

Scope of Patent Protection (Brazil)

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Practice notes | [Law stated as of 01-Apr-2023](#) | Brazil

A Practice Note addressing the scope of protection provided by a Brazilian patent. This Note includes information on the legal analytical framework for determining if a Brazilian patent covers potentially infringing products or processes. It also addresses patent claim construction and infringement, including infringement under the doctrine of equivalents.

A patent's value is directly related to the scope of protection it provides to its owner, the patentee, and its licensees. This scope of protection is based on the subject matter a patent's claims cover, which is the basis for certain exclusive rights the patent provides.

Since patents have territorial limits, patentees seeking to maximize the value of their patent portfolio must develop and implement a global patent strategy covering important jurisdictions that are key to their business. Each jurisdiction has its own set of statutes, patent rules, and case decisions so despite global efforts to harmonize patent laws, patent counsel must still understand the important differences among the patent laws in many jurisdictions around the world. This can be a challenging task for patent counsel when developing and managing a global patent portfolio as well as conducting freedom-to-operate (FTO) studies and evaluating third-party patent infringement risk.

This Note discusses important considerations for determining the scope of protection provided by a Brazilian patent by addressing claim construction and infringement, including infringement under the doctrine of equivalents.

Scope of Patent Protection

The right to patent protection in Brazil is guaranteed by the Brazilian Federal Constitution, and regulated by [Law No. 9279/96](#) (known as the Brazilian IP Law). The scope of patent protection is determined by the content of the claims (Article 41, Law No. 9279/96), which should be read with the content of the specification and the drawings.

Several guidelines and resolutions are currently in force to harmonize application drafting and prosecution. These documents clarify unique aspects of Brazilian practice, and failure to comply with them can jeopardize the scope of patent protection.

Although a patentee can pursue a criminal action for patent infringement, in Brazil most infringement lawsuits are directed to a civil court because criminal penalties:

- Are very weak.
- Are addressed to the individual instead of the company.
- Typically have no economic effect on the infringer.

Therefore, criminal lawsuits are rare and not as effective as civil actions, which are the most common and efficient mechanism to stop patent infringement in Brazil. Patent infringement actions mostly combine claims for damages and cessation of use, and a preliminary injunction request (see [Infringement](#)).

Claim Scope

Although Brazilian practice, like in most countries in the world, does not allow the inclusion of any new subject matter in a patent application once it is filed, local practice related to changing and increasing the scope of the claimed subject matter is quite specific.

The Brazilian Patent and Trademark Office, the [National Institute of Industrial Property](#) (*Instituto Nacional da Propriedade Industrial*) (INPI) has a restrictive interpretation of amendments that affect the scope of protection, especially amendments made after the examination request. The applicant may make amendments to better clarify or define the patent application until the examination is requested, provided they are limited to the matter initially disclosed in the application (Article 32, Law No. 9279/96).

In 2013, the INPI issued [Rule No. 093/2013](#) establishing guidelines on the applicability of Article 32, allowing changes to the patent application even after the examination request, provided that these changes restrict the scope of the invention and do not extend it. Although Rule No. 093/2013 was challenged by the Federal Public Prosecutors Office before the Rio de Janeiro Federal Court on the grounds that it would violate the wording of Article 32 of Law No. 9279/96, the judge ruled that the Article is not absolute, and allows specific amendments in the patent application after it has been filed, mainly because the INPI is the regulatory agency with the designated jurisdiction to rule, supervise, and foster the subject matter based on the Federal Constitution.

Therefore, the current understanding in Brazil is that amendments to the set of claims are possible after the examination request of a pending patent application in the INPI, if requested by the examiner or by the patentee themselves, as long as they:

- Are exclusively aimed at restricting the subject matter claimed.
- Do not add any new subject matter with respect to what was initially claimed.

This interpretation also affects any future divisional application.

Non-compliance with Article 32 is a common reason for rejections or loss of scope of protection in Brazil. Regarding possible amendments to the claim set, see [Prosecution History](#).

Patent Infringement

Law No. 9279/96 establishes that the scope of patent protection is defined by the set of claims, based on the disclosure of the specification and drawings as originally filed. Therefore, patentees can restrain unauthorized third parties from economically exploiting the patented product or process based on the set of claims, under penalty of compensation for moral and material damages for the time that the infringement took place.

To better protect a claimed invention, it is important that the set of claims, which the scope of protection relies on, is constructed to prevent free riders from using the claimed invention. If the wording of the set of claims is too narrow or too broad, this can directly impact the patent infringement analysis in a specific case. Also, due to the doctrine of collateral estoppel, any subject matter which has been withdrawn by the patentee during the administrative proceeding cannot be later claimed as part of the invention and, consequently, as being infringed by a third party (see also [Prosecution History](#)).

In Brazil there are three main infringement possibilities:

- **Literal infringement** where:
 - one or more of the claims is literally reproduced in the infringing product; and
 - the infringing party does not present any variant to distinguish its product or process from the claimed invention.

(See [Literal Infringement](#).)

- **Equivalent infringement**, which is a more common type of patent infringement in Brazil where the infringing party includes minor differences in the infringing product or process that do not alter the essential constituent means of the claimed invention (see [Doctrine of Equivalents](#)).
- **Contributory infringement** where anyone who assists in counterfeiting, whether by supplying or simply offering to supply a constituent element of a claimed invention, may be:
 - considered an infringing party; and
 - liable in a civil proceeding or penalized for the crime of counterfeiting, when these practices are not authorized by the patentee.

(See [Contributory Infringement](#).)

Claim Construction

In addition to patentability requirements under the Brazilian IP Law:

- The claims of an application must be:
 - clear, precise, and sufficiently disclosed in the specification (see [Claims](#)); and
 - based on the specification, characterizing the particularities of the invention, and clearly and precisely defining the subject matter to be protected (see [Specification](#)) (Article 25, Law No. 9279/96).
- The specification must clearly and sufficiently describe the subject matter to enable a person skilled in the art to carry it out, and indicate, when applicable, the best way of executing the claimed invention (Article 24, Law No. 9279/96) (see [Specification](#)).
- Although claims can be amended during prosecution, they may not be amended to broaden the scope of protection beyond the scope of the claims for which the applicant requested examination (see [Prosecution History](#)).

In the case of biological material essential for the practical execution of the object of the claimed invention, which cannot be described as typically required by Article 24, and which is not accessible to the public, the specification must be supplemented by a deposit of the essential material in an institution authorized by the INPI or indicated in an international agreement (Article 24, sole paragraph, Law No. 9279/96).

Although not included in the explicit language of Article 24, if the subject matter of a patent application includes one or more nucleotide or amino acid sequences, which are fundamental for the description of the invention, a sequence listing must be submitted for compliance with the sufficiency of disclosure requirement of that article.

Claims

An invention is typically composed of features that are already known and new features. To facilitate the understanding of the invention, an independent claim must be drafted containing:

- An initial portion, which should correspond to the title, or part of the title, of the claim category.
- When necessary, a preamble containing the features already encompassed by the state of the art.
- The words "characterized by", followed by a characterizing portion, containing the specific features of the invention that are new and inventive.

Known and new elements must be separated to facilitate the distinction between them. However, this does not change the scope of the claim, which will always be determined based on the features contained in the preamble, which may be part of the prior art, and the characterizing portion, which contains the potentially patentable aspects of the invention.

The only exception to this format is a process claim, where the transposition of the already-known steps to the preamble of the claim impairs the sequence and logic of the claimed process. In these cases, the "characterized by" expression should be used before the entire sequence of steps.

Every claim must be drafted based on the technical features of the invention. Non-technical aspects, such as the advantages of the claimed object, should not be included in the claims.

In addition to these basic rules of claim construction, different claim types may deserve special attention, for example:

- Independent claims (see [Independent Claims](#)).
- Dependent claims (see [Dependent Claims](#)).
- Means-plus-function claims (see [Means-Plus-Function Claims](#)).
- Product-by-process claims (see [Product-By-Process Claims](#)).
- Claims covering life-sciences or chemical inventions (see [Claims Covering Life-Sciences or Chemical Inventions](#)).
- Claims for computer-implemented inventions (see [Claims for Computer-Implemented Inventions](#)).

Independent Claims

Independent claims define the essential and specific technical features of the invention as a whole.

A single patent application may comprise more than one claim category, such as a system and a process, provided they are linked by one single inventive concept. To highlight the link, it might be necessary to draft the additional claim categories explicitly interconnected with the first claimed category, by using the expression "as defined in claim (...)." For example, if

the claim set comprises claims related to the process of obtaining a composition, the process claims should be interconnected to the composition claims with the following language:

"Process for obtaining a composition, as defined in claim 1, characterized by the following steps (...)."

The presence of more than one independent claim of the same category is usually only accepted when these claims define different sets of essential features within the same inventive concept.

Dependent Claims

Dependent claims include all the features of other previous claims the dependent claim refers to and define details of those features or additional features that are not considered essential features of the invention. Every dependent claim must contain an indication of its dependency relationship and the "characterized by" wording.

Dependent claims must not exceed the limitations of the features of the claims to which they refer.

Means-Plus-Function Claims

A means-plus-function claim must be supported by a patent specification containing at least one embodiment which presents the structural elements used to achieve the function the means-plus-function claim recites. In Brazil, means-plus-function claims are narrowly construed to cover only the specific means or embodiment for achieving the function described in the specification.

Product-by-Process Claims

Product claims defined in terms of a manufacturing process are allowed only if the product cannot be described otherwise. A product is not considered new simply because it is produced using a new process. This means that in assessing novelty, a claim of product X obtained by a process lacks novelty if the prior art discloses the same product X, regardless of the process by which it was obtained. Similarly, for infringement, the scope of a product-by-process claim is limited to the product and not limited in any way to the process for making the product.

Claims Covering Life-Sciences or Chemical Inventions

Claims covering life-sciences or chemical inventions raise unique issues and may require specific language or information to be considered sufficiently disclosed and supported in the specification. Therefore, special attention is required for claims:

- Seeking to cover:
 - methods of treatment (see [Method of Treatment Claims](#)); and
 - certain cell lines (see [Composition of Matter Claims for Biotechnology Inventions](#)).
- Directed to chemical polymorphs (see [Composition of Matter Claims for Chemical Inventions](#))

Method of Treatment Claims

According to Brazilian practice, therapeutic, surgical, and diagnostic methods applied to the human or animal body are not considered to be inventions and therefore are not patentable. In addition, use claims such as, "Use of a compound X characterized

by it being used to treat a disease Y" are also considered method of treatment claims and are therefore not patentable in Brazil. These claims are not Swiss-type claims.

Until 2018, the only accepted format in Brazil for claims seeking to cover a method of treatment was the Swiss-type claim format ("Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z"). Although this is still the most acceptable format, certain composition or compound for use claims may also be accepted if the composition or compound is quantitatively and qualitatively described. The novelty and inventive step of these claims are assessed based on their quantitative and qualitative definition, not use.

Therefore, for cases where the invention is related solely to the new medical use of a known product, claims must be drafted in the Swiss-type format. However, features related to the therapeutic scheme, dosages, and group of patients are not accepted even if the claim is in the Swiss-type format.

When seeking to obtain protection for a new medical use, in vivo test information proving the claimed use must be provided in the specification so that the use is considered sufficiently disclosed (see [Specification](#)).

Composition of Matter Claims for Biotechnology Inventions

As in other jurisdictions, applications regarding biotechnology inventions may be prohibited. In particular, the whole or part of natural living beings and biological materials found in nature, or even isolated from it, including the genome or germplasm of any natural living being and natural biological processes are not considered to be an invention and are not patentable (Article 10(IX), Law No. 9279/96). However, transgenic microorganisms that meet the three patentability requirements of novelty, inventive step, and utility and that are not mere discoveries are not patentable (Article 18(III), Law No. 9279/96). Law No. 9279/96 defines transgenic microorganisms in the sole paragraph of Article 18(III), as "organisms, other than the whole or part of plants or animals, that express, through direct human intervention in their genetic composition, a feature normally not achievable by the species under natural conditions."

Accordingly, claims regarding cells must be restricted to transgenic microorganisms' cells. This restriction may be added during prosecution of the pending patent application.

Composition of Matter Claims for Chemical Inventions

Claims regarding a polymorphic crystalline of a chemical compound are considered properly defined when they provide physicochemical parameters, typically more than one, that define the polymorph structure (see [Polymorphic Crystalline Chemical Composition of Matter Claims](#)).

Claims for Computer-Implemented Inventions

Computer software per se is not considered to be an invention and therefore is not patentable in Brazil (Article 10(V), Law No. 9279/96). However, according to the [Guidelines for Examining Patent Applications Involving Computer-Implemented Inventions](#) (Ordinance/BPTO/PR 411) (in Portuguese), a support claim to execute a patentable method is acceptable. Examples of acceptable support claims include recording media, memory, signal, wave, carrier, and computer-readable non-transitory media.

Therefore, the preambles of claims regarding computer software must be drafted as follows:

"Computer-readable memory characterized by comprising instructions stored thereon which, when executed, perform/carry out the steps of the method (...)."

Specification

Claims must be sufficiently disclosed and supported by the specification, which means that the specification must always:

- Describe the invention in a sufficiently clear and precise manner, so that it can be reproduced by a person skilled in the art. This enablement requirement means that the specification must allow a person skilled in the art to make the invention without undue experimentation, based solely on the specification, which should detail the object of the invention. A person skilled in the art:
 - is someone, or in some situations a group of people, with average technical and scientific skill in the field at the time the application is filed, or someone with operational practical knowledge of the subject matter; and
 - should have access to the means and the ability to perform routine work and the usual experimentation in the technical field.
- Be the basis for the subject matter of each claim. The scope of the claims cannot be broader than the content of the specification and drawings, if any.

Moreover, when the application contains drawings and they are considered necessary for the understanding of the subject matter, the claims must include the reference signs in the patent drawings related to the technical features of the claim.

There should be no inconsistency between the specification and the set of claims, as this raises doubts as to the extent of protection sought and makes the set of claims unclear or not supported by the specification. If a certain feature is described in the specification as an essential feature of the invention, that feature must be included in the wording of the corresponding independent claim.

If a broad claim is considered not supported by the specification, the burden of demonstrating otherwise lies with the applicant. Additional evidence can be submitted during technical examination, provided that it is exclusively intended to complement the information already contained in the application as initially filed.

Particular attention should be placed on the relationship between the content of the specification and certain claims, for example:

- Medical use claims (see [New Medical Use Claims](#)).
- Markush-type claims (see [Claims Including Markush Groups](#)).
- Polymorphic Crystalline Chemical Composition of Matter Claims (see [Polymorphic Crystalline Chemical Composition of Matter Claims](#)).

New Medical Use Claims

For new medical use claims, the specification as initially filed must contain evidence proving the new use. If no evidence is provided, the claimed subject matter lacks support and sufficiency. In vivo test results are required to show evidence of the new

therapeutic use, since it is not always possible to extrapolate the results of in vitro tests for an actual therapeutic application. In the case of studies performed in animals, the models adopted should be extrapolated for the humans or animals to be treated.

Claims Including Markush Groups

Markush-type claims, which commonly refer to claims reciting a list of alternative members of a claimed group of compounds, the processes for obtaining the claimed compounds, described in the specification, should enable the preparation of all the claimed compounds. In other words, either:

- The examples must be representative of all classes of the claimed compounds in the Markush group.
- All classes of the claimed compounds in the Markush group must be sufficiently described in the specification.

When an application seeks protection for a new use of several compounds identified in a Markush group, the compounds and their uses that have been effectively demonstrated in the specification will be considered sufficiently described.

Polymorphic Crystalline Chemical Composition of Matter Claims

A claimed polymorphic crystalline form is only considered sufficiently disclosed if the specification, as originally filed, contains the identification data obtained by solid physicochemical characterization techniques. The monocrystal X-ray Diffraction (XRD) technique is considered sufficient for perfect characterization of the crystalline structure of a solid. However, when this characterization is not provided, the powder XRD technique should be used, associated with other methods of physicochemical identification of solids. (See [Guidelines for Examination of Patent Applications: Aspects Related to the Examination of Patent Applications in the Chemistry Field](#) (in Portuguese).)

It is important to note that the submission of characterization data of the claimed solid after the patent application is filed is considered to be an addition of subject matter, and therefore not accepted.

Process parameters to obtain crystalline form must also be defined in the specification, to guarantee its reproducibility by a person skilled in the art. Otherwise, the claims will be considered not sufficiently disclosed.

Prosecution History

A patent application may be amended until the end of the examination procedure, including during the appeal phase, so amendments are permitted until there is an allowance, final rejection, or final abandonment decision. However, the date of the examination request:

- Is an important landmark for a patent application in terms of scope of protection.
- Can define the success or failure of the prosecution before the INPI, depending on the strategy adopted to draft the claims at this point.

After examination is requested, it is not possible to broaden the scope of protection, nor include new claim categories not presented in the set of claims at the time of the examination request, even if disclosed in the specification as originally filed. Therefore, before filing an examination request, applicants may modify the patent application by adding or cancelling claims, adjusting claim categories, adding or removing features, and rewriting entire claims, provided that these amendments are limited to the subject matter initially disclosed in the application. Some examples of acceptable amendments only before examination include:

- Removing features from the claims.
- Changing the category of a claim.
- Adding new independent claims.

Nevertheless, once examination is requested, the scenario changes. The claims can still be amended (voluntarily or in response to technical opinions), provided the amendments exclusively narrow the subject matter and do not change the claimed object. For instance, after the examination request, the applicant may:

- Insert information from a dependent claim into an independent one.
- Restrict claimed ranges and alternatives.
- Remove features, words, or phrases to overcome a lack of clarity.

If the amendments broaden or change the scope of protection, the set of claims is entirely rejected by the INPI, even if the amendment affects only one or a few claims.

The date of the examination request is also important because the subject matter of any future divisional application must be limited to the claim set for which the examination of the original application was requested. Therefore, it is not possible to try to increase or change the claimed scope after the examination request by filing a divisional application.

Infringement is determined by the claim language so that, generally, arguments made during prosecution do not limit claim scope unless the argument is incorporated into the claim language itself. For example, if a patent applicant withdraws a specific element from the claim language during the prosecution in order to restrict their claims to avoid the prior art, the same applicant, upon becoming the holder of the patent, cannot claim infringement by equivalence for the use, by a third party, of the element that was withdrawn.

Infringement

To assert a claim for patent infringement, the patentee must file a lawsuit before one of the Brazilian state courts. The INPI does not participate in these proceedings. The São Paulo and Rio de Janeiro state courts have chambers and judges specialized in intellectual property (IP) matters. Other Brazilian state courts do not have this specialization, which directly impacts the quality and accuracy of the final decision on the merits. Brazilian court decisions are rendered after the production of technical evidence and are guided by unbiased court experts (see [Proof of Infringement](#)).

To prove infringement, the patentee must make a direct comparison between the claimed invention and the infringing technology to demonstrate that the allegedly infringing product or process:

- Conflicts with at least one of the independent patent claims.
- Includes all the claim elements.

In civil law, a preliminary injunction can be requested and granted at any time, even before the alleged infringer becomes aware of the action (*ex parte*). The judge may grant an injunction to stop the infringement, to avoid irreparable damages to the patentee (Article 209, § 1, Law No. 9279/96).

To obtain a preliminary injunction in Brazil, the patentee must comply with certain requirements, such as:

- Providing clear and convincing evidence of the claimed rights and of the infringement to demonstrate a likelihood of success on the merits.
- Attesting the risk of irreparable harm.

(Section 300, Civil Procedure Code (*Código de Processo Civil*), Law No. 13105/2015))

However, generally in patent infringement cases, judges do not rely exclusively upon unilateral reports from the patentee, so obtaining an ex parte injunction is not easy, since issues concerning an injunction are highly complex and requires an in-depth analysis of technical issues. Permanent injunctions are only obtained on a final decision on the merits.

Therefore, temporary relief should be grounded on solid and irrefutable evidence that demonstrates a prima facie case of infringement. Although this evidence varies on a case-by-case basis, the patentee must submit to the court the letter patent that is allegedly being infringed. Although this is not sufficient to fulfill the requirement of likelihood of success on the merits, it is considered to be a partial demonstration, since it corroborates the ownership and the patent's presumption of validity.

It is also advisable that the patentee submits evidence that indicates signs of the infringement, such as:

- Cease-and-desist letters sent, and any response from the counterparty.
- Any prior licenses with the alleged infringer, regarding the specific patented technology which is being enforced in the court.
- A direct comparison that shows the reproduction of the patent set of claims (or just one independent claim) in the alleged infringing product or process.

Direct infringement (also called literal infringement) occurs when each element of the infringing product is set forth in at least one independent claim (see [Literal Infringement](#)). It may be necessary to interpret the meaning or scope of a particular term in the claim, such as by reference to the prosecution history, dictionaries, treatises, and the prior art (see [Claim Construction](#)). However, once the term has been interpreted and the meaning clarified, the correspondence of each element to the terms in at least one independent claim should be immediate to assess a literal infringement.

Other types of non-literal infringements are by:

- Equivalence (see [Doctrine of Equivalents](#)).
- Contribution.

The patentee should evaluate the type of infringement necessary to enjoin an infringer and consider necessary claim language to:

- Avoid an unfair loss of protection due to inadequate wording of a patent's claims.
- Prevent unauthorized third parties from improperly benefiting from the patentee's innovation.

Literal Infringement

The scope of the protection conferred by the patent is determined by the claim language as interpreted based on the specification and drawings (Article 41, Law No. 9279/96).

In addition, the patent confers on its titleholder the right to prevent a third party from producing, using, offering for sale, selling, or importing, without the titleholder's consent:

- A product that is covered by the patent claims.
- A process or a product directly obtained by a patented process.

(Article 42, Law No. 9279/96.)

Patent infringement occurs when an unauthorized party either:

- Manufactures a product that is covered by the claims.
- Uses a means or process that is covered by the claims.

Therefore, Brazil is in harmony with global practice in considering that the scope of protection sought through a patent is defined by its claims, that is, it is the text of the claims that determines the limits of the rights guaranteed by the patent. As a result, although the scope of protection is not limited to a literal interpretation of the claims, a patent does not grant protection to a patent's basic inventive concept or general inventive concept. Instead, for there to be literal infringement, the infringing product or process must replicate exactly the same characteristics defined in the claims of a particular patent.

The independent claim defines the essential features of the invention, while the dependent claims define the non-essential or optional features. The dependent claims help in the interpretation of the independent claims, to which they are all subordinated (see [Claims](#)).

Doctrine of Equivalents

For infringement to be found, at least one of the independent claims contained in a patent must be reproduced in the infringing product or process. To provide more effective protection to the patentee, it is essential to interpret this in a way that is not only literal and formal, but also that analyzes each of the elements that constitute the set of claims.

Limiting patent protection to a literal interpretation of the claims would:

- Deprive the patentee of obtaining full and effective protection and, consequently, deprive them of obtaining all the benefits arising from their invention.
- Allow free riders to simply change one element for another that performs the same function as the one claimed, to exclude the possibility of infringement, even if the counterfeit product or process exercises the same functionalities as the patented one.

To provide a balance between freedom of competition, and the rights assured by Law No. 9279/96 to patentees, in Brazil there may be patent infringement even if the violation does not affect all the patent claims or if it is based on the use of means equivalent to the patent's claimed subject matter (section 186, Law No. 9279/96).

Therefore, when assessing patent infringement in a specific case, it is common that parties and the court expert who will guide the production of technical evidence, analyze infringement under the doctrine of equivalents and make use of the triple identity test. This means that there is infringement by equivalence if the following are present when comparing the claimed invention to the allegedly infringing product:

- Substantial identity of function.
- Substantial identity of the means used to reach that function.
- Identity of result between the elements in comparison.

However, it is important to consider that elements that were already included in the prior art at the time of the patent application, or that are obvious variations of the state of the art are outside the scope of patent protection and, therefore, cannot be indicators of infringement by equivalence. For this reason, alleged infringers usually use this argument as a defense strategy in patent infringement actions where the infringement by equivalence is considered. It is the role of the court's expert to demonstrate, if applicable, that this specific element is not included in the set of claims, either because it was already in the prior art or because it is an obvious variation of it.

Therefore, the finding of equivalence must be analyzed based on:

- The context of the patent.
- The changes made during patent prosecution.
- The state of the art.
- The peculiarities of each specific case.

Contributory Infringement

The concept of contributory infringement can be found in Law No. 9279/96, which provides that the patent holder has the right to prevent third parties from contributing to causing others to do the acts referred to in Article 42. Therefore, anyone that provides a component of a patented product, or material, or equipment to carry out a patented process, if the end use of the component, material, or equipment necessarily leads to the exploitation of the claimed invention, is liable for infringement under this law (Article 185, Law No. 9279/96).

For this type of infringement to be verified in a process patent, an agent must provide material or equipment to a third party (in this case, the direct infringer), in advance, which is necessary for the exploitation of the claimed invention. However, the material or equipment supplied must be specific to the infringement, not in standard or general use in the market.

There is no concept of inducement of infringement in Brazilian IP legislation or case law.

Proof of Infringement

The technical assessments of the court expert to attest the infringement of a patent are the most important steps of the proceeding.

Although the burden of proof lies with the patentee, except when enforcing process patents, judges will trust the technical debate to an unbiased expert appointed by the court who is able to analyze the subject matter, to assess whether there is an infringement.

To ensure that a well-grounded technical report is produced, the unbiased expert appointed must be a skilled person in the patent's technology field and must have knowledge of industrial property. Additional experience in judicial discussions is also important. A combination of knowledge in theory and practice enables a fair trial, since most judges will tend to follow the technical report's conclusion, because they do not have enough technical background to assess the technology involved.

Each state court displays on its website a roster of hundreds of experts skilled in a wide variety of areas, who can produce technical evidence in lawsuits. This list is publicly accessible, and can be accessed by parties and non-parties at any time. Whenever technical evidence must be produced in a specific lawsuit, the judge will consult this list to identify the most suitable expert for the subject that is being discussed in the case.

Therefore, when the judge appoints a particular expert, parties can either agree or disagree with the nomination. Usually, skilled attorneys in the area will carry out an in-depth analysis of the appointed expert's qualifications and experience to assess if they have enough technical and scientific experience to properly conduct the evidence phase.

If one of the parties, or both, consider that the expert does not meet the requirements for the technical discussion on the patent, it is possible to challenge the nomination with the court. If this challenge is unsuccessful, it is possible to file an interlocutory appeal, directing the discussion to the court of second instance.

Once the expert's appointment is confirmed by the trial court, the parties can appoint their own technical assistants, and submit queries to the expert, who will guide their assessments and conclusion.

The expert technical report is a combination of:

- An overview of the technology involved.
- Answers to the queries of the parties.
- A conclusion assessment.

Normally, specialized judges submit their own queries to the expert to contribute to the final discussion.

After the expert's technical report is submitted to the court, the parties can submit their considerations, agreeing or disagreeing with the expert's conclusions. The parties can point out potential inconsistencies, requesting clarifications or scheduling a trial court hearing.

The parties can mutually choose the expert who will conduct the evidence phase, to avoid, or reduce, the likelihood of appointment of an expert without enough technical background (section 471, Civil Procedure Code).

This provision is considered an important advantage of the Brazilian system, since it makes the procedure cheaper (parties can avoid spending several months challenging the expert's nomination, for instance) and is based on the principle of self-determination interest.

Nevertheless, depending on the complexity of the case, it is also possible for the judge to indicate more than one expert to conduct the evidence phase (section 475, Civil Procedure Code), when discussion of the patent involves more than one area of expertise, such as pharmaceutical, telecommunications, and software.

This measure tends to increase the costs of the evidence phase, as generally the plaintiff must bear the experts' fees. However, depending on the importance of the case, and the difficulty of finding a single expert skilled in the patent's fields, who also has knowledge in IP matters, a combination of experts tends to be the best course of action.

Practical Considerations

Patent Portfolio Considerations

It is necessary to consider the following aspects when drafting an application to be filed in Brazil:

- Subject matter excluded from protection.
- Appropriate claim format.
- Information required to be disclosed in the specification, so that the claims are sufficiently disclosed and supported.

It is advisable to draft the claim set as broadly as possible and include claims regarding all categories that might be related to the invention, since it is not possible to increase or change the claimed scope after the examination is requested. This includes a prohibition on including new claim categories in the claim set, even if the category is duly disclosed in the specification.

In practice, the applicant may request examination for a claim set comprising broadened independent claims and more limited dependent claims, and then restrict the claim set during the prosecution, for clarity and precision, as well as the novelty and inventive step requirements.

Brazilian practice is being constantly updated, with the publication of new resolutions and guidelines in technical fields where technology has been changing very fast, such as telecommunications and biotechnology. It may therefore be advisable to contact a local professional, who should be aware of any recent or expected changes in local practice.

Minimizing Patent Infringement Risks

The most appropriate strategy to minimize the risks of infringing a patent is to perform an FTO analysis before starting any activity related to a certain product or process. Since the protection granted by a patent is territorial, it is advisable to perform this analysis in each country of interest, preferably using professionals who are familiar with local practice and are therefore better able to determine the limits of protection.

In Brazil, the FTO analysis is based on the results obtained from a clearance search performed in the [INPI database](#). Both granted patents and patent applications, which could interfere in the free commercial exploitation of the product or process in Brazil, are considered.

Based on the FTO result, it is possible to diagnose the free commercialization of a proposed product or process in Brazil, ensuring that the commercial production, distribution, importation, marketing, and use of them does not infringe the existing IP rights of other parties. The FTO analysis may be able to provide a roadmap that can help avoid these risks, allowing the company to:

- Make decisions on the exploitation of its product or process in Brazil without infringing on the IP rights of third parties.
- Define marketing and commercial strategies based on existing IP opportunities, for example, expiring patents, limited scope of claims, and limited territorial coverage.

Therefore, an FTO analysis is a useful tool to monitor the marketplace and competitors and minimize patent infringement risks. The results can guide the company not only to protect its assets, but also avoid lawsuits and claims for material and moral damages for the period the allegedly infringing practices occurred.

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