

**DRAFT**



## **THE PATENT ACT OF LIBERIA, 2014**

# **THE PATENT ACT OF LIBERIA, 2014**

It is enacted by the Senate and House of Representatives of the Republic of Liberia in  
Legislature Assembled:

## **SECTION 1. *Short Title***

This Act may be cited as the “Patent Act”.

## **SECTION 2 *Repealer***

Chapter 3, All provisions of Part I Patents and Part II International Applications under the Patent Cooperation Treaty, and Part V General Provisions of the Industrial Property Act of Liberia dated April 30, 2003 are hereby repealed. The Patent Act of Liberia shall read as follows:

## **PART I**

### **PRELIMINARY PROVISIONS**

#### **§1.1. Purpose**

The purpose of this Act is to provide for the promotion of inventive and innovative activities, to facilitate the acquisition of technology through the grant and regulation of patents, and utility models.

#### **§1.2 Definitions**

In this chapter, unless the context otherwise requires,

“Budapest Treaty” means the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, done at Budapest on April 28, 1977, as amended;

“compulsory license” means an authorization given under this Act to allow a person to exploit an invention, utility model or layout-design patented or registered in Liberia;

“court” means a court of justice in Liberia;

“Director General” means the Director General of the Liberia Intellectual Property Office;

“Exploitation” means any of the following acts:

- (a) if the patent has been granted in respect of a product:
  - (i) making, offering for sale, selling and using the product;
  - (ii) importing such product for the purposes of offering for sale, selling or using the product;
- (b) if the patent has been granted in respect of a process:
  - (i) using the process;
  - (ii) doing any of the acts referred to in item (a) in respect of a product obtained directly by means of the process.

“Exclusive license” means a license granted to the effect that the licensor is bound to abstain from granting any equivalent license to another person in Liberia and, to abstain from exploiting the licensed industrial property right himself in Liberia;

“Intellectual Property Office” means the office established under §1.1 of this Act;

“International Classification” means, as regards patents of invention, the classification as established by the Strasbourg Agreement concerning the International Patent Classification, of March 24, 1971, as amended;

“Invention” means an idea that permits in practice the solution to a specific problem in the field of technology; an invention may be a product or a process;

“Minister” means the Minister of Commerce & Industry;

“Office” means the Intellectual Property Office;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised;

“Patent” means the title granted in respect of an invention claimed in a patent application under this Act;

“Patent Cooperation Treaty” means the Patent Cooperation Treaty, done at Washington on June 19, 1970, as amended;

“Priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“TRIPS Agreement” means the Agreement on Trade-related aspects of Intellectual Property contained in Annex 1C of the Agreement establishing the World Trade Organization, concluded in Marrakesh on April 15, 1994; and

“Utility Model” means

## **PART II**

### **PATENTS; PATENTABILITY**

#### **§2.1. Scope of Inventions**

(a) The following matters shall not be regarded as inventions for the purpose of this Act:

- (i.) matter that does not comply with the definition of invention under Section 1.1 of this Act;
- (ii.) discoveries, scientific theories and mathematical methods;
- (iii.) schemes, rules or methods for doing business, performing mental acts or playing games;
- (iv.) products of nature and substances obtained or extracted from nature, even if purified or otherwise isolated from nature; this exclusion shall not apply to the processes of isolating those natural substances;
- (v.) computer programs and the presentation of information;
- (vi.) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body; this provision shall not apply to products for use in any of those methods.

(b) The following matter shall be excluded from patent protection:

- (i.) plants and animals, including parts thereof, other than micro-organisms, and essentially biological processes for the production of plants or animals and parts thereof, other than non-biological and microbiological processes;
- (ii.) animal and plant varieties;
- (iii.) inventions, the prevention within the territory of Liberia of the commercial exploitation of which is necessary to protect public order or morality; such exclusion shall not be made merely because the exploitation of those inventions is prohibited by law or subject to regulation;

(iv.) pharmaceutical products until January 1, 2016, or until the expiry of such a later period of extension agreed upon by the World Trade Organization for least developed countries.

(c) The Director General may by regulation determine that any exclusion under this sub-section is suspended should national policy or market circumstances so require pursuant to the policy directives of the Minister..]

## **§2.2. Patentable Inventions**

(a) An invention is patentable if it is industrially applicable, new and involves an inventive step.

(b) An invention shall be considered industrially applicable if it can be made in any kind of industry leading to the production of goods and services; it shall include, among others, manufacturing, handicraft, agriculture, fishery and services.

(c) An invention is new if it does not from part of the state of the art.

(d) The state of the art shall consist of everything disclosed to the public, anywhere in the world, by publication or by oral disclosure, by use or in any other way, or by deposit of a material in any deposit institution, prior to the filing or, where appropriate, the priority date, of the application claiming the invention. The content of any patent application, the filing or priority date of which is earlier than the filing or priority date of the application claiming the invention, and which is subsequently published, shall also be considered as comprised in the state of the art for the purposes of determining novelty and inventive step.

(e) For the purposes of determining novelty and inventive step, disclosure to the public of an invention shall not be taken into consideration if it occurred within twelve months preceding the filing date or, where applicable, the priority date of the application, and if it was by reason or in consequence of an abuse committed by a third party with regard to the applicant or his predecessor in title, or by reason of any act committed by the applicant or his predecessor in title, other than the filing of an application to patent or otherwise obtain legal registration for the invention, with an industrial property authority.

(f) An invention shall be considered as involving an inventive step if, having regard to the state of the art, including written and non-written knowledge, it would not have been obvious to a person in the field with ordinary skill, creativity and intuition. An inventive step will not exist when the invention can be directly derived from the combination of any pieces of prior art.

(g) In the case of chemical substances of therapeutic use, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives thereof shall not be deemed to involve an inventive step unless they meet the requirement set out in Subsection (f) of this Section and they result in a significant enhancement of the therapeutic efficacy of the known substance. Advantageous properties such as

thermodynamic stability, lower hygroscopicity and potency of a substance shall not be deemed to constitute an enhancement of therapeutic efficacy.

### **§2.3. Right to Patent; Naming of Inventor**

- (a) The right to a patent shall belong to the inventor.
- (b) If two or more persons have jointly made an invention, the right to the patent shall belong to them jointly.
- (c) If two or more persons have made the same invention independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest priority date shall have the right to the patent, provided such application is not withdrawn, abandoned or rejected. To this effect, the Director General shall take into account the matter claimed in the respective application.
- (d) The right to a patent may be assigned, and may be transferred by succession.
- (e) Where an invention is made under an employment contract the purpose of which is to invent, the right to the patent shall belong, in the absence of contractual provisions to the contrary, to the employer. If the economic gains obtained by the employer from the commercial exploitation of that invention rise above the reasonable expectations of gain that the employer had from his employee's inventive output at the time he hired him, the employee shall be entitled to an equitable remuneration.
- (f) Where an invention is made by an employee outside an employment contract, but in making that invention the employee used materials, data or know-how of the employer, the right to the patent shall belong, in the absence of contractual provisions to the contrary, to the employer. The employee shall be entitled to an equitable remuneration equivalent to one third of the economic gains obtained by the employer from the commercial exploitation of the invention.
- (g) Any invention claimed in a patent application filed by a former employee within one year following the expiry of his employment, where the invention falls within the scope of the former employer's main line of business, shall be presumed to have been made during the employment relationship, unless the employee produces evidence to the contrary.
- (h) Any anticipated promise or undertaking by the inventor made to his employer to the effect that he will waive any remuneration he is entitled to under this section shall be without legal effect.
- (i) The inventor shall be named as such in the patent, unless he indicates to the Director General in writing that he wishes not to be named. Any promise or undertaking by the inventor made to the effect that he will make such a declaration shall be without legal effect.

## **§2.4. Application for a Patent**

- (a) The application for a patent shall be filed with the Director General and shall contain a request, a description, one or more claims, one or more drawings (where required), and an abstract, as prescribed in the Regulations. It shall be subject to the payment of the prescribed fee.
- (b) The request shall contain a petition to the effect that a patent be granted, the name of and other prescribed data concerning the applicant, the inventor and the agent, if any, and the title of the invention.
- (c) Where the applicant is not the inventor, the request shall include a statement justifying the applicant's right to the patent.
- (d) The description shall disclose the invention in a manner sufficiently clear and complete for all the claimed embodiments of the invention to be carried out by a person having ordinary skill in the art in Liberia, and shall, in particular, indicate at least the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application.
- (e) In the case of inventions related to biological material that cannot be described as required under Subsection (d) of this Section, the applicant shall deposit a sample thereof, not later than the date of filing of the application, with a depositary institution recognized under the Budapest Treaty. After the publication of the application, any interested party shall have access to a sample of the deposited biological material, subject to the obligation by said party to use said sample for experimental purposes only.
- (f) Where the claimed invention consists of or is directly derived from biological material or from traditional knowledge obtained from a particular community, the description shall indicate the source and the origin of that material or knowledge, as known to the applicant. The application shall also provide information, including evidence, of compliance with any applicable legal requirements in the supplying country regarding prior informed consent and sharing of benefits arising from the commercial or other utilization of such material and/or knowledge.
- (g) The Director General may, at any time before the grant of the patent, require the description in a patent application to be amended to comply with the requirements of this section to ensure technology dissemination, provided that any amendment shall not result in the application disclosing matter extending beyond what was disclosed in the initial application.
- (h) The claim or claims shall define the matter for which protection is sought. The description and the drawings may be used to interpret the claims.
- (i) Claims shall be clear and concise. They shall be fully supported by the description. Subject to Section 2.5 of this Act, a main claim shall define all novel and essential features of the invention.

All claims dependent on a main claim shall be subordinated to and narrower than that main claim.

(j) In the case of inventions relating to chemical products and processes, the description, claims and abstract shall include the relevant internationally recognized chemical denomination of the claimed products or of the products obtainable with the claimed process. In the case of pharmaceutical products, the international non-proprietary name, wherever available at the date of filing the application, shall be included.

(k) Drawings shall be required when they are necessary to understand the invention.

(l) The abstract, must be concise and precise and accurately describe the essential elements and industrial applicability of the invention. It shall serve the purpose of technical information; in particular, it shall not be taken into account for the purpose of interpreting the scope of the protection conferred by the patent.

(m) Failure to disclose prior art known to the applicant that is material to the patentability of a claimed invention, or to comply with the requirements set out in Subsection (f) and Subsection (j) of this Section shall result in the refusal of the patent or, if granted, its invalidation in whole or in part.

(n) The applicant may withdraw the application at any time during its pendency.

## **§2.5. Unity of Invention; Amendment and Division of Application**

(a) An application for a patent shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

(b) The applicant may, up to the time when the application is in order or grant, divide the application into two or more applications (“divisional applications”), provided that each divisional application shall not introduce matter not comprised in the disclosure of the initial application.

(c) Each divisional application shall be entitled to the filing date and, where applicable, the priority date of the initial application.

(d) The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention under subsection (a) shall not be a ground for the invalidation of the patent.

(e) The applicant may, up to the time when the application is in order for grant, amend the application, provided that the amendment shall not result in the application disclosing matter extending beyond what was disclosed in the initial application.



## **§2.6. Right of Priority**

(a) The application may, in accordance with Article 4 of the Paris Convention, contain a declaration claiming the priority of one or more earlier applications filed for the same invention by the applicant or his predecessor in title in or for any State party to the said Convention or any Member of the World Trade Organization. The period of priority shall be of twelve months and shall be computed in accordance with the provisions of Article 4 of the Paris Convention, that is from the date of filing of the first application, but shall exclude the day of filing in the six months period, and shall end on the last day of the period unless an official holiday or a day the Intellectual Property Office is not opened in which case the period shall be extended until the next working day.

(b) The effect of the claiming of priority shall be as provided in Article 4B of the Paris Convention. In particular, an application filed within the priority period shall not be refused or invalidated by reason of any acts occurring during that period, in particular, another filing or the publication or exploitation of the invention, and such acts shall not give rise to any third-party right or any right of personal possession.

(c) Where the application contains a declaration claiming priority the Director General may request the applicant to furnish, within the prescribed time limit which shall not be less than three months following the date of filing, a copy of the earlier application or applications, certified as correct by the foreign authority with which it was filed. The Director General may also request that the copy be accompanied by a certificate from that authority showing the date of filing, and by a translation into a prescribed language.

(d) If the Director General finds that the conditions for the right of priority or the requirements for claiming priority have not been fulfilled, the declaration claiming priority shall be considered not to have been made.

## **§2.7. Information Concerning Corresponding Foreign Applications for Patents**

(a) The applicant shall indicate in the patent application the date and number of any application filed abroad ("foreign application") by him or by his predecessor in title relating to the same or essentially the same invention as that claimed in the application filed in Liberia.

(b) The applicant shall, at the request of the Director General, provide a copy of the patent granted on the basis of the foreign application, accompanied by a translation into English if required, relating to any of the foreign applications referred to in Subsection (a) of this Section, as indicated by the Director General:

(c) The applicant shall provide the following documents, within sixty days from having received notice thereof, accompanied by a translation into English if required, relating to any of the

foreign applications referred to in Subsection (a) of this Section, as indicated by the Director General:

- (i) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (ii) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.
- (iii) a copy of any final decision invalidating the patent granted on the basis of the foreign application referred to in Subsection (a) of this Section.

## **§2.8. Filing Date; Publication; Opposition; Examination**

(a) The filing date of a patent application shall be the earliest date on which the application contains at least the following:

- (i) an express or implicit indication that the granting of a patent is sought;
- (ii) indications allowing the identity of the applicant to be established;
- (iii) a part, which, on the face of it, appears to be a description of an invention.

(b) If the Director General finds that the application did not fulfill, at the time of receipt, the requirements referred to in Subsection (a) of this Section, he shall notify the applicant inviting him to file the required correction within two months from the date of notification. If the correction is made in due time, the filing date shall be the date of receipt of the required correction; otherwise the application shall be treated as if it had not been filed.

(c) Where the application refers to drawings that in fact are not included in the application, the Director General shall notify the applicant inviting him to furnish the missing drawings within two months from the date of the notification. If the applicant complies with the said invitation, the filing date shall be the date of receipt of the missing drawings. Otherwise, the filing date shall be the date of receipt of the application and any reference to the said drawings shall be treated as non-existent.

(d) Upon payment of the prescribed fee, the applicant or any interested party may request the Director General, within 36 (thirty six) months counted from the date of filing, the examination of the application. An application for which such request has not been filed will be deemed abandoned. If that request is duly filed, the Director General shall cause the application to be examined for compliance with the requirements of Section 2.4, Subsections (a) and (b) of this

Act and the Regulations pertaining thereto, and to determine whether any information required under Section 2-7 has been provided.

(e) If the application is found to comply with the requirements mentioned in subsection (3), the Director General shall verify compliance with the requirements of Section 2.1, Section 2.2, Section 2.4, Subsection (d), (e) and (f), and Subsection 2.5 of this Act and the Regulations pertaining thereto, and for this purpose may, as specified in the Regulations, cause the application to be examined.

(f) For the purposes of subsection (e) of this Section, and to decide on the grant or refusal of the application, the Director General may take into account, the following:

- (i.) the results of any international search report and any international preliminary examination report established under the Patent Cooperation Treaty in relation to the application;
- (ii.) any document submitted under Section 2.7;
- (iii.) a search and examination report carried out by an external search and examination authority or by a specialized agency within Liberia or abroad,
- (iv.) any information and evaluation provided in accordance with subsection (7)

(g) Immediately after eighteen months from the filing date, the Director General shall lay open the patent application for public inspection and publish in the prescribed manner an announcement containing the following:

- (i) the number and the filing date of the application;
- (ii) the title of the invention;
- (iii) the name of the applicant(s) and of the inventor(s);
- (iv) the priority date(s);
- (v) the international classification;
- (vi) one drawing, if any, that depicts the main element(s) of the invention;
- (vii) the abstract.

(h) After publication, any interested person shall, upon request and payment of the prescribed fees, receive a copy of the entire patent application. With respect to applications referred in Section 2.4, Subsection (e), the Director General shall, upon request and as prescribed, issue the certificate mentioned in rule 11.2 of the Regulations under the Budapest Treaty.

(i) The Director General shall not give access to or information about the contents of the patent application to third persons until the announcement mentioned in Subsection (g) of this Section is published.

(j) At any time before the expiration of the period mentioned in Subsection (g) of this Section, the applicant may request the Director General to lay open of the application for public inspection.

(k) After the publication mentioned in subsection (g) and up to the time when the application is in order for grant, any interested party may file with the Director General a notice of opposition. The notice of opposition shall identify the opposed patent application, as well as the grounds that the opponent deems relevant to refuse the grant. The opponent shall produce all relevant evidence in support of his opposition.

(l) The Director General shall give notice of the opposition to the applicant.

(m) The patent applicant shall have three months from the publication of the notice of opposition to file a counter-statement.

(n) The Director General shall grant a hearing at which the patent applicant and the opponent may argue on their cases and submit additional evidence.

## **§2.9. Grant of Patent; Changes in Patents**

(a) Where the Director General finds that the conditions under this Act are fulfilled, he shall grant the patent. Otherwise, he shall refuse the application and notify the applicant of that decision.

(b) When he grants a patent, the Director General shall:

(a) order a reference to the grant of the patent to be published in the Official Gazette;

(b) issue to the applicant a certificate of the grant of the patent and a copy of the patent document;

(c) ensure the patent is recorded on the patents register;

(d) make available copies of the patent to the public, on payment of the prescribed fee.

(3) The Director General shall, upon request of the holder of the patent, authorize changes in the text or drawings of the patent in order to limit the extent of the protection conferred thereby. No change shall be allowed that would result in the patent containing subject matter that extends beyond the matter disclosed in the initial application or in an extension of the matter claimed in the patent.

## **§2.10. Rights Conferred by the Patent; Limitations and Exceptions**

(a) A patent shall confer on its holder the right to prevent third parties from exploiting the patented invention in Liberia. The scope of the right conferred by the patent shall be defined by the claims.

(b) For the purposes of this Act, “exploiting” a patented invention shall have the meaning as defined in Section 1.2 of this Act.

(c) The rights under a patent may not be used to prevent:

- (i.) acts in respect of a product covered by the patent after that product has been put on the market in Liberia or abroad by the holder of the patent, by a person acting with the holder’s consent or having an economic tie to the holder, or by an otherwise authorized person. For the purposes of this provision, an economic tie shall exist between two persons where one of them may exercise on the other a decisive influence with respect to the exploitation of the patented invention, or where a third party may exercise such an influence on both persons;
- (ii.) acts done for purposes of scientific research in academic, educational or research institutions;
- (iii.) acts done for experimental purposes relating to the subject matter of the patented invention;
- (iv.) acts performed by any person to make, construct, use or sell the patented invention solely for uses reasonably related to the development and submission of information required under any law of Liberia or a country other than Liberia that regulates the manufacture, construction, use or sale of any product;
- (v.) acts performed by any person who in good faith, before the filing or, where priority is claimed, the priority date of the application on which the patent is granted, was using the invention or had made effective and serious preparations for such use in Liberia (the “prior user”);
- (vi.) acts done privately and for non-commercial purposes;
- (vii.) the use by a farmer of the product of his harvest for propagation or multiplication by him on his own holding or for exchange with other farmers in the context of traditional or communal practices, where the plant material used by the farmer to produce the harvest was put on the market in accordance with Subsection (c)(i) of this Section;
- (viii.) the use of the invention in the body or gear of aircraft, land vehicles or vessels that temporarily or accidentally enter the jurisdiction of Liberia, or the importation of

spare parts or accessories for the purpose of repairing such aircraft, vehicles or vessels;

- (ix.) the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription, and to dealing with the medicines so prepared.

(d) The right of the prior user referred to in Subsection (c)(v) of this Section may be transferred or devolve only together with the enterprise or business, or with that part of the enterprise or business, in which the use or preparations for use have been made.

## **§2.11. Duration; Annual Fees; Restoration**

(a) Subject to subsection (b), a patent shall expire 20 years after the filing date of the patent application.

(b) In order to maintain the patent or the patent application, as the case may be, an annual fee as prescribed shall be paid in advance to the Director General for each year, starting one year after the filing date of the application for grant of the patent. A period of grace of six months shall be allowed for the late payment of the annual fee on payment of the prescribed surcharge. If an annual fee is not paid in accordance with this subsection, the patent application shall be deemed to have been withdrawn or the patent shall lapse, as the case may be.

## **§2.12. Compulsory Licenses**

(a) The Director General or the court may grant, upon request, a compulsory license where:

- (i) the public interest, in particular, national security or cases of national emergency or other circumstances of extreme urgency, including those involving nutrition or health, so requires; or
- (ii) a judicial or administrative body has determined that the manner of exploitation of the patented invention, by the holder of the patent or someone acting under his authorization or with his consent, is anti-competitive, and that the exploitation of the invention in accordance with this subsection would remedy such practice; or
- (iii) the holder of the patent is abusing his exclusive rights or neglecting to take measures to prevent someone acting under his authorization or with his consent from abusing the exclusive rights conferred by the patent; or
- (iv) after the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last, the patented invention is not exploited or is insufficiently exploited, by working the invention in Liberia. Notwithstanding this, a

compulsory license shall not be issued if the owner of the patent demonstrates that legitimate reasons such as *force majeure* exist which justify the non-exploitation or insufficient exploitation of the patented invention in Liberia.

; or

(v) a patent (the “second patent”) claiming an invention that involves an important technical advance of considerable economic significance in relation to an invention claimed in an earlier patent (the “first patent”) cannot be exploited without infringing the earlier patent; or

(vi) the patent owner has refused to grant a voluntary license to a third party on reasonable commercial terms and conditions.

(b) Each request for a compulsory license shall be considered on its individual merits. The decision shall be taken after hearing the holder of the patent if he wishes to be heard. Where the compulsory license is granted by the court, the Director General shall be notified with the decision.

(c) The exploitation of the patented invention shall be limited to the purpose and duration for which it was authorized and shall be subject to the payment to the said holder of an adequate remuneration in the circumstances of each case. Such remuneration shall take into account the economic value of the compulsory license and, where the decision has been taken under Subsection (a)(ii) or (iii) of this Section this shall be taken into account in determining the amount of the remuneration.

(d) The decision on the remuneration of the compulsory license of a patent claiming a pharmaceutical product or a process to obtain a pharmaceutical product, shall take into account, when applicable, the terms and conditions of the WTO Decision of 30 August, 2003 or Article 31*bis* of the TRIPS Agreement, as appropriate, and of the Annex thereto.

(e) The government of Liberia may decide at any time the use of a patented invention for public non-commercial purposes through a government agency, a subcontractor or another third person designated by the respective Ministry or the court. The right holder shall be informed promptly of such use.

(f) Upon request of the holder of the patent, or of the Government agency or person licensed to exploit the patented invention, the court may, after hearing the parties, if either or both wish to be heard, vary the terms of the decision authorizing the exploitation of the patented invention to the extent that changed circumstances justify such variation.

(g) Upon the request of the holder of the patent, the Director General or the court may terminate the compulsory license if it is determined, after hearing the parties, if either or both wish to be heard, that the circumstances which led to the decision to grant the compulsory license have ceased to exist and are unlikely to recur.

license where an adequate protection of the legitimate interests of the Government agency or third person designated to exploit the invention justifies the maintenance of the decision.

(j) A compulsory license shall be non-exclusive. Therefore, it shall not exclude:

(i) A compulsory license may only be transferred with the enterprise or business of that person or with the part of the enterprise or business within which the patented invention is being exploited.

(i.) the exploitation of the invention by the patent holder himself; and

(ii.) the conclusion of license contracts by the holder of the patent; and

(iii.) the exercise, by the holder of the patent, of his rights under Section 2.10 (a) of this Act to the extent that it does not interfere with the operation of the compulsory license.

(k) A request for a compulsory license shall be addressed to the Director General or to the court and accompanied by evidence that the holder of the patent has received, from the person seeking the compulsory license, a request for a contractual license, but that that person has been unable to obtain such a license on reasonable commercial terms and conditions and within ninety days from the request.

(l) Evidence concerning an attempt to obtain a voluntary license shall not be required in cases of national emergency or other circumstances of extreme urgency or in cases of public non-commercial use or when the license is granted to remedy a practice determined after judicial or administrative process to be anti-competitive; in such cases the holder of the patent shall be notified of the Director General's decision as soon as reasonably practicable.

(m) The exploitation of the invention under a compulsory license shall be predominantly for the supply of the market in Liberia except when the compulsory license concerns a patent claiming a pharmaceutical product or a process to obtain a pharmaceutical product, and the purpose of the license is to export the patented product or the product manufactured by the patented process to a foreign territory with no or insufficient manufacturing capacity, in accordance with the WTO Decision of 30 August, 2003 or Article 31*bis* of the TRIPS Agreement, as appropriate, and the Annex thereto.

(n) A compulsory license in respect of an invention in the field of semi-conductor technology shall only be granted for public non-commercial use or where a judicial or administrative body has determined that the manner of exploitation of the patented invention, by the holder of the patent or someone acting under his authorization or with his consent, is anti-competitive and that the grant of the non-voluntary license would remedy such practice.

(o) Where a compulsory license is granted under Subsection (a)(v) of this Section, the holder of the first patent shall be entitled to a cross-license on reasonable terms to use the invention



claimed in the second patent; and the license on the first patent may not be assigned separately from the second patent.

### **§2.13. Invalidation; Surrender**

(a) Patents shall be granted without any guarantee about the novelty, inventive step or industrial applicability of the invention.

(b) Any interested person may request the Director General or the court to invalidate a patent. Invalidation shall be decided on the evidence submitted by the parties.

(c) The Director General or the court shall invalidate the patent if Sections 2.1, 2.2, and Section 2.4, Subsections (h) thru (k) of this Act are not complied with.

(d) When the grounds for invalidation are established with respect to a main claim, any dependent claim may be deemed invalid if it does not comply with Section 2.4, Subsections (h) thru (j) of this Act. If a dependent claim is invalidated, the other claims may remain valid if they comply with Section 2.4, Subsections (h) thru (j) of this Act.

(e) Any invalidated patent, or claim or part of a claim, shall be regarded as null and void from the date of the grant of the patent, and shall be deemed as if it had never been granted. Any limitation shall be deemed to have existed from the applicable filing date.

(f) Any dispute over the right to the patent under Section 2.3. of this Act shall be heard by the court. An interested person may request the court to transfer the granted patent to him or to invalidate the patent. In case the interested person claims co-inventorship, he may request the court to have his name added as co-inventor and, where applicable, as co-holder of the corresponding patent.

(g) The final decision of the court shall be notified to the Director General who shall record it and publish a reference thereto as prescribed.

(h) A patent may be surrendered by its holder. The surrender may be limited to one or more claims.

## **PART III**

### **INTERNATION APPLICATIONS UNDER THE PATENT COOPERATION TREATY**

#### **§ 3.1. Specific Meanings**

For purposes of this Part, the expressions: “designate,” “designated office,” “elect,” “elected

office,” “international application,” “international filing date,” “international preliminary examination,” “priority period” and “receiving office” have the same meanings as in the Patent Cooperation Treaty.

### **§ 3.2. Filing date and effects of international application designating Liberia**

An international application designating Liberia shall, subject to this section, be treated as an application for a patent filed under this Act having as its filing date the international filing date accorded under the Patent Cooperation Treaty.

### **§ 3.3. The Office as receiving office**

The Office shall act as a receiving office in respect of an international application filed with it by a resident or national of Liberia.

### **§ 3.4. Filing of international applications with the office**

An international application filed with the Office as receiving office shall be filed in English and the prescribed transmittal fee shall be paid to the Office.

### **§ 3.5. The office as designated office**

The Office shall act as a designated office in respect of an international application in which Liberia is designated for the purposes of obtaining a national patent under this Act.

### **§ 3.6. The office as elected office**

The Office shall act as an elected office in respect of an international application in which Liberia is designated as referred to in Section 3.5 of this Part if the applicant files a demand for the purposes of international preliminary examination under Chapter II of the Patent Cooperation Treaty.

### **§ 3.7. Processing international applications**

The Office as designated office or elected office shall not commence processing of an international application designating Liberia before the expiration of the time limit referred to in § 3.22 except if the applicant complies with the requirements of that subsection and files with the Office an express request for early commencement of such processing.

### **§ 3.8. Entering national phase**

The applicant shall, in respect of an international application designating Liberia and before the expiration of the time limit applicable under Article 22(1) or 39(1)(a) of the Patent Cooperation Treaty or of such later time limit as may be specified in the regulations to this Act, pay the

national fee to the Office and file with the Office a translation of the international application into English if the international application was not filed in, and has not been published under the Patent Cooperation Treaty as a translation into English.

### **§ 3.9. Failure to enter national phase**

If the applicant does not comply with the requirements of Section 3.8 of this Act within the time limit referred to in that subsection, the international application shall be considered withdrawn for purposes of this Act.

### **§ 3.10. Reinstatement of rights after failure to enter national phase**

(a) Where the international application is considered withdrawn under Section 3.9 of this Act, the Office shall, upon request of the applicant in accordance with the regulations to this Act, reinstate the rights of the applicant with respect to that international application if it finds that the failure to meet the time limit referred to in Section 3.8 of this Act occurred in spite of due care required by the circumstances having been taken.

(b) The Office shall not refuse a request for reinstatement of rights without giving the applicant the opportunity to make observations on the intended refusal within a time limit, which shall not be less than three months counted from the date of notification.

### **§ 3.11. Restoration of right of priority**

(a) Where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the Office shall, upon request of the applicant in accordance with the regulations to this Act, restore the right of priority with respect to that international application if the Office finds that the failure to file the international application within the priority period was unintentional or occurred in spite of due care required by the circumstances having been taken.

(b) The Office shall not refuse, totally or in part, a request for restoration of right of priority without giving the applicant the opportunity to make observations on the intended refusal within a time limit, which shall not be less than three months counted from the date of notification.

### **§ 3.12. Processing international applications in accordance with treaty**

(a) The Office shall process international applications in accordance with the provisions of the Patent Cooperation Treaty, the Regulations established thereunder and the Administrative Instructions under those Regulations and with the provisions of this Act and the regulations thereunder. In the event of conflict, the provisions of the Patent Cooperation Treaty, the Regulations thereunder and the Administrative Instructions under those Regulations shall apply.

(b) Further details concerning the processing of international applications by, and other functions of, the Office in connection with the Patent Cooperation Treaty, including fees payable, time limits, prescribed languages and other requirements in relation to international applications, may be included in the regulations.

## **PART IV**

### **UTILITY MODELS**

#### **§4.1. Applicability of provisions relating to patents**

The provisions of Part II thru Part II of this Act shall apply *mutatis mutandis* to utility models certificates or applications thereof.

#### **§4.2. Special provisions relating to utility model certificates**

- (a) An invention qualifies for a utility model certificate if it is new and industrially applicable.
- (b) The provisions of this Act on patentable inventions and inventive steps, however, shall not apply to utility model certificates.
- (c) A utility model certificate shall expire at the end of the 10<sup>th</sup> year after the date of the grant of the utility model, and shall not be renewable.

#### **§4.3. Conversions**

- (a) At any time before the grant or refusal of a patent an applicant for a patent may, upon payment of the prescribed fees, convert his/her application into an application for a utility model certificate which shall be accorded the filing date of the initial application.
- (b) At any time before the grant or refusal of a utility model certificate, an applicant for a utility model certificate may, upon payment of the prescribed fees, convert his application into a patent application, which shall be accorded the filing date of the initial application.
- (c) An application may not be converted under Subsection (a) of this Section more than once.

## **PART V**

### **ENFORCEMENT OF RIGHTS AND LEGAL PROCEEDINGS**

#### **§5.1. Infringement of Patents**

- (a) A patent shall be infringed by the performance of any act referred to in Section 2.10, Subsection (b) of this Act by a person other than the holder of the patent and without the holder's

agreement, subject to the limitations and exceptions provided for in Section 2.10, Subsection (c) of this Act.

(b) On the request of the holder of the patent the court may grant an injunction to prevent infringement or an imminent infringement and, where the infringer acted knowingly or with reasonable grounds to know, award damages and grant any other remedy provided for in the general law or under this Act.

## **§ 5.2. Remedies**

On the request of the registered holder of a patent, or of a licensee if he has requested the holder to institute court proceedings for a specific relief and the holder has refused or failed to do so within ninety days, the court may grant an injunction to prevent infringement or an imminent infringement, award damages and grant any other remedy provided for in the general law or under this Act.

## **§5.3. Provisional Measures**

(a) All provisional remedies under the Civil Procedure Law of Liberia including injunctions shall be applicable to civil proceedings relating to patents primarily to prevent an infringement from occurring and preserve relevant evidence in regard to the alleged infringement;

(b) Time limitations for action for damages under the Civil Procedure Law of Liberia shall be applicable to patents.

(c ) The aggrieved party's entitlement to compensation shall be pursuant to the Civil Procedure Law of Liberia.

## **§5.4. Evidence**

(a) Any party to proceedings relating to patents infringement shall be governed by the provisions of the Civil Procedure Law relative to evidence including burden of proof, the right to compel production of documents and to designate documents as privileged or confidential.

(b) Any registration issued under this Act of a patent registered on the principal register for layout designs and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered patent and of the registration of the patent, of the registrant's ownership of the patent, and of the registrants' exclusive right to use the patent.

## **§5.5. Damages**

(a) An aggrieved party to proceedings involving patent rights may seek and obtain a court order that the infringer pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity, inclusive of expenses such as attorney fees, or an order for the recovery of profits and or payment of pre-established damages where the infringer with reasonable grounds to know engaged in infringing activity.

(b) An order may also be sought and obtained that the infringer to inform the holder of the right of the identity of third persons involved in the production and distribution of the infringing goods or rendering of services and of their channels of distribution, where this would be in proportion to the seriousness of the infringement.

### **§3.6. Indemnification of Defendant**

Any party to patent proceedings who abuses enforcement proceedings may be required by Court order to indemnify the defendant for injury suffered for such an abuse pursuant to the Civil Procedure Law of Liberia.

### **§3.7. Unfair Competition**

Unfair competition legislation in Liberia prohibiting dishonest practices in industrial or commercial matters shall be applicable to patents.

### **§3.8. Appeals**

(a) An applicant for registration of a patent, party to an opposition proceeding, or applicant for renewal or other infringement proceedings who is dissatisfied with the decision of the Director General may appeal to the courts.

(b) The appeal shall follow the procedure provided under the Civil Procedure Law of the Republic of Liberia.

### **§3.9. Further Sanctions**

When a person has been found liable for infringement under this Act, to create an effective deterrent to further infringement, the infringer may be subjected to a court order for seizure, forfeiture or disposal of the infringing goods and of any materials and instruments the predominant use of which have been in the commission of the infringement.

## **PART VI-**

## **OFFENSES**

### **§6.1. Fraud in relation to registers**

(a) A person is guilty of the offense of fraud in relation to registers, which shall constitute a felony of the second degree under the Penal Law of Liberia, who:

- (i.) makes or causes to be made a false entry in a register for patents maintained by the Liberia Intellectual Property Office; or

- (ii.) makes or causes to be made a writing falsely purporting to be a copy of an entry in any such register; or
- (iii.) produces or tenders or causes to be produced or tendered as evidence any such entry or copy thereof knowing it to be false.

#### **§4.4. False statement for the purpose of deceiving**

(a) A person is guilty of the offense of false statement for the purpose of deceiving or influencing the Director General, the Registrar or other officer of the Liberia Intellectual Property Office, which shall constitute a felony of the second degree, who makes a false statement for the purpose of:

- (i.) deceiving the Director General, the Registrar or any officer in the execution of the provisions of this Act;
- (ii.) procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder; or
- (iii.) makes a false representation knowing it to be false.

#### **§4.5. Falsely representing patent as registered**

(a) A person is guilty of falsely representing patent as registered, which shall constitute a felony of the second degree, under the Penal Law of Liberia, who:

- (i.) makes a representation with respect to a patent not being a registered patent, to the effect that it is a registered patent;
- (ii.) makes a representation that the registration of a patent gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered in the register, the registration does not give that right;

This Act shall take effect immediately upon publication into Handbills by the Ministry of Foreign Affairs.

**ANY LAW TO THE CONTRARY NOTWITHSTANDING**

