

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

Amended by : **Act No. 402/2002 Coll.**
 Act No. 84/2007 Coll.
 Act No. 517/2007 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 relations arising in relation to creation, legal protection and utilisation of inventions, which are subject-matter of a patent application or granted patent or are 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 [Article 3(f)], international application,
- b) patent, European patent [Article 3(f)],
- c) rights and obligations of an inventor, applicant (hereinafter referred to as “applicant”) and to an owner of a patent, an applicant for a European Patent application and to an owner of a European patent, an applicant of an international application,
- d) legal status of the third party who is a holder of other rights or obligations in relation to an application, European patent application, international application, patent or European patent,
- e) proceedings on subject-matters of right pursuant to points (a) to (d).

Article 3
Definition of terms

For purposes 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 mean any process using microbiological material or performed upon microbiological material or process result of which is microbiological material,
- c) essentially biological process for creation plants or animals shall mean a process based exclusively on natural phenomena such as breeding or selection,

- d) reproduction shall mean a generative or vegetative reproduction,
- e) European patent application shall mean an application for a European patent filed pursuant to the Convention on granting European patents signed in Munich on October 5, 1973 (hereinafter referred to as "European Patent Convention"),
- f) European patent shall mean a patent granted by the European Patent Office pursuant to the European Patent Convention,
- g) international application shall mean an application filed pursuant to the Patent Co-operation Treaty,¹⁾
- h) commercial exploitation of a patent or an invention shall mean any activity related to a patent as a subject-matter of right or in relation to an invention as a subject-matter of a patent, performed by an owner or any other authorised person with a purpose of making profit.

PART TWO PATENTS FOR INVENTIONS

Article 4

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

Article 5 Patentability of inventions

(1) Patents shall be granted for inventions from all fields of technology, which are new, involve inventive activity and are industrially applicable.

(2) Patents pursuant to paragraph 1 shall be also granted for biotechnological inventions concerning to a product consisting of or containing biological material, or to a process by means of which biological material is produced, processed or utilised, including cases when invention relates to

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

(3) The following shall not be regarded as inventions pursuant to paragraph 1:

- a) discoveries, scientific theories and mathematical methods,
- b) aesthetic creations,
- c) schemes, rules and methods for performing intellectual acts, games or business,
- d) computer programmes,
- e) presentation of information.

¹⁾ 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.

²⁾ 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.

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

Article 6 Exceptions to patentability

- (1) Patents shall not be granted to
- a) plant and animal varieties,
 - b) essentially biological processes for creation plants or animals,
 - c) methods of surgical or therapeutic treatment of human or animal body and diagnostic methods and methods of illness prevention practised on human or animal body. This provision shall not apply to products, in particular substances or compositions usable in any of above-mentioned methods of treatment, diagnostics or illness prevention,
 - d) inventions relating to human body in different stages of its formation or development or relating only to discovery of some elements of human body, including sequences or partial sequence of a gene, with an exception pursuant to Article 5(2)(d),
 - e) inventions commercial exploitation of which would be in contradiction with public order or good manners. The sole prohibition of exploitation of an invention by law shall not be considered to be in contradiction with public order or good manners pursuant to this provision.
- (2) Patents shall not be granted pursuant to paragraph 1(e) to
- a) processes of cloning human beings,
 - b) processes of modifying germ line genetic identity of human beings,
 - c) utilisation of human embryos for industrial or commercial purposes,
 - d) processes of modifying genetic identity of animals which are likely to cause suffering to animals without having substantial medical benefit for people or animals, neither on animals which are results of such processes.

Article 7 Novelty

- (1) An invention shall be considered to be new if it does not form part of state of the art.
- (2) State of the art shall be everything made available to public by any means of disclosure before the day from which an applicant enjoys priority right (Article 36).
- (3) Contents of patent applications and utility model applications filed in the Slovak Republic with earlier priority right shall also be considered as 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 an applicant enjoys priority right or after this day. This shall also apply to international applications with designation for the Slovak Republic; publication of an international application shall be publication in the Journal (Article 41) , and to European patent applications with designation for the Slovak Republic (hereinafter referred to as "European patent application"); publication of a European patent application shall be publication pursuant to Article 93 or Article 153 of the European Patent Convention. Confidential patent application (Article 59(10)) shall be deemed for purposes of this provision to be published after expiry of 18 months from the day of the rise of priority right.

(4) Disclosure of an invention to public shall not be considered as state of the art if it occurred not earlier than six months preceding filing a patent application and which directly or indirectly follows from

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

(5) Patentability of substances or compositions shall not be excluded pursuant to paragraphs 1 to 3, which are

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

Article 8 Inventive activity

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

(2) Contents of applications, European patent applications and utility model applications which have not been published as by the day from which an applicant enjoys priority right shall not be taken into consideration in determination of an inventive activity.

Article 9 Industrial application

An invention shall be considered to be industrially applicable if its subject-matter can be produced or utilised in any branch of industry, particularly in any branch of industry and agriculture.

Inventor Article 10

(1) An author of an invention (hereinafter referred to as “inventor”) shall have right to a patent including right to file an application (hereinafter referred to as “right to a patent”).

(2) An inventor shall be a person who has created an invention by his own creative work.

(3) Co-inventors of an invention (hereinafter referred to as “co-inventors”) shall have right to a solution within extent to which they participated in creating an invention. Share of co-inventors in creating an invention shall be equal, unless co-inventors agreed otherwise or unless a court decides otherwise.

³⁾ 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.

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

Article 11

(1) If an inventor has created an invention within the framework fulfilling tasks from an employment, similar relationship or from membership relation right to a solution shall pass to an employer, until parties to this relationship agreed otherwise. Right of being an inventor shall remain unaffected.

(2) An inventor who has created an invention pursuant to paragraph 1 shall be obliged to inform an employer about this fact immediately in writing and at the same time he shall submit any materials necessary for assessment of an invention.

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

(4) If an employer fails to exercise right to a solution patent in writing within the time limit pursuant to paragraph 3, this right shall pass back to an inventor. An employer as well as an inventor shall be obliged to preserve confidentiality about an invention *vis-à-vis* third parties.

(5) An inventor, against whom right to a solution pursuant to paragraph 3 has been exercised, shall be entitled to an appropriate remuneration from an employer. Technical and economic importance of an invention and contribution achievable by its exploitation or by other application shall be decisive for determining amount of remuneration, whereas material share of an employer in creating an invention as well as a scope and contents of workload of an inventor shall be taken into consideration. If remuneration fails evidently to correspond with a contribution achieved by later exploitation or other application of an invention, an inventor shall have right to supplementary compensation.

(6) Rights and obligations pursuant to paragraphs 1 to 5 shall remain unaffected after legal relationship between inventor and employer has ceased.

Article 12

(1) Right to a solution shall also belong to legal successors in title of persons listed in Article 10(1) and (3) or in Article 11(1).

(2) Right to a solution shall be transferred to another person in cases specified by special regulations.⁴⁾

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

⁴⁾ 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.

(4) Together with assignment or transfer of right to a solution, which shall be executed after filing an application, assignment or transfer of rights conferred by an application shall occur concurrently. Transfer or assignment of rights conferred by an application shall come into effect *vis-à-vis* third parties on the day of its entry into the Register of patent applications (Article 57); This shall not apply *vis-à-vis* third parties who have been informed about assignment or transfer or according to circumstances should have known.

Article 13 Scope of protection

(1) Scope of protection conferred by a patent shall be determined by contents of patent claims. Description and drawings shall be used for interpretation of patent claims.

(2) Scope of protection conferred by an application shall be preliminary determined by contents of patent claims published pursuant to Article 41. Granted patent or patent partially revoked shall determine scope of this preliminary protection retroactively; this shall not apply if there is conferred wider protection by a granted patent than by a published patent application.

(3) Protection conferred by a patent granted for a process shall also apply to a product directly obtained by such process.

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

(5) Protection conferred by a patent granted for a process enabling production of a biological material with specific characteristics which are result of an invention, shall also apply to biological material obtained directly by a protected process as well as to any other biological material derived from directly obtained biological material by reproduction in identical or different form with same characteristics same characteristics.

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

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

Article 14 Exploitation of an invention

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

(2) A patent shall be effective from the day when announcement on grant of a patent is published in the Journal.

Article 15
Prohibition of exploitation of an invention

- (1) Without consent of a patent owner following shall be prohibited
- a) producing, exploitation, offering or placing on the market, or for this purpose storing or importing a product which is a subject-matter of a patent,
 - b) exploitation of a production process which is a subject-matter of a patent (hereinafter referred to as “protected process”) or offering such protected process for exploitation to another person,
 - c) producing, exploitation, offering or placing on the market, or for this purpose storing or importing a product directly obtained by a protected process,
 - d) supplying or offering for delivery to a person not entitled to exploit an invention any means enabling him to carry out an invention, if a person infringing right has been informed or with regard to circumstances he should have been informed that these means are intended or suitable to carry out an invention; this shall not apply if these means are currently available on the market and a supplier did not instigate the person not entitled to perform acts in contradiction with points (a) to (c).

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

Article 16
Exhaustion of rights

(1) A patent owner shall not be entitled to prohibit third parties to dispose of a product which is a subject-matter of a patent protection after this product has been placed on the market in the member state of the European Union or in the state which is a contracting party to the Agreement on the European Economic Area by a patent owner or with his explicit consent. This shall not apply if there are reasons for extension of rights to a patent for such treatment.

(2) Paragraph 1 shall also apply to a biological material obtained by reproduction of a protected biological material provided that such reproduction necessarily results from using for which the biological material has been placed on the market, if biological material obtained in this way is not subsequently utilised for its further reproduction.

(3) Acquisition of protected plant reproduction material by a farmer within the scope of a commercial relation with a patent owner or with his consent implies right of a farmer to utilise a product of his work for reproduction of this product in his farm. Provisions of a special regulation 6a) shall apply *mutatis mutandis* for determination of a scope of right of a farmer pursuant to sentence one and condition of claiming such right.

(4) Acquisition of protected animal reproduction material by a farmer within the scope of a commercial relation with a patent owner or with his consent implies for right of a farmer to use a protected livestock for agricultural purposes including using of an animal reproductive material for his agricultural activity with exception of sale of animal reproduction material form performing agricultural activities of a farmer with exception of a sale of an animal reproduction material in relation with business or for the purpose of business ⁵⁾ in the form of a subsequent reproduction activity.

Limitation to effects of a patent

Article 17

(1) Right of a patent owner shall not be exercised *vis-à-vis* a person who before priority right (Article 36) has exploited an invention in a good faith or has made appropriate arrangements immediately aiming at exploitation of an invention independently from an inventor or a patent owner (hereinafter referred to as “prior user“) within the territory of the Slovak Republic. In case of doubts action of a prior user shall be considered acting in a good faith unless proved otherwise.

(2) Assignment or transfer of right of a prior user for exploitation of an 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 an invention is being utilised.

Article 18

(1) Rights of a patent owner shall not be infringed if an invention is exploited

- a) on board vessels of other states which are contracting parties to an international convention ⁶⁾ or parties to the World Trade Organisation ⁷⁾ (hereinafter referred to as “Union countries“) to which the Slovak Republic is a contracting party, in a body of a vessel, machinery, tackle, gear and other accessories, if these vessels temporarily or accidentally enter the territory of the Slovak Republic provided an invention is used exclusively for needs of a vessel,
- b) in construction or operation of aircrafts or land vehicles of the Union countries, or in their components or other accessories when they temporarily or accidentally enter the territory of the Slovak Republic,
- c) when conducting activities pursuant to an international convention, ⁸⁾ if these activities relate to an aircraft of a state benefiting from 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 this way,
- e) in activity conducted privately and for non-commercial purposes,
- f) in activity conducted for experimental purposes which shall also be studies, exams necessary for registration proceedings pursuant to a special regulation. 8a).

⁵⁾ Article 2(1) of the Commercial Code.

⁶⁾ 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.

⁷⁾ 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.

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

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

Article 19 Patent owner

A legal entity or a natural person entered as an owner into the Patent Register of the Office (hereinafter referred to as “Register“) shall be considered a patent owner.

Article 20 Co-ownership of a patent

(1) Provisions of a special regulation ⁹⁾ shall apply to regulation of relationships among patent co-owners *e mutatis mutandis*, unless this Act provides otherwise.

(2) Proportionate ownership of a co-owner to a patent shall be derived from the scope of right to a solution belonging to a co-inventor (Article 10(3)) as a patent owner or a co-inventor as a legal predecessor of a patent owner .

(3) Each of co-owners shall have right to exploit an invention, which is a subject-matter of a patent, except granting right for utilisation of an invention to a third party, unless co-owners have agreed otherwise.

(4) An agreement on abandonment 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 into the Register. The Office shall be obliged to enter changes from the agreement into the Register no later than six months from its delivery to the Office or within this time limit to communicate a decision specifying reasons on basis of which it shall not possible to enter modifications into the Register.

(6) If a patent co-owner has no legal successor, after a patent co-owner’s death or forfeiture, his proportionate ownership shall be transferred to other patent co-owners in a rate appropriate to their proportionate co-ownerships.

(7) Provisions of paragraphs 1 to 5 shall apply *mutatis mutandis* to relations between co-applicants.

Article 21 Assignment of patent

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

(2) Assignment shall have legal effects *vis-à-vis* third parties from the day of entry into the Register. This shall not apply *vis-à-vis* persons who knew about assignment or should have known according to circumstances. The Office shall be obliged to enter this assignment into the Register no

⁹⁾ Articles 136 and 142 of the Civil Code.

later than six months from delivery of an agreement on assignment to the Office or in this time limit to communicate a decision specifying reasons on basis of which it shall not be possible to enter assignment into the Register within.

(3) Rights of third parties acquired before the day of entry of patent assignment into the Register shall remain unaffected.

Article 22 Transfer of patent

(1) A Patent shall be transferred to a new owner pursuant to Article 48 including cases specified by special regulations.⁴⁾

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

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

Article 23 Right of lien

(1) Right of lien on a patent may be established.

(2) Provisions of a special regulation¹⁰⁾ shall apply *mutatis mutandis* to right of lien and to relations between pledge creditor and pledge debtor.

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

(4) Contractual right of lien shall begin on the day of entry into the Register. The Office shall be obliged to enter right of lien into the Register no later than within six months from delivery of an agreement on establishing right of lien to the Office or within this time limit to communicate a decision specifying reasons on basis of which it shall not be possible to enter right of lien into the Register.

(5) Special regulation¹¹⁾ and paragraphs 2 and 3 shall apply *mutatis mutandis* to sub-lien right.

Article 24 Licence agreement

(1) Rise, lapse and enforcement of right from a licence agreement shall be governed by provisions of a special regulation.¹²⁾

¹⁰⁾ Article 151(a) to (j) and Article 552 of the Civil Code.

¹¹⁾ Article 151(k) to (m) of the Civil Code.

¹²⁾ Articles 508 to 515 of the Commercial Code.

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

(3) Granted licence shall be considered non-exclusive, unless a licence agreement stipulates otherwise.

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

Licence offer

Article 25

(1) If a patent applicant or a patent owner (hereinafter referred to as “provider“) shall file a written statement with the Office that he shall grant right to utilise an invention to any person for appropriate compensation (hereinafter referred to as “licence offer“), the Office shall enter a licence offer into the Register.

(2) Licence offer may be withdrawn until a written statement about acceptance of a licence offer is delivered to the provider.

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

(4) Statement on a licence offer may not be validly filed if an exclusive licence has been entered into the Register.

(5) If a new patent owner or a patent applicant delivers a written request on maintenance of a licence offer to the Office within a time limit of 30 days from the day of validity of a decision on forfeiture of protection and transfer it shall apply on the day of entry of a decision on forfeiture of a patent protection and transfer pursuant to Article 48 into the Register, that a licence offer has been withdrawn., .

Article 26

(1) Person, who accepts a licence offer and communicates it to a provider and at the same time to the Office in writing, shall obtain right to exploit an 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 granted licence has been concluded among parties to licence relation, notwithstanding negotiations relating thereto, amount of an adequate compensation as

well as terms of payment shall be determined by a court on proposal of one of parties to licence relation taking into consideration importance of an invention and usual licence prices in particular field. In case of a substantial change of circumstances decisive for determining an adequate compensation, the court shall be entitled on proposal of one of parties to licence relation to change amount of a compensation or terms of payment originally negotiated or settled by a court, if no agreement has been concluded among parties, notwithstanding negotiations relating thereto.

Compulsory licence

Article 27

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

- a) 4 years have expired since filing of an application or 3 years have expired from granting a patent, where the time limit, which expires later, shall apply,
- b) person requesting granting of a compulsory licence has offered before filing a request to a patent owner a proper conclusion of a licence agreement, whilst this offer was not accepted by a patent owner within three months from its filing, and
- c) invention has not been exploited within the territory of the Slovak Republic without an appropriate reason by a patent owner, or it has been exploited insufficiently, while a subject-matter of a patented invention as a product has not been supplied to the market of the Slovak Republic in a sufficient quantity. Non-existence of an 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 shall be limited to purpose for which it has been granted provided that domestic market needs shall be satisfied preferentially.

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

(4) Notwithstanding paragraph 1(a) and (b) 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 shall be entitled to grant a compulsory non-exclusive licence for utilisation of a biotechnological invention on request, if a cultivator shall not be able to exploit or acquire right to a plant variety without infringing earlier right to a patent, if the plaintiff proves that

- a) before filing a request he has offered to a patent owner a proper conclusion of a licence agreement, whilst this offer was not been accepted by a patent owner within three months from its filing, and

¹³⁾ 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.

- b) plant variety represents an important technical progress of a considerable economic importance comparable with an invention which is a subject-matter of a request for granting a compulsory licence.

(6) In case of granting a compulsory licence pursuant to paragraph 5, a patent owner shall have right for granting a cross compulsory licence for utilisation of a plant variety pursuant to a special regulation.2)

(7) If a patent owner has granted a compulsory licence for utilisation of a plant variety pursuant to a special regulation, 13b) an owner of a cultivator certificate shall have right for granting a cross compulsory licence for utilisation of a biotechnological invention.

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

(9) A holder of a compulsory licence shall be entitled to waive rights from a compulsory licence by a written notice delivered to the Office. Waiver of right shall come into effect from the day of delivery of a notice to the Office or on a later day which is stated in a notice as a day from which a compulsory licence rights holder waives his rights.

Article 28

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

(2) In case of substantial change of circumstances, which led to granting a compulsory licence, the court shall be entitled on a request of one of parties to licence relation to cancel a decision on granting a compulsory licence, provided that re-occurrence of reasons for granting a compulsory licence is improbable or compulsory licence rights have not been used during one year.

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

Article 29 Validity of a patent

The term of validity of a patent shall be 20 years from the filing a patent application (Article 35).

Article 30 Abandonment of a patent

(1) Patent owner shall be entitled to abandon a patent by a written notice delivered to the Office. Partial abandonment of a patent shall not be admissible.

(2) If a patent co-owner waives his proportionate ownership, it shall be transferred to the rest of co-owners in a rate appropriate to their proportionate co-ownerships.

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

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

Article 31 Lapse of the patent

(1) Patent shall lapse:

- a) by expiry of its term,
- b) by expiry of a time limit set for payment of administrative fees for maintenance of validity of a patent ¹²⁾ (hereinafter referred to as “maintenance fees“)(Article 79(9)),
- c) from the day of effectiveness of abandonment of a patent pursuant to Article 30(3).

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

(3) Cancelled from January 1, 2008.

(4) Cancelled form January 1, 2008.

Article 32 Infringement of rights

(1) In case of infringement of rights protected by this Act or jeopardising of these rights, a person, whose rights have been infringed or jeopardised, shall be entitled to claim prohibition of infringement or jeopardising of right and to eliminate consequences of infringement.

(2) If a damage has been caused by infringement of rights pursuant to paragraph 1, the aggrieved party shall have right to compensation of actual damage including profit lost. If a non-pecuniary injury has been caused by infringement of rights pursuant to paragraph 1 or by jeopardising of these rights, the aggrieved party shall have right to adequate satisfaction, which can be in form of pecuniary consideration.

(3) Also an aggrieved party, whose pecuniary or non-pecuniary injury has been caused directly by performing a preliminary injunction imposed by a court on proposal filed without adequate reason, shall also have right to compensation of actual damage as well as right to satisfaction pursuant to paragraph 2. .

Article 32a
Right to information

(1) A patent holder may request in case of infringement or jeopardising of his rights protected by this Act that a person infringing or jeopardising his rights provided him information related to the origin of a product infringing rights pursuant to this Act and to circumstances of its placing on the market.

(2) Information pursuant to paragraph 1 shall contain particularly

a) name and surname or business name or name and place of permanent residence or place of business, or place of business of a producer, processor, storekeeper, distributor, provider, dealer and other previous holders of a product;

b) indications on produced, processed, provided or ordered quantity and price of relevant products.

(3) To provide information pursuant to paragraphs 1 and 2 shall be obliged also a person who

a) has in possession products infringing rights pursuant to this Act;

b) exploits services infringing rights pursuant to this Act;

c) provides services exploited in activities related to infringement of rights pursuant to this Act; or

d) was indicated by a person mentioned in sub-paragraphs a) to c) as a person participating in a production, processing or distribution of products or providing services infringing rights pursuant to this Act.

Disputes hearing

Article 33

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

(2) The court shall order on request that products, materials or instruments by means of which right is directly infringed or jeopardised, were

a) withdrawn from a trade network;

b) definitely removed from a trade network;

c) secured in other way by preventing further infringement or jeopardising of right;

d) destroyed in a suitable way.

(3) Provisions pursuant to paragraph 2 shall be executed at expenses of a person infringing or jeopardising rights protected by this Act, unless special circumstances give reason for other process.

(4) Request pursuant to paragraph 2(d) in the part related to process of destruction of objects shall not be binding for the court.

(5) The court shall not confer right to provide information pursuant to Article 32a, if seriousness of jeopardising or infringement of right were inadequate to seriousness of consequences resulting from fulfilment of obligation imposed in such way.

Article 34

(1) In protection of rights pursuant to this Act, a court shall be entitled by a preliminary injunction¹⁴⁾ to impose same obligations as in the decision on the merit if any delay could cause to entitled person a hardly reclaimable pecuniary or non-pecuniary injury.

(2) Within a decision on the preliminary injunction the court may, also *ex officio*, impose to a plaintiff an obligation to deposit of an adequate amount or to implicate that a decision comes into force by execution of an imposed obligation. The court shall take into account, within its deciding on the amount of a warranty deposit, the seriousness of a pecuniary or non-pecuniary injury, which can occur to the adverse party, as well as assets of the plaintiff, therewith that imposing an obligation to pay a deposit shall not be a substantial impediment of efficient application of right.

(3) The court may on request to decide on giving a warranty deposit over to the adverse party as a compensation of pecuniary or non-pecuniary injury in finance caused directly by execution of preliminary injunction issued without an adequate reason.

(4) If within the period of six months from detection of injury occurrence pursuant to paragraph 3, compensation or satisfaction is not applied at the court or an agreement on using the warranty deposit between parties is not concluded, the court shall refund the warranty deposit.

PART THREE PROCEEDINGS BEFORE THE OFFICE

Article 35

Filing date of patent application

(1) Proceedings on application shall start by filing an application with the Office.

(2) Unless stated otherwise below, filing date of an application shall be a day of delivery or amendment of filing containing at least

- a) data indicating an apparent intention of an applicant to file an application,
- b) data enabling identification of an applicant and contact with an applicant,
- c) part of appearing as a description.

(3) Obligation of an applicant pursuant to Article 798) shall not apply for purposes of determination of filing date of an application in relation to data pursuant to paragraph 2(c).

(4) If the Office ascertains that an application fails to meet requirements pursuant to paragraph 2(c) or is not complete, the Office shall invite an applicant to amend an application.

(5) In case pursuant to paragraph 4 day of amendment of missing part of filing shall be considered as filing date of an application.

¹⁴⁾ Articles 74 to 77 and Article 102 of The Rules of Civil Procedure.

(6) Determination of filing date of an application pursuant to paragraph 5 shall not apply if an applicant withdraws his filing in the part amended in after amendment of filing for reason of incompleteness pursuant to paragraph 4.

Article 35a

(1) An applicant shall be entitled to substitute a part of filing pursuant to Article 35 (2)(c) with a reference to earlier application if he applied priority right pursuant to Article 36(2) in the application.

(2) Reference to an earlier application pursuant to paragraph 1 shall contain

- a) an explicit manifestation of will of an applicant that a part of filing pursuant to Article 35(2)(c) shall be substituted by a reference to an earlier application,
- b) filing number of an earlier application,
- c) filing date of an earlier application,
- d) a state where an earlier application has been filed, eventually an authority with which an earlier application has been filed.

(3) An applicant shall be obliged to submit on invitation of the Office within two months a copy of an earlier application; if an earlier application is not in an official language, an applicant shall be obliged to submit on invitation of the Office within two months also a translation into the official language.

(4) If a reference to an earlier application pursuant to paragraph 1 fails to contain requirements pursuant to paragraph 2 or an applicant fails to comply with an invitation of the Office pursuant to paragraph 3, an application shall be deemed not to have been filed. If an application is deemed not to have been filed, the Office shall inform an applicant about this fact.

Article 36

Priority right

(1) Priority right for an applicant shall be established

- a) on filing date of an application or
- b) on priority date in accordance with an international convention ⁶⁾ following from the first application, utility model application or author's certificate or utility certificate.

(2) Priority right, which follows from an international convention⁶⁾, shall be claimed by an applicant in an application.

(3) Priority right pursuant to paragraph 2 may be claimed if the first application is filed in a state or in relation to a State which is a contracting party to an international convention ⁶⁾ or which is a member state of the World Trade Organisation. ⁷⁾ Otherwise this right may be claimed only under the condition of reciprocity.

(4) If an applicant who has filed an application within a time limit of 12 months from the date of rise of priority right, fails to claim priority right pursuant to paragraph 2, the Office shall grant priority right on basis of a request for subsequent granting of priority right filed within 16 months from the date of rise of priority right, but no later than

- a) within a time limit of four months from the filing date of an application,

b) on the day of filing a request for an earlier publication of an application (Article 41(2)).

(5) If an applicant files an application after expiry of 12 months from the day of rise of priority right despite of reasonable care required by circumstances, the Office shall grant priority right on basis of a request for subsequent granting of priority right, provided that

- a) an application as well as a 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) an applicant shall adequately substantiate in his request delayed filing an application and particularly state facts preventing him from filing an application in due time, .

(6) The Office may invite an applicant to prove claimed priority right by a priority right document (hereinafter referred to as "priority document") within a time limit specified by the Office, but not earlier than 16 months from the day of rise priority right.

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

- a) request for issue of a priority document has been filed with a competent authority at the latest within one month from the day of delivery of request to the Office pursuant to paragraph 6 ,
- b) request for subsequent recognition of priority document together with a priority document has been filed within one month from the day of delivery of a priority document to an applicant.

(8) If examination of patentability of an invention depends on granting priority right, the Office may invite an applicant to submit a translation of a priority document into the Slovak language or into one of official languages of the European Patent Office in accordance with a choice of an applicant.

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

(10) An applicant shall be obliged to pay an administrative fee Article 79(9) for request pursuant to paragraphs 4, 5, and 7.

(11) Claiming and proving priority right which fails to meet conditions pursuant to this provision and pursuant to generally binding regulation, shall not be taken into consideration by the Office in proceedings. The Office shall notify an applicant on this fact.

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

Article 36a

(1) If an applicant, before filing an application, has filed a utility model application with identical subject-matter in the Slovak Republic, he may request, with filing an application, granting a date of filing or also priority right from this utility model application. The Office shall grant a date of filing to an application or also priority right from this utility model application, if an application is filed within a time limit of 36 months form filing a utility model application; if proceedings on utility model application have been suspended or a utility model application has been refused, an application shall

be filed within a time limit of 2 months from delivery of this decision, at latest within 36 months from filing a utility model application.

(2) An applicant claiming priority right pursuant to paragraph 1 shall be obliged within a time limit of 3 months from filing an application to submit original of a utility model application, date of filing or priority right of which he has been claiming, otherwise it shall not be taken into consideration.

Article 37 Application

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

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

(3) 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) An invention shall be described and explained in an application clearly and completely so that it can be carried out by a person skilled in the art.

(5) Application shall contain:

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

(6) An applicant shall be obliged to pay an administrative fee for filing an application (Article 79(8)).

Article 38 Special provision on application of biotechnological invention

(1) If a subject-matter of an invention is biological material or utilisation of biological material, which is not available to public and which cannot be described in an application in a manner that it can be carried out by a person skilled in the art, description shall be deemed sufficient only provided that

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

(2) Deposited biological material shall be available by providing a sample on request from the publication day of an application up to granting a patent. An applicant shall be entitled on request filed with the Office before publication of an application to limit an access to deposited biological material only for independent experts.

(3) After granting a patent irrespective of its cancellation or lapse, deposited biological material shall be available by providing a sample on request

(4) Deposited sample may be provided only if a requesting person or independent expert pursuant to paragraph 2, second sentence, shall bound himself that during the term of a patent

- a) he shall provide neither sample nor material derived from it to third party,
- b) he shall utilise sample and material derived from it only for experimental purposes, unless an applicant or a patent owner explicitly repeals this obligation for him.

(5) Applicant shall be entitled on request filed with the Office before publication of an application to limit an access to deposited biological material for time limit of 20 years from the day of filing an application only for independent experts for case that an application would be refused or proceedings on application would be suspended; paragraph 4 shall apply *mutatis mutandis*.

(6) In case of doubts about accessibility of biological material to public or about sufficiency of description pursuant to paragraph 1,

Article 39

Interruption of application proceedings

(1) The Office shall interrupt application proceedings after the court litigation for right to a solution has started., .

(2) Time limits pursuant to this Act, with exception of a time limit pursuant to Article 41(1), shall be stopped. During the interruption of the proceedings the running, the

(3) When a decision, by which a proposal for forfeiture of application rights and transfer of them (Article 48(3)) has been satisfied, comes into effect, the Office shall continue in proceedings interrupted pursuant to paragraph 1.

Preliminary examination of application

Article 40

(1) Within preliminary examination the Office shall ascertain whether

- a) conditions to determine filing date of an application pursuant to Article 35 have been met,
- b) conditions to confer priority right pursuant to Article 36 have been met,
- c) application meets conditions pursuant to Articles 37, 38 and 59,
- d) application meets conditions pursuant to a generally binding regulation (Article 80),
- e) applicant has paid an appropriate administrative fee pursuant to Article 79(9),
- f) applicant is being represented by an authorised representative pursuant to Article 79(1),

g) application does not contain a subject-matter which clearly fails to meet conditions pursuant to Article 5(1) or is not being considered to be an invention pursuant to Article 5(3), or which is a subject to exclusion from patentability pursuant to Article 6.

(2) In case of doubts the Office may invite an applicant to prove utility of a subject-matter of an application by its demonstrating or in another suitable manner. If an applicant fails to prove utility or fails to comply with an invitation, subject-matter of an application shall be deemed not to be utilisable.

(3) In case that irregularities have been ascertained pursuant to paragraph 1(e) and (f) or Article 35(2), or Article 37(3) and (5), or Article 79(9), or pursuant to implementing regulation (Article (80)), the Office shall invite an applicant to correct these irregularities within the prescribed time limit or to respond to the invitation. If an applicant fails to comply with the invitation within the prescribed time limit or his response fails to rebut validity of the invitation, the Office shall suspend application proceedings. An applicant shall be notified in an invitation about this consequence.

(4) If an application fails to meet conditions pursuant to Article 37(1) and (4) or Article 38(1) to (3) or a subject-matter of an application evidently fails to meet conditions pursuant to Article 5(1), or it is not being considered to be an invention pursuant to Article 5(3), or is subject to exclusion from patentability pursuant to Article 6, or an assumption pursuant to paragraph 2 applies, the Office shall refuse an application. Before an application is refused, the Office shall enable an applicant to respond to ascertained reasons for refusal of an application.

(5) If conditions for claiming priority right pursuant to Article 36(2) to (9) and pursuant to generally binding regulation (Article 80) have not been met, the Office shall grant to an applicant priority right pursuant to Article 36(1)(a).

Article 41

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

(2) An application may be published before expiry of the time limit prescribed in paragraph 1, if an applicant requests it no later than within 12 months from rise of priority right and if he pays administrative fee (Article 79(9)). The Office shall publish an application before expiry of the time limit prescribed in paragraph 1, if a patent has already been granted for an invention; the Office shall not publish an application before expiry of 12 months from rise of priority right without consent of an applicant.

(3) The Office may publish, together with an application, a search report on a state of the art related to an invention applied in an application.

Article 42

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

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

Substantive examination of an application

Article 43

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

(2) Request for conducting substantive examination has to be filed no later than within 36 months from filing an application (Article 35) and it cannot be withdrawn. Requesting person shall be obliged to pay administrative fee (Article 79(9)) together with a request.

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

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

Article 44

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

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

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

(4) If a subject-matter of an application meets stipulated conditions and an applicants pays an appropriate administrative fee (Article 79(9)), the Office shall grant a patent to an applicant and an applicant shall become an owner of a patent. The Office shall issue a patent document to an owner and granting of a patent shall be published in the Journal.

(5) Owner of a patent shall be obliged to pay administrative fee for maintenance (Article 79(9)).

Article 45

Amendment and division of application

(1) The applicant shall be entitled to amend an application in the course of proceedings on application; amendments and changes shall not exceed the scope of an application as filed.

(2) An applicant shall be entitled to divide an application up to time of granting a patent pursuant to Article 44(4). The Office shall confer the filing date and eventually priority right from the application as filed to divisional applications if they shall not exceed its scope.

- (3) If an application had been divided after substantive examination started pursuant to Article 43, divisional application shall be considered as an application in which a request for substantive examination was filed.

Revocation and partial revocation of a patent

Article 46

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

- a) requirements for its granting pursuant to Articles 5 to 9 have not been met,
- b) invention has not been disclosed and described in a patent so clearly and fully so that it could be carried out by a person skilled in the art,
- c) subject-matter of a patent exceeds content of an application as filed. This shall also apply in case if subject-matter of a patent granted on basis of a divisional application exceeds contents of an application as filed,
- d) scope of protection following from patent was exceeded,
- e) ownershall not be entitled to a solution pursuant to Article 10(1) and (3), Article 11(1) or Article 12(1).
- f) requirements for its granting pursuant to regulations valid in time of its granting have not been met.

(2) If reasons for revocation are concerning a patent partially, a patent shall be revoked only to extent adequate to ascertained reasons, by amendment of patent claims, description or drawings.

(3) If a patent has been revoked, it shall apply that it has never been granted within the scope affected by revocation.

(4) The Office shall be entitled to revoke a patent also after its lapse, if a requesting person proves his legal interest.

(5) The Office shall be entitled to revoke a patent partially pursuant to paragraph 2 and also on request of its owner notwithstanding existence of grounds pursuant to paragraph 1.

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

(7) Requesting person shall be obliged to pay an administrative fee (Article 79(9)) with filing a request pursuant to paragraphs 1 and 5.

Article 47

(1) If a request for revocation or partial revocation of a patent (hereinafter referred to as “revocation request”) fails to contain requirements stipulated by a generally binding regulation (Article 80) or if a person requesting revocation is not being represented by an authorised representative pursuant to Article 79(1) or if an administrative fee has not been paid (Article 79(9)), the Office shall invite a requesting person to correct ascertained irregularities within a prescribed time limit. If a requesting person fails to comply with an invitation within a prescribed time limit, the

Office shall suspend proceedings on revocation request. Requesting person shall be notified about this consequence in an invitation.

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

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

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

(5) If it is impossible to decide on a basis of written filings of parties, the Office shall determine a date for oral proceedings. The Office shall at the same time deliver to a requesting person a statement of an owner to his request.

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

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

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

Article 48 Forfeiture of patent and transfer

(1) The Office shall, on request, forfeit a patent from a patent owner entered into the Register and a requesting person shall be entered as a patent owner if

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

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

(3) Paragraph 1 shall apply *mutatis mutandis* to forfeiture of rights from an application and their transfer to an entitled person. . If rights from an application have not been transferred due to reasons pursuant to paragraph 2, the Office shall refuse an application pursuant to Article 40(4).

(4) Article 47(1) to (6) shall apply *mutatis mutandis* to proceedings pursuant to paragraphs 1 to 3..

(5) Together with filing a request pursuant to paragraphs 1 and 3 a requesting person shall be obliged to pay an administrative fee (Article 79(9)).

Article 49 Determination proceedings

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

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

(3) In case that a determination request has been filed in relation with pending court proceedings subject-matter of which is right protected by this Act, all parties to court proceedings, whose rights and obligations may be affected by determination proceedings and deciding on determination, shall be parties to determination proceedings.

(4) Provision of Article 47(1), (5) the first sentence, and paragraph 6 shall apply *mutatis mutandis* to proceedings to which a proposing person shall be an exclusive party, otherwise for determination proceedings provisions of Article 47(1) to (6) shall apply *mutatis mutandis*.

(5) Proposing person shall be obliged to pay an administrative fee pursuant to Article 79(9) together with determination request.

Article 50 Entry of licence, right of lien, assignment or transfer of a patent and court litigation into the Register

(1) Article 47(1) shall apply *mutatis mutandis* to proceedings on request for entry of licence, right of lien, assignment or transfer of a patent (hereinafter referred to as “request for entry of right”) and a court litigation into the Register. .

(2) In case of doubts the Office may ask for submission of a certified copy or of an original of a patent document proving acquisition of right or other supplementary data.

(3) Provisions of paragraphs 1 and 2 shall not apply to compulsory licence, which shall be entered into the Register by the Office *ex officio* after delivery of a valid court decision on its granting.

(4) On request of a party to court proceedings, subject-matter of which is right protected by this Act, supplied with a copy of filing with a court certified by a court, the Office shall enter into the Register the fact that court proceedings are pending as well as a subject-matter of proceedings, with effect from the day of delivery of a request to the Office.

(5) An applicant shall be obliged to pay administrative fee (Article 79(9)) together with a request pursuant to paragraphs 1 and 4. .

Article 51 Further processing

(1) On request of a party to proceedings on extension of the time limit for performing an act set by the Office, filed before the expiry of such time limit, the Office shall be entitled to extend the time limit.

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

(3) An applicant shall be obliged to pay an administrative fee (Article 79(9)) together with filing a request pursuant to paragraphs 1 or 2. .

(4) A request pursuant to paragraph 2 shall be refused in case of a time limit pursuant to Article 47 (1) and (2).

(5) The Office shall refuse a request for extension of a time limit or for further shall be refused pursuant to paragraph 4 ; before decision on refusing request the Office shall enable a requesting person to respond to ascertained reasons on basis of which the request shall be refused.

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

(7) If the Office fails to decide about refusing a request pursuant to paragraph 1 within two months from its delivery and 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 a party to proceedings before the Office unintentionally fails to comply with legal time limit or time limit for performing an act set by the Office whereas the consequence of failure to perform this act is proceedings suspension or forfeiture of other right, he is entitled to ask the Office for *restitutio in integrum* and at the same time to perform the omitted act within two months from removal of impediment causing the failure of performing an act, no later than within 12 months from expiry of non-complied time limit.

(2) Requesting person shall be obliged to pay an administrative fee (Article 79(9)) together with filing a request pursuant to paragraph 1..

(3) Party to proceedings shall be obliged to sustain request pursuant to paragraph 1 and state facts preventing performing an act and a date of ceasing of impediment preventing performing an act. The Office shall not take into consideration statements submitted after time limits pursuant to paragraph 1 expired in deciding about request.

(4) In case of reasonable doubts about veracity of a statement pursuant to paragraph 3 the Office is entitled to invite requesting person to prove his statements.

(5) Request for *restitutio in integrum* shall not be satisfied in case of failure to comply with time limits for

- a) filing a request for further processing pursuant to Article 51(2) and request for *restitutio in integrum* pursuant to paragraph (1),
- b) additional conferring and proving priority right pursuant to Article 36 (4), (5) and (7),
- c) filing a remedy in proceedings before the Office pursuant to Article 55(1),
- d) performing acts pursuant to Article 47(1) and (2).

(6) The Office shall refuse request for *restitutio in integrum* which fails to comply with conditions pursuant to paragraphs 1 and 3, or which is not possible to be satisfied pursuant to paragraph 5, or requesting person fails to prove his statements pursuant to paragraph 4; before the request is refused the Office shall enable requesting person to respond to ascertained reasons on basis of which request is to be refused.

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

(8) Third party that has exploited an invention, which was a subject-matter of an application or a patent or has made provable preparations immediately aiming to utilisation of such invention within the territory of the Slovak Republic in a good faith from validity of a 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, shall be entitled to exploit an invention within his business activity without an obligation for remuneration for exploitation of an invention.

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

Article 53 Grounds for decision

(1) Party to administrative proceedings before the Office (hereinafter referred to as “party”) shall be obliged to submit or propose evidence in support his statements.

(2) The Office shall exercise evidence and evaluate evidence at its discretion, namely each evidence separately and all evidences in their mutual relations.

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

Article 54
Costs of proceedings

(1) Costs of proceedings shall be particularly cash expenses of parties and their representatives, including administrative fee, loss of earnings of parties, costs of evidence and remuneration for representing by a patent representative,¹⁶⁾ attorney,¹⁷⁾ or commercial lawyer.¹⁸⁾

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

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

(4) If an expert's report has been submitted, an expert shall be entitled to a reimbursement of cash expenses and remuneration pursuant to special regulations.¹⁹⁾

(5) Person who has been imposed an obligation to submit a document or to enable inspection of an object by the Office during proceedings on evidence, , shall have same rights as a witness, if he is not a party to proceedings.

(6) The Office may order a party to deposit advance payment for costs of evidence proposed by him, in amount of assumed costs, if ordering of such duty does not represent a substantial obstacle of effective enforcement of right.

(7) If a party fails to comply with an invitation to deposit advance payment within the prescribed time limit, the Office shall continue in proceedings as though a proposal for evidence has not been filed.

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

(9) The Office is entitled to declare the Successful party to proceedings for right to compensation of costs incurred for effective enforcement of right against unsuccessful party. If a party to proceedings has been successful on the merit only partially, the Office shall share compensation of costs proportionally or shall not confer right to such compensation of costs to any party.

(10) Party shall apply compensation of proceedings costs no later than till the day when the decision on the merit as such is issued.

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

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

¹⁸⁾ 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.

¹⁹⁾ 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.

Article 55
Remedies

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

(2) The Office shall be bound by scope of an appeal in deciding on it; this shall not apply

- a) for matters in which proceedings can be started *ex officio*,
- b) for matters of joint rights or obligations concerning several parties to proceedings on one side.

(3) Filing an appeal shall not be admissible against a decision by which

- a) request for further proceedings or for *restitutio in integrum* has been satisfied,
- b) proceedings have been suspended pursuant to Article 79(5).

(4) Deleted from January 1, 2008.

Article 56
Data accessibility

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

(2) Irrespective of paragraph 1, the Office shall on request enable a patent owner or an applicant or a person *vis-à-vis* who rights from non-published application have been applied to inspect file relating a non-published application, if a non-published application refers to a patent or application of this patent owner or this applicant. .

(3) After application is being published, the Office shall on request enable any person to inspect file relating an application or a patent, unless stated otherwise.

(4) Right for file inspection shall include right for making photocopies on payment .

(5) On written request of an inventor stated in an application pursuant to Article 37(5) the Office shall not make accessible his identification data to third parties, particularly with publication of an application, notice of granting a patent, issuing a patent document, issuing an abstract of record and with file inspection.

(6) On a written request, by proving an emergent legal interest, the Office shall be entitled to notify requesting person whether a person indicated by him is in an application as an inventor, or not.

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

(8) Rights pursuant to paragraphs 1 to 3 shall not be applied in relation to applications and patents kept confidential pursuant to a special regulation,²⁰⁾ to record on voting and to parts of a file containing supplementary notes or draft versions of decisions, assessments or standpoints .

Article 57 Register and Official Journal

- (1) The Office shall keep
- a) Register in which decisive data concerning applications and granted patents are entered,
 - b) European Patents Register in which decisive data concerning granted European patents with designation for Slovak Republic are entered,
 - c) a Register in which decisive data concerning applications for granting supplementary protection certificates for medicinal products or plant protection products, and granted supplementary protection certificates for medicinal products or plant protection products are entered.
- (2) Data entered into registers pursuant to paragraph 1 shall be considered valid unless a decision of a relevant authority states otherwise.
- (3) Changes in data entered into the Register ensuing from valid and enforceable decision of a relevant authority, shall be entered without delay into the Register by the Office after delivery of decision with a validity clause.
- (4) Entry of data and facts ensuing from law or from decision of a relevant authority shall not be considered a decision issued in proceedings pursuant to a special regulation.²¹⁾
- (5) Any person shall be entitled to inspect Registers stated in paragraph 1.
- (6) The Office shall issue the Official Journal in which facts concerning published patent applications, European patent applications as well as patents, European patents, supplementary protection certificates and their protection are published.

Article 58 International application

- (1) An international application¹⁾ may be filed with the Office by
- a) natural persons who are nationals of the Slovak Republic,
 - b) natural persons or legal entities with residence, seat, establishment or organisational component within the territory of the Slovak Republic,
- (2) Applicant shall be obliged to pay an administrative fee (Article 79(9)) for acts relating to filing an international application and to pay fees specified by the Patent Co-operation Treaty¹⁾ through the Office.
- (3) An applicant for an international application¹⁾ requesting granting a patent in the Slovak Republic shall be obliged to submit this international application to the Office within the time limit of 31 months from the priority date, to pay an administrative fee for filing an application (Article 79(9)) and to submit its translation into the official language.

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

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

(4) If an applicant for an international application¹⁾ requesting granting a patent in the Slovak Republic fails to submit this international application to the Office within the time limit pursuant to paragraph 3, the Office shall confer priority right to the application pursuant to Article 36(1)(a). (5) On request of an applicant, provided that conditions pursuant to paragraph 3 have been met, the Office may begin proceedings on international application also before expiry of time limits laid down in paragraph 3.

Protection of confidential information

Article 59

(1) If a national applicant knows or due to circumstances should know that an application contains confidential information pursuant to a special regulation,²⁰⁾ he shall be obliged to request confidentiality for an application in the application.

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

(3) The Office after conferring a filing date (Article 35) shall deliver one version of an application to the National Security Office²⁰⁾ (hereinafter referred to as "Security Office") together with request for decision on confidentiality of an application pursuant to a special regulation²⁰⁾ or with request for permission of filing an application abroad.

(4) The Office may proceed pursuant to paragraph 3 also in case when an applicant has not requested confidentiality for an application pursuant to paragraph 1.

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

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

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

(8) Article 11(5) shall apply *mutatis mutandis* to determination of amount of pecuniary injury pursuant to paragraph 7.

(9) Patent applications, European patent applications or international applications, for confidentiality of which contracting party or foreign applicant request pursuant to an international convention, treaty or agreement binding for the Slovak Republic, shall be considered confidential pursuant to a special regulation.²⁰⁾ A foreign applicant who does not act on behalf of contracting party

shall be obliged to prove confidentiality of subject-matter of an application by contracting party, to submit permission of contracting party for filing an application in the Slovak Republic and to supplement a declaration on waiving any claims for compensation of damage or other pecuniary injury which might occur as a result of confidentiality of an application within 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 regulation,²⁰⁾ with exception of publication (Article 41) and accessibility of data (Article 56) related to confidential application or patent.

(11) If the Security Office does not consider facts contained in an application confidential pursuant to a special regulation,²⁰⁾ the Office shall notify this fact to an applicant and shall proceed on an application without confidentiality regime.

PART FOUR IMPLEMENTATION OF THE EUROPEAN PATENT CONVENTION

Article 60

Effects of the European patent application

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

(2) After European patent application is being published by the European Patent Office and translation of patent claims into Slovak language is being submitted subsequently and after payment of publication fee (Article 79(9)) by an applicant of a European patent application, the Office shall make translation of patent claims accessible to public and shall publish this fact in the Journal.

(3) From the day of accessibility of translation of patent claims to public pursuant to paragraph 2, an applicant of a European patent application shall have same rights as an applicant pursuant to this Act provided that a European patent shall be granted with effects in the Slovak Republic.

(4) If a European patent application or designation for the Slovak Republic in proceeding before the European Patent Office have been withdrawn, or is deemed withdrawn, application proceedings shall be deemed to have been suspended pursuant to Article 40(3). Refusal of European patent application shall have same effects as refusal of an application pursuant to Article 40(4).

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

Article 61 Conversion of European patent application

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

(2) Applicant shall be obliged on a basis of an invitation of the Office to submit a translation of the European patent application into the Slovak language within 3 months and to pay an administrative fee for filing an application (Article 79(9)).

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

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

(5) Deleted from January 1, 2008.

Article 62 Binding wording of European patent application and European patent

(1) Contents of a European patent application modified by wording of a European patent in a language of proceedings on a European patent application before the European Patent Office shall be decisive for determination of the scope of protection ensuing from a European patent application and a European patent.

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

(3) Applicant of a European patent application or an owner of a European patent may file a corrected translation of patent claims pursuant to Article 60(2) or a corrected translation of a European patent specification pursuant to Article 63(2) into Slovak language at any time. After corrected translation has been delivered and administrative fee (Article 79(9)) has been paid, the Office shall make corrected translation accessible to public and this fact shall be announced in the Journal.

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

(5) Right of third parties to use a subject-matter of an invention, which pursuant to translation into the Slovak language valid in decisive period has not fallen within the scope of a European patent,

shall remain unaffected by effects of corrected translation, provided that, they have utilised a subject-matter of an invention within the territory of the Slovak Republic in good faith, the or they have made provable preparations for utilisation of a subject-matter of an invention.

Article 63 Effects of European patent

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

(2) Owner of a European patent shall be obliged to submit to the Office within three months from notification on granting a European patent a translation of a patent specification into the Slovak language, to pay a publication fee (Article 79(9)) and to notify the Office of a address for correspondence within the territory of the Slovak Republic.

(3) If an owner of European patent fails to submit to the Office a translation of a European patent specification within the time limit pursuant to paragraph 2, he may submit this translation within an additional period of three months provided that a surcharge pursuant to paragraph 2 has been paid together with submission of a translation.

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

(5) If a patent owner fails to notify to the Office an address for correspondence within the territory of the Slovak Republic, official correspondence related to his patent shall be deposited at the Office and considered to be delivered within the time limit of 30 days from the day of deposition. An applicant shall be notified about this consequence by the Office.

(6) Based on fulfilment of conditions pursuant to paragraph 2 or 3, the Office shall make a translation of a European patent specification accessible and shall notify this accessibility and also granting a European patent in the Journal (Article 57).

(7) After publication in the European Patent Journal about granting a European patent the Office shall enter a European patent into the European Patents Register with data entered into the European Patents Register.

Article 64 Inadmissibility of double protection

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

Article 65
Revocation or maintenance of European patent in a modified wording

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

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

(3) If a European patent has been maintained in a modified wording in opposition proceedings pursuant to Article 101 of the European Patent Convention or limited in proceeding pursuant to Article 105b of the European Patent Convention by a decision of the European Patent Office, a European patent owner shall be obliged within three months from the day of publication of modification in the European Patent Journal to submit a translation of modified wording of a patent specification into the Slovak language to the Office and to pay a publication fee(Article 79(9)).

(4) If a European patent owner fails to submit a translation of modified wording of a European patent specification into the Slovak language or if fails to pay 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 a European patent with designation for the Slovak Republic under conditions stipulated in Article 46(2) to (7) and Article 47, if in proceedings started on a request or *ex officio* a reason for revocation of a patent pursuant to Article 138 in conjunction with Article 139 of the European Patent Convention is proved, provided that

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

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

Article 66
Filing a European patent application

(1) The Office shall be the place where legal entities or natural persons may file a European patent application.

(2) Paragraph 1 shall not apply for filing a divisional European patent application pursuant to Article 76 of the European Patent Convention.

Article 67
Fees

(1) An owner shall be obliged to pay annual maintenance fee for maintaining validity of European patent in the Slovak Republic (Article 79(9)).

(2) Right of third parties to utilise a subject-matter of an invention shall not be affected by subsequent payment of maintenance fee provided that if they have utilised in good faith a subject-matter of an invention within the territory of the Slovak Republic or they have made provable arrangements for its utilisation after vain expiry of time limit for payment of maintenance fee.

PART FIVE
Deleted from March 1, 2007

Title deleted from March 1, 2007

Article 68
Deleted from March 1, 2007

Article 69
Deleted from March 1, 2007

Title deleted from March 1, 2007

Article 70
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Article 71
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Article 76
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Article 77
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Article 78
Deleted from March 1, 2007

PART SIX
COMMON, AUTHORISING, TRANSITIONAL AND REPEALING PROVISIONS

Article 79
Common provision

(1) Parties shall have equal position in proceedings before the Office, but parties without permanent residence or seat in the Slovak Republic shall be in proceedings, including submitting translations pursuant to Part Four of this Act, represented by an authorised representative,²⁶⁾ with exception of acts

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

(2) When applying for an exception from mandatory representation pursuant to paragraph 1 a party to proceedings shall be obliged to notify the Office of an address for correspondence within the territory of the Slovak Republic. If a party to proceedings fails to notify the Office of an address for correspondence, official announcements related to proceedings shall be deposited at the Office, whilst they shall be deemed to be delivered after expiry of 30 days from the date of deposition. A party shall be notified about this consequence.

(3) The Act on Administrative Proceedings²¹⁾ with 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 to proceedings before the Office pursuant to this Act.

(4) Provisions of this Act shall apply *mutatis mutandis* to arise, change and lapse of legal relations, subject-matter of which is a certificate pursuant to special regulations, 22a) as well as to proceedings on certificates pursuant to special regulations 22a), unless a special regulation 22a) states otherwise.

(5) If a party to proceedings fails to comply with an invitation of the Office within set time limit, the Office may suspend the proceedings. Party shall be notified about this consequence in an invitation.

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

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

²⁶⁾ 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.

(8) Unless this Act or the generally binding regulation (Article (80) states otherwise, submission with the Office shall be made in writing, in a official language. ²⁷⁾

(9) For acts pursuant to this Act and for maintaining validity of a patent, European patent and for filing a request for granting a certificate, request for cancellation or amendment of a certificate and for maintaining validity of a certificate pursuant to a special regulation 22a) administrative fees pursuant to a separate regulation. ²⁸⁾ shall be paid .

(10) Filing with the Office shall be made by means of electronic media. If such filing is not being supplied with an electronic signature, filing shall be supplemented by a written form within a time limit of one month, otherwise such filing is being considered legally ineffective.

Article 80 Authorising provision

Generally binding regulation issued by the Office shall stipulate

- a) details about method and requirements of claiming and proving priority right,
- b) details about filing and requirements of a patent application,
- c) requirements of re-deposition of biological material in a recognised depository institution and requirements for making deposited material accessible to public,
- d) details on divisional application, admissible amendments of application and correction of certain mistakes,
- e) details about requirements of a patent revocation request, request for forfeiture of a patent and transfer, request for determination, request for further proceeding and request for *restitutio in integrum*,
- f) details about method and requirements of filing an international application, its translation and languages of filing,
- g) details about method and requirements of filing a European patent application,
- h) details about method and requirements of filing a request for cancellation of a certificate pursuant to a special regulation 22a) and amendment of a certificate pursuant to a special regulation 22a) as well as details about proceedings on cancellation and amendment of a certificate pursuant to a special regulation 22a),
- i) details about form of filing with the Office in general, about delivery and about filing by means of electronic media,
- j) details about form and requirements of filing requests for entry of right into the Register,
- k) details about method and requirements of a licence offer and its acceptance,
- l) details about data entered into the Register and published in the Journal,
- m) details about regime of proceedings on matters of confidential applications, patents and certificates pursuant to a special regulation, 22a)
- n) details about method of filing and requirements of request for conversion of author's certificate to a patent,
- o) time limits determined by the Office for acts of parties to proceedings pursuant to this Act.
- p)

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

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

Transitional provisions

Article 81

(1) Rise, modification and lapse of legal relations which occurred before this Act comes into effect shall be assessed pursuant to present regulations.

(2) Proceedings on applications of inventions and proceedings on patents which have not been lawfully concluded before this Act comes into effect, shall be concluded pursuant to this Act therewith that in case of applications 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 present regulations shall be deemed applications pursuant to this Act.

(4) If utilisation of subject-matter of applications of inventions stated in paragraphs 1 and 2 occurred before this Act comes into effect and under conditions specified by present regulations, third parties' rights shall remain unaffected. Right of an inventor to remuneration for utilisation of a subject-matter of an invention with request for granting an author's certificate pursuant to present regulations shall remain unaffected.

Article 82

(1) Author's certificate for an invention, granted pursuant to Act No 84/1972 Coll. shall be valid for 15 years from filing an application. For maintaining validity of an author's certificate, administrative fees shall be paid (Article 79(9)).

(2) An organisation having pursuant to present regulations right to manage an invention or was authorised by this right shall have same rights as a patent owner.

(3) In case of an invention created in manner different than under conditions pursuant to Article 28(a) of the Act No. 84/1972 Coll. protected by an author's certificate granted pursuant to present regulations, which has not been utilised by an organisation having right to manage an invention or that was authorised by this right, an inventor shall be entitled to request the Office for its conversion to a patent (hereinafter referred to as "request for conversion") at any time during validity of an author's certificate. Requesting person shall be obliged to pay administrative fee (Article 79(9)) for request for conversion.

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

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

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

Article 83

(1) Utilisation of an invention protected by an author's certificate, which in accordance with present regulations started before January 1, 1991 or for which right was granted before this date on basis of a contract, shall not infringe rights of a patent owner. Right of an inventor for remuneration for utilisation of an invention pursuant to present regulations shall not be thereby affected.

(2) Claims to remuneration for utilisation of an invention as well as claims for reimbursement of reasonable costs related to working up of drawings, models or prototypes, remuneration for initiative participation in working up, testing or introduction of an invention and claims for remuneration for referring to a possibility of utilisation of an invention arisen before this Act has come into force, shall be settled pursuant to present regulations.

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

Article 84

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

- a) document confirming granting a consent for sale or production of a subject-matter of a patent granted in any state abroad, and
- b) decision on registration pursuant to special regulations, issued on request filed within six months from granting a consent for sale or production of a subject-matter of a patent in any state.

(2) An applicant of an invention shall be obliged to submit document and decision pursuant to paragraph 1 to the Office within the time limit of three months from their delivery but no later than 16 years from the date of rise of priority right.

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

(4) The Office shall refuse an application of an invention pursuant to paragraph 1 if

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

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

Article 85

If time limits pursuant to Article 74(3) expire before July 1, 2002, request for granting a certificate pursuant to Article 74 shall be possible to file before December 31, 2002, if a decision on registration of a medicine or on registration of a preparation for plant protection pursuant to special regulations became valid after January 1, 2000.

Article 85a

Legal acts of the European Communities and the European Union mentioned in Annex shall be governed by this Act.

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 within 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 on 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 as follows:

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

“(3) If a court grants to an owner of a breeder certificate a compulsory licence for utilisation of an invention protected by patent pursuant to a special regulation,^{1f)} Ministry shall grant on a request compulsory licence pursuant to paragraph 1 to a patent owner.”

Footnote 1f) shall read as follows:

“^{1f)} 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

Deleted from January 1, 2008

Footnote 4 shall be as follows:

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

Title IV

This Act shall enter into force on November 1, 2001 with exception of Part Four and Part Five which shall enter into force on July 1, 2002.

Act No. 402/ 2002 Coll. entered into force on August 1, 2002.

Act No. 84/ 2007 Coll. entered into force on March 1, 2007.

Act No. 517/ 2007 Coll. entered into force on January 1, 2007.

Rudolf Schuster s.m.

Jozef Migaš s.m.

Mikuláš Dzurinda s.m.
