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Technical Solutions and Their Legal Protection

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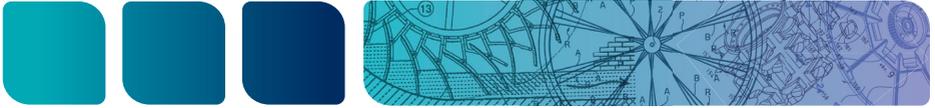
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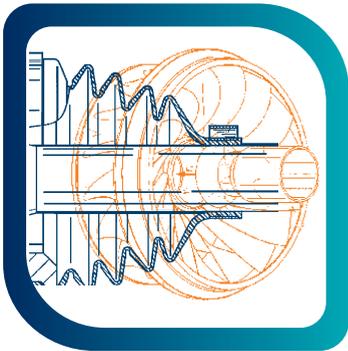
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TECHNICAL SOLUTIONS AND THEIR LEGAL PROTECTION



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Technical solutions and their legal protection

One of the main tasks of the Industrial Property Office (hereinafter referred to as "Office") is to decide on the provision of industrial legal protection for technical solutions by granting patents for inventions and registering utility models.

The purpose of industrial legal protection is to provide the authors and owners of new technical solutions with advantages and to safeguard the result of their creative work so as to prevent their competitors from getting hold of that result quickly and easily without incurring any costs and from depriving the author of the new solution or the person who financed and directed the project of profit to which they are entitled to on the basis of good manners.

At present, two types of legal protection for technical solutions are available, namely protection by a patent or by a utility model. These forms of protection differ in particular in the length of protection and in financial costs spent on the obtaining and maintenance of the protection. Higher financial costs of the patent grant procedure and of maintaining the patent valid as well as longer duration of the patent grant procedure are counterbalanced by longer term of protection and, thanks to the examination of the patentability conditions, by high degree of certainty for the patent owner in the market position.

The subject matters of protection, i.e. an invention or a technical solution, are comparable; for an invention eligible for patent protection, higher professional activity that had to be spent to solve the given technical problem can be assumed.

The protection by a patent or a utility model and the application procedure are regulated particularly by the following legal rules:

- Act No. 527/1990 Coll., on inventions and rationalization proposals, as amended;
- Act No. 206/2000 Coll., on the protection of biotechnological inventions;
- Decree No. 550/1990 Coll., on the procedure concerning inventions and industrial designs, as amended by Decree No. 21/2002 Coll.;
- Act No. 478/1992 Coll., on utility models, as amended;
- Act No. 634/2004 Coll., on administrative fees, as amended;
- Act No. 173/2002 Coll., on fees for maintenance of patents and supplementary protection certificates for medicaments and plant protection products.



What is a patent?

A patent is a form of legal protection of an invention meeting the legal criteria for this protection. The patent owner has the exclusive right to use the protected invention, to authorise others to use the invention (by concluding a licence contract) and to assign the patent to another person. An invention for which a patent was granted, e.g. a product, a manufacturing facility, a chemical substance or a manufacturing process, may not be manufactured, offered for sale or used by a third party for industrial or commercial purposes without the consent of its owner. If the patent relates to manufacturing processes,

the patent owner may prohibit third parties from using such processes. The right to prohibit also applies to products that are the direct result of a protected process.

Patents are granted for any inventions which are new, involve an inventive step and are susceptible of industrial application. The following in particular is not regarded as inventions: discoveries, scientific theories and mathematical methods, aesthetic creations, schemes, rules and methods of performing mental acts, playing games or doing business, programs for computers or presentation of information. Patents also cannot be granted for plant or animal varieties or essentially biological processes for the production of plants or animals, methods of treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body, and for inventions the exploitation of which would be contrary to public order or morality.

How can I obtain a patent?

The patent is applied for by filing an application for an invention with the Office on a prescribed form which can be obtained free of charge in the Office's filing office or through the Internet on the Office's website. In addition to the completed and signed form of the application with the request for the grant of the patent in one copy, the application also includes the description of the patent, at least one patent claim, drawings, if any, and an abstract, all these in three copies, of which at least one, the main copy, must comply with the requirements for print and reproduction. One additional copy must be signed by the applicant.

The application (as well as all submissions) can be filed electronically with an advanced electronic signature. Fax or electronic submission without an advanced electronic signature must be completed with written form (or electronic form with an advanced electronic signature) within 5 days. The filing can also be done through the Office's data box.

The invention must be disclosed in the invention application in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. From the point of view of the effects of the patent, it is also necessary to clearly and precisely distinguish what the patent protects. Patent claims must clearly and briefly define the subject matter to be protected by the patent. The abstract, which serves particularly for search purposes must contain a brief characteristic of the subject matter to be protected by the patent.

The requirements placed on the application for an invention are stated in more detail in the "Instruction of the President of the Industrial Property Office which defines the standard of arrangement of an application for an invention, a request for the grant of a supplementary protection certificate and an application for a utility model" (hereinafter referred to as "Instruction"). The Instruction can be obtained free of charge in the Office's filing office or through the Internet.

The priority right of the applicant shall begin with the filing of the application for an invention. This particularly means that in the case of granting protection for a subject matter applied for or publication in the course of the invention application procedure (see below), another applicant cannot be effectively granted protection for the same subject matter applied for later.

If the application does not contain obviously non-patentable solutions (see above)

and if there are no defects that would prevent its publication, the Office will publish the application after the expiration of 18 months from the rise of the priority right and will announce this publication in the Bulletin of the Office.

At the request of the applicant or another person, the Office will subject the application to examination as to whether it meets the criteria for the grant of the patent, i.e. the criteria of novelty, inventive step and industrial applicability. The request for full examination must be filed 36 months after the filing date of the application at the latest. This time limit cannot be extended and its missing cannot be waived. If the technical solution applied for meets the legal requirements, the Office will grant the patent for the invention.

The patent is valid for 20 years from the filing date of the application. The effects of the patent begin on the day on which the grant of the patent was announced in the Bulletin of the Office. After the grant of the patent, the Office will invite the patent owner to pay the first maintenance fee for the validity of the patent up to that moment. Fees for maintaining the validity of the patent for further periods are paid without assessment (without invitation by the Office) year after year, always before the expiration of the previous year of the validity of the patent. The fee may be paid within the so-called grace period of six months (if not paid within the prescribed time limit), but the fee will double in that case.

The application procedure and the maintenance of patents in force are subject to fees.

What are the basic administrative fees for protection?

For filing of application	1,200 CZK
- if only inventor(s) is (are) applicant(s)	600 CZK
For request for substantive examination	3,000 CZK
- for 11 th and each additional asserted patent claim	500 CZK
For issuance of patent document within the extent of 10 typed pages	1,600 CZK
- for each additional page	100 CZK
Patent maintenance fees	
a) for first to fourth year (per year)	1 000 CZK
b) for fifth to eighth year (per year)	2,000 CZK
c) for ninth year	3,000 CZK
d) for tenth year	4,000 CZK
e) for eleventh and every additional year, the fee under increases each year by	2,000 CZK



What is a utility model?

The utility model can protect a technical solution which is new, goes beyond mere professional skills and is susceptible of industrial application. The following is not regarded as technical solutions: discoveries, scientific theories and mathematical methods, mere outer finishing of products (pursuing aesthetic purposes), schemes, rules and methods of performing mental acts, programs for computers and mere presentation of information.

The following is also excluded from the protection: technical solutions that are contrary to public interest, particularly to the principles of humanity and public morality, plant and animal varieties as well as biological reproductive materials and production processes or work activities. Subject matters that can be protected by a patent and by a utility model are therefore comparable. However, unlike patents, utility models cannot be used to protect biological reproductive materials and any “methods“.

Utility models are registered in the register on the basis of the so-called registration principle where the Office registers the utility model in the register without examining whether the subject matter of the application meets the criteria of novelty and inventive step, i.e. whether it is eligible for protection. This is the main difference from the patent system.

Since the registration of a utility model in the register of the Office gives rise to protection whose effects fully correspond with the effects of a patent, protection of a solution eligible for the registration can be obtained much faster with a utility model than with a patent. This is particularly relevant for items that are ready to be launched on the market at the time when protection is being secured and that would remain without protection for a long period of time (or forever) due to the relatively lengthy patent grant procedure.

Nobody can manufacture, put into circulation or use in their business activity a technical solution protected by a utility model without the consent of the owner of the registered utility model. The owner of the registered utility model is entitled, just like in the case of an invention, to give their consent to the use of the subject matter of the utility model (licence) to other persons or to assign the utility model to them.



How can I obtain the registration of a utility model?

The utility model is applied for by filing an application for a utility model with the Office on a prescribed form which can be obtained free of charge in the Office's filing office or through the Internet. In addition to the completed and signed form of the application for registration on a utility model in one copy, the application must also include the description of the technical solution, at least one claim for protection and drawings, if any; all these in two copies, of which at least one, the main copy, must comply with the requirements for print and reproduction. On additional copy must be signed by the applicant. The application (as well as all submissions) can be filed electronically with an advanced electronic signature. Fax or electronic submission without an advanced electronic signature must be completed with written form (or electronic form with an advanced electronic signature) within 5 days. The filing can also be done through the Office's data box.

The technical solution must be disclosed in the application in a manner sufficiently clear for it to be carried out by a person skilled in the art. Claims for protection must clearly and briefly define the subject matter to be protected by the utility model. The form of claims fully corresponds to patent claims with the exception that no claims as to methods can be effectively asserted.

The requirements placed on the utility model application are stated in more detail in the "Instruction" which can be obtained free of charge in the Office's filing office or through the Internet. The priority right of the applicant shall begin with the filing of the application with the Office vis-à-vis any person who later files an identical application.

Based on the so-called registration principle, the Office subjects the application only to formal examination prior to registration of the utility model and excludes from further procedure those applications whose subject matters do not represent a technical solution, are not susceptible of industrial application or fall within exclusions from protection. The Office does not examine whether the subject matter of the application meets the criteria of novelty and inventive step. The so-called examination for registration results in very quick registration of the utility model in the register when compared with the grant of a patent, usually within 2 to 3 months from the filing of the application.

A registered utility model is valid for 4 years from the filing date of the application. The Office shall extend the term of validity of the utility model registration at the request of the owner of the utility model up to two times, each time by three years. Therefore, the maximum term of validity of the registered utility model is 10 years.

The application procedure and the extension of the term of validity of the utility model registration are subject to fees.



What are the basic administrative fees for the protection?

For the filing of the utility model application **1,000 CZK**

- if only the author(s) is (are) the applicant(s) **500 CZK**

For the filing of a request for extension of the term of validity of the utility model registration

- for three years for the first time **6,000 CZK**
- for three years for the second time **6,000 CZK**



How can I file application concerning invention abroad?

Currently, there are the following possibilities how to file an application concerning an invention abroad:

1. **National route**

The applicant may file the application concerning an invention directly in each state in which they wish to have their invention protected. For this purpose, it is necessary to

choose a representative in each state who will be authorized to represent the applicant before the respective office, to translate the description of the invention, patent claims and the abstract in the official language of that office and to pay the fees. All information concerning the filing of the application for the invention, the application procedure and the amount of fees including deadlines for their payment will be provided by the chosen representative.

2. „European patent“ route

If the applicant wishes to obtain the patent only for the member states of the European Patent Organization (EPOrg), they can file an application for a European patent. As of 1 January 2018, the EPOrg member states are as follows: Albania, Austria, Belgium, Bulgaria, Croatia, Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, the Former Yugoslav Republic of Macedonia, Malta, Monaco, the Netherlands, Norway, Poland, Portugal, Romania, San Marino, Serbia, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey, and the United Kingdom. The non-member states in whose territories the European patent can take effect on the basis of the so-called “extension system” are Bosnia and Herzegovina, and Montenegro. European patents can also take effect in Morocco, Moldova and Tunisia.

A European patent application may be filed by any natural person or legal entity, regardless of their nationality, or residence or seat. However, applicants who do not have their residence or seat in one of the contracting states have to be represented in all proceedings before the European Patent Office (EPO), except for the filing of the European patent application, by a representative who is registered in the list administered for this purpose by EPO. The directory of qualified representatives can be ordered from EPO.

The European patent application can be filed

- with the European Patent Office in Munich or with its branch in Hague or its local office in Berlin;
- if the law of the contracting state permits or prescribes so, with the central industrial property office or another competent body of that contracting state.

The European patent application is filed in one of the official languages of the EPO, i.e. in English, French or German, or, if filed in another language, it has to be translated into one of the official languages in accordance with the implementing regulation which sets the time limit of 2 months from the filing date of the European patent application for submission of the translation. Applicants who have their residence or seat in the territory of a contracting state whose official language is a language other than one of the official languages of the EPO and nationals of that state who have their permanent residence abroad and file a European patent application in the official language of that state, therefore also in Czech, are entitled, under certain conditions to a reduction of the filing fee by 30% (the same applies to the examination fee). The said 30% reduction only applies to small and medium enterprises, natural persons, universities, non-profit organizations and public research organizations.

The following fees are associated with the filing of the European patent application:

- filing fee
- search fee
- fee for the 16th and each additional claim, if any

(payable within one month from the filing date of the application)

All fees associated with the filing of European applications are payable directly to EPO in the European currency (EUR). The day considered as the payment day is the day on which the amount or transfer is actually credited to the EPO's bank account. It is recommended that applicants, when providing data concerning payments, always use the EPA/EPO/OEB 1010 form where the individual amounts of the payment are specified.

Some selected fees from the Schedule of Fees:

Valid as of 1 April 2016

(more information at <http://www.epoline.org/portal/portal/default/epoline.Scheduleoffees>)

Filing fee 210 EUR

Filing fee (online filing) 120 EUR

Additional fee for applications with more than 35 pages

- for the 36th and each subsequent page 15 EUR

Search fee 1,300 EUR

Lump sum designation fee 585 EUR

Fee for the 16th and each subsequent claim up to the limit of 50 / for the 51st and each subsequent claim 235 / 585 EUR

Examination fee 1,635 EUR

Fees for excluded European patent applications have been newly introduced

More information on the filing of European patent applications:

Internet: www.epo.org

Publication: *Jak získat Evropský patent (How to obtain a European patent)*

Address of the EPO: European Patent Office – headquarters in Munich:

European Patent Office
Bob-van-Benthem-Platz 1
80469 München
Germany



Postal address: European Patent Office
80298 München, Germany

3. **International application route - PCT**

As regards the international patent application filed under the Patent Cooperation Treaty (PCT), single application filed e.g. with the Industrial Property Office (IPO CZ) serves as the filing in all (designated) states. After entering the national phase of the procedure, protection can be obtained in up to 148 contracting states, together with four regional patents (including the European patent) (situation as at 1 March 2016). The international application is filed with IPO CZ in English, German or French, the form for request for international application must be in the same language. The application may be filed also in Czech, it being understood that it is necessary to submit a translation into one of the aforementioned languages within one month from the filing date of the international application. However, the request must always be submitted in one of these languages. **The**

The following fees are associated with the filing:

Valid as of 1 April 2016

(more information at <http://www.wipo.int/pct/en/fees/>)

Transmittal fee	1,500 CZK
Fee for the proof of the priority right (if priority right from an earlier Czech application is claimed)	600 CZK
International filing fee	1,219 EUR
International search fee	1,875 EUR

If the applicant is a natural person with the Czech nationality and the seat in the Czech Republic, the applicant may claim 90% reduction from the international filing fee. If there are multiple applicants, all of them must fulfil these preconditions.

The international filing fee and the search fee are paid to the account of the Industrial Property Office, opened particularly for this purpose, in the said amounts in EUR.

The international application may also be filed in electronic form; IPO CZ allows the filing through ePCT software. Information about the software, including information how to obtain it and what the hardware requirements are, is available on the WIPO website (www.wipo.int/pct).

With effect from 1 July 2016, the applicant or their representative must select in Box VII of the request form (Form PCT/RO/101) the searching authority that will perform the search. From this date, the Czech applicant may choose between the EPO and the Visegrad

Patent Institute (VPI). More detailed information on fees and language requirements can be obtained on IPO CZ's website.

The international phase of the procedure consists of the performance of international search and the publication of the international application 18 months from the priority date. Based on the international search and the issuance of the opinion on patentability, the applicant may decide whether and in which state they will apply for the grant of a national patent. The deadline for entry into the national phase is set at 30 months from the rise of the priority right, with each office having the possibility to set a longer time limit. However, offices in states where the extension of the deadline to 30 months is not in accordance with the national law may leave the deadline for entry into the national phase as previously set. Each office must notify this fact to the International Bureau of WIPO which will publish this information. It is therefore necessary for the applicant to verify in due time, e.g. on the WIPO website or in the PCT Applicant's Guide, the deadline for the entry into the national phase set by the office with which the applicant plans to apply for the grant of a national or regional patent.

Furthermore, the applicant may, within 22 months from the rise of the priority right or within three months from handover of the search report and the written opinion, whichever comes later, request international preliminary examination. The international preliminary examination fee is 1,930 EUR, the handling fee is 183 EUR. In this way, the applicant can also extend the deadline for entry into the national or regional phase to 30 months from the rise of the priority right with those offices with whom it is not possible, pursuant to the national law, to extend the deadline for entry into the national phase from 20 to 30 months without requesting the international preliminary examination.

Since 1 July 2016, Czech applicants may file a request for international preliminary examination to the Visegrad Patent Institute (VPI) through IPO CZ. It is still possible to send the request for international preliminary examination to the EPO in Munich and to pay the relevant fee to its account.

When entering the national or regional phase, where the grant procedure takes place, it is necessary to pay other fees in accordance with the national or regional legislation. In most states, the applicant must be represented in proceedings by a representative authorized to represent applicants before the respective office.

More information about the international application procedure:

Internet: www.wipo.int/pct

Email: pct.infoline@wipo.int

Tel.: (+41 - 22) 338 83 38

Fax: (+42 - 22) 338 83 39

Attorneys and patent attorneys registered in the Czech Republic are authorized to represent applicants before the Industrial Property Office of the Czech Republic within the meaning of

the provision of Section 70 of Act No. 527/1990 Coll., as amended. It is also possible to ask directly the respective professional chambers for the list of members.



Where can I get further information?

Employees of the Industrial Property Office are ready to answer your questions related to the protection of technical solutions, to provide general information on the individual institutes of industrial law, on formal requirements for applications or the circumstances of proceedings concerning these applications, on administrative fees and performance of searches.

The Industrial Property Office provides the following services:

- monitoring and constantly sending newly published documents or parts thereof
- searches performed in national databases and databases of commercial providers (STN, EPOQUE):
- searches for prior art (based on keywords, international patent classification symbols, etc.)
- searches for the legal status of a document
- searches for patent families
- searches for the name of the inventor or applicant
- inquiries and searches in the database of national documents
- trade mark searches
- searches for outer appearance of products

Information Centre

Employees of the Information Centre will be happy to provide you with information related to the issue area of the protection of technical solutions or to the invention and utility model application procedures

Internet

You can get information about the activities and services of the Office also on the Internet at www.upv.cz.

On its website, the Office provides access to information about the individual subject matters of industrial property, provided services, relevant legal regulations and activity of the Industrial Property Training Institute. The presentation of the individual subject matters of industrial property includes the relevant application forms.

As part of the extension of services to the Internet users, the Office placed on its website order forms that can be used to order online patent searches, industrial searches and trade mark searches, Bulletins and publications of the Office.

The individual industrial rights classifications are also available on the website (in PDF format); the public has access through the Internet to both levels of the 8th version of the International Patent Classification. Starting with the issue 1/2000, the Bulletin of the Office is displayed on the Internet.

Industrial Property Office

Antonína Čermáka 2a,
160 68 Praha 6 - Bubeneč

tel.: 220 383 xxx (direct dial-in)
220 383 111 switchboard
220 383 129 public reading room
220 383 120 Information Centre
fax: 224 324 718 (filing office)
224 311 566 (public reading room)
email: objednavky@upv.cz
posta@upv.cz
helpdesk@upv.cz
studovna@upv.cz

Internet: www.upv.cz

Office hours of the public reading room and the Information Centre:

Monday 8:00 a.m. – 5:00 p.m.
Tuesday 8:00 a.m. – 4:00 p.m.
Wednesday 8:00 a.m. – 5:00 p.m.
Thursday 8:00 a.m. – 4:00 p.m.
Friday 8:00 a.m. – 2:30 p.m.

Attorneys and patent attorneys:

Attorneys and patent attorneys provide expert advice and assistance to natural persons and legal entities in industrial property matters, arrange preparation of applications, their filing and representation in proceedings before the Office.

Chamber of Patent Attorneys

Gorkého 12
602 00 Brno
tel.: 541 248 246
fax: 541 219 469
email: kpz@patentovizastupci.cz
www.patzastupci.cz/

Czech Bar Association

Národní 16
110 00 Praha 1
tel.: 221 729 011
fax: 224 932 989
email: sekr@cak.cz
www.cak.cz