

Act No. 444/2002 Coll. on Designs

of 20. June 2002

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

PART ONE

BASIC PROVISIONS

Article 1

Subject-matter of the regulation

- (1) This Act governs the legal relations arising in relation to creation, legal protection and utilisation of a design.
- (2) This Act does not substitute the protection afforded to the same subject pursuant to the special regulations.¹

Article 2

Definition of terms

For the purposes of this Act

- a) design shall mean the appearance of a whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of a product itself or its ornamentation;
- b) registered design shall mean design entered into the Register of designs;
- c) product shall mean any industrial or handicraft item, including *inter alia* parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;
- d) complex product shall mean a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

Article 3

Protection requirements

- (1) A design shall be eligible for the protection if it is new and has individual character.
- (2) A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:
 - (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
 - (b) to the extent that those visible features of the component fulfil in themselves the requirement as to novelty and individual character.
- (3) Normal use within the meaning of paragraph (2)(a) shall mean use by the end user, excluding maintenance, servicing or repair works.

¹ e.g. Act No. 383/1997 Coll. Copyright Act and act amending the Customs Act as amended by later regulations, Act No. 55/1997 Coll. on Trademarks in wording of Act No. 577/2001 Coll.

Article 4 Novelty

- (1) A design shall be considered new if no identical design has been made available to the public before the date of priority (Article 32).
- (2) Designs shall be deemed to be identical if their features differ only in immaterial details.

Article 5 Individual character

- (1) A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of priority (Article 32).
- (2) In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

Article 6 Disclosure

- (1) A design shall be deemed to have been made available to the public if it has been published in Register of Designs (hereinafter referred to as a “Register”) or exhibited, used in trade or otherwise disclosed, before the date of priority. This shall not apply if these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned before the date of priority (Article 32).
- (2) The design shall not be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under the condition of confidentiality.
- (3) The design for which the protection according to this Act has been claimed shall not be deemed to have been made available to the public if the design has been available to the public by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer, or his successor in title during the 12-month time limit preceding the date of priority (Article 32); This shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designer of his successor in title.

Article 7 Designs dictated by their technical function and designs of interconnections

- (1) Upon the examining conditions for entering of design to the Register, the features which
 - a) are solely dictated by the technical function of the product;
 - b) must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected or placed in, around or against another product so that either product may perform its function;shall not be taken into the consideration.
- (2) Provision of paragraph 1 shall not apply if a design, which meets the requirements pursuant to Articles 4 and 5, serves the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

Article 8

Registration and exclusions of registration

A design, which meets the requirements according to this Act, shall be entered in the Register by the Industrial Property Office of the Slovak Republic (hereinafter referred to as “the Office”).

Article 9

A design, which is contrary to public policy or to the accepted principles of morality, shall not be entered in the Register by the Office.

Article 10

- (1) A design shall not be entered in the Register by the Office if the design is identical with a prior design, which has been a subject-matter of an application for registration of a design (hereinafter referred to as an “application”) filed in the Slovak Republic with the prior date of priority (Article 32) providing of its registration.
- (2) A design shall not be entered in the Register by the Office if it is identical with a design registered in the Slovak Republic with the prior date of priority (Article 32).

Designer

Article 11

- (1) A designer is a person, who has developed a design by his/ her own creative activity.
- (2) A designer shall have the right to the design including the right to file an application (hereinafter referred to as “a right to a design”).
- (3) If the applicant is other person a designer shall have the right to be cited in the application, and if the owner of a registered design (Article 15) is other person a designer shall have the right to be cited in the Register as a designer.
- (4) A co-designer is a person, who has jointly developed the design by his/ her creative activity.
- (5) A co-designer shall have the right to a design to the extent of his/ her participation on the design. The participation of co-designers shall be in the same extent, unless otherwise agreed, or unless otherwise agreed by a relative body.

Article 12

- (1) If the designer has created a design while fulfilling tasks following from employment or analogous relationship, the right to the design shall pass to the employer, unless the parties to this relationship agreed otherwise. The designer shall have the exclusive right to the design.
- (2) Designer who has created a design under paragraph 1 shall be obliged to inform the employer about this fact without delay in the writing and at the same time shall submit the image of the design.
- (3) The employer may exercise the right to the design vis-à-vis a designer in the writing within a time limit of three months from the notification pursuant to paragraph 2. If the employer does not exercise the right to a design within this time limit in writing, the right shall pass back to a designer. The employer as well as the designer shall be obliged to preserve confidentiality about the design vis-à-vis third parties within this time limit.

The employer shall be obliged to preserve confidentiality about the design within one-month time limit from the date, when the right to the design passed back to the designer.

- (4) A designer, against whom the right to the design has been exercised under paragraph 3 shall be entitled to an appropriate remuneration from the employer. The contribution achievable by exploitation or other application of the design shall be decisive for the determining the amount of remuneration. The material share of the employer in the design developing as well as the scope and contents of designer's tasks shall be taken into consideration. If the remuneration agreed or determined by a competent authority is clearly disproportionate to the benefit achieved by latter exploitation or other application of the design, the designer shall be entitled to an additional settlement.
- (5) Rights and obligations following from provisions of paragraphs 1 to 4 shall remain unaffected after the legal relationship between the designer and the employer has ceased.

Article 13

- (1) The right to a design shall be subject to the transfer or assignment.
- (2) The right to a design, with an exception to the right to the authorship, shall belong to the successors in title of the persons listed in Article 11(2) and (5) and in Article 12(1).
- (3) An agreement on assignment of the right to design shall be made in writing.
- (4) The right to design shall be transferred to other person in the cases stipulated by special regulations².

Together with the assignment or the transfer of the right to design, which shall be realised after filing an application, the assignment or the transfer of the rights from application shall perform simultaneously. Assignment or transfer of the rights of application however shall become effective vis-à-vis third parties as from the date of its entry into the register.

Article 14

Scope of protection

- (1) The scope of protection shall be given by representation of the design as it is entered in the Register, with exception of symbols under paragraph 7. The scope of the protection shall include any design, which does not produce on the informed user a different overall impression.
- (2) In assessing the scope of protection, the degree of designer freedom (Article 11) in developing his design shall be taken into consideration.

PART TWO

Effects of the registered design

Article 15

Owner of registered design

- (1) A legal or natural person entered as the owner in the Register shall be considered the owner of a registered design.
- (2) A registered design may be a subject of a co-ownership of several persons.

² e.g. Articles 69, 479 and 487 of the Commercial Code, Articles 460 and 469 of the Civil Code, Articles 12 to 17 of the Act No 111/1990 Coll. on State Enterprise as amended.

Article 16
Co-ownership of a registered design

- (1) Provisions of special regulation³ shall apply to the regulation of the relationships among the co-owners of the registered design *mutatis mutandis*, if this Act does not state otherwise.
- (2) Each of the co-owners of the registered design is entitled to exploit the registered design.
- (3) An agreement on cancelling co-ownership of a registered design and on mutual settlement shall be made in writing.
- (4) In the case of a registered design co-owner's or co-applicant's death or forfeiture without any legal successor, a share of such design co-owner or co-applicant shall be assigned to the rest of the registered design co-owners or co-applicants in an adequate ratio to their shares.
- (5) If the registered design co-owner surrenders his share, it shall be assigned to the rest of the co-owners in a ratio equivalent to their co-owner shares.

Article 17
Rights conferred by registration

- (1) The registration of a design shall confer on its owner the exclusive right to exploit the registered design, to prevent third parties not having his consent from exploitation it, to grant consent for the exploitation of the registered design, to assign the registered design to another person or to establish a lien to the registered design.
- (2) The exploitation of the registered design shall cover, in particular, making, offering, putting on the market, importing, exporting or using of a product in which the registered design is incorporated or to which it is applied, or stocking such a product for those purposes.
- (3) The registered design shall be effective as from the date it entered into the Register. If the registered design has not been published (Article 35(2)) in the Official Journal of the Industrial Property Office of the Slovak Republic (hereinafter referred to as "Journal"), the owner shall exercise the rights conferred by the registration in the Register *vis-à-vis* third parties, only if the design included within the scope of the protection, has not been used in a good faith.

Article 18
Exhaustion of rights

The owner of the registered design shall not be entitled to prevent third parties from the acts related to the product, in which the design included within the scope of the protection is incorporated or to which it is applied, if this product has been put on the market by the owner of the registered design or with his consent.

Limitations of registered design effects
Article 19

- (1) The right of the registered design owner shall not be exercised *vis-à-vis* a person who before the rise of the priority right (Article 32) in the territory of the Slovak Republic has used the design included within the scope of the protection or has made arrangements

³ Articles 136 and 142 of the Civil Code.

leading to the use of the design included within the scope of the protection independently from the designer or the registered design owner (hereinafter referred to as “prior user”). In the case of doubt the acting of prior user shall be considered as acting in a good faith, unless proved otherwise.

- (2) Assignment or transfer of the right of the prior user for the use of the design pursuant to paragraph 1 shall be possible exclusively as a part of assignment or transfer of a company or its part, in the framework of which the design included within the scope of the protection has been used or the arrangements leading to the use of the design included within the scope of the protection has been made.

Article 20

The rights conferred by a registered design shall not be exercised in respect of:

- (a) acts done privately and for non-commercial purposes;
- (b) acts done for experimental purposes;
- (c) acts done for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source;
- (d) the equipment of vessels and aircrafts (hereinafter referred to as “crafts”) of other states if these crafts temporarily enter the territory of the Slovak Republic;
- (e) the importation of spare parts and accessories to the territory of the Slovak Republic for the purpose of repairing such crafts pursuant to paragraph (d);
- (f) the carrying out of repairs on such crafts pursuant to paragraph (d).

Article 21

Assignment of the registered design

- (1) The agreement on assignment of the registered design to another person shall be made in writing.
- (2) The assignment of the registered design shall have legal effects vis-à-vis third parties from the date of entry in the Register.
- (3) The rights of third parties being acquired before the date of the registered design assignment shall remain unaffected.

Article 22

Transfer of the registered design

- (1) The registered design shall be transferred to a new owner in the cases stipulated by special regulations².
- (2) The transfer of the registered design shall have legal effects vis-à-vis third parties from the date of entry in the Register.
- (3) The rights of third parties being acquired before the date of registered design transfer shall remain unaffected.

Article 23

Right of pledge

- (1) The right of pledge on the registered design may be established.

- (2) As far as the right of pledge and the relations between the pledge creditor and the pledge debtor are concerned, provisions of special regulation⁴ shall apply *mutatis mutandis*.
- (3) A pledge agreement shall be made in writing.
- (4) The contractual right of pledge shall begin on the date of entry in the Register.

Article 24 License agreement

- (1) The license agreement (hereinafter referred as to “license”) shall confer the consent to exploit the registered design.
- (2) The rise, lapse and enforcement of the right from the license agreement shall be regulated by provisions of special regulation⁵.
- (3) Unless stipulated otherwise, the license agreement shall be valid only with consent of all co-owners of the registered design.
- (4) The license agreement shall have legal effects vis-à-vis third parties from the day of entry in the Register.
- (5) Unless the license agreement stipulates otherwise, the granted license shall be considered non-exclusive.
- (6) Assignment or transfer of the right of the contractual license holder shall be possible exclusively as part of assignment or transfer of the company or its part, within which the registered design pursuant to the contractual license is being used, unless the license agreement stipulates otherwise.

Article 25 Validity and term of protection of the registered design

- (1) The registered design shall be protected for a period of five years from the date of filing the application (Article 32).
- (2) The validity of the registered design shall be renewed by the Office pursuant to the request for renewal of the validity of the registered design filed by the owner of the registered design or one of the co-owners of the registered design repeatedly for up to four periods of five years, up to a total term of 25 years from the date of filing the application (Article 32).
- (3) The request for renewal of the registered design shall be submitted by the owner of the registered design or one of the co-owners of the registered design not sooner than during the last year of its validity. If the request for renewal of the registered design has not been submitted during the last year of its validity at latest at the date, which is identical with the filing date of the application (Article 32), the request for renewal of the registered design shall be deemed not have been filed.
- (4) If the request for renewal of the registered design has not been submitted pursuant to paragraph 3, the owner of the registered design or one of the co-owners of the registered design has a right to submit the request within the additional time limit of six months from the date, when the request should have been filed at latest pursuant to paragraph 3. If the request for renewal of the registered design has not been submitted within this additional time limit, the validity of the registered design shall expire to the date, when, pursuant to paragraph 3, the request for the renewal of the registered design should be filed at the latest.

⁴ Article 151(a) to (j) and Article 552 of the Civil Code.

⁵ Articles 508 to 515 of the Commercial Code.

- (5) The pledge creditor (Article 23) may request the Office in writing to invite him to file a request for renewal of the registered design, if the pledge debtor as an owner of the registered design shall not submit the request for renewal of the registered design within the prescribed time limit pursuant to paragraph 3.
- (6) The registered design shall lapse after futile expiration of three-month time limit from the date of invitation to file the request for renewal of the registered design delivery pursuant to paragraph 5 to the pledge creditor (Article 23).
- (7) The rights of third parties, who have begun to exploit the design in a good faith or have made serious preparations for such exploitation after the futile expiration of the time limit for filing the request for renewal of the registered design pursuant to paragraph 3, shall not be infringed by extending the validity with effect pursuant to the request for renewal of the registered design filed within the further time limit.
- (8) The course of the time limit for filing the request for renewal of the registered design shall be disrupted from the date of delivery of the request for registration of the court action on the right to design to the Register (Article 42(3)) up to expiry of the six-month time limit from the date of legal court decision.

Article 26 Lapse of a registered design

- (1) Registered design shall lapse
 - a) by expiration of its validity;
 - b) from the date of the surrender of the registered design pursuant to paragraph 2.
- (2) The surrender shall be valid from the date when the notice on the surrender was delivered to the Office, or from the date introduced in the notice as a date, when the owner of the registered design or all co-owners of the registered design surrender the registered design.
- (3) The surrender of the registered design, affecting third party rights which are entered in the Register, shall come into effect only after submission of a written consent of the party whose rights and justified interests may be damaged by the surrender of the registered design. The same shall apply in case of existence of litigation entered in the Register whose subject-matter is the right to the registered design namely to the expiration of a time limit of six months as from the day of validity of the court decision.

Article 27 Infringement of rights

- (1) In the case of unauthorised interference with the rights protected by this Act or jeopardising these rights, the person whose rights have been infringed or jeopardised is entitled to claim that the infringement or jeopardising of the right has to be prohibited and the consequences of infringement removed.
- (2) In the case of interference with the rights protected by this Act or jeopardising these rights, the damaged party is entitled to claim the party who jeopardises or infringes his rights to submit to the entitled party the data related to the origin of the product, in which the registered design is incorporated or to which the registered design is applied, and circumstances of its placing on the market.
- (3) If a damage has been caused by the interference with the rights pursuant to paragraph 1, the damaged party has a right to its compensation including the lost profit. If the

interference caused a non-pecuniary injury, the damaged party has a right to adequate satisfaction, which may be represented by pecuniary compensation.

- (4) The right to compensation or satisfaction pursuant to paragraph 3 shall also belong to the damaged party, whose pecuniary or non-pecuniary injury has been caused directly by enforcement of the preliminary injunction declared by the court on proposal filed without a reasonable title.

Disputes hearing Article 28

- (1) Disputes on rights pursuant to this Act shall be heard and ruled by courts, unless this Act stipulates otherwise.
- (2) On request the court is entitled to order that products, materials or instruments, through which the infringement or jeopardising of right, protected by this Act, is directly performed to be
 - a) disposed of outside of the channels of commerce,
 - b) rendered to the plaintiff,
 - c) otherwise secured by a method preventing further infringement or jeopardising of the right,
 - d) destroyed in a suitable manner at the cost of the person infringing the right, unless a more appropriate solution is available.
- (3) The proposal of the plaintiff pursuant to paragraph 2(d) in the part related to the manner of destruction of the objects shall not be binding for the court.
- (4) The court shall not grant the right to submit the data related to the origin of the product, in which the registered design is incorporated or to which the registered design is applied, and the circumstances of its placing on market (Article 27(2)), if the seriousness of jeopardising or infringing the right is disproportionate to the seriousness of consequences following from the fulfilment of obligation imposed in this manner.

Article 29

- (1) When protecting the rights pursuant to this Act, a court by means of preliminary injunction⁶ is entitled to impose obligations identical in content with decision on the matter as such in case any delay may cause to the entitled party a damage, which can be repaired only with difficulties, or a non-pecuniary injury.
- (2) Within a decision on the preliminary injunction the court is also *ex officio* entitled to impose on the plaintiff an obligation to deposit a financial security in a reasonable amount, or to condition the effectiveness of the decision by fulfilment of the imposed obligation. When taking decision on the amount of the financial security, the court shall take into consideration the scope of the pecuniary or non-pecuniary injury, which can occur to the counterpart, as well as to the financial situation of the plaintiff, where the imposition of the obligation to deposit the financial security shall not create a substantial obstacle for the effective enforcement of the right.
- (3) On the proposal the court is entitled to decide upon releasing the financial security to the counterpart as a compensation of pecuniary injury or satisfaction of non-pecuniary injury in terms of money caused directly by the enforcement of the injunction decision without a reasonable title.
- (4) If within a six-month time limit from the finding of the injury pursuant to paragraph 3, the claim to compensation or satisfaction is not exercised before the court or if no agreement

⁶ Articles 74 to 77 and Article 102 of the Code of Civil Procedure.

of the parties on the use of the financial security is reached, the court shall return the financial security.

PART THREE

PROCEDURE BEFORE THE OFFICE

Article 30

The Act on Administrative Proceedings⁷, except the provisions of Articles 19, 23, 28 to 30, 32, 39, 49, 50, 59(1) and 61(1), is related to the procedure before the Office pursuant to this Act.

Article 31

Application

- (1) An application shall be filed by a person entitled to the right to a design pursuant to Article 11(2) and (5), Article 12(1) or Article 13(2).
- (2) If the right to the design belongs to several persons, an application may be filed by one or some of these persons *suo nomine*. The Office shall enter this person into the Register as a joint-applicant on the base of the application supported by a written agreement between an applicant or applicants and a person entitled to file an application pursuant to paragraph 1.
- (3) An application shall contain:
 - a) a request for entering a design into the Register (hereinafter referred to as “a request for registration”);
 - b) data identifying the applicant;
 - c) data identifying a designer or a statement of an applicant that the designer has waived the right to be cited;
 - d) indication of the products in which the design is incorporated or to which is applied;
 - e) representation of every design, registration of which is required in the application and from which it is possible to distinguish exactly the substance of a design;
 - f) document on obtaining the right to a design, if an applicant is not a designer; this shall not be applied if the right to a design has been transferred pursuant to Article 12 (1).
- (4) An application may also contain:
 - a) a request for delay of disclosure of a design (Article 35 (2)),
 - b) description presenting a figure,
 - c) classifying pursuant to international classification⁸.
- (5) An application may contain a request for registration of one design into the Register (hereinafter referred to as “a simple application”) or a request for registration of several designs into the Register (hereinafter referred to as “multiple application”) belonging to one class of the international classification⁸; this shall not apply for designs consist of ornamentation.
- (6) A multiple application shall contain the list of designs, for which the registration is requested.
- (7) Data pursuant to paragraph 3(d) and paragraph 4(b) shall have no influence on the scope of the protection resulting from a design as such.

⁷ Act No. 71/1967 Coll. on Administrative Proceedings (The Administrative Procedure Code).

⁸ Decree of the Minister of Foreign Affairs No 28/1981 Coll. on Locarno Agreement Establishing an International Classification for Industrial Designs, signed at Locarno on October 8, 1968.

Article 32

Right of priority

- (1) For the purposes to start the procedure and for the purposes of the priority right arising, the filing date shall be the date of delivering of the submission or completing of the submission, which contains at least
 - a) data, from which the intention of an applicant to file an application is apparent;
 - b) data enabling the identification of an applicant and relation with an applicant, and
 - c) representation of each design for which the registration is required in an application, and from which it is possible to distinguish expressly the nature of the design.
- (2) Priority right shall arise to the applicant:
 - a) on the date of filing an application or
 - b) on the date of the priority right pursuant to international convention⁹.
- (3) The priority right pursuant to paragraph 2(b) shall be applied by an applicant in the application already and to prove this right by a document on the right of priority within a three-month time limit since it was filed.
- (4) The right of priority pursuant to paragraph 3 may be applied from the first application submitted in the state or in relation to the state, which is contracting party of the international convention⁹ or which is the member of the World Trade Organisation¹⁰. Otherwise this right may be claimed only under the condition of reciprocity.
- (5) The Office during the proceedings shall disregard claiming and proving the existence of the priority right, which fails to meet the requirements pursuant to paragraph 3 and pursuant to the special regulations (Article 50). The Office shall notify the applicant on this fact.
- (6) On the request of an applicant or owner of a registered design a document certifying the right of priority following from the application shall be issued by the Office.
- (7) The right of priority shall be applied only from one application.

Article 33

Adjournment of the application procedure

- (1) After the start of court proceedings in litigation for the right to the design, the Office shall adjourn the application procedure.
- (2) During the adjournment of the procedure the time limits pursuant to this Act shall stop running.
- (3) After the court decision pursuant to Article 40(1)(a) has become valid, the Office shall continue the procedure adjourned pursuant to paragraph 1.

Article 34

Examination of an application

- (1) Within the examination the Office shall ascertain whether

⁹ Decree of the Minister of Foreign Affairs No 64/1975 Coll. on Paris Convention on Protection of Industrial Property of 20 March 1883 revised in Brussels on 14. December 1900, in Washington on 2. June 1911, in the Hague on 6. November 1925, in London on 2. June 1934, in Lisbon on 31. October 1958 and in Stockholm on 14. July 1967 as amended by Decree No 81/1958 Coll.

¹⁰ Communication of the Ministry of Foreign Affairs of the Slovak Republic No 152/2000 Coll. on Conclusion of the Agreement establishing the World Trade Organisation.

- a) the conditions for granting the right of priority pursuant to Article 32 have been met;
 - b) the application meets the conditions pursuant to Article 31(1), (3), (5) and (6);
 - c) the application meets conditions pursuant to the special regulation (Article 50);
 - d) the applicant is represented by an authorised representative¹¹ (Article 49);
 - e) the application contains a design, which meets the conditions pursuant to Articles 2 to 7, Article 9 and Article 10.
- (2) In the case of irregularities pursuant to paragraph 1(a), (c) or (d) or pursuant to Article 31(3), (5) or (6), the Office shall invite the applicant to remedy these irregularities within the prescribed time limit. If the irregularities are not remedied by the applicant, the Office shall suspend the application procedure. The applicant has to be notified about this consequence in the invitation.
- (3) If the application fails to meet the conditions pursuant to paragraph 1(e) or pursuant to Article 31(1), the Office shall refuse the application. Before the refusal of the application the Office shall enable the applicant to respond to the ascertained reasons on the basis of which the application shall be refused.
- (4) The applicant is entitled to divide the multiple application and to file the excluded application before the design is entered into the Register. The right of priority pursuant to the international convention⁹ and the filing date of the original application shall retain also for the excluded application if it contains only designs introduced in the original application.

Article 35

Registration of a design into the Register

- (1) If a subject matter of an application meets the conditions pursuant to this Act, the Office shall enter a design into the Register and the applicant shall become an owner of the registered design. The Office shall issue the certificate on the registration of the design into the Register to the owner of the registered design, design shall be published and the registration shall be mentioned in the Bulletin.
- (2) If the applicant has requested to defer the publication of the design for the time limit not extending 30 months from the date of the priority right rise, the Office shall publish the registered design after the expiration of the requested time limit; the Office shall notify deferral of the publication of the registered design together with the notification of the registration pursuant to paragraph 1.
- (3) The court proceedings on the infringement of the rights from the registered design, which has not been published yet, shall start only under the condition, that the person whom the proposal has been instituted against should be enabled to access the data contained in the Register and in the file related to the registered design.

Invalidation of the registered design

Article 36

- (1) The Office shall declare invalid the registered design (hereinafter referred to “invalidation”), if
- a) a registered design does not correspond to the definition of a design pursuant to Article 2;

¹¹ Article 40 of the Act No 237/1991 Coll. on Patent Attorneys as amended by the Act of the National Council of the Slovak Republic No 90/1993 Coll.

- b) it ascertains, that the design has been registered contrary to the conditions for registration pursuant to Articles 3 to 7, Article 9 or Article 10;
- c) its owner is not entitled to the design pursuant to Article 11(2) and (5), Article 12(1) or Article 13(2);
- d) a distinctive sign is used in the registered design, which confers to the owner of this sign the right to claim the prohibition of the use of such sign before the priority date (Article 32) of the registered design;
- e) a registered design constitutes an unauthorised use of a work protected under the copyright law;
- f) a registered design constitutes an improper use of any of the items listed in the international convention¹² or of the badges, flags or escutcheons other than those covered by the international convention and which are of particular public interest in a Member State.

(2) The Office shall declare invalid an industrial design registered under existing regulations, in the case that the in proceedings started on the proposal of the third party or *ex officio* it has been additionally proved that the conditions for its registration under the rules valid in the time of registration were not met.

(3) Only the person with the right to the design pursuant to the valid decision of the court is entitled to file the proposal for invalidation of the registered design pursuant to paragraph 1(c).

(4) Person whose prior rights have been infringed is entitled to propose the invalidation of the registered design pursuant to paragraph 1(d) and (e).

(5) A person offended by such unauthorised use is entitled to propose the invalidation of the registered design pursuant to paragraph 1(f).

(6) The Office may declare invalid registered design pursuant to paragraph 1(a) and (b) also on its own initiative.

(7) The registered design may be partly declared invalid pursuant to paragraph 1 (b), (d), (e) or (f), if it meets the conditions of the protection also after such invalidation.

Article 37

(1) Where the registered design is declared invalid, it shall be deemed not to have been registered.

(2) If a plaintiff proves his legal interest, it is possible to perform the invalidation also after the lapse of the registered design.

(3) The Office shall publish the decision on the invalidation in the Official Journal.

Article 38

(1) If a proposal for invalidation fails to contain the requirements requested by a special regulation (Article 50) or a plaintiff is not represented by an authorised representative¹¹, the Office shall request the plaintiff to remedy the irregularities within the prescribed time limit. If a plaintiff does not remedy the irregularities within the prescribed time limit, the Office shall suspend the proceeding on the proposal for invalidation. The plaintiff has to be notified about this consequence in the invitation.

¹² Article 6ter of the Decree of the Minister of Foreign Affairs No 64/1975 Coll. on Paris Convention on Protection of Industrial Property of 20. March 1883 revised in Brussels on 14. December 1900, in Washington on 2. June 1911, in the Hague on 6. November 1925, in London on 2. June 1934, in Lisbon on 31. October 1958 and in Stockholm on 14. July 1967 as amended by Decree No 81/1958 Coll.

- (2) If the proceeding has not been suspended pursuant to paragraph 1, the Office shall deliver the proposal for invalidation to the owner of the registered design and concurrently invites him to respond to the proposal within the prescribed time limit.
- (3) If the owner fails to respond within the time limit prescribed in the notice, the Office shall decide on the basis of the file contents.
- (4) The Office shall proceed pursuant to paragraph 3 in the case if the owner is not represented by an authorised representative¹¹. If the owner of the registered design fails to comply with the notice for submitting the authorisation within the prescribed time limit, he shall be deemed not to have responded to the request for the invalidation.
- (5) If the character of the matter requires, the Office shall order an oral proceeding. The Office shall set a date for oral proceeding and shall concurrently deliver a statement of the owner of the registered design to the proposal for the invalidation to the plaintiff.
- (6) The Office may continue in the proceeding and decide in the matter also in the case that the duly summoned party fails to participate in the oral proceeding.
- (7) Extending or supplementing the proposal for invalidation, as well as extending or supplementing the statement of the registered design owner shall be inadmissible; such extending or supplementing shall not be taken into consideration within the proceeding and decision-making by the Office.

Article 39

The plaintiff is obliged to pay a deposit 2,500 SKK together with the proposal for invalidation. The Office shall refund a deposit if the proceeding proves that the submitted proposal for invalidation has been legitimate.

Article 40

Forfeiture of the registered design and transfer

- (1) The Office, on request, shall forfeit the registered design from the owner and shall enter as an owner of the registered design a person who proposes, if
 - a) it has been determined by a valid decision of the court, that the person originally entered as the owner was not entitled to the right to the design pursuant to Article 11(2) and (5), Article 12(1) or Article 13(2);
 - b) the request has been filed by a person, who according to a valid decision of the court, has a right to the design, or by his legal successor in title, and
 - c) the request has been filed within six month time limit from the date of validity of the court decision.
- (2) The request for the forfeiture of the registered design and the transfer has to be proved by the valid decision of the court pursuant to paragraph 1(a).
- (3) Provided that the condition pursuant to paragraph 1(a) has been met, if the request pursuant to paragraph 1 has not been filed or it has not been filed by an authorised person or within the prescribed time limit, the Office shall declare invalid the registered design *ex officio* [Article 36(1)(c)].
- (4) As far as the forfeiture of rights from the application and their transfer to the entitled person is concerned, paragraph 1 shall apply *mutatis mutandis*. If no transfer of the rights from the application occurs pursuant to paragraph 3, the Office shall refuse the application.

- (5) When the entitled person has been entered as an owner of the registered design pursuant to paragraph 1, the licenses and other rights granted to the originally registered owners shall lapse.
- (6) If an originally entered owner or a third party, who acquired a license from the owner before the court proceeding on the right on the design has started, used the design, falling within the scope of the protection, in a good faith or made provable preparations directly aimed at using of the design, falling within the scope of the protection, may continue in the using of the design, if they request for granting the non-exclusive license under the usual condition, within three month time limit from the date of entering an authorised person into the Register.
- (7) To the proceeding pursuant to paragraphs 1 to 4 Article 38 shall apply *mutatis mutandis*.

Article 41

Determination proceedings

- (1) On the request, the Office shall determine, whether the subject matter stated in the proposal falls within the scope of the protection of a certain registered design (hereinafter referred to as “determination request”).
- (2) On the basis of an explicit proposal of the proponent, also a person, whose rights and obligation may be affected by the determination decision, shall be a party to the proceedings pursuant to paragraph 1.
- (3) If the determination request was filed in connection with the pending court proceedings, the subject matter of which is the right protected by this Act, all parties of the court proceedings, whose rights and obligations may be affected by the proceedings and decision making, shall be the parties to the determination proceedings.
- (4) As far as the proceedings to which the proponent is an exclusive party, the provision of Article 38(1), first sentence, and (6) shall apply *mutatis mutandis*, otherwise the provision of Article 38(1) to (6) shall apply *mutatis mutandis* for the determination proceedings.

Article 42

Registration of license, right of pledge, assignment or transfer of the registered design and court litigation in the Register

- (1) As far as the request for the registration of the license, right of pledge, assignment or transfer of the registered design (hereinafter referred to as “entry request”) into the Register or the court proceedings are concerned, Article 38(1) shall apply *mutatis mutandis*.
- (2) In the case of doubts, the Office may ask for submission of a certified copy or an original of a deed proving the acquisition of the right or other supplementary data.
- (3) On the basis of a request of the party to the court proceedings, subject matter of which is the right protected by this Act, supplemented by a counterpart of the petition to the court certified by the court, the Office shall enter into the Register the fact, that the court proceedings are pending as well as the subject matter of the proceedings, with effect from the date of delivering the request to the Office.

Article 43

Further proceeding

- (1) On the basis of the request of the party to the proceedings on extension of the time limit prescribed by the Office for performing an action, submitted before the expiry of this time limit, the Office is entitled to extend the time limit.

- (2) If a party to the proceedings before the Office has failed to comply with the time limit prescribed by the Office for performing an action, he is entitled to ask the Office for further proceeding and at the same time to perform the omitted action no later than two months from the delivery of the official decision issued as a consequence of failure to comply with the time limit.
- (3) The Office shall refuse a request pursuant to paragraphs 1 or 2 in the case of failure to comply with the time limits for submitting the request for further proceeding pursuant to paragraph 2 and *restitutio in integrum* (Article 44(1)).
- (4) The Office shall refuse a request pursuant to paragraph 2 in the case of failure to comply with the time limit for response of the owner to the proposal for invalidation (Article 38(2)).
- (5) The Office shall refuse the request for extension of time limits or for further proceeding which fails to comply with conditions pursuant to paragraphs 1 or 2 or to which a restriction pursuant to paragraphs 3 or 4 applies; before the refusal of the request the Office shall enable the person who requests it to respond to the ascertained reasons on the basis of which the request is to be refused.
- (6) If the Office shall refuse the request for further proceeding, the legal effects of the decision issued as a consequence of failure to comply with the time limit shall be retracted or shall not ensue.
- (7) If the Office fails to make a decision about refusing the request pursuant to paragraphs 1 or 2 within two months from its delivery, the request shall be deemed to be satisfied.

Article 44 Restitutio in integrum

- (1) If the party to the proceedings before the Office unintentionally fails to comply with the statutory time limit or the time limit prescribed by the Office for performing an action, where a consequence of non-performance of the action is a suspension of the proceedings or another right is lost, he is entitled to ask the Office for *restitutio in integrum* and at the same time to perform the omitted action within two months from the removal of the cause for which he could not perform the action, not later than within 12 months from the expiry of the non-complied time limit.
- (2) The party to the proceedings shall be obliged to justify the request pursuant to paragraph 1 and state the facts, which prevented the performance of the action. The statements submitted after the expiry of any of the time limits pursuant to paragraph 1 shall not be taken into consideration by the Office when making a decision about the request.
- (3) In the case of reasonable doubts about the veracity of the statement pursuant to paragraph 2, the Office may ask the applicant to prove his statements in a different way.
- (4) The request for *restitutio in integrum* shall not be granted in the case of failure to comply with the time limits for:
 - a) filing a request for extending the validity of the registered design in the additional time limit;
 - b) claiming priority right (Article 32);
 - c) filing an appeal (Article 46);
 - d) delivery of the valid court decision pursuant to Article 40(1)(c);
 - e) performing the actions pursuant to paragraph 1;
 - f) performing the actions pursuant to Article 43(3) or (4).
- (5) The Office shall refuse the request for *restitutio in integrum*, which fails to meet the requirements pursuant to paragraphs 1 and 2, or to which the restriction pursuant to

paragraph 4 applies, or the applicant has not proven his statements pursuant to paragraph 3; before the refusal of the request the Office shall enable the applicant to respond to the ascertained reasons on the basis of which the request is to be refused.

- (6) If the Office satisfies the request for *restitutio in integrum*, the legal effects of the decision issued as a consequence of failure to comply with the time limit shall be retracted or shall not ensue.
- (7) The rights of the third parties acquired in the territory of the Slovak Republic in a good faith from the validity date of the decision issued as a consequence of failure to comply the time limit of the legal effects of this decision pursuant to paragraph 6, shall be retained.
- (8) Transfer or assignment of the rights pursuant to paragraph 7 shall be possible exclusively as a part of transfer or assignment of a company or its part, within which the registered design is being used.

Article 45

Grounds for the decision

- (1) The party to the proceedings before the Office shall be obliged to submit or propose the evidence to support his statements.
- (2) The Office shall perform the evidence and evaluate the evidence at its discretion, namely each evidence separately and all evidences in their mutual relationships.
- (3) The Office shall decide on the basis of the facts ascertained from the performed evidences submitted or proposed by the parties of the proceedings.

Article 46

Remedies

- (1) An appeal against the decision of the Office may be lodged within one-month time limit from the delivery of the decision; an appeal filed in time has a dilatory effect.
- (2) When making decisions on the appeal the Office shall be bound by its scope; this shall not apply
 - a) in matters in which the proceedings can be started *ex officio*,
 - b) in the case of joint rights or obligations concerning several parties on one side.
- (3) Filing an appeal shall not be admissible against the decision on which
 - a) a request for further proceedings or request for *restitutio in integrum* has been satisfied,
 - b) the proceedings on the application, to which the court proceedings registered in the Register relates, has been suspended after submitting the written consent of the person, who filed the application for registration of the court proceedings into the Register.

Article 47

Data accessibility

- (1) Before the entering a design into the Register or before the publishing of the registered design, in which the publication defer was requested, the Office shall be entitled to notify third parties without the consent of the applicant only the data, who is the designer, applicant, the name of the application and the file number of the application and the data about the priority right.
- (2) After entering of the design into the Register, the Office shall on the basis of the request enable anyone to inspect the file concerning the application and the registered design.

- (3) If the publication of the registered design has been deferred, the Office shall after entering the design into the Register and before its publication enable to inspect the file only the person, who was determined by the owner of the registered design as an infringer of the rights protected by this Act.
- (4) The right for a file inspection shall include a right for making photocopies for the fee.
- (5) On the basis of a written request, provided that the emergent legal interest has been met, the Office shall be entitled to notify the person who requests whether a person indicated by him is alleged as a designer in the application, or not.
- (6) On the basis of a written request of the applicant or owner of the registered design, those parts of the file, which contain trade secret or other confidential information, publication of which is not necessary for a guarantee of the right of third parties, including the parties to the proceedings, shall be excluded from the file inspection.

Article 48 Register and Official Journal

- (1) The Office shall keep the Register, in which it enters decisive data concerning the applications and registered designs.
- (2) Data entered in the Register shall be considered valid unless a decision of the relevant authority determines otherwise.
- (3) Modifications of data entered in the Register, ensuing from valid and enforceable decision of the relevant authority shall be entered in the Register without delay by the Office after delivery of the decision with a validity clause.
- (4) Entry of data and fact ensuing from the law or from a decision of the relevant authority pursuant to paragraph 3 shall not be considered a decision issued in the proceedings pursuant to provisions of the Administrative Procedure Code⁷.
- (5) Anybody is authorised to inspect in the Register of the registered designs; this shall not apply for designs, the applicant of which requested for the publication deferral (Article 35(2)), until the requested time limit of deferral expires.
- (6) The Office shall publish the Official Journal, in which it publishes and notifies the facts concerning the applications and registered designs.

PART FOUR

COMMON, AUTHORISING, TRANSITIONAL AND REPEALING PROVISIONS

Article 49 Common provision

- (1) The parties with the residence or seat in the territory of the member state of an international convention⁹ or in the territory of a Member State of the World Trade Organisation¹⁰, have same rights and obligations as national applicants or owners of registered designs; if the state in which the parties have the residence or seat, is not a member state of an international convention or a member of the World Trade Organisation, the rights and obligations shall be granted only under the condition of reciprocity.
- (2) The parties without a residence or seat in the Slovak Republic shall have to be represented in the proceedings on designs by an authorised representative¹¹.
- (3) If a party to the proceedings fails to comply with the notice of the Office within the prescribed time limit, the Office may suspend the proceedings. The party must be notified

about this consequence in the notice. The Office shall suspend the proceedings also on the request of the party who filed the proposal for its starting. The proposal for the suspension of the proceedings shall not be withdrawn.

- (4) In the case of proposal for suspension of the proceedings on application to which a court litigation entered in the Register is related, the Office may only suspend the proceedings after submission of a written consent of the person, who filed the request for entry of the court litigation into the Register.
- (5) Unless this Act or special regulation (Article 50) stipulates otherwise, submission to the Office shall be made in writing, in the official language¹³.
- (6) Submission to the Office may be made by means of electronic media. Such submission has to be supplemented in writing within the time limit of 14 days, otherwise such submission shall be considered not to be filed.

Article 50 Authorising provision

The special regulation issued by the Office shall stipulate the details about

- a) the filing method and requirements of the application,
- b) the method and requirements of claiming and proving the priority right,
- c) the requirements of the request for extension of the validity of the registered design, request for extension of the validity of the registered design in the additional time limit, request for deferral of the registered design publication,
- d) requirements of the proposal for the forfeiture of the registered design and rectification, proposal for determination, request for further proceedings and request for *restitutio in integrum*,
- e) the form of filing at the Office, delivering and about the filing via electronic media,
- f) the method and requirements of filing the application for an entry of the right, transfer or assignment of the application into the Register,
- g) the data entered in the Register and published in the Journal.

Article 51 Transitional provision

- (1) Proceedings on applications of industrial designs and proceedings on matters of registered industrial designs which has not been legally concluded before the date of the effectiveness of this Act, shall be concluded pursuant to this Act. In the proceedings on the request for the remission of the time limit actual regulations shall apply.
- (2) Rights and relationships from industrial designs entered into the Register before the date of entry into force of this Act shall apply pursuant to this Act. Rise of these rights and relationships, as well as claims occurred before the date of entry into force of this Act has entered into force shall be adjudicated pursuant to the regulations valid in the time of their rise.
- (3) Validity of the registration of industrial designs entered before the date of entry into force of this Act shall be adjudicated pursuant to the Act valid in the time of entering of an industrial design into the Register.

¹³ Act of the National Council of the Slovak Republic No 270/1995 Coll. on official language of the Slovak Republic as amended.

- (4) If the term industrial design is being used in Acts and other special regulations, the term design shall be meant.

Article 52
Repealing provision

The following shall be repealed

1. Article 1 in the extent modifying legal relations and proceedings concerning industrial designs, Articles 36 to 71, Article 75(2) in the extent modifying legal relations and proceedings concerning industrial designs, Article 83, Article 86 in the extent modifying legal relations and proceedings concerning industrial designs and Article 88(1) of the Act No. 527/1990 Coll. on inventions, industrial designs and rationalisation proposals as amended by the Act No. 519/1991 Coll., the Act of the National Council of the Slovak Republic No. 90/1993 Coll., the Act of the National Council of the Slovak Republic No. 185/1994 Coll. and the Act No. 435/2001 Coll. on inventions, supplementary protection certificates and on amendment of some acts (the Patent Act),
2. The Decree of the Federal Office for Inventions No. 550/1990 Coll. on procedure in matters of inventions and industrial designs as amended by the Act No. 435/2001 Coll. on inventions, supplementary protection certificates and on amendment of some Acts (the Patent Act).

Article 53
Entry into force

This Act shall enter into force on 1 October 2002.

Rudolf Schuster s. m.

Jozef Migaš s. m.

Mikuláš Dzurinda s. m.