

# Kluwer Patent Blog

## Examination & Appeal Changes in Brazil: What Can We Learn from Recent Cases

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In 2024, the Brazilian Patent and Trademark Office (BRPTO) introduced pivotal changes to the appeal stage. Appeals has long been critical for applicants seeking to overturn unfavorable first-instance decisions. Historically, examiners at the appellate level have had to correct procedural inconsistencies from first instance, leading to prolonged delays—often exceeding two years for final decisions—that undermine the efficiency of the process. To address these issues, the BRPTO implemented substantial reforms aimed at enhancing procedural clarity, reducing bottlenecks, and ensuring a streamlined approach.

### The new BRPTO appeal workflow

Published on August 28, 2024, Ordinance #4 establishes a structured, two-phase process for handling appeals. The first phase focuses on a formal review of the case records, with second-instance examiners assessing the presence of procedural errors in the first-instance examination. If errors are identified, the case is returned to the first instance for re-examination. When no defects are found, the appeal advances to the second phase, which involves a substantive review of the rejection grounds in light of the appellant's arguments.

To enhance transparency, the Ordinance also introduced new decision codes. Code 100.1 signals an allowance decision that reverses the previous rejection, while code 100.2 directs the case back to the first instance for further examination.

Notably, decision code 121, though not new, is expected to play a prominent role during the transition period covering appeals pending as of April 1, 2024. This code is typically used in cases where examiners believe that amended claims or arguments presented during an appeal may lead to an allowance decision but require additional clarification. In such instances, an office action is issued, giving the appellant an opportunity to address formal and/or technical requirements. During the transition period, this code will be applied more broadly. This expanded use ensures that appellants have the chance to present their arguments and justify why their applications should be reconsidered during the appeal stage. As a result, the number of decisions citing code 121 is expected to increase significantly in the coming years.

While these changes offer much-needed structure and enhance clarity, some stakeholders have raised concerns about the rigidity they introduce, which could limit flexibility in addressing

complex cases.

It is also worth mentioning Appeal Board Opinion #03/24, published by the BRPTO in April 2024, which clarified the new restrictions on amendments during the appeal stage, complementing Opinion #19/23. According to these guidelines, administrative preclusion limits the types of amendments that may be submitted during appeals. While substantial amendments are not allowed after the request for examination, amendments that narrow the scope of protection or correct errors related to procedural or technical issues raised in the first-instance examination are still permitted. However, this is only under specific circumstances and must be explicitly requested by second-instance examiners.

This strict application of administrative preclusion impacts the way applicants and attorneys approach patent prosecution. By limiting flexibility during the appeal stage, the new framework requires comprehensive and well-prepared submissions during the earlier stages of prosecution, emphasizing the importance of strategic planning from the outset. Addressing all potential objections in the first-instance examination becomes crucial to avoiding procedural hurdles later. Moreover, this heightened focus on early-stage preparation demands meticulous planning to ensure that no key arguments, clarifications, or amendments are overlooked, as these cannot be revisited or introduced during appeals. This shift places a greater burden on applicants and their attorneys to anticipate potential challenges and proactively address them early in the patent prosecution process.

### **Updates on Divisional Applications: Ordinances #14 and #16**

Another noteworthy development in 2024 was the revision of rules governing divisional applications, introduced through Ordinances #14 and #16, published in September. Ordinance #14 clarified that examination officially concludes upon the publication of a notification of allowance, rejection, or definitive shelving in the BRPTO's Official Gazette. This eliminated a prior exception that allowed examinations to end earlier if the examiner signed their opinion within 30 days before publication.

A significant change introduced by Ordinance #14 is the allowance of divisional applications during the appeal stage, but only when explicitly requested by the examiner. This change, which overturns the previous prohibition on divisional filings during appeals, creates a strategic opportunity for applicants and examiners to address objections or irregularities raised during prosecution, thereby facilitating patent grants.

To ensure transparency and efficiency, applicants must now submit divisional applications using a track-change format to highlight differences from the claims of the parent application. Any overlapping claims between the parent and divisional applications must be resolved promptly to avoid procedural delays.

Ordinance #16 reinforced these updates by revising the Patent Applications Examination Guidelines.

### **Recent decisions applying the new rules**

An analysis of eleven cases decided by the BRPTO's Board of Appeals reveals valuable insights on the implementation of the new rules in regard to (1) reevaluation of prior-art references; (2) reexamination of claims and arguments; and (3) case outcomes.

- **Reevaluation of prior-art references:**

In *CAGECE (BR 10 2021 006355-6)*, an additional prior-art document prompted the case to be returned to the first instance for further examination. This decision followed an assessment that the previously cited prior-art documents did not anticipate the claimed matter, underscoring the importance of comprehensive prior-art searches.

Similarly, in *Modernatx, Inc. (BR 12 2022 001757-6)*, second-instance examiners identified two newly relevant prior-art references and recommended returning the case for additional review.

In the pharmaceutical sector, two cases filed by *Regeneron Pharmaceutical (BR 11 2021 025158-8 and divisional BR 12 2023 012219-4)* were also sent back to the first instance due to incomplete prior-art searches.

- **Reexamination of the set of claims/arguments:**

Several cases showcased the Board of Appeals' efforts to address procedural shortcomings related to claim analysis and argument reexamination. For example, in *Compagnie Gervais Danone (BR 11 2012 030363-5)*, the Board of Appeals reversed the initial rejection and ordered a reexamination after identifying that certain claim modifications proposed by the applicant had not been properly examined.

Similarly, *CJ CheilJedang Corporation (BR 11 2020 001174-6)* exposed procedural unfairness when the rejection relied on a prior-art document that had not been cited earlier, leading to a reassessment of the case.

In *PolyIC GmbH & Co. KG (PI 1013615-0)*, the Board identified a failure by the first-instance examiner to analyze key arguments submitted by the applicant, further reinforcing its commitment to procedural integrity.

The validation of alternative claims also stood out in certain cases. In *Finzelberg GmbH & Co. KG (BR 11 2012 015553-9)*, the auxiliary set of claims successfully addressed prior objections related to Article 10 of the Patent Statute (eligibility), resulting in the case being sent back for further examination of unresolved issues. In *Google Technology Holdings LLC (BR 11 2012 001133-2)*, the Board of Appeals clarified that the claims did not infringe Article 10, enabling the examination to proceed toward determining patentability.

When dealing with parent and divisional applications, the Board of Appeals ensured that the first-instance examiners conducted a thorough comparison of the claim charts. In *BR 12 2019 018347-3*, the application was returned for reexamination because the claims of the divisional application were found to overlap with those already granted in the parent application.

- **Case outcome:**

Changes in examination guidelines are influencing examination. In *Monsanto Technology LLC (PI 0920827-5)*, the case was returned to the first instance following the issuance of guidelines that introduced new parameters for analyzing inventions related to transgenic plants. This demonstrates the evolving nature of the legal and technical framework and its direct impact on the appeal process.

## Concluding remarks

The implementation of changes to Brazilian prosecution has not been without challenges. The strict application of administrative preclusion, while fostering efficiency, imposes significant restrictions on applicants and patent attorneys, demanding a heightened focus on early-stage thoroughness. On its turn, the frequent return of cases to the first instance, due to incomplete prior-art searches or procedural oversights, raises concerns about delays. While these practices ensure higher examination standards, they also underscore the need for a balanced approach that prioritizes both thoroughness and efficiency.

While the transition to this new framework may present a learning curve for examiners and applicants alike, it also lays a robust foundation for fostering innovation and strengthening intellectual property rights in Brazil. Looking ahead to 2025, the BRPTO's commitment to modernization and its reform agenda offer a promising outlook for inventors and businesses navigating the evolving patent landscape.

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