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## Brazil – The impacts of BRPTO’s interpretation of the “end of examination” in patent prosecution

Roberto Rodrigues Pinho (RNA Law) · Friday, June 14th, 2024

Divisional applications and pre-grant oppositions may be filed until the “*end of the examination*”. That is the wording of the Brazilian IP Statute (Law No. 9279/96, articles 26 and 31). Looks simple enough, but in the absence of a definition in the law of what constitutes the “*end of the examination*”, the BRPTO has been defining this moment in a strictly.

According to article 32 of BRPTO’s Normative Instruction No. 30/2013, the examination “*ends*” when the notice of allowance, rejection or definitive dismissal is published in its Official Gazette. That gives rise to a myriad of issues with severe – and until recently, irreversible – impacts to applicants deciding on the best strategy for prosecuting their cases.

A patent application is initially examined by the BRPTO’s first instance examiners, which will weigh whether the claimed matter meets all patentability requirements, is drafted in a clear and precise manner, and the sufficiency of the description in the specification (enablement) in a way as to allow a person skilled in the art to reproduce the claims.

If the application is rejected on any or multiple of these grounds, an appeal can be filed and the application will be sent to the Board of Appeals, to be examined by a separate group of examiners tasked with carrying out an independent examination, including conducting a whole new prior art search.

Despite the fact that, in this scenario, the examination has clearly not ended yet, the applicant will still be barred by the BRPTO from filing divisional applications that could allow for different matters to be treated separately. This becomes a major problem considering that it is routine for applicants to challenge objections instead of simply complying with every request by the BRPTO.

As an example, if the first instance examiners found the application to generally meet the subject matter eligibility standards, but some claims were deemed to contain matter not eligible for protection, the decision by the applicant to try and reverse the BRPTO’s initial stance could lead to the whole application being rejected. In such a case, filing a divisional would no longer be possible and obtaining any protection would require the applicant to either exclude those claims or risk insisting on arguing at the appeal stage.

On the flip side, in the event that the application is allowed and granted, third parties will be able to file post-grant oppositions – which will also result in further *examination* –, but, regardless of what

is argued or what position the BRPTO takes, it is also not possible to file a divisional at this stage.

In many cases, there is a need to file “safe” divisional applications just to safeguard the right to have a divisional claim accepted. Over the past couple of years, the courts have been called to intervene and have ordered the BRPTO to accept divisional applications after what patent office interprets as the end of examination, specifically after a rejection decision.

These are only a small subset of nuances to be considered when prosecuting patents in Brazil. Developing and implementing the right strategy for each case, as well as being able to adapt on the spot in the face of constantly changing regulations, is of paramount importance to improve the chances of successfully obtaining protection for the desired subject matter.

**Post also prepared by Brenno Telles and Luiza Cotia from RNA Law (<https://www.rna-law.com/>).**

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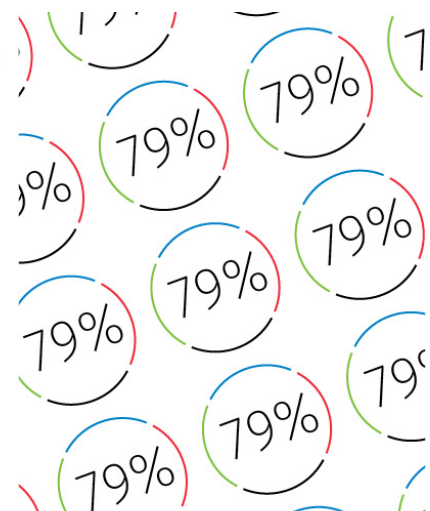
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