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Standing Committee on the Law of Patents
Brazil

Information on Substantive and Procedural Requirements Regarding Voluntary Division of Patent Applications by Applicants

Inputs for the preparation of documents to the 37th Session of the Standing Committee on the Law of Patents [1]

VOLUNTARY DIVISION PATENT APPLICATIONS IN BRAZILIAN LEGISLATION AND RULES

In Brazil, the division of patent applications is regulated by Articles 26, 27 and 28 of Brazilian Industrial Property Law No. 9,279, of May 14, 1996 (IP Law).

> *Brazilian IP Law*
>
> *Article 26 - A patent application may, until the end of examination, be divided,* ex officio *or on request of the applicant, into two or more applications, provided that the divisional application:*
>
> *I - makes specific reference to the original application; and*
>
> *II - does not exceed the matter disclosed in the original application.*

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

Sole Paragraph - A request for division not in accordance with the provisions of this article will be shelved.

Article 27 - Divisional applications will have the filing date of the original application and the benefit of the priority of the latter, if any.

Article 28 - Each divisional application will be subject to payment of the corresponding fees.

For the purposes of Article 26 of the IP Law, the first filed application is considered an “original application” and can only be divided in two or more applications until the end of the examination procedure (First Instance Procedure).

In September 2024, INPI republished two regulations that, among other issues, deal with the administrative processing of divisional applications in order to change the interpretation given to the term "end of the examination", as referred to in Article 26 of IP Law:

- INPI/DIRPA Ordinance No. 16, of 2024 - Guidelines for Examination of Patent Applications (Block I), in particular, item 3.133, as per transcription:

“3.133 For the purposes of article 26 of the IP Law, the first application filed is considered an "original application". The application may be divided upon request of the applicant until the end of the examination in the first instance. This time limit does not apply to the division of an application proposed by INPI (ex officio). Divisions of already divided applications will not be accepted.” [2]

[2] Previous text – Resolution No. 124, of 2013: “3.133 For the purposes of article 26 of the LPI, the first application filed is considered an “original application”, and may only be divided up until the end of the examination in the first instance. Divisions of applications that have already been divided will not be accepted.”

- INPI/DIRPA Ordinance No. 14, of August 29, 2024 - General procedural rules to explain and comply with the provisions of the IP Law, as regards to specifications concerning the form and content of patent applications and certificates of addition. In special, Articles 50 and 63 defines the term “end of examination”, as follows:

> *“Art. 50. The patent application may be divided only up to the date of the end of the examination of the original application in the first instance, which consists of the date of publication of the decision of granting, denying or definitive shelving.*
>
> *§ 1 - The first application filed is considered the “original application”.*
>
> *§ 2 - Untimely division requests as per the caput will be shelved.*
>
> *§ 3 - The request for division of an application that has already been divided will be shelved.*
>
> *§ 4 - The term of the caput does not apply to an* ex officio *division of a patent application.”*

> *“Art. 63. For the purposes of articles 26 and 31 of the IP Law, the date of publication in the RPI of the decision to grant, reject or definitively shelve will be considered as the end of the examination in the first instance.*
>
> *Sole paragraph - The term set out in the caput does not apply to the division of an* ex officio *patent application.”*

Briefly speaking, a divisional application may be filed voluntarily or in order to overcome an objection of lack of unity of invention raised during the substantive examination. A divisional application may be requested until the date of publication of the decision to grant, reject or definitively shelve the original application[3]. This deadline does not apply to divisional applications proposed by INPI during the substantive examination of the original application. Also, a division request for a divisional application is not allowed. A divisional application is considered an independent application

[3] The date of publication of the decision is the date of publication in the Industrial Property Bulletin (RPI).

from the original application, despite the fact that both have the same filing date or priority date (if any).

During substantive examination, the Patent Examiner will verify whether the subject matter contained in the divisional application exceeds or not the subject matter revealed in the original patent application (Item II of Article 26 of the IP Law). The divisional application cannot exceed the subject matter disclosed in the original application. Once this criterion is met, the substantive examination will proceed. Otherwise, the divisional patent application will be shelved.

Also, if the request for a divisional application is made after the date of the request for examination of the original application, the Patent Examiner shall verify if the divisional application complies with the provisions of Art. 32 of IP Law[4], related to voluntary amendments, as ruled by the "INPI Guidelines on the Applicability of the Provisions of Article 32 of IP Law in the Examination of Patent Applications" (INPI/DIRPA Resolution No. 93, of 2013), particularly Items 2.6, 2.7, and 3.3. The claimed subject matter in a divisional application cannot exceed the claimed subject matter in the original application.

Issues relating to patentability requirements and double protection of divisional applications are examined in the substantive examination procedure based on INPI Guidelines for Examination of Patent Applications, Blocks I[5] and II[6]. Special aspects related to the substantive examination of divisional applications can be found in the Block I of the Guidelines, Paragraphs 3.133 to 3.143.

[4] Article 32 of Brazilian IP Law – "To better clarify or define the patent application, the applicant may make changes until the request for examination, as long as they are limited to the matter initially disclosed in the application."
[5] INPI/DIRPA Ordinance No. 16, of September 2, 2024.
[6] INPI/DIRPA Resolution No. 169, of July 15, 2016.

DOUBLE PATENTING

In Brazil, the division of patent applications cannot imply double patenting of the claimed invention or utility model. Although the Brazilian IP Law does not have a specific article directed to the "double patenting" issue, double patenting rejections may be raised based on Article 6 of IP Law.

Article 6 of the IP Law establishes that to the author of an invention or utility model will be assured "the right to obtain a patent" that guarantees ownership of the claimed subject matter. In other words, to the inventor is granted one patent relating to his/her invention (and only one), and the granting of two patents for the same invention or utility model by the same inventor is not allowed.

> *Article 6 of IP Law*
>
> *"The author of an invention or of a utility model will be assured the right to obtain* ***a patent*** *that guarantees to him the property, under the terms established by this law".*

When filling for a divisional patent application, the applicant must remove the part of the claimed subject matter that appears in the original application to avoid double patenting. The simple replication of part of the subject matter claimed in the original application to compose a divisional application actually constitutes a "multiplication of the patent application" and not a division, in the sense of Article 26 of IP Law.

The question of whether the divisional application claims the same subject matter (partially or in full) contained in the original application is not verified until the examination procedure has started.

The examination of double protection in a divisional application is carried out by comparing its claims set with the claims of the original patent application and also with the claims of the other

divisional applications, if any. Once a double protection is recognized by the Examiner, the divisional application request is rejected as it does not meet the provisions of Article 6 of the IP Law.

In the event that a divisional application claims a more specific subject matter than that claimed on the original application, it will be rejected as it does not comply with the provisions of Article 6 of the IP Law (double protection), considering that the broader subject matter claimed in the original application already covers the specific subject matter claimed in the divisional application. On the other hand, an alternative implementation of the invention may be removed from the set of claims of the original application to be claimed in a divisional application, even if this alternative implementation shares the same inventive concept as the subject matter claimed in the original patent application.

If the divisional application contains only subject matter already examined and rejected in the substantive examination of the original patent application, it will be rejected for the same legal reasons presented for the original patent application[7].

CHALLENGES RELATED TO VOLUNTARY DIVISIONAL APPLICATIONS

In recent years, INPI has observed a progressive increase in the number of voluntary filings of divisional applications, mainly in strategic technological areas. Part of these divisional applications does not correspond to a division of the subject matter of the original patent application, in the strict sense of the term, but rather to a replication of the subject matter of the original application[8]. As a result, there is a growing of replicated patent applications, which need to be examined by the Patent Office, generating unnecessary rework and, consequently, an increase in the backlog of patent applications.

[7] INPI/DIRPA Ordinance No. 16, of September 2, 2024 – Item 3.142.
[8] INPI/DIRPA Ordinance No. 16, of September 2, 2024 – Item 3.138.

To monitor and study the profile of divisional applications in Brazil, INPI launched the Management Report on Divisional Applications[9]. As can be seen from the Report Data (Figure 1), over the years, six technological areas stand out in the number of divisional applications: Pharmaceuticals (1,953[10]), Biopharmaceuticals (1,594), Biotechnology (1,331), Electronics (1,278), Agrochemicals (1,092), and Telecommunications (1,033)[11].

The number of voluntary divisional applications began to increase progressively from 2018 onwards, reaching its peak in 2020. From this year ahead, a progressive decline in the number of divisional applications could be noted, totaling 1,185 divisional applications in 2024, a number still well above that of 2018 (707 divisional applications).

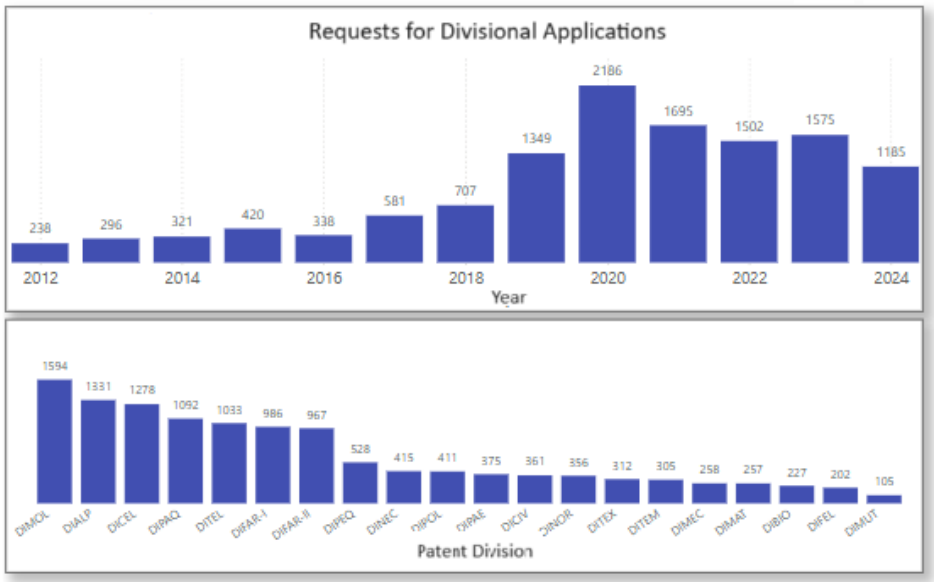

Figure 1 – Requests for Divisional Applications in Brazil between 2012 and 2024.

[9] https://www.gov.br/inpi/pt-br/servicos/patentes/relatorios-gerenciais. See “Relatório de pedidos divididos”.
[10] Sum of the number of divisional applications of Pharmacy Divisions I and II (DIFAR I, DIFAR II).
[11] Pharmaceuticals corresponds to DIFAR-I and DIFAR-II; Biopharmaceuticals corresponds to DIMOL; Biotechnology corresponds to DIALP; Electronics corresponds to DICEL; Agrochemicals corresponds to DIPAQ, and Telecommunications corresponds to DITEL.

INPI has been studying the possible causes that justify this new observed tendency. Let us take, as an example, the year 2020, in which 2,186 divisional applications were filed. By the end of 2024, 1,887 divisional applications had already been decided, of which 826 were rejected (43.8%). Preliminary results indicate that part of the 2020 divisional applications ended up being rejected, either due to double protection or withdrawal.

The filing of a divisional patent application that claims the same subject matter (in part or totally) could serve for different objectives or strategies, such as (i) to take advantage of discussing controversial matter during its examination, while placing the original application in condition to be allowed[12]; (ii) the exclusive licensing of the same invention to different licensees; (iii) an attempt by the Applicant to have the patent application examined by two patent examiners and eventually obtain the grant of a patent; (iv) to irregularly compose a larger patent portfolio that could benefit the company in a patent pool, so that the duplication of patents could negatively interfere with the fair participation of such royalties; (v) the possibility of multiple suits against an accused infringer by different assignees of patents claiming the same subject matter; (vi) the need to litigate against more than one patent in the case of erroneously granted subject matter; (vii) in the past, to prolong the examination of the subject matter in a divisional application with a view to obtaining an extension of the patent's term in accordance with the sole paragraph of Article 40 of the IP Law (revoked by Law No. 14,195, of August 27, 2021)[13].

No less important is the fact that the indiscriminate filing of divisional patent applications can negatively interfere with free enterprise and competition due to the legal uncertainty generated by the existence of pending divisional applications[14] and, consequently, lead to the exclusion of

[12] Afonso, Renata Campello. In “Divisional patent applications in Brazil”, accessible via Internet link (03/29/2025): https://llip.com/Content/Files/Artigos/Divisional%20Patent%20Applications%20in%20Brazil.pdf
[13] Abrantes, Antonio Carlos Souza de. In “Fundamentos do exame de patente: novidade, atividade inventiva e aplicação industrial”, Lumis Juris Editora, Rio de Janeiro, Brasil, 424 p. (2017). See pages 98 and 99, Chapter “Double Patenting”.
[14] Article 44 of Brazilian IP Law - A patentee is guaranteed the right to obtain compensation for the unauthorised exploitation of the subject matter of the patent, including exploitation that occurred between the date of publication of the application and that of grant of the patent.

competitors from the market. In the pharmaceutical area, such practices may prevent and delay the entry of generics into the market, hindering the population's access to healthcare.

Recently, the increase in the number of voluntary requests for divisional applications by patent applicants and its effects on the patent system and on competition aspects have attracted the attention of Brazilian competition authorities and judicial bodies, as potential abuses of dominant position. Unfortunately, this does not seem to be a problem exclusive faced by the Brazilian National Institute of Industrial Property (INPI), but common to other patent offices.

In order to mitigate these problems, INPI has been improving its administrative procedures relating to divisional applications with the intention to provide more transparency and increase efficiency. In mid-December 2022, the Institute started to notify in the INPI Official Bulletin (RPI[15]) the requests for divisional applications as part of the administrative process of the original patent application (Order 15.50). Later, in October 2023, the full content of the divisional applications began to be published for the sake of transparency (Order 3.1). Today, every person or enterprise can monitor the requests and status of divisional applications through the BI Platform available for consultation on the Internet Portal[7].

Since 2024, the request for divisional applications must include a marked copy specifically indicating the changes in the set of claims of the divisional application in relation to the last set of claims presented in the original application. Also, whenever the scope claimed in the original and the

§ 1 - If the infringer obtains, by any means, knowledge of the contents of a filed application, prior to publication, the period of undue exploitation, for the effect of compensation, will be counted from the date of commencement of the exploitation.
§ 2 - When the subject matter of a patent application relates to biological material, deposited under the terms of the sole paragraph of article 24, the right to compensation will only be conferred when the biological material has been made available to the public.
§ 3 - The right to obtain compensation for unauthorised exploitation, including with respect to the period prior to grant of the patent, is limited to the contents of the subject matter of the patent, under the terms of article 41.

[15] RPI means “Revista da Propriedade Industrial”, the INPI Official Bulletin, generally issued every Tuesday.

divisional application overlaps, the set of claims of the original application must be correspondingly amended to exclude the subject matter claimed in the divisional application[16].

Whenever possible, the substantive examination of the divisional application is carried out by the same Patent Examiner responsible for examining the original application. In addition, every effort is made to have the divisional application decided at the same time (or very close to it) of the original patent application[17].

[16] INPI Ordinance No. 14, of 2024 – "Art. 54. Whenever the scope claimed in the original and divisional applications overlaps, the claims of the original application must be correspondingly amended to exclude the subject matter claimed in the divisional application."
[17] INPI Ordinance No. 14, of 2024 – "Art. 56. The original application and its divisionals must be examined simultaneously, whenever possible. Sole paragraph - The decision on the divisional application should preferably occur after the decision on the original application."