

Fast-track examination for patents in Brazil: INPI launches unified Patent Prosecution Highway programme

According to WIPO's World Intellectual Property Indicators 2019 report, the number of patent applications filed in Brazil fell for a fifth consecutive year, with a drop in resident applications in 2018. Despite the economic and political explanations for this, the same report also states that Brazil granted 9,966 patents in 2018, which is the second-fastest growth in patent grants among the top 20 offices in the past year (up 82.9% since 2017).

This data reflects the National Institute of Industrial Property's (INPI) efforts to fight the patent backlog. Over the past few years, INPI has adopted a number of measures to expedite examination time and narrow the timeframe for issuing final decisions, one of which was the Patent Prosecution Highway (PPH) agreement with several foreign patent offices. The PPH is a fast-track programme for patents belonging to a patent family, for which the application has already been allowed or granted by one of the participating offices, namely: the EPO , the China National IP Administration, the USPTO, the UK Intellectual Property Office, the Danish patent and Trademark Office, the Japan Patent Office (for further information see [here](#)) and the Forum for the Progress and Development of South America (including the patent offices of Chile, Argentina, Colombia, Ecuador, Paraguay, Peru, Uruguay and Costa Rica).

The problem is that each of these agreements had a specific resolution with different rules and were limited to different technological fields. However, it seems that these limits may soon be a thing of the past.

Resolution 252/2019 – what are the changes?

On 22 October 2019 INPI launched Resolution 252/2019, which merges the rules and procedures of all the current PPH pilot projects. The resolution will come in force on 1 December 2019 and will last three years. Therefore, all the previous PPH pilot programmes will be revoked on 30 November 2019.

According to INPI, the resolution aims to simplify procedures for both the user and the office and expands the potential of these agreements. In addition to unifying and standardising the procedures for all PPHs, it will also remove the requirement that INPI publish a resolution for each cooperation agreement signed, making the process faster and less complicated.

The main change is the elimination of the technological field limitations in previous PPH programmes (ie, patent applications of any technical field). Any International Patent Classification (IPC) may benefit from the unified PPH programme from now on.

This unified PPH programme can receive up to 400 participation requests per year (limited to up to 100 requests in the same IPC section) and one patent application per applicant may be submitted per month only.

In order to be eligible for the unified PPH programme, a patent application must meet the following requirements:

- it must have been filed for at least 18 months or have its early publication requested, or – in case of international applications – have been published by WIPO;
- the examination fee must have been paid;
- it must not have fast-track prosecution granted and published by INPI;
- substantive examination cannot have commenced;
- it must not have been voluntarily divided or amended by the applicant between the request and the decision of fast-track prosecution;
- it must belong to a patent family wherein at least the earliest application has been filed at the INPI or at the Office of Earlier Examination, acting as national or regional office, or as receiving office under the Patent Cooperation Treaty;
- it must belong to a patent family wherein the Office of Earlier Examination has examined the application, found that there is patentable subject matter and issued an allowance or granting decision; and
- it must claim a subject matter that is equal to, or more restrictive than, the one considered as patentable by the Office of Earlier Examination for the application of the same family. The addition of any subject matter not examined by this office is forbidden.

Patent offices from Chile, Argentina, Colombia, Ecuador, Paraguay, Peru, Uruguay, Costa Rica and Denmark have already signed cooperation agreements with INPI in light of the new resolution, and more countries are set to sign in the next few weeks.

Comment

The PPH pilot project has proved to be effective. According to INPI, the average timeframe between participation request and first examination time related to applications submitted to PPH in Brazil was 190 days and 265 days for a final decision.

It is believed that this new resolution will increase adherence to the programme, mainly due to the higher coverage (without limitations of technical fields), thus further helping to reduce the patent backlog.