

Current interpretation of Article 32 of the Industrial Property Law and its consequences

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Topics

Intellectual Property Patents

When a patent application is filed, the filing date is established as a time frame to define the matter originally disclosed, which indicates the invention to be protected via patent.

An efficient patent system – one that encourages technological development, promotes industrial activity, and guarantees adequate protection for inventors – must contemplate a level of flexibility for its own evolution and survival. However, the patent legislation in Brazil establishes limitations that do not envisage this demand and, therefore, there is a lot of controversy and discussion about the need to modernize the Brazilian Industrial Property Law ("LPI").

Law 5,772/71 ("Industrial Property Code") established that there could be modifications to the patent application under examination based on requirements deemed necessary by the examiners, provided that such modifications were restricted to **the matter initially requested**.

Prior to the enactment of the current Brazilian Industrial Property Law, Law 9,279/96 ("LPI"), a bill¹ established that applicants could make changes to better define the scope to be protected for a particular invention or even opt by the filing of divisional applications **until the end of the technical examination**, provided that the changes or divisionals filed were restricted to the matter initially disclosed in said applications.

However, article 32 of the LPI, as currently in force, provides that:

*"In order better to clarify or define a patent application, the applicant may effect alterations **up to the request for examination**, provided that they be limited to the **subject matter initially disclosed in the application**."*
(emphasis added)

Firstly, in 2002, an opinion by the Attorney General² established that article 32 of the LPI would not prevent, after the examination request, that modifications were made in the scope of protection claimed, provided that it was limited to the matter that was initially disclosed in the patent application as filed.

Nevertheless, after a judicial discussion³ in 2003, this understanding changed and in 2008 the National Institute of Industrial Property – INPI – established administrative regulations so that the divisions responsible for technical examinations of patent applications analyzed the voluntary amendments required by applicants in such a way that said amendments were only accepted **up to the time of the examination request**. That is, from that moment on, voluntary amendments which changed the scope of protection

of a patent application after the request for examination of the same could only be carried out to **restrict said scope**. Or even, after the examination request, voluntary amendments that alter or broaden the scope of protection would not be accepted.

Subsequently, other procedures were established by the INPI also regarding divisional applications. Thus, the scope of protection of divisional application of a parent application could only be altered **up to the time of the examination request of the parent application**. In practice, what happens is that divisional applications are restricted to the scope of the parent application at the time of its examination request, even though there is matter initially disclosed, but not claimed, in the parent application.

The result of this more restrictive interpretation of article 32 of the LPI is that applicants for patent applications with an interest in protecting their inventions in Brazil must pay close attention when requesting the technical examination of their applications, since by the end of the day, this will be the time frame for voluntary amendments, and not the matter initially disclosed. After the examination timeframe, amendments will be restricted to the subject matter as claimed at the time of the examination request.

In general terms, it is possible to summarize the effects of the current interpretation of article 32 of the LPI as follows:

- Voluntary amendments that aim to correct or reduce the scope of protection **initially claimed** are not subject to the time limit of the request for examination of the patent application.
- **Until the request for examination** of the patent application, amendments will be accepted in the specification, in the scope to be protected (even if it is to broaden the claimed matter), abstract, drawings (if any), sequence listing (if any), provided that they are **limited to the matter initially disclosed**.
- **After the examination request**, any change in the scope to be protected will be **limited to the subject matter claimed at the time of the examination request**.
- Voluntary amendments to the set of claims of a divisional application **will be limited by the scope defined in the claim set of the original application for which examination was requested**.
- Amendments to correct unambiguous typographical or translation errors will be **accepted at any time during the processing of the patent application**.
- Broadening the scope of protection claimed by a patent application after the examination is requested **is not permitted by the LPI**.

Regarding specifically the divisional applications, it is worth mentioning the consequence of the current procedures related to the interpretation of article 32 of the LPI, as per the following.

Article 26 of the LPI provides as follows:

"A patent application may, until the end of examination, be divided, ex officio or on request of the applicant, into two or more applications, provided

that the divisional application:

I - makes specific reference to the original application; and

II - does not exceed the matter disclosed in the original application.

Sole Paragraph - A request for division not in accordance with the provisions of this article will be shelved."

Divisional applications are generally recommended only if an objection based on lack of unity of invention has been issued or anticipated, or if the pending set of claims includes multiple and alternative embodiments, each with different chances of allowance. Also, divisional applications should be examined (and decided on) in parallel with the examination of the parent application.

Since the scope of claims in any divisional application is also limited to the matter claimed in the parent application by the time examination was requested, the applicant for patent applications in Brazil needs once again to be very attentive and well advised at the time examination of the parent application is requested. For example, no embodiment of the invention should be left out of the set of claims for which the examination will be requested, under penalty of jeopardizing any future divisional applications, and even future amendments in the very scope of protection of the parent application.

The restrictive interpretation of article 32 of the LPI as adopted by the INPI in relation to the possibility of voluntary amendments to patent applications under examination ends up encouraging applicants to adopt a conservative and preventive approach as a strategy to seek the broadest possible scope of protection, including through the voluntary filing of divisional applications.

It is notable the increase in the number of filings of divisional applications from the year 2019, when the INPI put into practice its plan to combat the patent backlog⁴, that is, it started to take advantage of the results of searches carried out by patent offices of other countries to reduce the administrative processing time of patent applications in Brazil.

Between 2014 and 2018 (inclusive) the average annual number of divisional applications filed was 482 divisionals/year. Between 2019 and 2021 (inclusive), this average increases by approximately 261%, to a number of 1,740 divisionals/year.

Well, if the divisional applications should be examined concomitantly with the respective parent applications, the burden on the INPI examiners has increased considerably, impacting even the productivity necessary for the efficiency and good results of the program to combat the backlog.

This fact ended up reinforcing a movement of interested parties to strengthen the scenario of innovation and industrial property in Brazil, already underway, to change the restrictive interpretation currently adopted by the INPI for article 32 of the LPI.

It is essential to follow the debates about the need to modernize the LPI, especially with regard to article 32, to improve the innovation environment in Brazil, in addition to encouraging more and more the use of the Brazilian

patent system. While the results are not yet a reality, the need for full attention and care with the processing of patent applications in Brazil persists, especially at the time of requesting the technical examination.

>>> *This article belongs to the e-book: "Intellectual Property". Click here to read more articles.*

NOTES:

¹ Article 34 of Bill No. 824, of 1991.

² PROC/DICONS N° 07/2002.

³ Public civil action No. 2003.51.01.513584-5, against the INPI and against the regulation and application of Opinion PROC/DICONS No. 07/2002 at the INPI.

⁴ Stock of patent applications pending decision by the INPI.

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