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Implementation of Convention on Grant of European Patents Act

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RT I 2002, 38, 233

Entry into force pursuant to section 21

Amended by the following acts

Passed	Published	Entry into force
17.12.2003	RT I 2003, 88, 594	08.01.2004
10.03.2004	RT I 2004, 20, 141	01.05.2004
17.12.2008	RT I 2009, 4, 24	01.03.2009
07.12.2011	RT I, 28.12.2011, 1	01.01.2012

§ 1. Scope of application of Act

This Act provides for the legal status of European patents and patent applications in Estonia and regulates legal relationships arising from the accession of the Republic of Estonia to the Convention on the Grant of European Patents (European Patent Convention) which do not fall within the scope of application of the Patents Act, other Acts or the specified Convention.

§ 2. Definitions

For the purposes of this Act:

- 1) 'Convention' means the Convention on the Grant of European Patents (European Patent Convention), signed in Munich on 5 October 1973;
- 2) 'Organisation' means the European Patent Organisation established in accordance with the Convention;
- 3) 'European Patent Office' means a body of the Organisation carrying out tasks related to the grant of European patents;
- 4) 'Contracting State' means a contracting state of the Convention;
- 5) 'Estonian Patent Office' means, within the meaning of the Convention, the central industrial property office in Estonia;
- 6) 'European patent' means a patent granted by the European Patent Office in accordance with the Convention;
- 7) 'European patent application' means an application for a European patent filed in accordance with the Convention;
- 8) 'applicant' means a natural or legal person applying for a European patent;
- 9) 'proprietor of a patent' means a proprietor of a European patent;
- 10) 'national patent' means a patent granted in accordance with the Patents Act;
- 11) 'national patent application' means an application for a national patent filed in accordance with the Patents Act;
- 12) 'utility model' means an invention registered in accordance with the Utility Models Act.

§ 3. Filing of European patent applications

(1) European patent applications may be filed with the European Patent Office or with the Estonian Patent Office which forwards the applications to the European Patent Office.

(2) A European divisional application shall be filed directly with the European Patent Office. For the purposes of this Act, a 'European divisional application' means a patent application which is separate from a European patent application.

§ 4. Language of European patent application

A European patent application shall be filed in one of the official languages of the European Patent Office (English, French, German) or, under the conditions provided for in the Convention, in any other language. [RT I 2009, 4, 24 - entry into force 01.03.2009]

§ 5. Legal status of European patent application

A European patent application in which the Republic of Estonia is indicated as the designated state and the filing date of which has been determined according to the Convention, shall be legally equivalent to a national patent application filed on the same date, regardless of the outcome of the proceedings. Where the European patent application enjoys priority of an earlier date as compared to the date of filing, such priority shall also have effect in Estonia.

§ 6. Provisional protection based on European patent application

Provisional protection provided for in the Patents Act shall be conferred to an invention contained in a published European patent application, in which the Republic of Estonia is indicated as the designated state, as of the date on which the applicant forwards a translation of the patent claims of the published European patent application into the Estonian language to a person who uses the invention in Estonia or as of the date on which the Estonian Patent Office publishes the specified translation, if the translation has been forwarded to the Estonian Patent Office and the state fee payable for the publication of the translation has been paid.

§ 7. Legal status of European patent

(1) A European patent in which the Republic of Estonia is indicated as the designated state shall be legally equivalent to a national patent as of the date of the mention of its grant by the European Patent Office, provided that the proprietor of the patent submits a translation of the specification of the European patent into the Estonian language to the Estonian Patent Office within three months as of the date of mention of the grant, and pays the state fee prescribed for publication of the translation. The term for submission of the translation may be extended by two months by paying a supplementary state fee for the extension.

(2) Where the proprietor of a patent fails to submit the translation specified in subsection (1) of this section by the due date or, upon submission of the translation, fails to pay the state fee prescribed for publication of the translation or, upon extension of the term for submission of the translation, fails to pay the prescribed supplementary state fee, the European patent shall be deemed to be void *ab initio* in Estonia.

(3) Where the Contracting States have agreed to replace the requirement for submission of a translation of the patent specification with the requirement for submission of a translation of patent claims, the proprietor of the patent shall submit the translation of the patent claims pursuant to the procedure provided for in subsection (1) of this section. In this case, the provisions of subsection (2) also apply.

(4) Where the Contracting States have agreed to waive the requirement for submission of a translation of the patent specification or patent claims, the proprietor of the patent shall, in case of an administrative dispute or court action relating to a European patent, submit the translation of the patent specification into the Estonian language at his or her own expense at the request of the administrative authority resolving the dispute, court or assumed infringer of patent rights, within three months after receiving the request. Upon failure to submit the translation, the court may declare the European patent void *ab initio* in Estonia.

§ 8. Authentic text of European patent application and European patent specification

(1) The text of a European patent application or European patent specification in the language of the proceedings before the European Patent Office is the authentic text.

(2) Where the extent of legal protection of an invention conferred by a European patent application or a European patent specification in the translation into the Estonian language is narrower than that conferred by it in the language of the proceedings before the European Patent Office, the Estonian translation is deemed to be the authentic text, except for revocation proceedings regarding a patent in a court. Upon revocation proceedings regarding a patent, a court may, for the purpose of the proceedings, request a translation into the Estonian language which is authentic with the text in the language of the proceedings before the European Patent Office.

§ 9. Correction of translation of European patent application or European patent specification

(1) An applicant for or proprietor of a patent may correct the translation of a European patent application or European patent specification at any time.

(2) The corrected translation takes effect as of the date of communication to the person using the invention in Estonia, or as of the date when the Estonian Patent Office publishes a notice concerning publication of the corrected translation in its official gazette.

(3) Any person who in good faith is using or has made serious and effective preparations for using an invention contained in a European patent application or in a European patent, and the use of the invention would not

constitute infringement of patent rights in the original translation may, after the corrected translation takes effect, continue to use the invention in the same manner without payment.

(4) The right to use an invention which is provided for in subsection (3) of this section may be transferred to another person only with an enterprise or a part thereof, which is covered by the specified right of use.

§ 10. Maintenance of European patent

(1) For maintaining a European patent valid in Estonia, the proprietor of the patent shall pay a state fee for maintenance for each year of validity.

(2) The state fee for maintenance shall be paid to the Estonian Patent Office as of the year of validity following the mention of the grant of the European patent by the European Patent Office.

(3) The state fee for maintenance shall be paid on the due date of payment or within six months before the due date of payment. The last day of the calendar month during which the year of validity begins is deemed to be the due date of payment. The date of filing a European patent application is deemed to be the date when the year of validity begins.

(4) The state fee for maintenance may be paid also up to six months after the due date of payment, by paying a supplementary state fee.

(5) If the period between the date on which the grant of a European patent is mentioned by the European Patent Office and the due date of payment of the state fee for maintenance for the following year of validity is less than two months, the proprietor of the patent is entitled, within two months as of the mention of the grant of the European patent, to pay the state fee for maintenance for the following year of validity without the supplementary state fee specified in subsection (4) of this section.

(6) Upon failure to pay the state fee for maintenance in the established amount within the term provided for in subsections (3) or (4) of this section, the European patent becomes invalid in Estonia as of the due date of payment specified in subsection (3).

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

§ 11. Conversion of European patent application into national patent application and registration application of utility model

(1) An applicant may request the conversion of a European patent application in which the Republic of Estonia is indicated as the designated state into a national patent application or a registration application of a utility model, or both, where the European patent application is deemed to be withdrawn for the reason that the European patent application or the translation of the application into the language of the proceedings has not arrived in the European Patent Office in due time.

(2) An applicant for or a proprietor of a patent may request the conversion of a European patent application in which the Republic of Estonia is indicated as the designated state into a registration application of a utility model if the European patent application is deemed to be withdrawn by the European Patent Office or has been withdrawn by the applicant or if the European Patent Office has rejected the European patent application or revoked the European patent.

(3) A European patent application may not be converted into a registration application of a utility model if the invention contained therein is included among the inventions not protected as utility models as provided for in section 6 of the Utility Models Act.

(4) A European patent application containing a group of inventions linked together as to form a single general inventive concept may be converted into several independent registration applications of a utility model.

(5) The Estonian Patent Office shall notify the applicant of the receipt of a request for the conversion of a European patent application into a national patent application or a registration application of a utility model and of the receipt of a copy of the European patent application, forwarded by the European Patent Office, and establish a term of three months for submission of a translation of the European patent application into the Estonian language. At the request of the applicant, the term for submitting the translation may be extended by two further months.

(6) Upon submission of the translation specified in subsection (5) of this section, the applicant shall pay to the Estonian Patent Office the state fee for acceptance of the European patent application for national proceedings as a national patent application or registration application of a utility model.

(7) Where an applicant fails to submit the translation specified in subsection (5) of this section by the due date or fails to pay the state fee specified in subsection (6) of this section upon submission of the translation or within

one month after submission of the translation, the request for conversion of a European patent application into a national patent application or registration application of a utility model is deemed to be withdrawn.

§ 12. Prohibition on simultaneous protection

(1) Where a European patent in which the Republic of Estonia is indicated as the designated state and a national patent having the same filing date or, where priority has been claimed, the same priority date, have been granted to the same person or his or her legal successor, the legal effect of the national patent shall cease to exist to the extent that the invention is covered by the European patent as of the day:

- 1) of expiry of the term for filing an opposition to the European patent, provided that no opposition has been filed to the European patent, or
- 2) on which a final decision to maintain the European patent, resulting from the opposition procedure, enters into force.

(2) Where, in the Estonian Patent Office, a national patent application is pending which belongs to a person or his or her legal successor to whom a European patent has been granted in which the Republic of Estonia is indicated as the designated state and which has the same filing date or, where priority has been claimed, the same priority date, the national patent application shall be rejected to the extent that the invention is covered by the European patent.

(3) The prohibition on simultaneous protection does not apply to utility models.

§ 13. Legal consequences of revocation or amendment of European patent

(1) Where, as a result of an opposition procedure before the European Patent Office, a decision to revoke or amend is made regarding a European patent in which the Republic of Estonia is indicated as the designated state, the decision is legally binding on the Republic of Estonia.

(2) Where a European patent is amended, the proprietor of the patent shall, within three months after the corresponding notice regarding the amendment is published in the Official Journal of the European Patent Office, submit to the Estonian Patent Office a translation of the amended specification of the European patent into the Estonian language and pay the state fee prescribed for publication of the translation. The term for submission of the translation may be extended by two months by paying a supplementary state fee for the extension. Subsection 7 (2) of this Act applies to the translation.

(3) The Estonian Patent Office publishes a notice concerning the revocation or amendment of a European patent in its official gazette.

§ 14. Suspension of national court proceedings

(1) If, simultaneously with national court proceedings on a matter relating to the validity of a European patent or to the protection of the rights of the proprietor of a patent, the European Patent Office has commenced proceedings regarding an opposition to the European patent, the national court proceedings shall be suspended until publication of the notice specified in subsection 13 (3) of this Act.

(2) National court proceedings shall be terminated upon revocation of a European patent or where a European patent is considered void pursuant to the provisions of section 7 or section 13 of this Act.

§ 15. Representation of proprietor of patent

Upon performance of procedures during national proceedings related to the maintenance of a European patent in Estonia, other than payment for the procedures relating to the national proceedings and maintenance of a European patent, the proprietor of the patent may be represented before the Estonian Patent Office solely by patent attorneys entered in the state register of patent attorneys and specialising in the legal protection of inventions and layout-designs of integrated circuits.

§ 16. Register of European patents valid in Estonia

(1) A register of European patents valid in Estonia (hereinafter register) is maintained for European patents that are under legal protection in Estonia in accordance with the provisions of this Act.

(2) The register is legally equivalent to the register of patents provided for in the Patents Act.

(3) Upon maintenance of the register, the provisions of the Patents Act apply subject to the specifications arising from this Act.

§ 17. Register entries

The following are register entries:

- 1) an entry regarding data characterising European patents in which the Republic of Estonia is indicated as the designated state;
- 2) an entry regarding validation of a European patent in Estonia;

- 3) an entry regarding maintenance of a European patent;
- 4) an entry regarding amendment of a European patent;
- 5) an entry regarding revocation of a European patent;
- 6) an entry regarding the end of validity of a European patent;
- 7) other entries with legal significance to a European patent, including entries regarding the transfer of rights, the registration of a licence or pledge and supplementary protection for medicinal products and plant protection products.

§ 18. State fees related to European patents

(1) State fees related to European patents are state fees for the procedures related to national proceedings regarding European patent applications and European patents, and for the maintenance of European patents, which are provided for in this Act. State fees related to European patents shall be used for covering the costs connected with the fulfilment of the tasks of the Estonian Patent Office arising from the Convention, including the costs of national proceedings regarding European patent applications and European patents and information technology development connected with the proceedings.

(2) According to the Convention, the Estonian Patent Office shall transfer to the European Patent Office a proportion, fixed by the Organisation, of all state fees for the maintenance of European patents received by the Estonian Patent Office.

(3) The amount received from state fees related to European patents shall, after the transfer of the proportion of the state fees for maintenance to the European Patent Office pursuant to subsection (2) of this section, cover the costs of the implementation of the Convention and of the national proceedings, and the total amounts received in the last three years shall not exceed the total of the specified costs by more than 10 per cent.

(4) If, under the provisions of subsection (3) of this section, the total of the received state fees for the last three years does not cover the costs or exceeds the total of costs of the same period by more than 10 per cent, new rates for the state fees shall be established.

§ 19. Legal and administrative co-operation

Pursuant to the provisions of the Convention and in the accordance with the implementing regulation to the Convention and section 2 of the Accession to the Convention on the Grant of European Patents Act (RT II 2002, 10, 40), the Estonian Patent Office shall communicate with the European Patent Office with regard to the information exchange and receipt of requests for legal assistance arising from the implementation of the Convention. In the cases specified in the Convention, courts and other Estonian administrative agencies shall communicate with the European Patent Office through the Estonian Patent Office.

§ 20. Application of Act

(1) The following shall be established by a regulation of the Minister of Justice:

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

- 1) the procedure for filing European patent applications with the Estonian Patent Office and forwarding the applications to the European Patent Office;
- 2) the procedure for submission of the translations specified in section 6, subsection 7 (1) and subsection 13 (2) of this Act to the Estonian Patent Office and the procedure for giving notice of their publication in the official gazette of the Estonian Patent Office;
- 3) the procedure for converting European patent applications into national patent applications and registration applications of a utility model.

(2) The procedure for transfer of the state fees related to European patents to the account of the Estonian Patent Office and procedure for transfer of the state fees for the maintenance of European patents specified in subsection 18 (2) of this Act to the European Patent Office shall be established by the Minister of Finance.

(3) In matters relating to national proceedings regarding European patents which are not regulated by this Act or other provisions of national legislation, the Estonian Patent Office, courts and any other Estonian administrative agencies shall act in accordance with the decisions of the bodies of the Organisation on the same or similar matters.

[RT I 2003, 88, 594 - entry into force 08.01.2004]

§ 21. Entry into force of Act

This Act enters into force on the day when the accession of the Republic of Estonia to the Convention enters into force.