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## Brazil: PTO publishes patent re-examination guidelines & Post-Appeal prosecution

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The Brazilian Patent and Trademark Office (BRPTO) published Ordinance No. 04/2025 (May 27, 2025), which formalizes the internal workflow for resuming the technical examination of patent applications following an appeal against a previous rejection decision (identified by publication code 100.2).

The ordinance consolidates and standardizes the procedures to be followed when the BRPTO's Board of Appeals overturns a rejection decision and remands the application to the first instance for further examination. Key aspects of the ordinance include:

- **Binding Nature of Appeal Decisions:** Decisions rendered by the Board of Appeals are final and binding on first-instance examiners, in accordance with Article 215 of Brazil's IP Statute. However, examiners may raise new objections based on issues not previously addressed.
- **Same Examiner, When Possible:** The application should be reassigned to the examiner who originally issued the rejection decision, wherever possible. If that examiner is unavailable, a qualified substitute will be designated.
- **No Third-Party Submissions:** At this stage, the BRPTO will not accept third-party submissions, such as technical comments or prior art suggestions.
- **No Voluntary Divisional Applications:** Applicants may not file voluntary divisional applications unless a lack of unity was previously raised during examination.
- **New Prior Art Search is Allowed:** Examiners may conduct a new prior art search if the technical considerations raised in the appeal decision justify it. All prior art references must remain consistent throughout the file wrapper.
- **Procedural Safeguards and Subsequent Decisions:** Any new rejection (publication code 9.2) may only be issued after the applicant has had an opportunity to respond to a new Office Action. Moreover, any final opinion must reference the binding nature of the appeal ruling.

In addition to how examiners of the first instance should proceed when analyzing cases in post-appeal prosecution, the new guidelines further establish that the notices of allowance should indicate the sequence listing section to be published with the Letters Patent (i.e., which sequence listing submitted before the BRPTO during prosecution will compose the Letters Patent). This aims at improving the organization within the PTO, as this procedure was already in force for the remaining sections of a Letters Patent, namely: set of claims, specification and drawings. Although the process brings little difference for the applicants, it is likely to improve the quality of Letters Patent issuances by the BRPTO, facilitating not only publication per se but also correction

requests.

However, regulatory limitations such as the filing of voluntary divisionals are still going against the recent case law and legislation.

Ordinance No. 04/2025 provides transparency and predictability to the handling of patent applications following a successful appeal. The binding nature of appeal decisions is particularly advantageous to applicants, as it ensures greater legal certainty and procedural efficiency. However, applicants must be prepared to address new patentability issues raised during this continued examination phase. Furthermore, certain procedural limitations, notably the restrictions on filing voluntary divisional applications, continue to diverge from recent case law, raising concerns among stakeholders.

It is also expected that some aspects of the ordinance, particularly those that appear to restrict applicants' rights beyond what is provided in the IP Statute, will likely be challenged before Brazilian courts, potentially prompting further adjustments to the BRPTO's internal practices.

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