Instituto Nacional de la Propiedad Industrial

BUENOS AIRES, SEPTEMBER 12, 2016

In view of file A 253-62214/03; the Invention and Utility Model Act N° 24,481 (as amended in 1996), modified by acts 24,572 and 25,859, and its Legislative Decree N° 260 of March 20, 1996, Annex II; and INPI resolutions Nº P–263/03 and INPI Nº P–125/09; and

WHEREAS:

Technological advances require more highly specialized skills to assess the claimed matter in patent applications.

The above brings about the need to generate instruments to adjust to such changes and maintain a high quality standard in the study of patent applications.

The most effective tool is the reuse of the search results and the examination previously carried out by other patent offices.

Work allocation programs among patent offices has become an essential element to improve the patent system in many countries around the world.

Patent holders usually file trans–national–scale patent applications, which results in applications in the same family being examined in various countries.

As a consequence of the above, several offices carry out searches on their own of equal or similar patent claims, thus repeating the essential part of the work performed by another office.

This duplication of efforts and tasks is not beneficial to offices, applicants, or

society in general.

Taking advantage of the search and examination performed by other patent offices will not only improve the quality of the search task and the examination performed by the National Patent Administration but it will also shorten file processing time, by not duplicating work already performed.

All of the above does not imply neither the admission or integration of procedures being used by other patent offices nor their legal framework or regulations.

The goal is for the examiner to have a more accurate starting point available to perform the search and examination of the application, thus granting high quality patents.

The prevailing principle does not in any way disregard the State policies on the matter.

The methodology to be implement must be applied in conformance with substantial and procedural rules as established by Act Nº 24,481 (as amended in 1996), modified by Acts 24,572 and 25.859, Act N° 24,425, which approved the "TRADE–RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS AGREEMENT" (TRIPS), as well as those standards related to the compliance with principles as established by Paris Convention, Act Nº 17,011.

Such initiative is supported by law, since Section 27 of Act Nº 24,481 and subsection III a) of Section 27 of Annex II of Decree N° 260/96, grant the National Patent Administration the authority to have its examiners, when they so deem

appropriate, require a copy of the substantial examination performed by offices abroad.

Therefore, it is advisable that the National Patent Administration to acknowledge the international background searches and substantial technical examinations performed during the processing of equivalent patents granted by foreign offices as valid.

In order to do so, it shall be established that claims as filed in the domestic application must cover an identical or lesser scope than claims of an equivalent patent granted by a foreign patent office, and that such office complies with the same standards for the application of patentability requirements as those required by the Argentine Republic.

For its implementation it shall be required that precautions and qualifications be adopted, such as performing the background search for invention patents and patent applications, as well as utility models filed in the ARGENTINE REPUBLIC.

It is clear that this course of action is optional and not compulsory to the Administration, since the latter is hereby authorized to not apply the present resolution when there are sufficiently founded technical–legal or public order reasons to do so.

The National Patent Administration and the Department of Legal Affairs have been duly involved in this matter.

The present resolution is hereby issued according to the functions as

conferred by the legal framework currently in force.

Therefore,

THE PRESIDENT OF THE

NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

HEREBY ORDERS:

ARTICLE 1st.- That the National Patent Administration be authorized to consider that the requirements as set by Section 4th of Act N° 24,481 (as amended in 1996) have been duly fulfilled, as well as the International search for an invention patent application filed in conformance with Act Nº 24,481 (as amended in 1996), when it is ascertained that the priority as claimed under the provisions of Section 4 A 1 of Paris Convention has been granted abroad by the source office or by other offices, whenever the legislation ruling over such offices contemplates the performance of a substantial examination and they abide by the same application standards for patentability requirements as those established in the Argentine Republic.

ARTICLE 2nd. That the National Patent Administration be authorized to consider the requirements as set by Section 4th of Act N° 24,481 (as amended in 1996) have been duly fulfilled, as well as the International search for an invention patent application filed in conformance with Act Nº 24,481 (as amended in 1996), which has not claimed a priority under the provisions of Section 4 A 1 of Paris Convention, but when they confirm that such invention patent has been granted in a foreign country after the date of filing the Argentine application, the publication of which invention has

been issued after the filing of the national application, and that the office which has granted it has performed the substantial examination and shares the same standards for the application of patentability requirements as those applied by the Argentine Republic.

ARTICLE 3rd.- The applications the previous paragraph refers to shall be granted under the following obligatory provisos: a) That the scope of the patent claims as filed in the ARGENTINE REPUBLIC is lesser or equal to that of the foreign patent Articles 1st and 2nd of the present Resolution refer to; b) That there is no National background at the effective date of filing of the application in the ARGENTINE REPUBLIC; c) That there is no background abroad between the date the equivalent patent to which reference is made in Article 2nd of the present Resolution is filed and the effective date the application is filed in the ARGENTINE REPUBLIC, which may affect the patentability requirements required by Section 4th of Act N° 24,481 (as amended in 1996); d) That the matter being claimed in the National patent application is not comprised under Sections 5th and 7th of Act Nº 24,481 (as amended in 1996) and 6th of the Regulations (Annex II of Decree Nº 260/96); e) That the objections raised by third parties are assessed according to the provisions of Section 28 of Act Nº 24,481 (as amended in 1996) and Regulations (Annex II of Decree Nº 260/96); f) That the foreign office wherein the equivalent patent was studied contemplates the same standards for the application of patentability requirements as those of the ARGENTINE REPUBLIC for the case under study.

ARTICLE 4th. - The present Resolution shall be applicable to those invention patents

for which the substantial examination has not been started and which meet the aforementioned conditions.

ARTICLE 5th. - In the cases contemplated in Articles 1st and 2nd, prior to the performance of the substantial examination, the applicant will be able to voluntarily file a request for the application of the present Resolution to the file under study, for which they shall enclose an adjustment of the scope of the national claims to the one granted in the foreign country, together with a suitable translation. The National Patent Administration will issue a decision within SIXTY (60) days as of the filing of such request.

ARTICLE 6th. - In the cases contemplated under Articles 1st and 2nd, the National Patent Administration may require the applicant to adjust the scope of the national claims to the one as granted in the foreign country within NINETY (90) calendar days after they are notified.

ARTICLE 7th. - The National Patent Administration shall not apply the present resolution when there is technical–legal grounds for it, or when there are reasons of national defense, internal security, health emergency or other reasons of public interest.

ARTICLE 8th. - The present resolution shall be effective on October FIFTEENTH (15th) 2016. Once the present resolution becomes effective, INPI Resolutions Nos. INPI P–263/03 and INPI Nº P-125/09 will be revoked, though these resolutions shall be applied to already ongoing procedures, unless the applicant expressly requests the application of the present resolution to those files.

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ARTICLE 9th. - A model form that the applicant shall use to request the application of the present Resolution according to the provisions of Article 5th is hereby enclosed as an Annex.

ARTICLE 10th. - It is hereby ordered that this be recorded, published and that the National Department of Official Registry be notified for its publication in the Official Bulletin; once this has been done, that it be published in the Patent Bulletin; that a copy of this be disclosed in the news board and on INPI web site, after which it shall be filed.

RESOLUTION Nº P - 056