

Berken IP â?? Alicia Alvarez Berkenwald, Managing Partner and Patent Analyst â?? Argentina



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Alicia Alvarez Berkenwald, Partner at the specialized intellectual property services firm Berken IP, gives an introduction to the Argentinian IP environment, common strategies used to bypass obstacles, and Berken IPâ??s role in helping increase IP awareness in Argentinian research institutions.

Could you give us an overview of the changes in Argentinian IP law since TRIPS came into effect in 1996?

I started my practice shortly before the TRIPS agreement came into effect and Argentina reformed its laws to come into compliance. In 1995, Argentina introduced the new Patent Law, which recognized the patentability of pharmaceutical products for the first time. The first pharmaceutical patent wasnâ??t granted until 2000, when the five-year transition period had elapsed.

At the time, the prior National Direction of Industrial Property (DNPI) had already developed into the National Institute of Industrial Property (INPI) and significant internal reforms were under way to improve the instituteâ??s operational quality. The patent examiners were given excellent training, and in fact we have former patent examiners working at Berken IP. One is part of our biotech group and was sent by INPI to EPO for training. Partner Ernesto Machicote worked at the INPI for many years, and was the head of the Information Technology department for at least 10 years before joining us. He now leads our Patent Research group. Elena Perez is another member of the Firm who worked at the INPI and received training in EPO and the Japanese Patent Office.

The next big change didnâ??t occur until 2012, when the INPI issued a joint resolution in conjunction with the Ministry of Industry and the Ministry of Health, introducing new restrictions for Chemical and Pharmaceutical patents. Most significantly, it limited the patentability of incremental innovations such

as changes in compositions and dosages. This is particularly contentious because almost every pharmaceutical and biotech innovation in Argentina is incremental in nature; I was told once that on average, it will take 400 researchers at least 25 years to create one new pharmaceutical molecular entity, and in Argentina we do not have enough resources to sustain research at this scale.

Looking forward, I expect that the next big change in the not too distant future will be joining the Patent Cooperation Treaty.

What strategy do you advise you clients to follow given the significant patent application backlog in Argentina and the fact that Argentina is not a part of the Patent Cooperation Treaty?

For reference, the backlog was recently cited at 16 000 pending patent applications; however I would expect it to be actually larger. Following the request for substantive examination, processing time ranges from two or three years for electronic or mechanical technologies, to eight or more years for pharmaceutical and biotech innovations.

As to how one succeeds in this industry in view of this constraint, perhaps I should provide some context. When working with research institutions or small innovative companies, they of course apply for and expect to obtain patents in Argentina, but know that the process will be quite slow. One of the most critical aspects for the success of their projects is getting IP protection. Thus, they usually apply for an international patent through PCT so that they may rely on a search report and patentability opinion which is better recognized on a global level. With a positive patentability opinion in hand, approaching potential investors to license the technology becomes easier. At the moment of entering national stages, clients usually choose the US and secondly Europe, and/or other countries depending on the technology and the export market. Sometimes we will file in unusual markets such as Uzbekistan if the country is of interest for that specific technology.

What is Berken IP's role in the R&D process in Argentina?

We help our clients protect the returns on their R&D investments. In doing so, we work with them closely to understand their objectives, specific challenges and commercial strategy so that we may develop a customized IP protection strategy to help them reach these goals. Our other role lies in helping research institutions understand the importance of IP and the existing patent landscape early on in the research process, so that they don't expend time and money developing something that has already been disclosed.

I would also add that the research and innovation environment in Argentina is much stronger now than it was 20 years ago. This is partly due to the strong government support given to research in the public sector, and also to a changing global business environment, where IP is essential to the business strategy. When I joined the IP industry 20 years ago, there wasn't significant awareness of the importance of obtaining a patent. Now, the business world understands their value and the researchers' community concedes prestige to patents. Berken IP played a role in bringing about this new paradigm for our clients.

As a very specialized IP firm that focuses on life sciences within that field, what edge do you have over your competition?

Being the experts and leaders in our field, and having built this very specialized and experienced Firm that is relatively well known, institutions and companies tend to reach out to us when they need IP related services, and this is a process that reinforces itself as we build more experience and reputation. Since we provide a comprehensive set of IP services including IP Prosecution, Legal Services, and Patent Intelligence, we are a one-stop shop for their IP needs. This extends beyond

Argentina, as we have a lot of experience and strong connections with the other countries in the southern cone and are thus able to handle clients' needs in the entire region. In Latin America, we are of the few firms with the legal and technical capability to perform searches, draft and prosecute patent applications and if the need arises, to litigate. Furthermore, as we made the decision to work internationally very early on, we have an extensive network of reliable colleagues around the world we have already worked with. We are also members of several important international IP organizations and constantly attend international meetings. As a result, we know the key players in the IP field in most countries around the world, and are able to faultlessly help clients design and manage a global IP strategy.

How does the client base vary across your different business areas?

Some clients make use of all of our services, while others come to us with more specific needs. In general terms, for life sciences our foreign clients tend to be more interested in our IP services than in our legal services; we file a lot of trademark and patent applications on their behalf and have a staff of sworn translators that provide high quality translation services. Our domestic clients tend to be more interested in our patent intelligence and legal services.

Could you tell us a bit about how you became involved in the IP industry?

I started working with patents 20 years ago roughly, and at that time I was of the few people with technical background in the IP field in Argentina. At one point I traveled to the US to learn about the US patent system, and later joined international organizations to have academic and professional exposure to the international patent environment.

I was very lucky because in 1997 – when the patent laws surrounding pharmaceuticals had just changed – I did a lot of work for a small and successful pharmaceutical company that worked with osmotic devices. The company quickly learnt that to access international markets, it needed a patent portfolio, so we worked together very hard to develop one. Timing wise, this was an excellent opportunity because very early in my career I was able to be active in an industry that was seeking to internationalize its business.

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