

DANIEL

OFFICIAL COMMUNICATION

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Preliminary Standardized Office Action Program - Brazilian PTO Rules 240 and 241

Dear Colleagues,

Further to our previous announcement ([see here](#)), the Brazilian PTO has now released **Rules 240/2019** and **241/2019** ([see translation here](#)), governing the “**Preliminary Standardized Office Action Program**”, which aims at reducing the patent backlog by at least 80% in the course of the next 2 years – after this period, the PTO estimates the office will start taking less than 24 months to examine new patent applications. A simplified flowchart describing the new program and our advice can be found [here](#).

Basically, said program divide pending applications into three different groups:

Group I – applications for which a respective foreign counterpart was already examined;

Group II – applications that do not have a foreign counterpart examined abroad; and

Group III – applications that were subject to third party observations (pre-grant oppositions), to requests for inclusion into a fast-track program (PPH or Priority examination), that already received a technical opinion from the Brazilian PTO or from ANVISA (Brazilian FDA), or that were filed after December 31, 2016, which are not encompassed by this new program.

Regarding **Group I**, the PTO will publish a standardized office action simply listing the prior art references identified by a foreign patent office. For applications in **Group II**, the PTO will carry out a search and publish a standardized office action just listing prior art documents found on such search. In both cases, applicants will have 90 days to present a response to standardized office actions, otherwise applications will be dismissed with no right to appeal. **Group III** applications will follow the regular examination, as they are not encompassed by this new

program.

The table below summarizes which applications will be affected by the “Preliminary Standardized Opinion Program”, as per the cumulative requirements established by the new rules:

<u>INCLUDED in the new “Preliminary Standardized Office Action Program”</u>	
<u>Group I</u> Applications examined abroad (Rule 241/2019)	<u>Group II</u> Applications not yet examined abroad or without a foreign counterpart (Rule 240/2019)
Filing date until December 31, 2016	
No office actions on patentability issued by Brazilian PTO	
No requests for fast-track examination	
No third-party observations (pre-grant oppositions)	
No opinion on the merits (patentability) by ANVISA (Brazilian FDA)	

Applications that do not meet all these cumulative requirements will fall under **Group III** and will not be subject to the standardized office actions created by this new program.

It is important to notice that these standardized office actions, to be issued for applications in **Group I** and **Group II**, will neither bring specific technical comments on patentability nor formalities regarding the claimed invention. These standardized office actions will simply contain a list of prior art documents, providing applicants with an opportunity to amend the claims and/or present technical arguments in view of the listed prior art. Substantive examination taking place after the issuance of these standardized office actions will be limited to prior art documents listed on these standardized office actions, that is, there will be no additional searches at a later point.

Please see below other general comments regarding this new program and our advice on how to respond to these standardized office actions and benefit the most from this new program:

General Comments

- Divisional applications will be considered in this program only if the parent application also complies with the requirements above.

- For applications in **Group I**, if the response to the preliminary standardized office action does not contain neither amendments nor technical arguments, the Brazilian PTO will issue a rejection opinion with the right to appeal.
- The preliminary standardized office action may not be a final opinion. Further technical opinions may be later issued on patentability or formalities, including clarity, sufficiency of disclosure, and other issues.
- When amending the claims, it is necessary to observe Brazilian rules related to claim amendments. After the request for examination, Brazilian PTO does not allow applicants to amend the claims to make them broader or to include new claim categories, that is, applicants can only amend the claims to make them narrower or clearer.

Our Advice

How to respond to these standardized office actions to benefit the most from this new program and increase chances of obtaining patent protection:

- Consider amending the claims to mirror the ones already allowed by a foreign patent office, taking into consideration Brazilian rules regarding claim amendments and patentable subject-matter.
- Pay complementary examination fees if the amended set of claims contain more claims than the one for which the examination was requested.
- In addition to amended claims, present a complete copy of the application containing specification, abstract, drawings, sequence listing *etc*, in order to make the process easier for the examiner.

Please contact us if you need any clarification or additional information.



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