



# ICLG

The International Comparative Legal Guide to:

## Patents 2015

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# Chile

Beuchat, Barros & Pfenninger

Andrés Melossi



## 1 Patent Enforcement

### 1.1 How and before what tribunals can a patent be enforced against an infringer?

According to the Chilean System, the enforcement of a patent is through judicial procedure before civil or criminal judges.

### 1.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

In Chile there are no pre-trial procedural stages or discovery.

### 1.3 Can a defence of patent invalidity be raised and if so how?

No, in Chile it is not possible to file an invalidation action as a defence. The invalidation action procedure has to be carried out as a separate trial before the Chilean Trademark and Patent Office and not before civil or criminal judges.

### 1.4 How is the case on each side set out pre-trial? Is any technical evidence produced and if so how?

The Chilean System does not provide a pre-trial procedural stage. Regarding the technical evidence, this has to be filed during the probationary stage of a civil action enforcement procedure or during the investigation stage of a criminal procedure.

### 1.5 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

Arguments are filed in writing and evidence is filed during the probationary stage in a civil case and during the investigation stage in a criminal case.

The general rule is that no changes are allowed in pleaded arguments. In exceptional circumstances parties can file evidence regarding previously unknown facts and this justifies new allegations.

### 1.6 How long does the trial generally last and how long is it before a judgment is made available?

Civil trials take around two years for the first instance hearing. For criminal cases, the timescales vary depending on the amount of

time that the judge gives to the prosecutor in order to complete the investigation.

The second instance hearing can take two years for civil cases and one year for criminal cases.

### 1.7 Are there specialist judges or hearing officers and if so do they have a technical background?

No, judges have a general background in law so it is common to file and produce technical reports in order to support the allegations.

### 1.8 What interest must a party have to bring (i) infringement (ii) revocation and (iii) declaratory proceedings?

- i) The patentee and licensee (unless there is a provision in the licence agreement that states otherwise) are entitled to prosecute a suit against a third party infringement.
- ii) Any party that may have interest in the revocation of the patent.
- iii) Cease and desist letters provide the required legal standing as evidence to prove the bad faith of the offender.

### 1.9 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, this can be obtained by special request as a pre-judicial measure or during the probationary stage.

In criminal trials, this measure can be requested by the prosecutor during the investigation stage.

### 1.10 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of but not all of the infringing product or process?

According to civil law, liability is extended to any person who may have made an illegitimate profit and for criminal cases, liability is extended to any person who is guilty of aiding and abetting.

### 1.11 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

According to the Chilean Patent Law the holder of the patent can impede any commercial act (such as the importation of products) if

the process for producing these goods is patented in Chile. Therefore, importation of a product infringing a granted Chilean process patent when the process is carried abroad can be liable for patent infringement in Chile.

### 1.12 Does the scope of protection of a patent claim extend to non-literal equivalents?

This matter is debatable because the Chilean Patent Law does not make a direct and explicit reference to the doctrine of equivalents. However, it is not possible to consider that the Chilean Law only punishes the literal infringement of a patent since the right of a patent holder extends to the manufacture, selling or marketing “in any way” of the patented product. In addition, the Chilean Regulation defines what we must understand by Technical Equivalent which gives to the interpreter of the law and regulations a general criteria about what can be considered within a certain patent scope.

### 1.13 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

In addition to novelty and inventive step, the Chilean System requires industrial application. So the lack of industrial application is grounds for invalidity of a patent.

Additionally, there are two other grounds for invalidity of a patent:

- when examiner reports issued during the patent procedure were substantially wrong; or
- when the patent holder is not the inventor or legitimate assignee.

### 1.14 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

Yes, they are, but this depends on a formal ruling issued by the judge who is handling the criminal infringement case. With regard to civil cases, the procedure might be stayed while an annulment procedure is pending before the Chilean Patent Office but this is theoretical since there is no provision in the General Civil Procedure Law that entitles the judges to take *ex officio* such a suspension in the trial. However, this suspension can be ruled if a party specifically requests it.

### 1.15 What other grounds of defence can be raised in addition to non-infringement or invalidity?

There are no grounds other than non-infringement and invalidity.

### 1.16 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Yes, IP law provides for the possibility of requesting preliminary and final injunctions.

Both preliminary and final injunctions are requested in writing and, in the case of preliminary injunctions, a bond will be fixed if it is ruled without prior notification to the defending party.

Preliminary and final injunctions are available if the party meets both of the following requirements: *Fumus boni iuris*; and *periculum in mora*.

### 1.17 On what basis are damages or an account of profits estimated?

IP law contemplates a claim for damages and lost profit in a civil

law action (whether this civil action is filed directly or as a consequence of a criminal case).

The indemnification is calculated by the plaintiff, according to the following criteria:

- a) The lost profits directly suffered by the plaintiff as a consequence of the infringement.
- b) The profits effectively earned by the offender as a direct consequence of the infringement.
- c) The commercial price of a licence that the offender should have paid to the patent holder in a licence agreement.

### 1.18 What other form of relief can be obtained for patent infringement?

Procedural costs and attorneys’ fees can be recovered in a civil claim for damages and lost profits.

### 1.19 Are declarations available and if so can they address (i) non-infringement and/or (ii) claim coverage over a technical standard or hypothetical activity?

In general terms, the Chilean System provides the right to obtain formal judicial declarations in terms of deciding whether or not any behaviour or private act is lawful or unlawful, as well as when the applicant seeks the recognition of a specific legal status.

The legal tool for this is recognised in the Civil Procedure Law and is called the “voluntary procedure” (*procedimiento voluntario*). This procedure is non-contentious but it can become contentious if the right or declaration requested may affect the rights of others.

It is difficult to foresee if this procedure (as a non-contentious matter) can be successfully used in patent matters because the judge can order any eventual interested patent owner to be notified of the request, so the procedure may easily become contentious.

### 1.20 After what period is a claim for patent infringement time-barred?

According to the Chilean System, there is a five-year prescription term for filing a civil action for infringement acts performed during the validity term of a patent. It is a matter of debate as to whether or not it is possible to obtain indemnification for infringement acts carried out during the period the patent is pending.

### 1.21 Is there a right of appeal from a first instance judgment and if so is it a right to contest all aspects of the judgment?

Yes, any important decision adopted by the Chilean Patent Office can be appealed before the *Tribunal de Propiedad Industrial*.

### 1.22 What are the typical costs of proceedings to first instance judgment on (i) infringement and (ii) validity; how much of such costs are recoverable from the losing party?

Costs of proceedings (either for infringement or for validity actions) are not significant, as long as the evidence is available.

For infringement actions, costs of proceedings are calculated and assessed by the judge at the end of the trial, and it is only possible to recover costs from the losing party if ordered by the judge in the final ruling.

For validity actions, it is not common practice that the Chilean Patent Office condemns the losing party.

- 1.23 For countries within the European Union: What steps are being taken in your country towards ratification, implementation and participation in the Unitary Patent Regulation (EU Regulation No. 1257/2012) and the Agreement on a Unified Patent Court? For countries outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your country?**

Chile is not part of any international treaty or agreement that provides any kind of recognition of judgments arrangements relating to patents.

According to the general civil law (article 245 Civil Procedural Code), judgments arrangements adopted in civil and commercial matters by foreign courts can be recognised as long as these judgments: a) do not contain any provision against any Chilean Law; b) are not opposed to the Chilean Jurisdiction; c) have been duly served on the person against whom the actions are filed; and d) have no pending appeals against the same action in the country of origin.

## 2 Patent Amendment

- 2.1 Can a patent be amended *ex parte* after grant and if so how?**

Yes, as long as the amendment does not involve an amplification of the scope of protection and/or a change in the technical solution proposed at the moment when the patent application was filed.

- 2.2 Can a patent be amended in *inter partes* revocation proceedings?**

No, any change to the patent can be applied for and carried out through an independent proceeding and not in an *inter partes* revocation proceeding.

- 2.3 Are there any constraints upon the amendments that may be made?**

The amendments are only restricted to correct form errors and to limit the scope of the claims.

## 3 Licensing

- 3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?**

No, the content of the licences is left to the will of the contracting parties, except in the case of a non-voluntary licence.

- 3.2 Can a patent be the subject of a compulsory licence and if so how are the terms settled and how common is this type of licence?**

Yes a patent can be the subject of a compulsory licence. There are standard terms for these kinds of contracts and the licence price, as well as the term of extension, which is set by the authority who orders the granting of the non-voluntary licence. The licence price must keep the general market conditions of a voluntary equivalent licence.

## 4 Patent Term Extension

- 4.1 Can the term of a patent be extended and if so (i) on what grounds and (ii) for how long?**

According to the Chilean System, a patent term can be extended on the grounds of “Supplementary Protection” when the patent proceedings have experienced unjustified administrative delays, not attributable to the applicant and the procedure has lasted more than five years from the application day or more than three years from the request of substantive examination.

The extension of this Supplementary Protection depends on the days/months of the delay calculated by the Chilean Patent Office.

## 5 Patent Prosecution and Opposition

- 5.1 Are all types of subject matter patentable and if not what types are excluded?**

According to the Chilean Patent System, patents are allowed in all the fields of science and technique, except for the following matters:

- Discoveries, scientific theories and methods of mathematicians.
- Plants and animals other than microorganisms that meet the general conditions of patentability. Plant varieties will be protected only in accordance with the provisions of Law No. 19,342 on the Rights of Breeders of New Varieties of Plants. Essentially biological processes for the production of plants and animals other than microbiological processes are not patentable. For these purposes, an essentially biological process is one that consists entirely of natural phenomena such as crossing and selection.
- Systems, methods, principles, or economic plans, financial, commercial, business or those of simple verification and inspection, and those referring to purely mental or intellectual activities or the playing of games.
- Surgical methods or therapeutic treatment of the human or animal body, as well as diagnostic methods practised on the human or animal body, except for products intended to implement one of these methods.
- The new use, change of shape, change in dimensions, change of proportions or change of article materials, objects or elements already known and used for certain purposes. Notwithstanding the foregoing, the novel use of articles, objects or elements already known are patentable provided that the new use solves a technical problem unresolved by an equivalent, as long as it meets the requirements of novelty, inventive step and industrial application and there is a change in the dimensions or proportions or materials of an article, object or element known for said solution to said technical problem. The new use claimed must be proved with experimental evidence.
- Some living beings as found in nature, natural biological processes, and biological material existing in nature or which may be separated, including the genome or germplasm. However, matters may be eligible for protection procedures using one or more of the biological materials set out above and the products directly obtained by them, provided they meet the requirements of novelty, inventive step and industrial application, provided that the biological material is fully described and the industrial application of the same must figure explicitly in the patent application.

Finally, the Chilean Patent Law provides an additional non-patentable matter related to inventions whose commercial exploitation is prevented in order to protect public order, security of

State, morals and good customs, health or life of people or animals, or plant life or health or the environment, provided that such exclusion is not made merely because there is a legal or administrative provision that prohibits or regulates such exploitation.

**5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?**

According to the Chilean Patent System, the substantive examination, provided as mandatory by the law, involves the duty of the Patent Office through the examiners to disclose any prejudicial prior disclosures or documents, as long as they are available.

**5.3 May the grant of a patent by the Patent Office be opposed by a third party and if so when can this be done?**

Opposition is permitted during the procedure, and within 45 working days of the publication of the patent. No opposition is possible against a granted patent. However, it is possible to file an annulment action against a granted patent.

**5.4 Is there a right of appeal from a decision of the Patent Office and if so to whom?**

Yes, it is possible to file an appeal to the *Tribunal de Propiedad Industrial*, which is a second instance proceeding.

**5.5 How are disputes over entitlement to priority and ownership of the invention resolved?**

Disputes over entitlement to priority and ownership of the invention are resolved by the Chilean Patent Office (INAPI). A final decision issued by the INAPI may be appealed.

**5.6 Is there a "grace period" in your country and if so how long is it?**

Yes, the law provides that any disclosure that occurred during the 12 months prior to the application date does not affect the novelty and inventive step of the invention, provided that:

- a) it was made by, authorised by and came from the applicant; or
- b) it came from unfair competition from a third party.

**5.7 What is the term of a patent?**

The term of a patent is 20 years from the application date.

## 6 Border Control Measures

**6.1 Is there any mechanism for seizing or preventing the importation of infringing products and if so how quickly are such measures resolved?**

Yes, there is a special law regulating border control measures and this allows requests for injunctions of infringing goods while they are in the customs port.

The measures are resolved in a very short time but the deadline for requesting border control measures from the Chilean customs authority is short.

## 7 Antitrust Law and Inequitable Conduct

**7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?**

There is no precedent in Chile for antitrust and unfair competition cases brought against patentees for the use of a patent. With the exception of the abuse of rights, in general terms it is considered that the use of an authority-given patent right does not constitute *per se* a violation or abuse of rights.

**7.2 What limitations are put on patent licensing due to antitrust law?**

There are no limitations in the antitrust law on patent licensing.

## 8 Current Developments

**8.1 What have been the significant developments in relation to patents in the last year?**

The latest development is the discussion that is taking place in Congress with regards to a law project connected to the Pharmaceutical Linkage and regarding a new industrial property law.

**8.2 Are there any significant developments expected in the next year?**

The final approval of the Pharmaceutical Linkage law as well as the new industrial property law, is expected within the next year.

**8.3 Are there any general practice or enforcement trends that have become apparent in Chile over the last year or so?**

The discussion for implementing a Pharmaceutical Linkage System as well as the new industrial property law has been a prevalent issue over the last year in Congress.



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- "Regulation of Appellation of Origin Regarding Wines in Chile, A Critic Analysis". "The Current Challenges of Intellectual Property: the Latin American Vision", Asociación Civil THEMIS, Pontificia Universidad Católica del Peru, 2013.
- "Some Relevant Aspects of the Substantive Law of Patents of Invention", Propiedad Industrial e Intelectual, Facultad de Derecho, Universidad Finis Terrae, 2008.
- "Patent of Invention. The Theory of Equivalentents in Chile", Ed. Lexis Nexis Nexos, 2006.



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