

**Act No. 435/2001 Coll. on Patents,  
Supplementary Protection Certificates  
and on Amendment of Some Acts as Amended  
(The Patent Act)**

**Amended by the Act No. 402/2002 Coll.**

The National Council of the Slovak Republic has adopted the following Act:

**Title I**

**PART ONE  
BASIC PROVISIONS**

Article 1

Subject-matter of regulation

This Act shall govern the relations arising in relation to creation, legal protection and utilisation of inventions, which are the subject-matter of a patent application or granted patent or are the subject-matter of supplementary protection certificates.

Article 2

Scope of the Act

This Act shall apply to

- a) patent application (hereinafter referred to as "application"), European patent application in accordance with Article 3(e), international application in accordance with Article 3(g), and to application for granting supplementary protection certificates in accordance with Article 74,
- b) patent, European patent in accordance with Article 3(f) and supplementary protection certificate in accordance with Articles 69 and 71,
- c) rights and obligations of an inventors, applicants (hereinafter referred to as "applicant") and to owners of the patent, applicants of the European Patent application and to owners of the European patent, applicants of the International application, applicants on granting the supplementary protection certificate and to its owners,
- d) the legal status of the third party which is a holder of other rights or obligations in relation to application, European patent application, International applications, patents, European patents or to supplementary protection certificates,
- e) proceedings on subject-matters of the right pursuant to points (a) to (d).

### Article 3 Definition of terms

For the purpose of this Act

- a) biological material shall mean any material containing genetic information capable of reproducing itself or being reproduced in a biological system,
- b) microbiological process shall be any process using microbiological material or performed upon or resulting in microbiological material,
- c) essentially biological process for the production of plants and animals shall be a process consisting exclusively of natural phenomena, such as breeding or selection,
- d) reproduction shall be generative or vegetative reproduction,
- e) European patent application shall be an application for a European patent filed pursuant to the Convention on the grant of European patents signed at Munich on 5 October 1973 (hereinafter referred to as “European Patent Convention“),
- f) European patent shall be a patent granted by the European Patent Office pursuant to the European Patent Convention,
- g) international application shall be an application filed pursuant to the Patent Co-operation Treaty,<sup>1)</sup>
- h) commercial exploitation of a patent or an invention shall be any activity related to a patent as subject-matter of a right or related to an invention as subject-matter of a patent, performed by the owner or any other authorised person with the purpose of making profit.

## **PART TWO PATENTS FOR INVENTIONS**

### Article 4

The Industrial Property Office of the Slovak Republic (hereinafter referred to as “Office”) shall grant patents for inventions, which meet the conditions, stipulated by this Act.

### Article 5

#### Patentability of inventions

(1) Patents shall be granted for inventions in all fields of technology, which are new, involve inventive activity and are susceptible of industrial application.

(2) Patents pursuant to paragraph 1 shall also be granted for biotechnological inventions which concern a product consisting of or containing biological material, or a process by

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<sup>1)</sup> Communication of the Federal Ministry of Foreign Affairs No 296/1991 Coll. on Deposition of the Document on Accession of the Czech and Slovak Federal Republic to the Patent Co-operation Treaty agreed in Washington on 17 June 1970 as amended.

means of which the biological material is produced, processed or used, including the case when

- a) biological material which is isolated from its natural environment or is produced by means of a technical process, already occurred in nature,
- b) invention concerns a plant or an animal, if the technical feasibility of the invention is not confined to a particular plant or animal variety,<sup>2)</sup>
- c) invention concerns a microbiological or other technical process or a product obtained by means of such process,
- d) invention concerns an element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, including the case when the structure of such an element is identical to the structure of a naturally existing element.

(3) 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,
- d) computer programs,
- e) presentation of information.

(4) Subject-matters or activities stated in paragraph 3 shall be excluded from the patentability only to the extent to which a patent application relates to these subject-matters or activities as such.

## Article 6

### Exceptions to patentability

(1) The following shall not be patentable

- a) plant and animal varieties,
- b) essentially biological processes for the production plants or animals,
- c) methods of surgical or therapeutic treatment of the human or animal body and diagnostic methods and methods of illness prevention practised on the human or animal body. This provision shall not apply to products, in particular substances or compositions for use in any of the above-mentioned methods of treatment, diagnostics, or illness prevention,
- d) inventions which concern the human body in various stages of its formation or development or concern the simple discovery of some elements of the human body, including the sequence or partial sequence of a gene, with an exception pursuant to Article 5(2)(d),
- e) inventions whose commercial exploitation would be in contradiction with public order or morality. The sole fact that the exploitation of an invention is prohibited by law shall not be considered to result in a contradiction with public order or morality pursuant to this provision.

(2) Pursuant to paragraph 1(e) the following, in particular, shall not be considered patentable

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<sup>2)</sup> Act No 132/1989 Coll. on Protection of Rights to New Plant and Animal Variety as amended by the Act of the National Council of the Slovak Republic No 22/1996 Coll.

- a) processes for cloning human beings,
- b) processes for modifying the germ line genetic identity of human beings,
- c) the use of human embryos for industrial or commercial purposes,
- d) processes for modifying the genetic identity of animals which are likely to cause suffering to the animals while not having substantial medical benefit for people or animals, or for animals which result from such processes.

## Article 7 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 any means of disclosure before the day from which the applicant enjoys priority right referred to in Article 36.

(3) The contents of patent applications and utility model applications filed in the Slovak Republic with an earlier priority right shall also be considered as the state of the art, if they are published in the Official Journal of the Industrial Property Office of the Slovak Republic (hereinafter referred to as “Journal”) on the day from which the applicant enjoys the priority right or after this day. This shall also apply to international applications with the designation for the Slovak Republic where a publication in the Journal in accordance with Article 41 is considered to be the publication of international application and to European patent applications with the designation for the Slovak Republic where an announcement in the Journal as defined in Article 60(2) is considered to be the publication of European patent application. Patent applications the subject-matter of which has been made confidential pursuant to Article 59(10) shall be for the purpose of this provision considered published after the expiry of 18 months from the day of the rise of priority right.

(4) Such disclosure of the invention shall not be considered as the state of the art provided that such disclosure occurred no earlier than six months preceding the filing of the patent application and which directly or indirectly follows from

- a) an evident abuse in relation to the applicant or his legal predecessor,
- b) the fact that the applicant or his legal predecessor has displayed the invention at an official or officially recognised exhibition pursuant to the international convention.<sup>3)</sup> In such a case when filing the patent application the applicant shall be obliged to state that the invention has been so displayed and within four months of filing the patent application file a certificate on the displaying of the invention pursuant to the international convention.<sup>3)</sup>

(5) the paragraphs 1 to 3 shall not exclude the patentability of any substance, or composition

- a) comprised in the state of the art, for use in methods referred to in the provision of Article 6(1)(c), provided that such use is not comprised in the state of the art,
- b) referred in point (a) for any specific use in the methods referred to in the provision of Article 6(1)(c), provided that such specific use is not comprised in the state of the art.

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<sup>3)</sup> Convention on International Exhibitions signed in Paris on 22 November 1928 (Collection of acts and regulations of the Czechoslovak State No 46/1932), last revised in Paris on 30 November 1972.

## Article 8 Inventive activity

(1) An invention shall be considered as a result of an inventive activity if for a person skilled in the art it is not obvious from the state of the art.

(2) The contents of applications, European patent applications and utility model applications which have not been published as defined in Article 41 or Article 60(2) by the day from which the applicant enjoys the priority right shall not be considered in deciding whether there has been an inventive activity.

## Article 9 Industrial application

An invention shall be considered as susceptible of industrial application if its subject-matter can be made or used in any kind of industry, mainly in an industrial branch and agriculture.

## Inventor

## Article 10

(1) The right to a patent including the right to file an application (hereinafter referred to as “right to a patent”) shall belong to the inventor of an invention (hereinafter referred to as “inventor”).

(2) Inventor is the person who has created the invention with his own creative work.

(3) Co-inventors of an invention (hereinafter referred to as “co-inventors”) have a right to the patent to the extent to which they participated in creating an invention. If co-inventors do not agree or unless a court decides otherwise, the share of co-inventors in creating the invention shall be considered equal.

(4) If an invention has been created by several persons independently from each other, the right to the patent shall belong to the person with an earlier priority right in accordance with Article 36. This shall only apply in case the patent application has been published pursuant to Article 41 or Article 60(2).

## Article 11

(1) If the inventor has created the invention while fulfilling tasks following from employment, similar relationship or from membership relation the right to a patent shall pass to the employer, unless the parties to this relationship agreed otherwise. The right of being the inventor shall remain unaffected.

(2) The inventor who has created the invention pursuant to paragraph 1 shall be obliged to inform the employer about this fact without delay in writing and at the same time shall submit any materials necessary for the assessment of the invention.

(3) The employer shall exercise the right to the patent vis-à-vis the inventor in writing, within a time limit of three months from notification pursuant to paragraph 2.

(4) If the employer does not exercise the right to the patent in writing within the time limit stipulated pursuant to paragraph 3, this right shall pass back to the inventor. The employer as well as the inventor shall be obliged to preserve confidentiality about the invention vis-à-vis third parties.

(5) The inventor, against whom the right to the patent pursuant to paragraph 3 has been exercised, shall be entitled to an appropriate remuneration from the employer. The technical and economic importance of the invention and the benefit achieved through its exploitation or other application shall be decisive for determining the amount of remuneration, while the material share of the employer in creating the invention, as well as the scope and contents of work tasks of the inventor shall be taken into consideration. If the remuneration agreed or determined by the court is clearly disproportionate to the benefit achieved by a later exploitation or other application of the invention, the inventor shall be entitled to an additional settlement.

(6) If no agreement on the amount of the remuneration is reached between the inventor and the employer and for reasons caused by the employer the benefit achieved through the exploitation or other application of the invention is not proportionate to the technical and economic importance of the invention or the invention is not used or otherwise applied at all, the benefit achievable through potential exploitation or other application of the invention with regard to objective economic circumstances prevailing during at least 3 years, starting with the calendar year following the year of the proper exercise of the right to the patent pursuant to paragraph 3 shall be decisive for the exercise of the right to a remuneration and for determining the amount of remuneration pursuant to paragraph 5.

(7) Rights and obligations following from provisions of paragraphs 1 to 6 shall remain unaffected after the legal relationship between the inventor and the employer has ceased.

## Article 12

(1) The right to the patent shall also belong to legal successors in title of persons listed in Article 10(1) and (3) or in Article 11(1).

(2) The right to the patent shall be transferred to another person in cases stipulated by special regulations.<sup>4)</sup>

(3) An agreement on the assignment of the right to the patent shall be made in writing, otherwise it is invalid.

(4) Together with the assignment or the transfer of the right to the patent, which occurred after the filing of the patent application, there is simultaneously a transfer or assignment of the rights to the patent application. Transfer or assignment of the rights to the patent application however shall become effective vis-à-vis third parties as from its entry to the patent applications register referred to in Article 57. This shall not apply vis-à-vis third parties that knew or according to the circumstances should have known on such transfer or assignment.

## Article 13

### Scope of protection

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<sup>4)</sup> For example Articles 69, 479 and 487 of the Commercial Code, Articles 460 and 469 of the Civil Code, Articles 12 to 17 of the Act No 111/1990 Coll. on State Enterprise as amended.

(1) The scope of protection following from the patent shall be determined by the contents of the patent claims. The description and drawings shall be used for interpretation of the patent claims.

(2) The scope of protection following from the patent application shall be determined in a preliminary way by the contents of the patent claims published pursuant to Article 41. However, the granted patent or the patent partially revoked shall retroactively modify the scope of this preliminary protection; this does not apply if wider protection follows from the granted patent than from the published patent application.

(3) Protection following from a patent granted for a process shall also apply to a product directly obtained through that process.

(4) Protection following from a patent granted for biological material with specific characteristics, which are result of invention shall also apply to any other biological material derived from the original biological material by reproduction in identical or divergent form, which possesses the same characteristics.

(5) Protection following from a patent granted for a process enabling biological material to be produced possessing specific characteristics as a result of the invention, shall also apply to biological material directly obtained through that process as well as to any other biological material derived from directly obtained biological material by reproduction in identical or divergent form which possess those same characteristics.

(6) Protection following from the patent granted for a product containing or consisting of genetic information shall apply to all material in which the product is incorporated and in which the genetic information is contained and performs its functions. This shall not apply in case pursuant to Article 6(1)(d).

(7) A product, which is identical with the product protected pursuant paragraphs 3 and 5 shall be deemed to be a product achieved by the protected process directly until it is proved otherwise.

#### Article 14

##### Exploitation of the patent

(1) The owner of the patent in accordance with Article 19 shall have the exclusive right to exploit the invention, to grant consent for the exploitation of the invention, to assign the patent to another person or to establish a lien to the patent.

(2) The patent shall be effective from the day on which the notification of the announcement on the grant of the patent is published in the Journal.

#### Article 15

##### Prohibition of exploitation of an invention

- (1) Without the consent of the owner it shall be prohibited
- a) to produce, exploit, offer or place on the market, or store or import for this purpose a product which is the subject-matter of the patent,
  - b) to exploit a production process which is the subject-matter of the patent (hereinafter referred to as “protected process”) or offer such a protected process for exploitation to another person,

- c) to produce, exploit, offer or place on the market, or store or import for this purpose a product directly obtained by the protected process,
- d) to supply or offer for delivery to a person not entitled to exploit the invention any means enabling him to carry out the invention, if the person infringing the right knows or with regard to the circumstances he should know that these means are intended or suitable to realise the invention; this shall not apply if these means are currently available on the market and the supplier did not instigate the person not entitled to act to perform acts in contradiction to points (a) to (c).

(2) Exclusive rights pursuant to paragraph 1 shall also belong to the applicant, starting from the day of publication of the patent application in the Journal, provided that a patent has been granted for the invention, which is the subject-matter of the application. However, execution of these rights vis-à-vis third parties shall be possible only as from the day on which the effects of the patent begin.

## Article 16 Exhaustion of rights

(1) The owner of the patent shall not be entitled to prohibit third parties activity related to the product which is the subject-matter of the patent protection after the product has been placed on the market in the Slovak Republic by the patent owner or with his explicit consent. This shall not apply if there are reasons for the extension of rights to a patent for such treatment.

(2) Provisions of paragraph 1 shall also apply to biological material obtained by reproduction of protected biological material provided that such reproduction necessarily follows from the use for which the biological material has been placed on the market, unless such obtained biological material is subsequently used for its further reproduction.

(3) Acquisition of protected plant propagating material by a farmer within any commercial relation with the patent owner or with his consent implies authorisation for the farmer to use the product of his harvest for reproduction of this product on his own farm.

(4) Acquisition of protected animal reproductive material by a farmer within any commercial relation with the patent owner or with his consent implies authorisation for the farmer to use the protected livestock for an agricultural purpose including the use of animal reproductive material for his agricultural activity with exception of sale of animal reproductive material within the framework of business activities or the purpose thereof<sup>5)</sup> in the form of a subsequent reproductive activity.

## Limitation of the effects of the patent

### Article 17

(1) The right of the patent owner shall not be exercised vis-à-vis a person who before the rise of the priority right pursuant to Article 36 has exploited the invention in good faith or has made appropriate arrangements immediately aiming at the exploitation of the invention independently from the inventor or patent owner (hereinafter referred to as “prior user“) in the

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<sup>5)</sup> Article 2(1) of the Commercial Code.

territory of the Slovak Republic. In case of doubt the action of the prior user is considered acting in good faith, unless proved otherwise.

(2) Assignment or transfer of the right of the prior user for the exploitation of the invention pursuant to paragraph 1 shall be possible exclusively as a part of assignment or transfer of ownership of a company or its part, within which the invention is being used.

## Article 18

- (1) The rights of the patent owner shall not be infringed if the invention is used
- a) on board vessels of other states party to the international convention <sup>6)</sup> or party to the World Trade Organisation <sup>7)</sup> (hereinafter referred to as “Union countries“) binding for the Slovak Republic, in the body of vessel, machinery, tackle, gear and other accessories, if these vessels temporarily or accidentally enter the territory of the Slovak Republic provided the invention is used exclusively for the needs of the vessel,
  - b) in construction or operation of aircraft or land vehicles of the Union countries, or of accessories of these aircraft or land vehicles when they temporarily or accidentally enter the territory of the Slovak Republic,
  - c) when conducting activity pursuant to international convention, <sup>8)</sup> if these activities relate to an aircraft of the State which benefits from the advantages of this convention,
  - d) in individual preparation of a medicine in a pharmacy according to a medical prescription or in activity related to a medicine prepared in such a manner,
  - e) in activity being conducted privately and for non-commercial purposes,
  - f) in activity being conducted for experimental purposes.

(2) Persons using the invention pursuant to paragraph 1(d) to (f) shall not be considered as persons entitled to exploit the invention pursuant the Article 15(1)(d).

## Article 19

### Owner of the patent

A legal or natural person entered as the owner in the patent register of the Office (hereinafter referred to as “Register“) shall be considered the patent owner.

## Article 20

### Co-ownership of patent

(1) Provisions of a special regulation <sup>9)</sup> shall apply to the regulation of the relationships among the co-owners of the patent *mutatis mutandis*, if this act does not state otherwise.

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<sup>6)</sup> Decree of the Minister of Foreign Affairs No 64/1975 Coll. on Paris Convention on Protection of Industrial Property of 20 March 1883 revised in Brussels on 14 December 1900, in Washington on 2 June 1911, in the Hague on 6 November 1925, in London on 2 June 1934, in Lisbon on 31 October 1958 and in Stockholm on 14 July 1967 as amended by Decree No 81/1958 Coll.

<sup>7)</sup> Communication of the Ministry of Foreign Affairs of the Slovak Republic No 152/2000 Coll. on Conclusion of the Agreement establishing the World Trade Organisation.

<sup>8)</sup> Article 27 of the Treaty on International Civil Aviation of 7 December 1944 (Decree No 147/1947 Coll.).

<sup>9)</sup> Articles 136 and 142 of the Civil Code.

(2) The share of a co-owner to the patent shall be derived from the scope of the right to a patent belonging to the co-inventor referred to in Article 10(3) as the owner of the patent or to co-inventor as a legal predecessor of the owner of the patent.

(3) Each of the co-owners is entitled to exploit the invention, which is the subject – matter of a patent within its own company, unless the agreement between co-owners states otherwise.

(4) An agreement on cancelling of co-ownership and on mutual settlement shall be made in writing, otherwise it is invalid.

(5) An agreement pursuant to paragraph 4 shall have legal effects vis-à-vis third parties from the day of entry in the Register. The Office is obliged to enter changes following the agreement in the Register no later than within six months from its delivery to the Office or notify a decision specifying the reasons on the basis of which it is not possible to enter the modifications in the Register within this time limit.

(6) In case of the patent co-owner's death or forfeiture without any legal successor, a share of such patent co-owner shall be assigned to the rest of the co-owners in an adequate ratio to their shares.

(7) As far as the relations between co-applicants are concerned the provisions of paragraphs 1 to 5 shall apply *mutatis mutandis*.

## Article 21

### Assignment of patent

(1) An agreement on assignment of a patent shall be made in writing, otherwise it is invalid.

(2) The assignment shall have legal effects vis-à-vis third parties from the day of entry in the Register. This shall not apply vis-à-vis persons who knew or should have known according to the circumstances about the assignment. The Office is obliged to enter this assignment in the Register no later than within six months from delivery of the agreement on assignment to the Office or notify the decision specifying the reasons on the basis of which it is not possible to enter the assignment in the Register within this time limit.

(3) Third party rights being acquired before the day of entry of the patent assignment to the Register shall remain unaffected.

## Article 22

### Transfer of patent

(1) Patent ownership shall be transferred to a new owner pursuant to Article 48 including the cases stipulated by special regulations.<sup>4)</sup>

(2) The transfer shall have legal effects vis-à-vis third parties from the day of entry in the Register. This shall not apply vis-à-vis persons who knew or should have known according to the circumstances about the transfer. The office is obliged to enter this transfer in the Register no later than within six months from its delivery to the Office or notify the decision specifying the reasons on the basis of which it is not available to enter the transfer in the Register within this time limit.

(3) With the exception pursuant to Article 48, third party rights being acquired before the day of patent transfer shall remain unaffected.

## Article 23 Right of lien

(1) The right of lien on the patent can be established.

(2) As far as the right of lien and the relations between pledge creditor and pledge debtor are concerned, provisions of a special regulation <sup>10)</sup> shall apply *mutatis mutandis*.

(3) Agreement on establishing the right of lien shall be made in writing, otherwise it is invalid.

The contractual right of lien shall begin on the day of entry in the Register. The Office is obliged to enter the right of lien in the Register no later than within six months from delivery of the agreement on establishing the right of lien to the Office or notify the decision specifying the reasons on the basis of which it is not possible to enter the right of in the Register within this time limit.

(5) As far as the sub-lien right is concerned, provisions of paragraphs 2 and 3 as well as provisions of a special regulation <sup>11)</sup> shall apply *mutatis mutandis*.

## Article 24 Licence agreement

(1) The rise, lapse and enforcement of the right from the licence agreement shall be regulated by provisions of a special regulation. <sup>12)</sup>

(2). The licence agreement shall have legal effects vis-à-vis third parties from the day of entry in the Register. This shall not apply vis-à-vis persons who knew or should have known according to the circumstances about signing of licence agreement. The Office is obliged to enter the licence in the Register no later than within six months from delivery of the licence agreement to the Office or notify the decision specifying the reasons on the basis of which it is not possible to enter the licence in the Register within this time limit

(3) Unless the licence agreement stipulates otherwise, the granted licence shall be considered non-exclusive

(4) Assignment or transfer of the right of the contractual licence holder shall be possible exclusively as part of assignment or transfer of the company or its part, within which the invention pursuant to the contractual licence is being exploited, unless the licence agreement stipulates otherwise

## Licence offer

## Article 25

(1) If the patent applicant or patent owner (hereinafter referred to as “provider“) files a written statement with the Office that he shall provide to any person the right to use the

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<sup>10)</sup> Article 151(a) to (j) and Article 552 of the Civil Code.

<sup>11)</sup> Article 151(k) to (m) of the Civil Code.

<sup>12)</sup> Articles 508 to 515 of the Commercial Code.

invention for appropriate compensation (hereinafter referred to as “licence offer“), the Office shall enter the licence offer in the Register.

(2) The licence offer may be withdrawn until a written statement about accepting the licence offer is delivered to the provider.

(3) If the licence offer is not withdrawn by the provider, the entry of an exclusive licence in the Register shall be impossible.

(4) A statement on the licence offer may not be validly filed if an exclusive licence is entered in the Register.

(5) On the day of entry the decision on forfeiture of the patent protection and transfer pursuant to Article 48 in the Register, the licence offer shall be deemed to be withdrawn, unless a new patent owner or patent applicant delivers a written request on maintenance of the licence offer to the Office within a time limit of 30 days from the day of validity of the decision on forfeiture of protection and transfer.

## Article 26

(1) The person who accepts the licence offer and notifies the provider and at the same time the Office in writing shall obtain the right to exploit the invention.

(2) A licence obtained pursuant to paragraph 1 shall be considered contractual, non-exclusive, concluded for indefinite time and valid within the territory of the Slovak Republic.

(3) If no agreement on compensation for the granted licence is reached among the parties to the licence relationship, notwithstanding negotiations relating thereto, the amount of the appropriate compensation as well as terms of payment shall be determined by a court on proposal of one of the parties to the licence relationship. The importance of the invention and usual licence prices in the particular field shall be taken into consideration. In case of a substantial change of circumstances decisive for determining the appropriate compensation, the court on proposal of one of the parties to the licence relationship is entitled to change the method of compensation originally agreed or determined by the court, if no agreement has been reached among the parties, notwithstanding negotiations relating thereto.

## Compulsory licence

### Article 27

(1) On request the court is entitled to grant a compulsory licence to any person who can demonstrate the capability to exploit the invention, which is the subject-matter of the granted patent, in the territory of the Slovak Republic, provided that

- a) 4 years have expired since the filing of the application or 3 years have expired from the grant of the patent, where the time limit, which expires later, shall apply,
- b) the person who requests the granting of a compulsory licence before filing the request has made to the patent owner a proper offer for concluding a licence agreement, where this offer has not been accepted by the patent owner, and
- c) the invention is not exploited in the territory of the Slovak Republic, without an appropriate reason by the patent owner, or it is exploited insufficiently, while the subject-matter of the patented invention as a product is not supplied to the market of the Slovak

Republic in a sufficient quantity. Non-existence of appropriate reason shall be presupposed, unless proved otherwise.

(2) Compulsory licence may be granted only as a non-exclusive licence, whilst its duration and scope is limited to the purpose for which it is granted with the proviso that the domestic market needs are satisfied preferentially.

(3) If the subject-matter of the patent is a technology of semiconductor products, the compulsory licence may be granted only for the public non-commercial use or to prevent further action of the patent owner, which pursuant to a decision of the competent body can be considered as an action abusing or restricting economic competition,<sup>13)</sup> or in case of serious public interest menace.

(4) Notwithstanding paragraph 1(a) and (b) the compulsory licence may be granted in case of serious public interest menace.

(5) Notwithstanding presuppositions pursuant to paragraph 1 and conditions pursuant to paragraph 2, a court is entitled to grant a compulsory non-exclusive licence for use of a biotechnological invention on request, in case that the breeder is not able to acquire or exploit a plant variety right without infringing an earlier right to the patent, if the plaintiff can demonstrate that

- a) before filing the request he has made to the patent owner a proper offer to conclude a licence agreement, where this offer has not been accepted by the patent owner within three months from the filing date, and
- b) the plant variety represents an important technical progress of an considerable economic importance comparable with the invention which is the subject-matter of request for granting the compulsory licence.

(6) In case of granting the compulsory licence pursuant to paragraph 5, the patent owner shall have a right for granting the licence for the use of the plant variety pursuant to a special regulation.

(7) Assignment or transfer of the right of the compulsory licence holder shall be possible exclusively as part of an assignment or transfer of the company or the part thereof, within which the invention is being used on the basis of the compulsory licence.

(8) The holder of the compulsory licence is entitled to repudiate the rights from the compulsory licence by a written notice delivered to the Office. The repudiation of the right shall come into effect from the day of on which a notice to this effect is delivered to the Office or a later day which is stated in the notice as a day from which the compulsory licence rights holder repudiates the rights.

## Article 28

(1) By granting the compulsory licence, the right of the patent owner to adequate compensation shall remain unaffected; for the purposes of determining the compensation for the exploitation of the invention, which is the subject-matter of the compulsory licence, the provision of Article 26(3) shall apply *mutatis mutandis*.

(2) In case of a substantial change of circumstances, which had led to the grant of compulsory licence, the court is entitled, on request of one of the parties to the licence relationship, to cancel the decision on granting the compulsory licence, provided that repeated

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<sup>13)</sup> Act No 136/2001 Coll. on Protection of Economy Competition and on Amendment of the Act of the National Council of the Slovak Republic No 347/1990 Coll. on Organisation of Ministries and Other Central State Administration Authorities of the Slovak Republic as amended.

occurrence of reasons for granting the compulsory licence is improbable or the compulsory licence rights have not been used during one year.

(3) The Office shall enter the valid decision on granting and cancelling the compulsory licence in the Register.

#### Article 29 Validity of the patent

The term of the patent shall be 20 years from the filing date of the patent application as defined in Article 35.

#### Article 30 Abandonment of the patent

(1) The patent owner may abandon the patent by a written notice delivered to the Office. Partial abandonment of the patent is not admissible.

(2) If the patent co-owner waives his share, it shall be assigned to the rest of the co-owners in a ratio equivalent to their shares.

(3) Abandonment of the patent shall come into effect on the day of delivering the notice pursuant to paragraph 1 to the Office, or a later day, which is stated in the notice as a day on which the owner abandons the patent.

(4) Abandonment of the patent affecting third party rights which are entered in the Register, shall come into effect only after submission of a written consent of the party whose rights and justified interests may be damaged by the lapse of the patent. The same shall apply in case of existence of litigation entered in the Register whose subject-matter is the right to the patent namely to the expiration of a time limit of six months as from the day of validity of the court decision.

#### Article 31 Lapse of the patent

(1) The patent shall lapse:

- a) by expiry of the patent term,
- b) by expiry of the time limit set for payment of the administrative fees for the maintenance of the validity of the patent <sup>12)</sup> (hereinafter referred to as “maintenance fees“) pursuant to Article 79(8),
- c) from the day of effectiveness of abandonment of the patent pursuant to Article 30(3).

(2) From the day of the delivery of the request for the entry of the litigation on the right to a patent in the Register as defined in Article 50(4), the running of the time limits for the payment of maintenance fees shall be interrupted to the expiry of a time limit of six months as from the validity day of the court decision.

(3) If the pledge debtor as the owner of the patent has not paid the maintenance fees within the fixed time limit, the pledge creditor in accordance with Article (23) shall be entitled to file a written request to the Office where he asks the Office to invite him as the pledge creditor to pay the maintenance fees.

(4) In the case pursuant to paragraph 3, the patent shall lapse after the expiry of the time limit of three months from the delivery of the notice of the Office to the pledge creditor where he is asked to pay the maintenance fees.

## Article 32 Infringement of rights

(1) In case of unauthorised interference with the rights protected by this Act or jeopardising these rights, the person whose rights have been infringed or jeopardised is entitled to claim that the infringement or jeopardising of the right to be prohibited and the consequences of infringement removed.

(2) In case of interference with the rights pursuant to paragraph 1 or jeopardising these rights, the damaged party is entitled to claim the party who jeopardises or infringes his rights to submit to the damaged party data related to the origin of the product and circumstances of its placing on the market.

(3) If damage has been caused by the interference with the rights pursuant to paragraph 1, the damaged party is entitled to its compensation including the lost profit. If the interference caused a non-pecuniary injury, the damaged party is entitled to adequate satisfaction, which may be represented by pecuniary compensation.

(4) The right to compensation or satisfaction pursuant to paragraph 3 shall also belong to the damaged party whose pecuniary or non-pecuniary injury has been caused directly by enforcement of the preliminary injunction declared by the court on proposal filed without a reasonable title.

## Disputes hearing

### Article 33

(1) Disputes on rights pursuant to this Act shall be heard and ruled by courts, unless this Act stipulates otherwise.

(2) On request the court is entitled to order that products, materials or instruments through which the infringement or jeopardising of right is directly performed to be

- a) disposed of outside the channels of commerce,
- b) rendered to the plaintiff,
- c) otherwise secured by a method preventing further infringement or jeopardising of the right,
- d) destroyed in a suitable manner at the cost of the person infringing the right, unless a more appropriate solution is available.

(3) The request of the plaintiff pursuant to paragraph 2(d) in the part related to the manner of destruction of objects shall not be binding for the court.

(4) The court shall not grant the right to submit the data pursuant to Article 32(2), if the seriousness of jeopardising or infringing the right is disproportionate to the seriousness of consequences following from the fulfilment of obligation imposed in this manner.

## Article 34

(1) When protecting the rights pursuant to this Act, a court by means of preliminary injunction<sup>14)</sup> is entitled to impose obligations identical in content with decision on the matter as such in case any delay may cause to the entitled party a damage, which can be repaired only with difficulties, or a non-pecuniary injury.

(2) Within a decision on the preliminary injunction the court is also *ex officio* entitled to impose on the plaintiff an obligation to deposit a financial security in a reasonable amount, or it is entitled to condition the effectiveness of the decision by fulfilment of imposed obligation. When taking a decision on the amount of the financial security, the court shall take into consideration the scope of pecuniary or non-pecuniary injury which can occur to the counterpart, as well as to the financial situation of the plaintiff, where the imposition of the obligation to deposit a financial security shall not create a substantial obstacle for effective enforcement of the right.

(3) On proposal the court is entitled to decide upon releasing the financial security to the counterpart, as a compensation of pecuniary injury or satisfaction of non-pecuniary injury caused directly by the enforcement of the injunction decision without a reasonable title.

(4) If within a time limit of six months from the finding of the injury pursuant to paragraph 3, the claim to compensation or satisfaction is not exercised before the court or if no agreement of the parties is reached on the use of the financial security, the court shall return the financial security.

## **PART THREE PROCEEDINGS ON GRANTING OF A PATENT**

### Article 35

#### Filing date of patent application

(1) Proceedings on granting of a patent shall start by filing a patent application with the Office.

(2) Unless stated otherwise below, the filing date of the application shall be considered the day of delivering or supplementing the submission which as a minimum shall contain

- a) data indicating an apparent intention of the applicant to file a patent application,
- b) data allowing identification of the applicant to be established and allowing the applicant to be contacted,
- c) part of description clearly expressing the subject – matter of invention.

(3) The obligation of the applicant pursuant to Article 79(7) shall not apply for the purposes of determining the filing date of the application in relation to data pursuant to paragraph 2(c).

(4) If the Office finds out that the part of submission pursuant to paragraph 2(c) is missing, it shall request the applicant to supplement the missing part of the submission within a set time limit.

(5) In the case pursuant to paragraph 4 the date of supplementing the missing part of the submission shall be considered as the filing date of the application.

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<sup>14)</sup> Articles 74 to 77 and Article 102 of The Rules of Civil Procedure.

(6) The determination of the filing date of the application pursuant to paragraph 5 shall not be applied if

- a) a priority right was claimed pursuant to Article 36(2) in the original submission and the applicant at the same time when supplementing of the missing part of the submission pursuant to paragraph 2(c) asks for determining of filing date of the application to the filing date of the submission is filed, or
- b) after supplementing of the submission pursuant to paragraph 4 the applicant within the set time limit withdraws his submission in the part supplemented pursuant to paragraph 4.

### Article 36 Priority right

(1) The priority right for the applicant shall be established

- a) on the filing date of the application or
- b) on the priority date according to the international convention <sup>6)</sup> following from an earlier patent application, utility model application or author's certificate or utility certificate.

(2) The priority right, which follows from the international convention <sup>6)</sup> has to be claimed by the applicant in the application.

(3) A priority right pursuant to paragraph 2 may be claimed if an earlier application is filed in the State or in relation to a State which is a contracting party to the international convention <sup>6)</sup> or which is a member state of the World Trade Organisation. <sup>7)</sup> Otherwise this right may be claimed exclusively in case of the reciprocity.

(4) If the applicant who has filed an application within a time limit of 12 months from the date of rise of the priority right, does not claim the priority right pursuant to paragraph 2, the Office shall grant priority right on the basis of a request for subsequent granting of priority right filed within 16 months from the date of rise of the priority right, but no later than

- a) within a time limit of four months from the filing date of application,
- b) on the day of submitting the request for an earlier publication of the application according to Article 41(2),

(5) If the applicant files the application after the expiry of 12 months from the day of rise of the priority right, the Office shall grant priority right on the basis of the request for subsequent granting of priority right, provided that

- a) the application as well as the request for subsequent granting of priority right have been filed within the time limit of 14 months from the date of rise of priority right,
- b) in his request the applicant shall justify in an appropriate manner the delayed filing of the application and particularly state the facts which had prevented him from timely filing of the application, not caused by him.

(6) The Office is entitled to request the applicant to prove the claimed priority right by a priority right document (hereinafter referred to as "priority document") within a time limit stipulated by the Office, however not earlier than 16 months from the day of rise of priority right.

(7) If the applicant fails to prove the existence of the priority right properly and in time pursuant to paragraph 6, the Office shall grant the priority right on the basis of a justified request for subsequent recognition of the priority document, provided that

- a) the request for an issue of the priority document was submitted to the competent authority within a time limit of one month as from the day of submitting the request to the Office pursuant to paragraph 6 at the latest,
- b) request for subsequent recognition of priority document together with the priority document was submitted within one month from delivering of the priority document to the applicant.

(8) If the assessment of patentability of the invention depends on the granting of the priority right, the Office is entitled to invite the applicant to submit a translation of the priority document in Slovak language or one of the official languages of the European Patent Office, which is at the discretion of the applicant.

(9) In case of reasonable doubt about the veracity of the justification pursuant to paragraphs 5 and 7, the Office may invite the applicant to prove his statements.

(10) For the requests pursuant to paragraphs 4, 5, and 7 the applicant is obliged to pay an administrative fee pursuant to Article 79(8).

(11) Claiming and proving the existence of the priority right which fails to meet the requirements pursuant to this provision and pursuant to the generally binding regulations, shall be disregarded by the Office during the proceedings. The Office shall notify the applicant on this fact.

(12) On the basis of the request of the applicant or patent owner the Office shall, after the payment of the administrative fee pursuant to Article 79(8), issue a priority document certifying the priority right following from the application, international application or European patent application filed with the Office.

## Article 37 Application

(1) A patent application may be filed by a person or persons who have the right to a patent pursuant to Article 10(1) and (3), Article 11(1) or Article 12(1).

(2) If the right to a patent belongs to several persons, one or some of these persons in his or their own name may file the application. On the basis of a request supported by a written agreement between the applicant or applicants and the person, that has the right to file the application pursuant to paragraph 1, the Office shall enter such a person as a co-applicant in the Register.

(3) The application may contain only one invention or a group of inventions, which are mutually related in such a manner, that they create a single inventive concept.

(4) The invention has to be described and explained in the application clearly and completely so that it can be carried out by a person skilled in the art.

(5) The patent application shall contain:

- a) a request for granting the patent,
- b) a description of the invention, abstract and drawings, if appropriate,
- c) at least one patent claim applied for,
- d) the identification data of the applicant or co-applicant,
- e) the identification data of the inventor or co-inventors,
- f) a document on acquisition of right to the patent, if the applicant is not the inventor.

(6) For filing the application the applicant is obliged to pay the administrative fee in accordance with Article 79(8).

#### Article 38

##### Special provision on the application of biotechnological invention

(1) If the subject-matter of an invention is biological material or the use of biological material, which is not publicly available and which cannot be described in the application in such a manner so as to be carried out by a person skilled in the art, the description shall be considered adequate only on condition that

- a) the biological material has been deposited in a recognised depository institution no later than by the filing date of the application,
- b) the application as filed contains information on the characteristics of the deposited biological material, which was available to the applicant,
- c) the application states the name and seat of the recognised depository institution, as well as the deposit number of the deposited sample.

(2) In case of doubt about making the biological material available or the adequacy of the description pursuant to paragraph 1, it shall be deemed that the availability condition or adequacy of description condition is not met, unless proved otherwise.

(3) If the subject-matter of the application is a sequence or partial sequence of a gene, the industrial application of the invention has to be explained in the application.

(4) The recognised depository institution is the institution for the deposition of biological material, which acquired a status pursuant to the international convention <sup>15)</sup> or it was recognised by the Office.

#### Article 39

##### Interruption of the patent application proceedings

(1) After the start of court proceedings in litigation for the right to the patent, the Office shall interrupt the patent application proceedings.

(2) During the interruption of the proceedings the time limits pursuant to this Act stop running, with the exception of the time limit pursuant to Article 41(1).

(3) After a decision by which the proposal for forfeiture of the application rights and a transfer of these rights referred to in Article 48(3) has been approved to become valid, the Office shall continue the proceedings interrupted pursuant to paragraph 1.

##### Preliminary examination of the application

#### Article 40

(1) Within the preliminary examination the Office shall ascertain whether

- a) conditions for determining the filing date of the application pursuant to Article 35 have been met,

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<sup>15)</sup> Decree of the Minister of Foreign Affairs No 22/1989 Coll. on Budapest Agreement on International Recognition of Micro organism Deposit for purposes of patent proceeding and its implementing regulation.

- b) conditions for granting the priority right pursuant to Article 36 have been met,
- c) the application meets conditions pursuant to Articles 37, 38 and 59,
- d) the application meets conditions pursuant to the generally binding regulation as defined in Article 80,
- e) the applicant has paid the appropriate administrative fee pursuant to Article 79(8),
- f) the applicant is represented by an authorised representative pursuant to Article 79(1),
- g) the application does not contain subject-matter which clearly does not meet conditions pursuant to Article 5(1) or is not considered an invention pursuant to Article 5(3), or which is subject to exception from patentability pursuant to Article 6.

(2) In case of doubt the Office may invite the applicant to prove the application of the subject-matter of the application, by demonstrating it or in another suitable manner. If the applicant fails to prove the application or fails to comply with the invitation, the subject-matter of the application shall be deemed to be inapplicable.

(3) In case irregularities are found pursuant to paragraph 1(e) and (f) or Article 35(2), or Article 37(3) and (5), or Article 79(8), or pursuant to the implementing regulation as defined in Article (80), the Office shall invite the applicant to correct the relevant irregularities or to react to the invitation. If the applicant fails to comply with the invitation within a time limit set or his statement fails to render the invitation unjustified, the Office shall suspend the application proceedings. The applicant has to be notified about this consequence in the invitation.

(4) If the application fails to meet conditions pursuant to Article 37(1) and (4) or Article 38(1) to (3) or the subject-matter of the application clearly fails to meet conditions pursuant to Article 5(1), or is not considered an invention pursuant to Article 5(3), or is subject to exception to patentability pursuant to Article 6, or an assumption pursuant to paragraph 2 applies, the Office shall refuse the application. Before the refusal of the application the Office shall enable the applicant to react to the ascertained reasons on the basis of which it is to be refused.

(5) If the conditions for claiming the priority right pursuant to Article 36(2) to (9) and pursuant to the generally binding regulation in accordance with Article 80 failed to meet, the Office shall grant to the applicant the priority right pursuant to Article 36(1)(a).

#### Article 41

(1) The Office shall without delay publish the application after an expiry of 18 months from the rise of the priority right and shall announce this publication in the Journal.

(2) The application may be published before the expiry of the time limit stipulated in paragraph 1, if the applicant applies for it no later than within 12 months from the rise of the priority right and if he pays the administrative fee pursuant to Article 79(8). The Office shall publish the application before the expiry of the time limit stipulated in paragraph 1, if a patent has already been granted for the invention; however, without the consent of the applicant the Office shall not publish the application before the expiry of 12 months from the rise of the priority right.

(3) Together with the application the Office may publish a search report related to the invention applied for in the application.

## Article 42

(1) After the publication of the application any person may file with the Office oppositions on the patentability of its subject-matter; the Office shall take them into consideration during substantive examination of the application.

(2) Persons who have filed oppositions pursuant to paragraph 1 shall not become parties to the application proceedings. However, the applicant has to be notified about the oppositions and he is allowed to respond to them.

## Substantive examination of the application

## Article 43

(1) Upon request of the applicant, of third party or *ex officio*, the Office shall without delay conduct substantive examination of the patent application, in which it shall assess whether the application meets the conditions for granting a patent stipulated by this Act.

(2) The request for conducting substantive examination has to be filed no later than within 36 months from filing the application as defined in Article 35 and it cannot be withdrawn. Together with the request the person who requests shall be obliged to pay administrative fee pursuant to Article 79(8).

(3) If request for conducting a substantive examination was not properly filed within the time limit stipulated in paragraph 2, or if within the same time limit the Office failed to start the substantive examination of the application *ex officio*, the Office shall suspend the application proceedings.

(4) The Office shall notify the applicant without delay about the starting of substantive examination on request of a third party or *ex officio*.

## Article 44

(1) If the conditions stipulated for granting the patent are not met referred to in Articles 5, 7, 8 and 9, the Office shall refuse the application. Before refusing the application the Office shall enable the applicant to react to the ascertained reasons on the basis of which it has to be refused.

(2) If the Office additionally finds out irregularities in the application or failure to meet conditions, which are the subject-matter of preliminary examination of the application, it shall proceed according to Article 40(2) to (5).

(3) If more applications have been filed with an identical subject-matter, one applicant shall be granted only one patent.

(4) If the subject-matter of the application meets the stipulated conditions and the applicants pays the appropriate administrative fee in accordance with Article 79(8), the Office shall grant the patent to the applicant, whereby the applicant becomes the owner of the patent. The Office shall issue a patent deed to the owner and the granting of the patent shall be published in the Journal.

(5) Owner of the patent shall be obliged to pay administrative fee for maintenance of the patent in accordance with Article 79(8).

Article 45  
Amendment of the application

(1) The applicant is entitled to amend the application in the course of the proceedings on application in the form and to the scope, which does not extend the content of the application as filed.

(2) Amendment of the application pursuant to paragraph 1 shall mean also the exclusion of the application in case of non-fulfilment of the condition pursuant to Article 37(3).

Revocation and partial revocation of a patent

Article 46

(1) The Office shall revoke a patent if during the proceedings started on third party request or *ex officio* it is proved that

- a) requirements for granting it pursuant to Articles 5 to 9 have not been met,
- b) the invention is not disclosed and described in the patent so clearly and so fully so that it can be carried out by a person skilled in the art,
- c) the subject-matter of the patent extends the content of the application as filed. This shall also apply in case the subject-matter of the patent granted on the basis of an divisional application extending over the contents of the application as filed,
- d) the scope of protection following from the patent was extended,
- e) the owner does not have the right to the patent pursuant to Article 10(1) and (3), Article 11(1) or Article 12(1).
- f) the granting conditions valid in time of granting were not fulfilled.

(2) If the reasons for revocation concern the patent partially, the patent shall be revoked only to the extent proportionate to the reasons found, by means of modifying of the patent claims, description or drawings.

(3) If the patent has been revoked within the scope affected by the revocation it shall be deemed not to have been granted.

(4) A request for revocation of the patent may be filed also after the lapse of the patent, if the person who requests revocation proves legal interest.

(5) The Office can partially revoke the patent pursuant to paragraph 2 also on request of the owner notwithstanding the existence of the grounds pursuant to paragraph 1.

(6) The Office shall notify the decision on revocation or partial revocation of the patent in the Journal.

(7) For a request pursuant to paragraphs 1 and 5 the person who requests the revocation shall be obliged to pay an administrative fee pursuant to Article 79(8).

Article 47

(1) If the request for revocation or partial revocation of a patent (hereinafter referred to as “revocation request”) fails to contain requirements stipulated in the generally binding regulation in accordance with Article 80 or if the person who requests the revocation is not represented by an authorised representative pursuant to Article 79(1) or if the administrative

fee has not been paid as defined in Article 79(8), the Office shall invite the person who requests the revocation to correct the irregularities found within a fixed time limit. If the person who requests the revocation fails to comply with the invitation served on him, the Office shall suspend the revocation request proceedings. The person who proposes the revocation has to be notified about this consequence in the invitation.

(2) If the proceedings have not been suspended pursuant to paragraph 1, the Office shall deliver the revocation request to the patent owner and shall invite him at the same time to respond to it within a set time limit and at the same time to indicate proofs and supplement documents.

(3) If the patent owner fails to respond within the time limit stipulated in the notice, the Office shall continue the proceedings and is entitled to make a decision on the basis of the contents of the file.

(4) The Office shall proceed pursuant to paragraph 3 also in the case when the patent owner is not represented by an authorised representative pursuant to Article 79(1). If the owner fails to comply with the notice to submit the authorisation within the stipulated time limit, he shall be deemed not to have responded to the revocation request.

(5) If it is impossible to decide on the basis of written submissions of the parties, the Office shall set a date for oral proceedings. The Office shall at the same time deliver to the person who requests revocation a statement of the owner on his request.

(6) The Office may continue in the proceedings and decide in the matter also in case a duly summoned party fails to participate in the oral proceedings.

(7) Extending or supplementing the revocation request, as well as extending or supplementing the statement of the patent owner in proceedings pursuant to Article 46(1) shall be inadmissible; such extending or supplementing shall not be taken into consideration within the proceedings and decision-making by the Office.

(8) At the time of patent revocation proceedings pursuant to Article 46(1), the proceedings on the request of the owner pursuant to Article 46(5) shall be interrupted.

## Article 48

### Forfeiture of patent and transfer

(1) The Office, on request, shall forfeit the patent from the patent owner entered in the Register and shall enter the person who requests it as patent owner if

- a) it has been determined by a valid decision of the court that the person originally entered as the owner was not entitled to the right to the patent pursuant to Article 10(1) and (3), Article 11(1) or Article 12(1),
- b) the request has been filed by a person who according to a valid decision of the court has the right to the patent, or is his legal successor in title,
- c) the request has been filed within three months from the day of validity of the court decision.

(2) Provided that the condition pursuant to paragraph 1(a) has been met, if the request pursuant to paragraph 1 has not been filed or it has not been filed by the authorised person or within the set time limit, the Office shall revoke the patent *ex officio* due to a reason pursuant to Article 46(1)(e).

(3) As far as the forfeiture of rights from an application and their transfer to the entitled person is concerned, the paragraph 1 shall apply *mutatis mutandis*. If no rectification of rights

from the application occurs due to reasons pursuant to paragraph 2, the Office shall refuse the application pursuant to Article 40(4).

(4) As far as proceedings according to the paragraphs 1 to 3 are concerned, Article 47(1) to (6) shall apply *mutatis mutandis*.

(5) Together with the request pursuant to the paragraphs 1 and 3 the person who requests it shall be obliged to pay the administrative fee in accordance with Article 79(8).

#### Article 49

##### Determination proceedings

(1) On the request, the Office shall determine whether the subject-matter stated and described in the request falls within the scope of protection of a certain patent (hereinafter referred to as “determination request”).

(2) On the basis of an explicit request of the proponent, also a person whose rights and obligations may be affected by the determination decision shall be party to the proceedings pursuant to paragraph 1.

(3) In case the determination request was filed in connection with the pending court proceedings whose subject-matter is the right protected by this Act, all parties to the court proceedings whose rights and obligations may be affected by the determination proceedings and decision-making on determination shall be the parties to the determination proceedings.

(4) As far as proceedings to which the owner of the patent is the exclusive party, the provision of Article 47(1) and (5) the first sentence and paragraph 6 shall apply *mutatis mutandis*, otherwise provisions of Article 47(1) to (6) shall apply *mutatis mutandis* for the determination proceedings.

(5) Together with the determination request the proponent shall be obliged to pay the administrative fee according to Article 79(8).

#### Article 50

##### Registration of licence, right of lien, assignment or transfer of the patent and court litigation in the Register

(1) As far as the request for the registration of the licence, right of lien, assignment or transfer of the patent in the Register (hereinafter referred to as “entry request”) are concerned, Article 47(1) shall apply *mutatis mutandis*.

(2) In case of doubt the Office may ask for submission of a certified copy or the original of the deed if appropriate which proves the acquisition of the right or other supplementary data.

(3) Provisions of paragraphs 1 and 2 shall not apply to compulsory licence, which the Office shall enter in the Register *ex officio* after the service of valid court decision on its grant.

(4) On the basis of a request of the party to the court proceedings, whose subject-matter is the right protected by this Act, supplemented by a counterpart of the petition to the court certified by the court, the Office shall enter in the Register the fact that court proceedings are pending as well as the subject-matter of the proceedings, with effect from the day of delivering the request to the Office.

(5) The applicant submitting request pursuant to paragraphs 1 and 4 shall be obliged to pay administrative fee pursuant to Article 79(8).

## Article 51 Further processing

(1) On the basis of the request of the party to the proceedings on extension of the time limit set by the Office for performing an act, while such request has been filed before the expiry of such a time limit, the Office is entitled to extend the relevant time limit.

(2) If a party to the proceedings before the Office has failed to comply with the time limit set by the Office for performing an act, he is entitled to ask the Office for further processing and at the same time perform the omitted act no later than two months from the service of the official decision issued as a consequence of failure to comply with the time limit.

(3) Together with submitting a request pursuant to paragraphs 1 or 2 the applicant shall be obliged to pay an administrative fee as defined in Article 79(8).

(4) The Office shall refuse a request pursuant to paragraphs 1 or 2 in case of failure to comply with time limits for

- a) payment of the maintenance fee pursuant to Article 79(8),
- b) claiming of priority right pursuant to Article 36,
- c) submitting a request for further processing and *restitutio in integrum* pursuant to paragraph 2 and Article 52(1),
- d) filing a remedy in proceedings before the Office,
- e) fulfilment of obligation imposed in the litigation proceedings before the Office pursuant to Article 47(3) or claiming of right pursuant to Article 48(1)(c).

(5) The Office shall refuse the request for extension of time limits or for further processing which fails to comply with conditions pursuant to paragraphs 1 or 2 or to which a restriction pursuant to paragraph 4 applies; before the refusal of the request the Office shall enable the person who requests it to respond to the ascertained reasons on the basis of which it is to be refused.

(6) If the Office grants request for further processing the legal effects of the decision issued as a consequence of failure to comply with time limit shall be retracted or shall not ensue.

(7) If the Office fails to make a decision about refusing the request pursuant to paragraphs 1 or 2 within two months from its delivery and the administrative fee has been paid duly and in time pursuant to paragraph 3, the request shall be deemed to be satisfied.

## Article 52 Restitutio in integrum

(1) If the party to the proceedings before the Office unintentionally fails to comply with the statutory time limit or the time limit set by the Office for performing an act where a consequence of non-performance of the act is suspension of the proceedings or another right is lost, he is entitled to ask the Office for *restitutio in integrum* and at the same time perform the omitted act within two months from the removal of the cause for which he could not perform the act, however, no later than within 12 months from the expiry of the non-complied time limit.

(2) Together with the submission of the request pursuant to paragraph 1 the applicant shall be obliged to pay an administrative fee according to Article 79(8).

(3) The party to the proceedings shall be obliged to justify the request pursuant to paragraph 1 and state particularly the facts, which had prevented the performance of the action. Statements submitted after the expiry of any of the time limits pursuant to paragraph 1 shall not be taken into consideration by the Office when making a decision about the request.

(4) In case of reasonable doubt about the veracity of the statement pursuant to paragraph 3 the Office may ask the applicant to prove his statements.

(5) Request for *restitutio in integrum* shall not be granted in case of failure to comply with the time limits for performance of the act pursuant to Article 51(4).

(6) The Office shall refuse the request for *restitutio in integrum* which fails to meet the requirements pursuant to paragraphs 1 and 3, or to which the restriction pursuant to paragraph 5 applies or if the applicant who requests has not proven his statements pursuant to paragraph 4; before the refusal of the request the Office shall enable the person who requests it to respond to the ascertained reasons on the basis of which it is to be refused.

(7) If the Office satisfies the request for *restitutio in integrum*, the legal effects of the decision issued as a consequence of failure to comply with the time limit shall be retracted or shall not ensue.

(8) A third party that within the territory of the Slovak Republic has exploited the invention which was the subject-matter of the published application or of a patent in good faith or has made appropriate arrangements focused on the exploitation of the invention since the validity of the decision issued as a consequence of failure to comply with the time limit until the lapse of legal effects of this decision pursuant to paragraph 7, is entitled to exploit the invention within its business activity without the obligation for remuneration for the exploitation of the invention.

(9) Assignment or transfer of the right of the entitled user pursuant to paragraph 8 shall be possible exclusively as part of assignment or transfer of ownership of a company or its part, within which the invention is being used.

## Article 53

### Grounds for the decision

(1) Parties to the administrative proceedings before the Office (hereinafter referred to as “parties”) shall be obliged to submit or propose the evidence in support of their statements.

(2) The Office shall develop the evidence and evaluate the evidence at its discretion, namely each of them separately and all of them in their mutual relationships.

(3) The Office shall decide on the basis of the facts ascertained from the developed evidence submitted or proposed by the parties.

## Article 54

### Costs of proceedings

(1) Costs of proceedings are particularly expenses of the parties and their representatives, including the administrative fees, lost income of the parties, costs of evidence and remuneration of patent representatives,<sup>16)</sup> attorneys at law,<sup>17)</sup> or commercial lawyers.<sup>18)</sup>

(2) Each party shall bear the costs of proceedings which have incurred to him personally and to his representative.

(3) Witnesses are entitled to reimbursement of expenses and lost income. This right shall cease if it is not claimed within three days of the hearing or from the day on which the witness is notified about cancellation of the hearing.

(4) If an expert witness report has been submitted, the expert witness is entitled to a reimbursement of expenses and remuneration pursuant to special regulations.<sup>19)</sup>

(5) The person on whom the Office imposed an obligation during the proceedings, particularly to submit a deed or enable an inspection of an object, has the same rights as the witness, if he is not a party to the proceedings.

(6) The Office may order the party to deposit advancement for the cost of the evidence which he had proposed, in the amount of the assumed costs, unless the imposition of such duty represents a substantial obstacle to effective enforcement of the right.

(7) If the party fails to comply with the invitation to deposit advancement within the set time limit, the Office shall continue in the proceedings as though a proposal for evidence had not been filed.

(8) If the Office incurs costs which are not covered by the advancement pursuant to paragraph 6, the Office shall be entitled to their compensation from the party which has not been successful in the proceeding.

(9) The Office is entitled to declare the party to the proceedings which has been successful in the proceeding be authorised for compensation of costs incurred for effective enforcement of the right against the party unsuccessful in the proceeding. If the party to the proceedings has been only partially successful in the matter, the Office shall divide the compensation of costs accordingly or is entitled not to declare the authorisation for such compensation of costs to any party.

(10) The party shall claim the compensation of the proceedings costs no later than till the day when the decision on the merits as such is issued.

## Article 55

### Remedies

(1) An appeal against the decision of the Office may be lodged within 30 days from the delivery of the decision.

(2) When making decisions on the appeal the Office shall be bound by its scope; this shall not apply

a) in matters in which proceedings can be started *ex officio*,

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<sup>16)</sup> Decree of Federal Office for Inventions No 350/1991 Coll. on Remuneration of Patent Attorneys.

<sup>17)</sup> Decree of the Ministry of Justice of the Slovak Republic No 240/1990 Coll. on Remuneration of Attorneys for Providing Legal Advice as amended.

<sup>18)</sup> Decree of the Ministry of Justice of the Slovak Republic No 180/1991 Coll. on Remuneration of Commercial Lawyers for Providing Legal Advice as amended.

<sup>19)</sup> Act No 36/1967 Coll. on Experts and Interpreters as amended by Act No 238/2000 Coll.; Decree of the Ministry of Justice of the Slovak Republic No 263/1996 Coll. which implements the Act No. 36/1967 on Experts and Interpreters as amended by 294/2000 Coll.

- b) in case of joint rights or obligations concerning several parties on one side.
- (3) Filing an appeal shall not be admissible against a decision on which
  - a) a request for further processing, or request for *restitutio in integrum* has been satisfied,
  - b) the proceedings have been suspended pursuant to Article 79(5).
- (4) Together with the appeal the party shall be obliged to pay administrative fee according to Article 79(8).

## Article 56 Data accessibility

(1) Before publishing the patent application the Office shall be entitled to notify third parties without consent of the applicant only the data who is the inventor, the patent applicant, the name and file number of the patent application and data about priority right, unless stated otherwise below.

(2) Notwithstanding the provisions of paragraph 1, the Office shall on the basis of the request enable to inspect the file concerning a non-published application to the owner of the patent or applicant, provided that the non-published application refers to the patent or application of this owner of the patent or this applicant, or to a person vis- à-vis a person whose rights from non-published applications were applied.

(3) Unless stated otherwise below, after the publication of the application, the Office shall enable anyone to inspect the file on the basis of his request.

(4) The right for a file inspection shall include a right for making photocopies for the fee.

(5) On the basis of a written request of the inventor stated in the application pursuant to Article 37(5) the Office shall not make accessible his identifying data to third parties, particularly by publication of the patent application, the notice of the grant of a patent, the issue of the letters patent, the issue of the extract from the register and by file inspection.

(6) On the basis of a written request, provided that the emergent legal interest has been met, the Office shall be entitled to notify the person who requests whether a person indicated by him is alleged as an inventor in the application, or not.

(7) On the basis of a written request of the applicant or owner of the patent, those parts of the file which contain trade secret or other confidential information which publication is not necessary for a guarantee of the right for an information of third parties including the parties to the proceedings shall be excluded from the file inspection.

(8) Rights pursuant to paragraphs 1 to 3 shall not be claimed in relation to the applications and patents kept confidential according to the special regulation <sup>20)</sup> to the record on voting and to those parts of the file containing ancillary notes or draft versions of decisions or other correspondence.

## Article 57 Register and Official Journal

- (1) The Office shall keep
  - a) a Register in which it enters decisive data concerning the patent applications and granted patents,

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<sup>20)</sup> Act No 241/2001 Coll. on Protection of Confidential Matters as amended.

- b) a European Patents Register in which it enters decisive data concerning granted European patents designating the Slovak Republic,
- c) a Register in which it enters decisive data concerning applications for granting supplementary protection certificates for medicinal products or plant protection products, as well as granted supplementary protection certificates for medicinal products or plant protection products.

(2) Data entered in the registers pursuant to paragraph 1 shall be considered valid, unless a decision of the relevant authority determines otherwise.

(3) Modifications of data in the Register, ensuing from a valid and enforceable decision of the relevant authority, shall be entered in the Register without delay by the Office after delivery of the court decision with validity clause.

(4) The entry of data and facts ensuing from the law or from a decision of the relevant authority shall not be considered a decision issued in the proceedings pursuant to a special regulation.<sup>21)</sup>

(5) Any person is authorised to inspect the Registers stated in the paragraph 1.

(6) The Office shall publish an Official Journal in which it publishes facts concerning the published patent applications, European patent applications as well as patents, European patents, supplementary protection certificates and their protection.

## Article 58

### International application

(1) An international application may be filed with the Office by

- a) natural persons who are the nationals of the Slovak Republic,
- b) natural persons or legal persons with a residence or seat, establishment or organisational component in the territory of the Slovak Republic,

(2) For actions related to filing an international application the applicant shall be obliged to pay an administrative fee as defined in Article 79(8) and, through the Office, to pay the fees stipulated in the Patent Co-operation Treaty.<sup>1)</sup>

(3) The person filing an international application<sup>1)</sup> by which he applies for the grant of a patent in the Slovak Republic shall be obliged to submit the international application to the Office within 31 month from the priority date, pay an administrative fee for filing the application (as defined in Article 79(8)) and submit its translation into the official language.

(4) On request of the applicant, if conditions pursuant to paragraph 3 have been met, the Office may start proceedings on the international application even before the expiry of time limits laid down in paragraph 3.

### Protection of confidential matters

## Article 59

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<sup>21)</sup> Act No 71/1967 Coll. on Administrative Proceedings (Administrative Procedure Code).

(1) If a domestic applicant knows or due to the circumstances should know that the application contains confidential matters pursuant to a special regulation, <sup>20)</sup> he shall be obliged to request explicitly in the application to keep it confidential.

(2) The applicant shall be obliged to file an application pursuant to paragraph 1, which is an international application of an invention or a European patent application, with the Office.

(3) The Office after it has accorded a filing date according to Article 35 shall deliver one version of the application to the National Security Office <sup>20)</sup> (hereinafter referred to as “Security Office”) together with the request for decision on confidentiality of the application pursuant to the special regulation <sup>20)</sup> or, as the case may be, with the request for permission of filing the application abroad.

(4) The Office is entitled to act pursuant to paragraph 3 also in case when the applicant has not asked to keep the application confidential pursuant to paragraph 1.

(5) The Security Office shall decide on the request pursuant to paragraph 3 and deliver the decision to the Office. In case an international convention, treaty or agreement, by which the Slovak Republic is bound, allows it, the Security Office shall supplement the decision with a request for keeping the subject-matter of the application confidential by the contracting party to the international convention, in which the application should be filed. The Office shall notify the applicant on the decision of the Security Office.

(6) An application pursuant to paragraph 1, which is neither a European patent application nor an international application, may be filed by the applicant directly abroad only on the basis of permission of the Security Office pursuant to the paragraph 3, issued on the basis of the request of the applicant.

(7) If as a consequence of keeping the application confidential or as a result of the refusal of a request for permission to file an application abroad the owner incurs a pecuniary injury consisting in preventing or limiting the commercial exploitation of the patent as defined in Article 3(h), the owner shall be entitled to a compensation of the pecuniary injury towards the Slovak Republic represented by the state administration authority to which competence belongs the subject-matter of the confidential application.

(8) As far as the determination of the amount of pecuniary injury pursuant to paragraph 7 is concerned, Article 11(6) shall apply *mutatis mutandis*.

(9) Patent applications, European patent applications or international applications, for the confidentiality of which the contracting party or a foreign applicant has applied pursuant to an international convention binding for the Slovak Republic, shall be considered confidential pursuant to a special regulation. <sup>20)</sup> A foreign applicant who does not act on behalf of the contracting party shall be obliged to prove the confidentiality of the application subject-matter by the contracting party, submit the permission of the contracting party for filing the application in the Slovak Republic and supplement a declaration on repudiation of any claims for compensation of damage or other pecuniary injury which might occur as a result of keeping the application confidential in the territory of the Slovak Republic.

(10) Provisions of this Act shall apply to proceedings on applications which are confidential or deemed to be confidential pursuant to a special act, <sup>20)</sup> with the exception of publication laid down in Article 41 and making data available in accordance with Article 56 related to the confidential application or patent.

(11) If the Security Office does not consider facts contained in the application confidential pursuant to a special regulation, <sup>20)</sup> the Office shall notify this fact to the applicant and shall continue proceedings on the application without applying the confidentiality regime.

**PART FOUR**  
**IMPLEMENTATION OF THE EUROPEAN PATENT CONVENTION**

Article 60

Effects of the European patent application

(1) A European patent application designating the Slovak Republic (hereinafter referred to as “European Patent Application”) shall have from the accorded filing date or from the day of rise of the priority right claimed by the applicant the same effect as a patent application filed pursuant to Article 35 on the same day, or an application with the same day of rise of priority right pursuant to Article 36.

(2) After the publication of a European Patent Application by the European Patent Office and a subsequent submission of a translation of the patent claims into Slovak language and the payment of the publication fee according to Article 79(8) by the applicant of the European Patent Application, the Office shall make the translation of patent claims available to the public and shall publish this fact in the Journal.

(3) From the day of making the translation of the patent claims available to the public pursuant to paragraph 2, the person filing the European Patent Application has the same rights as a person filing an application pursuant to this Act as defined in Article 13(1) to (3) provided that the European patent has been granted with effect in the Slovak Republic.

(4) If the European Patent Application has been withdrawn in the proceedings before the European Patent Office, or if it is deemed withdrawn, the application proceedings shall be deemed to have been suspended pursuant to Article 40(3). Refusal of European Patent Application shall have the same effects as refusal of application pursuant to Article 40(4).

(5) A decision of the European Patent Office on further processing or *restitutio in integrum* shall have the same effects as a decision of the Office pursuant to Article 51(5) and (6) or Article 52(7) and (8).

Article 61

Conversion of European Patent Application

(1) On the basis of a request of the applicant for a conversion of European Patent Application to a national application (hereinafter referred to as “conversion”) filed pursuant to Articles 135 and 136 of the European Patent Convention, the Office shall start proceedings on this application pursuant to Part Three of this Act or it shall proceed according to Article 136(2) of the European Patent Convention.

(2) The applicant shall be obliged on the basis of the notice of the Office to submit within 3 months a translation of the European Patent Application into Slovak language and pay the administrative fee for filing an application in accordance with Article 79(8).

(3) In case the request for conversion is not filed within three months from the day when the European Patent Application has been withdrawn or when a notification has been delivered that the application is considered withdrawn, or in the case of a decision on the refusal of the application or revocation of European patent, the applicant shall lose the priority right following from European Patent Application as filed.

(4) If the request for conversion of European Patent Application has been filed in contradiction with Articles 135 to 137 of the European Patent Convention, the Office shall refuse the request.

(5) On the basis of a request for a conversion of the European Patent Application to a national application of a utility model filed pursuant to paragraph 1, the Office shall, on the basis of the European Patent Application, start proceedings on utility model application pursuant to a special regulation,<sup>22)</sup> or it shall proceed according to Article 136(2) of the European Patent Convention. Provisions of paragraphs 2 to 4 shall apply *mutatis mutandis*.

## Article 62

### Binding wording of the European Patent Application and European patent

(1) The contents of the European Patent Application modified by the wording of the European patent in the language in which the proceedings on the European Patent Application were held before the European Patent Office shall be decisive for determination of the scope of protection ensuing from European Patent Application and European patent.

(2) If protection ensuing from the translation of the patent specification into the Slovak language submitted to the Office pursuant to Article 63(2) as well as from the translation of patent claims submitted to the Office pursuant to Article 60(2) is narrower than from the wording of the European Patent Application and European patent in the language in which the proceedings before the European Patent Office were held, the translation into the Slovak language shall be considered the binding wording, with the exception of proceedings for revocation of the European patent.

(3) At any time the applicant or owner of a European patent may file a corrected translation of claims pursuant to Article 60(2) or a corrected translation of the European patent specification pursuant to Article 63(2) into Slovak language. After the delivery of the corrected translation and payment of fee pursuant to Article 79(8), the Office shall make the corrected translation available to the public and shall publish this fact in the Journal.

(4) The corrected translation shall apply instead of the original translation from the day of notification of making the corrected translation available in the Journal.

(5) The right of third parties to use the subject-matter of the invention, which according to the translation into the Slovak language valid in the decisive period has not fallen within the scope of the European patent, shall remain unaffected by the effects of the corrected translation, provided that, within the territory of the Slovak Republic and in good faith, the subject-matter of the invention has been used or evincible arrangements for using the subject-matter of the invention have been made..

## Article 63

### Effects of European patent

(1) A European patent granted by the European Patent Office designating the Slovak Republic shall have the same effects as a patent granted pursuant to Article 44(4) from the day of notification of granting the European patent in the European Patent Bulletin.

(2) The owner of European patent shall be obliged to submit to the Office within three months from the notification on granting the European patent a translation of the patent

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<sup>22)</sup> Act No 478/1992 Coll. on Utility Models as amended by the Act No 90/1993 Coll.

specification into the Slovak language, pay the publication fee according to Article 79(8) and notify to the Office an address for correspondence in the territory of the Slovak Republic.

(3) If the owner of European patent fails to submit to the Office a translation of the European patent specification within the time limit pursuant to paragraph 2, he may submit the translation within a grace period of three months on condition of payment of a surcharge pursuant to paragraph 2 together with the submission of the translation.

(4) If the translation of the European patent specification into the Slovak language is not submitted to the Office even within the grace period under conditions pursuant to paragraph 3, the European patent shall be deemed ineffective in the territory of the Slovak Republic *ab initio*.

(5) If the patent owner does not notify to the Office the address for correspondence in the territory of the Slovak Republic, official correspondence related to his patent shall be deposited at the Office and considered delivered within a time limit of 30 days as from the day of deposition. The Office shall notify the applicant about this consequence.

(6) Based on the fulfilment of conditions pursuant to paragraph 2, the Office shall make the translation of the European patent specification available and notify this availability as well as the granting of European patent in the Journal in accordance with Article 57.

(7) After publication in the European Patent Bulletin about the granting of European patent the Office shall enter the European patent in the European Patents Register with data that had been entered in the Register of European Patents.

#### Article 64

##### Inadmissibility of double protection

If the patent is granted for an invention for which the same owner or his legal successor in title has been granted European patent with the same priority right, the national patent shall become invalid to the extent to which it is identical with the European patent, from the day of expiry of the time limit for filing the opposition against the European patent, if no opposition have been filed, or from the day of validity of the decision of the European Patent Office, by which the European patent has been preserved in the opposition proceedings.

#### Article 65

##### Revocation or maintenance of European patent in a modified wording

(1) A decision of the European Patent Office on full or partial revocation of a European patent or on maintenance of a European patent in a modified wording shall have the same effect in the Slovak Republic as a decision of the Office pursuant to Article 46.

(2) Revocation or maintenance in a modified wording of a European patent shall be notified by the Office in the Journal.

(3) If during the opposition proceedings pursuant to Article 102 of the European Patent Convention the European patent is maintained based on a decision of the European Patent Office in a modified wording, the owner of the European patent shall be obliged within three months from the day of publication of the modification in the European Patent Bulletin to submit to the Office a translation of the modified wording of the patent specification into the Slovak language and pay the publication fee pursuant to Article 79(8). The Office shall make the translation of the patent specification in a modified wording available and notify this

availability as well as the decision about the maintenance of the European patent in a modified wording in the Journal.

(4) If the owner fails to submit a translation of the modified wording of the European patent specification into the Slovak language or if he fails to pay the publication fee within the time limit pursuant to paragraph 3, the European patent shall be deemed ineffective in the Slovak Republic *ab initio*.

(5) The Office shall revoke the European patent designating the Slovak Republic under conditions stipulated in Article 46(2) to (7) and Article 47, if during the proceedings started on a request or *ex officio* a reason for revocation of the patent pursuant to Article 138 in conjunction with Article 139 of the European Patent Convention is proved, provided that

- a) the time for filing the opposition pursuant to the European Patent Convention has vainly expired, or
- b) the European patent has not been revoked during the opposition proceedings before the European Patent Office.

(6) If at the time of the proceedings on revocation of the European patent before the Office proceedings on revocation of the patent in the same matter have started or have been pending before the European Patent Office, the Office shall suspend the revocation proceedings. After termination the proceedings before the European Patent Office, during which the European patent has not been revoked, the Office shall, on request of any party, continue the patent revocation proceedings. If the request for further processing of the patent revocation proceedings is not submitted within six months from the validity of the decision of the European Patent Office, the Office shall terminate the patent revocation proceedings.

#### Article 66

##### Filing of European Patent Application

(1) The Office is the place where legal or natural persons may file a European Patent Application.

(2) Paragraph 1 shall not apply in case of filing a divisional European Patent Application pursuant to Article 76 of the European Patent Convention.

#### Article 67

##### Fees

(1) For maintaining the validity of European patent in the Slovak Republic the owner shall be obliged to pay annual maintenance fees according to Article 79(8).

(2) The right of third parties to use the subject-matter of the invention shall not be affected by subsequent payment of the maintenance fee provided that after the vain expiry of time limit for payment of the maintenance fee, within the territory of the Slovak Republic and in good faith, the subject-matter of the invention has been used or evincible arrangements for using the subject-matter of the invention have been made..

### PART FIVE

#### GRANTING SUPPLEMENTARY PROTECTION CERTIFICATES FOR MEDICINAL PRODUCTS AND PLANT PROTECTION PRODUCTS

## Supplementary protection certificate for medicinal products

### Article 68

The basic patent is a patent, which protects

- a) a medicinal product<sup>23)</sup> or a combination of medicinal products (hereinafter referred to as “medicinal product”),
- b) a process for obtaining the medicinal product, or
- c) a process of application of the medicinal product .

### Article 69

The Office shall grant the supplementary protection certificate for a medicinal product to any medicinal product which is the ingredient of a medicine which before being placed on the market is a subject to registration pursuant to a special regulation,<sup>23)</sup> provided that

- a) the medicinal product is protected by a basic patent in the territory of the Slovak Republic,
- b) the medicinal product is a component of the medicine registered pursuant to a special regulation,<sup>23)</sup> where it is the first registration in the territory of the Slovak Republic,
- c) the medicinal product has not been granted a supplementary protection certificate for medicinal product in the previous period,
- d) the basic patent has not been granted on the basis of the application for invention pursuant to the Article 82 of the Act No 527/1990 Coll.

## Supplementary protection certificate for plant protection products

### Article 70

(1) For the purposes of this Act shall be

- a) an active substance a uniform or non-uniform substance or micro organism as well as the virus, having a general or specific effect against harmful organism, plant or its part or plant product,<sup>24)</sup>
- b) a plant protection product (hereinafter referred to as “product”) an active substance or combination of active substances of the preparation for the protection of plants.

(2) The basic patent is a patent which protects

- a) a product defined in paragraph 1(b) as such,
- b) a preparation intended for use as preparation for plant protection which forms a mixture or a solution composed of several substances of which at least one substance is active,
- c) a process to obtain the product or an application of the product.

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<sup>23)</sup> Act of the National Council of the Slovak Republic No 140/1998 Coll. on Medicines and Medical Devices and on amendment of the Act No 455/1991 Coll.

<sup>24)</sup> Act of the National Council of the Slovak Republic No 285/1995 Coll. on Plant Medicinal Care.

## Article 71

(1) The Office shall grant a supplementary protection certificate for plant protection products to a product which is a component part of a preparation for plant protection, which before being placed on the market is subject to registration pursuant to a special regulation,<sup>24)</sup> provided that

- a) the product is protected by a basic patent in the territory of the Slovak Republic,
- b) the preparation for plant protection is registered pursuant to a special regulation,<sup>24)</sup> where it is the first registration in the territory of the Slovak Republic,
- c) the product has not been granted a supplementary protection certificate for plant protection products in the previous period, and
- d) the basic patent has not been granted on the basis of the application for invention pursuant to the Article 82 of the Act No 527/1990 Coll.

(2) A product which is protected by several basic patents belonging to one owner may be granted only one supplementary protection certificate for plant protection products.

(3) A product which is protected by several basic patents belonging to various owners may be granted a supplementary protection certificate for plant protection products to each of the owners separately.

## Common provisions

### Article 72

#### The subject-matter of protection

(1) Within the scope of protection conferred by the basic patent, the supplementary protection certificate for medicinal products or the supplementary protection certificate for plant protection products (hereinafter referred to as “certificate”) shall protect the medicinal product or the product which is subject to registration of a medicine or registration of a preparation for plant protection pursuant to special regulations,<sup>25)</sup> as well as to any use of this medicinal product or product that has been authorised before the expiry of the certificate.

(2) The owner of the certificate shall enjoy the same rights and shall be subject to the same obligations and limitations as the owner of the basic patent.

### Article 73

#### Duration of the certificate

(1) The certificate shall take effect for a period equal to the period which elapsed between the filing date of the application for the basic patent and the date of the first registration of the medicine or preparation for plant protection pursuant to special regulations, reduced by a period of five years, however, the duration of the certificate may not exceed five years from the date on which it takes effect.

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<sup>25)</sup> Act of the National Council of the Slovak Republic No 140/1998 Coll.  
Act of the National Council of the Slovak Republic No 285/1995 Coll.

(2) The certificate shall take effect on the day following the expiry of the lawful term of the basic patent.

(3) The owner shall be obliged to pay an annual administrative fee for the maintenance of the validity of the certificate pursuant to Article 79(8).

#### Application for granting the certificate

#### Article 74

(1) A Certificate shall be granted on the basis of an application exclusively to the owner of the basic patent.

(2) An Application for granting the certificate may also be filed by a legal successor in title of the basic patent owner.

(3) An Application for granting the certificate has to be filed within six months from the day of validity of the decision on the registration of the medicine or the preparation for plant protection pursuant to special regulations. <sup>25)</sup> If the decision on registration came into effect before the granting of the basic patent, the application for granting the certificate shall be filed within six months from the day of granting the patent.

(4) The applicant shall be obliged to pay for the application for granting the certificate an administrative fee according to Article 79(8).

#### Article 75

(1) If the application for granting the certificate fails to contain requirements stipulated by the generally binding regulation pursuant to Article (80), or if the applicant is not represented by an authorised representative pursuant to Article 79(1), or if he fails to submit the application for entry of the assignment or transfer pursuant to Article 74(2), the Office shall request the applicant to rectify the irregularities within a set time limit. If the applicant fails to comply with delivered notice within the set time limit and the proceedings shall not for this reason be continued, the Office shall suspend the proceedings on the application for granting the certificate. The applicant shall be notified of the consequence of suspension of the proceedings by notice.

(2) If the application fails to meet the conditions for granting the certificate pursuant to any of the provisions of Article 69, Article 71 and 74(1) and (3), or if the applicant is neither the owner of the basic patent, nor his legal successor in title, the Office shall refuse the application.

(3) If requirements for granting the certificate are met, the Office shall grant the certificate, where in a case pursuant to Article 74(2) the granting of the certificate must be preceded by the entry in the Register of the applicant as basic patent owner.

#### Article 76

#### Expiry of the certificate

Certificate shall lapse

a) by expiry of the time of its validity pursuant to Article 73,

- b) on the day of effectiveness of abandonment of the certificate by the owner,
- c) by the vain expiry of the period stipulated for the payment of the administrative fee for maintaining the validity of the certificate in accordance with Article 79(8),
- d) on the day of revocation the registration pursuant to special regulations.<sup>25)</sup>

#### Article 77

##### Revocation or change of the certificate

(1) The Office shall revoke the certificate, if during proceedings initiated on request of a third party or *ex officio* it is demonstrated that

- a) the conditions for granting have not been met pursuant to any of the provisions of Articles 69, 71 and 74(1) and (3),
- b) the basic patent has lapsed before its expiration,
- c) the basic patent has been revoked or partially revoked to the extent that the medicinal product or product for which the certificate was granted is no longer protected by the basic patent. This shall also apply in case of revocation of the basic patent which occurred after its expiration.

(2) The Office shall change the certificate if, in the proceedings started on the request of a third party or *ex officio*, it is proved that time of validity of the certificate pursuant to Article 73(1) has not been determined correctly.

(3) A request for revocation of the certificate or for the change of the certificate may be filed also after the lapse of validity of the certificate pursuant to Article 76, if the person who proposes it proves legal interest.

(4) In case of revocation, the certificate shall be deemed not to have been granted.

(5) For the request pursuant to paragraphs 1 and 2 the person requesting is obliged to pay an administrative fee pursuant to Article 79(8).

#### Article 78

As far as the rise, modification and lapse of legal relationships whose subject-matter is the certificate, as well as for proceedings on certificates are concerned, Articles 19 to 28, Article 30, Articles 32 to 34, Article 39, Article 45, Articles 47 to 58 shall apply; regime of the confidentiality of the basic patent referred to in Article 59 shall apply to the certificate *mutatis mutandis*.

### **PART SIX**

#### **COMMON, AUTHORISING, TRANSITIONAL AND FINAL PROVISIONS**

#### Article 79

##### Common provision

(1) Parties to proceedings before the Office shall have equal position, however, parties without residence or seat in the Slovak Republic shall have to be represented in the

proceedings, including submitting of the translations pursuant to Part Four of this Act, by an authorised representative, <sup>26)</sup> with the exception of acts

- a) preceding and related to the accordance of the filing date pursuant to Article 35,
- b) related to the payment of the fees,
- c) related to the demonstration of a priority right pursuant to Article 36.

(2) When applying for an exception from mandatory representation pursuant to paragraph 1 the party to the proceedings shall be obliged to notify the Office of an address for correspondence in the territory of the Slovak Republic. If the party to the proceedings fails to notify the Office of an address for correspondence, official communications related to the proceedings shall be deposited in the Office, where they shall be deemed delivered after the expiry of 30 days from the date of deposition. The party has to be informed about this consequence.

(3) As far as proceedings before the Office pursuant to this Act are concerned, the Act on Administrative Proceedings <sup>21)</sup> with the exception of provisions of Article 19, Article 23, Articles 28 to 32, Article 39, Article 49, Article 50, Article 59(1) and Article 60 shall apply *mutatis mutandis*.

(4) If a party to the proceedings fails to comply with a notice of the Office within the set time limit, the Office may suspend the proceedings. The party must be notified about this consequence in the notice.

(5) Unless stated otherwise below, the Office may suspend the proceedings also on request of a party whose application or request is the subject-matter of the proceedings. Request for suspension the proceedings shall not be withdrawn.

(6) In case of request for suspension of the proceedings on application, or on application for granting the certificate to which a court litigation entered in the Register is related, the Office may only suspend the proceedings after submission of a written consent of the person who had filed the request for entry of the court litigation in the Register.

(7) Unless this Act or the generally binding regulation according to Article(80) stipulates otherwise, submissions to the Office shall be made in writing, in the national language. <sup>27)</sup>

(8) For realisation the acts pursuant to this Act and for maintaining the validity of the patent, European patent or certificate the administrative fees pursuant to a separate regulation. <sup>28)</sup>shall be paid .

(9) Details related to the submission by means of electronic media shall be stipulated by a generally binding regulation issued by the Office. Filing, which pursuant to the generally binding regulation according to Article(80) has to be supplemented by the submission of a written original within the set time limit, shall not be taken into consideration by the Office in the proceedings in case of failure to meet this obligation.

## Article 80

### Authorising provision

The generally binding regulation issued by the Office shall stipulate

- a) details about the method and requirements of claiming and proving the priority right,

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<sup>26)</sup> Article 40 of the Act No 237/1991 Coll. on Patent Attorneys as amended by the Act of the National Council of the Slovak Republic No 90/1993 Coll.

<sup>27)</sup> Act of the National Council of the Slovak Republic No 270/1995 Coll. on Official Language of the Slovak Republic as amended.

<sup>28)</sup> Act of the National Council of the Slovak Republic No 145/1995 on Administration Fees as amended.

- b) details about the filing method and requirements of the patent application,
- c) conditions of re-deposition of biological material in a recognised depository institution <sup>15)</sup> and conditions for making the deposited material available to the public,
- d) details on the divisional application, admissible amendment of application and correction of certain mistakes,
- e) details about requirements of the patent revocation request, request for forfeiture of protection and rectification, request for determination, request for further processing and request for *restitutio in integrum*,
- f) details about the method and requirements of filing an international application, its translation and languages of the filing,
- g) details about the method and requirements of filing a European Patent Application,
- h) details about the method and requirements of filing a application for granting the certificate , as well as details about the proceeding for granting the Certificate,
- i) details about the method of filing and requirements of a request for change and revocation of a certificate , as well as details about the proceedings for change and revocation of a certificate,
- j) details about the form of filing at the Office in general, about correspondence and filing via electronic media,
- k) details about the method and requirements of filing an application for an entry of the right in the Register,
- l) details about the method and requirements of the licence offer and its acceptance,
- m) details about data entered in the Register and published in the Journal,
- n) details about the regime of proceedings in case of confidential applications, patents and certificates,
- o) details about the method of filing and requirements of application for transfer of an author's certificate to a patent,
- p) time limit determined by the Office for actions of parties to the proceedings pursuant to this Act.

## Transitional provisions

### Article 81

(1) Rise, modification and lapse of legal relationships which have occurred before this Act has come into effect are adjudicated pursuant to previous Acts.

(2) Proceedings on applications of inventions and proceedings on patents which were not lawfully concluded before this Act comes into effect, shall be concluded pursuant to this Act, where in the case of application of inventions filed pursuant to Act No 84/1972 Coll. on discoveries, inventions, rationalisation proposals and industrial designs the Office shall perform substantive examination *ex officio*.

(3) Applications of inventions filed pursuant to previous regulations shall be deemed to be filed pursuant to this Act.

(4) If the use of the subject-matter of the applications of inventions stated in paragraphs 1 and 2 has occurred before this Act comes into effect and under conditions stipulated by the previous regulations, third party rights shall remain unaffected. The right of the inventor to

remuneration for the use of the subject-matter of the invention with the application for grant of author's certificate pursuant to previous regulations shall remain unaffected.

## Article 82

(1) An author's certificate for an invention, granted pursuant to Act No 84/1972 Coll. shall be valid for 15 years from the filing of the application. For maintaining the validity of the author's certificate, the administrative fees shall be paid pursuant to Article 79(8).

(2) An organisation which possesses under prior regulations the right to use the invention or which was granted with this right shall have the same rights as the patent owner.

(3) In case of an invention created in different manner than under conditions of the provision of Article 28(a) of the Act No 84/1972 Coll. protected by an author's certificate granted pursuant to the prior regulations, which has not been used by the organisation that has the right to manage the invention or that was granted with this right, the inventor shall be entitled to ask the Office for its conversion to a patent (hereinafter referred to as "request for conversion") at any point in time during the validity of the author's certificate. The applicant shall be obliged to pay administrative fee pursuant to Article 79(8) for the request for conversion of the author's certificate to a patent.

(4) The Office shall publish the request for conversion as well as the decision on conversion in the Journal. Anyone may file an opposition to the request for conversion within a time limit of three months since the publication of the request for conversion.

(5) A patent granted on the basis of the request for conversion shall be valid 15 years since the filing date of the application of the invention; the rights following from a patent granted on the basis of the request for conversion shall arise since the date of publication of the request for conversion in the Journal.

(6) If invention protected by an author's certificate was not created under conditions of the provision of Article 28(a) of the Act No 84/1972 Coll., the inventor shall be entitled to use the invention in his business activity.

## Article 83

(1) The use of an invention protected by an author's certificate, which in accordance with the prior regulations has started before January 1, 1991 or for which right has been granted before such date on the basis of a contract, shall not create an infringement of the rights of the patent owner. The right of the inventor for remuneration for the use of the invention pursuant to the previous regulations shall not be thereby affected.

(2) Claims to a remuneration for the use of an invention as well as claims for the reimbursement of reasonable costs related to the preparation of drawings, models or prototypes, remuneration for initiative participation in the preparation, testing or introduction of the invention and claims for remuneration for pointing out the possibility of using an invention which originated before this Act has come into force, shall be settled pursuant to the prior regulations.

(3) If, after this Act has come into effect, an invention is used which is protected by an author's certificate to which an organisation has the right corresponding to the right of the patent owner pursuant to provision of Article 82(2), the organisation shall be obliged to pay the inventor a remuneration pursuant to Article 11 of this Act.

## Article 84

(1) An applicant of an invention pursuant to the Article 82(1) and (2) of the Act No 527/1990 Coll. is obliged to submit to the Office

- a) a document confirming the granting of the consent for marketing or producing the subject-matter of the patent granted in any state abroad, and
- b) a decision on registration pursuant to the special regulations,<sup>25)</sup> issued on the basis of the request filed within six months from the date of granting the consent for marketing or production the subject-matter of the patent in any state.

(2) An applicant of an invention is obliged to submit the record and the decision pursuant to the paragraph 1 to the Office within the time limit of three months from its delivery but no later than 16 years from the date of rise the priority rights expired.

(3) The failure to comply with time limits stated in the paragraphs 1 and 2 shall not be excused.

(4) The Office shall reject an application concerning the invention pursuant to the paragraph 1 when

- a) an applicant failed to meet the conditions pursuant the paragraphs 1 and 2,
- b) the subject-matter of the patent granted abroad has been put on the market in the Czech and Slovak Federative Republic before the filing date of the application pursuant to the paragraph 1.

(5) The patent granted pursuant to the Article 82(1) and (2) of the Act No 527/1990 Coll. shall be considered valid within 16 years from the date of rise the priority right.

## Article 85

When the time limits pursuant to the Article 74(3) lapse before the 1 July, 2002, it shall be available to file the application on granting the Certificate pursuant to Article 74 till the 31 December, 2002 provided that decision on medicine registration or preparation for plant protection registration pursuant to the special Acts<sup>25)</sup> became valid after the January 1, 2000.

## Article 86

### Repealing provision

The following shall be repealed

1. Articles 2 to 35, Articles 78 to 82, Article 84 of the Act No 527/1990 Coll. on Inventions, Industrial Designs and Rationalisation Proposals as amended by Article III of the Act No 90/1993 Coll. and the Act No 185/1994 Coll.;
2. Article 65(2), Articles 66 to 71, Article 75(2) and Article 86 of the Act No 527/1990 Coll. on Inventions, Industrial Designs and Rationalisation Proposals as amended to the extent governing legal relations and proceedings related to inventions, patents and author's certificates;
3. Chapter One of the Decree of the Federal Office for Inventions No 550/1990 Coll. on Procedure in Matters of Inventions and Industrial Designs.

## Title II

Act No 132/1989 Coll. on Protection of Rights to New Plant and Animal Varieties as amended by the Act No 22/1996 Coll. shall be amended in the following way:

Article 10 shall be supplemented by paragraph 3, which shall read as follows:

“(3) If the court grants to the owner of the breeder certificate a compulsory licence for the use of an invention protected by a patent pursuant to a special regulation,<sup>1f)</sup> the Ministry shall grant to the patent owner, on the basis of a request, a compulsory licence pursuant to paragraph 1.“

Footnote 1f) shall read as follows:

“<sup>1f)</sup> Article 27(5) and (6) of the Act No 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts (The Patent Act).”

### **Title III**

Act No 478/1992 Coll. on Utility Designs as amended by the Act of the National Council of the Slovak Republic No 90/1993 Coll. shall be amended in the following way:

Article 21(2) shall read as follows:

“(2) For the application of the right to the utility model, relations among co-creators, relations among co-owners, assignment, transfer, right of lien, contractual licence, status of the parties to the proceedings, representation before the Office, suspension of the proceedings, extension of the time limit, further processing, *restitutio in integrum*, determination proceedings, remedies and for the protection against the infringement of rights, the provisions of the Patent Act shall apply *mutatis mutandis*.<sup>4)</sup>”

Footnote 4 shall read as follows:

“<sup>4)</sup> Act No 435/2001 on Patents, Supplementary Protection Certificates and on Amendment of Some Acts (The Patent Act).”

### **Title IV**

This Act shall come into effect on 1 November 2001 with the exception of the Part Four and Part Five which shall come into effect on 1 July 2002.

**Rudolf Schuster** s.m.

**Jozef Migaš** s.m.

**Mikuláš Dzurinda** s.m.