



**Topic:**  
**Typical problems of foreign patent applications  
in the major Latin American countries**



**I. IP landscape**

**II. Common problems on comparative level**

- Formalities and timelines
- Patentability and exceptions
- Others
- Excursus: design matters

**III. Country highlights**

- Mexico
- Brazil
- Argentina
- Chile
- Colombia (only if time permits)





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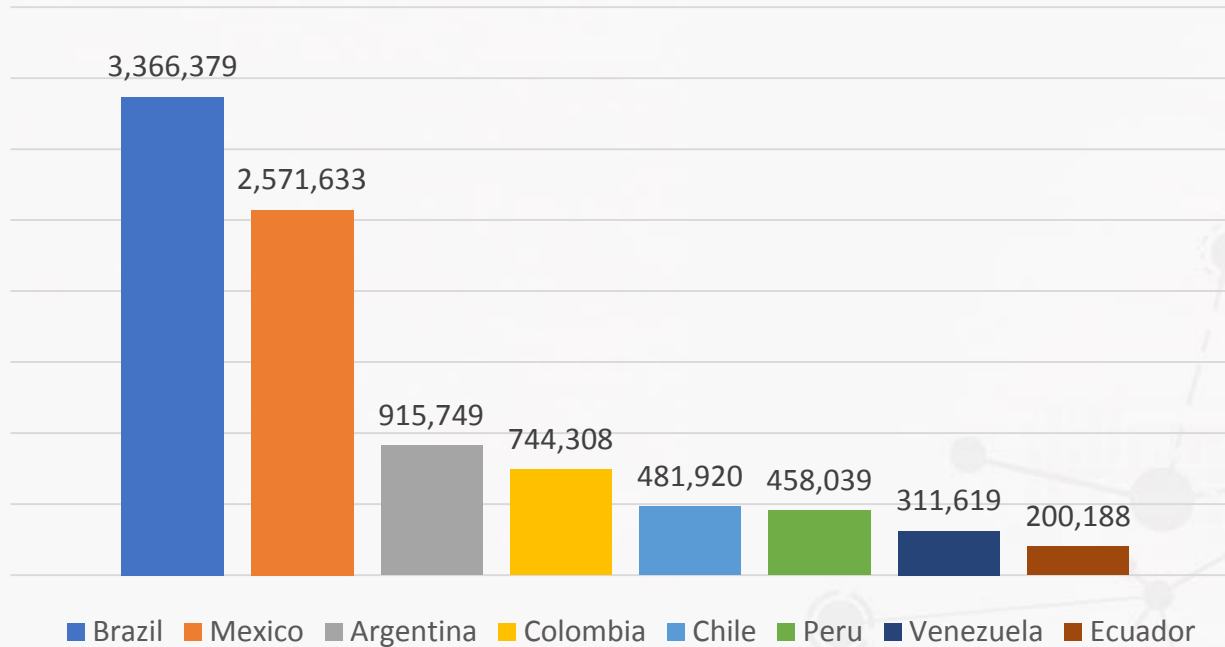
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# I. IP Landscape

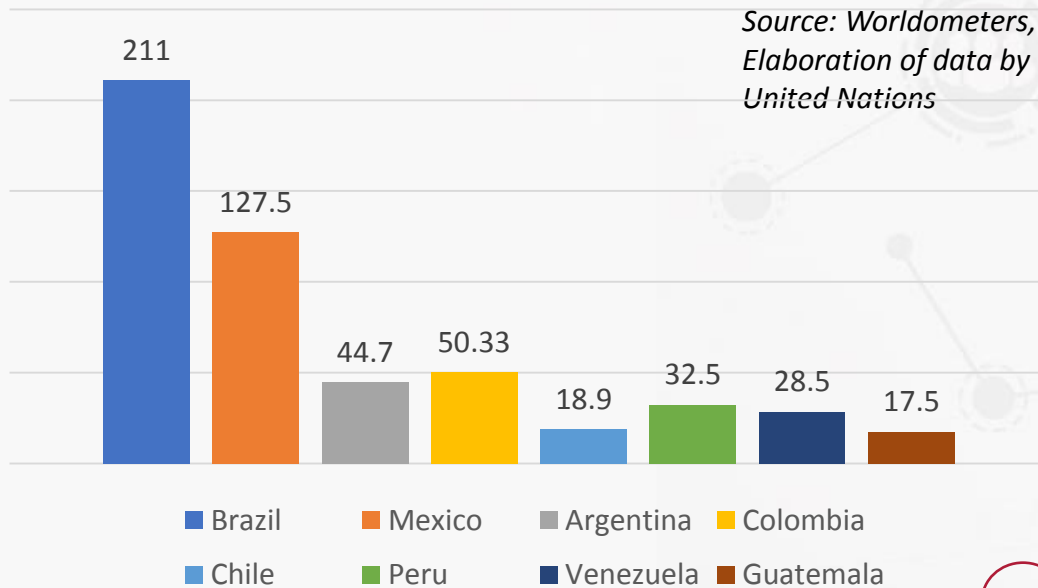


Source: International Monetary Fund; October 2019

## Economics:

➤ Total gross domestic product GDP (PPP) of the region is above 10.000,000 (trillion) USD

- Japan 5.596,959
- Germany 4.342,909

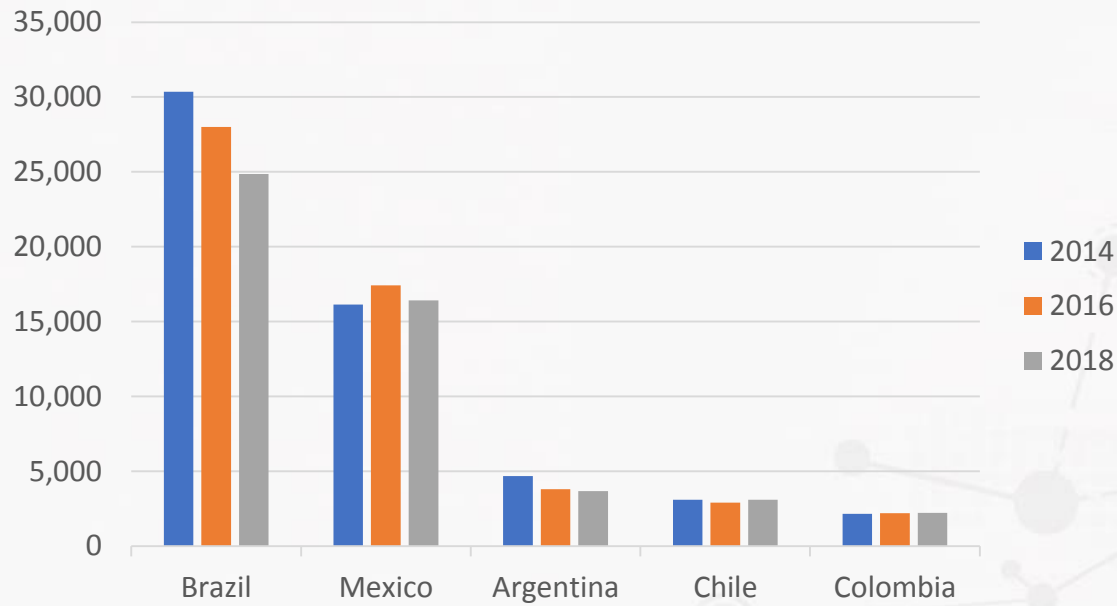


Source: Worldometers, Elaboration of data by United Nations

## Population:

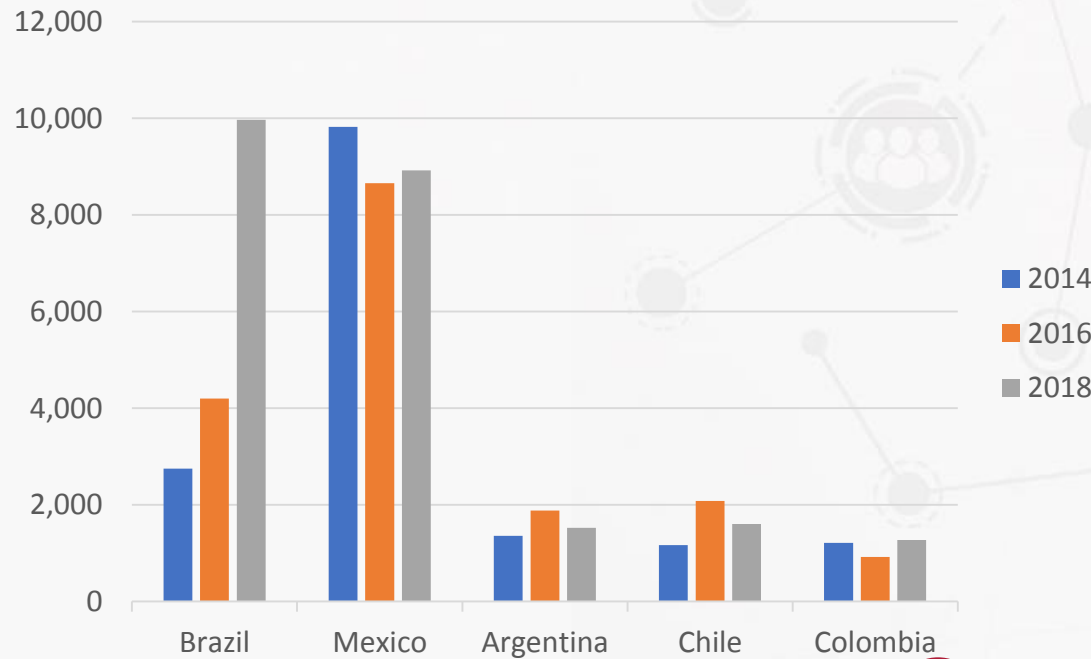
- Total in the region of about 640 million
- Brazil, Mexico, Argentina and Colombia = 433 million

**Patent Applications, 2014-2018**



- *IP filings show similar “country ranking” as population and economics; Brazil with decrease*
- *Argentina and PCT?*

**Patent Grants, 2014-2018**



- *Brazil undertaking major efforts to fight the backlog*

## II. Common problems on comparative level

- Formalities and timelines
- Patentability and exceptions
- Others
- Excursus: design matters

## Complicated formalities and burocracy in some countries

- Slows down handling
- Rises cost
- Short timelines



Plan filings well in advance!

TIER	Formality complexity level
1 (easiest)	BR, MX
2	CO, PE, CL
3	AR, VE, UY, EC, BO, Central America



**II. Common problems - Formalities**

	Brazil	Mexico	Argentina	Colombia (Andean)	Chile	Central America
Power of Attorney	Simply signed by applicant (scan copy enough)	Simply signed (2 witnesses) (physical)  (legalisation for Courts)	Notarized and Apostille (scan copy enough)   (original can be requested but copy meets deadline) 	CO & PE: Simply signed by applicant (scan copy enough)  BO & EC: Notarized & Apostille	Simply signed by applicant (scan copy enough)	All countries notarized and apostille
Late filing	60 working days from filing	60 working days from OA	40 working days from filing	60 working days from OA	60 working days from Office Action	HN& NI: 60 working days from OA  SV (60), CR (90), GT (120) working days from filing



## II. Common problems - Formalities

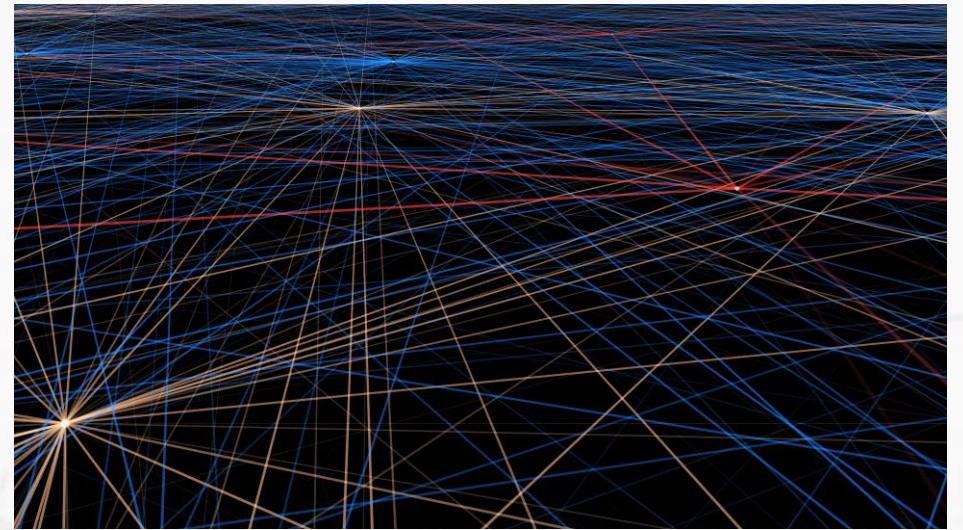
	Brazil	Mexico	Argentina	Colombia (Andean)	Chile	Central America
Assignment	<p>PCT: Required if the applicant of the PCT and priority are different from the national phase</p> <p>(merly signed, scan copy enough)</p>	PCT: Not requested	<p>Not required if the applicant of the priority is the same of the Argentinian case.</p> <p>(merly signed, scan copy enough if at filing)</p>	<p>For recent PCT's, recent objections (if the assignment is not registered in the international phase)</p> <p>(merly signed, scan copy)</p>	<p>Not mandatory. The office may require at any time (rarely happens)</p> <p>(if requested, merly signed)</p>	<p>All Central American countries require an assignment notarized and apostilled.</p>
Late filing	180 working days from filing		Necessary at examination (file as early as possible)	PE, BO, EC diverse special rules		60 working days from OA in all except GT (90)

## II. Common problems - Formalities

	Brazil	Mexico	Argentina	Colombia (Andean)	Chile	Central America
Translation	translation of abstract and claims at initial filing	Not required at filing	Filed in any language	At the time of filing  (EC, PE, BO same)	Not required at filing	At the time of filing
Late filing	60 days after filing to be completed	will be requested by Office Action	within 10 days after filing (sworn translation)		30 working days from filing date	



Sworn translation – the chain of sworn translation can never be broken – JP-EN; EN-ES)



## Shortage of digitalization at Patent Offices

- only biggest 6 countries have online databases (BR, MX, AR, CL, CO, PE)
- Brazil has problems in actualization



plan patent searches, FTO studies, status checks etc.  
with enough time in advance



## Faster prosecution as to diverse PPH programs



	Brazil	Mexico	Argentina	Colombia (Andean)	Chile
PPH with Japan	Yes <b>(new!)</b>	Yes	No	Yes	Yes
Other measures	PPH:  EPO, USPTO, PROSUR etc. Green patents, other*....		Prosur, Resolution 56/2016, covers all areas.	Prosur, Global PPH	Prosur
Timelines for grant or next Office Action	Approx. 6 months from request	Approx. 4-5 months from request	Approx. 2-3 months from request	Approx. 6 months from request	Approx. 6 months from request



## General requirements: Novelty, Inventive Step, Industrial Applicability

	Brazil	Mexico	Argentina	Colombia (Andean)	Chile
Use claims	yes	yes	no	no (in no country of Andean Community)	yes
Software*	rather restrictive	rather restrictive	very restrictive	rather restrictive	computer implemented

\* *Granting possibilities increase if no explicit mention of computer program or computer instructions is included in the claims*

**II. Common problems – Patentability, Claim types**

	<b>Brazil</b>	<b>Mexico</b>	<b>Argentina</b>	<b>Colombia</b>	<b>Chile</b>
Pharma	<p>Swiss type claims allowed.</p> <p>Surgical, therapeutic or diagnostic methods, for application to the human or animal body are not patentable subject-matter.</p>	<p>Swiss type, and “compound for use” type format claims allowed.</p> <p>Surgical, therapeutic or diagnostic methods, for application to the human or animal body are not patentable subject-matter.</p>	<p>Restricted patentability in Pharma inventions. Barely, new molecular entities are patentable.</p> <p>Use claims and surgical, therapeutic or diagnostic methods are not patentable subject-matter.</p>	<p>Use claims and surgical, therapeutic or diagnostic methods are not patentable subject-matter.</p>	<p>Swiss type claims allowed.</p> <p>Surgical, therapeutic or diagnostic methods are not patentable subject-matter.</p>

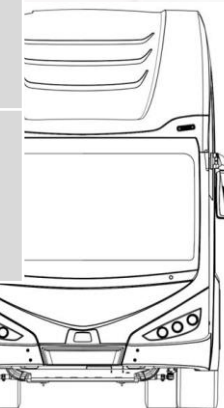
## II. Common problems – Office Actions

	Brazil	Mexico	Argentina	Colombia	Chile
Terminology	2 types	Regular	Regular	Regular	Regular
Number (watch out for divisionals!)	2	4	3	3-4	2 (max.3)
Deadline	90 working days	60 working days	30 or 60 calendar days (depending if formal or substantial OA)	60 working days	60 working days
Extensions	No	Yes, 60 working days	Yes, 3 of 30 calendar days	Yes, 30 working days	Yes, 60 working days (only one)

## II. Common problems – Excursus: Designs



	Brazil	Mexico	Argentina	Colombia (Andean)	Chile
Multiple designs allowed?	Yes. Up to 20 variations if intended for the same purpose and with same preponderant distinguishing features	No. But IMPI is relaxing criteria lately. We recommend filing 1 application and split afterwards if needed	Yes. Up to 20 if same Locarno Class	No	No
Description mandatory?	Not provided that six orthogonal views + a perspective view are filed	No	No	No	Yes
Maximum duration	25 years	25 years	15 years	10 years	10 years
Latest News / tips	Dotted lines not allowed	Entry into the Hague Convention imminent		Dotted lines not allowed	Clothing of any nature cannot be protected





### III. Country Highlights

- Mexico
- Brazil
- Argentina
- Chile
- Colombia (only if time permits)



III. Country  
Highlights  
- MEXICO



- PPH with Japan (highly effective!)
- Technical Examination
- Divisional Applications

## PPH with Japan



In practice, 60-70% of applications that have requested PPH, do not receive any technical office action and are directly granted!

- Should be requested **2 months after publication** and before examination starts.
- Important to include **set of claims** pointing out the **equivalence** between MX claims and the equivalent foreign application which will be considered for PPH.
- must belong to a patent family having **an application examined and considered** as comprising **patentable** subject matter after the examination or already **granted** by the Earlier Examination Office.

## PPH with Japan

- **Practical tip:** do not forget to include link, source or available information from the equivalent foreign application to which it will be amended. This will be helpful for the Examiner.
- **Reduces timeline** of prosecution at least 1 year.
- No official fees.

## Technical examination

- **Similar examination criteria to USPTO or EPO**, although closer to EPO. Follow these cases for anticipating rejections and increase grant possibilities. If acceptable, **adapt to the granted subject-matter**, if any, of the USPTO or EPO parallel case.
- **No examination request. Automatic!**
- Maximum of **4 Office Actions** (have in mind for possible divisionals).

## Technical examination

- **Use interviews with examiners:** there is not “right of audience” for a meeting. In practise, examiners are however approachable and provide useful insights on their evaluation of the case. They will never compromise themselves but guide the patent attorney to the requested adaptation.
- **Inventive step:** Examples **may be included as annex** of the responses of the OA for avoiding rejections (special importance in the Biotech and Pharma field).

## Divisional applications

Divisional applications may be filed at anytime during prosecution **up to the granting of final resolution** or by request of the Patent Office.

### ***WHEN (voluntary divisionals)?***

If it is a granting resolution, divisionals need to be filed **up to the payment** of the granting fees.

- **Recommendable** to file divisional applications **in a response to a 4th office action**, to maintain alive the application if a rejection resolution is foreseen to a response to the 4th Office Action.

## Divisional applications

### *HOW?*

- **Cascades** of divisional applications are allowed and no initial restrictions for subject matter included in a divisional application.



### III. Country Highlights - BRAZIL

#### Two main tools to speed up prosecution:

- New PPH procedure (01.12.2019!)
- New (mandatory) “stage”:  
Pre – Examination Office Actions

- ANVISA – National Health Surveillance Agency
- Selected matters



## New Measures to Cut Down on Brazil Patent Backlog

### The Automatic Grant System

In 2018 the Brazilian PTO was about to launch an emergency and very controversial measure to cut down on the country patents backlog. According to the plan, the PTO would automatically grant around 230.000 patents by 2020, provided the applications do not concern pharmaceutical products.

It is very well known that the backlog is probably the main issue affecting the Brazilian patent system. A patent may take an average of 7-10 years for being granted.

In order to solve this problem, the PTO has revoked this idea and issued two main tools to speed up the prosecution.

## New PPH procedure

From December 1, 2019, a new pilot project (Resolution 252/2019) began with standardized requirements.

Until now, countries that have signed the new agreement are: **Japan, Argentina, Chile, Colombia, Costa Rica, Denmark, Ecuador, Dominican Republic, El Salvador, Paraguay, Peru, Uruguay, Panama, Europe and US.**

**Main difference** with respect to former PPH pilot project is that under R 252/2019 there is no limitation regarding the **technical fields** as before. Patent applications classified under any International Patent Classification (IPC) will be accepted - more information may be provided as soon as the BRPTO consolidates the procedures.

## New PPH procedure

R 252/2019 establishes that the Brazilian application must comply with the following requirements to be accepted in this PPH Pilot Program:

- Patent must have been filed for at least 18 months or have a request for anticipated publication or, in case of PCT applications, have been published by WIPO;
- It must have its request for examination submitted before the BRPTO;
- It must have not been accepted in any fast-track examination program.
- It must not have its technical examination initiated by the BRPTO, i.e.:

*Publication codes [6.1 - office action], [6.21 - office action], [6.22 - office action], [7.1 - unfavorable opinion] and [9.1 - grant] configure that the technical examination has been initiated, so that from these publications it will no longer be possible to request the PPH.*

## Pre-exam in Brazil

Part of the **Backlog Fighting Project**.

Target: reducing the number of patent applications pending examination and decision within a **period of 2 years**.

Patent applications eligible to enter the program :

- Must have a **filing date before 12/31/2016**;
- No prioritized application in fast track systems;
- For technical examinations that have not started yet.

## Pre-exam in Brazil

New Resolutions:

**R.240**; addressed to patent applications that do not have search reports issued by other Patent Offices, but only a relevant Prior Art search report detected by the Brazilian examiner; and

**R.241**: addressed to patent applications with search reports already issued by other Patent Offices. They will be published as Official Actions codes 6.22 and 6.21.

## Pre-exam in Brazil

### Major characteristics of Resolution 241:

- Is a **prerequisite** for the exam. If the application is selected for the program the **response is mandatory**. Failure to file claims and/or arguments adequate to Prior Art cited by the examiner will result in the **rejection of the application**, NO right of appeal;
- Non-extendable deadline for replying is **90 days** after publication;
- The substantive technical examination carried out after pre-exam must consider **only the prior art cited in the preliminary requirement**, no additional search will be performed by the Brazilian examiners.

## Pre-exam in Brazil

### Main points when responding to R.241 ([6.21 - office action], [6.22 - office action]):

- As BRPTO has autonomy and independence, the answer requires the presentation of arguments and/or amendments defending patentability of the claimed invention against cited prior art. No defence/moot arguments/claims that do not overcome prior art can lead to a definitive shelving/rejection of the application.  
*But still: New set of claims must comply with BR IP Law: Added subject matter is not allowed!*
- We need to know if you/applicant wish to adapt the claims according to a corresponding application that has already been granted in another patent office or that has already made amendments and has a positive review already for granting.
- INPI has no preference to which set of claims of any foreign Patent Office can be considered. *(Advantage!!! – maximum scope of protection eligible)*



## Pre-exam in Brazil

### Tips for responding:

1.- When the pre-exam outcome is aligned with the procedure at other Patent Office and the same claims have been granted with the same prior art cited, it is strongly recommended to file also the same arguments in defense of novelty and of inventive too, just to strengthen its grant in Brazil.

In other words, it is always recommended to file arguments to reinforce the patentability of the invention even in the case the set of claims filed in BR pre-exam is equivalent to the set of claims of a granted counterpart in other country.

## Pre-exam in Brazil

### Tips for responding:

2.- When the Examiner cites only prior art that is not considered of particular relevance, we may only address the response highlighting this aspect and that no amendment therefore is necessary.

In other words, when the prior art cited for a patent application are documents that defines the general state of the art but is not considered of particular relevance (A), response to the office action may be as to reinforce that the Search Report (EP, PCT, Etc.,) is positive, and thus that the claimed invention complies with the patentability requirements.

## Pre-exam in Brazil

### Tips for responding:

3.- When the Examiner cites different relevant pieces of prior art (CCD), e.g., (D1-D4) cited during EP prosecution and (D5-D7) cited during Japanese prosecution, it would be advisable to, apart from adapting claims to the EP counterpart, filing technical arguments defending the patentability of the claimed invention regarding novelty and inventive step for documents cited both in EP and JP.

In other words, when responding to pre-exam, all relevant documents of prior-art cited by the BR examiner must be commented in defense of patentability.

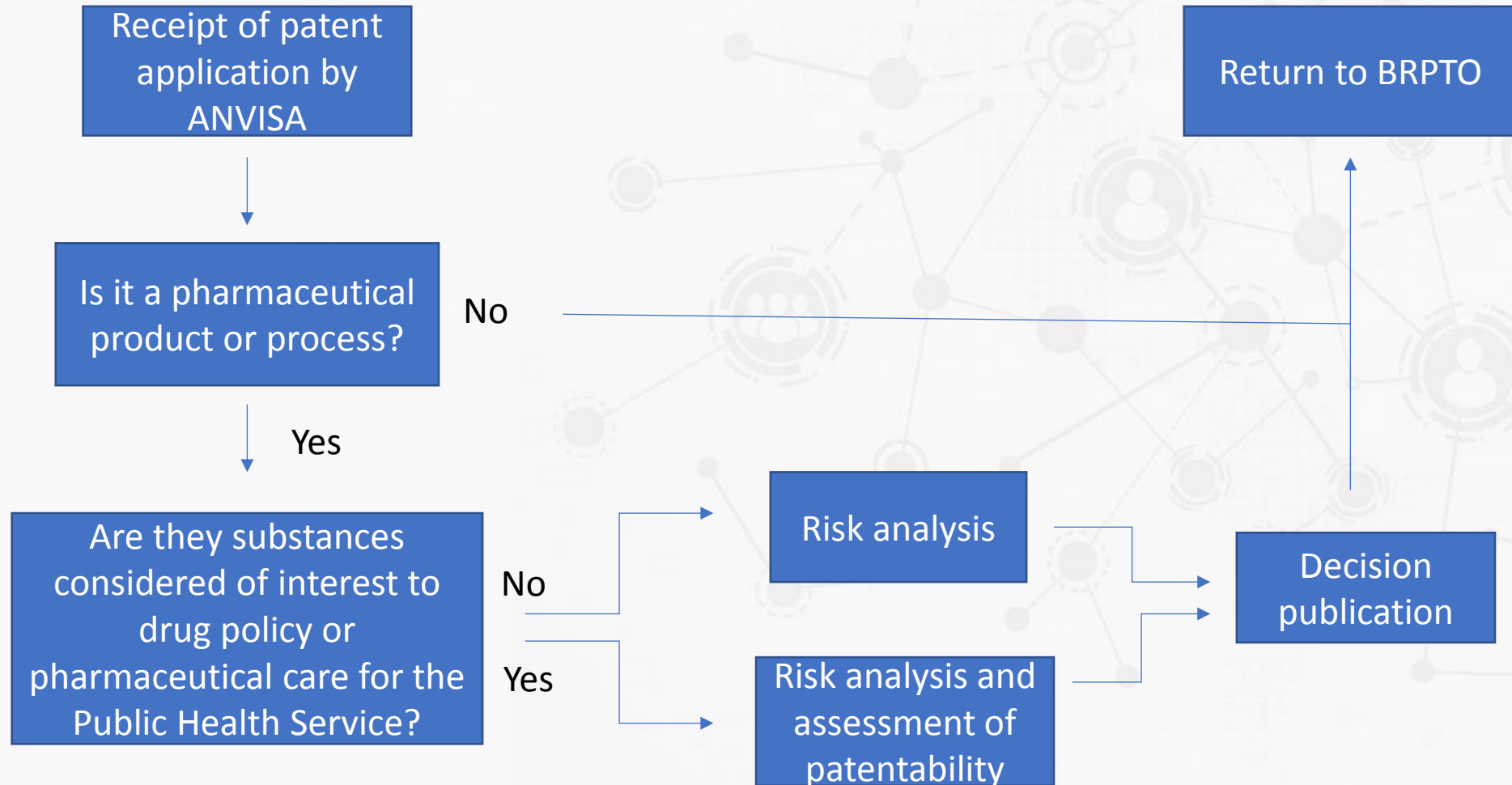
## ANVISA – pharmaceutical products and processes analysis

In regard to patenting of pharma products, we point out that this issue is also considered a matter of public health in Brazil and as such this mix of innovation and public health determines that both PTO and the National Health Surveillance Agency are involved in the decision.

It must be noted however that ANVISAS's role is related to health and not technology itself.

Given the institutional barrier of pharma patents, in need to overcome the difficulties of two different governmental bodies involved, in 2017 they have sorted out how to work together. Therefore, unless the product contains a forbidden substance in Brazil – which leads to shelving of the application – the final decision is still in the hands of the Brazilian PTO.

## FLOWCHART OF THE ANALYSIS PROCEDURE FOR PRIOR CONSENT



## Selected matters:

### IP Litigation:

Speedy and efficient litigation system contrasts the slow prosecution. In fact, Brazil is one of the main battlefields in Latin America for IP disputes.

### Examination request:

Excess of claims generates cost issue.

## News & more

- Improvements in simplicity
- Resolution 56/2016
- Warning



## Improvements in simplicity: Digital Access Service (DAS) & Time extensions

- As (DAS) **ACCESING OFFICE**: Since **October 1<sup>st</sup> 2019** (Resolution 268/2019) INPI has joined the Digital Access Services (DAS) for recognition of priority documents through it.

**BUT...it is important to keep in mind that a Spanish certified translation of the priority document is still mandatory.**

As (DAS) **DEPOSITING OFFICE**. Since **March 2nd 2020** INPI will also be Depositing Office, giving the chance to other DAS Offices to collect Argentinian priority documents.

- **Resolution 98/2019** established a regime of **3 automatic time extensions for office actions** (each 30 days).

**Retroactive effect** for pending office actions?...yes, but **better check it up with local Patent Attorneys for exceptions!**



## Resolution 56/2016. A PPH Argentina-style!

### HOW?

- Asking INPI to adequate claims to any granted patent of the same family.  
**BUT...**Only issued by Patent Offices with examination procedure.

### WHEN?

- Voluntarily before receiving the Preliminary Examination, or
- In response to the Preliminary Examination  
**BUT...**Only when the examiner mentions a granted counterpart.

## Resolution 56/2016. A PPH Argentina-style!

### BEWARE OF

Some examiners, not all, (there is no unanimous criterion among them) ask for the translation of the granted text to be done by a sworn translator.

In view of this, we recommend:

- Always submit a sworn translation; or
- Ask the examiner to know in advance what his criteria will be.  
(may take a while)

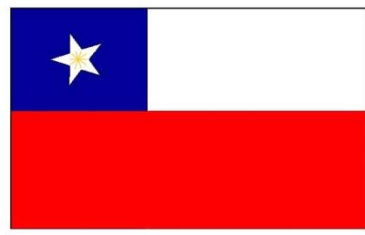
## Warning!

New Government usually implies changes in Argentinean PTO (INPI)

New examination criteria about to come?

**Watch out!**





**Examination practice** generally orientated in line with EPO and USPTO

- however restrictive to patentability of animals and plants even if genetically modified.

**Claim construction demands:**

- The Chilean Patent Office is reluctant to accept claims with functional features which comprise numerous adjectives and often asks to delete them. Japanese translations into Spanish sometimes generate such abundance of adjectives.
- The Chilean Office demands on regular basis to include the technical problem into independent claims.

### **Divisional applications**

- Voluntarily: only until issuance of first office action!
- As to request of the Patent Office as to lack of unity of invention.

### **PPH with Japan**

- Can be applied for until first office action (6 – 12 months after filing).
- Useful for accelerating notification of first office action. Granting will depend on examiner's opinion.

**Patent term extension (SPC)** possible (with Costa Rica only country in Latin America).



**Examination practice** is, with Brazil, of the most strictest ones in Latin America regarding novelty and inventive step. Colombian Patent Office makes strict own assessment and is not biased by EPO or USPTO results.

- Examiners are not always flexible for applicants' proposals in overcoming objections to Office Actions.

**Agile processes:** The Office is however one of the most agile ones in Latin America and examiners can be convinced using a solid argumentation.

**Assignment** of rights has been requested in the last months also for PCT applications due to stricter interpretation of examination guidelines at the Colombian Patent Office.

**Appeal stage:** claims can be amended at the time of filing an appeal against the denial decision of the patent. In this case an official fee for the claim amendment has to be paid.

**Divisionals** can be filed anytime even after grant or refusal.

- Cascades of divisional applications are not allowed
- Strict rules to using same set of claims as in parent application (double patenting)

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**Portugal** (Lisboa)  
**Spain** (Madrid)

**&H  
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