

# PATENT LAW OF GEORGIA

## CHAPTER I

### GENERAL PROVISIONS

**ARTICLE 1. Scope of Regulation** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (The Legislative Herald of Georgia I, 24.05.2010 N27))*

This Law regulates relations in connection with the creation, use and legal protection of inventions and utility models.

**ARTICLE 2. Definition of Terms** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. Terms used in this Law shall have following meaning:

a) Legal Entity of Public Law - National Intellectual Property Center of Georgia “Sakpatenti” – an independent body functioning in the field of intellectual property protection (hereinafter -Sakpatenti); *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

b) International Bureau - International Bureau of the World Intellectual Property Organization;

c) Paris Convention - the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883 (as revised at Stockholm on July 14, 1967, and as amended on September 28, 1979);

d) Patent Cooperation Treaty (PCT) - multilateral international treaty, signed on June 19, 1970 (as revised on September 28, 1979, and as amended on February 3, 1984);

e) Repealed *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

e<sup>1</sup>) Inventor – a natural person as a result of whose creative intellectual efforts an invention was created *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

f) Patent – the document granted in the name of the patent owner in accordance with this Law, certifying the exclusive rights of the patent owner for the moment of its granting. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

g) Repealed *(4.05.2010. N3031 shall enter into force after 1 month from the publication, LHG I, 24.05.2010 N27))*

h) Applicant – a natural person or legal entity applying for a patent; *(4.05.2010. N3031 shall enter into force after 1 month from the publication, LHG I, 24.05.2010 N27))*

i) Application – the package of documents, necessary for granting of a patent under this Law; *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

j) International application – an application drafted and filed under the Patent Cooperation Treaty;

k) Repealed; *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

l) Priority - the privilege enjoyed by an application as compared with an application filed later; *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

m) Convention priority - the priority established under Article 4 of the Paris Convention which the applicant can exercise in another member state of the Paris Convention or the World Trade Organization; *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

n) Exhibition priority – the priority established under Article 11 of the Paris Convention which the applicant can exercise in another member state of the Paris Convention or the World Trade Organization; *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

o) Repealed; (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

p) Depository –an authorized organization that stores biological reproducible material.

q) Pharmaceutical product - for purposes of this Law, any patentable product or any product obtained as a result of patentable method(s), intended for treatment or prevention of human or animal diseases, and that could be prescribed to human or animal for medical diagnosis and recovery, correction or modification of physiological function. Pharmaceutical product shall also cover the active ingredient required for manufacturing of the above-mentioned product and the diagnostic means which is required for the use of the above-mentioned product; (23.12.2017. N1918)

r) Plant protection products - For the purposes of this Law, chemical or biological agents that are used against plant diseases and their carriers, pests and weeds, diseases and pests of stored agricultural products, rodents and animal parasites, as well as for plant growth regulation, removal of leaves of plants before harvesting (defoliant) and drying of plants (desiccants), disinfection of storehouses, warehouses, vehicles, greenhouses, soil, plant and other products subject to phytosanitary control;

s) Supplementary protection certificate – a document issued by Sakpatenti, which extends the term of patent validity for the pharmaceutical and plant protection products which require the consent/registration of the competent authority to be put on the Georgian market; (23.12.2017. N1918)

t) Competent authority – according to the legislation of Georgia, a body authorized to register plant protection products for authorization to place them on the Georgian market or a body authorized to issue authorization to place a pharmaceutical product on the Georgian market; (23.12.2017. N1918)

u) Bulletin – Official Bulletin of Industrial Property, published by Sakpatenti. (23.12.2017. N1918)

**ARTICLE 3.** Repealed (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 4.** Repealed (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 5. Term of Validity of a Patent for an Invention** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. The term of validity of a patent for an invention shall be 20 years from the date of filing an application with Sakpatenti. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

2. Repealed; (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

3. Repealed; (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

4. Repealed; (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

5. For a patent of an invention related to a pharmaceutical and plant protection product which requires the consent/registration of the competent authority in order to be placed on the Georgian market, by request of the patent owner, a supplementary protection certificate can be issued. (23.12.2017. N1918)

6. A supplementary protection certificate shall extend the patent validity for an additional term, which is equal to the period from filing the application with Sakpatenti to the receipt of the consent of the competent authority, reduced by a period of 5 years. (23.12.2017. N1918)

7. The additional term indicated in Paragraph 6 of this Article shall not exceed 5 years. (23.12.2017. N1918)

8. The request for obtaining a supplementary protection certificate shall be submitted by the patent owner within 6 months from the date of receipt of the consent of the competent authority. If the consent of the competent authority was issued/registration occurred before granting the patent, then the patent owner shall submit the request within 6 months from the granting of the patent. (23.12.2017. N1918)

9. Regarding the request for obtaining a supplementary protection certificate, within one month Sakpatenti shall take a decision on issuing a supplementary protection certificate or on refusal to issue a supplementary protection certificate. (23.12.2017. N1918)

10. In case of taking a decision on issuing a supplementary protection certificate, Sakpatenti shall register the supplementary protection in Register of Industrial Property and shall publish information concerning this in the Bulletin. (23.12.2017. N1918)

11. For the pharmaceutical product for which pediatric studies have been carried out and where the results of these studies are indicated in the information on the product, the additional term specified in Paragraph 6 of this Article may be extended for additional 6 months. (23.12.2017. N1918)

12. The procedures of issuing of supplementary protection certificate are determined by the relevant Instruction approved by Sakpatenti. (23.12.2017. N1918)

**ARTICLE 6. Scope of Protection** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. The scope of the legal protection of an invention shall be determined by the claims.

2. Repealed - (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

3. Repealed - (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 7. Invention Secrecy** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. With respect to an invention which is kept secret by a competent authority for the purposes of state defense, Sakpatenti shall grant a patent only after its declassification, on the basis of a decision of this competent authority (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

2. An invention can be kept secret for no longer than 2 years, which can be extended several times, for a term determined by this paragraph (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

3. Repealed (4.05.2010. N3031 shall enter into force after 1 month from the publication)

4. In case of keeping an invention secret, an appropriate compensation shall be paid to the inventor, the amount and the rule of granting of which shall be determined by a normative act enacted by a competent authority. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

## **CHAPTER II**

### **SAKPATENTI**

**ARTICLE 8. Sakpatenti** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. The functions and competences of Sakpatenti shall be defined by its Statute, approved by the Government of Georgia.

2. Sakpatenti is headed by a Chairman, who is appointed and dismissed by the Prime Minister of Georgia. *(20.09.2013. N 1257 shall enter into force after taking the oath by the President of Georgia, elected as a result of the Presidential Elections of October 2013.)*

3. The Chairman of Sakpatenti shall be appointed for a term of 4 years.

4. Article 11 of the Law of Georgia on “Legal Entity of Public Law” shall not apply to Sakpatenti.

5. Sakpatenti is accountable before the Prime Minister of Georgia.

**Article 8<sup>1</sup>. Authority to Issue By-laws** *(26.10.2010 №3741)*

1. The Chairman of Sakpatenti is authorized within his/her competence to issue by-laws.

2. A by-law of the Chairman of Sakpatenti is an order of the Chairman of Sakpatenti.

3. The Chairman of Sakpatenti issues by-laws according to the Law of Georgia “On By-laws”.

**ARTICLE 9. Chamber of Appeals** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. The Chamber of Appeals is established at Sakpatenti, which hears related with decisions of Sakpatenti on intellectual property subject-matters as well as criteria of their protection, grant of a patent and registration of other subject-matters of industrial property.

2. The functions and competences of the Chamber of Appeals are defined by its Statute, approved by the Chairman of Sakpatenti.

**ARTICLE 10. Repealed** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

**ARTICLE 11. Budget of Sakpatenti** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. Sakpatenti shall be funded from:

a) the income received from the service related to the main activities of Sakpatenti;

b) the income received from the work carried out on the basis of a contract;

c) other income permitted by legislation of Georgia, including the income received from the State Budget of Georgia.

2. Fees for the service determined by paragraph 1(a) of this Article shall be approved by the Government of Georgia.

3. Fees and other income shall be transferred to the account of Sakpatenti, managed exclusively by Sakpatenti. The funds unspent by Sakpatenti during a year shall be transferred to the budget of the following year.

4. By December 1 of every year, Sakpatenti shall prepare the budget for the next year, reflecting total expenses of Sakpatenti and sources for their payment.

5. In extraordinary cases, funds unspent by Sakpatenti during a year may be transferred to the state budget upon the instruction of the Prime Minister of Georgia.

6. The budget of Sakpatenti shall be approved by the Chairman of Sakpatenti, by agreement with the Prime Minister of Georgia.

7. Sakpatenti shall be entitled to purchase and dispose of property independently, except real estate. Sakpatenti shall purchase and dispose of real estate by agreement with the Prime Minister of Georgia.

### **CHAPTER III**

### **PATENTABILITY**

**ARTICLE 12. Criteria of Patentability of an Invention** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))



1. An invention is patentable if it satisfies the criteria of patentability - novelty, inventive step and industrial applicability. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

2. An invention has novelty if it is not known from the existing state of the art. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

3. An invention involves an inventive step if by the priority date it is not obvious from the state of the art. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

4. An invention has industrial applicability if it is possible to produce it or to use it in industry or agriculture. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

5. The state of the art shall be defined by all the data which before the priority date have become available to the public in writing, by a verbal description, public use or other source. *(4.05.2010. N3031 shall enter into force after a month from its publication, (24.05.2010 N27) (2.07.2010 № 3278)*

6. In the course of determining novelty, to the state of the art, in addition to the criteria defined in Paragraph 5 of this Article shall be assigned all patent applications for inventions and utility models, filed with Sakpatenti, if they have an earlier priority as compared to an application the novelty of is being determined, and such applications were published after the priority date of the application. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))(2.07.2010 N 3278)*

7. In the course of determination of an inventive step, to the state of the art shall not be assigned the data indicated in applications for invention and utility models, filed with Sakpatenti, which are not available to the public. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))(2.07.2010 N 3278)*

8. Repealed (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))(2.07.2010 N 3278)

**ARTICLE 13. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 14. Repealed** ((4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 15. Disclosure of Information** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

Data assigned to the state of the art shall not influence the patentability of the subject-matter if they became available to the public within 12 months from the date of filing the application for an invention or the priority date: (2.07.2010 N 3278)

- a) by the action of the inventor or his/her successor;
- b) if the information on the invention is disclosed for the third party, directly or indirectly, provided that confidentiality is maintained;
- c) as a result of an action carried out in bad faith by a third person with respect to the inventor or his/her successor;

**ARTICLE 16. Subject-Matters Not Regarded as Inventions** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. The following shall not be regarded as an invention:
  - a) a discovery, scientific theory, mathematical method;
  - b) an artistic creation;
  - c) an algorithm, computer program;
  - d) an educational or teaching method and system, grammatical system of a language, method for performance of mental operations, rules for a game or gambling;
  - e) a method of business and organizational management;
  - f) a planning design and scheme of a construction, building, territory;

g) presentation of information.

2. Subject-matters provided for under Paragraph 1 of this Article shall not be considered patentable only in the case when these subject-matters directly represent the subject of an application.

**ARTICLE 17. Patent Ineligible Subject-Matters** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

A patent shall not be granted for:

a) an invention which is contrary to the public order *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

b) Inventions related to surgical, therapeutic and diagnostic methods of treatment of humans and animals. This shall not apply to devices and substances used in such methods. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

c) Inventions related to plant varieties and animal breeds, as well as primarily biological methods for breeding of plant varieties and animal breeds. This rule shall not apply to micro-biological methods and products obtained through such methods. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

d) Repealed *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

e) Repealed *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

## **CHAPTER IV**

### **INVENTOR AND PATENT OWNER**

*(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

**ARTICLE 18. Inventor** *((4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. Repealed (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

2. Repealed (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

3. Upon the request of an inventor, Sakpatenti shall not publish his/her name. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

4. If an invention was created by the effort of several persons, each of them shall be regarded as a co-inventor. ((4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

5. Relations between co-inventors are defined by a contract concluded between them. In case of absence of a contract, each of co-inventors enjoys common equal rights. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 19. Right to Obtain a Patent** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An inventor or his/her successor has the right to obtain a patent.

2. An application for an invention created by several persons can be filed by all co-inventors jointly, or each co-inventor with the written consent of other co-inventors, unless otherwise provided by the contract concluded between them.

3. If one and the same invention was independently created by two or more persons, the inventor whose application has an earlier priority has the right to obtain a patent.

4. If applications under Paragraph 3 of this Article were established to have the same priority, a patent is granted to the person(s) noted in the agreement of the applicants. In case of disagreement between the parties, the dispute shall be settled by the court.

5. An employer or contractor has the right to acquire a patent for an invention created by staff member and/or a hired employee in the course of fulfilling the official or contract duty, unless otherwise provided by the contract.

6. Where creation of an invention is not related to fulfilling the official or contract duty of a staff member or a hired employee, but for the creation of an invention the staff member/hired employee has made use of the resources owned by the employer or contractor, the employer/contractor has the preemptive right to acquire a patent, whereas the staff member/hired employee has the right to acquire free of charge a non-exclusive private license on such an invention or to acquire exclusive rights deriving from the patent, unless otherwise provided by the contract.

**ARTICLE 20. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 21. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 22. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

## **CHAPTER V**

### **FILING AN APPLICATION**

**ARTICLE 23. Filing an Application** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An application shall be filed with Sakpatenti by an applicant or her/his representative (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

2. Repealed (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

3. Repealed (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

4. Repealed (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

5. An application shall be filed with Sakpatenti by submitting application documents directly or otherwise.

6. A representative may also be a patent attorney registered in Sakpatenti. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

7. The registration rules and qualification requirements of patent attorneys are defined by the Statute, approved by the Chairman of Sakpatenti (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

8. The form of an application and procedures for filing an application are defined by the Instruction on Procedures Related with Drafting and Filing Applications for Inventions and Utility Models and Granting a Patent (hereinafter - Instruction). (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 24. Application** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An application shall include:

a) a request for granting a patent;

b) the description of an invention;

c) claims;

d) drawings and other documents, if they are necessary to explain the essence of an invention;

e) the abstract of an invention, which is only of informative nature.

2. If an application is filed by the applicant's representative, a document certifying the representation authority shall be attached to the application at the time of filing or within 2 months from the filing date.

3. If the applicant is the inventor's successor, a document certifying the successor's status shall be attached to the application at the time of filing or within 2 months from the filing date.

4. An application shall be filed in the state language of Georgia, and other application documents - in any language.

5. In case of filing the application documents in a foreign language, the applicant shall provide the Georgian translation within 2 months from the application filing date. Otherwise, the application materials submitted in a foreign language shall not be considered filed.

**ARTICLE 25. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 26. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 27. Application Filing Date** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27)) An application shall be considered filed from the moment when a request for granting a patent, the description of an invention, claims and drawings of the invention, if they are noted in the description of the invention, are submitted..

**ARTICLE 28. Unity of an Invention** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An invention shall meet the requirement of the unity of an invention, namely, an application shall contain a single invention or a group of inventions united by a single inventive idea. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

2. Repealed (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 29. Unification and Division of Applications** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An applicant is entitled:

a) to divide the filed application into separate parts and file a divisional application;

b) to unify applications and file a unified application.

2. A divisional application separated according to Paragraph 1(a) of this Article shall retain the date of filing of the initial application with Sakpatenti and the priority.

3. An application unified under Paragraph 1(b) of this Article shall retain the priority of each application.

4. A divisional or unified application can be filed before Sakpatenti takes a decision on granting a patent

**ARTICLE 30. Priority** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An applicant wishing to benefit from the convention priority shall file an application with Sakpatenti within 12 months from the date of filing of an earlier application for this invention in a contracting state of the Paris Convention or a member state of the World Trade Organization. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

2. An applicant wishing to benefit from the exhibition priority shall file an application with Sakpatenti within 6 months from the date of exposition of the invention at an official/officially recognized exhibition held in a contracting state of the Paris Convention or a member state of the World Trade Organization. The exhibition and convention priorities shall not be cumulative. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))



3. In cases where an applicant, for excusable reasons, fails to file an application with Sakpatenti within the time limits under Paragraph 1 and 2 of this Article claiming the convention or exhibition priority, he/she may file an application within the following 2 months. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

4. An applicant wishing to benefit from the convention or exhibition priority shall:

a) indicate such an intention at the time of filing an application with Sakpatenti or within 4 months from the filing date, but no later than 16 months from the date of the claimed priority; *(2.07.2010 N 3278)*

b) submit to Sakpatenti a document certifying the right to claim the relevant priority within 3 months from the date of claiming the convention or exhibition priority. *((4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

5. Priority may be established:

a) Repealed *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

b) by the date of filing an earlier application with Sakpatenti by the same applicant, disclosing the essence of an invention, provided that the application on the basis of which such a priority is sought was filed within 12 months from the filing date of earlier application for an invention. The applicant shall indicate the intention on claiming the priority at the moment of filing the application with Sakpatenti or within 4 months from the application filing, but no later than 16 months from the date of the claimed priority. Hereby, the application whose priority was sought shall be considered withdrawn; *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

c) on the basis of several applications filed earlier, where each of these conforms with the conditions set in Sub-paragraph (b) of this Paragraph *((4.05.2010.*

*N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

6. The priority for the application shall not be established by the filing date of an application for which an earlier priority has already been claimed. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

**ARTICLE 31. Repealed** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

## **CHAPTER VI**

### **PATENT EXAMINATION AND GRANTING OF A PATENT**

**ARTICLE 32. Examination of an Application** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. Sakpatenti shall conduct patent examination of an application, on the basis of which it shall take a decision about granting a patent.

2. Patent examination comprises confirmation of application filing date, conducting examination as to form and substantive examination.

3. During examination, Sakpatenti is authorized to request from the applicant to amend or correct the application or to submit an explanation without which it is impossible to continue examination of the application and publication of the application materials. The applicant shall comply with the request within 2 months from the date of receiving the notification. Where the applicant fails to comply with the request, Sakpatenti shall take a decision to terminate the proceedings on the application.

**ARTICLE 33. Confirmation of the Application Filing Date** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. Sakpatenti shall confirm the filing date of an application within 2 weeks from its filing.

2. Where an application is found to be lacking any of application materials required by Article 27 of this Law, the applicant shall provide such materials within 1 month from the date of receiving the notification.

3. Where an applicant complies with the requirements of Paragraph 2 of this Article, the date of compliance shall be considered as the application filing date. In case of the failure to comply, the application shall not be considered filed.

4. Where the description of an invention refers to drawings that are not attached to the application, the applicant shall submit such drawings within the term provided by Paragraph 2 of this Article. Where the drawings are submitted in time, the date of receipt of such drawings shall be considered as the application filing date. In case of the failure to comply with the term, the date of receiving the application without the drawings shall be considered as the application filing date, while any reference to the drawings shall be considered omitted.

**ARTICLE 34. Examination as to Form** *((4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. Within 2 weeks from the confirmation of an application filing date, Sakpatenti conducts examination as to form during which the integrity of the application and correctness of its drawing up shall be checked.

2. If an application meets the formal requirements, Sakpatenti shall take a decision on the completion of the examination as to form.

**ARTICLE 35. Substantive Examination** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. Within 6 months from the completion of the examination as to form Sakpatenti shall conduct substantive examination in order to determine the subject-matter of protection described in the application and the state of the art. *(4.05.2010.*

*N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1<sup>1</sup>. In the process of determining the subject-matter of protection described in the application, substantive examination shall be conducted to check the claims, the description and the unity of the invention, as well as whether the requirements of Articles 16 and 17 of this Law are violated. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1<sup>2</sup>. In the process of determining the state of the art, Sakpatenti shall conduct search and examination as to novelty. If it is identified that the application meets the requirements of examination as to novelty, Sakpatenti shall take a decision on granting a patent. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1<sup>3</sup>. If an examiner is fully convinced that an invention is obvious from the current state of the art, Sakpatenti, after considering the examiner's proposal, shall take a decision on evaluating the inventive step, on the basis of which Sakpatenti shall take a decision on granting a patent. *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

2. Repealed *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

3. Repealed *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

**ARTICLE 36. Procedure for Taking a Decision on Substantive Examination of an Application** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

In the course of substantive examination of an application, Sakpatenti shall send to the applicant the following:

a) the decision on determining the subject-matter of protection described in the application;

- b) the results of search on state of the art (search report);
- c) the conclusion on the state of the art, taking into account the results of examination as to novelty;
- d) the decision on granting a patent.

**ARTICLE 37. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 38. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 39. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 40. Decision on Granting a Patent and Publication** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. After taking a decision on granting a patent, Sakpatenti shall publish the application data and the abstract of the invention in the Bulletin and shall exhibit the application materials.

2. In case of replacement of a refusal to grant a patent, taken by examination, by a legally enforced positive decision of the court, Sakpatenti shall publish the application data and the abstract of the invention in the Bulletin and shall exhibit the application materials for familiarization within 1 month from the court decision.

**ARTICLE 40<sup>1</sup>. Amending a Granted Patent** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. At the request of the patent owner, it is permitted to amend the description and the claims of the invention of a granted patent, in order to correct accidental mistakes, only where such amendments are obvious from the contents of the documents in question and it is clear that nothing else could be implied.

2. The rule of making amendments pursuant to Paragraph 1 of this Article shall be defined by the Instruction.

**ARTICLE 40<sup>2</sup>. Disclosure of Information** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

Deliberate disclosure of the essence of the application filed with Sakpatenti (except for by the applicant or his/her successor) before Sakpatenti publishes the application data in Bulletin shall entail responsibility under the legislation of Georgia.

**ARTICLE 40<sup>3</sup>. Grounds of Appeal at the Chamber of Appeals**

(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An applicant shall be entitled to file an appeal to the Chamber of Appeals against decisions of Sakpatenti on the completion of the examination as to form or termination of proceedings, as well as a decision of substantive examination on refusal of granting a patent.

2. An interested party shall be entitled to file an appeal to the Chamber of Appeals against a decision of the patent examination, if the requirements of Articles 16 and 17 of this Law were violated or if an invention does not meet the criteria of novelty and inventive step provided for by Paragraph 1<sup>2</sup> and 1<sup>3</sup> of Article 35 of this Law. At the same time, it is inadmissible to file an appeal to the Chamber of Appeals against a decision of patent examination on the same grounds which is the basis of ongoing court proceedings and/or with respect to which a court decision has been enacted.

3. An interested party shall be entitled to apply to the Chamber of Appeals with the request to assess those criteria of patentability that were not examined by the examiner in the course of patent examination, and on the basis of this to request taking a decision on granting a patent. In assessing the criteria of patentability, the Chamber of Appeal shall take into account only the argumentation presented by the interested party, which are based on relevant documents.

4. An appeal can be filed to the Chamber of Appeals within 3 months from the date of publication/receipt of the respective decision.

5. The Chamber of Appeals shall hear the appeal and take a decision within 3 months from its filing date.

6. A decision of the Chamber of Appeals may be appealed in court term prescribed by law for appealing an administrative-legal act.

**ARTICLE 40<sup>4</sup>. Conflict of Interests** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An application shall not be filed by:

a) a natural person employed by Sakpatenti currently or in the period of 12 months prior to filing an application;

b) a legal entity in which a person envisaged by Sub-paragraph (a) of this paragraph is a member, partner, stockholder or head.

2. A person directly involved in taking a decision on the appealed decision shall not be a member of the Chamber of Appeals in the course of hearing a legal dispute related to granting of a patent.

3. A patent attorney shall not be a person who is employed by Sakpatenti on the position of an examiner currently or in the period of 12 months preceding the date of registration as a patent attorney or who is a first-kin relative of a Sakpatenti examiner.

**ARTICLE 41. Granting a Patent** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. Sakpatenti shall register a patent in the Industrial Property Register (hereinafter - the Register) and issue a patent certificate, if: (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

a) no appeal is filed to the Chamber of Appeals within the term provided for by Paragraph 4 of Article 40<sup>3</sup> of this Law;

b) the Chamber of Appeals takes a decision to grant a patent on the basis of an appeal filed under Article 40<sup>3</sup> of this Law;

c) the court takes a decision to grant a patent.

2. Sakpatenti shall define the form of a patent certificate and the data to be entered in the Register. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

3. Any person has the right to familiarize with the Register data. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

4. Repealed 4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 42. Decision on Refusing to Grant a Patent** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. Sakpatenti shall take a decision to refuse granting of a patent where:

a) an application is related to a subject-matter that is not regarded as an invention under Article 16 of this Law;

b) an application is related to a subject-matter that is not regarded as an invention under Article 17 of this Law;

c) an invention does not comply with the criteria of novelty;

d) in the case under Paragraph 1<sup>3</sup> of Article 35 of this Law, an invention does not meet the criteria of an inventive step;

e) an application does not meet the requirements provided by Paragraph 6 of Article 23 of this Law;

f) an application according to the description and claims of the invention does not allow determining the subject-matter of protection pursuant to Paragraph 1<sub>1</sub> of Article 35 of this Law.

2. Where the refusal to grant a patent relates only to a part of an application, corresponding claims shall be considered removed.

**ARTICLE 42<sup>1</sup>. Re-Examination of an Invention** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))



1. An interested party is entitled to request re-examination of an invention within the term of the patent validity on the grounds that the invention does not meet the patentability criteria.

2. An application for re-examination shall be accompanied by:

a) a written argumentation an invention does not meet the patentability criteria;

b) copies of all earlier granted patents or publications on which the interested party relied for argumentation. In addition, if the documents required by this subparagraph are presented in a foreign language, the interested party shall provide their Georgian translation within 1 month. Otherwise, the documents in a foreign language shall not be considered submitted.

3. Within 2 weeks from the date of filing an application for re-examination of an invention, the patent owner is entitled to make a written objection that will be taken into account during re-examination.

4. On the basis of re-examination, Sakpatenti shall take a decision to refuse invalidation of the patent or to invalidate the patent completely or partially

5. The data on the complete or partial invalidation of a patent shall be published in the Bulletin and recorded into the Register.

6. The rule for re-examination of an invention shall be determined by the Instruction.

**ARTICLE 43. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 44. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 45. Withdrawal of an Application** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

An applicant is entitled to withdraw the application before its publication.

**ARTICLE 46. Extension of the Procedural Timeframes and Reinstatement**

*(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. An applicant is entitled during the application proceedings to request in accordance with the applicable rule:

a) to suspend consideration of the application;

b) to make amendments to the submitted application materials, provided that such amendments are not beyond the essence of the invention;

c) to extend the timeframe for submission of a reply to the requirement of Sakpatenti;

d) to reinstate the rights related to the application forfeited due to the failure to meet the deadline.

2. The rule of implementation of the actions under Paragraph 1 of this Article shall be determined by the Instruction.

**ARTICLE 47. Service Fee** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. A fee shall be paid for examination of an application as to form, patent examination, publication and registration, patent renewal annually, appeal, making amendments to the Register data and other acts.

(1. A fee shall be paid for examination of an application as to form, patent examination, application publication, patent registration, patent renewal annually, proceedings to issue a supplementary protection certificate, registration of a supplementary protection certificate, publication, annual renewal of a supplementary protection certificate, hearing an appeal, making an amendment to the Register data and other acts.,(23.12.2017. N1918 shall enter into force on June 1, 2018))

2. Non-payment of the prescribed fee determined by Paragraph 1 of this Article within the time limit shall entail termination of the application proceedings.

3. The form and amount of the fee shall be determined by the resolution of the Government of Georgia.

4. The form and rule of payment of the fee shall be determined by the Instruction.

## **CHAPTER VII**

**SCOPE OF USE OF EXCLUSIVE RIGHTS DERIVING FROM A PATENT** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

**ARTICLE 48. Scope of Exclusive Rights** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. A patent owner shall exploit the invention at his/her discretion. He/she is entitled to sell or alienate the invention otherwise, issue a private license for the use of the patent in accordance with the applicable rule and/or put the patent in pledge.

2. A patent vests its holder with the exclusive right to prevent others, without the owner' permission, from:

a) producing, selling, offering for sale, using, importing or using otherwise in the course of trade a product protected by the patent;

b) using or offering for sale of a patented method;

c) selling, offering for sale, using, importing or using otherwise in the course of trade of a product directly made by a patented method.

3. If the exclusive right of a patent owner applies to a patent the subject of which is a method for producing a new product, until proven otherwise, any other similar product made by another person shall be deemed produced by this method.

4. Where patent is held by several persons:

a) the transfer of the patent right, issuing a private license for the use of the patent or putting the patent in pledge shall be admissible only with the consent of all owners;

b) each patent owner is entitled to use the patented subject-matter in his/her own production without consent of the other patent owners.

5. The limitations of the exclusive rights provided for by Paragraph 2 of this Article shall be defined by Articles 52 and 52<sup>1</sup> of this Law. (23.12.2017. N1918)

**ARTICLE 49. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 50. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 51. Conventional Rights** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

From the date of publication of the application until the grant of a patent, the applicant shall be conventionally granted the same rights which would have been granted to him/her by the patent. If a patent is not granted, these rights shall not be deemed originated.

**ARTICLE 52. Restriction of Exclusive Rights** (23.12.2017. N1918)

The following shall not be considered an infringement of exclusive rights:

a) further dissemination or other use of the product produced by the patent owner or under his/her permission, after putting it on the market;

b) private use of invention for personal ends, unless such action is intended for economic activity;

c) use of invention on board a foreign sea vessel, aircraft or land vehicle during its temporary presence on the territory of Georgia. In such cases, the invention shall be used only on board such a vehicle and not for entrepreneurial purposes;

d) use of the invention for experimental or research purposes;

e) conducting research and other procedures necessary for obtaining consent to put on the market the pharmaceutical products, protected by a patent, unless this pharmaceutical product is used for entrepreneurial purposes until the expiration of the patent validity term.

**52<sup>1</sup>. Compulsory License** (23.12.2017. N1918 shall enter into force from September 1, 2018)

1. Without the consent of the patent owner, a compulsory license for use of a patented invention and/or utility model within the territory of Georgia (hereinafter – compulsory license) may be granted.
2. A decision on granting a compulsory license shall be taken by the Standing Council for Taking a Decision on Granting a Compulsory License, functioning at the Ministry of Economy and Sustainable Development of Georgia (hereinafter – Standing Council). Its structure shall be defined by the Resolution of the Government of Georgia.
3. The rule and conditions on granting a compulsory license shall be defined according to the “Rule of Granting a Compulsory License for the Use of a Patented Invention and Utility Model”, approved by the Resolution of the Government of Georgia.
4. A request for granting a compulsory license shall be submitted by the interested person to the Standing Council.
5. A compulsory license shall not be issued exclusively only to 1 person.
6. The compulsory license shall not be transferred to another person.
7. A compulsory license may be issued in case if:
  - a) it is necessary to use a patent during a natural calamity, catastrophe, epidemics, national defense, defense of public health;

- b) It is impossible to use the patented invention and/or utility model without infringement of the exclusive right of the patent owner or his successor on another earlier patent.
8. In case of Subparagraph “a” of Paragraph 7 of this Article, granting of a compulsory license can be requested by a governmental body, if it substantiates that there are respective ground for this.
9. In the case of Subparagraphs “b” of Paragraph 7 of this Article, the request for granting a compulsory license shall contain substantiation that the invention or utility model is an important technical solution, which essentially depends on the invention or utility model protected by an earlier patent and has substantial economic advantages compared with the invention or utility model protected by the earlier patent.
10. The person to whom the compulsory license is granted on the basis of Subparagraph “b” of Paragraph 7 of this Article, in case of patent protection of the respective invention or utility model, is obliged to grant a private license to the patent owner on whose patent the compulsory license was granted.
11. A compulsory license shall be granted only in the case if the presumable recipient of the compulsory license unsuccessfully tried within a reasonable period of time to obtain permission from the patent owner or his/her successor on reasonable commercial terms.
12. The request indicated in Paragraph 11 of this Article may not be taken into account in the case of emergency, about which the patent owner shall be notified immediately.
13. The limits of use of the object of a compulsory license, the term of validity of a compulsory license, the amount of a relevant compensation of a compulsory license shall be determined by the objective for which the use of

the respective invention and/or utility model was permitted. Such use is permitted above all in order to meet the demand of the market of Georgia.

14. In the case of granting a compulsory license the patent owner shall be given the respective compensation on acceptable commercial conditions.
15. The decision regarding granting a compulsory license shall be subject to periodic revision and it may be annulled if the circumstance which gave rise to the need to grant the license no longer exists.
16. In case the granting a compulsory license, Sakpatenti shall make a relevant entry in the Register and shall publish the data in the Bulletin within 1 month from granting the compulsory license.
17. The decision on granting a compulsory license and on the granting a relevant compensation may be appealed in the court.
18. A compulsory license is not a license envisaged by the Law of Georgia “On Licenses and Permits”.

**ARTICLE 53. Right of Prior Use** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. The right of prior use implies a right of a person to use an invention regardless of the effect of the patent, if such a person has been using the invention in good faith or conducted preparatory works for its use prior to the date of filing the patent application with Sakpatenti or the priority date. *(2.07.2010 N 3278)*

2. The right of prior use allows a third party to exploit an invention for a purpose and to such an extent with which he has already used it or for which he/she has made preparation works, prior to the date of filing the patent application with Sakpatenti or the priority date *(2.07.2010 N 3278)*

3. It shall be impermissible to issue a private license for the right of prior use.

4. The right of prior use can be transferred only together with such an enterprise, where the actions envisaged by Paragraph 2 of this Article were implemented.

**ARTICLE 54. Revocation of a Patent** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. A patent shall be revoked by Sakpatenti:

a) on the basis of the request of the patent owner;

b) in case of Inon-payment of the annual patent renewal fee by the patent owner;

c) on the basis of decision of re-examination of an invention.

2. A patent revoked pursuant to Paragraph 1(b) of this Article may be reinstated if within 6 months from expiration of the term for payment of the annual patent renewal fee, the patent owner pays the patent renewal fee for the next year. Within 6 months from the expiration of the afore-noted term, the revoked patent may be reinstated if the patent owner pays the patent reinstatement renewal fees.

3. In cases where the patent renewal fee for the next year is not paid before the expiry of the term noted in Paragraph 2 of this Article, the patent shall be regarded revoked from the date of expiry of the patent validity term.

4. Information on the patent revocation and reinstatement shall be recorded in the Register.

5. The patent validity shall be regarded reinstated from the date of publishing the information concerning the reinstatement.

**ARTICLE 55. Right of Further Use** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

Any person, who has been using the invention protected by a patent in good faith or conducted preparatory works for its use on the territory of Georgia from the date of the patent invalidation until its reinstatement is entitled to continue its use for



entrepreneurial purposes. Transfer of this right is permitted only together with the enterprise (right of further use).

**ARTICLE 56. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 57. Invalidation of a Patent** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. A patent shall be invalidated by the court if it is ascertained that:

a) the subject of the patent is not patentable;

b) the patent does not describe an invention to the extent that makes its implementation possible;

c) the subject of the patent falls in the category of subject-matters for which a patent shall not be granted under Article 16 of this Law;

d) the subject of the patent falls in the category of subject-matters that cannot be regarded as an invention under Article 17 of this Law;

e) the subject of the patent goes beyond the scope of the contents of the application in respect of which the priority was established, or the patent is granted on the basis of a divisional application and its subject goes beyond the scope of the contents of the first application;

f) the patent owner had no right to hold the patent under Article 19 of this Law.

2. In the case provided for under Paragraph 1(f) of this Article, instead of requesting invalidation of the patent, an interested party may require assignment of the patent to him/her.

3. The information on the invalidation of a patent shall be recorded in the Register and published in the Bulletin.

**ARTICLE 58. Results of a Patent Invalidation** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

As a result of the invalidation of a patent, the rights granted by the patent shall not be regarded as originated.

## CHAPTER VIII

**TRANSFER OF PATENT RIGHTS AND PRIVATE LICENSE ON THE USE OF A PATENT** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 59. Private License on the Use of a Patent** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. A patent owner is entitled to issue a private license for the use of a patent.
2. A private license is not a license envisaged by the Law of Georgia “On Licenses and Permits”.
3. A private license agreement shall be concluded in writing. The license shall define the scope of use of the subject-matter protected by the patent.
4. A private license may be exclusive or non-exclusive. If a private license agreement does not define the type of license, the private license shall be regarded to be non-exclusive.
5. Granting of a non-exclusive private license does not deprive the licensor of the right to issue another license with the equivalent terms.
6. Granting of an exclusive private license deprives the licensor of a right to issue another license with the equivalent terms.
7. A private license holder is entitled to file an appeal to the court concerning the infringement of the rights deriving from the patent, unless the patent owner files an appeal on his/her own accord within the reasonable term after the receipt of the notification on such an infringement.
8. A private license agreement and its amendments may be recorded in the Register.

**ARTICLE 60. OPEN LICENSING** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. A patent owner is entitled to announce an open license status if an exclusive license has not been issued for the patent.

2. An open license can be only non-exclusive.

3. An open license status entitles any person to use the patent pursuant to the conditions established by the open license status.

4. In the case of announcing an open license status, the amount of the fee defined for the registration of a private license agreement shall be halved.

5. About the announcement of the open license status shall be notified to Sakpatenti which shall enter a corresponding record in the Register and publish the data in the Bulletin.

6. A patent owner at any time can apply to Sakpatenti with a request to cancel the open license status. Cancellation of the open license status shall not affect the issued open licenses.

**ARTICLE 60<sup>1</sup>. Transfer of Patent Rights** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An agreement on the transfer of exclusive rights shall be concluded in writing.

2. An agreement on the transfer of exclusive rights and its amendments according to the applicable rule shall be registered in the Register and the data shall be published in the Bulletin.

3. A new owner of the patent shall not use the rights deriving from the patent against third parties until the registration of relevant changes in the Register.

**ARTICLE 61. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 62. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

## **CHAPTER VIII<sup>1</sup>**

**PATENT LEASE<sup>1</sup>** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 62<sup>1</sup>. Patent Lease** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. Unless provided otherwise by this Law, norms established for leasing by Chapter 6, Title 3, Book 2 of the Civil Code of Georgia shall govern patent lease agreements.

**ARTICLE 62<sup>2</sup>. Form and Rule of Concluding a Patent Lease Agreement** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. A patent lease agreement shall be concluded in writing. Failure to comply with the written form of agreement shall render a lease agreement void.

2. A patent cannot be leased simultaneously in favor of several persons.

3. A patent lease agreement shall be registered at Sakpatenti and the data shall be published in the Bulletin.

**ARTICLE 62<sup>3</sup>. Private License on a Leased Patent.** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. Licenses issued by the patent owner prior to the conclusion of a patent lease agreement, pursuant to the rule defined by the Law, shall remain in force.

2. Granting a license on a leased patent shall be admissible only by the prior written consent of the lease holder.

**ARTICLE 62<sup>4</sup>. Alienation of a Leased Patent** *(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))*

1. A lease holder is entitled to alienate the leased patent to satisfy his/her need only after notifying the patent owner in accordance with the rule established by Part 1 of Article 282 of the Civil Code of Georgia.

2. Alienation of a leased patent shall be conducted through an auction.

3. Auctions shall be held in accordance with the rules of Articles 301-309 of the Civil Code of Georgia.

4. The owner of an exclusive license on a leased patent has a priority right to redeem the leased patent prior to the auction.

5. In the course of alienation of a patent by the lease holder, the licenses granted by the patent owner pursuant to the rules set by the Law prior to the conclusion of the lease agreement shall remain in force.

**Article 62<sup>5</sup>. Open License Status of a Leased Patent** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. Upon a request of a lease holder, the court may order an open license status of the leased patent instead of its compulsory alienation by way of an auction.

2. The open licensing status of the leased patent shall be terminated when the creditor is satisfied or it is obvious that the creditor will not be satisfied by such a status.

3. Licenses granted in the course of the open license status of a leased patent shall remain in force after the cancellation of this status.

**CHAPTER IX. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**CHAPTER X Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**CHAPTER XI Patent Dispute** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 68. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 68<sup>1</sup>. Appeal to the Court** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. Infringement of rights derived from a patent shall mean infringement of rights accorded by this Law, entailing responsibility under the legislation of Georgia.

2. Sakpatenti shall not participate as a party in patent disputes concerning infringement of rights derived from a patent.

3. Infringement of exclusive rights may lead to criminal and civil responsibility.

**ARTICLE 68<sup>2</sup>. Statute of Limitation** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

Unless otherwise provided by this Chapter, a claim concerning infringement of rights deriving from a patent can be filed within 3 years from the moment when the infringement of rights became known to the patent owner.

**ARTICLE 68<sup>3</sup>. Repealed** (23.12.2017. N1918)

**ARTICLE 68<sup>4</sup>. Repealed** (23.12.2017. N1918)

**Article 68<sup>5</sup>. Protection of Exclusive Rights Deriving from a Patent**  
(23.12.2017. N1918)

1. In case of infringement of exclusive rights deriving from a patent, the patent holder is entitled to demand:
  - a) prohibition of the acts under Paragraph 2 of Article 48;
  - b) removal from public circulation of goods made in violation of the rights deriving from a patent or confiscation of the product, made in violation of the rights deriving from a patent, imported or stored on the territory of Georgia with the purpose of inclusion in the public circulation;
  - c) destruction of goods made in violation of the rights deriving from a patent.
  - d) destruction of machinery, technical equipment and tools designed for making the goods in violation of the rights deriving from a patent.
2. If according to the court decision it is identified that the exclusive rights deriving from a patent were infringed, upon the request of the patent owner, the actions provided for by Subparagraph “a” of Paragraph 1 of this Article may apply also with respect to a person who was aware or should have been aware that his/her service is or was used in activities infringing exclusive rights on a commercial scale.

3. It is possible to request carrying out the action envisaged under Paragraph 1 of this Article also in case when a product is obtained directly by a method protected by the patent.
4. A product, made in violation of exclusive rights deriving from a patent, which was purchased by a third party in good faith, shall not be subject to seizure, unless it was purchased for receiving profit.
5. On the basis of a request of the infringer of exclusive rights deriving from a patent, in special cases, the court is authorized, instead of actions provided for under Subparagraphs “b”-“d” of Paragraph 1 of this Article, to demand from him payment of a lump sum compensation, if the infringer of rights acted unintentionally, or if execution of the relevant measure would cause him/her disproportionate harm and if, along with this, the amount of pecuniary compensation defined by the court appears satisfactory to the patent owner.
6. In addition to the actions provided for in Paragraph 1 of this Article, in case of infringement of exclusive rights deriving from a patent the holder of exclusive rights deriving from a patent shall be entitled to request any one of the following acts:
  - a) compensation for damages (including lost profits), if the infringer of the exclusive rights was aware or should have been aware of the infringement of exclusive rights deriving from a patent;
  - b) confiscation of the profits gained by the infringer of the exclusive rights in violation of exclusive rights in favour of the holder of exclusive rights;
  - c) payment of a lump sum compensation.
7. When determining the amount of damages, the essence of the infringement of exclusive rights deriving from a patent, profits gained through infringement of exclusive rights, the economic and moral damage caused to the holder of exclusive rights, as well as the expected income that would

have been gained by the holder of exclusive rights as a result of the lawful use of the patent shall be taken into consideration.

8. The compensation shall at least be the amount which would have been due if the infringer of exclusive rights deriving from a patent acquired a license for the use of the patent.
9. When determining the amount of a lump sum compensation, the quantity of the goods made in violation of the rights deriving from a patent, the intention of the infringer of rights deriving from a patent, the scale, character and other features of the service offered in violation of exclusive rights deriving from a patent and/or any other circumstance which may be taken into account in determining the amount of the compensation, shall be taken into consideration.
10. The holder of exclusive rights is entitled to demand simultaneous application of several measures provided for in Paragraph 1 of this Article at his/her discretion.

**ARTICLE 69. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 70. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 71. Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

## **CHAPTER XI<sup>1</sup>**

**UTILITY MODEL** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

**ARTICLE 71<sup>1</sup>. Criteria of Patentability of a Utility Model** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))



1. A utility model, characterized by a lesser inventive step as compared with an invention and by its essence is a minor invention, is patentable if it satisfies the criteria of patentability - novelty, inventive step and industrial applicability.

2. A utility model is novel if it is not known from the existing state of the art.

3. A utility model involves an inventive step if by the date of filing the application or the priority date it is not obvious from the state of the art to the person skilled in the art. (2.07.2010 N 3278)

4. A utility model has industrial applicability if it is possible to produce it or to use it in industry.

5. The term of validity of a patent for utility model shall be 10 years from the date of filing an application with Sakpatenti.

6. Unless otherwise is provided in this Chapter, utility models are governed by the norms of this Law on the creation, examination, use and legal protection of inventions.

7. In the course of substantive examination of a utility model application, Sakpatenti shall send to the applicant only decisions provided by Paragraphs 1(a) and 1(d) of Article 36 of this Law.

8. In determining novelty of a utility model, Sakpatenti shall conduct search only with regard to the application filed with Sakpatenti.

9. The rule for conducting examination of a utility model application shall be defined by the Instruction.

**ARTICLE 71<sup>2</sup>. Relationship between Inventions and Utility Models**  
(4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An applicant can file with Sakpatenti an application for one and the same invention simultaneously for an invention and a utility model.

2. Applications filed in accordance with Paragraph 1 of this Article shall be examined and a decision shall be taken independently of each other.

3. In cases under this Article, granting of a patent for an invention entails revocation of the patent on a utility model. The refusal to grant a patent on the grounds that an invention lacks novelty shall entail the invalidation of the utility model.

4. Before taking a decision on granting a patent, it shall be permissible to transform an application for an invention into utility model application and vice versa.

## **CHAPTER XII**

### **INTERNATIONAL APPLICATION**

**ARTICLE 72. International Application** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. The rules of this Chapter shall apply to international applications filed with Sakpatenti in accordance with the Patent Cooperation Treaty (PCT).

2. Sakpatenti shall process international applications in line with the Patent Cooperation Treaty, this Law and other normative acts.

**ARTICLE 73. Status of an International Application** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An international application indicating Georgia as a place for obtaining a national patent for an invention or utility model shall be equal to the application filed with Sakpatenti, and from the date of filing the international application shall be treated as a national application.

2. An applicant shall be granted the rights provided by Article 51 of this Law if an international application has been published in Sakpatenti in the Georgian language in accordance with Article 40 of this Law.

**ARTICLE 74. Rule of Filing an International Application** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. Sakpatenti shall act as a “receiving office” of international applications of citizens or permanent residents of Georgia.

2. Sakpatenti, in its capacity of a “receiving office” of international applications shall accept international applications filed in the Georgian, English or Russian languages. At the same time, the postage fee for sending to competent international organizations or offices shall be paid within 1 month from the filing date of the international application.

3. In case of filing an international application in the Georgian language, the applicant shall provide a translation of the application in English or Russian within 1 month from the date of filing.

**ARTICLE 75. Accepting an International Application** 4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. Sakpatenti shall act as a “designated office” with regard to international applications indicating Georgia as a place for obtaining a national patent for an invention or utility model.

2. Sakpatenti shall act as an “elected office” with regard to international applications indicating Georgia as a place for obtaining a national patent for an invention or utility model, where the inventor has selected Georgia under the provisions of Chapter II of the Patent Cooperation Treaty.

## CHAPTER XIII

### TRANSITIONAL PROVISIONS

**ARTICLE 76. Application of the Norms of this Law to Earlier Established Relations** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. An application in the process of patent examination by the date of the entry into force of this Law shall continue to be subject to the proceedings, including granting of a patent, in accordance with the Decree of the Cabinet of Ministers of Georgia No 302 of March 16, 1992 “On Approving and Enacting of the Statute on

Inventions” and Decree No 303 of March 15, 1992 “On Approving and Enacting of the Statute on Industrial Designs”.

2. An application filed with Sakpatenti on the basis of author’s certificate of invention issued by the former USSR may be granted a patent of Georgia unless by the date of its filing with Sakpatenti 20 years have lapsed from filing an application for an invention in USSR office.

## CHAPTER XIV

### FINAL PROVISIONS

**ARTICLE 77. Measures Related to Enactment of this Law** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

1. This law shall enter into force after 3 months from the publication.

2. Along with the enactment of this Law, taking into account the Transitional Provisions, Decree of the Cabinet of Ministers of Georgia No 302 of March 16, 1992 “On Approving and Enacting of the Statute on Inventions” and Decree No 303 of March 15, 1992 “On Approving and Enacting of the Statute on Industrial Designs”. shall be considered annulled.

2<sup>1</sup>. Order of the President of Georgia No 223 of May 8, 2002 “On Patent Attorneys of Georgia” shall be considered annulled. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

3. **Repealed** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

4. The President of Georgia shall ensure the compliance of Order No 451 of October 16, 2000 “On Approving the Statute on “Protection and Use of Secret Invention and Utility Models” with this Law. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

5. Sakpatenti shall draft and submit to the Government of Georgia for approval: (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

a) **Repealed** – (26.10.2010.N3741)

b) the fees for the service related with patenting, registration and deposition of intellectual property subject-matters.

6. Sakpatenti (26.10.2010.N3741) shall enact the statute on patent attorneys of Georgia. (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

7. The Chairman of Sakpatenti shall enact the instruction “On Procedures Related with Drafting and Filing Applications for Inventions and Utility Models and Granting a Patent” (26.10.2010.N3741)

**ARTICLE 78. Status of Patents Granted before Enactment of this Law** (4.05.2010. N3031 shall enter into force after 1 month from the publication, (LHG I, 24.05.2010 N27))

Patents granted before enactment of this Law shall be equal to patents granted under this Law.

President of Georgia  
Tbilisi,  
February 5, 1999  
N 1791 IIS

*Eduard Shevardnadze*