

Brazil
in English

Report Q. 189
by the Brazilian Group

Amendment of patent claims after grant (in court and administrative proceedings, including re-examination proceedings requested by third parties)

Questions

The Groups are invited to answer the following questions under their national laws:

I) Analysis of current legislation and case law

- 1) Does your national law permit post-grant amendment of patent claims? Are utility models – if available – treated the same way as patents or differently? If so, what are the differences?**

Yes, post-grant amendments are possible.

Patents and utility models are treated as far as possible in the same manner.

- 2) Who is entitled to request post-grant amendment of patent claims under your national law?**

The Patent Office or any person with a legitimate interest can start the annulment proceedings, this being the only manner foreseen in the law to change a patent after it is granted.

- 3) What is the procedural framework for requesting post-grant amendment of patent claims under your national law, in particular:**

– What procedures (judicial, administrative or other) are available for dealing with requests for post-grant amendment of patent claims under your national law?

The only manner to change a patent after it is granted is by requesting the annulment thereof.

The law foresees that annulment may affect only some of the claims. Therefore, the patent may persist with only those claims that are not annulled.

It is also possible that during administrative annulment proceedings the claims are individually restricted. The amended claims will be substituted in the patent by means of an apostil.

In the not so distant past, administrative custom also allowed correcting formal mistakes in the patent by means of an apostil. A specific request was presented to the PtO, which would normally admit the amendment, as long as the scope of the claims was not expanded. More recently, though, the administration stopped considering such requests.

– Are all of these procedures freely available under your national law to those wishing to request post–grant amendment of patent claims, or does the law give priority to certain procedural measures in certain situations?

National law grants to the Patent Office itself, or any person with a legitimate interest, the right to start either administrative or judicial annulment proceedings.

However, the statute limits the period in which administrative proceedings can be started to 6 (six) months from the date of the grant. On the other hand, court proceedings can be started at any time of the life of the patent.

It is also worth mentioning that the Patent Office will abstain from deciding any matter which is being simultaneously considered by the courts.

– Is it possible under your national law for patentees to make multiple subsequent amendments of patent claims directed towards individual alleged infringers?

No.

– Who is entitled to amend claims? Is this limited to courts or do also the patent offices have the competence to amend claims? Please limit the answer to a general description of the proceedings avoiding discussion of procedural details and peculiarities.

Both the courts and the patent office can change the claims.

4) What are the substantive conditions for allowing post–grant amendment of patent claims under your national law, in particular:

– Is there a distinction in your national law between the remedies available to patentees/third parties and/or the substantive conditions applicable to patentees/third parties for allowing post-grant amendment?

No distinction is foreseen in the law, which simply refers to a “person with a legitimate interest”.

– In what ways may patent claims be amended post grant under your national law?

Patent claims can be annulled. The annulment may affect just some of the claims of a patent. The claims that persist must constitute by themselves patentable matter.

Patent claims can be redrafted so as to be restricted in scope.

– Is it a requirement (or a possibility) under your national law that the description/ specification be amended to correspond with amendments of the claims?

The possibility does exist.

– Is it possible to make amendments for the purposes of clarification and/or correction of errors?

As previously stated, the Patent Office is not currently considering such requests. However, in the past, the possibility existed as an administrative custom.

5) What are the consequences for third parties of post-grant amendments of patent claims under your national law, in particular:

– What are the consequences for third parties' liability for patent infringement where patent claims are amended post grant?

This will depend on the forum in which the amendment is carried out – see below.

– Are amendments effective only *inter partes* or, conversely, *erga omnes*, including in relation to previously decided cases?

Amendments carried out either by the Patent Office or by a Federal Court in a revocation action are effective *erga omnes*, but they do not apply to previously decided cases. Amendments carried out by a State Court in an infringement action are effective *inter partes*.

– Are amendments effective only *ex nunc* or also *ex tunc*? Does that depend on the context in which the amendment is made?

Amendments are effective *ex tunc*.

II) Proposals for substantive harmonisation

The Groups are invited to put forward their proposals for adoption of uniform rules, and in particular to consider the following questions:

6) Should post-grant amendment of patent claims be permitted?

Yes.

7) Who should be entitled to request post-grant amendment of patent claims and who should have the competence to amend?

Anyone with a legitimate interest should be allowed to request the amendment.

In Brazil, no one can be prevented from submitting a matter to the courts. However, in view of the undeniable practicality of the administrative proceedings when compared to the judicial ones, the Patent Office should be an option to patentees/third parties, at least for a certain period of time after the grant.

8) What should be the substantial conditions for allowing post-grant amendment of patent claims?

A patent should always comply with the substantive patentability requirements and the scope of protection should be commensurate with the contribution the invention represents to the art and should not extend beyond the matter initially disclosed in the application.

The possibility to amend the claims should be conditioned to these two criteria.

9) Should there be a distinction between the remedies available to patentees/third parties and/or the substantive conditions applicable to patentees/third parties for allowing post-grant amendment?

No. The proper balance between the interests of the patentee and those of the society would not allow such a distinction.

10) What should be the consequences for third parties' liability for patent infringement where patent claims are amended post grant?

Again, for a proper balance between the interests of the patentee and those of the society to be achieved, any post-grant modification in the patent claims should have an effect *erga omnes* and *ex tunc*.

11) Does your Group have any other views or proposals for harmonisation in this area?