

Kluwer Patent Blog

Brazil: third party participation in patent examination

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The recent publication of the pharma tech-transfer guidelines (PDPs or partnership for productive developments) is bringing an interest for companies to monitor patent portfolios in Brazil. (<https://patentblog.kluweriplaw.com/2024/06/25/brazil-pharma-pdps-and-challenges-for-ip-owners/>).

In view of this development, one of the questions arising is how third parties can influence patent examination of cases that they are interested in the outcome.

There are three different stages during examination when third parties can provide substantive arguments: *(i)* during the first instance examination by filing pre-grant submissions; *(ii)* during appeals by filing reasons against the granting of an appeal; or *(iii)* after granting by filing a post-grant opposition.

I – Pre-grant submission

Any interested third party is allowed to submit documents and arguments to aid the BRPTO's technical examination up to the so-called end of examination, as per the provisions of article 31 of the Brazilian IP Statute (Law #9279/96). Although said Statute is silent on the meaning of "end of examination", the BRPTO defines this moment as the date of the issuance of the notice of allowance, rejection or definitive dismissal (BRPTO Normative Instruction #30/2013).

Therefore, during the examination of a patent application (first instance examination), any third party can submit prior-art documents and arguments against the patentability of the specific patent application. Third parties can bring decisions/opinions issued by foreign patent offices or introduce additional prior arts that could be of interest.

Although the BRPTO isn't obliged to issue any notification informing the applicant that a pre-grant submission was filed, the examiners are obliged to consider all the briefs in the file wrapper, including the third part submission.

II – Counter reasons

When the BRPTO's examiners reject a patent application – first instance decision, the applicant has a 60-day term to lodge an appeal. The BRPTO publishes the filing of the appeal in its Official

Gazette opening a 60-day term for any interested party to file counter reasons to the appeal brief (article 213 of the Brazilian IP Statute).

Remarkably, the appellant is not formally allowed to file a reply to any counter reason brief. If a “reply brief” is filed by the appellant, such brief is not considered by the BRPTO for being “untimely”.

Upon analyzing the appeal and/or the counter reasons briefs, the BRPTO can still issue an office action in the appeal stage, according to article 214 of the Brazilian IP Statute, opening another 60-day term deadline. However, in this stage of prosecution, only the appellant is permitted to file a reply. Any brief filed by a third party will be dismissed as being considered “untimely”. Therefore, any interested third party can only participate in the appeal phase by filing counter reasons to the appeal brief. Any additional brief is not permitted and, therefore, not considered by the BRPTO.

III – Post-grant opposition

Article 51 of the Brazilian IP Statute establishes that a post-grant opposition can be started within 6 (six) months from the grant of the patent. The opponent can introduce new arguments and new prior arts against the granting of the patent. When a post-grant opposition is requested, the BRPTO notifies such request in its Official Gazette, after which the Patentee has a 60-day term to file a reply.

After analyzing all the arguments filed, the BRPTO publishes an intermediate opinion regarding the merits of the post-grant opposition. Both the interested third party and the Patentee are allowed to file a reply to the intermediate opinion within 60 days counted from the notification thereof at the Official Gazette.

After that, the matter is analyzed and decided by the President of the BRPTO (final opinion), ending the post-grant opposition procedure.

It is not permitted to innovate in the reply to the intermediate opinion. Only the arguments and documents already submitted by the third party and the Patentee are considered in the final decision.

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