INPI revokes restriction regarding restoration of patent applications and patents

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The Brazilian Patent and Trademark Office (National Institute of Industrial Property - INPI) finally revoked a regulation issued in 2013 that, in practice, considered patent applications and patents with more than one annuity pending payment to be definitively abandoned.

According to article 13 of Resolution No. 113/2013, the INPI was authorized to definitively shelve applications or extinguish patents, with no possibility of restoration, if there was more than one annual fee pending payment.

This initiative contradicted the prior practice and limited a legal provision that establishes a three-month period for restoration in cases of shelving and extinction, including for failure to pay the annual fee (Article 87 of Law No. 9,279/1996, Industrial Property Law).

INPI's Resolution 113 was challenged in court by the Brazilian Association of Industrial Property Agents (ABAPI), with the participation of the Brazilian Intellectual Property Association (ABPI). The associations managed to suspend the application of Resolution 113 and, in September 2020, the Superior Court of Justice (STJ) decided that the INPI must notify the holder of an application or a patent to exercise the right of restoration. According to the STJ,"the INPI, by removing the right to restore a patent in cases not provided for in the law [Industrial Property Law], unlawfully restricted the right to restore"

Subsequently, INPI issued a new resolution (No. 348/2020, of October 9, 2020) revoking art. 13 of Resolution 113 and establishing that INPI will cancel the definitive shelving of patent applications or definitive extinction of patents that resulted from the application of the revoked provision.

It is possible that the INPI restriction that was challenged in court did not harm a large number of holders, as one may assume that several of the cases shelved by the INPI by applying art. 13 were not really of interest to their holders anymore. However, the above-mentioned developments exemplify how constant and consistent actions from various sectors of the Brazilian society are improving the industrial property system in the country, seeking a balance between efficiency and legal certainty.

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