

Conselho Directivo

*By email only*

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Sua referência:                  Sua comunicação de:                  Nossa referência:                  Data: **09.03.2018**  
**CD1-02-18**

**SUBJECT: C. 8728 - INPI PT Comments**

In reference to your Circular C. 8728, dated February 9, 2018, the comments of the Portuguese Institute of Industrial Property (INPI PT) are as follows:

INPI PT does not have additional inputs for the preparation of the second draft reference document on exception regarding acts for obtaining regulatory approval from authorities beyond those stated in our answer to the Circular C. 8687.

In relation to the examination guidelines/manuals and summary of the most important case law or interpretive decisions, we must inform you that the Portuguese Office has internal and external documents related with examination, such as "Industrial Property Code Application Manual", "How to interpret Search report with written opinion", "How to interpret Examination report" and "N3 product quality standard", some of them available at our webpage (in annex, available only in Portuguese language).

The Portuguese Examination Guidelines are being reviewed, but we also use the European Patent Guidelines in our examination procedures.

Portugal has few court cases (jurisprudence) related to patents, although we have the following interpretive decisions for the inventive step:

- Proc. Nr. 372/14.0YHLSB - Intellectual Property Court (PT105407) related with synergic effects;
- Proc. Nr. 245 ARBITRARE - (PT106763) related with selection inventions;
- Proc. Nr. 167/12.5YHLSB - Intellectual Property Court (PT102634);

8 Proc. Nr. 317 / 2002.S1 - Judgment of the Supreme Court (PT 94306)

An English version automatically translated of these decisions obtained in Darts-IP can be found in annex.

With regard to applicable national patent law, the Portuguese legislation (Industrial Property Code) has not changed, so the information related with prior art, novelty, inventive step, grace period, sufficiency of disclosure, exclusions from patentable subject matter and Exceptions and Limitations of the Rights available at WIPO's website is updated. We are, however, undergoing a revision of the Industrial Property Code that might require an update of the information in 2019.

In relation to national laws on opposition systems and other administrative revocation and invalidation mechanisms, INPI PT would like to mention some minor amendments to the information available at WIPO's webpage and market-below in bold:

*"To file an opposition, the opponent has to pay the opposition fee and if the patent applicant wishes to reply to an opposition, it is also necessary to pay a fee. **Please see the table of IP Fees, available at <https://inpi.justica.gov.pt/Documentos/Taxas/Tabelas-de-taxas>.***

*The substantive examination phase starts after the opposition phase. If an opposition was submitted, it will be considered by the examiner in the analysis of the patentability criteria (novelty, inventive step and industrial applicability). The conclusion of the examination process is the notification of grant, refusal, or partial grant, issued accordingly, and is communicated both to the patent applicant and the opponent. These decisions are subject to appeal at the **Intellectual Property Court or at the Arbitral Court**, within two months that follow the publication of the decision in the Industrial Property Bulletin."*

Finally, INPI PT's information related to laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors available at the WIPO's website is updated (INPI PT's response to Circulars C.8585 and C.8261).

Yours sincerely,



Marco Dinis

Member of the Board