Intellectual Property - Argentina

The TRIPs Agreement and Aspects of Patent Prosecution in Argentina

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Introduction

By the time the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) was approved and Law 24,425 was passed by the Argentine Congress in 1995, Argentina was already a member of several international conventions administered by the World Intellectual Property Organization as detailed in Articles 1.3 and 2 of the TRIPs Agreement.

Regarding the Paris Convention for the Protection of Industrial Property (1967), Argentina has ratified the Lisbon Act (1958), but not the Stockholm Act (1967). However, in accordance with Article 2.1 of the TRIPs Agreement, it is mandatory for members to comply with the substantive parts of the Paris Convention.

Following adoption of the TRIPs Agreement, several changes were introduced to adapt Argentine legislation to the agreement's minimum standards (e.g., the term of patent protection and the availability of patent rights in all fields of technology).

Law 24,481

In Argentina, patents and utility models are governed by Law 24,481, as amended by Laws 24,572 and 25,859, and by Regulatory Decree 260/96.

One positive aspect of the Argentine patent regime is that unlike many other similar statutes in the world, the Constitution explicitly sets forth in Article 17 that inventors are entitled to obtain property rights on their inventions.

On the other hand, Argentina is not a member of the Patent Cooperation Treaty. Consequently, foreign patent applicants must decide within a shorter timeframe whether to file a patent application in Argentina, maintaining their foreign priority application date.

Protection Term

Article 33 of the TRIPs Agreement states that "the term of protection available shall not end before the expiration of a period of twenty years counted from the filing date". Under Article 35 of Law 24,481, patents are granted for a non-extendable term of 20 years, to be counted from the application filing date.

In many cases it is necessary to obtain patent protection during the initial years before technological advances make the invention obsolete. Regarding such need, and as a result of the increasing number of patent applications, the National Institute of Industrial Property (INPI) faces a major backlog of patent filings because the number of applications resolved by the INPI is significantly lower than the number of applications filed.

Since 2005 the INPI has adopted several measures aimed at reducing the prosecution term of patent applications in order to comply with Article 62.2 of the TRIPs Agreement. Such article states that:

"where the acquisition of an intellectual property right is subject to the right being granted or registered, Members shall ensure that the procedures for grant or registration, subject to compliance with the substantive conditions for acquisition of the
right, permit the granting or registration of the right within a reasonable period of time so as to avoid unwarranted curtailment of the protection period."

In the meantime that the patent application is not granted, the patent applicant cannot defend its rights in case of infringement. Bills have been submitted to Congress to address this lack of protection, but they have not been considered.

Novelty and Lack of Obviousness

Article 27 of the TRIPs Agreement establishes that patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application.

In 2003 the INPI approved the Patentability Guidelines, by which the examination of patent applications is conducted by INPI examiners. Such guidelines should be considered as instructions and not regulations in themselves to replace the Patent Law dispositions.

However, since interpretation of the patentability requirements of novelty and lack of obviousness may be discretionary, in certain cases such interpretation has been used to reject patent applications (usually in the pharmaceutical field) which had, for example, been previously granted in the United States or Europe.

Effective Measures

Article 50 of the TRIPs Agreement (crucial for the enforcement of the agreement) requires that judicial authorities have the authority to order prompt and effective provisional measures so as to prevent IP rights infringement.

Nevertheless, the amendment to the Patent Law by means of Law 25,859 determined that preliminary injunctions can no longer be obtained with the same speed as before.

Need for Proper Legal Advice

In view of the above situations, obtaining proper legal advice, including a strategic analysis to determine the necessary actions to be taken by patent applicants during the patent prosecution process, will avoid unnecessary delays, thus expediting and assuring the grant of the patent in order to provide the invention with the widest protection within the shortest amount of time.

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