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March 08, 2021

Note C. 8940

Standing Committee on the Law of Patents¹

Brazil

**Additional Inputs for the Preparation of a Draft Reference Document on the
Exception Regarding Prior Use**

Legal issues regarding the exception to patent rights related to the previous user are regulated in Section II of Chapter V of Law No. 9,279, of May 14, 1996 (IPL), which deals with the protection conferred by the patent. Article 45 of IPL provides for a limitation on the rights of the patent holder in cases where the use of the patent object by a *bona fide* third party is prior to the filing or priority date of the patent application.

CHAPTER V

PROTECTION CONFERRED BY THE PATENT

Section II

Prior User

Article 45. A person who in good faith, prior to the filing or priority date of a patent application, was exploiting the object thereof in this country, shall be assured the right to continue the exploitation, without onus, in the same manner and under the same conditions as before.

¹ The answers to this Note have been provided on behalf of Brazil by Brazilian National Institute of Industrial Property (INPI).



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This legal provision gives the prior user in good faith permission to continue using the patent object without being legally framed as an infringer. In this case, the holder will not be entitled to any kind of compensation for the exploitation of the patented invention.

In international agreements to which Brazil is part there is no specific regulation on the issue of limitations on the "previous user in good faith." Both Paris Convention for the Protection of Industrial Property (Paris Union) and Trade-Related Aspects on Intellectual Property Rights Agreement (TRIPS) give countries the freedom to choose the most appropriate way to address this issue at the national level². Brazilian IP Law has established some rules that must be observed by the user in good faith so that there is no abuse of the patent holder rights:

- The previous user right is territorial, with no possibility of extension for cases in which the previous use has occurred abroad, even though it can be considered as in good faith. Therefore, the premises of Article 45 of IPL are only applicable to cases in which previous exploitation of the patented object took place in Brazil.

- The previous user right can only be assigned with the business or the company, or part of it that has a direct relationship with the exploitation of the patent object, by alienation or lease (Article 45, First Paragraph, IPL³). This means that, unlike the patent holder, the *bona fide* user will not be able to license his rights to third parties who wish to exploit the patent.

- The previous user must not have been aware of the patent object through disclosure, in the form of article 12 of IPL (grace period), provided that the application has been filed within 1

² Article 30 of TRIPS Agreement - Exceptions to Rights Conferred - Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.

³ Article 45, Paragraph 1 of Law N° 9,279, of 1996 - The right conferred under this Article may only be assigned together with the business or company, or part thereof that is directly related to the exploitation of the object of the patent, by transfer or leasing.



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(one) year of the disclosure date (Article 45, Paragraph 2, IPL⁴). It should be noted that the fact that a disclosure occurred in the cases provided for in Article 12 of IPL does not directly imply that the previous user was aware of the patent object by such means of disclosure. The *bona fide* previous user can prove that there was no access to said disclosure and will then be entitled to the exception, being authorized to proceed with the exploitation of the patent object in the previous manner. In addition, it is important to take into account the fact that the information transmitted to third parties during this period may be quite inaccurate or insufficient, so as not to allow the reproduction of the patent object by third parties. Therefore, when the previous user's right is claimed by a third party after the inventor has revealed information about the invention and before the filing date of the respective patent application, it must first be assessed whether the product or process exploited by the third party can be considered as a direct consequence of the information released by the inventor, regardless of whether this product or process is within the scope of protection of patent claims⁵.

In summary, if the *bona fide* is configured, the previous user will be able to continue exploiting the patent object in the same form and condition that he had been practicing previously, without this act being set as an infringement of the patentee rights. The previous user cannot exceed the usual volume of manufactured products or the level of activity related to the patented invention, which can be both a product and a process⁶. In the event that the product was already being sold within the scope of the domestic market, the previous user will no longer be able to expand his business with a view to the foreign market after the patent filing. If the previous use was restricted to the business itself or particular needs, without commercial purposes, after the filing date of the patent application, the previous user will not be able to start marketing the product and / or use the process for third parties. Likewise, the right of the previous user is restricted to exploitation of the object, considering that the *de facto* right (including the possibility of assignment)

⁴ Article 45, Paragraph 2 of Law N° 9,279, of 1996 - The right referred to in this Article shall not be assured to a person who gained knowledge of the object of the patent through disclosure, in accordance with Article 12, provided that the application has been filed within 1 (one) year of the disclosure.

⁵ AHLERT, Ivan B.; CAMARA JUNIOR, Eduardo G. Patentes: Proteção na Lei de Propriedade Industrial. São Paulo: Editora Atlas, 2019.



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belongs to the patent holder, who will have the possibility to file lawsuits against infringers or to grant exploitation licenses⁶.

A secondary issue that may arise from a lawsuit recognizing *bona fide* previous use is the validity of the patent that protects the object of use. If the previous use was public, it is possible for the user to claim the patent nullity based on the absence of the novelty requirement. In this case, the testimonial evidence that proves the previous use in good faith is usually not sufficient to attest to the lack of novelty of the patent object due to lack of specifications and technical details. A lawsuit for patent invalidity necessarily involves a stage of judicial investigation, in which a comparative technical analysis is carried out between the object claimed and the knowledge available in the state of the art at the time of the filing of the patent application.

It is important to note that, in order to be entitled to the exception provided for in Article 45 of the IPL, it is necessary to verify if the third party in fact has previously used the patented invention, considering that the central objective of this legal provision is to allow the previous user to continue to use the patented object in the same way it was being done before the patent filing. Thus, it is not enough, nor is it necessary, that the person proves to have created the invention before the date of the filing of the patent application⁶. Another point to be considered is whether the previous use derives from bad faith practice. This happens, for example, when the previous user became aware of the patented invention illegally, through information of industrial secrecy, from the employment contract (employee / employer relationship), from project disclosure with confidentiality clause, among others.

In practice, recognizing the good faith of the previous user is not always a simple task for judges, who must seek to examine the issue in the concrete set of each case. According to

⁶ ROUBIER, Paul. Le Droit de la Propriété Industrielle, Partie Générale, Paris: Librairie du Recueil Sirey, 1952.



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renowned Brazilian jurist Miguel Reale^{7,8}, good faith is “*one of the essential conditions of ethical activity, including legal activity, characterized by the sincerity and probity of those who participate in it*”.

Objective good faith presents itself as a “loyalty requirement”, an objective model of conduct, a social archetype by which it imposes the power-duty that each person adjusts his own conduct to that archetype, working as an honest person, a loyal. In the context of Industrial Property, the good faith of the previous user can be verified from the moment when he made the invention himself or else he received it legitimately from its inventor⁹.

The following are extracts from Brazilian court decisions involving the exception related to the *bona fide* previous user.

Case 1. Civil Appeal: AC 224505 SC 2003.022450-5¹⁰

Santa Catarina Court of Justice TJ-SC

Rapporteur: Paulo Roberto Camargo Costa

Plaintiff: Prademir Antonio Werner

Defendant: Irmãos Wickert Ltda./ME

Sentence: Recognition of a previous user in good faith

The patent holder of the Utility Model N° MU7101764-0, referring to a “manual planter with brake and tongue”, filed a “lawsuit for abstaining from the practice of an illegal act with

⁷ REALE, Miguel. A boa-fé no Código Civil. 2003. Available at the Internet: www.miguelreale.com.br/artigos/boafe.htm. Accessed on February 27, of 2020.

⁸ REALE, Miguel. Estudos Preliminares do Código Civil. São Paulo: Editora Revista dos Tribunais, 2ª Edição, 2003.

⁹ PHILIPP, Fernando Eid. Patente de Invenção: Extensão da Proteção e Hipóteses de Violação. São Paulo. Editora Juarez de Oliveira, 2006.

¹⁰ Accessed on February 28, of 2020 at the Internet address: <https://tj-sc.jusbrasil.com.br/jurisprudencia/6537379/apelacao-civel-ac-224505-sc-2003022450-5/inteiro-teor-12638871?ref=juris-tabs>



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compensation for loss of profits” n.º 059.00.001043-8 against a third party alleging infringement of patent rights. The Defendant filed its defense arguing the lack of identity between the planters produced by him and those manufactured by the Plaintiff, as well as the absence of illicit conduct, as he had already produced such objects even before the regulation of property rights, as a previous user, pursuant to Article 45 of IPL, which was recognized by the first instance judge.

The patent holder filed an appeal, claiming that there was no evidence that the machines produced by the Defendant, prior to filing, already had the innovations described in patent no. MU7101764-0 (brake and tongue assembly).

To assess whether there was good faith from the part of previous user of the patent object, the judge in charge relied on documentary evidence (invoice and planter's advertising folder) and testimonials (three witnesses who used the machine before filing) presented by the accused. The magistrate also took into account in his judgment the probability that third parties would have learned of the patent object directly from the inventor during the grace period (Article 12 of IPL).

In view of the evidence that the planter protected by the Plaintiff's patent was already produced and used by third parties before the patent filing date, and as there was no evidence on the applicability of the restriction on Article 12 of IPL, the judge concluded that the case fit in the limitation of Article 45 of IPL, which deals with the previous user in good faith, and the holder does not have the right of any type of indemnity, according to the transcription of the sentence:

“Therefore, to bona fide third parties that produced and marketed the patent object prior to its filing, the right to exploit the invention is ensured, and the holder right to obtain indemnity is no longer imposed on them. And, as outlined in the cited articles, this benefit is no longer applied only if it is verified that they were aware of the invention in the grace period and in the form of paragraphs 2 and 3 of article 12, now quoted.



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As GABRIEL DI BLASI explains, “this provision deals with the recognition of the user's rights prior to the filing date or the priority date of the patent application. This principle applies to certain people who already have acquired rights in relation to the exploitation of the invention that will become the object of a patent. In other words, the rights of that bona fide person, who already exploited the invention before it became the object of a patent application, will be assured, and the said user may continue to exploit the invention in the form and conditions in which he previously used it, free of charge. In this case, the erga omnes exercise resulting from the patent right will not be applied to the previous user”.

And, adds the aforementioned Counselor: “However, this right is not guaranteed for those who obtained the knowledge of the invention through the disclosure established in article 12. However, great care must be taken when such a prediction (grace period) is used, since, after the disclosure of the aforementioned invention, another unauthorized person, who had access to the disclosure information, based on the acts provided for in the mentioned items, can apply for a patent. In this case, if the real inventor fails to prove that such deposit is due to the disclosure promoted by him, the application will be granted and he will lose the right to obtain the patent, which becomes the property of the unauthorized person.” (in “A propriedade industrial: os sistemas de marcas, patentes e desenhos industriais a partir da Lei n.º 9.279, de 14 de maio de 1996”. Rio de Janeiro: Forense, 2005, p. 296). In casu, I note that the defendant's presumption of good faith remained sound, as there was no demonstration that she obtained knowledge of the invention through disclosure made in accordance with the provisions of paragraphs of article 12 of Law No. 9,279 / 1996, it is not appropriate to remove the legal protection offered by article 45 of the said legislation, since it has satisfactorily proven its priority in the exploitation of the planters indicated in the initial one.

In view of the above, I am aware of the appeal and dismiss it.

DECISION

Under the terms of the rapporteur's vote, the Chamber decided, unanimously, to hear the appeal and dismiss it.”



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Case 2. Special Appeal nº 1.096.598 - MG (2008/0234753-8)

Superior Court of Justice (STJ)

Rapporteur: Ministry Nancy Andrichi

Appellant: UAI - União De Artefatos Industriais LTDA.

Appellee: Brasilata S/A Embalagens Metálicas

Decision: Failure to qualify as a previous user in good faith / Witness evidence does not prove exploitation of the patent object by the Appellee, but only by third parties

In the Special Appeal analyzed by the Superior Court of Justice (STJ), Minister Nancy Andrichi maintained the understanding of the Court of Appeal (TJ / MG) that the previous use in good faith cannot be proven by the testimonial evidence brought by the company UAI (Appellant). It turns out that such evidence only proves the previous use of the invention by third parties, but does not certify that the company itself already used the patented object before the filing of patent application of the company Brasilata S / A Embalagens Metálicas (Appellee). Therefore, the Appellant is not entitled to the exception of article 45 of the IPL regarding the previous use in good faith. Additionally, the Appellant's allegations that the testimonies of third parties prove the lack of novelty in the patent was also not accepted by the court, since such testimonies were considered insufficient to revoke the patent in the absence of technical expertise. The Appellant was then ordered to indemnify the patent holder for the unauthorized use of the invention and the validity of the patent PI 9408643-5 was maintained. Below are some relevant excerpts from the report and the sentence.

“REPORT

The Hon. MRS. MINISTER NANCY ANDRIGHI (Rapporteur):

This is a special appeal filed by UAI - União de Artefatos Industriais Ltda., Based on paragraph “a” of the constitutional permissive, against a judgment issued by the TJ / MG Court.



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Action: the Appellee, Brasilata S / A Embalagens Metálicas, filed an action for damages against the Appellant in which he claimed to be the holder of a patent for an invention that concerns the system for opening and closing metal cans (PI 9408643-5, granted by the INPI in 19.10.1999). However, the Appellant, without authorization, started to sell cans that have the same patent protected device. He asked the Appellant to refrain from violating industrial property rights and to indemnify the lost profits.

Sentence: dismissed the requests made in the initial petition. Although he recognized that the products under analysis have “the same concepts of retention and sealing protected in patent PI 9408643-5 of the applicant Brasilata” (pages 821), the court in the first degree of jurisdiction found that the model marketed by the appellant is simpler than the protected one and that, in addition, it was already manufactured by other companies when the patent application was filed at the INPI.

Judgment: the TJ / MG Court upheld the appeal filed by the defendant to order the applicant to refrain from manufacturing, importing, selling, exposing the sale, concealing or receiving, for the purpose of sale, a product that would imply infringement of patent PI 9408643 -5, under penalty of a daily fine equivalent to R \$ 10,000.00 (ten thousand reais). The applicant was also ordered to pay indemnity for losses and damages, as of 10.19.1999, the amount of which must be determined in the settlement of the sentence.

(...)

VOTE

The Hon. MRS. MINISTER NANCY ANDRIGHI (Rapporteur):

(...)

V. Error in the evaluation of the proof (art. 333, I and II, of the CPC).

The lodging of a special appeal is permitted when it is a question of erroneous assessment of the evidence. This understanding is based on the premise that there are certain legal rules that guide the evidential activity and the violation of them is a matter of law, not of fact. Thus, the error in the valuation presupposes the contradiction to a principle or a legal rule in the evidential field (REsp 695.000 / RJ, 3rd Panel, Rel. Min. Menezes Direito, DJ 21.05.2007).

However, the valuation is not considered erroneous when the judge, within the legal criteria, considers the most emphatic and relevant evidence for the resolution of the controversy.



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Such valuation is not erroneous because it is based on the principle of free rational conviction.

There is, therefore, a clear line that separates erroneous valuation and free rational conviction. In relation to that, there is an error of law; in relation to this, there is no illegality and, therefore, its revision is beyond the control of the STJ, due to Precedent 7 / STJ.

Based on this differentiation, in the case before the Court, the Appellant stated that there was an error of law, especially in the assessment of testimonial evidence. That evidence, in his view, shows that the invention was widely used in the manufacture of metal cans even before the date on which the Appellee filed a patent application with the INPI.

The Appellant highlighted the testimony of Marino Pacheco, according to which "other companies already manufactured this same product with the same closing system; that in 1992, when working at another company in the same branch as the Appellee, the product was already manufactured using the same closing system as the Appellee "(pages 999).

After presenting these arguments, the Appellant concludes that the hypothesis of the case is inserted in the context of art. 45 of Law No. 9,279 / 1996. This norm determines that "to the person in good faith who, before the date of filing or priority of patent application, explored its object in the Country, the right to continue the exploration, without charge, in the previous form and condition" will be guaranteed.

When dealing with this issue, Professor José Carlos Tinoco Soares reminds us that no one is obliged to apply for a patent to protect the inventions he uses in industrial activity. If an entrepreneur obtains protection for the invention that was already used by his competitors, two possibilities are opened up to those harmed: (i) challenge the patent, by proving the absence of novelty; or (ii) make use of the "Common Law" ensured by article 45 of Law No. 9,279 / 1996 ("Lei de Patentes, marcas e Direitos Conexos". São Paulo: RT, 1997, p. 91).

Nullity cannot be incidentally recognized in this process, as the testimonial evidence proves to be weak for this purpose. Nor is the subject of the special appeal.

On the other hand, the application of article 45 of Law No. 9,279 / 1996 requires that the invention has been used by the Appellant itself, but the testimonial evidence produced only reliably points to use by third parties.



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Thus, it must be recognized that the special feature presents these arguments with some deviation of perspective. The TJ / MG Court realized this fact and it was intended to another part of this same testimony, according to which Marino Pacheco "does not know if in 1993 or 1994 (...) the Appellee manufactured the cans with this closure system" (pages 933).

Therefore, the contested judgment concluded that "although the Appellant insists on claiming that it has manufactured its metal cans since 1993, in identical configuration with the current ones, and therefore, in a period prior to the filing of the invention with INPI by the Appellee, there is no evidence in the file supporting this defensive thesis "(pages 933).

In what is essential for the solution of the dispute, the Appelant intends to emphasize the public knowledge of the technique he used, but the TJ / MG Court, in line with the provisions of article 45 of Law No. 9,279 / 1996 requires proof that the Appelant, by itself, already produced, in the past, metal cans of the current form.

Having made these considerations, it should be noted that the present hypothesis is not exactly an error in valuation. The applicant actually wants a new weight to be attached to the evidence set, in order to obtain from the evidence produced a new conclusion that is more favorable to it. As stated, this claim is hindered in Precedent 7 / STJ.

Strong on such grounds, DENY the special appeal."

Case 3. Civil Process nº 021/1.05.0025189-9 (0251891-81.2005.8.21.0021)

Court of Justice of the State of Rio Grande do Sul (TJ/RS) – Passo Fundo District

Judge: Sílvio Luis Algarve

Plaintiff: Glaucio Ciriaco Neuwald Silva

Defendant: Bandeirante Indústria e Comercio De Máquinas Ltda

Sentence: Failure to designate a previous user in good faith / Absence of effective exploitation of the patent object by the Plaintiff



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The matter brought up for discussion in the present case concerns rights and obligations related to industrial property, and the plaintiff bases his claim on the circumstance of being a previous user of an industrial product, invented by him, but whose patent filing request was formalized with the INPI (National Institute of Industrial Property), and granted to the Defendant, now appealed.

The Plaintiff intends, based on the prototype that she had manufactured and, on 7/31/1989, sent on consignment to the company Comércio de Máquinas Agrícolas Justi Ltda. (fl. 31), the recognition of the right, under Article 45, of the Industrial Property Law, to explore, without charge, the product covered by patent No. PI9303883-6A, called 'limestone distributor', granted to the Defendant, and on which the request for privilege was deposited on September 16, 1999.

The so-called 'previous user's right' basically consists of the protection that the legislation gives to the one who developed a product, and who already exploited it when there was a application for the privilege of invention, filed with the National Institute of Industrial Property (INPI) by another person, who independently conceived it along the same lines, and who, merely in view of the previous filing of the application, and not the creation of the invention, will be the holder of the patent rights.

It is, therefore, a limitation to the rights granted to the applicant of the request for privilege, which, in the face of the previous user, will not have the prerogative to prevent the use of the invention, and cannot, in the face of such use, charge any remuneration, licensing, royalties, etc.

Provides for the aforementioned article, verbis:

Artigo 45. A person who in good faith, prior to the filing or priority date of a patent application, was exploiting the object thereof in this country, shall be assured the right to continue the exploitation, without onus, in the same manner and under the same conditions as before.

§ 1º The right conferred under this Article may only be assigned together with the business or company, or part thereof that is directly related to the exploitation of the object of the patent, by transfer or leasing.



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§ 2º The right referred to in this Article shall not be assured to a person who gained knowledge of the object of the patent through disclosure, in accordance with Article 12, provided that the application has been filed within 1 (one) year of the disclosure.

In order to characterize this condition, therefore, the legislation determines that two basic requirements are fulfilled.

Thus, it is necessary, in the first place, that the user holds, in good faith, the technology used by the patent applicant. Therefore, the rules do not provide protection to those who become aware of it through the inventor himself, or by third parties, based on the information obtained from the invention or in the face of their acts, or through INPI, through the publication of the filed patent application, without the consent of the inventor, everything provided that the request has been filed within one year after the disclosure (article 45, paragraph 2, and article 12, of Law No. 9,279 / 1996).

Moreover, it was not claimed that the Plaintiff had become aware of the invention in the terms above, as well of an application for an equipment with specific characteristics. In fact, there is even evidence that the development of her prototype occurred independently, in relation to the machine manufactured by the Defendant, from other models that she already produced (pages 206/214).

Secondly, in order to be considered as a previous use according to this legal provision, the user must exploit the invention in Brazil, thus ensuring the right to continue the enterprise, free of charge, in the form and condition in which it was already developing. And at this point, regardless of the possible identity or not of mechanisms used by the parties, I understand that the rule does not support the Plaintiff's claim.

There is no doubt that the Plaintiff has, in fact, produced a device equipped with mats, which conveyed the limestone until the moment when, due to the action of gravity, it was deposited on the ground.

The generic challenge to the documents presented by the Plaintiff (pages 96/97) does not obscure the testimony of the witness Délcio Baseggio (page 358), who confirms the performance of tests with the equipment on his rural property, an opportunity in which the photographs attached to the pages. 34, 35 and 36 have been taken.



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It turns out that the evidential elements do not allow to conclude that there was an effective exploitation, a true economic activity developed around the invention.

Although the limestone dispensing equipment developed by the Plaintiff and sent on consignment to the company Comércio de Máquinas Agrícolas Justi Ltda. on July 31, 1998 (page 31), effectively uses the same mechanical principle patented by the Defendant, it is impossible to consider the production of a single prototype in the history of a company that has, among others, the manufacture of agricultural machines and implements (fl. 26), as a serious willingness to exploit the invention.

However, the manufacture and shipment of the equipment to the company established in Correntina, BA, took place in July, 1989, more than four years before the Defendant's patent application, which came to be filed only on September 16, 1993 (page 53).

The activities carried out until then regarding the limestone distributor, in reality, were nothing less than tests with a new product, designed and manufactured at the request of the one to whom, afterwards, the equipment was sent.

And nothing is reported, during that prolonged interval, about improvements made in the original project, or even about statistics or studies on its performance in comparison with the existing models, which would not be missed if there was a real intention to commercialize the product. And, if there was no need for improvements in the equipment produced, the reason why the implement was not immediately manufactured and marketed is not understood, since there was a problem in the distribution of limestone that had been solved by means of its invention, and being certain that the field in which the Plaintiff operates has a 'highly interesting' market, as mentioned (page 15), which is still a means of fierce competitiveness, as demonstrated by the intense litigation verified in the demands that contribute in this and in other forums, the Plaintiff would not wait a long four years to start production on a larger scale, making it possible for competitors to develop a similar product, or that, although different, would likewise distribute the limestone without the losses that were seen in other models of implements for the same purpose.

In these circumstances, it is unreasonable that until the moment when the Plaintiff heard about the filing of the patent application, made by the Defendant, he was still waiting for the opportunity to exploit the invention, without taking any effective action in this regard besides sending, twice, parts to the city of Correntina, at intervals of approximately one and two



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years, respectively, from the shipment of the equipment (on September 24, 1996, the sale of a 'limestone spreader ratchet', and on June 7, 1999, from 'parts for ratchet limestone spreader '- pages 32/33).

To corroborate these assertions, the Plaintiff's representative, Flávio Paulo Formigheri, in personal testimony (page 354), maintained that 'if it were to be successful [the new implement], it would need greater structure, and for this reason the Plaintiff chose to manufacture simpler machines, of other species. In addition, as there was a need to send a mechanic later to carry out repairs on the equipment, the production was ceased, being limited to the machine sent to Bahia, stating that 'to date, it has not produced any other similar one'.

Finally, there is no glimpse of a picture of effective exploitation of the idealized implement, but of a concrete abandonment of its manufacture, which was also due to the structure at its disposal, and there is no need to talk about preparations for exploitation.

By the way, the shipment of the machine to a distant Federation State was intended only to continue the 'tests of durability of the spare parts of the machine, with verification of the commercial viability of the set, in normal activity, in a relatively deserted place, to meet the necessary secrecy before the filing of the patent application... '(page 03, item 1.2). Anyway, it had not passed the testing phase, confidential, until concluding, regarding the feasibility of production and commercialization, that 'it would need a bigger structure, and for that reason the Plaintiff chose to manufacture simpler machines, of other species'.

In fact, everything indicates that, seeing the Plaintiff, only now, the possibility of manufacturing the implement, seeks to make use of a rule that does not reach her, because she did not perform acts that can be said to be framed in the norm, in order to perfect the machine developed, start exploiting it, taking advantage of the dissemination work already carried out by the Defendant, and by the company to which it licensed the rights to use the invention.

It happens that the rule of the right of the previous user must be understood as protective of the economic activity that was already developed around the invention, as well as of the expectations legally created around that activity when the filing of the patent application happened.



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Thus, as Fábio Ulhoa Coelho points out, although the law protects those who first claim its protection, who is not necessarily the one who first develops the product, there is no reason to sacrifice the economic activity that is already organized due to a given invention, nor the jobs and wealth it generates, due to the protection granted to the first person who applied for the patent, being 'fully compatible the protection released in favor of industrial creations and the principle of preservation of the company'.

Now, the celebrated counsellor warns that 'the exception does not benefit the inventor or the designer who, on the date of filing the patent made by another, did not exploit his intellectual creation economically'.

Protection, therefore, is geared to economic activity, the jobs and wealth it already generated, to its social functionalization, in short. For no other reason, the exploitation of the patented invention must take place, in the exact terms of the Industrial Property Law, in the 'previous form and condition' (article 45, caput), that is, it cannot be developed any further, from the patented product, an activity that until then did not exist, as already mentioned, at the absolute option of the Plaintiff, who renounced its manufacture.

In short, to the industrial law it does not matter who was the first to invent the object, but who was the first to claim the right to its exclusive economic exploitation. Thus, even if the Plaintiff designed the implement before the Defendant, she cannot prevent the exercise of the patent against her as well, since she did not grant economic exploitation to the equipment.

Although based on the justifiable reasons that the invention constitutes an acquired right of the creator, and that each one has the property of the creations of his spirit, our order did not accept, as noted by the Author, the doctrine followed by French law, according to which is enough that the first inventor only idealized the invention before the date of filing or priority, without performing any act for its exploitation, so that the hypothesis of application of the rule of the previous user is configured.

On the contrary, it welcomed, as Luiz Guilherme Loureiro teaches, even in view of the title of the respective section ('From the previous user' - emphasis added), the doctrine that only admits the possibility of the first inventor to exploit his creation 'if he had already started such exploitation, or started preparations to do so, before the date of filing or priority of the patent application.' According to the defenders of the doctrine, the Magistrate continues, 'the inventor who keeps his invention a secret and has not expressed an intention to exploit it



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does not deserve legal protection, because he has made no contribution to the progress of society'.

And the Plaintiff, on the contrary, did not express the intention to exploit the invention, but gave up of doing so, limiting himself to making a prototype, and then ending the production of the implement. Hence it is considered that there were not even effective and serious preparatory acts for the exploitation of the invention, but a true abandonment of the creation. And this withdrawal would have occurred not only until the date of filing of the patent application by the Defendant, when, he says, he imagined he could no longer manufacture the implement, but until the current possibility of production was glimpsed.

Finally, the Plaintiff, in her opening piece, states that the rejection of the postulated injunction would entail immense economic losses, 'since she is excluded from increasing her participation in a highly interesting market, prevented at least from now on exploiting her invention '(page 15).

Under these conditions, it is legitimate to state that although the Plaintiff may eventually be considered the previous inventor of the equipment (and even excluding the possibility of identity between the implements), she cannot be characterized as a previous user of that machine.