



National Group: Ukrainian National Group
Title: Questionnaire Apotex Inc. v Sanofi-Aventis
Proposed AIPPI intervention – Supreme Court of Canada appeal
Date: June 20, 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.

In Ukraine the utility or industrial applicability requirement is provided based on the statute.

According to par. 8 Art. 7 of the Law of Ukraine “On Protection of Rights to Inventions and Utility Models” an invention (utility model) shall be taken to be industrially applicable if it can be used in industry or in any other field of activity.

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?

According to Rules 6.5.1.1., 6.5.1.2., 6.5.1.3. 6.5.1.4. of the Order of the Ministry of Education and Science of Ukraine “On Approval of Rules for Consideration of an

Application for a Patent for Invention and a Patent for a Utility Model”, for establishing the industrial applicability of the invention it is checked whether:

- the application materials contain the reference to the intended purpose of the claimed subject of the invention (for new chemical formulations – the reference to its possible use);
- original application materials contain the description of means and methods using which the invention may be put into practice in the form as it is specified in any of the claims. If the application materials do not contain such information, it is allowed that such means and methods referred to in the application were described in the sources of information which became open to public by the priority date of the invention.

Apart from that, in case of putting into practice of the invention according to any of the claims, it is checked whether the intended purpose indicated by the applicant may actually be put into practice.

In case if all the above-mentioned requirements are met as of the date of the priority date of the invention, the invention specified in the independent claim shall be considered to meet the requirements of industrial applicability.

If at least one of the above-mentioned requirements is not met, it shall be found that the invention does not meet the requirement of industrial applicability. An applicant shall be forwarded the preliminary decision on refusal in grant of a patent with a motivated grounding and an offer to provide his response with regard to this grounding, and, if necessary, an offer to provide amended claims of the invention. The request or preliminary refusal may contain specific suggestions as to the amending the claims of the invention.

If it is established that the invention does not meet the requirement of industrial applicability, no further examination for compatibility with the other patentability requirements is carried out.

4. Is the basis for any disclosure required in the patent specification:

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

(a)

B. Prosecution

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

YES

6. Is the requirement to demonstrate utility or industrial application during prosecution based on:

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

(a)

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

Yes. It is required that industrial applicability was demonstrated as of the priority date of the application.

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 (a) and (b) are applicable.

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?

(a)

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

Yes. It is required that industrial applicability was demonstrated as of the priority date of the application.

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?

Both (a) and (b) are applicable. Actually, all the evidence which do not go beyond the application materials, may be adduced. Practice shows that there were no cases in which patent would be challenged based on industrial applicability.