

# Important changes on the Brazilian Patent Office's appeal instance

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**Brazil** | February 28 2024

On February 27<sup>th</sup>, 2024, the Brazilian PTO published Attorney's-General Opinion no. 00003/2024, with normative effect, concerning changes in the patent examination during the appeal instance. Said opinion was published along with some relevant clarifications, which are summarized below:

1. The Board of Appeals is responsible for analyzing the amendments proposed in the appeal and decide if they can be accepted. In general terms, amendments cannot contain a new scope which was not discussed during the first instance examination.
2. Specifically, regarding the amendments to be made in the rejected set of claims through an appeal, the applicant is allowed to make restrictive amendments intended to overcome the objections pointed out during first instance examination, provided that the following conditions are fulfilled:
  - Amendments to the claims must necessarily have a causal link with the rejection decision. Amendments which are not connected to the grounds of rejection will not be accepted.
  - Amendments must be logical restrictive limitations of the rejected set of claims. Therefore, subject matter deleted in the first instance cannot be reinserted in the claims during the appeal instance.
  - Claim restrictions must be expressly predicted in dependent claims or must be derived from the combination of independent/interconnected claims. Therefore, limitations based on the specification which are not present in the rejected set of claims will no longer be accepted.
  - Changes in the nature of the application will not be allowed if they have not been discussed in the first instance examination. In other words, a patent of invention application cannot become a utility model application during appeal procedures if this issue has not been raised in the first instance.
3. Additional data or documents can be submitted in the appeal instance if they intend to substantiate arguments related to the inventive step requirement.

These measures represent BPTO's attempt to reduce the backlog of more than 7,000 appeals pending in the appeal instance.

Since the above rules will be applied retroactively, the BPTO will accept the submission of petitions to amend the already-filed appeals until **April 2<sup>nd</sup>, 2024.**

Due to possible legal uncertainties, the implementation of such new ordinances may be subject to discussions before the Courts.

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