

Agreement  
between  
Ufficio di Stato Brevetti e Marchi,  
Republic of San Marino  
and  
the Swedish Intellectual Property Office

# Agreement

between

Ufficio di Stato Brevetti e Marchi,

Republic of San Marino and

the Swedish Intellectual Property Office

This Agreement has been reached between Ufficio di Stato Brevetti e Marchi, Republic of San Marino on one part and the Swedish Intellectual Property Office on the other.

## PREAMBLE

Ufficio di Stato Brevetti e Marchi (USBM), Republic of San Marino and the Swedish Intellectual Property Office (PRV).

## CONSIDERING

that the Swedish Intellectual Property Office is qualified as an International Searching Authority and an International Preliminary Examining Authority in accordance with Art. 16 and 32 of the Patent Co-operation Treaty (PCT).

## DESIRING

to increase the co-operation between Ufficio di Stato Brevetti e Marchi (USBM), Republic of San Marino and the Swedish Intellectual Property Office (PRV).

HAVE DECIDED AS FOLLOWS:

## Article 1

### Basic Obligations

1. PRV will carry out search and examination for USBM. In carrying out search and examination, PRV will be guided, to the extent appropriate and necessary, by the Guidelines for International Search and Preliminary Examination to be carried out under the Patent Co-operation Treaty (PCT).

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2. USBM will transmit to PRV requests on search, examination, or combined search and examination of technical features each laid down in a description, claim(s), abstract and drawing(s), the latter where appropriate, each in English. In case priority is claimed the relevant priority document(s) shall be enclosed either in English, French or German, if available at USBM. Otherwise, the USBM will give an Information to PRV whether the claimed priority is given or not.
3. PRV and USBM will render, to the fullest extent possible, mutual assistance in the performance of their obligations under this Agreement.
4. Where activities pursued under this Agreement calls for communication with the applicant, such communication shall be the sole responsibility of the USBM. Nothing in this Agreement shall be construed as to authorize or oblige PRV to enter into any dialogue with the applicant or persons representing the applicant.

## **Article 2**

### **Provision of personnel**

For the purposes of carrying out its obligations under this Agreement, PRV will make available the necessary staff having sufficient technical qualifications to fulfil the obligations referred to in Article 1 of this Agreement to the extent required by the workload up to 50 search & examination or examination products. If this limit is reached PRV has the right to waive further requests under this Agreement.

## **Article 3**

### **Subject matter required to be searched**

PRV will search as much of the relevant prior art as its facilities permit and will, in any case, consult the documents specified in the PCT-Minimum-documentation in accordance with Rule 34 of the Regulations under the PCT, complemented by

- patent documents filed with or issued by PRV,
- patent documents filed with or issued by other Nordic patent offices
- patent documents filed with or issued by the USBM, insofar as the USBM has transmitted such documents to PRV in English, French or German.

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## Article 4

### Search and Examination

#### 1. Novelty Search

##### 1.1 Formal requirements

The USBM shall only transmit application that meet the formal requirements set up in the USBM-Patent Regulations under Article 12,13,14,15,16 and 18. If the application does not meet the requirements of Article 18(1) (non-unity) of the USBM-Patent Regulations PRV shall establish the search report of those parts of the application which relate to the invention first mentioned in the claims, ("main invention"). With the transmission of the search report USBM shall receive information on the above mentioned fact.

##### 1.2 Novelty Search report

The novelty search report including the state of the art, will be in accordance with Rules 43.2, 43.3, 43.5, 43.6, 43.7, and 44.2 of the Regulations under the PCT and shall contain a list of all patent documents or non-patent literature (NPL) -documents found in the novelty search accompanied by a written explanation. This novelty search report should indicate the IPC fields searched by the examiner and shall include one copy of each document cited. Where necessary for compliance with Swedish copyright law NPL documents cited by PRV in search reports will be distributed separately by paper.

A reference will be carried out by PRV to the precise part of the cited document with regard to the invention as a whole or to each claim concerned or to a combination of two or more documents. The references should be made precisely to the lines, paragraphs, pages or drawings of the cited documents with an indication of its relevance to the claims of the application, and its date of publication.

#### 2. Examination

##### 2.1 Formal requirements

The USBM shall transmit application that meet the formal requirements set up in the USBM-Regulations under Article 12, 13, 14, 15, 16 and 18 only. If the application does not meet the requirements of Article 18(1) (non-unity) of the USBM-Regulations PRV shall establish the examination report of those parts of the application which relate to the invention first mentioned in the claims, ("main invention"). With the transmission of the examination report USBM shall receive information on the above mentioned fact.

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The examination will be performed on the basis of

- a) a novelty search report set up PRV or
- b) the novelty search report(s) elected by USBM.

If the examination should be based on a novelty search report, elected by USBM, this novelty search report will be transmitted by USBM to PRV. If the search report is not in English, French or German, a translation into any of these languages will be provided by the USBM.

If the selected novelty search report contains patent documents and/or non-patent literature (NPL) documents which are not available to PRV or which are not in English, French or German, USBM will, submit to PRV a copy of each document and, if these documents are not in English, French or German, a translation into any of these languages.

## **2.2 Examination Reports**

Examination reports will be established in accordance with Rules 70.2, 70.4, 70.5, 70.6, 70.7, 70.10 (examination of the claimed priority included), 70.11, 70.12 and 70.13 of the Regulations under the PCT, and shall include a statement whether the subject matter of the request is deemed to be patentable, which means that it meets the requirements of novelty, inventive step, and industrial applicability, based on the results of the novelty search report, as laid down in Article 2 and 3 of the USBM- Regulations and is not excluded by Article 1 of the USBM- Regulations. A further statement will be issued if the claimed priority is not certified by the enclosed priority document.

If the first examination report set up by PRV or issued by any other Examination Authority under the PCT indicates that the application does not meet the substantive requirements PRV shall upon request of USBM establish a further examination report.

This request shall contain written arguments in response to the first examination report and/or amended claims. The total number of examination reports based on similar procedure is limited with 3 reports. First examination reports established by an International Examination Authority under the PCT ("International Preliminary Examination Report") are to be transmitted by USBM to PRV. The above mentioned language regime applies.

*PRV*

## **Article 5**

### **Time limits**

1. PRV will transmit to USBM a novelty search report, a combined novelty search and examination report or a 1st examination report within four to six months from the date of receipt by the Swedish Intellectual Property Office of the relevant request.
2. PRV will transmit to USBM a 2nd or 3rd examination report within three months from the date of receipt by the PRV of the relevant request.
3. PRV will transmit to USBM services according to Art 5.1 and Art. 5.2 within one month from the date of receipt PRV of the relevant request should so called Express- services be ordered.
4. The date of transmission is the date when the report was available in the PIS-system.

## **Article 6**

### **Language of correspondence**

For the purpose of correspondence/communication between the parties the English language will be used. The search and examination reports drawn up by PRV will be in English only.

## **Article 7**

### **Electronic Interchange of Documents**

Electronic interchange of documents required for the transmittal of applications and reports will be facilitated by a secure ftp (sftp:) service provided by PRV. All documents to be interchanged between offices shall comply with a standard defined by both Parties. In order to be in compliance with Swedish copyright law, NPL documents cited by PRV in search reports will be distributed separately via post (in paper format) by the library of PRV, after a request from USBM, to the library of USBM.

## **Article 8**

### **Charges**

5. A schedule of charges which PRV will be entitled to demand is set out in the Annex to this Agreement.
6. All charges include the costs of providing copies of documents cited in the search and examination reports and dispatch expenses for transmittals from PRV to USBM.

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7. The charges set out in the Schedule are fixed for a period of two years from the date of entry into force of this Agreement. Any amendments of the Annex shall be reached upon mutual consent at the end of the second year after entering into force of this Agreement.
8. Payments must be effected by bank transfer to:  
  
Danske Bank Sverige, Norrmalmstorg 1, Box 7523, 103 92 Stockholm IB  
  
AN:SE1712000000012810107165  
  
BIC/SWIFT: DABASESX),  
  
The payment must give indications to the reference number of PRV and the application number of the USBM.
9. The currency of payment will be EURO.

#### **Article 9**

##### **Dispute settlement**

Any difficulties arising between the two parties from the present Agreement shall be solved through negotiations between the parties.

#### **Article 10**

##### **Liability**

The work shall be carried out by PRV on the basis of the literature available in the PRV with the greatest possible care to reach correctness and completeness of information.

Taking into consideration the normal procedure of search and examination under national and international standards PRV does not accept any liability for the work carried out on request of USBM.

#### **Article 11**

##### **Entry into force of the Agreement**

This Agreement will take effect on January 1, 2023. Both an Italian and an English copy of this Agreement will be drawn up.

*PRV*

*[Signature]*



## Article 12

### Duration and Renewal of the Agreement

This Agreement will remain in effect for a period of two years after the Agreement has come into force. Should neither party indicate its wish to terminate the Agreement said Agreement will automatically be considered renewed for a period of two years subsequent to the initial two years' validity.

At least six months before the expiry of the Agreement (whether of two or four years duration), the parties of this Agreement will indicate their wish to terminate or renegotiate the terms of this Agreement.

Modifications, additions and legal relevant information having effects on the Agreement have to be done in written form.

In case of change of the San Marino acts relating to patents, which refer in particular to a re-organization of the law articles which are referred to in the present Agreement, the necessary amendments will be made by exchange of letters, provided no substantive changes are introduced in those articles.

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### Article 13

#### Termination of the Agreement

1. This Agreement shall terminate before the end of duration of the Agreement as stated in Article 11 of this memorandum if USBM or PRV gives other party notice to terminate this Agreement.
2. The Termination of this Agreement will take effect six months after the date of receipt for the notice by the Partner Office; unless a longer period is specified in such notice or, unless both parties consent to a shorter period.

Munich, Dec 13th, 2022

On behalf of

The Swedish Intellectual Property Office



Mr Peter Strömbäck

Director General of PRV The Swedish  
Intellectual Property Office.

On behalf of

Ufficio di Stato Brevetti e Marchi

Ms Silvia Rossi

Director of the Ufficio di Stato Brevetti e  
Marchi



**ANNEX**

<b>Subject matter</b>	<b>Standard EURO</b>	<b>Express EURO</b>
<b>Novelty search report</b>	<b>1500</b>	<b>1700</b>
<b>Novelty search and examination report</b>	<b>2200</b>	<b>2400</b>
<b>Examination report (1<sup>st</sup> exam, search done by PRV)</b>	<b>900</b>	<b>1100</b>
<b>Examination report (1<sup>st</sup> exam, search done by other office than PRV)</b>	<b>1000</b>	<b>1300</b>
<b>2:nd, 3rd examination report (search by PRV)</b>	<b>500</b>	<b>700</b>
<b>2:nd, 3rd examination report, (search by other office than PRV)</b>	<b>800</b>	<b>1000</b>

