Inputs from Member States and Regional Patent Offices to the Thirty-Eighth Session of the Standing Committee on the Law of Patents

Respondent Information

First Name:

[redacted]

Last Name:

[redacted]

Country:

Portugal

IP Office

INPI

Job title

patent examiner

Email address:

[redacted]

Email address confirmation:

[redacted]

Disclaimer:

The information provided in response to this questionnaire is understood to be submitted on behalf of the Member State or regional organization concerned, through its competent authority and in accordance with its applicable official internal procedures.
It is assumed that the person completing and submitting the questionnaire is duly authorized to do so and that the information reflects the official position or practice of the Member State or organization, to the extent possible.

I confirm that I have read and understood the statement above and that I agree with its contents.

A. Prior Art

1. How is prior art defined under the applicable national or regional law?

According article 55º (1) and (2) of the Industrial Property Code, the state of the art comprises everything that inside or outside of Portugal has been made available to the public before the date of the patent application (priority date, when applicable), via description, use or by any other means. It is also considered state of the art the content of the applications for patents and utility models requested prior to the date of the patent application, for enforcement in Portugal and not yet published, provided that they are published on the same date or at a date that is later than the patent application date.
According to this definition, there are no restrictions regarding the geographical origin, the language in which the relevant information was made public, or the manner in which it was made public. Furthermore, no age limit is stipulated for the documents or other sources of information.

2. Against which date is prior art assessed under the applicable law?

Application date, or when applicable, Priority date.

3. Which types of information may constitute prior art under the applicable law, and how is it determined whether such information is considered to form part of the prior art?

There are no restrictions on how the information was made public. So, all types of information may constitute prior art, namely, written and oral disclosures, disclosures by use, patent documents, online disclosures or other sources of information.
However, a given subject matter is only considered to have been effectively disclosed to the public, and therefore to be part of the state of the art, if the information provided is sufficient for an expert in the relevant technical field to be able to apply, at the relevant date, the technical teaching contained in the disclosure, also taking into account the general knowledge in that technical field at the same time.
Regarding a written description, i.e, a document, it should be considered to have been made publicly accessible if, at the relevant date, it is possible for members of the public to become aware of the document's contents and if there is no confidentiality agreement restricting the dissemination of that knowledge.
Regarding an oral disclosure, if is only available a document that reproduces an oral description (for example, a public lecture) or if only the oral description was publicly available prior to the patent application date, provided that the written document reproduced herein was made available to the public on the date of the request or on a later date, the examiners should assume that the document faithfully reproduces the conference, exhibition, or other prior event, and therefore consider it as part of the prior art. If the applicant presents solid reasons to contest this presumption, then the examiner should cease to consider the document as part of the prior art.
Online disclosures (such as online manuals, tutorials, videos) form part of the prior art and the information contained in that online disclosures is considered to be publicly available as of the date the information was publicly posted. The publication date is established in two steps: i) assess if a given date is correct and (ii) assess if the information in question is indeed made available to the public on that date.
When a relevant online disclosure does not explicitly indicate the publication date the examiners try to find information to establish or confirm the publication date from internet archiving service (such as "Wayback machine") or from information Computer-generated timestamp.
If no date can be obtained, the online disclosure cannot be used as prior art in examination. However, if the undated disclosure is highly relevant, it may be cited in the search report (for example as an "L" document, i.e. cited for other reasons), with an explanation.
There are also some cases where Academic Thesis and Dissertations are locked as confidential, in that cases the disclosure is not considered state of the art.
When an internet disclosure is cited the examiner saves the link of the webpage and indicates the date on which the webpage was retrieved.

4. Does the applicable law provide for any category of prior art that is taken into account for patentability purposes notwithstanding that it was not publicly available before the relevant filing or priority date (sometimes referred to as “secret prior art”)?

Yes

If yes, please indicate, where applicable, the types of information or documents concerned (for example, earlier-filed patent applications), the relevant date(s) for determining such prior art, as well as any limitations, exclusions, or special rules applicable to such prior art. : As we answered in the first question, article 55º(2) of Industrial Property Code establishes that "2- Also deemed to be included in the state of the art is the content of the applications for patents and utility models requested prior to the date of the patent application, for enforcement in Portugal and not yet published, provided that they are published on the same date or at a date that is later than the patent application date". Our manual for applying the Industrial Property Code clarifies that any international application, as originally filed, is considered to be requested to take effect in Portugal if it enters the national phase in Portugal and that any European patent application, as originally filed, is requested to produce effects in Portugal. The documents mentioned in paragraph 2 of article 55º of Industrial Property Code shall not be not taken into consideration when assessing the inventive activity. They can only be used for novelty destroying.

5. Please provide any additional information that may be relevant to the understanding or application of prior art under the applicable law, including where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Please upload any document that may be relevant to the understanding or application of prior art under the applicable law.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The legal provisions applicable to patents apply mutatis mutandis to utility models.

B. Novelty

1. How is the requirement of novelty defined under the applicable national or regional law?

Article 54º (1) of the Industrial Property Code establishes that "An invention shall be considered new where it is not included in the state of the art.".
In other words, one invention is not new if the state of the art (a disclosure) contains all the technical features claimed in the application.

2. For the purposes of assessing novelty under the applicable law, are there any novelty-specific considerations regarding the relevant date or the scope of information taken into account, beyond those addressed in the Prior Art section of this survey?

No.

3. Does the applicable law apply an absolute novelty requirement, or does it provide for any limitations or qualifications to novelty (for example, relative novelty or other restricted approaches), apart from any grace period mechanisms addressed separately in this survey?

Portuguese law applies an absolute novelty requirement, without any exception.
A document removes novelty from any claimed subject matter that is directly and unambiguously derivable from said document, including any implied features, to an expert in the field, insofar as it is expressly mentioned in the document.
In other words, the document must contais all the technical features claimed in the application to destroy novelty. Well-known technical equivalents are not considered subject matter that is directly and unambiguously derivable from that document.
When assessing novelty, combining separate items from the prior art or separate items contained in the same document is not permitted unless such combination has been specifically suggested; that is, a single document is sufficient to destroy novelty. However, if a document (the "primary" document) explicitly refers to another document that provides more detailed information about certain characteristics, the respective contribution is considered to be included in the document containing the reference, provided that the referenced document was publicly available at the date of publication of the document containing the reference. However, the relevant date for the purposes of assessing novelty is always that of the "primary" document.
When analyzing novelty, it should be taken into consideration that a generic disclosure does not usually remove the novelty from any specific example covered by said generic disclosure, but the opposite is true. That is, a specific disclosure does, in fact, remove the novelty from a generic claim that covers said specific disclosure.

4. Apart from the approach described in question 3, are there any specific rules or contextual factors that affect what is taken into account as prior art for the purposes of assessing novelty under the applicable law?

No.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The legal provisions applicable to patents regarding novelty apply mutatis mutandis to utility models.

C. Inventive Step

1. How is the criterion of inventive step or non-obviousness defined under the applicable national or regional law?

Article 54º (2) of the Industrial Property Code establishes that "An invention shall be considered as involving an inventive step if, having regard to the state of the art, is not obvious to a person skilled in the art".
The term "obvious" means that which does not go beyond the normal progress of technology, that is, what is simply and logically deduced from previous techniques, for example, something that does not involve the exercise of any skill or ability beyond what would be expected of a person skilled in the art.

2. For the purposes of assessing inventive step or non-obviousness under the applicable law, what is the relevant date and what prior art or information is taken into account?

In order to assess the inventive step the contents of non-published patent applications and non-published utility model applications, with earlier filing date than that of the patent application, with effect in Portugal, shall not be taken into consideration.

3. What is the standard applied under the applicable law to determine whether an invention involves an inventive step or is non-obvious, in particular as reflected in the concept of the "person skilled in the art", focusing on how the standard is understood or applied, rather than its formal legal definition?

In Portugal, we apply the problem-solution approach to determine if an invention involves an inventive step or not, which essentially consists of three steps: (i) determining the "closest prior art". The closest prior art generally corresponds to a similar use and requires the minimum of structural and functional modifications to arrive at the claimed invention; (ii) establishing the "objective technical problem" to be solved; and (iii) considering if the claimed invention, starting from the clostest prior art and the objective technical problem, would have been obvious to the person skilled in the art. In the last step, the question to be answered is if there is any teaching in the prior art, considered as a whole, that "would" (and not merely "could") have prompted the person skilled in the art, in the face of the objective technical problem, to modify or adapt the closest state of the art, taking into account said teaching, in such a way as to arrive at something that falls within the scope of the claims and thus achieving what the invention achieves.

4. Are there any specific rules, limitations, or contextual factors that apply to the assessment of inventive step or non-obviousness under the applicable law?

No

Please indicate, where relevant, whether such rules or factors include geographic or territorial considerations affecting the relevance of prior art (for example, distinctions between domestic and foreign disclosures, uses, or publications, or territorial conditions applicable to particular categories of prior art) or any other particular considerations relevant to the assessment.

***Responses should be limited to such contextual factors asthey relate to the assessment of inventive step or non-obviousness, without restating general rules on what constitutes prior art.*:**

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

In the case of utility models, the definition of inventive step is diferente from patents. According article 122º(2) of the Industrial Property Code, an invention protected by a utility model is considered to involve an inventive step when it fulfils one of the following requirements: a) If, according to a person skilled in the art, it does not evidently result from the state of the art. b) If it offers a practical or technical advantage in the manufacture and use of the product or process concerned.

D. Grace Period Mechanisms and Pre-Filing Disclosures

1. Does the applicable law provide for any mechanism under which certain disclosures made before the filing or priority date do not prejudice the patentability of an invention, in particular with respect to novelty and/or the legal effect on prior art?

Yes

If yes, please identify the relevant legal provisions (in primary and/or secondary legislation) and describe their operation.: The article 56º of the Industrial Property Code, regarding "Non-prejudicial disclosures", establishes that "1 – The following shall not negatively affect the novelty of the invention: a)Disclosures at official exhibitions or exhibitions that are officially recognised by the Convention on International Exhibitions if the request for the respective patent is submitted in Portugal within six month b)Disclosures resulting from evident abuse of the inventor or his or her successor in any form, or from any publication unduly made by the INPI, I. P. 2 – The provision of (a) of the previous paragraph shall only apply if the applicant proves within one month from the date of the patent application that the invention was in fact shown or disclosed in accordance with the terms stipulated in the aforementioned sub-paragraph, thereby submitting a certificate issued by the entity responsible for the exposition, indicating the date on which the invention was first shown or disclosed at that exposition, along with identification of the invention concerned. 3 – At the request of the applicant, the time period stipulated in the previous paragraph may be extended once for an equal period."

2. What is the duration of the mechanism referred to in question 1, during which the covered disclosures do not prejudice the patentability of the invention?

The duration of the mechanism regarding disclosures at official exhibitions is 6 month. For disclosures resulting from evident abuse there are no associated duration.

3. Where such a mechanism exists, which categories of disclosures are covered by it?

The mechanism includes disclosures at official exhibitions or exhibitions that are officially recognised by the Convention on International Exhibitions and also disclosures resulting from evident abuse of the inventor or his or her successor in any form, or from any publication unduly made by the INPI, I. P.

4. Are there any formalities or procedural requirements that must be fulfilled in order to rely on the mechanism identified in question 1?

Yes

Please describe any such requirements, where applicable, including, for example, the need to file statements, declarations or notices, to submit certificates or other supporting evidence, or to comply with any timing or notification requirements or any information relating to the burden of proof. **:** the applicant must to prove within one month from the date of the patent application (could be extended, only once, for an equal period at the request of the applicant), that the disclosure was effectively exhibited or disclosed in official exhibitions or exhibitions that are officially recognised by the Convention on International Exhibitions and must to submit a certificate issued by the entity responsible for the exposition, indicating the date on which the invention was first shown or disclosed at that exposition, along with identification of the invention concerned.

5. Does the applicable law provide for prior user rights or other protections for third parties who may be affected by an invention that has benefited from a graced pre-filing disclosure?

If yes, identify the relevant legal provisions (including any provisions in primary and/or secondary legislation), and describe the conditions under which such rights or protections arise (for example, good-faith use of the invention prior to the filing or priority date), as well as how such rights or protections operate. **:** Our law doesn´t provide prior user rights for third parties who may be affected by an invention, specifically, for graced pre-filing disclosure, but has a general provision in artigle 105 (1) of the Industrial Property Code that establishes "The rights conferred by the patent shall not be enforceable within national territory and before the application date, or before the priority date where it is claimed, in relation to anyone who in good faith has by his or her own means acquired the knowledge of the invention and used the invention or made actual and serious preparations in view of such use.".

6. Please provide any additional information that may be relevant, including, where applicable, any guidance (e.g. patent office manual/guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Please upload any document that may be relevant to grace period mechanisms and/or pre-filing disclosures.

7. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The legal provisions applicable to patents apply mutatis mutandis to utility models.

Submission of information concerning other aspects of national/regional patent law

E. Sufficiency of Disclosure

E._Sufficiency_of_Disclosure.pdf

F. Exclusions from Patentable Subject Matter

F._Exclusions_from_Patentable_Subject_Matter.pdf

G. Exceptions and Limitations to Patent rights

G._Exceptions_and_Limitations_to_Patent_rights.pdf

Final review before submission

Confirmation of submission

I am aware that by clicking "Submit" below, my responses will be sent to the SCP Secretariat.