



National Registry,  
Republic of Costa Rica

May 7, 2014

Standing Committee on the Law of Patents (SCP)

Following the invitation contained in Circular 8343, of March 10, 2014, we wish to submit our comments on the topics listed below.

#### *Exceptions and Limitations to Patent Rights*

The Costa Rican Patent Office has not kept any records relating to the implementation of the following exceptions and limitations: (i) acts for obtaining regulatory approval from authorities; (ii) exhaustion of patent rights; (iii) compulsory licensing and/or government use.

As to the exception concerning farmers' and/or breeders' use of patented inventions, as stated in the responses to the questionnaire on exceptions and limitations to patent rights, our laws make no provision in this regard.

#### *Transfer of Technology*

With regard to patent-related incentives and impediments to transfer of technology, the Patent Office has received the following comments from patent system users.

- Article 4 of the Law on Patents provides that the worker concerned shall enjoy a 50 per cent share in intellectual property (IP) that actually belongs to the employer at the global level. This provision discourages companies from investing in innovation in Costa Rica, as the Law forces them to treat employees as partners.
- Certain universities apply a rule whereby IP belongs to the university if it is the university that drafts the patent. This rule is excessive and dissuades innovators from working with universities.
- In the case of Small and Medium-sized Enterprise Support Program (PROPYME) funds, an hourly rate is charged in the case of IP, despite the existence of a decree on tariffs that sets out minimum amounts for charges.
- Most of the existing funds are not designed to finance IP processes. Restrictions were introduced in this regard this year under PROPYME.
- The Patent Office must clearly inform users that they cannot draft patents on their own and that they must seek out an agent with the relevant training. Many inventions are lost in this way. Nevertheless, there are no recognized agents and such a requirement cannot therefore be made. Recently, the parties concerned were invited to add themselves to a database of agents and patents, as well as to provide the Patent Office with their contact details, with a view to said information being incorporated into the National Registry web site and made available to users.
- Many national inventions consist of methods of business and games, which, unfortunately, are excluded from patentability in Costa Rica. Work should therefore be carried out to look into the possibility of introducing legislative amendments in that regard.
- The national patent system does not provide for provisional patents.

We would like to take this opportunity to update the information on certain aspects of national/regional patent laws (document available at: [http://www.wipo.int/scp/es/annex\\_ii.html](http://www.wipo.int/scp/es/annex_ii.html)), in order to ensure the inclusion of the information contained in document SCP/17/2/ADD concerning the grace period and exclusions from patentable subject matter. The following information should also be included:

- The following paragraph should be added under the headings corresponding to Prior Art, Novelty and Inventive Step:

“The disclosure resulting from a publication made by an industrial property Office in the process of granting a patent shall be included in the state of the art, except for the case of a patent applicant, or when the application in question has been filed by a person who did not have the right to obtain the patent or when the publication has been made unlawfully. (Amended by Law No. 8632 of March 28, 2008. Gazette No. 80 of April 25, 2008.)”

- Under the heading corresponding to Exceptions and Limitations of the Rights, paragraph 7 should be corrected to read:

“7. Compulsory licenses and public utility licenses”

Finally, with regard to national or regional laws and practices relating to the confidentiality of communications between patent advisors and their clients, we wish to state, in addition to our comments sent on August 9, 2011 (document attached), that, in accordance with Article 34 of Law No. 6867 on Patents, Industrial Designs and Utility Models, “where applicants have their domicile or headquarters outside Costa Rica, they shall be represented by a lawyer domiciled in the country, with sufficient authority.” (emphasis added).