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BRPTO publishes new workflow for patent examination in appeal stage

Roberto Rodrigues Pinho, Luiza Cotia (RNA Law) · Tuesday, September 3rd, 2024

The BRPTO published on August 28, 2024, Appeal Board Ordinance #4, a rule intended to provide internal guidelines for the examiners responsible for analyzing appeals of patent applications, the so called “second instance” in Brazil. This Ordinance brings structured and standardized procedures that the examiners shall observe when analyzing appeals briefs ensuring consistency, transparency and efficiency for the examination of patent applications rejected in the first instance. In Brazil, there is no notice of appeal and, therefore, all arguments and amendments must be submitted together with the appeal brief.

This Ordinance outlines several critical steps and criteria for decision making for the examiners aligning with legal and administrative celerity principles to try to ensure a greater legal certainty scenario in Brazil. Some of the key assessments brought by these guidelines include:

- Initial/formal analysis of the rejection decision: Examiners will review the rejection decision to determine if there were any procedural or substantive defects or misjudgments in the initial rejection of the patent application that could have affected the outcome of rejecting the application. If any issue is found, the case may be returned to the first instance for re-examination.
- Substantive review of the rejection decision: If the initial analysis did not detect any formal or procedural issue that would affect the outcome of rejecting the application, the examiners should proceed to perform a substantive review analyzing the reasons for the rejection and whether the arguments presented by the appellant can overcome the first instance objections.
- Analysis of the amendments: Together with lodging the appeal against the rejection decision, the appellant may present a new set of claims that the examiners must carefully analyze to determine if it addresses the objections raised during the first instance examination and is in accordance with the procedures established by Opinion #19/2023 from the Specialized Federal Attorney’s Office. If the new set of claims does not fully address the raised objections or is not in accordance with the provisions of said Opinion, further office actions in the appeal stage containing technical requirements may be issued so that the appellant may redraft the claims.

Thus, there are several possible outcomes on the appeal stage, which are explained below:

When the examiners understand that the amendments and/or arguments presented in the appeal successfully address all the objections, the BRPTO reverses the rejection and grants the patent

(decision code 100.1).

If the examiners understand that the amendments and/or arguments presented in the appeal will not adequately address the grounds for rejection, they will maintain the rejection decision ending the administrative phase of the patent application (decision code 111).

In case the examiners understand that the appeal has amended claims or arguments that may lead to allowance of the patent application but need further clarification, they may issue an Office Action containing formal and/or technical requirements for the appellant to address – decision code 121. The Appeal Board Ordinance also clarified that during the transition period some applications might receive an Office Action so that appellants have the opportunity to present their arguments for why their applications should be reconsidered in the appeal stage (retroactive for applications that were already in the appeal stage and for which a first substantive technical opinion was issued before April 1st, 2024).

All these previous decisions were already possible during the appeal stage as per the previous rules. However, now it is also possible that the patent application is returned to the first instance via decision code 100.2 for reexamination. In this case, the examiners of the second instance must direct, comment and make suggestions for the examiner of the first instance in order to expedite a decision.

As a reminder, Opinion #19 established some new procedures that are now structured and standardized by BRPTO's Ordinance#10 and new Appeal Board Ordinance #4, both from 2024. In that opportunity, the administrative preclusion concept was introduced. Such concept establishes that once a certain procedural stage is over, requests or modifications (even if restrictive) not submitted for first instance analysis are not permitted in the appeal stage.

Despite being quite restrictive, Opinion #19/2023 together with Appeal Board Ordinance #4 address a very important aspect: comprehensive justifications. Patent attorneys in Brazil have fought for years for the examiners to provide solid grounds for their opinions during prosecution of patent applications. The silver lining of the present scenario is that examiners are now required to provide detailed justifications for their decisions, based on the Brazilian IP Statute and regulations. The new guidelines may prove to be a significant step towards a more structured and standardized appeal process for patent examination in Brazil.

The new guidelines are aligned with the procedural aspirations set by the BRPTO, aiming at enhancing not only the clarity and fairness of the patent prosecution in Brazil, but mainly to enhance the PTO's efficiency/celerity. Currently, an application in the appeal stage takes at least two years to be examined and there's a backlog of more than 7.000 applications. By providing a well-defined and standardized structure for examiners to follow, these guidelines will ensure that decisions are made consistently and transparently, thereby supporting innovation and the protection of Intellectual Property rights.

To corroborate the aspirations set by the BRPTO towards reducing the backlog the patent office just added around 40 new examiners.

Also co-authored by Rodrigo Mourao and Rhuan Quintanilha

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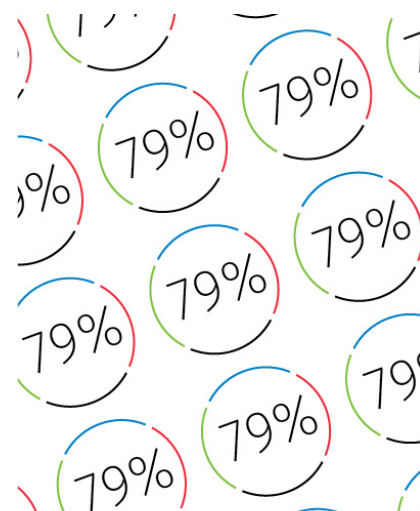
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