

**LAW OF UKRAINE  
ON AMENDMENT OF THE LAW OF UKRAINE  
“ON PROTECTION OF RIGHTS TO INVENTIONS AND UTILITY MODELS”**

**No.1771-III**

**June 1, 2000**

The Supreme Rada (Parliament) of Ukraine RESOLVES hereby as follows:

Changes shall be introduced in the Law of Ukraine “On Protection of Rights to Inventions and Utility models” (3687-12) (Vidomosti Verkhovnoyi Rady Ukrayiny, 1994, issue 7, page 32), by setting it forth in the following wording:

**“LAW OF UKRAINE  
ON PROTECTION OF RIGHTS TO INVENTIONS AND UTILITY MODELS**

**Section I. GENERAL PROVISIONS**

**Article 1. Definitions of Terms**

The terms listed herein below shall have the following meaning:

‘Institution’ shall be understood as a central executive agency in the field of the legal protection of industrial property objects;

‘Chamber of Appeal’ shall be understood as a collegial body of the Institution designated to examine objections to decisions of the Institution as to the acquisition of rights to the objects of intellectual property;

‘invention’ shall be understood as a technological (technical) solution, which meets the conditions of the patentability (novelty, involvement of an inventive step and capability of industrial application);

‘useful model’ shall be understood as a new design of a device capable of industrial application;

‘secret invention (secret useful model)’ shall be understood as an invention (useful model), which contains the information treated as state secret;

‘proprietary invention (useful model)’ shall be understood as an invention (useful model) created by an employee:

- in connection with fulfilling work responsibilities or upon employer’s instruction, unless the labour agreement (contract) provides otherwise;

- using the experience, industrial knowledge, trade secrets and employer’s equipment;

‘work responsibilities’ shall be understood as functional responsibilities of an employee stated in labour agreements (contracts) and job descriptions, which provide for performing the work, which may result in an invention (useful model);

‘employer’s instruction’ shall be understood as an assignment issued to an employee in writing, which is directly related to the specifics of the activity of the enterprise or the employer and may result in an invention (utility models);

‘employer’ shall be understood as a person, which hired an employee on the basis of a labour agreement (contract);

‘inventor’ shall be understood as a natural person, whose result of the creative work has been recognised as an invention (useful model);

‘patent (patent for an invention, declarative patent for an invention, declarative patent for a useful model, patent (declarative patent) for a secret invention, declarative patent for secret model)’ shall be understood as a protective document confirming the priority, authorship, and the title to the invention (useful model);

‘patent for an invention’ shall be understood as a patent variety issued as a result of the qualification expert appraisal of the application for patent;

‘declarative patent for an invention’ shall be understood as a patent variety issued as a result of the formal expert appraisal and the local novelty appraisal of the application for patent;

‘declarative patent for a useful model’ shall be understood as a patent variety issued as a result of the formal expert appraisal of the application for the useful model;

‘patent (declarative patent) for a secret invention’ shall be understood as a patent variety issued in respect of an invention considered as state secret;

‘declarative patent for a secret useful model’ shall be understood as a patent variety issued for a useful model considered as state secret;

‘qualification expert appraisal (expert appraisal of content)’ shall be understood as an expert appraisal, which ascertains the compliance of an invention with patentability conditions (being novel, involving an inventive step and being capable of industrial application);

‘local novelty expert appraisal’ shall be understood as a component of a qualification expert assessment, which ascertains the local novelty of an invention;

‘local novelty’ shall be understood as novelty ascertained on the basis of patents for inventions issued in Ukraine and applications for patents submitted to the Institution;

‘formal expert appraisal (appraisal for formal indications) shall be understood as expert appraisal, during which the affiliation of the object specified in the application with the list of objects, which may be declared inventions (utility models) and the compliance of the application and its format with specified requirements;

‘licence’ shall be understood as a permission of the patent owner (licensor) granted to another person (licensee) to use the invention (useful model) on certain conditions;

‘person’ shall be understood as a natural person or a legal entity;

‘application’ shall be understood as a set of documents needed for the Institution to issue a patent (declarative patent) for invention or a declarative patent for a useful model;

‘applicant’ shall be understood as a person, who submitted the application;

‘application priority (priority)’ shall be understood as the priority in the submission of the application;

‘date of priority’ shall be understood as the date of the submission of the application to the institution or an appropriate body of a state being party to the Paris Convention on Industrial Property Protection, under which the priority is declared;

‘international application’ shall be understood as an application submitted in accordance with the Patent Co-operation Treaty;

‘Register’ shall be understood as the State Register of Patents and Declarative Patents of Ukraine for Inventions, State Register of Declarative Patents of Ukraine for Utility models, State Register of Patents and Declarative Patents of Ukraine for a secret inventions, State Register of Declarative Patents of Ukraine for a secret utility models.

## **Article 2. Legislation of Ukraine on the Protection of Rights to Inventions (Utility models)**

The legislation of Ukraine on the protection of rights to inventions (utility models) shall be based upon the Constitution of Ukraine (254k/96-VR) and consist of this Law, laws of Ukraine “On Property” (697-12), “On State Secrets” (3855-12) and other regulations.

### **Article 3. Powers of the Institution in the Field of the Protection of Rights to Inventions (Utility models)**

1. The Institution shall ensure the implementation of the state policy in the field of the legal protection of the intellectual property, including inventions and utility models. The Institution shall be a successor to the liquidated State Patent Authority of Ukraine in respect of legal relations emerging from this Law and international treaties of Ukraine. The Institution shall:

- organise the receipt of applications and the expert appraisal thereof;
- issue patents for inventions and utility models, ensure the state registration thereof;
- ensure the publication of the official information about inventions and utility models;
- represent interests of Ukraine as regards the protection of rights to inventions and utility models in international organisations in accordance with the current legislation;
- adopt regulations within the scope of its authority according to the established procedure;
- carry out other functions in accordance with the Charter of the Institution approved according to the established procedure.

2. On a contractual basis, the Institution may provide any person with patent information and other services in the field of the protection of rights to patents (utility models) according to the procedure established by the Institution itself.

3. The activities of the Institution shall be financed from the State Budget of Ukraine.

### **Article 4. International Treaties**

If an international treaty of Ukraine sets rules other than those envisaged by the legislation of Ukraine on inventions (utility models), then the rules of an international treaty ratified by the Supreme Rada of Ukraine as binding shall apply.

### **Article 5. Rights of Foreign and Stateless Persons**

1. Foreign and stateless persons shall enjoy rights provided for hereby on an equal basis with citizens of Ukraine according to international treaties of Ukraine ratified by the Supreme Rada of Ukraine as binding.

2. Foreign and stateless persons, which reside or are permanently located outside the borders of Ukraine, shall enjoy their rights pertaining to relations with the Institution via intellectual property representatives (patent agents) registered according hereto.

## **Section II. LEGAL PROTECTION OF INVENTIONS (UTILITY MODELS)**

### **Article 6. Conditions of the Legal Protection**

1. The legal protection shall be granted to an invention (useful model), which does not contradict public interest, principles of humanity and moral and complies with patentability conditions.

2. The following may be an object of an invention:

- a product (a device, a substance, a culture of micro-organisms, a culture of cells of plants and animals, etc.);
- a method;
- a new application of an earlier known product or method.

The design of a device may be an object of a useful model.

3. The following shall not be eligible for the legal protection hereunder;

- discoveries, scientific theories and mathematical methods;
- methods of the organisation and management of economy;

- plans, symbols, schedules, rules;
- methods of performance of intellectual operations;
- computer software;
- results of artistic design;
- layout-designs (topographies) of integral circuits;
- plant varieties and animal breeds, etc.

4. The priority, the authorship and the title to an invention shall be affirmed by a patent (declarative patent).

The priority, the authorship and the title to a useful model shall be affirmed by a declarative patent.

The term of validity of a patent of Ukraine for invention shall be 20 years from the date of the submission of the application to the Institution.

The term of validity of a declarative patent for an invention shall be 6 years from the date of the submission of the application to the Institution.

The term of validity of a patent for an invention, whose object is a medicinal product, plant or animal protection means, etc., whose application requires a permit of a relevant competent authority, may be extended upon request of the patent owner by the time lapsed from the date of the submission of the application and the date of the receipt of such permit, but not more than 5 years.

The procedure of the request submission and the extension of the patent validity term in this case shall be determined by the Institution.

The term of validity of a declarative patent for a useful model shall be 10 years from the date of the submission of the application to the Institution.

The term of validity of a patent (declarative patent) for a secret invention and a declarative patent for a secret useful model shall be equal to the term of the invention's (useful model's) being secret, but may not be longer than the term of the protection of the invention (useful model) set hereby.

The validity of the patent shall be terminated early subject to conditions stated in Article 32 hereof.

5. The scope of the legal protection being provided shall be determined by the formula of the invention (useful model). The formula shall be construed within the scope of the description of the invention (useful model) and related drawings.

6. A patent (declarative patent) granted for a method of obtaining a product shall also apply to the product directly derived using such method.

#### **Article 7. Patentability Conditions of an Invention, Useful Model**

1. An invention shall meet patentability conditions if it is novel, involves an inventive step and is capable of industrial application.

2. A useful model shall meet patentability conditions if it is novel and capable of industrial application.

3. An invention (useful model) shall be deemed novel unless it is a part of the level of technology. Objects being part of the level of technology shall be considered only separately for the invention novelty determination purposes.

4. The level of technology shall comprise all the information, which became public domain before the date of the application submission to the Institution or, if the priority is claimed, before the date of priority.

5. The level of technology shall also include the contents of any application for patent in Ukraine (including an international application including Ukraine) stated in the initial wording of

such application, provided that the submission date (and the date of priority, if the priority is claimed) precedes the date specified in part four of this article, which was published as of or after that date.

6. The disclosure of the information about an invention (useful model) by the inventor or a person, which obtained such information from the inventor directly or indirectly, shall not affect the patentability of such invention (useful model) during 12 months till the date of the application submission to the institution or, if the priority is claimed, the date of priority. At that, the burden of proof of circumstances of such information disclosure shall be laid upon the person interested in the application of this part.

7. An invention involves an inventive step, if it is not obvious for a specialist, i.e., does not result from the level of technology. The contents of applications mentioned in part five of this article shall not be taken into account in the course of the assessment of the inventive step.

8. An invention (useful model) shall be deemed capable of industrial application, if it can be used in the industry or in another field of activities.

### **Section III. RIGHT TO PATENT**

#### **Article 8. Inventor's Right**

1. An inventor shall enjoy the right to obtain a patent, unless otherwise provided hereby.

2. Inventors, who created an invention (useful model) jointly, shall enjoy equal rights to obtain a patent, unless otherwise provided by an agreement among them.

3. In case of the revision of terms and conditions of the agreement on the complement of inventors, the Institution shall make changes in appropriate documents according to the procedure specified by the Institution upon joint request of persons stated in the application as inventors and persons, which are inventors, but are not stated in the application as inventors.

4. Natural persons, which did not contribute creatively to the creation of the invention (useful model) but provided the inventor (inventors) solely with technical, organisational or material assistance in the course of the creation thereof and/or the formulation of the application, shall not be deemed inventors.

5. An inventor shall enjoy the authorship right, which is an inalienable personal right and shall be protected perpetually.

An inventor shall enjoy the right to confer his name on the invention (useful model) created by him.

#### **Article 9. Right of Employer**

1. The inventor's employer shall enjoy the right to obtain a patent for a proprietary invention (useful model).

2. An inventor shall give the employer a notice in writing of a proprietary invention (useful model) created by him with a description, disclosing the content of the invention (useful model) in a sufficiently clear and complete manner.

3. Within four months of the date of receipt of the notice from the inventor, the employer shall be obliged to submit an application for patent to the Institution or confer the right to obtain such patent on another person or take a decision to treat the proprietary invention (useful model) as confidential information. Within the same time frame, the employer shall conclude an agreement in writing with the inventor in respect of the amount and conditions of the payment of emoluments to the inventor (inventor's successor) according to the economic value of the invention (useful model) and/or any other benefit, which can be derived by the employer.

4. Should the employer fail to meet the requirements stated in part three of this article within the specified time frame, the right to obtain a patent for a proprietary invention (useful

model) shall pass on to the inventor or the inventor's successor. In this case, the employer shall retain the preferential right to the acquisition of the licence.

5. The time for treating the proprietary invention (useful model) not being used as confidential information by the employer or its successor shall not exceed four years, if such invention (useful model) is not used. Otherwise, the right to obtain a patent for a proprietary invention (useful model) shall pass on to the inventor or the inventor's successor.

6. Disputes related to the conditions of the award of the emoluments to the inventor of the proprietary invention (useful model) and the amount thereof shall be settled by way of the court procedure.

#### **Article 10. Right of a Successor**

The right to obtain a patent may be enjoyed by a successor of the inventor or that of the employer respectively.

#### **Article 11. Right of the First Applicant**

If an invention (useful model) has been created by two or more inventors independently on one another, then the right to obtain a patent (declarative patent) for such invention or declarative patent for a useful model shall be enjoyed by the applicant, whose application has an earlier date of submission to the Institution or, if the priority is claimed, an earlier date of priority, provided that the said application is not deemed revoked, is not revoked and under which no decision to refuse the issue of patent has been made.

### **Section IV. PATENT OBTAINMENT PROCEDURE**

#### **Article 12. Application**

1. A person desirous of obtaining a patent (declarative patent) and having the right thereto shall submit an application to the Institution.

2. Upon instruction of the applicant, the application may be submitted via an intellectual property agent or another agent.

3. The information contained in the application shall be declared state secret in accordance with the Law of Ukraine "On State Secrets" (3855-12) and regulations adopted on its basis.

If an invention (useful model) has been created using the information registered in the Book of State Secrets of Ukraine, or if such invention (useful model) may be declared state secret according to the Law of Ukraine "On State Secrets", the application shall be submitted to the institution via the regime and secrets body of the applicant or via a competent body of the local state administration in the location (for legal entities) or the place of residence (for natural persons). Applicant's proposal to declare the invention (useful model) state secret with reference to the applicable provisions of the Law of Ukraine "On State Secrets" shall be attached to the application.

4. The application for invention shall cover a single invention or a group of inventions combined by a single invention concept (requirement of the singularity of an invention).

Application for a useful model shall cover a single useful model (requirement of the singularity of a useful model).

5. An application shall be drawn up in Ukrainian and contain:

- an application for the issue of a patent for an invention on the basis of the qualification expert appraisal or a declarative patent for an invention (useful model);
- a description of the invention (useful model);

- a formula of the invention (useful model);
- drawings (if there are references thereto in the description);
- a synopsis.

6. In an application for a patent (declarative patent), the applicant (applicants) and his (their) address, as well as the inventor (inventors) shall be indicated.

An inventor shall have the right to require his not being mentioned as an inventor of the given invention (useful model) in any publication of the Institution, for instance in the information about the application or the patent.

7. The description of the invention (useful model) shall be set forth according to the established procedure and disclose the content of the invention (useful model) so clearly and fully that a specialist in the relevant field be able to produce it.

8. The formula of the invention (useful model) shall express its content, be based upon the description and be set forth clearly and concisely according to the established procedure.

9. The synopsis shall be made for information purposes only. It cannot be taken into consideration for any other purposes, in particular for construing the formula of the invention (useful model) and determining the level of technology.

10. Other requirements to the application documents shall be put forward by the Institution in accordance herewith.

11. A fee shall be levied on the submission of the application. A document confirming the payment of the fee shall be received by the Institution together with the application or within two months upon the date of the submission of the application.

The said time frame may be extended but not more than by six months. A fee shall be levied upon extension of the time frame.

### **Article 13. Application Submission Date**

1. The application submission date shall be the date of the receipt by the Institution of materials, which contain at least:

- an application for the issue of a patent (declarative patent) in Ukrainian made in arbitrary form;
- the information about the applicant and his address in Ukrainian;
- a material making an impression of being a description of the invention (useful model) and a part of the material, which can be recognised as the invention (useful model) formula, in Ukrainian or another language. If the description and the formula of the invention (useful model) are provided in another language, then the Ukrainian translation thereof must be received by the Institution within two months of the application submission date to maintain the application submission date.

2. If the Institution believes that at the moment of the receipt, the materials of the application do not comply with requirements of part one hereof, it shall advise the applicant accordingly.

Two months from the date of the receipt of the Institution's notice by the applicant shall be granted for introducing changes in the materials. If the inconsistencies are rectified by the said time, then the date of the receipt of the amended materials by the Institution will be deemed to be the date of the application submission. Otherwise, the application shall be deemed not submitted, whereof the applicant should be notified.

If there are references to drawings in the application containing materials mentioned in part one of this article, but such drawing was not received by the Institution as of the date of the application, the Institution shall notify the applicant thereof and suggest him to either send the drawing or exclude the reference thereto from the application.

If the Institution receives the drawing within 2 months of the date of the applicant's receipt of the notice of the Institution, then the date of the receipt of such drawing by the Institution shall be deemed to be the application submission date. If the applicant fails to make the offered choice within the same time, the application shall be deemed not submitted, whereof the applicant should be notified.

The decision to set the date of the application submission shall be sent by the Institution to the applicant upon receipt of the document confirming the payment of the application fee in accordance with part eleven of Article 12 hereof. In case of the violation of requirements of part eleven of Article 12 hereof, the said decision shall not be sent and the application shall be deemed revoked.

#### **Article 14. International Application**

An international application shall be accepted for the consideration according to the national procedure provided that it was received by the Institution not later than in 21 months or, in case of the preliminary international expert appraisal, not later than in 31 months from the date of priority.

The translation of the international application into Ukrainian and the document confirming the payment of the application submission fee shall be received either together with the application or within 2 months after the above mentioned deadlines.

The time for the provision of the translation of the international application and the document confirming the fee payment may be extended to 6 months from the date of the receipt of the international application. A fee shall be payable for such time extension.

2. The Institution shall send the applicant a notice of acceptance of the international application for examination subject to compliance with requirements of part one of this article.

3. If at least one of the conditions of part one of this article is not met, the application shall not be accepted for the examination, whereof the applicant should be notified.

4. The Institution shall publish the information about the international application accepted for examination determined by the Institution in its official bulletin.

5. The international application shall be examined in the Institution in accordance herewith.

#### **Article 15. Priority**

1. An applicant shall enjoy the right to the priority of the preliminary application for the same invention (useful model) within 12 months of the date of the submission of the preliminary application to the Institution or an appropriate body of a state being party to the Paris Convention on Industrial Property Protection, if no priority is claimed in respect of the preliminary application.

2. Within three months of the date of application submission to the Institution, the applicant desirous of enjoying the right of priority shall submit an application of priority with reference to the date of submission and the number of the preliminary application with a copy thereof, if such application has been submitted in a foreign state being party to the Paris Convention on Industrial Property Protection (995\_123). During this time, the said materials may be amended. If these materials are not submitted in time, the right of priority of the application shall be deemed lost, whereof the applicant should be notified.

The deadlines mentioned in parts one and two of this article, which have been missed by the applicant for unforeseen reasons not depending on the same, may be extended by 2 months after the date of the expiry of the said term subject to the payment of an appropriate fee. The procedure of the extension of such terms shall be specified by the Institution.

If necessary, the Institution may require translation of the preliminary application into Ukrainian. The translation shall be received by the Institution within 2 months after the date of the receipt of the Institution's inquiry by the applicant. If the translation is not received by the stated time, the right of priority of the application shall be deemed lost, whereof the applicant should be notified.

The time for receipt of the translation of the preliminary application may be extended up to 6 months of the date of the receipt of the Institution's inquiry by the applicant. A fee shall be payable for such time extension.

3. The priority of several preliminary applications may be claimed in respect of the application as a whole or an individual item of the formula of the invention (useful model). At that, the time frames, whose initial date is the date of priority, shall be calculated from the earliest priority date.

4. The priority shall cover only those features of the invention (useful model), which are stated in the preliminary application, whose priority is claimed.

5. If some features of the invention (useful model) are missing from the invention (useful model) formula stated in the preliminary application, then the precise indication of such features in the description of the preliminary application shall suffice to grant the right of priority.

6. If the processing of the preliminary application in the Institution is not completed, then, upon receipt of the application for priority under part two of this article, the preliminary application shall be deemed revoked to the extent of the claimed priority.

7. The priority of the application divided from the preliminary one upon suggestion of the Institution or the applicant's initiative prior to the decision to grant a patent (declarative patent) or to refuse such patent (divisional application) shall be ascertained on the basis of the date of the submission of the preliminary application, from which it was divided, to the Institution or, if the priority is claimed under the preliminary application, on the basis of the date of this priority, provided that the content of the invention under the divisional application falls within the scope of the content of the preliminary application as of the date of the submission thereof.

#### **Article 16. Expert Appraisal of an Application**

1. The expert appraisal of the application shall be carried out by the Institution in accordance with this Law and the rules established by the Institution.

2. On own initiative or on invitation of the Institution, an applicant may take part in the consideration of issues, which emerged in the course of the expert appraisal, either in person or via his agent. The procedure of the participation of the applicant or the agent in the consideration of the said issues shall be determined by the Institution.

3. An applicant shall have the right to amend and clarify the application on own initiative. Such amendments and clarifications shall not be taken into account, if they were received by the Institution after the applicant's receipt of the decision to grant a patent (declarative patent) or the decision to refuse such patent.

In the course of the publication of the information on the application for a patent for an invention, the said amendments and clarifications shall be taken into account, if received by the Institution 6 months prior to the publication date.

4. If the applicant submitted additional materials, then it shall be ascertained in the course of the expert appraisal, whether they fall within the scope of the content of the invention (useful model) disclosed in the submitted application.

The additional materials do not fall within the scope of the content of the invention (useful model) disclosed in the submitted application, if they contain indications, which should be included in the formula of the invention (useful model).

The additional materials shall not be taken into account in the course of the application examination to the extent of not being within the scope of the content of the invention (useful model) disclosed in the submitted application and may be submitted by the applicant as a separate application.

5. Preliminary examination of the application shall take place prior to ascertaining the application submission date. In the course of the preliminary examination, an application, which does not include an applicant's proposal to declare the invention (useful model) state secret, shall be examined for its containing the materials, which can be declared state secret in accordance with the Book of State Secrets.

In case of availability of such data in the application or if an application contains an applicant's proposal to declare the invention (useful model) state secret, then the State Expert for Secret Matters (hereinafter referred to as 'State Expert') shall be appointed to examine such issues. The Institution shall send the materials of the application to this expert in order to declare an invention (useful model) state secret.

The State Expert shall send its opinion together with materials of the application to the Institution within one month of his receipt of the same.

The time frame of the validity of the decision to declare the information stated in the application a state secret shall be set by the State Expert taking into account the degree of the confidentiality of such information.

If the State Expert decided to declare the claimed invention (useful model) state secret, he also shall specify the people, which may access it; the subsequent examination of the application in the Institution shall proceed in adherence to secrecy procedures.

The Institution shall notify the applicant of the decision within one month. If the application did not contain a proposal of the applicant to declare the invention (useful model) state secret, but the State Expert declared the invention (useful model) state secret, then the applicant, in case of dissent, may submit to the Institution a substantiated request to declassify the materials of the application or appeal against the decision of the State Expert in the court.

6. The examination of the application in the Institution shall start from the date of its submission in accordance with Article 13 hereof.

7. Upon the submission of the application and subject to availability of the document confirming the payment of the submission fee, the Institution shall carry out a formal expert appraisal of the application, during which:

a) it shall be ascertained, whether the object of application belongs to objects specified in part two of article 6 hereof and whether it belongs to objects specified in part three of article 6 hereof;

b) the application shall be checked for the compliance with requirements of article 12 hereof.

The first notice of the Institution of the formal expert appraisal to the applicant, which may be made in the form of a notification of the completion of the expert appraisal or a requirement to amend the materials of the application, shall be sent by the Institution within 6 months of the ascertained application submission date.

8. If the application does not comply with requirements of parts two and three of article 6 hereof, the Institution shall send the applicant a decision to refuse the issue of the patent (declarative patent).

If the application does not comply with requirements of article 12 hereof or the document confirming the payment of the application submission fee was not received, the Institution shall notify the applicant thereof.

In case of the violation of the requirement of the singularity of the invention (useful model), it shall be suggested to the applicant to advise, which invention (useful model) must be considered, and, if necessary, to amend the application. In this case, other inventions (utility models) may become subjects of separate applications.

The applicant shall be given two months from the date of the receipt of the Institution's notification to amend the materials. If the requirement of singularity is not met during this term, the Institution, while performing the formal expert appraisal, shall examine the invention (useful model) being first in the formula. If other inconsistencies are not rectified during the same term and the applicant fails to submit an application for the extension of the said term, the Institution shall send the applicant a decision to refuse the issue of the patent.

9. If the application for the patent for invention meets the requirements of article 12 hereof, the Institution, subject to the availability of the document confirming the payment of the application submission fee, shall send the applicant a notice of the completion of the formal expert appraisal and the possibility of the qualification expert appraisal of the application.

10. If the application for a declarative patent for the invention meets the requirements of Article 12 hereof, the Institution, subject to the availability of the document confirming the payment of the application submission fee, shall start the local novelty expert appraisal of the application.

In case of the positive outcome of the local novelty expert appraisal, the Institution shall send the applicant a decision to issue the declarative patent for the invention. Otherwise, the applicant shall be sent a decision to refuse the issue of the declarative patent.

11. If the application for the declarative patent for a useful model meets requirements of article 12 hereof, the Institution, subject to the availability of the document confirming the payment of the application submission fee, shall send the applicant a decision to issue a declarative patent for the useful model.

12. Upon expiry of 18 months of the date of the submission of an application for a patent for an invention, or, if the priority is claimed, then of the date of its priority, the Institution shall publish in its official bulletin the information about the application ascertained by it, provided that the application is not revoked, is not deemed revoked and under which no decision to refuse the issue of patent has been made.

Upon application of the applicant, the Institution shall publish the information on the application earlier the said term.

Upon request of the applicant, he shall not be mentioned in the published information on the application.

Upon publication of the information on the application, any person shall have the right to familiarise himself with materials of the application according to the procedure to be specified by the Institution.

In case of the detection of obvious errors in the published information, the applicant shall have the right to refer to the Institution with a request to rectify them.

No information about the application for a declarative patent for an invention (useful model) shall be published.

The information on applications, which were declared state secret by a decision of the State Expert, shall not be published.

13. Upon application of any person and subject to a document confirming the payment of the fee for the qualification expert appraisal of the application for a patent for an invention, the

Institution shall carry out the said expert appraisal, during which the compliance of the claimed invention with patentability conditions of article 7 hereof shall be verified.

The applicant may submit the said application within three years of the application submission date. If such application is not received by the Institution within the specified period, the application shall be deemed revoked.

Another person may submit the said application after the publication of the information on the application, but only within three years of the application submission date. At that, such person shall not participate in the solution of issues related to the application. The qualification expert appraisal shall be performed subject to the payment of the appropriate fee. The expert opinion of the qualification expert appraisal shall be sent to such person by the Institution.

14. During the qualification expert appraisal of the application for a patent, the Institution shall have the right to require the applicant to provide additional materials, without which such appraisal is impossible, or suggest to alter the invention formula.

An applicant shall have the right to require the Institution to provide copies of patent materials opposing the application within one month of the date of the receipt of the Institution's inquiry. Copies of such materials shall be provided by the Institution to the applicant within one month.

Additional materials shall be submitted by the applicant within 2 months of the date of the receipt of the inquiry or copies of patent materials opposing the application.

Should the applicant fail to furnish the materials requested by the Institution or a substantiated application for the extension of the said time frame, the application shall be deemed revoked.

The procedure set out by part four of this article shall apply to additional materials to the extent of their not being within the scope of the content of invention cited in the submitted application.

15. If the violation of the invention singularity requirement was ascertained at the stage of the qualification expert appraisal of the application, then the appraisal shall be undertaken according to the procedure of part eight of this article in respect of the invention singularity requirement.

16. If it is ascertained as a result of the qualification expert appraisal that the invention, whose content is expressed in the formula suggested by the applicant, meets the patentability conditions, the Institution shall send the applicant a decision to issue the patent for the invention. Otherwise, a preliminary decision to refuse the patent shall be sent to the applicant.

Within 2 months of the date of the receipt of the preliminary decision to refuse the patent, the applicant may amend materials of the application, furnish additional materials, which fall within the scope of the content of the invention specified in the application.

Taking into account amendments and additional materials submitted in connection with the receipt of the preliminary decision to refuse a patent by the applicant, the Institution shall prepare a final conclusion in respect of the compliance of the claimed object with patentability conditions and take a decision to issue or refuse a patent.

If, within 2 months of the date of the receipt of the preliminary decision to refuse a patent for an invention, the applicant failed to amend or to furnish additional materials, the Institution shall make a decision to refuse a patent for an invention.

The decision to issue or to refuse the patent for an invention shall be sent to the applicant.

17. The applicant shall have the right to familiarise himself with all materials mentioned in the inquiry or the decision of the Institution. Copies of patent materials requested by the application shall be sent by the Institution within one month.

18. The first notice of the Institution to the applicant in respect of the qualification expert appraisal, which may have the form of a decision to refuse a patent, a preliminary decision to refuse a patent or a requirement to provide additional materials, without which the expert appraisal is impossible, shall be sent by the Institution within 18 months of the date of the commencement of the qualification expert appraisal. The qualification expert appraisal commencement date shall be deemed to be the date of the receipt of an application for such expert appraisal by the Institution. If the said application was received by the Institution prior to the completion of the formal expert appraisal, then the date of the completion of the said appraisal shall be deemed to be the qualification expert appraisal commencement date.

19. The time frames specified for applicants by parts eight, thirteen, fourteen and sixteen of this article may be extended by the Institution, but not more than by 6 months. A fee shall be levied on the time extension. The procedure of the submission of requests for the time extension shall be specified by the Institution.

20. If the applicant missed the time envisaged by parts eight, thirteen, fourteen and sixteen of this article during the examination of his application in the Institution, he may submit a request to the Institution for the renewal of the missed time within 12 months of the date of the expiry of the missed time frame. If the applicant missed the time for legitimate reasons, such time may be renewed. A fee shall be levied on such renewal.

#### **Article 17. Revocation of an Application**

An applicant shall have the right to revoke the application at any time before the date of the receipt of the decision to issue a patent.

#### **Article 18. Transformation of Applications**

An applicant shall have the right to transform:

- an application for a patent for an invention into an application for a declarative patent for an invention and vice versa at any time until the receipt of the decision to issue a patent (a declarative patent) or a decision to refuse such patent;

- an application for a patent (declarative patent) for an invention into an application for a declarative patent for a useful model and vice versa at any time until the receipt of the decision to issue a patent (a declarative patent) or a decision to refuse such patent.

In this case, the ascertained application submission date and the date of priority, if the priority is claimed, shall be retained.

#### **Article 19. Confidentiality of an Application**

From the date of the receipt of an application by the Institution and till the publication of the information on the application or the publication of the information on the issue of a patent, the materials of the application shall be treated as confidential information. Third party access to materials of the application shall be prohibited, unless such access takes place on a permission of the applicant or subject to a decision of a competent authority.

Persons guilty of the violation of the application materials confidentiality requirements shall be liable under laws of Ukraine.

#### **Article 20. Alteration of an Applicant**

The alteration of an applicant shall be effected as a result of the cession of the right to obtain a patent on the basis of a contract or the application of the law, or the enforcement of a court decision, as a result of the re-organisation or liquidation of a legal entity, etc. The applicant or a person, who acquired such rights, shall submit an application to the Institution supported by

a document or a certified copy of a document being the basis for such alteration. If not all applicants are altered, the application for such alteration shall be signed by all applicants, who submitted the application.

The alteration of an applicant shall only be possible until the Institution makes a decision to issue a patent.

### **Article 21. Temporary Protection**

1. The information on an application for a patent for an invention published in accordance with part twelve of article 16 hereof shall provide the applicant with temporary legal protection within the scope of the formula of the invention, on whose basis such information was published.

2. An applicant shall be entitled to compensation for losses caused to him after the publication of the information on an application by the person, who really knew or was notified in writing in the Ukrainian language with the reference to the application number that the information on an application for a patent for an invention being used by such person without permit of the applicant has been published. The said compensation may be received by the applicant only after his being granted the patent.

3. The temporary legal protection shall cease as from the date of the publication in the official bulletin of the information on the issue of a patent for an invention or a notice of the termination of the application processing.

4. The temporary legal protection under an international application shall start as from the date of its publication by the Institution on the terms and conditions set forth in part two of this article.

### **Article 22. Patent Registration**

1. On the basis of the decision to issue a patent for an invention or a declarative patent for a useful model and subject to availability of a document confirming the payment of the patent issue fee, the Institution shall effect the state registration of the patent for an invention or a declarative patent for a useful model and enter appropriate information in the Register. The form of the Register and the Register keeping procedure shall be determined by the Institution.

A document confirming the fee payment shall be received by the Institution within 3 months of the date of the receipt of the decision to issue a patent by the applicant.

The said time frame may be extended but not more than by 6 months. A fee shall be payable for such extension.

If the document confirming the payment of the patent issue fee was not received by the Institution by the said time, the registration shall not be effected and the application shall be deemed revoked.

No fee shall be payable for the issue of a patent (declarative patent) for a secret invention.

2. Upon entering the information in the Register, any person shall have the right to familiarise himself with it according to the procedure to be specified by the Institution.

### **Article 23. Publications on the Patent Issue**

1. The Institution shall publish the information on the issue of a patent (declarative patent) determined by it in its official bulletin.

2. Not later than in 3 months upon the date of the publication of the information on the issue of a patent, the Institution shall publish a description to the patent (declarative patent),

which contains the formula and the description of the invention (useful model) and the drawings referred to in the description of the invention (useful model).

3. Upon the publication of the information on the issue of a patent, any person shall have the right to familiarise himself with materials of the application according to the procedure to be specified by the Institution.

4. The information on the issue of a patent (declarative patent) for a secret invention and a declarative patent for a secret useful model shall not be published.

#### **Article 24. Appeals against the Decision in respect of an Application**

1. An applicant shall have the right to appeal to a court of law against any decision or any failure to make a decision by the Institution in respect of an application.

2. An applicant may file objection to any decision of the Institution in respect of the application to the Chamber of Appeal within 6 months of the date of the receipt of the Institution's decision or copies of patent materials sent by the Institution on his request.

3. Requirements as to the conditions of filing applicants' objections to decisions of the Institution to the Chamber of Appeal shall be specified by the Institution.

4. A fee shall be payable for an applicant's filing an objection to the Chamber of Appeal.

5. Applicant's objection to a decision of the Institution shall be considered by the Chamber of Appeal within 4 months upon receipt of such objection.

6. The decision of the Chamber of Appeal in respect of the applicant's objection may be appealed against at the court of law.

#### **Article 25. Issue of a Patent**

1. A patent shall be issued by the Institution within one month upon its state registration.

A patent shall be issued to an eligible person. If several persons are eligible for the same patent, one patent shall be issued to them.

A declarative patent for an invention (useful model) shall be issued subject to the patent holder's responsibility for the compliance of the invention (useful model) with patentability conditions.

2. The form of the patent and the contents of the information provided therein shall be specified by the Institution.

3. The Institution shall amend obvious mistakes in the issued patent on request of the patent holder with subsequent announcement to this effect in the official bulletin.

#### **Article 26. Transformation of a Declarative Patent**

For the purposes of the transformation of a declarative patent for an invention into a patent for an invention, the holder of a declarative patent for an invention or his successor may submit a request for a qualification expert appraisal of the application, on whose basis the declarative patent was issued. Such a request shall be received by the Institution not later than within three years of the date of the submission of the application, , on whose basis the declarative patent was issued.

The Institution shall carry out the qualification expert appraisal subject to the payment of an appropriate fee.

If a decision to issue a patent for an invention is made as a result of the qualification expert appraisal, the declarative patent shall cease to be valid as from the date of the publication of the information on the issue of the patent for an invention. The Institution shall publish the information about the cessation of the validity of the declarative patent in the official bulletin. The term of validity of a patent for an invention issued in lieu of the declarative patent for an

invention shall be 20 years from the date of the submission of an application for a declarative patent for an invention.

If the qualification expert appraisal carried out on the request to transform a declarative patent for an invention into a patent for an invention does not end by the expiry date of the declarative patent and any person starts using the invention or performs considerable and serious preparations to using the same after that date, then, in case of the issue of a patent for an invention on the basis of the application, under which a declarative patent was granted earlier, such person may continue to use the invention in the scope of the actual preparations without paying the compensation to the holder of the patent for the invention.

If a decision to refuse a patent for an invention has been taken as a result of the qualification expert appraisal of the application, the declarative patent for an invention shall be deemed failed to come into force as from the date of the publication of the information on its issue, whereof the Institution shall publish the information in the official bulletin.

#### **Article 27. Declassification of a Secret Invention (Useful Model)**

1. A holder of a patent for a secret invention (useful model) shall have the right to submit to the appropriate State Expert a proposal to declassify the invention (useful model) or to change the secrecy classification. In this case, the State Expert shall examine the proposal and reply in writing within one month of the date of the receipt of such proposal.

2. The change in the secrecy classification of an invention (useful model) or its declassification shall take place on the basis of a decision of the appropriate State Expert taken on the basis of a proposal of the patent holder in connection with the expiry of the validity term of the decision to declare the information on an invention (useful model) state secret or on the basis of a court decision.

3. Within one year of the date of the receipt of the State Expert's decision to declassify an invention (useful model), the holder of a patent (declarative patent) for a secret invention or a declarative patent for a secret useful model shall have the right to submit a request to the Institution for a patent (declarative patent) for an invention for the period remaining till the expiry of the patent (declarative patent) for a secret invention or the declarative patent for a secret useful model. In this case, the Institution shall make appropriate changes in the Register, publish the information on the patent issue and issue the patent (declarative patent) in accordance with articles 22, 23 and 25 hereof subject to the payment of appropriate fees.

### **Section V. RIGHTS AND RESPONSIBILITIES RESULTING FROM A PATENT**

#### **Article 28. Rights Resulting from a Patent**

1. The rights resulting from a patent shall become effective as from the date of the publication of the information on the patent issue.

The rights resulting from a patent (declarative patent) for a secret invention or a declarative patent for a secret useful model shall become effective as from the date of entering the information about it in the appropriate Register.

2. The patent shall confer on its holder the exclusive right to use the invention (useful model) at his discretion, unless such use infringes upon rights of other patent holders.

A secret invention (useful model) shall be used by the patent holder in adherence to requirements of the Law of Ukraine "On State Secrets" (3855-12) and in concurrence with the State Expert.

The relations in the course of the use of an invention (useful model), for which the patent is held by several persons, shall be determined by an agreement among such person.

Lacking such an agreement, each patent holder may use the invention (useful model) at his discretion. However, none of them shall have the right to grant a permit (a licence) for using the invention (useful model) and transfer the title to the invention (useful model) to another person without a consent of other patent holders.

The following shall be considered to be use of an invention (useful model):

- manufacture, offering for sale, application or importation, storage, introduction of a product in the business turnover otherwise for the above mentioned purposes, provided that the product has been manufactured using the patented invention (useful model);

- application of the method protected by the patent or offering thereof for the application in Ukraine, if the person offering such method is aware of such application's being prohibited without consent of the patent holder or, in view of circumstances, it is obvious;

- offering for sale, introduction in the business turnover, application or importation or storage for the above-mentioned purposes of a product directly manufactured by the method protected by the patent.

A product shall be declared manufactured using the patented invention (useful model), if each feature included in an independent item of the formula of the invention (useful model) or an equivalent feature is used.

A method protected by the patent shall be declared applied, if each feature included in an independent item of the formula of the invention (useful model) or an equivalent feature is used.

3. The exclusive right of the holder of a patent (declarative patent) for a secret invention and a declarative patent for a secret useful model shall be limited by the Law of Ukraine "On State Secrets" and appropriate decisions of the State Expert.

A holder of a patent (declarative patent) for an invention or a declarative patent for a secret useful model shall be entitled to a compensation for covering the expenses related to the payment of fees envisaged hereby from the state authority nominated by the Cabinet of Ministers of Ukraine.

Disputes in respect of the amount and the procedure of the payment of the compensation shall be settled by way of a court procedure.

4. A patent holder may use precautionary marking with the patent number on the product or the package of the product manufactured using the patented invention.

5. The patent shall confer upon its holder the right to prohibit other persons from using the invention (useful model) without his consent, except for cases, when such use is not considered to be the infringement upon rights conferred by the patent hereunder.

6. A patent holder may cede the title to an invention (useful model) on a contractual basis to any person, which becomes his successor. Such cession in respect of a secret invention (useful model) shall be effected only in concurrence with the State Expert.

7. A patent holder shall grant a permit (licence) to any person for the use of the invention (useful model) on the basis of a licence agreement. Such permit in respect of a secret invention (useful model) shall be given only in concurrence with the State Expert.

On the basis of a licence agreement, the patent owner (licensor) shall transfer the right to use the invention (useful model) to another person (licensee), who shall undertake to make contractual payments to the licensor and effect other actions envisaged by an exclusive or non-exclusive licence agreement.

On the basis of an exclusive licence agreement, a licensor shall transfer the right to use the invention (useful model) to the licensee in certain scope on a designated territory and for an agreed period, while reserving the right to use the invention (useful model) in the scope not transferred to the licensee. In this case, the licensor shall not have the right to grant licences for

the use of the invention (useful model) to another person on the same territory within the scope of the rights granted to the licensee.

On the basis of a non-exclusive licence agreement, the licensor shall transfer the right to use the invention (useful model) to the licensee, while reserving the right to use the invention (useful model), including the right to grant licences to other persons.

8. A contract on the transfer of the title to an invention (useful model) and a licence agreement shall be deemed valid, if made in writing and signed by the parties. The said contracts and agreements shall come into force in respect of any other person only after being registered with the Institution.

The duration of the registration of the licence agreement in the Institution shall not exceed 2 months.

9. A holder of the patent for an invention, a declarative patent for an invention, except for a patent (declarative patent) for a secret invention or a declarative patent for a secret useful model, shall have the right to submit to the Institution for the official publication a statement of the willingness to grant any person a permit to use the patented invention (useful model). In this case, the annual fee for maintaining the validity of the patent shall be reduced by 50 per cent starting from the year, which follows the year of the publication of such statement.

A person desirous of making use of such permit shall be obliged a fee contract with the holder of the patent or the declarative patent. Disputes arising in the course of the performance of such contract shall be settled by courts of law.

If no person announced his intentions to use the patent (useful model) to the patent holder, the latter may submit to the Institution a written request for the revocation of his statement. In this case, the annual fee for maintaining the validity of the patent shall be payable in full starting from the year, which follows the year of the publication of such request.

10. Rights arising from the patent shall not affect any other personal property or non-property rights of the inventor, which are governed by other laws of Ukraine.

### **Article 29. Responsibilities Resulting from a Patent**

A patent holder shall pay appropriate fees for maintaining the validity of the patent and use the exclusive right resulting from the patent *bona fide*.

### **Article 30. Forced Alienation of Rights to an Invention (Useful Model)**

1. If an invention (useful model), except for a secret invention (useful model), has not been used or has been used not fully in Ukraine during three years after the date of the publication of the information on the patent issue or after the date, when the use of the invention (useful model) was terminated, then any person desirous of and prepared to using the invention (useful model) may refer to the court of law with an application for a permit to use the invention (useful model) on a non-exclusive licence conditions, in case of the refusal of the owner of rights to conclude a licence agreement.

Unless the patent holder proves that the failure to use the invention (useful model) was caused by justifiable reasons for non-use, the court of law shall pass a decision to grant the permit to the interested person to use the invention (useful model) on a non-exclusive licence conditions stating the scope of the application, the term of validity of the permit, the amount and the procedure of the payment of emoluments to the patent holder.

2. A patent holder shall be obliged to grant a permit (licence) for the use of the invention (useful model) to a holder of a patent granted later, if the latter's invention (useful model) is intended for attaining another objective or has considerable technical and economic advantages but may not be used without infringement on rights of the owner of the patent granted earlier.

The permit shall be granted in the scope required to use the invention (useful model) by the holder of the patent granted later. In this case, the owner of the patent granted earlier shall have the right to obtain a licence for using the invention (useful model), which is protected by the patent granted later, on favourable conditions.

3. Taking into account the public interest and in case of the state of martial law or the state of emergency, the Cabinet of Ministers of Ukraine shall have the right to allow a person nominated by it to use the invention (useful model) without consent of the holder of the patent (declarative patent) on non-exclusive licence conditions with the payment of an appropriate compensation to the patent holder.

4. A holder of the patent (declarative patent) for a secret invention or a declarative patent for a secret useful model may grant a licence for using his invention (useful model) only to a person having the right of access to such invention (useful model) obtained from the State Expert.

If the said person is not able to come to an agreement in respect of the licence with the holder of such patent, the Cabinet of Ministers of Ukraine shall have the right to allow the person nominated by the State Expert to use the secret invention (useful model) without consent of the patent holder on non-exclusive licence conditions with the payment of an appropriate compensation to the patent holder.

5. Disputes related to conditions of granting licences and the payment of compensations and the amount thereof shall be settled by way of court procedure.

### **Article 31. Actions not Deemed to Constitute Infringement upon Rights**

1. Any person, which has used the technological (technical) solution identical to the claimed invention (useful model) in the interests of his activities for commercial purposes *bona fide* or made considerable and serious preparations to such use prior to the date of the submission of an application to the Institution or, if the priority is claimed, prior to the date of priority, shall retain the right to the gratis continuation of such use or to the use of the invention (useful model) envisaged by the said preparations (right of prior use).

The right of prior use shall be restricted by the scope of the use of the solution identical to the claimed invention, which existed as of the application submission date.

The right of prior use may be transferred or passed on to another person only together with the enterprise or the business practice or the part of the enterprise or the business practice, where the solution identical to the claimed invention (useful model) was used or considerable and serious preparations for such use were made.

2. The following use of the patented invention (useful model) shall not be considered to constitute the infringement upon rights resulting from a patent:

- the use in the design or in the course of the operation of a vehicle of a foreign state, which sojourns temporarily or accidentally in waters, airspace or on the territory of Ukraine, provided that the invention (useful model) is being used solely for the needs of the said vehicle;
- the use without commercial purposes;
- the use for scientific or experimental purposes;
- the use in case of extraordinary situations (acts of God, disasters, epidemics, etc.);
- the use for the one-time production of medicines in pharmacies according to a doctor's prescription.

3. The introduction in business turnover of a product manufactured using the patented invention (useful model) by any person, which acquired it without infringing upon rights of the holder, shall not be considered to constitute infringement upon rights resulting from a patent.

A product manufactured using the patented invention (useful model) shall be deemed to have been acquired without infringing upon rights of the patent holder, if such product has been manufactured and/or introduced in the turnover after the manufacture by the patent holder or another person upon special permit (licence) of the patent holder.

4. The use of an invention for commercial purposes by any person, which acquired a product manufactured using the patented invention and could not know that such product has been manufactured or introduced in the turnover with infringement upon rights conferred by the patent, shall not be considered to constitute the infringement upon rights resulting from the patent. However, upon receipt of an appropriate notice of the owner of rights, the said person shall cease using the product or pay the owner of rights relevant costs, whose amount shall be ascertained according to laws or upon consent of the parties. The disputes related to such payments and the disbursement procedures shall be settled by way of a court procedure.

## **Section VI. TERMINATION AND INVALIDATION OF A PATENT**

### **Article 32. Termination of a Patent**

1. At any time, a patent holder may renounce the patent in full or in part on the basis of an application submitted to the Institution. The said renunciation shall become effective as from the date of the publication of the information about it in the official bulletin of the Institution.

No full or partial renunciation of a patent without prior notice to a person vested with the right to use the invention under a licence agreement registered in the Institution or in case of the attachment of the property for the debt, if it includes the rights confirmed by the patent shall be allowed.

2. The validity of the patent shall be terminated in case of the failure to pay the annual fee for maintaining the validity of the patent.

The annual fee for maintaining the validity of the patent shall be payable for each year of its validity starting from the application submission date. The document confirming the first payment of the said fee shall be received by the Institution not later than in 4 months upon the date of the publication of the information on the patent issue. The document confirming the payment of the fee for each subsequent year shall be received by or sent to the Institution till the end of the current year of the patent validity subject to the fee's being paid within last four months of the year.

The validity of the patent shall be terminated from the first day of the year, for which no fee was paid.

The annual fee for maintaining the validity of the patent may be paid during 12 months after the expiry of the established period. In this case, the annual fee amount shall be increased by 50 per cent. In case of the fee payment, the validity of the patent shall be restored.

If the fee was not paid during these 12 months, the Institution shall publish the information on the termination of the patent in its official bulletin.

No fee shall be payable for maintaining the validity of a patent (declarative patent) for a secret invention or a declarative patent for a secret useful model.

### **Article 33. Invalidation of a Patent**

1. A patent may be declared invalid in full or in part, in case of:

a) non-compliance of the patented invention (useful model) with patentability conditions specified hereby;

b) availability of features in the formula of the invention (useful model), which were not included in the submitted application;

c) violation of requirements of part two of article 37 hereof.

2. Any person may appeal against the issue of the patent to the court and submit an objection to the patent to the Chamber of Appeal within 6 months of the date of the publication of the information on the patent issue.

3. The objection to the patent shall be considered by the Chamber of Appeal within 4 months of the receipt date, or, in case of the consideration of an objection to a declarative patent for an invention (useful model)—within 4 months of the date of the receipt of an expert opinion on compliance of the invention (useful model) with patentability conditions.

The patent holder shall be familiarised with the objection. The Chamber of Appeal shall consider the objection within the scope of motives set forth therein. The person, who filed the objection, and the patent holder may take part in the deliberation. The decision of the Chamber of Appeal may be appealed against at a court of law.

If the objection to a patent was not received by the Chamber of Appeal within the specified term, the patent may be invalidated only by way of the court procedure.

4. The term of appeal against the issue of a patent to the Chamber of Appeal may be extended, but not more than by 6 months. A fee shall be payable for such extension.

The procedure of bringing appeal against a patent to the Chamber of Appeal and the procedure of the extension of the term of appeal shall be specified by the Institution.

5. In case of appealing against a declarative patent for an invention (useful model) at the court, the latter may order an expert appraisal of the compliance of the invention (useful model) with patentability conditions.

6. The expert opinion in respect of the compliance of an invention (useful model) with patentability conditions shall be provided by the Institution to any person, who submitted an application for the qualification expert appraisal and paid an appropriate fee therefor.

7. The Institution shall announce the invalidation of the patent or a part thereof in its official bulletin.

A patent or a part thereof, which are invalidated, shall be deemed not to have come into force as from the date of the publication of the information on the patent issue.

## **Section VII. PROTECTION OF RIGHTS**

### **Article 34. Infringement upon Rights of the Patent Holder**

Any encroachment upon rights of the patent holder envisaged by article 28 hereof shall be deemed to constitute the infringement upon the rights of the patent holder resulting in the liability under the current legislation of Ukraine.

2. The patent holder may require:

- the termination of actions, which infringe upon or threaten with the infringement upon his rights, and the restoration of the *status quo* before such infringement;
- the payment of damages, including non-received revenue;
- reimbursement for the emotional duress;
- taking other actions related to the protection of rights of the patent holder envisaged by legislative acts.

A person entitled to use the invention (useful model) under a licence agreement may also require the restoration of the infringed rights of the patent holder, unless otherwise provided by such agreement.

### **Article 35. Disputes to be Settled by Way of Court Procedure**

1. Disputes related to the application hereof shall be settled by the court of law, court of arbitration according to the procedure established by the current legislation of Ukraine.

2. According to their competence, the courts shall consider the disputes related to:

- the invalidation of a patent;
- the authorship of an invention (useful model);
- ascertaining the patent holder;
- infringement upon property rights of the patent holder;
- the conclusion and performance of licence agreements;
- the issue of a forced licence;
- the right of prior use;
- the emoluments of the inventor;
- the compensation.

Courts shall also consider other disputes related to the protection of rights conferred hereby.

## **Section VIII. CLOSING PROVISIONS**

### **Article 36. Fees**

Fees shall be payable for the submission of applications, the expert appraisal thereof, the state registration and the issue of patents, maintaining the validity of patents and extension of their validity period, etc. The amounts of fees envisaged hereby, the time for and the procedure of the payment thereof shall be specified by the Cabinet of Ministers of Ukraine.

The funds derived from the fees and payments for the provided services shall be credited to the State Budget of Ukraine and used for the development of the national system of the legal protection of the industrial property.

### **Article 37. Patenting an Invention (Useful Model) in Foreign Countries**

1. Any person shall have the right to patent an invention (useful model) in foreign countries.

2. Prior to the submission of an application for a protective document in respect of an invention (useful model) to a body of a foreign country, including an international application, the applicant shall be obliged to submit an application to the Institution and notify it of the intention to effect such patenting.

Unless a notice of prohibition has been given during 3 months of the date of the receipt of such notification by the Institution, an application for a patent for an invention (useful model) may be submitted to a body of a foreign country.

If necessary, the Institution may allow to patent an invention (useful model) in foreign countries before the expiry of the above period.

3. If an invention is patented under the procedure of the Patent Co-operation Treaty, the international application shall be submitted to the Institution.

### **Article 38. State Encouragement of the Development and Use of Inventions (Utility models)**

The state shall encourage the development and use of inventions (utility models), set privileged conditions of taxation and lending for inventors and persons using the inventions (utility models), and grant them other privileges according to the current legislation of Ukraine.

A honorary title of the Ukraine's Honoured Inventor may be conferred upon inventors of highly efficient used inventions (utility models).

## **Section IX. TRANSITIONAL PROVISIONS**

1. Applications for patents of Ukraine for inventions with a validity period of five years without expert appraisal of the content (hereinafter referred to as ‘five-year patents’) submitted in accordance with Resolution of the Supreme Rada (Parliament) of Ukraine of 23 December 1993 “On Enforcing the Law of Ukraine “On Protection of Rights to Inventions and Utility models” (3769-12), whose processing was not completed by 31 October 1998, shall be treated by the Institution as applications for declarative patents for inventions.

2. For applications for five-year patents, in whose respect the decision to grant a patent was taken before 31 October 1998 but neither the state registration, nor the publication of the information about the issue of patents have been effected, the Institution shall issue declarative patents for inventions and publish the information about the issue thereof subject to the payment of an appropriate fee.

Holders of five-year patents for inventions may submit applications for the qualification expert appraisal and the transformation of patents according to the procedure established for declarative patents by article 26 hereof.

## **Section X. FINAL PROVISIONS**

1. This Law shall come into force from the date of the publication thereof.

2. It shall be established that until the legislation is brought in compliance herewith, other laws and regulations shall apply to the extent of their not contradicting this Law.

3. Within three months, the Cabinet of Ministers of Ukraine shall submit to the Supreme Radas of Ukraine proposals on bringing legislative acts of Ukraine in compliance herewith.

4. It shall be established that upon this Law’s coming into force, the following acts shall become null and void:

Resolution of the Supreme Rada of Ukraine of 19 January 1995 “On Approval of the Regulations on the Procedure of Formalising and Using the Rights to Inventions, Utility models and Industrial Samples Being State Secrets” (4/95-VR) (Vidomosti Verkhovnoyi Rady Ukrayiny, 1995, issue 3, page 23);

paragraphs ten and eleven of item 3 and item 4 of Resolution of the Supreme Rada (Parliament) of Ukraine of 23 December 1993 (3769-12) “On Enforcing the Law of Ukraine “On Protection of Rights to Inventions and Utility models” (Vidomosti Verkhovnoyi Rady Ukrayiny, 1994, issue 7, page 33; 1997, issue 40, page 269)”.

**L. Kuchma**  
**President of Ukraine**  
**City of Kyiv,**