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

Answer of the Spanish Group

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?

   No.

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

   No. Patents are an exception to the principle of free competition insofar as they are considered an efficient instrument for the technical and technological progress of the industry (in a wide sense), and, consequently, of the society.

   From the above mentioned point of view, the protection as a patent of inventions merely refers to abstract concepts (such as ideas, theories and laws of nature not *per se* applicable); inventions contrary to the laws of nature; inventions that cannot be reproduced, etc. would not be justified as they would not contribute to the progress of the industry and the society.

   If an invention does not provide an improvement of what already exists (state of the art) it does not deserve any reward (should not be patentable). Inventions with no practical use are not improvements; why should we reward the inventor?
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?

Maybe, but it would be necessary to analyze it case by case. For example, it may be patentable if it is known that it would be useful when the technical problem, which, at the present moment, makes the invention unfeasible, would be solved; in such case, it would be a patent which will depend from the one that would solve this problem.

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?

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?

It must be clearly explained the use for which the invention has been made. It must be taken into account that a patent for an invention of a new use would be possible; thus, the first use must be clearly shown.

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?

If so, please provide a list of candidates.

No.

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

Yes.
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?

Our group considers that the concept of "practical use" requires a more complete definition, specially in order to exclude the patentability of inventions that cannot be reproduced or that do not materialise in a corporeal result.

It is not enough that the invention has a practical use, the description should always explain how it could be put into practice; otherwise, mere ideas could be patented.

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?

Our group is in favour of maintaining the traditional content of the industrial applicability's criterion.

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).

Yes. Other examples of domestic provisions that would require amendment:

- The rule that software is not patentable.

- The rule that business methods cannot be patented.

- The rule that scientific theories, mathematical methods, scientific works, ways of presentation of information, etc., are not patentable.