

A note on the Term of Brazilian Patents under TRIPs

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Brazil was always well provided with patent laws of complex technical and legal consequence. Fourth country in the world to enact a patent law (in 1809), it was a founding member of the Paris Convention in 1882 and remained a full-fledged party to such treaty since then. Patents received Constitutional acceptance in the first Imperial Charter of 1824, and further Republican Constitutions provided for patent protection (and eventually, trademarks) in their Bill of Rights.

Multilateral considerations were of course present during all the lengthy Congressional proceedings leading to the new law, which entered in force on May, 1997. Harmonization procedures held by the World Intellectual Property Organization in Geneva and, especially, the negotiation of the Uruguay Round of GATT had brought to the field of intellectual property the concept of *international minimum standards*, substantive requirements on the content of national laws.

The 1994 successful end of the Uruguay Round and the new (TRIPs) Agreement under World Trade Organization established the minimum standards requirement as the applicable legal criterion. Law 9.279 is obviously intended to fulfill TRIPs required levels.

Patents are now granted for inventions and utility models (design creations are protectible according to a special system of registration). Novelty and industrial application are the requisites of patentability; the pertinent legal definitions of such requirements follow the classical criteria. Inventions are evaluated under the light of the also classical concept of inventive activity.

The new Code draws a distinction between subject matters unpatentable by reason of not being an invention on one hand, and statutory exclusions of patentability on the other hand. As previously stated, the new 1996 Law 9.279 provides for the patenting of chemical products (as processes were already patentable) and all sorts of food and pharmaceutical inventions.

The Law deems not to be inventions, and for such reason unpatentable: a) discoveries of natural occurring laws and items; b) mathematical or otherwise scientific theories and purely abstract concepts; c) commercial, financial, advertisement, accountancy and similar schemes; d) works of art; e) computer programs by itself; f) presentations of information; g) rules of games; and g) surgical procedures and therapeutic methods for human and animal body¹.

¹ Also excluded as non inventions are the whole or part of any live natural being and biological material found in Nature, even isolated thereof, including the genom or germoplasm, and the natural biological processes.

These non invention items are generally in conformity with European standards, even though some of them (as the medical items, computer programs and isolated items of nature) may differ to some extent from recent U.S. practice. However, it might be argued those statutory definitions should be held applicable only in the cases were the subject matter of the filing was not actually an invention (a human-solved technical problem).

Actual statutory exclusions (i.e., excluded notwithstanding they are actually inventions) are: a) the inventions offensive to morals, good customs, security, to public order and public health; b) items resulting from the transformation of atomic nuclei; and c) the whole or a part of living bodies (even though not found in nature), except in case of transgenic microorganisms that satisfy all the patent requirements

As stated, Law 9.279 was in full force from May 15, 1997. A special set of provisions, however, covered the chemical product, food and pharmaceutical inventions not previously patentable. Those inventions are granted special filing rights, to be requested from the date of the publication of the law to one year thereafter.

During such period, applications regarding such inventions previously filed abroad are to be accepted and patents granted for the remaining term of the original patent, limited to the maximum Brazilian term (20 years). This special provision does not apply to cases where the object of the patent has not been marketed anywhere in the world by the foreign patent owner² before the special filing is requested in Brazil.

Except for the case of special filing above mentioned, no new protection shall be granted to the patent requests not yet granted at the moment of the new 1996 Law, which referred to the non statutory matters indicated under the 1971 law³ (1996 Law, art. 229).

A specific provision (art. 232) states that: a) manufacturing of food, pharmaceutical or chemical products, even if they were patented abroad and b) use of food or pharmaceutical related processes, even though they were patented abroad, may continue as they were before the law, and no fees or royalties shall be due retroactively or in the future. The same shall apply in cases where significant investments were made before the law for the same purposes.

If the patent were granted as requested its final term, according to the Law then in force, would be fifteen years from filing date. Under the new Law, normal patent term expires in 20 years counting from filing date, or 15 years in case of utility models; but it is assured a minimum of 10 or 7 years respectively, counted from issuance of letters patent, *except if INPI was prevented from examining the application by court order* (Art. 40 of the 1996 Law)⁴.

In a number of cases filed in the last few months, plaintiffs have argued that TRIPs art. 33 imposed upon the patents already issued by requesting that patents should have a minimum

² No protection is due also in the case where substantive investments were done in Brazil by third parties as to the object of the patent.

³ Namely, manufacturing of food, pharmaceutical or chemical products and use of food or pharmaceutical-related processes.

⁴ See Tinoco Soares, Lei de Patentes, Marcas e Direitos Conexos, Ed. RT, 1996, p. 83.

term of 20 years. Some preliminary injunctions were issued in connection with such actions. None of these cases were decided on the merits for the time being.

The INPI as a defendant in such actions has consistently argued that TRIPs was *not* applicable to Brazil until 2001. The Ministry of Foreign Affairs, in a letter addressed to the Brazilian Association of Fine Chemicals on November 17, 1997, has fully supported such contention as the official Brazilian position during the negotiations which conducted to the TRIPs Agreement.

A legal opinion by the General Counsel of the Ministry of Industry, Commerce and Tourism was published at the Official Gazette of November 29, 1997, also stating that no further term is due on the patents granted under the 1971 Code.

Both TRIPs⁵ and the 1996 Law⁶ also contain general provisions stating that they do not apply to facts occurring before they entered into force.

⁵ Art. 70.1 of TRIPs.

⁶ Art. 235 and 243.