

Brazil-USA PPH Program Pilot, For Oil, Gas and Petrochemical Industries

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As informed in our newsletter 11/15 # 14 the Patent Offices of Brazil and the United States of America instituted a joint PPH pilot program. The details of the program have now been regulated by Resolution 154/2015 of the President of the Brazilian Patent Office, issued on 21 December 2015. A translation into English language of this regulatory instrument is attached here to.

The resolution confirms the scope of the program and defines the conditions to be met for acceptance of an application, as well as the documents that must be enclosed with the request form.

The Brazilian Patent Office has limited the number of applications that will be accepted to 150 and their subject matter is restricted to oil and gas technologies — actually Annex 1 of the Resolution defines a closed list of classes of the International Patent Classification to which an application must belong. This list is repeated below for your ready reference:

1. B01 - Physical or Chemical Processes or Apparatus in General;
2. B63 - Ships or other waterborne vessels; related equipment;
3. C09K8 - Compositions for drilling of boreholes or wells; Compositions for treating boreholes or wells, e.g. for completion or for remedial operations;
4. C10 - Petroleum, gas or coke industries; fuels; lubricants; peat;
5. E02 - Hydraulic engineering; foundations; soil-shifting;
6. E21 - Earth or rock drilling; mining;
7. F15 - Fluid-pressure actuators; hydraulics or pneumatics in general;
8. F16 - Engineering elements or units; general measures for producing and maintaining effective functioning of machines or installations;
9. F17 - Storing or distributing gases or liquids;
10. G01 - Measuring; Testing.

Further to the above, the conditions to be met are several. Most can be found in Article 7 of the resolution. Importantly, the application must:

- have been filed in Brazil on or after 01 January 2013;
- be an application for a patent of invention (utility model patents are excluded);
- have been published in the Brazilian Industrial Property Official Gazette;
- have had its examination requested and all previous annuities paid;
- have been allowed by the USPTO.

A specific request form has been created for applying to the program. The documents that must accompany it and the statements that must be submitted by the applicant are defined in articles 12 and 13. Documents originally in Portuguese, English or Spanish will not need to be translated. A simple translation will be accepted for documents originally in other languages.

A working group has been created to assess each candidate application's compliance with all the acceptance criteria. The decisions of this working group are not appealable and will be published in the Brazilian Industrial Property Official Gazette.

Should you be interested in more details, have specific doubts or immediately applying for the program, please let us know. We will be delighted to assist you.

For more detailed information on this matter, please contact us via e-mail through mail@kasznarleonardos.com.

	FEDERAL PUBLIC SERVICE MINISTRY OF DEVELOPMENT, INDUSTRY AND FOREIGN TRADE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY
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PRESIDENCY

December 21, 2015

RESOLUTION

No. 154/2015

Subject: Establishes the administrative proceedings of the Pilot Program for Patent Prosecution Highway – PPH Shared Priority Examination.

THE PRESIDENT OF THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY – INPI and the PATENT DIRECTOR, within the scope of their regimental assignments, and in view of the provisions of Law No. 9,279, dated May 14, 1996, Industrial Property Law – LPI, and of Articles 159 (IV) and 106 of Bylaws of the INPI, annexed to Decree No. 149 of the Ministry of Development, Industry and Foreign Trade – MDIC, of May 15, 2013, and

Considering the Joint Declaration made between the Governments of Brazil and United States of America concerning the Sharing of Examination of Patents between the Offices, signed in Washington on June 30, 2015;

Considering the Memorandum of Understandings between the INPI and the United States Patent and Trademark Office – USPTO, dated November 19, 2015, and the respective Work Plan agreed upon at the same occasion; and

Considering the principles of the territoriality and independence of the industrial property rights.

DECIDE:

Art. 1st This Resolution establishes the administrative proceedings of the Pilot Program of Patent Prosecution Highway – PPH Shared Examination being agreed between the INPI and the USPTO, henceforth, INPI-USPTO PPH Pilot Program, within the sphere of the INPI.

Art. 2nd For the purposes of the provisions of this Resolution, the following definitions shall be applied:

I - First patent application: patent application filed at the INPI or at the USPTO, without claiming priority, valid as priority document for a second patent application filing at other national patent office or international organization, and capable of originating a patent family; or international filing, within the scope of the Patent Cooperation Treaty – PCT, without claiming priority, wherein the INPI or the USPTO was designated as the receiving office, capable of entering into national phase and originating a patent family;

II - Second patent application: patent application filed at the INPI or at the USPTO and that is part of the patent family of the first patent application; or a patent application that entered into national phase at the INPI or at the USPTO and that is part of the patent family of the first patent application;

III - Patent Family: set of patent applications filed at more than one national patent office or international organization, wherein all of them claim, at least, the earliest priority document;

IV - Office of First Filing – OFF: the patent office where the first patent application is filed;

V - Office of Second Filing – OSF: the patent office where the second patent application is filed;

VI - Office of Earlier Examination – OEE: the national patent office, INPI or USPTO, which first notifies the patent granting decision for an application of a patent family, it being either the OFF or the OSF;

VII - Office of Later Examination – OLE: the national patent office, INPI or USPTO, where the PPH is requested, which prioritizes the prosecution and carries out the examination of a patent application pertaining to the same patent family based on the results of the OEE;

VIII - Valid patent application: patent application which complies with the eligibility conditions as set forth by Art. 7th of this Resolution;

IX - Date of request: date of filing protocol for the petition requesting the shared priority examination at the INPI's headquarter or at the respective regional branches and/or representations in each State of the Federation or by means of electronic form or the date of postage in the hypothesis of remittance by mail;

X - Sufficiently corresponding application: application which subject matter described in the application filed at the OLE neither adds, nor modifies the subject matter regarded as being patentable at the OEE, even considering differences due to translations, both pertaining to the same patent family;

XI - Sufficiently corresponding claim: claim which subject matter claimed at the OLE has the same or more restricted scope than the subject matter regarded as being patentable at the OEE, even considering differences due to translations of the claim; and

XII - More restricted claim scope: the scope of a claim is more restricted when it is limited, under the terms of Art. 32 of the LPI and Resolution INPI PR No. 93, of June 10, 2013.

Art. 3rd To the effects of this Resolution, the following steps take place in the PPH:

I - The applicant files the first patent application, and the national office or the international organization becomes the OFF;

II - The applicant files the second patent application still claiming priority of the first patent application or gives it national phase entry, and the national office becomes the OSF;

III - The national office that notifies the first decision of patent granting, it being either of the first or of the second patent application, becomes the OEE;

IV - The applicant requests the participation in the INPI-USPTO PPH Pilot Program at the other national Office, which becomes the OLE, upon fulfilling the requirements and submitting the results of the first decision of patent granting; and

V - If it is deemed valid, the OLE prioritizes the patent application from the same family in all the subsequent steps, until the final decision.

Sole paragraph. The eventual abandonment of the First Patent Application that served as priority document for international filing within the scope of the PCT does not exclude the participation of the respective national phase entries of the INPI-USPTO PPH Pilot Program.

Art. 4th The applicant of a patent application allowed by the USPTO may request priority in the examination of a patent application pertaining to the same family at the INPI, if it fulfils the requirements set forth by this Resolution.

Art. 5th The INPI-USPTO PPH Pilot Program will be valid for the period of two years for the reception of requests for participation, or the Pilot Program will be extended until all the applications regarded as being valid have been decided.

Art. 6th The INPI will examine up to 150 (one hundred and fifty) applications as an OLE.

§1st The examination that is the object of the *caput* of this article should observe the chronological order of the dates of request for the participation in the INPI-USPTO PPH Pilot Program.

§2nd The applications that can validly participate in the INPI-USPTO PPH Pilot Program, but that exceed the limit set forth by the *caput* of this article will not be included in the Program.

Art. 7th The following are the requirements for the priority examination in the INPI-USPTO PPH Pilot Program:

I - Patent application filed at the INPI as from January 1st, 2013;

II - Application for a Patent of Invention;

III - Patent application published in the Industrial Property Gazette – RPI, under the terms of the provisions of Art. 30 of the LPI, or which had its publication anticipated at the applicant's request, pursuant to the provisions of paragraph 1st of Art. 30 of the LPI, or which has been accepted in the admissibility examination for the national phase entry for the applications filed via PCT;

IV - Patent application having the request for examination presented, pursuant to the provisions of Art. 33 of the LPI;

V - Patent application which examination is not found to be suspended for compliance with an office action previously formulated by the INPI;

VI - Patent application which annuity fees are being regularly paid, in line with the obligations of payment of the annuity fees as set forth by Art. 84 of the LPI;

VII - Patent application that has not had a request for priority examination granted and published in the RPI;

VIII - Patent application that is not subject to judicial proceedings in Brazil;

IX - Patent application that is not a division, except for those resulting from the direct division of the original application and deriving from the allegation of lack of unity of invention made by the OEE in the sufficiently corresponding application;

X - Patent application that has not undergone regular technical examination

duly published in the RPI;

XI - Patent application which claimed subject matter explicitly relates to the oil, gas, and petrochemical industry, and classified within any of the International Patent Classification – IPC's symbols, including its respective lower hierarchical levels of classification, as listed in Appendix I of this Resolution;

XII - Patent application pertaining to a patent family, pursuant to what has been provided in Art. 2nd of this Resolution;

XIII - Patent application which member of the family has been allowed by the USPTO (“notice of allowance”);

XIV - Patent application which family has at least the first patent application filed at the INPI or at the USPTO.

§1st Utility model patent and industrial design applications are excluded from the INPI-USPTO PPH Pilot Program.

§2nd “Plant patent applications”, “re-examination applications”, “re-issue applications” and “industrial design applications” may not be used for requesting the participation in the INPI-USPTO PPH Pilot Program.

Art. 8th The request for admission in the INPI-USPTO PPH Pilot Program, as addressed by this Resolution, will be effected by means of Service Code No. 277, as depicted in the Official Schedule of Charges for the Services Relative to Patents Rendered by the INPI, but it does not exempt the applicant from payment of the other official fees related to the procedural flow of the patent application.

Art. 9th Under the assumptions that the INPI acts as the OEE of a patent application having a family member at the USPTO, the applicant may request the participation in the INPI-USPTO PPH Pilot Program at the USPTO, observing the rules established by the USPTO.

Art. 10. In order that the patent application may be admitted in the INPI-USPTO PPH Pilot Program, only the applicant may submit the request, using

the Form of Request for Participation in the Patent Prosecution Highway (i.e. PPH) Program.

Sole paragraph. There being more than one filing applicant for the patent application, all of them should authorize the request for participation.

Art. 11. The acts dealt with in this Resolution, when not practiced by the applicant himself, should be accompanied by the Power of Attorney Form, under the terms of paragraph 1st of Art. 216 of the LPI.

Art. 12. The filing applicant should submit the following documents and information in Portuguese language to the INPI, when requesting the admission of a patent application in the INPI-USPTO PPH Pilot Program:

I - Form of Request for Priority Examination;

II - New pages of the patent application, adapted to sufficiently correspond to the subject matter previously postulated as allowed by the OEE, in due regard to the normative instructions in force related to submission of patent applications to the INPI;

III - Table of correspondences of the claim sets, evidencing the correlation between the new claims submitted to the INPI and the claims regarded as being patentable by the USPTO as an OEE, pursuant to the model of Appendix II of this Resolution;

IV - Proof that the application falls within the technological sector capable of participating in the Pilot Program, pursuant to Art. 7th (IX) of this Resolution;

V - Under the hypothesis that the object of the patent application is derived from access to a sample of component of Brazilian genetic heritage or associated traditional knowledge, it is necessary to submit, together with the request for the INPI-USPTO PPH Pilot Program, information required by the legislation in force;

VI - Under the hypothesis that a technical examination report of the OEE cites non-patent prior art documents, it is necessary to submit, together with the request for the INPI-USPTO PPH Pilot Program, such documents;

Sole paragraph. Under the hypothesis that the claims submitted to the INPI constitute a mere translation of the claims as allowed by the USPTO as an OEE, said table of correspondences depicted in Item III of this article may be replaced with a simple declaration of such condition.

Art. 13. The filing applicant should submit documents having the following statements, in Portuguese language, to the INPI, at the time of the request for the participation in the INPI-USPTO PPH Pilot Program, or declare them in the Form of Request for Priority Examination:

I - That the copies of the actions from the OEE, if submitted to the INPI, are a true copy of the original documents, reproducing their form and contents;

II - That the translations, if submitted to the INPI, are a true copy of the contents of the original documents;

III - That the patent application is not *sub judice* in Brazil; and

IV - That the patent application is not a result of voluntary division of the patent application.

Art. 14. The assessment of the priority examination requirements and of the eligibility of the patent applications that might participate in the INPI-USPTO PPH Pilot Program is under the responsibility of the Patent Directorship – DIRPA, by means of the Working Group on the Shared Priority Examination Program.

Art. 15. When the pending patent application is deemed valid to participate in the INPI-USPTO PPH Pilot Program, the INPI will notify the grant of the priority examination for the patent application under specific publication in the RPI.

Art. 16. When the patent application is not deemed valid to participate in the Pilot Program or exceeds the limit of cases, the INPI will notify the denial of the priority examination for the patent application under specific publication in the RPI.

§1st The patent application for which the priority examination is denied will return to regular prosecution.

§2nd In the cases where the INPI indicates reparable deficiencies, the filing applicant may submit one single additional request for priority examination within the term of 60 days, pursuant to the provisions of Art. 224 of the LPI, correcting the eventual deficiencies, being exempted the filing applicant from re-submitting eventual documents for which irregularities have not been indicated.

Art. 17. The decisions provided in this Resolution may not be subject to appeal, pursuant to Art. 212 of the LPI.

Art. 18. Even if the prioritization of the prosecution of the proceedings is granted, the examination of the patent application will not begin before 60 (sixty) days from its publication, pursuant to the provisions of Art. 31 of the LPI.

Art. 19. The INPI-USPTO PPH Pilot Program does not alter the principle of the independence of the rights set forth by Art. 4th *bis* of the Paris Convention for the Protection of Industrial Property.

Art. 20. The INPI-USPTO PPH Pilot Program does not exempt the filing applicant from compliance with the provisions of the LPI for the patent applications filed at the INPI.

Art. 21. The examination of a patent application through the INPI-USPTO PPH Pilot Program will be carried out in agreement with the Brazilian legislation, duly observing the remaining proceedings in force on the date of examination.

Art. 22. At the occasion of technical examination, the INPI may request the filing applicant to obtain copies of the following documents:

I - Copy of the search reports, technical examination reports performed by the OEE and replies filed by the filing applicant to said reports;

II - Copy of the set of claims regarded as being patentable by the OEE;

III - Copy of the prior art documents cited by the OEE in its technical examination reports.

Sole paragraph. Those documents requested by the INPI, which are not originally in Portuguese, English or Spanish language, should be submitted to the INPI in the form of a simple translation into one of such languages, at applicant's discretion.

Art. 23. This Resolution shall enter into force on January 11, 2016.

LUIZ OTÁVIO PIMENTEL
President

JÚLIO CÉSAR CASTELO BRANCO REIS MOREIRA
Patent Director

APPENDIX I

SYMBOLS OF INTERNATIONAL PATENT CLASSIFICATION – IPC

In order to participate in the INPI-USPTO PPH Pilot Program, the patent applications must be classified within at least one of the symbols of International Patent Classification – IPC, being introduced herein below their respective lower hierarchical levels of classification, namely:

- a) B01 - Physical or Chemical Processes or Apparatus in General;
- b) B63 - Ships or other waterborne vessels; related equipment;
- c) C09K8 - Compositions for drilling of boreholes or wells; Compositions for treating boreholes or wells, e.g. for completion or for remedial operations;
- d) C10 - Petroleum, gas or coke industries; fuels; lubricants; peat;
- e) E02 - Hydraulic engineering; foundations; soil-shifting;
- f) E21 - Earth or rock drilling; mining;
- g) F15 - Fluid-pressure actuators; hydraulics or pneumatics in general;
- h) F16 - Engineering elements or units; general measures for producing and maintaining effective functioning of machines or installations;
- i) F17 - Storing or distributing gases or liquids;
- j) G01 - Measuring; Testing.

APPENDIX II

TABLE OF CORRESPONDENCES OF THE CLAIM SETS

Table of Correspondence for Claims		
Claim required at the INPI	Claim granted by the USPTO	Comments concerning the correspondence