

**REGULATION ON THE EXTENSION OF EUROPEAN PATENTS TO
SLOVENIA UNDER THE AGREEMENT IMPLEMENTING ARTICLE 3(3)
OF THE COOPERATION AGREEMENT BETWEEN THE
GOVERNMENT OF THE REPUBLIC OF SLOVENIA AND THE
EUROPEAN PATENT ORGANISATION¹**

Article 1

Extension of the effects of European patents

A European patent application and a European patent extending to Slovenia shall, subject to the provisions of this Regulation, have the effect of and be subject to the same conditions as a national patent application and a national patent under the Law on Industrial Property (IPL).

For the purposes of this Regulation,

(a) "European patent application" means an application for a European patent filed under the European Patent Convention (EPC), as well as an international application filed under the Patent Cooperation Treaty for which the European Patent Office (EPO) acts as designated or elected Office and in which Slovenia is designated;

(b) "extended European patent" means a European patent granted by the EPO on a European patent application in respect of which extension to Slovenia has been requested;

(c) "national patent application" means a patent application filed under the IPL with the Office for the Protection of Industrial Property ("the Office");

(d) "national patent" means a patent granted on a national patent application.

Article 2

Request for extension

A European patent application and a European patent granted on such application shall be extended to Slovenia at the request of the applicant. The request for extension shall be deemed to be filed with any European patent application filed on or after 1 March 1994.

Any request for extension shall be published by the Office as soon as possible after it has been transmitted by the EPO but not before the expiry of 18 months from the filing date or, if priority has been claimed, the earliest priority date.

The request for extension may be withdrawn at any time. It shall be deemed withdrawn where the prescribed extension fee has not been paid in time or where the European patent application has been finally refused, withdrawn or deemed withdrawn. The Office shall publish this as soon as possible if the request for extension has already been published.

¹ Published in the Official Gazette RS No. 6/1994 on February 11, 1994, and entered into force on February 12, 1994.

Article 3

Extension fee

The extension fee under Article 2(2) shall be DEM 200. It is due to be paid to the EPO within the applicable time-limit provided under the EPC for the payment of the designation fee.

The extension fee may still be validly paid within the period of grace of two months, as it is specified in Rule 85a(2) EPC, provided that a surcharge of 50% is paid within this period.

For the payment of extension fees the EPO Rules relating to Fees shall apply *mutatis mutandis*. Extension fees validly paid shall not be refunded.

Article 4

Effects of European patent applications

A European patent application which has been accorded a filing date shall be equivalent to a regular national application, where appropriate with the priority claimed for the European patent application, whatever its outcome may be.

A published European patent application shall provisionally confer the protection conferred by Articles 93 and 94 IPL as from the date on which a translation of the claims of the published European patent application into the Slovenian language has been communicated by the applicant to the person using the invention in Slovenia.

The European patent application shall be deemed not to have had *ab initio* the effects referred to in paragraph (2) where the request for extension has been withdrawn or is deemed withdrawn.

Article 5

Effects of European patents

An extended European patent shall, subject to paragraphs (2) to (6), confer from the date of publication of the mention of its grant by the EPO the same rights as would be conferred by a national patent under Article 32 IPL.

Within three months from the date on which the mention of the grant of the European patent has been published, the owner of the patent shall furnish to the Office a translation of the claims of the European patent into the Slovenian language and shall pay the prescribed fee for publication.

If, as a result of an opposition filed with the EPO, the European patent is maintained with amended claims, the owner of the patent shall, within three months from the date on which the decision to maintain the European patent as amended was published, furnish to the Office a translation of the amended claims into the Slovenian language and pay the prescribed fee for publication.

The Office shall publish any translation duly filed under paragraph (2) or (3).

If the translation specified in paragraph (2) or (3) is not filed in due time or the prescribed fee is not paid in due time, the extended European patent shall be deemed to be void ab initio.

An extended European patent and the European patent application on which it is based shall be deemed not to have had ab initio the effects specified in paragraph (1) and Article 4(2) to the extent that the patent has been revoked in opposition proceedings before the EPO.

Article 6

Authentic text of European patent applications or European patents

The text of a European patent application or a European patent in the language of the proceedings before the EPO shall be the authentic text in any proceedings in Slovenia.

However, the translation as provided for under Articles 4 and 5 shall be regarded as authentic, except in revocation proceedings, where the application or patent in the language of the translation confers protection which is narrower than that conferred by it in the language of the proceedings.

The applicant or owner of the patent may file a corrected translation of the claims of the European patent application or European patent. The corrected translation shall not have any legal effects until it has been published by the Office. Any person who, in good faith, uses or has made effective and serious preparations for using an invention, the use of which would not constitute infringement of the application or patent in the original translation may, after the corrected translation takes effect, continue such use in the course of his business or for the needs thereof without payment.

Article 7

Rights of earlier date

A European patent application for which the extension fee has been paid and an extended European patent shall have with regard to a national patent application and a national patent the same prior art effect as a national patent application and a national patent under Article 9 No. 2 IPL.

A national patent application and a national patent shall have with regard to an extended European patent the same prior art effect as they have with regard to a national patent under Article 9 No. 2 IPL.

Article 8

Simultaneous protection

Where an extended European patent and a national patent having the same filing date or, where priority has been claimed, the same priority date have been granted to the same person or his successor in title, the national patent shall have no effect to the extent that it covers the same invention as the extended European

patent as from the date on which the time limit for filing an opposition to the European patent has expired without an opposition having been filed or as from the date on which the opposition procedure has resulted in a final decision maintaining the European patent.

Article 9
Renewal fees for extended European patents

Renewal fees for an extended European patent shall be paid to the Office for the years following the year in which the mention of the grant of the European patent was published by the EPO.

Article 10
Applicability of the EPC

The provisions of the EPC and its Implementing Regulations shall not apply unless otherwise provided in this Regulation.

Article 11
Entry into force

This Regulation shall enter into force on the day following its publication in the Official Gazette of the Republic of Slovenia.