

## Amending patent applications after examination requests: the controversy continues

On 15 January 2019 the 25th Federal Court of Rio de Janeiro handed down a decision on the Federal Public Prosecutors Office's (MPF) public civil action, which it filed against the National Institute of Industrial Property (INPI). The MPF challenged INPI's Resolution 93/2013, which provided guidelines on the provisions of Article 32 of the Intellectual Property Law (9279/96). Under Article 32, amendments to a patent application can be made until the date of the examination request, provided that:

- they are limited to the subject matter initially disclosed in the application; and
- they do not alter the scope of protection.

Resolution 93/2013 aimed to consolidate patent examination guidelines under Article 32. According to INPI's interpretation, amendments to claims could be made after the examination request under specific conditions.

The court stated that this resolution should prevail. This is mainly due to the following reasons:

- the Federal Constitution grants INPI regulatory powers over its internal procedures, which includes patent applications;
- the resolution could help to reduce the backlog of pending patent examinations; and
- the resolution does not violate the *res judicata* in connection to the previous court decision that repealed INPI's Ordinance 07/2002, which also aimed to clarify provisions in Article 32.

On 21 March 2019 the MPF filed an appeal against the decision, which is still pending before the Federal Appellate Court in Rio de Janeiro.

### Background

The federal court decision was a continuation of a 2003 lawsuit that the MPF had filed against INPI, which alleged that its Ordinance 07/2002 violated Article 32. The ordinance stated that amendments to patent applications were not permitted under the IP Law, even though the examination request stated that they were allowed, but were limited to the subject matter initially disclosed. INPI revoked this ordinance in 2007 and the lawsuit was dismissed.

Six years later, INPI enacted Resolution 93/2013, which provided guidelines on provisions in Article 32. Further, it clarified the examination process for patent application amendments.

In October 2017 MPF filed an enforcement proceeding in the records of the same public civil action that had challenged Resolution 93/2013. The Brazilian Association of Industrial Property Agents, as well as other associations and governmental agencies, were involved in the lawsuit as *amicus curiae*. They claimed that the wording of Resolution 93/2013 did not violate the *res judicata* of the decision that repealed

Ordinance 07/2002, since Resolution 93/2013 does not allow amendments to be submitted after an examination request if they broaden the scope of protection.

#### Resolution 93/2013

According to the resolution, voluntary amendments to claims are accepted until the date of the examination request, provided that they are limited to the subject matter initially disclosed. Examples of acceptable amendments include:

- correcting spelling or translation errors;
- inserting a characterising expression;
- correcting errors as to the relationship between claims; and
- inserting numerical references based on drawings.

After the examination request, voluntary amendments and those in response to a request made by INPI are accepted as long as they exclusively narrow the subject matter and do not change the claimed object (eg, insert information from a dependent claim into an independent one).

However, if the amendments broaden the scope of protection, the set of claims must be entirely rejected, even if the amendment affects one or a few claims only.

With regard to divisional applications, voluntary amendments to claims can occur if the application was filed before the examination request of the parent application only. This interpretation is based on a combination of Articles 26 and 32.

*Article 26 - 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.*

...

*Article 32 - In order to better clarify or define a patent application, the applicant may effect amendments until the examination request, provided that they are limited to the subject matter initially disclosed in the application.*

Resolution 93/2013 has established that the examination of a divisional application must consider the submitted claims until the examination request of the parent application. If a divisional application is filed after the parent application's examination request, amendments that insert a new category of claim or broaden the scope of protection of the original claims will not be permitted.

The court decision under appeal seems to be in line with the provisions of Articles 26, 31, 35, 33 and 47, which already foresee the possibility of submitting amendments after the examination request, as well as with Article 220, whereby INPI will consider the acts of the parties whenever possible.

