

No. 4/2001 Coll.
Complete wording of Act
No. 478/1992 Coll. on Utility Models,
as follows from amendments implemented by Act No. 116 / 2000 Coll.

ACT
on Utility Models

Basic Provisions

Section 1

Technical solutions which are new, exceed the framework of mere professional skill and are industrially applicable shall be protected as utility models.

Section 2

The following in particular shall not be deemed technical solutions:

- a) discoveries, scientific theories and mathematical methods;
- b) the mere appearance of products;
- c) schemes, rules and methods for performing mental acts;
- d) computer programs;
- e) the mere presentation of information.

Section 3

The following shall not be protected as utility models:

- a) technical solutions contrary to public interest, particularly the principles of humanity and public morality;
- b) plant or animal varieties and biological reproductive materials;
- c) production processes or work activities.

Section 4

- (1) A technical solution shall be considered new if it does not form part of the state of the art.
- (2) For the purposes of this Act, the state of the art shall be deemed to comprise everything made available to the public prior to the date from which the applicant claimed the right of priority (Section 9).
- (3) The state of the art shall not be held to comprise any disclosure of the applicant's work or that of his predecessor in title, which took place within six months before the filing of the utility model application.

Section 5

A technical solution shall be considered susceptible of industrial application if it can be used repeatedly in economic activities.

Section 6

- (1) The right to utility model protection shall belong to the author or his successor in title.
- (2) The author of utility model shall be the person who created the utility model by means of his own creative work.

Section 7

Utility models shall be registered by the Industrial Property Office (hereinafter referred to as "the Office") in the Utility Model Register (hereinafter referred to as "the Register").

Filing and Registration of a Utility Model

Section 8

- (1) Registration of a utility model shall be subject to the filing of a written application for a utility model (hereinafter referred to as the "application") with the Office.
- (2) The application shall relate to one technical solution only or to a group of technical solutions so linked as to form a single inventive concept.
- (3) The application shall contain the following:
 - a) a request for registration containing the title of the utility model;
 - b) a description of the technical solution and the relevant documentation if necessary;
 - c) claims to protection giving a clear and concise definition of the subject matter for which utility model protection is sought.
- (4) The application shall contain the name of the author of the subject matter of the application.
- (5) The application shall comply with a single form and requirements published by the Office in the Official Bulletin (hereinafter referred to as the "Bulletin").

Section 9

- (1) The priority right of the applicant shall begin with the filing of the application.
- (2) The applicant shall claim the right of priority under the Paris Convention for the Protection of Industrial Property (hereinafter "Paris Convention")¹ already on filing the application and, at the same time, state the filing date of the application from which the right of priority derives, its number and the state in which the application has been filed or the authority with which the application has been filed under the international treaty. At the request of the Office, the applicant must furnish evidence of this right within the stated time limit, failing which the priority right shall not be taken into consideration.
- (3) In case of the conversion of the European patent application, in which the protection for the Czech Republic was requested, into the application under Section 8, the applicant may

1) Paris Convention for the Protection of Intellectual Property of March 20, 1883, revised in Brussels on December 14, 1900, in Washington on June 2, 1911, in The Hague on November 6, 1925, in London on June 2, 1934, in Lisbon on October 31, 1958 and in Stockholm on July 14, 1967, published under No. 64/1975 Coll.

claim his right of priority from the European patent application. For claiming the right of priority, the paragraph 2 shall apply *mutatis mutandis*.

Section 10

(1) If the applicant has already sought in the Czech Republic a patent² for the same technical solution, he shall be entitled to request in his application the recognition of the filing date of such application or any right of priority deriving therefrom. The Office shall afford the application for utility model protection the date of filing or of priority of the earlier patent application if the later application is filed within two months of the decision on the patent application and, at the latest however, within 10 years of its filing date.

(2) An applicant claiming rights under paragraph 1 shall be required - within a period of two months from filing the application for utility model protection - to submit a duplicate of the patent application the filing or priority date of which is claimed, failing which the right shall lapse.

(3) Failure to comply with a time limit set in paragraph 1 may not be excused.

Section 10a

Conversion of the European patent application to the application

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

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

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

Section 11

(1) If the application meets the conditions stipulated in Section 8 and if its subject matter is not obviously contrary to Sections 2, 3 and 5, the Office shall register the utility model.

(2) Protection under this Act shall begin with the registration of the utility model. When registering the utility model, the Office shall issue to the applicant - who on registration becomes the owner of the utility model - a certificate of registration of the utility model and shall announce the registration of the utility model in the Bulletin. After registration of the utility model the Office shall publish the documentation referred to in Section 8 paragraph 3 letters b) and c).

² Section 2 and the following of the Act No. 527/1990 Coll. on Inventions, Industrial Designs and Rationalisation Proposals.

^{2a} Act No. 368/1992 Coll. On Administrative Fees as amended.

- (3) If the application does not meet the requirements of Section 8, the Office shall request the applicant to remedy the deficiencies within a prescribed time limit. If the applicant fails to remedy the deficiencies within that time limit, the Office shall terminate the procedure. When setting the above time limit, the Office shall inform the applicant of that consequence.
- (4) If the application contains subject matter referred to in Sections 2 and 3 or if the subject matter is obviously contrary to Section 5, the Office shall reject the application. The applicant shall be notified of such consequence prior to issuing the decision.
- (5) Amendments and changes made to the application shall not extend beyond the content of the application as originally filed.
- (6) Up to the time of registration according to the paragraph 1, the applicant may divide the application. The Office shall accord to divisional applications the priority of the original application if the divisional applications do not extend beyond the scope of the original application and if they are filed within three months of a written communication by the applicant that he intends to divide the application as filed.
- (7) At the request of the applicant, the Office shall postpone the registration of a utility model for a maximum period of 15 months from the date of filing the application.

Effects of Utility Model

Section 12

- (1) Nobody may manufacture, place on the market or use in his economic activities a technical solution enjoying utility model protection without the consent of the owner of the utility model.
- (2) The owner of the utility model shall be entitled to give his consent (licence) to the use of a technical solution utility model protection to other persons or to assign the utility model to them.
- (3) Rights conferred by a patent granted on the basis of a patent application having later priority may not be asserted in the event of a dispute without the consent of the owner of the utility model.

Section 13

- (1) A utility model shall not be invoked against persons who have used the technical solution enjoying utility model protection independently of the author or the owner of the utility model before its priority date or who have verifiably undertaken measures to that end (hereinafter referred to as "prior users").
- (2) If agreement is not reached, the prior user may apply to a court for recognition of his rights by the owner of the utility model.

Section 14

Deleted

Term of Utility Model Protection

Section 15

- (1) The validity of utility model protection shall be four years as from the filing date of the application or the filing date of an earlier patent application in respect of the same subject matter (Sections 10 and 10a).
- (2) At the request of the owner of the utility model the Office shall extend the term of validity of the utility model registration for further two three-year periods.
- (3) Extension of the term of validity of the utility model may be applied for at the earliest during the final year of the validity.
- (4) If the utility model is registered after expiration of the time limit set out in paragraph 1, the Office shall extend the term of validity of the utility model without a request from the owner of the utility model.

Section 16

Utility model shall lapse:

- (a) on expiry of its term of validity;
- (b) on relinquishment by the owner of the utility model; in such case, protection shall terminate as from the date on which the Office receives a written declaration to such effect by the owner of the utility model.

Cancellation of Utility Model

Section 17

- (1) At the request of any person, the Office shall cancel the registration of a utility model if:
 - (a) its technical solution does not qualify for protection under Sections 1 and 3;
 - (b) the subject matter of the utility model is already protected by a patent with effects on the territory of the Czech Republic or utility model enjoying earlier priority;
 - (c) the subject matter of the utility model extends beyond the content of the application as filed.
- (2) The effect of cancellation of the registration of a utility model shall be as if the utility model had not been recorded in the Register.
- (3) If the grounds for the cancellation only relate to the part of the utility model, the utility model shall be cancelled partially.
- (4) Cancellation of a utility model may also be carried out even after lapse of the utility model (Section 16) if the person filing the request can prove a legal interest.

Section 18

- (1) A request for cancellation of the registration of a utility model shall be filed with the Office in two copies.

(2) A request for cancellation of the registration of a utility model shall be duly justified and supporting evidence on which the request is based shall be submitted at the same time. The grounds of the cancellation including the indication of evidence to that the request refers cannot be additionally amended.

(3) The Office shall invite the owner of the utility model to submit his comments on the request for cancellation of the registration within a stated time limit. The owner of the utility model shall submit his comments on the request for cancellation of the registration in writing and in two copies.

(4) If the owner of the utility model fails to submit his comments within the stated time limit, the Office shall cancel the registration.

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

Section 19

Revocation of Protection

(1) The Office shall, at the request, revoke the utility model protection if a court decision determines that the owner of the utility model was not entitled thereto under Section 6.

(2) A request for revocation of protection under paragraph 1 may only be filed by a person or such person's successor in title, who has been determined by the court decision to be entitled to utility model protection.

(3) At the request of the person entitled to utility model protection, filed within one month of the final court decision, the Office shall register such person as the owner of the utility model.

(4) If no request for transfer under paragraph 3 is filed, the Office shall cancel the utility model registration ex officio.

Section 20

Register

(1) The Office shall keep a Register in which it shall record the particulars of applications for utility model protection and of the registration of utility models.

(2) The following particulars for each utility model shall be entered in the Register:

(a) number of the registration (certificate);

(b) date of the registration;

(c) date of publication of the utility model registration in the Bulletin;

(d) title of the utility model;

(e) date of filing of the application and, where appropriate, date of priority and filing number of the application;

(f) identity of the applicant for the utility model (name of person or company) and address (headquarters) or of his representative;

- (g) surname, first name and address of the author of the utility model;
 - (h) identity of the owner of the utility model (name of person or company) and address (headquarters) or of his representative;
 - (i) rights of prior user;
 - (j) classification of the utility model under the International Patent Classification;
 - (k) assignment of the utility model;
 - (l) licences;
 - (m) compulsory licence;
 - (n) extension of the term of registration;
 - (o) cancellation of the registration;
 - (p) revocation or assignment of protection;
 - (r) lapse of protection.
- (3) The Office shall publish the particulars concerning utility models and any official communications and decisions of basic importance in the Bulletin.

Final Provisions

Section 21

- (1) Except as otherwise provided by this Act, the general rules on the administrative procedure shall apply to proceedings in utility model matters, with the exception of the provisions concerning termination of proceedings, sworn statements, time limits for decisions and measures concerning failure to act.³
- (2) The provisions of the Act on Inventions, Industrial Designs and Rationalisation Proposals⁴ shall apply *mutatis mutandis* to right in utility models, joint ownership relations, registration of utility model licence agreements, assignment of utility models, relations with foreign countries, representation in proceedings before the Office, stay of proceedings, excusing failure to comply with deadline, inspection of documents, declaratory judgements, registration of utility models kept secret under special regulations, appeal proceedings, infringement of rights and the right of the information and for granting of compulsory licences.
- (3) The Office shall levy administrative fees^{2a} for the individual legal acts performed under this Act.

Section 22

This Act shall enter into force on the day of its publication. (26 October 1992).

3) Sections 29, 39, 49 and 50 of Act No. 71/1967 Coll. on administrative procedures (Administrative Code).

4) Sections 8 to 10, 14 to 16, 64 to 68, 70 to 71 and 75 of Act No. 527/1990 Coll. and Section 19 of the Decree of the Federal Office for Inventions No. 550/1990 Coll. On Procedure concerning inventions and industrial designs.

The Act No. 116/2000 amending some Acts on the Protection of Industrial Property entered into force on the date of the publication (May 10, 2000), except for the provisions of the Section 9 paragraph 3, Section 10a and paragraphs 1 and 2 of Transitional Provisions which shall enter into force on July 1, 2002.

Transitional provisions of the Act No. 116/2000 Coll.

1. The right of priority from the European patent application under Section 9, paragraph 3 can be claimed after the accession of the Czech Republic to the European Patent Convention.

2. The application for the conversion of the European patent application to the application under Section 10a can be filed after the accession of the Czech Republic to the European Patent Convention.

3. The reimbursement of costs necessary to the efficient enforcement or defence of the right according to Section 18, paragraph 7 can only be claimed within the procedure of the cancellation of the utility model commenced before the date of the entry into force of this Act.

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