

New guidelines for examining patent applications that involve computer-implemented inventions



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Intellectual Property, Brazil

🔗 Scope of new guidelines

🔗 Comment

On 29 December 2020 the Brazilian Patent and Trademark Office (BPTO) published the Guidelines for Examining Patent Applications Involving Computer-Implemented Inventions in *Official Gazette* 2608. These guidelines, which were under public consultation in August 2020, replace Resolution 158/2016. The new guidelines were long overdue, considering that technology and intelligent systems (eg, the Internet of Things (IoT) and AI) are becoming increasingly integrated into everyday life.

Scope of new guidelines

The main difference between the new guidelines and Resolution 158/2016 is that during the analysis of a computer-implemented process, the fact that it is executed in an IoT environment is now irrelevant. Therefore, patent applications for inventions implemented in this environment will be examined like any other computer-implemented invention.

The new guidelines also establish that AI techniques (eg, machine learning and deep learning tools) may be considered inventions when they are applied to resolve technical problems. However, given the increasing importance of this topic, further guidelines are required regarding how these inventions relate to the current IP system (eg, the ownership of inventions made by machines, how inventiveness will be assessed and disclosure sufficiency requirements).

The BPTO's rules regarding the drafting of claims for computer-implemented inventions are the same as those found in Resolution 158/2016, as is the need to define claims in relation to the methods and processes that are necessary to carry out the inventions. When product claims must be defined in terms of 'means plus functions', such features must be supported by the specification. However, when they are not supported by the specification and the means for implementing a functionality are specific, the claims must specify those means. The BPTO states as follows:

the expression 'means for storing data' is not accepted when the Specification defines that for the proposed invention to achieve the desired results there is a need to use a 'DRAM memory' and there is no support in the Specification for the invention to function adequately with any type of memory.

Further, terms such as 'computer programme', 'software' or 'apps' should be avoided.

Comment

In recent years, the BPTO has taken actions to improve IP protection policies in Brazil. In addition to the new guidelines, actions taken include:

- the plan to combat the patent backlog, which is in its final phase of implementation; and

- Brazil's accession to the Madrid Protocol.

These changes are expected to make Brazil an important destination for companies that seek consumer markets with mature IP protection policies. This would generate a favourable environment for company growth and the maturation of Brazil's competitive environment, which would in turn benefit Brazilians.

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