

The Patent Lawyer

September/October 2015

GLOBAL REACH, LOCAL KNOWLEDGE

www.patentlawyermagazine.com

CTC Legal Media

AIPPI welcomes you to Rio

PLUS

Knowledge share: Patent litigation and management in Brazil



- Interesting developments throughout Europe
- Four-year long slipper patent fight nears end
- The importance of pharmacokinetic patents in the US
- The impact of timing during stay motions



Ana Paula Jardim

Hopes are renewed



Tatiana Schuenck da Fonseca

The appointment of a new President at the Brazilian Patent and Trademark Office was announced in July. Ana Paula Jardim and Tatiana Schuenck da Fonseca of Luiz Leonardos & Advogados set out the challenges he faces.

The President of Brazil, Dilma Rousseff named Luiz Otavio Pimentel as President of the Brazilian Patent and Trademark Office on July 28, 2015.

Luiz Otavio Pimentel is a Doctor of Legal Sciences and has vast experience in law and public policies, particularly as regards to intellectual property and innovation, with extensive academic research in this field. He is an associate professor at the Federal University of Santa Catarina (UFSC) and a teacher at the Intellectual Property, Innovation and Development Academy of the Brazilian Patent and Trademark Office. Dr Pimentel is a referee of the Mercosur Ad Hoc Arbitration Court and a member of the Ad Hoc

Committee for Evaluation of Research of the National Research Council (CNPq).

“There is a challenge to be overcome jointly by the general management and all employees of the Brazilian Patent and Trademark Office, which is to attack the backlog disease,” Dr Pimentel said during the inauguration ceremony.

Pending cases

One of the difficulties faced by the new President, as well as the Patent Office’s personnel, is to develop a strategy to handle the large number of pending cases. Currently, around 200 examiners take care of roughly 180,000 patent cases.

According to the results of the priority agenda of the Brazilian Patent and Trademark Office, the turnout of patent decisions was 40% higher in 2014 than during the previous year. However, this increase in production was mainly due to the shelving of applications involved in administrative disputes. Associating the increase in decisions with a 3% reduction in patent application filings, we can observe a reduction in the backlog growth rate. This analysis shows that the reduction in the backlog was not due to an increase in the number of patent applications effectively examined.

“Luiz Otavio Pimentel is a Doctor of Legal Sciences and has vast experience in law and public policies, particularly as regards to intellectual property and innovation, with extensive academic research in this field.”

Résumés

Ana Paula Jardim, Luiz Leonardos & Advogados

Ana is a Senior Partner of Luiz Leonardos & Advogados, an electrical engineer and an attorney at law. She is a skilled professional admitted both to the Regional Council of Engineering, Architecture and Agronomy of the State of Rio de Janeiro and to the Brazilian Bar Association, and a post-graduate in Intellectual Property Law. Ana is focused in administrative and judicial prosecution of industrial designs and patents in the technical fields of electricity, electronics, computer systems, telecommunications, mechanics, metallurgy and other related sciences, as well as software and information technologies. She has a solid experience in the Intellectual Property area, namely, in patent portfolio management, strategic counselling, preparing patentability, validity, infringement opinions, and drafting and prosecuting patents. She works with clients ranging from sole inventors and small technology companies operating in Brazil to large multi-national corporations based in Brazil and abroad.

Tatiana Schuenck da Fonseca, Luiz Leonardos & Advogados

Tatiana is a Partner of Luiz Leonardos & Advogados, a chemical engineer and an attorney at law. She is a skilled professional admitted both to the Regional Council of Chemical Engineering of the State of Rio de Janeiro and to the Brazilian Bar Association, and a post-graduate in Environmental Chemistry. Tatiana is focused in administrative and judicial prosecution of patents in the technical fields of chemical engineering, biotechnology, pharmaceutical and other related sciences as well as plant varieties and the National Agency for Sanitary Surveillance (ANVISA). She has a solid experience in the Intellectual Property area and works with clients ranging from small companies operating in Brazil to large multi-national corporations based in Brazil and abroad.



Technical examination

According to the Brazilian regulations in force, priority examination of patent applications can only be requested in the following situations: a) the applicant is 60 (sixty) years old or more; b) the object of the application is being reproduced by third parties without his consent, or c) the grant of the patent is a condition to obtaining financial resources from fomentation agencies or national official credit institutions, granted in the form of economic subvention, financing or share participation, or originating from investment funds, for the exploration of the respective product or process.

In addition, the Green Patent Pilot Program, which was implemented by the Brazilian Patent and Trademark Office in April 2012 and is valid until April 16, 2016, refers to the prioritized treatment for patent applications related to green technologies. A list of the technologies encompassed by the program can be found at the Brazilian PTO's website.

According to the statistics provided by the Brazilian Patent and Trademark Office, more than 50 patents have already been granted within an average time of 18 months of examination through the Green Patent Pilot Program.

Furthermore, on April 9, 2013, the BRPTO published a resolution enacting new rules to regulate the prioritization of examination for patent applications covering pharmaceutical products and processes relevant to the public health care system. The resolution established two situations where a prioritization request can be made. First, the Ministry of Health may request prioritization of examination for any patent application referring to products, processes, equipment or materials for health care related to public assistance policies and regarded to be strategic to the Universal Health Care System existing in Brazil. Second, applicants and third parties may request prioritization of examination for patent applications related to diagnosis, prophylaxis and treatment of AIDS/HIV, Cancer and neglected diseases listed in Attachment I of Resolution No. 80/2013, such as Chagas Disease, Malaria, Tuberculosis and others. Therefore, the rights of the Ministry of Health are broader, encompassing any patent application regarded as strategic to the public health care system.

For the cases which are not included in one of the above hypothesis,

the technical examination currently reaches up to as long as 10 years after the filing thereof (in some fields of technology, such as chemical, biotech and telecommunications, an applicant might still have to wait even more than 10 years to have its patent application examined).

This is very frustrating to inventors, and to those who have dedicated time and efforts to the development of their inventions and sought patent protection under the Industrial Property Law.

The huge backlog of patent applications awaiting examination is one important aspect that reduces the competitiveness of the Brazilian industry and makes the country unattractive for international investors.

Further, for cases related to the pharmaceutical field, in addition to the Brazilian Patent and Trademark Office the patent applications must also be analyzed by the National Surveillance Agency (ANVISA). ANVISA works under the Ministry of Health, while the Patent and Trademark Office works under the Ministry of Development, Industry and Foreign Trade. Such parallel procedure, not only increases the timeframe for ending examination, but also sometimes results in unusual denials of patent applications.

In order to try to solve the backlog problem in the patent area, the Patent and Trademark Office has been focusing on hiring and training staff and reviewing internal procedures. Another strategic project, which is already operative, is the electronic system named e-Patents. Nowadays, most of the recent technical opinions, Letters Patents and information on the prosecution of the cases are available online.

Electronic management and processing

The e-Patent is part of a broad set of proposed actions aimed at modernizing the prosecution of patents within the Patent and Trademark Office. This set of actions and solutions includes systems both in the area of e-management (internal improvements and/or communicating with other government agencies) and in e-services (improvements in communicating with the general public). As more and more documents are made available online, applicants are able to readily retrieve information relating to their cases and to monitor the status thereof.

Furthermore, as of the end of 2012, it has been possible to file a patent application online using the electronic filing system (e-filing). The Patent and Trademark Office has also very recently implemented the e-filing system for industrial designs too.

The Patent and Trademark Office suffers from severe shortcomings in the personnel area and this problem is primarily responsible for the backlog growth. This deficiency results in a high turnover rate among newly hired examiners and is to a large extent due to the unattractive payment and career options.

In spite of the adoption of electronic proceedings and the modernization of its headquarters, working conditions for examiners are still below the country's level for technical officers. Hiring and retaining the work force is a fierce challenge for this governmental agency with an insufficient budget. Bringing the Office to a better standard of efficiency should be top priority for the new management.

Increasing staff numbers

The Minister of Development, Industry and Foreign Trade, Armando Monteiro, also recognizes that the Patent and Trademark Office has a highly qualified technical team that needs to be increased so as to handle the necessary volume of cases. "In Brazil, each examiner analyzes 10 times more applications than the recommendable standard adopted by other patent offices worldwide," said the Minister during the inauguration of the new president of the Office.

Promoting know-how exchange, by means of training courses and lectures, with professionals from patent offices in other countries,

such as the European Patent Office, US Patent and Trademark Office, Japanese Patent Office, can be of great value to further developing the potential of the Brazilian Patent and Trademark Office's technical and human resources.

Although the Minister has tried to take an optimistic approach to the backlog issue and appears to understand the urgent need to hire and train more examiners, short term changes should not be expected. The restrictive economic adjustments that are currently being carried out by the Brazilian government will limit the options.

Therefore, while most of the expected changes will not be forthcoming immediately, according to the Minister, "the Brazilian Patent and Trademark Office has the space and capacity to review proceedings and improve productivity, with the optimized use of information technology and particularly through cooperation with other international patent offices and agencies".

Dr Pimentel will face a series of challenges to achieve the goal of rendering the Brazilian Patent and Trademark Office an efficient and reliable agency. Providing the proper conditions of protecting intellectual property rights is crucial to enhancing our position as an innovative country.



“Dr Pimentel will face a series of challenges to achieve the goal of rendering the Brazilian Patent and Trademark Office an efficient and reliable agency.”

You provide the Idea
We develop the Growth

LLIP – Your Best Option in Brazil



LLIP
Luiz Leonardos Intellectual Property

Avenida Rio Branco, 80 | 10th floor
Rio de Janeiro | Brazil
20040-070

www.llip.com | llip@llip.com

T. +55 21 3514 0400
F. +55 21 3514 0401