

**UKRAINE**

**On Protection of Rights to Inventions and Utility Models**

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## **Section I GENERAL PROVISIONS**

### **Article 1. Definitions**

For the purposes of this Law, the following definitions shall apply;

National Intellectual Property Office (hereinafter NIPO) means a state organisation that is part of the state system of the legal protection of intellectual property, defined at the national level by the Cabinet of Ministers of Ukraine, exercising powers in the field of intellectual property, defined by this Law, other laws in the field of intellectual property, acts of the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, and the charter, and has the right to represent Ukraine in international and regional organisations;

Appeals Chamber means a collegiate body of NIPO for consideration of objections against NIPO's decisions on acquisition of intellectual property rights, statements of invalidation of intellectual property rights in whole or in part, statements of recognizing a trademark well known in Ukraine and consideration of other issues within its competence under this Law, other laws and regulations of Ukraine;

invention (utility model) means the result of intellectual, creative human activity in any field of technology;

secret invention (secret utility model) means an invention (utility model) containing information classified as a state secret, the rights to which are certified by a patent for a secret invention (secret utility model);

service invention (utility model) means an invention (utility model) created by an employee;

in connection with the performance of official duties or upon employer's instruction, unless the labour agreement (contract) provides otherwise;

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

official duties mean responsibilities of an employee stated in labour agreements (contracts) and job descriptions functional, which involve the performance of works that may result in an invention (utility model);

employer's instruction means an assignment issued to the employee in writing, which is directly related to the specifics of the activity of the enterprise or employer and may result in an invention (utility model);

employer means a person who hired an employee on the basis of a

labour agreement (contract);

inventor means a person whose intellectual and creative activity resulted in an invention (utility model);

patent (patent for an invention, patent for a secret invention, patent for a utility model, patent for a secret utility model) means a security document confirming the priority, authorship, and rights to an invention (utility model);

qualification expert appraisal (expert appraisal of content) means an expert appraisal that ascertains the compliance of an invention with patentability conditions (being novel, involving an inventive step, and being capable of industrial application);

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

license means a permission of the patent holder (licensor) granted to another person (licensee) to use the invention (utility model) under certain conditions;

person means an individual or legal entity;

application means a set of documents required for state registration of an invention (utility model);

applicant means a person who has filed an application or acquired the rights of an applicant under another procedure established by law;

priority of an application (priority) means the priority in submitting an application;

date of priority means the date of submission of the application to NIPO or an appropriate body of a state being party to the Paris Convention for the Protection of Industrial Property or Agreement establishing the World Trade Organization under which the priority is declared;

international application means an application submitted in accordance with the Patent Cooperation Treaty;

Register means the State Register of Inventions of Ukraine, State Register of Secret Inventions of Ukraine, State Register of Utility Models of Ukraine, State Register of Secret Utility Models of Ukraine maintained in electronic format;

state system of legal protection of intellectual property means the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, NIPO and a

system of scientific, educational, informational, and other state enterprises, institutions, organisations of relevant specialisation which are managed by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property;

1. Personnel Review Commission means the NIPO's collegiate body, the main purpose of which is to undertake a performance review of persons who have shown their intention to acquire the right to engage in the activities of a representative in intellectual property cases (patent attorney);

Appeals Commission means the NIPO's collegiate body, the main purpose of which is to consider complaints of candidates for representatives in intellectual property cases (patent attorneys) against decisions of the Personnel Review Commission and to consider complaints against the actions of intellectual property representatives (patent attorneys);

biological material means the material that contains genetic information and can self-reproduce or be reproduced in a biological system;

Bulletin means the official electronic bulletin of NIPO;

WIPO means the World Intellectual Property Organization;

state registration of an invention (utility model) means state registration of intellectual property rights to an invention (utility model);

rights to an invention (utility model) mean intellectual property rights to an invention (utility model).

## **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 and consists of this Law, Civil Code of Ukraine, Law of Ukraine On the State Secret and other regulations.

## **Article 3. Powers of the Central Executive Authority in Charge of Shaping and Implementing State Policy in the Field of Intellectual Property**

1. Powers of the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, shall include;

ensuring the regulatory and legal governance in the field of

protection of rights to inventions and utility models;  
defining the priority areas of developing the field of protection of rights to inventions and utility models;  
interaction and coordination with central executive authorities, other government authorities when shaping and implementing state policy in the field of intellectual property, as well with a view to strengthening the protection of intellectual property rights;  
development of proposals to improve legislation in the field of legal protection of intellectual property;  
international cooperation in the field of legal protection of intellectual property and representation of Ukraine's interests in the protection of rights to inventions and utility models at international organisations;  
conclusion of international treaties on cooperation in the field of legal protection of intellectual property in accordance with the law;  
ensuring the implementation of international programs and projects in the field of legal protection of intellectual property in accordance with international treaties;  
ensuring the fulfilment of obligations arising from Ukraine's membership in international organisations in the field of legal protection of intellectual property;  
interaction with the relevant authorities of foreign states and international organisations in accordance with the established procedure;  
approval of regulations on representatives in intellectual property cases (patent attorneys), on the Personnel Review Commission and the procedure for the review of representatives in intellectual property cases (patent attorneys), on the Appeals Commission, on the State register of representatives in intellectual property cases (patent attorneys);  
coordination of NIPO's activities in the field of intellectual property;  
exercising control over the NIPO's observance of the legislation in the field of intellectual property, use of proceeds from the collection of fees for actions related to the protection of intellectual property rights.

2. The central executive authority in charge of shaping and implementing state policy in the field of intellectual property shall exercise other powers under the law.

**Article 3-1. Powers of the National Intellectual Property Office in the Field of Protecting Rights to Inventions and Utility Models**

1. The functions of NIPO are performed by a legal entity of public law (state organisation), formed by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, and determined by the Cabinet of Ministers of Ukraine.

2. The powers delegated to NIPO shall include;

- receipt of applications, their expert appraisal, decision-making on them;
- conduct of the state registration of inventions and utility models and issuance of patents for inventions and utility models;
- recognition of rights to inventions and utility models in the manner prescribed by law;
- publication of official information about inventions and utility models in the Bulletin, maintenance of the Register, entering information into it, providing extracts and excerpts in electronic and (or) paper format;
- international cooperation in the field of legal protection of intellectual property and representation of Ukraine's interests in the protection of rights to inventions and utility model at the World Intellectual Property Organisation and international organisations in accordance with the law;
- training, performance review and registration of representatives in intellectual property cases (patent attorneys);
- maintenance of the State Register of Representatives in Intellectual Property Cases (patent attorneys);
- informing and giving explanations on implementation of the state policy in the field of protection of rights to inventions and utility models.

3. NIPO also shall;

- perform functions of the "Receiving Office", "International Search Authority", and "International Preliminary Examining Authorities" according to the Patent Cooperation Treaty;
- conduct informational and publishing activities in the field of legal protection of intellectual property;
- generalisation of national and international practice of application of legislation in the field of protection of rights to inventions

and utility models, elaboration of proposals for improvement of legislation in this area and submission of such proposals to the central executive authority in charge of shaping and implementing state policy in the field of intellectual property;  
approval of guidelines for the expert appraisal of applications and state registration of inventions and utility models;  
organisation and performance of training, retraining, and qualification improvement of personnel of the state system for legal protection of intellectual property;  
other functions and powers provided by this Law, other laws and regulations of Ukraine, the charter.

NIPO has the right to receive from ministries, other central and local executive bodies, and local self-government bodies the information, documents, and materials necessary to perform the powers and functions assigned to it free of charge.

4. NIPO acts on the basis of this Law, other laws, acts of the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, and the charter approved by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

5. To ensure the implementation of delegated powers by NIPO, the head of NIPO is authorised to sign law-making documents.

6. To prepare recommendations on matters falling within the competence of NIPO, the authority shall conduct scientific research, engage experts and consultants.

7. NIPO is chaired by the head, who is appointed and dismissed by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

The head of NIPO may be a citizen of Ukraine who has lived in Ukraine for the last five years, is fluent in the national language, fluent in one of the official languages of the World Intellectual Property Organisation (WIPO), has a university degree in law and/or intellectual property, work experience in the field of intellectual property for at least 10 years and experience in management positions for at least five years.

The head of NIPO may not be a person who, in accordance with a court decision, is deprived of the right to bring about activities

related to the performance of state functions or hold relevant positions, and has been subject to administrative penalties for corruption or corruption-related offences within three years following the day when the court judgment takes effect.

The head of NIPO is appointed subject to the results of an open competition conducted by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, in accordance with the established procedure for competitive selection of heads of business entities in the public sector.

The head of NIPO shall have one principal deputy and two deputies, who are appointed to the position by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, at the request of the head of NIPO.

8. The Supervisory Board is the supervisory body of NIPO and shall be composed of two representatives of the Verkhovna Rada of Ukraine; two representatives of the central executive authority in charge of shaping and implementing state policy in the field of intellectual property;

one representative of the central executive authority in charge of shaping and implementing state policy in the fields of science and education;

one representative of public organisations of intellectual property representatives (patent attorneys);

one representative of the National Academy of Sciences of Ukraine.

The Supervisory Board may consist of two representatives of international and/or regional intellectual property organisations with an advisory voting right.

The personal composition of the supervisory board shall be approved by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

Members of the Supervisory Board perform their duties on a pro bono basis.

The Head of the Supervisory Board and his/her deputies shall be elected by members of the Supervisory Board from among them. The Head of the Supervisory Board may not be a representative of the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

Powers of the Supervisory Board include the supervision of financial and economic activities of NIPO, budget execution, the use of funds

generated from the proceeds from the collection of fees for actions related to the protection of intellectual property rights. Supervisory Board shall be entitled to;

- request any information from NIPO, except for restricted information, and obtain such information;
- hear reports of the head of NIPO on the state of implementing powers by NIPO, on the conduct of financial and economic activities, budget execution, use of funds generated from the proceeds of collecting fees for actions related to the protection of intellectual property rights, as well as the plan of NIPO's activities;
- submit recommendations to NIPO that are mandatory for consideration;
- inform the central authority in charge of shaping and implementing state policy in the field of intellectual property, about identified violations.

The term of office of members of the Supervisory Board, except for the head, is two years and may be extended for no more than one term. Upon expiration of the term of office of a member of the Supervisory Board, the relevant body or organisation that delegated the member shall, within one month, delegate a new representative to the Supervisory Board or decide on extending the term of office of a member of the Supervisory Board.

The powers of a member of the Supervisory Board may be terminated prematurely at the request of the body that delegated him. The powers of a member of the Supervisory Board are also terminated at the initiative of the Supervisory Board in the case of;

- submission of an application for termination of powers at the member's request;
- inability to perform the duties due to health issues;
- termination of relations with the body delegating the member;
- entry into force of a court verdict against such member;
- death or by virtue of a court decision declaring the member incapable, of diminished legal capacity, missing or declared dead;
- application of administrative penalties for corruption or corruption-related offences.

The body that delegated a member of the Supervisory Board whose powers have been prematurely terminated shall be obliged to delegate a new representative to the supervisory board within one month from the date of early termination of the powers of the previous representative.

The Supervisory Board operates in accordance with this Law and the regulations on the Supervisory Board approved by the central

executive authority in charge of shaping and implementing state policy in the field of intellectual property.

The form of work of the Supervisory Board is a meeting, based on the results of which a protocol is drawn up, a copy of which is sent to NIPO and the central executive authority in charge of shaping and implementing state policy in the field of intellectual property. A meeting of the Supervisory Board shall be considered valid if a simple majority of the members of the Supervisory Board are present. The placement and organisational and material support of the Supervisory Board is provided by NIPO.

9. NIPO shall annually publish on its official website financial statements, in particular annual financial statements, audit reports on annual financial statements, the report on its activities, including budget execution, and the budget for the following year. NIPO's financial or consolidated financial statements are subject to audit, which is carried out based on the decision of the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

10. NIPO shall not have a purpose of making a profit from its activities. Funding of NIPO activities shall be provided from the proceeds from the collection of fees for actions related to the protection of intellectual property rights, as well as from other sources not prohibited by law.

NIPO procures goods, works and services in the manner and using the procedures established by the Law of Ukraine "On Public Procurement".

11. A qualified electronic signature may be used on documents accepted or approved by NIPO in accordance with this Law. Submission of documents in the electronic form to NIPO and issuance of documents in electronic form is carried out in accordance with the legislation in the field of electronic documents and electronic document management, electronic trust services, this Law and rules established by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

### **Article 3-2. Guarantees of Independence of the Appeals Chamber and Experts of the National Intellectual Property Office**

1. The activities of the Appeals Chamber shall be based on the

principles of legitimacy, impartiality, independence, transparency, reliability, collegiality and qualified staffing.

2. The main principles for considering objections and applications by the Appeals Chamber are the rule of law, legitimacy, equality of participants in the consideration before the law and the Appeals Chamber.

3. The powers of the Appeals Chamber, the requirements for its members, the procedure for consideration of objections against NIPO's decisions on acquisition of intellectual property rights by the Appeals Chamber, the procedure for organisational and technical support for activities of the Appeals Chamber and resolution of other issues falling within its competence shall be determined by the Rules of Procedure of the Appeals Chamber approved by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

4. Independence of a NIPO's experts and correctness of their opinion shall be ensured by; compliance with the procedure established by law for the appointment and conduct of expert appraisal; prohibition of interference in the expert appraisal process by anyone; creation of conditions necessary for the activities of the NIPO's experts, their financial, social, and other support; ensuring the possibility for the Appeals Chamber to review the conclusions of the expert appraisal; ensuring the possibility of the applicant and third parties to participate in the expert appraisal in the cases prescribed by law.

### **Article 3-3. Personnel Review Commission**

1. Personnel Review Commission means NIPO's collegiate body, which is established with the purpose of determining the level of professional training of persons who have shown their intention to acquire the right to engage in the activities of a representative in intellectual property cases (patent attorney);

2. The Personnel Review Commission shall consist of NIPO's employees, the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, and representatives in cases of intellectual property (patent

attorneys) who have at least 10 years of practical experience in the field of legal protection of intellectual property.

3. The powers of the Personnel Review Commission, its composition, formation procedure, requirements for its members, term of office as well as rules and procedures of its activities shall be determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

4. The Personnel Review Commission shall act on the basis of this Law and the regulation approved by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

#### **Article 3-4. Appeals Commission**

1. Appeals Commission means NIPO's collegiate body, which is formed to consider complaints of candidates for representatives in intellectual property cases (patent attorneys) against decisions of the Personnel Review Commission and to consider complaints against the actions of intellectual property representatives (patent attorneys), as well as to control that the patent attorneys meet the requirements of the legislation.

2. The Appeals Commission shall consist of employees of the NIPO, the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, prominent scientists working in the field of intellectual property, and representatives in cases of intellectual property (patent attorneys) who have practical experience in the field of legal protection of intellectual property for at least 10 years.

3. The powers of the Appeals Commission, its composition, formation procedure, requirements for its members, term of office, as well as rules and procedures of its activities shall be determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

4. The Appeals Commission shall act on the basis of this Law and the regulation approved by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

#### **Article 4. International treaties**

If an international treaty being of a binding nature approved by the Verkhovna Rada of Ukraine, establishes rules other than those provided for by the legislation of Ukraine on inventions (utility models), the rules of the international treaty shall apply.

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

1. Foreigners, stateless persons, and foreign legal entities enjoy the same rights, provided by this Law, as the citizens and legal entities of Ukraine in accordance with international treaties of Ukraine, the binding nature of which has been approved by the Verkhovna Rada of Ukraine.

2. Foreigners, stateless persons, foreign legal entities, and other persons residing or having a permanent location outside Ukraine, exercise their rights in relations with the NIPO through representatives of intellectual property (patent attorneys) registered in accordance with the provision, which is approved by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, except the cases provided in Part 3 of this Article.

3. Foreigners, stateless persons, foreign legal entities, and other persons residing or having a permanent location outside Ukraine may carry out the following actions independently; submit an application to establish the date of its submission; pay fees and state dues; provide copies of the previously submitted application to establish the date of its submission in accordance with Article 13 of this Law; provide copies of the previous application to establish the date of priority in accordance with Article 15 of this Law; receive receipts and notifications regarding any actions specified in Paragraphs 2 through 5 of this part, provided that the address for correspondence on the territory of Ukraine is indicated in the application.

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

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

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

2. An object of invention, the legal protection of which is provided in accordance with this Law, may be a product (a device, a substance, a culture of micro-organisms, a culture of cells of plants and animals, etc.), a process (method).

An object of a utility model, the legal protection of which is provided in accordance with this Law, may be a device or process (method).

3. Legal protection in accordance with this Law does not apply to the following objects; plant varieties and animal breeds; biological processes of reproduction of plants and animals that do not belong to non-biological and microbiological processes, as well as the products of such processes; structure of semiconductor devices; results of artistic design; surgical or therapeutic methods for treatment of a human or animal, methods for diagnosing the human or animal body. This provision does not apply to products (substances or compositions) used in diagnosis or treatment; processes for cloning human beings; processes for modifying germline genetic identity of human; the use of human embryos for industrial or commercial purposes; processes for modifying genetic identity of animals that may cause their suffering without any significant medical benefit to humans or animals, as well as animals bred as a result of such a process; the human body at different stages of its formation and development, as well as the simple detection of one of its elements, in particular a sequence or part of a gene sequence. This provision shall not affect the granting of legal protection to an invention which involves elements of the human body outside the body or otherwise obtained using a technical process, including a sequence or part of a gene sequence, even if the structure of that element is identical to that of a natural element; a product or process involving a plant or animal, the use of which is restricted to a particular plant variety or animal breed;

a product or process involving natural biological material which is not isolated from its natural environment or which is not a product of a technical process.

Prohibition at the legislative level of commercial use of a certain object for other reasons does not affect the provision of legal protection.

The following does not comply with the concept of invention (utility model), defined by Article 1 of this Law, and is not recognized as an invention (utility model) in accordance with this Law, if it acts as an independent object;

a discovery, scientific theory, mathematical method;

a diagram, rules and methods for games, competitions, auctions, physical exercises, intellectual or organisational, in particular economic, activities (planning, financing, supply, accounting, lending, forecasting, rationing, etc.);

computer software;

a form of presentation of information (for example, as tables, diagrams, graphs, using acoustic signals, words, visual demonstrations, in particular on the screen of a computer device, audio and video discs, symbolic notation, including road signs, route diagrams, codes, fonts, etc., schedules, instructions, designs or planning schemes of buildings, houses, territories);

the appearance of products (including products, buildings, areas) aimed at meeting solely aesthetic needs.

4. The priority, authorship, and rights to an invention and utility model are certified by a patent.

The term of validity of intellectual property rights to an invention shall be 20 years from the date of the submission of the application to the NIPO. If the application has been submitted as an international application, the term of validity of intellectual property rights to an invention shall be calculated from the date of submission of the international application.

The term of validity of intellectual property rights to a utility model shall be 10 years from the date of submission of the application to the NIPO.

The term of validity of intellectual property rights to a secret invention and secret utility model is equal to the term of the invention or utility model being secret, but may not be longer than the term of validity of intellectual property rights to an invention or utility model set hereby.

The validity of intellectual property rights to an invention (utility model) is terminated early under the conditions set out in Article 32 of this Law.

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

6. The validity of intellectual property rights to an invention, which is a method of obtaining a product, shall also apply to the product directly obtained using this method.

**Article 7. Patentability Conditions of an Invention, Utility Model**

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

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

3. An invention (utility 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 NIPO 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 state registration of an invention (utility model) in Ukraine (including an international application in which Ukraine is specified) 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 4 of this Article, which was published as of or after that date.

6. The disclosure of the information about an invention (utility 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 (utility model) during 6 months till the date of the application submission to the NIPO or, if the priority is claimed, till 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 explicitly. The contents of applications mentioned in Part 5 of this Article shall not be taken into account in the course of the assessment of the inventive step. New forms of drugs known from the level of technology, including salts, esters, ethers, compositions, combinations and other derivatives, polymorphs, metabolites, pure forms, particle sizes, isomers, may be deemed resulting from the level of technology explicitly if they do not differ significantly in efficiency.

8. An invention (utility 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 REGISTER AN INVENTION (UTILITY MODEL)**

#### **Article 8. Right of the Inventor**

1. An inventor shall enjoy the right to register an invention (utility model), secret invention (secret utility model), unless otherwise provided hereby.

2. Inventors, who created an invention (utility model) jointly, shall enjoy equal rights to register the invention (utility model), secret invention (utility model), unless otherwise provided by an agreement among them.

3. In case of the revision of terms and conditions of the agreement on the membership of inventors, the NIPO shall make changes in appropriate documents according to the procedure specified by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property 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. Individuals, which did not contribute creatively to the creation of the invention (utility 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/her name on the invention (utility model) created by him/her.

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

1. The inventor's employer shall enjoy the right to register a proprietary invention (utility model), unless otherwise provided in the agreement.

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

3. If the right to register a proprietary invention (utility model) belongs to the employer, the employer shall be obliged to submit an application for state registration of the invention (utility model) to the NIPO within four months of the date of receipt of the notice from the inventor, or confer the right to such registration on another person, or take a decision to treat the proprietary invention (utility 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 (utility model) and/or any other benefit which can be derived by the employer.

4. If the right to register the proprietary invention (utility model) belongs to the employer, and the employer fails to meet the requirements stated in Part 3 of this Article within the specified time frame, the right to register the proprietary invention (utility 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 (utility model) not being used as confidential information by the employer or its successor shall not exceed four years if such invention (utility model) is not used. Otherwise, the right to obtain a patent for the proprietary invention (utility 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 (utility model) and the amount thereof shall be settled by way of the court procedure.

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

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

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

If an invention (utility model) has been created by two or more inventors independently on one another, then the right for state registration of the invention (utility model) shall be enjoyed by

the applicant, whose application has an earlier date of submission to the NIPO 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 state registration of the invention (utility model) has been made.

## **Section IV PROCEDURE FOR INVENTION (UTILITY MODEL) REGISTRATION**

### **Article 12. Application**

1. A person desirous of registering an invention (utility model) and having the right thereto shall submit an application to the NIPO. The application can be submitted in paper or electronic form. The applicant shall choose the method of submitting the application. Applications submitted in electronic form shall be subject to electronic record keeping in accordance with the legislation in the field of electronic documents and electronic document management, this Law and the rules established based on them by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property. Applications in electronic form are submitted subject to the identification of the applicant (intellectual property agent or another agent of the applicant) using a qualified electronic signature.

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 and regulations adopted on its basis.

If an invention (utility model) has been created using the information registered in the Code of Information Constituting a State Secret of Ukraine, or if such invention (utility model) may be declared state secret according to the Law of Ukraine On State Secrets, the application shall be submitted to the NIPO 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 individuals). Applicant's proposal to declare the invention (utility 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 utility model shall cover a single utility model (requirement of the singularity of a utility model).

5. An application shall be drawn up in Ukrainian and contain; an application for state registration of the invention (utility model); a description of the invention (utility model); a claims of the invention (utility model); drawings (if there are references thereto in the description); a synopsis.

6. In an application for state registration of an invention (utility model), the applicant (applicants) and his/her (their) address, as well as the inventor (inventors) shall be indicated. An inventor shall have the right to require his/her not being mentioned as an inventor of the given invention (utility model) in any publication of the NIPO, in particular, in the information about the application or the state registration of the invention (utility model).

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

8. The claims of the invention (utility 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 and name of the invention (utility model) shall be made for information purposes only. They cannot be taken into consideration for any other purposes, in particular for construing the claims of the invention (utility model) and determining the scope of legal protection.

10. The application shall be drawn up and submitted in accordance with the rules established by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, in accordance with this Law.

11. A fee shall be levied on the submission of the application. This fee is paid before the expiration of two months from the date of application. The said time frame may be extended but not more than by 6 months if a corresponding application is submitted before

its expiry or a corresponding application is submitted within two months after its expiry and a fee is levied for its submission .

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

1. The application submission date shall be the date of the receipt by the NIPO of materials, which contain at least;  
an application for the state registration of the invention (utility model) in Ukrainian made in arbitrary form;  
the information about the applicant and his/her address in Ukrainian;  
a material making an impression of being a description of the invention (utility model) in Ukrainian or another language. In the latter case, the Ukrainian translation thereof must be received by the NIPO within two months of the application submission date to maintain the application submission date.

2. The application submission date shall be established in accordance with Parts 10, 11, and 12 of Article 16 of this Law.

3. The provisions of this Article shall not limit the applicant's right under Part 3 of Article 17-1 of this Law.

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

1. The procedure for state registration of an invention (utility model) on the basis of an international application shall be the same as the procedure for state registration of an invention (utility model) on the basis of a national application, with the exceptions arising from the Patent Cooperation Treaty.

2. Expert appraisal of an international application shall be carried out subject to receipt by the NIPO of the translation of this application into Ukrainian submitted by the applicant before the expiration of 31 months from its priority date and payment of the application fee. The said time frame may be extended but not more than by 2 months if a corresponding application is submitted before its expiry and a fee is levied for its submission.  
Upon receipt of the specified documents in due time and payment of the application fee, the applicant shall be notified of the acceptance of the international application for expert appraisal.

3. If the conditions of Part 2 of this Article are not met, the

international application shall be deemed terminated in Ukraine. If the applicant has not complied with at least one of these requirements, he/she shall be notified of such termination.

4. The validity of the international application in Ukraine may be renewed at the request of the applicant if the requirements of Part 2 of this Article have not been complied with for valid reasons. A fee is levied for the submission of such request.

Such a request may be submitted within 2 months from the date of termination of the circumstances that caused non-compliance with the time frame of 31 months established by Part 2 of this Article, or within 12 months from its expiration, whichever comes first. In this case, as of the date of submitting the request, the applicant shall perform all actions on the application provided by this Law, which were to be performed on that date.

5. If, as of the date of receipt of the request for renewal of the international application in Ukraine, the requirements of Part 4 of this Article have not been met, the applicant shall be notified of the possibility of refusing to satisfy the said request.

If within 2 months from the date of receipt of this notification by the applicant the non-compliance with the requirements of Part 4 of this Article is not eliminated, the applicant shall be notified of the refusal to satisfy the request.

6. The NIPO shall publish the information specified by it on the international application accepted for expert appraisal in the Bulletin.

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

1. The applicant shall have the right to the priority of a preliminary application for the same invention (utility model) within 12 months from the date of submission of the preliminary application to the NIPO or an appropriate body of a state being party to the Paris Convention for the Protection of Industrial Property or the Agreement Establishing the World Trade Organisation, if no priority is claimed in respect of the preliminary application.

2. Within three months of the date of application submission to the NIPO, 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 for the Protection of Industrial Property or the Agreement Establishing the World Trade Organisation. 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 1 and 2 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 central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

If necessary, the NIPO may require translation of the preliminary application into Ukrainian. The translation shall be received by the NIPO within 2 months after the date of the receipt of the NIPO'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 NIPO'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 claims of the invention (utility 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 (utility model), which are stated in the preliminary application, whose priority is claimed.

5. If some features of the invention (utility model) are missing from the invention (utility model) claims 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 NIPO is not completed, then, upon receipt of the application for priority under Part 2 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 NIPO or the applicant's initiative prior to the decision on state registration of an invention (utility model) 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 NIPO 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 (utility model) under the divisional application falls within the scope of the content of the preliminary application as of the date of the submission thereof.

8. The priority of the invention (utility model) may be established on the date of receipt by the NIPO of additional materials drawn up in accordance with Part 7 of Article 16 of this Law as an independent application, if this application is submitted within three months from the date of the receipt by the applicant of the notification that the said materials are not taken into account during the expert appraisal of the application to which they have been attached.

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

1. The expert appraisal of the application consists of preliminary appraisal, formal appraisal, and, on the application for a patent for an invention (secret invention), qualification appraisal and is conducted by NIPO in accordance with this Law and the rules established on its basis by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

2. The NIPO exercises the information activity needed for the proceeding expert appraisal of applications and is a centre for international exchange of publications in accordance with the Convention concerning the Exchange of Official Publications adopted on 3 December 1958 by the General Conference of the United Nations

Educational, Scientific and Cultural Organisation.

3. Final results of the expert appraisal of an application which is not considered withdrawn or has not been withdrawn are presented in a substantiated conclusion of the expert appraisal on request. On the ground of such a conclusion the NIPO adopts a decision on state registration of the invention (utility model) or refusal of such registration. The NIPO's decision along with conclusion is sent to the applicant.

The applicant shall have the right within one month from the date of reception by him/her of the NIPO's decision along with the conclusion of the expert appraisal to request copies of materials presented against the application. The copies shall be sent to the applicant within one month.

4. The applicant shall have the right on the own initiative or on invitation from the NIPO to take part personally or through his/her representative in the consideration of issues that have arisen during the expert appraisal by the procedure established by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

5. The applicant shall have the right to introduce corrections of mistakes and changes of his/her name and address, address for correspondence, name and address of his/her representative to the application.

The applicant may introduce changes to the application associated with change of the person of the applicant on condition of consent thereto of other applicants indicated in the application. Such changes may by consent of all applicants be introduced also by a person who wishes to become an applicant.

These corrections and changes are taken into account if received by the NIPO not later than the reception by it of a document on payment of the state fee for the registration of an invention (utility model).

When publishing information on the application for state registration of the invention, these corrections and changes are taken into account if they were received by the NIPO 6 months before the date of publication.

A fee shall be charged for the filing of a request for correction of a mistake or introduction of any of the above-indicated changes on

condition that the mistake is not obvious or technical and the change has arisen through circumstances depending on the person that submits the request.

6. The NIPO may request from the applicant submission of additional materials if expert appraisal is impossible without them or in the event of appearance of well-founded doubts about credibility of any data or elements contained in materials of the application.

The applicant shall have the right within one month from the date of receipt by him/her of the notification or conclusion of the expert appraisal with a request to submit additional materials to request from the NIPO copies of materials presented against the application. The additional materials are to be submitted by the applicant within two months from the date of receipt by him of the notification or conclusion of the expert appraisal or of copies of materials presented against the application. If the applicant fails to submit additional materials within the set time frame, the application is considered withdrawn, and the applicant shall be notified thereof. The period for filing of additional materials is extended, but for not more than 6 months if a corresponding request is submitted and the fee for its filing is paid before the expiry of this period. This period for filing of additional materials, if missed for valid reasons, is renewed if a corresponding request is submitted along with additional materials and the fee for its filing is paid within six months after its expiry.

7. If the applicant has submitted additional materials, then in the process of the expert appraisal it is cleared up whether they extend beyond the essence of the invention (utility model) disclosed in the submitted application.

Additional materials are deemed to extend beyond the essence of the invention (utility model) if they contain new essence features that are to be included in the invention (utility model) claims.

Additional materials in the part which extends beyond the essence of the invention (utility model) disclosed in the submitted application are ignored at the expert appraisal of the application and may after obtaining a corresponding request from the NIPO be executed by the applicant as an independent application.

8. In the course of the preliminary examination, an application, which does not include an applicant's proposal to declare the

invention (utility model) state secret, shall be examined for its containing the materials, which can be declared state secret in accordance with the Code of Information Constituting a State Secret. In case of availability of such data in the application or if an application contains an applicant's proposal to declare the invention (utility model) state secret, the application materials shall be sent to the relevant Expert on State Secrets (hereinafter referred to as the State Expert) to conclude whether the invention (utility model) shall be declared state secret.

The State Expert shall send his/her opinion together with materials of the application to the NIPO within one month of his/her 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 (utility model) state secret, he/she also shall specify the people that may access it; the subsequent examination of the application shall proceed in adherence to secrecy procedures.

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

9. During the formal examination;

the filing date of application is determined on the ground of Article 13 of this Law;

it is determined whether the invention applied for belongs to objects indicated in Paragraph 1, Part 2 of Article 6 of this Law, whether the utility model applied for belongs to objects indicated in Paragraph 2, Part 2, Article 6 of this Law, and whether the invention (utility model) belongs to objects indicated in Part 3, Article 6 of this Law;

the application is checked for conformity with formal requirements of Article 12 of this Law and rules determined on its basis by the central executive authority in charge of shaping and implementing

state policy in the field of intellectual property;  
the document about payment of the fee for the filing of the  
application is checked for conformity with determined requirements.

10. If materials of the application meet the requirements of Article 13 of this Law and the document about payment of the fee for the filing of the application meets the prescribed requirements, a notification of the determined an application submission date is sent to the applicant.

11. If materials of the application fail to meet the requirements of Article 13 of this Law, a notification of this is immediately sent to the applicant. If the non-conformity is eliminated within two months from the date of receiving of the notification by the applicant, then the date of receiving of corrected materials by the NIPO is considered the application submission date. Otherwise, the application shall be considered non-submitted, and the applicant shall be notified thereof.

12. If in materials of an application which meets requirements of Article 13 of this Law, there is a reference to a drawing, but such a drawing is absent, a notification of this is sent to the applicant with a proposal, on his/her choice, either to send the drawing or to exclude the reference to it in the application. If the drawing is filed within 2 months from the date of receipt of the notification by the applicant, the date of receiving of the drawing by the NIPO is considered the application submission date. If the applicant fails to make the proposed choice within this period, the application is considered non-submitted, and the applicant is notified thereof.

13. In the event of violation of the requirements of Paragraph 11, Article 12 of this Law, the application is considered withdrawn, and the applicant is notified thereof. If within two months after the commission of the actions provided for in Part 3, Article 5 of this Law by a foreign person or stateless person, no notification of the appointment of a representative and address for correspondence has been received, the application for which such action was committed shall be deemed withdrawn. The said time frame may be extended but not more than by two months if a corresponding application is submitted before its expiry and a fee is levied for its submission.

14. Provided that the invention belongs to technology objects indicated in Paragraph 1, Part 2, Article 6 of this Law, or the utility model belongs to technology objects indicated in Paragraph 2, Part 2, Article 6 of this Law, the application documents meet the formal requirements indicated in Article 12 of this Law and rules established on its basis by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, and the paid fee for submission of the application meets the established requirements, the following shall be sent to the applicant on request;

- patent for invention; a notification of completion of formal appraisal and the possibility of conducting a qualification appraisal;
- patent for utility model; NIPO's decision on the state registration of the utility model.

15. If there are grounds to consider that the claimed invention does not belong to technology objects indicated in Paragraph 1, Part 2, Article 6 of this Law, or the claimed utility model does not belong to technology objects indicated in Paragraph 2, Part 2, Article 6 of this Law, or the application fails to meet formal requirements of Article 12 of this Law and rules determined on its basis by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, or the document about the payment of the fee for the submission of the application fails to meet determined requirements, then the NIPO shall send the applicant a well-founded preliminary conclusion on this with a proposal to fill a motivated answer with elimination, if needed, of irregularities indicated in the conclusion.

The applicant's answer is to be filled within the period specified by Paragraph 6 of this Article and is taken into account at the preparation of the conclusion of the expert appraisal on the application.

In the event of violation of the requirement of unity, set by Part 4, Article 11 of this Law, the applicant is to indicate in the answer the invention (utility model) for which the appraisal of the application should be carried out and, when needed, to introduce refinements to the application. In this case, independent applications may be submitted for other inventions (utility models). If the requirement of unity, as proposed by the NIPO, is not

observed, the expert appraisal of the application is carried out for the invention (utility model) which is the first mentioned in its claims.

16. Upon expiry of 18 months of the date of the submission of the application for state registration of an invention, or, if the priority is claimed, then of the date of its priority and given that the requirements established by Part 14 of this Article for the application for state registration of the invention are met, the NIPO shall publish in its 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 state registration of the invention has been made. Upon application of the applicant, the NIPO shall publish the information on the application earlier the said term. A fee is levied for the submission of such request.

Upon publication of the information on the application, any person shall have the right to familiarise him/herself with materials of the application according to the procedure to be specified by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property. A fee shall be charged for familiarisation with materials of the application. In case of the detection of obvious errors in the published information, the applicant shall have the right to submit a request to rectify them.

No information about the application for state registration of a utility model shall be published.

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

17. Within six months of the date of publication of the information on the application for an invention, any person may file with the NIPO a reasoned objection to the application.

The objection is filed on the following grounds;

the claimed object does not meet the requirements of Part 1, 2, or 3, Article 6 of this Law;

the invention does not meet the patentability requirements set forth by Article 7 of this Law. A fee is levied for the submission of such objection.

Requirements for objections are determined by the central executive authority in charge of shaping and implementing state policy in the

field of intellectual property.

The objection shall be submitted together with a copy thereof, which the NIPO shall immediately send to the applicant. The applicant may notify the NIPO of his/her attitude to the objection within two months of the date of its receipt. The applicant may refuse the objection and leave the application unchanged, amend, or withdraw the application.

The submitted objection shall be considered within the limits of the reasons set forth therein and taking into account the applicant's response in the event of its submission within the prescribed period.

The results of the objection appraisal are reflected in the substantiated conclusion of the expert appraisal of the application. A copy of the NIPO's decision together with a substantiated conclusion shall be sent to the person who filed the objection.

18. Upon publication of information on the application for the invention, any person may submit to the NIPO a request for an information search on the basis of the invention claims, taking into account the description and available drawings.

A fee is levied for the submission of such request.

Requirements for the request and the procedure for information search shall be determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

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

After the publication of information on the application for the invention, any person may submit to the NIPO comments on the compliance of the claimed invention with the conditions of legal protection specified in this Law. Such persons do not participate in the records management at the request.

No fee is levied for the submission of such comments.

Requirements for comments, conditions and procedure for their consideration are determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

The comments received by NIPO shall be sent to the applicant without delay. The applicant may inform the NIPO of his/her attitude to the comments.

19. During the qualification expert appraisal, the compliance of the claimed invention with the conditions of patentability specified in Article 7 of this Law shall be verified.

Qualification expert appraisal shall be carried out after the NIPO receives the relevant application of any person and pays the fee for its conduct.

The applicant may submit the said application and pay the fee for the qualification expert appraisal within 3 years of the application submission date, and another person may do it after the publication of information about the application for the invention, but not later than 3 years of the application submission date. In this case, the other person does not participate in resolving issues related to the application. Only the expert appraisal conclusion on the application approved by NIPO is sent to him/her.

The period for submitting the said application is extended, but for not more than six months if a corresponding request is submitted and the fee for its submission is paid before the expiry of this period. If the applicant has not filed the said application in respect of the relevant application for the invention and has not paid the fee for the qualification expert appraisal within the prescribed period, the application shall be deemed withdrawn, and the applicant shall be notified thereof.

This period for submission of the said application and payment of the fee for the qualification expert appraisal, if missed for valid reasons, is renewed, provided that within six months of its expiration the relevant application is submitted together with the specified application and the fee for the qualification expert appraisal is paid for the submission of such application and qualification expert appraisal.

20. If there is reason to believe that the claimed invention does not meet the conditions of patentability, the NIPO sends the applicant a reasoned preliminary opinion with a proposal to provide a reasoned response to eliminate, if necessary, the shortcomings identified in the opinion.

The applicant's response shall be provided within the period established by Part 6 of this Article for additional materials and shall be taken into account during the preparation of the expert appraisal report on the application. In this case, the issues of compliance with the requirement of unity of invention are resolved

in accordance with Part 15 of this Article.

21. In the process of qualification expert appraisal of the application for an invention, the applicant has the right to make changes to the invention claims. Such changes may not go beyond the scope of the invention disclosed in the application or increase the scope of rights compared to the claims that was published on the date of application for qualification expert appraisal. The amended claims shall be deemed valid from the date of publication of the information on the state registration of the invention, provided that the claimed claims meets the conditions of patentability.

#### **Article 17. Withdrawal of the Application**

An applicant shall have the right to withdraw the application at any time before the date of the receipt of the decision on state registration of a secret invention or secret utility model or before the date of payment of the state fee for registration of the invention (utility model). Such application shall be deemed withdrawn from the date of submission of the application for its withdrawal.

#### **Article 17-1. Division of Application**

1. The applicant shall have the right to divide the application into two or more applications (divisional applications) before the date of receipt of the decision of the NIPO on the application, provided that the essence of the invention (utility model) on the divisional application does not go beyond the content of the divided application as of the date of its submission. The application may be divided on the applicant's own initiative or in response to NIPO's proposal.

2. The division of the application is carried out by submitting an application for division of the application and submitting a divisional application, subject to payment of fees for the submission of the application for division and divisional application.

3. The applicant shall have the right to determine the submission date of the divisional application to be the submission date of the divided application and the date of priority of the divisional application to be the date of priority of the divided application.

4. Expert appraisal of the divisional application shall be carried out in accordance with Article 16 of this Law, taking into account that the date of payment of fee for submission of the application, the date of submission of the application for qualification expert appraisal, and payment of the fee for its implementation are calculated from the date of receipt of the divisional application by NIPO. In addition to compliance with the requirements of Article 16 of this Law, the fulfilment of the condition specified in Part 1 of this Article shall be verified.

5. Upon expiry of 18 months of the date of the submission of the application for state registration of an invention, if the priority is claimed, then of the date of its priority, or immediately after the formal expert appraisal of the application for an invention (whichever comes last), the NIPO shall publish in its 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 state registration of the invention has been made.

6. Other requirements for the division of the application are determined by the rules established in accordance with this Law by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

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

The applicant shall have the right to transform the application for state registration of an invention into an application for state registration of a utility model and vice versa until the receipt of the decision on state registration of the invention (utility model) or a decision to refuse such registration.

In this case, the ascertained application submission date and the date of priority, if the priority is claimed, shall be retained. A fee is levied for submission of the application on transformation.

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

From the date of the receipt of an application by the NIPO and till the publication of the information on the application, 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 the laws of Ukraine.

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

1. The information on an application for state registration of an invention published in accordance with Part 16 of Article 16 hereof shall provide the applicant with temporary legal protection within the scope of the claims of the invention, on whose basis such information was published.

2. An applicant shall be entitled to compensation for losses caused to him/her 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 state registration of 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 state registration of such invention.

3. The temporary legal protection shall cease as from the date of the publication in the Bulletin of the information on state registration of 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 NIPO on the terms and conditions set forth in Part 2 of this Article.

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

1. On the basis of the decision on state registration of an invention (utility model), secret invention (secret utility model), the NIPO shall effect the state registration of the invention (utility model), secret invention (secret utility model) and enter appropriate information in the Register. The procedure for the Register maintenance and a list of information contained in the Register shall be determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

2. State registration of an invention (utility model) shall be carried out provided that a document on payment of the state fee for registration of an invention (utility model) is available and a fee for publications on state registration of an invention (utility model) is paid. These duties and fees shall be paid upon receipt by the applicant of the decision on state registration of the invention (utility model).

If the document on payment of the state fee for registration of the invention (utility model) and the fee for publication on the state registration of the invention (utility model) are not received by the NIPO within 3 months from the date of the receipt by the applicant of the decision on state registration of the invention (utility model), the registration shall not be effected and the application shall be deemed revoked.

The term of receipt of the document on payment of the state fee for registration of an invention (utility model), the term of payment of the fee for publication on the state registration of an invention (utility model) shall be extended, but for not more than six months if a corresponding request is submitted and the fee for its submission is paid before the expiry of this period.

This period for receipt of the document on payment of the state fee for registration of the invention (utility model), for payment of the fee for the publication on state registration of the invention (utility model), if missed for valid reasons, is renewed, provided that within six months of its expiration the relevant application is submitted together with the document on payment of state fee for registration of the invention (utility model), as well as the fee for the submission of such application and the fee for publication of state registration of the invention (utility model) are paid.

3. Upon entering the information in the Register, any person shall have the right to familiarise him/herself with it according to the procedure to be specified by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property and to obtain in reply to his/her request an extract from the Register as to the data on the state registration of the invention (utility model) on condition of payment of a fee for the submission of the request.

Familiarisation with the information entered in the Register

concerning the secret invention (secret utility model) is carried out with observance of requirements of the Law of Ukraine on State Secrets.

4. Mistakes in data entered in the Register are corrected on the initiative of the patent holder or of the NIPO.

On the initiative of the patent holder, changes may be introduced to the Register in accordance with the list of possible changes. A fee is charged for introduction of changes about an invention or utility model to the Register.

### **Article 23. Publication**

1. At the same time with the state registration of the invention (utility model), the NIPO publishes in Bulletin information on state registration of the invention (utility model) determined in the prescribed manner.

2. Not later than in 3 months upon the date of the publication of the information on state registration of the invention (utility model), the NIPO shall publish a description to the patent, which contains the claims and the description of the invention (utility model) and the drawings referred to in the description of the invention (utility model).

3. Upon the publication of the information on state registration of the invention (utility model), any person shall have the right to familiarise him/herself with materials of the application according to the procedure. A fee shall be charged for familiarisation with materials of the application.

4. The information on state registration of a secret invention (secret utility model) shall not be published

### **Article 24. Appeal Against Decision on Application**

1. An applicant may appeal against a decision of the NIPO on an application to the Appeals Chamber as well as to the court within two months from the date of receiving of the decision of the NIPO or of copies of materials requested in accordance with Paragraph 3 of Article 16 of this Law.

3. The right to appeal against a decision of the NIPO to the Appeals

Chamber is lost in the event of payment of the state fee for the registration of an invention (utility model).

4. A decision of the NIPO is appealed against to the Appeals Chamber by filing an objection against the decision by the procedure determined by this Law and on its basis by the Regulation of the Appeals Chamber, approved by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property. A fee is levied for the submission of such objection. If the fee has not been paid within the period indicated in Paragraph 1 of this Article, the objection is deemed not filed, of which a notification is sent to the applicant.

5. When the Appeals Chamber receives an objection and a document on the payment of the fee for the submission of the objection, the office work on the application is suspended until the decision of the Appeals Chamber is approved.

6. An objection against a decision of the NIPO on an application is examined in accordance with the regulation of the Appeals Chamber within two months from the date of receiving of the objection and the document on the payment of the fee for the submission of the objection, within the scope of arguments presented by the applicant in the objection and during its consideration. The period of consideration of an objection is extended on the initiative of the applicant, but for not more than two months if a relevant request is submitted and the fee for its submission is paid before the expiry of this period.

7. On results of consideration of an objection, the Appeals Chamber adopts a motivated decision which is approved by an order of the NIPO and sent to the applicant.

In the event of a full or partial satisfaction of an objection by the Appeals Chamber due to violation of the procedure of expert appraisal, the fee for the submission of the objection is to be returned, and the application is to be returned to the NIPO for re-appraisal.

9. An applicant may appeal against a decision of the Appellate Chamber, approved by the Office, or its copy to the court within two months from the date of receiving of the decision.

10. Upon approval, the NIPO shall publish the decision of the Appeals Chamber on its official website and publish in the Bulletin the information on this decision determined by it.

**Article 25. Issue of a Patent**

1. A patent shall be issued by the NIPO within one month upon state registration of an invention (utility model).

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 patent for a utility model shall be issued subject to the patent holder's responsibility for the compliance of the utility model with patentability conditions.

2. The form of the patent and the contents of the information provided therein shall be specified by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

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

4. In the event of loss or damage of a patent, its holder is granted with a duplicate of the patent by the procedure determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property. A fee is levied for granting a duplicate of the patent.

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

1. A holder of a patent for a secret invention (utility model) shall have the right to submit to the appropriate State Expert a proposal to declassify the invention (utility 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 (utility 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 (utility model) state secret or on the basis of a court decision.

3. Within 1 year of the date of the receipt of the State Expert's decision to declassify an invention (utility model), the holder of a patent for a secret invention (utility model) shall have the right to submit a request to the NIPO for a patent for an invention (utility model) for the period remaining till the expiry of the patent for a secret invention (utility model). In this case, the NIPO shall make appropriate changes in the Register, publish the information on the state registration of an invention (utility model) and issue the patent in accordance with Articles 22, 23, and 25 hereof subject to the payment of appropriate fees.

#### **Article 27-1. Supplementary protection of Rights to Inventions**

1. The holder of a patent for an invention, the object of which is an active pharmaceutical ingredient of a medicinal product, the process of obtaining a medicinal product, or application of a medicinal product, animal protection product, plant protection product, the introduction of which in Ukraine is granted by the relevant competent authority according to the current legislation of Ukraine, has the right to extend the validity of intellectual property rights to such an invention (supplementary protection), which is confirmed by a certificate of supplementary protection. The supplementary protection certificate is issued at the request of the patent holder. A fee is levied for the submission of such request.

The rights to supplementary protection are limited by the product (active pharmaceutical ingredient or set of active pharmaceutical ingredients of the medicinal product), the introduction of which in Ukraine is allowed by the relevant competent authority according to the current legislation of Ukraine, and by its use as a medicinal product, animal protection product, plant protection product within the rights granted by the respective patent as of the day of submitting the application for supplementary protection certificate, and are valid subject to the validity of such permission.

The holder of a patent for an invention, the object of which is a medicinal product, animal protection product, plant protection product, shall have the right to extend the validity of intellectual

property rights if the application for permission of the competent authority to introduce a medicinal product, animal protection product, plant protection product in civil circulation in Ukraine was filed within 1 year from the date of submission of such an application for the first time in any country.

2. The period of supplementary protection shall be equal to the period between the date of filing the application with the NIPO and the date of receipt by the patent holder of the first permission of the competent authority, reduced by 5 years.

The term of supplementary protection may not exceed 5 years.

The term of supplementary protection shall be extended for six months for the invention, the object of which is the active pharmaceutical ingredient of the medicinal product, which has been studied in the field of application for children, the results of which are reflected in the information on the medicinal product authorised by the relevant competent authority referred to in Paragraphs 1 and 2 of this Part.

3. The request for supplementary protection must be received by the NIPO within 6 months from the date of publication of the information on state registration of the invention or from the date of issuance of the first permit of the relevant competent authority (whichever comes last). The application shall be accompanied by documents confirming the right of the patent holder to supplementary protection.

The application shall be considered by the NIPO in the manner determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

4. If the submitted documents confirm the right of the patent holder to supplementary protection, the NIPO shall carry out the state registration of supplementary protection by entering the relevant information into the Register. Simultaneously with the state registration of supplementary protection, the NIPO shall publish in the Bulletin the information on such registration determined by it. Issuance of the supplementary protection certificate shall be carried out by the NIPO within one month after the state registration of supplementary protection.

5. The rights and obligations of the holder of the supplementary

protection certificate shall be the same as the rights of the holder of the respective patent, subject to the restrictions established by Part 1 hereof.

6. Subject to compliance with the requirements specified in this Part, the following use of the invention during the period of supplementary protection shall not be recognized as a violation of the rights to the invention;

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

2) the manufacture of a product or medicinal product containing the product that uses the patented invention not earlier than six months before the expiration of the period of supplementary protection for storage in order to put into circulation after the expiration of the term of supplementary protection, as well as other actions that, according to this Law, are recognized as the use of the invention if they are necessary for the manufacture of a product or medicinal product containing the product, and its storage that is not earlier than the specified period.

A person who intends to manufacture a product or a medicinal product containing a product that uses a patented invention during the period of supplementary protection is obliged to affix the information mark "UA Export" for the manufacture of the product.

A person who intends to manufacture a product or medicinal product containing a product that uses a patented invention during the period of supplementary protection shall notify the NIPO and the holder of the supplementary protection certificate in writing of such intention not later than three months before the use of the invention.

The applicant's notification shall indicate his/her address, methods of use of the invention and the purpose of such use, number and date of issue of the supplementary protection certificate. In the case of the manufacture of a product or medicinal product containing a product for export purposes, the notification shall also indicate the authorisation number of the competent authority of the third country to which the export is to be made. The NIPO ensures the publication of the information contained in the notification.

The manufacturer of a product or medicinal product containing a product is obliged to obtain written guarantees from all persons who, on his/her behalf, carry out storage, export, or perform other actions, which in accordance with this Part are not recognized as infringement of the rights to the invention, that the product or medicinal product containing the product will not be used other than for export or storage in the manner prescribed by law.

7. For maintaining the validity of the supplementary protection certificate for each full or incomplete year of its validity, a fee shall be paid in accordance with the procedure established in Part 2 of Article 32 hereof.

8. Termination of the supplementary protection certificate and its invalidation, protection of the rights of the holder of the supplementary protection certificate shall be carried out in accordance with the procedure established for the relevant patent.

**Section V RIGHTS AND OBLIGATIONS OF HOLDERS OF RIGHTS TO INVENTIONS  
(UTILITY MODELS)**

**Article 28. Rights Resulting from State Registration of an Invention  
(Utility Model)**

1. The rights resulting from state registration of an invention (utility model) shall become effective as of the date following the date of the state registration of the invention (utility model). The rights resulting from state registration of a secret invention (secret utility model) shall become effective as from the date of entering the information about the secret invention (secret utility model) in the appropriate Register.

2. The patent holder shall have the right to use the invention (utility model) at his/her discretion, unless such use infringes upon rights of other patent holders.

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

The relations in the course of the use of an invention (utility 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 (utility model) at his/her discretion, however, none of them shall have the right to grant a permit (a licence) for using the invention (utility model) and transfer the title to the invention (utility model) to another person without a consent of other patent holders.

The following shall be considered to be use of an invention (utility model);

manufacture, application, offering for sale, including via the Internet, sale, importation, introduction in the business turnover, or storage of a product for the above-mentioned purposes provided that the product has been manufactured using the patented invention (utility 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.

A product shall be declared manufactured using the patented invention (utility model), if each feature included in an

independent item of the claims of the invention (utility 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 claims of the invention (utility model) or an equivalent feature is used.

Any product, the manufacturing method of which is protected by a patent, in the absence of evidence to the contrary is considered manufactured using this method, provided that at least one of the two requirements is implemented;

the product manufactured using the method protected by the patent is new;

there is a reason to believe that this product is manufactured using this method, and the patent holder is unable by reasonable effort to determine the method used in the manufacture of this product.

In this case, the burden of proving that the method of making the product identical to that produced by the method protected by the patent differs from the latter rests with the person in respect of whom there are reasonable grounds to believe that he/she infringes the rights of the patent holder.

The right of the patent holder for an invention which is biological material extends to any other biological material with the same characteristics derived from such biological material by recreation or reproduction in a similar or different form.

The right of the patent holder to an invention which is a process for the production of biological material extends to biological material directly obtained using that process and to any biological material with the same characteristics obtained from it by recreation or reproduction in a similar or another form.

The right of the patent holder to an invention, which is a product with genetic information, extends to any material (except as specified in Paragraph 11, Part 3 of Article 6 hereof), which contains this product and in which genetic information performs its function.

The rights specified in Paragraphs 15 and 16 of this Part shall not apply to biological material obtained as a result of cultivation or reproduction of biological material placed on the market by the patent holder, if such reproduction or cultivation is necessarily the result of the biological material for which it was sold on the market, provided that the obtained material is not further used for other cultivation or reproduction.

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

A holder of a patent for a secret invention (secret utility 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 (utility model).

5. The patent shall confer upon its holder the exclusive property right to prevent and prohibit other persons from using the invention (utility model) without his/her consent, except for cases when such use is not considered to be the infringement upon rights resulting from the state registration of the invention (utility model) hereunder.

6. A patent holder may cede the exclusive property rights to an invention (utility model) on a contractual basis to any person, which becomes his/her successor; as for a secret invention (secret utility model), such cession 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 (utility model) on the basis of a licence agreement; as for a secret invention (secret utility model), such permit shall be given only in concurrence with the State Expert

8. A contract on the transfer of the title to an invention (utility model) and a licence agreement shall be deemed valid, if made in writing and signed by the parties.

The party to the contract shall have the right to officially inform other persons about the transfer of ownership of the invention (utility model) or the issuance of a license to use the invention (utility model). Such information shall be provided by publishing in the Bulletin of information in the amount and procedure established

by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, with its simultaneous entry in the Register.

A fee is levied for publishing of such information and amendments to information on the issuance of a license proposed by the party to the contract.

9. A holder of the patent for an invention, except for a secret invention (secret utility model), shall have the right to submit to the NIPO for the official publication a statement of the willingness to grant any person a permit to use the patented invention (utility model). In this case, the annual fee for maintaining the validity of intellectual property rights to an invention (utility model) 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 to conclude a 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/her intentions to use the invention (utility model) to the patent holder, the latter may submit to the NIPO a written request for the revocation of his/her 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 nonproperty rights of the inventor, which are governed by other laws of Ukraine.

#### **Article 29. Responsibilities Resulting from State Registration of the Invention (Utility Model)**

1. A patent holder shall pay appropriate fees for maintaining the validity of the intellectual property rights to an invention (utility model) and use the exclusive right resulting from the state registration of the invention (utility model) bona fide.

#### **Article 30. Diminution of Intellectual Property Rights to an Invention (Utility Model)**

1. If an invention (utility model), except for a secret invention (utility model), has not been used or has been used not fully in

Ukraine during 3 years after the date of state registration of the invention (utility model) or after the date, when the use of the invention (utility model) was terminated, then any person desirous of and prepared to using the invention (utility model) may refer to the court of law with an application for a permit to use the invention (utility model), in case of the refusal of the holder of rights to conclude a licence agreement.

Unless the patent holder proves that the failure to use the invention (utility 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 (utility model) 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. The right of the patent holder to grant permission to use the invention (utility model) is not limited in this case.

2. A patent holder shall be obliged to grant a permit (licence) for the use of the invention (utility model) to a holder of a patent granted later, if the latter's invention (utility 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 (utility model) by the holder of the patent granted later. In this case, the holder of the patent granted earlier shall have the right to obtain a licence for using the invention (utility model), which is protected by the patent granted later, on favourable conditions.

3. In order to ensure the health of the population, state defence, environmental security, and other public interests, the Cabinet of Ministers of Ukraine shall have the right to allow a person nominated by it to use the invention (utility model) without consent of the holder of the patent. However;

1) permission for such use is granted based on specific circumstances;

2) the scope and duration of such use are determined by the purpose of the permit, and in the case of semiconductor technology, it should be only non-commercial use by public authorities or correction of anti-competitive practices by the decision of the relevant public authority;

3) permission for such use does not deprive the patent holder of the

right to grant permits for the use of the invention (utility model) to other persons;

4) the right to such use is not transferred, except in the case when it is transferred together with that part of the enterprise or business practice in which this use is carried out;

5) the use is allowed mainly to meet the needs of the internal market;

6) the patent holder is notified of the granting of permission to use the invention (utility model) as soon as it becomes practically possible;

7) the permit for use is revoked if the circumstances due to which it was issued cease to exist;

8) the patent holder is paid adequate compensation in accordance with the economic value of the invention (utility model).

Decisions of the Cabinet of Ministers of Ukraine on granting permission to use an invention (utility model), term and conditions of its granting, revocation of permission to use, amount and procedure for payment of remuneration to the patent holder may be appealed in court.

4. A holder of the patent for a secret invention (secret utility model) may grant a licence for using his/her invention (utility model) only to a person having the right of access to such invention (utility 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 to use the secret invention (utility model) without consent of 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, who has used the technological (technical) solution identical to the claimed invention (utility model) in the interests of his/her activities bona fide or made considerable and serious preparations to such use prior to the date of the submission of an application to the NIPO, shall retain the right to

the gratis continuation of such use or to the use of the invention (utility 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 (utility model), 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 (utility model) was used or considerable and serious preparations for such use were made.

2. The following use of the patented invention (utility 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 (utility 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.) with notification of the patent holder as soon as it becomes practically possible and payment of the corresponding compensation.

3. The introduction in business turnover of a product manufactured using the patented invention (utility model) by any person, who 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 (utility 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 (utility model) for commercial purposes by any person, who acquired a product manufactured using the patented

invention (utility model) 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 state registration. However, upon receipt of an appropriate notice of the holder of rights, the said person shall cease using the product or pay the holder 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.

5. The importation into the customs territory of Ukraine in the manner prescribed by law of goods manufactured using the invention (utility model) for research and/or use of the invention (utility model) in research conducted for the purpose of preparation and submission of information for registration of a medicinal product shall not be considered to constitute the infringement upon rights resulting from the patent.

6. Manufacture of a product or medicinal product containing a product that uses a patented invention for export to third countries, as well as other actions recognized in accordance with this Law as use of the invention if they are necessary for the manufacture of a product or medicinal product containing product, for export to third countries shall not be considered to constitute the infringement upon rights resulting from the supplementary protection of rights for inventions set forth in Article 27-1 of this Law.

## **Section VI TERMINATION OF STATE REGISTRATION AND INVALIDATION OF RIGHTS**

### **Article 32. Termination of State Registration of an Invention (Utility Model)**

1. At any time, a patent holder may waiver of the rights resulting from state registration of the invention (utility model) in full or in part within the published invention (utility model) claims on the basis of an application submitted to the NIPO.

Partial waiver of rights is carried out by excluding independent clauses of the claims or by excluding one or more independent clauses of the claims and subordinate clauses of such independent clauses, or by making changes to the independent clause (s), provided that such exclusion and/or change lead to a decrease in the scope of legal protection provided by state registration.

Changes to an independent clause of the claims may be made by modifying the features of such a clause in the claims or by adding features to it. In this case, only the features present in the dependent clauses of the claims subordinate to such an independent clause may be entered.

NIPO conducts an expert appraisal of the invention with a new version of the claims for compliance with the requirements of this Article and Article 7 of this Law. A fee is levied for the expert appraisal.

Full or partial waiver of rights shall become effective as from the date of the publication of the information about it in the Bulletin.

The form of the application and the procedure for its consideration are determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property. A fee is levied for the submission of the application.

No full or partial waiver of rights resulting from state registration of the invention (utility model) without prior notice to a person vested with the right to use the invention under a licence agreement registered in the NIPO or in case of the attachment of the property for the debt, if it includes the rights resulting from state registration of the invention (utility model) shall be allowed.

The validity of the intellectual property rights to an invention (utility model) shall be terminated in case of the failure to pay the annual fee for maintaining the validity of the patent in due time.

The annual fee for maintaining the validity of intellectual property rights to an invention (utility model) 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 NIPO not later than in 4 months upon the date of the publication of the information on state registration of the invention (utility model). The document confirming the payment of the fee for each subsequent year shall be received by or sent to the NIPO till the end of the current year of the validity of intellectual property rights to an invention (utility model) subject to the fee's being paid within last 4 months of the year. The validity of intellectual property rights to an invention (utility model) shall be terminated from the first day of the year, for which no fee was paid.

The annual fee for maintaining the validity of intellectual property rights to an invention (utility model) 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 intellectual property rights to an invention (utility model) shall be restored.

If the fee was not paid during these 12 months, the NIPO shall publish the information on the termination of intellectual property rights to an invention (utility model) in the Bulletin.

No fee shall be payable for maintaining the validity of intellectual property rights to a secret invention (secret utility model).

If the deadline for payment of the fee for maintaining the validity of intellectual property rights to the invention (utility model) is missed, the patent applicant's rights are restored, provided that within 12 months after the expiration of the period, a relevant application is applied and a fee for such application is paid, as well as maintenance fee for intellectual property rights to the invention (utility model). Information on the restoration of the applicant's patent rights will be published by the NIPO in the Bulletin.

**Article 33. Recognition of Rights to an Invention (Utility Model)  
Invalid by a Court Order**

1. Rights to an invention (utility model) may be declared by a court order invalid in full or in part, in case of;

a) non-compliance of the patented invention (utility model) with patentability conditions specified hereby Article 7 hereof;

b) availability of features in the claims of the invention (utility model), which were not included in the submitted application;  
c) violation of requirements of Part 2 of Article 37 hereof;  
d) state registration of an invention (utility model) as a result of application submission in violation of the rights of other persons.

3. The NIPO shall announce the invalidation of right to an invention (utility model) in full or in part by a court order in the Bulletin.

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

Recognition of rights to an invention (utility model) invalid in part is carried out by excluding independent clauses of the claims or by excluding one or more independent clauses of the claims and subordinate clauses of such independent clauses, or by making changes to the independent clause (s), provided that such exclusion and/or change lead to a decrease in the scope of legal protection provided by state registration.

Changes to an independent clause of the claims may be made by modifying the features of such a clause in the claims or by adding features to it. In this case, only the features present in the dependent clauses of the claims subordinate to such an independent clause may be entered.

**Article 33-1. Recognition of Rights to an Invention (Utility Model) Invalid by the Appeals Chamber**

1. Any person may submit to the Appeals Chamber a substantiated application for recognition of the rights to an invention (utility model) as invalid in full or in part on the grounds of non-compliance of the invention (utility model) with the patentability conditions specified by this Law. The application may be submitted through an intellectual property representative (patent attorney) acting on the basis of a power of attorney.

Recognition of rights to an invention (utility model) invalid in part is carried out by excluding independent clauses of the claims or by excluding one or more independent clauses of the claims and subordinate clauses of such independent clauses, or by making changes to the independent clause (s), provided that such exclusion

and/or change lead to a decrease in the scope of legal protection provided by state registration.

Changes to an independent clause of the claims may be made by modifying the features of such a clause in the claims or by adding features to it. In this case, only the features present in the dependent clauses of the claims subordinate to such an independent clause may be entered.

2. An application for the invalidation of the rights to an invention may be submitted with the Appeals Chamber within nine months from the date of publication of the information on state registration of the invention. A fee is levied for the submission of the application. The application is deemed submitted in case of receipt of the fee on the account of NIPO.

3. An application for invalidation of utility model rights may be submitted to the Appeals Chamber during the entire term of validity of property rights to the utility model and after their termination. A fee is levied for the submission of the application. The application is deemed submitted in case of receipt of the fee on the account of NIPO.

4. The parties to the case on invalidation of the invention (utility model) in the Appeals Chamber are the person who submitted the application for invalidation of the invention (utility model) and the patent holder.

5. The parties shall have equal rights to present evidence, examine it, and prove its persuasiveness before the Appeals Chamber.

6. The Appeals Chamber shall not verify the accuracy of the evidence provided, and the person who provided the information shall be responsible for the accuracy of the information provided. In case the board of Appeals Chamber has reasonable doubts about the accuracy of the information provided in the submitted documents, the board shall have the right to request confirmation of this information.

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

8. Requirements for the application for recognition of the rights to an invention (utility model) as invalid, the conditions and procedure for its consideration shall be determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

9. The application for recognition of the rights to an invention (utility model) invalid shall be considered in accordance with the regulations of the Appeals Chamber within four months from the date of receipt of the application, subject to payment of a fee for its submission. This period may be extended for two months upon the application of the party to the consideration of application for recognition of the rights to the invention (utility model) invalid and subject to payment of the fee. The term for consideration of the application may be suspended on the grounds determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, but not more than for two months.

10. On results of consideration of the application, the Appeals Chamber adopts a motivated decision which is approved by an order of the NIPO and sent to the parties.

11. The parties may appeal the decision of the Appeals Chamber approved by the NIPO in court within two months from the date of its receipt.

12. Decisions of the Appeals Chamber enter into force on the date of their approval by an order of the NIPO and shall be published in full on the NIPO's official website.

In case of recognition of the rights to an invention (utility model) invalid, the NIPO informs about it in the Bulletin.

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

**Article 33-2. Conclusion on the Compliance of the Utility Model with the Patentability Conditions**

1. Any person may submit to the NIPO a motivated request for

examination of a utility model for compliance with the conditions of patentability. A fee is levied for the submission of such request. The application shall be considered by the NIPO in the manner determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

3. The NIPO shall notify the holder of the utility model patent of the receipt of the application upon receipt by the NIPO of the amount of the fee paid for submitting the application.

4. The opinion prepared by the NIPO on the conformity of the utility model to the conditions of patentability shall be sent to the person who filed the application and to the patent holder.

5. The opinion of the NIPO on compliance with the conditions of patentability may be obtained by the person who submitted the application in the case of an appeal to the court or the Appeals Chamber to invalidate the rights to the utility model.

## **Section VII PROTECTION OF RIGHTS**

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

1. Any encroachment upon rights 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. On request of the patent holder, such an infringement is to be ceased, and the infringer is bound to compensate the patent holder for inflicted losses.

Restoration of infringed rights of the patent holder may also, by his/her consent, be demanded by a person who has acquired a license.

### **Article 35. Remedies**

1. The protection of rights for an invention (utility model) is provided in the court and another procedure determined by legislation.

2. The jurisdiction of courts covers all legal relations arising in connection with the application of this Law.

Courts, in accordance with their competence, shall resolve, in particular, disputes about; authorship of an invention (utility model);

determination of a fact of use of an invention (utility model);

determination of the patent holder;

infringement of rights of the patent holder; conclusion and

enforcement of licence agreements; right to the previous use;

compensation.

## **Section VIII CLOSING PROVISIONS**

### **Article 36. State duty and fees**

The amount and procedure of payment of the state fee for the registration of inventions (utility models) are defined by the legislation.

The amount of fees provided for by this Law, terms and the procedure for their payment shall be determined by the Cabinet of Ministers of Ukraine.

Receipts received from the payment of state duty for registration of inventions (utility models) are credited to the budgets in the manner prescribed by the Budget Code of Ukraine.

Levies provided for by this Law shall be paid to the current accounts of the NIPO.

Receipts from fees stipulated by this Law are target-oriented and are used solely for the development and functioning of the state system of legal protection of intellectual property, in particular for the accomplishment of tasks defined by this Law and other normative and legislative acts in the field of intellectual property

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

1. Any person shall have the right to patent an invention (utility model) in foreign countries, subject to prior submission of an application for an invention (utility model) to the NIPO and failure of receipt of the notification on declaring the claimed invention (utility model) a state secret by this person within three months from the submission date of the said application.

At the request of the applicant, he/she is notified of the possibility of patenting the invention (utility model) in foreign countries before the specified period. A fee is levied for the submission of such request.

2. If an invention (utility model) is patented under the procedure of the Patent Co-operation Treaty, the international application shall be submitted to the World Intellectual Property Organisation in compliance with the condition specified in Part 1 of this Article, or to the NIPO.

**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 Verkhovna Rada of Ukraine of 23 December 1993 "On Enforcing the Law of Ukraine On Protection of Rights to Inventions and Utility models", whose processing was not completed by the enforcement of this Law, shall be treated by the NIPO as applications for declarative patents for inventions without the expert appraisal for local novelty.

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

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.

3. Existing utility model patents shall be equated in terms of legal regime, including their term of validity, to declarative utility model patents.

## **Section X FINAL PROVISIONS**

1. This Law shall enter into force on the date of its publication.
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 Verkhovna Rada 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 Verkhovna 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" (The Official Bulletin of the Verkhovna Rada of Ukraine, 1995, issue 3, page 23);  
paragraphs ten and eleven of Clause 3 and Clause 4 of Resolution of the Verkhovna Rada of Ukraine of 23 December 1993 "On Enforcing the Law of Ukraine On Protection of Rights to Inventions and Utility models" (The Official Bulletin of the Verkhovna Rada of Ukraine, 1994, issue 7, page 33; 1997, issue 40, page 269).