Questionnaire March 2006

Q180 – Content and relevance of industrial applicability and/or utility as requirements for patentability

Answer of the Polish Group

Questions

1) When taking into account all the patentability requirements applied in your country, can you quote examples of patentable inventions for which not the least practical use can be expected?

For example, what about:
- a chemical compound without any expected use?
- nucleotide or aminoacid sequences without any expected use?
- perpetual motion machines?

According to the art. 24 of the Polish Industrial Property Law (30 June, 2004) patents shall be granted regardless of the field of technology for any inventions which are new, involve inventive step and which are susceptible of industrial application. Consequently, any invention for which its industrial application has not been explicitly indicated will be rejected.

In the case of:
- chemical compounds - their industrial applications must be indicated;
- DNA sequences - a mere DNA sequence without indication of its function is not a patentable invention. To be regarded patentable, the industrial application of sequence or partial sequence must be disclosed in the patent application as filed. In the cases where a sequence or partial sequence of gene is used, in order to comply with the industrial application requirement, it
is necessary to produce a protein or part of protein, to specify which protein or part of protein is produced or what function it performs.

- in case of mechanical inventions, industrial application of the invention must be disclosed in the specification; perpetual motion machines are not considered under art. 28.4 of the Polish Industrial Property Law as patentable invention, as patents are not granted on solutions the incapability of exploitation of which may be proved under the generally accepted and recognized principles of science.

2) **In any event, does your Group consider that inventions without any practical use should be patentable? Why?**

In our opinion granting patents on inventions without any practical use is not advisable as it might lead to blocking in future the possibilities of obtaining protection for other inventions with their use indicated and supported by real embodiments.

3) **If your Group considers that inventions without any practical use should not be patentable, should the required use be ascertained at the filing or priority date? Or should it be sufficient that such use is either reasonably expected or only potential?**

We do not consider to present a reasonably expected or potential use as sufficient

4) **Still if your Group considers that inventions without any practical use should not be patentable, should the required use be explicitly described in the patent specification?**

Yes

Or should an explicit description of said practical use be required only when it is necessary for the skilled person? In other words, is it sufficient that the practical use is expected by the skilled person in light of the specification?
No - the situation where the description of said use would be required only when necessary for the skilled person might lead to ambiguities and possible enlargements of the expected use during the life of the patent.

5) Regarding the words defining the required use, does your Group have better terms to suggest than the terms “specific” (i.e. particular to the claimed subject-matter), “substantial” (i.e. conferring a real-world value to the claimed subject-matter) and “credible”, that are classically used in some of the countries applying the utility requirement?

No

If so, please provide a list of candidates.

6) Does your Group feel it essential to refer to a field of use, such as “industry” within the meaning of the Paris Convention?

It seems to be not essential

7) Does your Group feel that the concept of “practical use” needs to be further defined? If so, would your Group agree with a definition providing that an invention has a practical use if it can be implemented in order to produce an effective result? Does your Group have another proposal?

Further defining of “practical use” in our opinion is not required.

We propose, however, to complete the proposed definition with the statement “…an effective and repeatable results…”

8) Does your Group think it necessary to develop a new criterion (namely a criterion different from the two existing criteria of industrial applicability and utility) or does it consider it possible to refer to the existing utility requirement, with or without additional limits?
Essentially no; perhaps it may be necessary in case of new scientific developments that may be not envisaged at present.

9) **Would the adoption of a third harmonized criterion based on a use requirement would seriously conflict with the existing patent law? In particular, would it imply to amend other domestic provisions than those relating to the current requirement of industrial application or utility? If so, which amendment(s) seem(s) necessary? (As an example, the adoption of a third harmonized criterion may lead some countries to adopt separate provisions for the purpose of excluding the patentability of therapeutical methods).**

It depends on the kind of such third criterion. For example, if the use requirement criterion were adopted for pharmaceuticals, the exclusion of patentability of the therapeutical methods would have to be specified by further provisions. According to the present Polish Industrial Property Law some ambiguities might arise regarding the scope of protection if such a criterion were adopted.