

Confirmed: protection for medicines mailbox patents is 20 years from the filing of the application | Brazil

A mailbox patent is a patent application from abroad that was filed between 1 January 1995 and 14 May 1997 in Brazil whose object of protection consisted of a technology related to the chemical, pharmaceutical or food sector.

The former Brazilian Industrial Property Law 5772/1971 did not authorise the patent registration of medicines and agrochemicals. However, by adhering to the World Trade Organisation's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Brazil had to include transitional arrangements in its new Industrial Property Law (Law 9279/1996) in order to allow the registration of these products.

The general rule of the Industrial Property Law is that patents of invention are valid for 20 years from the date of filing. However, the same law provides a rule that the term must not be less than 10 years from the date of grant. Faced with this inaccuracy as to the applicable date, pharmaceutical companies usually base their arguments on the exception because it is more beneficial to them – sometimes patent application analysis can take more than 10 years.

Recently, when analysing a repetitive demands resolution incident presented by Trinity College, Dublin, the First Specialised Chamber of the Federal Court of Appeals of the Second Region (TRF 2) reached an understanding on the subject in the sense that the term of medicines mailbox patents' protection is 20 years from the filing date of the application before INPI.

The institution sought to convince the judges to change the understanding that had already been adopted by the court and which has now been confirmed.

The laboratories argued that the exclusivity of production and marketing of these products is for at least 10 years from the date that the patent is granted. However, the judges understood this differently. They reminded the laboratories that the Industrial Property Law provides the protection term to mailbox patents from the filing date before INPI.

From now on, this is the guideline that must be followed in all lawsuits that analyse the same subject in the Federal Justice in the states of Rio de Janeiro and Espírito Santo.

The understanding consolidated by TRF 2 accompanies the Superior Court of Justice, which judged a similar case last year and also recognised that the term of protection of mailbox patents is 20 years from the filing date, not 10 years from its grant.