



Licensed Patent and Trademark Attorneys  
Est 1919

Tomaz Francisco Leonardos  
Luiz Leonardos  
Maurício Leonardos  
Flávio Starling Leonardos  
Filipe da Cunha Leonardos  
Gustavo Starling Leonardos  
Gabriel Francisco Leonardos  
Denise de Oliveira Dale  
Elisabeth Kasznar Fekete  
Gustavo José Ferreira Barbosa

Ana Lúcia M. Carneiro  
Antonio Carlos Ramos  
Carla C. Castello  
Carlos Guarany  
Cláudio Roberto Barbosa  
Eduardo Colona Rosman  
Fernanda Burin Leonardos  
João Luis d'Orey Facco Vianna  
Liz Carneiro Leao Starling  
Louise Prutchi  
Marcelo Canelas Leite  
Marcelo de Oliveira Müller  
Otto Banho Licks  
Rodrigo Afonso de Ouro Preto Santos  
Ronaldo Magalhães Varela  
Rosane Rego Tavares da Silva  
Soniis Moraes de Souza

**RIO DE JANEIRO OFFICE**  
Rua Teófilo Otoni, 63-10º andar  
Centro  
20090-080 - Rio de Janeiro - RJ  
Brazil  
Tel (55-21) 2518-2264  
Fax (55-21) 2518-3152  
E-Mail: [momsen@leonardos.com.br](mailto:momsen@leonardos.com.br)  
[www.leonardos.com.br](http://www.leonardos.com.br)

**SÃO PAULO OFFICE:**  
Av. Nove de Julho, 3.147  
7º andar - conj. 72  
Jardim Paulista  
01407-000 - São Paulo - SP  
Brazil  
Tel (55-11) 2122-6600  
Fax (55-11) 2122-6633  
E-Mail: [momsensp@leonardos.com.br](mailto:momsensp@leonardos.com.br)  
[www.leonardos.com.br](http://www.leonardos.com.br)

P.O. BOX 21214  
Agência Praça Mauá  
20110-970 - Rio de Janeiro - RJ - Brazil

# Newsletter

**New Resolution N° 132/2006  
of 26 December 2006**

*No.169*

*January 2007*

**The Brazilian Patent Office published a new Normative Resolution regulating the possibility of patent applications being examined with priority.**

The large backlog of unexamined applications has been a great concern to the IP community in Brazil, inasmuch as most patents are currently being granted only seven to eight years after their filing.

Even though the Patent Law foresees remedies for some of the losses incurred by applicants per force of such delay, some situations are clearly not covered, and can only be alleviated by the grant itself.

The difficulties of applicants had been worsened in the beginning of 2006, when the Patent Office revoked two administrative regulations that allowed them to request that priority was given to the examination of their applications.

Now, some attention was finally given to applicants falling into three different situations:

- those natural persons more than 60 years old,
- those whose inventions are being copied without their authorization, and
- those who need a granted patent to obtain financial resources to explore their inventions.

Furthermore, a third party being accused of unduly copying the object of a patent application can now request that its examination is given priority

The request for priority in the examination must be presented in a specific form, especially created to this end, and will be analyzed by a board of officers, before being decided by the Director of Patents. The final decision will be published in the Official Gazette.

A most important change in the requirements imposed on applicants requesting priority in the examination with basis on a potential infringement, is the now compulsory obligation of notifying the infringer before presenting the request.

For third parties, the duty was created to present a copy of a notification received from the applicant, as well as presenting arguments and documents to subsidize the examination, before presenting the request for priority.

These two requirements imposed on opposing parties, the applicant and the potential infringer, clearly indicate the intent of the Patent Office of hearing both sides, whenever examining an application after an allegation of infringement.

Our translation of the resolution is attached hereto for ready reference.

-O-O-O-O-O-O-

Federal Public Service Ministry of Development, Industry and Foreign Trade National Institute of Industrial Property
--

Presidency	17/11/2006
Resolution	Nº132/2006

Subject: Regulates the priority in the examination of patent applications within the scope of the Brazilian Patent Office

Article 1 – This resolution regulates the priority in the examination of patent applications within the scope of the Brazilian Patent Office (INPI).

Article 2 – The priority in the examination of patent applications can be requested:

I – by the applicant himself whenever, it is shown that:

- a) he has an age of 60 (sixty) or more years;
- b) the object of the patent application is being reproduced by third parties without his authorization, 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 originated from investment funds, for the exploration of the respective product or process.

II – by third parties, who can prove that they are being accused by the applicant of reproducing the object of the patent application without his authorization.

Article 3 – Patent applications, the object of which is comprised by the act of the Federal Executive Power which declares a national emergency or public interest, under the hypotheses described in paragraphs 1 and 2 of article 2 of Decree Nº 3201, of 6 October 1999, will be the subject of ex officio priority examination.

Article 4 – The request for priority in the examination will be formulated by means of a petition, as per the form comprised in Annex A of the present Resolution, being exempted from the payment of fees.

Article 5 – The request for priority in the examination of a patent application shall be accompanied by the following documentation:

I – in the case foreseen in item I.(a) of Article 2, notarized copy of the identity document or birth certificate;

II - in the case foreseen in item I.(b) of Article 2:

- a) proof that the object of the patent application is being reproduced without his authorization;
- b) copy of the extra-judicial notification (cease ad desist letter) sent to the agent accused of undue reproduction of the object of the patent application by the applicant or by a duly empowered attorney (or agent), in which it is shown an express reference to the number of the application, the name of the applicant and the supposedly undue act, with proof of receipt by the alleged infringer.

III – in the case foreseen in item I.(c) of Article 2:

- a) notarized copy of the request for financial resources for the development of the object of the patent application to the fomentation agency or the credit institution.
- b) notarized copy of the document conditioning the liberation of the financial resources to the grant of the patent.

IV - in the case foreseen in item II of Article 2:

- a) copy of the extra-judicial notification (cease ad desist letter) sent to the party requesting priority examination , issued by the applicant or by a duly empowered attorney (or agent), in which it is shown an express reference to the number of the application, the name of the applicant and the supposedly undue act ; or
- b) any proof showing that the party requesting priority examination is being accused by the applicant of reproducing the object of the patent application without his authorization, provided that accompanied by evidence of presentation of subsidies to the technical examination, so as to demonstrate that the object of the patent application is comprised by the state of the art.

Article 6 – The acts which are the object of the present Resolution, whenever not carried out by the interested party, must be accompanied by a power of attorney, under the terms of Article 216, paragraph 1 of Law 9.279, of 14 May 1996.

Article 7 – The requests for priority in the examination of patent applications will be analyzed by a board of officers of the INPI and decided by the Director of Patents, the decision being published in the Electronic Official Gazette.

Article 8 – This resolution will come into force on the date of its publication in the Electronic Official Gazette

Jorge de Paula Costa Ávila  
President

Carlos Pazos Rodriguez  
Director of Patents