

Report to the International Bureau on inventive step and the requirements for sufficient disclosure of the Department of Patents of Paraguay

### **INVENTIVE STEP**

**(i) The definition of a person skilled in the art**

We do not have a definition of person skilled in the art

**(ii) methodologies employed for evaluating the inventive step**

We use the problem-solution method

**(iii) having regard to the prior art, level of inventiveness (obviousness) to meet the inventive step requirement.**

In practice, we require obviousness when a lack of data in the specification and comparison with prior art make it impossible to demonstrate the level of inventiveness of the invention for which a patent is sought.

### **Definitions**

***Prior art** comprises everything that has been disclosed or made available to the public, anywhere in the world, by means of tangible publication, oral disclosure, sale or marketing, use, or any other means, before the filing date of the patent application in the country or, as the case may be, before the filing date of the earlier application whose priority is claimed.*

*In order to assess the novelty of the invention, the prior art may also include the contents of a patent application pending before the Industrial Property Office whose filing date or, where applicable, priority date, precedes the filing date of the application being examined, but only if such contents were included in the earlier application when this was published.*

*The prior art shall not include any disclosure made during the year preceding the date of filing of the application in Paraguay or, where applicable, during the year preceding the date of filing the application whose priority is claimed, provided that such disclosure resulted directly or indirectly from acts performed by the inventor himself or his successor in title, or a from breach of contract or unlawful act committed against any of them.*

*Disclosure resulting from a publication made by an Industrial Property Office as part of formalities to grant a patent shall not fall within the exception set forth in the foregoing paragraph unless the application which is gave rise to such publication was filed by a person not entitled to obtain the patent, or the publication was the result of an error attributable to the Industrial Property Office. **(Art. 7 of Law No. 1.630/2000 to govern Patents).***

*Prior art/state of the art: shall comprise everything that has been disclosed or made available to the public anywhere in the world, through tangible publication, oral disclosure, sale or marketing, use, or by any other means, before the date of filing of the patent application in the country or, where appropriate, before the filing date of the earlier application whose priority is claimed. **(Definition provided in Resolution No. 103/2012).***

***Inventive step:*** An invention shall be considered to have an inventive step if to a person skilled in the technical field of the invention it is neither obvious nor has obviously been derived from the relevant prior art. (**Art. 8, Law No. 1.630/2000 to govern Patents**).

***Inventive level/inventive activity:*** An invention is deemed to attain the inventive level if to a person skilled in the relevant technical field of the invention, it is not obvious, or was not obviously derived from the relevant prior art.

An invention shall not be considered to have an inventive step in case of juxtaposition of known inventions or mixtures of known elements and/or products, variations in their form, dimensions or materials, except where they are combined or merged in such a manner that they cannot function separately or where their qualities or characteristic functions are modified to obtain an industrial result not obvious to a person skilled in the art;

(**Definition provided in Resolution No. 103/2012**).

### **SUFFICIENCY OF DISCLOSURE**

- (i) enabling disclosure requirement
- (ii) support requirement
- (iii) written description requirement

**Regarding sufficient disclosure, the following provisions are available:**

***Description*** - The description shall be accompanied by the relevant drawings where necessary to ensure that the disclosure of the invention is sufficiently clear, complete and understandable for the purpose of enabling execution. The description of the invention shall state its name, the sector to which it refers or to which the known prior art applies and references, previous documents and publications relating to the technology.

The description shall set out in detail the technical problem, together with the solution provided by the invention and the best way to execute or implement the invention, using examples and references to the drawings, indicating how the invention may be manufactured or used in any productive activity. (**Art. 15, Law No. 1.630/2000 to govern Patents**).

***Description of biological material*** - Where the invention refers to a product or procedure relating to biological material that is not publicly available and cannot be described such that the invention may be performed by a person skilled in the art, the description shall be supplemented by the deposit of such material in a depositary institution recognized by the Office of Industrial Property.

Such deposit shall be made no later than sixty days from the date of filing the application or, where a right of priority is claimed, no later than the priority date of the original application.

Such deposit shall not be required if it has already been made in a member country of the World Trade Organization or if the authority of any such country has already conducted the novelty examination. In such case, the name and address of the depositary institution, together with the filing date and the deposit number assigned by the institution shall be indicated. The nature and characteristics of the deposited material shall also be described where this is necessary for the disclosure of the invention. (**Art. 16, Law No. 1.630 / 2000 to govern Patents**).

*The description of the invention shall be concise and clear, without unnecessary repetition and consistent with the claims. It shall also include: the technical field to which the invention pertains, the indication of the prior art on the filing date or priority known to the applicant, if applicable, necessary for an understanding of the invention and for preparing the report, citing the available documents. An explanation of the invention as it is characterized in the claims, which permits an understanding of the technical problem and the solution thereto, indicating, where necessary, the advantages of the invention relative to the prior art. A description of the figures in the drawings, if any, and a detailed explanation of at least one embodiment of the invention, which may be illustrated by examples, and references and drawings, if any. The indication of the manner in which the invention may be used as an industrial application, unless it is obvious from the description or nature of the invention. (Art. 8, Decree No. 14,201/2001).*

**Disclosure:** The invention must be disclosed in a manner sufficiently clear and complete for it to be executed by a person skilled in the relevant art.

In the case of chemicals compounds or processes for the production of chemical compounds, in order to enable its implementation and understanding, the specification must be accompanied by drawings that represent the chemical structure of the intermediate and final chemicals involved. The representation of the drawings shall not be sufficient if it is not accompanied by the chemical names of the molecules involved. Possession of the generic name, if one exists, should also be disclosed in the specification.

The description of the invention shall contain the chemical name, the sector to which it pertains or in which the known prior art is applied and references, previous documents and publications relating to the technology.

The description shall set out in detail the technical problem and the solution provided by the invention and the best way to execute or implement the invention, using examples and references to the drawings, indicating how the invention may be produced or used in any productive activity.

The best known method must be accompanied by a sufficient description that allows a person skilled in the art to apply it in an industrial production process without major modifications. (**Point IV of Resolution No. 103/2012**).

Claims including a Markush-type formula, called Markush claims, make it possible to reveal many compounds that are structurally related. The representative compounds of each must be properly characterized and described in the specification, such as by melting point (mp), infrared spectrum (IR) and nuclear magnetic resonance spectra of protons and carbon 13 (<sup>1</sup>H-NMR and <sup>13</sup>C NMR).

In the case of compounds described by Markush formulas, the revelation of the basic structure, including all possible alternatives to chemical radicals, shall be equivalent to the disclosure of each of the compounds resulting from these substitutions. For the case of R = C1-C4 it is considered that all c1, c2, c3 and c4 straight and branched carbon chains are shown.

The compounds represented by a Markush formula shall be admitted if they meet the requirements for patentability (novelty, inventive step and industrial application), present a sufficient description in the specification of the application, and have properly characterized the representative compounds of the various embodiments, such as by: melting point, IR spectrum, NMR spectra of protons and C13, to see all the compounds under the Markush formula claimed. Claims must be clear, concise and fully

supported by the description presented. For a sufficient description of the compounds provided in the Markush formula claimed, forms of realization (synthesis procedures) of the invention described in the examples should be representative of all the compounds to be protected. Such forms of realization of the invention should be suitably exemplified, and compounds obtained from them appropriately characterized so as to make certain what compound(s) is/are obtained. (***Point IX of Resolution No. 103/2012***).