

## LAW 6867

THE LEGISLATIVE ASSEMBLY OF THE REPUBLIC OF COSTA RICA

HEREBY DECREES:

### **Law on Invention Patents, Industrial Designs and Utility Models**

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#### CHAPTER I

On inventions

#### **Article 1.– Inventions.**

“Invention” means any creation of the human mind, which is industrially applicable and meets the conditions of patentability laid down in this Law. It may be a product, machine, tool or manufacturing process, and shall be protected by an invention patent.

2.– The following shall not be considered inventions for the purposes of this Law:

- (a) discoveries, scientific theories, mathematical methods and computer programs, taken separately;
- (b) purely esthetic creations and literary and artistic works;
- (c) schemes, rules and economic methods for advertising or business, and those referring to purely mental or intellectual activities or game-playing;
- (d) the juxtaposition of known inventions or mixtures of known goods, a change in their form or use, dimensions or materials, except where such combination or amalgamation cannot function separately or where the qualities or functions that are characteristic thereof are modified to obtain an industrial result which is not obvious for a person skilled in the art.

3.– Plant varieties shall be protected by means of a special law.

4.– The following may not be patented:

- (a) inventions whose commercial exploitation must objectively and necessarily be prevented to protect public order, morality, the health or life of persons or animals or to preserve plants or prevent serious damage to the environment;
- (b) methods of diagnosis or surgery or therapy for the treatment of persons or animals;
- (c) plants and animals, except microorganisms, provided that they are not microorganisms as found in nature **(as amended by LAW No. 8632 of March 25, 2008)**;
- (d) essentially biological procedures for the production of plants or animals, where they are not non-biological or microbiological procedures **(as amended by LAW No, 8632 of March 25, 2008)**;

**(Article amended by Law No, 7979 of January 6, 2000, Article 2(a))**

#### **Article 2.– Patentable inventions.**

1. Inventions may be patented if they are new, involve an inventive step and are industrially applicable.

2. REPEALED

**(repealed by Law No. 7979 of January 6, 2000, Art. 4)**

3. Inventions shall be considered new if they do not form part of the prior art. Prior art shall consist of everything disclosed or made available to the public anywhere in the world and by

any means, prior to the date of filing of the patent application in Costa Rica or, as the case may be, prior to the applicable date of priority.

The state of the art shall also be deemed to include the content of another patent application pending with the same Industrial Property Registry, whose date of filing or, as the case may be, priority, is earlier than that of the application under consideration, but only to the extent that such content is included in the application from an earlier date, where it has been published. Prior art shall not be considered to include material that has been disclosed within the year prior to the date of filing of the application in Costa Rica or, as the case may be, within the year prior to the applicable priority, provided that such disclosure flows directly or indirectly from acts performed by the inventor himself or his successor in title or from the non-enforcement of the contract or any illicit act committed against any of them **(paragraph amended by Law No. 7979 of January 6, 2000, Article 2(b)).**

4. Disclosure arising from a publication made by an Industrial Property Office as part of the patent grant procedure shall be considered part of the prior art, except in the case of the patent applicant or where the application in question has been filed by someone who was not authorized to obtain the patent or where publication has been improperly made **(as amended by LAW No. 8632 of March 25, 2008).**

5. Inventions shall be considered to involve an inventive step if, for a person skilled in the art, they are not obvious from the relevant prior art.

6. Inventions shall be considered industrially applicable if they have a specific, substantive and credible use **(as amended by LAW No. 8632 of March 25, 2008).**

7. Patentable inventions shall encompass all products or processes which meet the requirements of patentability laid down in this Law, without discrimination as to the place of invention, field of technology or whether the products are imported or produced in the country.

**(paragraph amended by Law No. 7979 of January 6, 2000, Article 2(b)).**

### **Article 3.– Patent rights. Transfer and licensing.**

1. Patent rights shall belong to the inventor. The inventor shall be assumed to be the first applicant in the country of origin of the invention.

2. If different persons make an invention jointly, the patent right shall belong to them jointly, unless otherwise agreed.

3. Patent rights may be transferred *inter vivos* or by succession.

4. To be binding on third parties, any transfer or licensing of the patent must be registered with the Industrial Property Registry.

### **Article 4.– Inventions made in the performance of a contract for work or services, or an employment contract**

1. Where inventions are made as part of a non-work contract, the purpose of which is to produce them, the patent rights shall belong to the agent, unless otherwise agreed.

Where inventions have an economic value substantially greater than that foreseen by the parties, at least one-third of the value shall belong to the inventor. In the event that he considers such percentage insufficient, he shall be entitled to request that the respective percentage be set by court order, the amount of which may never be less than the one-third indicated above.

2. Where a worker whose employment contract or relationship is aimed at the production of given inventions, the patent rights for such inventions shall belong jointly to the parties who have established the employment relationship, and may not be renounced.

3. Where a worker whose employment contract or relationship is not aimed at the production of inventions, any inventions produced shall be his property. One-third of the income obtained in this way shall be paid to the employee.

4. In any other cases not specifically provided for in the above paragraphs, the patent right shall always belong to the employee.

#### **Article 5.– References to the inventor**

Inventors shall be mentioned as such in the patent, unless they indicate via a written statement to the Industrial Property Registry that they do not wish this. Any promise or commitment by an inventor obliging him to make such a statement shall have no legal value.

#### **Article 6.– Applications**

1. Patent applications shall be filed with the Industrial Property Registry, together with a description, claims, the drawings necessary for understanding the invention, and an abstract of these documents. They shall also be accompanied by proof that the applicant has paid the filing fee prescribed in the Regulations under this Law.

2. Where applicants wish to claim the priority conferred by an earlier application filed in another country, they must file the application within 12 months following the filing date of the first application which serves as a basis for the claim of the priority right, in accordance with the provisions of Article 4 of the Paris Convention for the Protection of Industrial Property revised in 1967 (**as amended by LAW 8632 of March 25, 2008**).

3. Applications shall contain the name and means for the service of notifications, which may be by fax, telegram, e-mail or post office box, in accordance with the respective Regulations and other information prescribed therein relating to the applicant, the inventor and the agent, if any, and the title of the invention. If the applicant is not the inventor, the application shall be accompanied by a statement justifying the applicant's right to the patent (**as amended by LAW No. 8632 of March 25, 2008**).

4. Descriptions shall describe the invention sufficiently clearly and comprehensively to evaluate it and to ensure that a person skilled in the art may carry it out. In particular, they shall specifically indicate the best way known to the applicant for carrying out the invention, giving one or more concrete examples where possible, and identifying, as the case may be, the one which would yield the most satisfactory results in terms of industrial exploitation.

5. The text of the first claim shall determine the scope of protection.

Any other claims shall be subordinate to the first such claim and may refer to specific ways of applying the invention. The description and the drawings may be used to interpret the claims, which shall be clear and concise and entirely based on the description.

6. Abstracts shall contain an overview of what is specified in the description, the claims and the drawings, if any, and shall include the formula which best characterizes the invention, as appropriate. They shall make it possible to understand the technological problem and the essential features of the solution provided by the invention, as well as the primary use thereof. Other requirements for abstracts shall be specified in the Regulations.

7. Abstracts shall be exclusively for technical information and shall not be used to interpret the scope of protection.

8. **REPEALED by LAW No. 8632 of March 25, 2008.**

9. All patent applications filed with the Registry shall be classified using the International Patent Classification.

10. In the event that, at the date on which the application is filed, it does not include at least the name of the applicant, the description, the claims and any drawings necessary to understand the invention, the Industrial Property Registry shall assign as the filing date the date on which full compliance was achieved with the corresponding requirements. **(as added by LAW No. 8632 of March 25, 2008).**

#### **Article 7.– Unity of invention**

Applications may only refer to an invention or group of inventions which are related in such a way that they form a single general inventive concept.

#### **Article 8.– Amendment, division and withdrawal of applications**

1. Applicants may amend their application and may also amend the claims, but this may not entail a broadening of the invention disclosed or an expansion of the disclosure contained in the initial application. **(as amended by LAW No. 8632 of March 25, 2008).**

2. Applicants may divide their application into two or more parts, but none of them may entail a broadening of the invention or of the disclosure contained in the initial application. Each divisional application shall have the filing date of the initial application.

3. Applicants may withdraw their application at any time.

#### **Article 9.– Formal examination**

1. The Industrial Property Registry shall ascertain whether applications meet the requirements of paragraphs 1, 2 and 3 of Article 6 and the corresponding provisions of the Regulations.

2. In the event that any omission or defect is noted, applicants shall be notified so that they can make the necessary correction within the following 15 working days. If they fail to make the correction within the said period, the Registry shall consider the application to be withdrawn **(as amended by LAW No. 8632 of March 25, 2008).**

#### **Article 10.– Publication of applications**

1. If the Industrial Property Registry notes that all of the requirements referred to in Article 9, paragraph 1 have been met, it shall notify the applicant so that he may pay the fee for publication of the application within the following month.

2. If the publication fee is not paid during this period, the application shall be deemed to be abandoned.

3. Applications shall be published in the Official Gazette for three consecutive days and at least once in a nationwide print media, and shall contain the name and other required information relating to the applicant, the inventor and the agent, if any, the title of the invention and the abstract, which shall clearly indicate what is to be patented and its usefulness, as well as any other information required by the Regulations.

4. Files for patent applications shall remain open to the public for information purposes as from the date of publication of the first notice.

An applicant's written consent shall be required to consult any application file prior to publication thereof.

### **Article 11.– Protection prior to the grant of the patent**

Compensation for damage may be claimed from any person who exploits the invention claimed in a patent application during the period between the date of publication of the application notice and the date of the grant of the patent. Such compensation shall be subject to the grant of the patent and shall only be entertained in respect of the claims that would have been included in the patent.

### **Article 12.– Opposition and observations**

1. Anyone who is opposed to the grant of a patent because he considers that the application violates the substantive requirements prescribed in this Law may file an opposition within a period of three months, beginning from the date of the third publication of the application in the Official Gazette *La Gaceta*. The opposition shall be duly substantiated, and shall be accompanied by the relevant evidence or the offer thereof, and proof of payment of the opposition fee. Evidence shall be submitted within two months following the filing of the opposition, on pain of inadmissibility **(as amended by LAW No. 8632 of March 25, 2008)**.

2. The Industrial Property Registry shall communicate any opposition to applicants, asking them to submit their reply within the following month.

Once this period has passed, the examination provided for in Article 13 shall be carried out.

3. If this period expires without any opposition being filed, the examination provided for in Article 13 shall be carried out.

### **Article 13.– Substantive examination**

1. The Industrial Property Registry shall ascertain whether the invention may be patented, in accordance with Articles 1 and 2, and, as applicable, whether the application meets the requirement of unity of invention, according to Article 7, and whether the amendment or divisional application is consistent with the provisions of Article 8, as appropriate. It shall also ascertain whether the description, the claims and the drawings comply with the requirements established in Article 6, paragraphs 2, 3, 4 and 5 and the corresponding provisions of the Regulations.

2. The Industrial Property Registry shall rely on professional examiners to conduct the substantive examination of patents, the cost of which shall be fixed by tariffs set for this purpose by the Administrative Board of the National Registry. Likewise, the Registry may request an opinion from official, higher education, scientific, technological or professional establishments, national or foreign, or, failing this, from independent experts in the field, as to the novelty, inventive step and industrial applicability of the invention. In all cases, the appointed examiner shall be independent, honest and not have a conflict of interest. He shall also respect the confidentiality of the information being examined. The above-mentioned centers that depend on or are funded by the State and the professional bodies shall be obliged to provide the required advice. Any person signing reports shall be held responsible for their content, as the case may be, in accordance with the provisions of Article 199 of the General Law of Public Administration.

Reports submitted by the centers, entities or experts consulted shall be issued within the period set by the Industrial Property Registry, depending on the complexity of the subject, and shall contain a detailed justification of the conclusions. The cost, which shall be set in

accordance with the Regulations, shall be borne by the applicant **(as amended by LAW 8632 of March 25, 2008)**.

3. If it notes that the conditions of paragraph 1 are not met, the Industrial Property Registry shall notify the applicant so that he may submit his comments within the following month, and, as the case may be, correct or complete the documentation provided, or amend or divide the application, subject to the provisions of Article 8.

4. If an applicant fails to comply with the requests of the Registry within the prescribed period or if the Registry notes that despite the request made to the applicant, the conditions laid down in paragraph 1 have not been met, it shall refuse to grant the patent. Such refusal shall be substantiated and shall be notified to the applicant by the Registry.

5. Decisions on the substance shall also rule on the oppositions filed.

6. The technical reports referred to in paragraph 2 of this Article shall be concluded within the non-extendable period of two years, computed from the receipt of the application for study by the corresponding body. Substantive examinations shall be concluded within the period of 30 months, beginning from the receipt of the application for study by the corresponding entity **(as amended by LAW No. 8632 of March 25, 2008)**.

#### **Article 14.–Information relating to patent applications**

1. Applicants for or owners of patents in Costa Rica shall indicate the date and number of any patent application or other title of protection they have submitted to or any rights they have obtained from an Industrial Property Office in any other country or from a regional Industrial Property Office, which refers in full or in part to the same invention claimed in the application filed in Costa Rica.

2. Where foreign inventors are unable to produce the patent certificate issued in the country of origin but can provide documentary proof that the country in question has no patent register for the class of inventions involved, a certificate of patent registration from any other country in which the patent has been registered shall be valid. In any case, documentary proof shall be provided as to the expiry date of the patent abroad.

3. Applicants or patent owners shall provide the following documents in respect of foreign applications or titles:

- (a) copies of all communications received by the applicant which refer to the results of a search for prior art or examinations conducted in respect of the foreign application;
- (b) copies of patents or other protection titles granted on the basis of foreign applications;
- (c) a copy of any final decision rejecting a foreign application or refusing to grant the concession sought;
- (d) information on disputes or complaints regarding the invention which are known or related to it.

**(paragraph amended by Law No. 7979 of January 6, 2000, Article 4).**

4. Patent applicants shall also provide the Industrial Property Registry at its request with a copy of any final decision invalidating the patent, or another protection title granted on the basis of the foreign applications referred to in paragraph 1.

5. Documents provided under this Article shall be used to facilitate the examination of novelty and the inventive step of the invention claimed with the Industrial Property Registry.

6. If patent applicants fail to provide the information or documentation sought within the prescribed period, the patents shall be refused. In duly justified cases, applicants may request an extension of the period for submitting the corresponding information or documentation.

7. Patent applicants may submit observations and comments on the information and documents they provide.

#### **Article 15.– Grant of patents**

1. If the Industrial Property Registry establishes that the requirements and conditions laid down by this Law and the Regulations thereunder have been met, it shall grant a patent.

2. Grant of a patent may be limited to one or some of the claims filed by the applicant, in which case the patent shall be refused for any claims in respect of which the requirements of the law are not met.

3. Decisions to grant or deny all or part of the patent shall be substantiated.

4. Where the decision is to grant the application, the Industrial Property Registry shall register the patent, issue a certificate of grant and a copy of the patent to the applicant, and publish an overview of the decision in the Official Gazette.

#### **Article 16.– Rights conferred by patents. Limitations**

1. With the limitations laid down in this Law, patents shall confer on the owner exclusive rights to work an invention and to grant licenses to third parties for its working. Likewise, patents shall give owners the following exclusive rights:

(a) where the subject matter of the patent is a product, the right to prevent third parties from performing without his consent acts of manufacturing, use, offering for sale, sale or import, for such purposes, of the good which forms the subject matter of the patent;

(b) where the subject matter of the patent is a process, the right to prevent third parties from performing, without his consent, acts of using the process and acts of use, offering for sale, sale or import for such purposes of at least the good obtained directly by means of this said process.

2. Provided that the following exceptions do not unjustifiably affect the normal working of the patent or result in unreasonable prejudice to the legitimate interests of the owner or his licensee, the rights conferred by the patent shall not extend to:

(a) legal acts of any kind, provided they are performed within the private sphere and for non-commercial purposes;

(b) acts performed for experimental purposes which are related to the subject matter of the patented invention;

(c) acts performed exclusively for purposes of teaching or scientific or academic research in respect of the subject matter of the patented invention;

(d) the act of selling, offering for sale, use, usufruct, import or any means of marketing a product protected by the patent or obtained via a patented process, once the product has been traded by any country, with the consent of the owner or a licensee;

(e) the necessary uses for researching, dealing with, processing or any other requirements for obtaining Health Registry approval with a view to marketing a product after the patent protecting it has expired.

3. Rights conferred by patents shall not be binding on any parties who, prior to the filing date or, as the case may be, the priority date of the application for the corresponding patent, were in the country producing the product or using the process of the invention. Moreover, such parties shall be entitled to continue producing the product or using the process. This right may only be assigned or transferred with the company or establishment which is producing the product or plans such production or use **(Article amended by LAW No. 7979 of January 6, 2000, Article 2(d)).**

4. With regard to the marketing approval process for drugs, the Ministry of Health and other competent authorities shall take steps to prevent any person other than the patent owner from marketing a product covered by the patent which encompasses the previously approved product or its authorized use for the duration of the patent, unless the patent owner has given his consent or approval **(as amended by Law No. 8632 of March 25, 2008).**

#### **Article 17.– Duration of patent protection**

1. Patents shall be valid for twenty (20) years, beginning from the date on which the application is filed with the Industrial Property Registry or, in the case of patents processed under the Patent Cooperation Treaty, from the date of international filing **(as amended by LAW No. 8686 of November 21, 2008)**

2. Notwithstanding the provisions of paragraph 1 above, if the Industrial Property Registry takes more than five (5) years to grant a patent, beginning from the date on which the application is filed with it, or takes more than three (3) years, beginning from the application for the substantive examination of the patent provided for in Article 13 of this Law, whichever comes last, the owner shall be entitled to petition the Industrial Property Registry for compensation for the period of patent validity. Said petition shall be filed in writing within three (3) months following the grant of the patent **(as amended by LAW No. 8686 of November 21, 2008)**

3. After receiving such a request, the Industrial Property Registry shall provide compensation for the period of the patent, by granting one day for every day over the periods of time referred to in paragraph 2. However, periods of time ascribable to actions taken by the applicant shall not be included in the determination of such delays. Notwithstanding the above, total compensation for the patent term may under no circumstances exceed 18 months.

4. Notwithstanding the provisions laid down in paragraph 1 above, in the case of existing patents which cover any pharmaceutical product, where Health Registry approval for the first marketing of said pharmaceutical product in the country granted by the Ministry of Health takes more than three (3) months, beginning from the date of filing of the application with the Health Registry for pharmaceutical products in the country, the patent owner shall be entitled to petition the Industrial Property Registry for compensation for the term of the patent. Said petition shall be filed in writing, within three (3) months following Health Registry approval for the first marketing of the pharmaceutical product in the country **(as amended by LAW No. 8686 of November 21, 2008).**

5. After receiving such a request, the Industrial Property Registry shall provide compensation for the patent term, by granting one day for every day over the periods of time referred to in paragraph 4, provided that the remaining validity of the patent does not exceed 12 years. Notwithstanding the above, total compensation for the patent term may under no circumstances exceed 18 months.

**(as amended by LAW No. 8632 of March 25, 2008)**



**Article 18.– Failure to work or insufficient industrial working**

1. Grant of a patent shall imply an obligation to work it in Costa Rica in a permanent and stable fashion, so that the market is appropriately and reasonably supplied within the period of three years, beginning from the date of grant of the patent, or four years, beginning from the application for the patent, whichever is longest.

Nor may the working be interrupted for more than one year (**paragraph amended by Law No. 7979 of January 6, 2000, Article 2(e)**).

2. **Repealed by LAW No. 8632 of March 25, 2008**

3. For the purposes of the first paragraph of this Article, the local production and legitimate import of products shall be considered, inter alia, forms of working  
(**paragraph amended by LAW No. 7979 of January 6, 2000, Article 2 (e)**)

4. **Repealed by LAW No. 8632 of March 25, 2008**

5. Upon the expiry of the periods referred to in paragraph 1 of this Article, any party may apply during the following year for the grant of a compulsory license due to failure to work. In the event that the grant of the compulsory license does not suffice to correct the failure to use the patent, the patent shall be declared to have lapsed. No proceedings for the lapsing or revocation of a patent may be brought before the expiry of the period of two years, beginning from the grant of the first compulsory license (**as amended by LAW No. 8632 of March 25, 2008**)

6. Authorization for compulsory licenses shall be considered on a case-by-case basis and shall extend to patents relating to components and processes which enable their working. Such uses shall be authorized primarily to supply the domestic market, in accordance with the provisions of the Agreement on Trade-Related Aspects of Intellectual Property. Before a compulsory license is granted, the applicant shall prove that he has sufficient capacity to work the patented invention and that he has endeavored to obtain the authorization of the right holder on reasonable commercial terms and conditions, and that such attempts have not succeeded within the period set in the first paragraph of this Article (**as amended by LAW No. 8632 of March 25, 2008**)

7. The Industrial Property Registry shall decide, within a period of 90 calendar days, whether or not to grant a compulsory license, after hearing the parties. When granting such a license, it shall stipulate the conditions under which it is granted, limiting the scope and duration for the purposes authorized and the economic remuneration which the right holder receives. To do so, it shall take into consideration the particular circumstances of each case and the economic value of the authorization, and shall bear in mind the average royalties for the sector in question, in commercial licensing contracts between independent parties. Semiconductor technology may only be used for public non-commercial purposes or to correct a practice declared anti-competitive following judicial or administrative proceedings (**paragraph amended by LAW No. 7979 of January 6, 2000, Article 2(e)**)

8. Appeals lodged against decisions to grant compulsory licenses shall not prevent licensees from working a license or interrupt the periods which are underway. Nor shall it prevent patent owners from receiving the royalties fixed by the Industrial Property Registry, for the part that is not subject to a complaint (**paragraph amended by LAW No. 7979 of January 6, 2000, Article 2(e)**)

9. The grant and conditions of compulsory licenses may be amended at any time by agreement of the parties, at the request of one of them, or *ex officio* by the Industrial

Property Registry where new facts so warrant and, in particular, where a patent owner has granted a license to third parties on conditions more favorable than those established. Similarly, authorization for compulsory licenses may be canceled without prejudice to the legitimate interests of those who have been granted authorization, if the circumstances which led to such authorization have ceased to exist and are unlikely to recur.

The Industrial Property Registry shall examine, upon motivated request, whether such circumstances continue to exist; in addition, it shall be authorized to refuse to revoke an authorization if it is likely that the conditions which gave rise to such authorization will recur.

**(paragraph amended by LAW No. 7979 January 6, 2000, Article 2(e))**

10. Compulsory licenses shall not be exclusive and may not be transmitted, even in the form of the grant of a sublicense, except with the part of the company or business establishment which works the license. Licensees shall be obliged to work their patent within the period of one year, starting from the date on which it was granted, and may not suspend working for a longer period or the license granted will be automatically revoked **(paragraph amended by LAW No. 7979 of January 6, 2000, Article 2(e))**

**11. Repealed by LAW No. 8632 of March 25, 2008**

**Article 19— Compulsory licenses for dependent patents and compulsory licenses for anti-competitive practices**

A.— Compulsory licenses in the case of dependent patents

1. If the invention claimed in a patent cannot be worked industrially in the country without infringing a prior patent, the Industrial Property Registry, at the request of the owner of the second patent, his licensee or the beneficiary of a compulsory license for the later patent, shall grant a compulsory license where necessary to avoid infringement of the prior patent, subject to the relevant provisions of Article 18 of this Law and to the following conditions:

- (a) the invention claimed in this second patent must offer a relevant technical advance, of considerable economic importance in respect of the invention claimed in the first patent;
- (b) the owner of the first patent shall be entitled to a cross-license on reasonable conditions, to work the invention claimed in the second patent;
- (c) the use authorized in the first patent may not be transferred without transferring the second patent.

2. The Industrial Property Registry may grant, in the same circumstances, a compulsory license in respect of the later patent, if asked to do so by the owner of the prior patent, his licensee or the beneficiary of a compulsory license for this patent.

B.— Compulsory licenses for anti-competitive practices

1. Compulsory licenses shall be granted where the Antitrust Commission has established that the patent owner has engaged in anti-competitive practices. In such cases, without prejudice to the appeals and hearings which shall be the responsibility of the patent owner, such grant shall not require the following conditions:

- (a) the potential licensee has endeavored to obtain the owner's authorization as per paragraph 6 of Article 18 of this Law;
- (b) it is to supply the domestic market.

2. Notwithstanding the provisions in subparagraph (a) of paragraph 1 of this Article, the owner of the patent which forms the subject matter of the license shall be notified where reasonably possible.

3. For the purposes of this Law, anti-competitive practices shall be deemed to constitute *inter alia* the following:

- (a) setting excessive or discriminatory prices for the patented goods;
- (b) failing to supply the market on reasonable commercial terms;
- (c) hindering business or productive activities

**(Article amended by LAW No. 7979 of January 6, 2000, Article 2(f))**

#### **Article 20.– Licenses in the public interest**

1. Where qualified reasons of extreme urgency, public interest, national emergency or security exist, the Executive may, by decree, subject the patent or the patent application to a compulsory license at any time, even without the owner's agreement, for the invention to be worked by a State body or by third parties authorized by the Government. The owner of the patent which forms the subject matter of the license shall be notified as soon as is reasonably possible. The grant of such licenses shall comply with the provisions contained in Article 18 of this Law, as appropriate.

2. The State shall compensate patent owners for licenses in the public interest. Owners may appeal to the administrative courts for the competent court to fix the respective financial remuneration. To do so, the judicial authorities shall consider the circumstances of each case and the economic value of the authorization, taking into account the rate of average royalties for the sector in question for commercial licensing contracts between independent parties.

3. Where the Government has granted a public interest license to a third party, that party shall reimburse the State, in full or in part, for the compensation due to the owner **(Article amended by Law No. 7979 of January 6, 2000, Article 2(f))**

4. **REPEALED BY LAW No. 8686 of November 21, 2008.**

**(This subparagraph was added by LAW 8632 of March 25, 2008).**

#### **Article 21– Invalidity**

1. At the request of any interested party or *ex officio*, and provided that the patent owner is heard, the Industrial Property Registry shall declare the said patent invalid, if it can be demonstrated that it was granted in violation of any of the provisions of Articles 1 and 2 of this Law. Any party requesting the invalidation of the patent shall provide all the proof he deems relevant **(as amended by LAW No. 8632 of March 25, 2008)**

2. The licensee of the canceled patent shall, where appropriate, be entitled to the reimbursement of the payments already made for the patent, provided that he has not benefited from the license.

3. Invalidity may be declared at any time before the expiry of the patent.

### **Article 22.– Recording and publication**

The Industrial Property Registry shall record and publish in the Official Gazette final decisions relating to the granting of compulsory and public interest licenses, declarations of invalidity, and patent lapse.

### **Article 23.– Consultation of files**

Any person may consult in the Industrial Property Registry the files corresponding to the applications. Similarly, any person may obtain copies of files, upon payment of the required fee.

### **Article 24.– Information service**

The Industrial Property Registry shall set up a patent information service for the public.

## **Chapter II**

### **Industrial designs and utility models**

#### **Article 25.–Definition of industrial designs and utility models**

1. For the purposes of this Law, any combination of lines or colors or any three-dimensional form, whether or not associated with lines or colors, shall be deemed to be an industrial design, provided that such combination or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for manufacture thereof. Any new arrangement or form obtained or introduced in known tools, work instruments or utensils which allow a better function or a special function for their use shall be deemed to be a utility model.
2. The protection afforded by this Law shall not include the elements or characteristics of the industrial design for the sole purpose of obtaining technical or functional effects. **(paragraph amended by LAW No. 7979 of January 6, 2000, Art. 2(g))**
3. The protection afforded by this Law shall neither exclude nor affect the rights derived from other legal provisions, in particular existing rules on copyright.
4. Owners of protected industrial designs shall have the right to prevent third parties, without their consent, from making, selling or importing articles which bear or incorporate a design or model which is basically a copy of the protected design or model, where such acts are performed for commercial purposes.

**(paragraph amended by LAW No. 7979 of January 6, 2000, Art.(g))**

#### **Article 26.– Protection. Excluded subject matter**

1. New and original industrial designs obtained independently shall be protected by this Law.
2. It shall not be allowed to register industrial designs which are contrary to public order, morality or good practices, provided that these exceptions do not unreasonably conflict with the normal exploitation of the protected industrial designs or do not unreasonably prejudice the legitimate interests of the holder of the protected design. The legitimate interests of third parties shall be taken into account **(Article amended by LAW No. 7979 of January 6, 2000, Art. 2(h))**

### **Article 27.– Rights to industrial designs. Transfer and licensing**

The right to secure the registration of an industrial design shall belong to its creator or creators.

The provisions of Article 3 shall apply in this respect, as appropriate.

### **Article 28.– Applications**

1. Applications for the registration of an industrial design or utility model shall be filed with the Industrial Property Registry and shall contain, in addition to the information required by the Regulations, an indication of the type or kind of goods to which the industrial design shall apply, as well as the class or classes to which the goods belong, in accordance with the International Classification of Industrial Designs.

2. Applications shall be accompanied by five graphic or photographic representations of the design, a brief description thereof, a copy of the object incorporating it, where possible, and proof of payment of the required fee.

### **Article 29.– Examination of registration**

1. The Industrial Property Registry shall ascertain whether applications meet the legal and regulatory requirements.

2. In the event that the Industrial Property Registry notes that the requirements have been met, it shall publish in the Official Gazette an overview of an application with the reproduction of the design or model, and in the case of an industrial design, shall register it and issue a certificate of registration to the applicant.

3. In the case of utility models, the Registry shall conduct a substantive examination, applying the provisions of Article 13, where applicable.

### **Article 30.– Term of registration**

Registrations of industrial designs or utility models shall be valid ten years **(as amended by Law No. 7979 of January 6, 2000, Art. 2(i))**

### **Article 32.– Default rules**

The first part of this Law shall apply, as appropriate, to the protection of industrial designs and utility models.

## **CHAPTER III**

### **General provisions**

#### **Article 32.– Abandonment**

Applications for registration and other action taken under this Law shall be deemed to have been abandoned and shall lapse by operation of the law if they are not taken in due time, within a period of three months, beginning from the date of the last notice served on the interested parties **(as amended by LAW No. 8632 of March 25, 2008)**

#### **Article 33.– Fees for invention patents**

The fees for invention patents shall be as follows:

- (a) filing of the application, which includes processing and examination of form: five hundred US dollars (US\$ 500.00);
- (b) for each divisional application: five hundred US dollars (US\$ 500.00);
- (c) recording and dispatching of the patent registration certificate: five hundred US dollars (US\$ 500.00);
- (d) opposition: twenty-five US dollars (US\$ 25.00);
- (e) request for an extension of the patent term: one hundred and fifty US dollars (US\$ 150.00);
- (f) annual fees: five hundred US dollars (US\$ 500.00);
- (g) surcharge for payment during the grace period: thirty per cent (30%) of the corresponding annual fee.

The fees applicable under this Law shall be paid into the budget of the Industrial Property Registry in order to strengthen the Registry, and may be settled in their equivalent in colones, at the official exchange rate of the banking institution which receives the payment.

Where the applications referred to in subparagraphs (a), (b), (c) and (e) of this Article have been filed by inventors who are natural persons, by micro or small enterprises according to Law No. 8262, by public institutions of higher education, or by public-sector institutes for science and technology research, these may pay only thirty per cent (30%) of the rate established for the fee, as well as thirty per cent (30%) of the rate established in subparagraph (f) for annual fees during the term of the patent. For this to be the case, the application shall be accompanied by the following documents, in addition to proof of payment:

- I.– A sworn statement to the effect that they come under one of the categories listed in the foregoing paragraph;
- II.– A copy of the tax identity card for natural persons and a copy of the corporation card in the case of legal entities.

In order to record the transfer of rights to a third party who does not come under any of the categories enumerated in this provision, that party shall pay the remaining seventy per cent (70%) of the current rate not initially covered by the transferor.

Similarly, once this transfer has been made, the transferee shall pay all of the annual fees set in order to keep his right **(as amended by LAW No. 8632 of March 25, 2008)**

#### **Article 33bis.– Payment of annual fees**

1. The annual fees to maintain the validity of the patent may be paid in advance for two or more annual periods.
2. In the event that the annual fee is paid during the grace period, the fee due and the respective surcharge shall be paid simultaneously. During the grace period, the patent shall remain completely in force.
3. If the Industrial Property Registry notes that payment of the respective annual fee has not been made, it shall send the payment reminders provided for in Article 150 of the General Law of Public Administration. If payment has still not been made within the period set for this purpose, the Director of the Industrial Property Registry shall take official notice of the arrears.
4. Payment of annual fees shall be entered in the Registry, under the section corresponding to the patent for which the fee has been paid. The entry shall indicate the amount paid, the annual period or periods to which the payment corresponds, and the date on which payment was received.
5. In the case of renunciation, expiry or declaration of invalidity, it shall not be possible to recover fees or annual payments made in advance

**(Article added by LAW No. 8632 of March 25, 2008)**

**Article 34.– Agents**

Where applicants have their domicile or headquarters outside Costa Rica, they shall be represented by a lawyer domiciled in the country, with sufficient authority.

**Article 34bis.– Formality of powers of attorney**

To act on behalf of a natural person or legal entity by performing any act relating to intellectual property, it shall be necessary to obtain the authorization of the principal, in the form of an authenticated mandate, as a minimum formality. In any event, it shall not be necessary to record the said mandate.

Where a power of attorney also covers other countries, it may be formalized in accordance with the domestic law of the country granting it, and shall be authenticated.

Unless otherwise agreed, all agents shall have sufficient authority to perform all of the acts which the law authorizes the actual holder of the corresponding intellectual or industrial property rights to perform, in relation to any authority, office or public register, for the recording, registration, transfer, licensing and other acts applied, conservation or defense of his rights, in both administrative and judicial proceedings, in all of their bodies and instances.

**(Article added by LAW No. 8632 of March 25, 2008)**

**Article 35.– Registries**

The Industrial Property Registry shall keep separate registries for patents, industrial designs and utility models. Any person shall be entitled to consult any entry in the Registry free of charge. Any person may request and obtain a copy of the entries and annotations of the registries, upon payment of the required fee.

**Article 36.– Substantive examiners**

The Administrative Board of the National Registry shall set up its own salary system for staff members who have stood out as institutional substantive examiners, and shall be authorized to hire the necessary technical and professional staff who meet the public service requirements of the Industrial Property Registry. These staff members shall be paid out of the funds of the Administrative Board, for the period stipulated or indefinitely. The staff contracted under this arrangement shall not form part of the civil service system.

The Administrative Board of the National Registry shall issue regulations to establish a special system for hiring outside staff, with a view to guaranteeing the suitability, honesty and impartiality of their functions. **(Article added by LAW No. 8632 of March 25, 2008)**

**Article 37.– REPEALED.**

**(repealed by LAW No. 8039 of October 12, 2000, Art. 73)**

**Article 38.– REPEALED.**

**(repealed by LAW No. 8039 of October 12, 2000, Art. 73)**

**Article 39.–** The benefits granted by this Law shall not apply in respect of the goods and services which the State or its institutions import in the form of donations or payments in kind.

### **Article 40.– Regulations**

1. The Executive shall enact the Regulations under this Law within a period of six months.
2. The Regulations shall set the fees authorized by this Law, on a proposal by the Administrative Board of the National Registry.

### **Article 41.– Entry into force. Provisions repealed**

1. This Law shall enter into force one month after its publication.
2. The Law shall constitute public policy and shall repeal Chapter VI of Articles 66, 67 and 71 of Law No. 40 of June 27, 1896, Articles 2 and 3 of Law No. 6219 of April 19, 1978, and any other provisions which are contrary to it.
3. Any provisions to the contrary in existing international agreements shall remain unaffected.

### **TRANSITIONAL PROVISIONS**

- I. Processing of applications that were pending when this Law came into force shall continue until a final decision has been taken in accordance with the provisions of the laws thus repealed.
- II. Applications received when this Law comes into force shall be numbered according to the existing numbering system, and shall also be processed with the particulars of entries.
- III. The registry books shall continue in the same way and the current order, but the Registry shall provide a new series of books for the recording of industrial designs and utility models, with initial numbering solely for these entries.
- IV. **The herbicide Propanil is hereby declared to be of public interest and shall thus be free for import and sale.**
- V. Any reductions in production costs due to the entry into force of this Law shall be passed on to the final good which reaches the consumer. The Consumer Protection Office is hereby authorized to enforce application of this transitional provision.

### **TRANSITIONAL PROVISIONS OF LAW NO. 8632 of March 25, 2008**

#### **TRANSITIONAL PROVISION I.**

The Executive is hereby given a period of one year, beginning from the publication of this Law, to establish the necessary procedures for the implementation of the provisions contained in paragraphs 2 to 5 of Article 17 of Law No. 6867, of April 25, 1983 on Invention Patents, Industrial Designs and Utility Models.

#### **TRANSITIONAL PROVISION II.**

The provisions contained in paragraphs 2 to 5 of Article 17 of Law No. 6867, of April 25, 1983 on Invention Patents, Industrial Designs and Utility Models shall apply to all patent applications filed within the 12 months following the date of publication of this Law.

#### **TRANSITIONAL PROVISION III.**

The requirements set out in Article 82 of Law No. 7978 of January 6, 2000 on Trademarks and Other Distinctive Signs shall apply to all pending applications for the recording or related treatment of any intellectual property right being processed.

#### **TRANSITIONAL PROVISION IV.**

The provisions of Article 34bis of Law No. 6867 on Invention Patents, Industrial Designs and Utility Models shall apply retroactively to all pending applications for the recording of any intellectual property right being processed.