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This month, our Intellectual Property Report specifically brought a summary of the latest regulations and understandings published by the Brazilian Patent and Trademarks Office (BPTO) in December 2023.

The BPTO published a series of changes to procedures and understandings in relation to the analysis and registration procedure of trademarks, patents, and industrial designs. Many of these changes aim at speeding up the analysis of patent applications and settling issues that have been under discussion for many years.

01

Administrative Appeals.

Moreover, on December 12, 2023, the BPTO published opinions on the limits and scope of the devolutive effect of administrative appeals filed with the BPTO.

The opinions have been given normative effect and will be fully applicable within sixty (60) days counted from the publication. During this period, interested parties will be able to submit amendments to the appeals filed, aiming to make any adjustments.



02 Patents.

Change in the BPTO's procedure to speed up patent analysis and improve the control of annuity payments for applications and patents

The BPTO published Ordinance INPI/PR No. 52 ([please see here](#)), which regulates certain procedures involving patent analysis, with the purpose of speeding up its decisions. In addition, the Ordinance provides formal and normative improvements to the procedures relating to the control and advance payment of annuities, shelving of applications and cancellation of granted patents, as well as the reinstatement of patent applications and granted patents.

In sum, starting on January 1st, 2024:

- **Queue for examination requests:** the queue of requests for technical examination of patents will be ordered by the date of the examination request, and no longer by the date of filing.
- **Advance payment of annuities:** the advance payment of annuities will be accepted if made within the three months prior to the annuity's ordinary term, provided that the previous annuities have been paid in full. If any previous annuity has not been paid, the payment of the current annuity will be used to offset the outstanding annuity; and
- **Reinstatement of shelved patent applications or canceled patents:** a shelved patent application or a canceled patent may be reinstated by its applicant or owner within three months of the publication of the shelving or cancelation of the patent, provided that the following fees have been paid: (a) the fee for reinstating the application, patent or certificate of addition and (b) the outstanding annuities and contributions due.

In sum, these improvements aim to enhance the language and terms used so that they are clearer to users, as well as to optimize their actions, such as accepting advance payments.



Concerning appeals related to patents, by means of Opinion 0019/2023/CGPI/PFE-INPI/PGF/AGU, the BTPO published new rules on the administrative procedures for granting patents. Coming into force on February 12, 2024, the change prevents applicants from submitting amendments to patent applications on appeal, even in case of any restrictive amendments to the claims.

On the same occasion, a change was announced in the technical examination queue for patent applications which, as of January 1, 2024, will be organized according to the order of examination requests, and no longer according to the filing date. New rules for the area of trademarks and industrial designs were also announced.

Bringing up the issue of the controversial deadline established in Brazil for the submission of voluntary amendments, accepted by the BTPO only up to the time of the request for technical examination, the new prohibition on appeal goes against the federal rules governing the administrative process for granting patents, since there were no such limitations in this for applicants.

03

Trademarks.

Concerning appeals related to trademarks, Opinion 0017/2023/CGPI/PFE-INPI/PGF/AGU concluded that:

- when examining an appeal against the rejection of a trademark application for reproduction or imitation of a registered trademark, in which there is an abandonment request against the prior trademark, there is no legal obligation to suspend the appeal's examination until the abandonment is analyzed, since the declaration of abandonment has no retroactive effects; and
- when the examination at first instance does not analyze the availability of the trademark because the sign did not meet the requirements of lawfulness, distinctiveness, or veracity, and the second instance recognizes the distinctiveness of such trademark, the case should return to the examination of availability at first instance. However, the possibility of a final analysis on the merits by the appellate court is not ruled out.

021

Industrial Designs.

Concerning appeals related to industrial designs, Opinion 0018/2023/CGPI/PFE-INPI/PGF/AGU, which is related to the scope of appeals involving industrial designs applications, establishes that in the analysis of appeals in the second administrative instance in which the examiner accepts the reasons for appeal and decides to reverse the rejection decision and also verifies that the object of the respective industrial design does not comply with the technical requirements for registrability listed in articles 100, 101 and 104 of the Brazilian Industrial Property Law (LPI), this industrial design application must return to the first instance, which has internal regulatory authority to carry out the formal and technical examination of this application.

It is important to mention that, unlike other registration procedures for other industrial property rights, in the industrial design registration procedure, there is no examination on the merits before the registration is granted, but only the formal and the technical examinations.

In this sense, even though industrial designs applications are still exempt from substantive examinations related to the novelty and originality of the object (examination on the merits), this new guideline encourages that industrial designs applications be carefully analyzed by the first administrative instance in accordance with the formal and technical criteria.

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