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ATTORNEYS

Rule #154/2015

This rule concerns the administrative proceedings of the Pilot Project of Shared Prioritized Examination Patent Prosecution Highway — PPH.

Current as of January, 2015

By exercising the powers vested in them by the BRPTO Bylaws, and considering the provisions of Statute #9 279, of May 14, 1996 (Brazilian IP Statute), as well as articles 159, Section IV and article 106 of the BRPTO Bylaws, which is attached to Order #149 of the Ministry of Development, Industry and Foreign Commerce of May 13, 2013, and

CONSIDERING the Joint Statement between the United States Government and the Government of Brazil on Patent Examination Sharing between Offices signed in Washington, D.C., on June 30, 2015;

CONSIDERING the Memorandum of Understanding between the BRPTO and the United States Patent and Trademark Office — USPTO, of November 19, 2015, and the relevant Work Plan established between the Offices; and

CONSIDERING the principles of territoriality and independence of intellectual property rights,

THE PRESIDENT OF THE BRAZILIAN PATENT AND TRADEMARK OFFICE (BRPTO) and the PATENT DIRECTOR DETERMINE:

Article 1. This Rule concerns the administrative proceeding of the Pilot Project of Shared Examination Patent Prosecution Highway — PPH established between the BRPTO and the USPTO, hereinafter BRPTO-USPTO PPH Pilot Project, under the BRPTO.

Article 2. For the purposes of this Rule, definitions are as follows:

I - First Patent Application: a patent application filed in the BRPTO or the USPTO without priority claim that can be used as priority document for a second patent application filing in another national Patent Office or international organization and that can create a patent family; or international filing, under the PCT, without priority claim, where the BRPTO or the USPTO is appointed as receiving office, in which case the patent application can enter national phase and create a patent family;

II - Second Patent Application: A patent application filed in the BRPTO or the USPTO and that is part of the

patent family of the first patent application; or a patent application that entered national phase in the BRPTO or USPTO composing the patent family of the first patent application;

III - Patent Family: a collection of patent applications filed in more than one national Patent Office or international organization, where all of them claim at least the oldest priority;

IV - Office of First Filing — OFF: The Patent Office where the first patent application is filed;

V - Office of Second Filing — OSF: The Patent Office where the second patent application is filed;

VI - Office of Earlier Examination — OEE: The national Patent Office (the BRPTO or the USPTO) that first issues a decision of patent grant of an application belonging to the patent family, be it the OFF or OSF;

VII - Office of Later Examination — OLE: The national Patent Office (the BRPTO or the USPTO) where PPH is requested and that prioritizes prosecution and examines a patent application belonging to the same patent family based on OEE results;

VIII - Able Patent Application: A patent application complying with eligibility conditions set out in Article 7 of this Rule; and

IX - Date of request: date of receipt of PPH request of shared prioritized examination at the BRPTO headquarters, or relevant regional divisional offices and/or representation offices in each State, or via electronic form, or date of posting should the request be sent via mail.

X - Sufficiently corresponding application: an application where the matter described in the application filed in the OLE does not amend or change the subject matter deemed patentable in the corresponding OEE application, even when translation inconsistencies are considered, and when both of them belong to the same patent family;

XI - Sufficiently corresponding claim: a claim where a claimed matter in the OLE is of the same or narrower scope of the subject matter deemed patentable in the corresponding OEE application, even when translation differences are considered; and

XII - Narrower claim scope: a claim scope is narrower when it is limited, under Article 32 of the Brazilian IP Statute and the BRPTO Rule # 93, of June 10, 2013.

Article 3. For the purposes of this Rule, the following steps should be followed for PPH to apply:

- I - Applicant files first patent application, which turns the receiving national Office or international organization into the OFF;
- II - Applicant files second patent application by claiming priority of the first patent application as priority or entering national phase, which turns the receiving national Office into the OSF;
- III - National Office that issues the first patent grant, either from first or second patent application, becomes the OEE;
- IV - Applicant requests participation in BRPTO-USPTO PPH Pilot Project by meeting requirements and submitting results of the first patent grant to the other national Office, which becomes OLE; and
- V - When the application is considered able, OLE prioritizes the patent application belonging to the same family in every following step, until the final decision.

Sole paragraph. Any waiver of the First Patent Application that was used as priority for international filing under the PCT does not exempt the participation of the corresponding entries into national phase in the BRPTO-USPTO PPH Pilot Project.

Article 4. The applicant of a patent application accepted in the USPTO may request a prioritized examination of an application of the same family in the BRPTO, should the application meet the requirements of this Rule.

Article 5. The BRPTO-USPTO PPH Pilot Project should accept participation requests for a period of two years, or the Pilot Project should extend until every application considered able has a final decision.

Article 6. The BRPTO will examine no more than 150 applications as OLE.

¶1. The examination mentioned in the main section of this article is completed chronologically as per date of request to participate the BRPTO-USPTO PPH Pilot Project.

¶2. The applications able to participate in the BRPTO-USPTO PPH Pilot Project that exceed the limit set out in the main section of this article will not be included in the Project.

Article 7. For the purposes of the BRPTO-USPTO PPH Pilot Project, the following requirements for prioritized examination are made:

- I - Patent application filed in the BRPTO from January 1, 2013 onwards;
- II - Utility patent application;
- III - Patent application published at the BRPTO Official Gazette — RPI (in the Portuguese abbreviation) under the provisions of article 30 of the Brazilian IP Statute, or patent application published in advance upon applicant's request under paragraph 1 of article 30 of the Brazilian IP Statute, or patent application that has been accepted in the admissibility examination to enter national phase filed via PCT;
- IV - Patent application for which a request for examination has been requested, under the provisions of article 33 of the Brazilian IP Statute;
- V - Patent application where examination is not pending answer to office action previously made by the BRPTO;
- VI - Patent application that has not defaulted payment of annuity under article 84 of the Brazilian IP Statute;
- VII - Patent application where request for prioritized examination was not granted and published in the BRPTO Official Gazette;
- VIII - Patent application that is not being judicially challenged in Brazil;
- IX - Non-divisional patent applications, except those arising from direct division of the original application, as a result of a lack of unity of invention objection from the OEE, in the sufficiently corresponding application;
- X - Patent application that has not undergone regular technical examination duly published in the BRPTO Official Gazette;
- XI - Patent application where claimed subject matter explicitly belongs to the oil, gas, or petrochemical industry, and classified as any of the symbols in the International Patent Classification — IPC, including IPC's relevant hierarchical lower levels of classification, found in Annex I of this Rule;
- XII - Patent application belonging to a patent family, under Article 2 of this Rule;
- XIII - Patent application where family member received a notice of allowance from the USPTO;
- XIV - Patent application where family has at least the first patent application filed in the BRPTO or USPTO;

¶1. Utility model and design applications are excluded from the BRPTO-USPTO PPH Pilot Project.

¶2. “Plant patent applications”, “reexamination applications”, “reissue applications” and “industrial design applications” should not be used as basis to request participation in the BRPTO-USPTO PPH Pilot Project.

Article 8. Admission request in the BRPTO-USPTO PPH Pilot Project provided for in this Rule should be made via Service Code #277 of the Table of Fees of Patent Services Provided by the BRPTO. However, applicant is not exempt from remaining fees pertaining to patent application prosecution.

Article 9. When the BRPTO acts as OEE of a patent application with family member in the USPTO, applicant may request participation in the BRPTO-USPTO PPH Pilot Project in the USPTO, by complying with the provisions set out by the USPTO.

Article 10. For admission in the BRPTO-USPTO PPH Pilot Project, only the applicant may request for participation by using the Patent Prosecution Highway Project Participation Request Form.

Sole paragraph. When a patent application has more than one applicant, all applicants should acknowledge the participation request.

Article 11. When an individual other than applicant practices the acts provided for in this Rule, a power of attorney should be submitted in addition, under paragraph 1 of Article 216 of the Brazilian IP Statute.

Article 12. Applicant should submit the following documents and information in Portuguese to the BRPTO upon requesting admission in the BRPTO-USPTO PPH Pilot Project of a patent application:

- I - Prioritized Examination Request Form;
- II - New pages of patent application adapted to sufficiently match the allowed subject matter that the OEE previously set out as accepted; pages should comply with applicable rules on patent application submission to the BRPTO;
- III - A Claim Correspondence Table of the claim charts

comparing new claims submitted to the BRPTO and the claims considered to be allowable/patentable by the USPTO as OEE, under model in Annex II of this Rule;

IV - Proof that the application falls within technology industry which is able to participate in the Pilot Project, pursuant to line XI, Article 7 of this Rule;

V - When the object of a patent application is a result of access to component of Brazilian genetic heritage or associated traditional knowledge, the information required under applicable laws should be provided, accompanied by request for the BRPTO-USPTO PPH Pilot Program,

VI - When the OEE technical examination report mentions non-patent prior art references, those documents should be submitted along with request for the BRPTO-USPTO PPH Pilot Program:

Sole paragraph. When claims submitted to the BRPTO are a mere translation of claims accepted by the USPTO as OEE, the Claim Correspondence Table described in Section III of this article can be replaced with a corresponding declaration.

Article 13. Applicant should submit the following statements, in Portuguese, to the BRPTO when applicant requests participation in the BRPTO-USPTO PPH Pilot Project or enters these in the Prioritized Examination Request Form:

- I - That all copies of OEE actions, when submitted to the BRPTO, correspond to the original documents and replicate their form and content;
- II - That translations, when submitted to the BRPTO, match the contents of the original documents;
- III - That the patent application is not being judicially challenged in Brazil; and
- IV - That the patent application does not arise from voluntary division of patent application.

Article 14. The Patent Board (DIRPA, in the Portuguese abbreviation) is responsible for checking requirements of prioritized examinations and eligibility of patent applications that may participate in the BRPTO-USPTO PPH Pilot Project through the Shared Prioritized Examination Project Work Group.

Article 15. When the submitted patent application is

considered able to participate in the BRPTO-USPTO PPH Project, the BRPTO should provide a specific notification of the acceptance of the prioritized examination of patent application in the Brazilian Official Gazette publication.

Article 16. When the patent application is not considered able to participate in the Pilot Project or exceeds the limit of openings, the BRPTO should notify the rejection of prioritized examination of patent application in the Brazilian Official Gazette.

¶1. When a prioritized examination is rejected, the patent application resumes ordinary prosecution.

¶2. When the BRPTO points out remediable irregularities, applicant may submit a single additional priority examination request within 60 days, pursuant to Article 224 of the Brazilian IP Statute by correcting any the irregularities; applicant is exempted from re-submitting any documents for which no irregularities were pointed out.

Article 17. Pursuant to article 212 of the Brazilian IP Statute, the decisions provided for in this Rule cannot be appealed.

Article 18. When prioritized prosecution is granted, patent application examination should not commence until 60 days after its publication, under article 31 of the Brazilian IP Statute.

Article 19. The BRPTO-USPTO PPH Pilot Project does not affect the fundamental principle of independence of exams set out in Article 4bis of the Paris Convention for the Protection of Industrial Property.

Article 20. The BRPTO-USPTO PPH Pilot Project does not exempt the applicant from complying with the provisions of the Brazilian IP Statute on patent applications filed in the BRPTO.

Article 21. Patent application examinations made via the BRPTO-USPTO PPH Pilot Project should comply with Brazilian laws and other proceedings applicable on the date of examination.

Article 22. Throughout the prosecution of the

application, the BRPTO may request that the applicant submits copies of the following documents in respect of the technical examination throughout the technical examination period:

I - Copy of search reports, office actions made by OEE and applicant's answers to such reports;

II - Copy of claims considered to be allowable/patentable by OEE;

III - Copy of prior art documents mentioned by OEE in its technical examination reports;

Sole paragraph. Documents requested by the BRPTO that are originally not in Portuguese, Spanish or English should be submitted to the BRPTO with a simple translation into one of these languages, at the applicant's discretion.

Article 23. This Rule enters into force on January 11, 2016.

LUIZ OTÁVIO PIMENTEL

President

JÚLIO CÉSAR CASTELO BRANCO REIS MOREIRA

Patent Director

ANNEX I

INTERNATIONAL PATENT CLASSIFICATION SYMBOLS — IPC

In order to participate in the BRPTO-USPTO PPH Pilot Project, patent applications should be classified into at least one of the International Patent Classification Symbols — IPC, including IPC’s relevant lower levels of classification, as below:

- a) B01 - Chemical or Physical Appliances or Processes in General;
- b) B63 - Ships or other vessels; related equipment;
- c) C09K8 - Compositions for well or hole drilling; Compositions for well or hole treating, e.g., for finishing or repair operations;
- d) C10 - Oil, gas or coke industries; fuels; lubes; peat;
- e) E02 - Hydraulic engineering; foundations; earthwork;
- f) E21 - Soil drilling; mining;
- g) F15 - Actuator by fluid pressure; hydraulics or pneumatics in general;
- h) F16 - Elements or unit of engineering; general measures to ensure and maintain effective operation of machinery or facilities;
- i) F17 - Storage or distribution of gases or liquids;
- j) G01 - Measurement; Testing.

ANNEX II

CLAIM CORRESPONDENCE TABLE

Claim Correspondence Table		
Claim requested in the BRPTO	Claim patented in the USPTO	Comment on correspondence



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