

ARGENTINA

Resolution No. 56/2016

Buenos Aires, September 12, 2016

MINDFUL of Dossier No. A 253-62214/03; Law No. 24.481 on patents and utility models (1996 consolidated text), as amended by Laws Nos. 24.572 and 25.859 and Regulatory Decree No. 260 of March 20, 1996, Annex II; and INPI Resolutions Nos. P-263/03 and P-125/09;

CONSIDERING THAT:

Technological progress requires greater expertise in order to assess the subject matter claimed in patent applications.

This creates the need to develop tools for adapting to these changes and maintaining high quality standards when examining patent applications.

The reuse of search and examination results previously produced by other offices is the most effective instrument to that end.

Work-sharing programs among patent offices have become crucial to the improvement of patent systems in many countries.

Patent holders often file transnational patent applications, such that applications from the same patent family are examined in different countries.

Accordingly, several offices individually perform searches of the same or similar patent claims, thus essentially repeating some of the work already done by other offices.

Such duplication of effort and work is not beneficial to the offices, applicants and society at large.

Relying on the search and examination results of other patent offices will not only improve the quality of searches and examinations performed within the national patent administration but also reduce document processing periods by avoiding the duplication of work already done.

The foregoing reasons do not entail acceptance or adoption of the practices, legislation or regulations of other patent offices.

The objective is to ensure that the examiner has a more accurate starting point for search and examination of applications in order to grant high quality patents.

This overriding principle is somehow ignored in State policies applicable to this domain.

The methodology to be implemented should be applied having regard to the substantive and procedural standards defined in Law No. 24.481 (1996 consolidated text), as amended by Laws Nos. 24.572 and 25.859; Law No. 24.425 to approve the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement); and all standards relating to observance of the principles established in the Paris Convention, Law No. 17.011.

Such an initiative has a legal basis under Article 27 of Law No. 24.481 and Article 27(iii)(a) in Annex II of Decree No. 260/96, which permit the National Patent Administration to request, through its examiners as appropriate, a copy of the report on the substantive examination conducted by foreign offices.

It would therefore be appropriate to authorize the National Patent Administration to accept the validity of international background searches and technical substantive examinations conducted during processing of the corresponding patents granted by foreign offices.

Accordingly, it should be established that the claims made in the national application should be identical or narrower in scope than the rights protected by the corresponding patent granted by the foreign office and that, the foreign office should apply the same standards, in terms of patentability requirements, as those

applicable in the Republic of Argentina when examining applications.

To ensure its implementation, various steps and precautions must be taken, such as conducting a background search of the applications for patents and utility model certificates filed in the Republic of Argentina.

This measure is clearly optional and not mandatory for the National Patent Administration, since it may disregard this resolution on well-founded technical, legal or law enforcement grounds.

The National Patent Administration and the Directorate for Legal Affairs have expressed their appropriate legal opinion.

This resolution is taken by virtue of powers conferred by the regulations in force.

Now, therefore,

THE PRESIDENT OF THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

HEREBY RESOLVES AS FOLLOWS:

Article 1: The National Patent Administration shall consider the requirements of Article 4 of Law No. 24.481 (1996 consolidated text) as fulfilled and accept the validity of international search reports pertaining to patent applications filed under Law No. 24.481 (1996 consolidated text), if it receives proof that the right of priority claimed under Article 4A(1) of the Paris Convention was granted abroad by the office of origin or by other offices, provided that the laws governing such offices require them to conduct a substantive examination and that these offices apply the same standards, in terms of patentability requirements, as the Republic of Argentina.

Article 2: The National Patent Administration shall consider the requirements of Article 4 of Law No. 24.481 (1996 consolidated text) as fulfilled and accept the validity of international searches pertaining to patent applications filed under Law No. 24.481 (1996 consolidated text) which do not invoke the right of priority under Article 4A(1) of the Paris Convention, but which prove that the same invention was patented abroad after the filing date of the Argentinian application, that the invention in question was disclosed after the filing date of the national application and that the office which granted the patent conducts substantive examinations and applies the same standards, in terms of patentability requirements, as the Republic of Argentina.

Article 3: The applications referred to in the preceding articles shall be granted under the following mandatory conditions: (a) the claims made in the application filed in the Republic of Argentina must be of narrower or equal scope with those made in the foreign patent referred to in Articles 1 and 2 of this Resolution; (b) there should be no national background as of the filing date of the application in the Republic of Argentina; (c) there should be no foreign background between the filing date of the corresponding patent referred to in Article 2 of this Resolution, and the effective filing date of the application in the Republic of Argentina, that affects the patentability requirements prescribed in Article 4 of the Law No. 24.481 (1996 consolidated text); (d) the subject matter claimed in the patent application should be covered under Articles 6 and 7 of Law No. 24.481 (1996 consolidated text) and Article 6 of the Regulation (Annex II of Decree No. 260/96); (e) observations submitted by third parties under Article 28 of Law No. 24.481 (1996 consolidated text) and the Regulation (Annex II of Decree No. 260/96) should be assessed; (f) the foreign office that examines the corresponding patent should apply the same patentability requirements as the Republic of Argentina.

Article 4: This Resolution shall apply to patent applications whose substantive examination has not yet commenced and which meet the conditions set out in the preceding articles.

Article 5: In the circumstances described in Articles 1 and 2, the applicant may, prior to the substantive examination report, voluntarily request that this resolution be applied to the application under study. To that end, the applicant shall provide evidence, together with the corresponding translation, that the scope

of national claims matches the scope of claims granted abroad. The National Patent Administration shall respond within 60 days of the filing of such a request.

Article 6: In the circumstances described in Articles 1 and 2, the National Patent Administration may require the applicant to adjust the scope of the national claims to match the scope of the claims granted abroad, within 90 days of notification.

Article 7: The National Patent Administration shall be released from the obligation to apply this resolution on legal and technical grounds, or for reasons of national defense, internal security, public health emergency or public order.

Article 8: This resolution shall become effective on October 15, 2016. Thereupon, Resolutions INPI No. P-263/03 and INPI No. P-125/09 shall be repealed. However they shall continue to govern application to procedures initiated while they were in force, and which are still ongoing as of the effective date, unless the applicant expressly requests that this resolution should apply.

Article 9: The template to be used by applicants to request the application of this resolution, pursuant to Article 5, is attached as an annex to this Resolution and forms an integral part thereof.

Article 10: This resolution shall be registered, communicated and transmitted to the National Directorate of the Official Registry, after which it shall be published, posted on the information board on the web page of INPI and archived.

Dr. Damaso A. Pardo, President, National Institute of Industrial Property

ANNEX

CODE: 333000

VOLUNTARILY ADHERES TO ARTICLE 5 OF INPI RESOLUTION NO. P... / 2016 FOR PATENT APPLICATION
No.....

NPA Commissioner:....

19/09/2016 N° 67907/16 v. September 19, 2016

Publication date: September 19, 2016