



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Julian Crump
President
c/o Abel & Imray
Westpoint Building
James Street West
Bath BA1 2DA
t. +44 1225 469914
julian.crump@ficpi.org

18 September 2019

Mr. Cláudio Vilar Furtado
President of INPI

via email: presidente@inpi.gov.br
coint@inpi.gov.br

Mrs. Liane Elizabeth Caldeira Lage
Director of Patents, Softwares and Topography of
Integrated Circuits

National Institute of Industrial Property
Rua Mayrink Veiga, 9, Centro, 22º andar
CEP 20090-910
Rio de Janeiro, RJ
BRAZIL

RE \ \ INPI Resolutions 240 and 241

Dear Mr. Vilar Furtado, dear Mrs. Lage

I am writing in the name of FICPI, the Fédération Internationale des Conseils en Propriété Intellectuelle (International Federation of Intellectual Property Attorneys), which is broadly representative of the global community of independent IP patent and trade mark attorneys, to congratulate INPI on the issuance of Resolutions 240 and 241.

I understand that these Resolutions are calculated to streamline patent examination and to reduce rapidly the existing backlog of applications in your office.

FICPI fully supports these new procedures, which are fully in line with a resolution on “TRIPs and extreme backlogs in patent examination” that our Executive Committee adopted in 2017.

I sincerely hope that the backlog of applications can now be reduced expeditiously. A copy of the resolution mentioned above is enclosed for your ease of reference.

Please do not hesitate to contact me or our Vice President, Mr. Iván Ahlert, whom I believe you know, if we can be of any service.

Yours sincerely,

Julian Crump
FICPI President

Enc.



Resolution of the Executive Committee, Hangzhou, China 26-30 March 2017

“TRIPs and extreme backlogs in patent examination”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Hangzhou, China from 26 to 30 March 2017, passed the following Resolution:

Noting that TRIPs Art. 62.2ⁱ requires Members to ensure the granting or registration of intellectual property rights “within a reasonable period of time” so as to avoid unwarranted curtailment of the period of protection;

Noting that some existing bilateral trade agreementsⁱⁱ define a reasonable period of time to constitute the longer of between four to five years from the date when the patent application was filed or two to three years from the date when the request for examination was filed; and

Considering that the average delay in granting patents by some patent offices greatly exceeds the above periods;

FICPI urges that:

- (a) (i) the period of five years from the date when the patent application was filed or, if applicable,
 - (ii) the period of three years from the date when the request for examination was filed or from the date of entry into a national phase PCT;
- is adopted as a standard with respect to the interpretation of “reasonable period of time” within the meaning of TRIPs’ Art. 62.2;
- (b) patent offices engage in actions to maintain the pendency of patent applications below the above periods, if necessary by making or intensifying the use of available resources, such as, but not limited to, PPH agreements, cooperative examination, use of shared information on examination (e.g. Global Dossier) or PCT search and examination reports; and
 - (c) if the examination period exceeds the applicable period of item (a), and if the local legislation so provides, patent owners should continue to be entitled to adjustment of the patent term to compensate for the time exceeding such period to the extent that the delay is caused by the patent office.

[End of document]

ⁱ ACQUISITION AND MAINTENANCE OF INTELLECTUAL PROPERTY RIGHTS AND RELATED INTER-PARTES PROCEDURES

Article 62

1. Members may require, as a condition of the acquisition or maintenance of the intellectual property rights provided for under Sections 2 through 6 of Part II, compliance with reasonable procedures and formalities. Such procedures and formalities shall be consistent with the provisions of this Agreement.

2. Where the acquisition of an intellectual property right is subject to the right being granted or registered, Members shall ensure that the procedures for grant or registration, subject to compliance with the substantive conditions for acquisition of the right, permit the granting or registration of the right within a reasonable period of time so as to avoid unwarranted curtailment of the period of protection.



ii See, e.g.:

(A) FTA USA-Chile: ARTICLE 17.9.6. Each Party shall provide for the adjustment of the term of a patent, at the request of the patent owner, to compensate for unreasonable delays that occur in granting the patent. For the purposes of this paragraph, an unreasonable delay shall be understood to include a delay in the issuance of the patent of more than five years from the date of filing of the application in the Party, or three years after a request for examination of the application has been made, whichever is later, provided that periods of time attributable to actions of the patent applicant need not be included in the determination of such delays.

(B) FTA USA-Colombia: ARTICLE 16.9.6. (b) Each Party shall provide the means to and shall, at the request of the patent owner, compensate for unreasonable delays in the issuance of a patent, other than a patent for a pharmaceutical product, by restoring patent term or patent rights. Each Party may provide the means to and may, at the request of the patent owner, compensate for unreasonable delays in the issuance of a patent for a pharmaceutical product by restoring patent term or patent rights. Any restoration under this subparagraph shall confer all of the exclusive rights of a patent subject to the same limitations and exceptions applicable to the original patent. For purposes of this subparagraph, an unreasonable delay shall at least include a delay in the issuance of the patent of more than five years from the date of filing of the application in the territory of the Party, or three years after a request for examination of the application has been made, whichever is later, provided that periods attributable to actions of the patent applicant need not be included in the determination of such delays.

(C) FTA USA-Australia: ARTICLE 17.9.8. (a) If there are unreasonable delays in a Party's issuance of patents, that Party shall provide the means to, and at the request of a patent owner, shall, adjust the term of the patent to compensate for such delays. An unreasonable delay shall at least include a delay in the issuance of a patent of more than four years from the date of filing of the application in the Party, or two years after a request for examination of the application has been made, whichever is later. For the purposes of this paragraph, any delays that occur in the issuance of a patent due to periods attributable to actions of the patent applicant or any opposing third person need not be included in the determination of such delay.