

ORDINANCE/INPI/PR NO. 48, OF NOVEMBER 29, 2024

Establishes phase V of the PPH Pilot Project.

The **PRESIDENT** and **DIRECTOR FOR PATENTS, COMPUTER PROGRAMS AND INTEGRATED CIRCUIT TOPOGRAPHIES** of the **NATIONAL INSTITUTE FOR INDUSTRIAL PROPERTY**, using the powers provided for in INPI/PR Ordinance No. 09, of March 06, 2024, and in view of what is contained in INPI process No. 52402.001426/2024-37,

RESOLVE:

Art. 1 This Ordinance establishes phase V of the *Patent Prosecution Highway* (PPH) Project within the scope of the Brazilian *Patent* and Trademark Office (BPTO).

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

I- *Patent Prosecution Highway* (PPH): is a project effective through a Memorandum of Understanding (MOU) between the INPI and other intellectual property offices.

II- *Global Patent Prosecution Highway* (GPPH): multilateral cooperation program for the *Patent Prosecution Highway* (PPH), which covers three types of PPH agreements: the traditional PPH, the MOTTAINAI PPH and the PCT-PPH.

III- International patent application: a patent application filed under the Patent Cooperation Treaty (PCT).

IV - Patent process: an administrative process at the INPI aimed at protecting industrial property rights by granting a patent for an invention or utility model, from the filing of the patent application or the request for entry into the Brazilian national phase of an international patent application (item III of Art. 2), until the administrative instance is closed.

V- Partner office: is an IP office participating that, at the time of the PPH application, has a PPH co-operation agreement with the INPI and/or is a participant in the GPPH, in both cases, according to the list available at <https://www.gov.br/inpi/pt-br/servicos/patentes/pph/acordos-pph-assinado-pelo-inpi>.

VI - Previous Examining Office: partner office (Art. 2(V)) that has examined the patentability of a corresponding patent application before the INPI, acting as an international authority under the PCT or as a national or regional patent office.

VII - Corresponding patent application: a patent application filed with the Office of Prior Examination (Art. 2(VI)) that is related to the patent application filed with the INPI because it shares the same priority document with an earlier date, or because it shares the same international filing document with an earlier date.

VIII - Subject matter considered patentable/admissible: matter that the Previous Examination Office (item VI of Art. 2):

a) acting as a national or regional patent office, has technically examined and indicated at least one claim as patentable/admissible in the last Prior Examining Office action;

b) acting as the international authority under the PCT, has technically examined and indicated at least one claim as admissible (with regard to novelty, inventive step and industrial applicability) in the last action of the international phase of a PCT application.

IX - Sufficiently corresponding claims: claims of the patent application filed with the INPI which, after taking into account differences in translation and formatting, have the same, similar or narrower scope

than the claims considered patentable/admissible by the Office of Previous Examination (item VI of Art. 2), according to Annex II of this Ordinance.

X - More restricted claim: claim submitted to the INPI which, in relation to the claims considered patentable/admissible by the Office of Prior Examination (item VI of Art. 2), is limited by some additional technical feature supported in the Specification and/or the set of claims.

§ Paragraph 1 When a new category of claim is introduced in the set of claims submitted to the INPI and which was not provided for in the set of claims of the Previous Examination Office, the new category will not be considered as a sufficiently corresponding claim, as specified in item IX of Art. 2.

§ Paragraph 2 Certificates of addition are considered patent processes, in accordance with item IV of the *heading*, and are conditional on the grant of the main application.

TITLE I THE REQUIREMENTS OF THE PROCEDURE AND THE REQUEST

Art. 3 Administrative procedures for patent applications with PPH requests that meet the following requirements will have priority:

I - not being within the secrecy period defined in Art. 30 of Law No. 9,279, of May 14 1996, or having applied for early publication, in accordance with the provisions of § 1 of Art. 30 of Law No. 9,279, of 1996, or, in the case of international applications, being published by the World Intellectual Property Organization (WIPO);

II - have paid the fee for the technical examination, in accordance with Art. 33 of Law No. 9,279 of 1996;

III – do not have any other type of priority procedure in progress;

IV – not having filed voluntarily a division or amendment to the patent application, in accordance with the provisions of Art. 26 and 32 of Law No. 9,279 of 1996, between the request and the priority processing decision;

V - Not having the technical examination started;

VI - Have a corresponding patent application, as defined in Art. 2, item VII;

VII- have subject matter considered patentable/admissible, as defined in Art. 2, item VIII;

VIII - have sufficiently corresponding claims, as defined in Art. 2, item IX.

Sole Paragraph. In the event of a division of the application, in accordance with the provisions of Art. 26 of Law no. 9.279, of 1996, prior to the request for priority examination, the parent and its divisional applications must comply with the provisions of items I, II and IV of the *caput*.

Art. 4 The PPH request must meet the following requirements:

I - be requested by any Applicant, alone or jointly, or their duly qualified attorney in the patent file wrapper;

II - be made after payment of the Union Collection Form (GRU), in the amount of service code 277, with the indication, in the object of the petition, of the Previous Examination Office;

III - be filed using the PPH/GPPH electronic form; and

IV - attach the following documents:

a) A copy of the cover page of the document proving that the patent application meets the definitions in item VI of Art. 3 of this Ordinance;

b) a copy of the latest action taken by the IP office, acting as a national office or international

authority, which shows that the patent application complies with Art. 3, item VII of this Ordinance, such as the actions listed on the PPH page within the Patent service on the INPI portal;

c) a declaration that the document listed in item "b" of section IV of the *caput* fulfills the requirements of article 3, section VII of this Ordinance, if the document is not in Portuguese, English or Spanish;

d) a copy of non-patentary prior art documents cited in any technical examination report of the Office of the previous examination;

e) a copy of the last set of claims submitted to the Office of Prior Examination based on the patent application that fulfils the requirements described in Art. 3 (items VI, VII and VIII) of this Ordinance;

f) an amended patent application, in order to comply with items VI, VII and VIII of Art. 3 of this Ordinance, respecting the legislation in force regarding the amendment of INPI patent applications, or a declaration that the patent application complies with the requirements of these items;

g) a table of correspondence of the sets of claims, according to the model in Annex I of this Ordinance, showing the correlation between the claims considered patentable/admissible by the Previous Examination Office (item VI of Art. 2) and the new claims submitted to the INPI, or a declaration that the claims submitted to the INPI constitute a mere translation of the claims of the application with subject matter considered patentable by the Previous Examination Office.

§ Paragraph 1. The presentation of a document, certificate or copy thereof, when issued by the INPI, and/or already included in the patent file of the request, and/or to identify the Applicant's or holder's representative, pursuant to Art. 75 of Law No. 13,105 of 16 March 2015, is waived.

§ Paragraph 2 The fee provided for in item II of the *caput* corresponds to the fee for assessing the application for participation.

§ Paragraph 3: If the required copies of documents are written in a language other than Portuguese, English or Spanish, a translation into one of these languages must also be submitted.

§ Paragraph 4 The request for priority processing shall be considered as an express application by the Applicant to immediately start processing or examining the international application for entry into the Brazilian national phase before the 30 (thirty) month deadline, in accordance with Article 23.2 of the Patent Cooperation Treaty (PCT).

Art. 5 The PPH Project will have the following limits:

I - Requests may be filed between 01/01/2025 and 12/31/2029;

II - Up to 1000 (one thousand) requests for participation in the Project may be made for patent processes classified in the same Section of the International Patent Classification (IPC), per annual cycle;

III - up to 3,200 (three thousand two hundred) requests for participation may be received per annual cycle; and

IV - The project will continue until the administrative instance at the INPI of all patent cases with admitted priority is finished.

§ Paragraph 1 The quantitative limits set out in the *headings* are independent of whether or not the respective requests for priority processing are accepted and whether or not the result presented by the Previous Examination Office is accepted.

§ Paragraph 2. The vacancies referred to in the *headings* will be filled in order of the date and time of the request for priority processing.

§ Paragraph 3 The annual cycle referred to in items II and III of the *heading* begins on the 1st day of the year and ends on the last day of the same year, and no extension is permitted.

TITLE II PRIORITY PROCESSING

Art. 6 The Directorate for Patents, Computer Programs and Topographies of Integrated Circuits (DIRPA) shall be responsible for defining the procedure for evaluating requests for priority processing, verifying that the requests and processes meet the criteria established in this Ordinance and publishing its decision in the Official Gazette (IPG).

§ Paragraph 1 - The INPI will prioritize the procedural acts necessary to assess the request for priority processing.

§ Paragraph 2. Omissions will be decided by the head of the DIRPA responsible for patent prosecution at first instance.

§ Paragraph 3 DIRPA may temporarily suspend, in whole or in part, the receipt of requests for priority processing of patent cases in the manner governed by this Ordinance.

§ Paragraph 4 DIRPA will notify the suspension described in Paragraph 3 at least 30 (thirty) days in advance.

Art. 7 - A single office action will be issued when it is necessary to provide information, present evidence, pay and/or top up fees.

§ Paragraph 1. Proof by the interested party of the information referred to in Article 4(IV)(a), (b), (c), (d) or (e) may be waived, at the discretion of the administration, if DIRPA has access to the information via a free public electronic database containing the document in Portuguese, English or Spanish.

§ Paragraph 2 - In the event of the Office Action described in the *caput*, the Applicant must fulfil it within 60 days through the INPI's electronic petitioning system, after generating a Federal Tax Collection Form (GRU) with service code 206, indicating "Compliance with formal office action for priority processing" in the subject of the petition.

§ Paragraph 3. If the summons is not complied with, DIRPA may, at the discretion of the administration, rectify the omission ex officio.

Art. 8 Priority processing will not be allowed when:

I - The data, actions and/or documents necessary for the appraisal of the application have been requested to the interested party and they have not been provided within the period and in the manner defined in Art. 7;

II - The application does not refer to a patent process, as defined in item IV or § 2 of Art. 2;

III - The patent process does not meet the requirements set out in items III, IV, V or VI

Art. 3;

IV - The application is not filed in accordance with Art. 4(I), (II) or (III); or

V - The limits stipulated in items II or III of Art. 5 have been reached.

§ Paragraph 1 The patent prosecution shall continue to be processed in the event that the priority request and amendments to the patent application submitted in the PPH request are not considered.

§ Paragraph 2 - At the applicant's/attorney's request, the fee paid for petitions for priority requests that are not admitted on the basis of items II, III or IV of the *main body* of this article, may be refunded.

Art. 9 The admission of priority processing will imply prioritisation of all acts in the INPI's administrative sphere.

§ Paragraph 1 Prioritised processing of the patent application will be carried out in accordance with Brazilian legislation and in compliance with the other regulations in force.

§ Paragraph 2 In the event of a priority application being split after the publication of the first technical examination opinion, only the original application will retain the priority processing attribute.

Art. 10: Priority processing will be cancelled when:

I - The patent process ceases to fulfill the conditions stipulated in Art. 3 of this Ordinance due to the Applicant's actions;

II - The applicant voluntarily divides or amends the patent application after admission to priority processing and before publication of the first technical examination opinion; or

III - an inconsistency is identified during the technical examination of the patent application in the documents listed in sub-paragraphs "b", "c", "d", "e" or "f" of item IV of Art. 4 of this Ordinance.

Art. 11: Decisions on priority processing cannot be appealed.

Sole Paragraph. The interested party may submit a new request for priority processing accompanied by new supporting documentation.

TITLE III TRANSITIONAL AND FINAL PROVISIONS

Art. 12: Requests pending assessment submitted for participation in the previous PPH Pilot Projects INPI-USPTO, PPH INPI-JPO, PPH PROSUL, PPH INPI-EPO, PPH INPI-CNIPA, PPH INPI-USPTO II, PPH INPI-DKPTO, PPH INPI-UK IPO, PPH INPI-PROSUL II, PPH INPI-JPO II, PPH PROSUL III, PPH, PPH II, PPH III and PPH IV will be assessed in accordance with the procedures set out in Title II of this Ordinance.

Sole Paragraph. The applications referred to in the *caput* must meet the formal and substantive requirements defined in the normative act in force at the time the application is filed, and will be accounted for the corresponding Pilot Project.

Art. 13: Ordinance INPI/ PR no. 78 of December 16, 2022, published in the Official Bulletin (IPG) no. 2712 on December 27, 2022, is hereby revoked.

Art. 14: This Ordinance comes into force on January 1st, 2025.

JÚLIO CÉSAR CASTELO BRANCO REIS MOREIRA

President

ALEXANDRE DANTAS RODRIGUES

Director of Patents, Computer Programs and Integrated Circuit Topographies

Annex I

OF ORDINANCE/INPI/PR NO. 48, OF NOVEMBER 29, 2024

Claims matching table

Claims Matching Table		
Claim filed with the INPI	No. of the claim considered patentable/admissible by the Previous Examination Office	Comment on correspondence

Annex II

1- Examples of claims considered sufficiently corresponding.

Case	Claims considered patentable/admissible by the Office of Prior Examination		Claims of the patent application filed with the INPI		Interpretation
	Claim	Technical Features	Claim	Technical Features	
Case 1	1	A	1	A	Claim 1 filed with the INPI has the same scope as claim 1 of the Previous Examination Office.
Case 2	1	A	1	A	<p>Claim 1 filed with the INPI has the same scope as claim 1 of the Previous Examination Office.</p> <p>Claim 2 filed with the INPI covers feature "A" and adds a technical feature "a" from the Specification or the set of claims.</p>
			2	A + a	
Case 3	1	A	1	A	<p>Claim 1 filed with INPI has the same scope as claim 1 of the Office of Previous examination</p> <p>Claims 2 and 3 filed at the INPI have the same scope as "patentable/admissible" claims 2 and 3 from the Previous Examination Office.</p>
	2	A + a	2	A + b	
	3	A + b	3	A + a	
Case 4	1	A	1	A + a	Claim 1 filed with the INPI has an additional technical feature described in the Specification or in the set of claims.

2- Examples of claims that are not considered sufficiently corresponding.

Case	Claims considered patentable/admissible by the Office of Prior Examination		Patent application claims filed with the INPI		Interpretation
	Claim	Technical features	Claim	Technical features	
Case 5	1	A (product)	1	A' (method)	Claim 1 filed with the INPI will not be accepted, as there has been a change in the category of the claim in relation to the claim from the Previous Examination Office.
Case 6	1	A + B	1	A + C	Claim 1 filed with the INPI will not be accepted because a technical feature of claim 1 has been altered (patentable / admissible) from the Previous Examination Office.