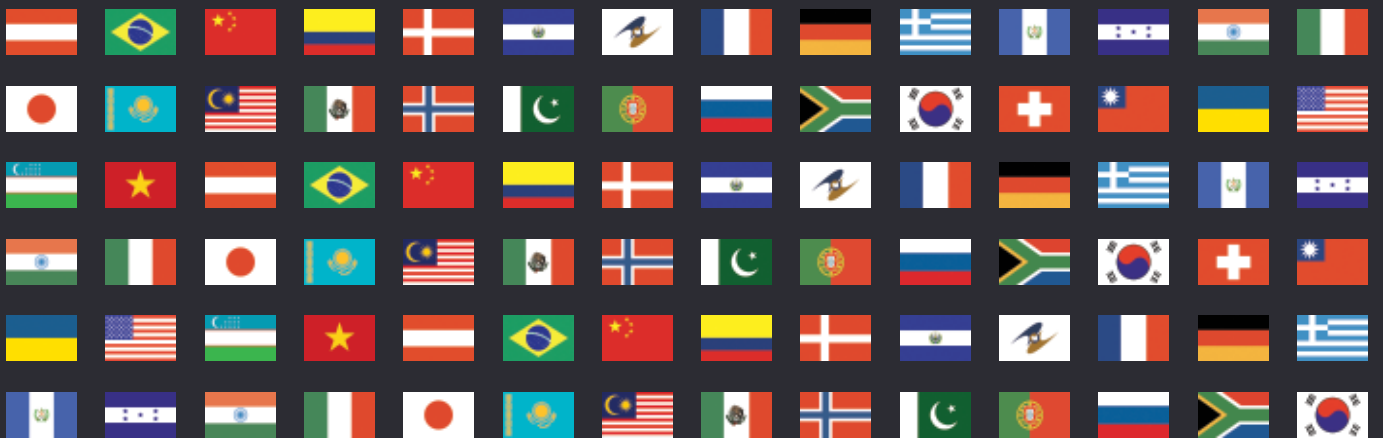


# Patents 2020

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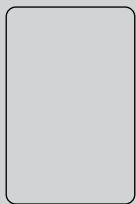
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# Patents

## 2020

**Contributing editor**

**Louis E Fogel**  
Jenner & Block

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Lexology Getting The Deal Through is delighted to publish the seventeenth edition of *Patents*, which is available in print and online at [www.lexology.com/gtdt](http://www.lexology.com/gtdt).

Lexology Getting The Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique Lexology Getting The Deal Through format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes new chapters on Eurasia, Honduras, Kazakhstan, Ukraine, United States and Uzbekistan.

Lexology Getting The Deal Through titles are published annually in print. Please ensure you are referring to the latest edition or to the online version at [www.lexology.com/gtdt](http://www.lexology.com/gtdt).

Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Lexology Getting The Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We also extend special thanks to the contributing editor, Louis E Fogel of Jenner & Block, for his continued assistance with this volume.



London  
May 2020

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# Portugal

Beatriz Lima and Sara Nazaré

VdA

## PATENT ENFORCEMENT PROCEEDINGS

### Lawsuits and courts

1 | What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

Patent litigation generally takes place before the Intellectual Property Court (IP Court), which is a specialised state court, with jurisdiction at a national level, and is competent to handle all actions concerning industrial property in all forms as provided in law, including both patent enforcement and invalidation proceedings.

Actions related to pharmaceutical patents and generic medicines may be subject to voluntary arbitration, according to Law 62/2011, of 12 December, recently amended by Decree-Law 110/2018. Upon the publication, by the relevant medicines agency, INFARMED, of a marketing authorisation application for a generic product, the patent holder has a 30-day period to submit the case to voluntary arbitration proceedings, with the agreement of both parties, or to file a legal action before the IP Court.

Patent infringement is considered a criminal offence, so criminal proceedings are also available and are conducted before the criminal courts, although this route is not usual.

### Trial format and timing

2 | What is the format of a patent infringement trial?

Disputes are decided by a single judge in the first instance, who conducts the entire trial. The IP Court is currently composed of three judges.

The parties or their representatives, if they wish to, may be present as well.

Technical advisors to assist each of the parties during the trial may be appointed: they assist the lawyers and have the same powers granted to the lawyers during the hearing (notably, they can pose questions to the witnesses).

It is also common for the judge to be assisted by technical advisors during the trial: they are appointed by the court, upon the recommendation of the Portuguese public institution agreed between the parties to that effect, based on a discussion between the parties on the characteristics that he or she should have in order to assist the court in technical matters.

The following acts are conducted during the trial phase:

- the parties' deposition (if it was requested by any of the parties);
- clarifications of the experts about the written report provided (if an expert review was conducted and clarifications about the final report were requested by the parties or ordered by the judge); and
- the questioning of witnesses and expert witnesses, which is generally conducted in person at the hearing or by means of

teleconference, by the parties and generally also the judge and the technical advisor assisting the judge, with cross-examination permitted but limited to the clarification of aspects that the witness has already responded to.

Documents, affidavits, legal opinions and expert opinions can also be submitted in first instance as evidence and be discussed during the trial. Exceptionally, documents conveyed by the witnesses during the trial may be attached to the proceedings.

At the end, lawyers are invited to present orally their final pleadings. Taking into consideration the evidence that was produced in the proceedings, lawyers of both parties convey their conclusions, factual and legal. Each lawyer may reply to the opposing side's submissions only once. It is very common for the parties to jointly request and the judge to accept the submission of the final pleadings in writing in complex patent cases.

A trial typically lasts between two days and two weeks, depending on the court's agenda and on the number of witnesses appointed by the parties and heard at the trial. If any of the witnesses are foreign and require an interpreter, this may delay the trial.

### Proof requirements

3 | What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

For establishing infringement, the burden of proof lies with the claimant patent holder. There is a reversal of the burden of proof for process claims and process patents of a new product in patent enforcement proceedings (both in the main proceedings and in proceedings for preliminary injunctions).

For the invalidity and unenforceability of a patent, the burden of proof lies with the party that alleges the facts that underlie the invalidity and unenforceability.

In short, the civil rule is that whoever seeks to enforce a right must provide evidence proving the facts that establish those rights; and whoever invokes a fact aiming at preventing, modifying or extinguishing a right must prove that fact. The civil law provides, however, for some general regimes on the reversal of the burden of proof.

### Standing to sue

4 | Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

Patent holders have legal standing to sue. Licensees or sub-licensees also have standing to enforce a patent, alone or together with the patentee, since they enjoy all the powers of the patent holder except as otherwise provided in the licence or sub-licence agreement, which must be registered with the national patent office.

A potential infringer may bring a declaratory non-infringement action, which could give him or her the advantage in obstructing any infringement action from the patentee, as it could be considered by the court as *lis pendens* (assuming that the grounds in both cases would be the same), before or after a patent infringement action has already been brought against him or her.

### Inducement, and contributory and multiple party infringement

5 | To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

According to the Industrial Property Code (IPC), the patent holder has the right to prevent any parties that supply or offer to supply a person who is not entitled to exploit the patented invention with any of the means, relating to an essential element of the invention, for putting the invention into effect, when he or she knows or should know that those means are suitable for putting the invention into effect and aim at putting the invention into effect (subject to the same exception of article 26(2) of the Agreement on a Unified Patent Court for means that are 'staple commercial products').

Apart from this specific provision included in the IPC, the general civil and criminal law applies on contributing or facilitating the infringement, as well as the regime applicable to more than one defendant having taken part on the infringement.

### Joinder of multiple defendants

6 | Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing all of the same patents?

Yes, multiple parties can be joined as defendants in the same lawsuit under different civil mechanisms (which have different requirements), depending on the exact facts that support the infringement and on the claims being made.

### Infringement by foreign activities

7 | To what extent can activities that take place outside the jurisdiction support a charge of patent infringement?

According to the IPC, a patent confers its owner with the right to prevent third parties, without the consent of the patentee, from exploiting the protected invention, notably manufacturing, offering, storing, putting on the market or using an infringing product, or importing or possessing it, for any of the mentioned purposes, in the Portuguese territory, while the patent rights are in force.

Any activities that take place outside Portugal may support a charge of patent infringement in Portugal if any of the above-mentioned acts, which would constitute an infringement of the patent, take place in Portugal.

### Infringement by equivalents

8 | To what extent can 'equivalents' of the claimed subject matter be shown to infringe?

There is no provision of Portuguese law that provides for 'equivalents' for determining the extent of protection by a patent. However, that doctrine is regularly invoked in patent litigation cases and is also regularly considered and applied by the courts and arbitral tribunals, although not in a harmonised way.

### Discovery of evidence

9 | What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

There is no discovery phase in judicial proceedings in Portugal. However, the IPC contemplates measures and procedures that correspond to articles 6 and 7 of the EU Enforcement Directive.

There is no significant case law in Portugal that could give an indication about the level of the evidence of the infringement or prospective infringement that would be necessary to succeed on an application for those orders.

### Litigation timetable

10 | What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

Typically, main actions on validity and infringement (combined or not with damages) are litigated at the same time (even if they are separately filed, the IP Court will in principle either attach both cases or stay the infringement case on the basis that the revocation case is prejudicial to the former).

A patent lawsuit in the IP Court, with minor procedural issues, usually takes one-and-a-half to three years to obtain a first-instance decision, but the duration will always depend on the complexity and the number of the matters involved. Typically, proceedings take longer if, for example, the case involves foreign companies, the parties request for a technical expertise review to be carried out and new documents (technical or otherwise) are submitted by the parties during the course of the proceedings.

A preliminary injunction may take eight months to a year-and-a-half to be decided in the first instance.

In the appellate courts, a decision can be expected within one to two years.

Arbitral main actions typically take one to two years from the filing of the statement of case to the decision at first instance (but see above regarding factors that may cause delay). Objections to the jurisdiction of an arbitral tribunal to decide on patent validity was commonly raised by the defendants in patent proceedings brought under Law 62/2011 before an arbitral tribunal. The matter is still under discussion. For this reason, since separate challenges can be brought on the matter, the timeline may vary. Some arbitral panels have decided to stay the arbitral infringement case pending a revocation action before the IP Court against the asserted patent.

### Litigation costs

11 | What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal? Are contingency fees permitted?

Several aspects shall be considered in what concerns predictable costs:

- The value of the proceedings: typically set at €30,000.01 in cases where patent rights (as immaterial rights) are at stake. In such a case, each party will have to pay €1,224 (in different phases of the proceedings and the judicial fee of the appeal is of €306). However, the court may set a different value for the case, considering different aspects, for example the amount of pecuniary interest of the claimant and the complexity of the case, which may lead to a substantial increase of the costs. It is, therefore, hard to predict which will be the costs of the patent lawsuit.
- The amount that each party shall pay at the end of the proceedings: according to Portuguese civil procedural law, at end of the proceedings, the court will fix the responsibility of the parties for

the costs to the extent to which the action was unsuccessful, being the due amount paid by the losing party directly to the court.

- Other administrative costs: translators, advisors to the court and experts.

Furthermore, the winning party may ask the losing party to proceed with the payment of all the court fees paid by the winning party, plus 50 per cent of all judicial fees paid by all the parties as a fictional compensation for the attorney's fees incurred, as well as the costs incurred with translations, witnesses' travel expenses, the court's advisor, experts (when this is ordered by the court) and certificate fees (when ordered by the court).

### Court appeals

- 12 | What avenues of appeal are available following an adverse decision in a patent infringement lawsuit? Is new evidence allowed at the appellate stage?

All court decisions are in principle subject to appeal in one or two degrees. The appeal against a decision of the IP Court (first instance) is to be filed to the Lisbon Court of Appeal (LCA), both on matters of fact and of law. The decision of the LCA may be subject to an appeal to the Supreme Court of Justice (SCJ), depending on the circumstances of the case. The SCJ only decides matters of law. In the LCA and SCJ, the appeal is assessed by a panel of three judges and, in principle, the appeal does not have a suspensive effect.

Should any issue of unconstitutionality arise, appeals may be filed to the Constitutional Court subject to some formal requirements being met.

Most interim decisions are appealable along with the final decision, although some interim decisions may be subject to an autonomous immediate appeal in certain cases expressly provided in the law.

Preliminary injunctions follow the same regime, although it is generally not possible to appeal to the SCJ except in very special and rare cases.

In pharmaceutical cases brought under Law 62/2011, the discussion is still open on whether the appeal to the SCJ is admissible in accordance with the general Civil Procedure Code rules or only on the very special circumstances that govern also the appeal for preliminary injunctions.

Generally, new evidence at the appellate stage is not allowed.

### Competition considerations

- 13 | To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition, or a business-related tort?

All these matters could be argued by a defendant in a patent lawsuit and these will be decided by the IP Court.

### Alternative dispute resolution

- 14 | To what extent are alternative dispute resolution techniques available to resolve patent disputes?

The parties are entitled to seek alternative means of dispute resolution such as mediation or voluntary arbitration in patent cases. However, this route is almost never used for patent disputes. However, the parties often manage to reach an alternative solution to litigation by executing an agreement either before or during pending proceedings.

## SCOPE AND OWNERSHIP OF PATENTS

### Types of protectable inventions

- 15 | Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

The Portuguese Industrial Property Code does not provide for substantively different exceptions to patentability from the international standards on patent law. Specifically, it is not possible to protect, as a patent right:

- computer programs or software as such with no technical contribution;
- schemes, rules or methods of doing business;
- methods for performing purely mental acts or playing games; and
- methods for the treatment of the human or animal body by surgery or therapy, as well as diagnostic methods.

### Patent ownership

- 16 | Who owns the patent on an invention made by a company employee, an independent contractor, multiple inventors or a joint venture? How is patent ownership officially recorded and transferred?

The rule is that the rights to a patent belong to the inventor or his or her successors in title.

However, if an invention was made during the performance of an employment contract in which inventive activity is provided for, the right to the patent belongs to the company. The same happens with research and development activities; the patent ownership belonging to the public entity.

If two or more persons, including joint ventures, have made an invention, any of them may apply for a patent on behalf of all.

Patent ownership is officially recorded at the Patent Office and transferred by a contract which must also be recorded at the Patent Office and shall be published in the Industrial Property Bulletin.

## DEFENCES

### Patent invalidity

- 17 | How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

In accordance with the Industrial Property Code (IPC), patents shall be totally or partially null:

- if its object does not meet the requirements of novelty, inventive step and industrial application;
- when any essential formalities for the grant have been disregarded;
- when public policy rules have been breached;
- when the protected subject matter is not patentable;
- the title and summary of the patent relates to a subject matter different from the invention; and
- the invention has not been described in a sufficient manner for it to be carried out by a skilled person.

In general, patents shall be totally or partially annulable if the holders are not entitled to them, namely:

- if the right does not belong to them; or
- if they were granted with disregard for the rights set forth in the procedural rules set out in the IPC.

Added matter is not listed as a specific ground for revocation, rather for rejection.

### Absolute novelty requirement

18 | Is there an 'absolute novelty' requirement for patentability, and if so, are there any exceptions?

Yes, there is an absolute novelty requirement for patentability.

The following shall not prevent the novelty of an invention:

- a disclosure in official or officially recognised exhibitions falling within the terms of the Convention of International Exhibitions if the application for the patent is filed in Portugal within six months; or
- a disclosure resulting from evident abuse of any kind in relation to the inventor or his or her successor in title or publications made unduly by the National Industrial Property Institute.

### Obviousness or inventiveness test

19 | What is the legal standard for determining whether a patent is 'obvious' or 'inventive' in view of the prior art?

The Portuguese courts and tribunals generally follow the European Patent Office's case law, notably using the 'problem-solution' approach for inventiveness.

### Patent unenforceability

20 | Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

Yes. The IPC provides for the exhaustion of rights and the unenforceability due to prior use.

### Prior user defence

21 | Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

It is, according to Article 105 of the IPC, which establishes that 'the rights conferred by a patent are not enforceable in the Portuguese territory before the application date or, if claimed, the priority date, against those who, in good faith, have learned of the invention by their own means and used it or made effective serious preparations with a view to use it'.

The defence covers all type of inventions and is not limited to commercial uses.

## REMEDIES

### Monetary remedies for infringement

22 | What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature? How are royalties calculated?

In determining the amount of compensation for losses and damages, the court shall consider the profits obtained by the infringer, the resulting damages and lost profits suffered by the injured party, the costs borne in the protection of the right in question, the investigation and termination of the harmful conduct and the importance of the revenue resulting from the infringer's unlawful conduct.

The court should also take the moral damages caused by the infringer's conduct into account.

If it is impossible to quantify the losses effectively suffered by the injured party, the court may, provided this is not opposed by the latter, define a fixed amount on the basis of equity (based, as a minimum value,

on the payment that the injured party would have received if the violator had been authorised to use the intellectual property rights in question, as well as the costs borne in the protection of the intellectual property right and the investigation and termination of the harmful conduct).

Damages start to accrue from the beginning of the infringement, assuming that a right was granted or that the patent applicant benefits from provisional protection if the patent application was published in the Industrial Property Bulletin or, before that, once the infringer was notified of such application and having received the 'necessary elements on the record of the case'.

No punitive damages can be claimed.

The case law on the calculation of royalties is not plentiful. But these are usually calculated based on the average amount of the royalties received by the claimant in the position of a licensor, in a licence contract, or on the average amount of royalties practised in the industrial or commercial sector at stake.

### Injunctions against infringement

23 | To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

With respect to preliminary injunctions, whenever an IP right is being infringed (actual infringement), or there is a justified threat that another party may cause serious and difficult-to-repair harm to an IP right (threat of infringement), the court may grant the appropriate injunctions to avoid an imminent future violation or order that the infringement ceases. The IP right holder must demonstrate that he or she actually holds an IP right (and it is common for the court to assess the validity of the right if the defendant raises the argument that it is not valid) which is being or will be infringed. If the injunction is applied for on the basis of threat of infringement, the IP right holder must also demonstrate the irreparable harm.

Main (final) injunctions are the most typical claims formulated by patent holders (namely, for the infringers to be ordered not to exploit the invention, for instance by practising any of the expressly prohibited conduct) and these can be claimed on the basis of actual infringement (reactive action) or threat of infringement (pre-emptive action).

The injunction will be effective against the infringer's suppliers or customers if these are also parties in the injunction proceedings and therefore specifically covered by the court's injunction decision.

### Banning importation of infringing products

24 | To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

One of the rights conferred by a patent is the right to prevent or cease the importation of infringing products aiming at practising any of the prohibited conduct, which has to be exercised in a patent lawsuit before the IP Court.

An alternative way to prevent or cease the importation of infringing products is an application for customs intervention, which tends to be more effective if a trademark is also asserted or if the patent relates to a product.

### Attorneys' fees

25 | Under what conditions can a successful litigant recover costs and attorneys' fees?

According to Portuguese law, the court shall, if the interested party so requests, fix a reasonable amount aimed at covering the duly



documented costs borne by the injured party in investigating and bringing to an end the violation of its rights.

However, there is (as yet) no relevant case law supporting the effective recover of attorneys' fees. This matter is governed by the general civil procedural rules, which determines a very limited recovery of attorney's fees, calculated according to a pre-determined basis, unless the amount calculated in accordance with such rules is lower (the sum of the total amount of judicial fees paid by all the parties, divided by two). The judicial fees, as well as the costs incurred in with translations, witnesses' displacement, the court's advisor, experts (when ordered by the court) and certificate fees (when ordered by the court) can also be recovered.

### Wilful infringement

**26** | Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate? Are opinions of counsel used as a defence to a charge of wilful infringement?

Patent infringement is a criminal offence and the criminal responsibility of the deliberate or wilful infringer can be addressed in criminal proceedings before a criminal court. The standard to assess wilful infringement is to determine whether the defendant considered the existence of an illicit act and wilfully pursued it or accepted it.

However, criminal complaints concerning patent infringement are quite rare.

Counsel's opinion cannot be effectively used as a defence to a charge of wilful infringement.

### Time limits for lawsuits

**27** | What is the time limit for seeking a remedy for patent infringement?

There is no time limit to file for injunctions. Although there is no urgency requirement, it is advisable to file for preliminary injunctions as soon as possible.

To claim damages, the general civil time limit of three years applies (as from when the IP right holder became aware that he or she was entitled to them). A longer time limit may apply under very specific circumstances and pursuant to requirements in the Civil Code, whenever the act also constitutes a crime.

### Patent marking

**28** | Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

A patent holder is not obliged to mark its patented products and, therefore, there are no legal consequences from not marking the patented products.

## LICENSING

### Voluntary licensing

**29** | Are there any restrictions on the contractual terms by which a patent owner may license a patent?

No, but formal conditions must be met; for example, licence contracts must be drawn up in writing and duly recorded at the Patent Office in order to be enforceable against third parties.

### Compulsory licences

**30** | Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

The IPC provides for three reasons for a patent to be compulsory licensed:

- The patent holder must exploit the invention, directly or under a licence, within four years as from the patent application or three years as from its grant and must ensure that the exploitation meets national needs. If the patent holder fails to exploit the patent within those time frames, a compulsory licence may be requested. The compulsory licence may, however, not be ordered if the patent holder has a justified reason (technical reasons, for instance, but not economic or financial complications) or a legal basis for not having exploited the invention.
- In the case of dependent patents, if they have different industrial purposes, the licence on the first patent will only be granted if the invention is essential to the exploitation of the second. If both patents have the same industrial purpose, licences can be granted for both and the two licences can co-exist.
- Public interest: if the commencement or increase of the exploitation of the invention or its more widespread exploitation, or the improvement of the conditions on which that exploitation is being carried out, is of the utmost importance for public health or national defence, or if the exploitation is lacking or is insufficient in terms of quality or quantity and that entails a serious obstacle to economic or technological national development, a compulsory licence can be granted by an order of a government entity that is materially competent.

All compulsory licences except those granted on the basis of public interest must be requested from the Patent Office. The licence applicant submits their arguments together with the application, which must demonstrate that he or she has made serious efforts to obtain a contractual licence from the patent holder with acceptable commercial conditions and failed to obtain one within a reasonable time. The patent holder is notified to respond within two months. The Patent Office then has two months to decide on the case. If the Patent Office decides in favour of the granting of the compulsory licence, it shall give both parties one month to appoint an expert who, together with the expert appointed by the Patent Office, shall agree, within two months, on the conditions of the compulsory licence and the compensation to be paid to the patent holder. All these decisions are appealable.

## PATENT OFFICE PROCEEDINGS

### Patenting timetable and costs

**31** | How long does it typically take, and how much does it typically cost, to obtain a patent?

As from the filing of the patent application (or priority, if applicable) and the grant of the patent, it can take around two to three years.

The costs – the Patent Office's fees – are between €100 and €400.

### Expedited patent prosecution

**32** | Are there any procedures to expedite patent prosecution?

Yes, it is possible to request for accelerated examination under the Patent Prosecution Highway Pilot Programme.

### Patent application contents

**33** | What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

A patent application must contain the following:

- the title of the invention;
- the claims as to what is considered new and what characterises the invention, and it must define the object of the protection requested, be clear, concise, correctly written and based on a description, and contain:
  - an introduction mentioning the subject of the invention and the technical characteristics required to define the elements claimed, but that, in combination, form part of the state of the art; and
  - a description preceded by the words 'characterised by' and describing the technical characteristics in connection with the characteristics indicated in the previous point, defining the extent of the protection requested.
- a description of the invention (providing a clear indication, with no provisos nor omissions, of everything that constitutes the invention and containing a detailed explanation of at least one embodiment of the invention, so that the skilled person may carry it out);
- drawings required for a perfect understanding of the description; and
- a summary of the invention, intended for publication in the Industrial Property Bulletin, which:
  - consists of a brief overview of the description, claims and drawings and preferably shall not contain more than 150 words; and
  - is exclusively for technical information purposes and shall not be taken into consideration for any other purpose, such as determining the extent of the protection requested.

The specific formal requirements for a patent application are defined in guidelines available at the Patent Office website dating from 2014 (which are being reviewed) and also in Order No. 6142/2019.

### Prior art disclosure obligations

**34** | Must an inventor disclose prior art to the patent office examiner?

No.

### Pursuit of additional claims

**35** | May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier filed application? If so, what are the applicable requirements or limitations?

Yes, it is possible to file for a divisional application in cases where the initial application lacks the requirement of the unity of the invention and as long as the divisional application only contains elements that do not extend beyond the content of the initial application.

### Patent office appeals

**36** | Is it possible to appeal an adverse decision by the patent office in a court of law?

Yes, the following decisions may be appealed (before the IP Court):

- those granting or refusing intellectual property rights; and
- those regarding transfers, licences, declarations of expiry or any other acts that affect, alter or extinguish intellectual property rights.



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### Oppositions or protests to patents

**37** | Does the patent office provide any mechanism for opposing the grant of a patent?

Yes. It is possible to file oppositions before the Patent Office within two months (extendable) after the patent application is published in the Industrial Property Bulletin.

Third-party observations are also admissible during the patent application procedure.

It is possible to apply for a modification of a decision of the Patent's Office. This is considered by a different, hierarchically superior, member of the Patent Office.

Finally, the Patent Office's decisions granting or refusing a patent application may be appealed before the Intellectual Property Court.

### Priority of invention

**38** | Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

No.

### Modification and re-examination of patents

**39** | Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

Patents can be limited, provided that such amendments do not affect the elements of the patent that are essential and characteristic thereof. An amendment application cannot be opposed but any third party who might be 'directly and effectively affected' by the Patent Office's decision may appeal the decision.

Patents may be limited (the amended claims shall not extend the protection of the patent as granted) either via the administrative route before Patent Office or the judicial route before the IP Court.

The Industrial Property Code (IPC) does not expressly provide for the requirements that need to be examined. The Patent Office will assess and decide on whether the amended claims reduce the scope of protection of the patent as granted, and whether the amended claims are clear, supported by the description and do not add matter beyond the application as filed. A decision by the Patent Office takes approximately

two to five months. If the limitation is granted, it publishes a notice of the alteration of the claims. The IPC does not provide for a deadline for third parties to oppose the limitation application but any third party who might be 'directly and effectively affected' by the decision may appeal the decision within two months of the respective publication (or the date of the respective certificate requested by the appellant, if made earlier). If the amendment is not granted, the Patent Office only communicates the decision to the applicant. The patentee may appeal this decision to the IP Court, within two months from the date of reception of the communication of the decision denying the limitation.

Although, the patent holder is entitled to limit the claims before the IP Court, this is uncommon in Portugal.

The jurisdiction to revoke a patent lies only with the IP Court.

### **Patent duration**

#### **40 | How is the duration of patent protection determined?**

The duration is 20 years from the date of application.

## **UPDATE AND TRENDS**

### **Key developments of the past year**

#### **41 | What are the most significant developing or emerging trends in the country's patent law?**

The following are emerging trends in Portugal: second medical use patents, supplemental protection certificates, damages and evidence production (particularly with regard to the protection of related trade secrets).

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