

26 December 2023

***THE BRAZILIAN PTO POSTPONED THE START OF RULES
LIMITING APPLICANTS' RIGHT TO AMEND THE CLAIMS
DURING APPEAL PHASE***

As mentioned in our Circular Letter No. 17/2023, on December 13, 2023, the Brazilian PTO published new rules, i.e., Legal Opinion No. 19/2023 stating, among other things, that patent applicants will no longer be allowed to present amended claims together with an administrative appeal against rejection, even if such claims have a narrower scope.

As indicated in our aforementioned Circular Letter, the BPTO's new rules are inconsistent with the Brazilian IP Law, which states that administrative appeals entail a review of all matters under examination.

As a result of meetings with BPTO's officers, we are now glad to report that the BPTO published on December 26, 2023 a notice informing that the new rules regarding claim amendments:

- Will come into effect on April 2, 2024;
- Applicants can amend the appeals already filed in view of the new rules by April 2, 2024 or in reply to the BPTO's appeal division's office action; and

The new rules will be valid only as of April 2, 2024 (ex nunc effects) meaning that the BPTO would not apply the new rules on already decided appeals.

The notice also mentions that the BPTO may reanalyze specific points of the new rules. Because of this, it is likely that the above restrictions concerning claim amendments together with an administrative appeal will be revised.

Our firm will closely monitor further developments and will be available to clarify any doubts.

Sincerely yours,
Dannemann Siemsen