

Chile

Questions

Groups are invited to answer the following questions under their national laws:

I. Analysis of current law and case law

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

Principal sources of Industrial Property Law:

- I. Political Constitution of the Republic of Chile (Codified law promulgated by Supreme Decree No. 100).
- II. Industrial Property Law N° 19.039.
- III. Decree No. 236 of 2005 fixing the Regulations of the Law No. 19.039.
- IV. Patent Guidelines. 2013.
- V. International Treaties, such as The Paris Convention (effective in Chile as of September 1991), Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement, since 1995), among others.

Industrial Property matters in Chile are governed mainly by the provisions of Law 19.039, dated September 30, 1991 (last amendment was effected by Law 20.569, dated February 6, 2012, which corresponds to the adjustment of Chilean norms to those found in the Trademark Law Treaty) and by Decree No. 236 of 2005, that establish regulations pertaining the existence, scope and exercise of industrial property rights. These rights include trademarks, patents of invention and its publication, utility models, industrial designs and drawings, layout-designs or topography of integrated circuits, geographical indications and appellations of origin as well as other titles for protection the Law may establish. Likewise, this Law determines the conducts that are considered unfair conducts in the field of protection of non-disclosed information.

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

No, publication of patent applications does not occur automatically in our

jurisdiction. After the CLPTO performs its preliminary examination, the applicant must request and pay for the publication of the application in the Official Journal, within a period of 60 working days counted as of the resolution of acceptance to proceeding.

If the publication is not made within such period, the application shall be considered abandoned. To restart the processing, the applicant must request to reopen the file and make the publication within 120 working days, from the date of the resolution stating that the application is abandoned. Otherwise, the application is shelved definitely in an archive which is not public.

The Official Journal publishes extract of applications for industrial property rights in a special supplement of Trademarks and Patents only on Fridays.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

No it doesn't affect the timing of the publication.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

No, according to our patent procedure the applicant can withdraw its application in any time before the request for the publication, or simply take a decision not to publish the application.

5. What parts of a pending patent application are published?

The extract shall be published indicating the application number, name of the applicant, and an explanatory extract with the content of the right whose protection is requested.

The explanatory extract shall be developed by the applicant and included in a "Technical Sheet" which must be submitted with the patent application.

6. Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

As we previously mentioned, all the antecedents of the application in Chile will be made public as of the date of publication in the Official Journal.

As a consequence of the above, in general terms, the applicant is entitled to request damage indemnity for acts that would have constituted an infringement, based on the awareness that the infringer has of the published patent application; either for the publication itself; and/or any other antecedent as a cease and desist letter; agreement of confidentiality or NDA (which have not been observed), use the expression "patent pending", among others.

Accordingly, a person is liable to pay damage indemnity to a patent owner, for acts that would have constituted an infringement, from the date of publication and/ or, from any other date (as is described in the above paragraph), depending on the submitted evidence and circumstances of the case.

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

Response of Question 6 shall apply, when applicable, to the present query.

Well, besides, a type of interim protection could be the “E documents”. Indeed, according to the international Categorization of Patent Documents “E document” corresponds to an earlier patent document (Rule 33.1.c) but published on, or after the filing date.

These documents (that could be unpublished) are only valid to object novelty of an examined application in Chile, if for any reason the priority of this last application is lost.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

As we explain before, when the application is accepted to proceeding, it will be obligatory a publication of an extract of the same in the Official Gazette, (which must be requested and paid by the applicant) in the form and terms determined in the Special Regulations complementary to the Law.

Accordingly, requesting an early “preliminary examination” may be a reasonable manner for attempting to publish earlier.

In referenced to patent filings in Chile, our Law and regulations do not state a term to publish a patent application. Accordingly, in the process of applying for patent protection under the Paris Convention (direct filing) CLPTO does not necessarily publish the application after the expiration of 18 months from the priority date; indeed the publication date will depend on multiples factors, as the date of the preliminary examination issuance, the date of the publication request and payment, among others.

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

No, it is no possible.

10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

No, the applicant in Chile must request and pay for the publication, accordingly, a lapsed, abandoned or withdrawn patent application cannot be published

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

The statutory applicable and criterion of the CLPTO in reference to a divisional application is exactly the same as is described in the response of question 2.

Notwithstanding the above, in case of divisional patents, is a frequent practice requesting an early “preliminary examination”, to attempt to publish earlier, for understandable reasons.

II. Policy considerations and proposals for improvements to your current system

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

We believe that automatic publication could constitute damage to the applicant, therefore, the patentee should be always given the opportunity to analyze whether to withdraw the application or file non-publication request, for a determined period of time.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

Yes, we believe that it should be legally available for the patentee to request and obtain the early publication of the application. This, based on the fact that the background of the patentee in connection to the invention subject of prosecution could be positively affected by said early publication.

In this sense, the patentee can gain some credibility in the market and investors may gain confidence based on a published application, since evidences the intention of protecting the invention.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

Such option should be available for the patentee; however, we believe that it should not be mandatory. This, because the purpose of an early publication can be achieved with the first application or priority. In addition, different applications might contain different subject matter, which the patentee may not want to disclose early.

15. Should there be a right for the patentee to withdraw the application before publication?

Yes.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

a. with respect to the patentee's own subsequent patent applications

The patentee, if needed, should have the right of secrecy if the withdrawal is filed before the publication. This, given that the mere application before a determined Office should not imply the entry of the invention into the prior art, being possible for the patentee to re-examine the invention and proceed with a new filing.

b. with respect to third party patent applications:

There should not be any consequences, for the application never got to be published.

17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

Not necessarily an assessment on the validity, but it could grant a preliminary opinion on patentability, which is a faculty of the applicant. Now, we believe it should not be an obligation for the Patent Office, but a faculty of the patentee to request a preliminary assessment or opinion.

18. In light of your answers to the previous policy questions, what would be appropriate time limits for:

- a. the patent office to provide the results of its initial assessment? **6 months**;
b. the applicant to decide whether to withdraw the application? **Before the request of publication**; and
c. the application to be published? **18 months**.

19. Should there be any exceptions to automatic publication and if so what on

what grounds, for example: **Yes, but only by initiative of the patentee and of the governmental agencies in case of compulsory licenses.**

- a. on the initiative of the patentee;
- b. on the initiative of the patent office; or
- c. on the initiative of third parties (such as other governmental agencies)?

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?

The patentee.

21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

In connection exclusively to divisional applications, which are regulated in Chile, there should not be differences on the appliance of rules for publication, given that the purpose of divisional applications is to provide the patentee to file a new application in case the original or “mother” application does not comply with the unity requirement. In that sense, the patentee files a new application, with its own particularities.

However, we believe that the patentee should have the right to request immediate publication in case of a divisional application.

22. What proposals would you make to improve your current system?

We believe the current system in Chile, where the burden of publication of the application relies on the patentee, can be subject of a modification introducing the right to request an early publication, in light of the necessities of the applicant.

As mentioned above, we believe that, in case of a divisional application, the patentee should have the right to request its immediate publication in order to accelerate the procedure.

III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

Certainly. Patent Offices could at least issue a preliminary search report before publication that would allow applicants to withdraw their applications in case they decide to protect their idea as a trade secret or make further improvements to make it patentable. Additionally, it should reduce the workload in our patent prosecution system by taking out from the examiners' review (i.e. saving time and resources) applications that have no expectations of success.

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

An exception to publication would speed up the prosecution of a patent application since any oppositions or invalidations would have to occur after the granting of the patent and not during the prosecution itself. We agree on the possibility of having exceptions to publication (e.g., applicants opt out) provided that our legislation is adapted to:

- (i) not allowing the applicant to exercise any "patent pending" rights or actions,
- (ii) nor allowing the recovery of damages caused before the granting of the patent application; and
- (iii) Increase the time period for seeking the invalidation of the granted patent (e.g. during the lifetime of the patent)

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?

These exceptional circumstances should be broadly defined but subject to a case-by-case analysis. Under such scenario, applicant should have the burden to provide evidence in order to support a petition to the Office to delay or suppress a publication.

26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?

Under our current system, which allows third party oppositions during

prosecution, extended periods for publications may increase pendency times. For that reason, a 3 to 6 months period for publication may seem more reasonable than 18 months. The latter considering that in our country patents usually take between 3 to 5 years from filing to issuance/rejection.

27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

The publication of the patent application should be of the complete application (including drawings) and not only an abstract (that sometimes is vague as to what the invention really is).