

Patents Act

No. 17/1991, with amendments according to Acts No. 92/1991, No. 67/1993, No. 36/1996, No. 91/1996, No. 132/1997, No. 82/1998, No. 28/2002, No. 72/2003, No. 22/2004, No. 53/2004, No. 54/2004, No. 12/2005, No. 127/2005, No. 108/2006 and No. 167/2007.

PART I

General Provisions.

Article 1

Any person who has made an invention which is susceptible of industrial application, or that person's successor in title, may, upon application, obtain a patent which gives the holder the exclusive right to exploit the invention commercially. [Inventions are patentable in any field of technology]¹⁾

The principal innovations which are not considered to be inventions are those which concern exclusively:

1. a discovery, scientific theory or mathematical method;
2. an aesthetic creation;
3. a scheme, rule or method for performing mental acts, for playing games or for doing business, or a programme for a computer;
4. the presentation of information.

[The granting of patents for inventions involving surgical, therapeutic or diagnostic methods for humans or animals shall be prohibited. However, this shall not prevent the possibility of granting patents on devices and products for exploitation within these methods, including on substances and compositions.

A patent shall not be granted for plant or animal varieties. It is however possible to grant patents for inventions pertaining to plants and animals if the implementation of the patent is not confined for technical reasons to a particular plant or animal variety. In this Act, plant variety refers to a plant variety as it is defined in the Act on Plant Variety Rights, No. 58/2000.

A patent shall not be granted on an essentially biological process for producing plants or animals. By an essentially biological process, this Act refers to a method that on the whole is based on natural phenomena such as crossing and selection. Nonetheless, patents may be granted for processes in the field of microbiology or other technical methods or the products of such processes. Process in the field of microbiology refers to any method that exploits microbiological material or produces microbiological material.

An invention may be patentable even though it involves a product consisting of or containing biological material, or pertains to a method for producing, processing or using biological material. Biological material which has been isolated from nature or produced by a technical process may be considered an invention, even if it is found in nature. In this Act, biological material refers to material containing genetic information and capable of reproducing itself or being reproduced in a biological system.]²⁾

1) Act No. 22/2004, Art. 1 (a) (Valid from May 11 2004)

2) Act No. 22/2004, Art. 1 (b) (Valid from May 11 2004)

[Article 1 a

The human body in its various stages of formation or development and the mere discovery of any of its elements, such as nucleotide sequences or partial nucleotide sequences of genes,

cannot be considered patentable inventions.

Notwithstanding Paragraph 1, an element of the human body, including a nucleotide sequence or partial nucleotide sequence of a gene, which is isolated from the body or produced in another way by a technical process may be considered a patentable invention even if the structure of such an element is identical to the structure of a natural element.]¹⁾

1) Act No. 22/2004, Art. 2 (a) (Valid from May 11 2004)

[Article 1 b

A patent shall not be granted for a discovery if its exploitation for commercial purposes is contrary to ordre public or morality.

Exploiting an invention is not considered contrary to ordre public or morality for the sole reason of being banned by law or government regulations.

In consequence of the provisions of Paragraph 1, it is for instance impermissible to grant patents for:

1. processes for cloning human beings,
2. processes for modifying the genetic identity of human sex cells,
3. uses of embryos for industrial or commercial purposes or
4. processes for modifying the genetic identity of animals that are likely to cause them suffering without significant medical benefit from the methods for man or animal, nor patents for animals resulting from such methods.]¹⁾

1) Act No. 22/2004, Art. 2 (b) (Valid from May 11 2004)

Article 2

Patents may only be granted for inventions which are new in relation to what was known before the filing date of the patent application and which also differ essentially therefrom.

Everything made available to the public in writing, in lectures, by public use or otherwise shall be considered as known. Also the contents of a patent application filed in this country before said filing date shall be considered as known if that application becomes available to the public pursuant to Article 22. The condition in the first paragraph that the invention must differ essentially from what was known before the filing date of the patent application does not, however, apply in respect of the contents of such applications.

Applications, which are discussed in Part III, shall in certain cases have the same effect in this country as is discussed in Paragraph 2, cf. Articles 29 and 38.

The stipulation in Paragraph 1 that the invention shall be new does not prevent the granting of a patent for a known substance or a known composition of substances for use in a method referred to in Paragraph 3, Article 1, provided the use of the substance or composition is not known in methods of this type.

[Moreover, the stipulations in Paragraph 1 shall not hinder the granting of a patent for a known substance or known composition of substances specifically to be used in the methods mentioned in Paragraph 3 of Article 1, insofar as such use is not known.]¹⁾

A patent may be granted despite the fact that the invention was made available to the public within six months prior to the filing of the application,

1. in consequence of evident abuse in relation to the applicant or his predecessor in title; or
2. because the invention was displayed by the applicant or his predecessor in title at an official, or officially organized exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on November 22, 1928.

1) Act No. 53/2004, Art. 1 (Valid from June 14 2004)

Article 3

The exclusive right conferred by a patent implies that no person except the proprietor of the patent may, without the proprietor's consent, use the invention by:

1. making, offering for sale, putting on the market, or using products or equipment protected by the patent, or importing or possessing such items for these purposes;
2. using a process which is protected by the patent or, while knowing, or it being obvious from the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent, offering the process for use in this country;
3. offering, putting on the market, or using products made by a process protected by the patent or importing or possessing the product for these purposes.

The exclusive right also implies that no person other than the proprietor of the patent may, without his consent, exploit the invention by offering or supplying a person who is not entitled to exploit the invention with such means for carrying out the invention in this country which relate to an essential element of the invention, if the person offering or supplying the means knows, or it is obvious from the circumstances, that said means are suited and intended for use in carrying out the invention. If the means are a staple commercial product, this paragraph only applies if the person offering or supplying the means attempts to induce the receiver to commit acts referred to in the first Paragraph. In applying the provisions of sentences 1 and 2 of this paragraph persons using the invention in a manner specified in Paragraph 3, Points 1, 3 and 4, shall not be considered as entitled to exploit the invention.

The following are excepted from the exclusive right:

1. use which is not commercial;
2. [use of the product protected by the patent which is put on the market within the European Economic Area, within a member state of the incorporation of the European Free Trade Association or in the Faroe Islands by the proprietor of the patent or with his consent]¹⁾;
3. use of the invention for experiments which relate to the invention itself, [i.a. studies and trials and other related procedures that are necessary to make possible an application for marketing authorization for e.g. a generic medicinal product and an improved pharmaceutical form;]²⁾
4. preparation in a pharmacy of a medicine in accordance with a physician's prescription in individual cases or acts with the medicine so prepared.

1) Act No. 108/2006, Art. 32 (Valid from November 1 2006)

2) Act No. 12/2005, Art. 1 (Valid from March 22 2005)

[Article 3 a

A patent on biological material that has particular characteristics as a result of the invention shall extend to any biological material which is derived in the same or altered form by propagation or multiplication from that material and possesses the same characteristics.

A patent on a process for producing biological material that has particular characteristics as a result of the invention shall extend to the biological material produced directly by that process, as well as to any other biological material which is derived in the same or altered form by propagation or multiplication from the directly produced biological material and possesses the

same characteristics.

A patent on a product containing or consisting of genetic information shall extend to all materials that the product is a part of and that contain genetic information performing its function there, cf. however Article 1 a.

A patent as referred to in Paragraph 1-3 does not, however, extend to biological material obtained by propagation or multiplication of biological material [marketed in the European Economic Area, in a member state of the incorporation of the European Free Trade Association or in the Faroe Islands]¹⁾ by patent holders or with their consent if the propagation or multiplication is a necessary factor in the use for which the biological material was marketed, provided that the material obtained will not be used for further propagation or multiplication.]²⁾

1) Act No. 108/2006, Art. 33 (Valid from November 1 2006)

2) Act No. 22/2004, Art. 3 (a) (Valid from May 11 2004)

[Article 3 b

Notwithstanding the provisions of Paragraph 1-3 of Article 3 a, sales to and other commercial exchanges with farmers, on the part of the patent holder or by her/his consent, of plant propagating material for agricultural use may be regarded as approval of the farmers' using their harvest themselves for propagation and multiplication on their own land. The scope and conditions for this exemption shall be in accordance with provisions of the Act on Plant Variety Rights, No. 58/2000, as subsequently amended, and with regulations based on that Act.

Notwithstanding the provisions of Paragraph 1-3 of Article 3 a, sales to and other commercial exchanges with farmers, on the part of the patent holder or by her/his consent, of breeding livestock or other animal reproductive material may be regarded as approval of the farmers' being authorised to use the protected livestock in agriculture. This includes, among other things, farmers being allowed to use animals and other materials for reproducing animals in their agricultural operations but not being allowed to sell the animals or the materials as a factor in reproduction activity for commercial reasons or with such an aim. [The Minister of Business Affairs]¹⁾ shall issue a set of regulations on the scope and conditions for farmers' utilising such discoveries protected by patents.]²⁾

1) Act No. 167/2007, Art. 86 (Valid from January 1 2008)

2) Act no. 22/2004, Art. 3 (b) (Valid from May 11 2004)

Article 4

Any person who, at the time when the application for a patent was filed, was using the invention commercially in this country may, notwithstanding the patent, continue such use while retaining its general character, provided the use does not constitute evident abuse in relation to the applicant or his predecessor in title. Such right of use shall also be due on corresponding conditions to any person who had made substantial preparations for commercial use of the invention in this country.

The right according to the preceding paragraph can only be transferred to others together with the business in which it originated or in which the use was intended to take place.

Article 5

Notwithstanding the grant of a patent, an invention may be utilized on a foreign vehicle, vessel or aircraft when such a means of transport is in this country temporarily or by chance.

[The Minister of Business Affairs]¹⁾ may decree that, notwithstanding the grant of a patent, spare parts and other accessories for aircraft may be imported into this country and used here for repair of aircraft of a foreign country in which corresponding privileges are granted to Icelandic aircraft.

1) Act No. 167/2007, Art. 86 (Valid from January 1 2008)

Article 6

An application for a patent which the applicant or his predecessor in title have within the 12 months prior to the filing date disclosed in another application for a patent in this country or for a patent, inventor's certificate or utility model protection in another country adhering to the Paris Convention for the Protection of Industrial Property of March 20, 1883, shall, when applying Paragraphs 1, 2 and 4 of Article 2 and Article 4, be deemed to have been filed simultaneously with the earlier application if the applicant so demands. [[The Minister of Business Affairs]¹⁾ may decide that applications, filed in States which are not members of the Paris Convention, may form the basis for priority in accordance with this Article.]²⁾

[...]³⁾

1) Act No. 167/2007, Art. 86 (Valid from January 1 2008)

2) Act no. 36/1996, Art. 1 (Valid from June 1 1996)

3) Act no. 36/1996, Art. 2 (Valid from June 1 1996)

PART II

The Patent Application and its Processing.

Article 7

This Act comes within the authority of [the Ministry of Business Affairs]¹⁾ which controls a Patent and Registration office. The Patent Authority in this Act refers to this Office unless otherwise stated.

[The Minister of Business Affairs]¹⁾ appoints a committee of appeal which rules on cases which are sent to appeal and which concern the Patent Authority, cf. Articles 25 and 67 of this Act. The committee is described in detail in the regulations accompanying this Act.

1) Act No. 167/2007, Art. 86 (Valid from January 1 2008)

Article 8

An application for a patent must be made in writing and filed with the Patent Authority, or in the case referred to in Part III, with a patent authority in a foreign country or with an international organization.

The application shall contain a description of the invention, also comprising drawings if such are necessary, and a distinct statement of what is sought to be protected by the patent (patent claims). The description shall be so clear as to enable a person skilled in the art to carry out the invention with the guidance thereof. [If an invention concerns or requires the use of biological material, it shall be considered inadequately described unless the requirements according to Paragraph 6 are fulfilled.]¹⁾

The application shall also contain an abstract of the description and claims. The abstract shall merely serve as technical information and it may not be taken into account for any other purpose.

[The name of the inventor must be specified in the application. If the applicant is someone other than the inventor, the application must state how the applicant acquired title to the invention. The Patent Authority can demand documentation proving the right of the applicant to the invention.]²⁾

The applicant shall pay a prescribed application fee. For the application, a prescribed annual fee shall also be paid for each fee year beginning before the application is finally decided on. A fee year according to this Act is 12 months and shall be counted the first time from the day on which the application was filed, and thereafter from the corresponding day according to the calendar.

[If it is necessary for the invention to use biological material which is neither available to the public nor can be described in the application in such a manner that, based on the application, a person skilled in the art would be able to execute the invention, a sample of the biological material must be deposited no later than the filing date of the application. From that time on, the sample shall remain constantly on deposit so that whoever has authorization according to this Act will be able to receive a sample of the biological material in this country. Regulations shall stipulate where such deposits may be made.

If a deposited biological material becomes inactive or it is impossible for other reasons to supply samples of it, it may be exchanged with a sample of the same culture within the prescribed time and in other aspects in accordance with the provisions of regulations. In such instances, the new deposit is considered to have been made on the same date as the previous deposit]³⁾

1) Act no. 22/2004, Art. 4 (a) (Valid from May 11 2004)

2) Act no. 22/2004, Art. 4 (b) (Valid from May 11 2004)

3) Act no. 22/2004, Art. 4 (c) (Valid from May 11 2004)

[Article 8 a

The Patent Office determines the filing date of an application as when:

1. the application may, on the basis of the application documents, be considered to be for a patent.
2. it may be seen, from the application documents, who the applicant is and where it is possible to contact her or him and
3. at least one of the following items is in the application documents:
 - a. a description of the invention,
 - b. drawings or
 - c. a reference to a previous application.

If the conditions of Paragraph 1 for determining the filing date of an application have not been fulfilled, the Patent Authority shall give the applicant a two-month deadline to rectify this. If the applicant rectifies the flaws by the deadline, the date of filing the application shall be figured as the day when rectifications reached the Patent Office. Should the flaws not be rectified by the deadline, the attitude shall be that no application was submitted.

A set of regulations issued by [the Minister of Business Affairs]¹⁾ shall provide in more detail for determining an application's filing date.]²⁾

1) Act No. 167/2007, Art. 86 (Valid from January 1 2008)

2) Act no. 53/2004, Art. 2 (Valid from June 14 2004)

Article 9

If the applicant so demands and pays the special fee, the Patent Authority under those conditions detailed in the regulations, shall allow the application to become subject to such novelty search by an International Searching Authority as referred to in Article 15(5) of the Patent Cooperation Treaty agreed at Washington on June 19, 1970.

Article 10

Patents for two or more mutually independent inventions may not be applied for in a single application.

Article 11

If a patent is sought for an invention disclosed in a patent application filed earlier by the applicant and not finally decided upon, the later application shall, on conditions laid down in the regulations, be regarded as filed at the time when the documents disclosing the invention were filed with the Patent Authority, if the applicant so demands.

Article 12

[An applicant who is not domiciled in Iceland must have [an agent, residing in the European Economic Area, in a member state of the incorporation of the European Free Trade Association or in the Faroe Islands]¹⁾ who can represent the applicant in all matters concerning the application. The name and address of the agent shall be entered in the Registry of Patents.]²⁾

1) Act No. 108/2006, Art. 34 (Valid from November 1 2006)

2) Act no. 28/2002, Art. 1 (Valid from April 1 2002)

Article 13

[The application for a patent must not be amended so as to claim protection for subject matter which did not appear in the application at the time when it was filed.]¹⁾

1) Act no. 36/1996, Art. 3 (Valid from June 1 1996)

Article 14

[...]¹⁾

1) Act no. 36/1996, Art. 4 (Valid from June 1 1996)

Article 15

If the applicant has not complied with the requirements regarding the application, or if the Patent Authority finds other obstacles to the allowance of the application, the applicant shall be notified thereof and be requested within a specified term to explain his case or make corrections to the application. The Patent Authority may, however, without consulting the applicant, make such changes in the abstract as it deems necessary.

If the applicant fails, within the stipulated term, to render a statement or to take measures to overcome the objections raised, the application shall be dismissed. Notice of this shall be given in accordance with Paragraph 1.

A dismissed application will be reinstated if, within four months from the expiration of the specified term, the applicant submits a statement or takes measures to overcome the objections and, within the same term, pays the prescribed resuming fee.

If renewal fees according to Articles 8, 41 and 42 are not paid, the application shall be dismissed without further notification. Applications which have been dismissed on these grounds shall not be reinstated

Article 16

If, after having received the applicant's statement, the Patent Authority still has objections to the allowance of the application, and the applicant has had an opportunity to submit a statement on the objections, the application shall be refused, unless there are found reasons to give the applicant another opportunity to state his case or amend his application according to Paragraph 1, Article 15.

Article 17

If a person claims before the Patent Authority that the proper title to the invention rests with him and not with the applicant, and if the case is deemed uncertain, the Patent Authority may invite him to bring an action before a court of law within a certain time. If the invitation is not complied with, the Patent Authority may disregard the claim in deciding on the patent application. Information to that effect shall be given in the invitation.

If litigation regarding the proper title to the invention is pending before the court, the patent application may be declared in abeyance until the litigation is finally settled by the court.

Article 18

If a person proves that the proper title to the invention rests with him and not with the applicant, the Patent Authority shall transfer the application to him, if he so requests. The transferee shall pay a new application fee.

If a request for transfer has been made under Paragraph 1, the application may not be dismissed, rejected or allowed until the request has been finally decided upon.

Article 19

[If the application is in accordance with applicable rules and no obstacles to the grant of a patent are found, and the applicant has given his approval to the text of the forthcoming patent, the Patent Authority shall notify the applicant that the patent can be granted upon payment of the fee prescribed for the publication of the patent document.

After the Patent Authority has sent the notification provided for in the first paragraph, the patent claims may not be amended so as to broaden the scope of the protection stated by the patent.

The publication fee shall be paid within two months of the date of notification of the Patent Authority provided for in the first paragraph. In default thereof, the application shall be dismissed. The processing of such application shall be resumed, however, if within four months after the expiration of this period of time the applicant pays the publication fee and the prescribed resumption fee.

An inventor applying for a patent himself may, within the time specified in the third paragraph, request exemption from payment of the publication fee. The Patent Authority may grant such exemption if the applicant may be regarded as having considerable difficulties in paying the fee. If such a request is refused, a fee paid within two months of the date of refusal shall be considered to have been paid within the proper time limit.]¹⁾

1) Act no. 36/1996, Art. 5 (Valid from June 1 1996)

Article 20

[When the conditions of Article 19 have been fulfilled the Patent Authority shall grant the patent and prepare the [patent document]²⁾. The granting of the patent shall be advertised / published in the Gazette which is published by the Icelandic Patent Office (69. gr.)

After the granting of the patent has been advertised the Patent Authority shall make available upon request copies of its description, patent claims and abstract. These documents shall indicate who the inventor is and who the applicant is.]¹⁾

1) Act no. 36/1996, Art. 6 (Valid from June 1 1996)

2) Act no. 53/2004, Art. 3 (Valid from June 14 2004)

Article 21

[Anyone may file an opposition against the patent granted with the Patent Authority. Opposition shall be made in writing and reasoned and must be filed with the Patent Authority within nine months from the date the granting of the patent was advertised.

Opposition may only be based on the contention that the patent was granted despite the following:

1. the conditions of Articles 1 and 2 were not fulfilled,
2. the invention is not described clearly enough to enable a person skilled in the art to carry out the invention on the base of the description,
3. the subject of the patent is more extensive than the application in the form in which it was filed.

The Patent Authority shall advertise that an opposition has been filed.]¹⁾

1) Act no. 36/1996, Art. 7 (Valid from June 1 1996)

Article 22

[As from the date the patent is granted, the application documents in the case shall be available to any person.

When 18 months have elapsed from the date of filing, or from the day when priority is claimed, cf. Article 6, the documents shall be available to any person, even though a patent has not been granted. If a decision has been made to dismiss or to refuse the application, the application documents shall, however, not be available unless the applicant requests resumption of the proceedings, appeals against the refusal or requests re-establishment of rights under Articles 72 or 73.]¹⁾

At the request of the applicant the files of the application shall be made available earlier than prescribed in Paragraphs 1 and 2.

When the files are made available under Paragraphs 2 or 3, a notice to that effect shall be published.

[If a document contains business secrets which do not concern an invention for which a patent is sought or granted, the Patent Authority may, on request and in special circumstances,

decide that the document, in whole or in part, shall not be made available to the public. If such a request has been filed, the document shall not be made available until a decision to this effect has been made or until the period during which the decision may be appealed has passed. An appeal shall have the effect of suspending the implementation of such decision.]²⁾

[If a sample of biological material has been deposited in accordance with the provisions of Article 8, anyone may be supplied a sample in accordance with the provisions of Paragraphs 1, 2 and 3. However, this does not mean that anyone is to be supplied with a sample who according to regulations or legal provisions is unauthorized to deal with deposited biological material. Nor shall samples be supplied to anyone who due to the harmful properties of the biological material is considered incompetent of processing the sample without considerable risk.

Notwithstanding the provisions of Paragraph 6, the applicant may demand that a sample of the biological material be supplied only to independent experts until a patent is granted. If an application has been refused or dismissed or may be considered withdrawn the applicant may, for 20 years from the filing date of the application, demand that samples of the biological material be supplied only to independent experts. [The Minister of Business Affairs]³⁾ issues rules on such requests, on time limits for presenting such requests and on who may be considered independent experts according to this stipulation.]⁴⁾

The request for the furnishing of a sample shall be filed in writing with the Patent Authority and shall contain a declaration of observance of the restriction on the use of the sample in accordance with the rules laid down by [the Minister of Business Affairs]³⁾. If the sample is to be furnished to an expert in the art then he shall make the declaration rather than the person requesting the sample.

1) Act no. 36/1996, Art. 8 (a) (Valid from June 1 1996)

2) Act no. 36/1996, Art. 8 (b) (Valid from June 1 1996)

3) Act no. 167/2007, Art. 86 (Valid from January 1, 2008)

4) Act no. 22/2004, Art. 5 (Valid from May 11 2004)

Article 23

[The Patent Authority shall notify the proprietor of the patent of opposition filed and give him an opportunity to submit his arguments.

The Patent Authority may accept opposition for processing even though a patent has lapsed or will cease to have effect, as referred to in Articles 51 or 54, the opposition has been withdrawn or the opponent is deceased or has lost the right to proceed with such a case.

The Patent Authority may declare the patent invalid or decide that it shall continue to be valid in the same or altered form. If the Patent Authority agrees that the Patent should be altered and the patent holder has indicated his agreement, the patent document shall be altered in accordance with the subsequent amendments after the patent holder has paid the required fee for the republishing of the patent. The Patent Authority shall make available copies of the final version of the patent document.

If the patent holder fails to agree to the altering of the patent or fails to pay the fee prescribed for the publication of a new patent document, the patent shall be considered to have lapsed.

When a final decision has been reached in an opposition case, such decision shall be advertised.]¹⁾

1) Act no. 36/1996, Art. 9 (Valid from June 1 1996)

Article 24

[An appeal against the final decision of the Patent Office concerning a patent application may be filed by the applicant to the Patent Board of Appeal. If a patent has been declared invalid or if the Patent Office considers that the patent may continue to be valid in an amended form following the decision in an opposition case, the patent holder may appeal such decisions to the Patent Board of Appeal. If the patent is to continue to be valid without alteration, or the Patent Office considers that the patent may continue to be valid in an altered form, despite legally submitted opposition, the opponent may refer this decision to the Patent Board of Appeal. Should the opponent withdraw his appeal the case may nonetheless be examined if special circumstances advocate such to be done.

Decisions rejecting a request for resumption under Paragraph 3, Article 15 or Paragraph 3, Article 19 or complying with a request for transfer under Article 18 may be appealed against by the applicant. Decisions rejecting a request for the transfer of the application may be appealed against by the person making such a request.

Decisions rejecting a request under Paragraphs 5 and 8, Article 22 may be appealed against to the Patent Board of Appeal by the person making the request.]¹⁾

1) Act no. 33/1996, Art. 10 (Valid from June 1 1996)

Article 25

[Appeals in accordance with Article 24 shall be filed with the Patent Board of Appeal not later than two months after the date on which the party concerned was notified of the decision by the Patent Authority. The prescribed appeal fee shall be paid within the same time limit. Failure to do so shall result in rejection of the appeal as inadmissible.]¹⁾

The decisions of the Patent Board of Appeal may not be brought before any higher administrative authority.

[Proceedings concerning decisions of the Patent Office which may be appealed against to the Patent Board of Appeal may not be brought before the courts until the decision of the Patent Board of Appeal has been given, cf., however, Articles 52 and 53. Proceedings concerning decisions of the Patent Board of Appeal to refuse an application for the patent or to declare a patent to be invalid shall be brought before the courts within two months from the date on which the party concerned was notified of the decision.]²⁾

The provisions of Paragraph 5, Article 22 shall also apply with respect to documents received by the Patent Board of Appeal.

1) Act no. 36/1996, Art. 11 (a) (Valid from June 1 1996)

2) Act no. 36/1996, Art. 11 (b) (Valid from June 1 1996)

Article 26

[If an application which has been made available to the public is finally refused or shelved, the refusal or shelving shall be advertised.]¹⁾

1) Act no. 36/1996, Art. 12 (Valid from June 1 1996)

Article 27

Granted patents shall be entered in a Register of Patents which shall be kept by the Patent Authority.

PART III

International Applications.

Article 28

An “international application” means an application under the Patent Cooperation Treaty done at Washington on June 19, 1970.

An international application shall be filed with a patent authority or an international organization which is competent under the Treaty and the Regulations to receive such an application (receiving Office). An international application may be filed with the Patent Authority of this country in accordance with rules laid down by [the Minister of Business Affairs]¹⁾. The applicant shall pay the fee prescribed for the application to the Patent Authority.

The provisions of Articles 29 to 38 shall apply to international applications designating Iceland.

1) Act no. 167/2007, Art. 86 (Valid from January 1, 2008)

Article 29

An international application which has been accorded an international filing date by the receiving Office shall have the same effect as a patent application filed in this country on that date. The provisions of the second sentence, Paragraph 2, Article 2 shall, however, only apply if the application has been proceeded with according to the provisions of Article 31.

Article 30

An international application shall be considered withdrawn as far as Iceland is concerned in cases referred to in Subarticles (i) and (ii), Paragraph 1, Article 24 of the Treaty.

Article 31

[Should an applicant request to proceed with an international application with respect to Iceland he must, within [31 months]²⁾ of the international date of filing or, if priority is claimed, of the priority date, pay the prescribed fee to the Patent Authority. In addition, the applicant must submit a translation of the application to the extent stipulated in a Regulation.

[]³⁾

If the applicant has paid the required fee within the time limits referred to in the first paragraph, the prescribed translation may be filed within an additional time limit of two months, provided that a stipulated additional fee is paid prior to the expiration of that time limit.]¹⁾

If the applicant fails to fulfill the requirements of this Article, the application shall be considered withdrawn as far as Iceland is concerned.

1) Act no. 28/2002, Art. 2 (Valid from April 1 2002)

2) Act no. 53/2004, Art. 4 (a) (Valid from June 14 2004)

3) Act no. 53/2004, Art. 4 (b) (Valid from June 14 2004)

Article 32

[]¹⁾

1) Act no. 28/2002, Art. 3 (Valid from April 1 2002)

Article 33

[When an international application has been proceeded with in accordance with the provisions of Article 31, the provisions of Part II shall apply to the application and processing

thereof unless otherwise provided for in this Article or in Articles 34-37. The application may, however, only be processed after the expiration of the time limits provided for in the first paragraph of Article 31, unless an applicant requests otherwise.]²⁾

The provisions of Article 12 shall only be applicable from the time when the Patent Authority may commence processing the application.

[The provisions of Article 22 shall apply as soon as an applicant has complied with his obligations under Article 31 to file a translation of the application with the Patent Authority even though the application has not yet been proceeded with.]¹⁾

In relation to the provisions of Articles 48, 56 and 60 an application shall be deemed to have been made available to the public when it has been made available under the provisions of Paragraph 3. If the application complies with the requirements relating to form and contents provided for in the Treaty, it shall be accepted in that respect.

1) Act no. 36/1996, Art. 14 (Valid from June 1 1996)

2) Act no. 28/2002, Art. 4 (Valid from April 1 2002)

Article 34

[A patent shall not be granted nor refused on the basis of an international application until the time limit prescribed in a Regulation has expired, unless the applicant has consented to the application being decided upon prior to such expiration.]¹⁾

1) Act no. 36/1996, Art. 15 (Valid from June 1 1996)

Article 35

[Without the consent of the applicant the Patent Authority may not grant a patent on the basis of an international application nor lay it open to public inspection prior to its publication by the International Bureau of the World Intellectual Property Organization (WIPO) or prior to the expiry of 20 months from the international filing date or, if priority is claimed, from the priority date.]¹⁾

1) Act no. 36/1996, Art. 16 (Valid from June 1 1996)

Article 36

If any part of an international application has not been the subject of an international search or an international preliminary examination because the application has been deemed to relate to two or more mutually independent inventions, and the applicant has not paid the additional fee under the Treaty within the prescribed time limit, the Patent Authority shall review the finding to determine whether it was justified. If this is found to be the case, the said part of the application shall be considered withdrawn before the Patent Authority unless the applicant pays the prescribed fee within two months after the date on which the Patent Authority notified him of the result of the review. If the Patent Authority considers that the finding was not justified, it shall proceed with the examination and other processing of the application in its entirety.

The applicant may appeal against a decision under Paragraph 1 by which an application is found to relate to two or more mutually independent inventions. The provisions of Paragraphs 1 to 3 of Article 25 shall apply in this case.

If the decision of the Patent Authority is confirmed the time limit for payment of the fee under sentence 2 of Paragraph 1 shall be from the date that the final decision is given.

Article 37

If any part of an international application has not been the subject of an international preliminary examination because the applicant has restricted the claims at the invitation of the International Preliminary Examining Authority, that part of the application shall be considered withdrawn before the Patent Authority unless the applicant pays the prescribed fee within two months after the date on which the Patent Authority invited him to pay with reference to the restriction of the examination carried out.

Article 38

If a receiving Office has refused to accord an international filing date to an international application, or if it has decided that the application or the designation of Iceland shall be considered withdrawn, the Patent Authority shall, at the request of the applicant, review the decision to determine whether it was justified. The same shall apply if the International Bureau deems a patent application to be withdrawn.

A request for a review under Paragraph 1 shall be presented to the International Bureau prior to the expiry date prescribed by regulations. The applicant shall, prior to the expiry of the same time limit and to the extent prescribed by regulations, file a translation of the application with the Patent Authority and pay the prescribed application fee.

If the Patent Authority finds that the decision of the receiving Office or the International Bureau was not justified, the Patent Authority shall process the application under Part II of this Act. If no international filing date has been accorded by the receiving Office, the application shall be deemed to have been filed on the date which, in the opinion of the Patent Authority, should have been accorded as the international filing date. If the application complies with the requirements relating to form and contents provided for the Treaty, it shall be accepted in that respect.

The provisions of sentence 2, Paragraph 2, Article 2 shall apply to applications processed according to Paragraph 3, provided that the application is made available to the public under Article 22.

PART IV

Extent of Protection and Term of the Patent.

Article 39

The extent of the protection conferred by a patent shall be determined by the claims. For the interpretation of the claims the description may serve as a guide.

Article 40

A granted patent may be maintained until 20 years have elapsed from the date of filing of the patent application. A renewal fee shall be paid for the patent in respect of each fee year beginning after the grant of the patent. If a patent is granted before the renewal fee for the application is due, cf. provisions of Article 41, the proprietor of the patent shall in addition, when the first renewal fee for the patent is due, pay the renewal fees for those fee years which had begun before the granting of the patent.

[Article 40 a

A patent holder may request that the Patent Office limit the patent's scope of protection by modifying the patent claims and, if necessary, modifying the description of the patent.

Submitting a request as provided for in Paragraph 1 is not possible if a patent is the object of

enforcement actions or a mortgage or court case according to Article 52 or 53.

A patent holder must pay the prescribed fee for requesting limitation in accordance with Paragraph 1.]¹⁾

1) Act no. 53/2004. Art. 5 (a) (Shall not enter into force until amendments made to the European Patent Convention in 2000 have entered into force and the Minister has published an advertisement on the amendments taking effect respecting Iceland)

[Article 40 b

If a request pursuant to Article 40 a does not fulfil the conditions mentioned there, or the limitation is covered by the instances in Points 2-4 of Paragraph 1 of Article 52, on revocation, the patent holder shall be given an opportunity to express him-/herself on the matter or to rectify the flaws. If the patent holder neither expresses him-/herself on the matter nor takes the necessary measures, or if the Patent Office, upon receiving an answer from the patent holder, still sees some obstacle to approving the request, and the patent holder has been given an opportunity to express him-/herself on this point, the request shall be rejected.

If the Patent Office sees no obstacle to approving the request of a patent holder as provided for in Article 40 a, the patent shall be limited in accordance with the request. The Patent Office shall publish an advertisement about the decision and prepare a new patent document, on condition of the patent holder having paid the prescribed fee for re-issue. From that time on, the patent shall be accessible to the public in its amended form.

The limitation of a patent as provided for in Paragraph 2 shall take effect upon notice being published of the amendment.

In cancellation cases, patent holders are obliged to inform judges of requests that have been submitted for patent limitation.

Decisions by the Patent Office to reject requests for limiting patents may be referred by patent holders to the Board of Appeal on intellectual property rights in the industrial field.]¹⁾

1) Act no. 53/2004. Art. 5 (b) (shall not enter into force until amendments made to the European Patent Convention in 2000 have entered into force and the Minister has published an advertisement on the amendments taking effect respecting Iceland)

PART V

Payment of Renewal Fees.

Article 41

The renewal fee shall fall due on the last day of the month in which the fee year begins. The renewal fees in respect of the first two fee years shall, however, only fall due at the same time as the fee in respect of the third fee year. Renewal fees may be paid a maximum of three months before the due date. If the decision of the Patent Board of Appeal to reject an application is reversed by a court, the renewal fee for the fee years beginning after the decision of the Patent Board of Appeal is made and extending until the court ruling comes into effect, may not fall due earlier than two months after the latter date.

For a later application as provided for in Article 11, the renewal fees in respect of fee years having begun before the date of filing of the later application or beginning within two months after that date shall in no case fall due before two months have elapsed after the said date. For an international application, renewal fees in respect of fee years having begun before the date on which the application was proceeded with under Article 31 or taken up for processing under Article 38 or beginning within two months after that date shall in no case fall due before two

months have elapsed after the date on which the application was proceeded with or taken up for processing.

Any renewal fee may, together with the prescribed additional fee, be paid within six months after its due date.

Article 42

If the inventor is the applicant or the proprietor of the patent, and if the payment of the renewal fees is deemed to involve great difficulties for him, the Patent Authority may grant him a respite from the payment thereof, provided that a request to that effect is submitted not later than the date on which the renewal fees fall due the first time. Respites may be granted of up to three years at a time, but no longer than until three years have elapsed from the grant of the patent. Any request for a prolongation of a respite shall be submitted not later than the date on which the granted respite expires.

If a request for a respite or a prolongation of a respite is rejected, payment within two months thereafter shall be regarded as payment in due time.

Any renewal fee for the payment of which a respite has been granted according to Paragraph 1 may, together with the same additional fee as referred to in Paragraph 3, Article 41, be paid within six months after the date until which the respite has been granted.

PART VI

Licensing, Transfer, etc.

Article 43

If the proprietor of the patent has granted another person a right to exploit the invention commercially (license), the licensee may not transfer that right to others in the absence of an agreement to the contrary.

Article 44

The transfer of a patent or the grant of a license shall on request be recorded in the Register of Patents.

If it is proved that a registered license has terminated, the license shall be deleted from the Register.

The provisions of Paragraphs 1 and 2 shall also apply to compulsory licenses and rights under Paragraph 2, Article 53.

Legal proceedings in respect of a patent may always be brought against the party who is entered in the Register as proprietor of the patent, and any notification from the Patent Authority may be sent to him.

Article 45

If a patented invention is not worked to a reasonable extent in this country when three years have elapsed from the grant of the patent and four years have elapsed from the filing of the patent application, any person wishing to work the invention in this country may obtain a compulsory license to do so unless there are shown legitimate reasons for the failure to work the invention.

Subject to reciprocity [the Minister of Business Affairs]¹⁾ may direct that, for the purposes of Paragraph 1, working of the invention in another country shall be equivalent to working in this country.

1) Act no. 167/2007, Art. 86 (Valid from January 1, 2008)

Article 46

[The proprietor of a patent for an invention, the exploitation of which is dependent on a patent held by another person, may obtain a compulsory license to exploit the invention protected by the latter patent if the former invention is considered to represent an important technical advance, which has considerable economic significance.

In the event of a compulsory license being granted to exploit a patented invention in pursuance of Paragraph 1, the proprietor of that invention shall be entitled to obtain, upon reasonable terms, a compulsory license to exploit the other invention.]¹⁾

1) Act no. 36/1996, Art. 17 (Valid from June 1 1996)

[Article 46 a)

A holder of a plant variety who can neither acquire nor exploit a plant variety right without infringing a prior patent may request a compulsory licence for a reasonable payment to exploit the invention if the licence is necessary to exploit the variety to be protected. A compulsory licence shall be granted only if the plant variety holder demonstrates that the variety involves technically important progress and leads to considerable financial benefit in comparison to the invention in the patent.

If a patent holder has obtained a compulsory licence on the basis of the Act on Plant Variety Rights, No. 58/2000, to exploit a protected plant variety, the holder of the plant variety is entitled to a compulsory cross-licence on reasonable terms to exploit the invention.]¹⁾

1) Act no. 22/2004, Art. 6 (Valid from May 11 2004)

Article 47

When required by important public interests, any person who wishes to exploit an invention commercially for which another person holds a patent may obtain a compulsory license to do so.

Article 48

Any person who, in this country, at the time when a patent application was made available to the public, was commercially exploiting the invention for which a patent is applied for, may, if the application results in a patent, obtain a compulsory license to exploit the invention if very special circumstances make it desirable and he had no knowledge and could not reasonably have obtained any knowledge of the application. Such a right shall also, under similar conditions, be enjoyed by any person who had made substantial preparations for commercial exploitation of the invention in this country.

A compulsory license in accordance with Paragraph 1 may include the time preceding the grant of the patent.

Article 49

[A compulsory license may only be granted to a person who has not been able to reach agreement to obtain a license on reasonable terms and may be presumed to be capable of exploiting the invention in a reasonable and acceptable way and in accordance with the terms of the license. [In the event of a national emergency or other circumstances of extreme urgency, it is permissible to waive the requirement for prior negotiations, though the patent holder shall in

such cases be notified of this use as soon as reasonably practicable. Further provisions may be made through regulations.]¹⁾

A compulsory license shall not prevent the proprietor of the patent from exploiting the invention himself or from granting licenses to others.

A compulsory license may only be transferred to others together with the business in which it is exploited or in which the exploitation was intended. Furthermore, where a compulsory license has been granted as provided for in Paragraph 1 of Article 46, transfer of a compulsory license may only occur concurrent with transfer of the patent which was dependent upon a patent held by another party.

A compulsory license concerning semi-conductor technology may only be granted for public exploitation which is not of a commercial nature, or to prevent behaviour which a court or government authority has regarded as anti-competitive.]²⁾

[A compulsory licence may be granted for exporting medicines to developing countries and countries which are struggling with a severe public health problem, in accordance with the decision of the World Trade Organisation's General Council of 30 August 2003 on the TRIPS agreement and public health. The party requesting a compulsory license must show that they have, for a period of thirty days, made unsuccessful efforts to obtain authorisation for manufacture from the patent holder. However, the above-mentioned requirement for negotiations does not apply in the event of an emergency or other circumstances of extreme urgency. Compulsory licenses, under the terms of this paragraph, will only be granted upon the fulfilment of conditions further specified in regulations ³⁾ that are in compliance with the aforementioned decision of the World Trade Organisation's General Council, for instance regarding quantities and drug labelling.]¹⁾

1) Act no. 127/2005, Art. 1 (Valid from December 30 2005)

2) Act no. 36/1996, Art. 18 (Valid from June 1 1996)

3) Regulation No. 1011/2006.

Article 50

[The Reykjavík City Court shall decide whether a compulsory license shall be granted, to what extent the invention may be exploited, the amount of compensation to be paid to the patent proprietor and other conditions of the compulsory license. If circumstances should change significantly, the Court may, at the request of either party, cancel the license or lay down new conditions.]¹⁾

1) Act no. 36/1996, Art. 19 (Valid from June 1 1996)

PART VII

Termination of the Patent etc.

Article 51

If any renewal fee is not paid in accordance with the rules laid down in Articles 40, 41 and 42, the patent shall lapse as from the beginning of the fee year in respect of which the fee has not been paid.

Article 52

A patent may be revoked [in its entirety or in part by a court decision if]: ²⁾

1. it has been granted notwithstanding that requirements under Articles 1 and 2 are not complied with;
2. it relates to an invention which is not disclosed in a manner sufficiently clear to enable a person skilled in the art to carry out the invention;
3. its subject matter extends beyond the content of the application as filed; or
- [4. the scope of protection conferred by the patent has been extended after the Patent Authority notified the applicant, in accordance with Article 19, that a patent could be granted.]¹⁾

A patent may not, however, be revoked in its entirety on the grounds that the proprietor of the patent was only partially entitled to the patent.

With the exceptions provided for in Paragraph 4, proceedings may be instituted by any person.

Proceedings on the grounds that the patent has been granted to a person other than the one entitled thereto under Article 1 may only be instituted by the person claiming to be entitled to the patent. Such proceedings shall be brought within one year after the entitled person obtained knowledge of the grant of the patent and of the other circumstances on which the proceedings are based. If the proprietor of the patent was in good faith when the patent was granted or when he acquired the patent, the proceedings may not be brought later than three years after the grant of the patent.

1) Act no. 36/1996, Art. 20 (Valid from June 1 1996)

2) Act no. 53/2004, Art. 6 (Valid from June 14 2004)

Article 53

If a patent has been granted to a person other than the one entitled thereto under Article 1, the court shall transfer the patent to the entitled person if he so claims. The provisions of Paragraph 4, Article 52 concerning the time of instituting the proceedings shall apply.

The person who is deprived of the patent shall, if he in good faith is exploiting the invention commercially in this country or has made substantial preparations for such exploitation, be entitled, for a reasonable compensation and on reasonable conditions in other respects, to continue the exploitation already commenced or to commence the planned exploitation within the same limits. Holders of registered licenses shall also enjoy the same right on the same conditions.

Rights under Paragraph 2 may only be transferred to others together with the business in which they are exploited or in which the exploitation was intended.

Article 54

If a proprietor of a patent surrenders the patent in writing to the Patent Authority, the Patent Authority shall declare the patent to have ceased to have effect [in its entirety.]¹⁾ [The cancellation of the patent shall take effect upon publication of the notice.]²⁾

If proceedings have been instituted for the transfer of a patent, the patent shall not be declared to have ceased to have effect until a final decision has been given in the proceedings.

1) Act no. 53/2004, Art. 7 (a) (shall not enter into force until amendments made to the European Patent Convention in 2000 have entered into force and the Minister has published an advertisement on the amendments taking effect respecting Iceland)

2) Act no. 53/2004, Art. 7 (b) (shall not enter into force until amendments made to the European Patent Convention in 2000 have entered into force and the Minister has published an advertisement on the amendments taking effect respecting Iceland)

Article 55

When a patent has lapsed or has been declared to have ceased to have effect or has been revoked or transferred to another person by a final court decision, the Patent Authority shall publish a notice to that effect.

PART VIII

Obligation to give Information about Patents.

Article 56

[If the applicant for a patent invokes her/his application in regard to other parties before it has been made accessible to the public, she/he is required to grant them access to the application documents if demanded. If a sample of biological material has been deposited in relation to the application, cf. Paragraph 6 of Article 8, a concerned party also has the right to receive a sample of the biological material. The provisions of the second and third sentences of Paragraph 6 of Article 22 apply in this case, as well as Paragraphs 7 and 8 of the same Article.]¹⁾

Any person who, by direct communication with another person or in advertisements or by the marking of goods or their packaging or in any other way, indicates that a patent has been applied for or granted, without indicating at the same time the number of the application or the patent, shall be under an obligation to give such information to any person requesting it without undue delay. If it is not explicitly indicated that a patent has been applied for or granted, but circumstances are such as to create that impression, information as to whether a patent has been applied for or granted shall be given on request without undue delay.

1) Act no. 22/2004, Art. 7 (Valid from May 11 2004)

PART IX

Liability to Punishments, Liability for Damages, etc.

Article 57

Any person who intentionally infringes the exclusive right conferred by a patent shall be punished by fine, or under aggravated circumstances, by [imprisonment]¹⁾ of up to three months.

If the offence is committed by a society or other company the enterprise may be liable to a fine.

Proceedings shall be brought by the injured party.

1) Act no. 82/1998, Art. 198 (Valid from October 1 1998)

Article 58

Any person who intentionally or negligently infringes a patent shall be liable to pay a reasonable compensation for the exploitation of the invention as well as damages for the further injury which the infringement may have caused.

If any person infringes a patent and such infringement is not intentional or due to negligence, he shall be liable to pay compensation and damages under the provisions of Paragraph 1 if and to the extent it is found reasonable.

Article 59

In the case of patent infringement the court may, to the extent it is found reasonable and when so demanded, order measures to prevent the abuse of products manufactured in accordance with the patent invention or of any apparatus, tool or other equipment the use of which would involve patent infringement. It may thus be decided that the item shall be altered in a specified manner or destroyed or, in the case of a patented item, that it shall be surrendered to the injured party in return for compensation. This shall not, however, apply to any person who in good faith has acquired the said item or has acquired rights in respect of the item and who has not himself committed patent infringement.

Under very special circumstances the court may, notwithstanding the provisions of Paragraph 1, and when so claimed, grant the owner of the products, apparatus, tools and other equipment, referred to in Paragraph 1 permission to dispose of these freely during the term of the patent or part of that term in return for a reasonable compensation and on reasonable conditions in other respects.

Article 60

[If any person exploits an invention commercially without permission after the application documents have been made available to the public, and the application results in a patent, the provisions concerning patent infringement, with the exception of the provisions of Article 57, shall apply *mutatis mutandis*. The patent protection conferred prior to the granting of a patent shall, however, only extend to subject matter which may be derived both from the claims as worded at the time when the application was made available to the public and from the patent as granted or as amended, as referred to in Paragraph 3 of Article 23.

A party, exploiting an invention in accordance with Paragraph 1, shall only be liable to the extent referred to in Paragraph 2 of Article 58 to pay damages for injury caused by infringement committed prior to advertisement of the granting of the patent in accordance with Article 20.]¹⁾

1) Act no. 36/1996, Art. 21 (Valid from June 1 1996)

Article 61

In proceedings for patent infringement the invalidity of the patent may only be put in issue if a claim for revocation is brought against the proprietor of the patent in the event that the latter has been summoned under the rules laid down in Paragraph 4, Article 63. If the patent is revoked, the provisions of Articles 57 to 60 shall not apply.

Article 62

Any person who fails to fulfill his obligations according to Article 56 or gives false information shall be punished by a fine, provided that a more severe punishment is not provided for by other legislation. He shall also compensate for the injury caused by his action to the extent that is considered reasonable.

The provisions of Paragraphs 2 and 3, Article 57 shall also apply in such cases.

Article 63

[Any person who institutes proceedings for the invalidation of a patent, for the transfer of right to a patent or for the grant of a compulsory license shall notify the Patent Authority thereof.]¹⁾ Simultaneously he shall, by registered letter, notify all registered licensees of the proceedings, provided that their address is recorded in the Register. Any licensee who wishes to

institute proceedings for patent infringement shall in a similar way notify the proprietor of the patent of the proceedings, provided that the latter's address is recorded in the Register.

If the plaintiff does not prove on the day on which the case comes up for trial that notification under Paragraph 1 has been effected, the court may fix a time limit for compliance with the requirements of Paragraph 1. If the said time limit is not observed, the case shall be dismissed.

If the proprietor of a patent brings proceedings for infringement of patent and the defendant wishes to claim revocation of the patent the latter shall, in accordance with the provisions of Paragraph 1, inform the Patent Authority and registered licensees that he intends to claim revocation. The provisions of Paragraph 2 shall also apply here so that the claim for revocation shall be dismissed if the time limit which has been fixed is not observed.

In proceedings for patent infringement brought by a licensee, the defendant may summon the proprietor of the patent to attend without regard to his domicile in order to claim against him that the patent be revoked.

1) Act no. 36/1996, Art. 22 (Valid from June 1 1996)

Article 64

The following proceedings shall be brought in the Reykjavik [City Court]¹⁾:

1. proceedings concerning the right to an invention which is the subject matter of an application for a patent;
2. proceedings concerning the grant of a patent, cf. Paragraph 3, Article 25;
3. proceedings for the revocation of a patent or for the transfer of a patent, cf. Articles 52 and 53 and proceedings concerning rights under Paragraph 2, Article 53;
4. proceedings concerning rights under Article 4 and Paragraph 2, Article 74;
5. proceedings concerning patent infringement;
6. proceedings for the assignment of a patent and proceedings regarding voluntary licenses.

Applicants and proprietors of patents who are not residents in this country shall be deemed, according to this Act, to have their domicile in Reykjavik.

1) Act no. 92/1991, Art. 106 (Valid from December 14, 1991)

[Article 64a

Should a patent involve a method for producing a novel product, then if this same product is produced by a person other than the holder of the patent, it shall be considered as having been produced by means of the patented method unless proved otherwise.

In presenting proof of the contrary, the legitimate interests of the parties to protect production and commercial secrets shall be respected.]¹⁾

1) Act no. 36/1996, Art. 23 (Valid from June 1 1996)

Article 65

Office copies of court decisions in the cases referred to Article 50 and Paragraph 1, Article 64 shall be communicated to the Patent Authority on the initiative of the judge.

[PART IXa

Supplementary protection.

Article 65a

European Council Regulation 1768/1992, concerning a supplementary protection certificate for medicinal products, which is Point 6 of Annex 17 of the Treaty Establishing a European Economic Area, is annexed to this Act and shall be considered as part of it. [European Parliament and the Council Regulation No. 1610/96 concerning the creation of a supplementary protection certificate for plant protection products, which is Point 6a of the same Annex is also annexed to this Act and shall be considered as part of it in respect to the adaptation text in the Decision of the Joint Committee No. 59/97 of July 31, 1997. The provisions of the Regulations shall have the force of law in this country.]²⁾ [The provisions also apply to citizens and legal bodies of member states of the incorporation of the European Free Trade Association, to the citizens of the Faroe Islands and legal bodies of the Faroe Islands.]³⁾

An application for supplementary protection shall be submitted in writing to the Patent Authority. The applicant shall pay the prescribed application fee.

An annual fee shall be paid for each fee year commencing after the patent has lapsed. The same rules which apply to annual fees for patents shall apply in other respects these annual fees.

More detailed rules concerning applications for supplementary protection, their processing and research, the registration of supplementary protection, etc. shall be set in a Regulation.

The penalty provisions of Articles 57 and 62 shall also apply to supplementary protection.]¹⁾

1) Act no. 36/1996, Art. 24 (Valid from June 1 1996)

2) Act no. 132/1997, Art. 1 (Valid from January 2 1998)

3) Act no. 108/2006, Art. 35 (Valid from November 1, 2006)

PART X

Miscellaneous Provisions.

Article 66

[The Patent Office may instruct a proprietor of a patent, who is not domiciled in Iceland, to appoint [an agent, residing in the European Economic Area, in a member state of the incorporation of the European Free Trade Association or in the Faroe Islands]¹⁾ to receive summonses and other notifications concerning the patent. The name and address of the agent shall be entered in the Registry of Patents.]²⁾

1) Act no. 108/2006, Art. 36 (Valid from November 1, 2006)

2) Act no. 28/2002, Art. 4 (Valid from April 1 2002)

Article 67

[An applicant, proprietor of a patent or person demanding the invalidation of a patent may appeal the final decisions of the Patent Office in addition to those referred to in Article 24 to the Patent Board of Appeal not later than two months after the date on which he was notified of the decision. The same shall apply for decisions in pursuance of Article 42, or the first and second paragraphs of Article 72, and Article 73. Other parties with interests at stake may, in the same manner, refer the decisions in question to the Patent Board of Appeal not later than two months after the publication of the decision.]¹⁾

The fee prescribed for the appeal shall be paid within the same time limit. If payment is not made, the appeal shall be rejected as inadmissible.

1) Act no. 36/1996, Art. 25 (Valid from June 1 1996)

Article 68

The amount for the fees, service costs and other payments provided for in this Act shall be stipulated in the regulations.¹⁾ It shall also be possible to decide by regulation that the renewal fee referred to in Article 41 may be cancelled for one or more fee years.

1) Regulation no. 639/1995.

Article 69

[[The Minister of Business Affairs]¹⁾ shall lay down detailed rules²⁾ concerning patent applications and their processing, the processing of opposition, the arrangement and keeping of the Register of Patents, the publication and contents of the Patent Gazette, the organisation and procedures of the Patent Office and the Patent Board of Appeal, and the implementation of this Act in general.]³⁾ It may thus be prescribed that the records of the Patent Office relating to applications filed shall be available to the public.

[The Minister of Business Affairs]¹⁾ may direct that, at the request of the authority of another country, the Patent Office may inform the said authority of the processing of patent applications filed in this country. [The Minister of Business Affairs]¹⁾ may also direct that the Patent Authority in this country, in deciding whether the conditions for patentability are complied with, may accept novelty searches which have been carried out for that purpose by a corresponding authority in another country or by an international institution.

[The Minister of Business Affairs]¹⁾ may furthermore direct that, at the request of the Patent Authority and within a time limit fixed by that Authority, any applicant who, in any country, has filed a corresponding application for a patent shall furnish information about the result of the examination as to the patentability of the invention which has been communicated to him by the patent authority of that country and transmit a copy of the correspondence to the said authority. However, no obligation to furnish information may be prescribed in respect of any application referred to in Part III of this Act which has been the subject of an international preliminary examination on which a report has been filed with the Patent Office.

1) Act no. 167/2007, Art. 86 (Valid from January 1, 2008)

*2) Regulation no. 574/1991; Advertisement no. 575/1991; Regulation no. 41/2000.
Act no. 36/1996, Art. 26 (Valid from June 1 1996)*

[Article 69a

All adverts and announcements from the Icelandic Patent Office, as stated in this Act and which shall be made public, shall be published in the Gazette which is published by the Icelandic Patent Office.

The gazette may be published and distributed electronically, for example on the Internet.]¹⁾

1) Act no. 54/2004, Art. 3 (Valid from June 1 2004)

Article 70

In a case of extreme necessity in the event of an emergency due to natural disaster, war or imminent risk of war, [the Minister of Business Affairs]¹⁾ may direct that all rights for the exploitation of an invention devolve on the state or any other party that the Minister directs. Full compensation shall be payable for such a transfer but if no agreement can be reached on the amount of compensation a decision shall be made according to criteria laid down in Act no. 11/1973.

If, on the grounds referred to in Paragraph 1, the right to exploit an invention is transferred to a party other than the state and if the said party fails to pay the appropriate compensation the state is obliged, on demand of the party who has right to compensation, to pay the amount without delay.

1) Act no. 167/2007, Art. 86 (Valid from January 1, 2008)

Article 71

The Patent Office may undertake projects involving the acquisition and processing of data in its keeping or which it has access to and which is available to the public. Rules for governing such service and fees shall be laid down in the regulations.

Article 72

If, apart from cases referred to in Paragraph 2, the non-observance of a time limit vis-à-vis the Patent Authority prescribed by or provided for in this Act causes a loss of rights to an applicant [or patent holder]¹⁾ and he or his agent has taken all due care reasonably required, and if he takes appropriate action within two months after the removal of the cause of non-observance though not later than one year after the expiry of the time limit, the Patent Authority shall re-establish his rights. In order for the right to be re-established the applicant shall, within the same time limit, provide a written request in this regard and pay the required fees.

[The provisions of Paragraph 1 shall apply to priority rights as referred to in Paragraph 1 of Article 6, if a request for re-establishment of rights is submitted within two months of the expiry of the time limit referred to in Paragraph 1 of Article 6. The provisions of Paragraph 1 shall not apply to deadlines for starting legal proceedings according to Paragraph 3 of Article 25.]²⁾

[The provisions of Paragraph 1 and 2 shall apply when proceeding with an international patent application as referred to in Article 31. The provisions shall also apply to such applications when the applicant has lost rights due to not respecting time limits of receiving authorities, international searching authorities, international preliminary examination authorities, or the World Intellectual Property Organization.]³⁾

1) Act no. 53/2004, Art. 8 (a) (Valid from June 14 2004)

2) Act no. 53/2004, Art. 8 (c) (Valid from June 14 2004)

3) Act no. 53/2004, Art. 8 (d) (Valid from June 14 2004)

Article 73

If, in cases referred to in Articles 31 and 38, the applicant has sent documents or fees by post, but these were not received in due time, and if the required documents and fees are received by the Patent Authority within two months after the date on which the applicant noticed or should have noticed that the time limit was exceeded and not later than one year after the expiry of the time limit, the Patent Authority shall re-establish the rights, provided that:

1. within 10 days preceding the expiry of the time limit the postal service was interrupted on account of wars, revolution, civil disorder, strike, natural disaster or other like reason in the locality where the sender is staying or has his place of business, and the mailing of documents or fees to the Patent Authority is effected within five days after the resumption of the postal service; or
2. the mailing of documents or fees was effected by registered mail to the Patent Authority not later than five days prior to the expiry of the time limit, though only

if the mailing was effected by airmail, where possible, or if the sender had every reason to believe that surface mail would not arrive later than two days after the date of mailing.

If the applicant wishes to have his rights re-established under Paragraph 1, he shall file a written request to that effect with the Patent Authority within the expiry of the time limit referred to.

Article 74

When a request under Articles 72 or 73 has been accepted and, in consequence, a patent application which has been shelved or refused after having been made available to the public shall be processed further, or a lapsed patent shall be regarded as maintained, a notice to that effect shall be published.

Any person who, after the expiry of the time limit prescribed for the resumption of proceedings in respect of a shelved application or after the refusal of the application or after the advertisement of the lapse of the patent, but prior to the publication of the notice under Paragraph 1, in good faith has commenced a commercial exploitation of the invention in this country or made substantial preparations for such exploitation, may continue the exploitation retaining its general character.

The right provided for in Paragraph 2 shall only be transferred to others together with the business in which it has arisen or in which the exploitation was intended.

[Part X a **European Patents]** ¹⁾ [Article 75

European Patent shall mean a patent granted by the European Patent Office (EPO) in accordance with the European Patent Convention (EPC) of 5 October 1973. A European patent application shall mean an application in accordance with provisions of the European Patent Convention.

A European patent may be valid for Iceland.

An application for a European patent must be submitted to the European Patent Office or the Icelandic Patent Office, which receives applications in Iceland. The Icelandic Patent Office forwards the application to the European Patent Office, in accordance with more detailed rules issued by [the Minister of Business Affairs]¹⁾ in a set of regulations. However, a European divisional patent application, as provided for in Article 76 of the European Patent Convention, is to be submitted only to the European Patent Office.

The provisions of this Part apply to European patents and European patent applications that are valid for Iceland.] ²⁾

1) Act no. 167/2007, Art. 86 (Valid from January 1, 2008)

2) Act no. 53/2004, Art. 9 (a) (Valid from November 1 2004)

[Article 76

A European patent shall be considered granted when the European Patent Office publishes a notification of its granting. A European patent which has taken effect in Iceland shall have the same effect as a patent granted by the Icelandic Patent Office and the same rules shall apply to it unless otherwise provided for in this Act.] ¹⁾

1) Act no. 53/2004, Art. 9 (b) (Valid from November 1 2004)

[Article 77

A European patent shall take effect in Iceland only if the applicant fulfils the following conditions within the required time limit according to regulations after the day on which the European Patent Office published notification of granting the patent or made a decision on maintaining the patent in an amended version:

1. submitting to the Icelandic Patent Office an Icelandic translation of the patent claims together with an Icelandic or English translation of the other parts of the patent if the European patent was granted or maintained in an amended version in German or French
2. paying the Icelandic Patent Office the prescribed fee for publication.

Patent documentation, whether appearing in electronic form or on paper, shall be accessible to everyone. Nonetheless, documentation shall never become accessible until the European Patent Office has published the patent application.

When documentation as provided for in Paragraph 1 has been submitted, the fee has been paid, and the European Patent Office has published notification of granting a patent or of the Office's decision to maintain the European patent in an amended form, the Icelandic Patent Office shall publish an advertisement to this effect. As soon as this is concluded, a copy of the patent shall be available from the Icelandic Patent Office.]¹⁾

1) Act no. 53/2004, Art. 9 (c) (Valid from November 1 2004)

[Article 78

The provisions of Paragraph 1 of Article 72 on re-establishment of rights shall also apply to time limits for translations and fee payments as provided for in Paragraph 1 of Article 77.

The Icelandic Patent Office shall publish an advertisement if a request for re-establishing rights is granted.

If any person has in good faith begun to exploit an invention in Iceland for commercial purposes, or taken substantial measures to do so, following the expiry of the time limit referred to in Paragraph 1 of Article 77 but preceding publication of the notice of re-establishment of rights, the provisions of Paragraph 2 and 3 of Article 74 shall apply concerning the right to exploitation.]¹⁾

1) Act no. 53/2004, Art. 9 (d) (Valid from November 1 2004)

[Article 79

The provisions of Point 4 of Paragraph 1 of Article 52, on revocation, shall apply to European patents also, provided a patent's scope of protection has been extended since the patent was granted, pursuant to Article 76.]¹⁾

1) Act no. 53/2004, Art. 9 (e) (Valid from November 1 2004)

[Article 80

A decision by the European Patent Office to limit, cancel or revoke a European patent shall have the same effect on the European patent in Iceland. The Icelandic Patent Office shall publish an advertisement to this effect.]¹⁾

1) Act no. 53/2004, Art. 9 (f) (Valid from November 1 2004)

[Article 81

The annual fee for a European patent shall be paid to the Icelandic Patent Office for each fee year commencing after the European Patent Office has published a notice of its deciding to grant the European patent.

If the annual fee is not paid as referred to in Paragraph 1, cf. Article 41, the patent shall become invalid. The annual fee for the first fee year after a patent is granted does not become due, however, until four months after the patent was granted.]¹⁾

1) Act no. 53/2004, Art. 9 (g) (Valid from November 1 2004)

[Article 82

Upon the European Patent Office determining the filing date of an application, the application shall have effect in Iceland as if it were a national application. If an applicant has demanded a right of priority in accordance with the European Patent Convention, this right of priority shall apply in Iceland also.

An application for a European patent which has been published as provided for in Article 93 of the European Patent Convention shall be considered to be known, cf. the second sentence of Paragraph 2 of Article 2, and shall be deemed equivalent to applications published as provided for in Article 22. The same shall apply to an international patent application as provided for in Paragraph 3 of Article 153 of the European Patent Convention, if the European Patent Office deems the publication of the application equivalent to publication as provided for in Article 93 of the European Patent Convention.]¹⁾

1) Act no. 53/2004, Art. 9 (h) (Valid from November 1 2004)

[Article 83

If an applicant submits to the Icelandic Patent Office an Icelandic translation of the claims of an application, as they were published on the part of the European Patent Office, this translation shall be made accessible to the public. The Icelandic Patent Office shall publish a notice to this effect in the Gazette.

Once such a notice has been published and the application has resulted in the granting of a European patent in Iceland, the provisions concerning violations of patent rights may be applied. However, in such instances patent protection shall include only what is presented both by the patent claims, as they were published, and the claims of the patent as it was granted or amended. The provisions of Article 57 shall not apply in the instances mentioned above; rather, the sole requirement is that of paying compensation for damages as provided for in Paragraph 2 of Article 58.]¹⁾

1) Act no. 53/2004, Art. 9 (i) (Valid from November 1 2004)

[Article 84

If an applicant has withdrawn an application for a European patent or the designation of Iceland in such an application, or should be regarded as having done so according to the European Patent Convention, and if the application has not been accepted for further processing as provided for in Article 121 of the European Patent Convention, this shall have the same effect as when an application is withdrawn in Iceland.

The rejection of a European patent application shall have the same effect as the rejection of an application in Iceland.]¹⁾

1) Act no. 53/2004, Art. 9 (j) (Valid from November 1 2004)

[Article 85

If translations as referred to in Articles 77 and 83 do not accord with the text in the language of proceedings by the European Patent Office, the patent protection covers only what is specified in both texts.

For invalidation cases, the text in the language of proceedings in the European Patent Office shall be regarded as authentic.]¹⁾

1) Act no. 53/2004, Art. 9 (k) (Valid from November 1 2004)

[Article 86

If a patent holder or applicant submits to the Icelandic Patent Office a corrected translation of patents, as referred to in Article 77, and pays the prescribed fee for publishing a corrected translation, this translation shall replace the one previously submitted. Once a correction has been submitted and the fee paid, the Icelandic Patent Office shall publish an advertisement to this effect, provided the original translation is accessible to the public. When the advertisement has been published, a copy of the corrected translation shall be accessible to the public and available at the Icelandic Patent Office.

If an applicant submits a corrected translation of an application, as referred to in Article 83, the Icelandic Patent Office shall publish an advertisement to this effect and have the corrected translation available for the public. Following publication of the advertisement, the corrected translation shall replace the original one.

Anyone who in good faith has exploited the invention for commercial purposes in Iceland, or taken substantial measures to do so, when the corrected translation becomes valid, and whose use did not violate the right of the applicant or patent holder according to a previous translation, shall be entitled to exploitation as provided for in Paragraph 2 and 3 of Article 74.]¹⁾

1) Act no. 53/2004, Art. 9 (l) (Valid from November 1 2004)

[Article 87

A decision by the European Patent Office to re-establish the rights of a patent holder or applicant which s/he has lost because of not complying with a prescribed time limit shall apply also in Iceland.

Anyone who in good faith starts to exploit an invention for commercial purposes in Iceland, or has taken substantial measures to do so, after a loss of rights occurred but before the European Patent Office has re-established the rights and published a notification to this effect, shall be entitled to exploitation in accordance with Paragraph 2 and 3 of Article 74.]¹⁾

1) Act no. 53/2004, Art. 9 (m) (Valid from November 1 2004)

[Article 87 a

Anyone who in good faith starts to exploit for commercial purposes in Iceland an invention described in a published European patent application or patent, or has taken substantial measures to do so, after a decision by a Board of Appeal of the European Patent Office was available but before a ruling by the Enlarged Board of Appeal of the European Patent Office, as provided for in Article 112 a of the European Patent Convention, was published, shall have rights according to Paragraph 2 and 3 of Article 74.]¹⁾

1) Act no. 53/2004, Art. 9 (n) (shall not enter into force until amendments made to the European Patent Convention in 2000 have entered into force and the Minister has published an advertisement on the amendments' taking effect respecting Iceland)

[Article 88

Should an application for a European patent which was submitted to the Patent Authority of a member state be deemed to be withdrawn because the application was not forwarded to the European Patent Office within the prescribed time limit, the Icelandic Patent Office shall, if an applicant so demands, consider this to have been changed to a national application in Iceland, provided that:

1. the demand is presented to the Patent Authority where the application was submitted within three months after the applicant was notified of the application having been deemed withdrawn,
2. the demand reaches the Icelandic Patent Office within twenty months from the filing date of the application or of the priority date, if priority is claimed, and
3. the applicant pays, within the time limit determined by [the Minister of Business Affairs]¹⁾, the application fee and submits an Icelandic translation of the application in accordance with the provisions of regulations.

If the application fulfils the European Patent Office requirements regarding form, it shall be accepted as valid in that respect.]²⁾

1) Act no. 167/2007, Art. 86 (Valid from January 1, 2008)

2) Act no. 53/2004, Art. 9 (o) (Valid from November 1 2004)

[Article 89

The provisions of Articles 9, 60 as amended, and 131 of the European Patent Convention and provisions of the Convention's Protocol on Jurisdiction and the Recognition of Decisions in Respect of the Right to the Grant of a European Patent (Protocol on Recognition) shall have legal force in Iceland. The provisions shall accompany this Act and be considered part of it.]¹⁾

1) Act no. 53/2004, Art. 9 (p) (Valid from November 1 2004)

[Article 89 a

The provisions of this Act regarding the deposit of biological material shall not apply to European patents.]¹⁾

1) Act no. 53/2004, Art. 9 (q) (Valid from November 1 2004)

[Article 90

[The Minister of Business Affairs]¹⁾ shall issue, in a set of regulations, more detailed provisions on the implementation of this Part.]¹⁾

1) Act no. 167/2007, Art. 86 (Valid from January 1, 2008)

2) Act no. 53/2004, Art. 9 (r) (Valid from November 1 2004)