

Administrative Revocation and Invalidation Mechanisms

Ecuador

Patent invalidation mechanisms are governed by the Andean Decision 486 and the Organic Code of the Social Economy of Knowledge, Creativity and Innovation (COESCCI) while other administrative situations are governed by the Organic Administration Code.

Decision 486 has several articles referring to the cancellation of a patent:

Article 75

The competent national authority may, either ex officio or at the request of a party, and at any time, declare a patent null and void, where:

- (a) the subject matter of the patent is not an invention according to the requirements stipulated in Article 15;
- (b) the invention fails to comply with the requirements for patentability set out in Article 14;
- (c) the patent was granted for an invention covered by Article 20;
- (d) the patent fails to disclose the invention, as required by Article 28 and, if relevant, Article 29;
- (e) the claims included in the patent are not fully substantiated by the description provided;
- (f) use of the patent granted has been broader than was indicated in the original application and requires extension of the scope of protection;
- (g) when relevant, the products or processes in respect of which the patent is being filed have been obtained and developed on the basis of genetic resources or their byproducts originating in one of the Member Countries, if the applicant failed to submit a copy of the contract for access to that genetic material;
- (h) when relevant, the products or processes for which protection is sought have been obtained or developed on the basis of traditional knowledge belonging to indigenous, Afro-American, or local communities in the Member Countries, if the applicant has failed to submit a copy of the document certifying the existence of a license or authorization for use of that knowledge originating in any one of the Member Countries; or,
- (i) there are grounds for absolute invalidation according to domestic legislation governing administrative acts.

Where the grounds specified above are applicable only to some of the claims or some parts of a claim, invalidation shall be pronounced only in respect of those claims or those parts of the said claim, as the case may be.

The patent, claim, or part of a claim that has been invalidated shall be deemed null and void as from the filing date of the patent application.

Article 76

Where defects in administrative acts fail to produce absolute invalidation as specified in the preceding article, those acts shall be relatively invalidated. In such cases, the competent national authority shall, in accordance with domestic legislation, declare them null and void within a period of five years with effect from the patent grant date.

Article 77

Where a patent has been granted to a person who has no right to it, the competent national authority may annul that patent. Invalidation proceedings may be initiated only by the person

who has a right to obtain that patent. That right of action shall lapse five years after the patent grant date or two years following the date on which the person to whom that right belongs learned about the use of the invention, whichever period expires first.

Article 78

In invalidation proceedings, the competent national authority shall request patent owners to present arguments and submit the proof they deem advisable.

Where that authority under the domestic law of a Member Country is the competent national office, the patent owner shall present the arguments and submit the proof referred to in the previous article within a period of two months after being notified thereof.

Before the expiry of the period stipulated in the previous article, the interested party may request an extension of two additional months.

Once the periods stipulated in this article have expired, the competent national office shall rule on the patent's invalidation and inform the parties of its decision.

Article 79

Where necessary to rule on the invalidation of a patent, the competent national authority may request the patent owner to submit one or more of the documents referred to in Article 46 with regard to the patent that is the subject matter of the proceeding.

At the national level, the COESCCI provides for matters relating to nullity as follows:

Article 303 Absolute invalidation of the patent

The competent national authority in matters of intellectual rights shall, ex officio or at the request of any person proving a legitimate interest, at any time, declare the absolute nullity of a patent in the following cases:

1. If the subject matter of the patent does not constitute an invention;
2. If the patent has been granted for an invention that cannot be patented;
3. If the invention does not comply with the requirements for patentability;
4. If the patent does not sufficiently disclose the invention;
5. If the claims included in the patent were not entirely supported in the description;
6. If the granted patent contains a wider disclosure than in the initial application and this implies an extension of protection;
7. Where the copy of the access contract has not been submitted, when the products or processes whose patent is applied for have been obtained or developed from genetic resources or their derived products for which Ecuador is the country of origin;
8. Where the copy of the document accrediting the license or authorization to use the traditional knowledge of the indigenous, Afro-American or local communities of Ecuador or the member countries of the Andean Community has not been submitted, when the products or processes for which protection is sought have been obtained or developed from such knowledge of which Ecuador or any of the member countries of the Andean Community is the country of origin;
9. If the patent was granted in contravention of Article 282;
10. If the patent was granted in contravention of Article 286;
11. If the grounds for absolute invalidity provided for in the law for administrative acts are established; and
12. If the patent was granted in any other violation of the law that substantially led to its grant. Where the causes indicated above affect only one of the claims or parts of a claim, invalidity shall be declared only in respect of such claims or parts of the claim, as the case may

be. The patent, the claim or that part of a claim that was declared invalid shall be deemed invalid from the filing date of the patent application.

Article 304 Relative invalidity

Administrative acts affected by defects that do not entail absolute invalidity, in accordance with Article 303, shall be affected by relative invalidity. In such cases, the competent national authority for intellectual rights may declare such invalidation within five years from the date on which the patent was granted.

Article 305 Action for invalidation for lack of right

The competent national authority in matters of intellectual rights may invalidate a patent when it has been granted to a person who did not have the right to obtain it. Action for invalidation may be brought only by the person to whom the right to obtain the patent belongs. Such action shall lapse five years from the date of grant of the patent, or two years from the date on which the person to whom the right belongs learned of the exploitation of the invention in the country, whichever period expires first.

Article 306 Notification and presentation of arguments and evidence

In cases of invalidation, the parties shall be notified so that they may present the arguments and evidence they deem appropriate. Where necessary to rule on the invalidity of a patent, the owner of the patent may be requested to submit one or more of the documents referred to in Article 300 relating to the patent that is the subject matter of the procedure.

Article 307 Time limit for the presentation of arguments and evidence

The arguments and evidence referred to in Article 306 above shall be submitted within two months following the notification. Before the expiry of the stipulated period, either party may request an extension for an additional two months. Once the periods referred to in this Article have expired, the competent national authority for intellectual rights shall decide on the invalidity of the patent, which shall be notified to the parties by means of a decision.

Article 596 Bringing a claim before a judicial authority

Where a trademark, a patent, a breeder's certificate, an industrial design registration or a layout-design of an integrated circuit has been applied for or obtained by a person who was not entitled to obtain it, or to the detriment of another person who also had such a right, the person concerned may bring an action before the competent judicial authority for recognition as an applicant or owner, or as a co-applicant or co-owner of the right. This action may be brought without prejudice to the other actions provided for in this Code. The claim action shall be dealt with in as ordinary proceedings governed by the general rules of procedure.

Article 597 Appeals

Decisions or administrative acts issued by the competent authority in matters of intellectual rights shall be appealable in accordance with the administrative and judicial remedies provided for in the legal system. Appeals shall be granted for suspensive and devolutionary purposes at administrative headquarters. In the case of administrative acts issued with respect to decisions on compulsory licenses and negative enforcement actions, appeals in administrative headquarters shall not have suspensive effect. In administrative headquarters, the appeals will be processed before a specialized collegiate body that will form part of the competent national authority in matters of intellectual rights. The powers and organization of this organ shall be consistent with the provisions of the relevant regulations.

The COA acts in a supplementary manner, in accordance with the provisions of its Fourth General Provision:

“In the field of intellectual property, the provisions contained in the Organic Code of the Social Economy of Knowledge, Creativity and Innovation, the norms of the Andean Community of Nations and other regulations in force are applicable; however, the provisions of this Code shall be applied supplementarily.”

However, it is worth mentioning that the COA establishes two types of administrative resources: Article 219 concerning the types of remedies available allows for appeal and extraordinary review. The hearing and resolution of appeals corresponds to the highest administrative authority of the public administration in which the impugned act was issued and is filed before the same body that issued the administrative act. The act issued by the highest administrative authority can only be challenged in court. Appeals will be transferred to all interested persons.