

Patent Prosecution and Enforcement in Brazil

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HISTORY OF DANIEL ADVOGADOS

- Over 70 years of experience and tradition in Intellectual Property;
- Daniel firm originally began in 1940 as the Patent and Trademark Department of the Law Office Carl Kincaid in Rio.

OUR OFFICE LOCATIONS



Rio de Janeiro



São Paulo

OUR STRUCTURE

| | |
|----------------------|----------------------------|
| ● Partners | 24 |
| ● Patent Engineers | 12 |
| ● Staff | 100 |
| ● Foreign Associates | 100 |
| ● Offices | Rio de Janeiro & São Paulo |

MAIN AREAS OF PRACTICE

- ◉ Patents
- ◉ Trademarks
- ◉ Contracts
- ◉ Unfair Competition
- ◉ Litigation
- ◉ Domain Names
- ◉ Franchising
- ◉ Copyright
- ◉ Software
- ◉ Comparative Advertising

CLIENT SUPPORT STRUCTURE

Partner Responsible



Team

Partner Responsible – Substitute
Prosecution Attorney – Patents
Prosecution Attorney – Trademarks
Litigation Attorney
Paralegal Staff

SOME OF OUR CLIENTS

- Amil
- Kimberly-Clark
- Philips
- Oi
- Vallée
- Whirlpool
- Abbott
- Avon
- Baxter
- Bristol
- Dow Chemical
- Exxon-Mobil
- Goodyear
- GSK
- Honda
- Kissei Pharmaceuticals
- Kraft Foods
- Microsoft
- Pfizer
- Philips
- Scania
- Shell
- Technicolor
- Toyota

PATENTABILITY REQUIREMENTS IN BRAZIL (Art. 8)

- ◉ Novelty = Absolute novelty;
- ◉ Inventive Step = the invention cannot be derived evidently or obviously from the State of Art;
- ◉ Industrial Application = inventions that can be used or produced in any type of industry;

GRACE PERIOD

Article 12 of Brazilian IP law provides that the disclosure of an invention shall not be considered as state of the art if it occurs during the twelve (12) months preceding the filing date or priority date of a patent application, when made by:

- ❖ The inventor;
- ❖ The Brazilian PTO through the official publication of the patent application filed without the consent of the inventor, based on information obtained from him or resulting from his acts;
- ❖ Third parties, on the basis of information obtained directly or indirectly from the inventor or results from his acts.

- ❑ **DIVISIONAL** - When the patent application relates to more than one inventive concept, before conclusion of technical examination, it may be divided ex-officio or at request of applicant into two or more applications.
- ❑ **FILING OF OBSERVATIONS** - From publication of application until conclusion of examination, interested third parties may submit documents and information to support examination.
- ❑ **VOLUNTARY AMENDMENT** - Up to time examination is requested. Amendments should be limited to better define or clarify invention. **SUBSTANTIVE EXAMINATION** - Within a term of 36 months.
- ❑ **EXPEDITED EXAMINATION**

- ❑ **REINSTATEMENT OF APPLICATION** - 60 days from publication of shelving of application.
- ❑ **FORMAL OFFICE ACTION** (objections and prior art and corresponding patents) - 60 days.
- ❑ **OFFICE ACTION/UNFAVORABLE OPINION** (Reply to Examiner's opinion) - 90 days.
- ❑ **ADMINISTRATIVE NULLIFICATION PROCEEDINGS** - Nullity is based on failure to comply with legal requirements / Subject matter extends beyond contents of application originally filed, lack of novelty and/or inventive step.

PATENT OBLIGATIONS PENALTIES.

WORKING/COMPULSORY LICENSES

- What constitutes working in Brazil.
- When is compulsory license granted.

I - Abuse of economic power.

II - Failure to effectively work the invention in Brazil.

OTHER USE WITHOUT AUTHORIZATION OF PATENTEE.

III - Patent dependency.

IV - Public interest/national emergency.

- ▶ *Article 68 - 74 of Brazilian Patent Law (BLP)*

PATENT ENFORCEMENT

WARNING LETTERS

- ❖ Cost Effective measure to stop infringement and avoid court actions.
- ❖ Warning letter may be served through Registry of Titles and Deeds; or

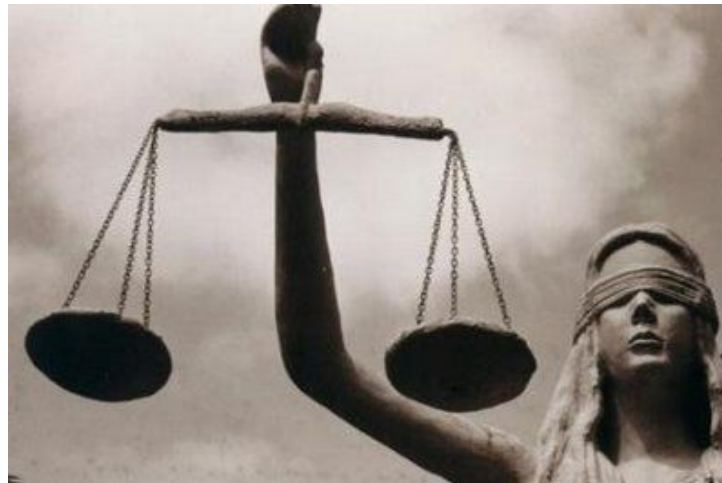


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PATENT ENFORCEMENT

WARNING LETTERS

- ❖ Via the Courts requesting the cessation of infringing activities (Court Officer)
- ❖ Decision to serve the infringer is a strategic one and has to be analyzed on case by case basis.



PATENT ENFORCEMENT

PRELIMINARY INJUNCTIONS

Requirement for obtaining ex parte search and seizure order of infringing products.

1) *Fumus boni juris*

2) *Periculum in mora*

3) In civil law, a preliminary injunction can be requested and granted at any time and even before Defendant comes aware of action.



PATENT ENFORCEMENT

EVIDENCE

- I) Personal deposition of parties;
- II) Statement of witnesses;
- III) Documentary evidence;
- IV) Expert evidence;
- V) Judicial Inspection (papers relating to infringement, specimens)



PATENT ENFORCEMENT

EVIDENCE

Under Brazilian Code of Civil Procedure all evidence should be morally legitimate.

- ❑ Plaintiff => Produces its evidence in the complaint.
- ❑ Defendant => Produces in its response

Request for oral evidence will be considered by Judge at any stage of proceedings.

PATENT ENFORCEMENT

ENFORCEMENT OF FIRST INSTANCE JUDGEMENT

- ❖ Competent Court,
- ❖ Posting of Bond,
- ❖ Evidence of infringement if injunction is sought with main action,
- ❖ Action to compensate damages to Patentee.

PATENT ENFORCEMENT

DAMAGES

- ❖ Valid Patent.
- ❖ Existence of Damages has to be shown in cognitive stage of proceedings.

CALCULATION OF DAMAGES

- ❖ *Damnum Emergens (Damages caused to Plaintiff)*
- ❖ *Lucrum Cessans (Lost Profits)*

PATENT ENFORCEMENT

DAMAGES

- ❑ Benefits that injured party would have gained had the infringement not occurred; or
- ❑ Benefits that were gained by infringer of the right; or
- ❑ Remuneration that infringer would have paid to holder of infringed right by grant of a license that would have legally permitted the use of right

CHANCES OF SUCCESS

- ❑ Judges - Pro-Patents or Not?
- ❑ Facts - Clear Cut.
- ❑ Strong Claims.
- ❑ Evidence of Infringement.
- ❑ Where to litigate.



PATENT LITIGATION

COMPETENT COURTS

- ✓Federal Justice Courts.
- ✓Federal Government or any of its entities.
- ✓State Justice Courts.
- ✓Private Parties.

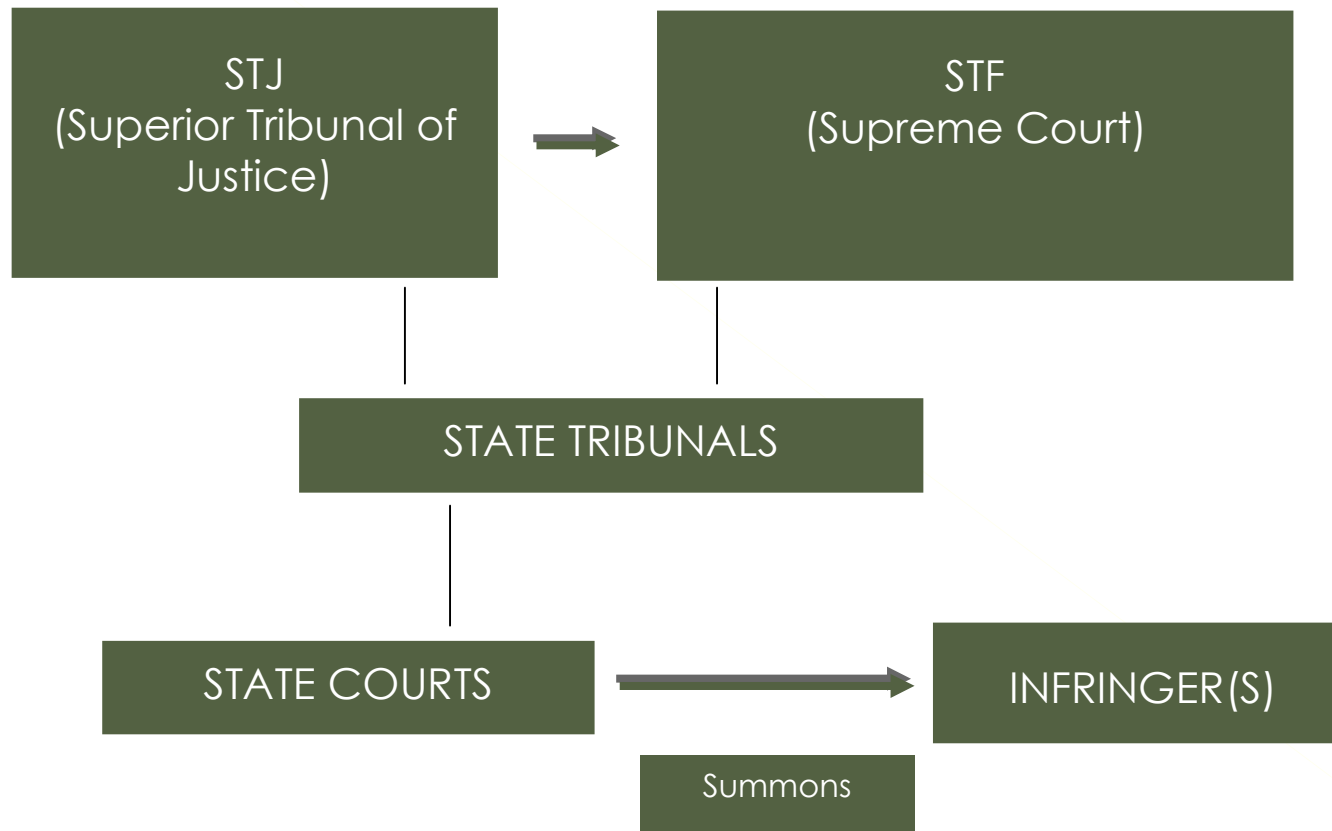
SECOND INSTANCE COURTS

- ✓Regional Federal Tribunals
- ✓Tribunals of Justice (winning party can execute Judgement at own risk)
- ✓“Provisional” Execution.

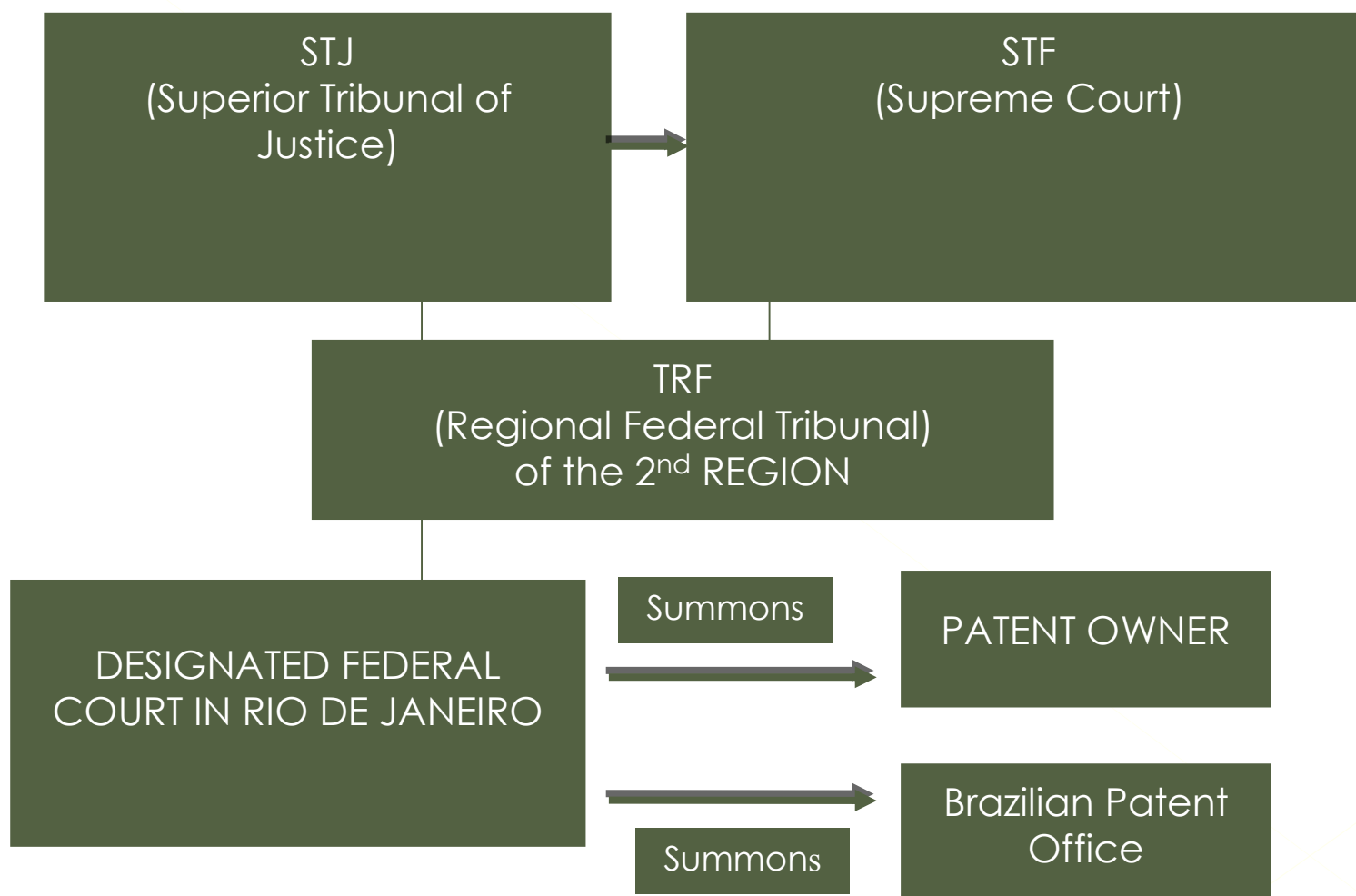
PATENT LITIGATION

- ✓ Superior Tribunal of Justice.
- ✓ Supreme Court.
- ✓ Jurisdiction of Superior Courts is determined by content of Appeal
- ✓ Special Appeals – STJ
- ✓ e.g. Infringement of a Federal Law or treaty, etc
- ✓ Extraordinary Appeals => Supreme Court
- ✓ e.g. grounds would be that decision infringes Federal Constitution

COURT STRUCTURE FOR PATENT INFRINGEMENT ACTIONS IN BRAZIL



COURT STRUCTURE FOR PATENT ANNULMENT ACTIONS IN BRAZIL



DESIGNS IN BRAZIL

Protection →
10 Years + 3 x 5 Years = 25 Years





Application

20 Variations

- Application shall refer to one single Design
- Plurality of variations are permitted provided that they are intended for same predominant distinctive characteristics.

APPLICATION FOR REGISTRATION (Documents)

- Petition
- Specification when there are more than one variation.
- Drawings or Photographs
- Field of application of design, and
- Proof of payment of filing fee.

INDUSTRIAL DESIGNS

- ◉ Partial Designs are not accepted
- ◉ Parts of Designs are accepted provided that:
 - > the part is separately manufactured;
 - > the part is separately sold/commercialized.

FORMAL REQUIREMENTS

- ◉ Line drawings are preferable in lieu of photos
- ◉ Drawings should not include:
 - dashed/phantom lines;
 - auxiliary lines;
 - filling/shading

PROSECUTION

- ◉ Designs are actually being granted within one year counted from the filing date;
- ◉ Designs do not undergo technical examination as to requirements of novelty and originality;
- ◉ Examination may be requested by the applicant after the design is granted;
- ◉ No provision of partial nullity – if a variation is considered to be null, the whole application will be nullified.

Thank you

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ありがとうございました

- ◎ ご質問等ございましたら、下記までお気軽にお問い合わせください

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