



National Group: Argentine Group
Title: Questionnaire Apotex Inc. v Sanofi-Aventis
Proposed AIPPI intervention – Supreme Court of Canada appeal
Contributors: Ignacio Sánchez Echagüe – Martín Bensadon
Date: June 9, 2014

Questions

A. Utility or industrial applicability requirement

1. Does your national law have a utility or industrial applicability requirement for patentability?

Yes.

2. Please briefly describe the utility or industrial applicability requirement, including whether it is based on:
 - (a) statute;
 - (b) jurisprudence; or
 - (c) both.

The industrial applicability requirement is based on statute. Section 4 of the Patent Law states that:

"Inventions of products or processes shall be patentable, provided they are new, involve an inventive activity, and are applicable in industry..."

e) The subject of the invention will be of application in industry when it leads to the obtaining an industrial result or product, the term "industry" being understood as embracing agriculture, forestry, cattle breeding, fishing, mining, transformation industries in the strict sense, and services."

3. What must be disclosed in the patent specification to satisfy the utility or industrial applicability requirement? In particular, must the patent specification disclose:
 - (a) the utility or industrial applicability;
 - (b) a basis (eg test data) to prove or demonstrate that the utility or industrial applicability is achieved; and/or
 - (c) a basis (eg test data) and/or a line of reasoning from which the utility or industrial applicability may be predicted?

When industrial applicability is obvious from the simple description of the invention, no

specific disclosure is necessary. When this is not the case, the specification must disclose how the invention may be used in industry.

4. Is the basis for any disclosure required in the patent specification:
 - (a) statute;
 - (b) jurisprudence; or
 - (c) both?

Statute.

B. Prosecution

5. Is it necessary to demonstrate utility or industrial applicability during prosecution?

Yes, only if it is not obvious from the description of the invention per se.

However, it should be borne in mind that the alleged use of the claimed subject matter should be properly demonstrated for support and inventiveness purposes.

6. Is the requirement to demonstrate utility or industrial application during prosecution based on:
 - (a) statute
 - (b) jurisprudence; or
 - (c) both?

Statute.

7. Is there a material date by which the utility or industrial applicability be demonstrated?

Filing or priority date.

8. What evidence is required to demonstrate utility or industrial applicability? For example:
 - (a) can post filing evidence be used; and/or
 - (b) can the applicant rely upon the utility or industrial applicability being soundly predicted as opposed to demonstrated?

Both options are acceptable depending on the particular case. However, industrial applicability must be clear from the specification as filed.

C. Litigation

9. Is lack of utility or industrial applicability a basis for a validity attack in litigation?

Yes.

10. Is such attack permitted by reason of:

- (a) statute;
- (b) jurisprudence; or
- (c) both?

Statute.

11. Is there a material date by which the utility or industrial applicability must be demonstrated?

Filing or priority date.

12. What evidence may the patentee adduce in response? For example:

- (a) can post filing evidence be used; and/or
- (b) can the patentee rely upon the utility or industrial applicability being soundly predicted as opposed to demonstrated?

The patentee may rely upon the utility or industrial applicability being soundly predicted but should not rely upon post filing evidence.