Questions

General

Groups are asked to give a summary of the legal position as regards a patent for a purported selection invention in their jurisdiction in relation to the following:

Q1 Legal developments on selection inventions

What specific types of inventions are recognized under the concept of selection invention and are patentable in your jurisdiction? Do you have any examples of selection inventions in a field other than chemical, pharmaceutical or material science fields?

There are no specific provisions as to Selection invention in the Patent Act and its regulations. In the Guidelines for Examination, Part C, Annex I, paragraph 3.2. Guidelines for evaluating inventive steps, two types of non-obvious selections are disclosed and exemplified: 1) the invention involves the selection of particular operating conditions for a process, achieving unexpected results 2) the invention involves the selection of certain specific compounds within a known broad group having unexpected advantages.

Examples of selection may exist for mechanical inventions. A given dimension in mechanical devices is susceptible of improvement and a reduced range for a defined dimensional parameter may be selected from a broader range. We do not have any examples apart from the chemical, pharmaceutical or material science fields.

In theory, any product or process that is defined by a range, comprising such range an extensive list of values, can be considered as susceptible of improvement by a selection invention.

Q2 Novelty

Groups are asked to discuss any issues that should be considered with respect to the novelty of selection inventions. For example, is merely carving a range out of a broad prior art disclosure sufficient to make a selection invention novel? Is a different advantage or use, or the same advantage with an unpredictable improvement required for a selection invention to be novel?
Neither different advantage/use nor the same advantage with an unpredictable improvement is required for a selection invention to be novel. Novelty is generally acknowledged if the selected invention has not been specifically disclosed in the prior art.

Q3 Inventive step or non-obviousness

Groups are asked to discuss the inventive step or non-obviousness requirements in their jurisdiction. If experimental data is used to back up the inventive step or non-obviousness requirement can it be submitted after initial patent filing? Are there any prerequisites or limitations on the late submission of data?

There is and should be no difference in how inventive step is analyzed between selection inventions and ordinary inventions. The focus of the evaluation is on whether a person of ordinary skill in the art would have arrived at the same result with no inventive activity.

The inventive character of the invention has to be disclosed at the filing date. However, the Patent Act allows filing corrections and new examples within 90 days as from the filing date provided no new matter is added. New experimental data, supporting the inventive step of the invention, can be submitted after the 90-day period provided no new matter is added, but said new information will be kept separately from the final text of the granted patent.

Q4 Sufficiency and/or written description requirements

Groups are asked to discuss the sufficiency or written description requirements in their jurisdiction. There may be several aspects to this question: (1) the threshold for sufficiency; (2) the allowable timing for submission of experimental data; (3) the time frame within which sufficiency or written description requirements must be satisfied; and (4) the breadth of claim scope that can be supported by a limited number of examples of asserted or proven advantages. With respect to item (1), please discuss to what extent all members of the class selected by the patentee are required to possess the requisite advantage in your jurisdiction. Is there an absolute requirement that all of the selected class possess the relevant advantage, or is the patentee excused if one or two examples fall short? Also, with respect to item (4) above, if a new utility is asserted as a selection invention, would it suffice to claim a particular range or selection of components which have been found to be associated with such a new utility or would it be necessary to recite such a new utility in the claims?

(1) The threshold of sufficiency

In Argentina, an invention shall be disclosed in a clear and complete way so as to allow a person having ordinary skill in the art to carry it out.

The written description must allow a person having ordinary skill in the art to perform the invention.

Generally, a claim will be considered supported by the written description unless there are grounded reasons to consider that a person having ordinary skill in the art will not be able to apply the teaching of the specification to the whole claimed subject matter. (Guidelines. Part C. Chapter III, paragraph 6.3).
As an example, if an application is related to a rubber composition comprising several ingredients and the applicant tries to introduce as further information that a new ingredient can be added thereto, then such amendment should be rejected under Art. 19 of the Patent Act. Similarly, if an application addressed to a device ‘mounted on elastic support members’ does not include any specific disclosure of said elastic members, the applicant would be barred from adding further information pointing out that the elastic members consist, or could consist, of helicoidal springs. (Guidelines, Part C, Chapter VI, paragraph 4.5.3).

Nevertheless, if the Applicant can demonstrate that, within the frame of the invention, the introduction of such new matter will be considered by a person of ordinary skill in the art as an obvious clarification, said amendment could be allowed. (Guidelines, Part C, Chapter VI, paragraph 4.5.4).

The Guidelines also provide several tests for the patent examiners to determine the broadening of scope due to the addition of new matter.

(2) The allowable timing for submission of experimental data

It is possible to submit corrections or adding new examples, without broadening the original scope or adding new matter, within 90 days from the filing date. However, adding experimental data is allowed at any time during prosecution provided it does not add new matter. Nevertheless, said new information will not be included in the final text of the application.

(3) The time frame within which sufficiency or written description requirements must be satisfied

The sufficiency or written description requirement must be satisfied at the filing date.

(4) The breadth of claim scope that can be supported by a limited number of examples of asserted or proven advantages

The breadth of the claims can be supported by a limited number of examples provided a person having ordinary skill in the art assumes that the example would be representative of the claimed subject matter. A person of ordinary skill in the art should not have to perform undue experimentation or inventive effort to arrive at embodiments not disclosed in specific examples but within the scope of the claims.

If a new utility is asserted as a selection invention, then, it should be specifically claimed.

Q5 Infringement

If a certain advantage or superior results were the reasons for the grant of a patent on a selection invention, does such advantage or superior result have to be implicitly or explicitly utilised by a third party for an infringement to be established?

A case of infringement will be established if the infringement performs the claimed subject matter either implicitly or explicitly.
If a selection invention is claimed as a new use, what are the requirements to establish infringement? Would a manufacturer of a product that may be used for the new use infringe the patent? Does the intention of an alleged infringer play any role in the determination of infringement?

If a selection invention is claimed as a new use, the infringer should perform the claimed subject matter.

The intention of the alleged infringer does not play any role in determining infringement.

Q6 Policy

Groups are asked to give a short commentary as to the policy that lies behind the law on selection inventions in their jurisdictions, and then to consider whether or not such policy considerations are still valid today as technology continues to advance.

The Patent Act and the Executive Order (regulating decree) do not regulate selection inventions. We consider that it would be advisable to have express provisions on selection inventions.

The need of clearness and certainty on provisions for selection inventions are more important in new fields of technology, for example nanotechnology. In this case, developments are heavily based on selection inventions that claim a sub-range in size or composition of an equivalent but broader known range and a further problem comes from the infringement perspective. The question to answer is whether the user of a nanotechnological invention can be considered infringer of a prior patent claiming wider ranges; even when at the moment of the filing of the prior patent the nanotechnological invention was unknown and unforeseeable.

This issue may have serious consequences for users and manufacturers of nanotechnology, as the universe to check for non-infringement purposes would not only consist of patents in the field of nanotechnological inventions, but also any other kind of patents with scope broad enough to cover a wide range of sizes or compositions. For example, in performing a freedom to operate analysis, third parties would need to take into account patents specifically relevant to the field of the invention and also other patents that even if they were not filed with the intention to cover nanotechnological invention, may cover part or the totality of the technology under assessment. For example, the use of nanoparticles of SiC as reinforcement in metals may infringe a patent protecting the use of SiC as filler in general—with particles in the range of cero to microsizes— even when the use of these nanoparticles confers exceptional properties to the composite not anticipated by the first applicant.

With Reference to the Examples

Q7 Novelty

In example 1 would the prior disclosure of the compounds containing the generic class of radicals anticipate any claim to a specific compound having a particular radical, or group of specific compounds having a selection of particular radicals in your jurisdiction? In the analysis, does it matter how wide the prior disclosed generic class of compounds is – i.e. would the analysis be different if the prior disclosed generic class consisted of 1,000,000 possible compounds (very few of which were specifically disclosed) as opposed to merely, say, 10?
A general disclosure does not invalidate novelty of a particular concept. In respect to the novelty requirement, there are no differences if the prior disclosure includes a large or small group of possible compounds.

**Q8 Inventive step or non-obviousness**

In example 2 would any of the three possibilities constitute an inventive step over the prior art in your jurisdiction? Further, if, say, scenario (iii) does constitute an inventive step over the prior art, what scope of protection should the inventor be able to obtain? Should the inventor be able to obtain protection for the products *per se* (that happen to have this advantageous property), or should any patent protection available be limited to the use of the products for the advantageous property (as an adhesive) not possessed by, and not obvious over the prior art?

The cases described in (i) and (ii) would not constitute an inventive step over the prior art. On the other hand, the case described in (iii) would constitute an inventive step, which could allow protecting the product *per se*.

**Q9 Sufficiency and/or written description requirements**

To what extent are all members of the class selected by the patentee required to possess the requisite advantage in your jurisdiction? Is there an absolute requirement that all of the selected class possess the relevant advantage, or is the patentee excused if one or two examples fall short?

All members of the class selected by the patentee should possess the advantage. A representative number of examples is required. The number may vary according to the technology field or to the chemical structure of the selected compounds.

**Q10 Infringement**

By reference to example 3 to what extent is evidence of the knowledge of the advantageous property of the selection, or intention of the infringer as to its supply, required to find infringement in your jurisdiction?

Knowledge of the advantageous property of the selection or intention of the infringer is not required to find infringement.

**Q11 Policy**

Groups are asked to consider, in respect of example 1 / 2, whether it matters how much effort the inventor has invested in arriving at his selection in order to found a valid selection patent. The answer to this question is closely related to the policy considerations that underpin the grant of selection patents and the incentive / reward equation involved. The inventor may have expended considerable time and money in trawling through the whole host of possible compounds encompassed by the prior disclosed generic class, and the particular selection that he has made may constitute a leap-forward in the field. Surely the inventor should be rewarded for his efforts and obtain protection? On the other hand, it could be argued that such considerations may have been relevant in an age when the inventor’s efforts actually involved many man-years of careful and painstaking laboratory work, but are now increasingly irrelevant in an age of combinatorial synthesis when large varieties of different compounds can be manufactured in a fraction of the time. Are such considerations relevant?
A great **technical** effort may matter when deciding about compliance with the inventive step requirement.

**Harmonisation**

Q12 Groups are asked to analyse what should be the harmonised standards for the patentability of selection inventions. In particular, the items discussed in Q1-Q6 and the examples discussed in Q7-Q10 above should be referred to.

Q13 Groups are also asked to recommend any issues for harmonisation not referred to in Q11 above.

Q13 Groups are asked to outline any other potential issues that merit discussion within AIPPI as regards selection inventions.

**Summary**

Argentina’s patent law does not specifically provide for the patentability of selection inventions. However, when providing the standards for evaluating inventive step, the Argentine Patent Office’s Guidelines expressly disclose and exemplify two types of non-obvious selection inventions. Novelty of selection inventions is generally accepted if the selected invention has not been specifically disclosed in the prior art, and the inventive step requirement is fulfilled if the creative process or its results cannot be inferred from the state of the art in a way which is evident for a person having ordinary skill in the art. The inventive character of the invention has to be disclosed at the filing date. A selection patent will be considered infringed if the infringer performs the claimed subject matter either implicitly or explicitly, regardless of the knowledge of the advantageous property of the selection or intention by the infringer. The Group considers that the Patent Law should include express provisions on selection inventions.

**Résumé**

La loi des brevets d'inventions argentine ne prévoit pas la possibilité de breveter les inventions de sélection (selection inventions) de manière spécifique. Néanmoins, quand il s'agit de fournir les standards pour évaluer l'activité inventive, le Registre des Brevets mentionne deux types d'inventions de sélection non évidentes. La nouveauté des brevets de sélection est généralement accepté quand l'invention de sélection na pas été révélé de manière spécifique dans l'art préalable (prior art), et les conditions de l'activité inventive sont remplies quand ni le processus créatif ni ses résultats peuvent être déduits par une personne qualifié. Le caractère inventif de l'invention doit être révélé à la date de présentation du dossier. La performance de la matière objet de revendication –de manière implicite ou explicite- sera considéré comme une infraction au brevet de sélection, sans tenir compte de la connaissance par l'infacteur de sa propriété avantageuse ni de son intention. Le Group considère que la Loi des brevets devrait inclure des dispositions spécifiques sur les inventions de sélection.

**Zusammenfassung**

Im Argentinischen Patentrecht wird nicht deutlich vorausgesehen dass eine Selektionserfindung ein Patent bekommen darf. Aber, die Standards in den Patentamt beschrieben Leitsatz zu erklären wie die Erfindungshöhe studiert soll, ausdrücklich erfassen und beschreiben als Beispiel zwei Typen nicht offensichtliche Erfindungen.

Note:
It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and use the questions and numbers for each answer.