



*Instituto Nacional de la Propiedad Industrial*

Buenos Aires, April 3, 2017

Ref. Note No. 40/2017 DNEMU letter  
Subject: WIPO Circular C 8653

**TO: DEPARTMENT OF MULTILATERAL ECONOMIC NEGOTIATIONS  
MINISTRY OF EXTERNAL RELATIONS AND CULTURE**

In response to the request made in the referenced note pertaining to WIPO Circular C 8653 dated May 16, 2016, pursuant to the decision taken by the Standing Committee on the Law of Patents (SCP) at its twenty-fifth session, we are providing information on following points as requested:

**(i) NATIONAL LEGISLATION GOVERNING PROCEDURES FOR OPPOSITION  
AND OTHER MECHANISMS FOR ANNULMENT OR ADMINISTRATIVE  
CANCELLATION**

**OPPOSITION**

In Argentina, patents are governed by Law No. 24.481 (LP) and amending legislation, numbered 24.572 and 25.859. The regulations of the law (RLP) are contained in Annex I (regular font), Decree No. 260/96, and Annex II (italics) Regulations of the law.

Our legal system does not provide for opposition. Instead, there are “third-party observations”, under both Art. 28 of the LP and Art. 28 of the Regulation, reproduced below.

**LAW**

ARTICLE 28. Where the application calls for observations, the National Patent Administration shall so inform the applicant so that, within 60 days, he may provide any clarifications that he deems relevant or submit the information or documentation that may be required [...].

**Any person may submit substantiated observations on the patent application, together with documentary evidence, within 60 days of the publication provided for in Article 26. The observations shall concern the failure to meet some or all of the legal requirements for granting the patent application.**

**REGULATION**

*ARTICLE 28. The examiner shall include among his observations those submitted by third parties, based on information arising from the publication made pursuant to Article 28 of the Law and based on the absence of novelty, industrial*



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*applicability, or inventive step or on the unlawfulness of the object of the application, unless the observations are manifestly unfounded and declared as such.*

The intervention of third parties in the procedure is limited to the submission of observations; they may not oppose the continuation of the procedure. During the substantive examination, the examiner concerned must include among his observations those submitted by third parties alleging the absence of novelty, industrial applicability, or inventive step or on the unlawfulness of the object of the protection, unless the observations submitted were unfounded and the examiner so declares.

Briefs submitted by third parties that fall outside the prescribed time limit or are not accompanied by payment of the requisite fee shall attract a reprimand.

All submissions by third parties will be incorporated into the application file of the patent or utility model.

## **ADMINISTRATIVE CANCELLATION AND INVALIDATION MECHANISMS**

The Argentinian legal system allows for two types of laws for these purposes: (A) National Law on Administrative Procedures No. 19.549 (LNPA) and its regulations approved by Decree No. 1759/72 of 1991 (RLNPA); and (B) Article 72 of Law No. 24.481 on Patents and its regulations (Decree No. 260/96, Annex II).

### **(A) Law on Administrative Procedures**

All **definitive** administrative acts issued by the National Patent Administration (ANP), which is under the authority of the National Institute of Industrial Property, shall be subject to the remedies provided for in the LNPA and the RLNPA. They are:

- request for reconsideration (Article 84 and related provisions of the LNPA), which must be filed before the same body that issued the decision, within 10 working days of notification of the act;
- hierarchical appeal (Article 89 of the RLNPA), which must be filed before the authority that issued the impugned act within 15 working days of notification; and
- appeal (Article 94), which must be filed before the authority that issued the impugned act within 15 working days of notification.

If the appeal lodged relies on the LNPA, the Legal Department of the ANP will issue the corresponding opinion. Where the Commissioner so allows, it will issue the relevant ruling, notifying the appellant. If the appeal is denied, after the interested party is notified, the file will be sent to the Legal Department, giving



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rise to a hierarchical appeal in the alternative, so that it can make a determination.

The intervention of an Industrial Property Agent or of an attorney is required to file an administrative appeal. Applicants who lack the means to be represented must request the INPI to designate an Industrial Property Agent who will act for them free of charge in accordance with Article 5(f) of the Regulations governing the profession of Industrial Property Agent, approved by Resolution P-101. Persons applying for that free representation must submit a duly legalized certificate of indigence issued by a judicial authority.

**(B) Art. 72 of the LP and the RLP provides for further remedies in addition to those laid down in the LNPA**

The above-mentioned appeal concerns the ruling of a Patent Commissioner who refuses to grant an application for a patent or a utility model.

The time-limit for filing the appeal is 30 working days, with effect from the notification of the relevant ruling, and the appeal must be submitted in writing to the President of the INPI, together with the corresponding fee.

Once the document has been entered in the ANP, through which the appeal is lodged, the Legal Department of the National Patent Office will verify whether it has been filed in good time and in the proper form. If the complainant has not paid the requisite fee or the brief does not have the signature of an Industrial Property Agent or lawyer, the owner will be notified to comply with these requirements on pain of *in limine* rejection of the appeal.

Once the above procedure is completed, the case file will be sent to the Legal Department for its information and action and, after the Legal Department provides its legal opinion, the file will be submitted to the INPI President, who will be the final arbiter.

Moreover, Article 72 of the RLP states: *The filing of the request for reconsideration provided for in Art. 72 of the law shall not be create the right to file other administrative or judicial appeals that may be relevant having regard to Law No. 19.549 and of the Regulations Governing Administrative Procedures, Decree No. 1759/72 of 1991.*

Upon exhaustion of the administrative remedies, the complainant may go to court with 90 working days as from notification of the impugned administrative act being appealed against.

**(ii) EXCEPTIONS AND LIMITATIONS TO RIGHTS CONFERRED BY PATENTS**

**GENERAL INFORMATION**



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Law No. 24.481 on Patents. Text confirmed by Decree No. 260/96, Annex I (regular font) and the Regulations Annex II (italics)

ARTICLE 4. Inventions for goods or procedures shall be patentable, provided that they possess novelty new, involve an inventive step and are industrially applicable.

- (a) For the purposes of this Law, an invention shall be considered to be any human creation which allows the transformation of subject matter or energy for the benefit of humanity.
- (b) Similarly, any invention which is not included in the prior art shall be considered to possess novelty.
- (c) Prior art shall mean all the technical knowledge made public prior to the filing date of the patent application or, where applicable, the recognized priority date, by means of an oral or written description, working, or any other means of dissemination or information, in the country or abroad.
- (d) An inventive step exists where the creative process or its results are not obvious from the prior art for a person with average skills in the technical field concerned.
- (e) An invention is industrially applicable where the subject matter of the invention leads to an industrial result or product; the term “industry” encompasses agriculture, forestry, animal breeding, fishing, mining, processing industries as such and services.

Exclusions from Patentability

#### Law

ARTICLE 6. The following shall not be considered inventions for the purposes of this Law:

- (a) discoveries, scientific theories and mathematical methods;
- (b) literary or artistic works or any other aesthetic creation, as well as scientific works;
- (c) plans, rules and methods for the practice of intellectual activity, for games or economic and commercial activities, as well as computer programs;
- (d) the manner of presenting information;
- (e) methods of surgical, therapeutic or diagnostic treatment applicable to the human body and to animals;
- (f) the juxtaposition of known inventions or mixtures of known products, or alteration of their form, dimensions or materials, except where in reality they are so combined or merged that they cannot function separately or where their particular qualities or characteristic have been modified so as to produce an industrial result not obvious to a person skilled in the art;
- (g) all living material and substances preexisting in nature.



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Regulation

*ARTICLE 6. Plants, animals and the essentially biological processes for their reproduction shall not be considered to be patentable material.*

Law

ARTICLE 7. The following are unpatentable:

- (a) inventions whose working in the territory of the Republic of Argentina should be prevented in the interests of public order or morality, the health or life of persons or animals, or to ensure the conservation of plants or the avoidance of serious damage to the environment;
- (b) biological and genetic material occurring in nature or derived therefrom by reproduction, and genetic reproduction processes replicating nature.

Regulation

*ARTICLE 7. The Executive arm of Government may prohibit the manufacture and commercialization of inventions whose working within its territory must be prevented in the interests of public order or morality, including to protect human, animal or plant life or health or to avoid serious damage to the environment.*

Exclusive rights granted by a patent, under the applicable laws:

Law

ARTICLE 8. The right to the patent shall be vested in the inventor or to his assignees, who shall have the right to assign or transfer the right by any lawful means and to enter into licensing contracts. A patent shall confer on its owner the following exclusive rights, without prejudice to the provisions of Articles 36 and 99 of this law:

- (a) where the subject matter of a patent is a product, to prevent third parties from carrying out the following acts without the owner's consent: making, using, offering for sale, selling, or importing the product that is the subject matter of the patent;
- (b) where the subject matter of the patent is a process, the owner of a process patent shall have the right to prevent third parties not having the owner's consent from carrying out the act of using the process and the acts of: using, offering for sale, selling, or importing for these purposes the product obtained directly by that process.

Regulation

*ARTICLE 8. The applicant may mention in his application the name(s) of the inventor(s) and request that it/they be included in the publication of the patent*



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*application, in the industrial property title granted and in the publication of the patent or utility model carried out.*

*Patent owners who learn by any means of the importation of goods in violation of the rights vested in them by the law shall have the right to bring legal action before the appropriate administrative or judicial entity.*

#### PRIVATE AND/OR NON-COMMERCIAL USE

##### Law:

ARTICLE 36. The right conferred by a patent shall not have any effect against the following:

- (a) a third party who, in the private or academic sphere and for non-commercial purposes, engages in scientific or technological research for purely experimental, testing or teaching purposes, and to that end manufactures or uses a product or a process identical to the one patented.

#### EXPERIMENTAL USE AND/OR SCIENTIFIC RESEARCH

##### Law:

ARTICLE 36. The right conferred by a patent shall not have any effect against:

- (a) a third party who, in the private or academic sphere and for non-commercial purposes, engages in scientific or technological research activities for purely experimental, testing or teaching purposes, and to that end manufactures or uses a product or a process identical to the one patented.

#### PREPARATION OF MEDICINES

##### Law

ARTICLE 36. The right conferred by a patent shall not have any effect against:

[...]

- (b) the preparation of medicines in the customary manner by an authorized professional and per unit following a medical prescription, or acts relating to medicines so prepared.

#### PRIOR USE

##### Law

ARTICLE 101



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[...]

The patent owner shall have the exclusive right to his invention five years after the publication of the present law in the Official Gazette, unless a third party or third parties making use of his invention without his authorization can guarantee the full supply of the domestic market at the same current prices. In such case, the patent owner shall only have the right to receive fair and reasonable compensation from the third parties making use of the patent from the date of its grant to its expiry. In the absence of agreement between the parties, the National Industrial Property Institute shall fix the compensation pursuant to Article 43. The provisions contained in this paragraph shall be applied unless the paragraph is amended to implement decisions of the World Trade Organization (WTO) adopted in accordance with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)/General Agreement on Tariffs and Trade (GATT) with which compliance is mandatory for the Republic of Argentina.

Regulation

ARTICLE 101. I.

*II. As from the date of expiry of the transition period, any person wishing to limit the remedies available to a holder of rights in protected subject matter must have initiated acts of working or have made a significant investment concerning such acts before January 1, 1995. In such case, the patent owner shall have the right to receive the compensation provided for under Article 102(3) of the law. Authorization cannot be granted if the patent owner guarantees full supply of the domestic market at the same current prices. The provisions of this paragraph shall apply unless the paragraph is amended to implement decisions of the World Trade Organization (WTO) with which compliance is mandatory for the Republic of Argentina.*

USE OF ARTICLES ON FOREIGN VESSELS, AIRCRAFT AND LAND VEHICLES

Law

ARTICLE 36

[...]

- (d) The use of inventions patented in Argentina on foreign land vehicles, vessels or aircraft accidentally or temporarily travelling in the jurisdiction of the Republic of Argentina, if they are used exclusively for the needs of said vehicles.

ACTS FOR SECURING REGULATORY APPROVAL FROM AUTHORITIES



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### Law

ARTICLE 98. This law does creates no exemption from compliance with the requirements established under Law No. 16.463 on authorization to prepare and commercialize pharmaceutical products in Argentina.

### Regulation

*ARTICLE 98. Authorization for the production and marketing of pharmaceutical products shall be requested from the Ministry of Health and Social Action and, in the field of agrochemical products, from the Argentinian Institute of Plant Health and Quality, which is under the authority of the Secretariat of Agriculture, Fisheries and Food of the Ministry of The Economy and Public Works and Services.*

## EXHAUSTION OF PATENT RIGHTS

### Law

ARTICLE 36. The right conferred by a patent shall not have any effect against:

[...]

- (c) Any person acquiring, using, importing or in any way marketing the patented product or the product obtained by means of the patented process, after the product has been lawfully placed on the market in any country. It shall be understood that the marketing is lawful if it is in accordance with Part III, Section 4 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)/General Agreement on Tariffs and Trade (GATT).

### Regulation

*ARTICLE 36. For the purposes of Article 36(c) of the law, the owner of a patent granted in the Republic of Argentina shall have the right to prevent third parties from carrying out acts of manufacturing, using, offering for sale or importing into the territory of Argentina the product which is the subject matter of the patent without his authorization, as long as said product has not been lawfully placed on the market in any country. The product shall be deemed to have been lawfully placed on the market when the licensee authorized to market it in the country proves that he has been so authorized by the owner of the patent in the country of acquisition, or by a third party authorized to market the product. The marketing of the imported product shall be subject to the provisions of Article 98 of the law and this regulation.*





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## COMPULSORY LICENSES AND/OR GOVERNMENT USE

### Law

ARTICLE 42. Where a proposed user has made efforts to obtain a license from the owner of the patent under reasonable commercial terms and conditions pursuant to Article 43, and such efforts have been unsuccessful after 150 consecutive days as from the date on which the license was requested, the National Industrial Property Institute may allow other uses of that patent without the authorization of its owner. Without prejudice to the above, an obligation to notify the authorities is established by Law No. 22.262, or the law amending or replacing Law No. 22.262, which protects free competition for the relevant purposes.

### Regulation:

*Once the time limits established in Article 43 of the Law have elapsed, if the invention has not been exploited – except in the case of force majeure – or if effective and serious preparations have not been made to work the patented invention, or if the exploitation of the patented invention has been interrupted for more than one year, any person may apply to the National Industrial Property Institute for a compulsory license for the manufacture and sale of the patented product or the use of the patented process. To this end, the applicant must prove that he has made efforts to obtain a voluntary license from the patent owner on reasonable commercial terms and conditions; that such efforts were unsuccessful after 150 days; and that technical and commercial conditions are such that he is in a position to supply the domestic market on reasonable commercial conditions.*

*The application for the license shall be processed by the National Industrial Property Institute and shall contain the relevant grounds, together with and any proof deemed relevant. The patent owner shall be notified of the corresponding document at the address indicated in the patent file and shall have 10 working days to respond and provide proof. The National Industrial Property Institute may reject any inconclusive evidence that is tendered and the patent owner shall tender any outstanding proof within 40 days. Once that time limit has elapsed or once all proof has been provided, the National Industrial Property Institute shall issue a reasoned ruling granting or refusing the compulsory license requested.*

*The ruling of the National Industrial Property Institute granting or refusing the compulsory license is directly appealable before the Federal Civil and Commercial Court within 10 days of notification, without prejudice to the remedies provide for in Article 72 of the law and under the Law on Administrative Procedures and its Regulations. The judicial proceedings shall not have suspensive effect.*



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### Law

ARTICLE 43. Three years after a patent is granted, or four years after the filing of the application, if the invention has not been exploited – except in the case of *force majeure* – or if effective and serious preparations have not been made to work the patented invention, or if the working of the patented invention has been interrupted for more than one year, any person may apply for authorization to use the invention without the authorization of its owner.

Objective difficulties of a technical and legal character, such as delays in obtaining registration for marketing approval from public bodies, which are beyond the patent owner's control and which make the exploitation of the invention impossible, shall be considered as *force majeure* in addition to those circumstances legally recognized as such. The lack of financial resources or the lack of financial feasibility of the exploitation shall not alone constitute justification.

The National Industrial Property Institute shall notify the patent owner of failure to comply with the provisions contained in the first paragraph prior to granting the use of the patent without his authorization.

The implementing authority shall hear the parties and, in the absence of agreement, it shall set a reasonable remuneration to be paid to the patent owner, such remuneration being set according to the specific circumstances of each case and taking into account the financial value of the authorization, as well as the average rate of royalties for the sector concerned with regard to commercial licensing contracts concluded between independent parties. Any decisions concerning the grant of these uses shall be adopted within 90 working days of the filing of the application and shall be appealable before the Federal Civil and Commercial Court. The judicial proceedings shall not have suspensive effect.

### Regulation

*ARTICLE 43. Exploitation of a product shall be deemed to occur where distribution and marketing are conducted on a scale sufficient to satisfy the demands of the domestic market, under reasonable commercial conditions.*

*The National Industrial Property Institute, having heard the parties and, failing agreement between them, shall set a reasonable remuneration to be paid to the patent owner, according to the specific circumstances of each case, having regard to the financial value of the authorization and the average rate of royalties for the sector concerned with regard to commercial licensing contracts concluded between independent parties.*

*Rulings of the National Industrial Property Institute in accordance with this Article shall be appealable against under Article 42, final paragraph of this regulation.*



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### Law

ARTICLE 44. The right to exploitation conferred by a patent shall be granted without the authorization of its owner if the competent authority has determined that the patent owner engaged in anti-competitive practices. In such case, without prejudice to the remedies available to the patent owner, the right shall be granted without implementing the procedure set out in Article 42.

For the purposes of this law, the following, *inter alia*, shall be deemed to be anti-competitive practices:

- (a) fixing excessive or discriminatory prices for patented products in relation to average market prices, in particular where offers of market supply exist at prices significantly lower than those offered by the owner of the patent for the same product;
- (b) refusal to supply the local market under reasonable commercial conditions;
- (c) obstruction of commercial or production activities; and
- (d) any other act that falls into the category of conduct that is punishable under Law No. 22.262 or the law replacing or substituting for that law.

### Regulation

*ARTICLE 44. The competent authority under Law 22.262, or the law replacing or substituting for that law, shall, either ex-officio or on request of a party, establish the existence of an alleged anti-competitive practice where activities are being conducted irregularly and in such a manner as to constitute abuse of a dominant position in the market, pursuant to Article 44 of the law and the other applicable provisions of the Law on the Defense of Competition, after the patent owner is summonsed and afforded 20 days to set out his case. Once the patent owner has set out his and adduced evidence if required, the competent authority shall rule on the appropriateness of the grant of compulsory licenses and shall set the conditions under which such licenses should be offered.*

*In this final instance, the National Industrial Property Institute shall, once seized of the case, order the publication of a notice in the Official Gazette, the Patent Gazette and in a national newspaper, stating that it will examine the offers of third parties interested in obtaining a compulsory license, provided they make known their interest within 30 days. Once applications are filed, the National Industrial Property Institute shall issue a reasoned ruling granting or refusing the compulsory license. This ruling shall be appealable in accordance with the last paragraph of Article 42.*

*The decisions of the National Industrial Property Institute concerning the appropriateness of the grant and those relating to the grant or, as the case may be, the refusal of the compulsory licenses, shall be adopted within 30 days.*



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### Law

ARTICLE 45. In a health emergency or for national security purposes, the Executive arm of Government may order the exploitation of certain patents through the grant of the right to exploit conferred by a patent; the scope and duration of the exploitation shall be limited to the purpose of the grant.

### Regulation

*ARTICLE 45. The Executive arm of Government shall grant compulsory licenses based on the provisions of Article 45 of the law, with the involvement of the Ministry of the Economy And Public Works and Services, the National Industrial Property Institute and, if need be, the Ministry of Health and Social Action or the Ministry of Defense, within the ambit of the powers vested in them by the Law on Ministries.*

### Law

ARTICLE 46. Use without the authorization of the patent owner to permit the exploitation of a patent (the second patent) which cannot be exploited without infringing another patent (the first patent) shall be allowed if the following conditions are met:

- (a) the invention claimed in the second patent involves an important technical advance of considerable economic significance in relation to the invention claimed in the first patent;
- (b) the owner of the first patent is entitled to obtain a cross-license on reasonable terms to use the invention claimed in the second patent; and
- (c) the use authorized in respect of the first patent is non-assignable except with the assignment of the second patent.

### Regulation

*ARTICLE 46. Rulings of the National Industrial Property Institute by virtue Article 46 of the Law shall be liable to the remedies provided for in the final paragraph of Article 42 of this regulation.*

### Law

ARTICLE 47. Where other uses are permitted without the authorization of the patent owner, the following conditions shall apply:

- (a) Authorization of such uses shall be granted by the National Industrial Property Institute.
- (b) Authorization of such use shall be considered on its individual merits.
- (c) For the uses contemplated in Article 43 and/or Article 46, the potential user must have attempted to obtain the authorization of the rightholder



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- under commercial terms and conditions in accordance with Article 43 and these efforts must have been unsuccessful in the time-limit provided for under Article 42. In the case of public non-commercial use, where the government or contractor, without making a patent search, knows or has demonstrable grounds to know that a valid patent is used or will be used by or for the Government, the patent owner shall be promptly informed.
- (d) The authorization shall include those patents relating to the manufacturing components and processes that permit the exploitation of the patent in question.
  - (e) Such use shall be non-exclusive.
  - (f) Such use shall be non-assignable, except with that part of the enterprise or goodwill that encompasses it.
  - (g) Authorization shall be granted predominantly for the supply of the domestic market, except in the cases provided for in Articles 44 and 45.
  - (h) The rightholder shall be paid reasonable remuneration having regard to the circumstances of each case, taking into account the economic value of the authorization in accordance with the procedure set forth in Article 43. When determining the amount of the remunerations where uses were authorized in order to remedy anti-competitive practices, the need to correct said practices must be taken into account and termination of authorization may be refused if it is considered probable that the conditions which led to a license being granted are likely to recur.
  - (i) The scope and duration of the uses set out in Article 45 and for any other use not contemplated shall be limited to the purposes for which they were authorized and authorization may be withdrawn if the circumstances which gave rise to the uses cease to exist and are unlikely to recur. The National Industrial Property Institute shall be authorized to review, upon reasoned request, the continued existence of these circumstances. When the abovementioned uses are no longer valid, the legitimate interests of the persons who received authorization must be taken into account. If such uses concern semi-conductor technology, authorization shall only be for public non-commercial use or to remedy a practice determined after judicial or administrative process to be anti-competitive.

### Regulation

*ARTICLE 47. The grant of compulsory licenses shall be considered on a case-by-case basis, wherever one of the grounds for granting licenses under the law exists. Compulsory licenses shall cover patents relating to manufacturing components and processes that permit their exploitation one of the grounds for granting licenses under the law exists. Such licenses shall be granted under the conditions provided for in Article 47 of the law.*

### Law



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ARTICLE 48. In all cases, decisions relating to uses not authorized by the patent owner shall be subject to judicial review, as shall matters pertaining to the corresponding remuneration, where applicable.

ARTICLE 49. Appeals against administrative decisions relating to the grant of the uses provided for in this chapter shall not have suspensive effect.

ARTICLE 50. Any person who applies for one of the uses contained in this chapter must have sufficient financial capacity to use the patented invention efficiently and have access to premises approved by the competent authority for that purpose.

#### Regulation

*ARTICLE 50. The National Industrial Property Institute shall establish the procedure and method for the accreditation of economic and technical capacity, according to the regulations in force issued by the competent authorities, for the efficient exploitation of the patented invention, understood as the ability to supply the domestic market under reasonable commercial conditions.*

#### OTHER EXCEPTIONS AND LIMITATIONS

##### Law

ARTICLE 41. On a reasoned request from a competent authority, the National Industrial Property Institute may establish exceptions limited to the rights conferred by a patent. The exceptions must not unreasonably conflict with the normal exploitation of the patent or unreasonably prejudice the legitimate interests of the patent owner, taking into account the legitimate interests of third parties.

##### Regulation

*ARTICLE 41. The Ministry of the Economy and Public Works and Services, together with the Ministry of Health and Social Action or the Ministry of Defense, each in his own sphere, shall be empowered to entertain applications for exceptions limited to the rights conferred by a patent, under the terms and within the limits provided for in Article 41 of the law.*

#### **(iii) LAWS AND PRACTICES GOVERNING THE SCOPE OF PROFESSIONAL SECRECY IN THE CLIENT-LAWYER RELATIONSHIP AND ITS APPLICATION TO PATENT LAWYER**

Firstly, it is worth noting that Law No. 24.481 on Patents and Utility Models and subsequent amendments, consolidated and amended by Decree 260/96, provides as follows:



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ARTICLE 75. Usurpation the rights of the inventor shall be deemed to be an offence of counterfeiting punishable by imprisonment of six months three years and a fine.

ARTICLE 77. The above sentence shall be increased by one-third in the case of a person who:

- (a) was a partner, representative, advisor, employee or worker of the inventor or of his assignees and who misappropriates or discloses the as-yet unprotected invention;
- (b) obtains the disclosure of the invention through the corruption of a partner, representative, advisor, employee or worker of the inventor or of his assignees; or
- (c) violates the obligation of secrecy imposed by this law.

Likewise, it is worth noting that this issue is also addressed by Ruling No. 101/96 of the National Industrial Property Institute approving the Regulations Governing the Profession of Industrial Property Agent. This ruling is only applicable to industrial property agents and **we refer specifically here to Article 5(B) of the ANNEX of the ruling:**

The relevant parts of the Ruling state the following:

Buenos Aires, April 18, 2006

The profession of industrial property agent has always been directly linked to the services provided, by legal imperative, by the National Industrial Property Institute.

Article 33 of Decree No. 1141 of November 26, 2003 of the Executive arm of Government, amending Decree No. 558/81 regulating Law No. 22.362 on Trademarks, authorizes the National Industrial Property Institute to regulate the professional responsibilities, rights and obligations, qualification examinations and conditions of registration of the industrial property agents whose licensing it oversees.

The same aim underpinned the delimitation of the powers vested in the disciplinary body, it being understood that to remain a mere observer in the face of certain types of unethical behavior adversely affected the image of industrial property agents, a group of professionals long linked with excellence and specialization. Accordingly, a shortcoming in the relevant legislation in force was remedied.

The system of sanctions is designed to guarantee fully and absolutely the right of defense of agents, allowing related associations to participate and ensuring the



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impartiality of the judgment through the establishment of the Disciplinary Committee.

Moreover, the interests of the individual and the protection with which the Administration is duty-bound to provide to him in order successfully to safeguard his industrial property rights were the primary reason for incorporating the obligation of assistance for highly technical issues, limited to the processing of trademark applications and administrative appeals, broadening the individual's right to take legal action by providing for free representation.

For these reasons,

THE PRESIDENT OF THE NATIONAL INDUSTRIAL PROPERTY INSTITUTE

DECIDES:

#### **Article 1**

The Regulations governing the Profession of Industrial Property Agent, annexed hereto, form an integral part of this ruling and are hereby approved.

#### ANNEX

#### REGULATIONS GOVERNING THE PROFESSION OF INDUSTRIAL PROPERTY AGENT

Definition: Industrial property agents are natural persons enrolled in the Registry of Industrial Property Agents maintained by the National Institute of Industrial Property, in accordance with the provisions of these regulations.

#### ARTICLE 2. Requirements

Persons wishing to be registered as industrial property agents must meet the following requirements:

[...]

- (d) Prove the absence of a criminal record in relation to the crimes mentioned in Article 3(b) and (c) of these regulations, through certification issued by the National Registry of Repeat Offenders.

#### ARTICLE 3. Impediments

The following may not be registered as industrial property agents:





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[...]

- (b) persons convicted of breach of confidentiality under Art. 70 of Decree No. 260/96, Annex II regulating Law No. 24.481, Art.156 of the Criminal Code and Law No. 24.766, for the duration of the sentence;
- (c) persons convicted of any wrongful act against a national, provincial or municipal administration, for the duration of the sentence;
- (d) unrehabilitated bankrupts; and
- (e) any person who, for whatever reason, is legally disqualified from practicing a profession, from trade or from industry.

#### ARTICLE 4. Effects and Powers

- (a) The intervention of an industrial property agent or of an attorney shall be mandatory in the following cases: (1) challenge to legal opinions of the National Institute of Industrial Property in trademark applications, corresponding to codes 1, 2 a, b, c, d; 3a, b, c, d, e, f, g, h, i, j; 4, 5, 6, 7, 8, 9, 10, 11 and 12 mentioned in Annex 1 of Decision No. M-545/04; and (2) administrative appeals. In the cases mentioned in this paragraph, the National Institute of Industrial Property shall state in its opinion that it must be challenged with the obligatory assistance of an industrial property agent or a lawyer [...].

#### ARTICLE 5. Duties

**Industrial property agents shall at all times conduct themselves professionally in accordance with the importance of the tasks entrusted to them, being especially obliged to perform the following:**

- (a) Properly advise persons who retain their services.
- (b) Maintain confidentiality with respect to all the reserved information received in the practice of their profession, in connection with the matter entrusted to their care.
- (c) Observe due diligence in the fulfillment of the formalities under their responsibility.
- (d) Take the necessary steps to avoid prejudice to their clients in case of outstanding impediments to the fulfillment of their mandate or in case of abandonment. In such case, the client must be notified of the new development by reliable means within at least 10 days before the effective termination of their action in the case.
- (e) Conduct themselves properly at all times in regard to other colleagues, personnel of the National Institute of Industrial Property and the public in general and within the National Institute of Industrial Property, both in performing the professional tasks entrusted to them and in offering their services and in their conduct after the cessation of services.



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- (f) Represent indigent applicants free of charge, only in cases where such representation is mandatory. To this end, the National Institute of Industrial Property shall designate the industrial property agent that will deal with each case by successive numbers following the order of registration, and the designated industrial property agent selected shall be notified by reliable means. The designated industrial property agent may only be excused for duly substantiated reasons, for which purpose he must file the application to be excused within five business days of his designation, failing which he will be deemed to have accepted the charge. Failure to comply with his or her duty or to perform it with due diligence shall be grounds for application of the disciplinary sanctions provided for in Art. 7. The application for free representation shall suspend the terms of the due diligence, which shall begin to run from the acceptance of the charge by the designated industrial property agent. Persons applying for the benefit of indigence must file a duly legalized certificate of indigence issued by a judicial authority.
- (g) When, by express instructions of the owner, an industrial property agent must intervene in ongoing cases in which a colleague is authorized, he must so inform the latter in writing, except in cases of urgency, in which he may effect the notification within 5 working days of his assumption of duty.
- (h) Industrial property agents shall refrain from employing means incompatible with professional decorum, probity and dignity in order to procure clients.

#### ARTICLE 6. Prohibitions

- (a) Without prejudice to the stipulations in the substantive rules, the following are set forth as specific cases of conduct from which industrial property agents are prohibited:
- (b) Unduly retaining documentation belonging to their clients.
- (c) Representing opposing interests within the same case file in any of its instances. This prohibition also extends to industrial property agents working in the same chambers.
- (d) Submitting instruments or statements, where the submitting party inexcusably knows or should know that they are totally or partially false, in any case or action brought before the National Institute of Industrial Property.
- (e) Removing or extracting without receipt or authorization files, documents or acts submitted to the National Institute of Industrial Property.
- (f) Adulterating and/or totally or partially destroying files, documents or acts submitted to the National Institute of Industrial Property.
- (g) Intentionally withdrawing instruments or acts submitted to National Institute of Industrial Property, while being aware that there was no representation or authorization on the date of the withdrawal.
- (h) Receiving sums to pay fees to the National Institute of Industrial Property, while omitting to deposit the submissions in order to make them effective.



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- (i) Conducting publicity that may be misleading or that offers or implies solutions that are contrary to law, morality or public order.
- (j) Publicizing or offering, either by themselves or through third parties, services that fall within the purview of the National Institute of Industrial Property.

#### ARTICLE 7. Disciplinary sanctions

Failure of industrial property agents to comply with these regulations may entail the following disciplinary measures after the relevant summary proceedings and a reasoned decision:

- (a) Written warning: for those acts that involve a violation of the obligations established in Articles 5(a), 9(b), (c) (d), (e) (f) (h), and (i) and have caused damage to property.
- (b) Suspension of the registration for ninety days: this shall apply to acts that violate the prohibitions set forth in Art. 6(a), (b), (g), (h) and (i) and when, within 2 years of a final warning, a person repeats the conduct that led to the sanction.
- (c) Cancellation of the registration: this shall apply to those acts that violate the prohibitions set forth in Art. 6(c), (d) and (f) where, following a final suspension ruling, a person repeats the conduct inviting such sanction. After cancellation, a new registration may only be allowed after three years elapse following the effective application of the measure.

#### ARTICLE 8. Disciplinary process

[...] accepting all means of proof provided for in the Code of Civil and Commercial Procedure that are relevant for reaching a decision.

The President of the National Institute of Industrial Property shall form a Disciplinary Committee within five business days of being seized of the matter and shall make a ruling within 20 business days thereafter. The resolution shall be appealable as established in Article 9 of these regulations. The Disciplinary Committee shall be composed of the President of the National Institute of Industrial Property, who shall be the chair, and by two permanent members of the Advisory Council of the National Institute of Industrial Property representing different entities, as designated by the President of the National Institute of Industrial Property. The Disciplinary Committee shall adopt its decisions by a majority.

#### ARTICLE 9. Appeals

[...]

#### ARTICLE 10. Cancellation of the registration



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Cancellation shall occur in case of death, resignation, and where the reasons for incompatibility set forth in Article 3 occur. The registration shall be presumed abandoned for lack of payment of the annual fee for 3 consecutive periods, without prejudice to the ability of the National Institute of Industrial Property to initiate debt collection proceedings. In such case, and only where the prescribed time limit has elapsed, the agent's action will cease *ex officio* in all ongoing proceedings and the agent shall be personally liable for damages caused to his or her clients and/or third parties, except for the assumption of being duly empowered with the limitations of acts provided for in Art. 4(g). The annulment, cancellation and resignation of the registration shall be published for one day in the Official Gazette and in the Trademark and Patents Bulletins.

#### ARTICLE 11. Notification to Professional Associations

The final ruling that will determine the application of sanctions to professionals shall be communicated to the respective professional association in Buenos Aires and/or any other jurisdiction.

#### ARTICLE 12. Re-registration

[...]

**All conduct not provided for in the relevant specific legislation shall be governed, by the Basic Codes of the Argentine Republic, that is, the Civil Code, the Commercial Code and the Criminal Code**

#### **(iv) COLLABORATION IN THE SEARCH AND EXAMINATION OF PATENT APPLICATIONS AND REUSING THE RESULTS OF INTERNATIONAL SEARCHES AND EXAMINATIONS**

The INPI has signed Pilot Patent Prosecution Highway (PPH) Agreements with PROSUR industrial property offices, namely: Argentina, Brazil, Chile, Colombia, Ecuador, Paraguay, Peru, Uruguay and Costa Rica, which entered into force on November 7, 2016.

A PPH agreement has also been signed with the United States Patent and Trademark Office, entering into force on March 3, 2017, and the INPI is in the process of signing similar agreements with the Japan Patent Office and the European Patent Office.

Notwithstanding this, on September 12, 2016, INPI President Dr. Dámaso Alejandro Pardo issued Ruling No. P-56, which empowers the national patent administration to accept international searches for patent applications where it is proven that the same invention (equivalent patent), whether or not priority has been claimed, has been granted abroad by the office of origin or by other offices, provided that the laws governing such offices require substantive examination



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and are subject to the same standards of application of the patentability requirements applied by the Republic of Argentina.

Argentinian applications whose substantive examination has not been conducted shall be evaluated and, if applicable, granted under the following *sine qua non* conditions: (a) the scope of the claims of the application filed in the Republic of Argentina is less than or equal to that of the foreign patent; (b) there is no national antecedent to the effective date of filing in the Republic of Argentina; (c) there is no foreign antecedent between the date of filing of the equivalent patent and the effective date of submission of the Argentinian application that affects the patentability requirements stipulated in Article 4 of the Law on Patents (novelty, inventive step and industrial application); (d) the subject matter claimed in the Argentinian patent does not fall within the exclusions to patentability and what is not considered an invention under Argentinian law; (e) observations submitted by third parties shall be evaluated; and (f) the foreign office that examined the equivalent patent adheres to the same standards of application of the patentability requirements as the Republic of Argentina.

#### NATIONAL PATENT ADMINISTRATION

Dr. Eduardo Ricardo Arias  
Commissioner  
National Patent Office  
National Institute of Industrial Property  
Republic of Argentina