Kluwer Patent Blog

Are we facing a change in the patent protection of inventions in the phytosanitary sector in Bolivia?

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Bolivia's industrial property law, Decision No. 486 of the Andean Community, contains an article that defines what cannot be patented. This article 20 b) is currently the subject of controversy due to Bolivian Patent Office's interpretation thereof.

Article 20 b) establishes that not patentable are:

(b) inventions the commercial exploitation of which in the member country concerned has necessarily to be prohibited in order to protect the health or life of persons or animals, or to preserve plants or the environment. To that end the commercial exploitation of an invention shall not be considered contrary to the health or life of persons or animals or liable to prejudice the conservation of plants or the environment solely on account of the existence of a legal or administrative provision that prohibits or regulates such exploitation

Decision No. 486 of the Andean Community is the common industrial property law for Bolivia, Colombia, Peru and Ecuador. However, limitations on the grant of certain patent applications in the phytosanitary sector based on Article 20 b) are only found in Bolivia.

The Bolivian Patent Office (SENAPI) applies article 20 b) in such a strict way that applications from the same family that are granted in Colombia, Peru and Ecuador, are rejected in Bolivia based on article 20 b). For example, patent applications that contain claims to a composition comprising active ingredients like *abamectin, picoxystrobin, sulfentrazone, tebuconazole, bifentrine, acetamiprid*, to cite just a few examples, are systematically objected under article 20 b) only in Bolivia. The SENAPI considers that such active ingredients are dangerous and inventions that contain them should not be subject to patent protection to preserve the health of people, animals or the environment.

The Bolivian Patent Office substantiates this rejection by resorting to publications from organizations of recognized scientific prestige such as the *Food and Agriculture Organization of the United Nations/World Health Organization (FAO/WHO)*, or the *International Pesticide Action Network (PAN).*

There are several arguments to be made against these article 20 b) based rejections.

Firstly, the regulations of the Andean Community expressly mentions that the existence of laws that regulate the exploitation of substances that could be harmful does not constitute an automatic

inclusion in the prohibition of patentability. Claims of applications that the patent office objected to for non-compliance with article 20 b) curiously involve active substances that are permitted by the competent authority, the National Agricultural Health and Food Safety Service (SENASAG), and marketed in Bolivia, for example all of the above mentioned.

It can be argued that it is not up to the Bolivian Patent Office to oppose the grant of patents in these cases based on article 20 b), but rather it is the responsibility of SENASAG to prohibit, or regulate, the use of phytosanitary substances.

Also, none of the countries of the Andean Community have made the same objection based on Article 20 b), despite sharing the industrial property law, while it is desirable that the criterions of the Andean Community are uniformly interpreted. This argument has not been accepted by Bolivian examiners, on the basis that they literally have no obligation to accept decisions from other Patent offices.

Likewise, the Patent Office has systematically been requested to request a prejudicial interpretation from the Court of Justice of the Andean Community (TJCA) as a last resort. Article 32 of the Treaty of Creation of the Court of Justice of the Andean Community, as well as Article 121 of its Statute, establish that it is up to the Court to interpret through preliminary rulings the rules that make up the community legal system in order to ensure its uniform application in the territory of the member countries.

The Office is not obliged to carry out such a request during the processing of an application, or after a rejection during the Revocation and Hierarchical Appeals. Referring the query to the TJCA is mandatory when a request is definitively rejected in the case of a Contentious Administrative Claim before the Supreme Court of Justice. As far as we are aware of a prejudicial interpretation request to the TJCA has not been raised.

First patent grants

Recently, the first favourable decisions and the first grants of patents have been received that were initially objected under the aforementioned article 20 b).

In this sense, the response to one of the Revocation Appeals has been positive: the Revocation Appeal has been admitted, sending the application back to the examination division, considering that the Patent Office had not responded in a well-founded manner to the assertions against the application of article 20 b). A new communication from the examination division in this case is pending.

Likewise, in the case of another patent application that was refused, a Revocation Appeal was filed and dismissed. After subsequently filing a Hierarchical Appeal against said negative administrative resolution, the corresponding higher authority has indicated that since there are Bolivian regulations that regulate the application of toxic substances, raising a prejudicial interpretation request to the TJCA on the application of the article 20 is not appropriate. Further, said higher authority has indicated that the regulations expressly mention that the existence of laws that regulate the exploitation of substances that could be harmful does not constitute an automatic inclusion in the prohibition of patentability.

Although these decisions are not binding for future patent applications, there is hope for changing the practice of the Bolivian Patent Office in line with international practice.

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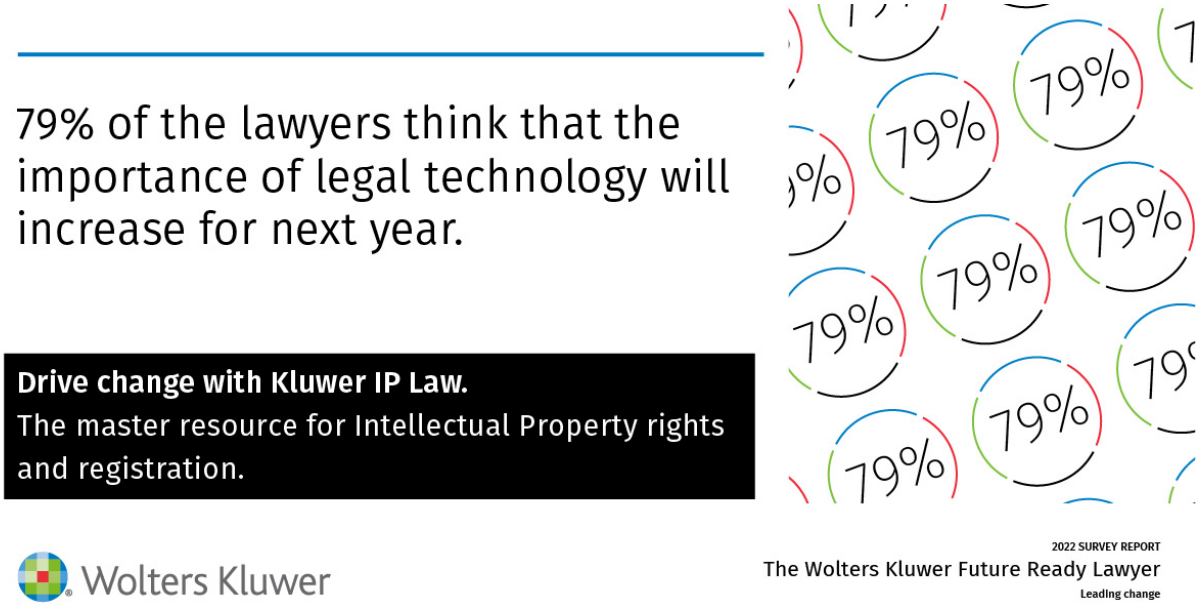

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