

PANORAMIC

PATENTS

Portugal



LEXOLOGY

Patents

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PATENT ENFORCEMENT PROCEEDINGS

Lawsuits and courts

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?

As a rule, patent rights enforcement proceedings take place before the Intellectual Property Court (IP Court) through actions aimed at preventing or putting an end to the infringement of those patent rights.

The IP Court is a specialised state court, with a single seat in Lisbon, currently composed of three judges, with jurisdiction at the national level. It has been operating in Portugal since 30 March 2012 and is competent to handle all actions concerning industrial property, in all forms provided by law, including both patent enforcement and invalidation proceedings (invalidity raised in separate proceedings or within the scope of a counterclaim in infringement proceedings).

In the field of pharmaceutical patents, special attention must be given to the patent enforcement system put in place by Law No. 62/2011 of 12 December 2011 (Law 62/2011).

Under this Law and system, from 2012 until January 2019 the enforcement of pharmaceutical patents in relation to generic medicines was mandatorily submitted to arbitration, regardless of whether they involved process, product or utilisation patents, or SPCs, and also including preliminary injunctions.

From 9 January 2019, the mandatory arbitration route was revoked (although there are still some pending cases). Patent owners seeking to enforce their industrial property rights against a generic medicines company must now initiate proceedings – voluntary arbitration proceedings, with the agreement of both parties, or pre-emptive civil action before the IP Court – within 30 days of the publication by the Portuguese Authority of Medicines and Health Products (INFARMED), on its official website, of the marketing authorisation application or of the date of the registration application, in the case of centralised marketing authorisation.

This unique pharmaceutical patent enforcement system has been playing a decisive role in the patent litigation landscape in Portugal, as it enables patent owners to act even before the actual infringement.

Because patent infringement is considered a criminal offence, punishable with imprisonment for up to three years or with a fine for up to a maximum of 360 days, the injured parties may also resort to criminal complaint and proceedings before the criminal courts. However, this route is not common in patent enforcement cases.

Law stated - 20 July 2024

Trial format and timing

What is the format of a patent infringement trial?

Civil enforcement proceedings before the IP Court, which is considered a first instance court, are ruled by a single judge, who conducts the entire trial.

The judge, the parties' representatives, and all those who have been summoned to appear before the Court must be present at the trial. This may include:

- the parties (even if they are not summoned to appear, they may attend if they wish and they may also be called to provide a party deposition for the purpose of confessing facts that are unfavourable to them, or to provide party statements, regarding facts in which they have personally participated or of which they have direct knowledge);
- the parties' technical advisers, who are experts previously appointed to assist each of the parties' lawyers, with the same powers as those granted to the lawyers during the hearing (notably, to question the witnesses);
- the Court's technical adviser, appointed by the Court for cases requiring specific technical skills and expertise, usually following the consultation of the relevant public institution agreed between the parties for that purpose;
- experts, if an expert review has been requested by the parties in their written pleadings; the parties may also request, or the judge may order, the experts to attend the final hearing to provide clarifications on their written report;
- witnesses and expert witnesses duly appointed by each party in their written pleadings; and
- interpreters, if there are any depositions (by witnesses or expert witnesses) or clarifications (by experts) in foreign languages.

The following acts are carried out during the trial phase:

- parties' examination: if the parties' deposition was requested by any of the parties;
- clarifications by the experts on their written report: if expert review was requested or ordered;
- witnesses and expert witnesses' examination: the witnesses appointed by the parties in their written pleadings are questioned at the final hearing, as a rule in person or, in the case of foreigners, by means of teleconference. Questions are posed by the lawyer of the party that has appointed the witness, or by the technical adviser assisting said lawyer, and also by the judge and the technical adviser assisting the judge. Cross-examination is allowed but is limited to clarification of the topics already addressed by the witness.

In addition, during the trial phase, all documentary evidence – including documents, affidavits, legal opinions and expert opinions, which should be submitted in the early stages – can be analysed and discussed during the witnesses or parties' examination, or both. In exceptional circumstances, witnesses may also refer to and provide documents enclosed to the proceedings.

All this evidence – documentary, witnesses and expert witnesses, and expert reports – is subject to the principle of free assessment of evidence by the judge.

The trial ends with the lawyers' final oral pleadings, in which they convey their conclusions on the facts and on the law. 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 typical patent infringement trial lasts between two days and two weeks (ideally, although not necessarily, consecutively), depending on the court's agenda, on the number of witnesses and experts to be heard at the trial, on the complexity of the matters at stake, and on the need for interpreters during the depositions.

Law stated - 20 July 2024

Proof requirements

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

The general civil rule is that the party seeking to enforce a right must provide evidence on the facts grounding its right; and the party invoking a fact with the aim of preventing, modifying or extinguishing a right must prove that fact. Accordingly, for establishing infringement, the burden of proof lies with the patent owner. There is, however, a reversal of the burden of proof in process claims referring to a new product.

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

Law stated - 20 July 2024

Standing to sue

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, or a licensee or sub-licensee (if this is contemplated in the respective licence or sub-licence agreement, duly registered with the Portuguese Industrial Property Office), have standing to enforce patent rights.

While declaratory civil proceedings are available to obtain a decision of non-infringement of patent rights, they are extremely scarce. However, potential infringers might resort to these proceedings in anticipation of a patent infringement action, thus obstructing any infringement action brought by the patentee on the grounds of *lis pendens*, if both cases have the same grounds.

Law stated - 20 July 2024

Inducement, and contributory and multiple party infringement

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 Portuguese Industrial Property Code (IPC), the patent holder has the right to prevent parties from supplying or offering to supply a person who is not entitled to exploit the patented invention by 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 are aimed at putting the invention into effect (subject to the same exception under article 26(2) of the Agreement on a Unified Patent Court for means that are 'staple commercial products').

In addition, general civil and criminal law may apply to contributing or facilitating the infringement, as well as the regime applicable to more than one defendant having taken part in the infringement.

Law stated - 20 July 2024

Joinder of multiple defendants

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?

Multiple parties can be joined as defendants in the same lawsuit. The applicable requirements will depend on the infringement acts alleged and on the claims made in the proceedings.

Law stated - 20 July 2024

Infringement by foreign activities

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

Patent owners (or their respective licensees or sub-licensees, if duly authorised) are entitled to prevent third parties, without the consent of the patentee, from exploiting a 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 taking place outside Portugal, notably, possessing, offering or exporting the infringing product for any of the mentioned purposes, in the Portuguese territory, may support a charge of patent infringement in Portugal.

Law stated - 20 July 2024

Infringement by equivalents

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

Neither article 98 of the IPC – establishing that the scope of protection conferred by a patent shall be determined by the contents of the claims and that the patent description and drawings shall serve for the interpretation of the claims – nor other provisions of Portuguese law foresee equivalents for determining the extent of protection of a patent. However, the doctrine of equivalents is regularly invoked in patent litigation cases and is also regularly considered and applied by the courts and arbitral tribunals.

Although the Protocol on the Interpretation of Article 69 European Patent Convention of 5 October 1973, as revised on 29 November 2000, has no equivalent under Portuguese law, considering that Portugal is a member of the European Patent Convention (EPC), it should be applied by the Portuguese courts and tribunals as a legal framework for the interpretation of patent claims and to determine their scope of protection, regardless of the patents being European or Portuguese, for reasons of equal treatment and legal certainty.

Law stated - 20 July 2024

Discovery of evidence

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

Albeit there being no discovery phase in judicial proceedings in Portugal, the IPC contemplates measures and procedures to ensure the enforcement of industrial property rights, including specific rules for obtaining relevant information, evidence of infringement and discovery, as a result of the transposition of the EU Enforcement Directive (namely articles 6 to 8).

Law stated - 20 July 2024

Litigation timetable

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

A typical main action takes around one and a half to three years to obtain a first instance decision, depending on the complexity of the matters involved, on whether the parties are foreign entities (with longer deadlines), and on the extent of evidence submitted (technical expertise review, documents and list of witnesses).

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

In the courts of appeal, a decision can be expected within one to two years in the context of a main action, and within three to nine months in the context of preliminary injunctions.

Law stated - 20 July 2024

Litigation costs

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

Regarding probable costs, the following should be considered:

- The value of the proceedings: in cases where patent rights (as immaterial rights) are at stake, it is common practice for the parties to set the value of the proceedings at €30,000.01 (as the reference value under law for cases dealing with immaterial rights). In such cases, each party will have to pay €1,224 (in different phases of the proceedings, along with the judicial fee of the appeal in the amount of €306). However, recently the IP Court, resorting to the legal provisions under which the value of the proceedings should correspond to the economic benefits of the claimant, has not been accepting the parties' agreement on the value of the proceedings and has instead been setting different values considering various aspects, such as the amount of the claimant's pecuniary interest and the complexity of the case, which may lead to a substantial increase in costs. It is therefore hard to predict the costs of a patent lawsuit.
- The amount that each party must pay at the end of the proceedings is established by the court in its final decision, the amount due being paid by the losing party directly to the court.
- Other administrative costs: translators, advisers to the court and experts.

Furthermore, the winning party may ask the losing party to pay the court fees paid by it, plus 50 per cent of all judicial fees paid by the parties as compensation for the attorney's fees incurred, as well as the costs incurred with translations, witnesses' travel expenses, the court's adviser, experts (when ordered by the court) and certificate fees (also when ordered by the court).

Law stated - 20 July 2024

Court appeals

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

In main actions, a first instance decision of the IP Court or of the Arbitral Tribunal can be appealed to the competent court of appeal (CA), both on matters of fact and of law.

In certain circumstances, the CA's decisions may be subject to an appeal to the Supreme Court of Justice (SCJ). The SCJ only decides on matters of law.

Subject to specific formal requirements and if there is any issue of unconstitutionality, it is possible to file appeals to the Constitutional Court.

Preliminary injunctions follow the same regime; although, as a rule, appeal to the SCJ is not allowed, and it is only possible in very special and rare cases.

In pharmaceutical arbitral cases brought under Law 62/2011, appeal to the SCJ is admissible only in very special circumstances that also govern the appeal for preliminary injunctions.

In the courts of appeal (CA and SCJ), the appeal is assessed by a panel of three judges and, in principle, the appeal does not have a suspensive effect.

As a rule, new evidence is not allowed at the appellate stage.

Law stated - 20 July 2024

Competition considerations

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?

The defendant may raise, in the context of the defence in an infringement action or in a separate action to be filed afterwards, the patent owner's liability for a competition violation, unfair competition or business-related tort.

Law stated - 20 July 2024

Alternative dispute resolution

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 (the latter being expressly provided for in Law 62/2011, for instance, in relation to pharmaceutical patent disputes when generic medicines are at stake). However, this route depends entirely on the parties' agreement and is not currently being used for patent disputes. The parties often manage to reach an alternative solution to litigation by executing an agreement either before or during pending proceedings.

Law stated - 20 July 2024

SCOPE AND OWNERSHIP OF PATENTS

Types of protectable inventions

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

Patents can be granted to any type of invention in any field of technology, whether it be a product or a process, as well as to new processes for obtaining products, substances or compounds that already exist. Under the IPC, it is not possible to protect, as a patent right:

- computer programs or software 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

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 general rule is that the inventor, or his or her successors in title, owns the patent on the invention.

If an invention is made by a company employee or an independent contractor and the inventive activity is provided for, respectively, in the employment contract or in the provision of services agreement, the right to the patent belongs to the company. The same applies to research and development activities, with the patent being owned by the public entity.

If the invention is made by multiple inventors or a joint venture, any of them may apply for a patent on behalf of all.

Patent ownership is officially recorded at the Portuguese Industrial Property Office (INPI), this recordal representing a legal condition for patent protection and the granting of exclusive rights regarding an invention.

Patent ownership transfer must be made in writing and must also be recorded at INPI and published in the Industrial Property Bulletin in order to be effective before third parties.

DEFENCES

Patent invalidity

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?

Patent invalidity cases are handled by the IP Court.

The Public Prosecutor's Office or any interested party are entitled to bring a suit to annul or declare the nullity of a patent against any holder of registered patent rights.

Total or partial nullity of a patent can be invoked at any time on the following grounds:

- if the patent's object does not meet the requirements of novelty, inventive step and industrial application;
- if any essential formalities for the granting of the patent have been disregarded;
- if public policy rules have been breached;
- if the protected subject matter is not patentable;
- if the title and summary of the patent relates to a subject matter different from the invention; and
-

if the invention has not been described in a sufficiently clear manner as to enable a skilled person to carry it out.

Following the enactment of the new IPC, total or partial annulment of a patent must now be filed within five years of the decision on the respective grant. In general, the request must be grounded on the owners lacking entitlement to the patent, namely:

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

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

Law stated - 20 July 2024

Absolute novelty requirement

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

There is an absolute novelty requirement for patentability in Portugal; however, the following shall not preclude the novelty of an invention:

- 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
- 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.

Law stated - 20 July 2024

Obviousness or inventiveness test

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

The European Patent Office's jurisprudence on the obviousness or inventiveness test is generally followed – notably, the 'problem–solution' approach and the consideration of the person skilled in the art.

Law stated - 20 July 2024

Patent unenforceability

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?

The IPC provides for the exhaustion of rights and unenforceability due to prior use in good faith.

Law stated - 20 July 2024

Prior user defence

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?

Yes, albeit it is not common, it is a defence for all types of inventions and not limited to commercial uses, according to which the patent owner cannot enforce the patent in the Portuguese territory against those who, before the patent application date or, if claimed, the priority date, have learned, in good faith, of the invention by their own means and have used it or made effective serious preparations with a view to using it.

Law stated - 20 July 2024

REMEDIES

Monetary remedies for infringement

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?

The court may order the infringer to pay a recurring penalty payment and to take corrective measures, such as those provided for in article 10 of the EU Enforcement Directive. Other remedies may include damages.

When 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 with protecting 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, and the moral damages caused.

If it is not possible to ascertain the amount of damages effectively suffered by the injured party, the court may, if not opposed by the injured party, establish a fixed amount based on the equity (based, as a minimum value, on the payment that the injured party would have received if the infringer had been authorised to use the intellectual property rights in question (ie, prospective royalties) and the expenses with 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, prior to that, when the infringer

was notified of such application and following its receipt of the 'necessary elements on the record of the case'.

No punitive damages can be claimed.

Case law is not abundant regarding the calculation of royalties. However, they are usually calculated based on the average amount of the royalties received by the claimant as licensor, under a licence agreement, or based on the average amount of royalties paid in the industrial or commercial sector at stake.

Law stated - 20 July 2024

Injunctions against infringement

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?

Preliminary injunctions can be obtained on the basis of threat of infringement or actual infringement. In the latter case, it suffices to prove the ownership right (the court will commonly assess the validity of the right if the defendant claims that it is not valid) and its infringement; however, if there is only a threat of infringement, irreparable harm must also be established (which may be difficult to prove).

The most common injunctions correspond to decisions preventing or putting an end to the infringement of an industrial property right, including seizure of the infringing products.

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

Law stated - 20 July 2024

Banning importation of infringing products

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?

In a patent infringement action before the IP Court, patent owners can exercise their right to prevent or cease the importation of infringing products, provided that they can prove that the importation is aimed at the manufacture, offer, storing, putting on the market or use of the infringing products in the Portuguese territory.

Customs intervention can also be applied for, it being more effective if the patent relates to a product.

Law stated - 20 July 2024

Attorneys' fees

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

Apart from compensation for damages, covering the duly evidenced costs borne with the litigation, and the limited recovery of the court fees paid, plus 50 per cent of all judicial fees paid by the winning party, there is as of yet no relevant case law supporting the effective recovery of attorneys' fees.

Law stated - 20 July 2024

Wilful infringement

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, yet criminal proceedings are not common in patent enforcement cases. The standard to assess wilful infringement is to determine whether the defendant perceived the existence of an illicit act and wilfully pursued or accepted it.

Opinions of counsel cannot be effectively used as a defence to a charge of wilful infringement.

Law stated - 20 July 2024

Time limits for lawsuits

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

Infringement actions are not subject to time limits, including preliminary injunctions. Although there is no urgency requirement, it is advisable to file for preliminary injunctions as soon as possible.

Damages claims are subject to the general civil time limit of three years as of when the intellectual property right holder becomes aware that he or she is entitled to compensation. A longer time limit may apply under very specific circumstances, whenever the act also constitutes a crime.

As regards invalidity actions, nullity actions (or claims) are not time limited, however annulment must be filed within five years of the decision of the respective grant.

Law stated - 20 July 2024

Patent marking

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?

There are no legal consequences for not marking patented products since this is not a legal requirement.

Law stated - 20 July 2024

LICENSING

Voluntary licensing

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

There are no restrictions, but licence agreements should be in writing and duly recorded at INPI.

Law stated - 20 July 2024

Compulsory licences

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

The IPC sets forth three reasons for the compulsory licensing of a patent:

- The patent holder must exploit the invention, directly or under a licence, within four years of the patent application or three years of its granting and must ensure that the exploitation meets national needs. If the patent holder fails to exploit the patent within the referred 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 for 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 this entails a serious obstacle to national economic or technological development, a compulsory licence can be granted by order of a competent government entity.

All compulsory licences, except those granted on the basis of public interest, must be requested from the Patent Office. The licence applicant must submit its arguments together with the application, demonstrating that he or she has made serious efforts to obtain a contractual licence from the patent holder under acceptable commercial conditions, but failed to obtain it within a reasonable time frame. The patent holder will be notified to respond within two months. The Patent Office then has two months to decide on the application.

If the Patent Office decides in favour of granting a compulsory licence, it shall give both parties one month to appoint an expert who, together with the expert appointed by the Patent Office, must 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.

Law stated - 20 July 2024

PATENT OFFICE PROCEEDINGS

Patenting timetable and costs

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

Patent prosecution, from filing to granting, can take around two to three years.

The associated costs – namely, the INPI's fees – are between €150 and €400.

Law stated - 20 July 2024

Expedited patent prosecution

Are there any procedures to expedite patent prosecution?

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

Law stated - 20 July 2024

Patent application contents

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 elements:

- the title of the invention; and
- the claims as to what is considered new and what characterises the invention, and the object of the protection requested must be defined in a clear, concise and correctly written manner based on a description, further containing:
 - an introduction mentioning the subject of the invention and the technical characteristics required to define the elements claimed, but which, combined, form part of the state of the art;
 - a description, preceded by the words 'characterised by', of the technical characteristics linked to 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 or omissions, of everything that constitutes the invention and containing a

detailed explanation of at least one embodiment of the invention enabling a skilled person to 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, consisting of a brief overview of the description, claims and drawings, and preferably not containing more than 150 words.

The specific formal requirements for a patent application are set forth in guidelines available at INPI's website, dating from 2020, and also in Order No. 6142/2019.

Law stated - 20 July 2024

Prior art disclosure obligations

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

No.

Law stated - 20 July 2024

Pursuit of additional claims

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?

Divisional applications are admissible in cases where the initial application fails to fulfil the requirement of the unity of the invention, and provided that it only contains elements that do not extend beyond the content.

Law stated - 20 July 2024

Patent office appeals

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

Yes, INPI's decisions granting or refusing intellectual property rights, and all other decisions regarding transfers, licences, expiration or any other matters affecting, altering or extinguishing intellectual property rights, are subject to judicial appeal to the IP Court.

Law stated - 20 July 2024

Oppositions or protests to patents

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

During the patent application procedure, and within two months (extendable) from the publication of the patent application in the Industrial Property Bulletin, opposition and third-party observations are possible.

After the grant of the patent, besides judicial appeal to the IP Court, it is possible to apply for a modification of the decision issued by INPI, before a hierarchically superior member of INPI.

Law stated - 20 July 2024

Priority of invention

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.

Law stated - 20 July 2024

Modification and re-examination of patents

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 the amendments do not affect the patent's essential and characteristic elements. 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 INPI, or the judicial route before the IP Court.

The IPC does not expressly provide for the requirements to be examined. INPI 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 initially filed. The IPC also does not establish a deadline for third parties to oppose the limitation application; however, any third party who might be 'directly and effectively affected' by the decision may appeal the decision within two months of its publication (or the date of the respective certificate requested by the appellant, if earlier). If the amendment is not granted, INPI only communicates this decision to the applicant. The patentee may appeal the decision to the IP Court, within two months from the date of receipt of notification of the decision rejecting the limitation.

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

Jurisdiction to revoke a patent lies only with the IP Court.

Law stated - 20 July 2024

Patent duration

How is the duration of patent protection determined?

Patent protection lasts for 20 years from the date of application.

Law stated - 20 July 2024

UPDATE AND TRENDS

Key developments of the past year

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

The most noteworthy emerging trends in Portugal include: second medical use patents, plausibility, supplementary protection certificates, damages and evidence production (particularly with respect to the protection of related trade secrets).

Law stated - 20 July 2024