

BRAZIL:

BRPTO published the First official list of Patents affected by the Supreme Court Decision

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As previously reported, the Brazilian Federal Supreme Court (STF) judged an action filed by the Attorney General's Office (PGR) regarding the sole paragraph of Article 40 of the Industrial Property Law – LPI (Law nº 9.279/79). Said paragraph established that the term of a patent would not be less than ten years for patents and seven years for utility model, counting from the granting date. The STF decided the sole paragraph of Article 40 of the Brazilian IP Law was unconstitutional.

A recent new decision establishes how this is to be applied to patents granted while the sole paragraph of Article 40 was in effect. In general terms, this decision will have ex nunc effects, meaning that those patents already granted before the publication of the final hearing minutes with the 10-year minimum term of protection from grant, will remain valid. There are, however, exceptions, as the effect will be ex tunc (retroactive) for the following:

- Patents encompassing pharmaceutical products and processes, and equipment and/or materials for use in health;
- Patents with pending invalidity lawsuits grounded on the unconstitutionality of the sole paragraph of Article 40 and lodged until 7 April 2021.

The Brazilian PTO published on the Official Bulletin No.2628, dated 18 May 2021, the first list of patents affected by this STF decision. Furthermore, the BRPTO also published a standard methodology to identify affected patents related to the pharmaceutical field. Such methodology includes the following:

- Patents sent to ANVISA (*acronym* in Portuguese for Brazilian National Health Surveillance Agency) for prior approval, related to the article Art. 229-C of the Brazilian IP Law;
- Patents having at least one of the following International classifications: A61B, A61C, A61D, A61F, A61G, A61H, A61J, A61L, A61M, A61N, or H05G, (considered by WIPO as related to medical-technologies);
- Patents having at least one of the following IPCs: A61K/6, C12Q/1, G01N/33, G16H;
- Patents with published lawsuit decisions (specifically published under the code 19.1);
- Certificates of addition related to patents “for use in healthcare”, as mentioned by the Supreme Court decision.

Additional lists of patents affected by the STF decision will be provided in forthcoming BRPTO Bulletins. We will keep you informed.

We remain at your full disposal should you need any further information.