

Intellectual Property in Costa Rica

Context

The rights of authors, inventors, producers and merchants to have exclusive ownership of their work, brand, or invention are established in the Political Constitution of Costa Rica. The specification regarding these subjects, particularly industrial property are embodied in the Law of Invention Patents, 6867, which has been amended several times since 1983, when it was established. Costa Rica has also been part of the World Intellectual Property Organization since 1980, a fact that is embodied in Law No. 6468. The Invention Patent Office of the Industrial Property Registry is the institution that acts as an extension of WIPO in the country. In terms of Private International Law, Costa Rica is also governed by the Convention on Private International Law, better known as the Bustamante Code (1928), which states that rights, such as intellectual and industrial, have an implied location; meaning that patent registries made in Costa Rica are only valid in Costa Rica, unless applied by PCT (Patent Cooperation Treaty).

International legal framework for patenting, adapted to our country

WIPO's Convention signed in Costa Rica in 1980 is the documentary evidence of the adherence of Costa Rica to WIPO, through which the creation of products and industrial procedures, and flattering protection, is promoted. The purposes, functions, members of the organization, forms in which they proceed, its organization and common expenses of its committees and other bodies, are included (Convention of the World Intellectual Property Organization WIPO, 1980).

Costa Rica has also been part of the Paris Convention for Industrial Protection since 1995 and, given that Costa Rica is a member of WIPO and the World Trade Organization (WTO), it is involved in the Agreement on aspects of Intellectual Property rights related to Trade (TRIPS), which seeks cooperation between these two organizations. Because of this, a Special Commission of the Legislative Assembly was assigned for the study and approval of bills related to intellectual property; the Law on Undisclosed Information, the Law on Trademarks and Other Distinctive Signs, the Law

on Procedures for the Enforcement of Intellectual Property Rights, and the Law on Copyright and Related Rights, were amended. Also, Costa Rica became part of the Protocol to the Central American Convention for the Protection of Industrial Property.

Law No. 6867, in addition to showing basic concepts to favor the understanding by applicants, also establishes details the publication periods and validity of the registries, but also clarifies those aspects under which all inventions submitted to the registry will be considered or not, and what the formal and substantive examinations consist of to count as a valid application and that way continue to the next steps (Patents Invention, Industrial Designs and Models Utility, 1983).

Patentable inventions according to Law No. 6867

An invention is a creation from the human intellect that meets three fundamental conditions: novelty, inventive level and industrial application. The first indicates that the invention must not exist at all in the worldwide state of the art, meaning any information made public by any written means. The second implies that the invention is not an obvious extrapolation of the state of the art for a person within the technical field. The third refers to the invention's utility, which must be substantial.

There are specific exclusions to the patentability such as:

- Inventions that threaten public order, health and morals, and the lives of people, animals, the protection of plant organisms and the environment.
- Diagnostic, therapeutic or surgical methods for the treatment of people or animals, since their patenting is considered to threaten life or health and a limitation to fundamental rights. Nonetheless, active components or others needed for manufacture can be patented.
- Plants, animals or any organism from nature, as well as essentially biological processes, other than non-biological or microbiological processes.
- Second uses for products.

Some patentable inventions have to follow additional guidelines:

- A sample from modified microorganisms must be deposited in the institutions authorized in accordance with the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, installed in 1980. Costa Rica is not one of the countries that has an authorized center for the deposit of microorganisms, therefore to protect an invention of this type, you must go to one of the Member States that has a center that can receive the sample, such as Mexico, Chile, the United States, Germany, South Korea, Spain, France, among others (WIPO, 2016). Afterwards, the receipt must be submitted to the Journal Office of the Intellectual Property Registry
- Plants that were modified are understood as inventions: However, they go through a different procedure, since they're regulated by the Union for the Protection of Plant Varieties.

With respect to the patent applications regarding biotechnology in Costa Rica, these present another particular characteristic, as stated in the article 80 of the Costa Rican Biodiversity Law:

“Both the National Seed Office and the Registries of Intellectual Property and Industrial Property, must obligatorily consult the Technical Office of the Commission, before granting intellectual or industrial property protection to innovations that involve elements of biodiversity. They will always provide the certificate of origin issued by the Technical Office of the Commission and the prior consent. The founded opposition of the Technical Office will prevent the registration of the patent or protection of the innovation.”

This “Commission” is the National Commission for Biodiversity Management (CONAGEBio) and hence must be consulted prior to the granting of a patent, otherwise the process could be reversed or retracted.

Patent application procedure

1. Complete the Patent Technical Document

According to Fascicle 6 of Intellectual Property of Technology and Innovation Support Center, from the National Registry (2013), this document must be presented before going to the Office of the Journal of the Intellectual Property Registry, and it includes:

a. **Title:** This must be short and that allows the specific identification of the subject of the invention and its character (product, procedure or a mixture of both); avoiding containing proper names, trademarks or fancy names.

b. **Description:** it must contain:

Field of the invention: locates the area of technology to be evaluated, by and indicates the technological sector (s) in which the invention will apply; This could be pharmaceutical, agricultural, design, chemical, biotechnological, among others.

Object of the invention: it is an extended version (one or two paragraphs) of what is shown in the title, and in this the object of the invention. It makes reference to the application, contribution, solution given to a problem or technical improvement, of the product or innovative procedure to be patented.

Background: they do not refer to what is to be protected, but rather allow the examiner to better understand the invention, showing close antecedents to the invention; what already exists, is known or is considered in the public domain, until the date of the request. It includes the state of the art of the product to be protected and of those that are similar, as well as the restrictions. In this section, known limitations or restrictions can be pointed out and a solution proposed for those that do not have one.

Brief description of the invention: this summarizes the content of the invention to highlight the technical problem raised and the proposed solution, showing the advantages over the state of the art.

Detailed description of the invention: it must be simple and as complete as possible so that a person with a medium level knowledge of the subject can understand it. It must have a small statement of the technical problem

to be solved and its corresponding solution in which the invention and its advantages are defended with respect to the state of the art, the novelties on which the invention is based must be specifically described, the characteristics of the invention must answer the questions what does it do? and how does it work? making use of drawings and marking the parts that make up the invention with numbers. The data must be provided in a general and specific way so that an average person skilled in the art can reproduce the invention and the industrial application corresponding to the object to be protected must also be included.

Examples: at least one example (if there are more, they must be numbered) must be presented. It can be about the realization of the invention, experimental data, formulas, tables, among others.

Mode of carrying out the invention: the realization of the invention can be described with figures that explain how the product or process works, clearly and sufficiently; important aspects in the background examination.

Brief description of the figures: this section can be included to explain the shape drawings.

- c. **Claims:** In this section, what is not included will not be protected, since they expose the technical characteristics that are to be protected with the patent and should include everything that is essential in the invention and makes it different from the state of the art. It consists of three parts:
- **Preamble:** also called introduction and it indicates the object of the invention and its characteristics.
 - **Expression of transition:** it is the union of the preamble and body of the claim.
 - **Body:** contains the technical characteristics to be protected.
- d. **Summary:** in no more than 200 words, the invention must be clearly described and without mentioning any patentable aspect of the invention that was not included in the description. It must answer affirmatively to the question: does this summary include all the information that is in the

description?, and if the answer is negative, the inventor will have to add the necessary material to the description or modify the summary.

- e. **Drawings:** It must be a clear image, of good quality, delimited and numbered with arabic numerals, without containing text, unless it is a strictly necessary isolated word.

2. Presentation of the application: once the Technical Document is completed, the procedure is carried out in the Intellectual Property Registry, presenting the Form Requirements that contemplate the following documents:

- The Form RPI-10, available on the website of the National Property Registry. It must include: stamp of the Bar Association, National Archive Stamp, signature authentication and proof of payment of the patent fee.
- Technical Patent Document, in the language of the country in which the patent will be made.
- A document proving ownership

3. Application publication: if the Form Requirements are approved, the applicant is given a notice for publication as indicated in Article 7 of Law 6867, and at the same time it must be published three consecutive times in the official newspaper *La Gaceta* and then once in a national newspaper. This procedure is carried out in order to give a citizen the opportunity to express his opposition against the approval of the patent.

4. Oppositions: when the application is published, a waiting period is opened (3 months from the third publication in the official newspaper *La Gaceta*) for oppositions, where anyone who considers that the application should not be approved, could have an opinion because it does not meet any of the requirements.

5. Background examination: if there is no opposition after the three-month period for objections, the request is passed to the examiners, who according to Vargas (2010), the examiners are in charge of determining whether or not the object to be patented meets the requirements within the Law and if the claims contain matter that cannot be protected within the laws of the country.

- 6. Grant or denial:** if the technical report in the background examination is approved by the examiner, the Patent Office will be in charge of drawing up a resolution granting a patent number, a registration notice and a certificate. If the examination is negative, either for some or all of the claims, the applicant will be given one month to make the necessary corrections and they will be returned again to the examiner who will approve or deny the application.

It is important to note that the validity of the patent is equivalent to 20 years from the date of application's presentation at the Industrial Property Registry or from the date of the international request presentation if they are patents processed within the Patent Cooperation Treaty. It must be exploited in a permanent and stable manner within a period of three years from the granting of the patent or four years from the patent application, without discontinuing commercial use for more than one year, otherwise anyone could take the patent from the owner by concession (Patents Invention, Industrial Designs and Models Utility, 1983, Articles 17,18).

Official Site for Intellectual Property Information in Costa Rica

http://www.registronacional.go.cr/propiedad_industrial/index.htm

Basic concepts and information summary

http://www.registronacional.go.cr/propiedad_industrial/Documentos/Conceptos%20Basicos%20Patentes,%20Modelos%20de%20Utilidad%20y%20Disenos%20Industriales.pdf

References

Legislative Assembly of the Republic of Costa Rica. (1980). Law N° 6468. Convention of the World Intellectual Property Organization WIPO. September 18, 1980. http://www.pgrweb.go.cr/scij/Busqueda/Normativa/Normas/nrm_texto_completo.aspx?param1=NRTC&nValor1=1&nValor2=5379&nValor3=5703&strTipM=TC

Legislative Assembly of the Republic of Costa Rica. (1983). Law N° 6867. Patents Invention, Industrial Designs and Models Utility. April 25, 1983. http://www.pgrweb.go.cr/scij/Busqueda/Normativa/Normas/nrm_texto_compl

eto.aspx?param1=NRTC&nValor1=1&nValor2=8148&nValor3=74713&strTip
M=TC

National Registry. (November 11, 2013). Patents of invention, utility models and industrial designs. Industrial property (6). National Registry of the Republic of Costa Rica, Costa Rica.
https://www.wipo.int/members/en/details.jsp?country_id=40

Vargas, J. (2010). Diagnosis of Experts' Criteria for Examining Pharmaceutical Patents and Comparison with Guidelines from Patent Offices of Other Countries. Proposal for a Unified Guide to Conduct this Evaluation. (Master's Thesis). State Distance University, Costa Rica.
<http://repositorio.uned.ac.cr/reuned/bitstream/120809/1021/1/Diagnostico%20del%20criterio%20de%20los%20peritos%20.pdf>

World Intellectual Property Organization, WIPO. (2016). Regulation of the Patent Cooperation Treaty.