

# LAW OF THE REPUBLIC OF TAJIKISTAN «ON INVENTIONS»

## SECTION 1

### GENERAL PROVISIONS

This Law shall govern proprietary and related personal non-proprietary relations arising in connection with the creation, legal protection and use of inventions on the territory of the Republic of Tajikistan.

#### **Article 1. Basic terms**

The terms used in this Law shall have the following meaning:

*application* - a set of documents determined by this Law and submitted to the Patent Office for obtaining a title of protection;

*patent owner* - a natural person or legal entity in whose name a title of protection is granted;

*invention* - a technical solution allowing to resolve specific problems in industry and other spheres of activity;

*patent attorney* - a national of the Republic of Tajikistan who, in accordance with the legislation, is granted the right to represent natural persons and legal entities before the Patent Office;

*objects of industrial property* - inventions, industrial designs and utility models resulting from the human intellectual activities;

*prototype of an invention* - an analog of an invention closest to it by the sum of its essential features;

Paris Convention - the Paris Convention for the Protection of Industrial Property of 20 March 1883 with subsequent changes,

*description of an invention* - a document of the application in which the invention is disclosed;

*claims of an invention* - an application document formed on the basis of the description of an invention and containing the sum of the essential features of an invention;

*conditions for patentability* - conditions for granting legal protection for inventions provided for by this Law;

*analog of the invention* - a device for the same purpose characterized by essential features similar to the essential features of the invention;

*titles of protection* - patents and petty patents granted in accordance with this Law;

#### **Article 2. Legislation of the Republic of Tajikistan on inventions**

The legislation of the Republic of Tajikistan on inventions shall be based on the Constitution of the Republic of Tajikistan and shall consist of the Civil Code of the Republic of Tajikistan, this Law and other legislative acts of the Republic of Tajikistan, as well as international legal acts recognized by the Republic of Tajikistan.

### **Article 3. State body for the protection of industrial property objects**

The State body for the protection of industrial property objects (hereinafter the Patent Office) shall implement a unified State policy in the area of legal protection of industrial property objects, receive applications for industrial property objects, examine those applications, perform the State registration and official publication of information on industrial property objects, issue titles of protection and also carry out other duties, in accordance with the documents establishing the Patent Office.

An Appeal Board shall be set up, attached to the Patent Office, and shall be a mandatory primary body for the settlement of disputes relating to the legal protection of industrial property objects. The Appeal Board shall carry out its authorized functions on the basis of the legislation of the Republic of Tajikistan and the Appeal Board Statute.

The sources of financing of the Patent Office shall include appropriations out of the State budget, procedural payments, as well as the revenue derived from rendering patent and information services.

### **Article 4. Titles of protection**

The right in an invention shall be protected by the State and shall be certified by a patent or petty patent (hereinafter "titles of protection").

A patent for an invention shall be granted following an examination of the substance of an application for the grant of a patent and shall be valid for 20 years, starting from the date of filing the application with the Patent Office.

A petty patent for an invention shall be granted following a preliminary examination of an application for the grant of a petty patent and shall be valid for ten years from the date of filing the application for an invention with the Patent Office.

A title of protection for an invention shall certify the priority and authorship of, and an exclusive right to use the invention.

### **Article 5. Legal protection of inventions**

The scope of legal protection conferred by a title of protection for an invention shall be determined by the claims. The claims of an invention may be interpreted with the help of a description and drawings.

The effect of a title of protection granted for a production process shall extend to the product directly obtained from the process. The new product shall also be deemed to be obtained from the patented process, in the absence of proof to the contrary.

Legal protection in accordance with this Law shall not be granted to inventions containing a State secret. The procedure for the grant of legal protection for such inventions shall be established by the corresponding legislative act.

## **SECTION 2**

### **PATENTABILITY OF INVENTIONS**

#### **Article 6. Conditions for patentability of an invention**

A technical solution shall be recognized as an invention and granted legal protection, if it is new,

involves an inventive step and is industrially applicable.

An invention shall be deemed new, if it does not form part of the prior art.

The prior art shall include any information which, before the date of priority of the invention, has been made available to the public anywhere in the world.

An invention shall be considered to involve an inventive step if it is not obvious from the prior art to a person skilled in the art.

An invention shall be considered industrially applicable, if it can be used in industry, agriculture, healthcare and other fields of human activity

The subjects of an invention may be a device, a process, a substance, a microorganism strain or plant or animal cells and also the use of these subjects with a new purpose.

The following shall not be regarded as inventions within the meaning of the provisions of this Law

- scientific theories and mathematical methods;
- method of organization and management of economy;
- conventional signs, schedules, rules;
- rules and method for performing mental acts;
- algorithms and programs for computers
- projects and lay-out design of constructions, buildings and territories;
- proposals concerning solely the outward appearance of manufactured articles and intended to satisfy aesthetic requirements;

The following shall not be recognized as patentable within the meaning of the provisions of this Law:

- layout designs of integrated circuits;
- plant varieties and animal breeds;
- proposals contrary to public interests, principles of humanity and morality.

The patentability of an invention shall not be prejudiced by the disclosure of information relating to such invention by the applicant (author) or by any other person who received such information, directly or indirectly, from the applicant, as a result of which the substance of the invention entered the public domain, if the application for such invention is filed with the Patent Office within six months of the date of such disclosure. The burden of proof in such case shall rest with the applicant.

## **SECTION 3**

### **SUBJECTS OF THE RIGHT IN AN INVENTION**

#### **Article 7. Author of an invention**

A natural person whose creative work resulted in the invention shall be recognized as the author thereof. Where an invention results from joint creative work of two or more natural persons, those persons shall be recognized as the joint authors thereof. The conditions for exercising author's rights shall be determined by an agreement between them.

Persons shall not be deemed to be joint authors if they did not make a personal creative contribution to the development of an invention or only provided the author(s) with technical, organizational or material assistance or with help in securing the registration of rights in such invention and in its use.

The authorship right shall be an inalienable personal right and shall be protected perpetually.

#### **Article 8. Applicant**

The right to file an application for the grant of a title of protection for an invention shall have:

- the author(s) of the invention;
- the employer in the cases provided for by part two of Article 9 of this Law;
- a legal successor(s) of the author(s) or employer.

#### **Article 9. Patent owner**

A title of protection shall be granted to

- the author of an invention;
- a person who is indicated by the author of an invention in the application for the grant of a patent;
- legal successors of the above-mentioned persons.

The right to obtain a title of protection for an invention created by an employee in connection with the fulfillment of his employment obligations or a specific task of the employer shall belong to the employer, unless otherwise agreed in the contract between them.

In the event that the employer fails, for four months after being notified of an invention by its author, to file an appropriate application with the Patent Office or to assign the right to file an application to another person, and (or) to notify the author of the employer's decision to keep secret the invention concerned, the right to file such application and obtain a title of protection shall belong to the author. The employer shall then have the right to use the invention concerned in his own production operations, subject to compensation payable to the patent owner in an amount to be determined on a contractual basis.

The right to obtain a title of protection for an invention, created by an employee using the experience, material, technical and other resources of the employer, but not in connection with the performance by the employee of professional duties or a specific task set by the employer, shall belong to the employee, unless otherwise agreed by the employer and employee. The employer shall then have the right to use the invention concerned in his own production operations, subject to compensation payable to the patent owner in an amount to be determined on a contractual basis.

#### **Article 10. The right of the author of an invention created in connection with the performance of professional duties**

An employee mentioned in part two of Article 9 shall be entitled to remuneration from the employer, commensurable with the gain that the employer derived or could have derived from the proper use of the invention in the event that:

- the employer obtained a title of protection;
- the employer assigned the right to obtain a title of protection to another person,
- the employer decided to keep the information on such invention secret,
- the employer failed to obtain a title of protection on the application filed by the employer due to reasons within his control,

Remuneration shall be paid in the amount and on conditions determined on the basis of the agreement between the author and the employer.

In the event that the parties fail to reach an agreement on the amount and procedure for payment the dispute shall be settled in the court.

For failure to pay on time the remuneration or compensation determined by the agreement the employer shall be liable in accordance with the legislation of the Republic of Tajikistan.

## **SECTION 4**

### **APPLICATION FOR THE GRANT OF A TITLE OF PROTECTION**

#### **Article 11. Filing an application for the grant of a title of protection**

An application for the grant of a title of protection for an invention (hereinafter -application) shall be filed by an applicant with the Patent Office.

An application may be filed through a patent attorney registered with the Patent Office.

Natural persons permanently residing outside the Republic of Tajikistan, or foreign legal entities or their representatives shall conduct business on obtaining titles of protection and maintaining them through patent attorneys registered with the Patent Office and authorized by a power of attorney.

Nationals of the Republic of Tajikistan, temporarily residing outside the country shall conduct business on obtaining titles of protection and maintaining them through a patent attorney or directly themselves, provided that they supply an address for correspondence on the territory of the Republic of Tajikistan.

The authority of a patent attorney shall be certified by the power of attorney issued by the applicant. The requirements for a patent attorney, the procedure of his attestation and registration shall be determined by the Patent Office.

#### **Article 12. Application**

An application for an invention shall relate to a single invention or a group of inventions, so linked as to form a single inventive concept (requirement for unity of invention).

An application shall contain:

- a request for the grant of a title of protection with an indication of the title of the invention, the author(s) thereof and person(s) in whose name the title of protection is requested, as well as their places of residence or business;
- a description of the invention disclosing it fully enough for a person skilled in the art to carry it out;
- the claims stating the essential features of the invention and based on the description;
- an abstract;
- drawings and other materials where necessary for the understanding of the subject matter of the invention.

A request for the grant of a title of protection shall be filed in the official language, other documents of an application may be submitted in other language.

In order to retain the date of filing of an application established in accordance with Article 14 of this Law the translation in the official language of the documents of the application submitted in other language must be furnished to the Patent Office within three months of the date of their receipt in other language.

The application shall be accompanied by a document, certifying the payment of a fee for filing an application in the prescribed amount, or a document, certifying the exemption from patent fees, or reduction of fees which may be submitted together with the application or within a three month period of the day of receipt of the application in the Patent Office.

Other requirements for the documents of an application shall be established by the Patent Office.

### **Article 13. Correction of documents of an application at the applicant's initiative**

An applicant shall have the right to make amendments and clarifications to the application documents without changing the essence of the claimed invention

Corrections and clarifications to an application may also be submitted after the expiry of a three-month period, but not later than a decision on the results of a substantive examination is taken, provided that the corresponding fee has been paid.

### **Article 16. Confidentiality in the processing of an application**

In the processing of an application the Patent Office shall not allow access for any person to the application before the publication thereof, unless requested or authorized by the applicant.

## **SECTION 5**

### **PRIORITY OF AN INVENTION**

#### **Article 17. Conditions for establishing priority**

The priority of an invention shall be established by the date of filing of the application with the Patent Office

The priority of an invention may be determined by the date of receipt of additional materials if they are submitted by the applicant as a separate application, provided that it has been filed before the

expiry of a three month period following the date of receipt by the applicant of a notification from the Patent Office to the effect that the additional materials cannot be taken into consideration since they are recognized as modifying the essence of the claimed invention.

Priority may be established by the date of filing by the same applicant, with the Patent Office, of the earlier application, disclosing the invention if the application for which such priority is sought is filed not later than within twelve months from the filing date of the earlier application for the invention. In this case the earlier application shall be deemed to have been withdrawn.

Priority may be established on the basis of several earlier applications if each application complies with the conditions set forth in part 3 of this Article.

Priority may not be established by the filing date of the application for invention for which earlier priority had been sought.

Priority of an invention for a divisional application shall be established by the date of filing by the same applicant with the Patent Office of the initial application disclosing said invention and if the divisional application has been received before a decision has been taken not to grant a title of protection, where the possibility for appeal has been exhausted, and if a decision to grant a title of protection has been received - prior to the date of registration of the invention in the State Registers of Inventions.

If the examination process reveals that identical inventions have the same date of priority, a title of protection shall be granted on the application for which an earlier date of dispatch is proven and on coincidence of these dates on the application with earlier registration number assigned by the Patent Office, unless otherwise agreed between the applicants.

#### **Article 18. Convention priority**

Priority may be determined by the filing date of the first application for an invention filed in a State party to the Paris Convention for the Protection of Industrial Property, provided that the application is filed with the Patent Office within 12 months of that date (convention priority). Where owing to circumstances beyond the applicant's control the application claiming convention priority could not be filed within the above time limit, the latter may be extended by a period not exceeding three months.

An applicant wishing to make use of the right of convention priority shall indicate this accordingly when filing an application for an invention or within two months of the date of receipt of the application at the Patent Office, and shall attach a copy of the first application or send it to the Patent Office not later than three months after the date of filing of the application with the Patent Office.

### **SECTION 6**

#### **EXAMINATION OF AN APPLICATION**

#### **Article 19. Formal examination of an application**

Upon the expiry of three months from the date of filing of an application the Patent Office shall carry out its formal examination. At the request in writing of the applicant a formal examination may be started before the expiry of the above mentioned period. In that case, the applicant shall forfeit the right, provided for by Article 13 of this Law, to correct and clarify the documents of the application at his own initiative without payment of a fee.

In the course of a formal examination of an application it shall be verified whether all requisite

documents are included and meet the requirements in accordance with Articles 11 and 12 of this Law and the question whether the claimed proposal relates to the objects mentioned in parts 6, 7 and 8 of Article 6 of this Law shall be considered.

It shall also be verified whether the claimed invention fits the conditions provided for by part three of Article 5 of this Law.

If, in accordance with Article 13 of this Law, the applicant submits supplementary materials for the application the examination shall verify whether they modify the subject matter of the claimed invention.

Supplementary materials shall be held to modify the substance of the invention applied for if they make for the inclusion in the claims of such invention of such features as were absent from the original materials of the application. Any supplementary materials modifying the substance of the invention applied for shall be ignored for the purposes of examining the application, but may be filed by the applicant as a separate application for the invention.

If the application for an invention is made in accordance with all established requirements the applicant shall be notified of a positive decision of the formal examination.

Where a filed application is found to be inconsistent with any requirements applicable to its documents, the applicant shall be given a notice requesting that amended or missing documents be submitted within two months of the receipt date of such notice. If the applicant fails to submit the requested documents within such time period or to apply for its extension, the application shall be deemed withdrawn.

Where an application is found to be inconsistent with the unity of invention requirement, the applicant shall be requested to make it clear, within two months of the receipt date of the appropriate notice, which of the proposals applied for is to be examined and, if necessary, to update documents comprising the application. The other proposals covered by the original application may be filed as divisional applications.

If the applicant fails to make it clear, within two months of receipt of the notice of non-compliance with the unity of invention requirement, which of the technical solutions is to be examined and to submit updated documents, the examination shall be carried out in respect of the technical solution that comes first in the claims, as well as other proposals constituting a single general inventive concept with it, if any.

In the event of disagreement with the examination decision the applicant shall have the right, within three months of the date of receipt of the decision, to lodge an appeal with the Appeal Board of the Patent Office. The appeal shall be considered within two months.

## **Article 20. Substantive examination of an application**

At the request of an applicant (or third parties) which may be submitted at any time within three years of the date of filing of an application for the grant of a patent for invention and also at the request of the owner of a petty patent, which may be submitted during the whole period of validity of the petty patent, the Patent Office shall carry out a substantive examination of the application.

If a request for substantive examination is not filed within a three year period the application which has not claimed a petty patent shall be considered withdrawn.

During the process of a substantive examination of an application which includes information search in respect of the claimed invention to determine the state of the art, priority of the invention shall be

established and compliance of the claimed invention with the requirements for patentability of the invention under Article 6 of this Law shall be verified.

In the course of a substantive examination of the application the Patent Office shall have the right to request from the applicant supplementary material including amended claims. The supplementary materials requested by the examination shall be furnished, without modification of the essence of the invention, within two months of the date of receipt of the request by the applicant.

Any supplementary documents introducing new matter to modify the substance of a filed invention shall be subject to the procedure prescribed by parts four and five of Article 19 of this Law.

If the Patent Office finds in the process of its substantive examination of an application that the filed invention as expressed by the claims proposed by the applicant meets the conditions for patentability set forth in Article 6 of this Law, a decision to grant a patent shall be made.

Where a claimed invention is found, within the scope of legal protection sought, to be inconsistent with the conditions for patentability a decision shall be made to refuse the grant of a patent.

An applicant shall have the right to acquaint himself with the materials indicated in the examination request, in the examination decision or in the search report. The Patent Office shall send copies of the requested materials to him within two months of the date of receipt of the request.

In the event of disagreement with the decision to refuse the grant of a patent the applicant shall have the right to lodge an appropriate appeal with the Appeal Board within three months of the date of receipt of the decision. The appeal shall be considered by the Appeal Board within six months of the date of its receipt.

In the event of disagreement of the applicant with the decision of the Appeal Board he may within six months from the date of receipt of the decision appeal to the Court.

If the applicant fails to respect the time limits for the furnishing of materials at the examiner's request and for filing an appeal with the Appeal Board, such time limits may be reinstated by the Patent Office at the applicant's request, submitted not later than twelve months from the day of the expiry of the time limit, on confirmation of good reasons for the delay and payment of the prescribed fee.

#### **Article 21. Preliminary examination of an application for the grant of a petty patent**

A preliminary examination of an application for the grant of a petty patent for an invention shall be carried out following the completion of a formal examination with a positive result.

During the process of a preliminary examination, the priority of an invention shall be established and its compliance with the requirements for novelty and industrial applicability shall be verified.

In verifying the compliance of the claimed invention with the requirements for novelty, the state of the art. shall include only:

- the analogs and prototypes, cited by the applicant in the application materials;
- applications for inventions and utility models not withdrawn and filed previously by other persons in the Republic of Tajikistan;
- inventions patented in the Republic of Tajikistan and registered utility models.

In the course of a preliminary examination, the Patent Office shall have the right to request from the

applicant supplementary materials including amended claims. The supplementary materials requested by the examination shall be furnished, without modification of the essence of the invention, within two months of the date of receipt of the request.

The procedure set forth in parts four and five of Article 19 of this Law shall be extended to the part of the supplementary materials that modifies the essential features of the invention

If as a result of a preliminary examination of an application the Patent Office establishes that the claimed proposal within the scope of legal protection sought by the applicant meets the conditions for novelty as determined in part three of this article and the conditions for industrial applicability as defined in Article 6 of this Law a decision to grant a petty patent shall be made

A petty patent shall be granted at the responsibility of the applicant.

Where a claimed invention is found to be inconsistent with the conditions for patentability a decision shall be made to refuse the grant of a petty patent.

An applicant shall have the right to acquaint himself with the materials cited in the examination request, in the examination decision or in the search report. The Patent Office shall send copies of the requested materials to him within two months of the date of receipt of the request.

In the event of disagreement with the decision to refuse the grant of a petty patent the applicant shall have the right to lodge an appeal with the Appeal Board within three months of the date of receipt of the decision. The appeal shall be considered by the Appeal Board within six months of the date of its receipt. In the event of disagreement of the applicant with the decision of the Appeal Board he may within six months after sending the decision appeal to the Court.

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If the applicant fails to respect the time limits for the furnishing of materials at the examiner's request and for filing an appeal with the Appeal Board, such time limits may be reinstated by the Patent Office at the applicant's request, submitted not later than twelve months from the day of the expiry of the time limit, on confirmation of good reasons for the delay and payment of the prescribed fee.

## **Article 22. Withdrawal of an application**

Before the publication of an application for invention but not later than the date of registration in the State Registers of Inventions of the Republic of Tajikistan the applicant shall have the right to withdraw the application.

## **Article 23. Publication of information on an application and grant of a title of protection**

Information about the application and title of protection shall be published in the Official Bulletin. The fullness of the published information shall be determined by the Patent Office.

Particulars of the application passed the formal examination with a positive result shall be published by the Patent Office after the expiry of 18 months from the date of filing of the application. At the applicant's request and provided the prescribed fee has been paid the application may be published earlier than the specified period.

Within six months of the day of making a decision to grant a title of protection for an invention the Patent Office shall publish information about the granted title of protection in the Official Bulletin.

The published particulars must include the names of the author(s) (with their consent) and patent

owner(s), the title and the claims of the invention

## SECTION 7

### GRANT OF LEGAL PROTECTION

#### Article 24. Provisional legal protection of an invention

A claimed invention shall enjoy provisional legal protection within the scope of published claims during the period between the date of publication of the application and the date of publication of the grant of a title of protection.

An invention, exhibited at an official or officially recognized international exhibition, shall be granted provisional legal protection from the date on which it is displayed at the exhibition up to the date of the first publication of information concerning the grant of a title of protection, provided that the application for this invention has been filed with the Patent Office not later than six months from the date of its display at the exhibition.

The provisional legal protection shall be considered never to have existed where a decision to refuse the grant of a title of protection has been made and the possibilities of appeal have been exhausted.

After the grant of a title of protection the patent owner shall have the right to claim commensurate compensation from a person who used the claimed invention during the period of its provisional protection.

The provisions of part four of this article shall be extended to inventions from the date of notification by the applicant of the person using them about the filed application for the grant of a title of protection if this date is earlier than the date of publication of information about the application.

#### Article 25. Registration of an invention and grant of a title of protection

Within three months of the date of receipt of documents confirming payment of the fee for registration and grant of a title of protection, the Patent Office shall enter an invention in the State Registers of Inventions and shall grant the patent owner a title of protection.

Where a title of protection was sought in the names of several persons, they shall all be issued a single patent or petty patent. The Patent Office shall grant to the author(s) of the invention, other than the patent owner, an official certificate confirming his authorship.

Unless a document confirming payment of the patent registration and grant fee is duly submitted, the registration of an invention, and the issuance of a title of protection shall not take place and the respective application shall be deemed withdrawn.

The content of the information entered in the State Registers, the layout of a patent and a petty patent and the list of data to be included therein shall be established by the Patent Office.

## SECTION 8

### EXCLUSIVE RIGHT TO USE AN INVENTION

#### Article 26. Rights of a patent owner

A patent owner shall have an exclusive right to use the invention protected by a patent or a petty

patent including the right to manufacture, use, import, sell and in any other way put in commercial use, or store for this purpose a product containing the invention protected by a patent or petty patent, the right to apply a process protected by a patent or petty patent for the invention, and also the right to prohibit use of the above inventions by other persons, except in the cases where such use, in accordance with this Law, does not constitute an infringement of the patent owner's exclusive right.

A product shall be deemed incorporating an invention protected by a patent or a petty patent and a process protected by a patent or a petty patent for invention shall be deemed used, if the product incorporates and the process uses every feature of such invention included in its independent claim or an equivalent feature, which became known as such in the given area of technology, respectively, prior to the use date.

Placing on the market or storage for this purpose of a product produced directly by the process protected by a patent or a petty patent shall also be recognized as the use of the process.

Manufacturing a test model of the device incorporating an invention, its experimental verification and testing shall not be recognized as the use of the invention.

The relations regarding the use of an invention a title of protection for which is owned by several persons shall be governed by a contract between such persons. In the absence of such contract, each of right owners may use the protected invention at his own discretion, but may not grant a license or assign the patent to another person without other patents owners' consent.

A patent owner may use a preventive marking which indicates that a petty patent or a patent have been obtained for the applied inventions.

A patent, a petty patent for an invention and the right to obtain them shall be inherited.

A patent owner may transfer an exclusive right (assign a patent) to any natural person or legal entity. An agreement on transfer of an exclusive right (assignment of a patent) shall be subject to registration with the Office, without which it shall be considered invalid.

If a patent owner is unable to use his invention without infringing the rights of another patent owner he shall be entitled to demand a license agreement to be concluded by the latter.

### **Article 27. Grant of the right to use an invention**

Any person, other than the patent owner, shall have the right to use an invention protected by a title of protection only under an authorization of its owner on the basis of a license contract.

Under a license contract, the patent owner (licensor) shall agree to grant the right to use the protected object, to the extent specified in such contract, to another party (licensee), while the licensee shall agree to perform all actions as may be stipulated in the contract.

Under an exclusive license contract, the licensee shall be assigned an exclusive right to use the invention to the extent stipulated in the contract, while the licensor shall retain the right to use it, but other than to the said extent.

Under a non-exclusive license, the licensor, while granting the right to use the invention to the licensee, shall retain all rights confirmed by the title of protection, including the right to grant licenses to third parties.

A license contract shall be subject to registration with the Patent Office and shall be deemed invalid without such registration.

A patent owner may file with the Patent Office a petition to grant to any person the right to use the invention (open license). The maintenance fee in such case shall be reduced by 50 percent as of the year following that during which the Patent Office publishes a notice of such petition.

In the case of the withdrawal of an open license by the patent owner the patent maintenance fee for the term of the open license shall not be paid and shall henceforth be paid in full.

A person, wishing to obtain an open license shall conclude an agreement on payments with the patent owner. Disputes concerning conditions for concluding an agreement shall be settled in the court.

### **Article 28. Compulsory license**

The patent owner shall be obliged to use the invention. In the event that an invention remains unused or insufficiently used by the patent owner for five years after the date of publication of the grant of a title of protection, any person willing and ready to use the invention may, if the patent owner refuses to enter into a license contract with such party on such terms and conditions as are consistent with prevailing practice, go to court to demand the grant thereto of a compulsory license to use such invention.

If the owner of a title of protection fails to prove that he made no or insufficient use of the invention for a valid reason, the court shall make a decision on the grant of a compulsory license

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Where a compulsory license is granted on the basis of a court finding, such license shall set limits on the use of the invention the title of protection for which is owned by the other person to the extent which may be necessary to use the invention owned by the person who demanded that grant of such compulsory license, and shall prescribe the amount of royalties, as well as time periods and procedures for their payment.

For national security reasons and in force majeure circumstances (natural disasters, catastrophes, major accidents) the Government of the Republic of Tajikistan shall have the right to authorize the use of an invention subject to payment of a commensurate compensation to the patent owner, whereby the scope and duration of use of the patented invention shall be limited to the purpose for which it was authorized

A compulsory license shall be nonexclusive; it may not be reassigned to another person. Disputes arising as a result of such use shall be settled by the court.

A compulsory license shall be subject to mandatory registration with the Patent Office, without which it shall be deemed invalid.

### **Article 29. Infringement of an exclusive right**

Any natural person or legal entity using an invention in a manner contrary to this Law shall be deemed to be infringing the exclusive right of a patent owner (to be infringing the title of protection).

A patent owner shall be entitled to require that:

- the infringement of the title of protection be terminated;
- the person guilty of the infringement of the title of protection provide compensation for resulting losses, including loss of gain, and pay moral damages;

- the income derived by the infringer of the title of protection be recovered in lieu of compensation for losses;
- the products put in commercial use or stored for that purpose which were found to have infringed the title of protection, as well as any facilities specially meant for the infringement of the title of protection, be confiscated for the benefit of the patent owner;
- the relevant court judgement be published in the official editions of the Patent Office in order to restore his business reputation;

Claims against an infringer of the title of protection may be made by the owner of an exclusive license, unless otherwise provided for by the license contract, or the owner of a non-exclusive license where it is provided for by the license contract.

### **Article 30. Actions not recognized as an infringement of an exclusive right**

The following actions shall not be deemed infringements of a patent owners' exclusive right:

- use of the devices incorporating inventions protected by patents or petty patents in the construction or operation of (land, air, water) vehicles of other countries if such vehicles entered the territory of the Republic of Tajikistan on a temporary basis or by accident and such devices are used for the needs of a vehicle. No such action shall be deemed to constitute an infringement of the patent owner's exclusive rights, provided that the vehicles concerned are owned by natural persons or legal entities of countries granting reciprocal rights to vehicle owners of the Republic of Tajikistan;
- scientific research or experiments involving devices incorporating inventions;
- use of the devices incorporating inventions, in force majeure circumstances (natural disasters, catastrophes, major accidents) with subsequent payment of commensurate compensation to the patent owner;
- use of the devices incorporating an invention for needs without aiming to derive any income;
- one-time production of medicines in pharmacies on a doctor's prescription; and
- use of the devices incorporating inventions protected by titles of protection if such devices were put to commercial use on a lawful basis in accordance with the rights granted by a patent owner.

### **Article 31. Right of prior use**

Any natural person or legal entity that, before the priority date of the invention, created and made use on the territory of the Republic of Tajikistan of an identical invention developed independently of the author or made appropriate preparations for such use shall retain the right to continue using such invention free of charge, unless the scope of such use is increased.

The right of prior use may be assigned to another natural person or legal entity, but only together with the production operations which involved the use of such identical invention or necessary preparations for such use.

## **SECTION 9**

### **TERMINATION OF A TITLE OF PROTECTION**

## **Article 32. Opposition to a title of protection**

A title of protection may be contested and invalidated, fully or partially, by any person at any time during its term in the following circumstances:

- the invention does not comply with the conditions for patentability prescribed by Article 6 of this Law;
- the claims of the invention include such features as were absent from the original specifications of the application;
- the title of protection wrongly names the author(s) or the patent owner(s).

An opposition to the grant of a title of protection on the grounds listed in paragraphs one and two of part 1 of this Article shall be filed with the Appeal Board and considered within 6 months of the date of its receipt. In this case the patent owner shall be acquainted with the opposition.

In the event of disagreement with the decision of the Appeal Board on opposition to a patent or a petty patent any party may, within six months after the decision start a court action

## **Article 33. Early termination of the validity of a title of protection**

The title of protection shall be terminated . early

- where a title of protection is recognized as completely invalid in accordance with Article 32 of this Law;
- on a request filed by a patent owner with the Patent Office;
- in the event of failure to pay, within the prescribed time limit, the fee for maintenance of the title of protection in force.

The Patent Office shall publish information about early termination of the validity of the title of protection in the Official Bulletin.

## **Article 34. Reinstatement of the validity of a title of protection. Right of consequent use**

The validity of the title of protection, terminated early in accordance with paragraph three of part one of Article 33 of this Law, may be reinstated on a request by the patent owner, within three years of the expiry of the time period prescribed for payment of a fee for maintenance of a title of protection, provided that the applicant gives good reasons for the delay and provides proof of payment in the prescribed amount of a fee for patent reinstatement.

The Patent Office shall publish information about reinstatement of the title of protection in the Official Bulletin.

Any person that, during the period between the date of termination and the date of reinstatement of the patent, commenced the use on the territory of the Republic of Tajikistan of the protected invention or that made essential preparations for the commencement of such use during the said period of time shall retain the right to continue using it free of charge unless the scope of its use is enlarged (right of consequent use).

The right of consequent use may be assigned to another person, but only together with the

production operations which involved the use of the invention or necessary preparations for such use.

## **SECTION 10**

### **FINAL PROVISIONS**

#### **Article 35. Rights and privileges of authors**

The author of an invention, at any stage of consideration of the application prior to the registration in the state Registers of Inventions shall have the right to give his name or a special title to the invention

An author shall have the right to participate, on contractual conditions, in preparation of inventions for their use.

The authors of the most important and widely used inventions may be put forward for a reward of the honorable title of "Arbobi ilm va tekhnikai Tojikiston".

#### **Article 36. State Encouragement of Creation and Use of Inventions**

Matters relating to encouragement of the creation and use of inventions shall be decided in accordance with the procedure and on the conditions determined by the Government of the Republic of Tajikistan.

#### **Article 37. Consideration of disputes**

Disputes over the infringement of the legal protection of inventions shall be considered by the Appeal Board within the limits of its competence.

In the event of disagreement with the decision of the Appeal Board any party shall have the right to apply to the court.

In the event of a dispute arising in connection with the application of the provisions of this Law, the Appeal Board shall, at the request of any of the parties involved in the dispute, act as a mediator for the settlement of disputes.

Courts shall hear the following disputes in accordance with their competence:

- disputes over the authorship of an invention
- disputes over the grant of a title of protection;
- disputes over patent ownership;
- disputes over the grant of a compulsory license;
- disputes over infringements of exclusive rights to use an invention and other proprietary rights of the patent owner;
- disputes over the execution and performance of license contracts for the use of inventions;
- disputes over the right of prior use and the right of consequent use;

- disputes over remuneration payable to the author by the employer in accordance with the agreement pursuant to Article 10 of this Law, and
- other disputes as may be related to the protection of rights.

### **Article 38. Liability for an Infringement of Authors 1 Rights**

Usurpation of authorship, coercion to co-authorship and unlawful disclosure of information about an invention shall entail liability, in accordance with the legislation of the Republic of Tajikistan.

### **Article 39. Fees and procedural payment**

Filing of an application for the grant of a title of protection, grant of a title of protection, their maintenance in force and extension and reinstatement of missed terms, as well as other legally relevant actions related to petty patents and patents for inventions shall be performed for a fee. The full list of actions for which patent fees shall be charged, their amounts, time periods for their payment, and grounds for exemptions from and rebates of such fees shall be established by the legislative and normative acts of the Republic of Tajikistan.

Carrying out examination, amendments and corrections to the application documents, publication of applications and granted titles of protection, consideration of appeals in the Appeal Board, as well as other legally relevant actions related to examination of an application shall be performed for a procedural payment payable to the Patent Office. The full list of actions for which procedural payments shall be charged, their amounts, time periods for their payment, and grounds for exemptions from and rebates of such procedural payments shall be established by the Patent Office and approved by the Government of the Republic of Tajikistan.

The fees and procedural payment shall be paid by the applicant, patent owner, or, in agreement with them, by any natural persons or legal entities.

### **Article 40. Patenting of inventions in foreign countries**

Patenting in foreign countries of inventions created in the Republic of Tajikistan by natural persons and legal entities shall be made upon the expiry of six months from the filing of the application for invention with the Patent Office of the Republic of Tajikistan. The applicant should notify about his intention of patenting in foreign countries.

The Patent Office may, in necessary cases, allow patenting of an invention in foreign countries earlier than upon expiry of the above time period, but upon the completion of a check undertaken in accordance with the prescribed procedure to verify that such application does not contain any data constituting a state secret.

### **Article 41. Procedure for entry into force of this Law**

This Law shall enter into force on the day of its official publication.

President of the Republic of Tajikistan

E. RAKHMONOV

#7 of 28 February 2004