

**Patent Act**  
**(Passed on 16 March 1994 (RT I 1994, 25, 406),**  
**entered into force 23 May 1994)**

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Amended by the following Acts (date the Act was passed, publication in the *Riigi Teataja* (State Gazette), date of entering into force):

26.06.1996  
(RT I 1996, 49, 953)  
26.07.1996

16.06.1998  
(RT I 1998, 64/65, 1003)  
25.07.1998

25.11.1998  
(RT I 1998, 107, 1768)  
21.12.1998

The amended section ends with a reference to the Act (date the Act was passed) enforcing the current wording.

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## **Chapter I General Provisions**

### *Purpose of the Act*

§ 1. This Act regulates relationships arising in connection with legal protection of patentable inventions (hereinafter *patent protection*) in the Republic of Estonia.

### *Legislation Providing Patent Protection*

§ 2. Patent protection shall be provided for by this Act, other acts, and regulations based on them and issued for their implementation by the Government of the Republic and the Ministers.

[26.06.1996]

### *Equality of Rights and Obligations of Natural and Legal Persons of the Republic of Estonia and of Foreign States*

§ 3. Natural and legal persons of the Republic of Estonia and of foreign states (hereinafter *persons*) shall exercise the rights and obligations prescribed by this Act on equal grounds unless the legislation of the Republic of Estonia or international agreements ratified by the *Riigikogu* provide otherwise.

### *Implementation of International Agreements*

§ 4. Where this Act is contrary to an international agreement, the provisions of the international agreement shall apply.

## **Chapter II Patent Protection and Patentability**

### *Patent Protection*

§ 5.—1.—(1) An invention shall be protected with a patent if the invention meets the conditions for patentability provided for in § 8 of this Act.

(2) An invention is granted patent protection by registering it in the State Register of Patents pursuant to procedure prescribed by this Act. Registration of the invention in the State Register of Patents shall be deemed to be the granting of patent.

[16.06.1998]

### *Subject of Invention*

§ 6.—(1) The subject of an invention can be equipment, process, material, or microorganism, or their combination, but also the use of known equipment, process, material or microorganism for novel purposes.

(2) The following shall not be regarded as the subject of an invention:

1. discoveries, scientific theories and mathematical methods;
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2. schemes, rules, instructions and methods for performing economic and mental acts;
3. projects and schemes of structures, buildings and territories;
4. conventional signs;
5. algorithms and programs for computers;
6. design solutions;
7. mere presentations of information;
8. plant or animal varieties.

#### *Inventions not Patentable*

§ 7. The following shall not be protected with patents:

1. inventions contrary to *ordre public* and morality;
2. methods for treatment of the human or animal body and diagnostic methods practised on the human or animal body;
3. layout-designs of integrated circuit;
4. [repealed—16.06.1998]

#### *Classification of Inventions*

§ 7<sup>1</sup>.—Inventions are classified according to the international patent classification adopted under the Strasbourg Agreement establishing the International Patent Classification.

[16.06.1998]

#### *Conditions for Patentability*

§ 8.—(1) An invention shall be deemed to be patentable if it is new, involves an inventive step and is industrially applicable.

(2) An invention shall be deemed to be new if it is not anticipated by the prior art. The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way prior to the date of filing of the patent application or, if priority is claimed, prior to the priority date. When determining novelty, the contents of patent applications filed earlier with the Patent Office and of utility model registration applications filed pursuant to the Utility Model Act (RT I 1994, 25, 407; 35, statement; 1996, 49, 953) shall be taken into account according to their filing date or, if priority is claimed, the priority date, provided that the patent applications have been published pursuant to § 24 of this Act and the utility model registration applications have been published pursuant to § 33 of the Utility Model Act.

(3) When determining the state of the art, the information disclosed within 12 months prior to the filing date of the patent application or, if priority is claimed, prior to the priority date by a person having the right to the patent pursuant to § 12 of this Act, or by another person having obtained information from the said person according to his will or against it, shall not be taken into account.

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(4) An invention shall be deemed to involve an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

(5) An invention shall be considered industrially applicable if it can be made or used in economy.

[16.06.1998]

### *Unity of Invention*

**§ 9.**—(1) Each patent application shall relate to one invention only or to a group of invention so linked as to form a single general inventive concept.

(2) Where the patent application contains several independent inventions, the applicant may, upon suggestion from the Patent Office or on his own initiative, divide the application into a number of independent applications and file them pursuant to §§ 19 and 20 of this Act within a term prescribed by the Patent Office.

### *Extent of Patent Protection and Patent Claims*

**§ 10.**—(1) The extent of patent protection shall be defined by the terms of the patent claims. The description of the invention, the drawing and other illustrative material shall be used to interpret the patent claims.

(2) The claims shall constitute a clear and concise definition of the subject matter of the invention for which patent protection is sought. The subject matter of the invention shall be presented in the patent claims as a set of essential features of the invention. The patent claims consist of one claim or several claims.

### *Priority*

**§ 11.**—(1) Priority shall be the privilege of a person, having first filed a patent application or a utility model registration application, to apply for patent protection for an invention. From the filing date of the first patent application or utility model registration application, the said person shall have privilege over another person who files a patent application for the same invention later. The date of filing with the Patent Office of the first patent application or utility model registration application is deemed to be the priority date.

(2) Where the patent application has been filed with the Patent Office within 12 months after the filing date of the first patent application or utility model registration application, priority can be established, upon claiming it, in the following cases:

1. according to the date of filing the first patent application or utility model registration application in any state party to the Paris Convention for the Protection of Industrial Property (RT II 1994, 4/5, 19) or to the World Trade Organisation;

2. according to the date of filing the first patent application or utility model registration application in a state not party to the Paris Convention or to the World Trade Organisation provided that the said state guarantees the same conditions for the first patent application or utility model registration application filed in the Republic of Estonia.

(3) If priority is claimed, priority may be established for a patent application, filed on the basis of corrections and supplementations to the previous patent application changing the

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subject matter of the invention, according to the date of filing of the said corrections and supplementations with the Patent Office.

(4) If priority is claimed, priority may be established for a patent application, having been divided from the previous patent application, according to the priority date of the previous patent application.

(5) If priority is claimed, priority may be established for a patent application filed with the Patent Office within 12 months by the same applicant in respect of the same invention according to the filing date of the previous patent application or utility model registration application, provided that the previous patent application or utility model registration application has not been published and it has not served as a basis for claiming priority for any other patent application or utility model registration application. Where the previous patent application is pending, it shall be considered withdrawn.

(6) If priority is claimed, priority may be established for a patent application according to the filing dates of several earlier filed patent applications or utility model registration applications.

(7) The applicant must claim priority in the patent application. The documents certifying the claim for priority shall be presented in the patent application or within four months from the filing date of the patent application.

[16.06.1998]

### **Chapter III** **Right to Apply for Patent**

#### *Right to Patent*

§ 12.—(1) The right to apply for a patent and to become a patentee shall belong to the author of the invention and to his successor in title.

(2) Where the invention has been made in the course of fulfilling a contractual or work assignment, the right to apply for a patent and to become a patentee shall belong to the author or to another person in pursuance with the contract or contract of employment.

#### *Author of Invention*

§ 13.—(1) The author of an invention (hereinafter *author*) shall be the natural person who, through his inventive activities, has made the invention.

(2) Where the invention has been made through combined inventive activities of several natural persons, they shall enjoy co-authorship.

(3) Upon co-authorship the authors shall enjoy all the rights conferred by authorship together, if they have not concluded an agreement in writing regulating otherwise.

(4) Where two or more persons apply for a patent for the same invention independently of each other and different natural persons have been designated as authors, that natural person shall be considered as the author who has been designated as the author in an earlier filed patent application or in a patent application with an earlier priority date, if the said application has not withdrawn or if it has not been rejected by the Patent Office.

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(5) Upon patent applications for the same invention with the same filing date, or upon patent applications with the same priority date, all natural persons indicated as authors in the said patent applications shall be considered as authors upon granting the patent.

(6) Authorship is inalienable and unspecified in term.

(7) The author has the right to the name of the author and he may:

1. demand the disclosure of his name as the author;
2. prohibit the disclosure of his name as the author;
3. cancel the prohibition of the disclosure of his name at any moment.

(8) The author shall be entitled to a fair income from the income received from the invention.

(9) The author's economic rights are alienable and inheritable.

## **Chapter IV** **Exclusive Right of Patentee**

### *Patentee*

**§ 14.**—(1) Patentee shall be the person enjoying full legal control (exclusive right) over the patent. The patentee shall have the right to possess, use and dispose the patent as well as to demand that all other persons avoid the infringement of those rights and eliminate the results of the infringement.

(2) The person shall be considered as a patentee whose name has last been entered into the State Register of Patents as the patentee.

(3) The exclusive right of a patentee may be limited solely by this Act or by the rights of other persons.

### *Exclusive Right of Patentee*

**§ 15.**—(1) The exclusive right of the patentee means that during the term of the patent a third party shall not be allowed, without the consent of the patentee, to:

1. possess, use or dispose the patent;
2. make, use, distribute, sell or offer for sale patented products, or to obtain (including the import) those products for the aforesaid purposes;
3. make, sell or offer for sale essential components of a patented product or to obtain and to export them with the purpose of making or assembling the product, except where components are other staple products;
4. use a patented process or to offer it to a third party;
5. use, distribute, sell or offer for sale a product made according to a patented process, or to obtain (including the import) those products for the aforesaid purposes.

(2) If the process of making a product has been patented, the making, use, distribution, selling, offering for sale or obtaining of a similar product for the aforesaid purposes without

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the consent of the patentee shall be deemed to be the infringement of the exclusive right of the patentee, unless it is proved that the similar product has been made according to a different process.

[16.06.1998]

### *Proceedings Non-Infringing Exclusive Right of Patentee*

**§ 16.** The following proceedings shall not be considered as infringement of the exclusive right of a patentee:

1. the use of a patented invention on board (in the body, machinery, tackle, gear and in other accessories) of vessels of other states if those vessels sojourn in the territorial waters of the Republic of Estonia temporarily or accidentally, provided that the invention is used exclusively for the needs of the vessel;

2. the use of a patented invention in the construction of aircraft and land vehicles of other states or in their additional devices, or in operating the vehicles and the devices, if those vehicles sojourn in the Republic of Estonia temporarily or accidentally;

3. the use of a patented invention in experiments concerning the invention itself;

4. the extemporaneous preparation for individual cases in a pharmacy of a medicine containing a patented invention in accordance with a medical prescription, and its use;

5. the private and non-commercial use of a patented invention provided that it does not infringe the interests of a patentee;

6. the use, distribution, selling or offering for sale of a patented invention by the patentee or with his consent.

### *Right of Prior Use*

**§ 17.—**(1) Any person who, before the filing of a patent application for the same invention by another person, industrially used the invention in the Republic of Estonia in good faith independently of the applicant, may continue to use the invention, retaining the general character of the use. The use shall be considered as done in good faith unless the user knew or should have known that a patent application was intended to be filed for the invention.

(2) The right of prior use shall also belong to any person having in good faith made significant arrangements for the industrial use of the invention in the Republic of Estonia.

(3) The right of prior use can only be transferred to another person together with the enterprise where the right of prior use has emerged or where it was intended to be used.

### *Provisional Protection*

**§ 18.—**(1) The invention shall be given provisional protection from the filing date of the application until the date of publication of an announcement about the grant of the patent.

(2) Any person starting or continuing to use the invention after the application has been published pursuant to § 24 of this Act, shall be deemed, upon the publication of an announcement about the grant of the patent, to be an infringer of the patentee's exclusive right if he does not enjoy the right of prior use pursuant to § 17 of this Act.

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(3) Any person who started to use the invention during the period between the filing date of the application and the publication date of the application shall not be deemed to be an infringer of the patentee's exclusive right unless he knew or should have known that an application for the invention had been filed, and unless the applicant sent him a notification in writing about the filing of the application before the publication of the said application by the Patent Office. A person whom the applicant has notified of filing an application shall be deemed, after the date of publication of an announcement about the grant of the patent, to be an infringer of the patentee's exclusive right from the date of receiving the notification about the filing of an application if he does not enjoy the right of prior use pursuant to § 17 of this Act.

(4) The extent of provisional protection shall be established by the contents of the patent claims contained in the published application. After the grant of the patent the extent of provisional protection shall be adjusted to the patent claims of the granted patent.

## **Chapter V** **Patent Application and its Examination**

### *Patent Application*

**§ 19.—**(1) The patent application shall contain the following documents:

1. the request for the grant of a patent, containing information about the applicant and the author, and the title of the invention;
2. the description of the invention disclosing the subject matter of the invention in a manner sufficiently clear and complete that it may be carried out by a person skilled in the art;
3. the patent claims containing one or more claims;
4. the drawings or other illustrative materials referred to in the description;
5. the document certifying the deposit of a microorganism if the subject of the invention is a microorganism or if the invention presumes the use of a new microorganism;
6. the abstract of the subject matter of the invention;
7. the document certifying the payment of the state fee;
8. the authorisation if the patent application is filed through an Estonian patent attorney.

(2) Formal and substantive requirements for the documents contained in the patent application shall be established by the Government of the Republic or by a Minister on the authorisation of the Government of the Republic.

(3) The patent application shall be filed in the Estonian language, except the abstract of the subject matter of the invention that shall be filed in the Estonian and the English languages.

[16.06.1998]

### *Filing of Patent Application*

**§ 20.—**(1) The patent application shall be filed with the Patent Office.

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(2) The applicant may independently file a patent application and arrange matters connected with the applying for and maintaining of a patent, or it may be done through an Estonian patent attorney residing in and citizen of the Republic of Estonia (hereinafter *patent attorney*). The authority of the patent attorney shall be established in the authorisation granted by the applicant.

(3) Persons residing or located outside the Republic of Estonia shall arrange matters connected with the applying for and maintaining of a patent in the Republic of Estonia only through patent attorneys, except filing a patent application. The applicant shall authorise the patent attorney upon filing the patent application or within three months from the date of receipt of the patent application at the Patent Office.

(4) The state fee shall be paid upon filing the patent application or within one month from the date of receipt of the application at the Patent Office.

(5) Upon more than 10 patent claims, a supplementary state fee shall be paid for every additional claim commencing with the eleventh.

(6) The procedure for filing patent application is established by the Government of the Republic or by a Minister on the authorisation of the Government of the Republic.

[16.06.1998]

### *Examination on Filing*

§ 21.—(1) After the receipt of the patent application, the Patent Office shall examine the existence of documents prescribed by § 19 of this Act.

(2) The Patent Office shall refuse to proceed with the examination on filing and return the patent application in the following cases:

1. the request for the grant of a patent is missing, or it does not designate the applicant, or the request for the grant of a patent is not filed in the Estonian language;

2. the description is missing;

3. the description is not in the Estonian language and the translation of the description into the Estonian language is missing, and it is not filed within three months from the date of receipt of the patent application at the Patent Office;

4. the drawing or other illustrative material referred to in the description is missing and it is not filed within three months from the date of receipt of the application at the Patent Office;

5. the document certifying the payment of the state fee is missing and it is not filed within one month from the date of receipt of the patent application at the Patent Office;

6. the requirements prescribed by subsection 20(3) of this Act are not satisfied.

(3) Upon returning the patent application the state fee shall be refunded.

(4) The Patent Office shall accord a number to a patent application accepted for processing and notify the applicant in writing of the filing date and the number of the patent application.

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*Files of Patent Applications, Access to and Release of Information Therefrom*

§ 21<sup>1</sup>.—(1) The files of patent applications is a structured body of data concerning patent application documents accepted for processing and information on the examination thereof. Information on a patent application and on the examination thereof is stored in the files until the patent application dossier is closed.

(2) Access to the files and release of information from the files of patent applications is generally prohibited. It is permitted to release only the following information: the title of the invention, the index of the International Patent Classification, the number of the patent application, the filing date of the patent application, the priority data, the name and address of the applicant and the name of the representative of the applicant.

(3) Access to a patent application dossier shall be granted to the applicant, or to the person having the written consent of the applicant or notified by the applicant in writing of the filing of the patent application and of the applicant's right to apply for the patent and to become the patentee, to the competent officials of state agencies which have supervisory authority and the courts.

(4) After the publication of the patent application, anyone may have access to the patent application dossier.

(5) No information on the author is released if the author has prohibited the disclosure of his name.

(6) Information from the files of patent applications is released upon payment with the exception of release of information to state agencies which have supervisory authority or to a court. A state fee shall be paid for the release of information.

(7) The files of patent applications shall be established by the Government of the Republic or by a Minister on the authorisation of the Government of the Republic.

[16.06.1998]

*Examination as to Formal Requirements of Patent Application*

§ 22.—(1) The Patent Office shall examine:

1. the form and substance of the application documents;
2. the subject of the invention;
3. the unity of the invention.

(2) If priority is claimed, the Patent Office shall examine the corresponding documents certifying it.

(3) Upon deficiencies regarding the form and substance of application documents or other factors preventing the examination of the patent application, the Patent Office shall notify the applicant of this in writing and shall prescribe a term for removing the deficiencies or for providing explanations.

(4) The Patent Office shall determine a priority date for the patent application.

(5) The Patent Office shall commence the substantive examination provided that the patent application meets the provisions of §§ 6, 7, 9 and 19 of this Act.

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(6) Where the subject of the invention does not comply with the provisions of §§ 6 or 7 of this Act, or where the applicant fails to remove the deficiencies regarding the form and substance of application documents or to provide explanations, the Patent Office shall make a decision on rejecting the application. The Patent Office shall notify the applicant in writing of the decision on rejecting the patent application.

### *Substantive Examination*

§ 23.—(1) In the course of the substantive examination the Patent Office shall examine the compliance of the invention with the conditions for patentability in pursuance with § 8 of this Act.

(2) The applicant may, pursuant to Article 15 (5) of the Patent Cooperation Treaty concluded at Washington on June 19, 1970 (RT II 1994, 6/7, 21), file a request for international-type search. Upon filing the request the applicant shall pay the state fee and the payment for international-type search.

(3) The Patent Office may demand that the applicant provide oral or written explanations and correct or supplement the claims, the description, the drawing or other illustrative material and the abstract of the subject matter of the invention. The Patent Office shall prescribe a term of two to six months for providing explanations or presenting corrections and supplementations.

(4) The Patent Office shall be entitled to demand that the applicant furnish copies of decisions made by foreign patent offices regarding his corresponding applications, it shall also be entitled to exchange information regarding the patent application with patent offices of other states.

(5) After completing the substantive examination of the patent application, the Patent Office shall make a decision on granting a patent or it shall refuse to grant a patent, making a decision on rejecting the patent application, and it shall notify the applicant of this in writing.

### *Publication of Patent Application*

§ 24.—(1) The publication of a patent application within the meaning of this Act is the publication of the documents of the patent application referred to in clauses 2, 3, 4 and 6 of subsection 19(1) of this Act.

(2) The Patent Office shall publish the patent application after the lapse of 18 months from the filing date of the patent application or, if priority is claimed, from the priority date.

(3) Upon request from the applicant, the patent application shall be published prior to the end of the term referred to in subsection 2 of this Section.

(4) The application shall not be published in the following cases:

1. the application has been withdrawn or is deemed to be withdrawn;
2. the application has been rejected;
3. the examination procedure of the application has been suspended.

(5) The applicant shall be notified in writing of the publication of the application.

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(6) The Patent Office shall publish an announcement of the publication of the patent application in its Official Gazette.

(7) The date of publication of the announcement referred to in subsection 6 of this Section shall be considered to be the date of publication of the application.

(8) The procedure for publishing patent applications shall be established by the Government of the Republic or by a Minister on the authorisation of the Government of the Republic.

[16.06.1998]

### *Corrections and Supplementations to Patent Application*

**§ 25.**—(1) The applicant may correct and supplement the patent application in the course of the examination procedure, without changing the subject matter of the invention as disclosed in the patent application at the filing date of the application.

(2) Corrections and supplementations change the subject matter of the invention if they contain features of the invention missing in the description, in the drawing or in other illustrative material at the filing date of the patent application.

(3) Where the corrections and supplementations change the subject matter of the invention, the Patent Office shall make a decision on rejecting them, notifying the applicant of this in writing.

(4) After the publication of the patent application pursuant to § 24 of this Act the applicant cannot make corrections and supplementations broadening the extent of patent protection.

(5) Where the Patent Office makes a decision pursuant to subsection 23(5), the applicant may correct and supplement the application within two months from the date of the said decision, paying the state fee. The state fee shall not be paid when the corrections involve obvious mathematical or clerical errors. The Patent Office shall be entitled to make a new decision on the grounds of the corrections and supplementations.

(6) In the course of the examination procedure the Patent Office may solely make editorial corrections in the application documents without consulting with the applicant. The abstract of the subject matter of invention may be changed without consulting with the applicant.

### *Withdrawal of Patent Application*

**§ 26.**—(1) The applicant may file a request for withdrawal of a patent application and withdraw a patent application under examination. Application documents shall not be returned.

(2) Where several persons apply for a patent, the request for withdrawal of the patent application may be filed with the consent of all those persons.

(3) The Patent Office shall consider the application withdrawn in the following cases:

1. the applicant has failed, during the examination of formalities, to respond to the invitation of the Patent Office regarding the providing of explanations or correcting or

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supplementing application documents within three months from the prescribed term pursuant to subsection 22(3) of this Act.

2. the applicant has failed, during the substantive examination, to respond to the invitation of the Patent Office regarding the providing of explanations or correcting or supplementing application documents within three months from the prescribed term pursuant to subsection 23(3) of this Act;

3. the applicant has failed to pay the prescribed state fee by the prescribed term;

4. in cases provided for in subsection 11(5) of this Act.

#### *Suspension of Examination Procedure*

§ 27.—(1) Where the applicant fails to respond by the prescribed term during the examination pursuant to subsection 22(2) of this Act, the Patent Office shall suspend the examination procedure. The examination procedure shall be resumed if the applicant, within three months from the said term, provides the response and pays the state fee.

(2) If there is a lack of unity of invention in the application, the Patent Office shall suspend the examination procedure until the term prescribed for the applicant for filing independent patent applications pursuant to subsection 9(2) of this Act.

(3) Where the applicant has filed, pursuant to subsection 23(2) of this Act, a request for international-type search, the Patent Office may suspend the examination procedure until the receipt of the said search report at the Patent Office.

(4) The applicant shall be notified in writing of the suspension of examination procedure.

#### *Termination of Examination Procedure*

§ 28.—(1) The Patent Office shall terminate the examination procedure of an application being withdrawn or deemed to be withdrawn.

(2) The applicant shall be notified in writing of the termination of examination procedure.

#### *Resuming of Examination Procedure*

§ 29.—(1) The applicant may require the resuming of the examination procedure where the Patent Office has terminated the examination procedure, deeming the application to be withdrawn pursuant to clauses 1 or 2 of subsection 26(3) of this Act, provided that the transactions cited in the said provisions failed due to force majeure or other impediment irrespective of the applicant and the patent attorney representing him.

(2) The Patent Office shall resume the examination procedure provided that the applicant proves the existence of the impediment and performs the prescribed transactions within two months after the removal of the impediment, paying the state fee.

(3) The request for resuming examination procedure may be submitted within one year from the term of the failed transaction.

(4) The provisions of subsections 1, 2 and 3 of this Section shall not extend to cover § 42 of this Act.

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### *Appealing against Decisions of Patent Office During Examination Procedure*

**§ 30.**—(1) The applicant may appeal against the decision of the Patent Office at the Industrial Property Board of Appeal (hereinafter *Board of Appeal*) formed on the basis of the Republic of Estonia Trademarks Act (RT 1992, 35, 459; RT I 1998, 15, 231), or in court.

(2) The applicant may file an appeal with the Board of Appeal within two months from the date of making the decision, paying the state fee.

(3) The Board of Appeal shall be entitled to:

1. dismiss the appeal and retain the decision of the Patent Office unchanged;
2. change or revoke the decision of the Patent Office and make a new decision;
3. revoke the decision of the Patent Office and enjoin the Patent Office to continue the examination procedure.

(4) Upon the granting of the appeal the state fee shall be refunded.

(5) Upon partial granting of the appeal the Board of Appeal shall prescribe the amount of the state fee to be refunded.

[16.06.1998]

### *Cessation of Examination Procedure*

**§ 31.** The examination procedure shall cease with granting a patent or with rejecting the patent application.

[16.06.1998]

## **Chapter VI International Application**

### *Definition of International Application*

**§ 32.**—(1) International application means a patent application filed under the Patent Cooperation Treaty done at Washington on June 19, 1970 (RT II 1994, 6/7, 21) (hereinafter *Patent Cooperation Treaty*).

2.—(2) The Patent Office shall act as a receiving office, a designated office and an elected office as defined in Article 2 of the Patent Cooperation Treaty.

(3) The Patent Office shall act as a receiving office for the international applications of citizens or residents of the Republic of Estonia.

(4) An international application shall be drawn up pursuant to the Patent Cooperation Treaty and its Implementing Regulations and Administrative Instructions, and it shall be filed with the Patent Office as the receiving office in the English or German language, paying the state fee and the payments prescribed by the Patent Cooperation Treaty.

(5) The Patent Office shall act as a designated office or an elected office for those international applications in which the Republic of Estonia has been designated or elected.

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(6) An international application in which the Republic of Estonia is designated shall be deemed to be equivalent to patent applications filed pursuant to §§ 19 and 20 of this Act.

(7) An international application in which the Republic of Estonia is designated shall be deemed to have been filed with the Patent Office at the international filing date accorded by the receiving office under the Patent Cooperation Treaty.

(8) The Patent Office shall carry out examination of those international patent applications in which the Republic of Estonia has been designated.

(9) The procedure for payments prescribed by the Patent Cooperation Treaty shall be established by the Government of the Republic or by a Minister on the authorisation of the Government of the Republic.

(10) The procedure for filing international applications with the Patent Office shall be established by the Government of the Republic or by a Minister on the authorisation of the Government of the Republic.

[16.06.1998]

### *Specifications of International Application Processing*

**§ 33.**—(1) For commencing the examination of an international application, the applicant shall, within 20 months from the priority date, file with the Patent Office a translation of the international application into the Estonian language and pay the state fee.

(2) Where the applicant has, within 19 months from the priority date, elected the Republic of Estonia to use the report of international preliminary examination, he shall, within 30 months from the priority date, file the translation referred to in subsection 1 of this Section and pay the state fee.

(3) In justified cases the applicant may be given an extension of two months for filing a translation of an international application referred to in subsection 1 of this Section, provided that upon the filing of the translation he pays a supplementary state fee.

(4) The applicant may, within 6 months from the date of filing the translation of an international application, supplement and correct the claims, description, drawing and other illustrative material, provided that the supplementations and corrections do not change the subject matter of the invention as disclosed in the international application on its filing date.

(5) Where the applicant should be represented by a patent attorney pursuant to subsection 20(3) of this Act, the applicant must authorise the attorney before the expiration of 6 months from the term provided for in subsection 1 or 2 of this Section.

(6) An international application shall lose its effect provided for in subsection 32(6) and (7) of this Act in the following cases:

1. the provisions of clauses i and ii of Article 24(1) of the Patent Cooperation Treaty are applied;

2. the applicant has failed to comply with the provisions of subsection 1, 2 or 3 of this Section;

3. the applicant withdraws the request for international preliminary examination or the demand for electing the Republic of Estonia after the expiration of the term provided for in subsection 1 of this Section;

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4. the applicant has failed to comply with the requirements of subsection 5 of this Section.

(7) Where the applicant has elected the Republic of Estonia to use the international preliminary examination report, the Patent Office shall not be entitled to request that the applicant furnish examination decisions of patent offices of states designated in the international application.

(8) Where part of the international application has not been subject to international preliminary examination or international search for the reason of lack of the unity of invention in the said application, and the applicant has failed to pay the state fee prescribed by the Patent Cooperation Treaty for additional international search or preliminary examination, the Patent Office shall examine the legitimacy of the decision of the International Searching Authority or the International Preliminary Examination Authority on excluding a part of the international application from the international search or international preliminary examination. If the decision proves correct, the parts infringing the unity of invention shall be deemed to be withdrawn from the international application. In the opposite case the Patent Office shall proceed with the examination of the international patent application in full extent. The Patent Office shall notify the applicant of its decision in writing.

(9) The Patent Office shall apply the provisions of subsection 9(2) of this Act to the parts of the international application infringing the unity of invention if the applicant, within two months from the date of the decision of the Patent Office referred to in subsection 8 of this Section, submits a corresponding request.

(10) Where the receiving office has refused to recognise the international filing date or has declared that the international application is deemed to be withdrawn, or where the International Bureau of the World Intellectual Property Organization (hereinafter *International Bureau*) has made a decision under Article 12(3) of the Patent Cooperation Treaty, or where the receiving office has declared that the designation of the Republic of Estonia is deemed to be withdrawn, the applicant shall be entitled to, within two months from receiving the corresponding notification or decision, request the examination of the international application in the Republic of Estonia, and request that the International Bureau transmit a copy of the international application to the Patent Office. The applicant shall file with the Patent Office the translation of the international application and in prescribed cases information regarding the patent attorney and pay the prescribed state fee within the term prescribed by the Patent Office. The Patent Office shall examine the legitimacy of the decision of the receiving office or the International Bureau and notify the applicant of the findings. Where the decision of the receiving office or the International Bureau is not legitimate, the patent application shall be treated as an international application.

(11) Where the examination of an international application has been terminated for the reason of the applicant failing, due to force majeure or other impediment irrespective of him, to perform, by the prescribed term, any transactions prescribed by the receiving office, the International Searching Authority, the International Preliminary Examination Authority or the International Bureau, the Patent Office shall resume the examination of the international application in the Republic of Estonia, provided that the applicant complies with the provisions of subsection 29(2) and (3) of this Act.

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*Files Concerning International Applications,  
Access to and Release of Information Therefrom*

§ 33<sup>1</sup>.—(1) The files concerning international applications and examination of international applications is a structured body of data concerning international patent application documents filed with the Patent Office as a receiving office pursuant to Article 2 of the Patent Cooperation Treaty, and information on the examination thereof. Information on an international application and on the examination thereof is stored in the files until the international application examination is closed.

(2) Access to and release of information from the files concerning international applications and examination of international patent applications is prohibited until the publication of the international application pursuant to Article 21 of the Patent Cooperation Treaty.

(3) After the publication of an international application pursuant to Article 21 of the Patent Cooperation Treaty, anyone may have access to the international patent application examination dossier.

(4) Information from the files concerning international patent applications and examination of international patent applications is released upon payment with the exception of release of information to state agencies with supervisory authority or to a court. A state fee shall be paid for the release of information.

(5) The files concerning international applications and examination of international applications are established by the Government of the Republic or a Minister on the authorisation of the Government of the Republic. (16.06.1998)

**Chapter VII  
State Register of  
Patents and Grant Of Patent**

*State Register of Patents*

§ 34.—(1) The State Register of Patents (hereinafter *Register*) is maintained for inventions that have been deemed to meet the conditions for patentability.

(2) The Patent Office shall be the chief and authorised processor of the Register.

(3) The registry secretary shall arrange maintenance of the Register and make entries in the Register.

(4) The Register shall be maintained as an entry book on paper carrier. The Register may be maintained on computer and the entries stored as print-outs.

(5) The language of the Register is Estonian. Foreign language documents shall be submitted to the authorised processor together with an Estonian translation.

(6) The Register consists of the entry book, the patent application examination dossiers and the registry dossiers. The entry book consists of registry cards that are bound into the volumes of the entry book.

(7) The expenditure for maintenance of the Register shall be covered from the State Budget through the budget of the Patent Office.

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(8) The statutes for maintenance of the Register shall be approved by the Government of the Republic.

[16.06.1998]

### *Registration of Invention in Register*

**§ 35.**—(1) An invention shall be registered in the Register by entering the data of the registration of invention (hereinafter *registration*) in the entry book on the basis of the decision made by the Patent Office, the Board of Appeal or the court to grant a patent.

(2) The registration data are the following:

1. the number of the registration;
  2. the date of registration;
  3. the title of the invention;
  4. the index of the International Patent Classification;
  5. the given name and surname and address of the author of invention;
  6. the given name and surname, residential address or address of the seat of enterprise and zip code of the patentee; where the patentee is a legal person, the name, address and zip code of the seat of the patentee;
  7. the date of the beginning of the term of registration;
  8. the date of the end of the term of registration;
  9. where a patent attorney has been appointed, the given name and surname of the attorney;
  10. where the common representative is a natural person, the given name and surname of the natural person; where the common representative is a legal person, the name of the legal person;
  11. the number of the patent application;
  12. the filing date of the patent application;
  13. priority data (priority date, state, number of application);
  14. the number and filing date of an earlier patent application from which the patent application has been divided up;
  15. the number and filing date of an earlier, continued patent application;
  16. the filing date of corrections and supplementations to the earlier patent application changing the subject of the invention;
  17. the data of the international application;
  18. the publication date of the patent application;
  19. the date of the disclosure of information referred to in subsection 8(3) of this Act;
  20. the data of the deposit of micro-organism;
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21. the data of the payment of the annual state fee paid for the maintaining of the patent application;

22. the patent claims;

23. the description of the invention;

24. the drawing or other illustrative material;

(3) The patent claim, the description of the invention and the drawing or other illustrative material shall be kept in the registry dossier.

(4) The applicant mentioned in the decision on granting a patent shall be entered in the Register as a patentee.

(5) The registrations are numbered in the order in which the inventions are registered, starting from number 02932 as a continuation of the Registry numeration which was discontinued in 1940.

(6) For registering the invention in the Register, the applicant shall pay the state fee within 3 months from the date of making the decision referred to in subsection 1 of this Section. Where the state fee has not been paid within the specified term, the patent application shall be deemed to be withdrawn.

(7) The registration data shall be entered in the Register within 3 months from the date of paying the state fee specified in subsection 3 of this Section.

(8) The Patent Office shall publish in its Official Gazette an announcement about the grant of the patent. The date of the publication of the announcement about the grant of the patent shall be entered in the entry book.

(9) The registration shall become valid on the date of the publication of the announcement about the grant of the patent.

[16.06.1998]

#### *Access to and Release of Data from Register*

§ 35<sup>1</sup>.—(1) The Register shall be public. Everyone shall have the right to examine the patent application examination dossier, the registry dossier and the entry book and to obtain copies thereof.

(2) Where the author has prohibited the disclosure of his name, no information on the author shall be released from the Register.

(3) Written information from the Register shall be released upon payment with the exception of release of information to state agencies with supervisory authority or to a court. A state fee shall be paid for the release of information.

[16.06.1998]

#### *Maintenance and Storage of Register*

§ 35<sup>2</sup>.—(1) The Register shall be maintained in the offices of the Patent Office, the removal of the Register from the offices shall be prohibited.

(2) The Register shall be permanently stored in the Patent Office archives.

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[16.06.1998]

### *Liability of Chief Processor*

§ 35<sup>3</sup>.—3.—Damage arising from the unlawful actions of the chief processor shall be compensated for by the State.

[16.06.1998]

### *Patent Specification*

§ 35<sup>4</sup>.—(1) The patent specification shall contain the description of the invention, the patent claims, the drawing and other illustrative materials, the abstract of the subject matter of the invention and the following information:

1. the name of the agency having issued the patent specification;
  2. the title and number of the document;
  3. the title of the invention;
  4. the index of the International Patent Classification;
  5. the given name and surname and address of the author of invention;
  6. the given name and surname, residential address or address of the seat of enterprise and zip code of the patentee; where the patentee is a legal person, the name, address and zip code of the seat of the patentee;
  7. where the patent attorney has been appointed, the given name and surname and address of the attorney;
  8. where the common representative is a natural person, the given name and surname of the natural person; where the common representative is a legal person, the name of the legal person;
  9. the number and filing date of the patent application;
  10. the priority data;
  11. the data of the international application;
  12. the data of the deposit of microorganism;
  13. the date of the publication of the patent application;
  14. the date of the publication of the patent specification;
  15. the date of the beginning of the term of the patent.
- (2) After entering the registration data in the Register, the Patent Office shall compile the patent specification.
- (3) The patent specification shall be kept in the registry dossier.
- (4) The patent specification shall be published on the date of the publication of the announcement about the grant of the patent.
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(5) The formal requirements and procedure for compilation of the patent specification shall be established by the Government of the Republic or by a Minister on the authorisation of the Government of the Republic.

[16.06.1998]

### *Letters Patent*

**§ 36.**—(1) The letters patent is a document certifying the registration and the exclusive right of the patentee to the invention.

(2) The letters patent shall consist of the certificate and the patent specification.

(3) The certificate shall contain:

1. the name of the state—the Republic of Estonia;
2. the coat of arms of the state—the small coat of arms of the Republic of Estonia;
3. the number of the patent document;
4. the text “The patent has been issued under § 5 of the Patent Act that entered into force on 23 May 1994. The patent is valid for 20 years from the filing date of the patent application. For maintaining the patent, a state fee shall be paid for each year of validity. The letters patent certifies the registration and the exclusive right of the patentee to the invention disclosed in the patent specification.”;

5. the data of the agency having issued the letters patent (the name and seat of the agency, the title, name and signature of the head of the agency, the seal of the agency);

6. the date of signing the letters patent.

(4) The date of issue of the letters patent shall be the date when the head of the agency having issued the letters patent signs it. The date of issue of the letters patent shall be entered in the entry book.

(5) The number of the letters patent shall be the number of the registration.

(6) The Patent Office shall issue the letters patent to the patentee within one month from the date of the publication of the announcement about the grant of the patent.

(7) Only one letters patent shall be issued regardless of the number of patentees.

(8) On a request from the patentee a duplicate may be issued for him. The duplicate shall be issued within one month from the receipt at the Patent Office of the request and of the document certifying the payment of the state fee. An announcement about the issue of the duplicate shall be published in the Official Gazette of the Patent Office.

(9) The formal requirements and the order of compilation and issue of the letters patent shall be established by the Government of the Republic or by a Minister on the authorisation of the Government of the Republic.

[16.06.1998]

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## **Chapter VIII** **Validity of Patent**

### *Term of Patent*

§ 37.—(1) The term of the patent shall be 20 years from the filing date of the patent application.

(2) For maintaining the patent application and the patent, a state fee shall be paid for each year of validity. The filing date of the patent application shall be deemed to be the beginning of the year of validity.

### *Premature Lapse of Patent*

§ 38.—(1) A patent shall lapse prematurely in the following cases:

1. upon failure in paying the annual state fee;
2. upon a corresponding request from the patentee for the invalidation of the patent;
3. upon liquidation or termination of a legal person being the patentee where the patent rights have not transferred.

(2) The Patent Office shall enter the premature lapse of the patent in the Register and publish a corresponding announcement in its Official Gazette.

### *Amendments to Patent*

§ 39.—(1) The patentee shall be entitled, during the whole term of the patent, to request the amending of the patent. The request for amendments shall be submitted to the Patent Office, paying the state fee.

(2) The patentee shall be entitled to request amendments that do not change the subject matter of invention as disclosed in the patent application at the filing date of the application.

(3) The amendments shall have a retroactive effect.

(4) The Patent Office shall publish in its Official Gazette an announcement about the amendments to the patent.

(5) The patentee shall not be entitled to request amendments to the patent claims which broaden the extent of patent protection, except in cases provided for in subsection 6 of this Section.

(6) For correction of obvious mathematical and clerical errors broadening the extent of patent protection, the patentee shall be entitled, within two years from the publication of the announcement about the grant of the patent, to submit to the Patent Office a corresponding request.

(7) The broadening of the extent of patent protection, provided for in subsection 6 of this Section, shall not restrict the rights of persons who, before the publication by the Patent Office of the announcement about the amendments, had taken into account the original extent of patent protection in their economic and business transactions.

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## Chapter IX State Fee

### *State Fee*

**§ 40.** In cases prescribed by this Act, state fees shall be levied for effecting transactions, issuing documents and maintaining a patent application and a patent pursuant to the provisions of the State Fees Act (RT I 1997, 80, 1344; 86, 1461; 87, 1466 and 1467; 93, 1563; 1998, 2, 47; 4, 63; 23, 321; 36/37, 552 and 553,; 52/53, 771; 57, 859; 59, 941; 60, 951; 61, 979 and 985; 64/65, 1004, 1005 and 1008).

[16.06.1998]

### *Payment of State Fees*

**§ 41.**—(1) State fees shall be paid by the applicant, the patentee or by any other person interested in effecting transactions prescribed by this Act or in the issue of documents or maintenance of a patent application or a patent. In case another person pays the state fee for applying for a patent, granting a patent or maintaining a patent, the consent of the applicant or the patentee shall be required.

(2) The state fee shall be deemed to be paid upon the receipt at the Patent Office, in case of an appeal at the Board of Appeal, of a document certifying the payment.

(3) The state fee shall not be refunded, except in cases provided for in subsections 21(3) and 30(4) and (5) of this Act.

### *Payment of Annual State Fees*

**§ 42.**—(1) Annual state fee shall be paid within 6 months before the due date. The due date is the last day of the calendar month when the corresponding year of validity began.

(2) The annual state fees for the first, the second and the third year of validity shall be paid simultaneously within 6 months before the due date of the annual state fee for the third year of validity.

(3) The annual state fee may be paid within 6 months after the expiry of the due date, paying a supplementary state fee.

(4) The Patent Office may give the applicant or the patentee, if he is also the author, an extension of time for paying the annual state fees for the first to the fifth year of validity. The petition for the extension should be submitted to the Patent Office before the corresponding due date. The decision of the Patent Office on the extension for paying the annual state fee is final.

(5) Where the Patent Office refuses to satisfy the petition for the extension and the due date has expired, the annual state fee can be paid, without paying a supplementary state fee, within two months from the date of the decision of the Patent Office.

[16.06.1998]

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## **Chapter X**

### **Transfer of Patent Rights**

#### *Transfer of Patent Rights to Successor in Title*

**§ 43.** Patent rights enjoyed by a patentee or by a person entitled to, pursuant to § 12 of this Act, apply for a patent, are transferred to the successor in title in the following cases:

1. upon death of a natural person by inheriting;
2. upon reorganisation or liquidation of a legal person on the basis of the decision of reorganisation or liquidation or on the basis of a corresponding contract.

#### *Assignment of Patent Application*

**§ 44.—**(1) Any person being, pursuant to § 12 of this Act, entitled to apply for a patent, may assign the said right to another person by a contract in writing.

(2) Upon assigning a patent application pending in the Patent Office, the applicant shall present to the Patent Office a statement certified by a notary in respect of the assignment of the patent application, paying the state fee.

#### *Assignment of Patent*

**§ 45.—**(1) Assignment of a patent may be effected upon the abandonment of patent rights by a patentee and upon the assignment of a patent to another person (expropriation of patent):

1. where economic and commercial activities are transferred to another person;
2. upon giving the patent to entrepreneurship as the capital;
3. for other reasons not contradicting the law.

(2) Upon assignment of a patent in cases provided by subsection 1 of this Section, the patentee shall submit to the Patent Office a statement certified by a notary in respect of the assignment of the patent, paying the state fee.

(3) The patentee may compulsorily be deprived of the patent and the patent may be assigned to another person in the following cases:

1. pursuant to subsection 49(1) of this Act by order of court where the provisions of § 12 of this Act are infringed;
2. upon bankruptcy of the enterprise, if the patent is considered to belong to the bankrupt assets pursuant to the Bankruptcy Act (RT 1992, 31, 403; RT I 1997, 18, 302; 1998, 2, 46; 36/37, 552);
3. with a lien upon the patent, where the creditor demands the pawner to release the pawned patent with the aim of selling it.

(4) Upon assignment of a patent in cases referred to in subsection 3 of this Section, the new patentee shall submit to the Patent Office a transcript of the court order or other document proving the assignment of a patent, paying the state fee.

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(5) The patent shall be deemed to be assigned from the date of entering the assignment in the Register. The assignment shall be entered in the Register on the date of the receipt at the Patent Office of a document certifying the payment of the state fee.

[16.06.1998]

### *Licence*

§ 46.—(1) Patentee (licensor) may transfer, in whole or in part, the right to use or dispose a patented invention to another person (licensee) by a licence.

(2) Upon granting a licence, a licence agreement shall be concluded in writing which shall be entered in the Register by the Patent Office. An entry shall be made in the Register upon the receipt at the Patent Office of a document certifying the payment of the state fee. An unregistered licence agreement is invalid.

### *Compulsory Licence*

§ 47.—(1) Each person interested in using a patented invention and able to use it in the Republic of Estonia may, upon refusal from the patentee to grant a licence, bring action for obtaining a compulsory licence, if:

1. the patentee has not used the invention in the Republic of Estonia within three years from publishing an announcement about the grant of the patent or within four years from filing the patent application, whereby the later date is taken into account;

2. the extent of the use of the invention by the patentee does not comply with the needs of Estonian domestic market;

3. the patent hinders the use of another invention which is technologically progressive and essential for Estonian economy;

4. the use of the invention is required by state defence, environment protection, public health or other important state interests of the Republic of Estonia, including an urgent necessity to use the invention in connection with nature catastrophes or other emergencies;

(1<sup>1</sup>) A compulsory licence shall not be granted where the patentee imports, from any member state of the World Trade Organisation, a product protected by a patent in the extent meeting the needs of Estonian domestic market.

(2) In cases provided for in clause 3 of subsection 1 of this Section, the patentee shall be entitled to obtain a compulsory licence for another invention if no agreement is reached about exchanging licences (reciprocal licence).

(3) Upon granting a compulsory licence, the court shall prescribe the terms of the compulsory licence, including the extent and duration of the use of the invention as well as the amount and payment procedure of the licence fee. The extent and duration of the use of the invention are determined on the basis of the needs of Estonian domestic market.

(4) The right to use the invention under the compulsory licence may be transferred to another person solely with the enterprise using the compulsory licence or planning to use it pursuant to the terms of the compulsory licence.

(5) The grant of a compulsory licence shall not prevent the patentee from using the invention or from granting licences to other persons.

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(6) A compulsory licence shall become effective from the date of entering it in the Register. The entry in the Register shall be made on the date of receipt at the Patent Office of a document certifying the payment of the state fee.

(7) Upon a change in the circumstances both the licensor and the licensee may file an action in court for changing the terms of the compulsory licence.

[16.06.1998]

## **Chapter XI** **Contestation and Protection of Patent Rights**

### *Contestation of Authorship*

**§ 48.**—(1) Disputes concerning authorship shall be resolved in court after the grant of the patent.

(2) Any natural person who considers his rights provided for in subsection 12(1) or (2) of this Act to have been infringed, or his successor in title, may file an action in court against the patentee for certification of the right of authorship.

(3) Authorship may be contested during the term of the patent.

### *Contestation of Patentee*

**§ 49.**—(1) Any person who proves that the right to the patent belongs to him may, within one year from the date of the publication of the announcement about the grant of the patent, or upon the transfer of patent rights from the date it becomes evident, file an action in court against the patentee for deprivation of the patent.

(2) Where an action filed pursuant to subsection 1 of this Section is granted, the respondent, who has used the invention or made notable arrangements for using it, may apply for the use of the invention for a payment or free of charge after the deprivation of the patent, provided that the nature of the use is retained.

### *Contestation of Patent*

**§ 50.**—(1) Any person may, within nine months from the date of publication of the announcement about the grant of the patent, file with the Board of Appeal an appeal in writing regarding the legitimacy of the grant of the patent, paying the state fee, or he may file an action in court.

(2) The appeal may be based on the following statements:

1. the provisions of §§ 6, 7 or 8 of this Act have been infringed when granting the patent;

2. the description does not disclose the subject matter of the invention completely and clearly enough to be carried out by a person skilled in the art;

3. the invention protected by a patent, including the invention divided from the initial patent application pursuant to subsection 9(2) of this Act, does not correspond to the subject matter of the invention disclosed in the initial patent application.

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(3) The Board of Appeal shall examine the appeal and make a decision on the invalidation of the patent in whole or in part, or on amending the patent, or it shall dismiss the appeal.

(4) Upon disagreement with the decision of the Board of Appeal, the appellant or the patentee may contest it, filing an action in court within three months from the date of the decision of the Board of Appeal.

(5) The Patent Office shall make an entry in the Register based on the decision of the Board of Appeal or the court, and publish in its Official Gazette an announcement about the invalidation or amending of the patent.

#### *Protection of Rights of Author*

§ 51.—(1) The author of an invention may, without expiration, file an action in court where the rights provided for in subsection 13(7) of this Act are infringed, and for settling non-proprietary disputes arising from authorship.

(2) For settling proprietary disputes arising from the use of the invention the author may file an action in court within three years from the day when he became or should have become aware of the infringement of his rights.

#### *Protection of Rights of Applicant*

§ 52.—(1) The applicant may, in compliance with § 30 of this Act, file with the Board of Appeal an appeal against the decision of the Patent Office or he may file an action in court within two months from the date of the decision.

(2) Upon disagreement with the decision of the Board of Appeal the applicant may appeal against it, filing an action in court within three months from the day of making the decision.

(3) The applicant may also file an action in court upon infringement of exclusive right that was commenced during provisional protection and demand termination of the infringement.

#### *Protection of Rights of Patentee*

§ 53.—(1) The patentee may file an action in court:

1. for disposal of the infringement of exclusive right, for preventing its repetition and for restoring the status quo before the infringement commenced;
2. for compensation for damages caused by the infringement of exclusive right;
3. for cancellation of compulsory licence or for changing its terms;
4. for resolving disputes arising from the licence agreement;
5. for appealing against the decisions of the Patent Office and the Board of Appeal.

(2) Any person having, through his culpable conduct, infringed the patentee's exclusive right, shall bear administrative or criminal liability in the cases provided by law.

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(3) Any person having, through his culpable conduct, infringed the patentee's exclusive right and caused him property damage, shall be obliged to compensate for the damage. Upon use of the invention in good faith the court may adjudicate a compensation for damage caused within no more than five years prior to the action.

(4) The patentee shall be entitled to file an action in court within three years from the time when he became aware of the person who had infringed the exclusive right.

(5) Where the infringement of the exclusive right was commenced during provisional protection, the action must be filed in court by the term prescribed in subsection 4 of this Section, or within one year from the publication of the announcement about the grant of the patent, whereby the later date is taken into consideration.

#### *Protection of Rights of Other Persons*

**§ 54.**—(1) Any person who, before the filing of the patent application, used the invention in good faith, may file an action in court against the patentee for certification of the right of prior use.

(2) Any person interested in using the patented invention may, in cases prescribed by subsection 47(1) of this Act, file an action in court against the patentee for obtaining compulsory licence.

(3) Any person using the invention under licence agreement (licensee) may file an action in court for resolving a dispute arising from the licence agreement.

(4) The licensee may also file an action in court upon the infringement of the patentee's exclusive right by other persons, provided that the licence agreement does not regulate otherwise. The licensee shall be obliged to previously notify the patentee of his wish to file an action. The obligation of notification shall be deemed to be fulfilled where the notification has been sent to the patentee in a registered letter at an address entered in the licence agreement or in the Patent Register.

(5) Any person may, upon doubt that his activities might infringe the patentee's exclusive right, file an action in court against the patentee for certifying that the existence of the patent does not hinder his economic or commercial activities.

#### *Procedure for Resolution of Patent Disputes*

**§ 55.**—4.—(1) In cases prescribed by the law patent disputes shall be resolved at the Board of Appeal and in court.

(2) Actions referred to in this Act fall within the jurisdiction of the court in the jurisdiction of which the Patent Office is located.

(3) The court shall resolve patent disputes pursuant to procedure prescribed by the Code of the Civil Procedure (RT I 1998, 43—45, 666), taking into account the specifications prescribed by this Act.

[25.11.1998]

(4) The court may refuse to proceed with the appeal if it includes solely an appeal to be resolved, as prescribed by this Act, by the Board of Appeal, and if the appeal has not been preliminarily examined by the Board of Appeal.

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(5) The Board of Appeal shall examine appeals filed with it on the grounds of this Act pursuant to procedure prescribed by the Statutes of the Board of Appeal.

#### *Burden of Proof*

§ 55<sup>1</sup>.—(1) Where an action has been filed in court under subsection 15(2) of this Act, the defendant shall be obliged to prove that for making a similar product he has used a process different from the patented process.

(2) Where the use of a different process is not proved, the product shall be deemed to have been made according to the patented process, provided that, despite of reasonable efforts, the patentee has not succeeded in specifying the process actually used for making this product and the use of the patented process is probable, or if the product made according to the patented process is new.

(3) Evidence submitted by the defendant and containing his manufacturing or business secrets may be disclosed solely with the consent of the defendant.

[16.06.1998]

#### *Court Proceedings upon Filing Action*

§ 56.—(1) In case of an action referred to in subsection 54(4) of this Act, the action should be accompanied by the copy of the notification sent to the patentee. Upon its absence the court shall reject the action and prescribe a term for the plaintiff to fulfil the obligation of notification.

(2) For the course of discussing an action for termination of the infringement of exclusive right, the court may, upon request from the plaintiff, order, for preventing continuous infringement, the product or object protected by a patent and made without the consent of the patentee, the use of which infringes the patentee's exclusive right, to be removed from circulation. Upon necessity the court may demand the plaintiff to give security for the damage of the defendant in case of nonsuit.

(3) In cases referred to in subsection 2 of this Section, the court may direct, upon request from the plaintiff, that the proprietor of the product or object may, during the remaining term of the patent or during part of it, continue using it for a fair compensation to the patentee.

#### *Attendance of Patent Office*

§ 57.—(1) Upon resolution in court of patent disputes the Patent Office may become a third party to the proceeding.

(2) A transcript of a court order passed with regard to patent disputes shall be sent by the court to the Patent Office for information also in cases where the Patent Office has not been party to the proceeding.

#### *Representative in Court upon Resolution of Patent Disputes*

§ 58.—(1) Upon resolving in court of patent disputes, patent attorneys shall be allowed to act in court as representatives.

[25.11.1998]

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(2) The authority of the patent attorney shall be certified by the certificate of the patent attorney and by the authorisation issued by the client.

(3) Where the plaintiff is a person residing in a foreign state, he shall be obliged to authorise as his representative a natural person residing in the Republic of Estonia for receiving notifications, invitations and documents from the court.

## **Chapter XII** **Patenting Inventions in Foreign States**

### *Procedure of Patenting Invention*

**§ 59.**—(1) Persons residing or located in the Republic of Estonia is entitled to patent his invention in foreign states independently of patenting it in the Republic of Estonia.

(2) Any resident of the Republic of Estonia shall patent his invention in foreign states independently pursuant to the laws of the foreign states and to international conventions.

### *Filing of International Patent Application*

**§ 60.** An international patent application shall be filed pursuant to subsection 32(3) and (4) of this Act.

## **Chapter XIII** **Implementation of the Act**

### *Entry into Force of the Act*

**§ 61.**—(1) The Patent Act shall enter into force on 23 May 1994.

(2) The provisions of clause 1 of subsection 11(2) of this Act shall apply after the restoration of the membership of the Republic of Estonia in the Paris Convention for the Protection of Industrial Property.

(3) The provisions of subsection 23(2) and Chapter VI of this Act shall apply after the expiry of three months from the acceding of the Republic of Estonia to the Patent Cooperation Treaty, concluded at Washington on 19 June 1970.

(4) Microorganisms shall be protected with patents after the acceding of the Republic of Estonia to the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, concluded in 1977 (RT II 1996, 14/15, 49).

(5) Upon filing a patent application within 6 months from the entry into force of this Act, each priority shall be recognised on the basis of the first patent application or utility model registration application that is not earlier than 20 August 1990 and is filed in a state member to the Paris Convention.

### *Invalidation of Prior Legal Acts*

**§ 62.** §§ 521 to 523 of Part V and §§ 524 to 530 of Part VI of the Civil Code of the Estonian SSR shall be repealed.

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