

Proposal of resolution presented by Gustavo Leonardos

Proposal of resolution presented by Gustavo Leonardos to the Executive Secretary of the Ministry of the Development, Industry and Commerce to decrease the patent backlog (75% of patent applications have been pending for over ten years) without costs and increasing revenues. A copy was presented to the presidencies of the Brazilian PTO, ABPI and to the National Industry Confederation. (o sistema tem limitação de caracteres)

Subject: Establishes rules on the administrative procedure regarding priority examination of patent applications subject to the sole paragraph of article 40 of Law No. 9.279/1996 (IPL).

Whereas the sole paragraph of article 40 of the IPL provides that: "The term of validity shall not be less than 10 (ten) years for patents of invention and 7 (seven) years for utility model patents, as from the date of grant, except if the BPTO is unable to proceed with the examination on the merits of the application, due to a proven pending litigation or for reasons of force majeure";

Whereas there is a large number of patent applications pending for over 10 years;

Whereas there are pending bills aiming to eliminate the sole paragraph of article 40 of the IPL given that the extension term of validity of the patents may be harmful to the diffusion of innovation and its appropriation by society, even due to the impossibility to import the product in question from cheaper sources;

Considering the principles of territoriality and independence of the industrial property rights, and the constitutional principle of efficiency;

DECIDES:

Art. 1. This resolution provides for the priority examination administrative procedure of patent applications falling, or about to fall, within the sole paragraph of article 40 of the IPL.

Art. 2. All the patent applications pending for more than 9 (nine) years and 6 (six) months counted from the respective filing date referred to in article 40 of the IPL are subject to the present legal provision.

Art. 3. For the purposes of this Resolution, the applicants or holders of patent applications that fall within the previous article, or even third parties, may submit a request for priority examination before the BPTO based on grant of rejection decision of these patent applications issued by any of the Patent Offices participating to the Patent Prosecution Highway (PPH), such as, for instance, the EPO, USPTO and JPO.

Art. 4. The applicant requesting priority examination based on the above conditions shall:

- 1) pay a fee to the BPTO in the amount of R\$ [10,000.00 (ten thousand reais)];
- 2) attest the correspondence between the patent or patent application on which the priority

examination request is based and the national application to be prioritize, being allowed the presentation, by the applicant, of restrictive amendments to the set of claims for such purpose, within the provisions of Resolution No. 93/2013;

3) submit certified translation of the foreign patent or patent application that served as the basis for the priority examination request.

Art. 5. The decision granting the priority examination request under the above conditions shall express its agreement with the decision of the corresponding foreign patent or patent application.

Art. 6. The decision rejecting the priority examination request under the above conditions shall detail the points on which its disagreement is based.

Art. 7. The grant or final rejection decision of patent applications having the examination prioritized under the above conditions shall be published in the Industrial Property Gazette (RPI) within 6 (six) months counted from the filing of the priority examination request, thus, respecting the principle of efficiency, foreseen in article 37, caput, and § 3 and § 6, of the Constitution.

Art. 8. This Resolution does not apply to the patent applications that depend on the prior consent of the National Health Surveillance Agency - ANVISA under article 229-C of the IPL.

Art. 9. This Resolution enters into force on ...