

Dear SCP Secretariat,

In reference to the Circular C. 9141 dated December 7, 2022, we have the pleasure to send you some inputs from the Portuguese Institute of Industrial Property (INPI PT) for the preparation of the following documents:

(i) a draft reference document on the exception regarding the use of articles on foreign vessels, aircrafts and land vehicles. The inputs may relate to, for example, relevant court cases, challenges faced by Member States in implementing the exception and the results of the national/regional implementation.

Concerning the exception regarding the use of articles on foreign vessels, aircrafts and land vehicles, the applicable provision is Article 103(1)(e),(f) and (g) of the Industrial Property Code. This Article establishes that:

“The rights conferred by a patent do not extend to:

- Use on board ships from other countries belonging to the Union or WTO of a patented invention in the hull, machinery, rigging, gear or other accessories of the ship, if they temporarily or accidentally enter the waters of the country, provided that said invention is used exclusively to serve the ship’s needs.

- The use of a patented invention in the construction or operation of aircraft or land vehicles of other countries belonging to the Union or WTO or their accessories if they temporarily or accidentally enter national territory.

- The acts set forth in Article 27 of the Convention of 7 December 1944 concerning international civil aviation if they have regard to aircraft from another state to which the provisions of said article apply.”

With regard to challenges faced by Portugal in implementing the exception regarding the use of articles on foreign vessels, aircrafts and land vehicles and the results of the national/regional implementation, the INPI PT has no information.

(ii) a further study on the sufficiency of disclosure (Part II), relating to inventions having an experimental nature in unpredictable art, such as chemistry and biotechnology, and any other areas that deserve special attention, as proposed in document SCP/31/8Rev.

Like any other invention, an invention in the chemistry and biotechnology fields should be disclosed in a sufficiently clear and complete manner in order to be carried out by a person skilled in the art (Article 66 of the Industrial Property Code).

However, in this type of inventions that have an experimental nature and involve unpredictable factors such as chemical reactions and biological activities, a greater disclosure of the invention is needed in order to fulfill the requirement of sufficiency of disclosure. Therefore, the use of specific, working examples in chemistry/biotechnology applications helps these unpredictable arts become more predictable.

In an application relating to a chemical compound, it is not sufficient to disclose the compound per se by its chemical structure or its chemical name, because unexpected chemical reactions could occur given that they are unpredictable, even the ones that seem naturally induced. In these cases, it is also necessary to describe in the application the process for obtaining the chemical compound and its experimental conditions, such as temperature, pressure, reagents, start and intermediate materials, chemical reactions, etc.

If not familiar to the person skilled in the art, the way the starting materials and intermediates compounds are obtained and their conversion into the final product has to be described as well. Otherwise, the disclosure is not deemed sufficient.

(iii) a document compiling information relating to the expedited examination programs of IP offices, including information on Prioritized Examination of COVID-19 related patent applications. Any additional contributions may include, for example, objectives and qualifying grounds for expediting examination programs, institutional arrangements, fees etc (document SCP/33/44, Annex).

At INPI PT, there are some mechanisms/programs for accelerating the examination of patent applications in any technical area, though not specific for Covid-19 related patent applications, namely:

- Patent Prosecution Highway (PPH). Portugal has bilateral agreements with China, Mexico, and Brazil and a global PPH agreement with an extensive network of partners. This mechanism enables worksharing between the partners, which contributes to accelerate the patenting process, to increase the quality of decisions and to harmonize them for the joint territory of the partners. The participation in PPH is free of charge.

- *Anticipation of publication of the patent application: the Portuguese legislation (Article 69 of the Industrial Property Code) establishes that the publication may be brought forward at the applicant's express request, upon payment of a fee.*

(iv) a compilation on how jurisdictions around the world address the issue of artificial intelligence (AI) inventorship through jurisprudence, legislation and practice. In this context, Member States and Regional Patent Offices are kindly invited to transmit inputs with regard to the general concept of inventorship, including employee inventors and joint inventors, as well as the application of that concept to inventions by AI.

The right to a patent shall belong to the inventor or his successors in title, as established in Article 57 of the Industrial Property Code. This Article also establishes that if two or more persons are the authors of an invention, any of them may apply for a patent on behalf of all.

Concerning employee inventors, Article 58 of the Industrial Property Code establishes that:

- *If an invention was created during the performance of an employment contract in which inventive activity is provided for, the right to the patent belongs to the company. However, if this activity is not especially remunerated, the inventor is entitled to remuneration in keeping with the importance of the invention.*
- *The inventor shall inform the company about the invention that he/she has created within three months of the date on which it is deemed to have been completed. If, during this period, the inventor applies for a patent for this invention, the time limit for informing the company is one month as of the filing of the application with the Portuguese Institute of Industrial Property. Breach by the inventor of the obligations set forth previously shall result in general civil and labour law liability.*
- *The company may exercise its pre-emptive right within three months of receipt of the inventor's notification. Notwithstanding, if the remuneration owed to the inventor is not paid in full within the established time limit, the company shall forfeit the right to the patent to the inventor.*
- *Inventions for which a patent has been applied for in the year following the date on which the inventor left the company shall be considered to have been made during the performance of the employment contract.*
- *The inventor's recognized rights may not be renounced in advance.*

Article 59 of the Industrial Property Code, regarding research and development activities, establishes that:

“1- The inventions made by its employees and service providers as a result of their research activities belong to the public legal person in whose statutory scope research and development activities are included.

2- The inventions referred to in the previous paragraph must be notified by the author of the invention within three days to the public legal person to which the employee and service provider is connected with.

3- The inventor shall, in any case, have the right to participate in the economic benefits gained by the public legal person in the exploitation or transfer of patent rights, and the modalities and terms of this participation are provided for by the statutes or by the intellectual property regulations of these legal persons.

4 - The public legal person may transfer the ownership of the inventions referred to in paragraph (1) to the inventor and may reserve the right to own a non-transferable and free non-exclusive exploitation license.

5- If, in the case provided for in the previous paragraph, the inventor obtains economic benefits from the exploitation of an invention referred to in (1), the public legal person shall have the right to a percentage of such benefits, under the terms set out in its statutes or in the intellectual property regulation of the respective body.

6- Where the employee or service provider obtains the invention during and because of the performance of a contract with a private or public body other than the public legal person of which he/she is an employee or service provider, this contract shall stipulate who will be the owner of the patent for that invention.

7- The participation of the employee or service provider in the economic benefits resulting from the exploitation of the inventions referred in paragraphs (2) to (6) is not of a remunerative or salary nature.

8- The provisions of this Article shall apply notwithstanding any stipulation or provision to the contrary.”

Regarding Inventor's rights, as established in Article 60 of the Industrial Property Code, if the patent is not applied for in the name of the inventor, the inventor is entitled to be mentioned

as such in the application and in the patent. And, if so requested in writing, the inventor may not be mentioned as such in any publications resulting from the application.

As regards inventorship, Portugal does not accept Artificial Intelligence (AI) as an inventor, because an inventor within the meaning of the Industrial Property Code must be a natural person.

This understanding is supported by:

- Article 61 (1)(c) of the Industrial Property Code, which requires that any application must contain the name and country of residence of the inventor or inventors. The terms “name” and “residence” are interpreted to mean the name and residence of a natural person.

- and also in Article 57 of the Industrial Property Code, that establishes that the right to a patent shall belong to the inventor or his/her successors in title. AI does not have legal personality; therefore, it cannot transfer any right/title.

In addition, INPI PT is also sending updated information on the following topics:

(i) certain aspects of the applicable national or regional patent law, related to prior art, novelty, inventive step (non-obviousness), grace period, sufficiency of disclosure, exclusions from patentable subject matter and/or exceptions and limitations of the rights

WIPO's website is up to date.

(ii) national and regional laws on opposition systems and other administrative revocation and invalidation mechanisms

As INPI PT reported in circular C. 9043, with the revision of the Portuguese legislation (Industrial Property Code), which is in force since 1 July 2019, the INPI PT may declare null, ex officio, a supplementary protection certificate (SPC) if the basic patent has expired before the end of its term or if the basic patent has been revoked. The remaining information available at the WIPO's website is updated.

(iii) international worksharing and collaborative activities for search and examination of patent applications

Regarding collaborative activities for search and examination of patent applications, the INPI PT established a protocol with the European Patent Office (EPO) in which the EPO will carry out search reports with written opinion of patent applications.

This collaborative activity will start after the amendments to the Industrial Property Code, which are currently under analysis, come into effect.

Since 2021, the INPI PT also has a collaborative project with the Spanish Patent and Trademark Office in SPC examination, which enables the exchange of best SPC examination practices between examiners of the two offices and the exchange of ideas on future SPC examinations.

In 2022, the INPI PT signed two Agreements with the INPI Brazil and with the Spanish Patent and Trademark Office. These Agreements provide the exchange of patent examiners, with the aim of updating and increasing the exchange relations through reciprocal assistance mechanisms.

Furthermore, the INPI PT continues to collaborate, upon request of the Institute of Quality Management and Intellectual Property of Cabo Verde (IGQPI), in the analysis of its patent applications, under the Memorandum of Understanding signed with this Institute.

In addition, the INPI PT has bilateral agreements established with China, Mexico, and Brazil and is part of the global PPH agreement network. This agreement with China also envisage the exchange of patent examiners, with the aim of exchanging best practices.

(iv) compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors

The information related with “laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors” available at the WIPO’s website is updated.

Best regards,

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