



ADVERTISEMENT OF INSTRUCTIONS concerning patent applications

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Abbreviations:

The Patent Office uses the following abbreviations for current law and regulations in the field of patents:

PA = Patent Act no. 17/1991

RCPA = Regulation Concerning Patent Applications, etc., no. 574/1991

AICP = Advertisement of Instructions Concerning Patent

Applications, no. 575/1991

The Icelandic Law and Ministerial Gazette B, no. 575/1991

Advertisement of instructions concerning patent applications

PART I General instructions

Section 1

The provisions of paragraph 3, section 1 of the Regulation concerning patent applications (RCPA) regarding the range of application of the said Regulation shall also apply to these instructions.

Section 2

(No provisions under this section)

Section 3

The provisions of section 45–50 RCPA shall apply regarding the operating practices of the Patent Office as a receiving authority under the Patent Cooperation Treaty.

The Swedish Patent Office shall be the international novelty search institution for international applications received by the Patent Office. If a request is made for novelty search of an international application, a translation in one of the Nordic languages or English shall be submitted.

PART II The patent application

The application and accompanying documents

Section 4

Patent applications shall be made on the application form printed for this purpose and shall be submitted in duplicate.

Two copies of the description as well as of the drawings, patent claims and abstract shall be submitted. Amendments to these documents shall be submitted in duplicate.

Applications submitted by telefax or similar equipment shall be endorsed in the application form with the signature of the applicant or his representative.

Section 4a

If an invention concerns or contains a sequence of 10 or more nucleotides or unbranched sequences with 4 or more aminoacids the application shall be accompanied by a specification of each sequence (fragment).

The specifications shall be submitted as an addition to the description and shall be in accordance with existing standards and shall appear immediately before the claims.

The description

Section 5

The description shall commence on an unnumbered front page with a short and descriptive name of the invention and shall proceed as follows:

1) The *general section* in which the use of the invention and the state of the art to which the invention is related are made known. A report on the state of the art shall be supported by references to publications which discuss the art concerned and which the applicant is familiar with. In particular the invention's contribution in light of known technology and the solution required to achieve the desired results shall be made known. The aforesaid discussion shall be consistent with any declarations made in the claims and may in this context refer to them.

If the practical exploitation of the invention in business or industry is not obvious this shall be explained in the description.

2) The *special section* in which a detailed description is given of the invention and in which examples are provided of at least one way of carrying out the invention, with reference being made to drawings where appropriate. The invention shall be described sufficiently with examples for the claims to be considered adequately founded.

If reference is made to drawings it shall usually be necessary to publish a list of drawings in the introduction of this section of the description.

Section 5a

Micro-organisms which are described in a publication available to the public may be identified by their category names, and if considered necessary for clarity, by reference to the publications in which the systematic analytical process is described.

Micro-organisms which have not been described before shall be identified distinctively in order to avoid confusion with other micro-organisms.

Micro-organisms shall generally be described in the style used in recognized specialist publications in this field.

In the case of micro-organisms available to the public, information shall be given on how a sample of the micro-organisms may be obtained.

Section 6

If several independent claims are included in the patent claims, the description shall deal with each invention in the independent claims in the manner indicated in section 5. Items in dependent claims (execution) for which protection is requested shall also be dealt with in the description to the extent considered necessary for assessment of the claim. It is sufficient that such discussion appear in the special section of the description.

Section 7

Invented names shall not be used.

Trademarks may be used in exceptional circumstances where it is difficult to differentiate a related product with a recognized name. In such cases the fact that the term used is a trademark shall be indicated. If the trademark is registered in Iceland this shall be indicated, where possible, with the symbol ® The design and features of the product shall always be clearly described.

Section 8

The description and drawings shall be kept apart on separate sheets of paper. Tables and chemical or mathematical formulae may appear in the description.

Section 9

Where reference is made to published data the instructions under section 83 shall apply.

Patent claims

Section 10

A patent claim shall include an introduction in which the items detailed in subsections 1 and 2, paragraph 1, section 14 RCPA appear, followed by a characterizing section in which items detailed in subsection 3 of the aforesaid section appear. The characterizing section shall begin with the words "characterized by" or other comparable expression.

Other formats for the patent claims may be permitted in special circumstances, e.g. in the case of use claims.

Section 11

Details shall be given in each patent claim of the technical characteristic features which are necessary to achieve the intended results.

Section 12

A product shall usually be identified by a description of its composition, and an apparatus or machine by a description of the design features of each component. An invention may further be distinguished by describing the function of individual components if it is not easily possible to describe the invention effectively in any other way. Products, particularly in the field of chemistry, may, in the case of serious problems of definition, be distinguished by describing the production process ("product-by-process") and if necessary by stating other characteristic features of the product.

Section 12a

Micro-organisms which have previously been described shall be identified by their category names.

Micro-organisms which have not previously been described may be identified in the description by direct or indirect reference, preferably in the form of category names, to the section of the description which deals with their biological features.

Section 13

When a patent application is made for substances or compounds of substances which are considered known as individual substances, and appeal is made to the fact that such a substance or compound of substances is used for the first time in the processes referred to in paragraph 3, section 1 of the Patent Act, the use shall be explained in the patent claims.

Section 14

A process shall be identified by describing its prerequisites (e.g. preparations, equipment, etc.) and its full cycle. (See Appendix II for more detail regarding patent applications relating to pharmaceuticals.)

Section 15

In claims relating to use, specific information shall be provided regarding the particular purpose for which the product, substance, equipment etc. or relevant process is used. If necessary, more specific information shall be provided regarding the product or process.

Section 16

Several independent claims, unrelated to each other, e.g. a claim relating to a product or a claim relating to a process, may be presented in the same application, notwithstanding that the inventions are explained, according to the presentation of the claims, with descriptions which are comparable in technical respects.

Section 17

Several independent claims of the same type (which relate to the same claim class) shall only be presented, if there are obvious problems in providing a precise enough description of the inventions, e.g. with different examples, if they were combined in the same patent claim. An invention of the type "sender-receiver" may also be explained in separate independent patent claims.

Section 18

An independent claim may be presented parallel to another independent claim. This shall apply in cases where an application contains independent claims which are related to each other in the manner referred to under section 48. A parallel and independent patent claim shall include a complete description of the invention in question. A parallel and independent patent claim may be linked to another claim. Dependent claims shall be placed immediately following those independent claims to which, directly or by linkage to other dependent claims, they refer.

Section 19

Dependent claims shall not deal solely with self-evident or simple and obvious solutions regarding design or process technology. An inventory which merely lists examples of obvious items shall not be permitted in the patent claims.

Section 20

In the introduction and characterizing section of a patent claim cross-reference shall be made to drawings (cross-reference symbol in brackets). However, notwithstanding the cross-references, the claim shall contain a clear explanation of the subject-matter for which protection is requested. Generalized comments such as "as has been described" or "as shown in the drawing" shall not be used in patent claims. In exceptional circumstances reference may be made directly to a graph or similar information presented in a drawing.

Trademarks shall usually not appear in patent claims.

The abstract (paragraph 3, section 8 PA and section 18, RCPA)

Section 21

Abstracts shall be produced in such a way as to be of optimum assistance for novelty search in the technical field in question.

The abstract shall contain a short overview of the contents of the description, patent claims and drawings. The abstract shall state the technical field to which the invention relates. An abstract shall be worded in such a way that the following are easily understood: the technical problem the invention relates to, the fundamental features of the solution which the invention entails and in particular the main use of the invention. The abstract shall, where appropriate, contain the chemical formula which, among those contained in the application, best characterizes the invention. The abstract shall not discuss the potential advantages of the invention nor make claims as to its value or potential for scientific use.

The abstract shall be intended to aid individuals in deciding whether they need to study the application itself or the patent itself.

The abstract shall not exceed 150 words.

Section 22

If drawings accompany the patent application the applicant shall state in the application form which drawing he wishes to appear with the abstract. If he fails to do this or if the Patent Office deems another drawing to have more explanatory value than the one selected by the applicant, the drawing selected by the Patent Office shall be published with the abstract. If the Patent Office considers it entirely unnecessary to publish a drawing with an abstract, no drawing need be included. Where technical characteristic features are explained in the abstract and also appear in the drawing, a cross-reference shall be provided in brackets after each main feature.

Drawings

Section 23

Drawings shall be executed on A4 paper. If there are more illustrations than can be fitted on one sheet, further sheets shall be used. To aid reprinting or duplication, e.g. offset printing, one copy shall be on strong, white, matt, opaque paper or other durable material. The area covered by drawings shall not exceed 26.2x17.0 cm. There shall be no frame or boarder around the paper. The minimum margins shall be 2.5 cm top and left, 1.5 cm right, and 1.0 cm at the bottom.

Drawings shall not be folded or fixed together.

Section 24

The drawing shall include those items which are necessary for the understanding of individual parts of the description and these parts shall be identified with the same letters of the alphabet or numbers in both the description and the drawing. No reference signs other than appear in the description shall be used in the drawing and signs shall not be used to a greater extent than is necessary for the clarity of the description. The drawing shall not contain explanatory comments, except for brief explanations such as water“, steam“, section A–B“ or closed“. In charts or graphs which show a production cycle or in diagrams of electrical circuits descriptive symbols shall be used which are immediately comprehensible.

Section 25

The illustrations and text of the drawings shall be executed in durable, clear black lines without color.

All cross-sections shall be hatched. All printed symbols (numerals or letters of the alphabet) on the drawings shall be clear and printed in an easily readable script. Illustrations and printed symbols shall be suitable for offset printing and for reduction in size by 15%. In the case of complex illustrations, detail shall

not be such that the drawing becomes unclear. Illustrations shall be separated from each other by a suitable space. Illustrations shall, regardless of the number of pages, be numbered consecutively, or if deemed convenient, with letters of the alphabet or both letters and numerals, preferably in the same order as the illustrations appear in the drawing. Identical items of the same type shall be labeled with the same symbol in all the illustrations.

Specific provisions concerning the description, claims and abstract (section 4, RCPA) and accompanying documents

Section 26

The description, claims and abstract shall be submitted in black print on strong, opaque, white A4 paper suitable for offset printing with 15% reduction. The text shall have line spacing of 1 1/2, a 2.5–4 cm left margin and 2–4 cm top margin. The text shall be justified with a right margin of 2–3 cm. There shall be a similar space at the bottom of the page. Only one side of the paper shall be printed. The text shall have a uniform appearance and individual characters shall be clear and distinct. Hand-written symbols or formulae shall be in black.

The expression “*characterized by*” or other comparable expressions shall be printed as shown (with spaced type).

Pages for the description, claims and abstract shall be numbered consecutively with Arabic numerals. Page numbers shall be centered at least 2 cm from the upper edge of the page without full points or dashes before or after. Every fifth line of the description and claims shall be numbered at least 2.5 cm from the left edge. The patent claims may be printed on a separate sheet. The abstract shall be printed on a separate sheet.

If amendments are made to a particular copy of the description which is intended for laying open for public inspection the said amendments shall be executed in such a way (e.g. by pasting over or erasing text) that they are not visible in the offset printed version.

Section 27

All units of measurement shall be metric (SI) or, where measurements are provided in other units the SI equivalent shall be given in addition. Temperature shall be indicated in degrees Celsius or, if appropriate, in degrees Kelvin. Density (specific gravity) shall also be indicated in metric units. International norms shall be adhered to when indicating mathematical formulae and units for the measurement of electricity, heat, energy, sound, light and magnetism. In the field of chemistry generally recognized symbols shall be used for atomic weight, molecular and/or structural formulae. In other respects, only technical terminology, signs and symbols which are generally used in the field in question shall be employed.

Section 28

Letters to the Patent Office shall be executed on white paper of a size not larger than A4. The application number shall preferably be indicated on the first page of the letter.

Models etc.

Section 29

Models and any samples shall only be submitted if such is considered essential for the understanding of the description. Accompanying items of this sort shall usually not be returned.

Authorization of representatives

Section 30

If an applicant is not resident in this country he shall be obliged to appoint a representative who is resident in Iceland and who is able to represent him in all matters related to the application.

An applicant who is resident in this country may appoint a representative.

Section 31

A representative shall be granted authorization either through the filing of a special document (deed of authorization) signed by the applicant or by including the authorization in the application form (subsection 2, paragraph 3, section 2 RCPA). The deed of authorization shall contain information on the name, home and postal address of the applicant and of the person to whom authorization is granted, as well as the name of the invention and/or the application number.

Where general authorization is granted this shall be referred to in every application to which it applies.

Section 32

If a representative is also empowered to receive a summons or other notifications relating to a possible patent, cf. section 66 PA, this shall be stated in the authorization.

Priority claim and its implications

Section 33

A claim of priority (cf. section 6 PA) which is made after an application has been filed shall be made by special request. The request shall be submitted within 3 months after the effective date of the application and shall include the information referred to in section 10 RCPA.

Section 34

If a certificate and copy as referred to under paragraph 1, section 11 RCPA is filed with the Patent Office together with a previously or simultaneously filed patent application, and the applicant refers to these documents or requests priority on the basis of an application which was filed in this country, the said certificate or copy shall only be filed if the Patent Office so requests.

Section 35

If an application has a valid claim of priority when the application becomes available to the public in accordance with section 22 PA, the content of the said application shall be considered known to the extent that the content appears in the priority document (cf. paragraph 2, section 2 PA) as of the priority date.

Section 36

The withdrawal of a priority claim shall be filed in writing.

International novelty search

Section 37

The requirements of format which apply for international patent applications also apply, *mutatis mutandis*, for patent applications for which an international novelty search is requested.

If a patent application is not in a language recognized by the international institution dealing with the novelty search (i.e. the Swedish Patent Office) a translation in Swedish, Norwegian, Danish or English shall accompany the claim for an international novelty search.

Translation of documents accompanying the patent application (sections 3 and 52 RCPA)

Section 38

The description, patent claims and abstract of patent applications shall be in Icelandic. Other documents may be in Icelandic, Danish, Norwegian, Swedish or English, cf. however section 40.

If documents in a foreign language are filed with a patent application in order to clarify the invention, a description, claims and abstract in Icelandic shall be filed within the prescribed time limit. The Icelandic text shall be a certified translation of the foreign documents. In lieu of this, the applicant or his representative may, however, make a declaration that the Icelandic text corresponds to the foreign documents, on condition that the said documents are in Danish, Norwegian, Swedish, English, German or French.

Section 39

The translation of the description, patent claims and abstract referred to in section 31 PA shall be certified.

It shall not be necessary to translate that part of the application which an international searching authority deems to relate to another independent invention, except where the Patent Authority requests such translation, provided the applicant has not paid additional fees for the application to the international authority in question (section 17(3a) PCT). The translation may further be limited to that part of the application which has been proceeded with after amendment instituted by the International Bureau (section 19(2) PCT). It shall not be necessary to translate any part of an international application which is not proceeded with after amendment by the International Bureau (Rule 66 PCT) or due to the exception provisions in paragraphs 2–4, section 1 PA or paragraph 2, section 75 PA.

If an applicant wishes to avail himself of the opportunity referred to above to except a particular part of the application from translation, he shall make a declaration clearly detailing which part of the application is excluded in the translation. The declaration shall also include a statement of the reasons for exclusion.

Section 40

Documents relating to patent applications and filed with the Patent Office (e.g. application form, opposition and responses) may be received notwithstanding that they are in English, French or German if there are significant reasons and if there is no objection from other parties to the case.

If other documents accompanying a patent application (namely, deed of authorization, document of assignment and priority document) are in English, French, German, Danish, Norwegian or Swedish, a translation into Icelandic shall not be required unless considered essential in individual cases. If the said documents are in a language other than the languages referred to here above, an Icelandic translation shall be filed unless the Patent Authority deems it possible to make an exception in this case.

Section 41

Translations requested under sections 38–40 shall be certified by the translator or by those responsible for the translation, unless the Patent Authority decides in individual cases that another form of certification shall be filed.

PART III The processing of patent applications

Errors subject to immediate rectification

Section 42

Applicants shall be required by letter (notification of error in format) to rectify the following errors:

- 1) The signature is missing from the application.
- 2) The application fee has not been paid in full.
- 3) The special fee for application by telefax has not been paid.
- 4) The name(s) of the inventor(s) is not indicated.
- 5) The name and address of the representative in this country is not indicated.
- 6) In the originally filed accompanying documents, the description, patent claims or abstract are missing or they have not been translated into Icelandic; or a drawing referred to in the description, patent claims or abstract is missing; or similarly, the format or presentation of the aforementioned documents is such that a novelty search clearly cannot be commenced.

Notifications of formal errors are to be communicated as quickly as possible after the application has been filed and prior to the application becoming subject to novelty search. The notification shall indicate that the application may be shelved or refused if the errors are not rectified (paragraph 2, section 15 and section 16 PA).

If accompanying documents which the applicant has inventoried are missing the said applicant shall be notified immediately. The same applies if the applicant has failed to provide documentary proof of his title to the invention or in the case of formal errors in the deed of transfer.

Section 43

If it is clear that the documents which were filed at the start are so deficient that the original filing date of the application cannot be maintained, a notification shall be made to this effect. In such a case the applicant shall be informed of the possibility of postponing the effective date in accordance with section 14 PA.

Section 44

Applicants shall be advised to consult specialists if the presentation of the documents is such that assistance appears necessary.

Section 45

If a communication is received indicating that the application has not been withdrawn and, in addition, the errors referred to in paragraph 1, section 42 have not been rectified, a decision on the issue shall be taken as quickly as possible, unless there is considered to be reason to send the applicant a new notification.

Unity of invention

Section 46
(No provisions under this section)

Inventions based on a single type of claim

Section 47

In addition to the subject-matter dealt with in an independent claim it is possible in a dependent claim (cf. subsection 2, paragraph 2, section 15 RCPA) to bring to attention more specific explanations and emphases designed to increase the technical influence of the invention or other further effects related to the invention according to such an independent claim. The additional information shall however be in accordance with the provisions of section 10 PA. In the case of combined inventions only dependent claims relating to particular forms of the components from which the invention is made shall be made if such form is important in order to bring the combination to work.

Inventions based on several types of claim

Section 48

The requirement for unity of inventions under section 16 RCPA shall always be considered fulfilled if the application contains the following:

- 1) in addition to an independent claim which states a product, an independent claim relating to a particular process for production of the product, and an independent claim which designates the use of the product, or
- 2) in addition to a an independent claim which states a process, an independent claim relating to specially developed equipment for the execution of the process, or
- 3) in addition to an independent claim which states the product, an independent claim relating to a particular process for production of the product and an independent claim relating to specially developed equipment for the execution of the process.

The processing of applications in relation to unity of invention

Section 49

If the subject-matter of an application is obviously deficient in the sense that it does not fulfill the requirements of unity of invention, the applicant shall wherever possible be notified and the application corrected prior to the commencement of the novelty search.

If the Patent Office issues a notification to the effect that the application, for example, covers two inventions, A and B, which are independent of each other, the applicant shall not limit his application first to A and later, when it transpires that the said invention is already known, change the application so that it applies to B. In addition, an applicant shall not, in order to keep such a possibility open, align the application equally with A and B.

When an applicant has limited the claims at the request of the Patent Office concerning the unity of the invention, it shall be held that he has once and for all withdrawn that invention or those inventions which have been excised from the claims through the limitation.

Section 50

If no international novelty search or international preliminary examination has been carried out on the patentability of part of an international patent application due to the fact that the application is deemed to relate to independent inventions, and if the applicant has failed within the prescribed time limit to pay the

surcharge prescribed in sections 17(3a) or 34(3a) of the Patent Cooperation Treaty, the Patent Office shall examine whether the application designates inventions which are independent of each other. If such is the case, the part of the application which has not been subject to novelty search shall be considered withdrawn as far as Iceland is concerned unless the applicant pays the prescribed surcharge within 2 months from the time that the authority notified the applicant of the conclusion of the examination. If the authority considers that the application does not designate inventions which are independent of each other, the application shall be proceeded with (section 36 PA).

If an applicant requests protection for an independent invention in an international patent application, the application shall be divided (section 22 RCPA) and the applicant shall pay a new application fee notwithstanding that the surcharge referred to in paragraph 1 has been paid.

Amendments to an application

Patent claims (section 19 RCPA)

Section 51

Numerical data and other symbols intended to explain the invention substantively may only be added to the claims if it is possible to show technically that such have foundation in the basic documents. Amendments may, however, be made to claims if such amendments regard corrections of printing errors or obvious translation errors, on condition that such amendments are likely to describe that which was initially intended (e.g. in respect of understanding of the subject-matter of the original text or the content of a possible priority document or the like).

Section 52

In applying paragraph 2, section 19 RCPA, the technical relationship rather than the formal relationship, i.e. the unity of the invention in light of the problem in question and its solution, shall be the principal criterion. Amendments regarding variants of the claims may be approved provided that there is a technical relationship and that such amendments have foundation in the basic documents.

Claims which are amended in violation of the provisions of paragraph 2, section 19 RCPA may be separated from the application through division or excision.

The description

Section 53

An applicant may only make amendments and additions to the description and accompanying drawings, including the addition of further examples of the carrying out of the invention, if such amendments and additions are considered essential for more precise explanation or correction or in order to bring a description into line with new or amended patent claims. Such amendments and additions shall not be so made that they suggest that the patent claims are more extensive or relate to something other than that which has foundation in the basic documents.

Section 54

When an applicant files a new copy of a description he shall also file a declaration indicating in what respect the wording of the description is different from that of the earlier description and specifying the filing date of the earlier description. In addition the declaration shall also indicate to what extent the said amendments have resulted in the addition of new subject-matter. Such a declaration may be approved without further investigation, as long as there is no reason against this.

Section 55

Minor amendments of the description, together with the date of the amendment and the author of the amendment shall be stated in the margin of the new copy.

Postponement of the effective date

Section 56

If the applicant, prior to the expiry of 6 months from the application date, amends the application in such a way that the original application date cannot be maintained for the application as a whole, he may decide either to excise the new amendment from the application or request that the application as a whole be considered to have been filed on the date on which the said amendment was submitted to the Patent Office (postponement of the effective date). If the applicant requests postponement of the effective date the necessity for such shall not be investigated.

When a request has been made, or would be made, for the postponement of the effective date as a result of an amended application, the application shall be processed in the same way as other applications in respect of the invention as a whole, amendments to claims, etc. The new effective date shall be the basis for processing of the application. If the application has been subjected to a novelty search prior to implementation of the amendment, in the case of the invention as a whole, the provision of paragraph 2, section 19 RCPA shall not prevent the applicant from having a novelty search carried out on amendments to claims in the same application. If an application which still has not been subject to a novelty search no longer fulfills requirements for the invention as a whole and this is due to an amendment which was implemented within six months from the application date, the requirement of invention as a whole shall be fulfilled before the novelty search is carried out (section 49).

When a postponement of the effective date has been requested, the provisions concerning basic documents shall apply to the documents submitted in the case documentation on the new effective date.

If an applicant has requested postponement of the effective date the abstract shall be based on those basic documents which are valid from and including the new effective date.

Section 57

If postponement of the effective date is requested for an application which has priority, cf. section 10 RCPA, priority shall be cancelled if the new effective date is moved to a date after the expiry of the year of priority.

Division and excision*General*

Section 58

Division occurs when a part of the basic documents (cf. section 21 RCPA and section 11 PA) of an application (parent application) is submitted as the basis for a new independent application (section 22 RCPA).

Section 59

Excision occurs when material which has no foundation in the basic documents of an application is added to a description, claims or in some other way and this is submitted as the basis for a new independent application (section 23 RCPA).

Section 60

There must be an unbroken continuity between a parent application and an application which results from division or excision. A new application may not, therefore, be filed after a final decision has been taken regarding the parent application. Division and excision shall therefore proceed prior to the granting of a patent on grounds of the parent application. If the parent application is refused or shelved, division or excision may proceed within the time limit for appeal or request for reopening of the case, regardless of whether the conclusion is appealed or the case reopened.

Section 61

If an application is divided in accordance with paragraph 2, section 22 RCPA, the time limit prescribed in that section shall apply for 4 months after the said limitation to the parent application is made. In such cases a parent application shall not be approved for laying open to public inspection, be refused or a decision relating to an opposition made prior to the expiry of the said the time limit.

Section 62

In an application resulting from division or excision, the description together with accompanying drawings and patent claims which were filed on the same date as the application form for the new application shall be considered the basic documents of the application (section 24 RCPA). Once such basic documents for the application, as described above, have been filed, data from the parent application shall not be added to the said application (cf. section 19 RCPA).

Section 63

In the case of division or excision the applicant shall state on which part of the parent application the claims in the new application are based (cf. paragraph 1, section 19 RCPA).

Furthermore, the applicant shall state in the parent application that division or excision has taken place.

Section 64

If a priority document refers to an invention which is not disclosed in the basic documents (cf. section 21 RCPA) the applicant shall be deemed to have withdrawn that invention of his own free will. The application shall not extend to such an invention and thus division and excision shall not be applicable. This shall apply regardless of whether the priority document is filed prior to, at the same time as or after the filing of the basic documents.

Authorizations regarding division or excision

Section 65

If an applicant has a representative, a deed of authorization shall be filed with each new application in the case of division or excision. In lieu of a new deed, a photocopy or duplicate of the authorization accompanying the parent application may be filed.

General accessibility of applications

Section 66

An 18 month period of secrecy under paragraph 2, section 22 PA shall commence on the filing date, or on the effective date if this is different from the filing date (i.e. in the case of division, excision or postponement of effective date in accordance with section 14 PA), or on the priority date when priority is requested in part or in full. If priority is requested on the basis of several applications the period during which the application shall be kept secret shall be deemed to commence from the first day of priority. The period of secrecy shall terminate at closing time of the Patent Office on the calendar date corresponding to the first day

of the period of secrecy. If the said calendar date does not occur in the month in question the last day of that month shall be the day of termination.

Section 67
(No provisions under this section)

Substantive processing of an application

Section 68

Independent claims shall be examined both for novelty and for patentability in other respects. Dependent claims shall usually only be examined in this way when circumstances put in question the patentability of the subject-matter stated in them or in independent claims which the dependent claims relate to.

Information on the results of the examination of an invention's patentability in another country

Section 69

When the Patent Office requests information regarding results of the examination of the patentability of an invention in another country, the applicant shall be granted a period in which to provide such information. At the request of the Patent Office the applicant shall also submit, within the prescribed time limit, a certified copy of the notification from the foreign authority regarding novelty of the invention and patentability in other respects or a declaration that he has received no notification in this regard (section 29 RCPA).

If the applicant fails to submit the result of the examination as required or to submit the said declaration, the application shall be shelved in accordance with section 15 PA. If an applicant refuses to file the result of the examination, the application shall be refused in accordance with section 16 PA.

Unclear applications

Section 70

If the subject-matter for which the applicant requests protection is not clearly indicated in the application documents, or the invention is insufficiently described, the applicant shall be encouraged to file a new and clearer description together with claims prior to the commencement of the novelty search (cf. paragraph 2, section 8 PA and section 14 PA).

Novelty search

Section 71

A novelty search shall be carried out on the basis of the material referred to in section 26 RCPA.

The initial search shall be sufficient to enable a decision to be made as to novelty. It shall not always be necessary to examine all available material and the search may be terminated when sufficient evidence is considered to have been acquired for assessment of the patentability of the invention. (Execution of the novelty search is further dealt with in Appendix I.)

Section 72

The novelty search shall extend to the date on which the application is filed. This also applies when priority is claimed.

Section 73

If the result of a novelty search carried out abroad has been communicated this shall result in limitation of the novelty search in this country with reference to the following: If the result of a novelty search originates from another Nordic state it shall usually be sufficient in addition to examine Icelandic material. If an international search report is available, including a novelty search of an international nature, the result of a novelty search done at EPO (European Patent Organization), from France, Germany, the Netherlands or Austria, the search shall usually be deemed sufficient when, in addition, Nordic material has been examined. If a result of a novelty search originates from the United Kingdom or the United States of America, in normal circumstances it shall be sufficient for the search to cover other material for which a search is obligatory (section 71).

*Novelty search with reference to earlier applications
which have not been made available to the public*

Section 74

If an invention which is the subject of a patent application is not new in regard to material in an earlier Icelandic application which has not been made available to the public, and if the application has not been refused on other grounds, the general rule shall be that the final processing of the application shall be suspended until the earlier application has become available to the public in accordance with section 22 PA, or until a final decision has been taken in regard to the said application within the time limit prescribed in that section.

The same shall apply in respect of material in an earlier international patent application which shall become valid in Iceland if the authorities are aware of the subject-matter of such an application. The final processing of the later application shall be continued when the international application, after transfer to Iceland, becomes available to the public in accordance with section 22 PA or lapses in respect of Iceland.

In both the above mentioned cases the applicant shall be informed of the possibility of an overlap.

Section 75

The basic documents in a patent application (section 21 RCPA) are considered novelty destroying according to subsection 2, paragraph 2, section 2 PA from the priority date, to the extent that their subject-matter has a basis in the priority document, or otherwise from the filing date.

The abstract and other application documents (additions to the description, written responses, priority documents) are novelty destroying from and including the date on which the documents became available to the public, cf. section 22 PA.

The aforesaid also applies to international patent applications proceeded with in this country.

Priority

Section 76

If the proprietor of an application upon which priority is based applies for a patent with other parties there shall be no requirement of confirmation that the latter enjoy priority. If the applicant for a patent in Iceland is an applicant with others in an application on which the priority of the Icelandic application is based, an assignment document shall be required from the latter.

Section 77

The scope of an application may be extended in respect of the subject-matter of the priority document (partial priority) without canceling the priority. Priority shall extend to all subject-matter indicated in the priority document, regardless of whether this is indicated in the claims or not. If an application and claims subsequently filed by the same applicant extend to matter which is disclosed only in the description

(drawings) of the earlier application, the said application shall not be considered the first filed application in the Convention state, except with the fulfillment of the conditions under paragraph 2, section 12 RCPA.

The basic documents shall also be used as a basis in the processing of an application for which priority is claimed. It shall therefore not be possible to add new matter to an Icelandic application by appealing to the priority document (cf. section 64). Obvious errors and printing errors may, however, be corrected for the sake of consistency with the priority document.

*Examination of description prior to the application being approved
for laying open to public inspection*

Section 78

Once it seems possible to approve the patent claims the description shall be checked before the application is laid open to public inspection. This shall entail a check of whether the description fulfills requirements of form, whether it is consistent with the claims and whether it includes necessary examples of the carrying out of the invention. Other changes or corrections of the description and drawings shall not be required except in so far as they are necessary to enable a specialist to understand the invention (inventions) with the aid of the aforementioned documents. Comments shall not therefore be made regarding wording, technical concepts, etc. except in order to avoid misunderstanding. Furthermore, it shall not be necessary to check whether all symbols in the drawings have been explained in the description.

Classification

Section 79

Patent applications shall be classified. Classification shall be according to the edition of The International Patent Classification current at the time and in accordance with The Guide. The edition is marked by a numeral after the abbreviation Int.Cl.“, which from 1 January 1990 inclusive is as follows: AIPlj.fl.⁵“(Int.Cl.⁵“).

Section 80

An invention or inventions which are disclosed in patent claims shall be classified.

If, in a patent application, new technical data are disclosed which are not part of the invention itself but which are considered worth conserving, such data may also be classified (optional classification). In a number of technical fields the classification system has been improved either by the appending of a list of identification codes or by the use of classification codes as identification codes (hybrid system). Identification codes are intended to be a kind of supplement to the classification and are intended to give more complete information, e.g. by indicating the principal components, process stages and areas of use of the item which is classified.

Section 81

The following applies for obligatory classification:

An invention shall, if possible, be classified as a unified whole and individual parts shall not be classified separately.

If it proves impossible to classify an invention (inventions) in one of the categories of the classification system further categories shall be used, so called multi-classification. The following are examples of cases in which multi-classification should be used:

- 1) when several independent claims are concerned which relate to inventions in different categories
- 2) when an independent claim relates to an invention which cannot be classified in one particular category, or

- 3) when claims relate to an invention which has potential for general use and can be used in one or more specialist fields, provided that the classification system contains both a general category and categories for specialist use.

Multi-classification shall be avoided in the case of subcategories which belong to the same superordinate category.

In the case of multi-classification the classification code of the division to which the invention mainly belongs shall appear first.

Section 82

A satisfactory classification code shall contain a code for the field, category, subcategory or division (main division or subdivision). A division code consists of two numerals separated by a slash. When an identification code is used a colon shall replace the slash.

The code for an obligatory classification shall be indicated first. After a double slash a suggested code for an optional classification shall be printed. In brackets, identification codes linked to the classification code shall follow and in the same brackets identification codes which have no such links.

In other respects the codes shall be separated from each other by commas or by brackets around the linked pairs of classification codes and identification codes.

If more than one classification/identification code relating to the same subcategory follow each other, the subcategory shall only be indicated once.

Examples of presentation and order of classification codes and identification codes (cf. Part 87 in the manual to the IPC system (The Guide)):

1. C 08 F 210/16, 255/04 // A 61 K 47/00, C 09 J 151/06
(C 08 F 210/16, 214:06) (C 08 F 255/04, 214:06)
2. B 29 C 65/08//B 29 K 83:00, B 29 L 23:18.

References to sources

Reports

Section 83

In reports novelty destroying documents shall be indicated in the following manner:

- 1) Patent documents:

The international code letters for the countries (WIPO/ICIREPAT), the nature of the document or possibly the document code indicated in the document, the number of the document, reference to relevant part of the document when appropriate.

Applications which have been made available to the public shall be listed with their application numbers as well as the number of the document which the application has referred to, where such is the case.

Example:

DE B2 2 124 745, column 7, lines 15–36.

FR patent document 985 216, pp.2, left hand column, lines 9–13.

IS application no.2462, cf. patent no. 1119.

- 2) Journals, series and abstracts:

Full title or generally cited abbreviation,

volume (year of issue),

number or issue,

publication date and place,

author,

title of article, number of pages and, when appropriate, more precise location of the relevant extract.

Example:

Phys., Rev. 75, 891–2(1949)

Melliand, Textilberichte, 1969, bind 50, Heidelberg, R. Grösser, Jacquard-einrichtungen an Grossrundstrickmaschinen“, pp.1436–1445, especially pp. 1443, line 1 in column 1-line 18 in column 2; illustration 19, 20.

CA 43, 2447 g.

3) Books and other publications, such as reports etc. which are not part of a series:

Name of the author or editor,

title of the publication,

edition and volume,

publisher,

publication place and year,

information on relevant pages.

Example:

H. Walton, Microwave Quantum Theory“, volume 2, Sweet and Maxwell, 1973, London, pp. 138–192, especially pp. 146–148.

4) Publications produced by companies:

Information shall be as detailed as possible, preferably the name of the company and its address, title of the publication, place and year of publication and number of pages.

Record of documents cited

Section 84

Prior to the laying open to public inspection a record shall be compiled of the documents which the Patent Authority has presented and used against the application in its processing (record of documents cited). Documents shall be listed in the record of documents used in oppositions in the same manner as in the reports. In addition the relevant classification code for the patent document which has been presented may be indicated, though only the first shall be indicated if there are several classification codes on the patent document.

Under exceptional circumstances and when there are special grounds for doing so, a particular document may be excluded from the record or a document may be added which was not used against the application. E.g. documents which have been presented erroneously and/or have been deemed irrelevant shall not be included; conversely, documents referred to in written replies from an applicant or in an application from which the application involved originates through division or excision may be included.

Section 85

If, due to a printing error, a case is proceeded with incorrectly in respect of e.g. country or number of the patent document, or number or page number of a journal cited, the error shall be corrected in the record of oppositions provided that the applicant is notified of the correction while the application is being processed. If such is not the case, the source may not be cited in the record.

Section 86

Sources shall be cited in the following order in the record: First, Icelandic patent applications which are available to the public shall be cited, applications which have been laid open to public inspection and granted patents, then published international and European patent applications or abstracts from them and finally patent applications, applications which have been laid open to public inspection and granted patents from other countries in alphabetical order of country. Patent applications, documents for the laying open to public

inspection and granted patents from the same country shall be cited in numerical order. Other sources shall be cited at the end of the record.

Patent applications which have been presented in accordance with subsections 2 and 3, paragraph 2, section 2 PA shall be indicated separately by the addition of »(PA section 2.2.3)« after the application number.

Section 87

When a patent application is filed the aforesaid record shall be printed in the document for laying open to public inspection under the heading Documents presented“. If new documents of opposition are presented after the laying open to public inspection, e.g. as the result of an opposition, they shall be added to the record if the patent is granted.

If no sources have been used this shall be indicated by a dash after the aforementioned heading.

Laying open of the application to public inspection

Section 88

When an application is approved for laying open to public inspection documents relating to it shall not be amended without prior notification to the applicant, except as regards obvious correction of form in the description or claims or as regards information which is otherwise unnecessary.

Section 89

If an application is ready to be laid open to public inspection in all respects except that documents suitable for offset printing are not available (sections 23 and 26), such documents, together with a declaration that the documents are entirely consistent with other previously certified documents, shall be filed at the latest when the fee for laying open to public inspection is due.

Section 90

In order for a request of postponement of laying open to public inspection to be considered (section 30 RCPA) such a request shall be submitted to the Patent Office together with a fee for laying open to public inspection within the time limit referred to in section 20 PA. The request shall be made in writing in a separate letter.

Oppositions

Section 91

Two copies of an opposition and accompanying documents shall be filed. Subsequent comments together with accompanying documents from the applicant and opponent shall also be filed in duplicate. In the case of amendments to the description and claims such accompanying documents shall be filed in triplicate.

Section 92

If an opposition is filed, an application shall always be subject to substantive examination. Before a decision is reached the examination shall take account of all matter disclosed, including matter which may have been disclosed in oppositions which were submitted too late or were withdrawn.

Section 93

If an opponent explains the grounds of his opposition (e.g. patents, specific public use) but does not give further evidence, he may be granted a period of time in which to submit more detailed evidence.

Section 94

The applicant shall receive copies of all correspondence and documents received from the opponent (section 35 RCPA). Correspondence with the opponent shall, however, be restricted to matter deemed indispensable and essential to the investigation of the case. The opponent shall only be given the opportunity to comment on the first reaction of the applicant regarding the opposition if circumstances warrant. The opponent shall not be given an opportunity to comment further unless special circumstances warrant (paragraph 2, section 35 RCPA).

When oppositions based on alleged public use are sent to an applicant the said applicant shall be requested to state to what extent he recognizes or rejects the justice of such information regarding public use received from the opponent.

The opponent shall be sent copies of correspondence to the applicant regarding the substantive examination of the case at the same time as they are sent to the applicant.

Copies of filed documents which a party to the case has not previously been aware of shall accompany such copies and the final decision in the case.

Section 95

If a verbal presentation is considered necessary for the processing of the opposition case, both applicant and opponent shall be summoned.

Section 96

Copies of the final decision shall be sent to both the applicant and the opponent. If it is deemed that the application shall result in a patent notwithstanding the opposition, the grounds for not considering the opposition shall be stated in the decision. Such a decision on the confirmation of the granting of a patent notwithstanding the filing of an opposition shall be unnecessary if the opposition is filed too late.

Section 97

If an opponent unequivocally withdraws his opposition or declares in writing that he no longer has any objections to the approval of the application, the said opponent shall be deemed to have forfeited his right to appeal any decision regarding the approval of the application.

Observation by a third party against the granting of a patent application

Section 98

If, in information submitted in writing in accordance with section 36 RCPA, reference is made to novelty destroying material other than public use the person responsible for the case shall immediately investigate whether there are grounds for commissioning a report on the case.

If the information relates to public use the main rule shall be that the case shall not be proceeded with prior to the expiry of the time limit for oppositions and only then if, in the letter of opposition, the information is explained.

Time limits

Section 99

Time limits granted under sections 100–103 shall commence from the date registered on the letter in question.

Section 100

The applicant has the following time periods before the laying open of his application to public inspection:

1. Errors in format of the application (cf. section 42)
if the application fee has not been paid..... 1 month
if the application fee has been paid 3 months
If errors in respect of the application fee relate only to the surcharge the latter time limit shall apply.
The surcharge shall be according to the rate in force at the expiry of the time limit.
2. First report regarding substantive examination 8 months
3. New report including new evidence against 6 months
4. Other reports..... 2–4 months
5. Request for presentation of the result of an examination of
patentability carried out abroad..... 3–6 months

Section 101

Time limits for responses in opposition cases:

1. Further evidence for the relevant opposition under section 93..... 2 months
2. Oppositions-the applicant's first response 6 months
3. Subsequent comments from the parties to the case..... 3 months
4. Possible measures by the Patent Office..... 2–4 months

Section 102

Time limit in which a case must be proceeded with under section 17 PA 2 months

Section 103

When special circumstances warrant other time limits than are described above in section 100–102 may be granted.

Time limits granted under section 100–102 shall only be extended if special circumstances warrant.

Entry into force

Section 104

This advertisement is published in accordance with section 37 of Regulation no. 574/1991 Concerning Patent Applications etc. accompanying Act no.17/1991. The Advertisement enters into force 1 January 1992 with the limitations referred to in section 58 of the aforementioned Regulation and its transitional provisions.

*Ministry of Industry,
2 December 1991.*

*On behalf of the Minister
Björn Friðfinnsson*

Helga Jóna Benediktsdóttir

Appendix I

Execution of novelty searches

1

The Patent Office shall sign an agreement with the Danish Patent Office (Patentdirektoratet) concerning assistance with examination of patentability and novelty search of applications, cf. paragraph 1, section 27 RCPA.

The agreement shall *inter alia* prescribe the time that shall usually elapse between the Danish institution's receipt of a request for examination and their provision of a result.

2

The provisions of sections 68 and 71–73 AICP and instructions provided by the Patent Office to the Danish Patent Institution shall apply to the execution of the examination.

In addition the Patent Office shall examine Icelandic material and other aspects within the scope of the Patent Act and accompanying Regulation, and shall take a decision on applications in the light of the results of the examination from the Danish Patent Institution.

3

All patent applications filed in this country shall usually be examined by the Danish Patent Office. An exception may be made, however, if the same or similar application has been filed at one or more of the Patent Offices in the other Nordic countries. In such a case the applicant shall, within 6 months from the filing date or effective date (cf. section 56 of these instructions), submit a declaration to that effect. The declaration shall also contain an undertaking to file the final result of the examination of patentability or novelty search regarding the application and, where appropriate, a certified copy of the granted patent.

The above exception does not apply to applications relating to pharmaceuticals.

4

For the purpose of examination in Denmark the applicant shall file a translation of the description, patent claims and abstract in Danish, Norwegian, Swedish or English:

- a) within three months from the filing date or effective date (cf. 56 of these instructions) if the application has not at the same time been filed in another country (basic application), or
- b) within six months from the filing date or effective date (cf. section 56 of these instructions) if in the said application priority is claimed on the basis of a foreign application.

Appendix II

Temporary provisions regarding the processing of patent applications relating to pharmaceuticals

1

The following transitional provisions apply to the execution of provisions of paragraph 2, section 75 of the Patent Act regarding inventions in the field of pharmaceuticals (as there is only authority for the granting of patents for particular production processes and not for the product as such).

2

If the novelty of the invention is considered to lie in the production process of the substance, the usual instructions for novelty search and examination of inventive step and unity of invention shall apply.

3

If the novelty of an invention is considered to relate only to the product, the claims shall be directed to an analogous process“. It shall then be possible to grant a patent for the production of a substance by chemical process even though there is nothing novel in the process as such that can be deemed patentable (i.e. is analogous to previously known chemical processes). The prerequisites for this are that the substance shall be new and that it contains, according to the description, unexpected and valuable features. The effectiveness of the substance and its use as a pharmaceutical shall be stated in the claims.

4

Other decisions regarding the unity of the invention shall not prevent the explication in the first independent claim of internally related diverse analogous processes (main reaction and by-reaction) for the production of one and the same pharmaceutical product. This product may be a chemical compound or group of chemical compounds with closely related chemical structure, i.e. their general formula is the same and the unexpected and valuable features are the same.

5

Claims shall usually only cover those analogous processes for which there are examples in the description.

6

The following are examples of by-reactions which may be included in the same patent as the main reaction:

- a) esterification from carboxylic acid
- b) salt formation from carboxylic acid
- c) etherisation of alcohol's
- d) acylation of alcohol's
- e) alkylation of amines
- f) acylation of amines
- g) salt formation of amines and formation of quaternary amino compounds
- h) hydrogen saturation of aliphatic double bonds
- i) oxidation of R-S groups for the formation of R-SO₂ groups
- j) reduction of carboxylic groups to aldehydes
- k) reduction of nitrogen groups to amino groups
- l) conversion of racemic mixtures to chiral isomers

7

Where conditions for the unity of invention are concerned, an application shall refer either exclusively to process or exclusively to analogous process. Prior to the execution of a novelty search the applicant, if necessary, shall state whether he is applying for protection of the invention as an analogous process or not.

8

Once the first novelty search report has been made, the applicant shall not alter a patent claim from an analogous process to a process unless this is done in a divided or excised application. If it transpires that the product is already known or that it has no unexpected or valuable properties the application shall be refused. However, alteration from a process to an analogous process may be made after the expiry of the above mentioned time limit.