



Republika e Kosovës
Republika Kosovo - Republic of Kosovo
Kuvendi - Skupština - Assembly

Law No. 05/L -039

**ON AMENDING AND SUPPLEMENTING THE LAW No. 04/L-029 ON
PATENTS**

The Assembly of the Republic of Kosovo,

Based on Article 65 (1) of the Constitution of the Republic of Kosovo,

Approves:

**LAW ON AMENDING AND SUPPLEMENTING THE LAW No. 04/L-029
ON PATENTS**

Article 1

In Article 1 of the basic Law after paragraph 1 there shall be added a new paragraph 2 with the following text:

2. This Law is in accordance with the Directives:

2.1. Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions (O.J. L 213, p. 13, 30.7.1998)

2.2. Directive 2004/48/EC of the European Parliament and of the Council of April 2004 on the enforcement of intellectual property rights (O.J. L 157, p.45, 30.4.2004; O.J. L 195, p.16, 2.6.2004);

2.3. Regulation (EC) No 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products (O.J. L 152, p.1, 16.6.2009) ;

2.4. Regulation (EC) No.1610/96 of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products (O.J. L 198, p.30, 8.8.1996) ;

2.5. Regulation (EC) No 816/2006 of the European Parliament and of the Council of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems (O.J. L 157, p.1, 9.6.2006).

Article 2

1. In Article 2 of the basic Law, paragraph 1, sub-paragraph 1.3 shall be deleted, and in the entire text of the basic Law, the denomination "Office of Industrial Property" (OIP) – shall be replaced with the denomination “the Agency for Industrial Property”, hereinafter (AIP).
2. In Article 2 of the basic Law, sub-paragraph 1.5 shall be deleted.

Article 3

In Article 4 of the basic Law, paragraph 1 and 2 shall be reworded with the following text:

1. AIP is an administrative central body of the Ministry of Trade and Industry which is responsible for legal protection of the innovation, trade mark, industrial design, and designation of origin, geographic indications and topographies of integrated circuits, and other issues arising from international agreements the signatory of which is the Republic of Kosovo.
2. Organization and functioning of AIP shall be defined by sub-legal act.

Article 4

Article 5 of the basic Law shall be reworded with the following text:

Article 5
Responsibilities of the Agency

1. Agency shall be responsible for:

1.1. developing procedures for issuing patents, supplementary protection certificates for inventions, registration of the trade mark, industrial designs, topographies of integrated circuits, designation of origin and of geographic indications;

1.2. compiling and maintaining the records prescribed by the basic Law;

1.3. proposes, designs and publishes the Official Bulletin of AIP, which shall contain information about the application and the rights granted to industrial property;

1.4. contributes in, develops and promotes the industrial property protection;

1.5. initiates and proposes the ratification of international agreements in regard to industrial property area;

1.6. provides information services in regard to industrial property facilities.

1.7. organizes testing for the authorized representatives of the industrial property right area;

1.8. prepares proposals for approval of the legal and sub-legal acts in regard to the industrial property area;

1.9. cooperates with other organizations to implement legal provisions regulating the industrial property;

1.10. represents the Republic of Kosovo in International Organization for the industrial property.

Article 5

1. In Article 6 of the basic Law, paragraph 4 shall be reworded with the following text:

4. Against decision of the commission a claim in accordance with the Law on administrative procedure may be submitted to the Basic Court in Prishtina within the time limit of thirty (30) days.

Article 6

1. In Article 9 of the basic Law paragraph 1, sub-paragraph 1.2 shall be divided into two sub-paragraphs 1.2.a and 1.2.b with the following text:

1.2.a. plants and animal varieties;

1.2.b. essentially biological processes for the production of plants or animals, this shall be without prejudice to the patentability of inventions concerning a microbiological or other technical process or a product obtained by means of such a process.

Article 7

In Article 24 of the basic Law, paragraph 1, 2 and 3 shall be deleted and reworded with the following text:

1. If a biological material possessing specific characteristics as a result of the invention is protected by a patent, the exclusive rights referred to in Article 23, paragraphs 1 and 2 of the basic Law shall extend to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

2. If a process that enables a biological material to be produced possessing specific characteristics as a result of the invention is protected by a patent, the exclusive rights referred to in Article 23 paragraphs 1 and 2 of the basic Law shall extend to biological material directly obtained from any other biological material derived from the directly obtained biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

3. If a product containing or consisting of genetic information is protected by a patent, the exclusive rights referred to in Article 23 paragraphs 1 and 2 of the basic Law shall extend to all material, save as the human body and the various stages of its formation and development or the simple discovery of one of its elements, including the sequence or partial sequence of a gene, in which the product is incorporated and in which the genetic information is contained and performs its function.

Article 8

In Article 36 of the basic Law, paragraph 4 shall be deleted and reworded with the following text:

4. On a reasoned request, the court may grant a compulsory license in respect of a first patent to the owner of a patent or to the owner of a plants varieties rights who cannot use his patent , second patent or his plants varieties right without infringing the first patent or

a prior plants varieties right, provided that the invention claimed in the second patent or a protected plant variety involves an important technical advance of considerable economic significance in relation to the invention claimed in the first patent.

Article 9

1. In Article 63 of the basic Law, paragraph 3 shall be deleted and reworded with the following text:

3. A subsequent patent application filed in or for the same state shall be considered as the first application for the purposes of determining priority right, in the part that it is related to the invention subject-matter of the first application, provided that, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The first application may not thereafter serve as a basis for claiming a right of priority.

2. In Article 63 of the basic Law, after paragraph 4 there shall be added a new paragraph 5 with the following text:

5. Where the copy of the first application referred to in paragraph 4.2 of Article 63 of the basic Law is not in one of the official languages in the Republic of Kosovo, AIP or a competent court may require that a translation of the first application in one of the official languages be filed by the person requesting priority within three (3) months from the receipt of the invitation.

Article 10

1. In Article 78 of the basic Law, paragraph 1 there shall be added a reference in Article 13.

Article 11

1. In Article 80 of the basic Law, paragraph 6 shall be deleted and reworded with the following text:

6. Reinstatement of rights can not be requested in case of the failure to comply with a time limit for the following acts:

2. In Article 80 of the basic Law, sub-paragraph 6.3 shall be entirely deleted.

Article 12

Article 83 of the basic Law, paragraph 5 shall be deleted and reworded with the following text:

5. Patent maintenance fee can be paid by any person.

Article 13

1. Article 84 of the basic Law, paragraph 1 shall be deleted and reworded with the following text:

1. The following terms used in relation to Supplementary Protection Certificate shall have the following meanings:

2. Article 84 of the basic Law, paragraph 1, sub-paragraph 1.3 shall be deleted and reworded with the following text:

1.3. basic patent shall be a patent which is designated by its holder for the purpose of the procedure for the grant of a Supplementary Protection Certificate, protecting a product as such, as defined in sub-paragraph 1.2 of Article 84 of the basic Law, or the process for obtaining a product or an application of a product;

3. Article 84 of the basic Law paragraph 2 shall be reworded with the following text:

2. The following terms used in relation to Supplementary Protection Certificate for plant protection products- hereinafter certificate - shall have the following meanings:

4. Article 84 of the basic Law, paragraph 2, sub-paragraph 2.9 shall be deleted and reworded with the following text:

2.9. basic patent shall be a patent which is designated by its holder for the purpose of the procedure for the grant of a “Supplementary Protection Certificate”, protecting a product as such, as defined in sub-paragraph 2.8 of Article 84 of the basic Law, a preparation as defined in paragraph 4 of Article 84 of the basic Law or a process for obtaining a product or an application of a product;

Article 14

Article 88 of the basic Law, paragraph 1 shall be deleted and reworded with the following text:

1. The procedure for granting the Certificate should be instituted by filing an application containing:

1.1. a request for the grant of the Certificate, stating in particular:

1.1.1. the name and address of the applicant;

1.1.2. the name and address of the authorized representative, if any;

1.1.3. the number of the basic patent and the title of the invention.

2. In Article 88 of the basic Law, paragraph 1, sub-paragraph 1.4 shall be renumbered as sub-paragraph 1.1.4, sub-paragraph 1.5 shall be renumbered as sub-paragraph 1.2 and sub-paragraph 1.6 shall be renumbered as sub-paragraph 1.3, sub-paragraph 1.7 shall be renumbered as 1.4, sub-paragraph 1.3 shall be reworded with the following text:

1.3. evidence that indicates the identity of the product, content of authorization procedure and the Bulletin in which the information for authorization is published, if the authorization referred to in sub-paragraph 1.2 of this Article is not the first authorization to place the product on the market;

3. In Article 88 of the basic Law, paragraph 4, sub-paragraph 4.2 shall be deleted and reworded with the following text:

4.2 where necessary, in addition to the copy of the authorisation to place the product on the market as referred to in paragraph 1.2 of Article 88 of the basic Law, there may be required even the evidence of possession of authorisations to place the product on the market of all EU Member States.

4. Article 88 of the basic Law, paragraph 5, 6 and 7 shall be deleted and reworded with the following text:

5. When application for a certificate is in the phase of examination, the application for the duration of term under paragraph 2 of Article 87 of the basic Law should include the data referred to in paragraph 4 of Article 88 of the basic Law and a reference on application for the certificate, already submitted.

6. The application for the duration of term of the certificate should include the data referred to in paragraph 4 of this Article 88 of the basic Law and a copy of the certificate already granted;

7. The application referred to in paragraph 1, sub-paragraph 1.1 of Article 88 of the basic Law shall be filed in the form the content of which shall be determined by sub-legal act.

Article 15

In Article 93 of the basic Law, paragraph 1 and 2 shall be deleted and reworded with the following text:

1. Within the limits of the protection conferred by the basic patent, the protection given by the Protection Supplementary Certificate shall extend only to the product covered by the authorisation to place on the market a medicinal product intended for humans or animals, or a plant protection product respectively, as well as for any use of the product as a medicinal product intended for humans or animals, or a plant protection product, respectively, that has been authorized before the expiry of the Protection Supplementary Certificate

2. The Protection Supplementary Certificate shall confer to the owner of the basic patent or to his successor in title the same rights as are conferred by the basic patent and shall be subject to the same limitations and the same obligations.

Article 16

Article 94 of the basic Law shall be deleted and reworded with the following text:

Article 94

AIP shall publish data concerning the filing of an application for the Protection Supplementary Certificate, the decision on the grant of the Certificate, or data on the rejection of the application for the Certificate. The data concerning the application for an extension of the Protection Supplementary Certificate and the termination of the Certificate shall be determined by a sub-legal act.

Article 17

In Article 96 of the basic Law, paragraph 1, sub-paragraph 1.2, there shall be added the reference in Article 99.

Article 18

1. In Article 102 of the basic Law, sub-paragraph 1.3 shall be deleted entirely.

2. In Article 102 of the basic Law, sub-paragraph 1.4 shall be renumbered as sub-paragraph 1.3.

Article 19

Article 110 of the basic Law shall be entirely deleted and reworded with the following text:

Article 110
Persons Entitled to Seek Enforcement of Rights

The protection of the rights under this Law may be claimed by a right holder, or a person authorized by a right holder accordance with the general provisions on representation, and by the holder of the exclusive licence, to the extent that he has acquired the right of exploitation of an invention on the basis of a legal transaction or Law.

Article 20

Title of Article 112 of the basic Law and paragraph 1 of this Article shall be deleted and reworded with the following text:

Article 112
The request due to the violation of the right of the inventor to be mentioned as such in the application

1. The inventor should have the right to submit a claim to require that his/her name to be mentioned in the patent application and/or documents relating to the patent and/or the registers of the AIP, if the person mentioned as such is not the inventor and if the inventor is not mentioned.

Article 21

1. In Article 113 of the basic Law, paragraph 2 there shall be amended the reference from Article 25 to Article 24.

2. In Article 113 of the basic Law, paragraph 4 shall be deleted and reworded with the following text:

4. A legal action referred to in Article 113 of the basic Law may be filed against the intermediaries whose services are used by a third party to infringe the patent or threaten towards its infringement.

Article 22

1. In Article 114 of the basic Law, paragraph 1, the word "acts" shall be replaced with the word "rights", the phrase "at the expense of the infringer" shall be deleted.

2. In Article 114 of the basic Law, paragraph 2 shall be deleted and reworded with the following text:

2. The court shall order the measures referred to in paragraph 1 of Article 114 of the basic Law, to be covered at the expense of the infringer, unless there are special reasons for not deciding so.

Article 23

In Article 115 of the basic Law, paragraph 1, 2 and 3 shall be deleted and reworded with the following text:

1. The patent owner shall be entitled to file a legal action against any person who, knowingly, or with reasonable grounds to know, is engaged in performing without authorization any of the rights referred to in Article 23 and Article 24 of the basic Law, claiming the damages pursuant to the general rules on legal redress laid down in the Law on Obligational Relationships.

2. The patent owner shall be entitled to file a legal action against any person who, knowingly, or with reasonable grounds to know, is engaged in performing without authorization any of the acts referred to in Article 23 and Article 24 of the basic Law, claiming the payment of remuneration in the amount that he would have received, considering the circumstances, in the license agreement, if concluded.

3. The patent holder shall be entitled to file a legal action against any person who, knowingly, or with reasonable grounds to know, is engaged in performing without authorization any of the acts referred to in Article 23 and Article 24 of the basic Law, having no grounds for it in any legal transaction, court decision or law, claiming the compensation or recover of such benefits in accordance with general rules on unjust enrichment, laid down in the Law on Obligational Relationships.

Article 24

In Article 119 of the basic Law, paragraph 2, sub-paragraphs 2.1, 2.2, 2.3, 2.4 and 2.5 shall be deleted and reworded with the following text:

2. A justified and proportionate request under paragraph 1 of this Article may be submitted in a form of a legal action or provisional measures against the alleged infringer and/or any other person:

2.1. against whom a legal action was lodged pursuant to paragraph 1 of this Article;

2.2. was found to be providing services , there exists the suspicion that they have infringed a patent on a commercial scale;

2.3. was found to be providing services suspected of infringing a patent on a commercial scale;

2.4. was found to be providing on a commercial scale services used in the activities suspected of infringing a patent;

2.5. was indicated by any person referred to in sub-paragraphs 2.1, 2.2, 2.3 or 2.4 of this Article as being involved in the production, manufacture or distribution of the goods or the provision of the services.

Article 25

In article 120 of the basic Law, sub-paragraph 1.1 and 1.2 shall be deleted and reworded with the following text:

1.1. order the opposing party to cease, respectively to withdraw from the acts infringing a patent; such order may also be issued against an intermediary whose services are being used by a third party to infringe a patent;

1.2. order the detention or removal from the market of the goods suspected of infringing a patent, to prevent their entry into or movement within the channels of commerce.

2. In Article 120 of the basic Law, paragraph 4 and 5 shall be deleted and reworded with the following text:

4. The interim measures referred to in paragraph 1 of Article 120 of the basic Law may be ordered informing the opposing party, if the claimant demonstrates that other measures would not be effective, or that any delay would cause irreparable harm to him. If the interim measures are ordered without informing the opposing party, the parties should be so informed without delay and at latest after the execution of the measures. A review, including a right to be heard, shall take place upon request of the opposing party with a view to deciding, within a reasonable time after notification of the measures, whether those measures shall be modified, revoked or confirmed.

5. In the decision ordering an interim measure, the court determines the duration of such measure, and, if the measure has been ordered before the beginning of the proceeding, the term within which the claimant for measures should files a claim to justify the measure, while this term should not exceed the period of twenty (20) working days or thirty-one (31) calendar days, from the date of communication of the decision to the claimant for measures, whichever is the longer.

3. In Article 120 of the basic Law after paragraph 5 there are added two new paragraphs 6 and 7 with the following text:

6. The court may, in respect of the measures referred to in paragraphs 1, 2 and 3 of Article 120 of the basic Law, require the patent holder to provide any reasonably available evidence in order to justify a sufficient degree of certainty that he/she is the right holder and that his/her right is being infringed, or that such infringement is imminent.

7. Where the interim measures are revoked or where they lapse due to any act or omission by the claimant, or where it is subsequently found that there has been no infringement or threat of infringement of a patent, the court may order the claimant, upon request of the opponent, to provide the respondent appropriate compensation for any damage caused by those measures.

Article 26

Article 121 of the basic Law shall be deleted and reworded with the following text:

Article 121

Provisional measures for preserving evidence

1. Upon the legal action of the patent owner who certifies that his patent has been infringed or threatened to be infringed, and that there is a likelihood that evidence on such infringement concerned or threatened could not be taken or that it could subsequently become more difficult to take it, the court may, even before the commencement of proceedings on the merits of the case, order a provisional measure for preserving the evidence, with the purpose of protecting the confidential information.

2. Through the provisional measures under paragraph 1 of this Article, the court may order:

2.1. a detailed description of the goods and services, suspected that they may infringe the patent, with or without taking of samples;

2.2. the seizure of goods suspected that may infringe the patent;

2.3. the seizure of the materials and tools used in the production and/or distribution of the goods that infringe a patent as well as the documentation related to it.

3. The provisional measures referred to in paragraphs 1 and 2 of this Article may be ordered without the opposing party having been heard thereof, if the claimant claiming the provisional measure to be taken, demonstrates that there is a risk that any delay is likely to cause irreparable harm to the right holder or where there is demonstrated that there is a risk of evidence being destroyed.

4. If a provisional measure is ordered without the opposing party having been heard thereof, the parties shall be so informed without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the opposing party with a view to deciding, within a reasonable time after the information of the measures, whether those measures shall be modified, revoked or confirmed.

5. In the decision ordering a provisional measure the court determines the duration of such measure, and, if the measure has been ordered prior to the proceeding, the period, within which the claimant for measures shall institute a claim to justify the measure, while this term should not exceed the period of twenty (20) working days and not more than thirty- one (31) calendar days, from the date of communication of the decision to the claimant for measures, whichever is the longer. If a claim is not submitted within this period, the provisional measure shall be revoked.

6. The court shall have the authority to order that the measures to preserve evidence be subject to the lodging by the claimant of adequate security or an equivalent security intended to ensure compensation for any prejudice declared by the defendant as provided for in paragraph 7 of this Article.

7. Where the provisional measures to preserve evidence are revoked or where they lapse due to any act or omission by the claimant, or where it is subsequently found that there has been no infringement or threat of infringement of a patent, the court may order the claimant, upon request of the opponent, to provide the respondent appropriate compensation for any damage caused by those measures.

Article 27

Article 122 of the basic Law, paragraphs 1 and 2 shall be deleted and reworded with the following text:

Article 122 Obtaining evidence during Procedure

1. Where a party to the proceedings who presented reasonably available evidence sufficient to support its claims that belong to the opposing party or lies in the control of the opposing party, the court shall order the opposing party to present such evidence within a specified time limit, subject to the protection of confidential information.

2. Where the owner of a patent as a claimant in the proceeding who presented reasonably available evidence sufficient to support its claim that the infringement of a patent has been committed on a commercial scale for the purpose of acquiring commercial or economic benefit, and where he has specified in the proceedings banking, financial or similar economic documents, papers or the like evidence, claiming that they belong to the

opposing party or lie in the control of the opposing party, the court shall invite the opposing party to present such evidence within a specified time limit, subject to the protection of confidential information.

Article 28

Article 128 of the basic Law shall be deleted and reworded with the following text:

Article 128

1. The patent representatives have the right to represent the parties in procedures in respect of the grant and maintenance of the patents and supplementary protection certificates in accordance with the legislation into force on patents.

2. A patent representative can be:

2.1. a natural person, a citizen of the Republic of Kosovo having permanent residence in the Republic of Kosovo, holding a university degree, and having passed the qualifying examination for a patent representative at the AIP;

2.2. a legal person, having its seat and business registered in the Republic of Kosovo and employing at least one (1) employee who fulfils the conditions foreseen in paragraph 2 of this Article.

Article 29

Enter into Force

This Law shall enter into force fifteen (15) days after its publication in the Official Gazette of the Republic of Kosovo.

Law No.05/L-039
31 July 2015

President of the Assembly of the Republic of Kosovo

Kadri VESELI