

COMMENTS OF THE SUPERINTENDENCY OF INDUSTRY AND COMMERCE (SIC)
Circular No. 8653 of March 16, 2017

I. National/regional laws on opposition procedures and other administrative revocation or invalidation mechanisms in Colombia.

Article 42 of Andean Community Decision No. 486 of 2000, which is the industrial property law applicable in Colombia, provides that anyone with a legitimate interest may file, only once and within a period of 60 days following the date of publication of the patent application in the Industrial Property Gazette, reasoned opposition that could undermine the patentability of the invention. The same article provides that the opponent may be granted, only once, a further period of sixty days to substantiate the opposition.

Meanwhile, article 43 of the aforementioned Decision states that, in the event of opposition, the competent national office shall notify the applicant who shall, within the next 60 days, present his/her arguments, submit supporting documents, and rewrite the claims or the description of the invention, as appropriate; and that this period may be extended once, for another 60 days, at the request of a party.

Furthermore, the Unique Circular Letter of the Superintendency of Industry and Commerce, the national industrial property office of Colombia, provides for the payment of an administrative fee for filing of oppositions within the patent application procedure.

The following regulations are attached to these comments:

	Resolutions of the Superintendency of Industry and Commerce	Subject
1	Circular No. 3719 of February 2, 2016	<ul style="list-style-type: none"> * Conversion of invention patent applications to applications for utility model certificates or vice versa * Conversion of applications for utility model certificates to industrial design applications * Division of a patent application * Joinder of patent applications
2	No. 16023 of April 4, 2016	<ul style="list-style-type: none"> * Requirements for patentability reviews conducted by other industrial property offices under article 46 of Andean Community Decision No. 486 of 2000.
3	No. 46582 of July 15, 2016	<ul style="list-style-type: none"> * Notifications and communications on matters of industrial property. * Format and presentation of documents * Registration of updated information on an applicant or holder of an industrial property right

II. Exceptions and limitations to the rights conferred by patents.

As a general comment, exceptions or limitations to patent rights should not be interpreted as flexibilities. A limitation or exception is intended to clarify a hypothetical situation which would, in principle, entail or be construed as exploitation of the patent by a person other than the holder. However, the law allows this possibility, without any need for prior authorization from the applicant.

It should be noted that Article 30 of TRIPS provides a clear mandate on exceptions, stating that they must be: (i) limited; which makes sense, because exceptions cannot be so many that they ultimately invalidate the rights conferred on the patentee or constitute an indirect way of evading patent obligations within a given territory.

Flexibility, therefore, is the legislative leeway available to each country to establish or develop the requisite exceptions, without departing from the parameters of TRIPS.

Having said that, we understand that the purpose of the rule is to define conduct in respect of which the exclusive rights conferred on the patentee are not applicable. Thus, it is possible to fulfill the social function of patents by allowing third parties to develop new technological advances from the knowledge revealed in the patented invention in order to promote technological progress.

Furthermore, research activities can also be conducted to further determine the properties of the invention, thus enhancing scientific understanding of the invention. The experimental use of patented objects may include, for example, activities developed in universities and other institutions for the purpose of obtaining knowledge and not for industrial exploitation.

Colombia believes that the legal framework governing these exceptions is adequate for the fulfilment of their intended purpose and we do not consider that amendments should be made to guarantee the right of third parties to perform non-commercial acts on objects patented for the purposes of scientific research and teaching, because that possibility is already contemplated as an exception, at least in Colombia.

III. Laws and practices in relation to the scope of professional secrecy in the client-lawyer relationship and its applicability to patent advisors

Under Article 74 of the Colombian Constitution, “professional secrecy is inviolable.” This imposes the obligation of reserve on the professional to whom a professional secret is entrusted and the effectiveness of that obligation against individuals and authorities.

The Constitutional Court has defined professional secrecy as: “reserved or confidential information to which a person becomes privy by practicing a particular profession or engaging in an activity”. Thus, professional

secrecy is both a right and an obligation of the professional, because “to be compelled to reveal what he knows will lose him the trust of his clients, his reputation and his income.”

Professional secrecy arises from a relationship of trust established between a professional and his client regarding the subject matter of their relationship. By virtue of professional secrecy, the user of a professional service transmits pieces of information that are covered by the right to privacy.

Professional secrecy is an autonomous and inviolable guarantee enshrined in Article 74 of the Constitution. It is based on respect for the right to privacy of the user of a professional service and on other guarantees that could be affected by the disclosure of the secret, such as the right to a defense or to a good name.

The Constitutional Court has established some features of professional secrecy. For example, it should be an essential aspect of professions linked to personal services. Another notable feature is that professional secrecy in Colombia is inviolable by express provision of Article 74 of the Constitution. Accordingly, the Constitutional Court has ruled as follows:

“As with the right to life, in the case of professional secrecy, the Constitution has allowed the legislature no leeway to indicate under what conditions an “inviolable” right might be legitimately violated. The inviolability attributed by the Constitution to professional secrecy means that it is not even optional for a professional bound by secrecy to reveal the secret or to refrain from doing so. He is obliged to keep it.”¹

Another feature of professional secrecy established by the Constitutional Court is that although it arises from an interpersonal relationship of trust, it is effective against third parties:

“From the foregoing, it follows that professional secrecy has been codified in keeping with the relationship between the professional and the person requesting and obtaining his services, who must necessarily make him aware of material and information to which he would not otherwise be privy. That protection has

¹ Constitutional Court Judgment No. C-264 of 1996, Presiding Judge: Eduardo Cifuentes Muñoz.

effects on people other than the persons involved in the professional relationship, that is, it is something that can be effective against third parties.”²

Finally, the Constitutional Court has further established that professional secrecy varies in scope with the profession, depending on how it impacts the right to personal and family privacy and State control over them, for example, in legal matters:

“In legal matters, the Constitutional Court has held that professional secrecy has a special scope because it may also affect the right to defense, which is why the Court has stated that the inviolability of communications is markedly noticeable in client-lawyer communications,³ so their illegal interception should be severely punished.”⁴

IV. Cooperation in the search and examination of patent applications and the re-use of international search and examination results

As a result of the increasing demand for industrial property services, evidenced by the rising volume of patent applications in all countries, the number of patent applications without examinations has increased exponentially in recent years, creating a system overload due in part to the submission of multiple applications for the same invention, so that the same patent application is often examined by patent examiners in different industrial property offices around the world.

Through its Industrial Property Office, (the Superintendency of Industry and Commerce – SIC), Colombia is implementing several mechanisms allowing it to modernize the patent examination framework to take full advantage of the legal benefits in this area.

² Constitutional Court Judgment No. T-151 of 1996, Presiding Judge: José Gregorio Hernández Galindo.

³ Constitutional Court Judgement No. T-708 of 2008, Presiding Judge: Clara Inés Vargas Hernández.

⁴ Constitutional Court Judgement No. T-708 of 2008, Presiding Judge: Clara Inés Vargas Hernández.

One of these mechanisms is cooperation with other South American industrial property offices, such as PROSUR, an alliance of twelve offices that seeks to share patent search and examination reports so as to reduce duplication of effort and processing times when examining the same patent applications in countries of the region.

Another mechanism is the Patent Prosecution Highway (PPH), which has been implemented bilaterally with the US, Spain, Japan, Korea, and the European Patent Office offices on a regional basis with member countries of PROSUR and the Pacific Alliance.

Colombia firmly believes that the cooperation process and the division of labor among various industrial property offices is one of the best ways to reduce duplication of efforts in patentability examinations so that the work already done by one office can be used by another, especially in relation to the search for prior art, the examination of patentability in light of the requirements established in the patent laws of various countries and the final decision about the right granted.