

Utility Models Act

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RT I 1994, 25, 407

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Amended by the following Acts:

Passing	Publication	Entry into force
26.06.1996	RT I 1996, 49, 953	26.07.1996
09.02.2000	RT I 2000, 19, 117	01.07.2000
Consolidated text in paper version of <i>Riigi Teataja</i>	RT I 2000, 60, 388	20.04.2001
21.02.2001	RT I 2001, 27, 151	20.04.2001
05.06.2002	RT I 2002, 53, 336	01.07.2002
19.06.2002	RT I 2002, 63, 387	01.09.2002
29.01.2003	RT I 2003, 18, 106	01.04.2003
17.12.2004	RT I 2003, 88, 594	08.01.2004
10.03.2004	RT I 2004, 20, 141	01.05.2004
15.06.2005	RT I 2005, 39, 308	01.01.2006
24.01.2007	RT I 2007, 13, 69	15.03.2007
10.12.2008	RT I 2008, 59, 330	01.01.2009
26.11.2009	RT I 2009, 62, 405	01.01.2010
22.04.2010	RT I 2010, 22, 108	1 January 2011, shall enter into force on the date specified in the decision of the Council of the European Union regarding the abrogation of the derogation established in respect of the Republic of Estonia on the basis of Article 140(2) of the Treaty on the Functioning of the European Union, Decision No. 2010/416/EU of the Council of the European Union of 13 July 2010 (OJ L 196, 28.07.2010, pp. 24-26).
09.11.2011	RT I, 29.11.2011, 1	01.01.2012
07.12.2011	RT I, 28.12.2011, 1	01.01.2012

Chapter 1

GENERAL PROVISIONS

§ 1. Purpose of Act

This Act provides for the legal protection of inventions as utility models.

§ 2. [Repealed]

§ 3. Equality of rights and obligations of persons of the Republic of Estonia and of foreign states

The rights and obligations prescribed by legal acts concerning the legal protection of inventions as utility models apply, taking account of the restrictions provided for in this Act, equally to persons of the Republic of Estonia and of foreign states (hereinafter *persons*).

§ 4. [Repealed]

Chapter 2

LEGAL PROTECTION AND PATENTABILITY OF UTILITY MODELS

§ 5. Legal protection of utility models

(1) Utility models are inventions which are new, which involve an inventive step and which are susceptible of industrial application.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) The following shall not be regarded as inventions:

- 1) industrial designs;
- 2) layout-designs of integrated circuits;
- 3) discoveries, scientific theories and mathematical methods;

- 4) schemes, rules and methods for performing mental acts or doing business;
- 5) design documentation for and plans of constructions, buildings or areas;
- 6) symbols;
- 7) algorithms for computers and computer programs;
- 8) presentations of information;
- 9) human bodies or parts thereof;
- 10) plant or animal varieties.

(3) An invention is granted legal protection upon registration in the register of utility models (hereinafter *register*).

(4) An invention which has obtained legal protection as a utility model shall be disclosed and the scope of the legal protection shall be determined by the substance of the claims of the utility model.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(5) Equipment, processes and materials can be protected as utility models. The scope of legal protection of a utility model is determined by the terms of the claims of the utility model.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 6. Inventions not protected as utility models

(1) The following shall not be protected as utility models:

- 1) inventions which are contrary to public order and morality;
- 2) methods of treatment and diagnostic methods practised on the human or animal body;
- 3) biotechnological inventions.

(2) For the purposes of this Act, “biotechnological inventions” specified in clause (1) 3) of this section mean:

- 1) inventions concerning biological materials or products which contain such materials;
- 2) inventions concerning the derivation or use of biological materials.

(3) For the purposes of this Act, “biological material” specified in subsection (2) of this section means any material, including micro-organisms, which contains genetic information and is capable of reproducing itself or being reproduced in a biological system.

§ 7. Novelty, inventive step and industrial application

(1) An invention shall be considered to be new if it does not form part of the state of the art. The state of the art shall be held to comprise any technical information made available to the public by means of written or oral description, by use, or in any other way, in any part of the world, before the filing date of the registration application of a utility model (hereinafter *registration application*) or before the date of priority if priority is claimed. In determining novelty, the content of registration applications published pursuant to § 33 of this Act and of patent applications published pursuant to § 24 of the Patents Act prior to the filing date of the registration application or the date of priority, if priority is claimed, shall also be taken into consideration if the filing dates or, if priority is claimed, the dates of priority of such applications are earlier.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) In determining the state of the art, provided that a corresponding request is submitted, no information disclosing an invention, which is disclosed within twelve months before the filing date of a registration application or, if priority is claimed, before the date of priority, by a person who is entitled to the registration of a utility model pursuant to § 11 of this Act, or by any other person who has received the information from such person against or according to the will of the person, shall be taken into consideration. If another person acquired the information unlawfully or the information was published unlawfully or without the knowledge of the person who has the right to apply for the registration of a utility model, the request may be filed in the course of the examination of the registration application or in case the utility model is contested. Evidence supporting the request shall be appended to the request.

(3) For the purposes of this Act, an invention shall be considered as involving an inventive step if, due to difference from the state of the art, beneficial technical characteristics or other beneficial characteristics become evident upon using the invention.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(4) A utility model shall be considered as susceptible to industrial application if it can be manufactured or used in the economy.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 8. Unity of utility model

Legal protection of the utility model on the basis of one and the same registration application may be applied for one invention only.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 9. Claims of utility model

(1) The claims of a utility model shall define the subject matter of the invention in words in a clear, concise and short manner.

(2) In claims, the subject matter of an invention shall be presented as a set of essential technical features.

(3) The claims of a utility model shall consist of an independent claim and dependent claims. The claims of a utility model may contain more than one independent claim only if the invention consists of several products grouped together and on the condition that the requirement of unity of the invention is complied with.

(4) The description and drawings of the invention shall be used to interpret the claims of the utility model. The abstract of an invention has no legal effect upon interpreting the claims of the utility model or in determining the legal protection of the utility model. The abstract shall merely serve for use upon disclosing technical information concerning the invention.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 10. Priority

(1) Priority is the preferential right of the person who files the first registration application or patent application to apply for legal protection of an invention as a utility model. The filing date of the first registration application or patent application shall be considered the date of priority.

(2) If a registration application is filed with the Patent Office within twelve months after the filing date of the first registration application or patent application, priority shall be established:

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

1) on the basis of the filing date of the first registration application or patent application in any State party to the Paris Convention of the Protection of Industrial Property (RT II 1994, 4/5, 19) or member of the World Trade Organisation;

2) on the basis of the filing date of the first registration application or patent application in a state which is not a State party to the Paris Convention for the Protection of Industrial Property or in a state which is not member of the World Trade Organisation if such state guarantees equivalent conditions for first registration applications and patent applications filed in the Republic of Estonia.

(3) [Repealed – RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(4) If priority is claimed, priority shall be established for a registration application on the basis of the filing dates of several registration applications or patent applications filed earlier. In the event of several registration applications or patent applications filed earlier, the twelve-month term specified in subsection (2) or (3) of this section shall be calculated as of the earliest date of priority.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(5) [Repealed - RT I 2004, 20, 141 – entry into force 01.05.2004]

(6) If priority is claimed, priority for a registration application filed with the Patent Office after expiry of the twelve-month term specified in subsection (2) or (3) of this section shall be established on the basis of the filing date of a first registration application or patent application pursuant to subsection (2) or (3) if:

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

1) the reasons for the failure to comply with the abovementioned term are appended to the priority claim;

2) the reasons stated pursuant to clause 1) of this subsection prove that the failure to file the application within the term was unintentional;

3) the registration application was filed within two months from the date on which the abovementioned term expired.

(7) In case of a registration application filed on the basis of a patent application pursuant § 19 of this Act, the priority valid in respect of the patent application or the corresponding part of the patent application is retained for the registration application.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

Chapter 3

RIGHT TO APPLY FOR REGISTRATION OF UTILITY MODELS

§ 11. Right to utility model

(1) The right to apply for the registration of a utility model and to become the owner of the utility model is vested in the author of the invention and a successor or legal successor of the author.

(2) If an invention is created in the performance of contractual obligations or duties of employment, the right to apply for the registration of a utility model and to become the owner of the utility model is vested in the author or another person pursuant to the contract or employment contract unless otherwise prescribed by the legislation of the country of the residence or seat of the applicant.

(3) Any person who pursuant to subsections (1) or (2) of this section has the right to apply for the registration of a utility model may transfer such right to another person.

(4) The right to apply for the registration of a utility model shall transfer to a legal successor.

(5) If two or more persons apply for legal protection of the utility model regarding the same invention independently of each other, the right to apply for the registration of a utility model is vested in the person who is indicated as the applicant in the registration application which has been filed earlier or which has an earlier date of priority, provided that such registration application has not been withdrawn or the Patent Office has not rejected the registration application or deemed the registration application to be withdrawn.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 12. Author of utility model

(1) The author of a utility model (hereinafter author) is a natural person who has created an invention as a result of his or her creative activities.

(2) If an invention is created as a result of the joint creative activities of several natural persons, such persons are joint authors.

(3) In the case of joint authorship, all rights arising from the authorship are exercised by the authors jointly, including the right to apply for the registration of a utility model and to become the owner of the utility model, unless they have entered into a written agreement which prescribes otherwise.

(4)-(5) [Repealed]

(6) Authorship is inalienable and unspecified in term.

(7) An author has the right to a pseudonym and he or she may:

- 1) request the disclosure of his or her name as the author;
- 2) prohibit the disclosure of his or her name as the author;
- 3) revoke at any time the prohibition to disclose his or her name.

(8) An author has the right to receive fair proceeds from the profit received from the utility model.

(9) The proprietary rights of an author are transferable and inheritable.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

Chapter 4

RIGHTS TO UTILITY MODEL

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 13. Owner of utility model

(1) The owner of a utility model is the person in respect of whom the last entry as the owner of the utility model has been made in the register.

(2) Upon the registration of a utility model, the applicant for the registration of the utility model (hereinafter applicant) is entered in the register as the owner of the utility model.

(3) The owner of a utility model has the exclusive right to the invention protected as the utility model. Only the owner of a utility model has the right to exercise rights arising from the legal protection of the utility model and to prohibit other persons from exercising those rights.

(4) The owner of a utility model may transfer the rights of the owner of a utility model in full or in part to another person or to surrender the rights or to pledge the utility model pursuant to the procedure provided by this Act. The rights to a utility model may be transferred to a legal successor of the owner of the utility model, provided that the registration in the register is valid.

(5) The exclusive right of the owner of a utility model may only be restricted by this Act or the rights of other persons.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 14. Exclusive right of owner of utility model

(1) The exclusive right of the owner of a utility model means that during the period of the protection of a utility model and without the permission of the owner of the utility model no person shall:

1) manufacture, use, distribute, sell or offer for sale products protected as utility models or to acquire (including by importation) such products for the aforementioned purposes;

2) manufacture, sell or offer for sale components which form a significant part of the product protected as a utility model or to acquire and export such components for the manufacture or preparation of the product, except if the components are other independent products;

3) use or offer for use to third persons a process protected as a utility model;

4) use, distribute, sell or offer for sale products manufactured by using a process protected as a utility models or to acquire (including by importation) such products for the aforementioned purposes.

(2) In the case of products manufactured according to a process which is protected as a utility model, the manufacture, use, distribution, sale, offering for sale or acquisition (including by importation) for the aforementioned purposes of a similar product without the authorisation of the owner is considered an infringement of the exclusive right of the owner of the utility model unless it is proved that the similar product is manufactured according to a different process.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 15. Acts which do not constitute infringement of exclusive right of owner of utility model

The following acts do not constitute infringement of the exclusive right of the owner of a utility model:

- 1) the use of the utility model on board of ships of other states (within the hull, machinery, rigging, radio-navigation equipment or other equipment) if such ships are temporarily or accidentally in the waters of the Republic of Estonia and the utility model is used solely for the purposes of the ship;
- 2) the use of the utility model within the construction or auxiliary equipment of aircraft or land vehicles of other states, or in the operation of the vehicles or equipment if such vehicles are temporarily or accidentally in the Republic of Estonia;
- 3) the use of the utility model in testing related to the utility model itself;
- 4) the private non-commercial use of the utility model if such use does not harm the interests of the owner of the utility model.

§ 15¹. Exhaustion of rights

The owner of a utility model has no right to prohibit the acquisition (including by importation) or use, distribution, sale or offer for sale of a product which contains an invention protected as a utility a model when the product has been put on the market in the territory of the Republic of Estonia or a State party to the Agreement of the European Economic Area by the owner of the utility model or with the owner's consent.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 16. Right of prior use

(1) A person who, prior to the filing of a registration application for an invention by another person, has, in good faith and independently of the person who files the registration application, used the same invention for industrial application in the Republic of Estonia, may continue to use the invention retaining the same general nature of application. Use is in good faith unless the user knew or should have known that the filing of a registration application for the invention was intended.

(2) The right of prior use also belongs to a person who has, in good faith, made serious preparations for the industrial application of an invention in the Republic in Estonia.

(3) The right of prior use can only be transferred to another person together with the enterprise with regard to which the right of prior use is established or in which it was intended to be used.

§ 16¹. Provisional protection

(1) An invention shall be granted provisional protection as of the filing date of a registration application until the date when a notice of registration of the utility model is published in the official gazette of the Patent Office.

(2) A person who commences use of an invention during the period between the filing date of the registration application and the date when the notice of registration of the utility model is published in the official gazette of the Patent Office is not deemed to infringe the exclusive right of the owner of the utility model, unless the person knew or should have known that a registration application has been filed with regard to the invention or the applicant notified the person in writing of filing the registration application.

(3) Persons whom an applicant notifies of the filing of the registration application shall be deemed, after the date when the notice registration of the utility model is published in the official gazette of the Patent Office, to infringe the exclusive right of the owner of the utility model as of the date of receipt of the notice concerning the filing of the registration application, unless such persons have the right of prior use pursuant to § 16 of this Act.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

Chapter 5

REGISTRATION APPLICATION AND PROCESSING THEREOF

§ 17. Registration application

(1) A registration application shall include the following documents:

1) registration application of a utility model which contains a request to register the utility model and information concerning the applicant and author and the name of the invention;

2) the description of the invention in which the invention must be disclosed in a sufficiently clear and concise manner which enables a person skilled in the art to make the invention;

- 3) the claims of the utility model;
- 4) the drawing referred to in the description of the invention or claims of the utility model;

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

- 5) an abstract of the invention.

(2) The following documents shall be annexed to a registration application:

- 1) an authorisation document if the registration application is filed via a patent agent;
- 2) documents certifying the priority claim, unless a specification specified in § 18² of this Act applies.

(3) If the applicant is not the author, the applicant shall declare, in the registration application of a utility model or another document annexed to the registration application, the legal basis of the right to apply for the registration of the utility model as specified in § 11 of this Act.

(4) The requirements for the content and format of the documents included in a registration application shall be established by the Minister of Justice. The Minister of Justice shall establish:

[RT I, 28.12.2011, 1 – entry into force 01.01.2012]

- 1) the structure of documents and information that each structural part must contain;
- 2) the data medium on which documents must be submitted;
- 3) national and international standards applied to documents and the format of information contained therein.

(5) A registration application shall be filed in Estonian. The name of an invention in an application for the registration of a utility model and the abstract of an invention shall be filed in Estonian and in English.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(6) The Patent Office has the right to request the submission of the Estonian translation of any foreign language document included in a registration application, document annexed to a registration application or document submitted in the course of processing within a term of two months, unless a different term is provided by this Act.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 18. Filing of registration application

(1) Registration applications shall be filed with the Patent Office.

(2) A state fee for filing a registration application shall be paid within two months as of the filing date of the registration application. The term for payment of the state fee cannot be extended.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(3) The procedure for filing registration applications shall be established by the Minister of Justice.

[RT I, 28.12.2011, 1 – entry into force 01.01.2012]

§ 18¹. Representation in performance of procedures related to legal protection of utility model

(1) Procedures related to legal protection of utility models shall be performed in the Patent Office and in the Industrial Property Board of Appeal (hereinafter *Board of Appeal*) by interested persons or patent agents who are expressly authorised by the interested persons and who have been awarded patent agent qualifications for operation in the area of inventions pursuant to the Patent Agents Act. An interested person or patent agent may involve, at own expense, an interpreter or adviser without the right of representation in oral proceedings in the Patent Office or in the Board of Appeal.

(2) A person whose residence or seat is not located in the Republic of Estonia shall authorise a patent agent as the person's representative for the performance of procedures relating to legal protection of a utility model in the Patent Office and in the Board of Appeal, except for filing a registration application, filing a request for acceptance of an international application for national processing specified in subsection 30 (1) of this Act and payment of all the state fees specified in this Act.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(3) If procedures related to legal protection of a utility model are performed in the Patent Office or in the Board of Appeal by several persons together, they may authorise a patent agent as their representative or choose a representative from among themselves (hereinafter *joint representative*) whose residence or seat is in the Republic of Estonia. A joint

representative has the right to perform all procedures relating to the legal protection of the utility model, unless it follows otherwise from the authority granted to the joint representative.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 18². Filing, correction or addition of priority claim

- (1) A priority claim is filed upon filing of the registration application.

- (2) Documents certifying the priority claim shall be filed together with the priority claim or within sixteen months as of the date of priority. Documents certifying the priority claim need not be submitted if priority is claimed on the basis of a first registration application or patent application in the Republic of Estonia.

- (3) Translations of foreign language documents certifying the priority claim shall be submitted at the request of the Patent Office pursuant to the provisions of subsection 21 (2) of this Act during the term determined by the Patent Office.

- (4) A priority claim may be corrected or added until the Patent Office has, on the basis of the registration application, made a decision to register the utility model or to reject the registration application.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 19. Registration application based on patent application

- (1) A person who has filed a patent application may file a registration regarding the same invention, taking into account the restrictions provided for in §§ 5-9 of this Act.

- (2) A registration application shall be submitted before any of the following events has occurred:
 - 1) filing a claim for the withdrawal of a pending patent application;
 - 2) informing of the termination of the patent application procedure due to the Patent Office declaring the patent application as withdrawn;
 - 3) informing of the decision to grant a patent;
 - 4) informing of the decision to reject the patent application.

- (3) In the event of a patent application involving a combination of inventions relating to a single general inventive concept, an individual registration application may be filed regarding each invention included in the combination. All individual registration applications to be filed regarding the inventions included in the combination shall be filed concurrently.

(4) A registration application cannot be filed after ten years have passed from the date of filing a patent application.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 20. Establishing filing date of registration application and acceptance thereof for processing

(1) The Patent Office shall establish as the filing date of a registration application the date on which the Patent Office has received all of the following elements in a set of documents:

- 1) request to register a utility model in Estonian or another express indication to the effect that the documents are intended to be a registration application of a utility model;
- 2) the applicant's name and address or other details allowing for sending the Patent Office's notices to the applicant;

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

- 3) a document which on the face of it appears to be a description of the invention.

(2) Where, upon review of the documents received, the Patent Office finds that an element of the registration application of a utility model listed in subsection (1) of this section is missing from the set of documents, the Patent Office shall notify the person who filed the registration application thereof. The missing elements shall be filed within two months as of the date of the notice of the Patent Office.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(3) The Patent Office does not have the obligation to give notice of deficiencies as specified in subsection (2) of this section if the missing element of the registration application is the information referred to in clause (1) 2) of this section. In such case, the applicant must submit all the missing elements of the registration application as specified in subsection (1) on the applicant's own initiative within two months from the date on which the initially submitted documents were received by the Patent Office.

(4) In the case specified in subsection (2) of this section, the Patent Office shall establish the date on which the applicant has eliminated all the deficiencies in the initially submitted documents as listed by the Patent Office as the filing date of the registration application and, in the case specified in subsection (3) of this section, the Patent Office shall establish the date on which the applicant submitted all the missing elements of the registration application as listed in subsection (1) on the applicant's own initiative as the filing date of the registration application.

(5) Where the Patent Office finds that a part of the description of the invention appears to be missing from the set of the documents of the registration application, or that the claims of the utility model refer to a drawing which appears to be missing from the application (hereinafter missing part), the Patent Office shall promptly notify the applicant thereof. If the applicant wishes to add the missing part to the registration application, the applicant, whether notified by the Patent Office or not, must file the missing part within two months from the filing date of the registration application. If the missing part is filed later, it shall not be taken into account upon processing the registration application. The Patent Office shall establish the date on which the missing part is received by the Patent Office as the new filing date of the registration application.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(6) If, within the term specified in subsection (5) of this section, the applicant gives notice to the Patent Office of declining to file the missing part or fails to file the missing part, the Patent Office shall establish the filing date of the registration application pursuant to the provisions of subsection (1) of this section.

(7) Where both the provisions of subsection (4) and subsection (5) of this section apply to the establishment of the filing date of a registration application, the filing date of the registration application shall be the later date as established pursuant to the said provisions.

(8) The Patent Office shall not establish the filing date of a registration application if the applicant fails:

1) in the event specified in subsection (2) of this section, to eliminate any deficiencies listed in the notice of the Patent Office within two months as of the date of the Patent Office's notice;

2) in the event specified in subsection (3) of this section, to file, on own initiative, all the elements of the registration application referred to in subsection (1) of this section that are missing within two months from the date of receipt of the initially submitted documents at the Patent Office.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(9) If a registration application has been filed on the basis of a patent application pursuant § 19 of this Act, the filing date of the patent application shall be the filing date of the registration application.

(10) The Patent Office shall accept a registration application for processing if the filing date of the registration application has been established.

(11) The Patent Office shall notify the applicant of the number and filing date of the registration application accepted for processing.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 20¹. Refusal to accept registration application for processing

(1) The Patent Office shall refuse to accept a registration application for processing if the filing date of the registration application is not established on the bases prescribed in subsection 20 (8) of this Act.

(2) Upon the refusal to accept a registration application for processing, the applicant is notified thereof in writing. The applicant is entitled to a refund of the state fee paid by the applicant.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 21. Processing of registration application

(1) In the course of processing a registration application, the Patent Office shall verify:

- 1) payment of the state fee specified in subsection 18 (2) of this Act;
- 2) existence of the documents specified in subsections 17 (1) and (2) of this Act;
- 3) compliance of the priority claim with the provisions of §§ 10 and 18² of this Act, if priority is claimed;
- 4) information on the author and compliance with the requirement to declare the legal basis of the right to apply for the utility model referred to in subsection 17 (3) of this Act if the applicant is not the author;
- 5) the right of the patent agent to operate in the area of inventions, if the registration application is filed via a patent agent;
- 5¹) the compliance of the registration application with subsection 5 (2), § 6, subsection 7 (4) and § 8 of this Act;

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

6) compliance of the registration application documents with the requirements for the content and format provided for in subsection 17 (4) of this Act.

(1¹) The Patent Office shall carry out a search of the state of the art regarding the invention in accordance with § 21¹ of this Act.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) If, upon verification specified in subsection (1) of this section or upon carrying out the search of the state of the art pursuant to § 21¹ of this Act, it is ascertained that a document is missing from the registration application or deficiencies relating to the form or content of the documents exist or if the contents of a document are not sufficient or are unclear for processing the registration application, including for carrying out a search of the state of the art, the Patent Office shall notify the applicant thereof in writing and set a term of two to four months or, by way of exception, six months for the elimination of deficiencies or provision of explanations. Not later than one month before the expiry of the set term, the applicant may apply for oral proceedings in accordance with subsection 26² (2) of this Act for providing explanations.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(3) In justified cases, an applicant has the right to request the extension of a term set by the Patent Office, but not over the term of six months specified in subsection (2) of this section. A request for the extension of the term shall be filed with the Patent Office before the expiry of the term specified in subsection (2) of this section. The decision of the Patent Office regarding granting an extension of the term shall be final.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(4) If a registration application is in compliance with the provisions of subsection (5) 2, § 6, subsection 7 (4) and §§ 8 and 17 of this Act, the Patent Office shall make a decision to register the utility model and notify the applicant thereof in writing. A registration entry shall be made on the basis of the decision.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(5) The Patent Office shall refuse to register a utility model, making a decision to reject the registration application, and shall inform the applicant thereof in writing if:

- 1) the object of the registration application cannot be protected as a utility model on the basis of subsection 5 (2) or § 6 of this Act;
- 2) the invention is not susceptible of industrial application on the basis of subsection 7 (4) of this Act;
- 3) the registration application does not comply with § 8 or § 17 of this Act and the applicant fails to eliminate any of the deficiencies identified by the Patent Office in the course of the verification specified in subsection (1) of this section or the search of the state of the art pursuant to § 21¹ of this Act or fails to provide sufficient explanations within the term set in

accordance with subsection (2) or (3) of this section or has not applied for oral proceedings in accordance with subsection (2) of this section;

4) the registration application filed on the basis of a patent application has disregarded § 19 of this Act;

5) in the event specified in subsection 23 (2¹) of this Act, the applicant refuses to withdraw corrections or amendments altering the invention; or

6) the applicant has not filed an objection pursuant to § 26¹ of this Act or the Patent Office has not agreed with an objection.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 21¹. Search of state of art

(1) The Patent Office shall identify the state of the art preceding the invention in accordance with subsections 7 (1) and (2) of this Act. The claims of the utility model filed by the applicant shall be taken into account upon identifying the state of the art.

(2) The Patent Office shall draw up a search report of the state of the art (hereinafter *search report*) and submit it to the applicant so that the applicant could take notice thereof.

(3) The search report shall set out information about technical solutions identical to the invention and technical solutions similar to the invention and indicate the date of the search.

(4) The substance and form requirements of the search report and the procedure for drawing up the report shall be established by the Minister of Economic Affairs and Communications.

[RT I, 28.12.2011, 1 – entry into force 01.01.2012]

(5) Taking into account the terms and conditions provided for in subsection 23 (1) of this Act, the applicant may make corrections and amendments to the registration application on the basis of the search report within two months after the date of issue of the search report by the Patent Office.

(6) The search report has an informative meaning.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 22. Suspension and resumption of processing of registration application

(1) If an applicant fails to take a step within a time limit set by the Patent Office under this Act and has not applied for oral proceedings for providing explanations in accordance with subsection 21 (2) of this Act or fails to attend oral proceedings at the agreed time without good reason, the Patent Office shall suspend the processing of the registration application and notify the applicant thereof in writing.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) If documents certifying the priority claim have not been submitted together with the priority claim pursuant to subsection 18² (2), the Patent Office shall suspend the processing of the registration application until the documents are submitted, however not for longer than 16 months as of the date of priority.

(3) The processing of a registration application whose processing has been suspended pursuant to subsection (1) of this section shall be resumed if the applicant takes the prescribed step or, in the event of failing to attend oral proceedings, proposes a new time for oral proceedings, pays the state fee and submits information about the paid state fee within two months as of the date of notification of the registration application procedure.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(4) The processing of a registration application the processing of which was suspended pursuant to subsection (2) of this section is resumed if the applicant submits documents certifying the priority claim or, if the applicant has not submitted documents certifying the priority claim, after 16 months as of the date of priority. In the last case mentioned, the Patent Office shall refuse to satisfy the priority claim and notify the applicant thereof in writing.

(5) [Repealed – RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 23. Correction and supplementation of registration application

(1) An applicant may correct and amend a registration application during processing such that no alterations are made to the subject matter of the invention which was disclosed in the registration application on the filing date of the registration application.

(2) Corrections and amendments are deemed to alter an invention if they contain essential characteristics of the invention which were not included in the description of the invention, the claims of the utility model or the drawings on the filing date of the registration application.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2¹) In the event of corrections and amendments altering an invention, the Patent Office shall make a proposal to the applicant to withdraw them, granting a term of two to four months for that purpose.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(3) [Repealed]

(4) During processing, the Patent Office may correct obvious mistakes, delete excessive data and make wording-related corrections in the documents of a registration application without the approval of the applicant, except in the description of the invention, in the claims of the utility model or in drawings. The abstract of the invention may be altered without the approval of the applicant.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 24. Withdrawal of registration application

(1) An applicant may file a request for the withdrawal of a registration application and withdraw a pending registration application. The date of withdrawal of a registration application is the date when the request to withdraw the registration application reaches the Patent Office. Registration application documents are not returned.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) If several persons apply for the registration of a utility model, a request for the withdrawal of the registration application shall be filed with the consent of all such persons.

(3) The Patent Office shall deem a registration application to be withdrawn if:

1) the Patent Office has suspended the processing of a registration application pursuant to subsection 22 (1) of this Act and the processing cannot be resumed pursuant to subsection 22 (3) of this Act, or

2) the applicant has not paid the prescribed state fee within the two-month term specified in subsection 18 (2) of this Act or within the one-month term specified in subsection 11 (7) of the Convention of the Grant of European Patents Implementation Act or, if the state fee has been paid, has not submitted information certifying payment of the state fee within the aforementioned terms.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 25. Termination of processing of registration application

(1) The Patent Office shall terminate the processing of a registration application which is withdrawn or deemed to be withdrawn.

(2) The applicant shall be notified of the termination of the processing of a registration application in writing.

§ 26. Resumption of processing of registration application

(1) An applicant may request the resumption of the processing of a registration application if the Patent Office has terminated the registration application procedure by having deemed the registration application to be withdrawn pursuant to clause 24 (3) 1) or 2) of this Act, provided that the failure to take the steps occurred due to *force majeure* or another impediment beyond the control of the applicant or the applicant's representative.

(2) The Patent Office shall resume the registration application procedure if the applicant files a request to resume the procedure, proves the existence of *force majeure* or another impediment beyond the control of the applicant or the applicant's representative, and takes the prescribed steps within two months after the impediment ceases to exist, pays the state fee and submits the information certifying payment of the state fee within the specified term.

(3) A request for the resumption of a registration application procedure can be filed within one year after the due date of the step that was not taken.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 26¹. Applicant's right to file observations

(1) If the Patent Office finds that circumstances which have become evident in the course of the registration application procedure bring about the rejection of the registration application under this Act, the Patent Office shall, before making a decision to reject the registration application, inform the applicant of the intended decision and the circumstances thereof and give the applicant at least one opportunity to file written or oral observations.

(2) The time limit for filing a written observation or, in the event of oral observations, for filing a request for oral proceedings is two months as of the date of the Patent Office's notice. A request for oral proceedings shall be filed in writing.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 26². Appealing against decision of Patent Office

(1) The Patent Office may summon the applicant to oral proceedings at the Patent Office to provide explanations about the registration application or to resolve issues relating to the patent application.

(2) The applicant can apply for oral proceedings for providing explanations about the registration application. The written request shall indicate the circumstances which the applicant intends to explain. The Patent Office's reasoned decision regarding whether it is practicable to conduct oral proceedings is final.

(3) The oral proceedings shall be conducted at the agreed time.

(4) Neither the Patent Office nor the applicant has the right to request the conduct of oral proceedings sooner than two or later than six months after the date of issue of the Patent Office's summons or the date of delivery of the applicant's request or claim to the Patent Office. The Patent Office and the applicant can agree that the oral proceedings will be held before or after the given dates.

(5) Minutes shall be taken of oral proceedings and the minutes shall contain at least the following:

- 1) the number of the request;
- 2) the date of the oral proceedings;
- 3) the names and positions of the participants of the oral proceedings;
- 4) the purpose of the oral proceedings;
- 5) a brief summary of the progress of the proceedings;
- 6) the agreement reached or the parties' dissenting opinions;
- 7) the signatures of the participants.

The minutes shall be binding. If no agreement is reached or the parties have dissenting opinions, the Patent Office shall continue the procedure. The applicant's refusal to sign the minutes does not mean that no oral proceedings have taken place. The Patent Office may take into account circumstances which have become evident in the oral proceedings if the circumstances have been recorded in the minutes.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 27. Filing appeals against decisions of Patent Office

(1) An applicant may file an appeal with the Board of Appeal against a decision of the Patent Office made on the basis of this Act.

[RT I 2008, 59, 330 – entry into force 01.01.2009]

(2) An applicant may file an appeal with the Board of Appeal within two months as of the date on which the decision of the Patent Office is made, and shall pay a state fee.

(3) The Board of Appeal has, with a decision, the right to:

- 1) dismiss an appeal or;
- 2) require the Patent Office to annul its decision and to continue the proceedings taking into account the circumstances set forth in the decision of the Board of Appeal.

(4) The state fee is refunded upon grant of appeal.

§ 28. Completion of processing of registration application

The registration application procedure shall terminate as of the entry into force of the registration of the utility model or as of the rejection of the registration application.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

Chapter 6

INTERNATIONAL REGISTRATION APPLICATION OF UTILITY MODEL

§ 29. Definition of international registration application of utility model

(1) For the purposes of this Act, international registration application of a utility model (hereinafter *international registration application*) is an international application filed on the basis of the Patent Cooperation Treaty (RT II 1994, 6/7, 21) entered into on 19 June 1970 in Washington (hereinafter *Patent Cooperation Treaty*).

(2)-(4) [Repealed]

(5) The Patent Office is the designated or elected office for such international registration applications in which the Republic of Estonia is indicated as the designated or elected state.

(6) International registration applications in which the Republic of Estonia is indicated as the designated state are deemed equal to registration applications filed pursuant to §§ 17 and 18 of this Act.

(7) An international registration application in which the Republic of Estonia is indicated as the designated state is deemed to be filed with the Patent Office on the international filing date which is determined by the receiving office (hereinafter receiving office), as specified in the Patent Cooperation Treaty.

(8) [Repealed]

§ 30. Specifications of processing of international registration applications

(1) For an international registration application to be accepted for national processing, an applicant shall file a corresponding request together with an Estonian translation of the international registration application with the Patent Office and pay a state fee not later than within thirty-one months as of the date of priority.

(2) [Repealed – RT I 2003, 18, 106 – entry into force 01.04.2003]

(3) In justified cases and at the request of an applicant, the applicant may be granted an additional period for filing the translation of an international application specified in subsection (1) of this section, but for not more than until the end of the thirty third month as of the date of priority, and in case of several priorities, until the end of the thirty third month as of the date of the earliest date of priority. An additional period is not granted if more than two months remain until the end of the thirty-one months' period specified in subsection (1) of this section. In case of submission of a translation or in case of expiry of the thirty three months' period specified in this section, a supplementary state fee shall be paid.

(3¹) A utility model is not registered in the register before the international application is published pursuant to Article 21 of the Patent Cooperation Treaty, except in case twenty months have passed as of the date of priority.

(10.03.2004 entry into force 01.05.2004 - RT I 2004, 20, 141)

(3²) If an international registration application is accepted for national processing, the procedure established on the basis of subsection 33 (3²) of the Patent Act applies.

(4)-(5) [Repealed – RT I 2004, 20, 141 – entry into force 01.05.2004]

(6) An international registration application shall lose the effect specified in subsections 29 (6) and (7) of this Act if:

- 1) the provisions of Article 24 (1) (i) and (ii) of the Patent Cooperation Treaty apply;
- 2) the applicant fails to comply with the requirements provided for in subsection (1) or (3) of this section;
- 3) the applicant fails to comply with the requirements for the authorisation of a representative specified in § 18¹ of this Act.

(6¹) An international registration application is rejected, if:

- 1) the applicant has failed to observe the term specified in subsection (1) of this section or to pay a state fee in the prescribed amount;
- 2) the applicant has failed to pay a state fee in the prescribed amount by the end of the additional period specified in subsection (3) of this section;
- 3) the applicant has failed to comply with the requirements specified in subsection (3²) of this section.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(7)-(9) [Repealed]

(10) If the receiving office refuses to accept an international filing date or reports that an international registration application is deemed to be withdrawn, or if the International Bureau of the World Intellectual Property Organization (hereinafter *International Bureau*) has made a decision pursuant to Article 12 (3) of the Patent Cooperation Treaty, or if the receiving office reports that the designation of the Republic of Estonia is deemed to be withdrawn, the applicant may, within two months after receipt of the corresponding report or decision, request the review of the international registration application in the Republic of Estonia and request that the International Bureau send a copy of the international registration application to the Patent Office. The applicant shall file a translation of the international registration application with the Patent Office and, in the cases prescribed, information concerning the patent agent, and pay a state fee during the term determined by the Patent Office. The Patent Office shall verify the correctness of the decision of the receiving office or the International Bureau and notify the applicant of the results. If the decision of the receiving office or the

International Bureau is incorrect, the registration application shall be reviewed as an international registration application.

(11) If the processing of an international registration application is terminated on the grounds that an applicant has failed to perform an act prescribed by the receiving office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau or an act provided for in subsection (1) of this section on time due to *force majeure* or some other impediment independent of the applicant, the Patent Office shall resume the processing of the international registration application in the Republic of Estonia, provided that the applicant adheres to the provisions of subsections 26 (2) and (3) of this Act.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

Chapter 7

REGISTER OF UTILITY MODELS

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 31. Register of utility models

(1) The register of utility models is maintained on the basis of this Act and the Principles of Legal Regulation of Industrial Property Act and pursuant to the procedure provided for in the specified Acts.

(2) Notices concerning register entries are published in the official gazette of the Patent Office in the events provided for in the Acts specified in subsection (1) of this section. The Patent Office may, in the public interest and pursuant to the procedure established in the statutes of the official gazette of the Patent Office, publish in the official gazette of the Patent Office notices concerning other register entries and other information whose publication is not prohibited or restricted on the basis of the specified Acts or international agreements.

(3) The statutes of the official gazette of the Patent Office shall be established by the Minister of Justice. The title of the official gazette of the Patent Office is “Eesti Kasuliku Mudeli Leht” [*Estonian Utility Model Paper*].

[RT I, 28.12.2011,1 – entry into force 01.01.2012]

§ 32. Registration of utility models in register

(1) If a registration application is accepted for processing, the number and filing date of the registration application and the receipt in the Patent Office of the documents submitted on the basis of § 17 of this Act and other documents submitted on the applicant's own initiative, and information contained in such documents pursuant to § 25 of the Principles of Legal Regulation of Industrial Property Act, shall be entered in the register.

(2) In the course of processing a registration application, information and notices concerning the procedural acts performed pursuant to this Act, documents received and issued, terms provided for in this Act and terms established by the Patent Office shall be entered in the register.

(3) Upon grant of legal protection to a utility model, a registration entry shall be made in the register.

(4) A registration entry shall be made pursuant to subsection 21 (4) of this Act on the basis of a decision of the Patent Office to register a utility model or, in the events specified in § 27, pursuant to a decision of the Board of Appeal or a court decision made regarding an appeal filed under subsection 63 (1) of the Principles of Legal Regulation of Industrial Property Act on the basis of a decision of the Patent Office to register the utility model. The applicant has the right to request the postponement of the entry into force of the registration entry, but not for more than 18 months as of the priority date. The request may be filed upon filing the registration application or in the course of the registration application procedure before the Patent Office has made a decision to register the utility model.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(5) Registration data is the following:

- 1) the registration number;
- 2) the registration date;
- 3) the name of the invention;
- 4) the index of the international patent classification;
- 5) the given name, surname and address of the author;
- 6) the given name, surname and the address of the residence or seat of the enterprise of the owner of the utility model, and in the case of a legal person, the name, address of the seat and the country code;
- 7) the date of beginning of the period of validity of the registration;
- 8) the date of expiry of the registration;
- 9) in the case of a patent agent, the given name and surname of the patent agent;

10) in the case of a joint representative, the given name and surname of the joint representative, and in the case of a joint representative who is a legal person, the name of the legal person;

11) the number of the registration application;

12) the filing date of the registration application;

13) priority data (date of priority, country, application number);

14) the number and filing date of an earlier, continued registration application or patent application which is the basis for the filing of the registration application;

15) international application or European patent application data;

16) the date of disclosure of information specified in subsection 7 (2) of this Act;

17) the claims of the utility model;

18) the description of the invention;

19) the drawing;

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

20) the date of the search of the state of the art;

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

21) the date of issue of a search report.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(6) The applicant specified in subsection (4) of this section is entered in the register as the owner of the utility model.

(7) After making a registration entry, the Patent Office shall prepare a description of the utility model. The requirements for the format and the procedure for drawing up the description of utility models shall be established by the Minister of Justice.

[RT I, 28.12.2011, 1 – entry into force 01.01.2012]

(8) After making a registration entry, the Patent Office shall publish in its official gazette a notice of the registration of the utility model, the description of the utility model and the search report. The date of publication of the notice shall be entered in the register.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(9) A registration shall enter into force on the publication date of a notice of the registration of the utility model in the official gazette of the Patent Office.

(10) After the notice of the registration of the utility model is published, the Patent Office shall issue the owner of the utility model a utility certificate which contains the specification of the utility model.

(11) Only one utility certificate is issued regardless of the number of owners of the utility model.

(12) The formal requirements and the procedure for drawing up and issuing utility model certificates shall be established by the Minister of Justice.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 33. Access to and release of data from register

(1) The register is public. Everyone has the right, as of the date of publication of the notice of the registration of a utility model, to examine the registry file concerning of a registration application and data entered in the database record taking account of the restrictions provided for in this Act, including the author's right to prohibit the disclosure of the author's name. The publication date of the specified notice shall be the date of the publication of the registration application.

(2) In order to access a registry file or receive copies or printouts from the register, a written request together with information concerning payment of the state fee for each file, copy or printout of a document shall be submitted. Applicants, owners of utility models and authors have access to the registry files of their utility models free of charge. Other persons can access the registry free of charge if authorised by the given persons.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(3) At the written request of the applicant or owner of the utility model and if the state fee has been paid, the Patent Office shall issue a document certifying priority of the invention consisting of a copy of the registration application and the official confirmation by the Patent Office. The requirements for the format and procedure for drawing up documents certifying priority shall be established by the Minister of Justice.

[RT I, 28.12.2011, 1 – entry into force 01.01.2012]

(4) The procedure for access to the register and release of information from the register shall be established by the Minister of Justice.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

Chapter 8

VALIDITY OF LEGAL PROTECTION OF UTILITY MODELS

§ 34. Period of validity of registration

(1) A registration shall be valid for four years as of the filing date of the registration application.

(2) The period of validity of a registration can be extended initially for four years and thereafter for another two years. A state fee shall be paid for the extension of a registration.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(3) A registration becomes prematurely invalid if the owner of the utility model files an application for the termination of the validity of the registration.

(4) A state fee is paid for the extension of validity of a registration:

- 1) within six months before the date of expiry of the validity of the registration, or,
- 2) upon payment of additional state fee, within six months as of the date of expiry of the validity of the registration.

(5) [Repealed – RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(6) The validity of a registration shall also be extended if the state fee for the validity of the registration was not paid due to *force majeure* or due to an impediment beyond the control of the owner of the utility model or their representative. The Patent Office shall extend the validity of a registration if the owner of the utility model, within two months after the cessation of the impediment, files a request to extend the validity of the registration, evidences the existence of *force majeure* or another impediment beyond the control of the owner of the utility model or their representative and pays the state fee for the extension of the registration and the additional state fee specified in clause 2) of subsection (4) of this section.

The aforementioned claim can be filed within one year as of the expiry of the term specified in clause 2) of subsection (4) of this section.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 34¹. Payment of state fee

The state fee shall be deemed as paid if information on the state fee paid has been submitted to the Patent Office. If, by a mistake, the same step has been paid for more than once or if different persons have done it, the information submitted first regarding the state fee paid in the right amount shall be considered payment of the state fee.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 35. [Repealed]

§ 36. Amendments to utility models

(1) The owner of a utility model may restrict the scope of legal protection during the entire period of the validity of the registration without altering the invention by amending the claims of the utility model, and correct any bibliographical data and obvious spelling mistakes and calculation errors in the description of the utility model. A request for making amendments and new claims of the utility model and, if necessary, a new description of the invention shall be filed with the Patent Office and a state fee prescribed by subsection (2) of this section shall be paid. The Patent Office shall, on its own initiative or upon request of the owner of the utility model, correct its own mistakes without charge.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) If a request for amendments is made, a state fee shall be paid for publication of the notice of the amendment of the specification of the utility model in the case of correction of bibliographical data and spelling and calculation mistakes, and a state fee shall be paid for the publication of a notice concerning the amendment to the claims of the utility model and publication of a new specification of the utility model in the case of restricting the scope of legal protection.

(2¹) The Patent Office shall publish a notice of making amendments to a utility model in the official gazette of the Patent Office. If the scope of legal protection is restricted, also the new specification of the utility model shall be published.

(3) In order to correct obvious spelling mistakes and calculation errors which restrict the scope of legal protection of a utility model, the owner of the utility model may file a request with the Patent Office within one year after the publication of a registration notice of the utility model.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(4) The extension of the scope of legal protection of a utility model caused by amendments made on the basis of subsection (3) of this section shall not restrict the rights of persons who had, prior to the publication of the notice concerning the making of amendments to the registration of the utility model, taken into consideration the initial scope of legal protection of the utility model in their economic and commercial activities.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

Chapter 9

§§ 37-39. [Repealed]

Chapter 10

TRANSFER OF RIGHTS TO UTILITY MODEL

§ 40. Transfer of right to apply for registration of utility model

(1) The transfer of the right to apply for the registration of a utility model from the author to another person shall be performed on the basis of a separate written agreement or pursuant to a contract or employment contract as provided for in subsection 11 (2) of this Act. The specified agreement or contract shall contain provisions which ensure, pursuant to subsection 12 (8), the right of the author to receive fair proceeds from the profit received from the invention during the entire period of validity of the registration.

(2) Upon the transfer of the right to apply for the registration of a utility model on the basis of law, the law of the country of the residence or seat of the applicant applies.

(3) The legal basis of the transfer of the right to apply for the registration of a utility model pursuant to subsections (1) or (2) of this section and information concerning the author shall be indicated in the registration application. In cases of reasonable doubt, the Patent Office and

courts have the right to require the submission of documents certifying the right to apply for the registration of a utility model and the authorship of the invention.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 41. Transfer of registration application

(1) An applicant may transfer a registration application which is being processed by the Patent Office to another person.

(2) In the event of the death of an applicant or dissolution of an applicant who is a legal person, a registration application which is being processed by the Patent Office shall transfer to a successor or a legal successor.

(3) In order to amend the applicant's data in a registration application, the applicant or the person to whom the registration application is transferred shall file a corresponding application and a document certifying payment of the state fee with the Patent Office. If the application is filed by the person to whom the registration application is transferred, the person shall enclose with the application reliable documents certifying the transfer.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(4) A registration application is deemed to be transferred to another person as of the date on which the entry to amend the registration application data entry is made.

§ 42. Transfer of utility model

(1) The owner of a utility model may transfer the utility model to another person.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) In the event of the death of the owner of a utility model or dissolution of an owner who is a legal person, the utility model shall transfer to a successor or a legal successor.

(3) In order to amend the data concerning the owner of a utility model in the registration, the owner of the utility model or the person to whom the utility model is transferred shall file a corresponding application and a document certifying payment of the state fee with the

Patent Office. If the application is filed by the person to whom the utility model is transferred, the person shall enclose with the application reliable documents certifying the transfer.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(4) The application specified in subsection (3) of this section shall be filed within one year after the date of transfer of the utility model set in the transaction or after the date of creation of legal succession. If the utility model is transferred pursuant to a court judgment, the application shall be filed within one month after the date on which the judgment enters into force. If the terms specified in this subsection are disregarded, the registration is deemed to be invalid.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(5) A utility model is deemed to be transferred to another person as of the date of transfer of the utility model determined by the transaction or court judgment or the date of creation of legal succession.

(6) A person to whom a utility model is transferred pursuant to the provisions of this section may commence use of the rights of the owner of the utility model as of the date on which the entry to amend the registration data becomes valid. A registry entry becomes valid on the date on which it is made. A registry entry shall have legal effect with regard to a third person as of the date on which a notice of the making of the registry entry is published in the official gazette of the Patent Office.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 43. Licence

(1) The owner of a utility model (licensor) may, pursuant to a written licence agreement, grant the use of the rights of the owner of the utility model listed in subsection 14 (1) of this Act to another person or persons (licensee) for commercial purposes in part or in full or inform of the granting of a public non-exclusive licence via the Patent Office in accordance with § 43¹ of this Act.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) With the consent of a licensor, a licensee may, by way of a sublicense, transfer the rights deriving from a licence to a third person.

(3) The term of a licence shall not be longer than the term of the registration.

(4) Licences may be registered in the register. A written request of the licensor or the licensee together with a copy of the licence agreement or an extract from the licence agreement which contains information necessary for the registration shall be the basis for the making of an entry concerning a licence. A state fee shall be paid for an entry concerning a licence. An unregistered licence has no legal effect with respect to third persons. If there is a conflict of rights granted by different licences to several licensees, preference is given to the licensee whose licence is registered.

(5) Upon transfer of a utility model to another person in the cases provided for in § 42 of this Act, the rights and obligations deriving from the licence are also transferred to the said person.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 43¹. Public non-exclusive licence

(1) A public non-exclusive licence means a licence to which anyone who pays the owner of the utility model the licence fee set by the owner of the utility model is entitled. With the utility model, the licensee has the right to, for commercial purposes, take the steps listed in subsection 14 (1) of this Act throughout the territory of the Republic of Estonia.

(2) A public non-exclusive licence can be granted on the condition that no prior valid licences have been registered in the register regarding the same utility model.

(3) For the purpose of granting a public non-exclusive licence, the owner of the utility model shall submit to the Patent Office an application for the registration of a public non-exclusive licence and pay the state fee. The application shall set out at least the following:

- 1) the registration number;
- 2) the name of the invention;
- 3) the given name and surname of the owner of the utility model; in the event of a legal person, the name of the legal person;
- 4) the given name and surname of the patent agent if the application is filed via a patent agent;
- 5) the application for the registration of a public non-exclusive licence;
- 6) the term of validity of the licence;
- 7) the amount of the licence fee or the procedure for calculating it, the term of payment of the licence fee and, where necessary, other terms of payment;
- 8) information about the state fee paid;
- 9) the signature of the applicant and the date.

(4) A power of attorney shall be enclosed with an application for registration of a public non-exclusive licence if the application is submitted via a patent agent.

(5) If an application for the registration of a public non-exclusive licence complies with the requirements, the Patent Office shall enter the details of the licence in the register and publish a respective notice in the official gazette of the Patent Office.

(6) A person who wishes to obtain a public non-exclusive licence shall submit a written application to the Patent Office and pay a state fee. The application shall set out at least the following:

- 1) the registration number;
- 2) the name of the invention;
- 3) the given name and surname of the owner of the utility model; in the event of a legal person, the name of the legal person;
- 4) the application for a public non-exclusive licence;
- 5) the given name and surname of the licensee, the address of their place of residence or seat and the country code; in the event of a legal person, the address of the seat and the country code;
- 6) the given name and surname of the patent agent if the application is filed via a patent agent;
- 7) a confirmation of agreement with the amount of the licence fee and other terms of payment;
- 8) information about the state fee paid;
- 9) the signature of the applicant and the date.

(7) A power of attorney shall be enclosed with an application for a public non-exclusive licence if the application is submitted via a patent agent.

(8) If an application for a public non-exclusive licence complies with the requirements, the Patent Office shall enter the data of the licensee in the register regarding the grant of the public non-exclusive licence, publish a respective notice in the official gazette of the Patent Office and communicate the data of the licensee to the owner of the utility model in writing. In legal terms the entry of the data of the licensee in the register is deemed the entry into a licence agreement containing terms and conditions established on the basis of clauses 6) and 7) of subsection (3) of this section between the owner of the utility model and the licensee.

(9) The owner of the utility model can terminate the validity or shorten the term of validity of a public non-exclusive licence before the expiry of the term of validity entered in the register only with the consent of all the licensees.

(10) A licensee may waive a public non-exclusive licence by informing the Patent Office and the owner of the utility model thereof in writing. A public non-exclusive licence can be waived on the condition that the licence fee has been paid in the prescribed amount and pursuant to the terms and conditions of payment. If the owner of a utility model has not, within one month after receiving a notice from the licensee, informed the Patent Office of any overdue licence fees, the Patent Office shall delete the data of the licensee from the register and publish a respective notice in the official gazette of the Patent Office.

(11) A public non-exclusive licence shall become invalid towards a licensee at the request of the owner of the utility model if the licensee fails to pay the required amount of the licence fee within the term or on other terms and conditions of payment entered in the register.

(12) In the event of a significant change in the overall nature of using an invention, the owner of a utility model or a licensee has the right to demand that the other party amend the amount of the licence fee or the terms of payment thereof.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 44. [Repealed]

Chapter 11

CONTESTATION AND PROTECTION OF RIGHTS TO UTILITY MODEL

§ 45. Contestation of authorship

(1) Disputes concerning authorship are resolved in court after the registration of a utility model.

(2) Any person who finds that he or she is, pursuant to subsection 12 (1) or (2) of this Act, the author or joint author of a utility model, may file an action in court against the owner of the utility model for certification of his or her authorship.

(3) Authorship may be contested by the author or a successor of the author.

(09.02.2000 entry into force 01.07.2000 - RT I 2000, 19, 117)

(4) If authorship is certified, the person may, on the basis of § 11 of this Act, contest the owner of the utility model pursuant to subsection 46 (1) of this Act in the course of the same case.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 46. Contestation of owner of utility model

[RT I 2003, 18, 106 – entry into force 01.04.2003]

(1) Any person who finds that the right to a utility model belongs to the person on the basis of § 11 of this Act may file an action in court against the owner of the utility model for recognition of the person's rights. If the action is satisfied, the person has the right to:

- 1) register the utility model in the person's name,
- 2) revoke the registration and file a new registration application with the same filing date concerning the same invention, or
- 3) revoke the registration.

(2) A request stating the choice made pursuant to subsection (1) of this section along with a copy of the court judgment which has entered into force and, in the prescribed events, a document certifying payment of the state fee shall be filed with the Patent Office within one month after entry into force of the judgment. Upon filing a new registration application, the person must file the documents of the new registration application in accordance with the provisions of § 17 of this Act with the Patent Office within three months from the date of the court judgment which has entry into force. Upon failure to comply with the abovementioned requirements, the registration shall be revoked.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(3) Upon satisfaction of an action filed pursuant to subsection (1) of this section, the person who has used the invention or made serious preparations therefor may apply to a court for the right to use the invention for a charge or free of charge in the person's economic or professional activities after the transfer of the utility model, provided that the invention shall be used for the same purposes.

(4)-(5) [Repealed – RT I 2003, 18, 106 – entry into force 01.04.2003]

§ 47. Contestation of utility model

(1) A person may file an action with the court against the owner of a utility model for the revocation of the registration if the person finds that:

- 1) the registered utility model does not comply with §§ 5-9 of this Act;
- 2) the invention has not been described in the description with sufficient accuracy and clarity, so that an expert of the field can implement the invention, or
- 3) the invention does not correspond to the invention as disclosed in the initial registration application.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) An action specified in subsection (1) of this section may be filed even after the registration has expired.

(3) If a registration is revoked, the Patent Office shall delete the registration entry if the owner of the utility model or a person specified in subsection (1) of this section files an application accompanied by a copy of the court judgment which has entry into force with the Patent Office.

(4) The revocation of a registration shall not be a basis for the annulment of a court judgment made concerning the protection of the exclusive right of the owner of the utility model or cancellation of a contract, including a licence agreement, before the court judgment on the revocation of the registration enters into force. If the performance of the contract is continued, one party has the right to require the other party to change the payments or make recalculations.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 48. Protection of rights of author

(1) The author of a utility model or, in the event of the author's death, the author's successors may file, without a limitation period, an action with court in the event of infringement of the rights provided for in subsection 12 (7) of this Act and for the resolution of other non-economic disputes deriving from authorship.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) [Repealed – RT I 2002, 53, 336 – entry into force 01.07.2002]

§ 49. Protection of rights of applicants

(1) Pursuant to § 27 of this Act, an applicant may file an appeal with the Board of Appeal against a decision of the Patent Office.

[RT I 2008, 59, 330 – entry into force 01.01.2009]

(2) Upon disagreement with a decision of the Board of Appeal, an applicant may contest the decision by filing an appeal with a county court within three months as of the date on which the decision is made public.

[RT I 2005, 39, 308 – entry into force 01.01.2006]

§ 50. Protection of rights of owner of utility model

(1) In the case of unlawful use of a utility model, the owner of the utility model may request:

- 1) compensation for damage caused by unlawful use of the utility model pursuant to § 1043 of the Law of Obligations Act;
- 2) the transfer of that which is received as a result of the unlawful use of the utility model pursuant to §§ 1037 and 1039 of the Law of Obligations Act;
- 3) termination of the unlawful use of the utility model and refraining from further violation pursuant to § 1055 of the Law of Obligations Act;

(2) [Repealed]

(3) A person who infringes the exclusive right of the owner of a utility model by a wrongful act and causes the owner proprietary damage is required to compensate for the damage. Upon use of a utility model in good faith, a court may order a compensation which does not exceed the extent of damage caused within five years before the filing of the action.

(4) The owner of a utility model has the right to file an action within three years as of the time when the owner learns who the person is who has infringed the exclusive right.

(5) Upon infringement of an exclusive right prior to the publication of a notice of registration of a utility model, an action shall be filed within the term specified in subsection (4) of this section or within one year as of the date of the publication of the notice of registration of the utility model, depending on which one expires later.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 51. Protection of rights of other persons

(1) A person who used an invention in good faith before a registration application was filed may file a petition with court for recognition of the person's right of prior use. The court shall hear the application by way of proceedings on petition.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(2) A licensee may file an action in court for resolution of a dispute related to the licence.

(3) A licensee may also file an action upon infringement of the exclusive right of the owner of a utility model by other persons, unless otherwise prescribed upon the grant of licence. The licensee shall notify the owner of a utility model of the licensee's wish to file an action beforehand. The obligation to notify is deemed to be performed if the notice is sent to the owner of the utility model by registered mail to the address indicated in the licence agreement or the address entered in the register.

(4) Any person may, upon doubt that the person's activities may infringe the exclusive right of the owner of a utility model, file an action in court against the owner of the utility model to certify that the existence of the utility model does not hinder the person's economic or professional activities.

(5) Any person against whom an action has been filed on the basis of § 50 of this Act or misdemeanour proceedings or proceedings relating to a criminal offence have been commenced in connection with an alleged infringement of the exclusive right of the owner of a utility model, has the right, pursuant to subsection 47 (1) of this Act, to file an action with court against the owner of the utility model for the revocation of the registration. The court adjudicating the alleged infringement of the exclusive right may, at the request of the alleged offender, suspend the action, misdemeanour or criminal offence proceedings regarding the infringement of the exclusive right of the owner of the utility model for the period of adjudication of the action aimed at the revocation of the registration. As the prerequisite for the suspension, the court may ask for a security for compensation of possible damage caused to the owner of the utility model, provided that the registration remains in force.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 52. Procedure for hearing disputes relating to utility models

(1) In the cases provided by law, disputes related to utility models shall be heard by the Board of Appeal or in court.

(2) Actions and petitions referred to in §§ 45-48, subsections 51 (1), (2), (4) and (5) of this Act and appeals referred to in § 49 of this Act fall within the competence of the court in the jurisdiction of which the Patent Office is located. Actions referred to in § 50 and subsection 51 (3) and § 52¹ fall within the competence of the county court in the jurisdiction of which the infringement occurred. Implementation of provisional measures referred to in Article 50 of the Agreement on Trade-Related Aspects of Intellectual Property Rights in Annex 1C to the

WTO Agreement falls within the competence of the county court in the jurisdiction of which the infringement occurred.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

(3) Courts shall hear disputes related to utility models pursuant to the procedure provided for in the Code of Civil Procedure, taking into consideration the specifications established in this Act.

(4) [Repealed – RT I 2005, 39, 308 – entry into force 01.01.2006]

(5) The Board of Appeal shall hear appeals filed with it on the basis of this Act pursuant to the procedure provided for by the statutes of the Board of Appeal.

§ 52¹. Burden of proof

(1) If an action is filed on the basis of the provisions of subsection 14 (2) of this Act, the defendant is required to prove that the defendant used a process different from the process protected as a utility model for manufacturing a similar product.

(2) If the use of a different process cannot be proved, the product shall be deemed to have been manufactured according to the process protected as a utility model provided that, in spite of reasonable efforts, the owner of the utility model has not succeeded in determining the process actually used for manufacturing the product and the use of the process protected as a utility model is likely or if the product manufactured according to the process protected as a utility model is new.

(3) Evidence submitted by the defendant containing the defendant's production or business secrets may be disclosed only with the consent of the defendant.

§ 53. Acts of court upon filing of statement of claim

(1) In the event of an action specified in subsection 51 (4) of this Act, a copy of the notice sent to the owner of a utility model shall be annexed to the statement of claim. In the event of absence of the copy, the court shall not proceed with the statement of claim and shall set a term for the plaintiff for performance of the notification obligation.

(2) A court may rule, at the request of the plaintiff, that the products or objects protected as utility models and manufactured without the permission of the owner of the utility model, the use of which infringes the exclusive right of the owner of the utility model, shall be removed from circulation for the time of hearing the action filed for termination of an infringement of the exclusive right.

(3) In the event specified in subsection (2) of this section, a court may, at the request of the defendant, rule that the possessor of a product or an object may continue using the product or object for a fair fee payable to the owner of the utility model during the entire or a part of the remaining time of the period of validity of the registration.

[RT I 2005, 39, 308 – entry into force 01.01.2006]

§ 54. Participation of Patent Office

(1) [Repealed – RT I 2005, 39, 308 – entry into force 01.01.2006]

(2) A court shall send a copy of the judgment made in a dispute related to a utility model to the Patent Office so that the latter could take notice thereof.

[RT I 2005, 39, 308 – entry into force 01.01.2006]

§ 55. Representatives in resolution of judicial disputes relating to utility models

[RT I 2005, 39, 308 – entry into force 01.01.2006]

(1) In resolution of disputes related to utility models, patent agents may act as representatives in court.

(2)-(3) [Repealed – RT I 2004, 20, 141 – entry into force 01.05.2004]

Chapter 12

REGISTRATION OF UTILITY MODELS IN FOREIGN STATES

§ 56. Registration procedure

(1) Persons whose residence or seat is in the Republic of Estonia may register their utility models in foreign states regardless of the registration thereof in the Republic of Estonia.

(2) Persons whose residence or seat is in the Republic of Estonia are responsible for the registration of their utility models in foreign states in accordance with the law of the foreign state and international conventions.

§ 57. [Repealed]

Chapter 12¹

LIABILITY

[RT I 2007, 13, 69 – entry into force 15.03.2007]

§ 57¹. Infringement of author's moral rights

(1) Infringement of the author's moral rights provided for in subsection 12 (7) of this Act is punishable by a fine of up to 300 fine units.

[RT I 2007, 13, 69 – entry into force 15.03.2007]

(2) The same act, if committed by a legal person, is punishable by a fine of up to 32,000 euros.

[RT I 2010, 22, 108 – entry into force 01.01.2011]

§ 57². Proceedings

(1) The provisions of the General Part of the Penal Code and the Code of Misdemeanour Procedure apply to the misdemeanours provided for in § 57¹ of this Act.

(2) The extrajudicial proceedings of the misdemeanours provided for in §§ 57¹ of this Act shall be conducted by police prefectures.

[RT I 2009, 62, 405 – entry into force 01.01.2010]

Chapter 13

IMPLEMENTATION OF ACT

§ 58. Entry into force of Act

- (1) The Utility Models Act shall enter into force on 23 May 1994.

- (2) The provisions of clause 10 (2) 1) of this Act apply after the membership of the Republic of Estonia in the Paris Convention for the Protection of Industrial Property is restored.

- (3) The provisions of Chapter 4 of this Act do not apply earlier than three months after the accession of the Republic of Estonia to the Patent Cooperation Treaty entered into on 19 June 1970 in Washington.

- (4) The basis for establishing the priority specified in subsections 10 (2) of this Act may only be patent applications and registration applications filed after the entry into force of this Act.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]

§ 59. Transition provision

Section 21¹ of this Act applies also to all registration applications accepted before the entry into force of § 21¹ with regard to which no decision to register the utility model in accordance with subsection 21 (4) of this Act or a decision to reject the registration application in accordance with subsection (5) of the same section has been made by the date of entry into force of § 21¹.

[RT I, 29.11.2011, 1 – entry into force 01.01.2012]