

Conselho Directivo

Only by email

Mr. Francis Gurry
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Sua referência: Sua comunicação de: Nossa referência: Data: 28.02.2020
GP45/20

SUBJECT: Circular C. 8940 – INPI PT response

Dear Francis Gurry,

In reference to the above-mentioned Circular dated January 10, 2020, I have the pleasure to send you herewith the comments of the Portuguese Institute of Industrial Property (INPI PT):

(i) Exception regarding prior use

The applicable provision concerning prior use is the Article 105 of the Industrial Property Code. This article is directed at non-opposability and establishes that:

- "1-The rights conferred by a patent are not opposable in the Portuguese territory before the date of the application or of priority, if it is claimed against someone who, in good faith, has learned of the invention by his own means and used it or made effective, serious preparations to use it.*
- 2- The previous paragraph does not apply if the knowledge is the result of unlawful or immoral acts against the patentee.*
- 3 The burden of proof lies with the person invoking the situations set forth in paragraph 1.*

4-Prior use or preparations therefore based on the information referred to in Article 56(1)(a) does not prejudice good faith.

5-In the cases set forth in paragraph 1, the beneficiary has the right to pursue or commence use of the invention, within the limits of his prior knowledge, for his own business purposes, but may only transfer it in conjunction with the business establishment in which use is made.”

Furthermore, the Article 8 of the Industrial Property Code also establishes that applicants for or owners of rights that are re-established may not invoke them to a third party who, in good faith, in the period between the loss of the rights granted and the publication of the notice of re-establishment of the rights, has begun operation or sale of the object of the right or has made actual, serious preparations for its operation or sale. Third parties who may avail themselves of the provision in the previous paragraph may oppose the decision to re-establish rights of the applicant or owner within two months of the date of publication of the notice of re-establishment of the right.

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

(ii) Information on patent law provisions and practices that contributed to effective transfer of technology.

The Article 30 of the Industrial Property Code has a provision related to transfer, that establishes that the rights emerging from patents and utility models can be totally transferred free of charge or against payment. A transfer between living persons shall be proven by a written document. However, if the annotation of the transfer is requested by the transferring party, the recipient must also sign the document proving it or make a statement accepting the transfer.

(iii) Certain aspects of the applicable national or regional patent law, available at:
http://www.wipo.int/scp/en/annex_ii.html

WIPO's website is updated.

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(iv) National and regional laws on opposition systems and other administrative revocation and invalidation mechanisms, available at:

http://www.wipo.int/sco/en/revocation_mechanisms/

Regarding national and regional laws on opposition systems and other administrative revocation and invalidation mechanisms, available at WIPO's website, and considering the revision of the Industrial Property Code, which entered into force on 1st July 2019, INPI PT may declare, ex officio, null a supplementary protection certificate if the basic patent has expired before the end of its term or if the basic patent has been revoked.

(v) International worksharing and collaborative activities for search and examination of patent applications, available at

<http://www.wipo.int/patents/en/topics/worksharing/>

The INPI PT and the Institute of Quality Management and Intellectual Property of Cabo Verde (IGQPI) have signed a new Memorandum of Understanding in December 2029, in which INPI PT collaborates, at request of IGQPI, in the analysis of patents, utility model, supplementary protection certificates and topography of semiconductor products, at the request of the IGQPI.

(vi) Laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors, available at:

https://www.wipo.int/scp/en/confidentiality_advisors_clients/national_laws_practices.html

WIPO's website is updated.

Yours sincerely,



Ana Bandeira

President of the Directive Council