



Very Important Notice

Dear Sirs/Madams:

Below is a summarized text related to the **Decree No. 247** which was enacted on last 22 June 2020 by establishing **priority proceedings for patent applications with INPI**. Please read it very carefully and should you have any questions and/or need any assistance from us in this subject matter would you please let us know on top. We will be pleased to assist you with in this matter.

Keep safe and healthy!

Thank you!

Very truly yours,

C. Fernandes CEO



**MINISTRY OF ECONOMY
BRAZILIAN PATENT AND TRADEMARK OFFICE**

BPTO DECREE N° 247, DATED JUNE 22, 2020

Establishing priority proceedings for patent processes with BPTO.

The **PRESIDENT** and the **DIRECTOR OF PATENTS, COMPUTER SOFTWARE AND INTEGRATED CIRCUIT TOPOGRAPHY** of the **BRAZILIAN PATENT AND TRADEMARK OFFICE**, by using their attributions established by line XI of Article 17 and Article 19 of BPTO's Regimental Structure, as approved by the Decree n° 8854, dated September 22, 2016, and by line XII of Article 152 of the Internal Regulations, as approved by MDIC Decree n° 11, dated January 27, 2017,

DECIDE:

Art. 1. This Decree establishes priority proceedings for patent processes with the Brazilian Patent and Trademark Office (BPTO).



Art. 2. For the purposes of the regulations of this Decree, the following definitions will be adopted:

I – international patent application: a patent application filed according to the Patent Cooperation Treaty (PCT);

II – patent process: an administrative process within BPTO, intended to protect industrial property rights, by means of granting a patent of invention or utility model, from filing the patent application or, in case of an international application, its communication or remittance, until the end of the administrative proceedings; and

III – patent family: set of patents and/or patent applications, be them national or with the effect of regular national proceedings, directly related to each other by claiming an internal or Union priority and/or for sharing the same international application.

CHAPTER I
ON THE PROCESS AND APPLICATION REQUIREMENTS

Art. 3. Administrative procedures for patent processes following the requirements below will receive priority in proceedings:

I – to have been filed at least 18 (eighteen) months before or with an anticipated publication request, following the regulations of Paragraph 1st of Art. 30 of Law n° 9279, dated May 14, 1996, or, in case of international applications, published by the World Industrial Property Organization (WIPO);

II – the fee covering the technical examination was paid, as per the regulations of Art. 33 of Law n° 9279, dated 1996;

III – there is no proceeding priority;

IV – there is no voluntary division or amendment to the patent application by the applicant, between the application and the decision for the priority proceedings; and

V – to be included in one of the modes disclosed by Chapter II of this Decree.

Sole Paragraph. The certificates of addition fulfilling the requirements established by the caput are liable for prioritization after granting the patent to which they are related.

Art. 4. The requirement should fulfill the following requirements:

I – to be performed by at least one of the legitimate parties to Chapter II of this Decree or a duly qualified attorney for the patent process;



II – to be performed after the payment of the amount of the Federal Payment Receipt (GRU) for the service, as per the Table included in the Attachment I to this Decree and the table of fees for the services offered by BPTO in force;

III – to be filed by means of an electronic form; and

IV – to present attached documents as required to prove the classification of the patent process in the required mode, as disclosed by Chapter II of this Decree.

Paragraph 1st. Unless proven otherwise, the applicant or owner is presumed to be the legitimate party to require the priority proceeding.

Paragraph 2nd. The payment established by line II of the caput corresponds to the fee for evaluation of the participation requirement.

Paragraph 3rd. If the required document copies are written in a language different from Portuguese, English or Spanish, the translation to any of these languages should also be presented.

Paragraph 4th. The presentation of a document, certificate or their copies is dismissed, when issued by BPTO.

Paragraph 5th. The requirement for priority proceeding will be considered as an express requirement by the applicant for processing or examining the international application before the 30 (thirty)-month deadline, as per the regulations of Art. 23.2 of the PCT Treaty.

(...)

CHAPTER XIII APPLICANT ACCUSING COUNTERFEIT

Art. 17. A patent process wherein the applicant or owner has elements proving the probability of reproduction and/or commercialization of the object of the patent process, in whole or in part, without his/her authorization is included in the “Applicant accusing counterfeit” mode.

Sole Paragraph. The priority proceeding requirement should be filed by the applicant or owner and include:

a. a copy of the document showing the notification to the third party, including the express reference to the patent process number and the allegedly incorrect action;

b. a copy of the document of receipt for said notification by the third party; and



c. elements showing the probability for the notified third party to be reproducing and/or commercializing the object of the patent process, in whole or in part.

(...)

**CHAPTER XV
PREVIOUS USER OF THE TECHNOLOGY**

Art. 19. A patent process is included in the mode “Previous user of the technology” when the third party, simultaneously:

I – used, produced, sold and/or imported, in whole or in part, the object disclosed by the patent process on a previous date to the application; and

II – is suffering loss or is about to suffer loss for filing such technology on a date after its use, production, sale and/or import.

Sole Paragraph. The priority proceeding requirement should be filed by the third party and include:

a. elements proving that the applicant used, produced, sold and/or imported the object disclosed by the patent process, in whole or in part, on a date before the application;

b. a proof that the patent process, filed after the use, production, sale and/or import, causes loss or is about to cause loss to his/her use of the technology; and

c. an explanation indicating the background petition for the technical examination or an indication of the patent cancellation petition, showing that the object of the patent process, in whole or in part, was already included in the state of the art on its date of filing.

(...)

Art. 29. This Decree enters into force within 30 (thirty) days after its publication.

CLÁUDIO VILAR FURTADO
President

LIANE ELIZABETH CALDEIRA LAGE
Director of Patents, Computer Software and Integrated Circuit Topography

Source: www.inpi.gov.br

