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## The Brazilian Patent Office restricts its interpretation of the provisions that created a grace period for filing patent applications in Brazil.

The Brazilian Patent Office just published Opinion 02/09 of its General Attorney. This opinion, which has normative effects, discloses a restrictive interpretation of the provisions of the Brazilian IP Law dealing with the grace period.

As you may know, Law 9279, of 14 May 1996, introduced in the Brazilian legal framework the concept of the grace period, by means of which any disclosure of an invention directly or indirectly related to acts of the inventor will not destroy the novelty of an invention if made up to one year before the filing of a Brazilian application, or of the foreign application priority of which is claimed. The provisions in question read as follows:

**Article 12** - *The disclosure of an invention or utility model which occurs during the twelve months preceding the date of filing or priority of the patent application will not be considered as part of the state of the art, provided such disclosure is made:*

*I - by the inventor;*

*II - by the National Institute of Industrial Property - INPI, by means of the official publication of a patent application filed without the consent of the inventor and based on information obtained from him or as a result of his acts; or*

*III - by third parties, on the basis of information received directly or indirectly from the inventor or as the result of his acts.*

**Sole Paragraph** - *INPI may require the inventor to provide a declaration relating to the disclosure, accompanied or not by proof, under the conditions established in the rules.*

The Opinion about which we report to you refers specifically to Article 12 - III, and states that the scope of the expression "third parties" does not comprise foreign Industrial Property Offices. This means that, henceforth, the Brazilian Patent Office will not consider an official publication as an acceptable disclosure under the provisions of Article 12. This includes, for instance, the publication made by WIPO of international applications filed under the PCT.

We do not agree with such interpretation, because it actually implies an addition of words to the text of the law, which in the opinion of the Federal Attorney should read: *III - by third parties, as long as such third parties are not foreign industrial property offices,....* Therefore, we believe that there exist very good chances to reverse the rejection of an application based on it, if the matter is submitted to the Brazilian courts.

In any way, in view of this new interpretation of our law, we expect to receive in the future negative opinions in respect of cases filed under Article 12 - III, and in which the first disclosure corresponded to an official publication.

If one of your applications is eventually affected by this new policy of the Brazilian Patent Office, you will hear from us as soon as an office action is published. However, should you be interested in more details about this matter, please contact us at any time. □

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