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Divisional patent applications in Brazil

Renata Campello Afonso from Luiz Leonardos & Advogados investigates how divisional applications work in Brazil, what the deadline is for filing a divisional and whether the claims of a divisional application can be broader than those of the earlier (parent) application.

A divisional patent application is a type of application accepted in several jurisdictions and, although it is most commonly filed in response to an objection related to lack of unity of invention made during the examination of the earlier application (parent application), this is not the only reason for requesting the division of a patent application. Another quite common reason to file a divisional is to take advantage of discussing controversial matter during its examination, while placing the parent application in condition to be allowed.

As a matter of fact, according to Article 4G of the Paris Convention, the Applicant may divide the application into one or more divisional applications either if the examination reveals that an application contains more than one invention or on his own initiative, preserving the date of filing of the earlier application and the benefit of the right of priority.

However, it is important to observe the specific rules, procedures and deadlines related to the filing of divisional applications in each country of interest, since they may vary considerable from jurisdiction to jurisdiction.

As far as Brazil is concerned, the Industrial Property Law (Law 9279/96) defines in Article 26 that a patent application may, until the end of examination, be

divided, *ex officio* or on request of the Applicant, into two or more applications provided that the divisional application:

- I makes specific reference to the original application; and
- II does not exceed the matter disclosed in the original application.

Apart from the above, Normative Instruction 30 (NI 30/2013), issued on December 4, 2013 by the Brazilian PTO, defines some ground rules for the acceptance of a new divisional application. In this regard, according to NI 30/2013, a patent application may be divided into one or more applications up to the end of examination, under the following conditions:

- I upon the Applicant's request, even in the case where the application presents a group of inventions connected by the same inventive concept;
- II in compliance with a technical report when the technical examination determines that the application contains a group of inventions comprising more than one inventive concept, or more than one utility model.

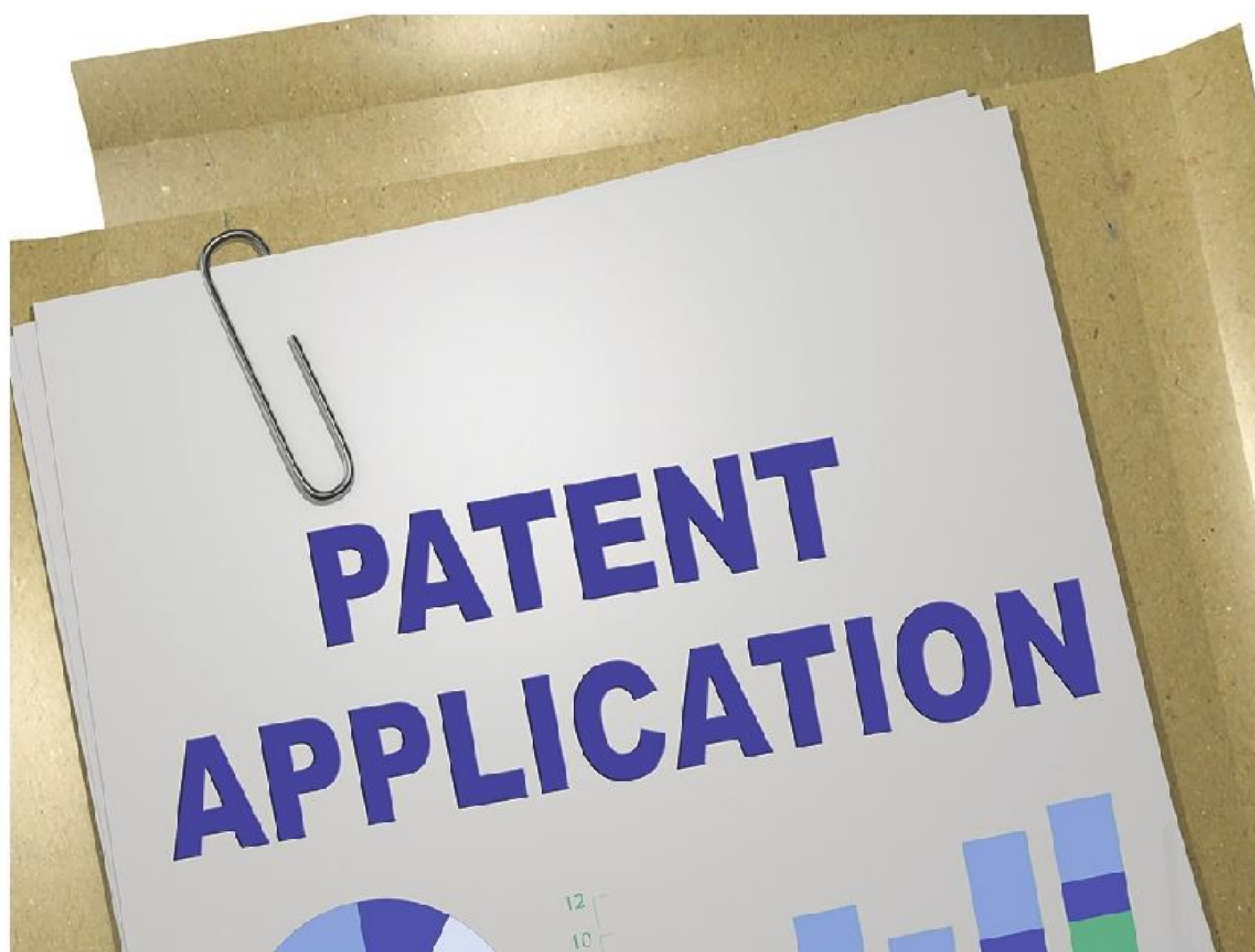
In addition, it should be pointed out that an application containing only one invention or one utility model cannot be divided if the division mutilates the invention or leads to double patenting of the invention or model. Consequently, it is not possible for a Brazilian divisional application to have claims, which either overlap with or are broader than the claims of the parent application.

Moreover, although there is no limit regarding the number of divisional applications filed based on a single parent application, another difference from other jurisdictions is the fact that, in Brazil, it is not permitted to file a divisional based on an application that is a divisional application itself.

Résumé

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A divisional application shall be considered as being in the same procedural phase as that of the parent application and the fee payments required for divisional application, such as annuities and examination request, shall be affected in accordance with the procedural phase of the parent application. The parent application and its divisional shall be simultaneously decided.

Restrictions based on Article 32 of Brazilian IP Law

Article 32 of the Brazilian IP Law states that amendments may be filed up to the time that the request for examination is submitted, provided they are designed to better clarify or define the application and are limited to the matter initially disclosed in the application.

In the early 2000s, the applicability of Article 32 was discussed in a Public Civil Court Action and, as a result, the Chief Prosecutor of the Brazilian PTO has issued an opinion establishing that only those amendments designed to correct a material typing mistake, or which seek to restrict the protection initially claimed, are not subject to the time limit determined in Article 32 and may even occur after the submission of the request for the technical examination.

Due to this decision with regard to the interpretation of Article 32 of Brazilian IP Law, the acceptance of voluntary amendments after the submission of the request for examination turned out to be quite restricted and, unfortunately, this had a direct impact in the scope of the claims of new divisional applications.

In 2013 the Brazilian PTO issued guidelines on the applicability of the provisions of Article 32, including a chapter directed to divisional applications, in which it is defined that the analysis of divisional applications filed after the submission of the request for examination of the parent application will be made based on the valid set of claims of the parent application, that is, the set of claims based on which the request for examination was submitted. In this scenario, the set of claims of a divisional application may not encompass subject matter which is not contained in the set of claims of the parent application, even if the subject matter is disclosed in the specification as originally filed.

For that reason, if the divisional application is filed before the submission of the request for examination of the parent application, the Applicant will be in a better position to draft the divisional set of claims, which may encompass any subject matter that was originally disclosed in the specification, even if it was not previously claimed.

On the other hand, if a divisional application is filed after the submission of the request for examination, voluntary amendments to the set of claims are barred with due regard for the interpretation of Article 32 of Brazilian IP Law and the Applicant will be limited by the set of claims based on which the request for examination of the parent

application was submitted. If the claims are considered to broaden the scope of protection when compared to the set of claims of the parent application, the divisional will not be accepted.

Indeed, during the examination of the divisional application, the Examiner will always analyze whether claims of the divisional fall within the provisions of Article 32. However, the advantage of filing the divisional before the request for examination of the parent application is submitted is that this analysis will be made not only based on the set of claims, but also in the disclosure of the specification.

In other words, the date when the request for examination of the parent application is submitted will represent an important timeline for future divisional applications as it will determine the scope of protection of the divisional claims.

In view of the above, when there is any interest in filing divisional applications in Brazil, it is advisable to file before the request for examination of the parent application is submitted in order to avoid the limitations of Article 32.

Deadline for filing Brazilian divisional applications

Another topic of great importance regarding the procedures for filing divisional applications in Brazil is the time limit to submit the request for the division of an application.

Determining the exact deadline for filing divisional applications in Brazil is a complex matter. Unlike many jurisdictions in which it is allowed to file divisional applications at least as long as the parent application is pending, meaning that even after the issuance of the notice of allowance of the parent application it is permitted to divide the application, the Brazilian PTO does not accept the submission of divisional applications after the Notice of Allowance of the parent application.

The time limit for filing a divisional application in Brazil is the end of examination in the first instance, which means that the issuance of a Notice of Allowance or a Notice of Rejection will, in fact, prevent the filing of a new divisional application, even if the Rejection Decision is reversed in the future. The Notice definitely abandoning the parent application also prevents the filing of a new divisional.

Therefore, considering that the parent application may be allowed without the issuance of official actions, if the request for examination for the parent application was already submitted, it is always advisable to file the divisional as soon as possible, in order not to miss the deadline.

Briefly speaking, the following are the most important aspects in connection with divisional patent applications in Brazil:

- A parent application may be divided upon the Applicant's request, even in the case where the application presents a group of inventions connected by the same inventive concept; or in compliance with a technical report when the technical examination determines that the application contains a group of inventions comprising more than one inventive concept, or more than a utility model;
- The divisional application cannot exceed the matter disclosed in the parent application, the analysis of which will depend directly on whether the request for examination of the parent application was already submitted;
- It is not possible for a Brazilian divisional application to have claims, which either overlap with or are broader than the claims of the parent application;
- It is not allowed to file a divisional application of previous divisional applications;
- A divisional application must be filed before the issuance of the Notice of Allowance, Notice of Rejection or the Notice definitely abandoning the parent application.