

IMPLEMENTATION OF THE CONVENTION ON THE GRANT OF EUROPEAN PATENTS ACT.

Unofficial translation

Passed on 17 April 2002, enter into force on the day of entering into force of the accession of the Republic of Estonia to the Convention on the grant of European Patents

(RT I 2002, 38, 233)

Section 1. Scope of application of Act

This Act provides for the legal status of European patents and patent applications in Estonia and regulates legal relations arising from the accession of the Republic of Estonia to the Convention on the grant of European Patents (European Patent Convention) not covered by the Patent Act (RT I 1994, 25, 406; 1998, 74, 1227; 107, 1768; 1999, 84, 764; 2001, 27, 151) or the said Convention.

Section 2. Definitions

For the purposes of this Act:

- 1) Convention means the Convention on the grant of European Patents (European Patent Convention), done at Munich on 5 October 1973;
- 2) Organisation means the European Patent Organisation as established by the Convention;
- 3) European Patent Office means the organ of the Organisation carrying out their task to grant European patents;
- 4) Contracting State means a contracting state of the Convention;
- 5) For the purposes of the Convention Estonian Patent Office means the central industrial property office in Estonia;
- 6) European patent means a patent granted by the European Patent Office in accordance with the Convention;
- 7) European patent application means an application for a European patent filed in accordance with the Convention;
- 8) Applicant means natural or legal person applying for a European patent;
- 9) Owner of patent means an owner of a European patent;
- 10) National patent means a patent granted in accordance with the Patent Act;

11) National patent application means an application for a national patent filed in accordance with the Patent Act;

12) Utility model means an invention registered in accordance with the Utility Model Act (RT I 1994, 25, 407; 2000, 60, 388; 2001, 27, 151).

Section 3. Filing of European patent applications

(1) European patent applications may be filed with the European Patent Office or with the Estonian Patent Office, who shall transmit them to the European Patent Office.

(2) A European divisional application must be filed directly with the European Patent Office. For the purposes of this Act a European divisional application means a patent application divided from a European patent application.

Section 4. Language of European patent application

A European patent application shall be filed in one of the official languages of the European Patent Office (English, French, German) or, pursuant to conditions specified by the Convention, in any official language of the Contracting State other than the official languages of the European Patent Office.

Section 5. Legal status of European patent application

A European patent application designating the Republic of Estonia which has been accorded a filing date according to the Convention shall be legally equivalent to a national patent application filed on the same date, whatever its outcome may be. Where the European patent application enjoys priority of earlier date, such priority shall also have effect in Estonia.

Section 6. Provisional protection based on European patent application

An invention containing in a published European patent application designating the Republic of Estonia shall confer the same provisional protection as provided for in the Patent Act as from the date on which a translation of the claims of the published European patent application into the Estonian language has been communicated by the applicant to the person using the invention in Estonia, or as from the date on which the said translation has been made available to the public by the Estonian Patent Office, where the translation was communicated to the Estonian Patent Office and the fee prescribed for the publication of the translation was paid.

Section 7. Legal status of European patent

(1) A European patent designating the Republic of Estonia shall be legally equivalent to a national patent as from the date of the mention of its grant by the European Patent Office provided that the owner of the patent furnishes to the Estonian Patent Office, within three months from the date of mention of grant, a translation of the specification of the European patent into the Estonian language and pays the fee prescribed for the publication of the translation. The term for furnishing the translation may be extended by two months, upon paying an additional fee.

(2) Where the owner of patent fails to furnish the translation specified in subsection (1) by the due date or fails to pay the prescribed fee for the publication of the translation or, upon

the extension of the term for furnishing the translation, fails to pay the prescribed additional fee, the European patent shall be considered void ab initio with regard to Estonia.

(3) Where the Contracting States have agreed to replace the requirement of furnishing a translation of the patent specification with the requirement of furnishing a translation of the patent claims, the owner of the patent shall furnish the translation of the patent claims in the manner prescribed by subsection (1) of this Section. In this case the provisions of subsection (2) shall also apply mutatis mutandis.

(4) Where the Contracting States have agreed to dispense with the requirement of furnishing a translation of the patent specification or a translation of the patent claims, the owner of the patent shall, in case of an administrative dispute or court action relating to a European patent, furnish at the request of the administrative organ, court or an alleged infringer of patent rights, within three months from the receipt of the request the translation of the specification into the Estonian language at his own expense. Upon failure to furnish the translation the court may declare the European patent void ab initio with regard to Estonia.

Section 8. Authentic text of European patent application and European patent

(1) The text of a European patent application or a European patent in the language of the proceedings before the European Patent Office shall be the authentic text.

(2) Where legal protection of an invention conferred by the translation into the Estonian language of a European patent application or a European patent specification is narrower than that conferred by the language of the proceedings before the European Patent Office, that translation shall be regarded as the authentic text, except for revocation proceedings in the court. Upon the revocation proceedings, the court may, for the purpose of the proceedings, request a translation into the Estonian language which is authentic with the text in the language of the proceedings before the European Patent Office.

Section 9. Correction of the translation of the European patent application or European patent specification

(1) An applicant or owner of patent may correct the translation of a European patent application or a European patent specification at any time.

(2) The corrected translation shall take effect as from the date when it has been communicated to the person using the invention in Estonia, or as from the date when the Estonian Patent Office announces in its official publication the publication of the corrected translation.

(3) Any person who in good faith is using or has made serious and effective preparations for using an invention contained in the European patent application or in the European patent without infringing the patent rights under the initial translation may, after the correction of the translation takes effect, continue to use the invention in the same manner without payment.

(4) The right to use the invention, which is provided for in subsection (3) of this Section, may transfer to another person only with the enterprise or part of it, which is covered by such right.

Section 10. Maintenance of European patent

(1) For maintaining a European patent in Estonia, the owner of patent shall pay a maintenance fee for each year of validity.

(2) The maintenance fee shall be paid to the Estonian Patent Office for each year following that in which the mention of the grant of the European patent is published by the European Patent Office.

(3) The maintenance fee shall be paid within six months before the due date. The due date is the first day of each year of validity, which is considered to be the filing date of the European patent application.

(4) The maintenance fee with the additional fee may still be paid within six months after the due date.

(5) If the period between the date on which the mention of the grant of the European patent is published by the European Patent Office and the due date of the maintenance fee for the following year of validity is less than two months, the owner of patent shall be entitled, within two months as from the publication date of the mention of the grant of the European patent, to pay the maintenance fee for the following year of validity without the additional fee mentioned in subsection (4) of this Section.

(6) If the owner of patent fails to pay the maintenance fee in the established amount by the date specified in subsections 3 or 4 of this Section, the European patent shall become invalid in Estonia as from the due date specified in subsection (3).

Section 11. Conversion of European patent application into national patent application and utility model application

(1) The applicant may request the conversion of a European patent application designating the Republic of Estonia into a national patent application or utility model application, or both, where the European patent application is deemed to be withdrawn for the reason that the European patent application or the translation of the application in the language of the proceedings has not reached the European Patent Office in due time.

(2) The applicant or owner of patent may request the conversion of a European patent application designating the Republic of Estonia into a utility model application if the European patent application is deemed to be withdrawn by the European Patent Office or has been withdrawn by the applicant or if the European Patent Office has rejected the European patent application or revoked the European patent.

(3) A European patent application may not be converted into a utility model application if the invention may not be protected as a utility model pursuant to Section 6 of the Utility Models Act.

(4) A European patent application containing a group of inventions linked together as to form a single general inventive concept may be converted into several independent utility model applications.

(5) The Estonian Patent Office shall notify the applicant of the receipt of the request for conversion of a European patent application into a national patent application or utility model application and of the receipt of the copy of the European patent application, transmitted by the European Patent Office, and establish a term of three months for furnishing of a translation of the European patent application into the Estonian language. At the request of the applicant, the date for submitting the translation may be extended for

additional two months.

(6) Upon furnishing of the translation specified in subsection (5) of this Section the applicant shall pay to the Estonian Patent Office the fee for approving the European patent application for national proceedings as a national patent application or utility model application.

(7) Where the applicant fails to furnish the translation specified in subsection (5) of this Section by the due date or fails to pay the fee specified in subsection (6) of this Section upon furnishing of the translation or within one month after furnishing of the translation, the request for conversion of a European patent application into a national patent application or utility model application shall be deemed to be withdrawn.

Section 12. Exclusion of simultaneous protection

(1) Where a European patent designating the Republic of Estonia and a national patent having the same filing date or, where priority has been claimed, the same priority date, have been granted to the same person or his legal successor, the national patent shall have no legal effect to the extent that it covers the same invention as the European patent as from the date on which

1) the time-limit for filing an opposition to the European patent has expired without an opposition having been filed or

2) the opposition procedure has resulted in a final decision to maintain the European patent.

(2) Where in the Estonian Patent Office a national patent application is pending which belongs to a person or his legal successor to whom a European patent has been granted designating the Republic of Estonia and having the same filing date or, where priority has been claimed, the same priority date, the national patent application shall be refused in the extent that it covers the same invention as the European patent.

(3) The exclusion of simultaneous protection shall not apply to utility models.

Section 13. Legal effect of revocation or amending of European patent

(1) Where, as a result of an opposition procedure before the European Patent Office, the European patent designating the Republic of Estonia is decided to be revoked or maintained as amended, the decision is legally binding for the Republic of Estonia.

(2) Where the European patent is maintained as amended, the owner of patent shall, within three months from the corresponding announcement in the official publication of the European Patent Office, furnish to the Estonian Patent Office a translation of the amended specification of the European patent into the Estonian language and pay the prescribed fee for the publication of the translation. The term for furnishing the translation may be extended by two months upon paying an additional fee. The provisions of subsection (2) of Section 7 shall apply mutatis mutandis.

(3) The Estonian Patent Office publishes announcements about the revocation or amending of European patents in its official publication.

Section 14. Suspension of national court proceedings

(1) If, simultaneously with national court proceedings relating to the validity of a European patent or the rights of the owner of patent, the European Patent Office has started examination of an opposition to the European patent, the national court proceedings shall be suspended until the publication of the announcement referred to in subsection (3) of Section 13.

(2) The national court proceedings are terminated upon the revocation of a European patent or where the European patent is considered pursuant to Section 7 or 13 void ab initio.

Section 15. Representation of the owner of patent

In national proceedings related to the maintaining of European patents in Estonia, other than paying fees for the transactions of national proceedings and maintenance of European patent, the owner of patent may be represented before the Estonian Patent Office solely by patent attorneys entered in the State Register of Patent Attorneys and specialising on the legal protection of inventions and layout-designs of integrated circuits.

Section 16. Register of European patents valid in Estonia

(1) A register of European patents valid in Estonia (hereinafter Register) is maintained for European patents validated in Estonia in accordance with this Act.

(2) The Register shall be legally equivalent to the Register of Patents provided for in the Patent Act.

(3) For the maintenance of the Register, the provisions of the Patent Act shall apply together with the specifications prescribed by this Act.

Section 17. Entry in Register

The entries in the Register are the following:

- 1) the entry of the data relevant to the particulars of a European Patent designating the Republic of Estonia;
- 2) the entry of validation of a European patent in Estonia;
- 3) the entry of maintaining a European patent;
- 4) the entry of amendment to a European patent;
- 5) the entry of revocation of a European patent;
- 6) the entry of the end of validity of a European patent;
- 7) other entries with legal significance to a European patent, including entries of the transfer of rights, the registration of a licence or a pledge and of supplementary protection for medicinal products or plant protection products.

Section 18. Fees related to European patents

(1) The fees related to European patents are the fees for the transactions of national proceedings of European patent applications and European patents and for the maintenance of European patents pursuant to this Act. The fees related to European patents shall be used for covering costs connected with the fulfillment of the tasks of the Estonian Patent Office under the Convention, including the costs of the national proceedings of European patent applications and European patents and developments in information technology connected with the proceedings.

(2) Pursuant to the Convention the Estonian Patent Office shall transmit a proportion, fixed by the Organisation, of all maintenance fees for European patents received by the Estonian Patent Office to the European Patent Office.

(3) The amount received from fees related to European patents must, after the transfer of the fixed proportion of the maintenance fees to the European Patent Office pursuant to subsection (2), cover the costs of the implementation of the Convention and of the national proceedings, and the total of the received amounts of three consecutive years must not exceed the total of the said expenses by more than ten per cent.

(4) Where the total of the received fees for three consecutive years, under the provisions of subsection (3), does not cover the expenses or exceeds the total of expenses of the same period by more than ten per cent, new rates for the fees shall be established.

Section 19. Legal and administrative co-operation

Pursuant to the Convention and in the accordance with the Implementing Regulations to the Convention and Section 2 of the Accession to the Convention on the Grant of European Patents Act (RT II 2002, 10, 40) the Estonian Patent Office shall communicate with the European Patent Office with regard to exchanging of information and to receiving of requests for legal assistance arising from the application of the Convention. Courts and other Estonian authorities shall communicate with the European Patent Office in the cases specified in the Convention through the Estonian Patent Office.

Section 20. Implementation of Act

(1) The regulations of the Minister of Economic Affairs shall prescribe:

1) the procedure for filing European patent applications with the Estonian Patent Office and transmitting the applications to the European Patent Office;

2) the procedure for furnishing with the Estonian Patent Office the translations referred to in Section 6, subsection (1) of Section 7 and subsection (2) of Section 13 and the procedure for the announcement of their publication in the official publication of the Estonian Patent Office;

3) the procedure for converting European patent applications into national patent applications and utility model applications.

(2) The Minister of Finance shall prescribe the procedure for payment of the fees related to the European patents to the account of the Estonian Patent Office and the procedure for transfer of the fees for the maintenance of European patents, referred to in subsection (2) of Section 18, to the European Patent Office.

(3) Any matter relating to the transactions of national proceedings of European patents, not

regulated by this Act or other provisions of national legislation, the Estonian Patent Office, courts and any other Estonian authority shall observe the decisions of the organs of the Organisation concerning the same or similar matter.

Section 21. Entry into force of Act

This Act shall enter into force on the day of entering into force of the accession of the Republic of Estonia to the Convention.