

Chapter

Comparative Analysis of Appeal Procedures in the European, American and Brazilian Patent Offices

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Abstract

The right to appeal exists as a response to the two main characteristics of every human being. The first refers to the attitude of not settling for adverse decisions, which leads people to seek instruments to remediate these decisions, while the second is the possibility that every human being has to make mistakes and the need to correct these mistakes in decision-making acts that may have been mistaken. Therefore, an appeal is an instrument that enables review of a decision by a higher authority to obtain its modification or revocation. In the patent system, appeals are used basically to reverse decisions of patent examiners during the examination procedure as, for example, the decision to reject a patent. Although all patent offices have procedures for appeal against first-instance decisions taken by these offices, there are significant differences as to how this procedure is conducted in each office. This chapter will study the laws and regulations, rules and procedures on appeals in two of the main patent offices in the world – the European Patent Office – EPO and the United States Patent and Trademark Office – USPTO, and in the Brazilian Patent Office – INPI, pointing out the main differences between them.

Keywords: appeal, patent, patent examination, industrial property, patent offices

1. Introduction

The right to appeal, in general, exists in several legal systems around the world responding to the two main characteristics of every human being. The first refers to the attitude of not settling for adverse decisions, which leads people to seek instruments to remediate these decisions, while the second is the possibility that every human being has to make mistakes and the need to correct these mistakes in decision-making acts that may have been mistaken [1].

Thus, an appeal is an instrument allowing for review of a decision made by a hierarchically higher instance aiming at its change or reversal. Appeals serve both as a process for correcting defective acts and as a process to find the actual and proper interpretation to a certain law or rule.

In the patent systems, appeals are primarily used to change or reverse an adverse decision by a first-instance patent examiner upon examination of the patentability of an application. This examination verifies compliance by the application with the legal provisions to become a patent. Among these provisions, attention is called to patentability requirements – novelty, inventive step, and industrial applicability – and patentability conditions – sufficiency of disclosure, clarity and/or support for the claims. When the patent examiner understands that any of these legal requirements and/or conditions is not met, the patent application is rejected.

Upon rejection of a patent application, a period for appeal against this decision begins. In the appeal procedure, a board of appeal or appeal division reviews the decision, taking the reasons that supported the first-instance administrative decision and the arguments of the parties into account, as to achieve a more proper decision for such case.

All patent offices have procedures for appeal against first instance administrative decisions taken by these offices, which are governed by specific laws, rules, and procedures. This chapter will study how appeals work in two of the main patent offices in the world, the European Patent Office – EPO and the United States Patent and Trademark Office – USPTO and in the Brazilian Patent Office – INPI, pointing out the main differences between them.

2. European patent office

The first relevant point of appeal procedure in the European patent system is that, unlike in the USPTO and INPI, appeals are not administrative proceedings. Although they exist in the EPO organizational structure, they are legal procedures under the responsibility of the boards of appeal [2, 3].

Boards of appeals are the second and final instances of the EPO, being independent of such office and only governed by the European Patent Convention (EPC). They are divided into four boards: enlarged board of appeal; legal board of appeal; technical boards of appeal; and disciplinary board of appeal.

Any party to the first-instance proceedings that led to the contested decision and that have been adversely affected by a decision of the receiving section, examining divisions, opposition divisions, and the legal division of the EPO may appeal to the Boards of Appeal.¹ In this regard, appeals may be divided into *ex parte* procedures, i.e., there is only one party to the appeal procedures, and *inter partes*, i.e., there are two or more parties to the appeal procedures. *Inter partes* appeal procedures occur when appealed decisions are taken by the opposition divisions, while *ex parte* procedures occur when the decisions are taken by the examining division. When there is more than one party to the appeal, the party filing the appeal is called the appellant, while the other parties are “parties of right” [2–4].

Although decisions taken by any of the EPO departments already mentioned can be appealed, technical decisions related to the patentability of a patent application or a patent already granted are those taken by the examining and opposition divisions. Examples of these types of decisions are those rejecting a patent application, in case of examining divisions, or decisions to revoke a patent or reject an opposition, in case of opposition divisions. It is worth noting that the European patent

¹ Articles 106 and 107, EPC.

system, unlike Brazil, allows for filing an appeal against the granting of a patent in cases in which the grant was based on a text not previously approved by the applicant [4].

Appeals in the European patent system have suspensive and devolutive effects. The suspensive effect suspends the effects of the appealed decision until a decision on the appeal is rendered by the boards of appeal. For example, if the opposition division decides to cancel a patent and the patentee files an appeal, the patent shall continue having its effects until the boards of appeal take a decision. On its turn, the devolutive effect, except for the interlocutory revision procedure to be addressed below, transfers the power to decide such case from the first-instance examining division to the boards of appeal [3].

Three actions are required to begin the appeal procedure: (a) filing of a notice of appeal within two months of notification of the appealed decision; (b) payment of an appeal fee, within the same period; and (c) within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed.² If the appellant fails to file the notice of appeal or to pay the fee within the established period, the appeal is deemed not filed [2, 4].

Once the appeal is filed, in case of *ex parte* procedures, it is forwarded to the division responsible for assessing the possibility of an interlocutory revision.³ This procedure consists in an evaluation of the appeal by the examining division responsible for the appealed decision itself. If this division considers the appeal to be admissible and well-founded, it may rectify its decision or, if new objections are raised and not previously discussed, proceed with the examination. Three reasons, for example, may explain a change in a decision under appeal by the own first-instance division responsible for the decision: (a) the division made a mistake by not considering a certain part of the material available; (b) the division did not receive the material filed within the EPO on time due to an error by the EPO itself, or; (c) the division's decision is not incorrect, but the presentation of new evidence, facts, or changes in the application overcomes the objections that led to the appealed decision [5].

Nonetheless, if the appeal is not examined or allowed by the examining division within three months of receipt of the statement of the grounds of appeal, it shall be remitted to the Board of Appeal without delay, and without comment as to its merit. As it only applies to *ex parte* procedures, this mechanism is not valid for decisions by the opposition divisions that, as already mentioned, always have at least two parties, the opponent and the patentee. If the appeal is received by the boards of appeal, the examining division cannot interfere thereon anymore. The mechanism of interlocutory revision is very useful to prevent cases that can be easily reversed from getting to the boards of appeal, saving quite some time.

Upon filing of the appeal, it will be examined for admissibility and, among other factors, the following points will be assessed: (a) if the decision is appealable, (b) if the appellant has the right to appeal, (c) if the deadlines were respected, (d) if the fee was paid, (e) if the notice of appeal and the statement of grounds meet the requirements in Rule 99 of the EPC [2, 4].

The statement of grounds of appeal shall contain a party's complete appeal case. Accordingly, it shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, and should specify expressly all the facts,

² Article 108 of the EPC.

³ Article 109 of the EPC.

arguments and evidence relied on.⁴ Pursuant to rule 12 [4] of the rules of procedure of the boards of appeal (RPBOA), these boards may use their discretion when admitting new submissions in the appeal procedure, i.e., when admitting facts, evidence, and/or objections not submitted during the first-instance procedure. Nonetheless, such submissions should be made preferably at the beginning of the appeal procedure, and the acceptance thereof by the board of appeals during the second-instance proceeding is at the board's discretion. In this sense, these boards have been adopting a restrictive stance in accepting late submissions. In order to accept or not late submissions to the appeal procedure, the boards consider, among others, the following factors: the stage of processing of the appeal or whether the submission is detrimental to procedural economy and the complexity of the case⁵ [6].

Some other principles not expressly defined in the EPC or the RPBOA, but that were established by decisions of the enlarged board of appeal, have been governing the appeal procedure in Europe. One of these principles establishes an important distinction between decisions by examining divisions and those by opposition divisions. When appeals come from opposition divisions, the boards of appeal cannot examine reasons that were not presented by the opponent during the first-instance proceeding and/or were not discussed by the opposition divisions, unless expressly authorized by the patentee. Nonetheless, the same restriction does not apply if the opposed decision is taken by the examining divisions, as in the case of an application rejection decision. In these cases, appeals are not restricted to the reasons that led to rejection of the patent application, and the boards of appeal may broaden their examination to patentability requirements or conditions that were not discussed at first instance.

During the appeal phase in the EPO, oral proceedings may occur at the request of the EPO itself or at the request of any other party to the appeal. When oral proceedings occur during the appeal, they are public, unlike those occurring before the examining divisions.⁶ In cases of oral proceedings, the Board of Appeal may provide a preliminary opinion on the matter within four months of this proceeding, enabling the appellant to assess its chances of success in the appeal.⁷

Regarding the powers of the boards of appeal in deciding appeals, article 111 (1) of the EPC determines that the boards may either exercise any power within the competence of the first-instance department which was responsible for the decision appealed or remit the case to that department for further prosecution. At this point, article 11 of the RPBOA advises the board not to remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons [2, 6]. The decisions of the boards of appeal are unappealable. Nonetheless, as an exception, it is possible, under certain conditions, to request review by the enlarged board of appeal.⁸

Figure 1 shows a schematic presentation of the procedures for appeal against rejections in the EPO.

⁴ Article 99 (2) of the EPC and Article 12 (3) of the RPBOA.

⁵ Article 13 of the RPBOA.

⁶ Article 116 of the EPC.

⁷ Article 15 of the RPBOA.

⁸ Article 112a of the EPC.

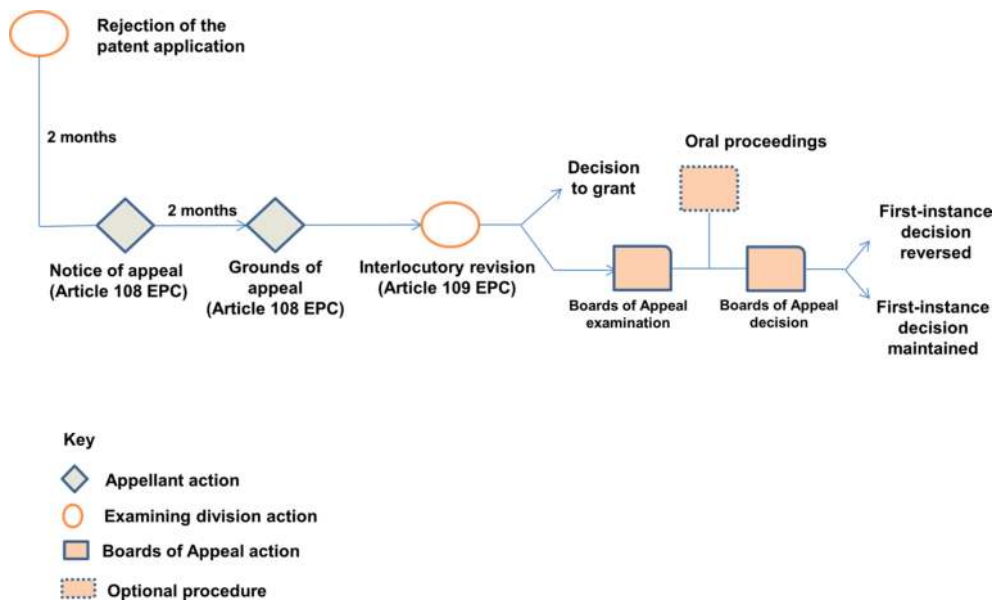


Figure 1.
 Schematic representation of the procedure for appeal against rejection in the EPO.

3. United States patent and trademark office

An important difference of the United States patent system compared to the Brazilian system, for example, is the fact that several are the possible paths in the USPTO after a second or subsequent rejection of some claims in a patent application. The applicant may file a request for continued examination (RCE),⁹ file for an amendment after final (AAF),¹⁰ abandon the application, apply for a continuation-in-part,¹¹ or file a request for appeal [7, 8].

Appeals in the United States patent system aim to review objections related to the patentability of claims in a patent application and may be filed after a second action by the office rejecting some of these claims. These procedures, at the administrative level of the USPTO, are conducted by three administrative judges of the Patent Trial and Appeal Board (PTAB), which is the second-instance administrative body responsible for patents in this office. These judges must be people with technical and legal knowledge. The duties of this Board are: (a) to review decisions rejecting claims in patent applications; (b) to review reexamination appeals;¹² (c) to conduct derivation proceeding,¹³

⁹ Request for Continued Examination (RCE). This is a request to reopen the processing of the patent application yet at first instance through the payment of a specific fee, where the examiner will evaluate the changes in the claims and the arguments presented [8].

¹⁰ Amendment after final (AAF). It is the filing of amendments to claims. This procedure, unlike the RCE, is free of charge; however, the examiner has little time to examine it [8].

¹¹ Continuation-in-part. A request for continuation of an original patent application, where a new matter or new claims are included in the application. This procedure does not end the first-instance proceeding for the new matter included.

¹² Reexamination. Procedure that can be requested by anyone, at any time during the term of a patent, aiming at reviewing a patent already granted.

¹³ Derivation proceeding. This is a trial proceeding conducted at the Board to determine whether (i) an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner's application, and (ii) the earlier application claiming such invention was filed without authorization.

(d) to conduct *inter partes* review;¹⁴ and post-grant review.¹⁵ Each of these procedures is conducted by a jury composed of at least three members of the board, who shall be appointed by the Director [9].

The USPTO's appeal procedure begins with the submission of a notice of appeal and payment of the required fee within no more than six months after the decision denying the patentability of the claims. Then, within a period of two months, which can be extended in exceptional situations for up to five months, the appeal brief must be filed with the office, including, in addition to the applicant's arguments regarding each of the objections raised by the examiner, other information, such as the name of the interested party, a concise explanation of the matter defined in each independent claim that has been rejected, and an appendix containing a copy of the claims under appeal [10].

A pilot program in progress at the USPTO provides the possibility of filing a pre-appeal request with the notice of appeal, where the applicant may request a review of the decision rejecting the claims. This request may not exceed five pages and must provide a series of succinct, concise, and focused arguments explaining the reasons why the review is being requested. This request is assessed by a panel of three examiners, including the examiner responsible for the decision to reject the claims. There are four possible outcomes for this review: (a) the request will continue under appeal, as the reasons were not sufficient; (b) the first-instance proceeding will be reopened; (c) the claims are accepted and, (d) the pre-appeal request does not meet the requirements and is disregarded [9].

After the appeal brief is filed with the USPTO, it does not immediately enter the jurisdiction of the appeal board. Appeals are first examined at an appeal conference, whose participants are the examiner responsible for the decision to reject the claims him/herself, his/her supervisor, and a third examiner who is able to consider the merits of the matter under appeal. After this procedure, the examiner may introduce new objections to reject the claims and reopen the case at first instance, may reverse the decision denying the claims, or may maintain the appeal, preparing a written response to the reasons for appeal. This reply must discuss all grounds for the challenged decision, enabling the examiner to add new objections to the request, if applicable.

After filing a notice of appeal with the USPTO, the filing of amendments to the application is not a matter of right. For acceptance of such amendments, two deadlines shall be considered and certain criteria shall be met. In the case these amendments are filed on the date or after the notice of appeal and before the appeal brief, such amendments may be accepted, as long as: (a) they cancel claims or comply with any requirement of form expressly set forth in a previous Office action; (b) they present rejected claims in better form for consideration, (c) they show good and sufficient reasons why the amendment is necessary and was not earlier presented.¹⁶ Amendments filed on or after the date of filing a brief may not make substantive amendments to the claims, but may be admitted: (a) to cancel claims, where such cancelation does not affect the scope of any other pending claim in the proceeding, or (b) to rewrite dependent claims into independent form.¹⁷ Amendments to the application are not accepted after the appeal enters the jurisdiction of the PTAB [10].

Like the filing of amendments to the application, the filing of new evidence or testimonies for inclusion in the application follows certain rules. If these amendments are

¹⁴ *Inter partes* review. It is a trial proceeding conducted at the Board to review the patentability of one or more claims in a patent based on novelty and inventive step and only on the basis of prior art consisting of patents or printed publications.

¹⁵ Post-grant review. It is a trial proceeding conducted at the Board to review the patentability of one or more claims on any ground and any matter of the prior art.

¹⁶ 37 CFR § 1.116.

¹⁷ 37 CFR § 41.33.

filed at the time of or after filing the notice of appeal, but before the appeal brief, these amendments may be accepted if the examiner understands that: (a) such evidence and/or testimonies surpass all objections under appeal; (b) show good and sufficient reasons as to why the amendment is necessary and was not previously filed. In all other cases, they shall be rejected. New evidence may not be filed together with the brief.

In case a new objection to the application is added to the examiner's written response to the appeal brief, the appellant has two options: apply for a reopening of the proceeding at first instance or request that the appeal is maintained by filing, within two months, a reply to the examiner's opinion. Only after expiration of the deadline to file the reply with the office, the appeal is forwarded to the PTAB. In this reply, no amendments to the claims or new evidence are admitted.

In the American patent system, the appellant may request oral proceedings in circumstances in which the appellant thinks it is necessary or desirable for proper understanding of the appeal. This request is made in writing and shall be accompanied by the payment of a fee, within two months of the date of the examiner's response to the appeal brief, or on the date of filing of his/her reply.

After submission of the reply to the examiner's opinion, with or without oral proceedings, the three PTAB judges shall render the final decision, issuing a written decision, whose outcomes may be: (a) affirmance, a situation in which the examiner's decision of rejecting the claims is fully confirmed; (b) affirmance-in-part, a situation in which the examiner's decision of rejecting at least one of the claims is confirmed, but not all; (c) reversed, when the decision of denying the claims is not confirmed, and (d) new grounds for rejection, a situation in which the PTAB judges understand there are additional reasons for which at least one of the claims is not patentable. In this last case, the appellant has two options: apply for reopening of the proceeding at first instance and file amendments or evidence deemed necessary, or request a review of the case. In the review, the appellant shall define specifically where he or she believes the appeal board was mistaken.

Figure 2 shows a schematic presentation of the procedures for appeal against rejection in the USPTO.

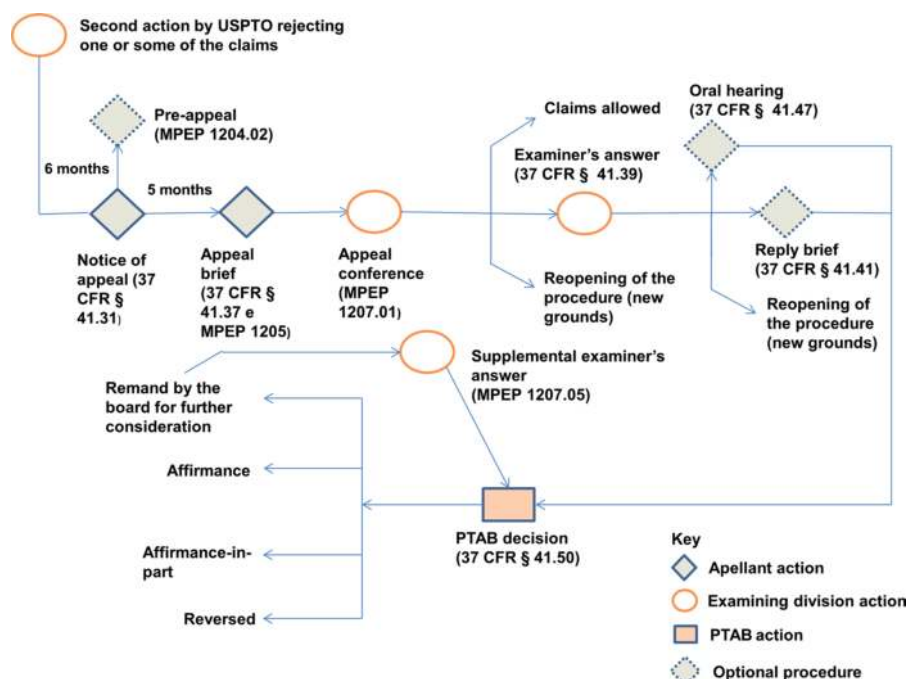


Figure 2. Schematic representation of the procedure for appeal against rejection in the USPTO.

4. Brazilian patent office

In the Brazilian patent system, the instrument for administrative appeals is provided for in chapter 1 of title VII of Law No. 9,279 of 1996, the Brazilian IP Law (LPI). This chapter of the aforementioned Law addresses the applicable appeals against decisions rendered by INPI, therefore including decisions related to patent applications [11].

Appeals are filed voluntarily by anyone feeling aggrieved in their rights by a decision determining rejection of a patent application, aiming at changing such decision. This filing is made in up to sixty days after the decision rejecting the application is published in the Industrial Property Gazette (RPI),¹⁸ through a written petition, observing the administrative principles of publicity and formalism [12].

Paragraph 2 of Article 212 of the LPI makes two important reservations about situations in which it is not possible to appeal against the INPI decisions regarding a patent application. The reservations are as follows: a decision determining the final dismissal of a patent application and a decision accepting the patent application. Therefore, it is clear, regarding the decisions on patentability of a patent application, that only decisions determining rejection of a patent application are subject to appeal [11].

Administrative appeals in the Brazilian patent system have suspensive and full devolutive effects, applying all provisions pertinent to examination in the first instance, in so far as they are applicable. The suspensive effect interrupts the effects of the contested act since the filing of the appeal until final decision, aiming to safeguard the right of the applicant and protect him against the damaging effects resulting from the appealed decision. The two major practical consequences of the suspensive effect are the interruption of the period of prescription¹⁹ and the impossibility of filing a lawsuit against the act to be challenged while there is no decision on the appeal [13, 14].

On its turn, full devolutive effect means that the decided matter is fully referred to a higher hierarchical authority for acknowledgement and decision, which for INPI is represented by the President of the independent agency. This implies full review of the merits of the patent application under analysis by a second administrative instance coordination. In this case, as all relevant provisions applied in the examination at first instance are still valid, second-instance examiners may suggest amendments to the application, carry out new searches, and raise new objections to the application, even if these have not been discussed at first instance. Accordingly, the appellant is allowed, at second administrative instance, to come up with new evidence favoring the application patentability, and amend the specifications and its patent claim scope, as long as the same are limited to what was initially disclosed.

In the Brazilian patent system, third parties may be a party to administrative appeals under patent applications. The period therefor is sixty days, and the counter-arguments petition shall be filed under the appeal²⁰ [11, 12].

¹⁸ The Industrial Property Gazette (RPI) communicates all INPI decisions to the general public by means of decision codes.

¹⁹ The 5-year period for filing legal actions is interrupted.

²⁰ Article 213, LPI. Interested parties shall be summoned to file, within sixty (60) days, counter-arguments under the appeal.

Although decisions on appeals are the responsibility of the President of INPI, as these decisions involve technical matters related to many technologies, the substantive examination is actually performed by a specific coordination office reporting directly to the INPI Presidency – the General Coordination Office for Administrative Invalidation Proceedings and Appeals (CGREC). This coordination office is responsible, therefore, for the administrative processing of patent applications at second administrative instance, for matters related to industrial property.

The two main duties of CGREC are: the issuance of expert opinions in intellectual property matters to support the President of INPI, which is the authority competent by law to register them, and the search to consolidate an administrative case law on the matter²¹ [15].

CGREC is currently divided into three technical coordination offices and one administrative support division. The CGREC division that deals with patents at second administrative instance is the Technical Coordination for Appeals and Administrative Invalidation Procedures for Patents (COREP), which is composed of eighteen patent examiners [16].

The following section shall present the administrative processing of patent applications at second instance in INPI.

4.1 Second-instance administrative proceedings for patent applications at INPI

Once a patent application has been rejected at first instance, the applicant may file an appeal, what must be done in up to sixty days, according to article 212 of the LPI. In case the applicant elects to file the appeal, a new procedural phase begins in INPI, which initiates with the admissibility exam; having the application satisfied the formal requirements,²² decision code 12.2 is published in the Industrial Property Gazette.²³

After publication of the appeal against rejection in the RPI, any interested party may file counter-arguments to the appeal, which are, in general, filed by third parties interested in the patent application, aiming at preservation of the rejection decision on the application. As appeals are fully referred to a higher instance, the second administrative instance completely reexamines the matter of the patent

²¹ Article 15, DECREE No. 8,854/2016 – The General Coordination Office for Administrative Invalidation Proceedings and Appeals is responsible for: I – examining and providing technical support for the decisions of the President of INPI in administrative invalidation proceedings and appeals filed pursuant to the prevailing industrial property laws and regulations, and issuing opinions on the matter raised; II – examining and providing technical support for the decisions of the President of INPI in the appeals regarding intellectual property, which registration is under the responsibility of INPI by law; III – guiding and coordinating the systematization, organization, and update of administrative decisions related to intellectual and industrial property, seeking to consolidate an administrative case law on matter; and IV – proposing improvements to the guidelines and procedures for examination of appeals and administrative invalidation proceedings filed pursuant to prevailing intellectual and industrial property laws and regulations.

²² In the admissibility examination, it is verified whether the appeal is applicable, if it is timely, and if the fee was paid.

²³ Decision code 12.2 indicates that an appeal was filed aiming at a new examination of the matter by the president of INPI.

application, applying all relevant legal provisions employed in the first-instance examination.

In the examination of the patent application by the second instance, the examiner uses all documentation filed at the first instance (expert opinions, petitions, amendments to the application, supporting information, etc.), as well as any new information filed by the appellant in with the appeal petition or by interested parties in the counter-arguments petition, if any. After the first second-instance examination, there are four possible outcomes for the patent application: the appeal is granted (decision code 100), the appeal is denied (decision code 111), non-patentability opinion (decision code 120) or technical requirements (decision code 121). In the decision to grant the appeal, the second-instance examiner understands that the application meets the legal requirements and conditions, draws up an opinion pointing out the parts of the documentation that shall compose the patent, and refers the application for decision of the President of INPI. In the decision to make requirements, like in the first instance, the second-instance examiner understands that the application or part of it has patentability conditions; however, it shows irregularities that prevent patenting as it is. For this reason, they issue an opinion requesting the appellant to meet certain requirements in order for the application to meet patentability requirements and conditions. When the examiner understands that the application does not meet the patentability requirements and/or conditions, he/she may decide to deny the appeal, a situation in which it is no longer possible to discuss it, and the application is forwarded to the President for decision, or he/she may issue a non-patentability opinion, situation in which new arguments and/or documents of the state-of-the-art are presented by the examiner or further clarifications by the applicant may be necessary.

During examination, the second-instance examiner evaluates the same legal requirements and conditions as the first-instance examiner and uses the same Normative Instructions and Examination Guidelines. **Figures 3–5** show a schematic representation of the procedural flow of patent applications at second instance in INPI.

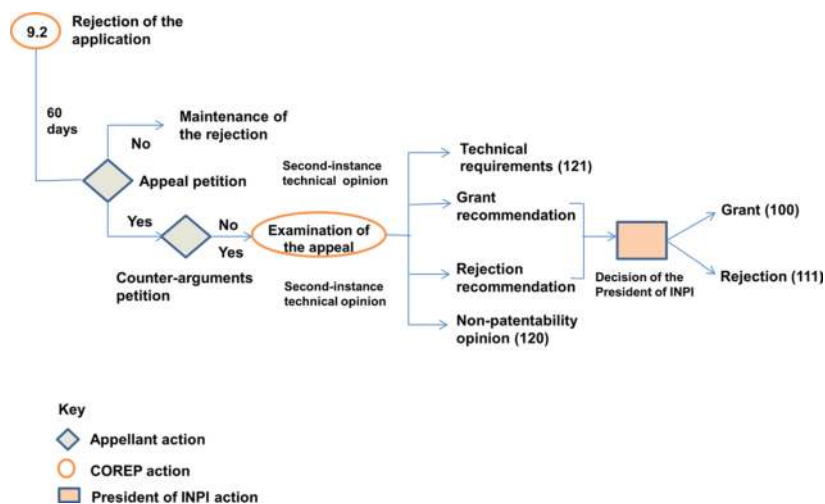


Figure 3. Schematic representation of the procedural flow of patent applications at second administrative instance in INPI.

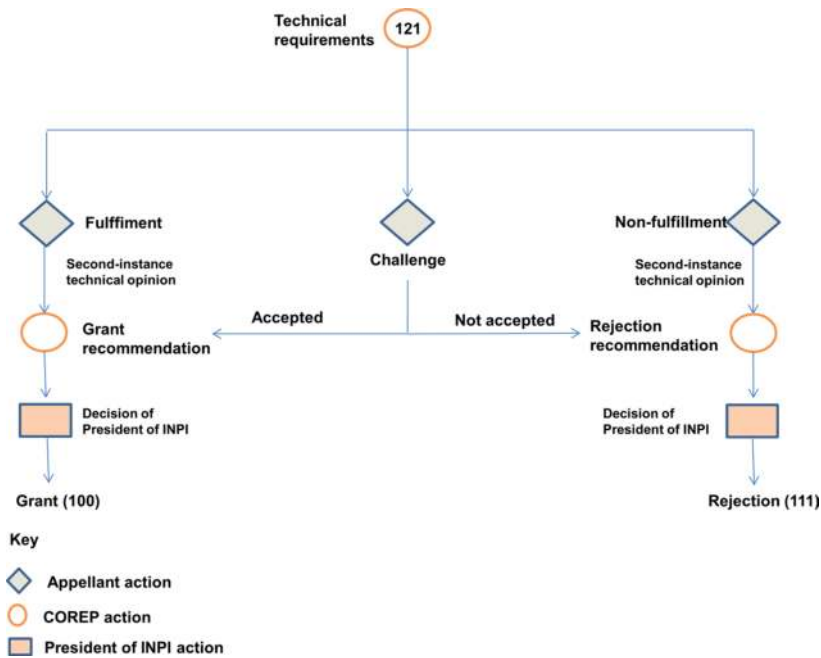


Figure 4.
 Schematic representation of the procedural flow of patent applications after technical requirements in INPI.

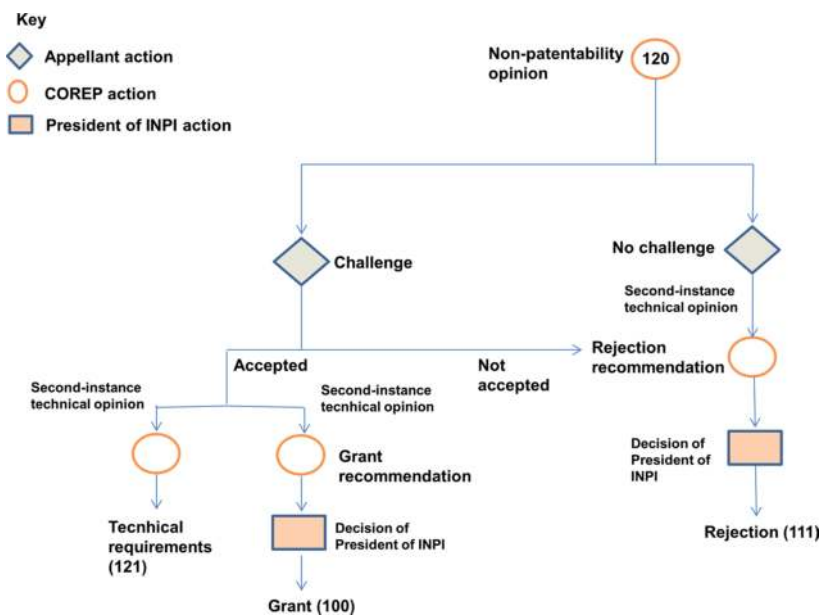


Figure 5.
 Schematic representation of the procedural flow of patent applications after technical requirements in INPI.

5. Final considerations

As it was evidenced, although the three patent offices have procedures for appeal against first-instance decisions, there are significant differences in the procedures of each of these offices, starting with the type of proceeding. While in the EPO it is a legal proceeding, in the USPTO and in INPI, it is an administrative proceeding. There are also differences in the types of appealable decisions in each office.

Regarding decisions related to the examination of the application patent-ability, in Brazil only decisions rejecting patent applications are subject to appeal. In Europe, in addition to decisions rejecting patent applications, the decisions by opposition divisions are also subject to appeal, in other words, those determining rejection of the opposition and maintenance of a patent in its full or amended form or those setting out the cancellation of the patent.

In the specific case of procedures for appeal against decisions rejecting a patent application, these offices also differ regarding the terms, the rules for filing new submissions, the existence of a review mechanism before analysis by the board of appeals, as well as the participation by interested third parties.

Regarding deadlines, the EPO and the USPTO present different deadlines for filing the notice of appeal and the grounds of the appeal. At INPI, both the notice of appeal and its grounds shall be filed together, within a maximum period of two months of the notice of the decision to reject the patent application.

All offices, as long as pursuant to certain conditions, permit amendments to the claims and/or filing of new evidence after the notice of appeal. In the case of the EPO, these submissions shall be filed preferably at the beginning of the appeal procedure, and the boards may accept or not, at their discretion, new submissions during the appeal procedure. In the USPTO, the filing of new evidence and/or amendments to the claims is also subject to certain rules; however, it is important to highlight that these submissions shall be filed before the appeal is sent to the PTAB, and no new submission shall be accepted after that date. In INPI, the filing of new evidence and/or amendments to the claims is accepted throughout the processing of the appeal. However, the filing of amendments to the claims is subject to the provisions in Article 32 of the LPI.²⁴

Unlike INPI, both the USPTO and the EPO have a mechanism for the first-instance department responsible for the decision to review its own appealed decisions before they are forwarded to the boards of appeal. This mechanism allows for quick resolution of some cases, with significant economy of time and resources.

INPI, unlike the EPO and the USPTO, has a mechanism for participation of interested third parties in the procedure for appeal against the rejection, the so-called counter-arguments to the appeal, which allows any interested parties to submit the reasons why they understand that the decision of rejecting a patent application shall be upheld. Regarding the effects of the appeal, both in Europe as in Brazil, the suspensive and devolutive effects apply.

Table 1 briefly presents the main differences in the appeal procedures of the three offices analyzed.

Results obtained through a comparative study enabled to identify good practices related to appeals adopted in two of the main patent offices in the world with potential for application in INPI. Among these practices, it is important to note the existence of a mechanism for reviewing the challenged decision by the first-instance department responsible for such decision, like the interlocutory revision mechanism adopted in the EPO, for example. Implementation of a mechanism similar to that in INPI is currently under evaluation by the Institute. If implemented, INPI may greatly improve its efficiency, considering that decisions that may be easily reversed, whether because of new evidence submitted or because of submission of new patent claim scopes overcoming the objections made in the first instance, may be reversed in a more speedy and economic way, with no need

²⁴ Article 32 of the LPI provides that amendments to the claims are not accepted when they add information to what was initially provided or broaden the scope of protection of the claims in comparison with the claims filed until the request for examination of the patent application.

	EPO	USPTO	INPI
Type of proceeding	Legal	Administrative	Administrative
Appealable decisions (regarding patentability)	Rejection Maintenance of a patent Revocation of a patent	Second or subsequent decision rejecting one or more claims	Rejection
Filing of appeal	2 months	Up to 6 months	2 months
Reason for appeal	4 months	Up to 11 months	2 months
New submissions ¹	YES	YES	YES
First-instance revision	YES	YES	NO
Counter-arguments ²	NO	NO	YES
Effects	Suspensive Devolutive	—	Suspensive Full devolutive
Oral proceedings	YES	YES	NO

¹In all offices, the submission of new claims and/or evidence to the proceeding is subject to specific rules.

²The results presented in this row of the table refer specifically to appeals against a decision rejecting a patent application.

Table 1.

Comparative table of the appeal procedures in the EPO, the USPTO, and INPI.

for evaluation by a new examiner or collegiate. It is worth noting that by shedding light on the laws, regulations, and procedures for appeals in three important patent offices, highlighting the practices adopted in each office, this study may contribute for the applicant to increase his/her chances of success in the appeal stage in these three patent offices studied.

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References

- [1] Dalla Pace, C. A sistematização dos recursos administrativos na legislação federal. Dissertação. São Paulo: Faculdade de Direito, Universidade de São Paulo; 2015.
- [2] European Patent Convention (EPC). 16th edition; 2016.
- [3] European Patent Office (EPO). Case Law of the Boards of Appeal [Internet]; 2019. Available at: <https://www.epo.org/law-practice/case-law-appeals/case-law.html>. [Retrieved on: 2021-09-03]
- [4] Veronese, A. Appeal procedure before the European Patent Office. In: Toshiko Takenaka, editor. Patent Law and Theory. A Handbook of Contemporary Research. Cheltenham: Edward Elgar Publishing Limited; 2008. P. 224-245.
- [5] European Patent Office (EPO). Guidelines for the Examination in the European Patent Office; 2019.
- [6] European Patent Office (EPO). Rules of procedure of the Boards of Appeal; 2020.
- [7] Merrill, S.A, Elliot, G.C.A. A patent primer. In: A Patent System for the 21st Century. Washington, D.C: The National Academies Press, 2004. (COMPLETAR REFERÊNCIA)
- [8] Yospin, M.M. Final rejection: not the end. Yospin Law [Internet]. 2019. Available at: <https://www.yospinlaw.com/2019/08/12/final-rejection> [Retrieved on: 2020-05-22].
- [9] United States Patent and Trademark Office (USPTO). Manual of Patent Examining Procedure [Internet]. 2014. Available at: <https://www.uspto.gov/web/offices/pac/mpep/index.html> [Retrieved on: 2021-03-09].
- [10] Code of Federal Regulations. Title 37. Patents, Trademarks and Copyrights [Internet]. 2019. Available at: <https://www.govinfo.gov/content/pkg/CFR-2019-title37-vol1/html/CFR-2019-title37-vol1.htm> [Retrieved on: 2021-03-09].
- [11] Brasil. Law No. 9,279 of May 14, 1996. Provides for industrial property rights and obligations. Diário Oficial da República Federativa do Brasil. [Internet]. 1996. Available at: http://www.planalto.gov.br/ccivil_03/leis/l9279.htm [Retrieved on: 2021-03-09]
- [12] Brasil. Law No. 9,784 of January 29, 1999. Provides for administrative proceedings at the Federal Administration level. [Internet] Available at: http://www.planalto.gov.br/ccivil_03/leis/l9784.htm [Retrieved on: 2020-05-23]
- [13] IDS-Instituto Dannemann Siemsen de Estudos Jurídicos e Técnicos. Comentários à lei da propriedade industrial. Edição revista e atualizada. Rio de Janeiro: Renovar. 2005. 548p.
- [14] Meirelles, H.L., Filho, J.E.B., Burle, C.R. Direito administrativo brasileiro. 42^a ed. São Paulo: Malheiros, 2016. 975p.
- [15] Brasil. Decree No. 8,854 of September 22, 2016. [Internet] Available at: http://www.planalto.gov.br/ccivil_03/_Ato2015-2018/2016/Decreto/D8854.htm. [Retrieved on: 2021-03-09]
- [16] Instituto Nacional da Propriedade Industrial (INPI). Portaria n° 210, de 1° de julho de 2015.