

**Statement of purpose**

**CHAPTER I  
Form of Protection and Patentability**

- Article 1- Protection of inventions
- Article 2 - Conditions of patentability
- Article 3 - Novelty
- Article 4 - Inventive step
- Article 5 - Industrial applicability
- Article 6 - Grace period

**CHAPTER II  
Right to a Patent; Mention of Inventor**

- Article 7 - Right to a patent
- Article 8 - Employee and commission inventions
- Article 9 - Mention and designation of inventor

**CHAPTER III  
The Application and Procedure up to Grant**

- Article 10 - Requirements of application
- Article 11 - Filing date
- Article 12 - Disclosure of invention
- Article 13 - Claims
- Article 14 - Abstract
- Article 15 - Unity of invention
- Article 16 - Division of an application
- Article 17- Right of priority
- Article 18 - Amendment, correction and withdrawal of application
- Article 19 - Publication of application, provisional protection and inspection of files
- Article 20 - Examination of application and grant of patent
- Article 21 - Confirmation of the granted patent
- Article 22 - Patent Register

**CHAPTER IV  
Effects of a Patent**

- Article 23 - Rights conferred by a patent
- Article 24 - Prior user
- Article 25 - Term of patent and maintenance fees
- Article 26 - Extent of protection and interpretation of claims

**CHAPTER V  
Change in Ownership and Joint Ownership of Patent Application or Patent**

- Article 27 - Change in Ownership of Patent Application or Patent
- Article 28 - Judicial assignment of patent application or patent
- Article 29 - Joint ownership of patent application or patent

**CHAPTER VI**  
**Contractual Licenses and Licenses of Right**

- Article 30 - License contract
- Article 31 - Rights of licensee
- Article 32 - Rights of licensor
- Article 33 - Licenses of right

**CHAPTER VII**  
**Compulsory Licenses**

- Article 34 - Compulsory licenses

**CHAPTER VIII**  
**Actions for infringement of the rights of the proprietor of a patent;  
procedure.**

- Article 35 - Right to Bring Action; actions; procedure
- Article 36 - Damages
- Article 37 - Provisional Measures
- Article 38 - Withholding at Customs
- Article 39 - Declaration of non-infringement

**CHAPTER IX**  
**Changes in Patents, Surrender and Invalidation**

- Article 40 - Changes in patents
- Article 41 - Surrender
- Article 42 - Lapse
- Article 43 - Revocation
- Article 44 - Effect of revocation or limitation

**CHAPTER X**  
**Extension of European patents**

- Article 45 - Extension of European patents

**CHAPTER XI**  
**International Applications under the Patent Cooperation Treaty**

- Article 46 - Application of the Patent Cooperation Treaty
- Article 47 - Filing Date and Effects of International Applications Designating Andorra
- Article 48 - International applications filed with the Patent Office as receiving Office
- Article 49 - Patent Office as designated and elected Office
- Article 50 - National processing
- Article 51 - Entering national phase

**CHAPTER XII**  
**Common Provisions**

- Article 52 - Further processing
- Article 53 - Appeals

Article 54 - Jurisdiction

Article 55 - Representation before the Patent Office

Article 56 - Patent agents

Article 57 - Summons

**Additional Provision**

**Derogatory Provision**

**First Final Provision**

**Second Final Provision**

## **CHAPTER I**

### **Form of Protection and Patentability**

#### **Article 1 - Protection of inventions**

Inventions shall be protected by patents in accordance with the provisions of this Law.

#### **Article 2 - Conditions of patentability**

(1) An invention shall be patentable if it is new, involves an inventive step and is susceptible of industrial application.

(2) The following, in particular, shall not be regarded as inventions within the meaning of paragraph (1):

- (a) discoveries, scientific theories and mathematical methods;
- (b) aesthetic creations;
- (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- (d) presentations of information.

(3) The provisions of paragraph (2) shall exclude patentability of the subject-matter or activities referred to in that paragraph only to the extent to which a patent application or patent relates to such subject-matter or activities as such.

(4) A patent shall not be granted in respect of

- (a) inventions the exploitation of which would be contrary to "ordre public" or public morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by Andorran legislation;
- (b) methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

#### **Article 3 - Novelty**

(1) An invention shall be considered to be new if it does not form part of the prior art. For the determination of novelty, items of prior art may only be taken into account individually.

(2) The prior art shall consist of everything which before the filing date or, where priority is claimed, the priority date of the application has been made available to the public by means of a written or oral description, by use or in any other way.

(3) The prior art shall also include the content of any patent application as filed in, or with effect for, Andorra, to the extent that such application or the patent granted thereon is published subsequently, provided that the filing date or, where priority is claimed, the priority date of such application is earlier than the date referred to in paragraph (2).

(4) The provisions of paragraphs (1) to (3) shall not exclude the patentability of any substance or composition, comprised in the prior art, for use in a method referred to in Article 2(4)(b), provided that its use for any such method is not comprised in the prior art.

#### **Article 4 - Inventive step**

An invention shall be considered to involve an inventive step if, having regard to the prior art, it is not obvious to a person skilled in the art. If the prior art also includes documents within the meaning of Article 3 (3), these documents are not to be considered in deciding whether there has been an inventive step.

**Article 5 - Industrial applicability**

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

**Article 6 - Grace period**

(1) Disclosure of information of an invention claimed in an application shall not affect the patentability of that invention where the information was disclosed no earlier than 6 months prior to the filing date or, where priority is claimed, the priority date of the application:

(a) by the inventor or any person who, at the filing date of the application, had the right to the patent;

(b) by a Patent Office and the information was contained:

(i) in another application filed by the inventor and should not have been disclosed by the Office, or,

(ii) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information direct or indirectly from the inventor;

(c) by a third party which obtained the information direct or indirectly from the inventor.

(2) The effects of paragraph (1) may be invoked at any time.

## CHAPTER II

### Right to a Patent; Mention of Inventor

#### Article 7 - Right to a patent

(1) The right to a patent shall belong to the inventor or his successor in title. Joint inventors shall, unless they agree otherwise, have equal rights.

(2) Where two or more persons have made an invention independently of each other, the right to a patent for that invention shall belong to the person whose application has the earliest filing date or, where priority is claimed, the earliest priority date, provided that this application has been published.

(3) For the purposes of proceedings before the Patent Office, the applicant shall be deemed to be entitled to exercise the right to the patent.

#### Article 8 - Employee and commission inventions

(1) Notwithstanding Article 7, when an invention is made in Andorra in execution of a commission or an employment contract, the right to the patent for that invention shall, in the absence of contractual provisions to the contrary, belong to the person having commissioned the work or to the employer.

(2) When provisions of paragraph (1) apply to an invention made in execution of an employment contract in Andorra, the employee being the inventor shall have the right to equitable remuneration taking into account his salary, the economic value of the invention and any benefit derived from the invention by the employer. In the absence of agreement between the parties to fix the remuneration, it shall be fixed by the Judicial authority upon application by one of the parties. This application shall be prosecuted according to "*el procediment abreuja*" (summary procedure).

#### Article 9 - Mention and designation of inventor

(1) The inventor shall have the right, vis-à-vis the applicant for or proprietor of the patent, to be mentioned as such before the Patent Office.

(2) The application shall designate the inventor or, where there are several inventors, all of them. If the applicant is not the inventor or is not the sole inventor, the applicant shall indicate the legal grounds of his entitlement to file the application.

(3) Any inventor designated shall be mentioned as such in the published application and the patent specification unless the inventor requests, in a declaration signed by him and addressed to the Patent Office, that he wishes not to be so mentioned.

## **CHAPTER III**

### **The Application and Procedure up to Grant**

#### **Article 10 - Requirements of application**

(1) The application for a patent shall be filed at the Patent Office and shall contain:

- (a) a request for the grant of a patent;
- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract of the invention.

(2) The application shall be subject to the payment of the filing fee prescribed in the Patent Office Tax Law and shall satisfy the conditions laid down in the Implementing Regulations.

(3) The request for the grant of a patent shall be drawn up in Catalan.

#### **Article 11 - Filing date**

(1) The filing date of an application shall be the date of receipt by the Patent Office of an application that contains at least the following elements:

- (a) an indication that a patent is sought;
- (b) information identifying the applicant;
- (c) a part which, on the face of it, appears to be a description of an invention, or a reference drawn up in Catalan to a previously filed application.

(2) (a) If the Patent Office finds that, at the time of receipt of an application, the requirements referred to in paragraph (1) have not been fulfilled, it shall invite the applicant to comply with the requirements as prescribed in the Implementing Regulations. If the applicant complies with the invitation, the filing date of the application shall be the date of receipt of all missing elements. If the applicant fails to comply with the invitation, the application shall be treated as if it had not been filed.

(b) Where the application refers to drawings which are not included in the application, the Patent Office shall invite the applicant to furnish the missing drawings. If the applicant complies with the said invitation, the filing date of the application shall be the date of receipt of the missing drawings. If the applicant fails to comply with the invitation, the filing date shall be the date of receipt of the application and any reference to the drawings shall be deemed to be deleted.

(3) Where the application has been accorded a filing date, the Patent Office shall inform the applicant accordingly.

#### **Article 12 - Disclosure of invention**

(1) The application shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

(2) Where the application refers to biological material which cannot be disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art and such material is not available to the public, the application shall be supplemented by a deposit of such material with a recognized depository institution as prescribed in the Implementing Regulations.

#### **Article 13 - Claims**

The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

#### **Article 14 - Abstract**

The abstract shall merely serve for use as technical information. It may not be taken into account for any other purpose, in particular not for the purpose of determining the extent of protection or of applying Article 3 (3).

#### **Article 15 - Unity of invention**

An application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

#### **Article 16 - Division of an application**

(1) The applicant may divide a pending application into two or more applications ("divisional application") up to the time when the earlier application is in order for grant.

(2) Any divisional application shall be entitled to the filing date and, where priority is claimed, the priority date of the earlier application provided its content does not go beyond the disclosure in the earlier application as filed.

(3) Priority documents that are submitted to the Patent Office in respect of the earlier application shall be considered as having been submitted in respect of any divisional application.

#### **Article 17 - Right of priority**

(1) Once the provisions of the Paris Convention for the Protection of Industrial Property (Paris Convention) have entered into effect, the application, when it is filed, may contain a declaration claiming priority, pursuant to the provisions of the Paris Convention, of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in or with effect for any State party to or bound by the Paris Convention. The effect of that declaration shall be as provided for in the Paris Convention.

(2) Where the application contains a declaration under paragraph (1) the applicant shall submit to the Patent Office, within the time limit prescribed in the Implementing Regulations, a simple copy or a photocopy of each earlier application whose priority is claimed

(3) If the Patent Office finds that the requirements under this Article have not been fulfilled, it shall invite the applicant to file the required correction as prescribed in the Implementing Regulations. If the applicant does not comply with this invitation, the declaration referred to in paragraph (1) shall be considered not to have been made.

(4) Subject to the payment of the fees prescribed in the Patent Office Tax Law, an applicant may file a request for an addition of priority claim if the filing date of the application is not later than the date of the expiration of the priority period calculated from the filing date of the earlier application whose priority is claimed.



(5) The request referred to in paragraph (4) shall be filed as prescribed in the Implementing Regulations and within a period of 16 months from the priority date or, where the addition of a priority claim causes a change in the priority date, 16 months from the priority date as so changed, whichever 16 month period expires first, provided that such a priority claim may not be submitted later than the expiration of 4 months from the filing date of the application.

#### **Article 18 - Amendment, correction and withdrawal of application**

(1) The applicant shall have the right, on his own initiative, to amend or correct the application up to the time when the application is in order for grant.

(2) No amendment or correction of the application shall extend beyond the content of the application as filed.

(3) The applicant may withdraw the application at any time during its pendency, with no right to claim paid fees.

#### **Article 19 - Publication of application, provisional protection and inspection of files**

(1) The Patent Office shall publish as prescribed in the Implementing Regulations any application filed with it as soon as possible after the expiration of 18 months from the filing date or, where priority is claimed, from the priority date of the application, except in the following cases:

(a) No application shall be published if it is withdrawn or finally rejected before the technical preparations for publication have been completed.

(b) Where, before the expiration of the said period of 18 months, the applicant files a written request at the Patent Office that his application be published, the Patent Office shall publish the application promptly after the receipt of the request.

(2) The patent application shall provisionally confer upon the applicant from the date of its publication the same rights as would be conferred by a patent. The patent application shall be deemed never to have had these effects if it is withdrawn or finally rejected.

(3) After the patent application has been published any person may inspect the files of the application in accordance with the Implementing Regulations.

#### **Article 20 - Examination of application and grant of patent**

(1) If an application has been accorded a filing date, the Patent Office shall examine whether the application complies with the requirements of Articles 9 and 10.

(2) The Patent Office is under no obligation to examine whether the application and the invention to which it relates comply with the requirements under Articles 2 to 5, 12, 13, 15 and 18 (2).

(3) Where the Patent Office finds that the application does not comply with the requirements referred to in paragraph (1), it shall indicate the deficiencies to the applicant and give him an opportunity to correct them in accordance with the Implementing Regulations. The application shall be rejected if the applicant fails to correct the deficiencies indicated by the Patent Office.

(4) Where the application complies with the requirements referred to in paragraph (1), the Patent Office shall, on payment of the fees prescribed in the Patent Office Tax Law, grant a patent on the application. The Patent Office shall record the

grant of the patent in the Patent Register and publish the patent specification as prescribed in the Implementing Regulations.

(5) Where the applicant has filed a request for early publication of the application pursuant to Article 19(1)(b), he may request that the patent be granted immediately upon publication of the application.

#### **Article 21 - Confirmation of the granted patent**

(1) Without prejudice to Article 45, the proprietor of a patent shall submit to the Patent Office within a period of ten years from the filing date of the application, written evidence that the patented invention complies with the requirements of Articles 2 to 5, 12 and 13. In the absence of the submission of such confirming written evidence, the patent and the application on which it is based shall be deemed not to have had, as from the outset, the effects specified in Articles 19(2) first sentence and 23.

(2) Shall be considered written evidence as referred to in paragraph (1) any patent for the same invention granted by the European Patent Office or any other patent office also acting as an International Preliminary Examining Authority under the Patent Cooperation Treaty (PCT), upon an examination as to whether that invention complies with the same requirements as or corresponding requirements to those referred to in Articles 2 to 5, 12, 13 and 18(2).

(3) Where the extent of protection conferred by the patent as granted extends beyond that of the patent submitted as evidence under paragraph (2), the proprietor of the patent shall amend the specification by limiting the extent of protection in order to bring it into conformity with such evidence.

(4) The patent shall be unenforceable against third parties until the specification has been brought into conformity with the evidence as prescribed under paragraph (3). However, provisional measures under Article 37 shall be available as from the date of grant of the patent, subject to the provisions of Article 37(8) and (9).

#### **Article 22 - Patent Register**

(1) The Patent Office shall maintain a Patent Register in which patent applications and patents granted shall be recorded.

(2) The Patent Register shall include, as prescribed in the Implementing Regulations, such matters constituting or relating to the patent application or patent and entries of all corrections, amendments, changes in ownership or other matters that the Patent Office is empowered or required by this Law to record. No entry shall be made in the Patent Register prior to the publication of the application.

(3) The Patent Register shall be prima facie evidence of all matters directed or authorized by or under this Law to be entered therein.

(4) The Patent Register shall be open to public inspection in accordance with the Implementing Regulations.

## **CHAPTER IV** **Effects of a Patent**

### **Article 23 - Rights conferred by a patent**

(1) A patent shall constitute a property right.

(2) A patent shall confer on its proprietor, in particular, the exclusive right to use the patented invention and to prevent any third party not having his consent from:

(a) making, offering, putting on the market or using a product which is the subject-matter of the patent, or importing or stocking the product for these purposes;

(b) using a process which is the subject-matter of the patent or, when the third party knows or it is obvious in the circumstances that the use of the process is prohibited without the consent of the proprietor of the patent, from offering the process for use within Andorra;

(c) offering, putting on the market, using, or importing or stocking for these purposes the product obtained directly by a process which is the subject-matter of the patent.

(3) A patent shall also confer on its proprietor the exclusive right to prevent any third party not having his consent from supplying or offering to supply a person, other than a party entitled to exploit the patented invention, with means relating to an essential element of that invention, for putting it into effect, when the third party knows or it is obvious in the circumstances that these means are suitable and intended for putting that invention into effect. This provision shall not apply when the means are staple commercial products except when the third party induces the person supplied to commit acts prohibited by paragraph (2). Persons performing any of the acts referred to in paragraph (4) (b) to (d) shall not be considered to be parties entitled to exploit the invention.

(4) The rights conferred by a patent shall not extend to:

(a) acts concerning a product covered by the patent after that product has been put on the market by the proprietor of the patent, or with his express consent, in Andorra or in any other territory specified in the Implementing Regulations;

(b) acts done privately and for non-commercial purposes;

(c) acts done for experimental purposes relating to the subject-matter of the patented invention;

(d) acts consisting of the extemporaneous preparation for individual cases, in a pharmacy or by a medical or veterinary doctor, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared.

(e) the use of the patented invention on any foreign aircraft, spacecraft or land vehicle which temporarily or accidentally enters the airspace or land of Andorra provided that the patented invention is used exclusively in the construction or operation of the aircraft, spacecraft or land vehicle.

### **Article 24 - Prior user**

(1) Any person who in good faith, for the purposes of his enterprise or business, before the filing date or, where priority is claimed, the priority date of the application on which the patent is granted, and within Andorra was using the invention or was making effective and serious preparations for such use, shall have the right, for the purposes of his enterprise or business, to continue such use or to use the invention as envisaged in such preparations.

(2) The right of the prior user may only be transferred or devolve together with his enterprise or business, or with that part of his enterprise or business in which the use or preparations for use have been made.

#### **Article 25 - Term of patent and maintenance fees**

(1) The term of a patent shall be 20 years as from the filing date of the application.

(2) The maintenance of a patent shall be subject to the payment of the annual fees prescribed in the Patent Office Tax Law. These fees shall be due for the years following the year in which the patent has been granted.

(3) When a maintenance fee has not been paid on or before the prescribed due date, it may still be validly paid within six months of that date, provided the prescribed surcharge is paid within that period.

#### **Article 26 - Extent of protection and interpretation of claims**

(1) The extent of the protection conferred by the patent shall be determined by the claims, which are to be interpreted in the light of the description and drawings so as to combine fair protection for the proprietor of the patent with a reasonable degree of certainty for third parties.

(2) For the purposes of determining the extent of protection and in accordance with the Implementing Regulations, due account shall be taken of elements which at the time of any alleged infringement are equivalent to the elements as expressed in the claims.

(3) In determining the extent of protection, due account shall be taken of any statement unambiguously limiting the scope of the claims made by the applicant or the proprietor of the patent during procedures concerning the grant, confirmation or validity of the patent.

(4) If the patent contains examples of embodiments, functions or results of the invention, the claims shall not be interpreted as being limited to such examples.

(5) For the period up to grant of the patent, the extent of the protection conferred by the patent application shall be determined by the claims published under Article 19. However, the patent as granted or as amended in confirmation proceedings according to Article 21 or revocation according to Article 43 shall determine retroactively the protection conferred by the patent application, in so far as such protection is not thereby extended.

## CHAPTER V

### Joint Ownership and Change in Ownership of Patent Application or Patent

#### Article 27 - Change in ownership of patent application or patent

(1) Any contract assigning a patent application or a patent shall be in writing. Otherwise it shall not be valid.

(2) Any change in the ownership of a patent application or a patent shall be recorded in the Patent Register on payment of the fee prescribed in the Patent Office Tax Law. The new proprietor of the application or patent shall be entitled to institute any legal proceedings concerning the application or patent only if he has been recorded in the Patent Register.

(3) The transfer or assignment of a patent application or patent shall not affect rights acquired by third parties before the date of such transfer or assignment and shall have effect vis-à-vis third parties only after entry in the Patent Register.

#### Article 28 - Judicial assignment of patent application or patent

If a patent application has been filed or a patent granted to a person who is not entitled to the patent under Articles 7 or 8, the person entitled to it under these provisions may request the Court to order the assignment to him of the patent application or patent.

#### Article 29 - Joint ownership of patent application or patent

(1) Where there are joint applicants of a patent application, each of them may without the agreement of the others separately assign or transfer by succession his share of the application, but the joint applicants may only jointly withdraw the application or conclude license contracts with third parties under the application.

(2) Where there are joint proprietors of a patent, each of them may without the agreement of the others separately assign or transfer by succession his share of the patent or institute court proceedings for infringement of the patent, but the joint proprietors may only jointly surrender the patent or conclude license contracts with third parties under the patent.

(3) The provisions of this Article shall be applicable only in the absence of an agreement to the contrary between the joint applicants or proprietors.

## **CHAPTER VI**

### **Contractual Licenses and Licenses of Right**

#### **Article 30 - License contract**

(1) A patent application or patent may be licensed in whole or in part. A license may be exclusive or non-exclusive. For the purposes of this Law, "license contract" means any contract by which a party ("the licensor") grants to the other party ("the licensee") the right to perform any of the acts referred to in Article 23(2) or (3) in respect of an invention which is the subject-matter of a patent or patent application.

(2) Any license contract shall be in writing. Otherwise it shall not be valid.

(3) A license may be recorded in the Patent Register on payment of the fee prescribed by the Patent Office Tax Law. Article 27(3) shall apply *mutatis mutandis* to the grant or transfer of a license.

#### **Article 31 - Rights of licensee**

(1) In the absence of any agreement to the contrary, the licensee shall be allowed to perform in respect of the invention any of the acts referred to in Article 23(2) or (3) without limitation as to time, and through any application of the invention, within the territory of Andorra.

(2) In the absence of any agreement to the contrary, the licensee may not allow a third person to perform in respect of the invention any of the acts referred to in Article 23(2) or (3).

#### **Article 32 - Rights of licensor**

(1) In the absence of any agreement to the contrary, the licensor may grant a third party the right to perform in respect of the invention any of the acts referred to in Article 23 (2) or (3) and shall not be prevented from performing them himself.

(2) Notwithstanding the provisions of paragraph 1) above if the license contract provides that the license is exclusive, and unless it is expressly agreed otherwise, the licensor may neither grant a third party the right to perform nor perform himself in respect of the invention any of the acts referred to in Article 23(2) or (3) which are covered by the said contract.

#### **Article 33 - Licenses of right**

(1) Where the proprietor of a patent files a written statement with the Patent Office that he is prepared to allow any person to use the invention as a licensee in return for appropriate compensation, the maintenance fees which fall due after receipt of the statement shall be reduced in accordance with the Implementing Regulations and the Patent Office Tax Law.

(2) The statement may not be filed as long as an exclusive license is recorded in the Patent Register.

(3) The statement may be withdrawn at any time upon written notification to this effect to the Patent Office, provided that no one has informed the proprietor of the patent of his intention to use the invention.

(4) On the basis of the statement, any person shall be entitled to use the invention as a licensee under the conditions laid down in the Implementing Regulations. Any license so obtained shall be treated as a contractual license.

(5) No request for recording an exclusive license in the Patent Register shall be admissible after the statement has been filed, unless the said statement is withdrawn.

## **CHAPTER VII Compulsory Licenses**

### **Article 34 - Compulsory licenses**

(1) Any person who proves his ability to work the patented invention in Andorra, after the expiration of a period of four years from the filing date of the application or three years from the grant of the patent, whichever is later, may institute legal proceedings in front of the Civil Court to request **a the** grant of a compulsory license to exploit the patented invention if it is not worked or is insufficiently worked in Andorra .

(2) The scope and duration of any compulsory license shall be limited to the purpose for which it is granted, and such license shall be

(a) non-exclusive,

(b) non-assignable, except with that part of the enterprise or goodwill which enjoys such authorization,

(c) granted exclusively for the supply of the domestic market.

(3) The grant of a compulsory license shall be subject to the payment of adequate remuneration to the proprietor of the patent. Such license may only be granted if, prior, the person requesting it has made efforts to obtain authorization from the proprietor on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time.

(4) A compulsory license shall not be granted if the Judicial Authority determines that circumstances exist which justify the non-working or insufficient working of the patented invention in Andorra , and in particular if the product covered by the patent is put on the market in Andorra in sufficient quantity to satisfy the needs in Andorra.

(5) Proceedings mentioned in paragraph (1) shall follow the "*procediment abreujat*" (summary procedure) and therefore the Court shall give both the proprietor of the patent and the person requesting such license an adequate opportunity to present arguments.

(6) The proprietor of a patent may institute legal proceedings in front of the Civil Court requesting the revocation of a compulsory license when the circumstances which led to its granting cease to exist and are unlikely to recur. The Court shall take into account the legitimate interests of the proprietor of the patent and of the licensee.

## **Chapter VIII Actions for infringement of the rights of the proprietor of a patent; procedure.**

### **Article 35 - Right to Bring Action; actions; procedure**

(1) Violation of any right established by article 23 constitutes an infringement of the rights of the patent proprietor. Any infringement of the rights protected under this law, shall make the infringer liable to civil and/or criminal prosecution.

(2) The proprietor of a patent may institute the appropriate civil and/or criminal proceedings before the judicial authorities against any person who infringes his rights, in particular:

- (a) to obtain an injunction ordering the infringer to cease and desist from actual and threatened use of the patented invention;
- (b) to obtain an adequate compensation for damages;
- (c) to obtain an order for the disposal outside the channels of commerce or the destruction without compensation, of infringing goods as well as of materials and implements, predominantly used for the creation of infringing goods or the making of the infringing process.

(3)

- (a) Unless the license contract provides otherwise, any licensee may request the proprietor of the patent to institute Court proceedings for any infringement of the rights of the patent proprietor, who must specify the relief desired.
- (b) Such licensee may, if he proves that the proprietor of the patent refused or failed to comply with the request within the period prescribed by the Implementing Regulations, institute such proceedings on his own behalf after notifying the proprietor of the patent of his intention. The proprietor of the patent shall have the right to join in the proceedings.
- (c) Where before the expiry of the period referred to in subparagraph (b), the licensee proves that immediate action is necessary to avoid substantial harm, he may institute the proceedings mentioned in that subparagraph immediately.
- (d) Any licensee shall be entitled to join in any proceedings instituted by the proprietor of the patent, in order to secure adequate relief for any injury suffered by him as a result of the infringement, without prejudice to the proceedings that such licensee may institute on his own.

(4) Unless a provisional measure has been applied for under article 37, infringement proceedings may be instituted only after such confirming evidence as referred to in Article 21 has been submitted to the Patent Office and, if required, the patent specification has been amended accordingly.

(5) Civil actions derived from the violation of the rights of a patent proprietor must be instituted within a period of five years from the date when the patent proprietor or, where appropriate, the licensee, has obtained knowledge of the infringement and of the identity of the alleged infringer.

(6) Proceedings concerning a patent application may be instituted only after a patent has been granted on that application.

(7) Where the subject-matter of the patent is a process for obtaining a new product, the same product when produced by any third party shall in the absence of proof to the contrary be deemed to have been obtained by the patented process. In the adduction of proof to the contrary in the course of legal proceedings, the Judicial Authority shall, after declaring that it is pertinent, proceed with the due caution to ensure the protection of the legitimate interests of the defendant in protecting his manufacturing and business secrets.

(8) The Judicial Authority shall order the losing party to pay the winning party its legal costs, including appropriate counsel fees, unless the Judicial Authority considers the case as doubtful



### **Article 36 - Damages**

(1) Infringement of the rights of the proprietor of the patent shall entail the liability of the infringer thereof, who shall be bound to compensate the proprietor of the patent, and where appropriate the licensee, for damages where the infringer knew or had reasonable grounds to know that he was engaged in an infringing activity.

(2) The amount of damages shall reflect not only actual losses suffered by the proprietor of the patent or, where appropriate, by the licensee, but also lost profits calculated at the discretion of the injured party on the basis of either:

(a) the profits which the patent proprietor or, where appropriate, the licensee, would have derived from the use of the patented invention had the infringement of his rights not occurred; or

(b) the profits realized by the infringer as a result of the infringement.

### **Article 37 - Provisional Measures.**

(1) The Judicial Authority may, as a provisional measure, prohibit by injunction the actual or threatened use of the patented invention, or order the provision of guarantees to ensure, where appropriate, compensation for the proprietor of the patent or for the licensee and order action to be taken to preserve relevant evidence in regard to the alleged infringement.

(2) The application for an injunction or for the ordering of guarantees established on above paragraph 1) shall be allowed only where the action on the merits appears to be founded and is brought within a brief time period following the day on which the proprietor of the patent or, where appropriate, the licensee became aware of the circumstances that gave rise to it. The Judicial Authority may make the grant of the injunction subject to the provision by the plaintiff of such guarantees as will indemnify the defendant for any prejudice suffered by him if the action is eventually judged unfounded.

(3) The measures established in paragraph (1) above may be ordered *ex parte*, in particular where any delay would be likely to cause irreparable harm to the injured party, or where there is a demonstrable risk of evidence being destroyed.

(4) Where, according to above paragraph (3), a provisional measure has been ordered *ex parte*, the defendant shall be notified without delay. He shall have the right to apply for a review of the order and the Court shall decide without further proceedings whether the measure ordered shall be confirmed, modified or revoked. When this decision is reached by the Judge (*Battle*), it shall be appealable.

(5) Where the proprietor of the patent or, where appropriate, the licensee, has failed to bring the principal action within 20 working days or 31 calendar days from the date the proprietor of the patent or, where appropriate, the licensee, received notification of the provisional measure, whichever is longer, or within any other period established by the Judicial Authority that granted the provisional measure, such provisional measure shall be null and void as of right, without prejudice to any damages that may be claimed by the party affected by the provisional measure.

(6) Where a provisional measure is revoked or ceases to have effect or where it is subsequently found that there is no actual or threatened infringement of the patent, the Judicial Authority may, upon request of the defendant, order the applicant to pay

appropriate compensation to the defendant for any injury caused by the measure, including appropriate counsel fees.

(7) Where a provisional measure has been ordered prior to the submission of confirming evidence under Article 21, and proceedings have been duly instituted under Article 35, such proceedings shall be stayed until such confirming evidence becomes available. In this case, the Judicial Authority may:

(a) order that the provisional measures be lifted, upon the provision of guarantees by the defendant to ensure the indemnification of the injured party for any injury suffered by him as a result of the infringing activities of the defendant; or

(b) order that provisional measures remain in force, upon the provision of guarantees by the injured party to ensure indemnification of the defendant for any injury suffered by him were the action eventually to be judged unfounded. Such an order shall be made only where the injured party shows that the patent to be submitted as confirming evidence under Article 21 is being prosecuted diligently.

(8) Where an order is made by the Judicial Authority pursuant to above paragraph (7), after hearing the injured party, the Judicial Authority shall set a time limit within which the confirming evidence is to be presented and proceedings resumed. If such confirming evidences are not presented within said time limit, the Judicial Authority shall leave provisional measures without effect.

(9) Subject to the conditions of any provisional measure established by this article, the proprietor of the patent or, where appropriate, the licensee, shall be entitled to cause the Judicial Authority, assisted by experts that it has selected, to carry out in any place either a detailed description, with or without the taking of samples, or the actual seizure of the goods that he alleges to be in violation of his rights.

### **Article 38 - Withholding at Customs**

(1) Subject to the conditions of any provisional measure established by article 37, the proprietor of a patent or, where appropriate, the licensee has the right to request the Judicial Authority to order the customs administration to withhold goods regarded by the said proprietor or the licensee as infringing his rights.

(2) The Judicial Authority, the person having made the request referred to in paragraph 1) above and the party declaring the withheld goods shall be informed without delay, by the customs administration, of the withholding measure that it has implemented.

(3) In the specific case of a withholding at customs, the time period established by article 37.(5) for any provisional measure, shall be of ten working days following the date on which the person who filed the request referred to in paragraph (1) above received the notification of the withholding according to paragraph (2) above.

(4) The person who filed the request referred to in paragraph 1) above may, through judicial order, obtain from the customs administration the communicate of the names and addresses of the sender, the importer and the consignee of the merchandise withheld, and also its quantity.

(5) The person who filed the request referred to in paragraph 1) above and the importer shall have the right to inspect the withheld goods, subject to compliance with the due security measures established by the Judicial Authority to protect the withheld goods.

(6) Provisions of article 37.4 second and third sentences shall apply, *mutatis mutandis*, to any withholding at customs

### **Article 39 - Declaration of non-infringement**

Any interested person may, by instituting proceedings against the proprietor of the patent, request the Judicial Authority to declare that the performance of any specific act does not constitute a violation of the rights established by article 23. The validity of the patent may not be put in issue in such proceedings. The request shall be inadmissible if and as long as the act in question is the subject of infringement proceedings involving said person.

## CHAPTER IX Changes in Patents, Surrender and Invalidation

### Article 40 - Changes in patents

(1) The proprietor of a patent may request the Patent Office, in accordance with the Implementing Regulations, to make changes in the patent in order to limit the extent of the protection conferred by it.

(2) The proprietor of a patent may request the Patent Office to make changes in the patent in order to correct mistakes or clerical errors made in good faith.

(3) The proprietor of a patent may request the Patent Office, in accordance with the Implementing Regulations, to make changes in the name or address of the proprietor entered in the Patent Register, as long as such modification does not imply a change of proprietor.

(4) No change in the patent shall extend beyond the content of the application as filed.

(5) If, and to the extent to which, the Patent Office accepts the changes related to the patent according to paragraphs (1) to (4) above, it shall enter the changes in the Patent Register and publish them.

### Article 41 - Surrender

(1) The proprietor of a patent may surrender the patent by written declaration filed with the Patent Office. It shall not have effect until it is entered in the Patent Register.

(2) The surrender will be entered in the Patent Register with the agreement of any third party who has a right in *rem* recorded in the Patent Register or has instituted proceedings under Article 28. If a license is recorded in the Patent Register, the surrender will be entered only if the proprietor of the patent proves that he has previously informed the licensee of his intention to surrender the patent.

### Article 42 - Lapse

A patent shall lapse:

- (a) at the end of the term laid down in Article 25(1);
- (b) if the proprietor of the patent has surrendered it, on the date at which such surrender has taken effect;
- (c) if a maintenance fee and any surcharge have not been paid in due time, on the date when the maintenance fee was due.

### Article 43 - Revocation

(1) Any person may request the Judicial Authority to revoke a patent, in whole or in part, but only on any of the following grounds:

- (a) the subject-matter of the patent is not patentable under Articles 2 to 5;

- (b) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (c) the subject-matter of the patent extends beyond the content of the application as filed or, if the patent was granted on a divisional application, the content of the earlier application as filed;
- (d) the protection conferred by the patent has been extended;
- (e) the proprietor of the patent is not entitled under Articles 7 or 8. This ground may be invoked only by a person who alleges to be entitled to the patent.

(2) The request for revocation may be made even if the patent has lapsed.

(3) If the grounds for revocation only affect the patent in part, the Judicial Authority shall pronounce a partial revocation limiting the extent of the patent accordingly.

#### **Article 44 - Effect of revocation or limitation**

(1) A patent and the application on which it is based shall be deemed not to have had as from the outset, the effects referred to in Articles 19 (2) and 23 to the extent that the patent has been revoked or has been limited according to Articles 21(3) or 40 (1).

(2) When a decision of the Judicial Authority to revoke a patent in whole or in part becomes final, the Judicial Authority shall notify the Patent Office which shall record the decision in the Patent Register and shall publish any amendments to the patent as prescribed by the Implementing Regulations.

**CHAPTER X**  
**Extension of European patents**

**Article 45 - Extension of European patents**

Protection of inventions in Andorra may also be obtained by extending the effects of European patent applications and patents in accordance with the Regulations related to the Cooperation Agreement between Andorra and the European Patent Organization (EPO).

**CHAPTER XI**  
**International Applications under the Patent Cooperation Treaty**

**Article 46 - Application of the Patent Cooperation Treaty**

(1) For the purposes of this Chapter and the Second final provision, "PCT" means the Patent Cooperation Treaty done at Washington on June 19, 1970; any word or expression defined in the PCT shall have the same meaning as in that Treaty.

(2) Where reference is made in this Law to the PCT, such reference shall include the Regulations under the PCT and the Administrative Instructions under those Regulations.

(3) The Patent Office shall process international applications in accordance with the provisions of the PCT and of this Law and of any implementing legislation. In the case of conflict between the provisions of the PCT and the provisions of this Law and of any implementing legislation, the provisions of the PCT shall prevail.

(4) Further details concerning the processing of international applications by, and other functions of, the Patent Office in connection with the PCT, including time limits and other requirements in relation to international applications, may be included in the Implementing Regulations under this Law. The Patent Office Tax Law shall prescribe the fees to be paid in relation to international applications.

**Article 47 - Filing date and effects of international applications designating Andorra**

(1) Any international application designating Andorra for the purpose of obtaining a national patent under this Law, shall be equivalent to an application filed with the Patent Office and shall be considered to have the effect of a regular national application as of its international filing date and this date shall be considered to be the filing date of the application under Article 11.

(2) Any international application designating Andorra which has been published under Article 21 of the PCT shall give rise to the same rights as an application published under Article 19.

(3) Any designation of Andorra for the purpose of obtaining a national patent under this Law, in an international application filed on or after the date of Andorra's accession to the European Patent Convention shall, in accordance with Article 45.2) of the PCT, be considered to be a designation of Andorra for a European patent under the European Patent Convention.

**Article 48 - International applications filed with the Patent Office as receiving Office**

(1) The Patent Office shall, subject to paragraph (3), act as a receiving Office in respect of an international application filed with it by a national or resident of Andorra.

(2) An international application filed with the Patent Office as receiving Office shall be filed in Catalan or in the language or in one of the languages specified in the agreement concluded between the International Bureau and the International

Searching Authority which is competent for the international searching of that application, as prescribed by the Regulations, and the transmittal fee prescribed by the Patent Office Tax Law shall be paid to the Patent Office as prescribed in the Implementing Regulations.

(3) The Government can conclude an agreement of the kind referred to in Rule 19.1(b) of the Regulations under the PCT whereby an intergovernmental organization or the national Office of another Contracting State of the PCT shall act instead of the Patent Office as receiving Office for applicants who are residents or nationals of Andorra.

#### **Article 49 - Patent Office as designated and elected Office**

(1) The Patent Office shall act as a designated Office in respect of an international application designating Andorra for the purposes of obtaining a national patent under this Law.

(2) The Patent Office shall act as an elected Office in respect of an international application designating Andorra if the applicant elects Andorra for the purposes of international preliminary examination under Chapter II of the PCT.

#### **Article 50 - National processing**

The Patent Office as designated or elected Office shall not commence the processing of an international application designating Andorra before the expiration of the time limit referred to in Article 51 unless the applicant complies with the requirement of that Article and files with the Patent Office an express request for early commencement of such processing.

#### **Article 51 - Entering national phase**

(1) Where the Patent Office acts as designated or elected office the applicant shall, before the expiration of the time limit applicable under Article 22 or 39 of the PCT or such later time limit as may be prescribed in the Implementing Regulations, pay the filing fee prescribed by the Patent Office Tax Law.

(2) For the purpose of Article 3 (3), any international application designating Andorra for the purposes of obtaining a national patent under this Law, shall be taken into account only if the filing fee has been duly paid.

(3) If the filing fee has not been duly paid within the time limit applicable under paragraph (1), the international application shall be considered withdrawn for the purposes of this Law.



## **CHAPTER XII Common Provisions**

### **Article 52 - Further processing**

(1) An applicant for or proprietor of a patent who has not complied with a time limit laid down by this Law or the Implementing Regulations or set by the Patent Office may file a request for further processing if the non-compliance with the time limit has the direct consequence of causing the rejection of the application or of a request, or the loss of any other right.

(2) The request shall be filed in writing within two months following a communication by the Patent Office pointing out the failure to observe the time limit, but no later than six months after expiry of the unobserved time limit. The omitted act shall be completed within this period. The request shall be deemed not to have been filed until the fee prescribed by the Patent Office Tax Law has been paid.

(3) The Patent Office shall enter in the Patent Register the acceptance of the request for further processing as established in the Implementing Regulations.

(4) Acceptance of the request for further processing shall have the effect that the legal consequence of non-compliance with the time limit shall not ensue or, if it has already ensued, shall be retracted.

(5) This Article shall not apply to the time limits under Articles 17, 21(1), 25 (3) and paragraph (2) of this Article.

(6) Any person who, in good faith, during the period between the loss of rights referred to in paragraph (1) and the publication of the acceptance of the request for further processing has used or made effective and serious preparations for using an invention, which is the subject of a patent or a patent application published according to article 19, may without payment continue such use in the course of his business or for the needs thereof.

### **Article 53 - Appeals**

Any person directly affected by a decision of the Patent Office may file an appeal against that decision according to the Law in effect.

### **Article 54 - Jurisdiction**

- 1) Without prejudice to the provisions of Chapter VIII, the civil or, eventually, criminal Judicial Authority shall have exclusive jurisdiction for any dispute between private parties concerning a patent application or patent, in particular for:
  - (a) any request for the order of provisional measures;
  - (b) any action for infringement or a declaration of non-infringement of a patent or patent application;
  - (c) any action for revocation of a patent;

(d) any action concerning the right to the patent, the ownership or assignment of a patent application or patent or a license contract;

(e) the grant or revocation of compulsory licenses;

(2) All civil actions brought under this Law shall be prosecuted according to "*el procediment abreujat*" (summary procedure).

#### **Article 55 -Representation before the Patent Office**

(1) Natural or legal persons not having their residence or principal place of business within Andorra shall be represented by a patent agent and shall act through him in all proceedings before the Patent Office, subject to the exceptions provided by the Implementing Regulations

(2) Natural or legal persons having their residence or principal place of business within Andorra may be represented in proceedings before the Patent Office by an employee who need not be a patent agent.

(3) Any representative shall be authorized in accordance with the Implementing Regulations.

#### **Article 56 - Patent Agents**

(1) Only natural persons entered on the Register of Patent Agents kept by the Patent Office can act as Patent agents.

(2) Any person who fulfills the conditions laid down in the Implementing Regulations may be entered on the Register of Patent Agents.

#### **Article 57 - Summons**

Any administrative or judicial summons addressed to an applicant or patent proprietor who is represented before the Patent Office by a patent agent according to Article 55.1), shall be sent to the address of said patent agent. Said summons shall, for all purposes, be considered as received by the applicant or the patent proprietor within the time period established by the administrative or Judicial Authority , which in any case shall not be less than 30 calendar days from the date of reception by the patent agent.

**Additional provision**

The required fees for registration and maintenance of a patent and any other entry into the Patent Register established in this Law and for any service that may be provided by the Patent Office, as established by the Implementing Regulations, shall be fixed by the Patent Office Tax Law.

**Derogatory provision**

The Literary and artistic property “*decret*” of June 25<sup>th</sup> 19971 is completely derogated when this Law comes into effect.

Any other prior provision, of equal or lower level, is equally derogated as far as it is in opposition to the content of this Law.

**First final provision**

(1) The Government shall draw up the necessary rules required or desirable to give effect to this Law, in particular the Implementing Regulations and the Regulations creating the Patent Office.

(2) The Government shall approve the Regulations related to the Cooperation Agreement between Andorra and the EPO, prescribing all matters which by this Law are required or permitted to be prescribed, or which are necessary or desirable to be prescribed in order to give effect to the Cooperation Agreement between Andorra and the EPO.

**Second final provision**

This Law shall enter into force on the day after the date of its publication, except for the provisions of Chapter X that shall enter into force on the date when the Cooperation Agreement between the Government of Andorra and the European Patent Organization enters into force and Chapter XI that shall enter into force on the date when the Patent Cooperation Treaty enters into force in respect of Andorra.

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