

Conselho Directivo

Only by email

Mr. Francis Gurry
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GP/158/18

SUBJECT: Comments on Circular C. 8787

Dear Francis,

In reference to the above-mentioned Circular dated July 31, 2018, I have the pleasure to send you herewith the comments of the Portuguese Institute of Industrial Property (INPI PT):

(i) a draft reference document on research exception. The inputs may relate to, for example, challenges faced by Member States in implementing the exception and the results of the national/regional implementation.

INPI PT: In the Portuguese legislation, the Bolar exception and the Research exception are aggregated in the same exception (article 102(c) of Industrial Property Code).

According to Article 102(c) of Industrial Property Code (IPC) the rights conferred by a patent do not extend to acts performed exclusively for trial or experimental purposes, including experiments for the preparation of the administrative processes required for the approval of products by the competent official bodies, though industrial or commercial exploitation of these products may not commence before expiry of the patent protecting them.

This exception was introduced in the Portuguese statutory law in 1995 as a result of Portugal joining the EU and subsequent ratification of International Treaties and Conventions, such as the Munich Convention. However, at that time, it only referred to

"Acts performed exclusively for trial or experimental purposes", being the remaining text only added in 2003.

This exception is motivated by the defense of higher public interests, such as the need to protect the realization of activities of scientific research based on the patented invention, under the penalty of preventing scientific and technological progress.

Regarding challenges faced by Portugal in implementing the exception and the results of the national/regional implementation, INPI has no information.

(ii) a document updating document SCP/20/9 (Confidentiality of Communications between Clients and their Patent Advisors: Compilation of Laws, Practices and other Information).

INPI PT: The information related to "Confidentiality of Communications between Clients and their Patent Advisors" available at the WIPO's website is updated (INPI PT's response to Circular C.8585 and C.8728). So INPI PT does not have any additional comments.

With regard to certain aspects of the applicable national or regional patent law available at WIPO's website, the Portuguese legislation (IPC) has not changed, so the information related to prior art, novelty, inventive step, grace period, sufficiency of disclosure, exclusions from patentable subject matter and exceptions and limitations of the rights at the WIPO's website is updated.

INPI PT is, however, undergoing a revision of the IPC that might require an update of the information in 2019, as we said in circular C.8728.

We would like to stress that some minor amendments to the information contained in the document SCP/18/4 related to national and regional laws on opposition systems have not been made yet (please see INPI PT's response to Circular c. 8585 in annex).

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The information related to international worksharing and collaborative activities for search and examination of patent applications available at WIPO's website is updated.

Yours sincerely,



Leonor Trindade

President of the Directive Council