

# Materia Patentable a la luz de las principales oficinas del mundo

Tertulia Académica – Casa Externadista

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# Agenda

- Principales oficinas de PI
- ¿Qué tipos de reivindicación contempla cada oficina de PI?
- Consideraciones para la novedad en cada oficina de PI
- Ejemplos



# ¿Cuáles son las principales?



Oficina Europea de Patentes (EPO)



Oficina Japonesa de Patentes (JPO)



Oficina de Propiedad Intelectual de Korea (KIPO)



Oficina Estatal de Propiedad Intelectual de la República Popular de China (SIPO)



**uspto.gov**

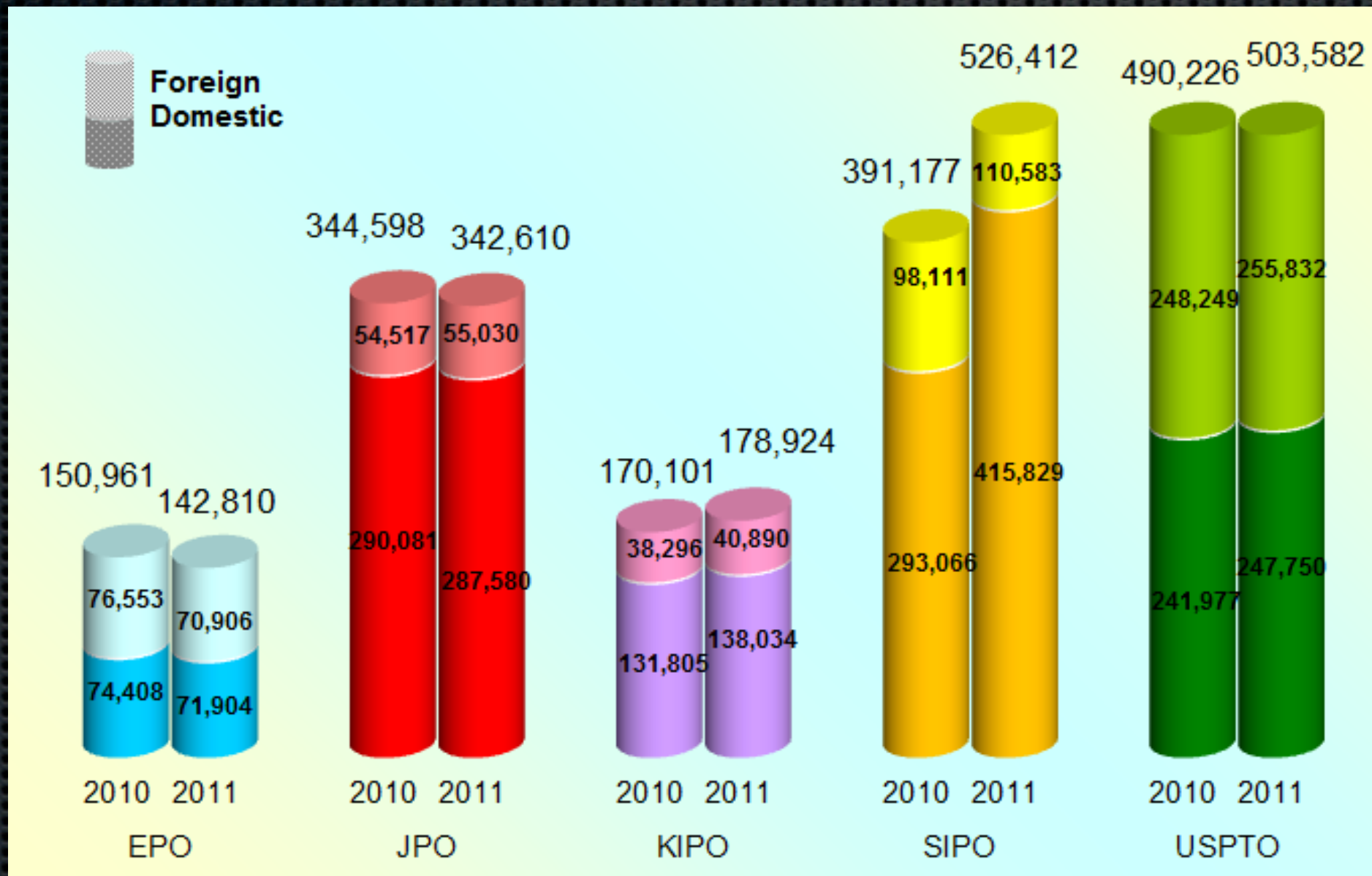
The United States Patent and Trademark Office  
an agency of the Department of Commerce

Oficina de Marcas y Patentes de Estados Unidos (USPTO)



# ¿Porqué son las principales?

Número de solicitudes presentadas en las principales oficinas

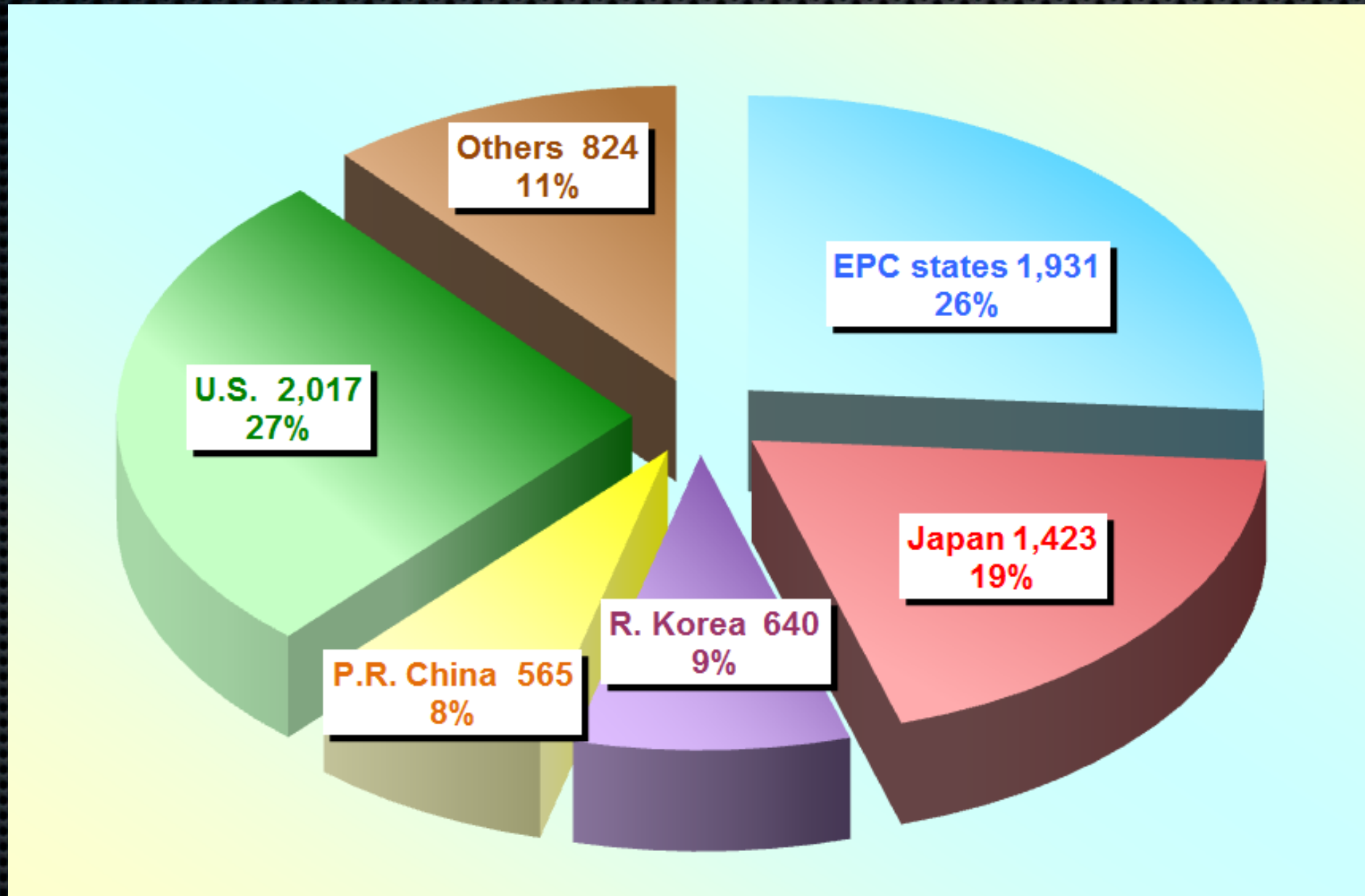


Información tomada del informe: "IP5 Statistics Report 2011". Disponible en: <http://www.fiveipoffices.org/>



# ¿Porqué son las principales?

Patentes vigentes a nivel mundial en 2010 (en miles)





# ¿Materia patentable?

- Invenciones relacionadas con biotecnología
- Usos de productos o procesos
- Software e invenciones implementadas por ordenador
- Métodos de tratamiento



# ¿Es patentable?

“Use of a strain of *Lactobacillus* for the manufacture of a medicament for reduction of the fibrinogen level in blood in mammals including man.”

“Use of oxytocin in order to stimulate plant growth.”



# Agenda

- Principales oficinas de PI
- Disposiciones que contempla cada oficina de PI
- Consideraciones para la novedad en cada oficina de PI
- Ejemplos



# EPO (REGLA 43(2) EPC)

(2).....a European patent application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter of the application involves one of the following:

(a) a plurality of interrelated products,

(b) different uses of a product or apparatus,

(c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.



# EPO

## Aspectos Generales – Reivindicaciones de Uso

“El uso de un transistor en un circuito amplificador”

“Un proceso de amplificación utilizando un circuito que contiene un transistor”

Misma  
interpretación

Interpretación

Errónea

“Un circuito de amplificación que incluye un transistor”

“Un proceso para la fabricación de un circuito de amplificación que contiene un transistor”



# JPO (GUIAS, Parte 1, Capítulo 1, 2.2.2.3 (3))

“Use” is interpreted as a term meaning a method for using things which is categorized into “a process.” (E.g. “Use of substance X as an insecticide” is interpreted as “method for using substance X as an insecticide.” Also, “Use of substance X for the manufacture of a medicament for therapeutic application Y” is interpreted as “method for using substance X for the manufacture of a medicament for therapeutic application Y.”



# KIPO (GUIAS, Parte 3, Capítulo 2, 4.1.2 (2))

4.1.2(2) The claim which includes an expression specifying a product by its use

“Where a claim includes an expression specifying a product by its use, the examiner should interpret the claimed invention **only as a product** especially suitable for the use disclosed in the claim, by taking into account the detailed descriptions in the specification and drawings, and the common general technical knowledge at the time of the filing.”



# SIPO (Guías, Parte 2, Cap. 2, Sección 3.2.2)

“A use claim belongs to the category of process claim.”

However, the examiner shall pay attention to distinguishing a use claim from a product claim from the wording thereof.

For example, a claim in such a form as “using compound X as an insecticide” or “the use of compound X as an insecticide” is a use claim, and belongs to process claim, while a claim in such a form as “an insecticide made of compound X” or “an insecticide containing compound X” is not a use claim but a product claim.”



# SIPO (Guías, Parte 2, Cap. 2, Sección 3.2.2)

“An application relating to the medical use of a substance shall not be granted if its claim is drafted in the wording “use of substance X for the treatment of diseases”, “use of substance X for diagnosis of diseases” or “use of substance X as a medicament”, because such claim is one for “method for the diagnosis or for the treatment of diseases” as referred to in Article 25.1(3)”



# SIPO (Guías, Parte 2, Cap. 2, Sección 3.2.2)

“The above-mentioned use claim in the form of method for manufacturing a medicament may be drafted as “use of compound X for manufacturing a medicament for the treatment of disease Y” or the like. ”



# SIPO (Guías, Parte 2, Cap. 2, Sección 3.2.2)

## Productos Químicos

“.... A known product does not destroy the novelty of its new use if the new use per se is an invention. This is because such use invention is an invention of method of application, and the substance of the invention lies in how to apply the product rather than the product per se. For example, said product X is originally used as a detergent. Then, someone discovers from research that it can be used as a plasticizer after adding to it certain additives. Then its preparation, the kind of additives selected and the proportion etc., are the technical features of the method of application.”



# USPTO (35 U.S.C. 101, 112)

“Use claims” are generally regarded (1) as indefinite because such claims merely recite a use without any active, positive steps delimiting how this use is actually practiced, and/or (2) as not falling into any of the statutory categories of subject matter eligible for patent protection because the claimed recitation of a use, without setting forth any steps involved in the process. See MPEP 2173.05(q).”



# USPTO (35 U.S.C. 102)

“The discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using. In re Hack, 114 USPQ 161, 163 (CCPA 1957). However, when the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated.”



# ¿Es patentable?

## Caso 1

WO 2002

“Use of at least one substance with oxytocin activity in order to stimulate plant growth.”



# ¿Es patentable?

## Caso 1 – Examen en la Oficina Europea

- No hay evidencia de la actividad para todos los compuestos descritos por la reivindicación
- El solicitante debe restringir el alcance de las reivindicaciones a lo incluido en la descripción.



# ¿Es patentable?

WO 2002 “Use of at least one substance with oxytocin activity in order to stimulate plant growth.”



EP 2004 “Use of oxytocin in order to stimulate plant growth.”





# ¿Es patentable?

## Caso 2

WO 1998

“Use of a strain of *Lactobacillus* for the manufacture of a medicament for reduction of the fibrinogen level in blood in mammals including man.”



# ¿Es patentable?

## Caso 2 – Examen en la Oficina Europea

- El estado del arte revela el uso médico de lactobacilos para reducir los niveles séricos de colesterol.
- Un nuevo efecto bioquímico de los lactobacilos no es necesariamente materia patentable.
- Ya es conocido el uso de lactobacilos para el tratamiento de condiciones cardíacas, por lo tanto no es posible una reivindicación de primer uso médico.



# ¿Es patentable?

WO 1998

“Use of a strain of Lactobacillus for the manufacture of a medicament for reduction of the fibrinogen level in blood in mammals including man.”



EP 2006

“Use of a strain of Lactobacillus for the manufacture of a medicament for the prophylaxis and/or treatment of circulatory diseases, wherein the patients suffer from an elevated fibrinogen level but not an elevated cholesterol level.”





# ¿Es patentable?

WO 1998

“Use of a strain of Lactobacillus for the manufacture of a medicament for reduction of the fibrinogen level in blood in mammals including man.”



US 2001

“A method of reducing the level of fibrinogen in the blood of a mammal, comprising administering to a mammal in need of reduced fibrinogen levels an effective amount of a strain of Lactobacillus. .”





# Bibliografía Principal

FiveIP Offices Official Reports

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Disponible en:

<http://www.epo.org/law-practice/legal-texts/html/guidelines/e/index.htm>

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Patent and Trademark Office (USPTO)

Disponible en:

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# Gracias

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