

## Comments from Peru

Letter no. 409-2013/PRE-INDECOPI

Lima, July 1, 2013

From: Hebert Tassano Velaochaga, President, Executive Board,  
National Institute for the Defense of Competition and Intellectual Property  
(INDECOPI)

To: Ana Cecilia Gervasi, Head, International Economic Negotiations Directorate,  
Ministry of External Relations, Lima

Ref: fax (DAE-DNE) 066

Dear Madam,

With regard to the communication referred to above, requesting information for the next meeting of the Standing Committee on the Law of Patents (SCP), please find attached report No. 0024-2013/DIN from the Inventions and New Technologies Directorate at INDECOPI.

Yours sincerely

Hebert Tassano Velaochaga

Report No. 0024-2013/DIN

To: Hebert Tassano Velaochaga  
President, Executive Board, INDECOPI

From: Bruno Mérchor Valderrama  
Director, Inventions and New Technologies

Subject: Request for information for the next meeting of the Standing Committee on the Law of Patents (SCP). Fax (DAE-DNE) No. 66

Ref: Transmission sheet No. 045/PRE

By means of the present report, the Inventions and New Technologies Directorate (DIN) issues an opinion on fax (DAE-DNE) No. 66 sent by Minister Ana Cecilia Gervasi, Head, International Economic Negotiations Directorate, Ministry of External Relations, via transmission sheet No. 045.

## 1. Background

By fax (DAE-DNE) No. 66, the Minister responsible for the International Economic Negotiations Directorate at the Ministry of External Relations requests the following information for the next meeting of the Standing Committee on the Law of Patents (SCP):

- (i) Exceptions and limitations to patent rights
- (ii) Quality of patents
- (iii) Confidentiality of communications between clients and their patent advisors
- (iv) Transfer of technology

## 2. Analysis

The Deputy Director General of WIPO, by communication C.8261, requests the Member States to submit the abovementioned information with a view to preparing the working papers to be presented at the twentieth session of the Standing Committee on the Law of Patents (SCP) due to be held in December 2013.

A number of points for consideration in this regard are set out below.

### 2.1 Exceptions and limitations

The requested information relates to the application in the national system of five exceptions and limitations, namely: (i) private and/or non-commercial use; (ii)

experimental use and/or scientific research; (iii) preparation of medicines; (iv) prior use; and (v) use of articles on foreign vessels, aircraft and land vehicles.

(a) Private and/or non-commercial use

Article 53(a) of Decision 486 of the Commission of the Andean Community establishing the common industrial property regime (hereinafter: Decision 486) provides that patentees may not exercise their right with regard to acts undertaken in the private sphere and/or for non-commercial purposes.

Furthermore, as indicated in the reply to the questionnaire on exceptions and limitations to patent rights, the concepts “non-commercial”, “commercial” and/or “private” are not defined in our legislation. To date, no judicial or administrative ruling on the scope of this exception has been handed down.

(b) Experimental use and/or scientific research

Article 53(b) and (c) of Decision 486 provide that patentees may not exercise their right with regard to acts undertaken exclusively for experimental purposes in relation to the subject of the patented invention, and acts carried out exclusively for the purposes of teaching or scientific or academic research.

Furthermore, as indicated in the reply to the questionnaire on exceptions and limitations to patent rights, our legislation does not contain any definition of the concept “experimental use”, nor is the commercial intention of the experimentation and/or research relevant in determining the scope of the exception. To date, no judicial or administrative ruling on the scope of this exception has been handed down.

(c) Preparation of medicines

Article 39 of Legislative Decree 1075 establishing supplementary provisions to Decision 486, as amended by Act 29316, provides that without prejudice to the exclusivity rights of the patentee, a third person may use the material protected by the said patent with the sole aim of generating the information necessary to support an application for approval for the marketing of a pharmaceutical or agrochemical product in Peru.

Any product produced in accordance with the terms of the previous paragraph may be manufactured, used, sold, offered for sale or imported in the national territory for the generation of information with the sole aim of meeting the requirements relating to the approval of marketing of the product once the term of the patent has expired. Moreover, the product may only be exported for the purposes of meeting the requirements relating to the approval of marketing in Peru.

(d) Prior use

Article 55 of Decision 486 provides that the rights conferred by a patent may not be enforced against a third party who, in good faith and before the priority date or the filing

date of the application on the basis of which the patent was granted, was already using or exploiting the invention, or had already made effective and serious preparations for such use or exploitation. In such cases, the said third party shall have the right to start or continue using or exploiting the invention, but that right may only be assigned or transferred together with the business or company in which that use or exploitation is taking place.

As regards the existence of any judicial or administrative ruling on the exception, it should be noted that Decision No. 346-2008/OIN-INDECOPI of 26 March 2008, issued in case No. 1328-2007/OIN, the Inventions and New Technologies Office (now the Inventions and New Technologies Directorate) declared the action for infringement to be baseless inasmuch as, under Article 55 of Decision 486, it had been established that prior to the filing date of the patent application for the utility model which formed the basis of the complaint for infringement, serious preparations had been made in good faith for exploiting the product that was the subject of the complaint, and thus the right was established to continue using the product.

(e) Use of articles on foreign vessels, aircraft and land vehicles

Article 5ter of the Paris Convention for the Protection of Industrial Property (hereinafter: Paris Convention) establishes that in any country of the Union the following shall not be considered as infringements of the rights of a patentee:

- (i) the use on board vessels of other countries of the Union of devices forming the subject of his patent in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of the said country, provided that such devices are used there exclusively for the needs of the vessel;
- (ii) the use of devices forming the subject of the patent in the construction or operation of aircraft or land vehicles of other countries of the Union, or of accessories of such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter the said country.

Article 53(d) of Decision 486 establishes that patentees may not exercise their right with regard to the acts referred to in Article 5ter of the Paris Convention.

Furthermore, as indicated in the reply to the questionnaire on exceptions and limitations to patent rights, the exception applies in relation to vessels, aircraft and land vehicles.

To date, no judicial or administrative ruling on the scope of this exception has been handed down.

## 2.2 Quality of patents

The requested information relates to the programs for the division of work between patent offices and use of external information for search and examination purposes.

In relation to the use of external search and examination reports, it should be noted that Article 46 of Decision 486 provides as follows:

“The competent national office may request reports from experts or from scientific or technological bodies that are considered suitable, in order to obtain their opinions on the patentability of the invention. Where it sees fit to do so, it may also request reports from other industrial property offices.

If the examination of the patentability of the invention requires it, the applicant shall, at the request of the competent national office and within a period not exceeding three months, submit one or more of the following documents relating to one or more foreign applications referring to all or part of the invention being examined:

- (a) a copy of the foreign application;
- (b) copies of the findings of the novelty or patentability examinations conducted with respect to the foreign application;
- (c) a copy of any patent or other protection granted on the basis of the foreign application;
- (d) a copy of any decision or ruling rejecting or refusing the foreign application; or,
- (e) a copy of any decision or ruling annulling or invalidating the patent or other protection granted on the basis of the foreign application.

The competent national office may accept the results of the examinations referred to in subparagraph (b) above as sufficient to certify that the conditions have been fulfilled regarding the patentability of the invention.

If the applicant fails to submit the requested documents within the period prescribed in the present article, the competent national office shall refuse the patent.”

Furthermore, as regards the use of various external databases to find search and examination information, patent examiners in the Directorate use various databases such as Espacenet (Epoline), USPTO (PAIR), JPO, PATENTSCOPE, OEPM and LATIPAT.

### 2.3 Confidentiality of communications between clients and their patent advisors

As regards the confidentiality of communications between clients and their patent advisors, we can make the general comment that Article 2(18) of the Constitution of Peru provides that every person is entitled not to disclose his/her political, philosophical, religious or other convictions, and also has the right to maintain professional secrecy.

Furthermore, Article 165 of the Penal Code, which deals with the offence of the violation of professional secrecy, provides that any person who, by virtue of his/her status, office, employment, profession or ministry, is party to confidential information whose publication may be detrimental and discloses such information without the consent of the interested party, shall be liable to imprisonment of up to two years and a fine equivalent to 60 to 100 days under the day-rate system.

### 3. Conclusions

The conclusions of the above analysis are as follows:

(a) As regards exceptions and limitations to patent rights, there has only been one case so far in which a ruling has been issued on the exception relating to prior use.

(b) With regard to the use of external search and examination reports, it should be noted that under Article 46 of Decision 486 of the Commission of the Andean Community, the Directorate may request reports from experts and also documentation relating to the examination of patentability undertaken by other patent offices.

Furthermore, patent examiners in the Directorate use various external databases for search and examination in relation to patent applications.

(c) As regards the confidentiality of communications between clients and their patent advisors, Article 2(18) of the Constitution of Peru provides that every person has the right to maintain professional secrecy. Furthermore, under the Penal Code, the violation of professional secrecy is a criminal offence.

Yours sincerely,

Bruno Mérchor Valderrama

Director, Inventions and New Technologies, INDECOPI

Lima, June 26, 2013