

## **Patent Cooperation Treaty (PCT) Committee for Technical Cooperation**

**Thirtieth Session  
Geneva, May 8 to 12, 2017**

### **EXTENSION OF APPOINTMENT OF THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY OF BRAZIL AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT**

*Document prepared by the International Bureau*

1. All of the existing International Authorities were appointed by the PCT Assembly for a period ending on December 31, 2017. In 2017, the Assembly will therefore need to make a decision on the extension of the appointment of each existing International Authority that wishes to seek an extension of its appointment, having first sought the advice of this Committee (see PCT Articles 16(3)(e) and 32(3)). Information concerning this process and the role of the Committee is set out in document PCT/CTC/30/INF/1.

2. On March 8, 2017, the National Institute of Industrial Property of Brazil submitted its application to extend its appointment as an International Searching Authority and International Preliminary Examining Authority under the PCT. This application is reproduced in the Annex to this document.

3. *The Committee is invited to give its advice on this matter.*

[Annex follows]

APPLICATION OF THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY OF BRAZIL  
FOR EXTENSION OF APPOINTMENT  
AS AN INTERNATIONAL SEARCHING AND  
PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

### **Application for Extension of Appointment**

The National Institute of Industrial Property of Brazil (INPI-Br) was appointed as an International Searching and Preliminary Examining Authority under the PCT at the thirty-sixth session of the PCT Assembly in September-October 2007 with effect until December 31, 2017, the same session at which Portuguese was added as a language of publication. It has performed an effective role in making the PCT system more accessible to applicants from the Latin-American and Caribbean regions and, in particular, for applicants filing in the Portuguese language.

INPI-Br now seeks extension of its appointment. As set out below, this will strengthen both the PCT system as a whole and the position of INPI-Br to support innovation and patent quality in Brazil and within the region.

### **Background**

Innovation and Intellectual Property are key concepts for the 21st century, the mastering of which better equip countries to develop their economy, technologies and society at large. The Brazilian Government continues to invest in improving services delivered by its patent and trademark office, the INPI-Br. This underlines the relevance attributed to the protection and enforcement of intellectual property rights by Brazil as a venue to further social and economic development, respecting the balance between rights and duties among producers and users of technology.

INPI-Br is a Federal Autarchy created in 1970, currently linked to the Ministry of Industry, Foreign Trade and Services (MDIC). Supported by the Industrial Property Law number 9.279/96, INPI has as main purpose to execute within Brazil the norms that regulate the industrial property, taking into account its social, economic, legal and technical functions. It is also a function of INPI to evaluate the costs and benefits of developing and ratifying conventions and treaties linked with industrial property matters.

INPI-Br plays a very relevant and strategic role as one of the main stakeholders of the so-called Brazilian System of Innovation, interacting with the academic circles, Brazilian and foreign public research centers and the industry sector. It is worth to mention that INPI and MDIC have jointly elaborated a project in order to: a) reduce the backlog in the patent field; b) improve and perfect the regulatory framework; c) simplify and reduce unnecessary bureaucracy without losing quality, and d) increase the operational efficiency by the means of management of human resources. The actions carried out will be further subject of the topic "Pursuit of Excellence in Service Delivery".

Since the beginning of its activities in 2009 as International Searching and International Preliminary Examining Authority (ISA & IPEA) under the PCT System, INPI has achieved positive results and is ready to continue its functions. The table 1 below presents numbers of PCT applications related to INPI-Br's activities and the table 2, applications by route.

Table 1: Activities of INPI-BR in PCT as RO, ISA and IPEA

	2009	2010	2011	2012	2013	2014	2015	2016
RO/BR	442	447	519	561	617	513	481	528
ISA/BR	65* <sup>1</sup>	331	424	424	504	444	438	433
IPEA/BR	7* <sup>2</sup>	15	22	48	41	51	44	46

Table 2: Applications by Route

Route \ Year	2011	2012	2013	2014	2015
PCT National Phase Entries	21.341	22.658	22.610	22.642	22.467
Direct filings	7.317	7.777	8.267	7.699	7.750
<b>Total</b>	<b>28.658</b>	<b>30.435</b>	<b>30.877</b>	<b>30.341</b>	<b>30.217</b>

Source: Badepi v3.0, "Anuário Estatístico de Propriedade Industrial"

At the same time as appointing INPI-BR as an International Searching and Preliminary Examining Authority, the PCT Assembly approved an amendment to PCT Rule 48.3, adding Portuguese as a language of publication. As a consequence of this change, applications filed in Portuguese increased from typically less than 30 per year to around 500 per year. Most of these international applications are searched by INPI-BR, which is the only ISA/IPEA able to search and examine these applications without requiring a translation for the purposes of international search. This offers a considerable advantage to applicants from the region in ensuring effective access to the PCT system.

### Compliance with the Minimum Requirements

INPI-BR fully complies with the minimum requirements for appointment in PCT Rules 36.1 and 63.1. Those Rules require (in relevant part) that:

- (i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches;
- (ii) that Office or organization must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media;
- (iii) that Office or organization must have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;
- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search;

<sup>1</sup> Data for ISA/BR and IPEA/BR must be considered after the beginning of activities in August, 2009.

<sup>2</sup> *Idem.*

### *Human Resources Policy with focus on its ISA and IPEA functions*

In response to the increased demand for IP rights, INPI-Br has taken advantage of the favorable national conditions to construct a continuing program to hire new examiners in recent years, and a continuing prospect for the next ones. By September, 2016, our Directorate of Patents had 68 (sixty eight) examiners in the mechanical field, 72 (seventy two) examiners in the electrical/electronic fields, 61 (sixty one) in chemistry and 59 (fifty nine) in biotechnology field, for a total of 260 examiners working in a full-time-job basis. As for educational background, it is worth to stress that all of them present at least a Master degree and the great majorities possess a Phd. In other words, all of whom have the sufficient technical qualifications to carry out international searches and examinations as required by PCT Rules 36.1(i) and 63.1(i).

While INPI-Br's patent examination staff has grown extensively in recent years, the continued influx of patent applications and INPI-Br's ongoing commitment to maintaining and improving service levels has demanded an aggressive recruitment of additional staff. INPI has recently hired 100 new patent examiners in the course of 2016 and 2017 which are already being trained.

Training efforts are not restricted to the education of new examiners. Experienced examiners are encouraged to keep abreast of technology developments in their field of specialty, by reviewing technical periodicals, attending conferences, and taking part in technical events.

Our examiners also present a high level of knowledge in foreign languages. A large number of examiners are able to perform work in both English and Spanish in addition to Portuguese.

In particular, it is worth the note that since 2010, INPI-Br has internally provided training for our examiners in PCT issues, covering the Guidelines for search and examination as well as the correct use of the ISA and IPEA forms compared to national search and examination processes.

As an example, in 2010, all of our 250 (two hundred fifty) examiners were provided proper training in all modules before mentioned, and from 2011 onwards our trainings have been offered on a basic formation basis for new examiners. Senior examiners participate in continuous trainings in order to keep updated, sometimes joining retraining our recycling initiatives.

### *Technological Information and Access to patent and non-patent literature*

INPI-Br continues to develop information technology solutions to address the requirements of its patent processes in Brazil, in order to improve access to its wealth of patent data and to achieve greater efficiency gains in the delivery of patent products and services. This path has been initiated through CAPES<sup>3</sup> Portal, a notorious national database related to non-patent literature and DIALOG<sup>4</sup> database system

The commitment of INPI- Br to maintain its high level of access to patent and non-patent literature is expressed, notwithstanding an agreement in course with the European Patent Office (EPO) concerning the full access to EPOQUE Database system, by the means of the recent decision to acquire one of the main tools available, the IEEE Xplore<sup>5</sup>, the THOMSON INNOVATION, which shall permit the access to Derwent World Patent Index (DWPI) and

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<sup>3</sup> For more information and details, see [www.capes.gov.br](http://www.capes.gov.br) and [www.periodicos.capes.gov.br](http://www.periodicos.capes.gov.br)

<sup>4</sup> DIALOG is the world's online information retrieval system that provides online-based information services about Industrial Property in our case.

<sup>5</sup> With over 4 million documents, the IEEE Xplore Digital Library is a powerful resource for discovery of and access to scientific and technical content published by IEEE and its publishing partners.

GENESEQ<sup>6</sup>. Through these measures, INPI Br guarantees Brazilian examiners to have access to a considerable amount of patent documents as well as a large volume of non-patent literature. Examiners also have access to a wide range of other databases on paper and through dedicated interfaces for access to specialized collections from the PCT minimum documentation and beyond relevant to certain fields of technology, including databases concerning traditional knowledge.

To support these systems, INPI-Br uses Pentium workstations which have a CD/DVD-ROM drive and Internet access through a high-speed connection. This permits access to the EPOQUE Database system, and provides patent examiners with the necessary facilities to conduct their search and examination functions.

As noted above, INPI-Br's examiners have excellent language skills. Moreover, many of the databases available to the examiners directly offer search of abstracts or machine translations or other tools to assist search of documentation in languages in which the examiners are less familiar. In addition, examiners have access to a variety of machine translation tools to assist with understanding documents in cases where this is not directly built into the relevant search databases.

As such, INPI-Br meets the requirements of PCT Rules 36.1(ii) and (iii) and 63.1(ii) and (iii).

#### *Pursuit of Excellence and Quality in Service Delivery*

INPI-Br is aware of the growing importance to maintain and deepen international cooperation as one of the main pillars of its function as ISA and IPEA. In the context of its mission to help accelerate Brazilian economic development, INPI-Br is focused towards maintaining as well as deepening fruitful partnerships with the most important stakeholders of the Brazilian Innovation System and with those IP Offices with the greatest amount of pending patent applications of the world to assist in improving the managerial capacity of the Office to act as ISA/IPEA. The aim is at providing its technical staff with the best training, knowledge and up-to-date systems for patent searches.

International cooperation is fully understood as a key tool for improvement. In this context, INPI is developing a new technical agreement with the World Intellectual Property Organization (WIPO) on a fund-in-trust basis which is being prepared in order to provide capacity building and training opportunities for our examiners. Another cooperative actions include the progresses made among PROSUR countries, a project which includes nine IP Offices in South America, to build initiatives among which we can point out a Patent Prosecution Highway (PPH) pilot project. INPI considers this project very important, which shall allow it to highly take into consideration the results of PCT. Another PPH pilots in course with IP Offices of so called Trilateral (USPTO, EPO and JPO) present similar prospects for INPI, open to discuss upon common interests to share information in real time about exams and final decisions regarding patent applications.

INPI-Br implemented a quality management system (QMS) policy based on the most appropriate patterns available and in compliance with Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. Its annual reports concerning its QMS since 2007 are available on the WIPO website at <http://www.wipo.int/pct/en/quality/authorities.html>. As such, INPI-Br can be seen to comply with PCT Rules 36.1(iv) and 63.1(iv).

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<sup>6</sup> GENESEQ™ is a global patent sequence database produced by Thomson Reuters, containing DNA, RNA and protein sequences indexed from 52 worldwide patent-issuing authorities, including WIPO/PCT, USPTO, Europe (EPO), Japan (JPO), South Korea (KIPO), India (IP India) and China (SIPO). The database has an archive which dates back to 1981, and each record contains standardized terminology and bibliographic data, enhanced titles, English language abstracts, and manually-captured sequence information.

Some of the results achieved since its appointment a manual for patent applicants, exchange of experiences between several IP Offices in the world and good practices that have been implemented in views its QMS. Moreover, INPI-Br has, ever since its appointment, been an advocate of the need to improve quality in the international search and examination process and was a key player in the call to set up the Quality Subgroup of the Meeting of International Authorities Under the PCT in order to support this goal.

## **Conclusion**

INPI-Br has demonstrated that it still meets the requirements to continue its function as an ISA/IPEA under the PCT on the basis of the following attributes:

- a highly qualified, competent and growing corps of patent examiners in all disciplines, possessing bilingual, sometimes multilingual capabilities;
- a project for a modern and efficient automated patent processing system, supported by a forward-thinking and comprehensive IT infrastructure;
- a vast collection of patent documents and on-line resources which permits INPI-Br to meet the minimum documentation requirements;
- an organizational commitment to the pursuit of excellence in client relations and service delivery; and
- an examination capacity to manage the international workload and which may, eventually, be in a position to offer its services to applicants filing through other receiving Offices.

In addition to that, it is important to stress that INPI-Br activities as ISA and IPEA provide the following benefits:

- ensure that there is an ISA/IPEA able to search and examine international applications filed in the Portuguese language;
- facilitates the prosecution of PCT international applications for applicants from Brazil and the region, enabling them to be more productive and competitive in the knowledge-based economy;
- enhance its international reputation as a mid-sized IP office by assuming a portion of the international workload burden;
- reinforce its commitment to a continuing search for excellence in the areas of client relations and service delivery;
- strengthen the quality of Brazilian national search and examination through increased exposure to the PCT system and access to additional search tools; and
- increase the quality and of scope of training which the Office has been able in recent years to offer to other national Offices as well as the use of the PCT System in the region.

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