

## **Law of Ukraine**

### **On amendments to certain legislative acts of Ukraine regarding the patent law reform**

The Verkhovna Rada of Ukraine hereby declares:

I. To amend the following legislative acts of Ukraine:

1. Part two of Article 460 of the Civil Code of Ukraine (Bulletin of Verkhovna Rada of Ukraine, 2003, № 40-44, Art. 356) to set forth in the following wording:

"The object of a useful model may be a device or process in any field of technology".

2. The Law of Ukraine "On Protection of Rights to Inventions and Utility Models" (Bulletin of Verkhovna Rada of Ukraine, 2000, No. 37, Art. 307 with subsequent amendments):

1) in Article 1:

the first paragraph should be set forth in the following wording:

"In this Law, the following terms and abbreviations are used in such meaning;

Paragraphs four, six, fourteen should read as follows: "In this Law, the following terms and abbreviations are used in that sense:

"Invention (utility model)" means the result of human intellectual activity in any field of technology;

"Secret invention (secret utility model) "means invention (utility model), containing information referred to the state secret, the rights for which are certified by a patent for a secret invention (secret utility model)";

"Patent (patent for invention, patent for secret invention, patent for utility model, patent for secret utility model)" means security document certifying priority, authorship and rights for invention (utility model)";

paragraphs fifteen to nineteenth are deleted;

the twenty-fourth, twenty-sixth, twenty-ninth and thirty-first paragraphs should be redrafted as follows:

"License" means permission of the patent owner (licensor) to use the invention (utility model) under certain conditions, granted to another person (licensee);

"Application" means a set of documents required for state registration of the invention (utility model)";

"Priority date" means the date of filing the application with the Institution or relevant body of the State Party to the Paris Convention for the Protection of Industrial Property or the Agreement Establishing the World Trade Organization under which the priority is claimed";

"Register" means State register of Ukraine of inventions, State register of Ukraine of secret inventions, State register of Ukraine of utility models, State register of Ukraine of secret utility models, are kept in electronic form";

supplement with new paragraphs of the following content:

"Biological material" means material that contains genetic information and can be self-replicated or be reproduced in a biological system;

"Bulletin" means official electronic bulletin of the Institution;

"WIPO" means World Intellectual Property Organization;

"State registration of an invention (utility model)" means state registration of an intellectual property right to an invention (utility model);

"Rights to an invention (utility model)" means intellectual property rights to an invention (utility model);

2) in Article 3:

in part one: "; 2) in article 3:

2) in Article 3: in Part One: Paragraph three to read as follows:

"Provides for state registration of inventions and utility models and grants patents";

after the third paragraph, add a new paragraph to read as follows:

"Declares the rights to inventions and utility models void".

In this regard, paragraphs four - eleventh to consider respectively paragraphs five - twelfth;

to supplement part three with the following:

"(3) Qualified electronic signature may be used on documents which the Institution accepts or approves in accordance with this Law. The submission of documents in electronic form to the Institution and the issuance of documents in electronic form by the Institution shall be performed in accordance with the legislation in the field of electronic documents and electronic document circulation, the present law and the rules established by the central executive body that ensures the formation of state policy in the field of intellectual property";

3) the text of Article 4 should be presented in the following wording:

"If the international treaty of Ukraine, liability of which is given by the Verkhovna Rada of Ukraine, establishes other rules than those provided by the legislation of Ukraine inventions (utility models), the rules of the international treaty shall be applied;

4) in Article 5:

replace the words "foreign persons and stateless persons" in the title with the words "foreign and other persons";

in the title, replace the words "foreign persons and stateless persons" with the words "foreigners, stateless persons and foreign legal entities", and the word "persons" with the words "citizens and legal entities";

the second part shall be set forth in the following wording:

"2 Foreigners, stateless persons, foreign legal entities and other persons with permanent residence or permanent location outside Ukraine, in relations with the Institution, shall exercise their rights through representatives of intellectual property cases (patent attorneys)

registered in accordance with the regulation approved by the central executive authority ensuring formation of the state policy in the field of intellectual property, except for the cases stipulated in part three of the Article "On the basis of the Law of Ukraine on Intellectual Property";

to supplement the third part with the following:

"3 Foreigners, stateless persons, foreign legal entities and other persons having permanent residence or permanent location outside of Ukraine may perform such actions themselves:

To submit an application to set the date of its submission;

to pay fees and state duty;

to provide copies of the earlier filed application to establish the filing date in accordance with Article 13 of this Law;

to provide copies of the preliminary application to establish the priority date in accordance with Article 15 of this Law;

to receive acknowledgements and messages on any of the actions specified in paragraphs two - five of this paragraph, provided that the application materials indicate the address for correspondence on the territory of Ukraine;

5) in Article 6:

in the first part, replace the words "principles of humanity and morality" with the words "generally recognized principles of morality";

the second and the third parts should be stated in the following wording:

"2) The object of invention, legal protection of which is provided in accordance with this Law, may be a product (device, substance, microorganism strain, cell culture of plants and animals, etc.), process (method).

The object of an useful model, legal protection of which is provided according to this Law, may be an equipment or process (method).

3. Legal protection in accordance with this Law does not extend to the following objects:

plant varieties and breeds of animals;

biological in nature processes of reproduction of plants and animals not related to non-biological and microbiological processes, as well as products of such processes;

layouts of semiconductor products;

results of artistic design;

surgical or therapeutic methods of human or animal treatment, methods of diagnosing the human or animal body. This provision does not apply to products (substances or compositions) used in diagnosis or treatment;

human cloning processes;

processes of change through the germ line of human genetic identity;

the use of human embryos for industrial or commercial purposes;

processes of altering the genetic identity of animals that may affect their suffering without any significant medical benefit to humans or animals, as well as animals bred by such a process;

the human organism at various stages of its formation and development, as well as the simple detection of one of its elements, in particular the sequence or part of a gene sequence. The effect of this provision does not affect the provision of legal protection for an invention the object of which is elements of a human body outside the body or which have been obtained by other means, using a technical process, including a sequence or partial sequence of a gene, even if the structure of this element is identical to that of a natural element;

a product or process involving plants or animals, the use of which is restricted to a certain plant variety or certain breed of animal;

a product or process that involves a natural biological material, not separated from its natural environment, or is not the product of a technical process.

A legal prohibition on the commercial use of a certain object for other reasons does not affect the provision of legal protection.

It does not correspond to the concept of "invention (utility model)" defined in Article 1 of this Law, but shall not be recognized as an invention (utility model) under this Law if it acts as an independent object:

discovery, scientific theory, mathematical method,

scheme, rules and method of games, contests, auctions, physical exercises, intellectual or organizational, in particular, economic activities (planning, financing, procurement, accounting, crediting, forecasting, rationing, etc.);

computer program;

the form of presentation of information (for example, in the form of tables, diagrams, graphs, with the help of acoustic signals, pronunciation of words, visual demonstrations, in particular on the screen of a computer device, audio and video disks, symbols, including road signs, schemes of routes, codes, fonts, etc., schedules, instructions, projects or schemes of planning of structures, buildings, territories);

the appearance of products (in particular, products, structures, territories), aimed at satisfying exclusively aesthetic needs;

in part four:

paragraph one to read as follows:

"4. priority, copyright and rights to inventions and utility models shall be certified by a patent;

the second paragraph is deleted;

the third paragraph should be revised as follows:

"The validity period of intellectual property rights to the invention shall be 20 years from the date of filing the application to the Institution. If an application is filed on the basis of an international application, the validity period of intellectual property rights for an invention shall be calculated from the date of filing of the international application";

Paragraphs four to six are excluded;

in paragraph seven, replace the words "actions of a declarative patent" with the words "actions of property rights of intellectual property";

the eighth paragraph should be redrafted as follows:

"The term of validity of property rights of intellectual property for a secret invention and a secret utility model shall be equal to the term of classification of an invention or a utility model, but may not be longer than the term of validity of property rights of intellectual property for an invention or a utility model determined under this Law;

in the ninth paragraph, replace the words "Effects of a patent" with the words "Effects of intellectual property rights for an invention (utility model)";

the fifth part shall be set forth in the following wording:

"5 The scope of legal protection granted by a claim for an invention or utility model. Claims shall be construed within the limits of the description of the invention, utility model and relevant drawings;

in the sixth part, replace the words "The effect of a patent (declarative patent) granted for a method" with the words "The effect of intellectual property rights for an invention is a method";

6) in Article 7:

insert the second sentence of part three after the word "invention" with the words "(utility model)";

in part five, the words "the grant of a patent in Ukraine" shall be replaced by the words "state registration of an invention (utility model) in Ukraine";

in the sixth part, replace the number "12" with the number "6";

to supplement part seven with the third sentence, which reads: "New forms of a medicinal product known from the state of the art, including salts, esters, esters, compositions, combinations and other derivatives, polymorphs, metabolites, pure forms, particle sizes, isomers, if they do not differ significantly in effectiveness;

7) the title of Section III is to be presented in the following wording:

**"SECTION III  
RIGHT TO REGISTRATE AN INVENTION (UTILITY MODEL)";**

8) in Article 8:

in parts one and two, replace the words "obtaining a patent" with the words "registration of invention (utility model), secret invention (secret utility model)";

in part three, the word "agreements" shall be replaced with the word "agreements", and the words "the central executive body ensuring the formation of the state policy in the field of intellectual property" shall be replaced with the word "institution";

9) in Article 9:

9) in Article 9: Parts one and three shall be redrafted as follows:

"1. The right to register a service invention (utility model) shall be vested in the employer of the inventor, unless otherwise provided by the contract";

"(3) If the right to register a service invention (utility model) belongs to an employer, the employer shall, within four months from the date of receipt of a notification from the inventor, file an application with the Institution for state registration of the invention (utility model), or transfer the right to such registration to another person, or decide to keep the service invention (utility model) as confidential information. Within the same period of time, the employer must conclude a written contract with the inventor on the amount and conditions of payment to him (his successor) of remuneration in accordance with the economic value of the invention (utility model) and (or) other benefits that can be obtained by the employer;

in the first sentence of part four, replace the word "employer" with the words "the right to register a service invention (utility model) belongs to the employer even now", and the words "obtaining a patent for a service invention (utility model)" with the words "registration of a service invention (utility model)";

10) in Article 11, the words "obtaining a patent (declarative patent) for this invention or a utility model patent" shall be replaced by the words "state registration of the invention (utility model)", and the words "granting a patent" by the words "state registration of the invention (utility model)";

11) the title of Section IV shall be presented in the following wording:

**"SECTION IV  
PRODUCT OF REGISTRATION OF THE INVENTION (UTILITY MODEL)";**

12) in Article 12:

part one shall be set forth in the following wording:

"1. A person wishing to register the invention (utility model) and having the right to do so shall file an application with the Foundation.

An application may be submitted in paper or electronic form. The applicant shall choose the method of filing the application.

Under the applications submitted in electronic form, electronic record keeping shall be performed in accordance with the legislation in the sphere of electronic documents and electronic document circulation, this Law and the rules established on their basis by the central executive authority ensuring formation of the state policy in the sphere of intellectual property. Applications in electronic form shall be submitted when identifying the applicant (representative for intellectual property or other authorized person of the applicant) using a qualified electronic signature";

The second paragraph of the second part of the fifth should be set out in the following wording:

"Application for state registration of the invention (utility model)";

in part six:

in the first paragraph, replace the words "granting a patent (declarative patent)" with the words "state registration of the invention (utility model)";

in the second paragraph, replace the word "patent" with the words "on state registration of the invention (utility model)";

the ninth part should be revised as follows:

"9 The abstract and the name of the invention (utility model) are for informational purposes only. They may not be taken into account for other purposes, in particular, to interpret the claims of the invention (utility model) and to determine the scope of legal protection;

in part ten, the words "Other requirements for application documents are defined" should be replaced by the words "The application is drafted and filed in accordance with the rules established";

in part eleven:

the second sentence should read as follows: "The said fee shall be payable before the expiration of two months from the date of filing;

to complete the third sentence after the words "before the expiration of" with the words "or within two months after the expiration of";

13) in Article 13:

in the second paragraph of the first part, replace the words "on granting a patent (declarative patent)" with the words "on state registration of the invention (utility model)";

to supplement the third part with the following:

"(3) The provisions of this Article shall not restrict the right of the applicant envisaged by Point 3 of Article 17-1 of this Law;

14) in Article 14:

in the first part of this Article, replace the words "obtaining a patent" with the words "state registration of the invention (utility model)";

in the second part of this Article:

in the first sentence, replace the word "document of payment" with the word "payment";

in the first sentence replace the first word "document of payment" with the word "application fee"; in the second sentence replace the second word "document of payment" with the word "application fee";

part six should be revised as follows:

"6. The Institution shall publish in the Bulletin the information it has defined about the international application accepted for examination";

15) in Article 15:

in the first, third and fourth paragraphs of the second part, the words "the central executive authority responsible for the formation of state policy in the field of intellectual property" shall be replaced by the words "the Institution" in the corresponding case;

in part seven, replace the words "the grant of a patent (declarative patent) or a decision to refuse it" with the words "state registration of the invention (utility model) or a decision to

refuse such registration", and after the words "the essence of the invention" add the words "(utility model)";

supplement the article after the words "the Paris Convention for the Protection of Industrial Property" with the words "or the Agreement on Establishing the World Trade Organization";

16) in Article 16:

in the first part, the words "has the status of scientific and technical expertise" shall be deleted;

in the second sentence of the first part of the third part, replace the words "patent granting or refusal of patent granting" with the words "state registration of the invention (utility model) or decision to refuse such registration";

in part five:

in the third part, replace the words "patent grant" with the words "registration of invention (utility model)";

in the fourth paragraph, replace the words "the grant of a patent for the invention" with the words "the state registration of the invention";

the third paragraph of the sixth part should be revised as follows:

"Additional materials shall be submitted by the applicant within two months from the date of receipt by him of the notification or the conclusion of the expert examination institution or copies of materials opposed to the application. If the applicant fails to submit additional materials within the established time limit, the application shall be considered withdrawn, about which the notice shall be sent. The deadline for submission of additional materials is extended, but not more than for six months, if before its expiration, the relevant application is filed and the fee for its submission is paid. If the time limit for submission of additional materials is missed for good reasons, but within six months after its expiration the relevant application is filed together with additional materials and the fee for its submission is paid, the rights of the applicant shall be restored;"

in part nine:

the third paragraph should read as follows:

"It shall be determined whether the invention (utility model) belongs to the objects specified in the first paragraph of the second part of Article 6 of this Law, a utility model belongs to the objects specified in the second paragraph of the second paragraph of Article 6 of this Law and the invention (utility model) does not belong to the objects specified in the third paragraph of Article 6 of this Law;

in the fifth paragraph, replace the words "the document on payment of the fee" with the words "the fee paid";

in the tenth part, replace the words "the existence of a document on the payment of the application fee" with the words "in the coordination of the paid application fee to the established requirements";

to supplement Paragraph 13 with two sentences of the following content: "If within two months after committing the acts stipulated by Paragraph 3 of Article 5 of this Law by a foreign person or a stateless person, there is no message on appointment of a representative



and address for correspondence, the application on which such act was performed shall be considered withdrawn. The said period shall be extended, but not more than for two months, if before its expiration the respective application is submitted and the fee for its submission is paid;

in part fourteen:

in the first paragraph of the first part of the second part of Article 6 of this Law, replace the words "the claimed object to the objects of technology specified in the second part of the second part" with the words and number of "inventions to the objects of technology specified in the first part of the second part of Article 6 of this Law, or belonging of a utility model to the objects of technology specified in the second part of the second part," and the words "of the document on payment of the fee" with the words "- the words" of the fee paid;

Paragraphs two and three should be stated in the following wording:

"Patent for invention" means a statement on the completion of a formal examination and the possibility of conducting a qualification examination;

a utility model patent - a decision of the Institution on state registration of a utility model";

in the first paragraph of the fifteenth part, replace the words "the invention does not relate to the technology objects specified in the second part," with the words and the figure "the invention does not relate to the technology objects specified in the second part, first paragraph, of Article 6 of this Law, or the claimed utility model does not relate to the technology objects specified in the second part, second paragraph," and the words "a document on payment of the fee "in words" of the fee paid;

in paragraph 16:

Paragraphs one and five shall be reworded as follows:

"16 Upon expiry of 18 months after the date of filing of the application for the state registration of the invention and, if the priority is claimed, from the date of its priority, provided that the requirements set forth in paragraph 14 of this Article for the application for the state registration of the invention are met, the Institution shall publish in the Bulletin the information on the application as defined by it, if it is not withdrawn, is not considered withdrawn or no decision is taken to refuse the state registration of the invention";

"Information on the application for state registration of a utility model shall not be published";

After the sixteenth part, add two new parts as follows:

"17 Within six months from the date of publication of the information on the application for the invention, any person may file a reasoned opposition to the application with the institution of examination.

An objection shall be filed on the following grounds:

the declared object does not meet the requirements of parts one, two or three of Article 6 of this Law;

the invention does not meet the conditions of patentability established by Article 7 of this Law.

A fee shall be paid for filing an objection.

The requirements for denial shall be defined by the central executive authority that ensures formation of the state policy in the field of intellectual property.

Objections shall be filed together with a copy thereof, which shall be promptly sent to the applicant by the expert authority. The applicant may inform the expert examination institution about its attitude to the denial within two months from the date of its receipt. The applicant may refute the objection and leave the application unchanged, make changes in the application or withdraw it.

Submitted opposition shall be considered within the limits of the motives set forth in it and taking into account the applicant's response in case of its submission within the established term.

The results of consideration of the objection shall be reflected in the reasonable conclusion of the expertise on the application. A copy of the decision of the Institution together with the justified conclusion is sent to the person who filed the objection.

18. After publication of information on the application, any person may file a request to the Institution of Examination to conduct an information search based on the claims, taking into account the description and available drawings.

A fee shall be paid for filing the application.

Requirements to an application and the procedure for conducting an information search shall be determined by the central executive authority that ensures formation of the state policy in the field of intellectual property.

The report on the results of the information search shall be sent to the person who filed the application within two months from the date of its submission.

After publication of the information on the application for the invention, any person may submit to the examination institution comments on the compliance of the claimed invention with the conditions for granting legal protection defined by this Law. Such persons shall not participate in the records management of the application.

There is no fee for filing a comment.

The requirements to an objection, conditions and procedure for its consideration shall be determined by the central executive authority that ensures the formation of the state policy in the field of intellectual property.

The comment received by the expert examination institution shall be sent to the applicant without delay. The applicant may inform the expert examination institution about his attitude towards the observation.

In this regard, the seventeenth and eighteenth parts should be considered parts nineteenth and twentieth, respectively;

in part nineteenth:

in the second paragraph, replace the words "of the fee payment document" with the words "the payment of the fee";

in the third paragraph the words "the payment of the fee":

the first and second sentences shall be replaced by the following sentence: "The applicant may file the specified application and pay the qualification examination fee within three years from the date of filing of the application, and another person may pay the qualification examination fee within three years from the date of filing of the application, but not later than three years from the date of filing of the application";

in the third sentence, replace the word "she" with "another person";

The fourth paragraph should be replaced with three new paragraphs as follows:

"The deadline for filing the specified application and payment of the fee shall be extended, but not more than for six months, if before its expiration the relevant application is filed and the fee for its filing is paid.

If the applicant has not submitted the said statement with respect to the respective invention application and has not paid the fee for carrying out the qualification examination within the established time limit, the application shall be considered withdrawn and a notice shall be sent to him.

If the term for submission of the specified application and payment of the fee for carrying out the qualification expertise missed for good reasons, the rights of the applicant under the application shall be restored, provided that within six months from its expiration a relevant petition shall be filed together with the specified application and fees shall be paid for submission of such an appeal and for carrying out the qualification expertise";

to supplement the twenty first part with the following:

"21 The applicant shall have the right to amend the claims in the course of the qualification examination of the invention application. Such amendments may not go beyond the essence of the invention disclosed in the application as filed and shall not increase the scope of the rights as compared to the claims published on the date of the request for the qualification examination. The amended formula shall be effective from the date of publication of information on state registration of the invention, provided that the claimed claim complies with the patentability conditions";

17) Article 17 shall be worded as follows:

"Article 17. Withdrawal of application

The applicant may revoke the application at any time before the date of receipt of the decision on state registration of a secret invention or a secret utility model or before the date of payment of the state registration fee for the invention (utility model). Such an application shall be considered withdrawn from the date of filing a request to withdraw it;

18) to supplement Article 17-1 with the following:

"Article 17-1. Division of application

1. The applicant shall have the right to divide an application into two or more applications (divisional applications) until the date of receipt of the decision of the Institution on the application, provided that the essence of the invention (utility model) for a divisional application does not exceed the content of a divisional application as of the

date of its submission. An application may be divided on the applicant's own initiative or in response to an offer of the institution of expertise.

2. 2. The division of the application shall be performed by filing an application for division of the application and submission of a divisional application, provided that the fees for filing the application for division and the divisional application are paid.
3. 3. The applicant shall be entitled to determine the date of filing a divisional application and the priority date of a divisional application.
4. The examination of the divisional application shall be conducted in accordance with Article 16 of this Law, taking into account that the term of payment of the fee for submission of the application, the term of submission of the application for conducting the qualification expertise and payment of the fee for conducting it shall be calculated from the date of receipt of the divisional application by the expert authority. Except for compliance with the requirements of Article 16 of this Law, compliance with the condition defined in the first part of this Article shall be verified.
5. After the expiration 18 months from the date of filing of the divisional application for the invention and, if the priority is claimed, from the date of its priority or immediately after the completion of the formal examination of the application for the invention (whichever is later), the institution shall publish in the Bulletin the information about the application, if it has not been withdrawn, is not considered withdrawn or a decision on refusal of state registration of the invention has not been taken.
6. Other requirements for the division of the application shall be defined by the rules established in accordance with this Law by the central executive authority ensuring formation of the state policy in the field of intellectual property";

19) paragraph one of Article 18 shall be set forth in the following wording:

"The applicant shall have the right to turn the application for state registration of an invention for state registration of a utility model and vice versa before receiving a decision on state registration of the invention (utility model) or decision on refusal of such registration";

20) in the first sentence of Part One of Article 19, replace the words "application or publication of information about the grant of a patent" with the word "its";

21) in Article 21:

in the first part, replace the words "patent for invention" with the words "state registration of the invention";

in the second paragraph:

in the first sentence, replace the word "invention" with the words "state registration of the invention";

in the second sentence, replace the words "obtaining a patent" with the words "state registration of such invention";

in the third part, replace the words "the grant of a patent for the invention" with the words "the state registration of the invention";

22) in Article 22:

in the title, delete the word "patent";

the first and second parts shall be set forth in the following wording:

"1. On the basis of the decision on state registration of the invention (utility model), secret invention (secret utility model), the Institution shall perform state registration of the invention (utility model), secret invention (secret utility model) by entering the relevant information into the Register. The procedure of keeping the Register and the list of information contained in the Register shall be defined by the central executive body that ensures the formation of the state policy in the field of intellectual property.

2. State registration of an invention (utility model) shall be performed upon availability of a document on payment of the state fee for registration of the invention (utility model) and the paid publication fee for state registration of the invention (utility model). The mentioned duty and fee shall be paid after the decision on state registration of the invention (utility model) is received by the applicant.

Where, within three months from the date of receipt by the applicant of the decision on state registration of the invention (utility model), the document on payment of the state fee for the registration of the invention (utility model) and the publication fee for the state registration of the invention (utility model) have not been received by the expert examination institution, the state registration of the invention (utility model) shall not be carried out and the application shall be considered withdrawn.

Where, within three months from the date of receipt by the applicant of the decision on state registration of the invention (utility model), the document on payment of the state fee for the registration of the invention (utility model) and the publication fee for the state registration of the invention (utility model) have not been received by the expert examination institution, the state registration of the invention (utility model) shall not be carried out and the application shall be considered withdrawn.

If the time limit for the receipt of the document on payment of the state fee for the registration of the invention (utility model), the time limit for payment of the publication fee for the state registration of the invention (utility model) missed for good reasons, the rights of the applicant under the application shall be restored, provided that within six months after its expiration a relevant petition shall be filed together with the document on payment of the state fee for the registration of the invention (utility model) and the fee for filing the said petition and the publication fee shall be paid;

in part three:

in the first paragraph, replace the words "on a certain patent" with the words "on state registration of the invention (utility model)";

in the second paragraph, replace the words "patent (declarative patent) for a secret invention and declarative patent for a secret utility model" with the words "secret invention (secret utility model)";

in the second sentence of the second part of the fourth part, replace the words "patent (declarative patent) for an invention or utility model patent" with the words "inventions or utility models";

23) in Article 23:

the title and part one to be set forth in the following wording:

## **"Article 23. Publication.**

(1) Simultaneously with the state registration of an invention (utility model), the Foundation shall publish in the Bulletin information on state registration of the invention (utility model), defined in the established procedure;

in the second part, the Institution shall publish a description of a patent (declarative patent)" replacing the words "state registration of an invention (utility model)" with the words "the Institution shall publish a description of a patent";

in the third part, replace the words "granting a patent (declarative patent) for an invention or a utility model patent" with the words "state registration of the invention (utility model)";

in the fourth part, replace the words "grant of a patent (declarative patent) for a secret invention and a declarative patent for a secret utility model" with the words "state registration of a secret invention (secret utility model)";

24) in Article 24:

the first part, replace the words "before the Court of Appeal or the Court of Appeal" with the words "before the Court of Appeal or the Court of Appeal";

part two is to exclude;

to supplement the third part after the word "Right" with the word "Applicant", and to replace the words "state fee for the grant of a patent (declarative patent) for an invention or a utility model patent" with the words "to them the state fee for registration of the invention (utility model)";

in the fourth part, replace the words "the central executive authority ensuring the formation of the state policy in the field of intellectual property" with the words "Institutions";

in part five and first sentence of part six, replace the word "document of payment" with the word "payment of";

the second paragraph of the second part of the seventh should be stated in the following wording:

"In case the Appeals Chamber satisfies the objection in whole or in part from the reasons of violation of the procedure for conducting the expertise, the fee for filing the objection shall be returned, and the application shall be returned to the expertise institution for conducting the repeated expertise";

part eight is to exclude;

part nine, after the word "decision", to be completed with the words "or copies thereof";

to supplement part ten with the following part:

"10. After approval of the decision of the Court of Appeal, the Institution shall publish on its official website and in the Bulletin the information about the decision determined by it";

25) in paragraph one of Article 25:

in the first paragraph, replace the words "after its state registration" with the words "after the state registration of the invention (utility model)";

the third paragraph should be set forth in the following wording:

"A utility model patent shall be issued under the responsibility of its owner for the compliance of the utility model with the patentability conditions";

26) Article 26 shall be deleted;

27) the third part of Article 27 shall be redrafted as follows:

"3. The owner of a patent for a classified invention (utility model) within one year from the date of receipt of the decision of the State Expert on declassification of the invention (utility model) shall have the right to file a request for a patent for an invention (utility model) with the Institution for the period remaining until the expiration of the patent for a classified invention (classified utility model). In such case, the EIF shall make appropriate amendments to the Register, publish the state registration of the invention (utility model) and grant a patent in accordance with Articles 22, 23 and 25 of this Law, provided that the relevant fees and state duty are paid;

28) To supplement Section VI with Article 27<sup>1</sup> as follows:

"Article 27<sup>1</sup>. Additional Protection of Rights to Inventions

1. The owner of a patent for an invention, the object of which is the active substance of a medicinal product, the process of obtaining a medicinal product or the use of a medicinal product, animal protection agent, plant protection agent, the introduction of which into circulation in Ukraine is provided by the relevant competent authority in accordance with the laws of Ukraine, has the right to extend the period of validity of intellectual property rights to such an invention (additional protection), which is certified by a certificate.

The certificate of additional protection shall be issued upon request of the patent owner. A fee shall be paid for filing an application.

Rights for additional protection shall be limited to a product (active substance or a set of active pharmaceutical ingredients of a medicinal product), the introduction into circulation of which in Ukraine is permitted by the relevant competent authority in accordance with the legislation of Ukraine, and its use in accordance with the quality of a medicinal product, animal protection product, plant protection product within the rights granted by the respective patent on the date of filing a petition for the issue of a certificate of additional protection, and shall be effective on the following occasions.

The owner of a patent for an invention, the object of which is a medicinal product, animal protection agent, plant protection agent, has the right to extend the validity of property rights of intellectual property, if an application for permission of the competent authority to introduce a medicinal product, animal protection agent, plant protection agent into civil circulation in Ukraine was filed within one year from the date of filing such an application for the first time in any country.

2. The term of additional protection is equal to the period between the date of filing an application with the Institution and the date when the patent owner received the first permission of the competent authority, reduced by five years.

The period of additional protection may not exceed five years.

For an invention, the subject matter of which is the active substance of a medicinal product, in respect of which studies have been carried out in the field of application for children, the results of which are reflected in the information about the medicinal product, for which a permission of the relevant competent authority has been issued, the periods of additional protection specified in paragraphs 1 and 2 of this Part shall continue for six months.

3. An application for additional protection must be received by the Foundation within six months from the date of publication of the information on the state registration of the invention or the date of issue of the first authorization by the relevant competent authority (whichever is later). The documents confirming the right of the patent owner to additional protection shall be attached to the application.

An application shall be considered by the expert authority in the procedure defined by the Federal Executive Body, which ensures the formation of state policy in the field of intellectual property.

4. If the submitted documents confirm the right of the patent holder for additional protection, the Institution shall register the additional protection by entering the relevant information into the Register. Simultaneously with the state registration of additional protection, the Office publishes information about such registration in the Bulletin. The Institution issues a certificate of additional protection within one month after the state registration of additional protection.

5. The rights and obligations of the owner of the additional protection certificate shall be the same as those of the owner of the corresponding patent, subject to the restrictions set forth in part 1 of this Article.

6. Provided that the requirements specified in this part are met, such use of the invention during the term of its additional protection shall not be considered a violation of the rights to the invention:

1) Manufacturing of a product or a medicinal product containing a product with the use of a patented invention for export to third countries, as well as other actions, which in accordance with this Law are recognized as use of the invention if they are necessary for manufacturing of the product or medicinal product containing the product for export to third countries;

2) manufacturing of a product or a medicinal product containing a product with the use of the patented invention not earlier than six months prior to the expiration of the term of additional protection for the purpose of its storage for putting into circulation after the expiration of the term of additional protection, as well as other actions, which according to this Law are recognized as use of the invention if they are necessary for manufacturing of the product or medicinal product containing the product and its storage not earlier than the mentioned term.

A person who intends to manufacture a product or a medicinal product containing a product using a patented invention during the period of additional protection is obliged to put the information label "UA Export" on the product during its manufacture.

A person who intends to manufacture a product or medicine containing a product using a patented invention within the term of additional protection shall notify the Establishment and the owner of the additional protection certificate of such intention in writing no later than three months before the beginning of use of the invention.



The applicant's notification shall indicate his address, methods of use of the invention and the purpose of such use, number and date of issue of the certificate of additional protection. In case of manufacture of a product or medicine containing the product for export, the communication shall also indicate the authorization number of the competent authority of the third country in which the export is planned. The institution shall ensure publication of information contained in the communication.

The manufacturer of a product or a medicinal product containing a product shall be obliged to obtain written guarantees from all persons who by its order store, export or perform other actions, which according to this Part are not recognized as a violation of the rights to invention, that such product or medicinal product containing a product will not be used otherwise than for export or storage in accordance with the procedure established by law.

7. A fee shall be paid for each full or partial year of validity of the additional protection certificate in accordance with the procedure defined in Part two of Article 32 of this Law.

8. Termination of the validity of the additional protection certificate and recognition of its invalidity, protection of rights of the holder of the additional protection certificate shall be carried out in the procedure established for the respective patent;

29) The title of Section V shall be set forth in the following wording:

#### **"Section V**

#### **RIGHTS AND DUTIES OF SUBJECTS OF INFORMATION (utility model) Rights";**

30) in Article 28:

in the title, replace the word "patent" with the words "state registration of the invention (utility model)";

part one to read as follows:

"1. The rights arising from the state registration of an invention (utility model) shall be effective from the date following the date of state registration of the invention (utility model).

The rights arising from the state registration of a secret invention (utility model) shall be effective from the date of entry of information about the secret invention (utility model) in the relevant Register;

in part two:

the first paragraph should be set out in the following wording:

"2. The patent owner shall have the right to use the invention (utility model) at his own discretion, if such use does not infringe the rights of other patent owners";

in the third paragraph:

in the first sentence, replace the words "a patent owned by more than one person shall be determined by agreement" with the words "the owners of a patent owned by more than one person shall be determined by agreement";

in the second sentence, replace the words "such an agreement" with the words "such an agreement" and the words "ownership" with the words "rights";

to supplement paragraphs fourteenth to seventeenth with the following:

"The right of the patent owner of an invention the subject matter of which is biological material shall extend to any other biological material with the same characteristics obtained from such biological material by reproduction or replication in a similar or different form.

The right of the patent owner for an invention subject to a biological material process extends to biological material directly obtained by the process and to any biological material with the same characteristics obtained from it by reproduction or duplication in similar or other form.

The right of the patent owner for an invention, the subject matter of which is a product with genetic information, shall extend to any material (other than that specified in the eleventh paragraph three of Article 6 of this Law) that contains that product and in which genetic information performs its function.

The rights set forth in paragraphs 15 and 16 of this Part do not apply to biological material derived from the cultivation or multiplication of biological material placed on the market by the patent owner, where such multiplication or multiplication necessarily results from the use of the biological material for which it was marketed, provided that the material derived is not subsequently used for other cultivation or multiplication;

in part three:

in the first paragraph, replace the words "Exclusive property rights of the owner of a patent (declarative patent) for a secret invention and a declarative patent for a secret utility model" with the words "Exclusive property rights of intellectual property of the owner of a patent for a secret invention (secret utility model)";

in the second paragraph, replace the words "The owner of a patent (declarative patent) for a secret invention or a declarative patent for a secret utility model" with the words "The owner of a patent for a secret invention (secret utility model)";

supplement part four with the words "(utility model)";

part five to be redrafted as follows:

"5 The patent shall grant its owner the exclusive property right to prevent the use of the invention (utility model), including prohibiting such use, unless such use is recognized as a violation of rights arising from the state registration of the invention (utility model) in accordance with this Law;

in part six, replace the word "ownership right" with the words "exclusive property rights of intellectual property";

in the second sentence of the second part, the word "institution" should be replaced with the words "the central executive authority ensuring the formation of state policy in the field of intellectual property";

in part nine:

in part nine: in paragraph one:

in the first sentence, replace the words "a patent (declarative patent) for a secret invention or a patents for a secret utility model" with the words "a patent for a secret invention (secret utility model)";

in the second sentence, replace the words "patent" with the words "actions of property rights of intellectual property rights for the invention (utility model)";

delete the words "about payments" in the first sentence of the second paragraph;

31) Article 29 should be redrafted as follows:

"Article 29: Obligations Arising from the State Registration of an Invention (a Utility Model)

1. The patent holder shall pay the appropriate fees for the maintenance of the effect of the intellectual property rights for the invention (utility model) and to use in good faith the rights arising from the state registration of the invention (utility model);

32) in Article 30:

the title should be set forth in the following wording:

"Article 30. Restrictions on intellectual property rights to an invention (utility model)";

in the first paragraph of the first part of the first part, replace the words "the date of publication of information about the patent grant" with the words "the date following the date of state registration of the invention (utility model)";

in the third part:

in the first sentence of the first sentence, replace the words "the patent (declarative patent) owner in case of his unjustified refusal to grant a license to use the invention (utility model)" with the words "the patent owner";

to supplement paragraph 3 with the words "other persons";

in the first paragraph of the first part of the fourth part, replace the words "The owner of a patent (declarative patent) for a secret invention or a declarative patent for a secret utility model" with the words "The owner of a patent for a secret invention (secret utility model)";

33) in Article 31:

in part one:

33) in Article 31: in Part One: in the first paragraph, the words "for commercial purposes" shall be deleted;

33. In Article 31: in the first part, in the first paragraph, the words "for commercial purposes" shall be deleted; and in the second paragraph, after the word "invention", the words "(utility model)" shall be added;

in the text of the part of the part, replace the word "preuse" with the word "previous user";

in the first sentence of part four:

in the first sentence of Part Four: replace the word "patent" with the words "state registration of invention (utility model)";

after the word "invention", add the words "(utility model)";

in the first sentence of Part Four: replace the word "patent" with the words "(utility model)"; after the word "invention" add the words "(utility model)"; replace the words "are granted by patent" with the words "arise from the state registration of the invention (utility model)";

to supplement with the sixth part as follows:

"6. It shall not be defined as violation of rights arising from additional protection of rights to inventions defined in Article 27<sup>1</sup> of this Law, manufacture of a product or a medicinal product containing a product with the use of a patented invention for export to third countries, as well as other actions, which in accordance with this Law are recognized as use of the invention if they are necessary for manufacture of the product or medicinal product containing a product for export to third countries;"

34) the title of Section VI should be given in the following wording:

## **"SECTION VI**

### **TERMINATION OF STATE REGISTRATION AND RIGHTS INVALID"**

35) in Article 32:

the title and part one to read as follows:

"Article 32. Termination of state registration of an invention (utility model)

1. The patent holder may at any time waive the rights arising from the state registration of the invention (utility model), in whole or in part within the limits of the published claim for the invention (utility model) on the basis of an application filed with the Institution.

Partial waiver is made by exclusion of independent claims or exclusion of one or more independent claims and dependent claims subordinate to such independent claims, or by amendment of the independent claim(s) if such exclusion and/or amendment reduces the scope of legal protection afforded by the state registration

An independent claim may be changed by amending or adding features to the existing features of the claim. Only the features contained in dependent claims subordinate to such an independent claim may be amended.

The Institute shall conduct an expert examination of the new version of the claims for compliance with the requirements of this Article and Article 7 of this Law. A fee shall be paid for the expert examination.

Full or partial waiver of rights shall take effect from the date of publication of information about it in the Bulletin. The form of an application and the procedure for its consideration shall be determined by the central executive authority that ensures formation of the state policy in the field of intellectual property. A fee shall be paid for filing an application.

No rights resulting from the state registration of the invention (utility model) may be fully or partially waived without warning to the person who has been granted the right to use the invention under the license contract registered with the Foundation, as well as in case of seizure of property described for debts, if it includes the rights resulting from the state registration of the invention (utility model);

in the second paragraph:

in the first paragraph, replace the word "his" with "their";

in the second sentence of the second sentence, replace the word "patent granting" with the word "state registration of the invention (utility model)";

in the text, replace the words "the effect of a patent", "the effect of a patent" and "patent" in all cases with the words "the effect of intellectual property rights for an invention (utility model)" in the corresponding case;

The sixth paragraph should be set forth in the following wording:

"No fee shall be paid for the support of the intellectual property rights for a secret invention (secret utility model);

to supplement the seventh paragraph with the following:

"If the time limit for payment of the fee for maintenance of the effect of the intellectual property rights for an invention (utility model) is missed, the rights of the applicant with respect to a patent shall be restored, if only within 12 months after the expiration of the time limit a relevant application is filed and the fee for filing such an application and the fee for maintenance of the effect of the intellectual property rights for an invention (utility model) shall be paid. The Institution shall publish information on restoration of the applicant's rights concerning the patent in Bulletin;

36) in Article 33:

the title should be set forth in the following wording:

"Article 33. Recognition of the rights to an invention (utility model) as invalid in a judicial procedure";

in part one:

the first paragraph should be redrafted as follows:

"1. The rights to an invention (utility model) may be invalidated by a court of law in whole or in part in a case";

in paragraph "d", replace the words "patent issue" with the words "state registration of the invention (utility model)";

part two shall be deleted;

in part three, replace the words "of a patent or part thereof invalid" with the words "rights to an invention (utility model) invalid in whole or in part in a judicial procedure";

part four should be redrafted as follows:

"(4) Rights to an invention (utility model) that have been declared invalid in whole or in part by a court of law shall be deemed not to have entered into force from the date of publication of information on state registration of the invention (utility model).

The recognition of rights to an invention (utility model) is partially invalidated by excluding independent claims or by excluding one or more independent claims and dependent claims subordinate to such independent claims or by amending the independent claim(s),

unless such exclusion and/or amendment reduces the scope of legal protection granted by the state registration.

An independent claim may be modified by amending the features of such a claim or by adding features to the claim. Only the features contained in dependent claims subordinate to such an independent claim may be amended;

37) Section VI should be completed with Articles 33<sup>1</sup> and 33<sup>2</sup> as follows:

"Article 33<sup>1</sup>. The recognition of the rights to the invention (utility model) as invalid by the Chamber of Appeal

1. Any person may file a reasonable application to the Chamber of Appeal to recognize the rights to the invention (utility model) as invalid in whole or in part on the grounds that the invention (utility model) does not meet the conditions of patentability established by this Law. The application may be filed through an intellectual property representative (patent attorney) acting on the basis of a power of attorney.

The recognition of rights to an invention (utility model) is partially invalidated by excluding independent claims or by excluding one or more independent claims and dependent claims subordinate to such independent claims or by amending the independent claim(s), unless such exclusion and/or amendment reduces the scope of legal protection granted by the state registration.

An independent claim may be modified by amending the features of such a claim or by adding features to the claim. Only the features contained in dependent claims subordinate to such an independent claim may be amended.

2. An application for recognition of rights to the invention as invalid may be filed with the Court of Appeal within nine months from the date of publication of information on state registration of the invention. A fee shall be paid for filing the application. The application shall be considered filed if the fee is received in the account of the expert examination institution.

3. An application for invalidation of the rights to a useful model may be filed with the Chamber of Appeal during the whole term of validity of property rights to a useful model and after termination of their validity. A fee shall be paid for filing the application. The application shall be considered to be filed in case the fee is paid to the account of the expert examination institution.

4. The parties to the case on recognition of the rights to the invention (utility model) as invalid in the Court of Appeal shall be the person who filed an application for recognition of the rights to the invention (utility model) as invalid and the owner of the patent.

5. The parties shall have equal rights to provide evidence, to study it and to communicate its persuasiveness to the Chamber of Appeal.

6. The Chamber of Appeal does not verify the authenticity of the submitted evidence, and the responsibility for the authenticity of the provided information lies with the person who provided it. In case of reasonable doubts in the Board of the Chamber of Appeal concerning reliability of information provided in the provided documents, the Board shall have the right to request confirmation of such information.

7. Each party shall prove the circumstances to which it refers as the basis of its claims or objections.

8. Requirements to the application for recognition of the rights to the invention (utility model) as invalid, conditions and procedure for its consideration shall be defined by the central executive authority, which ensures formation of the state policy in the field of intellectual property.

9. An application for recognition of rights to the invention (utility model) as invalid shall be considered according to the rules of the Chamber of Appeal within four months from the date of receipt of the application, provided that the fee for its submission is paid. This period may be extended by two months at the request of the party to the application for recognition of the rights to the invention (utility model) as invalid and on condition that the fee is paid. The time limit for consideration of an application may be suspended on the grounds determined by the central executive body that ensures the formation of the state policy in the field of intellectual property, but not more than for two months.

10. As a result of consideration of the application, the Court of Appeal makes a reasoned decision, which is approved by the order of the Institution and sent to the parties.

11. The parties can appeal against the decision of the Court of Appeal approved by the Institution within two months from the date of its receipt.

12. The decision of the Chamber of Appeals shall enter into force from the date of its approval by the Institution's order and shall be fully published on the Institution's official website.

If the rights to an invention (utility model) are declared invalid, the Foundation informs about it in the Bulletin.

13. The rights to the invention (utility model), which have been declared invalid by the Chamber of Appeal, shall be deemed not to have entered into force on the day following the day of state registration of the invention (utility model).

Article 33<sup>2</sup>. Conclusion as to whether a utility model meets the conditions of patentability

Any person may submit a motivated application to the Institution to conduct an examination of a utility model for compliance with the conditions of patentability. A fee is paid for filing an application.

An appeal shall be considered by the expert institution in accordance with the procedure established by the central executive authority ensuring formation of the state policy in the field of intellectual property. 2.

(3) The Institute shall notify the owner of a utility model patent of the receipt of an application after the amount of the fee paid for filing the application has been received by the Institute.

4. The report on the compliance of a utility model with the patentability conditions shall be sent to the person filing the patent application and the patent owner.

5. The Institution's conclusion on the compliance with the conditions of patentability may be invoked by a person, who filed an application, in case of appeal to the court or the Court of Appeal to invalidate the rights to a useful model;

38) in Article 34, paragraph 1, the words "rights of the patent owner" shall be replaced by the words "rights";

39) in Article 35, paragraph 2, paragraph 8, the words "prior use" shall be replaced with the words "previous user";

40) in Article 36:

in the first part, replace the words "grant of patents for inventions (utility models)" with the words "registration of inventions (utility models)";

part three to read as follows:

"The funds received from payment of the state duty for registration of inventions (utility models) shall be credited to the budgets in accordance with the procedure established by the Budget Code of Ukraine";

41) paragraph two of Article 37, after the words "the application shall be filed", to be completed with the words "with the International Bureau of the World Intellectual Property Organization in compliance with the condition specified in paragraph one of this Article, or";

42) in the text of the Law:

the word "owner" in all cases and numbers shall be replaced by the word "owner" in the corresponding case and number;

replace the words "its official gazette" and "official bulletin" in all decades with the word " Bulletin " in the corresponding box.

3. Decree of the Cabinet of Ministers of Ukraine dated January 21, 1993 No. 7-93 "On State Duty" (Bulletin of Verkhovna Rada of Ukraine, 1993, No. 13, Art. 113 with subsequent amendments):

1) Paragraph two of subparagraph "c" of paragraph 6 of Article 3 should be set forth in the following wording:

"For registration of the invention (utility model);

2) in Article 6, paragraph 1, the words "for actions related to the issuance of protection documents (patents and certificates) for intellectual property objects and for actions related to the maintenance of patents for plant varieties" shall be deleted.

## II. Final and transitional provisions

1. This Law shall enter into force from the day following the day of its publication.

2. Until the legal acts adopted before entry into force of this Law are brought into force, they shall be effective in accordance with this Law to the extent not contradicting this Law.

3. The expertise of applications for inventions (utility models), the expertise of which is not completed as of the date of entry into force of this Law, shall be conducted in the procedure established by this Law. The compliance of objects with the conditions for granting legal protection (patentability) shall be determined in accordance with the legislation in force on the date of filing the application.



4. The patents issued on applications received by the Institution before the effective date of this Law shall be valid.

5. An application for invalidation of intellectual property rights to an invention (utility model) may be filed with the Chamber of Appeal for any invention (utility model), on which the intellectual property rights, in particular, the invention (utility model), the right to which has been acquired on the date of entry into force of this Law. The compliance of objects with the conditions for granting legal protection (patentability) shall be determined in accordance with the legislation in force on the date of application.

6. The Cabinet of Ministers of Ukraine within six months from the day this Law enters into force:

to bring its regulatory legal acts into conformity with this Law;

to ensure that ministries and other central bodies of executive power bring their regulatory and legal acts into conformity with this Law.

<b>President of Ukraine</b>	<b>Volodymyr ZELENSKIY</b>
<b>Kyiv</b> <b>21 July 2020</b> <b>№ 816-IX</b>	