Venezuela
What next for industrial property as Venezuela leaves the Andean Community?

On September 17 2008 the director of the Venezuelan IP agency, the *Servicio Autónomo de la Propiedad Intelectual* (SAPI), announced that as a result of Venezuela's withdrawal from the Andean Community of Nations, the applicable law for industrial property was now the Law of 1955. This announcement effectively annulled the application of the Andean Community of Nations Decision 486 regulating industrial property rights in Venezuela.

The derogation of Decision 486 has generated much controversy in Venezuela, dividing opinion across various sectors. Some commentators argue that Decision 486 does not accord with the Venezuelan government's position on industrial property rights matters. Work has now begun on a draft Industrial Property Law which, the government maintains, will respect Venezuela's international commitments in this area. However, opponents of this view argue that the SAPI announcement had no legal basis since the authority has no power to invalidate an Andean Community of Nations decision. In addition, some commentators insist that the announcement contravenes the Constitution of 1999, which states that decisions enacted by the Commission of the Andean Community must be considered as having been adopted through national legislation; their application is direct and takes precedence over national law.

In view of this situation, appeals for interpretation have been submitted to the Supreme Court of Justice in order to confirm whether Decision 486 is still in force in Venezuela. Further, an appeal regarding the Law of 1955's conflict of norms has been submitted in relation to general industrial property matters, as well as the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) and the Paris Convention. At the time of writing, no decisions have been issued on these appeals.

This chapter provides an update on the Venezuelan industrial property legal framework and explores the impact of the Law of 1955's reinstatement. It also examines the basic steps that must be taken to file a patent application at the Venezuelan Patent Office.

Types of patent

The Law of 1955 recognises the following types of patent:

- patents of inventions (letters patents);
- patents for industrial models and industrial drawings (previously, industrial designs);
- patents on improvements (including utility models);
- revalidation patents; and
- introductory patents.

Revalidation patents are granted to holders of foreign patents, provided that they make a request to file their patent in Venezuela within 12 months of the foreign patent's filing date. Introductory patents are granted to inventions, discoveries or improvements already patented in any country and which could be patented in Venezuela by third parties, provided that the invention, discovery or improvement is not in the public domain.

The patent term

The Law of 1955 establishes a patent term of between five and 10 years from the date the application is allowed for letters patents (inventions), patents on improvements and patents on drawings and on industrial models. The validity period for introductory patents is only five years. Revalidation patents will last for as long as the patent's expiration in its country of origin, as long as this term is less than 10 years. In such cases, there is no possibility of filing an extension to the term.

Patentable matter and exclusions

According to Article 14 of the Law of 1955, the following can be patented:

- any new, definite and useful product;
- any new machine or tool and any new instrument or apparatus of industrial use, or of medical, technical or scientific application;

- parts or elements of machines, mechanisms, apparatuses or accessories through which a greater saving or perfection in the products or results is obtained;
- new processes for preparing materials or goods for industrial or commercial use;
- new processes for preparing chemicals and new methods of manufacture, extraction and separation of natural substances;
- reforms, improvements or modifications introduced in already-known things;
- any new model or design of industrial use;
- any other invention or discovery suitable for industrial application; and
- any invention, improvement or industrial model or design which, having been patented abroad, has not been divulged, patented or put into execution in Venezuela.

The following are not patentable:

- beverages, foodstuffs, medicines, pharmaceutical preparations and chemical combinations, preparations and reactions;
- financial, speculative, commercial and advertising plans, combinations or systems for simple control and fiscal supervision;
- the uses of the above-mentioned products;
- new uses of substances, objects or elements that are already known;
- work-craft modalities or fabrication secrets;
- inventions unlawful to moral standards and public order;
- theoretical and speculative inventions lacking in industrial application;
- a juxtaposition of elements already patented or belonging in the public domain; and
- inventions known in Venezuela by having been divulged or advertised in printed works or media, or in any other form, and those which belong in the public domain due to their execution, sale or advertisement within the country or abroad, prior to the patent application.

The patentability of inventions is assumed for vegetable varieties, vegetable species, animal breeds, micro-organisms, biological procedures, human or animal genomes, human or animal germo-plasma, therapeutic methods, cosmetic methods and software or its logical support; taking into consideration Article 14 of the Law of 1955, which states that: "The enumeration contained in this article is merely explanatory and not restrictive since, generally, the result of the inventive effort of human ingenuity could be subject to be patented, with the exceptions established in this law."

Requirements for patentability

The requirements for patentability are not expressly defined in the Law of 1955; nevertheless, it can be deduced that an invention's novelty is relative. This precept is valid even for inventions patented abroad which have not been disclosed, executed or patented in Venezuela. In a similar way, the Law of 1955 indicates the patentability of inventions or discoveries which qualify for industrial application. Inventive activity can be inferred from a broad interpretation of Ordinal 8, Article 15 of the law, which establishes as non-patentable "the juxtaposition of already patented elements or of elements which are of public domain, unless they are put together in such a way that they cannot work independently, losing their characteristic action".

Singularity

Article 8 of the law states that any granted patent can relate to only one creation, invention or discovery. Consequently, if a patent application includes more than one invention, the applicant must divide the application. The procedure for dividing a patent application is not anticipated or provided for in the law. However, the Patent Office does process such petitions.

Assessing applications

An application is assessed after it is received by the Patent Office. During this assessment, the office checks that the requirements set out in Article 59 have been fulfilled and the following included:

- an indication of the type of protection requested;
- data relating to the applicant, inventor and agent;
- in the case of introductory patents, an indication of the number, date and origin of the foreign patent or the source of information from which such data can be taken;
- in the case of a patent application for an invention already patented in another country, a certified copy, legalised and translated into Spanish, of the letters patents from the country of origin; and
- a description of the invention, drawings (if applicable), powers of attorney and payment receipts for the corresponding taxes.

If the applicant does not comply with these requirements, the Patent Office will return the application. The applicant then has 30 working days in which to make the necessary amendments; this period

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may be extended for an additional three months at the registrar's discretion. If the corrected application complies with the legal requirements, the registrar will order its publication; if not, the application will be considered abandoned.

If priority rights are requested in accordance with the Paris Convention, the applicant must present all the documents supporting this priority within three months of the application's filing date in Venezuela. This time period is not extendible.

In the case of inventions developed from autochthonous genetic resources or from traditional knowledge, the titleholders of such inventions are not required to file copies of any official documents of access to genetic resources or of contracts for the use of the traditional knowledge alongside the patent application, as was required under Decision 486. Similarly, if the patent application claims a product or procedure in respect of a biological material, it is not necessary to accompany the description of the invention with a sample of the material.

Publication

In accordance with the Law of 1955, a notification requesting publication of the patent application in a national newspaper will be published in the *Industrial Property Bulletin*. The applicant must pay for publication in one of the two newspapers, as instructed by the SAPI, for three times in a 30-day period, with intervals of 10 days between each publication. This must take place within 60 days of notification. The publication must contain:

- the number and date of the *Industrial Property Bulletin* in which the publication is to be made;
- the number and date of the application's presentation;
- the name and domicile of the applicant(s);
- the name and nationality of the inventor(s);
- the invention's title;
- a summary of the invention; and
- a drawing or chemical structure, if applicable, most representative of the invention.

Once the three newspaper publications have taken place, the applicant must file them at the Patent Office within two months of the publication order. After this, the application will be published in the *Industrial Property Bulletin*. The Patent Office will consider the application abandoned if:

- publication of the application is not conducted in the selected newspapers;
- publication takes place outside the established periods;
- the intervals between publications are not respected; or
- publication is defective.

Opposition

Any person may file an opposition to a patent application up to 60 days after it is published in the *Industrial Property Bulletin*. If this happens, the applicant is required to appear in person and be informed of such an opposition within 15 days of its receipt. Thereafter, the applicant has a further 15 working days in which to respond to the opposition.

Assessment of patentability

Once the period during which oppositions may be made has expired, the Patent Office will assess the application's patentability. It is not necessary to request this, since all applications that overcome the publication

and opposition stages are automatically assessed.

During the patentability assessment, the examiner:

- evaluates whether the application complies with Articles 14 and 15 of the Law of 1955;
- conducts a search in relation to the state of the technique; and
- evaluates the (relative) novelty, the (industrial application) utility and the obviousness of the invention.

If the application complies with the law's requirements, the registrar will grant the patent; if not, the patent will be denied. The applicant may file an appeal for reassessment within 15 working days of publication of the resolution denying the application in the *Industrial Property Bulletin*.

Nullity or invalidity

Any third party that does not file an opposition to the patent application may still file a request before a court that a registration for an industrial invention, improvement, model or drawing be invalidated if the grant of this was unjust. Such an action must be initiated within two years of the patent being issued.

Recommendations

The Patent Office's backlog is notorious and is a result of several changes in officers, as well as the legal uncertainty brought about by the reinstatement of the Law of 1955. However, the new situation might actually help to reduce the backlog as the Law of 1955 establishes that patents are valid only from when they are officially granted, instead of from when the patent is requested (as it is currently the case).

In any case, it is likely that the application of the Law of 1955 will not last long, since a proposal for a new law has already been announced. The government has taken care to state that the new law will respect and abide by international treaties, such as TRIPS.

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