



**MINISTRY OF DEVELOPMENT, INDUSTRY AND COMMERCE
NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY**

ORDINANCE / INPI / PR N° XXX, OF XXXXXXXX, 2024

Establishes the Phase V of the PPH Project.

The **PRESIDENT** and the **DIRECTOR OF PATENTS, COMPUTER PROGRAMS AND TOPOGRAPHIES OF INTEGRATED CIRCUITS** of the **NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY**, in the use of the attributions provided for in Decree n° 11,207, of September 26, 2022, and considering the content of the process INPI n° 52402.001426/2024-37,

DECIDE:

Art. 1 This Ordinance establishes the phase V of the Project of Patent Prosecution Highway (PPH) in the context of the National Institute of Industrial Property of Brazil (INPI).

Art. 2 For the purpose of this Ordinance, the following definitions will be adopted:

I – Patent Prosecution Highway (PPH): a project carried out through Memorandum of Understanding (MOU) between INPI and other intellectual property offices.

II – Global Patent Prosecution Highway (GPPH): multilateral cooperation program of Patent Prosecution Highway (PPH), which includes three types of PPH schemes, namely: the Normal PPH, the PPH MOTTAINAI and the PCT-PPH.

III – International patent application: patent application filed according to the Patent Cooperation Treaty (PCT).

IV – Patent process: administrative process, at INPI, destined to the protection of the industrial property rights, subject to the grant of patent of invention or utility model, since the presentation of the patent application or the request for entry into the Brazilian national phase of an international patent application until the closure of the administrative level.

V – Partner office: IP offices participating, in the moment of a PPH request, in a PPH agreement with INPI and/or in the GPPH, according to the list at <https://www.gov.br/inpi/pt-br/servicos/patentes/pph/acordos-pph-assinados-pelo-inpi>.

VI – Office of Earlier Examination (OEE): partner office (item V, Article 2) that examined the patentability of a corresponding patent application before INPI, acting as an international authority under the PCT or as a national or regional patent office.

VII – Corresponding patent application: patent application filed with the Office of Earlier Examination related to the patent application filed with INPI, sharing the same earliest date of priority or the same earliest date of international filing.

VIII – Subject-matter considered patentable/allowable: subject matter that the Office of Earlier Examination (item VI, Article 2):

a) acting as a national or regional patent office, examined substantively and indicated at least one claim as patentable/allowable in the latest office action by the OEE (See Annex F - https://www.jpo.go.jp/e/toppage/pph-portal/globalpph/annex_f.pdf).

b) acting as an international authority under the PCT, examined substantively and indicated at least one claim as allowable (from the aspect of novelty, inventive step and industrial applicability) in the latest work product in the international phase of a PCT application.

IX – Sufficiently corresponding claims: claims of the patent application filed with INPI that, after considering differences in translation and formatting, have the same, similar or narrower scope than the claims considered patentable/allowable by the Office of Earlier Examination (item VI, Article 2), as per Annex II of this Ordinance.

X – Narrower claim: claim submitted to INPI which, in relation to the claims considered patentable/allowable by the Office of Earlier Examination (item VI, Article 2), is limited by some additional technical feature supported in the description and/or claims.

§ 1 When a new category of claim is introduced in the set of claims presented to INPI and which was not foreseen in the set of claims of the Office of Earlier Examination, the new category will not be considered sufficiently corresponding, as specified in item IX of this Article.

§ 2 The Certificates of Addition are considered patent processes, according to item IV of this Article, subject to the granting of the main application.

TITLE I

PROCESS AND REQUEST REQUIREMENTS

Art. 3 The administrative procedures of patent applications with a PPH request will have processing priority if the applications meet the following requirements:

I – not being within the period of confidentiality defined in art. 30 of Law 9.279, of May 14th, 1996, or being with the request of anticipated publication, as provided under § 1° of art. 30 of Law 9.279, of 1996, or, in the case of international applications, being published by the World Intellectual Property Organization (WIPO);

II – having the fee related to the substantive examination paid, as provided under art. 33 of Law 9.279, of 1996;

III – not having any other processing priority;

IV – not having voluntary division or amendment of the patent application, as provided under arts. 26 and 32 of Law 9.279, of 1996, by the applicant, between the request and the decision of prioritized processing;

V – not having the substantive examination started;

VI – having a corresponding patent application, as defined in Article 2, item VII;

VII – having subject-matter considered patentable/allowable, as defined in Article 2, item VIII;

VIII – have sufficiently corresponding claims, as defined in Article 2, item IX.

Sole paragraph. In the case of division of the application, as provided for in art. 26 of Law 9,279, of 1996, prior to the request for prioritized processing, both the original application and its divisions must comply with the provisions of items I, II and IV of this Article.

Art. 4 The PPH request must meet the following requirements:

I – be done by any applicant, isolated or jointly, or by a qualified lawyer in the patent process;

II – be done after the payment of the Federal Revenue Collection Slips (*in Portuguese, Guia de Recolhimento da União - GRU*), using the fee of service code 277, with the indication, in the object of the petition, of the Office of Earlier Examination;

III – be filed by a completed PPH/GPPH electronic request form; and

IV – present, in attachment, the following documents:

a) copy of the front page of the document evidencing that the patent application meets the definitions of Article 3, item VI of this Ordinance;

b) copy of the latest office action by the OEE or the latest work product in the international phase of a PCT application, evidencing that the patent application meets the definitions of Article 3, item VII of this Ordinance, such as the actions are listed on the INPI webpage (www.inpi.gov.br), in “Patents” (“Patentes”), in “Patent Prosecution Highway (PPH)”.

c) declaration that the document listed in paragraph b), item IV of this Article, complies with the description in Article 3, item VII of this Ordinance, if the document is not in Portuguese, English or Spanish;

d) copy of documents of non-patentary prior art mentioned in any report of substantive examination of the Office of Earlier Examination;

e) copy of the last set of claims submitted to the Office of Earlier Examination based on which the patent application meets the requirements described in Article 3, items VI, VII and VIII of this Ordinance;

f) amended patent application, in order to meet the requirements in Article 3, items VI, VII and VIII of this Ordinance, respecting the current legislation related to the amendments of INPI’s patent applications, or declaration stating that the patent application meets the requirements in the items; and

g) claims correspondence table, according to model of Annex I of this Ordinance, showing a correlation between the claims considered patentable/allowable by the Office of Earlier Examination and the new claims presented to INPI, or declaration stating that the claims presented to INPI represent a mere translation of the claims of the application with subject matter considered patentable by the Office of Earlier Examination.

§ 1 It is not required to present a document, certificate or its copy, when issued by INPI, and/or when it is already in the patent process object of the prioritizing request, and/or to identify the representative of the applicant or holder, based on art. 75 of Law 13.105, of March 16th, 2015.

§ 2 The payment mentioned in this Article, item II corresponds to the evaluation fee of the request of participation.

§ 3 If the copies of the required documents are written in a different language than Portuguese, English or Spanish, the translation to one of these languages must be presented.

§ 4 The PPH/GPPH request for prioritized processing of a patent application will be considered as an express request of the applicant to immediately start the process or examination of the international application in the Brazilian national phase before the deadline of 30 (thirty) months, as provided for in Art. 23.2 of the Patent Cooperation Treaty (PCT).

Art. 5 The PPH Project will have the following limits:

I – the requests can be done during the period between 01/01/2025 and 31/12/2029;

II – up to 1000 (one thousand) requests of participation in the Project can be done to patent processes classified in the same Section of the International Patent Classification (IPC), per annual cycle;

III – up to 3200 (three thousand two hundred) requests of participation can be received per annual cycle; and

IV – the Project will last until the end of INPI's administrative level of all the patent processes with accepted priority.

§ 1 The quantitative limits mentioned in the items of this Article do not depend on admission or non-admission of the respective requests of the prioritized processing nor on acceptance or non-acceptance of the results of the Office of Earlier Examination (item IV, Article 2) presented.

§ 2 The filling of vacancies mentioned in the items of this Article will obey the order of date and time of the prioritized processing request protocol.

§ 3 The annual cycle mentioned in items II and III of this Article begins on the first day of the year and ends on the last day of the same year, with no extension allowed.

TITLE II

PROCESSING OF THE PRIORITIZED PROCESS

Art. 6 The Directorate of Patents, Computer Programs and Topographies of Integrated Circuits (DIRPA) will define the procedure for evaluating priority requests, verify if the requirements and the processes meet the criteria established in this Ordinance and publish its decision in the Industrial Property Gazette (*in Portuguese, Revista Eletrônica da Propriedade Industrial - RPI*).

§ 1 INPI will prioritize the expedient acts necessary for the evaluation of the prioritized processing request.

§ 2 Omitted cases will be decided by the maximum authority of the directorate responsible for processing patent processes in the first instance.

§ 3 DIRPA may temporarily suspend, in integral or partial way, the reception of prioritized processing requests of patent processes in the modalities addressed in this Ordinance.

§ 4 DIRPA will notify the suspension described in § 3 at least 30 (thirty) days in advance.

Art. 7 A single requirement will be made when it is necessary to provide information, present evidence, pay and/or supplement fees.

§ 1º Proof by the interested party of the information referred to in paragraphs “a”, “b”, “c”, “d” or “e” of item IV of Article 4 may be waived, at the discretion of the administration, in the event that DIRPA has access to information through a free, public electronic database containing the document in Portuguese, English or Spanish.

§ 2º In the event of any requirement described in this Article, the applicant must meet it within 60 days through INPI’s electronic petition system, after generating the Federal Revenue Collection Slips (*in Portuguese, Guia de Recolhimento da União - GRU*) with service code 206, indicating in the object of the petition “Compliance of formal requirement for prioritized processing”.

§ 3º If the requirement is not met, DIRPA may, at the discretion of the administration, correct ex officio such omission.

Art. 8 The prioritized processing will not be admitted when:

I – the data, actions and/or documents necessary to assess the request were required of the applicant/attorney and they do not comply with the deadline and the manner defined in Article 7;

II – the request is not related to the patent process, as defined in item IV or paragraph 2 of Article 2;

III – the application in the patent process does not meet the requirements set out in items III, IV, V or VI of Article 3;

IV – the request is filed in conflict with items I, II or III of Article 4; or

V – the limits set forth in items II or III of Article 5 have been reached.

§ 1 The patent process will maintain its regular processing in the event of inadmissibility of the prioritized processing, and amendments to the patent application presented in the PPH request will not be considered.

§ 2 It will be possible, upon request by the applicant/attorney, to refund the fee collected for the petitions of prioritized processing requests that were not admitted based on items II, III, IV or V of this Article.

Art. 9 The admission of prioritized processing will involve prioritization of all acts in the administrative level of INPI.

§ 1 The prioritized processing of the patent application will be carried out in accordance with Brazilian legislation and respecting the other procedures in force.

§ 2 In case of division of prioritized application after the publication of the first decision of substantive examination, only the original application will maintain the attribute of prioritized processing.

Art. 10. The prioritized processing will be revoked when:

I – the patent process no longer meets the conditions established in Article 3 of this Ordinance due to the applicant's action;

II – there is voluntary division or amendment of the patent application by the applicant, after admission of the prioritized processing and before publication of the first decision of substantive examination; or

III –during the substantive examination of the patent application, inconsistency is identified in the documents listed in paragraphs “b”, “c”, “d”, “e”, “f” or “g” of item IV of Article 4 of this Ordinance.

Art. 11. Decisions regarding the prioritized processing cannot be appealed.

Sole paragraph. The interested party may submit a new prioritized processing request accompanied by new supporting documentation.

TITLE III

TRANSITIONAL AND FINAL PROVISIONS

Art. 12. The pending evaluation requests presented for participation in the Pilot Projects PPH INPI-USPTO, PPH INPI-JPO, PPH PROSUL, PPH INPI-EPO, PPH INPI-CNIPA, PPH INPI-USPTO II, PPH INPI-DKPTO, PPH INPI-UK IPO, PPH INPI-PROSUL II, PPH INPI-JPO II, PPH PROSUL III, PPH, PPH II, PPH III and PPH IV, will be assessed in accordance with the procedures established in Title II of this Ordinance.

Sole paragraph. The requests mentioned in this Article shall meet the formal and substantial requirements defined in the regulatory act in force at the time of the petition filed, and they will be assigned to the correspondent Pilot Project.

Art. 13. The Ordinance/INPI/PR 78 of December 16, 2022, published at RPI 2712 on December 27, 2022, is revoked.

Art. 14. This Ordinance enters into force on 01/01/2025.

Rio de Janeiro, XXXXXXXX XX, XXXX.

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President

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Director of Patents, Computer Programs
and Topographies of Integrated Circuits

Annex I

Claims Correspondence Table

Claims Correspondence Table		
Claim number requested at INPI	Claim number considered patentable by the Office of Earlier Examination	Comment on correspondence

Annex II

1- Examples of claims considered sufficiently corresponding.

Case	Claims considered patentable/allowable by the Office of Earlier Examination		Claims of the patent application filed with INPI		Interpretation
	Claim	Technical Feature	Claim	Technical Feature	
Case 1	1	A	1	A	Claim 1 filed with INPI has the same scope as claim 1 from Office of Earlier Examination.
Case 2	1	A	1	A	Claim 1 filed with INPI has the same scope as claim 1 from Office of Earlier Examination. Claim 2 filed with INPI describes feature “A” and adds a technical feature “a” from specification (description or set claim).
			2	A + a	
Case 3	1	A	1	A	Claim 1 filed with INPI has the same scope as claim 1 of Office of Earlier Examination. Claims 2 and 3 filed with INPI are the same scope as claims 2 and 3 “patentable/allowable” from Office of Earlier Examination.
	2	A + a	2	A + b	
	3	A + b	3	A + a	
Case 4	1	A	1	A + a	Claim 1 filed with INPI has an additional technical feature disclosed in the specification.

2- Examples of claims considered not sufficiently corresponding.

Case	Claims considered patentable/allowable by the Office of Earlier Examination		Claims of the patent application filed with INPI		Interpretation
	Claim	Technical Feature	Claim	Technical Feature	
Case 5	1	A (product)	1	A' (method)	Claim 1 filed with INPI will not be accepted, as the claim category has changed in relation to claim 1 from Office of Earlier Examination.
Case 6	1	A + B	1	A + C	Claim 1 filed with INPI will not be accepted, because it creates or changes part of the technical features of claim 1 "patentable/allowable" from Office of Earlier Examination .