



REPUBLIC OF SAN MARINO

The Italian text shall be legally binding

DECREE – LAW no. 76 of 22 June 2009

**We the Captains Regent of
the Most Serene Republic of San Marino**

Having regard to the conditions of need and urgency referred to in Article 2, paragraph 2, letter b) of Constitutional Law no. 183 of 15 December 2005 and in Article 12 of Qualified Law no. 184 of 12 December 2005, with particular reference to the need and urgency to bring the San Marino legislation in line with that of the European Patent Convention and to introduce rules implementing the European Patent Convention, which will enter into force for the Republic of San Marino on 1 July 2009 following the deposit of the instrument of ratification.

Having regard to Congress of State Decision no. 9 adopted in its sitting of 15 June 2009;

Having regard to Article 5, paragraph 2 of Constitutional Law no. 185/2005 and to Articles 9 and 10, paragraph 2 of Qualified Law no. 186/2005;

Promulgate and order the publication of the following Decree-Law:

**RULES IMPLEMENTING THE EUROPEAN PATENT CONVENTION
(EPC)**

Art. 1

(Definitions)

1. For the purposes of application of this Decree-Law, the following definitions shall apply:
 - European Patent Convention: the Convention on the Grant of European Patents, done at Munich on 5 October 1973, updated in Munich on 29 November 2000;
 - European Patent: the European patent granted by the European Patent Office within the meaning of the European Patent Convention;
 - European Patent Application: the European patent application within the meaning of the European Patent Convention;
 - Office: the Patents and Trade Marks State Office.

Art. 2
(Applicable law)

1. The rules referred to in this Decree-Law shall apply to European patent applications and European patents pursuant to the European Patent Convention for which the Patents and Trade Marks State Office shall act as receiving and designated office.
2. The text of the European Patent Convention, ratified through Parliamentary Decree no. 48 of 31 March 2009, shall prevail over the text of this Decree-Law in case of conflict.

Art. 3
(Filing of a European patent application)

1. European patent applications, except for divisional applications, may be filed with the Patents and Trade Marks State Office, according to the manners envisaged by the European Patent Convention.
2. The Patents and Trade Marks State Office shall accept applications in any admissible language, in accordance with Article 14, paragraphs 1 and 2 of the European Patent Convention.
3. European patent applications may be filed with the Patents and Trade Marks State Office directly or by post or through similar service or by fax.
4. The Patents and Trade Marks State Office shall promptly forward the European patent applications to the European Patent Office.

Art. 4
(Effects of a patent application)

1. A European patent application which has been accorded a date of filing shall, in the Republic of San Marino, be equivalent to a national patent application submitted to the Patents and Trade Marks State Office of San Marino.
2. A published European patent application shall provisionally confer a protection corresponding to that envisaged for national patent applications by Article 21, paragraph 7 of Law no. 79 of 25 May 2005, from the date on which the applicant has notified an Italian translation of the claims published to the assumed infringer.
3. The European patent application referred to in the preceding paragraph shall be deemed never to have had any effects from the outset, when it has been refused or withdrawn, or when the designation of the Republic of San Marino is withdrawn.

Art. 5
(Effects of a European patent)

1. A European patent designating the Republic of San Marino shall, subject to the terms and the procedure set forth in this Article, confer the same rights as would be conferred by a San Marino national patent under Law no. 79 of 25 May 2005 and subsequent amendments.
2. Within six months following the publication of the mention of the grant of the European patent, the proprietor of the patent shall supply to the Patents and Trade Marks State Office a request to enter the European patent in the San Marino national register, a copy of the European patent published in the European Patent Bulletin, a translation thereof in Italian, brought into conformity with the original by the proprietor of the patent or any person acting on his/her behalf, as well as a description of the patent and claims. The proprietor of the patent or the person acting on his/her behalf shall also pay the prescribed costs of publication.
3. The Patents and Trade Marks State Office shall make a decision whether to grant the patent, pursuant to Articles 23 and 24 of Law no. 79 of 25 May 2005 and subsequent amendments.

4. If, following the filing of an opposition with the European Patent Office, the European patent is maintained in amended form or limited in accordance with Article 105a of the European Patent Convention, the proprietor of the patent, within 6 months after the publication of the European Patent Office's decision, shall supply to the Patents and Trade Marks State Office an Italian translation of the claims amended or limitation, brought into conformity with the original by the proprietor of the patent or a person acting on his/her behalf. The proprietor of the patent or the person acting on his/her behalf shall also pay the prescribed costs of publication.
5. The Patents and Trade Marks State Office shall promptly make the translations available to the public and give notice of the filing of the translations mentioned in paragraphs 2 and 4 of this Article, by publishing the information in the Official Bulletin.
6. If the translations referred to in paragraphs 2 and 4 of this Article are not filed within the prescribed period, or the prescribed costs of publication have not been paid, the patent shall be deemed not to have had, from the outset, the effects referred to in this Article for the Republic of San Marino.
7. Any infringement of a European patent shall be dealt with by national law.

Art. 6

(Authentic text of a European patent application)

1. The text of a European patent application or a European patent in the language of the proceedings before the European Patent Office shall be the authentic text for the extension of the protection in the Republic of San Marino.
2. However, any translation into Italian of the documents relating to the filing of the application and the grant of European patents shall be regarded as authentic within the territory of the State, if it confers protection which is narrower than that conferred by the text in the language of the proceedings before the European Patent Office.
3. The provision referred to in paragraph 2 shall not apply in case of an invalidity action.
4. A corrected translation may be filed, at any given moment, by the applicant or the proprietor of the patent. It shall take effect only after it has been made available to the public at the Patents and Trade Marks State Office, or it has been communicated to the assumed infringer.
5. Anyone who, in San Marino, in good faith has used or has made effective preparations for using an invention the use of which would not constitute infringement of the application or patent in the original translation, may, after the corrected translation takes effect, continue such use in the course of his business or for the needs thereof without payment.

Art. 7

(Annual renewal fees)

1. With a view to maintaining in force a European patent in the Republic of San Marino, any renewal fees envisaged for national patents shall be paid to the Patents and Trade Marks State Office.
2. The first payment of the renewal fees shall be made in respect of the year, calculated from the date of filing of the application, that follows the year in which the mention of the grant of the European patent is published in the European Patent Bulletin.

Art. 8

(Statement of an address for service)

1. In the proceedings before the Patents and Trade Marks State Office relating to a European patent having effect in San Marino, except for the proceedings referred to in Article 3 of this Decree-Law, the proprietor shall state an address for service with a professional qualified to act

before the Patents and Trade Marks State Office for any communication and notification from said Office.

Art. 9

(Conversion of a European patent application)

1. A European patent application for which the Republic of San Marino is designated may be converted into a San Marino patent application for an invention susceptible of industrial application:
 - a) in case of non-compliance with the time-limit referred to in Article 14, paragraph 2 of the European Patent Convention;
 - b) where the European patent application is deemed to be withdrawn under Article 77, paragraph 3 of the European Patent Convention.
2. In the case specified in paragraph 1, letter a) of this Article, a request for conversion shall be filed with the European Patent Office, which shall forward it to the Patents and Trade Marks State Office.
3. In the case referred to in paragraph 1, letter b) of this Article, a request for conversion shall be filed with the Patents and Trade Marks State Office, which shall transmit the request to the central industrial property offices of the Contracting States specified therein.
4. If a regular request for conversion is transmitted to the Patents and Trade Marks State Office, the patent application shall be deemed as filed in the Republic of San Marino on the date of filing of the European patent application. The documents accompanying this application which have been submitted to the European Patent Office shall be deemed as filed in San Marino on the same date.
5. Upon receipt of the request for conversion, the Office shall assign a national registration number to the application. It shall also require that the interested party shall, within a period of not less than two months, pay the national application fees and provide, if absent, a statement of an address for service in San Marino and a translation of the original text of the European patent application in Italian, as well as, where appropriate, a translation of the application as amended during the proceedings before the European Patent Office.
6. If the conditions laid down in the preceding paragraph are not fully met within the prescribed or, where appropriate, extended period, the Patents and Trade Marks State Office shall refuse the application.
7. The provisions in force for San Marino patent applications shall be applicable to the patent applications resulting from the conversion procedure, without prejudice to the first paragraph of Article 137 of the European Patent Convention.

Art. 10

(Primacy of European patents in case of simultaneous protection)

1. If a San Marino patent relates to an invention for which a European patent valid in San Marino has been granted to the same inventor or to his/her successor in title with the same date of filing or with the same date of priority, the San Marino patent shall cease to have effect to the extent that it covers the same invention as the European patent, from the date on which:
 - a) the period for filing an opposition to the European patent has expired without any opposition being filed;
 - b) the opposition proceedings are concluded with a decision to maintain the European patent.
2. The subsequent lapse or revocation of the European patent shall not affect the provisions of paragraph 1.
3. Upon expiry of the period referred to in paragraph 1, anyone having promoted an action to protect the San Marino patent may request a corresponding protection be granted to the

European patent, without prejudice to the rights deriving from the San Marino patent for the preceding period.

Art. 11

(Non-compliance with the terms)

1. In the event of non-compliance with the terms prescribed by this Decree-Law, Article 89 of Law no. 79 of 25 May 2005 shall apply, subject to payment of the relevant fee.

Done at Our Residence, on 22 June 2009/1708 since the Foundation of the Republic

THE CAPTAINS REGENT
Massimo Cenci – Oscar Mina

THE SECRETARY OF STATE
FOR INTERNAL AFFAIRS
Valeria Ciavatta