



**MINISTRY OF ECONOMY
NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY OF BRAZIL**

RESOLUTION/ INPI/PR N° 252, OF OCTOBER 18, 2019

Subject: Establishes the PPH Pilot Project.

The **PRESIDENT** and the **DIRECTOR OF PATENTS, COMPUTER PROGRAMS AND TOPOGRAPHIES OF INTEGRATED CIRCUITS** of the **NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY OF BRAZIL**, in the use of their attributions set forth in articles 17, item XI, and 19 of the Regimental Structure, approved by Decree No. 8,854, of September 22, 2016, in item XII of article 152 of the Internal Regulations, approved by Ordinance No. 11, of January 27, 2017,

DECIDE:

Article 1. This Resolution establishes the Patent Prosecution Highway (PPH) within the National Institute of Industrial Property of Brazil, so called the PPH Pilot Project.

Article 2. For the purposes of this Resolution, the following definitions shall be adopted:

I – international patent application: patent application filed under the Patent Cooperation Treaty (PCT);

II – patent process: INPI's administrative process for the protection of industrial property rights by granting a patent of invention or utility model, since the filing of the patent application or, in the case of an international application, communication or remittance until the end of the administrative instance;

III – patent family: set of patents and/or patent applications, national or with effect of regular nationals, directly related to each other by the claim of internal or unionist priority and/or by sharing the same international filing;

IV – Office of Earlier Examination: Institute responsible for the examination of patent applications with which INPI has a signed and existing cooperation instrument, which carried out the technical examination of a patent application of the same family prior to the INPI; and

V – subject considered patentable: subject that the Office of Earlier Examination has technically examined and considered that meets, at least, the requirements of novelty, inventive step and industrial application.

Article 3. The patent process shall meet the following requirements:

I – have been filed for at least 18 months or with the request of advance publication or, in the case of international applications, published by the World Intellectual Property Organisation (WIPO);

II – have collected the fee related to the technical examination;

III – not have priority of processing granted and published in the Industrial Property Gazette (RPI, in Portuguese);

IV – not have the technical examination started;

V – there is no voluntarily division nor modification of the patent application, by the applicant, between the request and the decision of the priority process;

VI – belong to a patent family which at least the oldest patent application has been filed with the INPI or the Office of Earlier Examination, acting as national or regional office, or, within the scope of the PCT, acting as a Receiving Office (RO);

VII – belong to a patent family in which the Office of Earlier Examination, acting as a national patent office, has examined an application from this family, and has considered that there is a subject considered patentable in a technical, substantive or merit examination;

VIII – belong to a patent family in which the Office of Earlier Examination, acting as a national patent office, has issued a decision to grant; and

IX – claim subject equal to or more restricted than the one considered patentable by the Office of Earlier Examination for the application of the same patent family, even considering differences due to translations, being prohibited the inclusion of subject for which the Office of Earlier Examination has not searched and or carried out technical examination, even if the object of the claim is restricted.

Sole Paragraph. Addition certificates that meet the requirements set out in the *caput* are subject to prioritization after granting the patent for the application to which they relate.

Article 4. The request for participation shall meet the following requirements:

I – be made by any applicant, isolated or jointly, or his/her attorney duly qualified in the patent process;

II – be the sole request in this Pilot Project of any applicant within the monthly cycle;

III – be made after payment of the Union Collection Guide (GRU, in Portuguese), according to the fee table of the services provided by the INPI;

IV – be made by electronic form;

V – present, in the annex, the following documents:

a) copy of the cover page of the document proving that the patent application meets the definitions of article 3, item VI, of this Resolution;

b) copy of the document proving that the patent application of the same family complies with that described in article 3, item VII, of this Resolution;

c) copy of document proving that the patent application of the same family meets the one described in article 3, item VIII, of this Resolution;

d) copy of non patenting state-of-the-art documents cited in any technical examination report of the Office of Earlier Examination, or statement that the Office of Earlier Examination did not cite non-patenting documents in any technical examination report;

e) copy of the claim frame as approved by the Office of Earlier Examination;

f) modified patent application, in order to comply with the provisions of article 3, item IX, of this Resolution, respecting the legislation in force regarding the alteration of patent applications at INPI, or statement that the patent application meets the provisions of the item; and

g) table of correspondence of the claim frame, according to the model of Annex I of this Resolution, evidencing the correlation between the claims considered patentable by the Office of Earlier Examination and the new claims presented to INPI constitute a mere translation of the claims of the application considered patentable by the Office of Earlier Examination; and

VI – be made between December 01, 2019 and November 11, 2022.

§ 1° The monthly cycle referred to in item II of the *caput* of the article begins on the first day of the month and ends on the last day of the month, and no extension is allowed.

§ 2° The fee provided for in item III of the *caput* corresponds to the service of evaluation of the participation request.

§ 3° If the copies of the documents required by item V of the *caput* are written in a language other than Portuguese, English or Spanish, the translation into one of these languages shall also be presented.

§ 4° The presentation of document, certificate or its copy is not required when issued by INPI.

§ 5° The request for priority processing shall be deemed to be the express request of the applicant to process or examine the international application before the 30-month deadline, in accordance with Article 23.2 of the PCT Treaty.

Article 5. The PPH Pilot Project may receive up to 400 (four hundred) requests for participation per annual cycle, regardless of the granting of the priority procedure, and will extend until the termination of the administrative instance of all patent processes with priority granted.

§ 1° The filing of the vacancies dealt with in the *caput* of this article shall obey the order of the date of the priority request protocol.

§ 2° The annual cycle referred to in the *caput* of the article begins on the first day and ends on the last day of the year, and no extension is allowed.

§ 3° The Directorate of Patents, Computer Programs and Topographies of Integrated Circuit (DIRPA) may temporarily suspend, totally or in partially, the reception of PPH requests for patent processes.

§ 4° DIRPA shall notify the suspension described in paragraph 3 of the *caput* at least thirty (30) days in advance.

Art. 6° Compete to DIRPA to define the procedure for evaluating priority requests, to verify if the requests and processes meet the criteria set forth in this Resolution and to publish its decision in the Industrial Property Gazette (RPI, in Portuguese).

§ 1° INPI will prioritize the actions needed to evaluate the request for priority processing.

§ 2° Omitted cases will be decided by the senior director of the directorate responsible for the processing of patent procedures at first instance.

Art. 7° The petitions will not be known when:

I - not refer to a patent process, in the form of item II of art. 2;

II - the patent process does not meet the requirements set forth in items III, IV or V of art.

III - the request is filed in disagreement with items I, II, III, IV or VI of art. 4; or

IV - the request exceeds the limit stipulated in the *caput* of art. 5 or reception is suspended as per paragraph 3 of the same article.

Art. 8° There will be a single requirement to be fulfilled within 60 (sixty) days when:

I - the applicant and/or his/her attorney are not properly qualified;

II - the formal conditions of the process stipulated in items I or II of art. 3 are not met;

III - the formal conditions of the request stipulated in any point of item V, or paragraph 3, of art. 4, are not met; or

IV - additional documents need to be submitted during the examination of participation requirements or during the technical examination.

§ 1° Proof by the interested party of the information referred to in items a), b), c), d) and e), of section V, of art. 4, may be waived in the event that DIRPA has access to the information through the public electronic database in Portuguese, English or Spanish.

§ 2° The applicant shall provide clarification on the fulfillment of the requirement within the time limit stipulated in *caput*.

§ 3° If the requirement described in item I of the *caput* is not met, the petition will not be known and, in the cases described in items II, III and IV, the priority procedure will be denied.

Art. 9° The granting of the priority procedure will imply prioritization of all acts in the administrative sphere of the INPI.

Art. 10. The priority procedure will be cancelled when:

I - he patent process no longer meets the conditions stipulated in art. 3 of this Resolution by action of the applicant; or

II - there is a voluntary division or modification of the patent application by the applicant prior to the publication of the first technical examination opinion.

Art. 11. Appeals against decisions that deny the priority processing of the patent process shall not be made when:

I - there is no fulfillment, prior to the analysis of the request by DIRPA, of the conditions provided for in items I or II of art. 3; or

II - the decision is based on the absence of documentation, including incomplete, invalid or untimely submission of documents.

Art. 12. Pending evaluation request submitted for participation in the Pilot Projects PPH INPI-USPTO, PPH INPI-JPO, PPH PROSUL, PPH INPI-EPO, PPH INPI-SIPO, PPH INPI-USPTO II, PPH INPI-DKPTO, PPH INPI-UKIPO, PPH PROSUL II, PPH INPI-JPO II and PPH PROSUL III shall be evaluated in accordance with the procedures set forth in this Resolution, provided for in articles 6, 7, 8, 9, 10 and 11.

Single paragraph. The requirements dealt with in the *caput* shall meet the formal and substantive requirements defined in the normative act in force at the time of the petition protocol, and will be accounted for the corresponding Pilot Project.

Art. 13. The following Resolutions are revoked:

I - Resolution INPI PR n° 202, of October 30, 2017, published at the RPI n° 2444, of November 07, 2017;

II - Resolution INPI PR n° 209, of January 26, 2018, published at the RPI n° 2456, of January 30, 2018;

III - Resolution INPI PR n° 218, of May 07, 2018, published at the RPI n° 2470, of May 08, 2018;

IV - Resolution INPI PR n° 222, of July 20, 2018, published at the RPI n° 2481, of July 24, 2018;

V - Resolution INPI PR n° 223, of August 09, from 2018, published at the RPI n° 2485, of August 21, 2018;

VI - Resolution INPI PR n° 253, of February 08, 2019, published at the RPI n° 2510, of February 12, 2019;

VII - Resolution INPI PR n° 237, of March 28, 2019, published at the RPI n° 2517, of April 02, 2019; and

VIII - Resolution INPI PR n° 242, of June 27, 2019, published at the RPI n° 2530, of July 02, 2019.

Art. 14. This Resolution enters into force on December 1st, 2019.

Rio de Janeiro, October 18, 2019.

CLAUDIO VILAR FURTADO

President

LIANE ELIZABETH CALDEIRA LAGE

Director of Patents, Computer Programs
and Topographies of Integrated Circuit

ANNEX I TO RESOLUTION/INPI/PR N° 252, OF 18 OCTOBER, 2019

TABLE OF CORRESPONDENCE OF CLAIMS

Table of Correspondence of Claims		
Number of claim requested at INPI	Number of claim considered patentable by the Partner Institute	Comment on Correspondence