

Act No. 517/2007 Coll. on Utility Models and on Amendment of Some Acts

Amended by : Act No. 495/2008 Coll.

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

Title I

P A R T I BASIC PROVISIONS

Article 1

This Act shall govern legal relations arising in relation to creation, legal protection and utilisation of a technical solution which is a subject-matter of a utility model application or of a utility model.

Article 2

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) essentially biological process for the production of plants or animals shall be a process consisting exclusively of natural phenomena, such as crossbreeding or selection;
- c) chemical substance shall mean any chemical element or any compound of chemical elements including any stabilisation additives and including all impurities arisen in a manufacturing process;
- d) pharmaceutical substance shall mean any substance or composition of substances which indicates curative or prophylactic effects in relation to human or animal affections, as well as any substance or composition of substances which can be administered to a human or animal to determine a diagnose or to regenerate, improve or modify physiological functions of a human or animal;
- e) medical utilisation of a substance or composition of substances shall mean methods of surgical or therapeutic treatment of the human or animal body and diagnostic methods and methods of diseases prevention used on a human or animal body;
- f) international application shall be an application filed pursuant to the Patent Co-operation Treaty;
- g) utility model owner shall be a legal or a natural person entered as an owner into the Utility Model Register (hereinafter referred to as "Register").

Article 3

The Industrial Property Office of the Slovak Republic (hereinafter referred to as "Office") shall enter utility models into the Register.

T e r m s o f P r o t e c t i o n

Article 4

Technical solution, which is new, is a result of an inventive activity, and is industrially applicable, shall be protected as a utility model.

Article 5

- (1) According to this Act the following shall not be deemed to be a technical solution:
- a) discoveries, scientific theories and mathematical methods;
 - b) aesthetic creations;
 - c) plans, rules and methods for performing mental acts, playing games or trade activities;
 - d) computer programmes;
 - e) presentation of information.
- (2) Subject-matters or activities stated in paragraph 1 shall be excluded from utility model protection only to extent to which an application of a utility model (hereinafter referred to as "application") relates to these subject-matters or activities as such.

Article 6

Exceptions to protection

The following cannot be protected by utility model:

- a) technical solutions commercial exploitation of which would be in contradiction with public order or good manners; prohibition of a technical solution exploitation as such shall not be considered to be in contradiction with public order or good manners within the meaning of this provision;
- b) plant and animal varieties;
- c) essentially biological processes for production of plants or animals;
- d) methods of surgical or therapeutic treatment of human or animal body and diagnostic methods and methods of diseases prevention used on a human or animal body;
- e) technical solutions concerning products consisting of biological material or containing biological material or a process by means of which the biological material is produced, processed or used;
- f) methods for production of chemical substances;
- g) methods for production of pharmaceutical substances; and
- h) medical use of substances and compositions of substances.

Article 7

Novelty

- (1) A technical solution shall be considered to be new if it does not form a part of state of the art in accordance with paragraphs 2 to 4.
- (2) State of the art for purposes of this Act shall be everything made available to the public by any means of disclosure before the day from which an applicant for a utility model (hereinafter referred to as “applicant”) enjoys priority right pursuant to Article 34(1).
- (3) The content of applications and patent applications filed in the Slovak Republic with an earlier priority right shall be also 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 the applicant enjoys the 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 the publication in the Journal, and for European patent applications with designation for the Slovak Republic (hereinafter referred to as “European patent application”); publication of a European patent application shall be the publication pursuant to Article 93 or Article 153 of the European Patent Convention. Confidential patent application shall be deemed to be published after the expiry of 18 months from the day of rise of priority right.
- (4) Disclosure of results of an applicant’s work or his legal predecessor shall not be considered as state of the art provided that such disclosure occurred no earlier than six months preceding the filing the application.

Article 8

Inventive activity

- (1) Technical solution 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, patent applications, international applications and European patent applications which have not been published by the day from which an applicant enjoys the priority right shall not be taken into consideration in determination of an inventive activity.

Article 9

Industrial application

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

Right to utility model protection

Article 10

- (1) An author of a technical solution (hereinafter referred to as “author”) shall have the right to utility model protection.
- (2) An author is a person who has created a technical solution by his own creative activity.
- (3) Co-authors of a technical solution (hereinafter referred to as “co-authors”) shall have the right to utility model protection within extent to which they participated in creating of a technical solution.

Article 11

- (1) If an author has created a technical solution within the framework of fulfilling tasks from an employment relationship, similar employment relationship or member relationship, right to utility model protection shall pass to an employer, until parties of this relationship agreed otherwise. The right of being an author shall remain unaffected.
- (2) An author who has created a technical solution pursuant to paragraph 1 shall be obliged to inform an employer about this fact in writing immediately and at the same time he shall submit any materials necessary for assessment of a technical solution.
- (3) An employer shall be entitled to exercise right to the utility model protection vis-à-vis an author in writing, within the period of three months from notification pursuant to paragraph 2.
- (4) If an employer fails to exercise right to utility model protection within the period pursuant to paragraph 3, this right shall pass back to the author. An employer as well as an author shall be obliged to preserve confidentiality about a technical solution vis-à-vis third parties.
- (5) An author, against whom the right to utility model protection pursuant to paragraph 3 has been exercised, shall be entitled to an appropriate remuneration from an employer. Technical and economic importance of a technical solution and a contribution achievable by its exploitation or other application, as well as extent and contents of a workload of an author shall be decisive for determining amount of remuneration. If remuneration fails evidently to correspond with the contribution achieved by later exploitation or other application of a technical solution, an author shall have the right to supplementary compensation.
- (6) Rights and obligations pursuant to paragraphs 1 to 5 shall remain unaffected after legal relationship between author and employer has ceased.

Article 12

- (1) Right to utility model protection except right to the authorship shall belong to legal successors of persons stated in Article 10 (1) and (3) and Article 11(1).
- (2) An agreement on assignment of right to utility model protection shall be made in writing, otherwise it is invalid.
- (3) Right to utility model protection shall be transferred to another person in cases specified by special regulations.
- (4) Together with assignment or transfer of right to utility model protection, which shall be executed after filing an application, assignment or transfer of rights conferred by an application shall occur concurrently. Assignment or transfer of rights conferred by an application shall come into effect vis-à-vis third parties on the day of its entry into the Register.

P A R T II **EFFECTS OF UTILITY MODEL**

Article 13

Rights conferred by registration

- (1) A utility model owner shall have an exclusive right to exploit a technical solution protected by utility model, to prevent third parties from exploitation of a technical solution protected by utility model without his consent, to provide his consent with exploitation of a technical solution protected by utility model, to assign a utility model to another person or to establish a lien to a utility model.
- (2) A utility model shall be effective from the day on which an announcement of entry of a utility model is published in the Journal.
- (3) A reasonable compensation from a person, who has used a subject-matter of an application after publication of an application, shall belong to an applicant. Right to reasonable compensation shall be executed only from the day on which effects of a utility model begin.

Article 14

Scope of protection

- (1) Scope of protection conferred by utility model shall be determined by contents of claims. Description or drawings shall be used for interpretation of claims in case of any uncertainties.
- (2) Scope of protection conferred by an application shall be preliminarily determined by contents of claims for protection published pursuant to Article 38(4). Scope of preliminary protection shall be retroactively determined by

claims for utility model protection; this shall not apply if there is conferred wider protection by utility model than by a published application.

Article 15

Exploitation of utility model

The user of the utility model is a person, who:

- a) produces, utilises, offers or places on the market, or stores or imports for this purpose the product protected by utility model;
- b) utilises the process protected by utility model (hereinafter referred to as “protected process”) or offers such protected process for utilisation to another person;
- c) produces, utilises, offers or places on the market, or stores or imports for this purpose the product directly obtained by the protected process; identical products shall be deemed to be produced by the protected process, until it is proved otherwise;
- d) supplies or offers to supply to a person not entitled to exploit a utility model any means enabling him to carry out a technical solution protected by utility model, if a person knows or with regard to circumstances he should know that these means are intended or suitable to realise a technical solution; this shall not apply if these means are being available on the market and the supplier did not instigate the person not entitled to exploit a utility model to act contrary to sub-paragraphs a) to c).

Article 16

Exhaustion of rights

A utility model owner shall not be entitled to prohibit third parties to dispose of a product protected by utility model after placing the product on the market in the member state of European Union or in the state which is a contracting party to the Agreement on the European Economic Area by the utility model owner or with his explicit consent.

Limitation to effects of utility model

Article 17

- (1) Right of a utility model owner shall not be exercised vis-à-vis person who before the right of priority has exploited a technical solution protected by utility model or has made appropriate arrangements immediately aiming at exploitation of a technical solution protected by utility model independently from an author or owner of a utility model (hereinafter referred to as “prior user”) in the territory of the Slovak Republic.
- (2) Assignment or transfer of right of a prior user for exploitation of a technical solution pursuant to paragraph 1 shall be possible exclusively as a part of assignment or transfer of a company or its part, within which a technical solution is being used.

Article 18

- (1) Rights of a utility model owner shall not be infringed if a technical solution is exploited
 - a) on board vessels of other states which are contracting parties to an international convention or parties to the World Trade Organisation, in a body of a vessel, machinery, tackle and other accessories, if these vessels temporarily or accidentally enter the territory of the Slovak Republic provided that a technical solution is used exclusively for needs of a vessel;
 - b) in construction or operation of aircrafts or land vehicles of states which are contracting parties to an international convention or parties to the World Trade Organisation or in their components or other accessories of these aircrafts or land vehicles if they temporarily or accidentally enter the territory of the Slovak Republic;
 - c) when conducting activities pursuant to an international convention, 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 an activity conducted privately and for non-commercial purposes;
 - f) in an activity conducted for experimental purposes.
- (2) Persons using a technical solution pursuant to paragraph 1(d) to (f) shall not be considered to be persons using a technical solution pursuant to Article 15(d).

Article 19

Co-ownership of utility model

- (1) Provisions of a special regulation shall apply *mutatis mutandis* to regulation of relationships among utility model co-owners, unless this Act provides otherwise.
- (2) Each of utility model co-owners shall have a right to exploit a utility model unless co-owners have agreed otherwise.
- (3) The consent of all utility model co-owners shall be required to conclude a licence contract validly, unless it is agreed otherwise.
- (4) If a utility model co-owner has no legal successor, after co-owner's death or forfeiture of a co-owner, his proportionate ownership shall be transferred to other utility model co-owners in a rate appropriate to their proportionate ownership.

Article 20

Assignment of utility model

- (1) A utility model shall be assigned to another person by an agreement made in writing, otherwise it is invalid.

- (2) An assignment of a utility model shall have legal effects vis-à-vis third parties from the day of entry into the Register. Rights of third parties acquired before the day of entry of utility model assignment into the Register shall remain unaffected.

Article 21

Transfer of utility model

- (1) A utility model shall be transferred to a new owner in cases stipulated by special regulations.
- (2) Transfer of a utility model shall have legal effects vis-à-vis third parties from the day of entry into the Register. Rights of third parties acquired before the day of the utility model transfer shall remain unaffected.

Article 22

Right of lien

- (1) The right of lien on a utility model may be established.
- (2) Provisions of a special regulation shall be applied *mutatis mutandis* to the right of lien and to relations between pledge creditor and pledge debtor.
- (3) An agreement on establishing the right of lien shall be made in writing, otherwise it is invalid.
- (4) The contractual right of lien shall begin on the day of entry into the Register.

Article 23

Licence agreement

- (1) The licence agreement (hereinafter referred to as “contractual licence”) shall grant a consent with exploitation of a technical solution protected by utility model.
- (2) The rise, lapse and enforcement of a right from the contractual licence shall be governed by provisions of a special regulation.
- (3) The contractual licence shall have legal effects vis-à-vis third parties from the day of entry into the Register. The granted licence shall be considered non-exclusive, unless the contractual licence stipulates otherwise.
- (4) The assignment or transfer of a right of a contractual licence holder shall be possible exclusively as a part of an assignment or transfer of a company or its part, within which the utility model is being exploited on basis of a contractual licence, unless the agreement stipulates otherwise.
- (5) In case of infringement or jeopardising of rights protected by this Act, the contractual licence holder shall have same rights as a utility model owner.

C o m p u l s o r y l i c e n c e

Article 24

- (1) On request the court is entitled to grant a compulsory licence to any person who proves a capability to exploit a technical solution protected by utility model in the territory of the Slovak Republic, provided that
 - a) four years have expired from the day of filing an application or three years from enter of a utility model into the Register, where the time limit, which expires later, shall apply;
 - b) person who requests granting the compulsory licence before filing request has made to utility model owner a proper offer for concluding a licence agreement, where this offer has not been accepted by utility model owner within three months from filing the offer;
 - c) technical solution is not being exploited or is being exploited insufficiently in the territory of the Slovak Republic without an appropriate reason by a utility model owner whilst the subject of a utility model protection is not being supplied to the market in the Slovak Republic sufficiently by the utility model owner; 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 the purpose for which it is granted provided that needs of domestic market are satisfied preferentially.
- (3) Notwithstanding paragraph 1(a) and (b) compulsory licence may be granted in case of serious public interest menace. A utility model owner shall be notified about this fact.
- (4) An 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 its part within which a technical solution is being exploited on of a compulsory licence.
- (5) The compulsory licence holder is entitled to waive rights from the compulsory licence by written notice delivered to the Office. The waiver of rights shall come into effect from the day of delivery of a notice to the Office or a later day, which is stated in the notice as a day from which a compulsory licence holder waives his rights.

Article 25

- (1) By granting a compulsory licence the right of a utility model holder to an adequate compensation shall not be affected.
- (2) In case of substantial change of circumstances, which led to granting of a compulsory licence, the court is entitled, on request of one of parties to the licence relation, to reverse a decision on granting the compulsory licence, provided that the repeated rising of reasons for granting the compulsory

licence is not presumable or rights from the compulsory licence are not being enforced during one year.

- (3) The Office shall enter the legal decision on granting and revocation of a compulsory licence into the Register without delay.

Article 26

Validity and duration of utility model

- (1) A utility model shall be valid four years from the day of filing an application in accordance with Article 33.
- (2) The Office may extend utility model validity on request of a utility model owner or pledge creditor twice always for another three years up to total term of protection ten years from the day of filing the application.
- (3) If a utility model has been entered into the Register after the period in accordance of paragraph 1 expired, the Office shall extend utility model validity without request of a utility model owner.
- (4) Extension of utility model validity can be requested at the earliest during the last year of its validity. If request for utility model validity extension has not been filed during the last year of its validity at the latest on the day which is identical with the day of filing an application, the request for utility model validity extension shall be deemed not to be filed.
- (5) If request for utility model validity extension is not filed in accordance with paragraph 4, a utility model owner or a pledge creditor shall be entitled to file the request within the additional period of six months from the day on which the request was supposed to be filed in accordance with paragraph 4. If request for utility model validity extension is not filed within this additional period, the utility model shall lapse on the day, when the request for utility model validity extension was supposed at the latest to be filed.
- (6) Rights of third parties, who, after the inefficient expiry of a period for filing the request, started to exploit the technical solution in a good faith or have made evident preparations for such exploitation, shall remain unaffected by the extension of the validity performed on the basis of the request for utility model validity extension filed in an additional period.
- (7) The Office shall extent the utility model validity also on request of a party to the court proceedings, subject-matter of which is a right to utility model protection, provided that the fact, that the court proceedings on the right to utility model protection is in the course pursuant to Article 49(4), has been entered into the Register.

Article 27
Lapse of utility model

- (1) A utility model shall lapse
 - a) by expiry of a utility model term;
 - b) from the day of effectiveness of abandonment of a utility model.
- (2) Abandonment of a utility model pursuant to paragraph 1(b) shall come into effect from the day of delivery the notice on abandonment to the Office or from the day, which is stated in the notice as the day, on which a utility model owner abandons a utility model. Partial abandonment of a utility model is not admissible.
- (3) Abandonment of a utility model which affects third parties rights entered into the Register shall come into effect only when the written consent of a party, whose rights and justified interests could be affected by lapse of a utility model, is submitted. The same shall apply in case of existence of a litigation entered into the Register, the subject-matter of which is a right to utility model protection.

Article 28
Infringement of rights

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

Article 29
Right to information

- (1) A utility model 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.

Article 30

Protection of rights

- (1) Disputes on 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 rights are infringed or jeopardised were particularly
- a) withdrawn from a trade network;
 - b) definitely removed from a trade network;
 - c) secured in other way preventing further infringement or jeopardising of right;
 - d) destroyed in a suitable way.
- (3) Provisions pursuant to paragraph 2 shall be performed at expenses of a person who infringes or jeopardises rights protected by this Act, unless the unusual circumstances shall not substantiate other procedure.
- (4) Request pursuant to paragraph 2(d) in the part related to process of destruction shall not be binding for the court.
- (5) The court shall not confer the right to provide information pursuant to Article 29, if the seriousness of jeopardising or infringement of a right was inadequate to the seriousness of the consequences resulting from duty imposed in such way.

Article 31

Precaution

- (1) In protection of rights in accordance with this Act the court may impose by precaution 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 the decision on precaution the court may, also without request, impose a duty to a requester to pay a deposit of an adequate amount or to implicate that the decision comes into force by execution of a duty. The court shall take into account, within its deciding on the amount of warranty deposit, the seriousness of a pecuniary or non-pecuniary injury which can occur to the adverse party as well as assets of the requester therewith that imposing the duty to pay a deposit shall not be the substantial impediment of efficient application of law.

- (3) The court, which ordered a precaution, may on request decide on giving the warranty deposit over to the adverse party as a compensation of pecuniary or non-pecuniary injury in finance caused directly by execution of precaution if this precaution expired or was discharged for some other reason than request on the merit was complied or because the right of a requester was met.
- (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.

P A R T I I I

PROCEEDINGS BEFORE THE OFFICE

Article 32

Application

- (1) Entry of a utility model into the Register shall be requested by an application filed with the Office.
- (2) Only one technical solution or a group of technical solutions which are interconnected to create a single technical concept may be a subject-matter of the application.
- (3) A technical solution 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.
- (4) Application shall contain
- a) request for entry into the Register of utility models with stating the name of a utility model;
 - b) description of a technical solution, abstract and where appropriate drawings;
 - c) at least one claim for protection;
 - d) identification data of an applicant or co-applicant;
 - e) identification data of an author or co-authors;
 - f) document on acquiring the right to utility model protection, if an applicant is not an author.

Article 33

Filing date of application

- (1) Filing date of an application shall be a delivery day or a day of filing amendment which contains at least
- a) data indicating an apparent intention of an applicant to file an application;
 - b) data allowing the identification of an applicant and contact with an applicant;
 - c) part which appears to be a description.

- (2) Obligation of an applicant to execute the filing in an official language pursuant to Article 58(8) shall not be applied for purpose of determination the filing day of an application in relation to the part of filing pursuant to paragraph 1(c).

Article 34

Priority right

- (1) Priority right for an applicant shall be established
- a) on filing date of an application;
 - b) on priority date in accordance with an international convention following from the first application, patent application, author's certificate or certificate on utility with the identical subject-matter.
- (2) Priority right pursuant to paragraph 1(b) shall be applied from the first application, patent application, author's certificate or certificate on utility with the identical subject-matter filed in a state or in relation to a state, which is a contractual party to an international convention or which is a member of the World Trade Organisation. Otherwise this right may be applied only under the condition of reciprocity.
- (3) An applicant shall apply the priority right pursuant to paragraph 1(b) in an application and within the period of three months from the day of its filing he shall prove this right by a priority right document.
- (4) If an applicant fails to prove the priority right properly and in due time in accordance with paragraph 3, the Office shall grant priority right on basis of a reasoned request for an additional recognition of a priority right document, provided that
- a) request for issue of a priority right document has been filed with a competent authority at the latest on the filing date of an application in the Slovak Republic pursuant to Article 33;
 - b) request for an additional recognition of a priority right document together with a priority right document was filed within 30 days from delivery day of a priority right document to the applicant.
- (5) The Office may invite an applicant to submit a translation of a priority right document into official language.
- (6) The Office shall not take into consideration an application of priority right and proving priority right which fails to meet conditions in accordance with this provision. This fact shall be communicated to an applicant.
- (7) The Office shall issue a document certifying priority right following the application on request of an applicant or a utility model holder.

Article 35

Deflection from patent application or from European patent application

- (1) If an applicant requested granting a patent in the Slovak Republic prior to filing an application with the identical subject-matter, he may with filing an application request conferring the filing date, where appropriate also priority right from this patent application or European patent application. The Office shall confer the filing date for an application, where appropriate also the priority right from this patent application or European patent application, if an application is filed within two months from delivery of decision on this patent application or European patent application, at the latest within ten years from filing this patent application or European patent application.
- (2) An applicant applying the right pursuant to paragraph 1 is obliged to submit an equivalent document of a patent application or European patent application, the filing date or eventually the priority right of which he is requesting, within the period of three months from filing the application; otherwise it shall not be taken into consideration.

Article 36

Conversion of European patent application

- (1) The Office shall begin proceedings on an application in accordance with the third part of this Act based on request of an applicant of European patent application for conversion to an application (hereinafter referred to as "conversion") filed pursuant to Article 135 of the European Patent Convention.
- (2) An applicant shall be obliged to submit translation of a European patent application into official language within three months on basis of invitation of the Office.
- (3) In case that request for conversion is not filed within three months from the day, when a European patent application was withdrawn or when a notice that a European patent application is deemed to be withdrawn, or a decision on refusal of a European patent application or decision on revocation of a European patent was delivered, an applicant shall lose priority rights conferred by European patent application as filed.
- (4) If request for conversion has been filed in contradiction with Articles 135 and 137 of the European Patent Convention, the Office shall refuse request for conversion.

Article 37

Interruption of application proceedings

- (1) The Office shall interrupt the application proceedings, with exception of application publication, on request of a party to court proceedings, subject of

which is a right to utility model protection, supported with an equivalent document of submission to the court certified by the court.

- (2) Time limits in accordance with this Act shall be stopped during interruption of proceedings.
- (3) When decision comes into effect, by which dispute on utility model protection has been decided, and after eventual transfer the Office shall continue in proceedings interrupted in accordance with paragraph 1.

Article 38

Examination and publication of application

- (1) If an application fails to meet conditions pursuant to Article 32(2) and (4), the Office shall invite an applicant to correct irregularities in a specified time limit. If an applicant fails to correct irregularities, the Office shall suspend proceedings on an application.
- (2) If a subject-matter of an application is not considered pursuant to Article 5 to be a technical solution or is pursuant to Article 6 excluded from the protection, eventually if a subject-matter of an application apparently fails to meet the condition pursuant to Article 9, or an application fails to meet the condition pursuant to Article 32(3), the Office shall refuse the application. Before the application is refused, the Office shall enable the applicant to respond to reasons for refusal of the application.
- (3) In case of doubts, the Office shall invite an applicant to prove utility of an application subject-matter by its demonstration or in other suitable manner. If an applicant fails to prove utility or fails to comply with the invitation, the application subject-matter shall be deemed not to be utilisable.
- (4) If proceedings on an application have not been suspended pursuant to paragraph 1 or if an application has not been refused pursuant to paragraph 2, the Office shall perform a research on state of the art (hereinafter referred to as "research") on an application subject-matter. The research result shall be communicated to an applicant, an application together with the research result shall be published and publication shall be announced in the Journal.
- (5) The Office shall delay an application publication on request of an applicant filed within the period of three months from the filing date of the application, at the latest up to 15 months from the filing date of an application.

Article 39

Amendment and division of application

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

- (2) An applicant is entitled to divide an application pursuant to Article 43 up to the time of entry of a utility model into the Register. The Office shall confer the filing date, eventually the priority right from the application as filed, to the divisional applications, if they shall not exceed its scope.

Opposition to entry into the Register

Article 40

- (1) Any person is entitled to file opposition against entry of a utility model into the Register with the Office after publication of an application within three months from this publication for a reason that a subject-matter of an application fails to meet conditions of protection pursuant to Articles 4 to 6 or that the application fails to meet a condition pursuant to Article 32(3).
- (2) Oppositions shall contain legal and factual statement of reasons as well as the evidence, eventually indication of the evidence, submitted by the opponent.

Article 41

- (1) The Office shall examine whether oppositions have been filed within the time limit in accordance to Article 40(1) and contain statement of reasons in accordance with Article 40(2).
- (2) If oppositions have not been filed pursuant to Article 40 or an opponent shall not submit indicated evidence within a specified time limit on an invitation of the Office, the Office shall suspend proceedings on oppositions.
- (3) The Office shall inform an applicant about oppositions submitted pursuant to Article 40, proceedings on which have not been suspended pursuant to paragraph 2, and shall invite him to respond within a specified time limit.
- (4) If an applicant fails to respond to oppositions within a specified time limit pursuant to paragraph 3, the Office shall suspend proceedings on an application.
- (5) If it is not possible to decide on basis of written submissions of an opponent and an applicant, the Office shall prescribe oral hearing. Herewith the Office shall deliver an applicant's response to oppositions to an opponent.
- (6) The Office is entitled to continue with proceedings on oppositions and to decide on the merit also in case, when the invited party does not participate in the oral hearing.
- (7) Written execution of a decision pursuant to paragraph 2 shall be delivered by the Office to an opponent and written execution of a decision pursuant to paragraph 4 shall be delivered by the Office to an applicant and opponent.

- (8) The Office shall suspend proceedings on oppositions, if a reason, for which an opposition was filed, has lapsed. The decision on suspension of proceedings on oppositions shall be delivered to an applicant and an opponent by the Office.

Article 42

- (1) The Office shall examine in extent of filed oppositions, whether the subject-matter of an application meets conditions of a protection pursuant to Articles 4 to 6 or whether an application meets the condition pursuant to Article 32(3), on basis of oppositions, to which an applicant have responded.
- (2) If the Office finds out in proceedings pursuant to paragraph 1 on basis of evidence exercised on request of a party that
- a) subject-matter of an application fails to meet conditions of protection pursuant to Articles 4 to 6 completely or partially or an application fails to meet a condition pursuant to Article 32(3), the Office shall comply with oppositions in a relevant extent and the application shall be refused completely or partially; or
 - b) conditions pursuant to Articles 4 to 6 and Article 32(3) are met, oppositions shall be refused.
- (3) The Office shall deliver the decision pursuant to paragraph 2 to an applicant and to an opponent.

Article 43

Entry of utility model into the Register

- (1) If proceedings on an application have not been suspended pursuant to Article 38(1) or an application has not been refused pursuant to Article 38(2), oppositions against entry of a utility model into the Register pursuant to Article 40 have not been filed or oppositions against entry of a utility model into the Register have been refused pursuant to Article 42(2)b, or proceedings on oppositions have been suspended, the Office shall enter the utility model into the Register and an applicant shall become a utility model owner.
- (2) The Office shall issue a certificate on entry of a utility model into the Register to an owner and entry of a utility model shall be announced in the Journal.
- (3) If same applicant files several applications with an identical subject-matter, only one utility model can be registered for this applicant.

Cancellation of utility model

Article 44

- (1) The Office shall cancel a utility model (hereinafter referred to as "cancellation") from the Register on request of a third party, if

- a) subject-matter of a utility model is not suitable for protection pursuant to Articles 4 to 6;
 - b) applicant was a person, who was not entitled to utility model protection pursuant to Article 10(1), Article 10(3) or Article 11(1);
 - c) application fails to meet condition pursuant to Article 32(2);
 - d) subject-matter of a utility model extends the content of an application as filed;
 - e) several utility models with identical subject-matter have been registered for same applicant;
 - f) conditions for entry of a utility model into the Register in accordance with regulations valid in the time of its registration have not been met.
- (2) The Office may cancel a utility model from the Register *ex officio* pursuant to paragraph 1(c) to (e) or if a subject-matter of an application is not apparently suitable for protection pursuant to Articles 5, 6 and 9 or an application failed to meet condition pursuant to Article 32(3).
- (3) Cancellation shall have same effects as though a utility model has never been entered into the Register.
- (4) A utility model may be also cancelled after lapse of a utility model pursuant to Article 27, if a proposer proves legal interest.
- (5) If reasons for cancellation refer to a utility model partially, the utility model shall be cancelled from the Register only in the extent adequate to recognised reasons by amendment of claims for protection, eventually also of a description.
- (6) The Office may cancel a utility model from the Register completely or partially on request of its owner irrespective of existence of reasons pursuant to paragraph 1; for partial cancellation on request of an owner of a utility model paragraph 5 shall be used *mutatis mutandis*.

Article 45

- (1) Request for cancellation shall contain legal and factual statement of reasons and concurrently evidence, submitted by a requester for cancellation and on which the request for cancellation is based, have to be submitted or indicated. Extension or amendment of such request is not admissible; such extension or amendment shall not be taken into consideration by the Office within proceedings and deciding on merit.
- (2) If request for cancellation shall not contain statement of reasons pursuant to paragraph 1 or a requester shall not submit indicated evidence on an invitation of the Office within a specified time limit, the Office shall suspend proceedings on request for cancellation. The requester shall be notified in the invitation of consequences of proceedings suspension.

- (3) The Office shall invite a utility model owner to respond to request for cancellation within a specified time limit.
- (4) If a utility model owner fails to respond within a specified time limit, the Office shall cancel the utility model from the Register.
- (5) If it is not possible to decide on basis of written filing of a requester for cancellation and a utility model owner, the Office shall appoint a date of the oral hearing. The Office also delivers response of a utility model owner on request for cancellation to a requester for the cancellation.
- (6) The Office shall continue with proceedings and decide on merit also in case, if a party invited in due form shall not participate the oral hearing.

Article 46

The plaintiff is obliged to pay a deposit of 82,50 euro together with request for cancellation. If it is proved that request for cancellation has been justified, the Office shall return the deposit without delay.

Article 47

Transfer

- (1) The Office shall record an applicant as a utility model owner if
 - a) it finds out from valid decision of a court that the person registered as a utility model owner has not been entitled to utility model protection in accordance with Article 10(1), Article 10(3) or Article 11(1);
 - b) request for transfer has been filed by a person who is pursuant to the valid decision of a court entitled to utility model protection or his successor in title; and
 - c) request for a transfer has been delivered within a period of three months from the validity date of the decision of the court.
- (2) Valid decision of a court in accordance with paragraph 1(a) shall be attached to request.
- (3) If request for transfer fails to meet conditions pursuant to paragraph 1(a) and (b) or paragraph 2, the Office shall refuse request for transfer; before the decision on refusing request for transfer is made, the Office shall enable the requester to respond to detected reasons on basis of which request for transfer is to be refused.
- (4) If a person, to whom the right for utility model protection is granted in accordance with valid decision of the court, or his successor in title, fails to file request for transfer within the time limit pursuant to paragraph 1(c), the Office shall cancel the utility model from the Register *ex officio*.
- (5) Paragraphs 1 and 2 shall be applied *mutatis mutandis* to forfeiture of rights from an application and their transfer to an entitled person. If no transfer of

rights from an application pursuant to paragraph 4 is executed, the Office shall refuse an application.

Article 48

Determination proceedings

The Office shall determine on request whether the subject-matter described in request falls within the scope of protection of a certain utility model.

Article 49

Registration of licence, right of lien, assignment or transfer of utility model and court litigation into the Register

- (1) If request for registration of licence, right of lien, assignment or transfer of utility model (hereinafter referred to as "request for registration of right") or court litigation into the Register fails to contain requirements stipulated in a generally binding regulation (Article 59), the Office shall invite a requester to correct irregularities within a specified time limit. If a requester fails to correct irregularities within a specified time limit, the Office shall suspend proceedings on request. The requester shall be notified about the consequence of proceedings suspension in the invitation.
- (2) In case of any doubts, the Office is entitled to require filing verified copy or eventually original of a document proving acquiring a right or other document proving a change of a utility model owner.
- (3) Paragraphs 1 and 2 shall not apply to a compulsory licence entered into the Register by the Office *ex officio* after delivery of a court's valid decision on its grant.
- (4) On basis of request of a party to court proceedings, subject-matter of which is a right to utility model protection, furnished with a counterpart of filing with the court authorised by the court, the Office shall enter into the Register the fact that the court proceedings on a right to utility model protection is pending.

Article 50

Further processing

- (1) On request of a party to proceedings on extension of a time limit for performing an act set by the Office, filed before expiry of such time limit, the Office shall be entitled to extend the time limit.
- (2) If a party to proceedings before the Office failed to comply with the time limit for performing the act set by the Office, he shall be entitled to ask the Office for further proceedings and at the same time to perform the omitted act no later than two months from delivery of a decision of the Office issued as a consequence of failure to comply with the time limit.
- (3) Request shall be refused pursuant to paragraphs 1 or 2 in case of time limit pursuant to Article 41(2).

- (4) Request shall be refused pursuant to paragraph 2 in case of failure to comply with time limits pursuant to Article 41(3) and Article 45(2) and (3).
- (5) The Office shall refuse request for extension of time limit or request for further proceedings which fails to comply with conditions pursuant to paragraphs 1 or 2 or shall be refused pursuant to paragraphs 3 or 4; before the request is refused the Office shall enable the requester to respond to ascertained reasons on basis of which the request is to be refused.
- (6) If the Office satisfies request for further proceedings, legal effects of a decision issued as a consequence of failure to comply with the time limit shall cease or shall not arise.
- (7) If the Office fails to decide on request pursuant to paragraph 1 within two months from the date of delivery, request shall be deemed to be satisfied.

Article 52

Restitutio in integrum

- (1) If a party to proceedings before the Office despite of a due attention required by circumstances fails to comply with the legal time limit or the 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 the elimination of the impediment causing the failure of performing the act at the latest within 12 months from expiry of non-complied time limit and in case of failure to comply with the time limit for filing request for extension of utility model validity at the latest within 12 months from expiry of non-complied additional time limit pursuant to Article 26(5).
- (2) Party to proceedings is obliged to sustain request pursuant to paragraph 1, to state facts preventing performing the act and date of impediment elimination, which caused the failure of performing the act. The Office shall not take into consideration statements submitted after time limits pursuant to paragraph 1 expired.
- (3) In case of reasonable doubts about veracity of a statement pursuant to paragraph 2, the Office is entitled to invite the requester to prove his statements.
- (4) Request for *restitutio in integrum* shall not be satisfied in case of failure to comply with time limits for
 - a) filing request for further proceedings in accordance with Article 50(2) and request for *restitutio in integrum* in accordance with paragraph 1;
 - b) applying and establishing priority right in accordance with Article 34;
 - c) filing request for application publication delay in accordance with Article 38(5);
 - d) lodging oppositions in accordance with Article 40(1);

- e) filing remedy in proceedings before the Office in accordance with Article 53(1);
 - f) performing acts in accordance with Article 41(2) and (3) and Article 45(2) and (3).
- (5) The Office shall refuse request for *restitutio in integrum* which fails to comply with conditions pursuant to paragraphs 1 and 2 or it is not possible to be satisfied pursuant to paragraph 4, or the requester fails to prove his statements pursuant to paragraph 3; before decision on request is made the Office shall enable the requester to respond to ascertained reasons on basis of which request is to be refused.
- (6) If the Office satisfies request for *restitutio in integrum*, legal effects of a decision issued as a consequence of failure to comply with the time limit shall cease or shall not arise.
- (7) Third party who has exploited technical solution, which is subject-matter of an application or of a utility model, 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 a time limit after lapse of this decision legal effects pursuant to paragraph 6, or has made evident preparation directly focusing on exploitation of such technical solution, is entitled to exploit a technical solution within the frame of his business activity without an obligation to pay for exploitation of the technical solution.
- (8) Assignment or transfer of right of entitled user pursuant to paragraph 7 is possible exclusively as a part of assignment or transfer of a company or its part, within which a technical solution is being used.

Article 52

Grounds for decision

- (1) Party to proceedings before the Office shall be obliged to submit or propose evidence to support his statements.
- (2) The Office shall decide on basis of facts ascertained from exercised evidence submitted or proposed by parties to proceedings.

Article 53

Appeal

- (1) An appeal against decision of the Office may be lodged within 30 days from delivery of decision; an appeal lodged in due time shall have deferring effect.
- (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 the proceedings on one side.

- (3) Filing an appeal shall not be admissible against decision by which
- a) request for further proceedings or for *restitutio in integrum* has been satisfied;
 - b) proceedings have been suspended in accordance with Article 58(7).

Article 54

Inspection of file and data accessibility

- (1) Parties to proceedings shall be entitled to inspect files, to make extracts and copies.
- (2) Before publishing an application pursuant to Article 38(4) the Office is entitled to notify third parties without consent of an applicant only data who is an author, who is an applicant, a name of a utility model, file number of an application and data about priority right.
- (3) On basis of request before publishing an application pursuant to Article 38(4) the Office shall enable a utility model owner, a patent owner, an applicant or an applicant of a patent application to inspect a file concerning an application, provided that this application refers to a utility model or patent of this owner or to an application or patent application of this applicant.
- (4) After publishing an application pursuant to Article 38(4) the Office shall enable third party on request to inspect file relating the application or utility model.
- (5) Right to a file inspection shall include right for making photocopies on payment for costs material relating to making copies and their delivery.
- (6) On written request of an author stated in an application pursuant to Article 32(4) the Office shall not make accessible his identification data to third parties, particularly by publishing an application, by notice on utility model registration, by issuing a certificate on entry of a utility model into the Register and by file inspection.
- (7) On written request and by proving legal interest the Office shall notify an applicant whether the person identified by him is or is not stated in the application as an author.
- (8) From right to file inspection there are excluded
- a) parts of a file containing confident information, publication of which is not necessary for securing right to information of third parties including parties to proceedings;
 - b) parts of file containing business secret on written request of a utility model applicant or a utility model owner; and
 - c) minute books and parts of a file containing auxiliary notes or decision proposals, assessments or viewpoints.

Article 55

Register

- (1) The Office shall keep the Register in which decisive data on applications and utility models are entered. Any person is entitled to inspect the Register.
- (2) Data entered into the Register 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 fact ensuing from law or from decision of a relevant authority pursuant to paragraph 3 shall not be considered a decision issued in proceedings in accordance with general regulation on administrative action.

Article 56

Official Journal

The Office shall issue an Official Journal in which facts concerning applications and utility models as well as official notification and decision of a principle character are published and notified.

Article 57

International application

- (1) An applicant of an international application requesting entry of a utility model into the Register in the Slovak Republic shall be obliged to submit this international application to the Office within a period of 31 months from the priority date and to file its translation into the official language.
- (2) On request of an applicant provided that conditions pursuant to paragraph 1 have been met the Office is entitled to start proceedings on an international application even before expiry of periods laid down in paragraph 1.

PART IV COMMON, AUTHORISING, TRANSITIONAL AND REVOCATION PROVISIONS

Article 58

Common provisions

- (1) Parties with permanent residence or seat in a territory of a member state of an international treaty or in a territory of a state which is a member to the World Trade Organisation shall have same rights and obligations as national applicants or utility model owners; if a state in which parties have permanent residence or seat is not a member state of an international treaty or a member of the World Trade Organisation, rights and obligations in accordance with this Act may be conferred only under condition of mutuality.

- (2) Parties without permanent residence or seat in the Slovak Republic shall be represented in proceedings before the Office by an authorised representative with exception of acts prior and related to determination of the filing date in accordance with Article 33.
- (3) The provision of paragraph 2 shall not be applied to parties to proceedings who are natural persons who are residents of a member state of the European Union or a state which is a contracting party to the Agreement on the European Economic Area, and legal persons with their administration or seat of their business in a territory of a member state of the European Union or a state which is a contracting party to the Agreement on the European Economic Area. Such party to proceedings shall be obliged to notify the Office the address for service within the territory of the Slovak Republic.
- (4) General provisions for administrative proceedings shall be applied to proceedings before the Office in accordance with this Act unless this Act stipulates otherwise.
- (5) Provisions on interruption of proceedings, on statutory declaration, on time limits for decision and on measures against inactiveness pursuant to general provisions for administrative proceedings shall not be applied to proceedings before the Office in accordance with this Act.
- (6) If a party to proceedings fails to comply with an invitation of the Office within the specified time limit, the Office is entitled to suspend proceedings. A party to proceedings shall be notified about consequences in the invitation.
- (7) The Office shall suspend proceedings on request of a person who filed the proposal to its beginning. The proposal for its suspension shall not be withdrawn.
- (8) Unless this Act stipulates otherwise, filing with the Office shall be made in writing and in an official language.
- (9) Filing with the Office can be made by means of electronic media. If such filing is not signed with an electronic signature, it shall be supplied in a written form within two weeks otherwise such filing shall be deemed legally ineffective.

Article 59

Authorising provision

Generally binding provision issued by the Office shall stipulate details about

- a) requirements of an application;
- b) method and requirements of claiming and proving priority right;
- c) translation of an international application;
- d) requirements of a request for delay of an application publication;
- e) requirements of oppositions against entry of a utility model into the Register;
- f) requirements of a request for extending a utility model validity;

- g) requirements of a proposal for cancellation, request for transfer, request for determination, request for further proceedings and request for *restitutio in integrum*;
- h) method of filing and requirements of a request for entry of right, request for entry of a court litigation into the Register and a request for entry of an assignment or transfer of rights from an application into the Register;
- i) data entered into the Register and published in the Journal.

Article 60

Transitional provisions

- (1) Proceedings on applications and proceedings on matters of utility models which have not been concluded lawfully before this Act comes into effect shall be concluded in accordance with this Act.
- (2) Rights and relations from utility models entered into the Register before this Act comes into effect shall be governed by provisions of this Act. Arising of these rights and relations as well as claims arising from them before this Act comes into effect shall be assessed in accordance with provisions effective in time of their arising.

Article 61

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

Article 62

Repealing provision

The following shall be repealed:

Act No. 478/1992 Coll. on Utility Models in the wording of Article VI of the Act of National Council of the Slovak Republic No. 90/1993 Coll. and Article III of the Act No. 435/2001 Coll.

Title IV

Entry into force

This Act enters into force on 1 January 2008.

Act No. 495/ 2008 Coll. entered into force on 1 February 2009

Ivan Gašparovič v.r.

Pavol Paška v.r.

Robert Fico v.r.