

BRAZILIAN SUPREME COURT DECIDES ON TERM OF VALIDITY FOR PATENTS

Background: Patents in Brazil used to be granted for 20 years counted from the filing date, or 10 years counted from the date of grant, whichever was the longest, but this legal provision was challenged before the Brazilian Supreme Court. As previously informed, on April 7, the Reporting Justice decided to partially grant injunctive relief, preventing the Brazilian PTO from granting new pharmaceutical and medical patents based on the 10 years from grant provision – this injunction only affected pending applications in the pharmaceutical and medical fields, that is, it did not affect patents that had already been granted nor pending applications in other fields of technology. On May 6, however, by majority (9 x 2), **the Court decided the merits of the case, establishing that the 10 years from grant provision violates the Constitution**, and that the Brazilian PTO should start granting patents for 20 years counted from the filing date, no matter the field of technology. A hearing was scheduled to occur on May 12 to decide if and how this Supreme Court ruling should affect patents that have already been granted.

Decision: On May 12, the Supreme Court decided, by majority (8 x 3), that as a general rule, its decision should NOT affect patents that have already been granted, with **two exceptions: (i) patents in the pharmaceutical and medical fields, and (ii) patents** that were subject to invalidity lawsuits filed until April 7, 2021 with arguments that the 10 years from grant provision violates the Constitution. For these cases, the Court decided that their term of validity should be reduced from 10 years from grant to 20 years from the filing date. For these cases that would have their term of validity reduced, the Court also indicated there should be no right to claim damages for royalties already paid or for purchasing a patented product when a cheaper one should have been available, for example. A written decision should be published soon, and might be subject to motions for clarification.

Summary: **(1)** All patents granted after this Supreme Court decision is fully effective will be in force for 20 years counted from the filing date, no matter the area of technology or for how long the application was pending at the Brazilian PTO. **(2)** Pharmaceutical and medical patents granted after April 8, when the injunction was already in place, will be in force for 20 years from the filing date. **(3)** All patents that were already granted before this Supreme Court decision is fully effective will keep their original expiration date (20 years from filing or 10 years from grant, whichever was the longest), except for **(i)** pharmaceutical and medical patents, or **(ii)** patents that were subject to invalidity lawsuits filed until April 7, 2021, which will have their term of validity reduced to 20 years from the filing date after this Supreme Court decision is fully effective. To better understand the impacts of this Supreme Court decision, please see the table below:

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Situation of the application/patent	Effects of the decision
Pharma and medical patents that were granted for 10 years counted from the date of grant.	Term of protection reduced to 20 years counted from the filing date after decision is fully effective.
Patents in any fields of technology that were granted for 10 years from the date of grant, and that are being challenged for that reason by lawsuits filed until April 7, 2021.	Term of protection reduced to 20 years counted from the filing date after decision is fully effective.
Patents that do not fall under neither of the two previous situations.	None, term of validity will remain the same.
Pending applications and applications yet to be filed in all fields of technology.	Will be granted for 20 years counted from the filing date after decision is fully effective.

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