



Intellectual Property Registry

Ministry of the Economy

REPORT BY GUATEMALA **STANDING COMMITTEE ON THE LAW OF PATENTS (SCP)**

THROUGH: Sylvia Ruiz Hochstetter
Registrar
Intellectual Property Registry

FROM: Carlos Antonio Castañeda
Legal Adviser
Department of Patents and Industrial Designs

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SUBJECT: Information on exceptions and limitations to patents rights and the client-patent advisor privilege. Commitment made during the 24th session on the Standing Committee on the Law of Patents (SCP), from June 27 to 30, 2016.

Dear Madam,

Please find herewith for your consideration and approval Guatemala's report following the commitment made during the 24th session on the Standing Committee on the Law of Patents (SCP), from June 27 to 30, 2016, concerning the provision of information on exceptions and limitations to patent rights and the client-patent advisor privilege.

EXCEPTIONS AND LIMITATIONS TO PATENT RIGHTS

This part deals with the practical experience of the effectiveness of exceptions and limitations to patent rights and the attendant challenges, particularly in the light of development issues.

In Guatemala, this issue is closely linked to patent quality whenever patent protection is determined by claims. Guatemala is aware that exceptions and limitations should be discussed in greater depth by the SCP; there is a need to consider what is governed by national legislation in each country and to analyze the differences in legislation between developed and developing countries.

Guatemala's own national legislation governs compulsory licenses, for which it is developing the grant procedure, the conditions governing use, modification and cancellation and, most important, the conditions under which such licenses can be obtained and their period of validity.

CLIENT-PATENT ADVISOR PRIVILEGE; LAWS AND PRACTICES CONCERNING PROFESSIONAL SECRECY IN THE ATTORNEY-CLIENT RELATIONSHIP AND ITS RELEVANCE TO PATENT ADVISORS

In Guatemala, there has been no litigation of any kind in the courts specifically concerning court cases on professional secrecy in client-patent advisor relations and the challenges encountered, at least as far as the Intellectual Property Registry is aware.

Like most developing countries, Guatemala takes the view that this subject should have trans-border implications and that professional secrecy should be governed by national legislation in each country. Our national legislation already encompasses this principle. Once again, Guatemala affirms that this is a matter of professional ethics and obedience of the law, in particular patent law, which it has enshrined in the Code of Professional Ethics, which holds the maintenance of professional secrecy to be both an



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obligation and a duty incumbent on attorneys in respect of their clients. This duty survives even after the lawyer has finished providing his services and it is contingent on good faith. It is an inalienable right before the courts and other authorities. In our area of interest, it falls within the ambit of administrative law. The professional secrecy obligation includes all confidential information relating to the matter at hand, in particular patents. Within the Registry, it concerns patent documentation, which enjoys the right of confidentiality for a maximum of 18 months, with effect from the date of filing of the application or the date of the priority claimed, as the case may be.

The Code of Ethics stipulates that the attorney-client relationship must be personal, given that the attorney has direct responsibility and it is in essence his duty to serve his client efficiently; he must not assure his client of success and must only confine himself to providing him with a legal opinion on the case, faithfully and honorably. If the attorney has any interest in the matter, a relationship with the parties, or if any influence is brought to bear on him that is contrary to the interest of his client, he must immediately inform the client so that if the client persists in seeking his services, he does so advisedly. Once he accepts a case, the attorney may not abandon it except in cases of *force majeure* or a subsequent justifiable occurrence affecting his honour, dignity or conscience; it would require the client's breach of his moral or material obligations to the attorney, or be a situation that requires the exclusive intervention of specialized professionals. Nonetheless, if he abandons his representation, the client should not be left defenseless or in the middle of the proceedings.

Likewise, Guatemala is of the opinion that the SCP is the international forum that should consider this issue, specifically with regard to patents – regardless of whether national legislation takes it into account – and invites other Member States to explore and discuss this issue in the upcoming deliberations of the SCP.

CERTAIN ASPECTS OF NATIONAL LEGISLATION AND OPPOSITION SYSTEMS AND OTHER ADMINISTRATIVE MECHANISMS FOR CANCELLATION OR INVALIDATION

In Guatemala, opposition as such during the processing of patent applications is not regulated by the Industrial Property Law, Decree No. 57-2000. However, for patents, “observation” is regulated. Observation is different from “opposition” in that the submission of observations does not have suspensive effect on the processing of the application and any person who submits observations cannot rely on them to become a party in the proceedings. Also, once the patent is granted, there can be no impediment to seeking its invalidation. Guatemala fully shares the viewpoint of GRULAC that patents should be granted having regard to the highest quality parameters and that patents granted by developing countries do not adversely affect patents granted by developed countries. Similarly, a patent granted within quality parameters is necessary for good access to health, which is why Guatemala continues to support the CADOPAT program initiated by Mexico, through which it is important to establish search mechanisms and quality in the substantive examination of patent applications.

Guatemala also supports the use of shared work or examination mechanisms, the free use of databases and the exchange of patent information among industrial property offices so as to improve the quality of examinations regardless of the level of development of the countries in which patent applications are filed. Guatemala considers it imperative for discussions within the SCP to establish minimum parameters to be taken into account in substantive examinations and to create time flexibilities in preparing these parameters. We likewise support the exchange of information concerning search strategies, actual searches, mechanisms for cooperation among offices and the subsequent preparation



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of the substantive technical opinion for patent applications.

COOPERATION IN SEARCHES AND EXAMINATIONS FOR PATENT APPLICATIONS AND THE REUSE OF INTERNATIONAL SEARCH AND EXAMINATION RESULTS

In Guatemala, when substantive technical searches and examinations are conducted, sometimes use is made of reference search and examination reports prepared by other patent offices and their grant and refusal decisions. This is called accreditation of foreign decisions in administrative matters.

One example is the PCT mechanism which makes it possible to obtain immediate results in patent searches and examinations through international search reports and preliminary examination reports. When international applications filed through the PCT System enter the national phase, it is possible to access additional search and examination information through the PATENTSCOPE website. WIPOCASE, for its part, makes it possible to obtain information from the Department of Patents regarding the exchange of search and examination information and documentation related to patent applications. Although we do not have the Patent Prosecution Highway (PPH), we will do our utmost to incorporate the procedure for this sort of accelerated processing.

Thank you for your attention.

Yours faithfully,

Sylvia Rutz Hochstetter
Registrar
Patents
Intellectual Property Registry
Ministry of the Economy

Carlos Antonio Castañeda
Legal Adviser, Department of
Intellectual Property Registry
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