I. Current law and practice

1. Does your current law contain any statutory provisions which specifically apply only to CII?

No

Please Explain

No. Uruguayan Patent Law No. 17.164 of September 2, 1999 ("the Patent Law") does not contain specific provisions which apply only to CII.

2. Please briefly describe the general patentability requirements in the written statute based law of your jurisdiction which are specifically relevant for the examination of the patentability of CII.

General patentability requirements are contained in articles 8 to 15 of the Patent Law. The general requirements of novelty, inventive step and industrial application are required in order for new products or processes to be patentable (articles 8 and 9 of the Patent Law). http://www.wipo.int/edocs/lexdocs/laws/en/uy/uy002en.pdf

Exclusions from patentability are contained in articles 13 to 15 of the Patent Law. Under article 13, the following shall not be considered inventions for the purposes of the Patent Law:

(a) discoveries, scientific theories and mathematical methods; (b) plants and animals, with the exception of microorganisms and essentially biological processes for the production of plants or animals, except for non-biological or microbiological processes; (c) schemes, plans, rules for playing games, business, accounting, financial, educational, publicity, lottery or taxation principles or methods; (d) literary or artistic works, or any other aesthetic creation, as well as scientific works; (e) computer programs considered in isolation; (f) various methods of reproducing information; (g) biological or genetic material existing in nature.

The reference to computer programs made in paragraph (e) of article 13 is the only reference to computers made throughout the Patent Law.
Under the case law or judicial or administrative practice in your jurisdiction, are there rules which specifically apply only to CII? If yes, please explain.

No

Please Explain

No. The Uruguayan Patent Office ("Uruguayan PTO") has not issued specific guidelines or rules to apply only to CII, nor are we aware of case law or judicial or administrative practice applying solely to CII.

Please briefly describe the general patentability requirements under the case law or judicial or administrative practice of your jurisdiction which are specifically relevant for the examination of the patentability of CII.

The rules of Chapter I Patentability, articles 8 to 15 of the Patent Law are specifically relevant for examination of the patentability of CII.

Under administrative practice in Uruguay by the Uruguayan Patent Office, in several cases, the Examiners have objected CII as constituting a case of business method patents, which would fall under the per se exclusion to patentability of Article 13, paragraph c) of the Patent Law: (c) schemes, plans, rules for playing games, business, accounting, financial, educational, publicity, lottery or taxation principles or methods.

For example, the PTO has not uniformly applied its criteria. In a case related to the obtention of cash from ATM’s without need of a banking card, via an SMS payment order, the Examiners have objected the application on the grounds that it would constitute a business method. However, in a case involving a method to make payments without cash and a system to implement said method, also with use of cellular phones, the Examiners did not object the per se patentability of said invention.

Exclusion of non-patentable subject matter per se.

Do the statutory provisions, case law or judicial or administrative practice (hereinafter collectively referred to as Law / Practice) in your jurisdiction exclude any particular subject matter relating to CII from patentability per se?

In this context, “per se” means that the non-patentable subject matter is identified without any implicit or explicit examination of the contribution to the state of the art the claimed CII makes.

If yes, please answer questions 5.b-5.e, if no, please go to question 6.a

No

Please Explain

No. There are no “per se” exclusions of patentable subject matter relating to CII.

Please describe the subject matter excluded from patentability per se and explain in detail how it is identified in practice.

If there is any subject matter identified in a patent claim relating to CII that is excluded from patentability per se, is it possible to overcome a rejection of the patent claim by adding other subject matter to the claim?

If yes, please answer questions 5.d-5.e, if no, please go to question 6.a
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<tr>
<th>Question</th>
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<tr>
<td>5. Does the “other subject matter” need to have a certain quality, e.g. does it need to be inventive?</td>
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<td>6. Can you describe the areas of human endeavour the “other subject matter” needs to relate to?</td>
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<td>7. Requirement of a contribution in a field of technology. Does the examination of the patentability of CII in your jurisdiction implicitly or explicitly involve an examination of the contribution the claimed CII makes to the state of the art (such examination may be part of a general “patentability” test or part of the novelty and inventive step/non-obviousness test)? If yes, please answer questions 6.b-6.d, if no, please go to question 7</td>
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<td>8. Does the examination of the patentability of CII in your jurisdiction implicitly or explicitly involve excluding contributions from areas of human endeavour which are not deemed to be sources of patentable inventions? In other words, does patentability of CII implicitly or explicitly require a contribution from areas of human endeavour which are deemed to be sources of patentable inventions (e.g. engineering, natural sciences)? If yes, please explain.</td>
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<td>9. Does this test also implicitly or explicitly require that the relevant contribution the CII makes to the state of the art qualifies as inventive/non-obvious? This additional test may be integrated into the general inventive step / non-obviousness examination, or may be a stand-alone test. If yes, please explain.</td>
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<td>10. Is there an implicit or explicit consensus in your jurisdiction as to the areas of human endeavour which are accepted as sources of patentable CII? If yes, are these areas of human endeavour defined, and if so how?</td>
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<td>11. Does the Law / Practice in your jurisdiction contain any specific claim drafting or other formal requirements which are applicable to CII, i.e. which deviate from the Law / Practice applicable to inventions which are not CII? If yes, please explain.</td>
<td>No</td>
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<td>12. Please Explain</td>
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<td>13. Does the Law / Practice in your jurisdiction contain any specific requirements as to sufficiency of disclosure and/or enablement which are applicable to CII, i.e. which deviate from the Law / Practice applicable to inventions which are not CII?</td>
<td>No</td>
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<td>14. Please Explain</td>
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<td>15. Do courts and administrative bodies in your jurisdiction apply the Law / Practice for patentability of CII in your jurisdiction in a harmonized way? If not, please explain.</td>
<td>Yes</td>
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<td>16. Please Explain</td>
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Uruguayan PTO generally applies the Law and Practice for Patentability of inventions in a relatively harmonized way. Nevertheless, as noted above, there are no specific written guidelines specifically addressing patentability of CII, and therefore, the decisions issued by the PTO in regard to CII do not show uniform criteria.

As to Courts, we are not aware of the issue of patentability of CII having been subject to a court ruling as yet in our jurisdiction.

II. Policy considerations and proposals for improvements of your current Law/Practice

10. Is the current Law/Practice in your jurisdiction regarding the patentability of CII considered by users of the patent system and practitioners to be understandable and workable? If not, please explain.

No

Please Explain

As mentioned above, there are no specific written guidelines regarding patentability of CII. In order to ensure a clear understanding of the criteria applied by the Uruguayan PTO in regard to CII, it would be desirable that the Uruguayan PTO issue such set of guidelines.

11. Does the current Law/Practice in your jurisdiction regarding patentability of CII provide appropriate outcomes, in particular from an economic perspective? If not, please explain.

No

Please Explain

There are not enough cases regarding CII to allow to establish whether the current Law/practice provides and appropriate outcome to patentability of CII.

12. In your jurisdiction, is copyright protection of CII regarded as sufficient from an economic standpoint? Please state why in either case.

Yes

Please Explain

Copyright protection has been the traditional avenue in Uruguay for protection of computer software, under the Berne Convention, and under the Copyright Law. From an economic standpoint, we are not aware of complaints having been raised at the industry level for lack of sufficient protection under the patent system for CII.

13. Alternatively, is there an explicit or implicit consensus that patent protection of CII is required to ensure sufficient reward on investments made into the development of CII? If yes, please explain.

No

Please Explain

See above.
In your jurisdiction, is there an implicit or explicit consensus that availability of patent protection should be limited to contributions from certain areas of human endeavour, excluding contributions from all other areas of human endeavour, no matter how advanced these contributions?

No

Please Explain

See above.

III. Proposals for harmonisation

Do you consider that harmonisation regarding patentability of CII is desirable?

Yes

Please Explain

It would be desirable to achieve harmonization in this area, as to its scope, boundaries and standards. However, as already mentioned, there is no relevant case law or detailed analysis of this issue either at the High Administrative Court or at the civil Courts level, and there is still room in this matter to be clarified. Scholars have also not specifically addressed in depth this issue as regards current Uruguayan law. For this reason, we consider that harmonization efforts and discussion should be considered once the matter is clarified first at the above mentioned levels in our jurisdiction, on how the current statute and standards should be interpreted and applied.

Exclusion of non-patentable subject matter per se.

Should there be any exclusion from patentability per se of subject matter relating to CII?

If yes, please answer questions 16.b-16.e, if no, please go to question 17.a

Please describe the subject matter that should be excluded from patentability per se and explain in detail how it should be identified in practice.

If there is subject matter identified in a patent claim related to CII you consider should be excluded from patentability per se, should it possible to overcome a rejection of the patent claim by adding other subject matter to the claim?

If yes, please answer questions 16.d-16.e, if no, please go to question 17.a

Should such “other subject matter” be required to have a certain quality, e.g. should it need to be inventive? Please state why in either case.
If yes to question 16.d above, please describe the areas of human endeavour to which such “other subject matter” should relate.

Requirement of a contribution in a field of technology.
Should the examination of subject matter eligibility of CII involve an examination of the contribution the claimed CII makes to the state of the art? If not, please explain.

If yes, please answer questions 17.b-17.e, if no, please go to question 18

Should such examination be made under a test specific to CII, or should it be part of the usual novelty and inventive step/non-obviousness test? Please state why in either case.

Under this test, should patentability of CII require a contribution from areas of human endeavour which are deemed to be sources of patentable inventions (e.g. engineering, natural sciences)? In other words, should contributions from areas of human endeavour which are not deemed to be sources of patentable inventions be disregarded? If not, please explain.

If yes, please answer questions 17.d-17.e, if no, please go to question 18

Should this test also require that the relevant contribution the CII makes to the state of the art qualifies as inventive/non-obvious? This additional test may be integrated into the general inventive step / non-obviousness examination, or may be a stand-alone test. Please state why in either case.

Should there be a non-exhaustive list of areas of human endeavour which are accepted as sources of patentable CII, taking into account the ultimate purpose of patent law (protecting unforeseen, non-obvious subject matter)? If yes, please provide such a list. If not, why?

Should there be any specific claim drafting or other formal requirements which are applicable to CII, i.e. which deviate from the rules or practice applicable to inventions which are not CII? Please explain why in either case.

Should there be any specific requirements as to sufficiency of disclosure and/or enablement which are applicable to CII, i.e. which deviate from the rules or practice applicable to inventions which are not CII? Please explain why in either case.

Please comment on any additional issues concerning patent protection of CII your Group considers relevant to this Study Question.

Please indicate which industry sector views are included in part “III. Proposals of harmonization” on this form:

Please enter the name of your nominee for Study Committee representative for this Question (see Rule 12.8, Regulations of AIPPI). Study Committee leadership is chosen from amongst the nominated Study Committee representatives. Thus, persons not nominated as a Study Committee representative cannot be in the Study Committee leadership.