

# MANUAL

FOR THE  
HANDLING OF APPLICATIONS

FOR  
PATENTS,  
DESIGNS AND TRADE MARKS  
THROUGHOUT THE WORLD

*Edited by*

ARNOLD  SIEDSMA



Wolters Kluwer  
Law & Business

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P.O. Box 316  
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The Netherlands  
E-mail: [sales@kluwerlaw.com](mailto:sales@kluwerlaw.com)  
Website: <http://www.kluwerlaw.com>

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E-mail: [permissions@kluwerlaw.com](mailto:permissions@kluwerlaw.com)

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## SAN MARINO

*EDITED BY*

ARNOLD  SIEDSMA

EUROPEAN PATENT ATTORNEYS  
ATTORNEYS AT LAW  
TRADE MARK ATTORNEYS

The Hague, Munich  
E-mail: [ipmanual@arnold-siedsma.com](mailto:ipmanual@arnold-siedsma.com)  
Website: [www.arnold-siedsma.com](http://www.arnold-siedsma.com)



Wellington/Auckland  
E-mail: [Wellington@ajpark.com](mailto:Wellington@ajpark.com)  
[Auckland@ajpark.com](mailto:Auckland@ajpark.com)  
Website: [www.ajpark.com](http://www.ajpark.com)

*IN COOPERATION WITH*



Roma, Milano, Firenze, Verona  
E-mail: [roma@sib.it](mailto:roma@sib.it)  
Website: [www.sib.it](http://www.sib.it)

## PATENTS

### SUMMARY

#### **Kinds of Patents**

- National patents of invention
- European patents

#### **Duration of Patents**

- 20 years from the filing date

#### **Patentable / Not Patentable**

- To be patentable an invention must meet the novelty, inventive step and industrial application requirements.
- The exceptions of Rule 39 PCT apply. The following are also not patentable: discoveries; computer programs as such; inventions the working of which is contrary to public policy and morality processes for cloning human beings; processes for modifying the germ line genetic identity of human beings; uses of human embryos for industrial or commercial purposes; processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes; the human body, at any stage of its formation

and development, and the simple discovery of one of its elements, including sequences or partial sequences of genes.

**Novelty**

- Absolute novelty is required.
- A 6-month grace period applies.

**Requirements and Procedure**

- Filing languages: any
- Language of translation: Italian
- Time limit for filing translation: one month from the filing date
- A patent is granted after formal examination only.

**Specific Aspects of Regional Patents**

- Patent protection in San Marino may also be obtained through a European patent validated in San Marino.

**Specific Aspects of International Patent Applications (PCT)**

- Time limit for entering National Phase: 31 months from the priority date
- Time limit for filing translation: 31 months from the priority date.

**Governmental Websites**

- [www.usbm.sm](http://www.usbm.sm) (San Marino Patent and Trademark State Office)

## DETAILED INFORMATION

### Conventions and Legislation

#### *Conventions*

- Paris Convention (International Union) 1883–1967 (effective in San Marino as from 4 March 1960; the Stockholm Act 1967 is in force as from 26 June 1991);
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967 (effective in San Marino as from 26 June 1991);
- The Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents 1961 (effective in San Marino as from 13 February 1995);
- Patent Cooperation Treaty (PCT) 1970 (effective in San Marino as from 14 December 2004);
- European Patent Convention (EPC) (effective in San Marino as from 1 July 2009); and
- Pact of Amity and Good Neighbourhood between the Republic of San Marino and Italy of 31 March 1939.

Pursuant to the 1939 Pact of Amity between San Marino and Italy, each country has the obligation to prevent in its own territory any infringement or counterfeiting of inventions which are covered by industrial property rights in the other country. Therefore, an Italian patent or patent application enjoys protection in San Marino. This, however, does not apply to European patents validated in Italy.

#### *Laws*

- Law No. 79 of 25 May 2005 (Industrial Property Sole Act) as amended by Law No. 114 of 20 July 2005 and by Law No. 189 of 5 December 2011;
- Decree No. 78 of 20 April 2010 (Patent, Trademark and Design Fees);
- Regulations No. 5 of 2 July 2007 (Regulation for the activity of professional representatives); and
- Decree No. 153 of 5 November 2004 (PCT implementing rules).

### Kinds of Patents

- National patents of invention
- European patents.

### Duration of Patents

Twenty years from the filing date of the application, subject to the payment of annual fees, and subject to the filing within nine years from the filing date of written statements that the invention satisfies the patentability requirements.

#### *Supplementary protection certificate*

Not applicable in this jurisdiction.

### Requirements for Renewal

A patent is to be maintained through the payment of annual fees.

The annual fees (starting with the fourth annual fee) are to be paid yearly in advance within the end of the anniversary month of the filing date.

Term for late payment: six months provided a fine is paid.

In respect of European patents validated in San Marino, the first annual fee due in San Marino is the one concerning the year following the year in which the mention of the grant of the patent was published in the European Patent Bulletin.

Before the end of a period of nine years from the filing date of the application, the applicant or the owner of the patent or the exclusive licensee must file written statements that the invention satisfies the patentability requirements, failing which the patent will lapse at the end of the ninth year. Any patent granted for the same invention by the European Patent Office (EPO) or by another international authority recognized by the PCT is in particular considered as a valid statement of patentability of the invention.

### Patentable / Not Patentable

An invention, in order to be patentable, must be new, must involve an inventive activity (inventive step), and be susceptible of industrial application.

An invention is considered to involve an inventive activity if, having regard to the state of the art, it is not obvious to a person skilled in the art.

An invention is considered to be susceptible of industrial application if it can be manufactured or utilized in any field of industry, including agriculture, handicraft, fishery and services.

The exceptions of Rule 39 PCT apply.

The following are not patentable:

- (i) Discoveries, scientific theories and mathematical methods as such.
- (ii) Aesthetic creations as such.
- (iii) Schemes, rules and methods for performing mental acts, playing games or doing business, and computer programs as such.
- (iv) Presentation of information as such.
- (v) Methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body. This provision shall not apply to products, in particular substances or compositions to be used in any of these methods.
- (vi) Inventions the working of which is contrary to public order or morality. The working of an invention is however not deemed to be contrary to public order or morality only because it is prohibited by law or regulation. In this connection, the following in particular are not patentable:
  - Processes for cloning human beings.
  - Processes for modifying the germ line genetic identity of human beings.
  - Uses of human embryos for industrial or commercial purposes.
  - Processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, as well as animals resulting from such processes.
- (vii) Animal varieties or essentially biological processes for the production thereof, it being understood, however, that microbiological processes and the products obtained thereby are not excluded from patentability. Essentially biological processes are deemed those which integrally consist of natural phenomena as crossbreed or selection.

- (viii) The human body since conception and at the various stages of its formation and development, and the mere discovery of one of its elements, including the sequence or partial sequence of a gene.

A biological material which is isolated from its natural environment or produced by means of a technical process shall be patentable, even if it previously occurred in nature.

*Chemical compositions*

Chemical compositions are patentable.

*Pharmaceuticals*

Pharmaceuticals are patentable.

*Second use*

An invention that concerns a new medical use or application of a substance or composition already known in the art (and forming part of the state of the art) is patentable.

*Treatment of the human body*

Methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body are not patentable.

*Biological materials*

‘Biological material’ means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system.

‘Microbiological process’ means any process involving or performed upon or resulting in microbiological material.

The limitations on the patentability of ethical sensitive biotechnological matters are explicitly indicated in the Law. Microbiological processes and the products thereof, and microorganisms per se may be patented.

Inventions comprising biological material isolated from its natural environment or produced by means of technical processes, may constitute patentable inventions.

However, the following are not patentable:

- The human body since conception and at the various stages of its formation and development, and the mere discovery of one of its elements, including the sequence or partial sequence of a gene.
- Processes for cloning human beings.
- Processes for modifying the germ line genetic identity of human beings.
- Any use of human embryos for industrial or commercial purposes.
- Processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, as well as animals resulting from such processes.

Animal varieties and essentially biological processes for the production of the same are not patentable. However, microbiological processes and the products obtained thereby are not excluded from patentability.

*Plant varieties*

Plant varieties are not patentable.

*Software-related inventions*

Computer programs as such are not patentable.

*Business methods*

Methods for doing business as such are not patentable.

*Immoral inventions or inventions contrary to public order*

Inventions the working of which is contrary to public order or morality are not patentable. The working of an invention is however, not deemed to be contrary to public order or morality only because it is prohibited by law or regulation.

*Semiconductors*

Semiconductors are not patentable.

**Novelty**

Absolute novelty applies.

An invention is new if it is not comprised in the state of the art. The state of the art comprises everything made available to the public anywhere in the world before the filing date of the patent application (or, if priority is claimed, before the priority date), by oral or written description or by use. Such a disclosure is deemed significant only when it allows an unspecified number of persons to understand the contents of the invention.

When determining the novelty of an invention, the elements pertaining to the state of the art are to be considered only individually and not combined together.

The state of the art furthermore comprises the contents of patent applications filed in the Republic of San Marino, or having effect in San Marino, in particular including Italian patent applications, as they have been filed, which applications have a filing date preceding that of the San Marino application, but which have been published or made available to the public on or after the filing date of the San Marino application. The contents of prior applications as meant here are only to be considered in determining the novelty of the invention, but not in deciding whether the invention implies 'inventive activity'.

Inventions concerning a new use or application of a substance or composition already known in the art (and forming part of the state of the art) are patentable.



*Grace period*

A prior disclosure of the invention shall not be taken into account in considering its novelty if the disclosure occurred not more than six months prior to the filing date of the application (or if applicable the priority date) and if it was due to, or in consequence of:

- following acts made by the applicant or his/her legal predecessor; or
- an abuse made by a third party in relation to the applicant or his/her legal predecessor.

A prior disclosure of the invention shall also not be taken into account when determining its novelty if the disclosure occurred no more than six months prior to the filing date of the application due to the fact that the invention was displayed at an official or officially recognized international exhibition falling under the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928, and its later revisions. Other official exhibitions for which this provision applies may be designated by the Director of the San Marino Patent and Trademark Office.

**Applicant**

The right to the patent belongs to the inventor or to his/her successor in title (natural or legal person).

If an invention is due to more than one inventor, the patent rights are governed by the provisions on co-ownership, unless there is a different agreement between the co-owners.

Where two or more inventors have made the same invention independently of each other, the right to a patent shall belong to the person whose patent application has the earliest filing date (or if applicable the earliest priority date), provided that this first patent application has been published.

It is presumed before the San Marino Patent and Trademark Office that the applicant is entitled to the invention.

An employee of the San Marino Patent and Trademark Office cannot apply for, be assignee of, or be concerned with any patent, neither directly nor through a third party. This provision applies also to a former employee during two years after the end of his/her work relation with the San Marino Patent and Trademark Office.

An invention made in the performance or fulfilment of a work or employment contract belongs to the employer, absent contractual provisions to the contrary. However, the inventor is entitled to a fair remuneration to be determined taking into consideration his/her salary and the importance of the invention.

In the absence of the above conditions, where the invention made by an employee falls within the field of activity of the employer (whether private or public), the latter has the right of preemption for the exclusive or not exclusive use of the invention or to purchase the patent as well as to apply for, or purchase, for the same invention, patents abroad. In such cases the inventor has the right to a royalty or a price, to be fixed under deduction of an amount equivalent to the value of the assistance that the inventor might have received from the employer in developing the invention. The inventor has the duty of communicating to the employer that an invention was made, that a patent application was filed in respect of the invention and that a patent was granted. The preemption right of the employer in such cases is to be exercised within three months from the receipt of the notice that the patent has been granted.

If in any of the above-mentioned cases no agreement is reached the fair remuneration, royalty or price to be paid to the employee-inventor, is established by arbitration.

An invention is still considered as having been made in the performance of a work or employment contract if the relevant patent is applied for within one year after the inventor

left the employment with the private undertaking or public administration in whose field of activity the invention falls.

As an exception to the general rule, when the employer is a research public organization (OPR), the inventor shall communicate the invention to the OPR and the latter shall express its interest for patenting the invention within two months from said communication.

In any case, the inventor has the right to receive at least 30% of the incomes obtained through the exploitation of the invention.

If the OPR does not express its interest or the patent application is not filed within four months from such expression of interest, the right to patent is transferred to the inventor.

Applications filed by or patent granted to a non-entitled person: If it is established by a final decision that the invention belongs to another person than the one who filed the application, such another person has, within the three months following the final decision and provided that the patent has not yet been granted, the following options:

- prosecute the patent application in his/her own name, assuming for all purposes the quality of the applicant;
- file a new patent application, which, provided that its contents do not extend beyond those of the first application, shall be effective as of the filing date, or the priority date, of the original application, which shall in any case cease to produce effects;
- cause the application to be refused.

If the patent has already been granted to a person other than the one entitled to it, the latter may, at his/her discretion:

- (a) cause the patent to be transferred to his/her name by a decision having retroactive effect;
- (b) obtain that the patent granted to a person not entitled to it is declared null and void.

After two years from the date of publication of the patent grant, if the person entitled to the patent has failed to exercise any of the rights provided for in the preceding paragraph, any interested person may claim the nullity of the patent granted to a person not entitled to it.

### **Assignment**

A patent or a patent application may be assigned even without written form, but a written assignment is necessary for recordal, which allows the assignment to be effective against third parties who have acquired and lawfully maintained rights in the patent or patent application.

Documents required for the recordal of an assignment: (a) a notarized and legalized (through Apostille where applicable) assignment deed or a certified copy thereof along with a sworn translation into Italian; (b) a Power of Attorney, not legalized; (c) proof of the payment of the prescribed official fees.

Pursuant to Law No. 189 of 5 December 2011, the San Marino Patent and Trademark Office also accepts instead of assignment deeds assignment declarations signed by both parties.

### **Requirements for Filing**

*Obligation to file first with national office*

No requirement.

*Minimum requirements for obtaining filing date / Provisional applications*

In order to obtain a filing date, the patent application shall contain:

- a request for a patent of invention in San Marino;
- information identifying the applicant; and
- a description of the invention.

Application fees must be paid before filing.

#### *Request for grant*

The patent application must be filed by the inventor or his/her successor in title or his/her professional representative.

Use of San Marino Patent and Trademark Office forms is mandatory and the patent application shall be signed in original.

The patent application shall contain: A request for grant which must include the full name, nationality and domicile of the applicant and full name of the inventor and of the professional representative, if any, the title of the invention, a declaration justifying the right to patent of the applicant, if the latter is not the inventor and, if priority is claimed, the name of the applicant, the indication of the country, serial number and filing date of the first foreign application the priority of which is claimed.

The application fees must be paid before filing.

The patent application must be accompanied by:

- the specification (description, abstract, claims and drawings if any);
- the proof of the payment of the prescribed official fees;
- the designation of the inventor;
- a Power of Attorney (in case of appointment of a representative);
- priority documents, if any.

The designation of inventor and the Power of Attorney may be filed within two months from the filing date of the application.

#### *Appointment of Representative*

Applicants residing abroad or whose main business address is abroad must be represented by a professional representative admitted to practice before the San Marino Office; nationals may file directly or through a qualified professional representative. Applicants or their professional representatives must elect an address for service in the Republic of San Marino, to which communications by the San Marino Patent and Trademark Office and deeds originating from Courts are served.

#### *Power of Attorney / Designation of inventor / Other documents*

Powers of Attorney do not require notarization or legalization. The Power of Attorney may be filed within two months from the filing date of the application.

The inventor(s) must be designated and such a designation may be filed within two months from the application filing date of the application.

#### *Priority*

The right of priority with respect to a prior first patent application filed abroad within the previous twelve months is recognized.

The priority document, i.e., a certified non-legalized copy of the earlier application must

be filed within six months from the filing date of the patent application or within sixteen months from the priority date, whichever term expires later (no extension allowed).

If the patent application is filed by a party other than the applicant of the first patent application the priority of which is claimed, a deed of assignment of the priority rights is required.

The priority document must be filed along with an Italian translation thereof. The San Marino Patent and Trademark Office may request a sworn Italian translation of the priority document.

Multiple priorities may be claimed in one application, provided there is unity of invention. Partial priorities are admissible.

#### *Allowable language(s) upon filing / Language(s) of procedure*

Description and claims may be filed in any language provided that an Italian translation is filed within one month from the filing date of the patent application.

All the documents drawn up in a foreign language shall be translated into Italian and the translation certified by the applicant or his/her professional representative.

However, the patent application and the declaration justifying the right to patent of the applicant must be filed in Italian.

#### *Description*

The specification shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

The description of the invention must:

- (a) begin with the title of the invention, formulated exactly as in the patent application;
- (b) specify the technical field to which the invention relates;
- (c) indicate the background art which, as far as it is known to the applicant, can be regarded as useful to understand the invention and, preferably, cite the documents reflecting such art;
- (d) disclose the invention, as claimed, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood, and state any advantageous effect of the invention with reference to the background art;
- (e) briefly describe the contents of the drawings, if any;
- (f) describe in detail at least one way of carrying out the invention claimed, using examples where appropriate and referring to the drawings, if any;
- (g) expressly indicate, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable.

The description shall be presented in the manner and order specified above, unless, owing to the nature of the invention, a different presentation would afford a better understanding or be more concise.

The specification must be printed or type-written in indelible colour on sheets of white paper of international size ISO A4. The minimum margins (top, bottom, left and right) are of 1.5 cm.

If an invention concerns microbiological process or a product obtained by such process and it implies the use of a microorganism which is not accessible to the public and cannot be described in such a way as to enable the invention to be carried out by a person skilled in the art, in order to fulfil the requirements of sufficiency of disclosure a culture of the microorganism concerned shall be deposited, at the latest on the filing (or priority) date, with an authorized culture collection under the Budapest Treaty.

The application shall contain information available to the applicant on the characteristics

of the microorganism, the name of the depositary institution and the deposit number. However, the name of the depositary institution and the deposit number of the microorganism can be provided within a period of two months from the filing date of the application.

Authorized culture collections with which deposits may be made are the collections recognized for obtaining European patents or international authorities recognized according to conventions ratified by the Republic of San Marino.

The expert solution is allowable, as well as the possibility of making a new deposit of the microorganism if an interruption of the availability of the same has occurred.

The new deposit shall be made on the same terms indicated above, and shall be accompanied by a declaration of the depositor on the identity between the new deposited material and the originally deposited material.

### *Claims*

The claims shall define, in terms of technical features of the invention, the matter for which protection is sought and the extent of the protection. They shall be clear, concise and supported by the description.

Where appropriate the claims shall contain:

- (a) a preamble indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, form part of the prior art; and
- (b) a characterizing portion, preceded by 'characterized in' or 'characterized by' and specifying the technical features for which, in combination with the preamble, protection is sought.

A patent application may contain several independent claims in the same category (product, process, apparatus or use) only if the object of the invention cannot conveniently be covered by one single claim.

Any claim stating the essential features of an invention may be followed by one or more dependent claims. Multiple dependency of claims is permitted.

Dependent claims shall contain, if possible at the beginning, a reference to the other claim or claims on which they depend and then state the additional features for which protection is sought. A dependent claim directly referring to another dependent claim shall also be admissible. All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most appropriate way possible.

The number of claims shall be reasonable with regard to the nature of the invention for which protection is sought. The claims shall be numbered consecutively in Arabic numerals.

### *Abstract*

The abstract (preferably no more than 150 words) must indicate the title of the invention.

The abstract shall contain a concise summary of the disclosure as contained in the description, the claims and any drawings. The summary shall indicate the technical field to which the invention pertains, and shall be drafted in a manner allowing the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention. The abstract shall, where applicable, contain the chemical formula which, among those contained in the application, best characterizes the invention.

If the patent application contains drawings, the applicant shall indicate the drawing or, exceptionally, the drawings which should be published with the abstract. The San Marino Patent and Trademark Office may decide to publish one or more other drawings if it considers

that they better characterize the invention. Each essential feature mentioned in the abstract and illustrated by a drawing shall be followed by a reference sign placed within parentheses.

### *Drawings*

Drawings have to be provided when required for a better understanding of the invention.

The usable surface area of the sheets containing the drawings shall not exceed 26.2 cm × 17 cm. The usable or used surface shall not be surrounded by frames. The minimum margins shall be as follows: top margin: 2.5 cm; left margin: 2.5 cm; right margin: 1.5 cm; bottom margin: 1.5 cm.

The drawings must be executed as follows:

- (a) The drawings must be executed, without colours, in black or blue, sufficiently dense and dark, and with uniformly thick and well-defined lines.
- (b) The sections shall be indicated by hatching which should not impede the clear reading of the reference signs and leading lines.
- (c) The scale of the drawings and the clarity of the graphical execution must be such that a photographic reproduction with a linear reduction in size to two thirds will allow all details to be distinguished without difficulty. If, exceptionally, the scale is given on a drawing, it shall be represented graphically.
- (d) All numbers, letters and reference signs appearing on the drawings shall be simple and clear. Brackets, circles or inverted commas shall not be used in association with numbers and letters.
- (e) Generally, all lines in the drawings must be drawn with the aid of drafting instruments.
- (f) The elements of the same drawing must be proportional to one another, unless a difference in proportion is indispensable for the clarity of the drawing.
- (g) The height of the numbers and letters shall not be less than to 0.32 cm. For the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used.
- (h) A drawing sheet may contain several figure; the different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets.
- (i) Reference signs not mentioned in the description and claims shall not appear in the drawings, and vice versa. Reference signs to features shall be consistent throughout the application.

The drawings shall not contain text matter. Where indispensable to understand the drawings, a few short keywords, such as 'water', 'steam', 'open', 'closed' or 'section AB', may be included.

### *Payment of fees*

Evidence showing the payment of the prescribed fee is to be enclosed with the patent application.

## **Procedure**

### *Filing Authority*

The patent authority is the San Marino Patent and Trademark State Office (*Ufficio di Stato Brevetti e Marchi* (USBM)).

*Online filing*

The San Marino Patent and Trademark Office does not provide for online filing.

*Formal examination*

The San Marino Patent and Trademark Office formally examines the application documents and accords a filing date if they contain: a) a request for grant; b) information identifying the applicant; c) a description of the invention.

If the examination reveals that the description, part of it or drawings referred to in the description are missing, the San Marino Patent and Trademark Office shall invite the applicant to correct the deficiency within two months from the receipt of its notice. If the applicant complies with the official request the filing date accorded to the application shall be the date on which the missing documents have been filed. The filing of the missing documents is subject to the payment of a re-establishment fee. Failing a reply to the official request the application is declared unreceivable.

The examination of the application does not begin before the publication of the application.

The examination is limited to formal aspects only and does not refer to the technical or economic value of the invention.

The San Marino Patent and Trademark Office does not examine if the invention meets the patentability requirements i.e., – novelty, inventive step and industrial applicability.

The San Marino Patent and Trademark Office examines whether the subject-matter for which patent protection is sought may actually be regarded as an invention and whether it does not fall within the category of non-patentable invention. For this examination, the Office may use search reports prepared by other authorities, in particular search authorities according to the PCT.

On request by the San Marino Patent and Trademark Office, the applicant shall file copy of any official communication regarding prior art search or the examination procedure of any other patent application (or similar titles) filed abroad by the same applicant and having as object the same, or substantially the same, invention of that claimed in the patent application filed with the San Marino Patent and Trademark Office.

Objections by the San Marino Patent and Trademark Office are notified to applicant with an indication of the time limit for replying; which may be extended with a grounded request. If no reply to the objections is received in due time, the application is rejected.

The San Marino Patent and Trademark Office shall notify the applicant the partial or total rejection of the patent application; the applicant may lodge an appeal.

*Search*

The applicant may request a prior art search to a search authority or organization entitled by the San Marino Patent and Trademark Office in order to establish whether the subject-matter of the patent application complies with the patentability requirements. The relevant fees have to be paid. Such search can be requested at any time until the decision to grant.

The San Marino Patent and Trademark Office may ask the applicant to produce a translation of the claims and/or of the description in another language, if necessary, to be supplied to the search authority.

The granting procedure is suspended by the San Marino Patent and Trademark Office until a search report has been completed. The search report is included in the patent application file.

*Obligation to submit corresponding foreign search results and/or application numbers*

On request by the San Marino Patent and Trademark Office, the applicant shall file copy of any official communication regarding prior art search or the examination procedure of any other patent application (or similar titles) filed abroad by the same applicant and concerning the same, or substantially the same, invention of that claimed in the patent application filed in San Marino.

Before the end of nine years from the filing date of the application, the applicant or the owner of the patent or the exclusive licensee must file written statements that the invention meets the patentability requirements, failing which the patent will lapse at the end of the ninth year. Any patent granted for the same invention by the EPO or by another international authority recognized by the PCT is in particular considered as a valid statement of patentability of the invention.

*Substantive examination*

Not applicable in this jurisdiction. The examination of the application is limited to formal aspects only.

*Accelerated examination*

On applicant's request, the examination of the application may be accelerated. In this case, if no search report has already been submitted, the applicant must supply the San Marino Patent and Trademark Office with such a search report.

*Amendments and corrections*

As long as the patent application is pending, amendments and corrections not adding subject-matter to the contents of the application as originally filed are allowed; if said requirement is met, even new examples may be added.

*Third-party observations*

Following the publication of the application, any third party may submit observations or disclosures against the patentability of the invention covered by the application. The observations submitted in writing and duly grounded are included in the file of the application. The third party does not become a party to the proceedings before the San Marino Patent and Trademark Office and may request to remain anonymous.

*Grant*

The patent is granted if the San Marino Patent and Trademark Office finds that it complies with all the prescribed requirements.

When granting a patent, the San Marino Patent and Trademark Office:

- (a) publishes a reference to said grant on the Official Bulletin;
- (b) issues a patent certificate and a copy of the patent to the applicant;
- (c) enters the patent in the Patent Register; and
- (d) makes copies of the patent available to the public.



The average processing time from filing to grant is two-three years.

The grant of the patent does not affect legal actions relating to its validity and the rights conferred by the invention.

Within nine years from the filing date of the application, the applicant or the owner of the patent or the exclusive licensee must file written statements that the invention meets the patentability requirements, failing which the patent will lapse at the end of the ninth year. Any patent granted for the same invention by the EPO or by another international authority recognized by the PCT is in particular considered as a valid statement of patentability of the invention.

The extent of the protection conferred by the San Marino patent cannot go beyond the protection conferred by any foreign patent for the same invention submitted as a statement as mentioned above. The description, claims and drawings must be amended accordingly.

#### *Re-examination*

Not applicable in this jurisdiction.

#### *Opposition*

Not applicable in this jurisdiction.

#### *Appeal*

The San Marino Patent and Trademark Office's decisions may be appealed to the San Marino Administrative Court.

#### *Continuation applications*

Not applicable in this jurisdiction.

#### *Unity of invention / Divisional applications*

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

If a patent application comprises more than one invention, the San Marino Patent and Trademark Office shall require that it be restricted to a single invention within an assigned term, and the applicant is entitled to file as many divisional applications as there are inventions left, each of these retaining the original filing (and priority if any) date.

The division of a patent application in two or more divisional patent applications may also be requested by the applicant as long as the patent is granted by the San Marino Patent and Trademark Office.

The subject-matter of divisional patent applications cannot extend beyond the content of the original application as filed.

For each divisional application, the required fees must be paid.

#### *Conversion*

Not applicable in this jurisdiction.

*Publication / Public File Inspection*

Patent applications are published after expiration of eighteen months from the filing date or priority date. The applicant may require that the patent application is published beforehand.

As from the day on which the application is made available to the public, the applicant is entitled to claim exclusive rights.

When granting a patent, the San Marino Patent and Trademark Office publishes a reference to said grant on the Official Bulletin and makes copies of the patent available to the public.

If an invention concerns a biological material, and a culture of said biological material has been deposited with an authorized collection, after the patent application has been made available to the public, third parties may obtain samples of the biological material. The request for a sample must be filed with the collection where the culture was deposited, and must indicate: (a) name and address of the submitter; (b) undertaking by the submitter vis-à-vis the applicant or patentee not to make the sample of the biological material available to any third party; and (c) undertaking by the submitter to use the material for experimental purposes only.

On the depositor's request, the sample of the biological material may be released, once the patent application has been made available, only through the intermediary of an independent expert, whose name must be specified in the request, until the date that the patent is granted or for twenty years from the filing date of the patent application, in case the patent application is rejected or withdrawn. The expert designated for the use of the culture is jointly liable for any abuse committed by the submitter of the request for a sample.

*Withdrawal to prevent publication*

A patent application shall not be published if it has been withdrawn or finally refused before the termination of the technical preparations for publication.

**Nullity and Lapse**

A patent may be declared null (totally or partially) by a Court decision, on any of the following grounds:

- (a) the invention is not patentable because of lack of novelty, inventive step, industrial application and/or because it is contrary to public order or morality or because the concerned invention is not patentable per se;
- (b) the invention is not described in a manner sufficiently clear and complete for enabling a person skilled in the art to carry it out;
- (c) the subject-matter of the patent extends beyond the contents of the application as filed, or, if the patent was granted on a divisional application, beyond the content of the original application as filed;
- (d) the patentee was not entitled to the patent.

Nullity on any of the grounds under (a), (b), (c) or (d) may be requested by any interested party.

Nullity on the ground mentioned under (d) may be requested by the person being entitled to the patent; if that person does not take action within two years from the grant of the patent, then any interested person may request the nullity of the patent on this ground as well.

Nullity may be requested, even after the expiration of the patent.

The declaration of nullity of a patent has retroactive effect, but does not affect:

- (1) Decisions in infringement proceedings which have become final and have been executed before the nullity final decision.
- (2) Agreements concerning the invention concluded before the nullity final decision, to the

extent they have been already executed. In the latter case however, refund of payments made under such agreements may be ordered on equity grounds, and taking into consideration the circumstances of the case.

Renunciation: a patent owner may renounce his/her patent. Such renunciation however has no effect if there are rights of third parties recorded under the patent and the renunciation takes place without their prior written consent.

Limitation of a patent is possible on request of the patent owner, accompanied by amended specification and drawings; printing fee will be due again in this case. Limitation does not affect the rights of third parties under the patent without their prior written consent. No limitation of a patent can be accepted as long as any nullity proceeding involving the patent has been finally terminated.

### Use Requirement

Patents must be worked in the Republic of San Marino or in Italy to an extent not seriously disproportionate to the needs of the Republic of San Marino within three years from the date of grant or within four years from the application date, whichever term expires later. Thereafter, the patent may not remain non-worked for longer than three consecutive years.

In case of non-working the patent becomes subject to the grant of compulsory licenses, unless the failure to work the invention is due to causes beyond the control of the owner of the patent. Lack of financial means or, if the product is widely circulated in foreign countries, lack of demand on the internal market for the patented product (or for the product obtained by the patented process), do not constitute grounds for excusing an insufficient working.

The importation into San Marino of goods manufactured abroad amounts to working of the patented invention.

Under the compulsory license provisions, a patent lapses owing to non-working or insufficient working only after expiry of a two-year period running from the date of grant of the first compulsory license. Consequently, if no compulsory license has been requested and granted, a non-worked patent does not lapse.

### Marking

Marking is advisable, but not compulsory. Possible marking: '*Brevettato*', or '*Brevetto*', or '*Brev.*', which may also be followed by the patent number, or '*Brevetto depositato*', or '*Brev. Dep.*', which may also be followed by the patent application number.

### Licenses

Exclusive and non-exclusive contractual licenses under a granted patent or even a pending patent application may be granted. License agreements must be recorded with the San Marino Patent and Trademark Office in order to be effective against third parties who have acquired and lawfully maintained rights in the patent or patent application.

Documents required for the recordal of a license: (a) a notarized and legalized (through Apostille where applicable) license deed or a certified copy thereof along with a sworn translation into Italian; (b) a Power of Attorney from licensor and from licensee, not legalized; (c) proof of the payment of the prescribed official fees.

Pursuant to Law No. 189 of 5 December 2011, the San Marino Patent and Trademark Office also accepts instead of license deeds license declarations signed by both parties.

Licenses of Right: As long as no exclusive license has been recorded with the San Marino Patent and Trademark Office in respect of an invention being the subject of a patent application or a granted patent, applicant or patentee may (in the patent application or in a written statement

addressed to the San Marino Patent and Trademark Office) offer to the public a non-exclusive license. Such license is effective as from notification of acceptance and irrespective whether any agreement has been reached on the remuneration. If no agreement on the remuneration is reached, the remuneration is determined by arbitration.

The patentee or applicant having offered a license of right enjoys a reduction of 50% on the annual fees, until revocation of the offer.

Compulsory licenses may be granted in the following cases:

A. Non-working. A compulsory license may be granted if, within three years from the date of grant of the patent or four years from the filing date of the application, whichever term expires later, the patented invention has not been worked, by the owner of the patent or his/her successor in title or by one or more licensees, or has been worked but to an extent which is seriously disproportionate to the needs of the Republic of San Marino. Furthermore, a compulsory license may be granted if working of the invention is interrupted or reduced, for more than three consecutive years, to an extent which is seriously disproportionate to the needs of the Republic of San Marino.

B. Dependent patents. The owner of an Italian or San Marino patent which cannot be worked without prejudice to the rights originating from a patent granted in San Marino on the basis of an earlier application may obtain a compulsory license under the earlier patent, but only to the extent necessary to work the invention covered by the later patent and provided that the invention of the later patent, as compared with the subject-matter of the earlier patent, represents an important technical progress. The owner of the earlier patent is entitled in turn to be granted a compulsory license under the later patent if the two inventions are aimed at the same industrial purpose.

No compulsory license may be granted to an infringer of the patent.

The term of a compulsory license may not exceed the remaining term of the patent and may be transferred only together with the business of the grantee, or with the particular branch of the business in which the license is used, except if the owner of the patent consents to the transfer without the business or its branch.

The grant of a compulsory license does not prevent the institution of legal proceedings relating to the validity of the patent concerned or the rights deriving from the patent, including actions instituted by the grantee of the license.

If the patent has not been worked within two years after the grant of the first compulsory license, or it has been worked within that period to an extent which is seriously disproportionate to the needs of the Republic of San Marino, it lapses.

A compulsory license is to be applied for, and is granted by the San Marino Patent and Trademark Office which determines the duration, the manner of exploitation, the guarantees and the other conditions of the grant, and the amount of the consideration and the payment conditions. The terms of the license may be modified by the San Marino Patent and Trademark Office, upon request by each of the interested parties if there are valid reasons. A compulsory license may be revoked, upon request by the patent owner, in case the circumstances leading to its grant no longer exist in a permanent way taking into account the patent owner's and the licensee's interests.

A compulsory license may furthermore be revoked by the San Marino Patent and Trademark Office if the conditions relating to the working of the invention have not been complied with, or if the grantee of the license has not paid the consideration in the amount and way as prescribed.

### **Pledge and Seizure**

Security interests in respect of granted patents or even pending patent applications may be established and recorded with the San Marino Patent and Trademark Office in order to be effective against third parties who have acquired and lawfully maintained rights in the patent or patent application; the requirements are as in the case of assignments.

## **Infringement**

### *Infringing acts / Non-infringing acts*

Provided that the patent is granted, its legal effects run from the date on which the relevant application has been made available to the public or as regards an alleged infringer, from such earlier date on which the application with specification and drawings (if any) has been served upon him/her.

The scope of protection conferred by a patent is determined by the claims. However, the specification and the drawings (if any) are used for interpreting the claims, so as to balance a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

The following acts done within the territory of the Republic of San Marino by a third party without the consent of the owner of the patent are considered as patent infringement:

- (1) in the case of a patented product: the manufacture, importation, placing on the market, sale and use of the product or of essential parts of the same, as well as the storing of said product for any of the above-mentioned aims;
- (2) in the case of a patented process or method: the use of that process or method or of essential parts of the same, and furthermore the carrying out of any of the acts referred to the above point (1) with respect to a product directly obtained by the patented process or method.

Reversal of burden of proof: Until the contrary has been proved, any product identical to a product produced by a patented process is deemed to have been obtained by the patented process: (i) if the product obtained by the patented process is new, or (ii) if there is a substantial likelihood that the identical product was made by the patented process and the owner of the patent, although he/she has made reasonable efforts to determine the process actually used in the production of the product, was unable to so determine.

If the proprietor of a patent on a new industrial method or process provides other persons with the means unambiguously intended to carry out the patented invention, he/she is presumed to have granted such other persons a license to use such method or process, unless agreed upon otherwise.

A patent, whose carrying out implies the carrying out of inventions protected by previous patents still in force, cannot be carried out or used without the consent of the owners of said previous patents.

The following acts are not considered as an infringement:

- (1) use for personal and non-commercial purposes, and use of experimental character;
- (2) preparation of medical products in pharmacies on an individual medical prescription and pharmaceuticals so prepared;
- (3) acts regarding products which have been put on the market in the territory of the Republic of San Marino by the patent owner or with his/her consent.

### *Prior user rights*

A person having been using, in good faith, an invention in his/her own undertaking within a twelve-month period preceding the filing (or the priority date) by a third party of a patent application concerning the same invention, may continue to use it within the same limits of such prior use. A right of prior use may only be transferred together with the undertaking in which the invention is being used. The burden of proving the prior use rests with the prior user.

### *Remedies*

Patent infringement actions are to be brought before the San Marino Court. Infringement actions based on a pending patent application may be brought provided the application has been published or served on the alleged infringer, but they cannot be decided until the patent is granted.

Measures which may be granted by the Court, prior to or during the infringement proceedings, or at the end of the proceedings, include:

- Injunction: the patent owner may apply to the Court for an injunction prohibiting the manufacture, marketing and use of anything constituting an infringement of his/her patent or patent application. The Court when ordering the injunction may set a penalty for any subsequent infringement or non-compliance or delay in the compliance with the injunction order.
- Judicial inspection or seizure: the patent owner may request that a judicial inspection (description) and/or seizure be ordered of some or all of the infringing articles and of any means used in their manufacture, as well as of the proof evidence concerning the alleged infringement.

Judicial inspection may also relate to goods belonging to parties other than the alleged infringer, if these goods are not for personal use. Seizure may also relate to goods belonging to parties other than the alleged infringer, if these goods are traded by such parties. Judicial inspection only, but not seizure, is possible in respect of goods exhibited at an official or officially recognized exhibition in San Marino or in Italy (or which are in transit to or from such exhibition).

Preliminary injunction, judicial inspection and seizure may be obtained only if the conditions of '*periculum in mora*' and '*fumus boni iuris*' are met. If any of these remedies is granted before the infringement action is brought, the action must start within a short fixed term.

The Court may also decide that the infringing items and the means for their manufacture be transferred to the owner of the patent, without prejudice to his/her right to award of damages. At the request of the owner of the items mentioned in the preceding sentence, and having regard to the remaining term of the patent or to the particular circumstances of the case, the Court may also order the seizure of these items and of means of production until expiration of the patent, at the infringing party's expense. In this case the patent owner may request that the seized items be assigned to him/her.

The Court may order that the decision in an infringement proceeding be published, integrally or in summary form, in one or more newspapers as specified by it, at the expense of the losing party.

The Court may also award damages. In assessing the damages the Court must also evaluate the prejudice suffered as lost revenues by the patent owner, the prejudice deriving from the loss of value of the patented product on the marketplace and the unfair advantage taken by the infringer. At the request of the interested party, damages may be awarded in a lump sum on the basis of the records of the judicial proceedings and of the deriving presumptions.

### *Penal provisions*

Patent infringement may be sanctionable, under given conditions, as a criminal offence.

### *Enforcement and Customs*

Customs enforcement is not applicable in this jurisdiction.

### **Restoration**

Restoration (re-establishment of rights) may be obtained if an applicant or patent owner, in spite of all due care required by the circumstances taken, has not been able to observe a time limit, and the consequence thereof is the lapse of a right or the rejection of an application or request.

Within two months after the cause impeding the observance of the time limit has ceased, the non-accomplished act is to be completed and a request for restoration is to be filed stating the reasons for the non-observance and accompanied by the appropriate evidence. The relevant official fee has also to have been paid.

Restoration does not apply to the following terms: term for requesting the re-establishment of rights; term for dividing a patent application and for filing divisional applications.

Persons who, in the period between the lapse of a patent or patent application and the re-establishment of rights, have made serious and effective preparations for the use of the invention, or have actually commenced such use, have the right to work the invention free of charge within the limits of the prior use or within the limits that result from the preparations.

### **Specific Aspects of Regional Patents**

San Marino has ratified the EPC with effect from 1 July 2009. Validation of a European patent in San Marino is possible.

#### *Filing Authority*

Applications, except divisional applications, for the grant of a European Patent may be filed with the San Marino Patent and Trademark Office in the manner prescribed by the EPC.

European patent applications can be filed with the San Marino Patent and Trademark Office in any language admissible under Article 14, paragraphs 1 and 2 of the EPC.

#### *Appointment of Representative*

In the proceedings before the San Marino Patent and Trademark Office relating to a European patent with effect for San Marino, except for the filing of a European patent application, the proprietor of the patent, if not resident in San Marino, must elect an address for service care of a local representative to whom communications by the San Marino Patent and Trademark Office and notifications are sent.

#### *Validation*

San Marino has not ratified the London Agreement on the application of Article 65 of the Convention on the Grant of European Patents.

Therefore, in order to validate in San Marino a European patent designating San Marino, a copy of the European patent published in the European Patent Bulletin and an Italian translation of the entire patent must be filed with the San Marino Patent and Trademark Office within six months from the publication of the mention of the grant of the European patent. Along with the translation of the European patent, a written and signed declaration is to be provided stating that the translation is entirely in conformity with the original text.

Publication fees must be paid.

If a European patent in opposition proceedings is maintained in an amended form, an Italian translation of the amended patent must be filed (with the declaration mentioned in the preceding paragraph) within six months from the publication of the decision on the opposition.

*Authentic text*

The authentic text of a European patent application or of a European patent is the text in the language of the proceedings before the EPO. If the translation into Italian of a European patent confers a protection which is narrower than that conferred by the authentic text, the Italian translation is regarded as the authentic text for determining the scope of protection conferred by the patent.

*Amendments and corrections*

The translation of a European patent may be corrected, and the corrected translation becomes effective after it has been filed with the San Marino Patent and Trademark Office and made available to the public. Anyone having in good faith started to use an invention being the subject of a European patent, or having in good faith made serious and real preparations for such use, where the use or intended use would not constitute an infringement of the patent in the version of the original Italian translation but would constitute an infringement of the patent in the version of the corrected translation, may continue (or start) such use in or for his/her own undertaking free of charge after the corrected translation has become effective (i.e., after the corrected translation has been filed with the San Marino Patent and Trademark Office).

*Publication*

After filing all necessary documents to validate the European patent in San Marino, the San Marino Patent and Trademark Office issues a decision and publishes a reference to said decision on the Official Bulletin and makes copies of the patent available to the public.

*Provisional protection*

Protection in San Marino conferred by a European patent application designating San Marino starts as from the day on which a translation of the published European patent's claims is notified to the alleged infringer.

*Simultaneous protection*

If a national San Marino patent and a European patent designating San Marino are granted in respect of the same invention belonging to the same inventor or his/her assignee or successor in title, and both patents have the same filing or priority date, the European patent automatically prevails over the San Marino patent (to the extent the protection conferred by both patents is the same) at the expiry of the opposition period (nine months from the publication of the mention of the grant of the European patent in the European Patent Bulletin) or, if opposition proceedings have been started and the European patent is maintained, after the date on which such proceedings are definitively terminated. If, subsequently, the European patent becomes ineffective, for whatever reason, this does not revive the national San Marino patent.

*Conversion*

A European patent application designating San Marino may be converted into a national San Marino patent application:



- (a) if the translation into the language of the proceedings before the EPO has not been filed within the term prescribed by Rule 6(1) EPC;
- (b) if the application filed with the San Marino Patent and Trademark Office has not reached the EPO within fourteen months from the filing (or priority) date.

Requirements for conversion: conversion request, election of address for service in San Marino (if applicable), payment of the prescribed fee, Italian translation of the application (if not yet in that language).

#### *Payment of fees*

Annual fees are due in respect of European patents validated in San Marino and are to be paid for each patent year starting with the year following that on which the mention of the grant of the European patent has been published in the European Patent Bulletin.

### **Specific Aspects of International Patent Applications (PCT)**

#### *Receiving Office*

Competent receiving offices for nationals and residents of San Marino are the San Marino Patent and Trademark Office, the EPO, or the International Bureau of WIPO.

The language in which an international patent application may be filed in San Marino is Italian. However, applications in English, French and Spanish are also accepted.

Nationals of San Marino and persons having their principal place of business or residence in San Marino are entitled, as from 1 July 2009, to file international applications with the EPO as receiving Office.

Any PCT request (PCT/RO/101) filed on or after 1 July 2009 automatically designate San Marino as an EPC contracting state for the purpose of obtaining a European patent.

No European patents for San Marino can be granted on the basis of international applications with a filing date prior to 1 July 2009.

#### *International Searching Authority*

EPO.

#### *International Preliminary Examining Authority*

EPO.

#### *National phase / Regional phase*

Patent protection for San Marino applied for in a PCT international application may be obtained via both a European patent valid in San Marino and a national patent.

Time limit for entering national phase is thirty-one months from the filing or priority date.

A translation into Italian of the International application must be furnished. Time limit for filing translation: thirty-one months from the priority date.

If the applicant is not resident in San Marino a representative shall be appointed.

The average processing time from entering national phase to grant is six to nine months.

*Payment of fees*

The national phase fees must be paid within the time limit for entering national phase.

**Fees***Table of official fees*

Fees in Euros (EUR), as from 30 June 2010.

	EUR
Filing fee for patent applications, including publication fee and first three annuities:	
– for a text of up to twenty pages.....	170.00
– supplement for each page of the text from the twenty-first.....	15.00
Registering an assignment or license (for each patent involved).....	120.00
Restoration (re-establishment of rights) fee.....	100.00
Transmission fee for a European or International patent application.....	70.00

For the validation in San Marino of European patents a publication fee in respect of the Italian translation is due in the amount of EUR 100.00 for a text of up to twenty pages, with a supplement of EUR 15.00 for each page from the twenty-first.

Annual fees are as follows:

Year	fourth year up to seventh year, each	eighth year up to eleventh year, each	twelfth year up to fifteenth year, each	sixteenth year
Fees	70.00	140.00	270.00	400.00
seventeenth	eighteenth	nineteenth	twentieth	
460.00	530.00	600.00	650.00	

The fine for late payment of the maintenance (renewal) fees amounts to 25% of the relevant fee.

**Transitional Provisions**

Not applicable in this jurisdiction.

**Specific Patent Issues**

As an implementation of the 1939 Pact of Amity and Good Neighbourhood with Italy, if an invention is protected by a valid Italian patent or patent application, but not by a San Marino patent or patent application, the carrying out of the invention by a not authorized third party in the territory of the Republic of San Marino is considered as an infringement of the Italian patent or patent application, and its owner or the successor in title may take legal actions before the San Marino Court.

If an invention is protected by both a valid San Marino patent or patent application and a valid Italian patent or patent application, having the same owner, applicant or successor in

title, the carrying out of the invention by a not authorized third party in the territory of the Republic of San Marino is considered as an infringement of the San Marino patent or patent application, rather than of the Italian patent or patent application, and the patentee, applicant or successor in title may take legal actions before the San Marino Court.

If the same invention is protected by both a San Marino patent or patent application and by an Italian patent or patent application having the same filing (or priority, if any) date and in the name of different patentees, applicants or successors in title linked by no legal or economic connection, provided the patents or patent applications are in force, the carrying out of the invention in the Republic of San Marino is not to be considered as an infringement of the Italian patent or patent application.

**Industrial and commercial secrets:** The disclosure to any third party of business information, including commercial information within the lawful control of a competitor, or the acquisition or use of such information in a manner contrary to the principles of professional fairness, are deemed as acts of unfair competition, provided the information: (i) is secret, i.e., it is not, as a whole or in the precise configuration and arrangement of its elements, generally known or easily accessible to experts and operators in the sector concerned, (ii) has a commercial value because it is secret, and (iii) is the subject of measures to be considered as reasonably adequate to keep it secret taken by the person(s) having the lawful control of the information. Furthermore, with regard to secret test data or other secret data the preparation of which has involved considerable efforts and the submission of which is required to obtain the authorization to market chemical, pharmaceutical or agricultural products which use new substances, the disclosure to third parties of such data or their acquisition or use in a manner contrary to the principles of professional fairness, shall also be deemed as acts of unfair competition.

#### **Governmental Websites**

- [www.usbm.sm](http://www.usbm.sm) (San Marino State Patent and Trademark Office)

## TRADEMARKS

### SUMMARY

#### Duration of Registration

- 10 years from the filing date of the application, indefinitely renewable for further periods of 10 years.

#### Registrable / Not Registrable

- Any new (i.e., complying with the novelty requirement) sign capable of being represented graphically (words, including personal names, designs, letters, sounds, numerals, the shape of goods or of their packaging, colour combinations or shades) can be registered.

#### Procedure

- A trademark is registered after examination on absolute grounds. The law covers relative grounds but there is no relative examination.

#### Governmental Websites

- [www.usbm.sm](http://www.usbm.sm) (San Marino Patent and Trademark State Office)

## DETAILED INFORMATION

### Conventions and Legislation

#### *Conventions*

- Paris Convention (International Union) 1883–1967 (effective in San Marino as from 4 March 1960; the Stockholm Act 1967 is in force as from 26 June 1991);
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967 (effective in San Marino as from 26 June 1991);
- Madrid Agreement Concerning the International Registration of Marks (Madrid Union) 1891–1967 (effective in San Marino as from 25 September 1960; the Stockholm Act is in force as from 26 June 1991);
- Protocol relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) 1989 (effective in San Marino as from 12 September 2007);
- Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods 1891-1967 (effective in San Marino as from 25 September 1960);
- The Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents 1961 (effective in San Marino as from 13 February 1995); and
- Pact of Amity and Good Neighbourhood between the Republic of San Marino and Italy of 31 March 1939.

Pursuant to the 1939 Pact of Amity between San Marino and Italy, each country has the obligation to prevent in its own territory any infringement or counterfeiting of trademarks registered and protected in the other country. Therefore, an Italian trademark registration or application enjoys protection in San Marino.

However, San Marino not being a member of the European Union, Community trademarks, although protected in Italy (which is on the contrary a European Union member country), do not enjoy any protection in San Marino.

As to International trademark registrations designating Italy under the Madrid Agreement or Protocol, their enforceability in San Marino is questionable and according to the San Marino Patent and Trademark Office it is to be excluded.

#### *Laws*

- Law No. 79 of 25 May 2005 (Industrial Property Sole Act) as amended by Law No. 114 of 20 July 2005 and by Law No. 189 of 5 December 2011;
- Decree No. 78 of 20 April 2010 (Patent, Trademark and Design Fees); and
- Regulations No. 5 of 2 July 2007 (Regulation for the activity of professional representatives).

### Duration of Registration

The duration of a registration is ten years from the filing date of the application, indefinitely renewable for further ten-year periods (starting from the previous expiration date).

### Requirements for Renewal

Applications for renewal must be filed in the twelve months preceding the expiration date.

Late renewal is possible in the six months following the expiration month of the registration upon payment of an additional fee.

A renewal application is required which must contain the registrant's details as well as the details of the registration and a specimen of the trademark.

On renewal minor changes of the trademark not affecting its distinctive features are accepted; if renewal is requested for a trademark, the distinctive features of which are different from those of the previously registered (or renewed) trademark, the San Marino Patent and Trademark Office requires the application for renewal to be converted into an application for first registration running from the filing date of the renewal application.

The renewal application must be accompanied by a simply signed Power of Attorney and by the payment of the prescribed fees.

The renewed registration has a duration of ten years from the expiration date of the registration.

In case the registration has been split up by partial assignment, renewal is to be applied for separately for each part into which the registration has been split, and each owner thereafter receives a renewal registration certificate.

### **Registrable / Not Registrable**

Any sign capable of being represented graphically (words, including personal names, designs, letters, sounds, numerals, the shape of goods or of their packaging, colour combinations or shades) can be registered if it is new and it complies with the other requirements provided for by the law.

The novelty requirement means that: there should be no prior identical or similar sign already known at a not merely local level as a trademark or distinctive sign (a well-known trademark pursuant to Article 6*bis* of the Paris Union Convention is considered known under this provision) or already registered as a trademark (or applied for, subject to its registration) in San Marino or with effect in San Marino (i.e., under an International trademark registration designating San Marino in accordance with the Madrid Agreement or Protocol) or already registered (or applied for, subject to its registration) in Italy, nor any prior identical or similar sign already known at a not merely local level as a trade name, company name or signboard, covering identical or similar goods/services, if because of the identity or similarity between the signs and of the identity or similarity between the goods or services a likelihood of confusion may arise on the part of the public, which may also consist of a likelihood of association. Prior filed/registered marks include those claiming priorities of foreign applications or of exhibitions.

Prior registered (or applied for, subject to their registration) marks are a bar to the validity of a junior one if applied for even for non-similar goods/services when the prior mark enjoys a reputation in San Marino or in Italy and the use without due cause of the junior mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the prior mark.

The prior registrations of all the aforesaid marks are likewise a bar for junior marks if they have expired for less than two years (three years for collective marks) or may not be regarded as having lapsed on account of non-use at the time on which the nullity of the junior mark is applied for or the validity of the junior mark is challenged in a Court action.

Prior use of the mark by the applicant or by its predecessor in title is not a bar to its registration.

Beside the novelty requirement the following are not registrable as a trademark:

- Signs not capable of being represented graphically.
- Signs consisting exclusively of signs that have become customary in the current language or in the established practices of the trade; however, if such signs, prior to the filing date of the application for registration, have acquired a distinctive character through the use made thereof (secondary meaning) they may be registered.
- Signs contrary to the law, to public order or to morality.
- Signs not capable of distinguishing the goods or services of one undertaking.

- Signs which may deceive the public or the dealers, in particular as to the geographical origin, nature or characteristics of the goods or services.
- Coats-of-arms, emblems or other signs of public interest or provided for by international conventions in force, unless their registration has been authorized by the competent authorities.
- Signs which consist exclusively of generic denominations of goods or services or of descriptive indications relating thereto, such as the signs which may serve, in trade, to designate the kind, quantity, quality, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the services, or other characteristics of the goods or services; however, here again signs having acquired a ‘secondary meaning’ prior to the filing date of the application for registration can be registered.
- Signs consisting exclusively of the shape resulting from the nature of the goods, or of the shape of goods which is necessary to obtain a technical result, or of the shape which gives a substantial value to the goods.
- Signs the use of which would infringe a copyright, industrial property right or any other exclusive right of a third party.
- The portrait of a person without such person’s consent (or, after the death of such person, without the consent of the nearest relatives).
- A personal name other than the name of the applicant if its use may prejudice the reputation, credit or dignity of the person entitled to bear that name, without such person’s consent (or, after the death of such person, without the consent of the nearest relatives).
- Well-known personal names, well-known signs used in the artistic, literary, scientific, political or sports field and well-known names and initials of shows and events and of non-profit bodies and associations and their characteristic emblems, without the consent of the parties entitled thereto (or, after the death of such parties, without the consent of the nearest relatives).

#### *Colour marks*

Colour combinations or shades are registrable, if distinctive.

#### *Three-dimensional marks*

Three-dimensional trademarks are registrable, unless they consist exclusively of the shape resulting from the nature of the goods, or being necessary to obtain a technical result, or giving a substantial value to the goods concerned.

#### *Collective marks*

Collective trademarks are registrable. The regulations governing the use of a collective trademark, the controls and the relevant sanctions for its misuse must be filed along with the application for registration of a collective trademark. The owner of the collective trademark is responsible for ensuring that the regulations are observed by all the users of the collective trademark. The owner of the collective trademark must submit to the San Marino Patent and Trademark Office any modifications in the regulations of use. Foreign collective trademarks which are registered in the home country may be registered in San Marino provided the home country grants reciprocity to San Marino.

Signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may be registered as collective trademarks; however, the San Marino Patent and Trademark Office may refuse their registration as a collective trademark if this would create unjustified privileges or could be harmful for the development of similar initiatives in the territory concerned. The registration of a geographical name as a collective trademark

does not entitle the owner to prevent third parties to use that name in trade, if such use is in accordance with honest practices and consequently is limited to the function as an indication of origin.

Licenses are not allowed for collective trademarks. Assignments require the prior approval by the San Marino Secretary of State for Industry.

#### *Certification marks*

Not applicable in this jurisdiction.

#### *Associated marks*

Not applicable in this jurisdiction.

#### *Series of marks*

Not applicable in this jurisdiction.

#### *Other marks*

Sounds and music notes may be registered as trademarks, provided they comply with the requirement of distinctiveness and can be represented graphically.

Defensive marks are provided for in the sense that lapse for lack of use does not apply in respect of a non-used registered trademark if its owner also owns one or more similar registered trademarks still in force, of which at least one is being genuinely used for the same goods or services.

### **Applicant**

Registration of a mark may be obtained by any person (individual or legal entity) who makes use of the trademark (in its own undertaking or through controlled or authorized undertakings) in the manufacture or trade of goods or in the rendering of services or has the intention to use it or have it used. Registration of a trademark may also be obtained by the administrations of States, regions, provinces or municipalities.

Foreigners are entitled to registration in San Marino based on reciprocity.

### **Assignment**

A trademark may be assigned with or without the business or the branch of the business pertaining to the trademark. Assignment may be for all or part of the goods or services for which the trademark is registered. Assignment is not allowed if there would be deceit in those features of the goods or services which are essential for the appraisal by the public.

A trademark may be assigned even without written form, but a written assignment is necessary for recordal, which allows the assignment to be effective against third parties who have acquired and lawfully maintained rights in the trademark application or registration. A registration cannot be split up if the assignment leads to mislead the public as to the source of goods/services.

Documents required for the recordal of an assignment: (a) a notarized and legalized (through Apostille where applicable) assignment deed or a certified copy thereof along with a sworn



translation into Italian; (b) a Power of Attorney, not legalized; and (c) proof of the payment of the prescribed official fees.

Pursuant to Law No. 189 of 5 December 2011, the San Marino Patent and Trademark Office also accepts instead of assignment deeds assignment declarations signed by both parties.

### **Requirements for Filing**

#### *Request for registration*

The required documents are the following:

- (1) Application (may be filled in and signed by the applicant's professional representative) containing full name, address and nationality of the applicant (and also full name and address of the professional representative, if any), a description and a representation of the trademark, the colour or colours claimed (if any), the specification of the goods/services (multiclass applications are allowed).
- (2) For collective marks, the regulations governing the use of the trademark, the controls and the relevant sanctions must be submitted.
- (3) If priority is claimed, the application must include a statement of the country, serial number and filing date of the foreign application the priority of which is claimed.
- (4) A Power of Attorney executed by the applicant in case the application is filed through a San Marino professional representative. No legalization or notarization is required. General Powers are allowed.

In Convention priority cases, a priority document, i.e., a certified copy of the priority application must be filed along with an Italian translation thereof. An assignment of priority rights, if applicable, is also required.

The application must be accompanied by the proof of the payment of the prescribed official fees.

The additional documents missing when filing the application (Power of Attorney and regulations governing the use of collective trademarks) may be filed within two months from the filing date of the application.

The priority document may be filed within six months from the filing date of the application (no extension allowed).

One application may relate to goods or services of more than one class of the applicable classification (i.e., the International Classification under the Nice Agreement), provided that an additional fee is paid for each class of goods or services over the third.

#### *Appointment of Representative*

Applicants residing abroad or whose main business address is abroad must be represented by a professional representative admitted to practice before the San Marino Office; nationals may file directly or through a qualified professional representative.

Applicants or their professional representatives must elect an address for service in the Republic of San Marino, to which communications by the San Marino Patent and Trademark Office and deeds originating from Courts are served.

#### *Power of Attorney*

Powers of Attorney do not require notarization or legalization. The Power of Attorney may be filed within two months from the filing date of the application.

### *Priority*

The right of priority with respect to a prior first trademark application filed abroad within the previous six months is recognized.

The priority document, i.e., a certified non-legalized copy of the earlier application must be filed within six months from the filing date of the trademark application (no extension allowed).

If the trademark application is filed by a party other than the applicant of the first trademark application the priority of which is claimed, a deed of assignment of the priority rights is required.

The priority document must be filed along with an Italian translation thereof. The San Marino Patent and Trademark Office may request a certified Italian translation of the priority document.

Exhibition priority may also be claimed for new trademarks used for the first time with goods or wares which are shown at official or officially recognized national or international exhibitions held in the State territory or in the territory of a foreign State that accords reciprocity of treatment, in particular Italy, provided an act by the San Marino Secretary of State for Industry grants a temporary protection to such trademarks. The non-extendable priority term is six months from the date on which the goods or wares were delivered for the exhibition and in any case it cannot extend beyond six months from the opening date of the exhibition.

### *Graphical representations*

A representation of the trademark must always be included in the application.

## **Procedure**

### *Filing Authority*

The trademark authority is the San Marino Patent and Trademark State Office (*Ufficio di Stato Brevetti e Marchi* (USBM)).

### *Online filing*

The San Marino Patent and Trademark Office does not provide for online filing.

### *Classification*

The International Classification of Goods and Services under the Nice Agreement applies. Multiclass applications may be filed.

### *Search*

No search as to earlier trademarks is carried out by the San Marino Patent and Trademark Office.

### *Examination*

Applications are examined as to form and as to whether the applied for trademark is contrary to the law, to public policy or to morality, is capable of distinguishing the goods or services of one undertaking, may deceive the public or the dealers, consists of coats-of-arms, emblems or other signs of public interest or provided for by international conventions in force, or of a sign that has become customary in the current language or in the established practices of the trade, or of the portrait of a person, or of a personal name other than the name of the applicant and its use may prejudice the reputation, credit or dignity of the person entitled to bear that name, or of a well-known personal name, or of a well-known sign used in the artistic, literary, scientific, political or sports field, or of a well-known name or of the initials of shows and events and of non-profit bodies and associations or of their characteristic emblem.

No novelty examination (for prior trademarks) is carried out.

The examination currently takes place within two to four months from the filing date of the application and the application is then published (in colours, if applicable) in the special Section of the Official Gazette of San Marino, which is issued every two months.

In case of a final refusal of the trademark application by the San Marino Office following its examination, it is possible to appeal to the Administrative Court.

### *Registration*

The registration is granted within about twelve to eighteen months as of the filing date of the application.

There are no formal steps required for the certificate to issue and no final registration fee is payable.

### *Opposition*

Opposition proceedings before the San Marino Patent and Trademark Office are provided for by the law but are not yet operational and will be possible only in the future, once the relevant rules are issued by the Director of the Office.

Oppositions (in the future) may then be filed within three months from the publication of the application on the basis of conflicting earlier San Marino or Italian trademark applications or registrations, or of earlier non-registered trademarks already known at a not merely local level, including well-known trademarks pursuant to Article *6bis* of the Paris Union Convention. In addition to the owners of said earlier signs also exclusive licensees are entitled to file oppositions, if they are not expressly prevented to do so in the license agreement.

Oppositions (in the future) may then also be possible against an International trademark registration designating San Marino within three months from the publication in the International Bulletin.

Any third party, including groups that represent manufacturers, service providers, traders or consumers may submit written observations against the registration of the applied for trademark. The observations are to be filed within four months from the publication date of the trademark application. The observations are included in the file of the trademark application and are served to the applicant who may file a reply. The party who has filed observations does not become a party to the proceedings before the San Marino Patent and Trademark Office.

Observations are based on absolute grounds only and cannot be filed based on relative grounds.

*Appeal*

The San Marino Patent and Trademark Office's decisions may be appealed to the San Marino Administrative Court.

*Alteration after Registration*

Alterations in registered marks are allowed on renewal and may concern the registered trademark, provided they are limited to its non-distinctive features and they do not substantially alter the identity of the trademark as initially registered, or the goods/services coverage, provided they are limited to similar goods/services in the same class.

*Publication / Public File Inspection*

Both trademark applications and registrations are published.

Once a trademark registration is granted, the relevant file is open to public inspection.

**Nullity and Lapse**

The nullity of a registration may be challenged in Court on the ground that the trademark was not registrable and may be partial (i.e., for only some of the goods/services covered by the registration).

The lapse of a registration, which likewise must be challenged in Court and may be partial, may occur on the ground: (a) of non-use of the trademark; (b) that, because of the owner's acts or inactivity, the trademark has become the common name in the trade of the product or service in respect of which it is registered, i.e., it has lost its distinctive character; (c) that the trademark has become liable to deceive the public, in particular as to the nature, quality or origin of the goods or services, because of the manner and context in which the trademark is used by its owner or with his/her consent for the goods or services for which it is registered; (d) that the trademark has become contrary to the law, to public policy or to morality; (e) of the failure to pay the renewal fees.

Lapse of a collective trademark registration may furthermore occur if the owner does not carry out the controls provided for by the regulations of use.

Any interested party (except as mentioned below) may bring a Court action to request the registration of a trademark to be declared null and void or lapsed.

Nullity on the ground of earlier rights, or on the ground that the trademark infringes another party's copyright, industrial property right or any other exclusive right, or on the ground that the trademark infringes another's party right to the name or portrait, or on the ground that the registrant was not entitled to registration may only be claimed by the owner of the earlier right and by his/her successor in title or by the entitled person.

Bad faith registrations (e.g., applied for by an agent or licensee) can be declared null and void.

If an application for registration was filed by a person not entitled thereto and the registration has not yet been granted, the entitled person may, as a result of a final decision given by the Court, within three months from the date on which said decision became final either prosecute the application as the applicant in his/her own name, or file a new application in his/her own name having the same application date of the application filed by the non-entitled person (the latter application shall then cease to have effect), or obtain the rejection of the application of the non-entitled person. If on the contrary the registration has already been granted, the entitled person may have the registration either transferred to his/her own name or declared null and void.

The Court final decision declaring a trademark registration null and void or lapsed is effective against everybody and is recorded with the San Marino Patent and Trademark Office.

Use by any party of a trademark the registration of which has been declared null and void is prohibited if the ground of the nullity declaration involves that the use of the trademark is unlawful.

### **Use Requirement**

A registered trademark must be used in San Marino or in Italy for the goods or services for which it is registered.

The registration lapses (lapse for lack of use must to be declared in Court proceedings), for all or part of the goods/services covered if the trademark is not genuinely used by the registrant or with his/her consent, within five years from the registration date, or if use is discontinued for five consecutive years, unless the lack of use is due to legitimate reasons.

Renewal does not constitute use, nor does it restore the compulsory five-year use period.

The validity of the registration is recovered if genuine use of the trademark is commenced or resumed after the expiration of the compulsory five-year use period provided that no rights in the trademark have been acquired by a third party through an application for registration or use. Likewise, recovering rights is not allowed if the owner of the trademark makes preparations for the commencement or resumption of use of the trademark only after having become aware that a lapse claim or counter-claim is about to be filed; such commencement or resumption of use is not taken into consideration if it did not occur after the expiry of the five-year period of non-use and at least three months prior to the filing of the lapse claim or counter-claim.

Use of the registered trademark in a modified form not affecting its distinctive character as also affixing the trademark in San Marino or in Italy to goods or their packaging for export purposes constitute use of the trademark.

Lapse of the trademark registration does furthermore not occur if the owner of the non-used trademark at the same time also owns one or more similar trademarks still in force of which at least one is being genuinely used for the same goods or services (see under the subheading 'Other marks').

The burden of proof to have the lapse of a trademark registration declared on account of non-use lies on the party which claims the lapse. The proof may be furnished by any means, including simple presumptive evidence.

### **Marking**

Marking is advisable, but not compulsory. Possible marking: '*Marchio registrato*', or '*Marchio reg.*', which may also be followed by the trademark registration number, or ®, or '*Marchio depositato*', or '*Marchio dep.*', which may also be followed by the trademark application number.

### **Licenses and Registered Users**

Exclusive and non-exclusive licenses under a registered trademark or even a pending trademark application may be granted. Licenses may be for all or part of the goods or services for which the trademark is registered, and may be for all or part of the San Marino territory.

License agreements must provide for an actual control by the licensor on the quality of the licensed goods or services. If such quality control is not provided for in the license agreement or if it is not carried out by the licensor the license agreement is not valid and the exclusive rights deriving from the registration cannot be enforced.

In case of a non-exclusive license the licensee is obliged to expressly undertake to provide

goods or services of the same kind as those provided under the same trademark by the trademark owner and/or by other licensees.

The owner of a licensed registered trademark may sue for infringement (and not only sue for breach of the license agreement) a licensee who acts in contravention of any provision of the license agreement with regard to the duration of the license, the form in which the trademark may be used, the goods or services for which the license was granted, the territory in which the trademark may be used, or the quality standards applicable to the goods manufactured or the services rendered by the licensee.

License agreements must be recorded with the San Marino Patent and Trademark Office in order to be effective against third parties who have acquired and lawfully maintained rights in the trademark application or registration.

Documents required for the recordal of a license: (a) a notarized and legalized (through Apostille where applicable) license deed or a certified copy thereof along with a sworn translation into Italian; (b) a Power of Attorney from licensor and from licensee, not legalized; (c) proof of the payment of the prescribed official fees.

Pursuant to Law No. 189 of 5 December 2011, the San Marino Patent and Trademark Office also accepts instead of license deeds license declarations signed by both parties.

Licenses are not allowed for collective trademarks.

### **Pledge and Seizure**

Security interests may be established in respect of registered trademarks or even pending trademark applications and may be recorded with the San Marino Patent and Trademark Office in order to be effective against third parties who have acquired and lawfully maintained rights in the trademark application or registration; the recordal requirements are as in the case of assignments.

### **Infringement**

#### *Infringing acts / Non-infringing acts*

The registration confers on the owner the exclusive right to use the trademark. Except for trademarks enjoying a reputation in San Marino or in Italy, exclusive trademark rights are limited to the goods or services listed in the registration and to similar goods or services.

Exclusive rights are also enjoyed by a non-registered trademark, de facto used in San Marino which has acquired a not mere local reputation, i.e., a nation-wide reputation, as well as by a well-known trademark under Article *6bis* of the Paris Union Convention. On the contrary, the prior user of a non-registered trademark which enjoys no reputation or a mere local reputation has the right to continue the use of the trademark (including use in advertisement) after the registration of an identical or similar mark by another party, within the (territorial and other) limits determined by the prior use, but is not entitled to challenge the registration of the later trademark.

The registration confers on the owner the exclusive right to use the trademark for the goods/services covered thereby. The owner has the right to prohibit third parties to use without his/her consent identical or confusingly similar trademarks. If the registered trademark enjoys a reputation in San Marino or in Italy its owner may prohibit the use of a sign identical with or similar to the registered trademark for non-similar goods or services if the use of the sign allows to take unfair advantage of the distinctive character or the repute of the trademark, or is detrimental thereto.

In particular the owner of a trademark may prohibit third parties to affix the sign to the goods or to their packaging; to offer the goods, to put them on the market or to stock them for these purposes, or to offer or supply services under the sign; to import or export the goods under that sign; to use the sign on business papers and in advertising. Traders may affix their

trademarks on the goods they market but are not allowed to suppress the trademark of the manufacturer or of the trader from whom they received the goods.

Owners of earlier registered trademarks and owners of earlier non-registered trademarks which are known at a not merely local level, who have tolerated use of a later identical or similar registered trademark during a period of five consecutive years, while being aware of such use, cannot request the registration of the later trademark to be declared null and void nor oppose the use of the later trademark for the goods or services for which that trademark has been used, except where registration of the later trademark was applied for in bad faith (forfeiture of rights through acquiescence). In this case the owner of the later trademark is not entitled to oppose the use of the earlier trademark or the continuation of use of the earlier non-registered trademark. The right to request the nullity of the registration of a trademark which infringes another party's copyright, industrial property right or other exclusive rights, or which has been registered without the required consent of another party (where it consists of another party's portrait, or personal name, or well-known personal name or sign used in the artistic, literary, scientific, political or sports field, or of a well-known name or initials of shows and events or of non-profit bodies and associations, or of their characteristic emblems) likewise forfeits under the same conditions.

The following acts carried out by a third party in the course of trade do not amount to an infringement of a trademark and cannot be prohibited by its owner:

- (a) use by the third party of his/her name and address;
- (b) use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service.

Third parties must however avoid such uses that give rise to confusion or deceit.

The trademark owner cannot prohibit third parties to use the trademark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts, provided such use is in accordance with the principles of professional fairness (honest practices) and thus the use is for descriptive purposes only.

Pact of Amity with Italy allows owners of trademarks registered in Italy to enforce their rights in San Marino.

The owner of a registered trademark cannot prohibit a third party to use the trademark in relation to goods which have been put on the market by him/her or with his/her consent in the San Marino territory, except if there exist legitimate reasons for the trademark owner to oppose the further commercialization of the goods, in particular where the condition of the goods is changed or impaired after they have been put on the market.

A licensee not complying with the provisions of the license agreement is considered as an infringer.

### *Remedies*

Trademark infringement actions are to be brought before the San Marino Court. Infringement actions based on a pending trademark application may be brought provided the trademark application has been published or served on the alleged infringer, but they cannot be decided until the registration is granted.

Available remedies in case of infringement include: an injunction prohibiting the use of the infringing trademark and the manufacture and trade of the goods or the rendering of the services bearing the infringing trademark, a penalty for any subsequent infringement or non-compliance or delay in the compliance with the injunction order; the destruction of the infringing trademark and even of the packaging of the goods and (if deemed appropriate by the Court) of the goods themselves (however, no order for removal or destruction may be issued if the infringing items belong to persons who use them in good faith for personal or domestic purposes); the assignment of the infringing goods manufactured, imported or sold

to the owner of the trademark right, together with those specific means univocally devoted to their manufacture, or, under certain circumstances, their seizure at the infringing party's expense; the publication of the Court decision; the award of damages. In assessing the damages the Court must also evaluate the prejudice suffered as lost revenues by the owner of the trademark rights, the prejudice deriving from the loss of value of the infringed trademark on the marketplace and the unfair advantage taken by the infringer.

At the request of the interested party, damages may be awarded in a lump sum on the basis of the records of the judicial proceedings and of the deriving presumptions.

Prior to or during infringement proceedings the trademark owner may request a preliminary injunction prohibiting the manufacture and trade of anything constituting an infringement of his/her trademark. The Court when ordering the preliminary injunction may set a penalty for any subsequent infringement or non-compliance or delay in the compliance with the injunction order.

The trademark owner may also request that a judicial inspection (description) and/or seizure be ordered of some or all of the infringing goods as well as of the means used in their manufacture and of the proof evidence concerning the alleged infringement. Judicial inspection may also relate to goods belonging to parties other than the alleged infringer, if these goods are not for personal use. Seizure may also relate to goods belonging to parties other than the alleged infringer, if these goods are traded by such parties. Judicial inspection only, but not seizure, is possible in respect of goods exhibited at an official or officially recognized exhibition in San Marino or in Italy (or which are in transit to or from such exhibition).

Preliminary injunction, judicial inspection and seizure may be obtained only if the conditions of '*periculum in mora*' and '*fumus boni iuris*' are met. If any of these remedies is granted before the infringement action is brought, the action must start within a short fixed term.

#### *Penal provisions*

Trademark infringement may be sanctionable, under given conditions, as a criminal offence.

#### *Enforcement and Customs*

Customs enforcement is not applicable in this jurisdiction.

### **Well-known and Reputed Marks**

A registered trademark enjoying a reputation in San Marino or in Italy is protected against use in San Marino without the consent of its owner of a third party's identical or similar trademark for non-similar goods/services if such use would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.

Well-known personal names, well-known signs used in the artistic, literary, scientific, political or sports field and well-known names and initials of shows and events and of non-profit bodies and associations and their characteristic emblems may only be registered by the parties entitled thereto or with their consent (or, after the death of such parties, with the consent of the nearest relatives).

### **Trademarks and Trade Names**

Trade names are protected even without registration. Use of a trade name, trademark, service mark or collective trademark identical with another party's earlier trade name is not allowed. Likewise use of a trade name or trademark similar to another party's earlier trade name is not allowed if it is likely to deceive the public.



### **Trademarks and Domain Names**

The Naming and Registration Authority of San Marino ([www.nic.sm](http://www.nic.sm)) is responsible for the registration and management of domain names in San Marino under the country code top-level domain '.sm'. Domain names under the ccTLD 'sm' may be applied for and registered also by foreigners. Ownership of a trademark application or registration in San Marino is not required for acquiring a domain name registration. Registration is made on a first-come first-served basis. The duration of the domain registration is one year, renewable for further one-year periods.

Trademarks belonging to third parties cannot be registered as domain names. Conflicts between domain names and trademarks may be resolved by submitting them to the General Direction of the Postal and Telecommunication Service (*Direzione Generale delle Poste e Telecomunicazioni*) or to the San Marino Secretary of State Office for telecommunications (*Segreteria di Stato alle Telecomunicazioni*) and/or through Court proceedings.

### **Trademarks and Appellations of Origin / Trademarks and Geographical Indications**

Any direct or indirect use of an appellation of origin (meaning the name of the country, region or other geographical entity used to designate a good that originates from it and the typical quality of which is exclusively or essentially attributable to its geographical environment, including natural and human factors) is prohibited if it is false or may deceive the public. The imitation of an appellation of origin is likewise prohibited even though the true place of origin of the good is mentioned. Use of a translation of the appellation or use of the appellation accompanied by terms such as 'kind', 'type', 'imitation' or similar terms are also prohibited.

Any direct or indirect use of an indication of origin (meaning any expression or sign used to designate that a good or service originates from a certain country, region or other geographical entity) is prohibited if it is false or may deceive the public about the origin of the goods or services or the identity of their manufacturers or suppliers.

There is no system of formal registration in San Marino of appellations and geographical indications.

Conflicts between trademarks and appellations of origin or geographical indications are resolved through Court proceedings.

### **Restoration**

Restoration (re-establishment of rights) may be obtained if an applicant or trademark owner, in spite of all due care required by the circumstances taken, has not been able to observe a time limit, and the consequence thereof is the lapse of a right or the rejection of an application or request.

Within two months after the cause impeding the observance of the time limit has ceased, the non-accomplished act is to be completed and a request for restoration is to be filed stating the reasons for the non-observance and accompanied by the appropriate evidence. The relevant official fee has also to be have been paid.

Restoration does not apply to the following terms: term for requesting the re-establishment of rights; term for dividing a trademark application and for filing divisional applications; opposition term.

Persons who, in the period between the lapse of a trademark registration or trademark application and the re-establishment of rights, have made serious and effective preparations for the use of the trademark, or have actually commenced such use, have the right to be refunded the costs they incurred.

### Specific Aspects of Regional Trademark Registration

San Marino is not a member of the European Union. Therefore, Community Trademarks do not enjoy any protection in San Marino.

### Specific Aspects of International Trademark Registration

San Marino is a party to both the Madrid Agreement Concerning the International Registration of Marks 1891–1967 and the Madrid Protocol of 1989. International applications designating San Marino are examined according to the national law in the same manner as national applications.

For international applications under the Protocol designating San Marino, San Marino has made declarations extending refusal to eighteen months and for payment of individual fees.

### Fees

#### *Table of official fees*

Fees in Euros (EUR), as from 30 June 2010.

	EUR
Application for first registration of a trademark, for ten years in up to three classes, including publication fee.....	150.00
Renewal of a trademark registration for ten years in up to three classes.....	150.00
Each additional class in addition to the fourth (for applications for first registration and for renewals of trademark registrations).....	40.00
Application for first registration of a collective trademark, for ten years in up to three classes, including publication fee.....	270.00
Renewal of a collective trademark registration for ten years in up to three classes.....	270.00
Each additional class in addition to the fourth (for applications for first registration of a collective trademark and for renewals of collective trademark registrations).....	70.00
Fine for late renewal, during the six-month grace period.....	25% of the renewal fee
Registering an assignment or license (for each trademark involved).....	120.00
Restoration (re-establishment of rights) fee.....	100.00
National fee for application for international registration (under the Madrid Agreement or Protocol).....	70.00

### Transitional Provisions

Not applicable in this jurisdiction.

**Specific Trademark Issues**

Pursuant to the 1939 Amity Pact with Italy, if a mark is simultaneously applied for/registered both in San Marino and in Italy in the name of the same owner, infringing acts performed in San Marino must be challenged on the basis of the San Marino application/registration; if the mark is applied for/registered in Italy only, infringing acts performed in San Marino can be challenged on the basis of the Italian application/registration before the San Marino Court.

**Governmental Websites**

- [www.usbm.sm](http://www.usbm.sm) (San Marino Patent and Trademark State Office)

## UTILITY MODELS

### SUMMARY

#### **Duration of Registration**

- See Chapter ‘Italy’.

#### **Registrable / Not Registrable**

- See Chapter ‘Italy’.

#### **Novelty**

- See Chapter ‘Italy’.

#### **Requirements and Procedure**

- See Chapter ‘Italy’.

#### **Government Websites**

- [www.usbm.sm](http://www.usbm.sm) (San Marino Patent and Trademark State Office)

**DETAILED INFORMATION****Conventions and Legislation***Conventions*

- Paris Convention (International Union) 1883–1967 (effective in San Marino as from 4 March 1960; the Stockholm Act 1967 is in force as from 26 June 1991);
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967 (effective for San Marino as from 26 June 1991);
- The Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents 1961 (effective in San Marino as from 13 February 1995);
- Patent Cooperation Treaty (PCT) 1970 (effective in San Marino as from 14 December 2004);
- European Patent Convention (EPC) (effective in San Marino as from 1 July 2009); and
- Pact of Amity and Good Neighbourhood between the Republic of San Marino and Italy of 31 March 1939.

Pursuant to the 1939 Pact of Amity between San Marino and Italy, each country has the obligation to prevent in its own territory any infringement or counterfeiting of models which are covered by industrial property rights in the other country. Therefore, an Italian utility model enjoys protection in San Marino.

*Laws*

- See Chapter ‘Italy’.
- The San Marino IP law does not provide utility models, but pursuant to the 1939 Pact of Amity between San Marino and Italy Italian utility models enjoy protection in San Marino.

**Duration of Registration**

See Chapter ‘Italy’.

**Requirements for Renewal**

See Chapter ‘Italy’.

**Registrable / Not Registrable**

See Chapter ‘Italy’.

**Novelty**

See Chapter ‘Italy’.

**Applicant**

See Chapter ‘Italy’.

**Assignment**

See Chapter ‘Italy’.

**Requirements for Filing**

See Chapter ‘Italy’.

**Procedure**

See Chapter ‘Italy’.

**Nullity and Lapse**

See Chapter ‘Italy’.

**Use Requirement**

See Chapter ‘Italy’.

**Marking**

See Chapter ‘Italy’.

**Licenses**

See Chapter ‘Italy’.

**Pledge and Seizure**

See Chapter ‘Italy’.

**Infringement**

See Chapter ‘Italy’.

**Restoration**

See Chapter ‘Italy’.

**Utility Model Application Based on International Patent Application (PCT)**

See Chapter ‘Italy’.

**Fees**

*Table of official fees*

See Chapter ‘Italy’.

**Transitional Provisions**

See Chapter ‘Italy’.

**Specific Utility Model Issues**

See Chapter ‘Italy’.

**Governmental Websites**

- [www.usbm.sm](http://www.usbm.sm) (San Marino Patent and Trademark State Office)

## INDUSTRIAL DESIGNS AND MODELS

### SUMMARY

#### Duration

- 5 years from the filing date of the application, renewable for one or more periods of 5 years, up to the maximum of 25 years.

#### Registrable / Not Registrable:

- A registrable design is defined as the appearance of the whole or a part of an industrial or handicraft item resulting, in particular, from the features of the lines, contours, colours, shape, texture and/or materials of the item itself and/or its ornamentation.

#### Novelty

- Absolute novelty is required, with respect to the circles specialized in the sector within San Marino or the European Union.
- A 12-month grace period preceding the filing/priority date applies.

#### Procedure

- Examination of new design applications is limited to form.

#### Governmental Websites

- [www.usbm.sm](http://www.usbm.sm) (San Marino Patent and Trademark State Office)



## DETAILED INFORMATION

### Conventions and Legislation

#### *Conventions*

- Paris Convention (International Union) 1883–1967 (effective in San Marino as from 4 March 1960; the Stockholm Act 1967 is in force as from 26 June 1991);
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967 (effective for San Marino as from 26 June 1991);
- The Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents 1961 (effective in San Marino as from 13 February 1995); and
- Pact of Amity and Good Neighbourhood between the Republic of San Marino and Italy of 31 March 1939.

Pursuant to the 1939 Pact of Amity between San Marino and Italy, each country has the obligation to prevent in its own territory any infringement or counterfeiting of models and designs which are covered by industrial property rights in the other country. Therefore, an Italian design or design application enjoys protection in San Marino.

However, San Marino not being a member of the European Union, Community designs, although protected in Italy (which is on the contrary a European Union member country), do not enjoy any protection in San Marino.

As to International designs designating Italy under the Hague Agreement, their enforceability in San Marino is questionable and according to the San Marino Patent and Trademark Office it is to be excluded.

#### *Laws*

- Law No. 79 of 25 May 2005 (Industrial Property Sole Act) as amended by Law No. 114 of 20 July 2005 and by Law No. 189 of 5 December 2011;
- Decree No. 78 of 20 April 2010 (Patent, Trademark and Design Fees); and
- Regulation No. 5 of 2 July 2007 (Regulation for the activity of professional representatives).

### Duration of Registration

The duration of a registration is five years from the filing date of the application. This period can be renewed for one or more periods of five years each, upon payment of the prescribed fees, up to the maximum of twenty-five years from the filing date of the application.

### Requirements for Renewal

Renewal requires payment of the prescribed renewal fee. The renewal fee is due on the last day of the month on which protection ends.

A grace period of six months is provided for the late payment with a fine of the renewal fees.

Anyone can pay the renewal fees. No particular documents or a Power of Attorney are required.

**Registrable / Not Registrable**

A registrable design is defined as the appearance of the whole or a part of an industrial or handicraft product resulting, in particular, from the features of the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.

Product means any industrial or handicraft item, including, among others, parts intended to be assembled into a complex product provided they remain visible, packaging, get-up, graphic symbols and typefaces, but excluding computer programs. Complex products are products composed of multiple components which may be disassembled and reassembled.

In order to be registrable, a design must be new and have individual character.

A design is not registrable if:

- it does not comply with the definition of design;
- it lacks the novelty requirement;
- it lacks the individual character requirement;
- it is contrary to public order or to morality.

No design registration may be obtained for those features of appearance of a product which are solely dictated by its technical function, or those features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.

A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing the application for registration or, if a priority is claimed, the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

**Novelty**

In order to be registrable, a design must be new. Absolute novelty with respect to the circles specialized in the sector within San Marino or the European Union is required.

A design shall be considered to be new if no identical design has been made available to the public before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.

*Grace period*

A disclosure, for the purpose of applying the novelty and the individual character requirements, shall not be taken into consideration if:

- (a) the design, during the twelve months preceding the filing date or, if priority is claimed, during the twelve months preceding the priority date, has been made available to the public by the author or his/her successor in title, or by a third party as a result of information provided or action by the author or his/her successor in title;
- (b) the design, during the twelve months preceding the filing date or, if priority is claimed, during the twelve months preceding the priority date, has been made available to the public as the consequence of an abuse in relation to the author or his/her successor in title.

### **Applicant**

The right to the registration of a design shall vest in its author or his/her successor in title (natural or legal person).

Where a design is developed by an employee in the performance of his/her duties, the right to the registration of the design shall vest in the employer, except otherwise agreed upon between the parties. However, the employee has the right to be recognized as the author and to be mentioned as such in the Register and in the publication of the design.

### **Assignment**

A design may be assigned even without written form, but a written assignment is necessary for recordal, which allows the assignment to be effective against third parties who have acquired and lawfully maintained rights in the design registration or application.

Documents required for the recordal of an assignment: (a) a notarized and legalized (through Apostille where applicable) assignment deed or a certified copy thereof along with a sworn translation into Italian; (b) a Power of Attorney, not legalized; (c) proof of the payment of the prescribed official fees.

Pursuant to Law No. 189 of 5 December 2011, the San Marino Patent and Trademark Office also accepts instead of assignment deeds assignment declarations signed by both parties.

### **Requirements for Filing**

#### *Request for registration*

The application for the registration of a design must be filed at the San Marino Patent and Trademark Office and must contain:

- (1) Full name, address and nationality of the applicant, and full name and address of the representative, if appointed.
- (2) The indication of the design or model in the form of a title, specifying the industrial products to which the design or model applies, the features of such products and, if necessary, the aim to be achieved by such features.

The following documents must be attached to the application:

- (1) a graphic reproduction of the design or model or of the industrial products incorporating the design or model, or a sample thereof;
- (2) a description of the design, only if required for proper understanding;
- (3) the proof of the payment of the prescribed official fees;
- (4) a Power of Attorney, if a representative is appointed;
- (5) in Convention priority cases, a priority document, i.e., a certified copy of the priority application must be filed along with an Italian translation thereof. An assignment of priority rights, if applicable, is also required.

#### *Appointment of Representative*

Applicants residing abroad or whose main business address is abroad must be represented by a professional representative admitted to practice before the San Marino Office; nationals may file directly or through a qualified professional representative.

Applicants or their professional representatives must elect an address for service in the Republic of San Marino, to which communications by the San Marino Patent and Trademark Office and deeds originating from Courts are served.

#### *Power of Attorney*

Powers of Attorney do not require notarization or legalization. The Power of Attorney may be filed within two months from the filing date of the application.

#### *Priority*

The right of priority with respect to a prior first design application filed abroad within the previous six months is recognized.

The priority document, i.e., a certified non-legalized copy of the earlier application must be filed within six months from the filing date of the design application (no extension allowed).

If the design application is filed by a party other than the applicant of the first design application the priority of which is claimed, a deed of assignment of the priority rights is required.

The priority document must be filed along with an Italian translation thereof. The San Marino Patent and Trademark Office may request a sworn Italian translation of the priority document.

#### *Description*

A description may be filed, in three copies, if required for proper understanding (a single copy may be filed and the remaining two copies may be filed within two months from the filing date of the application).

The three copies of the description, if filed, must be signed by the applicant or by its representative.

#### *Graphical representations*

The graphical reproductions can be drawings (handmade or printed) and/or photographs. They may be in black and white or in colour, if the colours constitute characteristic features of the design.

Dimensions and ratios between the different parts of the design or product must be clearly indicated if they are important for the appearance of the product.

The graphical reproductions must be filed in three copies (signed by the applicant or its representative). Where a single copy of the graphical reproductions is filed, the remaining two copies may be filed within two months from the filing date of the application.

As an alternative to the graphical reproductions, a sample (in three specimens) of the product incorporating the design can be filed.

#### *Multiple deposits*

Up to 100 models or designs may be included in the same application, provided that they are intended to be incorporated into products belonging to the same class of the International Classification under the Locarno Agreement.

**Procedure***Filing Authority*

The design authority is the San Marino Patent and Trademark State Office (*Ufficio di Stato Brevetti e Marchi* (USBM)).

*Online filing*

The San Marino Patent and Trademark Office does not provide for online filing.

*Classification*

The International Classification under the Locarno Agreement applies.

*Search*

No prior art search is performed by the San Marino Patent and Trademark Office.

*Examination*

The examination of new design applications is limited to the following:

- compliance with the definition of ‘design’;
- contrariety to public order or to morality;
- fulfilment of the filing formalities (content of the application);
- priority data.

*Amendments, corrections and withdrawal*

The Applicant may correct the application before the application matures into registration, without extending the scope of protection beyond that of the application as originally filed.

The Applicant may withdraw the application before it matures into registration.

*Registration*

Unless the application is rejected, the San Marino Patent and Trademark Office grants the registration, which is published and issues a registration certificate to the applicant.

*Opposition*

No administrative opposition proceedings are provided before the San Marino Patent and Trademark Office.

### *Appeal*

The San Marino Patent and Trademark Office's decisions may be appealed to the San Marino Administrative Court.

### *Publication / Deferred Publication / Public File Inspection*

Design applications are made available to the public immediately after filing unless the applicant on filing requests postponement of availability for a period (maximum twelve months from the filing date of the application or, if applicable, from the priority date).

### **Nullity and Lapse**

A design can be declared invalid if:

- it does not comply with the definition of 'design';
- it does not fulfil the registrability requirements (novelty, individual character, technical function);
- if the applicant is not entitled to the registration (only the holder of the right to the design can claim the invalidity of the design under this ground);
- if the design is in conflict with a prior design which has been made available to the public after the filing date of the application or, if priority is claimed, the date of priority of the design, and which is protected from an earlier date by a Community design application or registered design, or by a design application or registered design in the Republic of San Marino or in Italy (only the holder of the prior right or third parties having a legitimate interest can claim the invalidity of the design under this ground);
- if the design includes an earlier distinctive sign the owner of which prohibits its use or if the design constitutes an unauthorized use of a copyrighted work in the Republic of San Marino or in Italy (only the holder of the conflicting right can claim the invalidity of the design under these grounds);
- if the design constitutes an improper use of any of the items listed in Article 6ter of the 'Paris Convention', or of signs, emblems and coats-of-arms other than those covered by the said Article 6ter and which are of particular public interest in the Republic of San Marino or in Italy.

A registered design which has been declared invalid may be maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained.

### **Use Requirement**

Working is not compulsory.

### **Marking**

Marking is advisable, but not compulsory. Possible marking: '*Modello registrato*', or 'Mod. reg.', which may also be followed by the design registration number, or '*Modello Depositato*', or 'Mod. Dep.', which may also be followed by the design application number.

### **Licenses**

Exclusive and non-exclusive licenses under a design registration or even a pending design application may be granted.

License agreements must be recorded with the San Marino Patent and Trademark Office in order to be effective against third parties who have acquired and lawfully maintained rights in the design registration or application.

Documents required for the recordal of a license: (a) a notarized and legalized (through Apostille where applicable) license deed or a certified copy thereof along with a sworn translation into Italian; (b) a Power of Attorney from licensor and from licensee, not legalized; and (c) proof of the payment of the prescribed official fees.

Pursuant to Law No. 189 of 5 December 2011, the San Marino Patent and Trademark Office also accepts instead of license deeds license declarations signed by both parties.

### **Pledge and Seizure**

Security interests in respect of designs or even pending design applications may be established and recorded with the San Marino Patent and Trademark Office in order to be effective against third parties who have acquired and lawfully maintained rights in the design registration or application; the requirements are as in the case of assignments.

### **Infringement**

#### *Infringing acts / Non-infringing acts*

The registration of a design or model confers on the owner the exclusive right to use the design or model and to prevent any third party not having his/her consent from using it.

In particular, the following acts done without the consent of the owner of a registered design or model are considered infringement: manufacturing, offering, trading, importing, exporting or using a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

The right conferred by the registration of a design or model cannot be enforced in respect of the following:

- acts done privately and for non-commercial purposes;
- acts done for experimental purposes;
- acts of reproduction for citation or teaching purposes, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and provided further that mention is made of the source;
- equipment on ships and aircraft registered in other countries and temporarily entering in the territory of the Republic of San Marino, as well as their repairs and importing into the republic of San Marino spare parts and accessories necessary to carry out such repairs.

The Pact of Amity with Italy allows owners of San Marino design registrations to enforce their rights in the Italian territory and owners of designs registered in Italy to enforce their rights in San Marino.

#### *Prior user rights*

Not applicable in this jurisdiction.

### *Remedies*

Design infringement actions are to be brought before the San Marino Court. Infringement actions based on a pending design application may be brought provided the design application has been published or served on the alleged infringer, but they cannot be decided until the registration is granted.

Measures which may be granted by the Court, prior to or during the infringement proceedings, or at the end of the proceedings, include:

- Injunction: the design owner may apply to the Court for an injunction prohibiting the manufacture, marketing and use of anything constituting an infringement of his/her design. The Court when ordering the injunction may set a penalty for any subsequent infringement or non-compliance or delay in the compliance with the injunction order.
- Judicial inspection or seizure: the design owner may request that a judicial inspection (description) and/or seizure be ordered of some or all of the infringing articles and of any means used in their manufacture, as well as of the proof evidence concerning the alleged infringement.

Judicial inspection may also relate to goods belonging to parties other than the alleged infringer, if these goods are not for personal use. Seizure may also relate to goods belonging to parties other than the alleged infringer, if these goods are traded by such parties. Judicial inspection only, but not seizure, is possible in respect of goods exhibited at an official or officially recognized exhibition in San Marino or in Italy (or which are in transit to or from such exhibition).

Preliminary injunction, judicial inspection and seizure may be obtained only if the conditions of *'periculum in mora'* and *'fumus boni iuris'* are met. If any of these remedies is granted before the infringement action is brought, the action must start within a short fixed term.

The Court may also decide that the infringing items and the means for their manufacture be transferred to the owner of the design, without prejudice to his/her right to award of damages. At the request of the owner of the items mentioned in the preceding sentence, and having regard to the remaining term of the design or to the particular circumstances of the case, the Court may also order the seizure of these items and of means of production until expiration of the design, at the infringing party's expense. In this case the owner of the design may request that the seized items be assigned to him/her.

The Court may order that the decision in an infringement proceeding be published, integrally or in summary form, in one or more newspapers as specified by it, at the expense of the losing party.

The Court may also award damages. In assessing the damages the Court must also evaluate the prejudice suffered as lost revenues by the owner of the design rights, the prejudice deriving from the loss of value of the infringed design on the marketplace and the unfair advantage taken by the infringer. At the request of the interested party, damages may be awarded in a lump sum on the basis of the records of the judicial proceedings and of the deriving presumptions.

### *Penal provisions*

Design infringement may be sanctionable, under given conditions, as a criminal offence.

### *Enforcement and Customs*

Customs enforcement is not applicable in this jurisdiction.



### Restoration

Restoration (re-establishment of rights) may be obtained if an applicant or design owner, in spite of all due care required by the circumstances taken, has not been able to observe a time limit, and the consequence thereof is the lapse of a right or the rejection of an application or request.

Within two months after the cause impeding the observance of the time limit has ceased, the non-accomplished act is to be completed and a request for restoration is to be filed stating the reasons for the non-observance and accompanied by the appropriate evidence. The relevant official fee has also to have been paid.

Restoration does not apply to the following terms: term for requesting the re-establishment of rights; term for dividing a design application and for filing divisional applications.

Persons who, in the period between the lapse of a design registration or application and the re-establishment of rights, have made serious and effective preparations for the use of the design, or have actually commenced such use, have the right to work the design free of charge within the limits of the prior use or within the limits that result from the preparations.

### Specific Aspects of Regional Design Registration

San Marino is not a member of the European Union. Therefore, Community Designs do not enjoy any protection in San Marino.

### Specific Aspects of International Design Registration

Not applicable in this jurisdiction.

As to International designs designating Italy, their enforceability in San Marino pursuant to the 1939 Pact of Amity between San Marino and Italy, is questionable and according to the San Marino Patent and Trademark Office it is to be excluded.

### Design and Copyright Protection

A registered or registrable design or model may also benefit of copyright protection.

### Fees

#### *Table of official fees*

Fees in Euros (EUR), as from 30 June 2010.

	EUR
Filing fee for single design applications, including publication fee.....	70.00
Filing fee for multiple design applications:	
– up to twenty designs.....	140.00
– up to forty designs.....	190.00
– up to sixty designs.....	270.00
– up to eighty designs.....	320.00
– up to 100 designs.....	400.00
Registering an assignment or license (for each design involved).....	120.00

Restoration (re-establishment of rights) fee.....	100.00
Maintenance (renewal) fees are as follows:	
– Single design registrations:	
– second five-year period.....	140.00
– third five-year period.....	270.00
– fourth five-year period.....	340.00
– Multiple design registrations:	
– second five-year period.....	330.00
– third five-year period.....	490.00
– fifth five-year period.....	540.00

The fine for late payment of the maintenance (renewal) fees amounts to 25% of the relevant fee.

#### **Transitional Provisions**

Not applicable in this jurisdiction.

#### **Specific Industrial Design and Model Issues**

Simultaneous protection: A design or model may be protected by both a patent for industrial invention and an industrial design or model registration if, in addition to meet the conditions for registration of the industrial design or model, the conditions for filing a patent application for industrial inventions are met. Two different applications must be filed in this case.

#### **Governmental Websites**

- [www.usbm.sm](http://www.usbm.sm) (San Marino Patent and Trademark State Office)