

Amendments to patent legislation

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In consequence of the amendments to Act no. 62/2011 of 12 December and to the Industrial Property Code (IPC), the legal regime of patents has undergone some changes, of which we highlight the following:

— Act no. 62/2011, of 12 December

Arbitration for the resolution of industrial property disputes involving reference and generic medicines is no longer mandatory, parties in dispute being able to pursue one of two avenues. In the event of an agreement between the parties, and within 30 days of the publication of the marketing authorization application on the INFARMED website, the parties may opt for voluntary arbitration. Otherwise, the Claimant will have to bring an action before the Court of Intellectual Property in order to safeguard its rights.

Note, too, the possibility of the Respondent invoking the invalidity of the allegedly violated right in the arbitration proceedings. Invalidity of the right will only have effects between the parties to the arbitral proceedings.

The aforementioned amendments entered into force on 9 January 2019.

— Industrial Property Code

Below we highlight changes regarding process patents. According to Article 102(2)(b) and (c) of the IPC, the patentee may prevent third parties from using the process that is the subject matter of the patent without his consent and when the third party was or should have been aware that the use of the process is prohibited without the patentee's knowledge. Further, the patentee may prevent third parties from offering, storing, placing on the market, using, importing or possessing products obtained directly by the process that is the subject matter of the patent without his consent.

In addition, we should note the enshrinement of the indirect infringement of the patent: "The patent also confers on its holder the right to prevent third parties from, without his consent, offering or making available to any person who does not have the right to work the patented invention the means to execute it with regard to an essential element, if the third party was or should have been aware that such means are adequate and intended for such execution" (Article 102(3)).

Finally, Article 103 provides for new free uses, namely:

- The use of biological material for the purpose of cultivating or discovering and developing new plant varieties;
- The use by a farmer of the product of his harvest for the purposes of reproduction or multiplication on his holding, provided that the plant propagation material has been sold or otherwise marketed for agricultural purposes to the farmer by or with the consent of the patentee;
- The use by a farmer for agricultural purposes of protected animals, provided that farmed animals or other animal reproductive material have been sold or otherwise marketed to the farmer by or with the consent of the patentee;
- The access to and use of information obtained in accordance with software protection laws.

The aforementioned amendments shall take effect on 1 July 2019.