

CROATIA

C. 8585

1. Pursuant to the decision of the Standing Committee on the Law of Patents (SCP), at its twenty-fourth session held in Geneva from June 27 to 30, 2016 (document SCP/24/5, paragraph 17, first bullet point under "Exceptions and Limitations to Patent Rights" and "Confidentiality of Communications between Clients and Their Patent Advisors"), members and observers of the SCP are invited to provide information on:

(i) their practical experiences on the effectiveness of, and challenges associated to, exceptions and limitations to patent rights, in particular in addressing development issues;

Regarding the invitation to submit to the IB the information on the national experiences and case studies on the effectiveness of exceptions and limitations to patent rights, addressing development issues, on behalf of the State Intellectual Property Office of the Republic of Croatia (hereinafter: SIPO Croatia) we are informing that according to the present available data, such experiences are not known and there are no such challenges before the courts.

(ii) court cases with respect to client-patent advisor privilege including limitations or difficulties encountered.

In order to provide the information on court cases with respect to client-patent advisor privilege including limitations or difficulties encountered, on behalf of the SIPO Croatia we are informing that we do not have any data of such existing court cases.

Based on the information received, the Secretariat will prepare working documents to be submitted to the twenty-fifth session of the SCP, which is tentatively scheduled to be held in Geneva from December 12 to 15, 2016.

2. In addition, Member States and Regional Patent Offices are invited to send updated information concerning their applicable laws on the following subjects in order for the Secretariat to carry out the future work agreed by the Committee (document SCP/24/5, paragraph 5 and paragraph 17, second bullet point under "Quality of Patents, including Opposition Systems"):

(i) certain aspects of national/regional patent laws, available at:

http://www.wipo.int/scp/en/annex_ii.html

SIPO Croatia submitted the updated information on certain aspects of the applicable national or regional patent law in October 2015.

(ii) opposition systems and other administrative revocation and invalidation mechanisms, in document SCP/18/4 available at:

http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=202420

Legislation of the Republic of Croatia allows other mechanism related to the opposition system to be applied. Under Section IX of the Patent Act, any natural or legal person or a State Attorney may file a proposal for the declaration of nullity of a patent or consensual patent with the SIPO Croatia. A patent may be declared null and void at any time, if the patent has been granted:

1. for a subject matter which is not considered to be an invention, for inventions excluded from patent protection and for inventions which are considered unpatentable.

2. for an invention which, on the filing date of the patent application or on the date of the granted priority respectively, was not new or did not include an inventive step,

3. for an invention which is not industrially applicable,

4. for an invention which is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art,
5. for a subject-matter extending beyond the content of the patent application as filed or, if the patent was granted on a divisional application or on a new application filed under Article 89 of this Law (Appeal procedure), beyond the content of the earlier application as filed;
6. on behalf of a person not entitled to the patent protection for the invention.

The proposal for the declaration of nullity of a patent shall contain the data concerning the applicant, the owner of a patent, the number of the decision, and the registration number of the patent, the reasons for the proposal of the declaration of nullity of the patent, supported by necessary evidence. If the proposal is not drafted properly or if the administrative fee and procedural charges have not been paid, the SIPO Croatia shall order the applicant by a conclusion to correct such deficiencies within a period of two months from the day of receipt of the conclusion. If the applicant does not correct the proposal within the time limit, the SIPO shall reject the proposal by a decision.

The SIPO Croatia shall communicate the correct proposal to the patent owner and shall invite him to submit his response within a period which shall not be less than 30 days and shall not exceed 60 days, as from the day of the receipt thereof. The SIPO Croatia shall invite the parties as many times as necessary to submit their comments on the submissions of the other party. At the same time the SIPO Croatia shall invite the applicant to file, where necessary, the description, claims and drawings as amended, provided that the subject matter of the protection does not extend beyond the content of a patent as granted.

Before taking a decision to maintain a patent as amended, the SIPO Croatia shall inform the parties that it intends to maintain the patent as amended in the procedure for the declaration of nullity, and shall invite them to file their reasoned observations within a period between 30 and 60 days, if they disapprove of the text in which it intends to maintain the patent. If the parties disapprove of such text, the procedure for the declaration of nullity may be continued.

If the parties approve of the text in which the SIPO Croatia intends to maintain the patent or if they fail to reply to the invitation, the SIPO shall order the owner of the patent by a conclusion to pay the administrative fee and procedural charges for printing a new patent specification within a period of 2 months from the receipt of the conclusion. If the fee and procedural charges are not paid in due time, the patent shall be declared null and void within the limits of the proposal.

The SIPO Croatia may hold oral proceedings, if it considers it necessary in order to establish the facts essential for its decision.

If a proposal for the declaration of nullity of a consensual patent is filed, and where the supporting evidence is sufficient for likelihood that the consensual patent does not comply with the requirements referred to in Article 41 of the Patent Act (subject matter is not considered to be an invention, the invention is excluded from patent protection, the invention is considered unpatentable and the invention is not industrially applicable), a reply to the invitation shall also contain a request for the substantive examination.

If the person having filed the proposal for the declaration of nullity of a patent withdraws the proposal in the course of the procedure, the SIPO Croatia may continue the proceedings of its own motion. The same applies where the patent owner has surrendered the patent or the patent has lapsed.

On the basis of the results of the procedure, the SIPO Croatia shall issue a decision on the declaration of nullity of a patent, entirely or partially, taking into consideration the amendments of a patent made by the owner in the procedure concerning a proposal for the declaration of nullity of a patent, or the decision on the refusal of the proposal. The patent application and the patent granted thereon shall not have from the outset the effects, to the extent that the patent has been declared null and void.

I should be grateful if the above information could be submitted to the International Bureau on or before September 26, 2016.

3. Furthermore, the International Bureau takes this opportunity to note that, in order to maintain the information collected through the activities of the SCP up to date, Member States and Regional Patent Offices are invited to submit updated information with respect to the following webpages:

(i) exceptions and limitations to patent rights available at:

<http://www.wipo.int/scp/en/exceptions/>

Please find enclosed the updated information with respect to the exceptions and limitations to patent rights.

(ii) laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors, available at:

http://www.wipo.int/scp/en/confidentiality_advisors_clients/national_laws_practices.html

National aspects

Croatian legislation provides for confidentiality of any kind of communication between clients and their patent advisors/representatives/attorneys. Activities of representation before the SIPO Croatia may be performed by natural and legal persons entered in the Register of the Representatives maintained by the SIPO Croatia. Those authorised representatives are members of the Croatian Association of Patent and Trademark Attorneys.

Croatian law also allows any attorney registered into Croatian Bar Association to act as a representative before the SIPO Croatia.

The provisions under the Croatian legislation concerning duties of patent representatives address the issue with regard to responsibilities of protection of professional confidentiality. These rules are provided for in the Statute of Croatian Association of Patent and Trademark Attorneys (Official gazette, 91/2013). Pursuant to the Statute:

- Members of the Associations shall preserve the confidentiality of any information considering service acquired from a client or otherwise while rendering the service, particularly during representation. The representative's secret refers to all the information, documents, recordings, computer data, pictures and similar materials and deposits kept in the representative's office;
- Members of the Associations shall exercise reasonable care to ensure that the confidentiality of such information be preserved by other persons working in his or her law office;
- Confidences or information acquired in the course of rendering service to a client must not be used in the proceedings or otherwise to the client's disadvantage. A representative shall not use such confidences to the disadvantage of either one or more interested members who are in a status relationship with the client, or against them;
- A representative shall preserve the representative's confidentiality permanently;
- In order to preserve the representative's secret, a representative shall not disclose any information about the matters entrusted to him or her, even upon the termination of a case;
- Revelation of the representative's secret is permitted only upon the clear consent of the client or if it is necessary for the defence of the representative.

Cross-border aspects

The national legislation of the Republic of Croatia does not provide any provisions concerning cross-border aspects of confidentiality of communications between clients and patent advisors.

(iii) international worksharing and collaborative activities for search and examination of patent applications, available at:

<http://www.wipo.int/patents/en/topics/worksharing>

Regarding international worksharing and collaborative activities for search and examination of patent applications, the Republic of Croatia is engaged in several work-sharing programs:

PCT System

In carrying out patent search and examination, the SIPO Croatia utilizes international search and preliminary examination reports.

Patent Prosecution Highway (PPH)

- Bilateral PPH

The Republic of Croatia signed the Cooperation Agreement with the Czech Republic that has substantive elements of a PPH Agreement.

Unilateral use of work products related to foreign applications and grants

Patent examiners of the SIPO Croatia use, where appropriate, search and examination reports as well as other useful information issued in the European Patent Register in order to facilitate the examination of corresponding national applications.

Bilateral Cooperation

The Republic of Croatia signed the following agreements on performing the search and substantive examination:

- Agreement between the State Intellectual Property Office of the Republic of Croatia and the Austrian Patent Office (1995, 2005);
- Agreement between the State Intellectual Property Office of the Republic of Croatia and the Danish Patent and Trademark Office (2005).

The SCP Electronic Forum is available for members and observers of the SCP to accelerate the deliberations and discussions of the Committee (<http://www.wipo.int/scp/en>). The International Bureau encourages members and observers of the SCP to submit any comments and suggestions they may have with respect to the activities of the SCP in general and, in particular, the topics that are being discussed in the Committee. The information received will be posted on the SCP Electronic Forum, unless explicitly indicated otherwise by the submitting party.

Information relating to the activities of the SCP can be submitted via the following means:

e-mail: scp.forum@wipo.int

facsimile: (+41 22) 338 8830

mail: World Intellectual Property Organization (WIPO)

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