

**LUXEMBOURG**

**Patent Law**

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## **TITLE I GENERAL**

### **Art. 1. Definitions**

For the purposes of this Law:

- "Paris Convention" means the Convention for the Protection of Industrial Property signed in Paris on March 20, 1983, including each of its revised Acts, as ratified by the Grand Duchy of Luxembourg;
- "Agreement Establishing the WTO" means the Agreement Establishing the World Trade Organization, signed in Marrakech on April 15, 1994;
- "Law of 8 July 1967" means the Law on the disclosure and working of inventions and manufacturing secrets affecting the defense of the territory or the security of the State;
- "Minister" means the Minister having responsibility for intellectual property;
- "Service" means the National Intellectual Property Service acting in implementation of the Paris Convention and of the national legislation on intellectual property;
- "Head of Service" means the official placed in charge of the administration of intellectual property matters by the Minister by virtue of and in application of the statutory and regulatory provisions issued in that connection;
- "Court" means the district court acting in civil affairs;
- "Register" means the patent register kept by the Service;
- "Professional Representative" means any natural person entered in the Register of Professional Representatives in accordance with Article 85 of this Law.

### **Art. 2. International Conventions**

1. This Law shall be without prejudice to the application of the provisions of international conventions on industrial property to which the Grand Duchy of Luxembourg is party.

2. Notwithstanding the rights afforded the nationals of the other States party to the Paris Convention, Luxembourg nationals may claim application for their benefit, in the Grand Duchy of Luxembourg, of the provisions of that Convention, together with the agreements, additional acts, and closing protocols that have amended or may amend that Convention, in all those cases in which such provisions are more favorable than Luxembourg law for protecting their industrial property rights.

## **TITLE II PATENTS FOR INVENTION AND PATENTABILITY**

### **Art. 3. Origin and Content of Patent**

In accordance with the conditions and within the limits laid down by this Law, an invention may be the subject matter of an industrial property title issued by the Minister and referred to as a patent affording to its owner or to his successors in title an exclusive right of exploitation.

### **Art. 4. Patentable Inventions**

1. New inventions which involve an inventive step and which are susceptible of industrial application shall be patentable.

2. The following in particular shall not be regarded as inventions within the meaning of paragraph 1:

- (a) discoveries, scientific theories and mathematical methods;
- (b) aesthetic creations;
- (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- (d) presentations of information.

3. The provisions of paragraph 2 shall exclude patentability of the subject matter or activities referred to in that provision only to the extent to which a patent application or a patent relates to those subject matters or activities as such.

4. Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph 1. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

### **Art. 5. Exceptions to Patentability**

The following shall be excluded from the protection provided by this Law:

- (1) inventions the publication or exploitation of which would be contrary to public policy or morality, provided that the exploitation shall not be deemed to be so contrary merely because it

is prohibited by law or regulations;

(2) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof.

#### **Art. 6. Novelty**

1. An invention shall be considered to be new if it does not form part of the state of the art.

2. The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the patent application.

3. Additionally, the contents of Luxembourg patent applications and of European or international patent applications designating Luxembourg, as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.

4. The provisions of paragraphs 1 to 3 shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Article 4.4, provided that its use for any methods referred to in that Article is not comprised in the state of the art.

#### **Art. 7. Non-prejudicial Disclosures**

1. For the application of Article 6, a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months preceding the filing of the patent application and if it was due to or in consequence of:

(a) an evident abuse in relation to the applicant or his legal predecessor or

(b) the fact that the applicant or his legal predecessor had displayed the invention at an official, or officially recognized, international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on November 22, 1928 and last revised on November 30, 1972.

2. In the case of paragraph 1(b), paragraph 1 shall apply only if



the applicant states, when filing the patent application, that the invention has been so displayed and files a supporting certificate within the period and under the conditions laid down in a Grand-Ducal Regulation.

**Art. 8. Inventive Step**

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 6.3, such documents are not to be considered in deciding whether there has been an inventive step.

**Art. 9. Industrial Application**

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

### **TITLE III PERSONS ENTITLED TO APPLY FOR AND OBTAIN A PATENT**

#### **Art. 10. Entitlement to File a Patent Application**

A patent application may be filed by any natural or legal person, or any entity equivalent to a legal person by virtue of the law governing it.

#### **Art. 11. Multiple Applicants**

A patent application may also be filed by two or more applicants who jointly exercise the rights afforded to them by law, even after grant of a patent.

#### **Art. 12. Right to a Patent**

1. The right to a patent shall belong to the inventor or his successor in title.

2. If two or more persons have made an invention independently of each other, the right to a patent shall belong to the person whose patent application has the earliest date of filing.

3. For the purposes of proceedings before the Service, the applicant shall be deemed to be entitled to exercise the right to the patent.

#### **Art. 13. Employee Inventor**

1. If the inventor is an employee, the right to the patent, in the absence of any contractual clause more favorable to the employee, shall be determined in accordance with the following provisions.

The invention shall belong to the employer where made by an employee in the execution either of an employment contract comprising an inventive mission that corresponds to his effective tasks or of study or research explicitly entrusted to him.

The same shall apply if the invention is made by an employee either in the execution of his tasks or in the field of activity of the undertaking or through the knowledge or by use of the techniques or means specific to the undertaking or of data obtained by the undertaking.

All other inventions shall belong to the employee.

2. An employee who is the author of an invention shall inform his employer thereof and the latter shall confirm receipt.

The employee and the employer shall communicate to each other all necessary information concerning the invention. They shall refrain from any disclosure such as may compromise in whole or in part the exercise of the rights afforded by this Law.

Any agreement between the employee and the employer concerning an employee invention shall be set out in writing on pain of nullity.

3. Where the employer obtains a significant profit by reason of the patent, he shall be required to afford to the inventor an equitable share in the profits thus made.

4. Where legal proceedings are instituted by an employee who has made an invention belonging to his employer and for which a patent has been granted and it is ascertained that the employer obtains a significant profit by reason of that patent, the Court shall award special remuneration to the employee. Before taking any procedural steps, the Court shall hear the parties with a view to conciliation on the principle and on the amount of remuneration. The action afforded inventors under this paragraph shall be prescribed after three years from grant of the patent. However, the time limit shall be suspended for a period of one year if a request for the payment of special remuneration is addressed to the employer by registered mail.

5. Any decision on the payment of special remuneration may provide for the payment of a basic lump sum and of a periodical allocation or for the payment of one only of such types of remuneration. At the request of either of the parties, the Court that has taken the decision may amend it, withdraw it or suspend its application in whole or in part.

6. When determining the amount of the special remuneration due to the employee, the Court shall take into consideration all the circumstances in which the invention has been made, in particular:

(a) the economic importance of the invention and the conditions under which the significant profit has been made;

(b) the nature of the employee's tasks, his salary and any other advantages he draws or has drawn from his employment, his inventive task or the invention;

(c) the personal efforts and know-how of the employee involved in

making the invention;

(d) the efforts and know-how of any other person involved jointly with those of the employee concerned and any assistance and advice given by other employees who do not themselves enjoy the capacity of inventor;

(e) the employer's contribution to the making, development and industrial and commercial exploitation of the invention;

(f) the nature and size of the undertaking.

7. Notwithstanding the Law of 9 March 1987 relating to (a) the organization of technological research and development in the public sector and (b) transfer of technology and scientific and technical cooperation between undertakings and the public sector, the provisions of this Article shall also apply to servants of the State, local authorities, public establishments and all public law legal persons.

8. For the purposes of this Article, patent means any title of protection for an invention granted to the employer and having effect either in the Grand Duchy of Luxembourg or in one or more foreign countries.

9. Where not already provided for by the preceding paragraphs, a Grand-Ducal regulation may lay down measures to implement this Article.

#### **Art. 14. Patent Applications by Persons not Entitled**

1. If a patent has been sought for an invention that has been obtained from the inventor or from his successors in title either in violation of a statutory obligation or a contractual obligation, the injured party may claim his right to obtain a patent.

On pain of inadmissibility, the filing of a petition to the Court shall be entered in the Register. The final decision with regard to the petition or the relinquishment of the petition shall also be entered.

2. If by a final decision it is adjudged that a person referred to in Article 12.1, other than the applicant, is entitled to the grant of a patent, that person may, within a period of three months after the decision has become final, provided that the patent has not yet been granted:

- (a) prosecute the application as his own application in place of the applicant;
- (b) file a new application in respect of the same invention or
- (c) request that the application be refused.

3. The implementing instructions under this Article shall be laid down by Grand-Ducal regulation.

**Art. 15. Claim to the Right of a Patent**

1. If a patent has been granted to a person not entitled thereto under Article 12.1, the person entitled thereto under that Article may, without prejudice to all other rights and actions, claim transfer of the capacity of owner.

2. Where a person is entitled to a part of the patent only, he may claim, in accordance with the provisions of paragraph 1, the transfer of the patent in the capacity of joint owner.

3. The rights referred to in paragraphs 1 and 2 may be exercised before the Court only within a period of two years as from the date on which the notice relating to the grant of the patent has been published in the Mémorial. This provision shall not apply if the holder of the patent knew at the time of grant or acquisition of the patent that he was not entitled to the patent.

4. The filing of a petition to the Court shall be entered in the Register. The final decision on the petition to the Court or the relinquishment of the petition shall also be entered.

**Art. 16. Effects of Change in Ownership of the Patent**

1. Where the ownership of a patent has been integrally changed following a petition to the Court under Article 15, the licenses and other rights shall lapse on entry of the entitled person in the Register.

2. If, prior to entry of the petition to the Court,

- (a) the owner of the patent has exploited the invention or made effective and serious preparation to that end or if
- (b) the holder of a license has obtained and has exploited the

invention on Luxembourg territory or has made effective and serious preparation to that end,

he may continue such exploitation subject to requesting a non-exclusive license from the new owner entered in the Register. In order to do so, he shall have a two-month period as from the court decision in the case referred to under (a) and of four months as from entry of the decision in the Register in the case referred to in (b). The license shall be granted for a reasonable period under reasonable conditions.

3. Paragraph 2 shall not apply if the owner of the patent or the holder of the license had acted in bad faith at the time of beginning exploitation or of the preparations made to that end.

**Art. 17. Right of the Inventor to be Mentioned**

The inventor shall have the right, vis-à-vis the owner of the application or patent, to be mentioned as such before the Service. The inventor may oppose disclosure of his identity.

## **TITLE IV THE PATENT APPLICATION**

### **Chapter I Filing and Requirements of the Patent Application**

#### **Art. 18. Filing of the Patent Application**

1. Any person who wishes to obtain a patent shall be required to file an application in conformity with the statutory and regulatory provisions

2. The filing of the required elements shall be made with the Service which shall issue a receipt by affixing a stamp showing the date of receipt of the element on an authentic copy thereof, without prejudice to Articles 20 and 28.

#### **Art. 19. Requirements of the Patent Application**

1. A patent application shall contain:

- (a) a request for the grant of a patent;
- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract.

2. A patent application shall be subject to the payment of the filing fee and the publication fee; these fees shall be paid at the latest one month after the filing of the application.

3. The application shall also satisfy the statutory and regulatory conditions and, in particular, be supplemented by

- (a) a translation into French or German of the claims where the latter are not drafted in the French, German or Luxembourg languages;
- (b) where appropriate, the priority declaration referred to in Article 27;
- (c) the designation of the inventor;
- (d) where appropriate, the declaration that the inventor is opposed to disclosure of his identity in accordance with Article 17;
- (e) at the request of the Service, a declaration stating the origin of the right to the patent if the applicant is not the inventor or not the sole inventor;

(f) where appropriate, the declaration and attestation referred to in Article 7.2;

(g) proof of payment of the fees referred to in paragraph 2 of this Article.

4. During the whole duration of the procedure before the Service, the translation of the elements referred to in paragraph 3(a) may be made to conform with the original wording.

5. A Grand-Ducal regulation may provide that the patent application be supplemented by a translation into the French or German languages within a period to be laid down in the same Grand-Ducal regulation where the elements referred to in paragraph 1 are not drafted in the Luxembourg language.

#### **Art. 20. Filing Date**

The date of filing of an application shall be the date on which the documents filed by the applicant contain:

(a) an indication that a patent is sought;

(b) information identifying the applicant;

(c) a description and one or more claims drafted in the French, German, English or Luxembourg languages.

#### **Art. 21. Unity of Invention**

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

2. The preceding paragraph shall be understood to permit, in particular, the inclusion in one and the same patent application:

(a) in addition to an independent claim for a product, of an independent claim for a process specially designed for the manufacture of that product and an independent claim for the use of that product or,

(b) in addition to an independent claim for a process, of an independent claim for a device or means specially designed for the implementation of the process or,

(c) in addition to an independent claim for a product, of an independent claim for a process designed especially for the



manufacture of such product and an independent claim for a device or means specially designed for the implementation of that process.

**Art. 22. Disclosure of the Invention**

1. The patent application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

2. If an invention concerns the use of a microorganism which is not available to the public, the description shall not be deemed to disclose the invention satisfactorily unless a culture of the microorganism has been deposited with a body empowered thereto by Ministerial regulation.

**Art. 23. The Claims**

The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

**Art. 24. Drawings**

Drawings shall be provided where they are necessary for the comprehension of the invention.

**Art. 25. The Abstract**

The abstract shall merely serve for use as technical information; it may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought nor for the purpose of applying Article 6.3.

**Chapter II Priority**

**Art. 26. Priority Right**

1. A person who has duly filed in or for any State party to the Paris Convention or the Agreement Establishing the WTO, including the Grand Duchy of Luxembourg, an application for a patent or for the registration of a utility model or for a utility certificate or for a certificate of invention, or his successors in title, shall enjoy, for the purpose of filing a patent application in respect of the same invention, a right of priority during a period of 12 months from the date of filing of the first application.

2. Every filing that is equivalent to a regular filing under the

national law of the State where it was made or under bilateral or multilateral reciprocity agreements concluded with the Grand Duchy of Luxembourg shall be recognized as giving rise to a right of priority.

3. By a regular filing is meant any filing that is sufficient to establish the date on which the application was filed, particularly any filing that satisfies the conditions of Article 20 of this Law, whatever the outcome of the application concerned by such filing.

4. A subsequent application for the same subject matter as a previous first application and filed in or in respect of the same State, including the Grand Duchy of Luxembourg, shall be considered as the first application for the purposes of determining priority, provided that, at the date of filing of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The application may not thereafter serve as a basis for claiming a right of priority.

5. Where two patents have been granted for the same invention to the same inventor or to his successor in title with the same filing date or priority date, respectively, the patent resulting from the earlier application shall cease to have effect as from the date on which the patent resulting from the application for which the priority right is claimed has been granted. The patent that lapses shall not be reinstated if the subsisting patent is effected by revocation or if it is annulled.

#### **Art. 27. Claiming Priority**

1. An applicant for a patent desiring to take advantage of the priority of a previous application shall file a declaration and a copy of the previous application in accordance with the conditions and time limits to be laid down by Grand-Ducal regulation.

2. Multiple priorities may be claimed in respect of a patent application, notwithstanding the fact that they originated in different States. Where appropriate, multiple priorities may be claimed for any one claim.

Where multiple priorities are claimed, time limits which run from

the date of priority shall run from the earliest date of priority.

3. If one or more priorities are claimed in respect of a patent application, the right of priority shall cover only those elements of the patent application which are included in the application or applications whose priority is claimed.

4. If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted, provided that the documents of the previous application as a whole specifically disclose such elements.

**Art. 28. Effect of Priority Right**

The right of priority shall have the effect that the date of priority shall count as the date of filing of the application for the purposes of Article 6.2 and 3 and Article 12.2.

**Chapter III Registration and Regularization of the Application**

**Art. 29. Registration of the Application**

If an application satisfies the requirements for the accordancy of a date of filing, the Service shall effect its registration and shall draw up a filing certificate. If the application does not satisfy those requirements, the Service shall declare the application to be non-admissible and shall inform the applicant thereof.

**Art. 30. Regularization of the Application-Sanction**

1. If a filing date has been accorded to an application without, however, the application meeting the other statutory or regulatory provisions, the owner of the application shall be invited without delay by the Service to regularize the application unless he has already announced in writing his intention to carry out such regularization.

2. Failure to send or receive the regularization notices by the Service shall not exclude the need to regularize within the time limits laid down by law and may not be invoked by the applicant either before the Court or in respect of the Service.

3. Each regularization operation shall be subject to payment of a

fee.

4. If the elements referred to in Article 19.3(a) and (g) are not handed to the Service within one month as from the filing of the patent application, the latter shall be deemed to have been withdrawn.

5. Failure to comply with the requirements concerning the claim to a priority right within the time limits laid down in the regulation referred to in Article 27 shall entail the loss of that right for the application.

6. Where the omission of the designation of the inventor is not remedied within 16 months after the date of filing of the application or, if priority is claimed, after the date of priority, the application shall be deemed to be withdrawn.

7. If the application makes reference to drawings and those drawings have not been filed on the date of filing of the application, the filing date of the application shall be the date on which the drawings are filed or the date on which the references to drawings in the application are deemed to have been deleted, according to the choice exercised by the applicant.

8. In all other cases of failure to produce the required elements to support an application within the time limit prescribed by law or within four months as from the date of filing of the application, the application shall be refused, on a proposal by the Service, by Ministerial order.

#### **Art. 31. Divisional Applications**

1. The owner of a patent application shall have the faculty of dividing up his application on his own initiative and irreversibly by filing one or more divisional applications and by limiting the protection afforded by the initial application in a corresponding manner if he himself or the body responsible for drawing up the search report holds that the patent application does not satisfy the requirement of unity of invention referred to in Article 21. This faculty shall be suspended during the period running from the filing of the request for the drawing up of a search report and the transmission of the search report to the owner of the patent

application.

The protection afforded by the initial application shall be limited by deleting one or more claims, sentences in the description or figures in the drawings or, exceptionally, by amending the claims, description or the drawings in accordance with Article 37.

Where a patent has been granted which does not satisfy the requirement of unity of invention referred to in Article 21 and the deficiency is determined by the Court at the request of another party, the patent owner shall be required to file one or more divisional applications, failing which he shall definitively lose the rights not directly related to the main subject matter of the patent.

Except in the case of determination by the Court at the request of another party, a divisional application may no longer be filed after expiry of the fourth month after the accomplishment of the acts referred to in Article 37.1(b). In the case of a court determination, the divisional application or applications shall be filed prior to expiry of the fourth month as from exhaustion of the means of appeal.

2. Divisional applications may be filed only for elements which do not go beyond the initial application as filed. Insofar as this provision is complied with, the divisional applications shall enjoy the filing date of the initial application and, where appropriate, of the priority right.

3. The filing of a divisional application shall be subject to payment of the fees required for the filing of a patent application and to the fees that are due again by reason of the annual fees that have fallen due since the filing date of the initial application. The fees applied shall be in those in force at the time of the filing of the divisional application.

4. A request for the drawing up of a search report shall be made for each divisional application. The request is to be presented within a period of seven years as from the filing date of the initial application. However, if the divisional application is filed after that period of time, the request shall be presented on the same date as the filing of the divisional application failing which the divisional application shall not be admissible.

#### **Art. 32. Withdrawal of the Application**

1. The owner of a patent application may at any time withdraw his

application. Withdrawal shall be declared in writing to the Service by owner of the patent application and shall have effect only after entry in the Register. A notice of the withdrawal shall be published in the *Mémorial, Recueil administratif et économique*.

2. Notwithstanding Article 26.3, withdrawal shall imply the loss of the rights deriving from the patent application.

3. The withdrawal shall be entered in the Register only with the consent of any person enjoying a property right entered in the Register or in whose name an entry has been made under Article 14.1. If a license has been entered in the Register, withdrawal shall be entered only if the owner of the application proves that he has informed his licensee beforehand of his intention to renounce.

#### **Chapter IV Prosecution of the Application, Grant of the Patent**

##### **Art. 33. Public Inspection**

1. The file of the patent application shall be open to public inspection ex-officio on expiry of a period of 18 months as from the filing of the application or, where priority is claimed, as from the priority date.

However, the file of the patent application may be made public prior to expiry of such time limit at the request of the applicant. Such request shall not be admissible if presented prior to expiry of a period of two months as from the filing of the patent application, if it is not accompanied by evidence of payment of the relevant administrative fee or if the patent application is in the process of regularization for any reason whatsoever in implementation of the provisions of Article 30.

2. Where the inventor opposes under Article 17 the disclosure of his identity, the relevant declaration, together with the document designating the inventor, shall remain closed to public inspection.

3. Those files of patent applications shall not be open to public inspection in accordance with paragraph 1 which, on expiry of the prescribed time limit or at the time of filing of the request referred to in those provisions, have been declared inadmissible, have been deemed withdrawn, have been declared refused by Ministerial order or have been the subject matter of a declaration

of withdrawal entered in the Register. The same shall apply to patent applications to which secrecy has been applied under the Law of July 8, 1967 until the secrecy is lifted.

4. The opening of a file of a patent application to public inspection shall be entered in the Register and shall be published in the Mémorial, Recueil administratif et économique.

**Art. 34. Observations by Third Parties**

1. As from the date on which the file of a patent application is opened to public inspection and up to the date on which the patent is granted, any third party may address written observations to the Service concerning the patentability of the invention that is the subject matter of the patent application.

2. The observations shall be transmitted to the applicant who may comment thereon within a period of four months as from the transmission of the observations. The comments of the applicant shall be communicated to the other party.

**Art. 35. Documentary Searching**

1. The applicant for a patent shall be required, failing which his application shall be deemed to be refused, to submit within a period of seven years as from the filing date of his application or under the conditions set out in Article 31:

(a) either a request for the drawing up of a search report by a body to be designated by Grand-Ducal order;

(b) or one or more search reports drawn up by a body designated by Grand-Ducal order where such reports are based on one or more patent applications or similar industrial property titles

(i) of which the priority or priorities are claimed in the application for the Luxembourg patent or

(ii) which claim the same priority or priorities as the application for the Luxembourg patent or

(iii) which claim the priority of the application for a Luxembourg patent,

accompanied by a certified copy of such patent applications or similar industrial property title, in the case of foreign or regional applications, together with a translation of such applications in those cases prescribed by the Grand-Ducal

regulation;

(c) or a search report drawn up by a body designated by Grand-Ducal order where such report is based directly on the content of the application for a Luxembourg patent, that is the subject matter of the search.

2. The search report referred to in paragraph 1(a) shall be drawn up on the basis of the claims, in their final version, taking into account the description and, where appropriate, the drawings annexed thereto. It shall list the elements of the prior art that may be taken into consideration for assessing the novelty of the invention that is the subject matter of the patent application and the inventive step.

3. The search reports referred to in paragraph 1 shall be accepted in the French, German or English languages or shall be accompanied by a translation into one of those three languages.

4. The applicant shall be dispensed from submitting the elements referred to above if the application has been the subject matter of an intervention by another party under Article 36.

5. The request for the drawing up of a search report shall not be admissible unless accompanied by evidence of payment of the search fees, unless it satisfies the other requirements of this Law or if the patent application is in the process of regularization for any reason whatsoever under the provisions of Article 30.

6. The body shall draw up a search report on that part of the patent application that concerns the main subject matter of the claims and on those parts of the patent application for which the required additional search fees have been paid within the prescribed time limit. Those parts of the patent application for which additional search fees have not been paid within the prescribed time limit shall be deemed to have been withdrawn unless they are the subject matter of divisional applications under Article 31. The request for the drawing up of the search report shall refer to the elements referred to in paragraph 1(b) or (c) to be submitted by the owner of the patent application and shall identify those parts of the patent application to which the elements thus mentioned refer.



**Art. 36. Request for Search Submitted by Another Party**

1. As from the date on which the file relating to the patent application is opened for public inspection and up to expiry of a period of seven years as from the filing date of the application, other parties shall be entitled to file requests, under conditions to be laid down by Grand-Ducal regulation, for the drawing up of a search report within the meaning of the preceding Article where the applicant has not complied with that Article.

2. Action by another party under paragraph 1 shall be communicated to the owner of the patent application who shall receive a copy of the search report thus drawn up and who shall alone remain entitled to avail himself of the faculty provided in Article 37.

**Art. 37. Amendment of Claims, Description and Drawings**

1. The owner of an application shall be entitled to make amendments to the claims, the description and the drawing,

(a) until the filing of the request for the drawing up of a search report or until receipt by the Service of the elements referred to in Article 35.1(b) or (c),

(b) following receipt by the Service of the elements referred to in Article 35.1(b) or (c) or following transmission to the owner of the patent application of the search report requested by himself or by another party in accordance with Articles 35 and 36,

(c) in the case of the filing of a divisional application.

2. A patent application may not be amended in such a way that it contains subject matter which extends beyond the content of the application as filed.

3. The right to make amendments provided by this Article shall include the right to adapt the title of the invention and the abstract and the right to file a brief commentary.

4. In the cases referred to in paragraph 1(b) and (c), the right of amendment shall be exercised within four months as from the acts referred to therein.

5. Each amendment shall be subject to the payment of a fee.

6. The time limit afforded in accordance with paragraph 4 may in no case extend beyond the expiry of the fourth month as from the accomplishment of the acts referred to in paragraph 1(b).

**Art. 38. Search with Regard to an Invention Concerning Defense**

1. If the lifting of secrecy, with respect to a patent application placed under secrecy in accordance with the Law of July 8, 1967, occurs more than six years after the filing date, the obligations referred to in Article 35 shall be satisfied within a period of 12 months as from the date of the lifting of secrecy.

2. The right of intervention by other parties as set out in Article 36 shall be exercised within the period of time laid down in paragraph 1. Articles 34 and 37 shall apply.

**Art. 39. Regularization Concerning the Search Report**

1. If the request for the drawing up of a search report can not be prosecuted within the body designated by Grand-Ducal order due to the temporary exclusion of search activities in given fields of technology and if the body decides in such case not to carry out the search, the Service shall transmit to the applicant the relevant decision of the body that shall replace the search report for the purpose of granting a patent.

2. If the body responsible for drawing up the search report considers

(a) that the description, the claims or the drawings do not satisfy the prescribed conditions to such an extent that no significant search can be carried out or

(b) that the patent application concerns a subject matter that does not correspond to the concept of invention or does not constitute patentable matter or with respect to which it is not required, for other reasons, to carry out a search,

and declares that a search report will not be drawn up, the Service shall transmit the relevant declaration to the applicant to whom it shall afford a period of four months to correct any defective elements in the patent application in accordance with Article 37 and shall renew the request for the drawing up of a search report.

If, after renewal of the request for the drawing up of a search

report, the body does not consider itself in a position to change its conclusions with regard to the patent application, as corrected a first time, the applicant may file a petition by which he requests the immediate grant of a patent together with a brief justification for his petition. The petition shall be admissible only on condition that it is filed prior to expiry of the new time limit afforded by the Service under paragraph 1 on condition, however, that this new time limit expires later than the expiry of a time limit to be laid down by Grand-Ducal regulation or, failing that, later than the expiry of the time limit referred to in Article 35.1.

In the case referred to in paragraph 2, the Service may propose to the Minister that a patent should not be granted, giving its reasons therefor. The conditions for implementing the provisions of this paragraph together with the conditions for the reasoned opinion shall be laid down by Grand-Ducal regulation.

3. If the same conclusions result from the elements referred to in Article 35.1(b) or (c), the Service shall act in accordance with the provisions of paragraph 1 and 2, respectively.

4. If the Service ascertains that the request for the drawing up of a search report referred to in Article 35.1(a) does not satisfy the requirements of the Regulations, it shall afford the requester a period of four months in order to meet those requirements.

If the Service ascertains that the elements submitted under Article 35.1(b) or (d) do not meet the requirements of this Law or of its Regulations, it shall inform the owner of the patent application thereof and afford him a period of four months to regularize the aforementioned elements or to submit a request for the drawing up of a search report as referred to in Article 35.1(a).

5. The period of time afforded by the Service under the preceding paragraphs may extend beyond the expiry of the time limit laid down in Article 35.1. If the owner of the patent application does not comply with the invitation by the Service within the afforded time limit, the grant of a patent shall be refused by Ministerial order. However, if at the date of expiry of the time limit afforded by the Service the time limit under Article 35.1 has not yet expired, only the request for the drawing up of a search report and the elements referred to in Article 35.1(b) or (c) shall be refused, respectively. Where appropriate, the search fees shall be refunded after deduction

of the costs incurred on account of the refund.

**Art. 40. Restitutio in integrum**

1. The owner of a patent application or of a patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the Service shall, upon application, have his rights re-established if the non-observance in question has the direct consequence, by virtue of the law, of causing the refusal of the patent application or of a request or the deeming of the patent application to have been withdrawn or the revocation of the patent or the loss of any other right or means of redress.

2. The application must be filed in writing within two months from the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit.

3. The application must state the grounds on which it is based and must set out the facts on which it relies. It shall not be deemed to be filed until after the fee for re-establishment of rights, laid down by Grand-Ducal order, has been paid.

4. A decision on the application shall be taken by Ministerial order of which a notice shall be entered in the Register and published in the Mémorial, Recueil administratif et économique.

5. The provisions of this Article shall not be applicable to the time limits referred to in paragraph 2 and in Article 19.2, to the time limits afforded for filing a new application in accordance with Article 14.2, the filing of a patent application claiming the priority of an earlier application for the same invention under Article 26.1 or the filing of a divisional application under Article 31, nor to the time limits afforded for making payment of the fees relating to such filings.

6. Any person who in good faith has used or made effective and serious preparations for using all invention which is the subject of a patent application open to public inspection or a granted patent in the course of the period between the loss of rights referred to

in paragraph 1 and the date of the Ministerial decision relating to re-establishment of that right, may without payment continue such use in the course of his business or for the needs thereof.

**Art. 41. Grant of Patent**

1. The title constituting the patent for invention shall be granted in the form of an order of the Minister.

2. Such order shall be issued on completion of the formalities laid down for the grant of a patent or, where appropriate, on expiry of the period for intervention afforded the owner of the patent application in accordance with Article 37 and on condition that the due annual fees have been validly paid at such date or, where appropriate, are likely to have been paid on the expiry date of the current period of grace.

3. If, on the date on which the above-mentioned formalities have been fulfilled or on the date of expiry of the above-mentioned time limit for intervention, it is ascertained that the due annual fee may no longer be validly paid in view of the expiry of the period of grace, the application shall be deemed withdrawn and the patent shall not be granted.

4. The grant of a patent shall be made without prior examination of the patentability of inventions, without guarantee as to the exactitude of the description and at the responsibility of the applicant.

**Art. 42. Entry and Publication of Grant**

The grant of the patent shall be entered in the Register and published in the Mémorial.

## **TITLE V RIGHTS AND OBLIGATIONS DERIVING FROM PATENT APPLICATIONS AND PATENTS**

### **Art. 43. Term**

1. Subject to the provisions of Article 49, the exclusive right referred to in Article 3 shall take effect as from the date of grant of a patent.
2. The rights conferred by the patent shall lapse after 20 years as from the filing date of the application.

### **Art. 44. Extent of Protection**

1. The extent of the protection conferred by a patent or a patent application shall be determined by the terms of the claims. Nevertheless, the description and the drawings shall be used to interpret the claims.
2. For the period up to grant of the patent, the extent of the protection conferred by the patent application shall be determined by the latest filed claims prior to the day on which the file is opened to public inspection in accordance with Article 33.1. However, the patent as granted or as amended during prosecution of the application, shall determine retroactively the protection conferred by the patent application, insofar as such protection is not thereby extended.
3. If the subject matter of the patent is a process, the rights conferred by the patent shall extend to the products directly obtained by such process.

### **Art. 45. Prohibition of Direct Exploitation of the Invention**

A patent shall confer the right to prohibit any person, save consent by the owner of the patent, from:

- (a) making, offering, putting on the market or using a product which is the subject matter of the patent or from importing or stocking a product for such purposes;
- (b) using a process which is the subject matter of the patent or, when the third party knows or it is obvious in the circumstances that the use of the process is prohibited without the consent of the owner of the patent, offering the process for use on Luxembourg territory;

(c) offering, putting on the market or using the product obtained directly by a process which is the subject matter of the patent or importing or stocking the product for such purposes.

**Art. 46. Prohibition of Indirect Exploitation of the Invention**

1. A patent shall also confer the right to prohibit any third party, save consent by the owner of the patent, from supplying or offering to supply, on Luxembourg territory, a person other than a person entitled to exploit the patented invention, the means of implementing, on that territory, the invention with respect to an essential element thereof where the third party knows, or it is obvious from the circumstances, that such means are suited and intended for putting the invention into effect.

2. The provisions of paragraph 1 shall not apply where the means of implementation are staple commercial articles, except where the third party induces the person supplied to commit the acts prohibited by Article 45.

3. Persons carrying out the acts referred to in Article 47(a) to (c) shall not be deemed persons entitled to exploit the invention within the meaning of paragraph 1.

**Art. 47. Limitation of the Effects of the Patent**

The rights afforded by the patent shall not extend to:

(a) acts done privately and for non-commercial purposes;

(b) acts done for experimental purposes relating to the subject matter of the patented invention;

(c) the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared;

(d) use on board vessels of countries of the Paris Union for the Protection of Industrial Property other than Luxembourg of the subject matter of the patented invention in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of Luxembourg, provided that such devices are used there exclusively for the needs of the vessel;

(e) use of the subject matter of the patented invention in the construction or operation of aircraft or land vehicles of countries

of the Paris Union for the Protection of Industrial Property other than Luxembourg or of accessories of such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter Luxembourg territory;

(f) acts referred to in Article 27 of the Convention on International Civil Aviation of December 7, 1944 when those acts concern the aircraft of a State other than Luxembourg to which the provisions of that Article apply.

**Art. 48. Exhaustion of Rights Conferred by the Patent**

1. The rights afforded by a patent shall not extend to acts concerning a product covered by that patent which are done on Luxembourg territory after such product has been put on the market in one of the States of the European Economic Community by the owner of the patent or with his express consent unless there exist reasons in accordance with the rules of Community law for the rights conferred by the patent to extend to such acts.

2. Paragraph 1 shall also apply with respect to a product put on the market by the owner of the national patent, granted in another Community State for the same invention, who is economically linked to the owner of the patent referred to in paragraph 1. For the purposes of this paragraph, two persons shall be deemed economically linked where one of them may exercise on the other, directly or indirectly, with regard to the working of the patent, a decisive influence or where a third person may exercise such influence on one and the other of these persons.

3. Paragraphs 1 and 2 shall not apply where the product has been put on the market under a compulsory or ex-officio license.

**Art. 49. Rights Conferred by the Patent for the Period Preceding its Grant**

1. Reasonable compensation to be set in accordance with the circumstances may be claimed by the patent owner from any third party who, during the period between the date on which the file of the patent application has been made public in accordance with Article 33.1 or the date on which a copy of the patent application, certified by the Service, has been notified to such third party, if such date is earlier than the first mentioned date, and the day on which the patent is granted, has exploited the invention in a manner



that, after such date, would be prohibited by reason of the patent.

2. Where the invention that is the subject matter of the patent application concerns the use of a microorganism the rights referred to in paragraph 1 may be exercised only for the period that begins with the day on which the culture was made accessible to the public under the conditions laid down by Ministerial regulation.

3. The right referred to in paragraph 1 shall be prescribed after three years as from termination of working by the third party of the invention that is the subject matter of the patent application or, if such termination occurs before the date of grant of the patent, after three years as from the latter date.

**Art. 50. Rights Deriving from Prior Use or Personal Possession**

1. Any person who, in good faith, at the filing date or priority date of a patent application, possessed in Luxembourg a justified right in the prior use of the invention that is the subject matter of the patent granted as a result of such application or a right of personal possession in such invention shall be entitled to exploit the invention, for personal use, despite the existence of the patent.

2. The rights conferred by a patent shall not extend to acts in relation to a product covered by the patent carried out on the Luxembourg territory once the product has been put on the market in the Grand Duchy of Luxembourg by the person who enjoys the right referred to in paragraph 1.

3. The right afforded by this Article may only be transferred together with the business, undertaking or part of the undertaking to which it belongs.

**Art. 51. Effects of Nullity of the Patent**

1. A patent application together with the patent resulting therefrom shall be deemed not to have had, ab origine, the effects set out in this Title depending on whether the patent is annulled in whole or in part.

2. Notwithstanding the application of the principles relating to actions for damages as a result of a fault or of bad faith on the part of the patent owner or relating to unjustified gain, the retroactive effect of nullity of the patent shall not effect:

(a) final decisions with respect to infringement that have been enforced prior to the decision on nullity;

(b) contracts concluded prior to the decision on nullity insofar as they have been executed prior to such decision; however, the return of amounts paid under the contract may be claimed for reasons of equity insofar as the circumstances warrant.

## TITLE VI THE PATENT APPLICATION OR PATENT AS AN OBJECT OF PROPERTY

### Art. 52. Joint Ownership

1. Joint ownership of a patent application or a patent shall be governed by the following provisions:

(a) Each joint owner may work the invention for his own benefit subject to equitably compensating the other joint owners who do not personally work the invention or who have not granted a license. Failing amicable agreement, such compensation shall be laid down by the Court.

(b) Each joint owner may take action for infringement for his own exclusive benefit. A joint owner who takes action for infringement shall notify the other joint owners of the action that has been brought; judgment shall be deferred until such notification has been provided.

(c) Each joint owner may grant to a third party a non-exclusive license for his own benefit subject to making equitable compensation to the other joint owners who do not personally work the invention or who have not granted a license. Failing amicable agreement, such compensation shall be laid down by the Court.

However, the draft licensing agreement must be notified to the other joint owners accompanied by an offer for transfer of the share at a specified price.

Within three months of such notification, any of the joint owners may oppose the granting of a license on condition that he acquires the share of the joint owner wishing to grant the license.

Failing agreement within the time limit laid down in the foregoing paragraph, the price shall be laid down by the Court. The parties shall have one month from notification of the judgment or, in the case of an appeal, of the decision, to forego the sale or the purchase of the joint initial share without prejudice to any damages which may be due; the costs shall be borne by the renouncing party.

(d) An exclusive license to work may be granted only with the consent of all joint owners or by one joint owner having the authorization of the Court.

(e) Each joint owner may transfer his share at any time. The joint owners shall enjoy a right of preemption during a period of three months as from notification of the proposed transfer. Failing agreement on the price, it shall be laid down by the Court. The parties shall have one month from notification of the judgement or,

in the case of an appeal, of the decision, to forego the sale or the purchase of the joint initial share without prejudice to any damages which may be due; the costs shall be borne by the renouncing party.

2. Articles 815 et seq., Article 1873a-1 and the following Articles and Articles 883 et seq. of the Civil Code shall not apply to the joint ownership of a patent application or a patent.

3. Any joint owner of a patent application or a patent may notify the other joint owners and the Service that he renounces his share in favor of the other joint owners. As from such notification and the entry of the renunciation in the Register, such joint owner shall be relieved of all obligations towards the other joint owners; the latter shall divide the relinquished share between them in proportion of their rights in the joint property.

4. In the absence of provisions to the contrary, the provisions of this Article shall apply. The joint owners may derogate therefrom at any time by means of a joint ownership agreement.

#### **Art. 53. Transmission and Constitution of Rights**

1. A patent application and a patent may, in whole or in part, be transmitted, give rise to the constitution of material or personal rights and be subject to enforcement measures.

2. Notwithstanding the case referred to in Article 16, any event or act referred to in paragraph 1 shall not prejudice rights acquired by third parties prior to the date of such act.

3. All events or acts that transmit or affect the rights deriving from a patent application or a patent may only be invoked against the Service or third parties if they are entered in the Register. However, prior to its entry, a given event or act may be invoked against third parties who have acquired rights after the date of the event or act, but who had knowledge thereof prior to their acquisition of the rights.

The notification to the Service shall be accompanied by:

(a) original evidence or certified copies proving the accomplishment of the events and acts referred to in paragraph 1;

(b) proof of payment of the administrative fee for entry and

publication of such an event or act.

4. Rights acquired by third parties in a patent application shall maintain their effects with regard to the patent granted as a result of such application.

**Art. 54. Assignment Inter Vivos**

Assignment inter vivos of a patent application or a patent shall be done in writing, on pain of nullity, except if it results from a judgment.

**Art. 55. Contractual Licenses**

1. A patent application or a patent may be the subject matter, in whole or in part, of licenses with respect to the whole or a part of the territory. The licenses may be exclusive or non-exclusive and be subject or not, in whole or in part, to transmission or sublicensing, as agreed by the parties. The agreement of the parties shall be set out in writing, on pain of nullity, unless it results from a judgment.

2. The rights conferred by a patent application or a patent may be invoked against a licensee who exceeds any of the limits of his licenses stipulated in accordance with paragraph 1.

**Art. 56. Licenses of Right**

1. If the owner of a patent application that has satisfied the requirements of Article 35 or of a patent files with the Service a written declaration according to which he is willing to authorize any interested party to use the invention, as a licensee, against payment of an adequate royalty, the annual fees for maintaining the patent application or a patent that fall due after receipt of the declaration shall be reduced to the extent laid down by Grand-Ducal regulation. Where a complete change of ownership occurs following a petition to the Court referred to in Articles 14 and 15, the declaration shall be deemed withdrawn as of the date of entry of the name of the entitled person in the Register.

2. The declaration may be withdrawn at any time by written communication to the Service on condition that the owner has not yet been informed of an intention to use the invention. Such withdrawal shall take effect on filing. The amount of the reduction in annual

fees shall be paid within one month as from withdrawal; Article 67.2 shall apply, whereby the six month period shall begin to run on expiry of the time limit stipulated above.

3. The declaration may not be filed if an exclusive license is entered in the Register or if a request for entry of such license has been filed with the Service.

4. As a result of such declaration, any person shall be entitled to use the invention as a licensee. A license may only be not-exclusive. A license obtained under the provisions of this Article shall be assimilated to a contractual license.

5. Failing agreement between the parties, the amount of the adequate royalty shall be laid down by the Court, which may modify that amount at the request of one of the parties if facts occur or become known that make the amount appear obviously inadequate. The licensee may at any time renounce his license.

6. A request for entry in the Register of an exclusive license shall be inadmissible if the declaration referred to in paragraph 1 has been made, unless the declaration has been withdrawn or deemed withdrawn.

#### **Art. 57. Pledges**

1. The pledging of a patent application or a patent shall be governed by the provisions applicable to the pledging of intangible movable assets. It shall be set out in writing, on pain of nullity. It shall be invocable against third parties on entry in the Register, which effects the dispossession of the owner.

2. Pledging shall not prevent the working of the invention by the owner of the patent application or the patent or by his successors in title, particularly by the beneficiaries of licenses afforded prior to pledging.

3. The effect of the entry of the pledge shall be to make null and void any assignment or further pledging effected without the consent of the creditor.

4. Sale of pledge shall be subject to the conditions set out in

Article 58.

5. A creditor who has paid the fees again due in place of the owner shall be entitled to recover that amount from the owner. Such claim shall be covered by the preferential claim under Article 2073 of the Civil Code.

6. The pledging of a patent application or a patent referred to in the Law of July 8, 1967 shall be admissible only after the lifting of the prohibitions applicable under Article 8 of that Law, on pain of nullity.

**Art. 58. Seizure**

1. Seizure of a patent application or a patent shall be at the request of the creditor in possession of a writ of execution under the procedure applicable to execution seizure.

2. The writ of execution shall be notified to the owner of the patent application or patent and to the Service, of which the head or the person replacing the head shall sign the original and proceed immediately ex-officio and without costs to entry of the seizure in the Register.

3. It shall not be necessary to constitute a custodian. Opposition to sale and opposition to the proceeds of sale shall be notified to the seizer and denounced on seizure and also to the Service that shall immediately enter a notice in the Register ex-officio and without cost.

4. Sale shall be effected at the auditory of the justice of peace following two successive announcements made in two newspapers appearing in Luxembourg.

5. Exercise of the rights deriving from a patent application or a patent by the acquirer of such rights shall be subject to entry of the forced sale in the Register.

## TITLE VII COMPULSORY LICENSES AND EX-OFFICIO LICENSES

### **Art. 59. Compulsory Licenses**

1. On expiry of a period of three years from the grant of a patent or four years from the filing date of the patent application, whereby the period of time that expires the latest shall be taken into consideration, and subject to the conditions laid down in the following Articles, any public or private legal person may be granted a compulsory license under the patent provided that, at the time of the application for such license and failing legitimate reasons, neither the owner of the patent nor his successor in title:

(a) has begun to work or has made real and effective preparations for working the invention that is the subject matter of the patent on the territory of the Grand Duchy or of any other State Member of the Agreement Establishing the WTO;

(b) has worked the invention that is the subject matter of the patent in a manner sufficient to satisfy the needs of the Luxembourg market.

2. The same shall apply where working in the Grand Duchy or another State Member of the Agreement Establishing the WTO has been discontinued for more than three years.

### **Art. 60. Procedure for Obtaining and Conditions of a Compulsory License**

1. The request for a compulsory license shall be made to the Court; it shall be accompanied by proof that the requester has not been able to obtain a license from the owner of the patent and that he is in a position to work the invention in an effective and serious manner.

2. The license may only be non-exclusive; it shall be granted on fixed terms, particularly in respect of its duration, its field of application and the amount of the royalties to be paid in consideration thereof. Those terms may be amended by court decision on a request by the owner or the licensee.

3. A license shall be granted mainly for the supply of the Luxembourg market. When setting the amount of the royalties, the Court shall take into account the economic value of the license.



4. Judgments given in accordance with the above provisions shall be subject to appeal whatever the value in dispute.

**Art. 61. Withdrawal of Compulsory License**

1. If the holder of a compulsory license fails to comply with the terms under which the license was granted, the owner of the patent and, as appropriate, the other licensees may obtain withdrawal of the license by the Court.

2. Withdrawal of a compulsory license may also be obtained where the circumstances that had led to its granting cease to exist and will not reoccur in all probability.

**Art. 62. Dependent Patents**

1. The owner of a patent concerning an improvement of an invention already patented on behalf of another person may not work his invention without the consent of the owner of the earlier patent; the latter owner may not work the patented improvement without the consent of the owner of the patent of improvement.

2. After hearing the public prosecutor, and in the public interest, the Court may grant to the owner of the patent of improvement, at his request which shall not be made before expiry of the period specified in Article 59, a non-exclusive license to the extent necessary for working the invention that is the subject of the patent of improvement and to the extent that the invention that is the subject of the patent of improvement constitutes a substantial technical advance and significant economic value in relation to the earlier patent. On a request submitted to the Court, the owner of the earlier patent shall be granted a license under the patent of improvement.

3. The provisions of Articles 59, 60, 61 and 65 shall apply.

**Art. 63. Ex-Officio Licenses**

1. A patent shall be subject to ex-officio licensing if a Grand-Ducal Order, following the compulsory opinion of the Council of State, has declared the implementation of the invention to be of public interest. Save in cases of emergency, such order may not be issued unless it is established that the owner of the patent is not willing to voluntarily grant licenses under reasonable commercial

conditions and terms.

2. As from the date of publication of the order subjecting the patent to ex-officio licensing, any qualified person may apply to the Minister for the grant of a license to work the patent. Such license may only be non-exclusive and shall be granted by an order of the Minister on fixed conditions, in particular with regard to its duration and field of application, but excluding the amount of royalties to be paid in consideration thereof. The license shall take effect from the date of notification of the order to the parties.

3. Failing amicable agreement between the parties concerned, the amount of the royalties shall be laid down by the Court. In setting the amount of the royalties, the Court shall take into account the economic value of the license.

4. An ex-officio license may be withdrawn by a reasoned order of the Minister on expiry of a period of time to be laid down in the order granting the license if the patented invention is not worked in a serious manner or if the working does not comply with the conditions that have been imposed or agreed. It may also be withdrawn if the circumstances that have led to its being granted cease to exist and will not reoccur in all probability.

**Art. 63bis. Compulsory or Ex-Officio Licenses in the Field of Semiconductors**

If the subject matter of a patent is an invention in the field of semiconductor technology, a compulsory or ex-officio license may be granted only for a use that is intended to remedy a practice that has been declared contrary to competition law following judicial or administrative proceedings.

**Art. 64. Obligations of the Owner of a Patent that is the Subject Matter of a Compulsory License or an Ex-Officio License**

The owner of a patent that is the subject matter of a compulsory license or an ex-officio license shall be required to supply to the licensee, at the time of the grant of the license, any technical information that is in his possession at that time and is essential for the implementation of the patented invention.

**Art. 65. Transfer of a Compulsory License or an Ex-Officio License**

1. The rights deriving from a compulsory license or an ex-officio license may only be assigned together with the business, undertaking or part of the undertaking to which they belong.

2. A license as referred to in Article 62.2, first sentence, may furthermore only be assigned together with the patent of improvement.

**Art. 66. Entry of Decisions Relating to Compulsory License and Ex-Officio Licenses**

1. Compulsory licenses, ex-officio licenses and decisions relating to them shall be entered in the Register at the request of the beneficiary on submission of a certified copy of the record of the Court or administrative decision that has granted them or, where appropriate, has modified them and proof of payment of the entry fee.

2. The exercise of rights deriving from a compulsory license or an ex-officio license by the licensee shall be subject to fulfillment of the entry formalities.

## **TITLE VIII MAINTENANCE, REINSTATEMENT, RENUNCIATION AND NULLITY**

### **Art. 67. Maintenance**

1. All patent applications and patents shall be subject to the payment in advance of annual, progressive fees for their maintenance. These fees shall fall due on the last day of the anniversary month of the filing of the application and may not be validly paid more than 12 months before the due date.

2. Where an annual fee has not been paid at the due date, the fee may still be validly paid within a period of six months as from the due date subject to the payment at the same time of an additional fee. The end of this period of grace shall in all cases be extended to the last day of the following month to be taken into consideration notwithstanding the provisions of Article 90.4. A Grand-Ducal regulation may provide that any fee paid within the period of grace applicable to payment of the annual fee shall be considered to have been paid at the same time within the meaning of this paragraph.

3. A notice of payment of the annual fees and additional fees shall be entered in the Register.

4. If the annual fee and, where appropriate, the additional fee have not been paid within the time limits or if the annual fee and the additional fee have not been paid at the same time within the meaning of paragraph 2, the owner of the patent application or of the patent shall be automatically deprived of his rights. Loss of rights shall take effect as of the filing date or the anniversary date of the filing with reference to which the due date of the annual fee that has not been paid or has not been regularly paid is determined.

### **Art. 68. Payment of Annual Fees**

1. The payment of annual fees shall be subject to notification to the Service of a postal address in Luxembourg for the transmission of official communications relating to such payment.

2. However, failure to make such notification shall not invalidate the payment.

**Art. 69. Extension of Time Limits for Payment and Reinstatement of Rights as a General Measure**

1. A Grand-Ducal regulation may, with respect to exceptional situations and by a general measure, grant an extension of the time limits for the payment of annual fees or for other time limits that it shall specify and for which it shall lay down the conditions.

2. The extension of time limits for the payment of annual fees or of other time limits may not be longer than one year, but may be renewed from year to year.

3. The Grand-Ducal regulation may provide that during the period of extension or renewal of extension of the time limits for the payment of annual fees or of other time limits the fees that should normally have been paid during the last three years at most having preceded such period may be paid or the procedural acts which should normally have taken place during that same period of time may be carried out subject to payment of any fee required by virtue of that regulation.

**Art. 70. Reinstatement on Individual Decision**

1. The rights deriving from a patent application or a patent which, due to failure to pay an annual fee, have lapsed for reasons independent of the will of the owner and which have not been subject to an extension of time limits on the basis of the preceding Article, may be reinstated by individual Ministerial decision. The request for reinstatement shall be submitted to the Service within 20 months as from the date of lapse of the rights.

2. If the request for reinstatement is recognized to be justified, the Service shall invite the owner of the application or patent to pay within one month the due fees together with a reinstatement fee. The Ministerial order shall be issued only after the fees have been paid within the prescribed time limit.

3. Reinstatement of a patent application or of a patent under this Article shall be entered in the Register and an extract published in the Mémorial.

**Art. 71. Preservation of Third Party Rights**

Paragraph 6 of Article 40 shall apply in the cases referred to in Articles 69 and 70.

**Art. 72. Full or Partial Renunciation of the Patent**

A patent owner may at any time renounce his patent or one or more of the claims contained therein. In such case, Article 32 shall apply mutatis mutandis.

**Art. 73. Causes of Nullity**

1. A request for nullity of a patent may be based only on one of the following reasons:

(a) the subject matter of the patent is not patentable under Articles 4 to 9 of this Law;

(b) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

(c) the subject matter of the patent extends beyond the content of the patent application as filed or, if the patent was granted on the basis of a divisional application or of a new patent application filed in accordance with Article 14, beyond the content of the initial patent as filed;

(d) the protection conferred by the patent has been extended;

(e) the owner of the patent did not have the right to obtain the patent under Article 12.

2. If the grounds for nullity affect the patent in part only, nullity shall be pronounced in the form of a corresponding limitation of the patent. The limitation shall be effected in the form of cancellation of one or more claims, sentences in the description or figures in the drawings or, exceptionally, in the form of an amendment of the claims, the description or the drawings.

**Art. 74. Actions for Nullity and Contestation of Ownership**

1. Actions for nullity or contestation of ownership of a patent shall be heard, whatever the value of the petition, by the Court of the elected domicile of the patent owner.

2. The petition to the Court shall be entered in the Register on pain of inadmissibility.

3. All successors in title to the patent entered in the Register shall be implicated, on pain of the same sanction.

4. The case shall be examined and judged in summary proceedings. It shall be communicated to the public prosecutor. The judgment of the Court shall be subject to opposition or appeal whatever the value in dispute. An appeal in cassation against the decision of the appeal court shall be available in the cases, within the time limits and in accordance with the form laid down for appeals in civil and commercial matters.

5. The public prosecutor may act ex-officio as principal party in patent nullity under the conditions set out above.

6. The action for nullity may be exercised even if the patent has lapsed.

7. The costs incurred by the public prosecutor shall be fixed, determined and recovered as in criminal matters.

**Art. 75. Entry of Decision**

1. A final court decision shall be entered in the Register at the request of the court registry or, failing that, of the first party to act.

2. A notice thereof shall be published in the Mémorial, Recueil administratif et économique.

## **TITLE IX INFRINGEMENT**

### **Art. 76. Acts Constituting Infringement**

1. Any violation of the rights of the owner of a patent, as set forth in Articles 45, 46, 47 and 48, shall constitute an infringement.

2. An infringement shall imply the civil liability of the infringer.

3. However, offering, putting on the market, use, holding with a view to use or putting on the market of an infringing product, where such acts are committed by a person other than the manufacturer of the infringing product, shall only imply the liability of the person committing them if such acts have been committed in full knowledge of the facts.

### **Art. 77. Persons Entitled to Institute Infringement Proceedings**

1. Infringement proceedings shall be instituted by the owner of the patent.

2. However, the beneficiary of an exclusive exploitation right may, except as otherwise stipulated in the licensing contract, institute infringement proceedings if, after notice, the owner of the patent does not institute such proceedings.

The patentee shall be entitled to take part in the infringement proceedings instituted by the licensee under the preceding paragraph.

3. The holder of a license of right, a compulsory license or an ex-officio license, as referred to in Articles 56, 59, 62 and 63, may institute infringement proceedings if, after formal notice, the owner of the patent does not institute such proceedings.

4. Any licensee shall be entitled to take part in the infringement proceedings instituted by the patentee in order to obtain compensation for an injury he has personally sustained.

### **Art. 78. Proceedings Based on a Patent Application and/or in Respect of Events that Occurred Prior to Grant of the Patent**

1. Notwithstanding the rights deriving from a patent or a patent application during the periods defined in Articles 43 and 49, events prior to the date on which the patent application has been made



public under Article 33.1 or prior to the date of notification to any third party making use or preparing to make use of rights deriving from a certified copy of such application, shall not be considered to prejudice the rights deriving from the patent.

2. From the dates referred to in the preceding paragraph to the date of granting of the patent:

(a) the patent shall only be invokable if the claims have not been extended after the first of those dates;

(b) where the patent concerns the use of a microorganism, it shall not be invokable until the day on which the microorganism has been made available to the public.

3. The Court hearing proceedings based on Article 49.1 shall reserve judgment until the patent has been granted.

**Art. 79. Description, Infringement Seizure and Provisional Cessation**

1. Persons entitled to institute infringement proceedings under Article 77 may, on a simple request, be authorized by the President of the District Court to have a detailed description carried out, by one or more sworn experts designated by the President, of the allegedly infringing articles together with the instruments that have served to commit the alleged infringement, whoever the owner of such articles and instruments may be.

2. Such persons may, by means of the same order of the President or of a subsequent order, be authorized to have the effective seizure of the articles and instruments referred to in paragraph 1 carried out by a bailiff, assisted by the afore-designated expert or experts. Before carrying out the seizure, the bailiff shall give to the holders of the articles and instruments to be seized, on pain of nullity and liability to damages, a copy of the seizure order and of the seizure report together with, where appropriate, the act recording the deposit of a security referred to in paragraph 4. The custody of the articles and instruments may be entrusted to a custodian designated by the President.

3. The President of the court may, at the request of a person entitled to institute infringement proceedings, in accordance with

Article 77, issue an order in chambers enjoining any person against whom there exists a serious presumption of infringement to provisionally cease the activity considered to constitute infringement.

4. When ordering the effective seizure or provisional cessation under paragraphs 2 and 3, the President may require from the plaintiff a security that shall be deposited before the seizure may be carried out or before the provisional cessation measure may be executed.

5. The President shall determine the duration of the effects of the measures taken in accordance with paragraphs 1, 2 and 3, which may not exceed a period of three months as from notification of the order to the person or to his domicile.

If the petitioner fails to institute proceedings before the Court within the prescribed time limits, the description or seizure shall automatically be void, without prejudice to any damages that may be claimed where appropriate.

If the petitioner institutes proceedings before the Court within the prescribed time limit, the President may extend the duration of the effects of the seizure and provisional cessation orders for successive terms which may not exceed three months each.

6. Infringement seizure shall preclude any sale by measure of execution.

7. The order referred to in paragraphs 1, 2, 3 and 5, shall be provisionally enforceable notwithstanding any opposition, on record and prior to registration.

It shall not be subject to either opposition or third party opposition.

It may be appealed from by the petitioner and by the person against whom the measure is ordered within 15 days as from notification.

Appeals shall be heard as an urgent matter in summary proceedings without the requirement that written conclusions be notified or taken at the hearing.

The appeal decision given by default shall be subject to opposition within 15 days as from notification to the person or to his domicile.

**Art. 80. Infringement Proceedings and Damages**

1. Patent infringement proceedings and proceedings for infringement damages shall be heard exclusively by the District Court whatever the value of the petition.

2. The case shall be examined and judged in summary proceedings.

3. A cross action for patent nullity opposed to a main action for infringement shall be admissible only under the conditions laid down in Article 74.2 and 3. Compliance with those conditions shall not be required if the defendant in the infringement proceedings restricts himself to invoking nullity of the patent as a simple means of defense without requesting the court to pronounce nullity.

4. If the infringement proceedings are recognized as justified, the Court shall order the infringer or, where appropriate, more than one infringer jointly:

(a) to cease the infringement;

(b) to pay damages to make good the prejudice caused to the plaintiff.

5. The cessation order may be accompanied by the penalty of a daily fine. The Court may authorize publication of the judgment or of an extract thereof in one or more newspapers at the expense of the infringer or infringers.

**Art. 80bis. Process Patents: Burden of Proof**

1. If the subject matter of the patent is a process for obtaining a product, the Court hearing infringement proceedings may order the defendant to prove that the process used to obtain an identical product is different from the patented process. If the defendant fails to adduce such proof, any identical product manufactured without the consent of the owner of the patent shall be presumed to have been obtained by means of the patented process:

(a) if the product obtained by the patented process is new;

(b) or if there is the likelihood that the identical product has been obtained by means of the patented process even if the owner of the patent has not been able, despite reasonable effort, to determine which process has in fact been used.

2. When establishing the proof, consideration shall be taken of the legitimate interests of the defendant in protecting his industrial and commercial secrets.

**Art. 81. Confiscation**

1. At the request of the injured party, and where such measure is necessary to prevent continuing infringement, the Court may order confiscation, in favor of the plaintiff, of the articles recognized as constituting an infringement, which are the property of the infringer, on the date of entry into force of the prohibition and, where appropriate, of the devices or means specifically intended for committing the infringement.

The value of the articles confiscated shall be taken into account when computing the compensation to be awarded to the beneficiary of the decision.

2. Confiscation for the benefit of the plaintiff may be ordered even if the articles in question have been seized under a writ of execution or if the defendant is subject to bankruptcy or other collective liquidation arrangements.

3. At the request of the injured party, and where such measure is necessary, the Court may order the destruction, at the expense of the infringer, of the articles recognized as constituting an infringement and of the instruments, devices or means specifically intended for committing the infringement.

4. Confiscation for the benefit of the plaintiff provided for in paragraph 1 may concern, in whole or in part, elements of a realty nature without the petition having been registered with the Office of Mortgages.

**Art. 82. Prescription of Infringement Proceedings**

Without prejudice to the rule of prescription applicable to proceedings instituted on the basis of Article 49.1, infringement proceedings shall be prescribed after three years as from the last infringing act. Prescription shall be suspended by any cessation notice served by a bailiff and by any proceedings for cessation or damages instituted before the Court or effected in the same form under an arbitration clause.

## **TITLE X REPRESENTATION**

### **Art. 83. General Principles of Representation**

1. Subject to the provisions of paragraph 3, no person shall be compelled to be represented by a professional representative in proceedings established by this Law.

2. Natural or legal persons having their domicile or their headquarters on the territory of the European Economic Community may act through an employee in any proceedings established by this Law; such employee shall be in possession of powers in accordance with the legal, regulatory and statutory provisions of the national legislation applicable to the person represented but shall not be required to be a professional representative. The employee of a legal person referred to in this paragraph may also act for other legal persons who have their headquarters on the territory of the European Economic Community and who have economic links with such legal person.

3. Natural or legal persons not having either domicile or headquarters on the territory of the European Economic Community must be represented by a professional representative and act through him in all proceedings established by this Law, not including the payment of the fees provided for by this Law, other than that for filing a patent application.

4. No person may exercise rights deriving from a patent application or a patent if he has neither a real nor elected domicile in the Grand Duchy of Luxembourg. Election of domicile a Luxembourg, where appropriate, implies power of jurisdiction and may only be effected with respect to a professional representative registered in Luxembourg. If the latter has no real domicile in the country, he must elect domicile with a professional representative having real domicile in Luxembourg.

5. In the event of failure to fulfill or to cease the effects of one of the conditions set out in paragraphs 2 to 4 of this Article, the Service or the Court shall invite the owner of the patent application or of the patent to remedy such defect, subject to suspension of the effects of the rights deriving from the irregular act until such time as the defect is remedied, or to lapse of the

right or rights concerned, where not remedied within a period of two months after the relevant invitation by the Service or the Court, without prejudice to the application of Articles 40, 69 and 70.

6. Except in the cases referred to above, where recourse to a representative is not compulsory or may be carried out by an employee, the representation of natural or legal persons in proceedings established by this Law may be carried out only by representatives authorized on the basis of Articles 84 and 85.

7. If a representative is designated, notifications and communications shall be made to such representative. If more than one representative has been designated for one single party, it shall suffice for notifications and communications to be made to one of such representatives.

#### **Art. 84. Appointment of a Common Representative**

1. If there is more than one applicant and the request for the grant of a patent does not name a common representative, the applicant first named in the request shall be considered to be the common representative. However, if one of the applicants is obliged to appoint a professional representative, such representative shall be considered to be the common representative unless the first named applicant has appointed a professional representative.

2. If, during the course of proceedings, transfer is made to more than one person, and such persons have not appointed a common representative, paragraph 1 shall apply. If such application is not possible, the Service or, where appropriate, the Court shall require such persons to appoint a common representative within two months. If this request is not complied with, the Service or, where appropriate, the Court shall appoint the common representative.

3. The submission to the Service of a document replacing the common representative shall be subject to the payment of a fee.

#### **Art. 85. Register of Professional Representatives**

1. The Service shall keep a register of professional patent representatives.

2. Subject to the provisions of paragraph 2 of Article 83, those

natural persons shall be considered professional representatives with real domicile in the Grand Duchy of Luxembourg within the meaning of the second sentence of paragraph 4 of Article 83, in addition to lawyers members of the Order before the Luxembourg courts, who are authorized to exercise the profession of industrial property agent by the Law of December 28, 1988 (a) regulating access to the professions of craftsman, tradesman, industrialist and to certain liberal professions; (b) amending Article 4 of the Law of July 2, 1935 regulating the conditions for obtaining the title and master's certificate for the exercise of trades, without prejudice to acquired rights reserved in accordance with item (b) of Article 5 of the Grand-Ducal Regulation of January 12, 1977 setting out the professional qualification required for access to the profession of industrial property agent.

3. The register of professional representatives mentioning, in addition to the persons specifically concerned, the rights of the categories of person entitled to act with respect to patents without being entered by name in the register, as is the case of lawyers, as also the limitation of rights of those acting in their capacity as employee of given persons, shall be kept available to the public.

4. The entry and removal of persons to be shown by name in the register shall be done on production to the Service of the relevant documents.

## **TITLE XI MISCELLANEOUS PROVISIONS**

### **Art. 86. Changes to be Notified to the Service**

Changes that occur in the designation of the owner of the patent application or patent, in the designation of their representatives and of the common representative or which concern the elected domicile or postal address shall be notified to the Service in writing. Until such information has been provided, the person previously designated shall remain, with regard to third parties and to the administration, subject to the obligations under this Law and all notifications and communications shall be validly made at the elected domicile or postal address previously communicated.

### **Art. 87. Register**

The Service shall keep a Register in which shall be entered all particulars whose registration is required by this Law. No entry shall be made in the Register before the application has been published. The Register shall be open to public inspection.

### **Art. 88. Public Inspection**

1. The files relating to patent applications which have not yet been published shall not be made available for inspection without the consent of the applicant.

2. Any person who can prove that the applicant for a patent has invoked the rights under an application against him may obtain inspection of the files prior to the publication of that application and without the consent of the applicant.

3. Where a divisional application or a new patent application filed under Article 14.2 is published, any person may obtain inspection of the files of the original application prior to the publication of that application and without the consent of the applicant.

4. Subsequent to the publication of the patent application, the files relating to such application and the resultant patent may be inspected on request; copies may be obtained against payment of the fees to be prescribed.

5. Even prior to the publication of the patent application, the Service may communicate the following bibliographic data to third



parties or publish them:

- (a) the number of the patent application;
- (b) the date of filing of the patent application and, where the priority of a previous application is claimed, the date, State and file number of the previous application;
- (c) the name of the applicant;
- (d) the title of the invention.

6. In all cases, the document bearing the name of the inventor shall be withdrawn from the file if the inventor has opposed, in application of Article 17, communication of his identity to third parties.

**Art. 89. Implementing Regulations and Schedules of Fees**

1. Unless already provided by this Law, the Grand-Ducal regulations setting out the implementing measures shall lay down, in particular, the formalities and time limits.

2. A Grand-Ducal regulation shall establish the schedule of the various fees and additional fees to be paid in accordance with this Law and shall determine their mode of payment. None of the annual fees may exceed an amount of 20,000 francs. The other fees and additional fees may be neither less than 200 francs nor more than 2,000 francs.

3. In addition to the fees, reimbursement of expenses shall be required:

- (a) for all ancillary work by the Service such as copies, attestations, searches;
- (b) for the costs of publication in the Mémorial;
- (c) for the search report referred to in Article 31.4, in Article 35.1(a) and in Article 36.

4. Fees paid in accordance with this Law shall not be refunded.

**Art. 90. Calculation of Time Limits**

1. Periods shall be laid down in terms of full years, months, weeks or days.

2. Computation shall start on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another period. Where the procedural step is a notification, the event considered shall be the receipt of the document notified, unless otherwise provided.

3. When a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

4. When a period is expressed as one month or a certain number of months, it shall expire on the relevant subsequent month on the day which has the same number as the day on which the event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

5. When a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the event occurred.

6. When a period would normally expire on a Saturday, a Sunday, a public holiday, replacement public holiday or any other day on which the Service is closed, it shall be extended up to the first working day that follows. For the purposes of this provision, Saturday shall be assimilated to a public holiday.

7. When a period is computed as from the priority date and more than one priority is claimed, the date of the earliest priority shall be applicable.

## **TITLE XII APPEALS**

### **Art. 91. Competence and Procedure**

1. Appeals shall lie to the Minister from decisions taken by the head of the Service in application of this Law or of its Implementing Regulations. Such appeal must be lodged, on pain of preclusion, within three months of notification of the decision.

2. Appeals shall lie from decisions taken by the Minister under this Law or its Implementing Regulations, including decisions taken by the Minister in accordance with paragraph 1, to the Council of State, Disputes Committee, that shall take its decision on the merits and in final instance.

## **TITLE XIII EUROPEAN PATENT APPLICATIONS AND EUROPEAN PATENTS**

### **Art. 92. Translations and Annual Fees**

1. The first paragraph of Article 4 of the Law of May 27, 1977 (a) approving the Convention on the Grant of European Patents, signed at Munich on October 5, 1973, (b) amending the national legislation on patents shall be replaced by the following wording:

"Where the patent application has been published in a language other than French or German, the compensation provided for in the preceding Article may only be claimed for the period following the day on which a translation of the claims in one of the two above-mentioned languages has been submitted to the industrial property service and made accessible to the public or handed to the person exploiting the invention."

2. The first paragraph of Article 6 of the Law of May 27, 1997 shall be amended as follows:

"Third parties may invoke against the proprietor of the patent the text of the claims of the European patent application in the translation provided for by Article 4 where the text of the European patent application affords less extensive protection than the text in the language of the proceedings."

3. The second paragraph of Article 10 of the aforementioned law of May 27, 1977 shall be amended as follows:

"The amount of the renewal fees and, where appropriate, the additional fees to be paid shall be laid down by Grand-Ducal regulation. The arrangements for the payment of those fees shall be the same as those laid down for Luxembourg application and patents."

### **Art. 93. National Administrative Formalities**

All transactions carried out before the Service in relation to a European patent application may be effected without the intervention of a professional representative.

Where the translation of the claims of the European patent application is filed by a third party such third party shall be required to prove his capacity to act by means of a power of attorney on pain of inadmissibility.

**Art. 94. Concurrence of a European Patent and a National Patent Application**

The European patent shall be null and void with regard to its effects on the territory of the Grand Duchy of Luxembourg if the rights deriving therefrom were generated subsequently to the filing date or priority date of an application for a Luxembourg patent relating to the same invention and of which the file has been made available to the public in accordance with Article 33 at that date only or at a later date.

## TITLE XIV INTERNATIONAL PATENT APPLICATIONS

### Art. 95. Examination of International Applications Entering the National Phase

Article 6 of the Law of May 27, 1977 (a) approving the Patent Cooperation Treaty done at Washington on June 19, 1970 and (b) amending the national legislation on patents shall be replaced by the following wording:

"The Service shall act as designated Office or elected Office as defined in Article 2 of the Patent Cooperation Treaty with respect to international applications by which protection of the invention is sought in the Grand Duchy of Luxembourg, on condition, however, that those international applications do not have the effect of a European patent application.

If protection of an invention in the Grand Duchy of Luxembourg is sought by means of an international application for which the Service acts as designated Office or elected Office, the owner shall be required, prior to expiry of the time limit applicable in accordance with Article 22 or 39 of the Patent Cooperation Treaty, to pay the due national fees as if it were a national application that had been filed on the same day as the international application and to provide all information and documents that would be required in relation to a regularly filed national application. If the international application has not been published by the International Bureau in German or French, the owner shall also be required to file within the same time limit a translation into one of those two languages.

The additional periods afforded for the payment of national fees or for producing information, documents and translations that would be required in relation to a national application shall also be afforded the owner of an international application and shall begin as from the expiry date of the time limit applicable in accordance with Articles 22 and 39 of the Patent Cooperation Treaty.

Where the international application is dealt with by the Service under Article 23(2) of the Patent Cooperation Treaty, the formalities referred to in paragraph 2 shall be accomplished in anticipation at the time of presentation of the special request formulated by the owner of the international application. In such case, the additional periods referred to in the third paragraph shall begin to run on the day of presentation of the special request. Should the special request not be followed by withdrawal of the

international application or withdrawal of the designation of the Grand Duchy of Luxembourg, the prosecution of the international application shall be resumed on the basis of the international search report published by the International Bureau, unless the applicant has himself filed, within a period of four months as from expiry of the time limit applicable under Article 22 or 39 of the Patent Cooperation Treaty either the official request for the drawing up of a national search report or one or more search reports that would be required in relation to a national application."

## **TITLE XV TRANSITIONAL AND FINAL PROVISIONS**

### **Art. 96. Law Applicable During a Transitional Period**

1. Patent applications filed before the date of entry into force of this Law and the patents resulting therefrom shall remain subject to the rules applicable on the filing date of the patent application.

Likewise, as from the date of entry into force of this Law, the rules applicable prior to that date shall continue to apply to applications for certificates of addition and to certificates of addition on condition that the application from which the certificate of addition has resulted was validly received prior to that date under the arrangements of the previous legislation.

2. However, the exercise of the rights deriving from such titles and applications shall be governed by the provisions of this Law, as from the day of its entry into force, subject to any acquired rights that shall be maintained.

3. The annual fees to be paid for the maintenance of patents and which have become due prior to the date of entry into force of this Law shall remain subject to the previous statutory and regulatory provisions even if the payment takes place after that date.

4. The annual fees that become due after the entry into force of this Law shall be subject to application of the new legislation unless payment had already been made before that date.

### **Art. 97. Institution of Infringement Proceedings During a Transitional Period**

1. Civil proceedings for infringement of a patent that are pending before the appeal courts at the time of the entry into force of this Law shall be referred ex-officio to the civil courts at the same level and entered on the cause list to be prosecuted in accordance with the rules laid down in Article 80.

2. The registrar of the civil court shall inform the parties of its entry on the cause list. If the parties voluntarily brief a lawyer, the instance shall continue by simple act from lawyer to lawyer. Failing a voluntary brief, the plaintiff shall summons the defendant to brief a lawyer and to continue the proceedings before the civil court.



3. Cases pending before the Court of Cassation at the time of entry into force of this Law shall be settled by that court and referred, after cassation, to a civil chamber of the Court of Appeal.

4. The exercise of legal remedies against decisions taken, prior to the entry into force of this Law, in civil proceedings for patent infringement heard by the penal courts, shall continue to be governed, with regard to the form and the time limits, by the provisions applicable in criminal matters. Decisions shall be taken according to the form of civil proceedings.

**Art. 98. Confirmation of Earlier Entries in the Register of Professional Representatives**

Persons entered in the register of professional representatives provided for by Article 5 of the Law of October 31, 1978 (a) approving the Convention for the European Patent for the Common Market, signed at Luxembourg on December 15, 1975, (b) adapting national legislation on patents shall remain validly entered under the arrangements established by this Law.

**Art. 99. International Patent Classification**

Article 2 of the Law of December 10, 1975 approving the Strasbourg Agreement Concerning the International Patent Classification signed in Strasbourg on March 24, 1971 shall be replaced by the following wording:

"The Intellectual Property Service shall be responsible for the application of the International Patent Classification. In carrying out that task, it shall be authorized to use the services of the European Patent Office in Munich and communicate to that office the content of Luxembourg patent applications that have not yet been made available to the public."

**Art. 100. National Industrial Property Council**

There may be established in the Ministerial department responsible for industrial property matters a national industrial property council of which the task shall be to deliberate on matters relating to industrial property submitted to it by the Minister and to make proposals on any issue concerning industrial property.

The composition and conditions of operation of the national industrial property council shall be laid down by Grand-Ducal

regulation.

**Art. 101. Repeal Provisions**

Subject to certain of the transitional provisions in Articles 96 and 98, there shall be repealed:

1. the Law on Patents for Invention of June 30, 1880;
2. the Law on the Accession of the Grand Duchy of Luxembourg to the International Union for the Protection of Industrial Property of April 27, 1922 where it has amended the Law of June 30, 1880;
3. the Grand-Ducal Order of October 13, 1945 amending and supplementing the legislation on patents for invention;
4. the Law of June 25, 1957 approving the European Convention relating to the formalities required for patent applications, signed in Paris on December 11, 1953;
5. Articles 4, 5 and 6 of the Law of October 31, 1978 (a) approving the Convention for the European Patent for the Common Market, signed at Luxembourg on December 15, 1975, (b) adapting national legislation on patents;
6. all provisions contrary to this Law.

**Art. 102. Entry into Force**

A Grand-Ducal regulation shall lay down the entry into force of Articles 1 to 101 of this Law.