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New rules for patent claim amendments during appeal phase in Brazil

The Brazilian Patent and Trademark Office (BPTO) has just announced new rules concerning the analysis of appeals by the board of appellate patent examiners.

On December 12, 2023, the BPTO published new rules – Legal opinion No. 19/2023 – limiting the applicants' right to amend the claims during the appeal procedure. The rules shall come into effect on February 10, 2024.

The new rules state that the applicant could not present amended claims with an administrative appeal against the examining division's rejection, even if such claims result from restrictive amendments and overcome the grounds for refusal.

In other words, the BPTO's board of appellate patent examiners would simply have to analyse the exact same claims rejected by the examining division according to the BPTO's new rules.

Since the BPTO's president ultimately decides the appeals based on the opinion issued by the appeal board, these new rules will directly impact the outcome of the pending and future appeals.

In our view, the BPTO's new rules are inconsistent with the Brazilian IP Law, which clearly sets forth that the applicants have the right to a double level of examination, i.e., firstly by the first instance examining division and, after that, with a possibility of an administrative appeal to the board of appeals.

As a result, the new rules blatantly violate the right of the board of appellate patent examiners to perform a complete examination of the application and to reverse the rejection by the examining division.

The new rules, therefore, infringe upon the provision of the law due to the following reasons:

- The Brazilian Constitution states that a governmental entity – such as BPTO – is entitled to issue rules provided they comply with the federal laws;
- The Brazilian IP Law states that an administrative appeal against rejection has a full review effect (i.e., “de novo”), meaning the BPTO's appeal board shall carry out an independent examination of the merits of the patent application, and not be limited by the points raised in the rejection; and
- Recent precedents from the Brazilian Federal Court of Appeals for the 2nd Circuit state that the full discretionary examination should continue at the appellate level. If the examination continues, the applicant must have the right to amend the claims.

As we disagree with the new rules and they have been issued without proper prior discussion with the IP community, our firm has initiated efforts to seek changes in the new rules and we shall keep our clients posted on further news.

We shall be in contact with our clients concerning specific cases where the new rules may directly impact them and will propose adequate courses of action as far as their appeals are concerned.

In any event, our team is at your disposal should you have any questions or wish to discuss possible concerns and assess applicable alternatives.

Sincerely yours,
Dannemann Siemsen