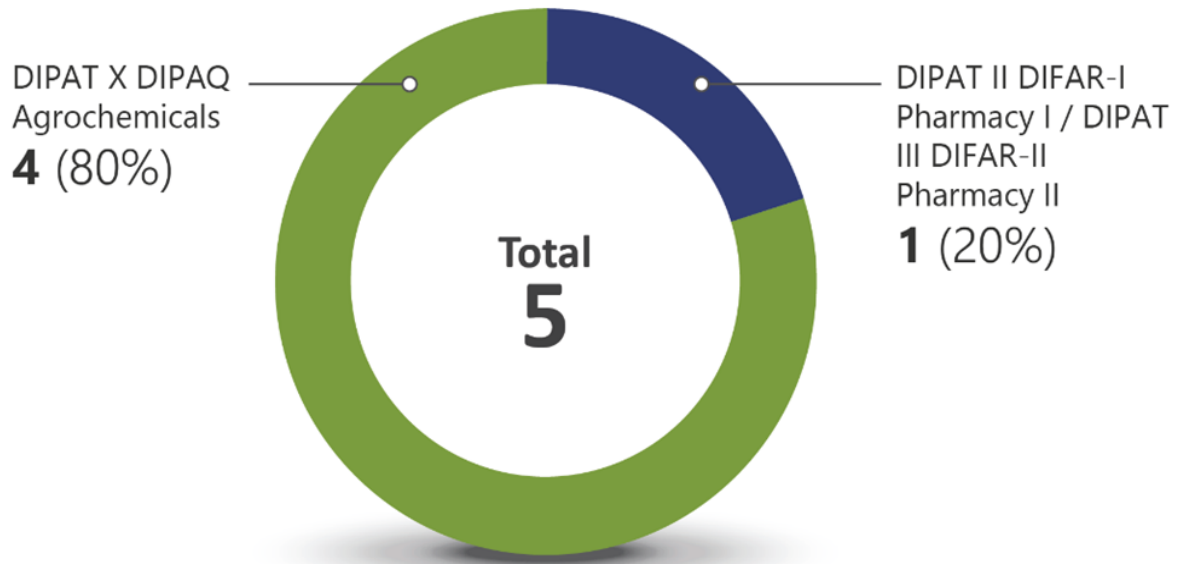


Figure 3: Divisional applications denied by the BRPTO that challenged the non-acceptance before the courts in the period of 2018 to 2023.

Contrary to the EPO, where the requirement to file divisionals is based on whether the parent application is pending when a divisional application is filed (https://www.epo.org/en/legal/guidelines-epc/2022/a_iv_1_1_1.html), the BRPTO applies a different criteria using the terminology provided in article 26 “end of examination” to create an additional layer of restriction. Basically, according to the PTO, anything after a first instance decision would be considered as happening after the end of examination. A second instance decision is “re-examination” and not examination, as also indicated in Opinion #00016/2023/CGPI/PFE-INPI/PGF/AGU – published in BRPTO’s Official gazette #2762 on December 12, 2023 – when addressing formal issues to administrative appeals.

Recently, the Brazilian Federal Court of Appeals for the 2nd Circuit (TRF-2) recognized the illegality of the very restrictive understanding established by article 32 of Normative Instruction # 30/2013, which provides the basis (or grounds) for the BRPTO’s interpretation of the “*end of examination*”. In short, the 1st Specialized Panel concluded that said interpretation of article 32 violates the principle of publicity of administrative acts, as well as the principles of legal certainty, broad defense and adversarial proceedings, as it establishes as milestones to file divisional applications, events that occur prior to the publication of the decision rejecting the patent application. To be more consistent with the aforementioned constitutional principles, the infraleagal rule should set as the end of the examination the date of effective publication of the final technical opinion.

Applicants’ determination to obtain divisional applications filed after the allowance decision issued for the original patent application is indicated below in Figure 4. Even though patentees are aware of Brazil’s current practice, they nevertheless proceed with the filing of divisionals to administratively require such a demand and, if it does not work, seek discussion before Courts.

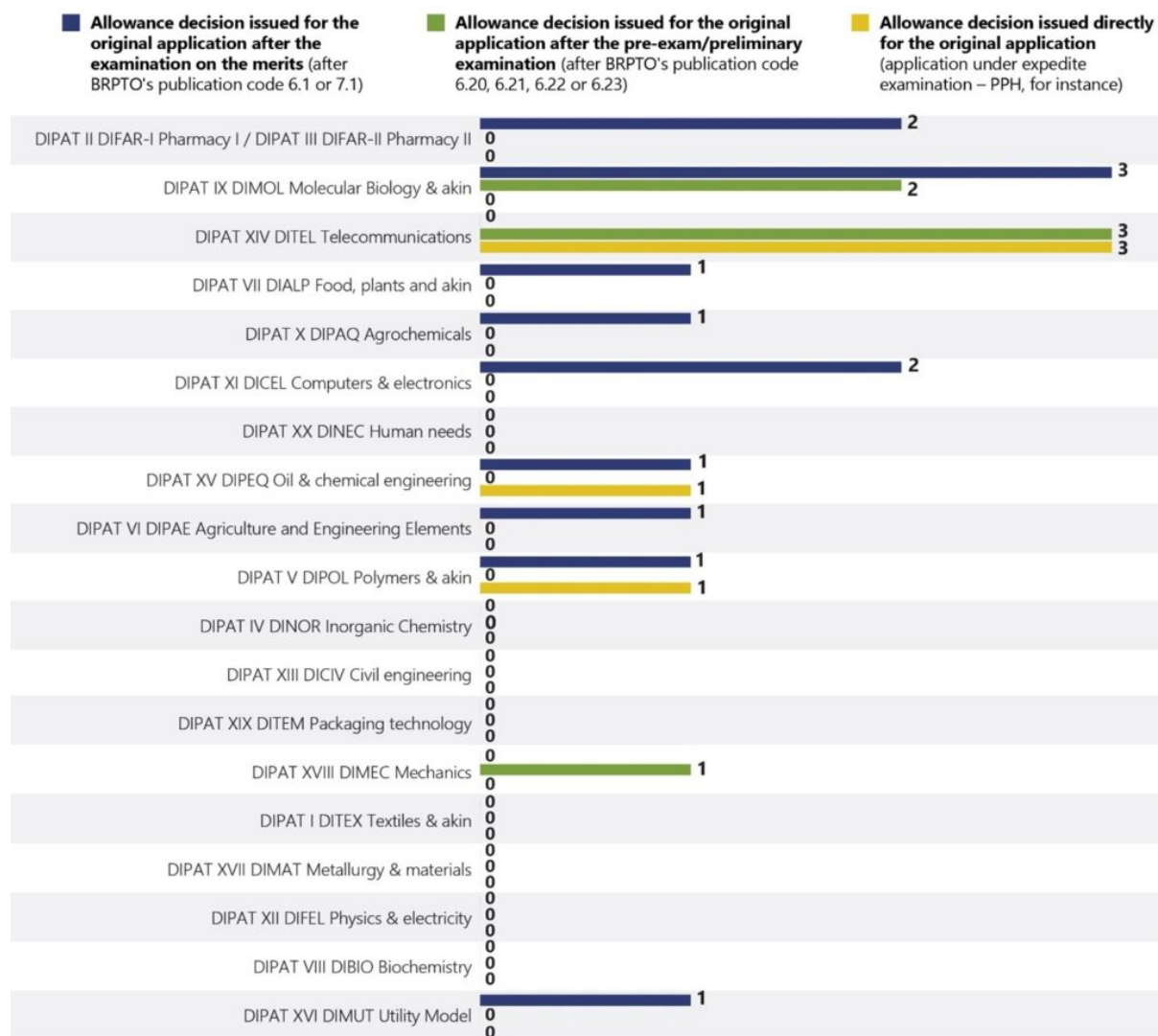


Figure 4: Divisional applications filed after the allowance decision issued for the original patent application per BRPTO's technical division in the period of 2018 to 2023.

In an attempt to align the expectations of both sides, an internal procedure during the examination could be adopted in which the BRPTO would inform that there is an intention of that the patent application will be allowed/denied. Doing so, the applicants would have the opportunity to make a final decision on the filing of divisional applications. There would be no surprises for the applicants and the BRPTO would be giving the opportunity for the applicant to timely file divisionals.

Finally, it would be of utmost importance that the BRPTO's practice be in line to what is actually determined in the Brazilian Patent Statute with regard to the filing of divisional applications. Nevertheless, in an attempt to strike a balance between the applicants' and the BRPTO's interests, less restrictive provisions could be applied in order to enable the applicants to exercise their rights to file divisional applications and the BRPTO to carry out the examination quickly and without reworks. Such practice would not cause uncertainty in the market, nor would reduce the legal certainty. On the contrary, it would provide an environment conducive to fostering innovation, competitiveness, and formal protection.

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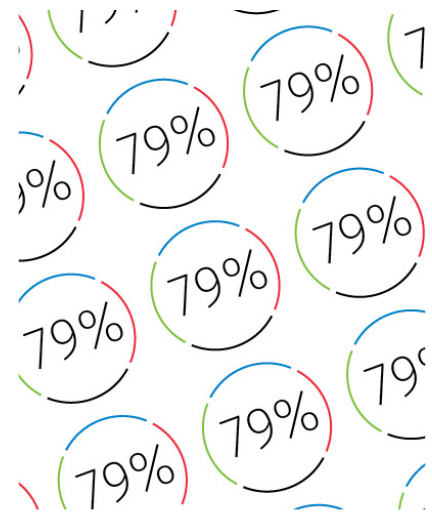
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