

REGISTRATION OF PATENTS IN PCT SIGNATORY LATIN AMERICAN COUNTRIES

I. THE INTERNATIONAL APPLICATION

Each international application is subject of an international search, i.e. a high level search conducted in the patent documents and related literature. The authorities responsible for the International Searching are required to possess at least the minimum PCT documentation defined in the Treaty, (patents published since 1920 by the major industrialized countries) in order to issue an international search report.

The aforementioned report allows the applicant to determine in the light the state of the art defined in the documents cited in the search report, if it is interested in continuing requesting protection for your invention in the designated States, or whether it is better for him to firstly modify it.

With the search report in hands, it is possible to request an optional international preliminary examination to confirm whether the invention seems likely to be patented.

The inventor who wants to continue the process requests for international publication. Mainly, this intends to show the public the invention, and the protection range that the patent will provide.

The International Office publishes a PCT brochure (in the filing language and English) with related technical drawings and data, usually about 18 months after the international application.

Normally, at the time of publication of the application, the International Office informs the designated offices in order to be processed in those offices, because the PCT is only a facilitative system and cost reduction at the international level, and is not concerned to grant patents, which is the exclusive competence of the national offices.

The establishment and filing of an international application causes a single set of costs (variables) in a single currency payable in the receiving office.

There are three:

1. The transmission fee (in favor of the local authority)
2. The search fee
3. The international fee



II. DOMESTIC PHASE

The domestic phase of a patent application in Latin American countries varies somewhat from country to country but the structure is similar with some peculiarities according to each national office (signatory or not to the PCT).

A. COLOMBIA

The application process starts by preparing the necessary documentation for the Colombian patent office to accept the filing of the application.

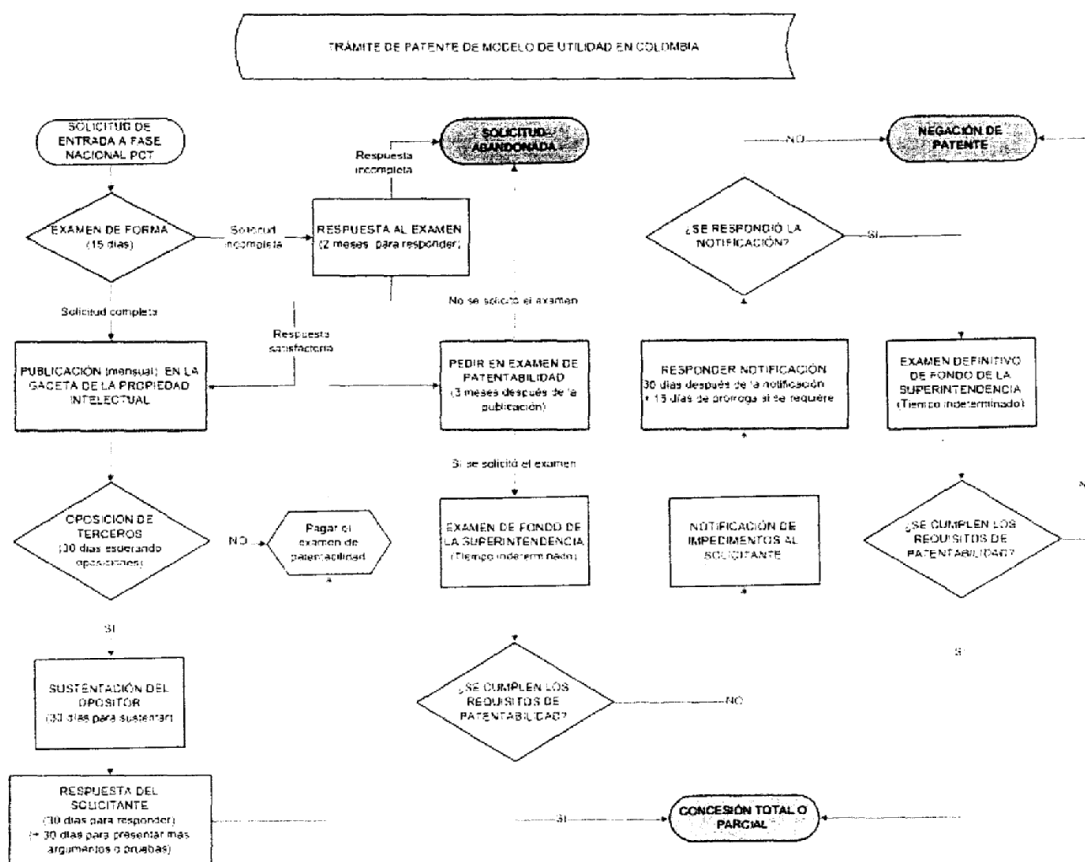
Once prepared, the national application it must be filed with the patent office of Colombia, which in turn perform a formal examination. If minimum requirements are met, then this will be published in the Journal of Intellectual Property. In case of a patent of invention and utility model, this occurs at 18 and 12 months respectively. This publication is opposable by third parties who consider that their rights are violated.

Six or three months after publication, depending on whether a patent or utility model, the examination of patentability should be requested, otherwise the application would be considered as abandoned.

After requested the substantive examination, the patentability requirements are analyzed by the Examiner and if the Technical Report is favorable, a patent can be fully or partially granted depending on the case. Otherwise failure or detected problems which prevents from obtaining the patent are notified. There is a right to reply, in the absence of this, the patent would be indefectibly refused.

When the reply of the applicant is received, the office is required to conduct a definitive thorough examination granting or denying a patent. After this ruling, there is only an appeal for review.





B. PERU

1. Deadline:

In Peru, the deadline for entering into the national phase is 30 months counted from the priority date (Articles 22 (1) and 39 (1) (a) PCT).

2. Language:

Filing language of the application must be Spanish, otherwise, it will be required to submit the translation of the application.

3. Steps:

Once the filing of the application is initiated by the interested party, then follows the requirement verification process, followed by the publication of an extract of the application in order to provide the necessary advertising thereof for opposition purposes.



After attending the oppositions that may arise (if any), the substantive examination of the application continues. This process ends with a decision of the competent national authority, in this case the Direction of Inventions and New Technologies of INDECOPI

4. Documents required:

In accordance with Articles 22 and 39 of the PCT: It is necessary to submit: An appropriate description, claims, drawings and summary. In the event that the claims have been amended, it will be necessary to submit the amended set of claims.

5. Special Requirements:

Name and address of the inventor if these were not mentioned in the international application.

Documentation proving the modification of the name of the applicant where the change occurred after the filing of the international application and it was not reflected in the notification of the International Office (PCT/IB/306).

If no declarations were filed in accordance with the provisions of Rule 4.17 of the PCT Regulations, it will be necessary to submit the statements of the applicant's entitlement to apply for the invention and claim priority.

The translation of the application must be submitted in duplicate. If necessary, the power of attorney of the agent. If so, the sequence listing in electronic format.

6. Copy of International Application:

It is required to submit a copy of the international application only if the International office has not sent a copy thereof, in accordance with the provisions of Article 20 of the Treaty.

7. Representation

Any person or legal entity domiciled in Peru (t the powers of the case must be submitted) may act as a representative .



8. Restoration of priority

The Invention management accepts applications for the restoration of priority rights, applying the due diligence criterion to determine whether or not accept the restoration.

9. Rates

Patents:

Detail	Amount
National Phase Application Filing	720.00 nuevos soles
Substantive examination	549.13nuevossoles
Further examination	488.13 nuevos soles
Changes per page	46.86 nuevos soles
Utility Model:	
Detail	Amount
National Phase Application Filing	324:00 nuevos soles
Substantive examination	279.55 nuevos soles
Further examination	235.11 nuevos soles
Changes per page	39.05 nuevos soles

C. ECUADOR

The procedure for registering a patent in Ecuador has the following steps:

- 1. FILING OF THE APPLICATION FORM FOR REGISTRATION:** Before the Ecuadorian Institute of Intellectual Property and pay the maintenance fee of the first annuity: By this step the registration process begins, documentation to be submitted consists of the request with the title of the invention, identification of the applicant and the inventor and the identification of representative or agent. It must be provided a specification, abstract, claim, drawings, copy of the patent application if it was filed abroad, and proof of payment of filing fee and the first annuity.



- 2. APPLICATION FOR REVIEW OF THE PATENT IN ECUADOR:** By this step, the Ecuadorian Institute of Intellectual Property (EIIP) conducts the examination of the positive requirements for patentability: world novelty, inventiveness and industrial applicability, all of which must be accompanied by documentary proof of payment.
- 3. ISSUANCE AND OBTAINING OF A PATENT TITLE IN ECUADOR:** Once the examination is positive and if the Ecuadorian Institute of Intellectual Property (EIIP) issues the corresponding title to the invention, which has a duration of 20 years counted from the date of application.
- 4. PAYMENT OF MAINTENANCE FEES IN ECUADOR:** During the 20-year life of the patent, the owner must make periodic payments for the maintenance in force of its rights; otherwise the expiration of the patent and loss of its rights will be declared.

DOCUMENTS NEEDED:

For the filing of a PCT patent application in Ecuador the following documents are required :

1. Copy of the International Application (containing: specification, claims, abstract, drawings and description of the drawings)
2. Copy of International Publication
3. Copy of search report
4. Copy of Preliminary Examination Report
5. Power of Attorney notarized and duly authenticated by the Consulate of Ecuador or legalized by Apostille.

The documents must be duly translated into Spanish and texts must be sent via e-mail in Word format and drawings in JPG format. Deadline for submitting the applications both in Chapter 1 and Chapter II of the PCT is 31 months.

However if the application is referred to a domestic application, it is required:



1. Specification, claims, abstract, drawings and description of the drawings.
2. Power of Attorney notarized and duly authenticated by the Consulate of Ecuador or legalized by Apostille.
3. Copy of the application filed in the country of origin of the patent.

D. CHILE

The procedure for registering a patent in Chile is as follows:

1. The submission of the Application includes:

Specification

This is a document containing a detailed, clear and complete description of what is desired to protect.

In the case of patents of invention and utility models, these must contain (Article 39 Regulation of Law No. 19.039)

- Description of the state of the art
- Description of the accompanied drawings, if any.
- Detailed description of the invention.
- Example of application where appropriate.

In the case of industrial designs and drawings, these must contain (Article 54 Regulation of Law No. 19.039)

Industrial Designs

- Introduction indicating the industrial object in question and the application of preference.
- Description of the accompanied drawings.
- Detailed description of the geometric characteristics of the design, referring to the proportions or relative dimensions, no expression of particular units, so that it is possible to reconstruct the image of the object by just reading this description.

Industrial Drawings



- Introduction indicating that it is an industrial drawing.
- Description of attached drawing.
- In the case of the layout-designs or topographies of integrated circuits, these must contain (Article 72 Regulation of Law No. 19.039)
- Introduction indicating that this is a layout design.
- Description of the attached prototype or model.

Set of claims

This is a document that contains the set of clear and concise descriptions, supported in the specification, which is designed to identify new aspects on which protection is sought.

Drawings

In the case of industrial design drawings, they must contain at least a top view, elevation, side view and perspective; other views may be required, depending on the complexity of design.

In the case of industrial drawings, it will suffice the representation on a flat reproduction of the drawing. Moreover, in these types of rights, the figures of the drawings must be numbered and presented with a photocopied duplicate (Art. 55 Regulation of Law No. 19.039).

2. Preliminary Examination

After filing the application for a patent of invention, utility model, industrial design, industrial drawing or layout-designs or topographies of integrated circuits, INAPI conducts a preliminary examination intended to verify that the documents that have been accompanied correspond to the type of application and satisfy the formal minimum requirements to continue its processing.

If there are observations the applicant must answer the observations within a term of 60 working days, making corrections, clarifications or accompanying documents, as applicable. If no answer is filed within deadline, the application will be considered as non filed. (Article 45 Law No. 19.039)

If there are no observations or they were corrected promptly, the application is accepted for processing. Then the applicant must withdraw an extract of the application in the INAPI and



require its publication in the Official Journal within a term of 60 working days counted from the date of acceptance for processing. (Article 14 of the Regulations of Law No. 19,030). For these purposes, an office of the Official Journal operates within the INAPI.

3. Publication of the Application

The applicant must remove an abstract of the application in the INAPI and require its publication in the Official Journal within 60 working days from the date of acceptance for processing (Article 4 Law No. 19.039).

For this purpose, there is an office of the Official Journal operating within the INAPI facilities.

If the application is not published within 60 days, the application will be considered as ABANDONED. To resume the processing, the applicant must apply for the restart of the application and making the publication within the period of 120 working days, counted from the date of the resolution that declared as abandoned the application. Otherwise, the application is definitely closed in a not public file.

All the backgrounds of the application will be made public on the date of publication in the Official Journal.

4. Appointment of an Expert

After Expert fee was paid, INAPI proceeds to appoint an expert, according to the technical area of the application.

The expert must accept the appointment within a 20 working day term counted from the appointment. (Article 81 of the Rules of Law No. 19.039)

On accepting the task, the expert must issue a written expert report with the technical analysis of the application within a term of 60 working days. The report shall contain a statement of compliance or non-compliance of the patentability requirements. (Article 7 of Law No. 19.039)

5. Expert Report

The expert report is a written document including a technical analysis of the application, designed to verify compliance of the patentability requirements set out in Articles 32, 56, 62 and 75 of Law No. 19039, as appropriate.

The expert must issue his report within 60 working days counted from the date he accepted the task. (Art 7 Law No. 19039).

The expert report may or may not contain observations to the application, which is notified to the applicant:

- The expert report makes observations The applicant has 60 days to respond to the observations of the expert.
- The expert report does not have observations

If there are no observations, the application will be formally reviewed and remains in a state of being accepted.

6. Final Resolution

If the application meets the patentability requirements set out in Articles 32, 56, 62 and 75 of Law No. 19039, the National Director of INAPI will issue a final decision, which grants the industrial property right, after formal review of the records.

- **Final Acceptance**

After the formal review, the National Director of INAPI dictates the resolution granting the patent of invention, utility model, industrial design, industrial drawings or layout-designs or topographies of integrated circuits.

- **Payment of fees and Accreditation**

Once the application is definitely accepted, the applicant shall require a payment order in the INAPI, to pay at any commercial bank the government fees for obtaining the patent. Later, proof of payment must be evidenced in INAPI, within a term of 60 working days



counted from the notification of the decision of final acceptance and attaching a copy of the order of acquittal duly stamped by the bank. With the accreditation of the payment, INAPI assigns the registration number of the right.

In the absence of payment and accreditation within that period, the application remains in the condition of ABANDONED.

- **Title**

Subsequently, the INAPI proceeds to the making of the record and extends on request, upon payment of corresponding value, the title that recognizes the ownership of the respective industrial property right in the name of a particular person.

Industrial property rights have territorial scope so that its protection extends only to the territory of the Republic. They also have a limited duration over the time.

- **Duration**

Applications filed until 30 November 2005

The validity of a patent is 15 years counted from the date of granting of the right. In the case of utility models and industrial designs the duration of the right is 10 years counted from the filing date of the application in INAPI. These terms are not renewable.

The titles of these industrial property rights and certificates in the case of patents of invention can be personally obtained in INAPI or online through the link under Online Services on this Site.

Applications filed as from December 1, 2005:

The validity of a patent is 20 years counted from the filing date of the application before INAPI. In the case of utility models, industrial designs, industrial drawings and layout designs or topographies of integrated circuits, the term is 10 years from the filing date of the application.



These terms are not renewable. The titles of these industrial property rights can be personally obtained or online through the link under Online Services on this Site.

