

# Updates on the changes in the Brazilian Patent and Trademark Office's appeal instance

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On March 19, 2024, the Brazilian PTO published Ordinance n° 10, which establishes new Guidelines for Appeals and Administrative Nullity Requests. Said Guidelines contain Transitional Dispositions that clarify the applicability of the new rules regarding amendments to the set of claims during the 2<sup>nd</sup> instance for patent applications in which appeals have already been filed.

In this regard, the Guidelines state that appeals that have been submitted before April 1<sup>st</sup>, 2024, and which do not comply with said Guidelines, will have another chance to amend the claims through a response to an Office Action that will be published in the appeal instance.

The Guidelines further clarify the situation of patent applications pending in the 1<sup>st</sup> instance of examination by establishing that an appeal arising from a patent application whose first Office Action is published by April 1<sup>st</sup>, 2024, may be admitted. In this situation, an Office Action may be published by the Board of Appeals and responded to by justifying and proving the technical impossibility of adapting the claims to the Guidelines. In other words, the set of claims of applications with a pending Office Action issued by April 1<sup>st</sup>, 2024, can also be amended in the event that the application is rejected and sent to the 2<sup>nd</sup> instance of examination.

It is important to recall the conditions that should be fulfilled when amending the set of claims during the appeal phase from April 2, 2024:

1. 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.
2. Amendments must be logical restrictive limitations of the rejected set of claims. Therefore, the subject matter deleted in the first instance cannot be reinserted into the claims during the appeal instance.
3. 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 that are not present in the rejected set of claims will no longer be accepted.
4. 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.

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