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Conseil des aspects de droits de propriété
intellectuelle qui touchent au commerce

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PRINCIPALES LOIS ET RÉGLEMENTATIONS CONSACRÉES À LA PROPRIÉTÉ INTELLECTUELLE NOTIFIÉES AU TITRE DE L'ARTICLE 63:2 DE L'ACCORD

RÉPUBLIQUE TCHÈQUE

Addendum

Par une communication de sa Mission permanente, datée du 23 novembre 2000, la République tchèque a notifié, au titre de l'article 63:2 de l'Accord, le texte ci-après¹ de la Loi n° 116 de 2000 portant modification de certaines lois sur la protection de la propriété industrielle, qui est entrée en vigueur en mai 2000, à l'exception de certaines nouvelles dispositions relatives au brevet européen qui entreront en vigueur le 1^{er} juillet 2002. La loi modifie:

- la Loi n° 527 de 1990 sur les inventions, les dessins ou modèles industriels et les propositions de rationalisation (distribuée sous la cote IP/N/1/CZE/I/1);
- la Loi n° 137 de 1995 sur les marques (distribuée sous la cote IP/N/1/CZE/T/1);
- la Loi n° 529 de 1991 sur la protection des topographies de semi-conducteurs (distribuée sous la cote IP/N/1/CZE/L/1); et
- la Loi n° 478 de 1992 sur les modèles d'utilité (distribuée sous la cote IP/N/1/CZE/I/3).

¹ En anglais seulement.

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LAW

of 6 April 2000,

amending some Acts on the Protection of Industrial Property

The Parliament has adopted the following Law of the Czech Republic:

PART ONE

**Amendment to the Act on Inventions, Industrial Designs
and Rationalisation Proposals**

Article I

The Law № 527/1990 of Coll., Act on Inventions, Industrial Designs and Rationalisation Proposals, as amended by the Law № 519/1991 of Coll., is amended as follows:

1. In § 3, Subsection reads as follows:

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

- a) discoveries, scientific theories and mathematical methods;
- b) aesthetic creations;
- c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- d) presentation of information.”

2. In § 3, Subsection 3 and 4 are added, having the following wording:

“(3) The patentability of the subject-matter or activities referred to in the Subsection 2 is excluded only to that extent to which an application or a patent relates to such subject-matter or activities as such.

(4) Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of Subsection 1. This provision shall not apply to products, in particular substances or compositions, for use in any of the above-mentioned methods.”

3. In § 4 the letter a) reads:

- a) inventions, the exploitation of which would be contrary to public order or morality; this fact may not be concluded merely because the exploitation of the invention is prohibited by law;”

4. In § 4, the letter b) is deleted.

The existing letter c) is designated as letter b).

5. In § 4 the letter b) reads:

b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes and products thereof.”

6. In § 5, Subsection 2 reads:

“(2) The state of the art shall be held to comprise everything made available to the public by means of written or oral description, by use or in any other way, prior to the date from which the right of priority (§ 27) belongs to the applicant.”

7. In § 5, the second sentence of the Subsection 3 is replaced by the following sentence: “This provision shall apply also to the international applications of inventions with the earlier right of priority, where the Office acts as a designated office,^{1a)} and for the European patent applications (§ 35a) with the earlier right of priority, where the Czech Republic is a validly designated state.”

8. The footnote № 1a) reads:

“^{1a)} Article 2 Subsection (xiii) of the Patent Co-operation Treaty published in the communication of the Federal Ministry of Foreign Affairs № 296/1991 of Coll. , on Patent Co-operation Treaty and the related Implementing regulations.”.

9. In § 5, after the Subsection 3, the new Subsection 4 is inserted if the following wording:

“(4) The provisions of Subsections 1 to 3 shall not exclude the patentability of any substance or composition, for use in a method referred to in § 3, Subsection 4, provided that its use for this method is not comprised in the state of the art.”

The existing Subsection 4 is designated as Subsection 5.

10. § 7 inclusive of its title reads:

“§7

Industrial application

An invention shall be considered as susceptible of industrial application, if its subject-matter can be made or used in any kind of industry, agriculture or other fields of the economy.”.

11. In § 11, Subsection 4, the words “or Slovak” are deleted.

12. § 12 reads:

“§12

(1) The extent of the protection conferred by a patent or an invention application shall be determined by terms of the patent claims. For the interpretation of the patent claims, the description and drawings shall be used.

(2) For the period up to grant of the patent, the extent of the protection conferred by the invention application shall be determined by the terms of the patent claims contained in the application published under § 31. However, the patent, as granted or as amended in the revocation procedure under § 23, shall determine retroactively the extent of the protection conferred by the invention application, in so far as the protection is not thereby extended.”

13. § 13 inclusive of the title and footnote № 1b) reads:

“§13

Prohibition of direct use

Nobody shall be allowed without the consent of patentee,

- a) to make, offer, put on the market or use a product which is the subject-matter of the patent, or to import or stock the product for this purpose, or to dispose with it by another manner;
- b) to use a process which is the subject-matter of the patent or to offer the process for use;
- c) to offer, put on the market, use or import or stock for this purpose the product obtained directly by a process, which is the subject-matter of the patent; identical products shall be held to have been obtained by means of the process, which is the subject-matter of the patent, when it is highly probable that the product was obtained by means of the process, which is the subject-matter of the patent, and in spite of reasonable effort, the patentee was not able to determinate the really used process; unless the contrary is proved. In proving the contrary, rights conferred by the trade secret protection ^{1b)} shall be respected.

^{1b)} § 124 of the Civil Procedure Code.”.

14. After § 13, new § 13a and 13b are inserted, with the following wording inclusive of the titles:

“§ 13a

Prohibition of indirect use

(1) Nobody shall be allowed without the consent of patentee, to supply or offer to supply a person, other than the person authorised to use the patented invention, with the means relating to an essential element of the invention and serving in this sense to put in into effect, when it is obvious in the circumstances, that these means are suitable and intended for putting the patented invention into effect.

(2) The Subsection 1 shall not apply when the means are products commonly existing on the market, unless the third person induces the purchaser to commit the act, prohibited by § 13.

(3) Persons performing the activities referred to in § 18, letter c) to e) shall not be considered as persons authorised to use the invention within the meaning of the Subsection 1.

§ 13b

Exhaustion of rights

The patentee shall not be entitled to prohibit third persons to dispose with the product, which is subject-matter of the protected invention, if the product has been put on the market in the Czech Republic by the patentee or with his consent, unless there exist the reasons for the extension of patent rights to the mentioned activities.”.

15. In § 18, Subsection 1, letter a), after the words “party to” are the words “the international treaties” replaced by the words, which inclusive of the footnote № 3 read as follows: “of the Paris Convention on the Protection of Industrial Property (thereinafter “Paris Convention”) ³⁾

³⁾ Paris Convention on the Protection of Industrial Property of 20 March 1883, revised in Brussels 14 December 1900, in Washington 2 June 1911, in the Hague 6 November 1925, in London 2 June 1934, in Lisbon 31 October 1958, and Stockholm 14 July 1967, published under the number 64/1975 of Coll.”.

16. In § 18, the Subsection 2 is deleted, as well as the denomination of the Subsection 1.

17. In § 18, at the end, the full stop is replaced by semicolon and the letters c) to e) are completed, with the following wording:

- “c) in the individual preparation of a medicament in a pharmacy based on a medical prescription including acts concerning the medicament so prepared;
- d) in acts done for non-commercial purposes;
- e) in acts relating to the subject-matter of the invention done for experimental purposes.”.

18. The footnote № 4) reads:

“⁴⁾ Law № 368/1992 of Coll., Act on Administrative Fees, as amended.”.

19. § 20 inclusive of the title reads:

“§ 20

Compulsory licence

(1) If the patentee unreasonably does not work the invention at all or works it insufficiently and he did not accept a due offer for a licence agreement in a reasonable term, the Office, upon the justified request, may grant a non-exclusive right to use the invention (compulsory licence); the compulsory licence may not be granted before the expiry of the period of 4 years as from the filing date of the invention application or 3 years as from the grant of the patent, whichever period expires last.

(2) The compulsory licence may be also granted, where an important public interest is endangered.

(3) The Office shall establish conditions, the scope and duration of the compulsory licence in its decision concerning the granting of the compulsory licence. The compulsory licence may be granted mainly for the supply of the home market.

(4) The compulsory licence may only be assigned within the transfer of the enterprise or its part, where the entrepreneur uses the invention based on the compulsory licence (thereinafter “compulsory licence holder”).

(5) The compulsory licence holder may waive the right to use the invention during the term of duration of the compulsory licence by notification made to the Office; on the day of delivery of the notification, the effect of decision on the grant of compulsory licence lapses.

(6) The Office shall revoke a compulsory licence or change conditions, scope or duration of the compulsory licence at the request of the owner of the patent in which he shall prove that conditions for the grant of compulsory licence have been changed and are unlikely to recur or the holder does not exploit the compulsory licence during one year or does not implement conditions established by the grant of the compulsory licence.

(7) The grant of a compulsory licence shall not affect the right of the patentee for the compensation of the value of the licence. If the value of the licence is not agreed by concerned parties it shall be determined, upon request, by the court, taking into account the importance of the invention and the value of the licence contracts in the relevant technical field.

(8) The compulsory licence shall be entered in the Patent Register (§ 69).”.

20. In § 21, the existing text is designated as the Subsection 1 and the Subsections 2 and 3 are added, having the following wording:

“(2) For maintaining the patent in force, the patentee shall pay yearly administrative fees under the special regulation. ⁴⁾

(3) The rights of third persons, which after expiry of the time limit for payment of the fee for maintaining the patent in force, in good faith have begun to use the subject-matter of the invention or have realized serious and effective preparations to use this invention, shall not be not affected by the payment of this fee in ulterior date.”.

21. In § 23, the Subsection 1 has the following wording:

“(1) The Office shall revoke the patent, if it is ascertained subsequently:

- a) that the invention did not meet the conditions of patentability;
- b) that the invention is not disclosed in the patent so clearly and completely, to be carried out by a person skilled in the art;
- c) that the subject-matter of the patent extends beyond the content of the invention application as filed or the subject-matter of the patents granted on the divisional

application extend beyond the content of the invention application as filed, or the extent arising from the patent was extended;

- d) that the patentee is not entitled to it according to § 8; in this case, the Office shall carry out the revocation upon the request of the authorised person (§ 29).”.

22. In § 23, in the end of the Subsection 2, the following sentence is added: “The partial revocation of the patent shall be carried out by the amendment of claims, description or drawings.”.

23. In § 24, after the Subsection 2, the new Subsections 3 and 4 are inserted, inclusive of the footnote № 4a), with following wording:

“(3) The Office is the body, with which the European patent application according to the Convention on the Grant of European Patents, done in Munich on October 5, 1973 (thereinafter the “European Patent Convention”) may be filed; this shall not apply in the case of a divisional European patent application.

(4) If the European patent application or the international application contains the matters that are kept secret under the special regulations, ^{4a)} the applicant shall file the application with the Office together with the approval issued by the National Security Office.

^{4a)} Law № 148/1998 of Coll., Act on Protection of Classified Matters and on the changes of several Laws, as amended.”.

The existing Subsection 3 is designated as the Subsection 5.

24. In § 26, the Subsection 1 reads:

“(1) An invention application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Where a group of inventions is claimed in one and the same patent application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression „special technical features“ shall mean those features which define a contribution which each of the claimed inventions considered as a whole makes the prior art.

25. In § 27, the Subsection 3 is added, having inclusive of the footnote № 4b) the following wording:

“(3) The priority right under the Subsection 2 can be claimed, if the invention application has been filed in the state or for the state which is party to the Paris Convention or a member of the World Trade Organisation. ^{4b)} If the state, where the first filing of the invention application is made, is neither a party of the Paris Convention, nor a member of the

World Trade Organisation, ^{4b)} the priority right can only be granted under condition of the reciprocity.

^{4b)} Convention on the creation of World Trade Organisation (WTO), published under the number 191/1995 of Coll.”.

26. After § 35, the new §§ 35a to 35g are inserted, which with the denomination of the Chapter three, titles and footnote № 4c) read as follows:

“CHAPTER THREE
EUROPEAN PATENT APPLICATION
AND EUROPEAN PATENT

§ 35a

(1) A European patent application with effects for the Czech Republic (hereinafter “European patent application”), which has been accorded a date of filing shall have the same effect in the Czech Republic as an invention application filed according to § 24 on the same date. If the European patent application enjoys a priority right from a date preceding the date of filing the European patent application, the earlier date shall apply for according the effects of the application.

(2) If the European patent application was withdrawn or if it is considered to be withdrawn, it shall have the same effects as the termination of the procedure on the invention application under § 64 Section 2. If the European patent application was rejected, it shall have the same effects as the rejection of the invention application under § 34 Subsection 1.

(3) The reestablishment of rights by the European Patent Office to the applicant of the European patent application, or to the owner of the European patent with effects for the Czech Republic (hereinafter “European patent”) shall also apply in the Czech Republic.

(4) If the European patent application has been published by the European Patent Office, the applicant has presented the translation of patent claims to the Czech language and paid the administrative fee for making the translation available under the special rules,⁴⁾ the Office makes the translation available to the public and announces this fact in the Bulletin. The applicant can then claim a reasonable compensation according to § 11, Subsection 3, if the patent, granted by the European Patent Office has effects in the Czech Republic (§ 35c).

(5) The content of the European patent application, determined by the wording of the European patent in the language, in which the European patent application has been proceeded before the European Patent Office, shall be decisive for the interpretation of the scope of protection conferred by the European patent application; if the protection conferred by the European patent is larger than the protection conferred by the published European patent application, the protection shall only be granted in the scope, which is conferred both by the published European patent application and the granted European patent. If the translation of patent claims according to the Subsection 4 doesn't comply with the wording of

the claims in the language of proceedings, the protection conferred by the European patent application can only be claimed in the scope which is obvious from its translation to the Czech language.

(6) If the applicant files with the Office the corrected translation of patent claims to the Czech language, the corrected translation shall have effect instead of the original translation as from the date of the mention of its publication in the Bulletin; the applicant shall pay the administrative fee for the publication according to special regulation. ⁴⁾ The rights of the third persons, which in good faith have used or have made serious and effective preparations for using the subject-matter of the European patent application which according to the translation presented by the applicant was not covered by its scope, are not affected by the delivery of the new translation.

§ 35b

Conversion of the European patent application into the national application

(1) The Office shall, at the request of the applicant of the European patent application, filed according to the Article 136 Subsection 2 of the European Patent Convention, start the procedure with the application as with respect to the national application.

(2) If the Office receives the request pursuant the Subsection 1, it shall invite the applicant to submit the Czech translation of the European patent application in three copies within a period of three months and to pay the filing fee.

(3) If the applicant has met the conditions pursuant in the Subsection 2 and the Office has received the request for conversion of the European patent application within a period of 20 months from the date of priority, the Office shall accord to the national application the right of priority deriving from the European patent application as filed.

(4) The Office shall, at the request of the applicant, proceed the European patent application filed under the Subsection 1, as the national application of an utility model in accordance with the special regulations. ^{4c)} The provisions of the Subsections 2 and 3 shall apply *mutatis mutandis*.

§ 35c

Effects of the European patent

(1) The patent granted by the European Patent Office shall have the same effects, as the patent granted in accordance with § 34, Subsection 3.

(2) The European patent shall have the effects in the Czech Republic as from the date, when the grant of the European patent was announced in the European Patent Bulletin; the owner of the patent shall be obliged to submit to the Office the translation of the patent specification to the Czech language within 3 months since this date, and to pay the administrative fee for the publication according to special legal regulations. ⁴⁾ In the same time, the patentee shall be obliged to submit to the Office the address in the Czech Republic, where the official notifications concerning his patent are to be sent. The Office shall

announce the grant of the European patent in the Bulletin and publish the translation of the European patent specification.

(3) If the translation of the European patent specification to the Czech language is not submitted within the period according to the Subsection 2, the owner of the European patent may submit it in the additional time limit of 3 months, provided that he will pay the administrative fee according to the special legal regulation.⁴⁾

(4) If the translation of the European patent specification to the Czech language is not submitted even within the time limit according to the Subsection 3, the European patent shall be considered in the Czech Republic as null and void from the outset.

(5) After the announcement of the grant of the European patent in the European Patent Bulletin, the Office shall enter the European patent to the Czech Register of European patents with the data recorded in the European Patent Register,

§ 35d

Extent of protection conferred by the European patent

(1) The text of the European patent in the language of the proceedings before the European Patent Office shall be decisive for the determination of the extent of protection conferred by the European patent; nevertheless, if the extent of protection conferred by the translation of the patent specification, submitted to the Office according to § 35c Subsection 2, is narrower than in the language of proceedings, third parties can refer to this translation.

(2) The owner of a European patent is entitled to submit to the Office the corrected translation of the European patent specification to the Czech language. The corrected translation shall have effects instead of the original translation as from the publication of the corrected translation by the Office; the owner of the European patent shall pay the fee for the publication according to special regulations.⁴⁾

(3) The rights of third persons, which on the territory of the Czech Republic in good faith have used or have realized serious and effective preparations to use the subject-matter, which pursuant to the translation valid in the period before the publication of the corrected translation by the Office was not covered by the extent of this European patent, are not affected by the delivery of the new translation.

§ 35e

Prohibition of the simultaneous protection

(1) If the national patent is granted to the invention, to which the European patent has been granted with the same right of priority to the same patentee or his successor in title, the national patent shall cease to have effect to the extent that it is identical with the European patent, from the date, on which the period for filing the notice of opposition to the European patent expires without such notice being filed, or the date of entry into force of the decision, by which the European patent has been maintained in the opposition proceedings.

(2) The national patent shall not have effects under § 11 Subsection 2 to the extent that it is identical with the European patent, if it was granted after the expiry of the period for

filing the notice of opposition to the European patent without such notice being filed, or after the date of entry into force of the decision, by which the European patent has been maintained in the opposition proceedings.

(3) The provisions of Subsections 1 and 2 shall not be affected by the revocation of the European patent under § 35f, Subsection 5.

§ 35f

Revocation of the European patent

(1) If the European Patent Office revokes the European patent or maintains it in the amended form, the decision shall have effects in the Czech Republic.

(2) The Office shall announce in the Bulletin the revocation of the European patent or its maintaining in the amended form according to the Subsection 1.

(3) If, the European patent is maintained in the amended text in the opposition proceedings by the European Patent Office, its owner shall be obliged to submit to the Office the translation of the amended text of the patent specification to the Czech language and to pay the publication fee within 3 months from the announcement of this amendment in the European Patent Bulletin. In the Bulletin, the Office shall announce the maintaining of the European patent in the amended text and shall publish the translation of the amended text of the patent specification.

(4) If the Czech translation of the amended text of the European patent specification is not submitted by the time limit according to the Subsection 3, the European patent shall be considered in the Czech Republic as null and void from the outset.

(5) If the time limit laid down by the European Patent Convention for filing the notice of opposition expires without such notice being filed, or if the European patent is not revoked during the opposition proceedings, the European patent can be revoked by the Office according to § 23; the Office shall suspend the revocation procedure with regard to the European patent, if the opposition procedure concerning the same matter is pending before the European Patent Office. If the European patent was not revoked in the opposition procedure, the Office shall upon request continue in the revocation procedure.

(6) In the revocation proceedings the text of the European patent in the language of the proceedings shall be authentic.

§35g

(1) The owner of patent shall be obliged to pay yearly fees for the maintaining the European patent in the Czech Republic (hereinafter “maintenance fees”). The Office shall stipulate the amount of maintenance fees by decree.

(2) The obligation to pay the maintenance fees shall arise by the announcement of the grant of the European patent in the European Patent Bulletin. The maintenance fees shall be paid to the Office and shall be payable in advance on the anniversary of the date of filing the application. If there is a period shorter than 2 months between the announcement of the grant of the European patent and the date corresponding to the date of filing the application, the

owner of the European patent shall be obliged to pay the first maintenance fee within 2 months from the date of announcement. If the maintenance fee is not paid within the prescribed time limit, it can still be validly paid within an additional period of 6 months in the double amount.

(3) The rights of third persons, which after the expiry of the period for payment of the maintenance fee without such fee being paid, in good faith have begun to make a use of the subject-matter of the invention or have realized serious and effective preparations to such use, are not affected by the additional payment of the maintenance fee.

^{4c)} Law No 478/1992 of Coll., Act on Utility Models, as amended by Law No 116/2000 of Coll.”.

27. After § 35g, the new § 35h to 35o are inserted, which including the denomination of the Chapter four, titles and footnotes No 4d) to 4f) read as follows:

“CHAPTER FOUR
GRANT OF SUPPLEMENTARY
PROTECTION CERTIFICATES
FOR MEDICAMENTS AND PLANT
PROTECTION PRODUCTS

§ 35h

(1) The Office shall grant supplementary protection certificates (hereinafter “certificates”) for substances protected on the territory of the Czech Republic by the valid patent, if they are the active substances of the products which prior being placed on the market are subject to the registration according to the special regulations ⁴⁾

(2) The active substance shall mean a chemically manufactured substance or a combination of substances, a micro-organism or a combination of micro-organisms, which have general or specific therapeutic or preventive effects with regard to human or animal diseases or which may be administered to the human beings or animals in order to disease diagnosis, improvement or arrangement of their health condition or which are destined to the protection of plants or plant products.

(3) The product referred to in Subsection 1 shall mean any active substance or a combination containing one or more active substances put up in the form for being placed on the market as a medicament ^{4e)} or a plant protection product. ^{4f)}

§ 35i

Application for a certificate

(1) The application for the grant of the certificate shall be filed by the owner of the patent, whose subject-matter is a substance, except for the patent granted according to § 82,

or a method for obtaining a substance or a use of a substance as a medicament or as a plant protection product (thereinafter “basic patent”), or his successor in title.

(2) The application for a certificate shall be filed within 6 months from the date on which the decision on the registration of the product is issued according to special regulations; ^{4d)} if the registration is made prior to the grant of the basic patent, the application for a certificate shall be filed within the period of 6 months from the date on which the patent is granted.

(3) The application for a certificate shall contain:

a) a request for the grant of the certificate stating in particular:

1. the name and address of the applicant;
2. the name and address of the representative, if any;
3. the number of the basic patent and the title of the invention;
4. the number and date of the first registration of the product according to special regulations; ^{4d)}

b) a copy of the decision on the registration of the product issued according to special regulations, ^{4d)} where the product is identified, including the product data summary, if it is a medicament;

c) chemical, generic or other terminology enabling to identify the substance protected by the basic patent with the registered product.

(4) When filing the application for a certificate, the applicant shall pay the administrative fee according to the special regulations. ⁴⁾

(5) The Office shall record the filing of the application for a certificate to the Patent Register and publish it in the Bulletin. The publication shall contain the name and address of the applicant, the number of the basic patent and the title of the invention protected by the patent, the number and the date of the registration, including of the mention of the product, putting on the market of which is authorised by means of this registration.

§ 35j

Conditions for the grant of the certificate

The Office shall grant a certificate, if the following conditions are met on the date of filing the application under § 35i:

- a) the basic patent is valid on the territory of the Czech Republic;
- b) the product contains the active substance protected by the basic patent and is validly registered as a medicament or a plant protection product according to special regulations; ^{4d)}
- c) the certificate has not yet been granted to the substance;
- d) the registration referred to in the letter b) is the first authorisation to place a medicament manufactured en masse in the Czech Republic or the first authorisation to place a plant protection product on the market in the Czech Republic.

§ 35k

Grant of the certificate

(1) If the application for a certificate meets the conditions laid down in § 35i and the substance, for which the certificate is applied for meets the conditions laid down in § 35j, the Office shall grant the certificate and record it in the Patent Register. The certificate shall contain:

- a) the name and address of the owner of the certificate;
- b) the number of the basic patent and the title of the invention;
- c) the number and date of the first registration, the authority having issued the decision on the registration, and the mention of the product, placing on the market of which is authorised by means of this registration;
- d) the duration of the certificate.

(2) The Office shall publish the grant of the certificate in the Bulletin. The publication shall contain the data referred to in Subsection.

(3) If the application for a certificate doesn't meet conditions laid down in § 35j, the Office shall invite the applicant to remedy the deficiencies within a set time limit. If the applicant fails to complete the application within the set time limit, the Office shall terminate the procedure; the applicant shall be notified about this consequence.

(4) If conditions for the grant of the certificate are not met, the application for a certificate shall be rejected.

(5) The Office shall publish the rejection of the application for a certificate and the termination of the procedure of the grant of the certificate in the Bulletin.; the publication shall contain the data specified in § 35i, Subsection 5.

§ 35l

Subject-matter and effects of the certificate

(1) Within the limits of the protection conferred by the basic patent, the protection by the certificate shall extend to the chemical substance or a combination of substances, micro-organism or a combination of micro-organisms, which represent the active substance of the registered product, as well as to every use of the subject-matter of the patent as a medicament or plant protection product, which was authorised before the expiry of the certificate.

(2) The certificate shall confer the same rights as conferred by the basic patent; the certificate shall be subject to the same limitations and the same obligations.

§ 35m

Duration of the certificate

(1) The certificate shall take effect for a period equal to the period, which elapsed between the filing date of the basic patent application and the date of the first registration

enabling to place the product on the market in the Czech Republic as a medicament or plant protection product, reduced by 5 years, but at most 5 years from the date, on which the certificate takes effect.

(2) The certificate shall take effect after the expiry of the lawful term of the basic patent.

(3) For maintaining the certificate, the owner shall pay yearly administrative fees according to the special regulations.⁴⁾

(4) The rights of third persons, which after the expiry of the period for payment of the maintenance fee without such fee being paid, in good faith have begun to make a use of the subject-matter of the invention or have realised serious and effective preparations to use this invention, are not affected by the payment of this fee in the additional time limit.

§ 35n

Lapse of the certificate

(1) The certificate shall lapse

- a) by expiry of its duration period in terms of § 35m, Subsection 1;
- b) if its owner surrenders it;
- c) if its owner doesn't pay administrative fees for maintaining the certificate in force;
- d) if the product may no longer be placed on the market following the revocation or expiry of the registration;
- e) by revocation of the certificate according to § 35o

(2) The Office shall record the lapse of the certificate to the Patent Register and announce it in the Bulletin.

§ 35o

Revocation of the certificate

(1) The Office shall revoke the certificate, if

- a) the conditions for its grant according to § 35j have not been met;
- b) the basic patent has lapsed before its duration period;
- c) the basic patent has been revoked or limited to the extent that the substance, for which the certificate was granted, is no longer protected by the basic patent; it shall apply also in case of the basic patent revocation, which occurred after its lapse.

(2) The application for revocation of the certificate may also be submitted after the lapse of the basic patent under Subsection 1, if the applicant proves his legal interest.

^{4d)} Law № 147/1996 of Coll., Act on Plant Medicine Care and on changes of some relating Laws.

Law № 79/1997 of Coll., Act on Medicaments and on changes and amendment of some relating Laws.

^{4e)} § 2, Subsection 1 of the Law № 79/1997 of Coll.

^{4e)} § 2, Subsection 7 of the Law № 147/1996 of Coll.”.

28. In § 48, the new Subsection 3 is added, having the following wording:

“(3) The right of priority under Subsection 2 can be claimed, if the industrial design application is filed in the state or for the state, which is a party to the Paris Convention ³⁾ or a member of the World Trade Organisation. ^{4b)} If the state, where the first filing of the industrial design application was made, is neither a party to the Paris Convention, ³⁾ nor a member of the World Trade Organisation, ^{4b)} the right of priority from this filing can only be granted on condition of reciprocity.”.

29. In § 63, at the end of the Subsection 1, the following sentence is added: “The proceedings before the Office shall be in the Czech language.”.

30. In § 63, Subsection 2, the text “35f, 35o,” is inserted after the number “23”.

31. In § 63, at the end of the Subsection 2, the following sentence is added: “The caution shall amount to 2 500 Kč.”.

32. In § 67, the Subsection 2 is deleted as well as the denomination of the Subsection 1.

33. In § 68, the Subsection 3 is deleted including the footnote № 6).

34. In § 69, after the Subsection 1, the new Subsection 2 is inserted, which reads:

“(2) The Office shall keep the Register of the European Patents valid on the territory of the Czech Republic. The Subsection 1 shall apply to entries in the Register of the European Patents.”.

The existing Section 2 is denominated as the Subsection 3.

35. § 70 inclusive of the title and the footnote № 7 reads:

“§ 70

Representation

Persons not having the domicile of headquarters on the territory of the Czech Republic, shall be represented in the proceedings before the Office by a representative

according to the special regulations.⁷⁾ This shall apply also for filing of translations in terms of the Chapter three.

⁷⁾ Law № 237/1991 of Coll., Act on Patent Attorneys, as amended by Law № 14/1993 of Coll.

Law № 85/1996 of Coll., Act on Legal Profession, as amended by Law № 210/1999 of Coll.”.

36. § 71 reads:

“§ 71

This Act shall apply also to the procedures on inventions, which are kept secret in terms of the special regulations ^{4a)} or international agreement, by which the Czech Republic is bound, except publication thereof.”.

37. In § 75, after the Subsection 1, the new Subsection 2 is inserted, which reads as follows:

“(2) The damaged party may request that the court order to the threatener or infringer of the rights to destroy products, the production or placing on the market of which has threatened or infringed the right protected by this Act, or to destroy the material and implements having been intended or used exclusively or predominantly in activities, threatening or infringing rights protected by this Act. The court shall not order the destruction, if the products in question are not property of the person, against which the proposal is directed or if the threat or infringement of the right could be removed otherwise and the destruction wouldn't be in proportionality with the threat or infringement.”.

The existing Subsection 2 is denominated as the Subsection 3.

38. After § 75, the new § 75a and 75b, which inclusive of the title have the following wording:

“§ 75a

Right of information

The holder of the right protected by this Act shall have towards everybody, who threatens or infringes his rights, the right to be informed about the source of the product including information concerning placing of products on the market; the court shall not grant the right of information, if there is no proportionality in relation to the severity of the threat or infringement.

§ 75b

(1) If a preliminary measure is requested in proceedings concerning the infringement of right to the invention or industrial design, the court can order the plaintiff to provide a security, sufficient to indemnify the defendant and to prevent the misuse of the protection granted to the owner of patent or industrial design.

- (2) The court, which is competent to order a preliminary measure either
- a) orders the plaintiff to provide the security under the Subsection within 7 days as from the filing date of the request and decides upon the request for a preliminary measure within 7 days from the date on which the court finds that the plaintiff has provided the security, or
 - b) decides on the request for the preliminary measure within 7 days at the latest from the filing date of the request.”.

39. In § 76, the Subsection 1 reads:

“(1) Persons having their domicile of headquarters on the territory of the state, which is a party to the Paris Convention ³⁾ or a member of the World Trade Organisation, ^{4b)} shall enjoy the equal rights as nationals of the Czech Republic.”.

40. In § 82, Subsection 3 letter b), the word “Czechoslovak” is replaced by the word “Czech”.

41. In § 88, at the end of the Subsection 1, the following sentence is added: “The Office shall set out by a Decree the amount of the maintenance fees.”

42. In § 88, the Subsections 2 and 3 are cancelled as well as the denomination of the Subsection 1.

43. In § 5, Subsection 3, the first sentence, § 11, Subsection 4, the first sentence, § 18, letters a) and b), § 24, Subsection 2, § 38, 41, 49, § 82, Subsection 1, § 82, Subsection 3 letter b), and § 82, Subsection 3 letter c), the words “to the Czech and Slovak Federal Republic” are replaced by the words “to the Czech Republic”. In § 18, letter a) and § 76, Subsection 2, the words “Czech and Slovak Federal Republic” are replaced by the words “Czech Republic”.

44. In § 2, the words “Federal Office for Inventions” are replaced by the words “Industrial Property Office”. In § 11, Subsection 2, the words “of the Federal Office for Inventions” are replaced by the words “Industrial Property Office”.

45. In § 24, Section 2, the words “Czechoslovak persons” are replaced by the words “citizens of the Czech Republic”.

PART TWO

Amendment to Act on Utility Models

Article II

The Law № 478/1992 of Coll., Act on Utility Models, is amended as follows:

1. In § 7, the words “Federal Office for Inventions” are replaced by the words “Industrial Property Office”. In § 8, Section 5, the words “of the Federal Office for Inventions” are replaced by the words “Industrial Property Office”.

2. In § 9, in the first sentence of the Section 2, after the words “under”, the words “international treaty” are replaced by words, which inclusive of footnote № 1) read as follows: “the Paris Convention on the Protection of Industrial Property (hereinafter “Paris Convention”) ¹⁾

1) Paris Convention on the Protection of Industrial Property of 20 March 1883, revised in Brussels 14 December 1900, in Washington 2 June 1911, in the Hague 6 November 1925, in London 2 June 1934, in Lisbon 31 October 1958, and Stockholm 14 July 1967, published under the number 64/1975 of Coll.”.

3. In § 9, the Subsection 3 is added, reading as follows:

“(3) In case of the amendment of the European patent application, in which the protection for the Czech Republic was requested, the applicant may claim his right of priority from the European patent application in relation to the application under § 8. For claiming the right of priority, the Subsection 2 shall apply *mutatis mutandis*.”

4. In § 10, Subsection 1, the words “to the Czech and Slovak Federal Republic” are replaced by the words “to the Czech Republic”.

5. After § 10, the new § 10a is inserted, having inclusive of the title and the footnote № 2a) the following wording:

“§ 10a

Conversion of the European patent application to the application

(1) At request by the applicant of the European patent application, filed under the Article 136 Subsection 2 of the European Patent Convention, the Office shall begin proceedings on the European patent application as on the application.

(2) If the application has been filed under the Subsection 1, the Office shall invite the applicant to pay within 3 months the filing fee in accordance with the special regulations ^{2a)} and to provide the translation of the European patent application to the Czech language in three copies.

(3) If the applicant meets the conditions under the Subsection 2 and the Office receives the application for the conversion of the European patent application within 20 months from the date of the priority right, the Office shall accord the right of priority to the national application from the European patent application as filed..

^{2a)} Law № 368/1992 of Coll., Act on Administrative Fees, as amended.”.

6. § 14 is deleted.

7. In § 15, Subsection 1, after the number “10” the text in parentheses “and 10a” is added.

8. In § 17, Subsection 1, letter b), after the word “by the patent” the words “with effects on the territory of the Czech Republic” are inserted.

9. In § 17, Subsection 1, the letter c) is deleted.

The existing letter d) is denominated as the letter c).

10. In § 17, after the Subsection 1 the next Subsection 3 is inserted having the following wording:

“(3) If the grounds for the cancellation only relate to the part of the utility model, the utility model shall be cancelled partially.”.

The existing Subsection 3 is denominated as the Subsection 4.

11. In § 18, at the end of the Subsection 2, the following sentence is added: “The reasons of the cancellation including the indication of evidences, to that the application refers, cannot be additionally amended.”.

12. In § 18, the Subsection 5 reads:

“(5) If the owner of the utility model submits his comments as to the proposal for cancellation of the utility design within the stated time limit, the Office shall decide on the proposal. The party of the procedure, which is not successful in the matter, shall pay the administrative fee for the procedure of the cancellation of the utility model, in accordance with the special regulations ^{2a)}”.

13. In § 18, the Subsections 6 and 7 are deleted.

14. In § 21, Subsection 2, after the words “infringement of rights” the words “ the right of the information and for granting of compulsory licences” are inserted.

15. In § 21, Subsection 3, the reference to the footnote № 5) is replaced by the reference to the footnote № 2a) and the footnote № 5) is deleted

Article III

Transitional provisions

1. The right of priority from the European patent application under § 9, Subsection 3 can be claimed after the accession of the Czech Republic to the European Patent Convention.
2. The application for the conversion of the European patent application to the application under § 10a can be filed after the accession of the Czech Republic to the European Patent Convention.
3. The reimbursement of costs necessary to the efficient enforcement or defence of the right according to § 18, Subsection 7 can only be claimed within the procedure of the cancellation of the utility model commenced before the date of the entry into force of this Act.

PART THREE

Amendment to the Act on Protection of Topographies of Semiconductor Products

Article IV

The Law № 529/1991 of Coll., Act on Protection of Topographies of Semiconductor Products, is amended as follows:

1. In § 2, the Subsection 3 in following wording is added:

“(3) For the purposes of this Act, the commercial exploitation shall mean the sale, rental, leasing, offer or any other method of commercial distribution of the topography or of the semiconductor product containing the topography or of the product containing the semiconductor product.”.

2. In § 5 and § 8, Subsection 1, the words “of the Federal Office for Inventions” are replaced by the words “the Industrial Property Office”.

3. § 6 inclusive of the footnote № 1a) reads:

“§ 6

(1) The nationals of the Czech Republic, as well as persons having their residence or headquarters on the territory of a state being member of the World Trade Organisation, ^{1a)} can claim their right of protection; if the state, where the applicant has his residence or headquarters is not member of the World Trade Organisation, ^{1a)} the right of protection can only be awarded on condition of the reciprocity.

(2) If the persons referred to in § 3 don't claim the right of protection, it can be claimed by persons, who with the exclusively authorisation by the person referred to in § 3 have exploited as the first in the Czech Republic the topography, which has not yet been exploited anywhere in the world.

^{1a)} Convention on the creation of World Trade Organisation (WTO), published under the number 191/1995 of Coll.”.

4. In § 8, at the end of the Subsection 3, the following sentence is added, which inclusive of the footnote № 1b) reads: “The Office can only make available documents containing a trade secret, ^{1b)} to third persons, if they are involved in the procedure on the cancellation of the topography from the Register according to § 13, or based on the order of a court, if they are involved in the procedure on the infringement of rights under § 10.

^{1a)} §§ 17 to 20 of the Civil Code.”

5. In § 9, Subsection 2, the words “this protection” are inserted after the words “in which”.

6. In § 10, at the end of the Subsection 1, the words “or to import them for this purpose” are added.

7. In § 10, the Subsection 3 is added, having the following wording:

“(3) If the owner of the topography proves that a third person, before the date referred to in § 9 Subsection 1, fraudulently reproduced, commercially exploited, or imported the topography for these purposes, he shall be entitled to seek compensation against the third person.”

8. In § 11, Subsection 2, the words “or there is a reasonable ground to believe that he can have known” are inserted after the words “knows”.

9. § 12. is deleted.

10. In § 14, the Subsection 8 is deleted.

11. In § 18, Subsection 2, the words “registration of licence agreements” are replaced by the words “compulsory licences and licence contracts”, after the words “appeal procedure”, the conjunction “and” is replaced by the comma and after the words “infringement of rights” the words “and the right of information” are inserted.

12. The footnote № 2) reads:

²⁾ § 14 to 16, 20, 64, 68, 70, 71 and § 75, Subsection 1, § 75a and 75b of the Law № 527/1990 of Coll. Act on Inventions, Industrial Designs and Rationalisation proposals, as amended by the Law № 519/1991 of Coll.”

13. The footnote № 3) reads:

³⁾ Law № 368/1992 of Coll., Act on Administrative Fees, as amended.”

Article V

Transitional provisions

The reimbursement of costs necessary to the efficient enforcement or defence of the right according to § 14, Subsection 8 can only be claimed within the procedure of the topography cancellation commenced before the date of the entry into force of this Act.

PART FOUR

Amendment to the Act on Trademarks

Article VI

The Law № 137/1995 of Coll., Act on Trademarks, as amended by the Law № 191/1999 of Coll. is amended as follows:

1. In § 2, Subsection 1, the letter c) reads:

“c) a sign that consists exclusively of signs or indications, serving in trade to designate the kind, quality, quantity, intended purpose, value or other characteristics of the goods or services, of indications of the geographical origin or the time of production of the goods or rendering of the service,”.

2. In § 2, at the end of the Subsection 1, the full stop is replaced by the comma and letters i) and j) are added, which have the following wording:

“i) a denomination containing the sign of a high symbolic value, namely religious symbols,
j) a denomination applied for wines or spirits, containing the geographical indication, with respect to the wines and spirits not having that geographical origin.”.

3. In § 2, Subsection 2, the words “at least two years” are deleted.

4. In § 3, at the end of the Subsection 1, the following sentence is added: “The sign can be registered, if the trademark owner or applicant with the earlier right of priority grant a written consent to the registration of the sign in the Trademark Register.”.

5. In § 6, in the first sentence of the Subsection 2, the words “of an international treaty, ²⁾” are replaced by words, which inclusive of footnote № 2) read as follows: “of the Paris Convention on the Protection of Industrial Property (thereinafter “Paris Convention”) ²⁾”

²⁾ Paris Convention on the Protection of Industrial Property of 20 March 1883, revised in Brussels 14 December 1900, in Washington 2 June 1911, in Haag 6 November 1925, in London 2 June 1934, in Lisbon 31 October 1958, and Stockholm 14 July 1967, published under the number 64/1975 of Coll.”.

6. In § 6, at the end of the Subsection 2, the following sentence is added, which including the footnote № 2a) reads: “The right of priority can be claimed from the trademark application, in which the protection is demanded in the member state of the Paris Convention²⁾ or in member state of the World Trade Organisation. ^{2a)} If the state, where the

first filing of the trademark application is made, is neither party to the Paris Convention²⁾, nor member of the World Trade Organisation,^{2a)} the right of priority can be only be awarded on condition of the reciprocity.

^{2a)} Notification № 191/1995 of Coll., on the conclusion of the Convention on the constitution of World Trade Organisation (WTO).”.

7. In § 9, Subsection 1, the letter b) reads:

“b) the owner of the earlier identical or confusingly similar trademark, which in terms of the Paris Convention³⁾ or as a consequence of the promotion of this trademark in the relevant circles of the public in the Czech Republic has become well-known in relation to the owner and his goods or services (thereinafter “well-known trademark”),”.

8. In § 9, after the Subsection 1, the new Subsection 2 is inserted, which reads as follows:

“(2) The Office shall not take into consideration the opposition filed after the expiry of the time limit laid down in the Subsection 1; this shall also apply to the evidence supporting the opposition.”.

The existing Subsection 2 is denominated as the Subsection 3.

9. In § 14, Subsection 2, at the end of the first sentence, the full stop is replaced by the semicolon and the following words are inserted: “the court shall not adjudicate the right of information, if it were in disproportion with the seriousness of the threat or infringement.”.

10. In § 15, at the end of the Subsection 1, the following sentences are added: “The trademark owner can request that the court order to the threatening or infringing person to destroy the goods, the production or placing on the market of which threatened or infringed the right protected by this Act, or to destroy the material and implements intended to or used exclusively or predominantly in activities, threatening or infringing rights protected by this Act. The court shall not order the destruction, if the goods in question are not the property of the person, against which the application is directed or if the threat or infringement of the right could be removed otherwise and the destruction wouldn’t be reasonable in comparison with the threat or infringement. The removal of the sign or counterfeited trademark from the goods before placing it on the market is only admissible in exceptional cases.”.

11. In § 16, the Subsections 4 and 5 are added, which read as follows:

“(4) The owner of a trademark shall acquiesce the further use of the identical or confusingly similar trademark with the posterior right of priority, if he has acquiesced this use during the period of 5 years since the day, when he got knowledge about this use, unless the application of the posterior trademark was not submitted in good faith.

(5) The owner of a trademark with the posterior right of priority is not entitled to prohibit the use of the identical or confusingly similar trademark with the earlier right of

priority, even if the owner of a trademark with the earlier right of priority was not allowed to claim his rights conferred by the trademark according to the Subsection 4.”.

12. In § 18, the Subsection 3 reads:

“(3) The licence contract shall be effective in respect to the third persons by the entry to the Trademark Register; the owner of the trademark is obliged to ask the Office for the registration.”.

13. In § 19, in the last sentence of the Subsection 1, the words “in relation to the third persons” are inserted after the words “shall be effective”.

14. In § 25, at the end of the Subsection 1, the full stop is replaced by semicolon and the following text is added: “the use of the trademark, which began or continued after the expiry of 5 years of its non-use, but in the period of 3 months before the commencement of the cancellation procedure, shall not be taken into consideration. As the use of the trademark, it shall be also considered its use in the form, which differs from the mark as registered in details not amending its distinctiveness, or the placing of the mark on goods or their packages exclusively for exportation purposes.”.

15. In § 26, in the first sentence of the Subsection 2, the following words “, as it takes unfair advantage of the distinctiveness or reputation of a well-known trademark or it is liable to detract from it” are deleted.

16. In § 35, the Subsection 2 reads:

“(2) Persons having their residence of headquarters on the territory of the member state of the Paris Convention ²⁾ or in the state, which is member of the World Trade Organisation, ^{2a)} shall enjoy the equal rights as persons having their residence of headquarters on the territory of the Czech Republic; if the state, in which the person has its residence of headquarters, is neither party to the Paris Convention, ²⁾ nor a member of the World Trade Organisation, ^{2a)} the rights according this Act can be awarded only on condition of the reciprocity.”.

17. In § 38, the second sentence of the Subsection 7 is deleted.

Article VII

Transitional provisions

1. The fact that the trade mark is well-known in terms of this Act can be claimed in the opposition procedure, only if the period for filing the opposition is opened, and in the cancellation procedure commenced after the date of the entry into force of this Act.

2. The application for the cancellation of the trademark, which is registered contrary to § 2, Subsection 1 letter i) and j) of the Law № 137/1995 of Coll., can be filed only in relation to the trademarks applied for after the date of the entry into force of this Act, unless the applicant was not in good faith.

PART FIVE
GENERAL, TRANSITIONAL AND FINAL
PROVISIONS

Article VIII

1. If it is not thereafter stipulated otherwise, the Act shall also apply to the relations created before the date of the entry into force of the Act. The creation of the relations shall be considered under the so far existing regulations.

2. The legal effects of the acts in pending procedures, which occurred before the effect of this Act, remain in-affected.

3. The pending procedures will be finished in accordance with the Act.

Article IX

The Prime Minister is authorized to pronounce the integral texts of the Law № 527/1990 of Coll., Act on Inventions, Industrial Designs and Rationalisation proposals, Law № 478/1992 of Coll., Act on Utility models, Law № 529/1991 of Coll., Act on Protection of Topography of Semiconductor Products, and Law № 137/1995 of Coll., Act on Trademarks, as amended.

PART SIX
ENTRY INTO FORCE

Article X

This Act shall enter into force on the date of the publication, except for the provisions of the Article I, § 24, Subsection 3, Article I, clause 26, Article II, clauses 3, 5 and 7 and Article III, clauses 1 and 2, which shall enter into force on 1st July 2002.

Klaus in his own hand

Havel in his own hand

Zeman in his own hand
