

# Newsletter

## The object of patent applications deriving from Brazilian genetic resources – the need of acknowledgment as set in new Resolutions issued by the Brazilian Patent Office.

*No.170*

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On December 26, 2006 the Brazilian Patent Office (BPO) published Resolutions numbers 134 and 135 which, respectively, set out proceedings regarding patent applications whose objects derive from Brazilian genetic resources, and amend the forms for filing new patent applications so as to enable compliance with the requirements established in Resolution 134.

Such Resolutions have come into force on January 2, 2007.

Resolution 134/2006 (R134) deals with substantive matters. It makes reference to Provisional Ruling<sup>1</sup> 2186-16 and to

<sup>1</sup> Provisional Rulings are de facto laws enacted by the President and subject to subsequent ratification by Congress (when a law is enacted to substitute the Provisional Ruling). Provisional Ruling 2,186-16 was initially numbered 2,052, re-edited several times, after renumbered 2,126, and terminating with Provisional Ruling 2,186 with several re-editions ending with 2,186-16.

Resolution no.23 of the Genetic Heritage Management Council (CGEN). Resolution 135/2006 (R135) addresses the formal issues derived from the R134.

In its turn, the currently in full force Provisional Ruling 2186-16, in its article 31, establishes that the granting of industrial property rights involving products and/or processes obtained from a sample of a component of the national genetic heritage depends on the compliance of said Provisional Ruling, the applicant having the duty of informing the origin of the genetic material and, if applicable, of the associated traditional knowledge (TK).

Provisional Ruling 2186-16 originated in Provisional Ruling 2052 of June 29, 2000 and deals with the access to the genetic heritage, the protection of, and access to, the associated TK, benefit sharing, and access to technology and transfer of technology for its conservation and use, following the dispositions set for by the Convention on Biological Diversity (CBD), more specifically in its articles 1, 8, letter “j”, 10, letter “c”, 15 and 16, items 3 and 4.

CGEN’s Resolution 23, of November 10, 2006, in full force as of January 2, 2007, establishes that in order to comply with what is set forth in Provisional Ruling 2186-16, applicants of patent applications for a product and/or a process resulting from access to a sample of the Brazilian genetic heritage effected as of June 30, 2000 should declare before the BPO that he/she has complied with the requirements of said Provisional Ruling 2186-16, also having to inform the number and date of the corresponding Access Authorization, under penalty of being subject of the applicable sanctions (these are of an administrative nature and are defined in Chapter VIII of Provisional Ruling 2186-16).

Under CGEN’s Resolution no. 23, new patent applications filed as of its publication (effected on December 28, 2006) should observe the above paragraph’s requirements and, to this end, the new forms provided through R135 should be used and duly filled out.

Additionally, proprietors of patent applications for a product and/or a process resulting from access to a sample of the Brazilian genetic heritage made as of June 30, 2000, which

applications were pending at the BPO at the time this Resolution was published, regardless of any notification on behalf of the BPO, should update their applications before the BPO so as to comply with it, and, to this end, a specific form provided by R135 should be used.

Both Provisional Ruling 2186-16 and CGEN's Resolution no. 23 have established the need to inform the BPO only in situations in which the patent application concerns an invention which object resulted from access to genetic materials in Brazil . However, in a stricter and, in our view, incorrect manner, the BPO's R134 has made it compulsory to inform also in situations in which the patent application's object has not resulted from access to genetic material in Brazil. Therefore, upon filing any new patent application it will be necessary to positively inform, either in the affirmative or in the negative, whether access to genetic material resulted in the invention, there not being an option to remain silent on the matter, even if the art involved bear no relationship at all with those arts in which genetic resources might play a role.

Taking all of the above into account, any currently pending applications that you have filed in Brazil should be revised in order to ascertain whether there are any cases which may fit into these new requirements, so that, if needed, forms for completion are sent to you.

Moreover, upon filing a new patent application in Brazil, applicants must report to the BPO, on a "yes" or "no" basis, whether the object of the invention derives somehow from genetic material of Brazilian origin. In the affirmative, it must also be informed the number and date of the Agreement on the access to such material provided by the Brazilian authorities. Furthermore, in the positive scenario, applicants will have to geographically define the origin of the genetic material.

P.S. We are hereto attaching English Language versions of Resolution 134 of December 26, 2006 and CGEN's Resolution 23 of November 10, 2006

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**MINISTRY OF ENVIRONMENT  
GENETIC HERITAGE MANAGEMENT COUNCIL**

**RESOLUTION NO. 23, OF 10 NOVEMBER 2006**

Addresses how to attest that the requirements recited in Provisional Ruling no. 2,186-16, of 23 August 2001 have been met, for the purpose of granting patents by the Brazilian Patent and Trade Mark Office – BPTO.

The Genetic Heritage Management Council, under its invested attributions recited in article 11, III, “a”, of Provisional Ruling no. 2,186-16, of 23 August 2001 sets out:

Art. 1o. This Resolution addresses how to attest that the requirements set forth in Provisional Ruling no. 2,186-16, of 23 August 2001 have been met, for the purpose of granting patents by the Brazilian Patent and Trade Mark Office – BPTO, in accordance with article 31 of said Provisional Ruling.

Art. 2o. For the purpose of attesting the compliance with the requirements set forth in Provisional Ruling no. 2,186-16, of 2001, the Applicant of a patent application for a product or process resulting from the access to a component of the genetic heritage made as from 30 June 2000, filed as of the publication date of this Resolution, shall declare to the BPTO that all requirements set forth in the Provisional Ruling have been met, as well as the number and the date of the corresponding authorization for the access, under penalty of the applicable sanctions.

Art. 3o. The applicant of a patent application for a product or a process resulting from the access to a component of the genetic heritage made between 30 June 2000 and the publication date of this Resolution shall straighten the application out before the BPTO aiming at complying with this Resolution.

Art. 4o. This Resolution shall come into force on 2 January 2007.

MARINA SILVA  
Minister of the Environment

**FEDERAL PUBLIC SERVICE**  
**MINISTRY OF DEVELOPMENT, INDUSTRY AND FOREIGN TRADE**  
**NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY**

<b>PRESIDENCY</b>	<b>12/13/2006</b>
<b>RESOLUTION</b>	<b>No. 134/2006</b>

**Re:** To set out the proceedings relative to the filing of patent applications whose object has been obtained through the access to a sample of a component of the national genetic heritage.

**THE BRAZILIAN PATENT AND TRADEMARK OFFICE'S PRESIDENT**, under its invested attributions, bearing in mind both article 31 of the Provisional Ruling no. 2,186-16, dated 23 August 2001, originated in Provisional Ruling no. 2,052, dated 29 June 2000, and Resolution no. 23, dated 10 November 2006, of the Genetic Heritage Management Council – CGEN,

**SETS OUT:**

Art. 1. This Resolution governs the proceedings relative to the filing of patent applications whose object has been obtained through the access to a sample of a component of the national genetic heritage.

Art. 2. In the case of patent applications filed as from the date CGEN's Resolution no. 23, of 10 November 2006, comes into force, Applicants shall declare to the Brazilian PTO, in the specific field of the patent application form or PCT form – entry into national phase, whichever applies to the case, whether or not the object of the patent application has been obtained through the access to a sample of a component of the national genetic heritage after 30 June 2000.

Sole Paragraph. If the object of the patent application has been obtained through the access to a sample of a component of the national genetic heritage as provided above, the Applicant shall also declare to the Brazilian PTO that all requirements set forth in Provisional Ruling no. 2,186-16/01 have been met. In addition, the Applicant shall inform the number and the date of the corresponding authorization for the access, as well as the origin of the genetic material and the associated traditional knowledge, if any.

Art. 3. In the case of patent applications whose object has been obtained through the access to a sample of a component of the national genetic heritage as from 30 June 2000, filed before the Brazilian PTO at the date CGEN's Resolution no. 23, of 10 November 2006, comes into force, Applicants shall declare to the Brazilian PTO, in a specific form, created by this Ruling, free of charges, that all requirements set forth in

Provisional Ruling no. 2,186-16/01 have been met. In addition, the Applicant shall inform the number and the date of the corresponding authorization for the access, as well as the origin of the genetic material and the associated traditional knowledge, if any, regardless of any notification from the Brazilian PTO.

Art. 4. This Resolution will come into force on 2 January 2007.

(signed by) **Jorge de Paula Costa Ávila**  
President

(signed by) **Carlos Pazos Rodriguez**  
Patent Director