

Conselho Directivo

*Only by email*

Mr. Francis Gurry  
Director General  
WIPO  
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1211 GENEVE 20  
SWITZERLAND

Sua referência:

Sua comunicação de:

Nossa referência:

Data: 28.09.2016

GP 146/16

**SUBJECT: Circular C. 8585**

*Dear Francis,*

In reference to the above-mentioned Circular inviting Member States of the SCP to provide or update information on "Exceptions and Limitations to Patent Rights", "Confidentiality of Communications between Clients and Their Patent Advisors", "Quality of Patents, including Opposition Systems", as well as to update information available at some WIPO's webpages, I have the pleasure to send you in attachment the comments of the Portuguese Institute of Industrial Property (INPI PT).

Yours sincerely,



Leonor Trindade

President of the Directive Council



**Circular C.8585**

**Portuguese Institute of Industrial Property (INPI PT)**

**"Exceptions and Limitations to Patent Rights" and "Confidentiality of Communications between Clients and Their Patent Advisors":**

(i) Practical experiences on the effectiveness of, and challenges associated to, exceptions and limitations to patent rights, in particular in addressing development issues:

*In INPI PT's response to Circular C.8481, it was submitted information on this topic.*

(ii) Court cases with respect to client-patent advisor privilege including limitations or difficulties encountered:

*INPI PT is not aware of court cases with respect to client-patent advisor privilege.*

**"Quality of Patents, including Opposition Systems":**

(i) Certain aspects of national/regional patent laws, available at:

[http://www.wipo.int/scp/en/annex\\_ii.html](http://www.wipo.int/scp/en/annex_ii.html):

*In INPI PT's response to Circulars C. 8481 and C. PCT 8436, it was informed that 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.*

*However, in our response to the Circular C. PCT 8436, INPI PT took the opportunity to make small amendments to the text concerning Grace Period, Exclusions from Patentable Subject Matter, Exceptions and Limitations of the Rights, in accordance to the English translation of the Portuguese Industrial Property Code.*

(ii) Opposition systems and other administrative revocation and invalidation mechanisms, in document SCP/18/4 available at:

([http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=202420](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=202420))

INPI PT would like to update and make small amendments to the information contained in the document SCP/18/4, such as:

**- page 27, bullet point 95 and 96:**

“95. 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” (~~50,70 €~~, if submitted through online services, or ~~101,40 €~~ when submitted in paper form, in both cases. Please see the Table of IP Fees, available at: [http://www.marcaspatentes.pt/files/collections/eng\\_US/28/29/30/Table%20of%20Industrial%20Property%20Fees%202016-2017.pdf](http://www.marcaspatentes.pt/files/collections/eng_US/28/29/30/Table%20of%20Industrial%20Property%20Fees%202016-2017.pdf).”

“96. 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 Lisbon Commercial Court, within two months that follow the publication of the decision in the Industrial Property Bulletin. The total number of oppositions filed from 2005 to 2014 is 29 42.”

**- Annex I, page 64**

Year	Number Percentage of oppositions
2005	4/360=1,11%
2006	6/417=1,44%
2007	2/422=0,47%
2008	1/633=0,16%
2009	1/923=0,11%
2010	8/911=0,88%
2011	7/939=0,75%
2012	4/1021=0,39%
2013	5/961=0,50%
2014	4/1031=0,39%

**- Annex II, page 71:**

Portugal wants to include "Third Party Observation and Protest" and "Administrative revocation and invalidation" in the table.

**Updated information with respect to the following webpages:**

(i) Exceptions and limitations to patent rights available at:

<http://www.wipo.int/scp/en/exceptions/>

INPI PT has already submitted the responses to the questionnaire on Exceptions and Limitations to Patent Rights. INPI PT informs that there has not been any change in the national applicable law relating to these matters and therefore it is not necessary to update the information already sent.

(ii) Laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors, available at:

[http://www.wipo.int/scp/en/confidentiality\\_advisors\\_clients/index.html](http://www.wipo.int/scp/en/confidentiality_advisors_clients/index.html)

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

(iii) International worksharing and collaborative activities for search and examination of patent applications, available at:

<http://www.wipo.int/patents/en/topics/worksharing>

INPI PT would like to update the information related with this topic, as follows:

"The Portuguese Institute of Industrial Property (INPI PT) and The Cape Verde Institute of Quality Management and Intellectual Property (IGQPI) signed in 2016 an agreement in which the INPI PT undertakes to collaborate, at the request of IGQPI, in the analysis of patents, utility models, supplementary protection certificate applications."

The other information contained in the website is updated.

