Re: VENEZUELA.
Venezuelan Patent and Trademarks Office (SAPI).
Administrative resolution No. DG-009-2020.
dated October 01, 2020.
National Patent and Trademarks Office announces automatic
recognition of TRIPS agreement and other International Treaties
(Paris Convention for the Protection of Industrial Property) as
preferred and immediate applicability over National Legislation
2020-0014GVE.

Dear friends and colleagues,

Recently, the Director of the Autonomous Intellectual Property Service (SAPI) signed an "Official Notice" (DG-09-2020, November 9, 2020) which:

"informs users and the general public that as of October 1, 2020, the substantive and adjectival rules for obtaining and defending the rights that are more favorable to the administered, contained in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) ...".

As a consequence of said Notice,

"... the interested parties may invoke said provisions in the requests made before this Autonomous Service, as well as those of other international agreements on the matter referred to in the TRIPS ...".

It stands out that the "Official Notice" refers to the date of the Approval Law of this international instrument, called Annex 1C of the Marrakesh Agreement, by which the World Trade Organization (WTO) was established, whose Approving Law is published in the Official Gazette No. 4.829 Extraordinary of December 29, 1994. It should be noted that this pronouncement also covers the direct and preferential application of the Paris Convention for the Protection of Industrial Property whose Approving Law also dates from the year 1994.

This announcement is of great importance since it is a form of recognition of the inappropriate interpretation and application in which the Trademark and Patent Office incurred since its withdrawal from the Andean Community which materialized in 2008, coincidentally by a similar Official Notice, with the difference that this time, the legal order is restored, especially for the
benefit of trademark applicants, inventors and authors, attempting to correct the deficiencies that Venezuela has had in terms of enforcement over recent years.

Moreover, since the previous point is useful, the most important thing is that it recognizes its immediate applicability and in all its aspects, for obtaining and defending, both before the National Patent and Trademark Office (SAPI) and in the Courts and National Courts in Administrative Litigation, where they must be applied retroactively and in all its effects, in favor of pending cases for the "non-application" of the provisions contained in the TRIPS, in accordance with the principles established in the Constitution.

Which matters does specifically this new official notice affect? Well, all of them.

Initially, we identify the following:

- It recognizes the patentability of "pharmaceutical, chemical and food" preparations that were manifestly considered as non-patentable matter in the National Law of Industrial Property of 1956;

- It is binding for the Patents Department on the guidelines for the analysis and examination of inventions, concession, and invalidation;

- Generates the possibility for VPTO to request any applicant information (article 29.2) concerning foreign applications and their examination, which will surely serve as basis for the fundamentals to each local substantive examination;

- The fact that the exploitation of the invention may be prohibited by local Law it cannot be the sole basis for the exclusion of patentability; this is a potential conflict with local legislation that has generated refusals for inventions that claim partial biological processes and products;

- Patents shall recognize and patent rights shall be enjoyable without discrimination as to whether products are imported or locally produced;

- Plant varieties can be subject to patents since there is no sui generis procedure legally in place;

- Diagnostic, therapeutic, and surgical methods for the treatment of humans or animals are not expressly contemplated as non-patentable subject matter according to national Law;

- Venezuela is then obliged to make patent protection available for the following inventions: a) microorganisms; b) micro-biological processes for the production of plants and animals; c) non-biological processes for the production of plants and animals;
- It provides a broad and up-to-date concept of manufacture rights and trademarks, which should translate into a current, flexible application in accordance with the International Classification of Products and Services for trademark registration purposes under the Nice Convention;

-Renewals of trademark registrations presented in a grace period of six months after expiration, should be accepted, extended to payments of patent annuities within grace period; and

- A space is created for the recognition of well-known and non-traditional trademarks.

It should be noted that, the National Patent and Trademark Office had already ruled on this same scope in two administrative decisions that took place during 2016. On such occasion, the Authority expressly manifested itself in this regard in these decisions associated with Denominations of Origin, based on TRIPS.

It is important to point out that the provisions set forth in the Industrial Property Law of 1956 that contradict or conflict with the obligations derived from the International Treaties, duly signed by the Republic, will be considered to be unenforceable.

We are carefully studying and identifying in what other aspects, changes and impacts are going to occur under the premise that the changes favors the applicant and thus will have preferred applicability over national legislation. This is an ongoing evaluation thus we shall maintain you updated with other incremental developments and once the VPTO starts implementing these changes.

In any case, we see the scope of this Administrative Resolution as positive and favorable.

We remain available to provide any additional information that you may require and in the meantime we send you a very cordial greeting,

Sebastián González Yanes
sgonzalez@pi360.legal

Andrés Rivero Baralt
arivero@pi360.legal

Matías Pérez Irazábal
mperez@pi360.legal