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Brazil – Important updates on the new rules regulating administrative appeals

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The Brazilian Patent and Trademark Office (BRPTO) has issued a new set of guidelines to clarify its recent regulations on amending patent claims during the appellate phase and help patent applicants adapt to the new policy.

Last month, we published an article regarding the decision rendered by the President of the BRPTO on 12 December 2023, giving normative and binding character to four Opinions of the Specialized Federal Attorney's Office that imposed restrictions on the actions available to applicants when appealing first instance decisions. Such restrictions sought to limit the provisions of the Brazilian Patent Statute which guarantee the "full devolutive effect" or the ability of Appellate Bodies to decide matters raised by the appellant during the appeal stage. The direct impact of these guidelines was that amending claims (including limiting the scope of protection of a patent application) and presenting new data to support a claimed invention was said to no longer be accepted during the appeal phase.

Many within the IP community voiced strong opposition to the new restrictions. In response, the BRPTO's General Coordination of Appeals requested a new consultation on two key points:

- **Amendments at Appeal Level:** The Coordination questioned whether it is reasonable that a BRPTO examiner, an expert in the relevant field, be the one authorized to determine whether an amendment during the appeal phase implies a change in the scope initially requested in the patent application or whether it results in a scope restriction that would allow the rejection decision to be reversed in order to grant the patent application request.
- **Evidence of Technical Effects:** The Coordination inquired about the BRPTO's existing examination guidelines that already allow appellants to adduce evidence to convince the examiner about the technical effects of the invention.

The opinion published on **February 27, 2024**, is a response by the Specialized Federal Attorney's Office to these questions, seeking to complement the latest guidelines and clarify the points raised by the General Coordination, as well as harmonizing them with the BRPTO's previous decisions and standpoints.

The opinion acknowledges that the BRPTO has a consolidated understanding regarding the differences between amendments that broaden the claimed scope of protection (which can only be submitted before the examination request, under the terms of article 32 of the Brazilian Patent

Statute), and those that restrict the claimed scope of protection, which may be filed at any time.

Consequently, it concludes that **it is up to the Boards of Appeal to evaluate any amendments presented** and for them to judge as to whether the case is one of "appeal innovation". In deciding whether there is "appeal innovation" (*i.e.*, the amendment is only a restriction to the claimed scope), the Boards of Appeal must consider the amendments and make their own judgment.

As for the second question from the Coordination, the opinion pointed out that the second administrative instance may accept and assess reasons (arguments) that aim to clarify and prove the technical effect of the requested invention, as they are inherent to the matter initially disclosed in the patent application. Nevertheless, **the presentation of documents** after the appropriate procedural point in time **is not allowed**, due to administrative estoppel.

Exceptionally, if the appellant proves that they were unable to produce the documents for just cause, in accordance with article 221 of the Patent Statute (unforeseen event, beyond the will of the party and which prevented them from carrying out the act), it is possible to accept such documents at appeal level.

Together with this latest opinion, the President of the BRPTO issued a new decision giving binding character to the opinion's conclusions and remarks and further elaborating on the new benchmarks for claim amendment and evidence production before the Boards of Appeal.

Besides reaffirming the Specialized Federal Attorney's conclusion on the Boards of Appeal's responsibility to determine whether a claim amendment is allowed, the President also decided that **restrictive amendments in the appeal phase will only be accepted if**:

- they have a causal link with the grounds of the rejection decision.
- they do not reintroduce material abandoned at first instance.
- they are based on the set of claims itself (and not the specification).

Regarding the production of evidence on the appeal phase, the President clarified that **documents and data which are adduced exclusively to support the appellant's arguments on inventive step will be accepted**.

This entry was posted on Wednesday, February 28th, 2024 at 11:07 am 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, Extension of subject matter, Guidelines, Patents
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