

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

**December 15, 1993**  
**No.3687-XII**

**as amended by Law of Ukraine # 1771-III, dated 1 June 2000**  
**(Law of Ukraine # 1771-III, dated 1 June 2000**  
**this Law is restated in the following reading)**  
**by Law of Ukraine # 2188-III, dated 21 December 2000**

**SECTION I. GENERAL PROVISIONS**

**ARTICLE 1. DEFINITIONS OF TERMS**

In this Law, the terms listed herein below shall have the following meaning:

‘Institution’ shall mean a central agency of executive power in the field of legal protection of intellectual property;

(Paragraph 2 of Article 1 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

‘Appellate Chamber’ shall mean a collegial body of the Institution designated to examine challenges against decisions of the Institution as to the acquisition of rights to intellectual property;

‘invention’ shall mean a technological (technical) solution, which meets conditions of patentability (novelty, inventiveness (non-obviousness) and industrial application);

‘utility model’ shall mean a new and industrially applicable design of a device;

‘secret invention (secret utility model)’ shall mean an invention (utility model), which contains information referred to as state secrets;

‘made-for-hire invention (utility model)’ shall mean an invention (utility model) created by an employee:

- in connection with fulfilling employment duties or upon the employer’s instructions, unless otherwise provided by the labor agreement (contract);

- with the use of experience, industrial knowledge, production secrets and equipment of the employer;

‘employment duties’ shall mean functional duties of employees as stated in labor agreements (contracts) and job descriptions, which provide for performing work that may lead to the creation of an invention (utility model);

‘instruction by an employer’ shall mean an order issued to an employee in writing, which is directly related to the specifics of activity of the enterprise or activities of the employer and may lead to the creation of an invention (utility models);

‘employer’ shall mean a person who has employed an employee on the basis of a labor agreement (contract);

‘inventor’ shall mean a natural person, whose creative work result has been recognized as an invention (utility model);

‘patent (patent on an invention, declarative patent on an invention, declarative patent on a utility model, patent (declarative patent) on a secret invention, declarative patent on a secret utility model)’ shall mean a protective document confirming priority, authorship, and title to the invention (utility model);

‘patent on an invention’ shall mean a type of patent issued following results of a qualification expert examination of an application for a patent;

‘declarative patent on an invention’ shall mean a type of patent issued following results of a formal expert examination and examination regarding local novelty of an application for a patent;

‘declarative patent on a utility model’ shall mean a type of patent issued following results of a formal expert examination of an application for a utility model;

‘patent (declarative patent) on a secret invention’ shall mean a type of patent issued in respect of an invention considered as a state secret;

‘declarative patent on a secret utility model’ shall mean a type of patent issued for a utility model considered as a state secret;

‘qualification expert examination (expert examination on the merits)’ shall mean an expert examination, which ascertains compliance of an invention with the conditions of patentability (novelty, inventiveness (non-obviousness) and industrial application);

‘local novelty expert examination’ shall mean a component of the qualification expert examination, which ascertains the local novelty of an invention;

‘local novelty’ shall mean novelty that is determined on the basis of patents issued in Ukraine and applications for patents filed with the Institution;

(Paragraph 22 of Article 1 as amended pursuant to  
Law of Ukraine # 2188-III, dated 21 December 2000)

‘formal expert examination (examination under formal indications)’ shall mean an expert examination, during which it is determined whether an object specified in the application is affiliated with the list of objects, which may be declared inventions (utility models), and whether the application and its format comply with the prescribed requirements;

‘license’ shall mean a permit from the holder (owner) of a patent (licensor) that is granted to another person (licensee) to use an invention (utility model) on certain conditions;

‘person’ shall mean a natural person or a legal entity;

‘application’ shall mean a set of documents required for the Institution to issue a patent (declarative patent) on an invention or a declarative patent on a utility model;

‘applicant’ shall mean a person who has filed the application;

‘application priority (priority)’ shall mean priority in filing an application;

‘date of priority’ shall mean the date of the filing of an application with the Institution or to an appropriate body of a state party to the Paris Convention for the Protection of Industrial Property, under which priority is declared;

‘international application’ shall mean an application filed in accordance with the Patent Co-operation Treaty;

‘Register’ shall mean the State Register of Patents and Declarative Invention Patents of Ukraine; the State Register of Declarative Patents of Ukraine on Utility Models; the State Register of Patents and Declarative Patents of Ukraine on Secret Inventions; the State Register of Declarative Patents of Ukraine on Secret Utility Models;

‘Examination institution’ shall mean a state institution (enterprise, organization) authorized by the Institution to review and expertly examine applications;

(Article 1 is supplemented with Paragraph 32 pursuant to  
Law of Ukraine # 2188-III, dated 21 December 2000)

‘State system of legal protection of intellectual property’ shall mean the Institution and the totality of expert, scientific, educational, informational and other respectively specialized state organizations that are under the jurisdiction of the Institution.

(Article 1 is supplemented with Paragraph 33 pursuant to  
Law of Ukraine # 2188-III, dated 21 December 2000)

## **ARTICLE 2. LEGISLATION OF UKRAINE ON 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 shall consist of this Law, Laws of Ukraine “On Property”, “On State Secrets”, and other regulations.

## **ARTICLE 3. POWERS OF THE INSTITUTION IN THE FIELD OF PROTECTION OF RIGHTS TO INVENTIONS (UTILITY MODELS)**

1. The Institution shall ensure implementation of state policies in the field of legal protection of rights to inventions and utility models, for which purpose it shall:

- organize receipt of applications, performance of expert examinations thereof, and pass decisions thereon;

- issue patents on inventions and useful models, and ensure their state registration;

- ensure publication of official information about inventions and useful models;
  - engage in international co-operation in the field of legal protection of intellectual property and represent interests of Ukraine as regards the protection of rights to inventions and useful models in international organizations in accordance with applicable law;
  - adopt rules regulations within the scope of its authority according to the established procedures;
  - organize informational and publishing activities in the field of legal protection of intellectual property;
  - organize research concerned with improvements of law and the structure of activities in the field of legal protection of intellectual property;
  - organize activities concerned with personnel retraining within the state system of legal protection of intellectual property;
- assign institutions within the state system of legal protection of intellectual property to carry out, according to their specialization, certain tasks as are specified by this Law, the Enabling Rules on the Institution, other regulatory rules in the field of legal protection of intellectual property;
- discharge other functions pursuant to its Enabling Rules approved in accordance with the prescribed procedure.

(Part 1 of Article 3 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

2. Part 2 of Article 3 has been deleted.

(pursuant to Law of Ukraine # 2188-III, dated 21 December 2000,  
in connection therewith, Part 3 should be considered as Part 2)

2. Activities of the Institution shall be financed from the State Budget of Ukraine.

#### **ARTICLE 4. INTERNATIONAL TREATIES**

If an international treaty of Ukraine contains rules other than those envisaged by Ukrainian legislation on inventions (useful models), the rules of the international treaty, to which binding force the Supreme Rada of Ukraine has given its consent, shall apply.

#### **ARTICLE 5. RIGHTS OF FOREIGN NATIONALS AND STATELESS PERSONS**

1. Foreign nationals and stateless persons shall enjoy rights provided hereunder on an equal basis with citizens of Ukraine according to international treaties of Ukraine, to which binding force the Supreme Rada of Ukraine has given its consent.

2. Foreign nationals and stateless persons who have residence or domicile outside Ukraine, shall exercise their rights in relations with the Institution through intellectual property representatives (patent agents) registered according to law.

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

### **ARTICLE 6. CONDITIONS OF PROVISION OF LEGAL PROTECTION**

1. Legal protection shall be granted to an invention (utility model), which does not contradict public interests, principles of humanity and morals and complies with conditions of patentability.

2. The following may be inventions:

- a product (device, substance, culture of micro-organisms, culture of cells of plants and animals, etc.);

- a method;

- use of an earlier known product or method for new designation purposes.

A utility model may be a product/device embodying a utility model.

3. The following may not be granted legal protections hereunder:

- discoveries, scientific theories and mathematical methods;

- methods of organization and management of the economy;

- plans, conventional symbols, schedules, rules;

- methods of performance of mental operations;

- computer software;

- results of artistic design;

- layout-designs (topographies) of integrated circuits;

- plant varieties and animal breeds, etc.

4. Priority, authorship and title to an invention shall be evidenced by a patent (declarative patent).

Priority, authorship and title to a utility model shall be evidenced by a declarative patent.

The term of a patent of Ukraine on an invention shall be 20 years from the date of filing of the application with the Institution.

The term of a declarative patent on an invention shall be 6 years from the date of the filing of the application with the Institution.

The term of a patent on an invention that is embodied by a medicine, plant protection means or animal protection means, etc., which application requires a permit of a relevant competent authority, may be extended, upon request of the holder (owner) of such patent, for a term equal to the period starting as of the application filing date and ending on the date of receipt of such permit, but not more than 5 years.

Procedures for filing requests and extending the term of a patent in such case shall be determined by the Institution.

The term of a declarative patent on a utility model shall be 10 years from the date of filing of the application with the Institution.

The term of a patent (declarative patent) on a secret invention and a declarative patent on a secret utility model shall be equal to the period during which the invention (utility model) will be regarded as secret, but may not be longer than the period of protection of the invention (utility model) provided in this Law.

The term of a patent shall be terminated prior to its expiration under conditions specified in Article 32 hereof.

5. The scope of legal protections provided shall be determined by the formula of an invention (utility model). The formula shall be construed within the scope of the description of the invention (utility model) and related drawings.

6. The term of a patent (declarative patent) issued for a method of obtaining a product shall also apply to the product directly obtained through such method.

#### **ARTICLE 7. CONDITIONS OF PATENTABILITY OF AN INVENTION, UTILITY MODEL**

1. An invention meets conditions of patentability, if it is novel, inventive (non-obvious) and has industrial application.

2. A utility model meets conditions of patentability, if it is novel and has industrial utility.

3. An invention (utility model) shall be deemed novel if it is a part of the level of technology. Elements that are part of the level of technology shall, for purposes of determining the novelty of the invention, be considered only separately.

4. The level of technology shall comprise all the information, which have become publicly available before the date on which an application was filed with the Institution, or, if priority is claimed, before the date of priority.

5. The level of technology shall also include the contents of any application for a patent in Ukraine (including an international application wherein Ukraine is specified) in the original version as this application was initially filed, provided that its filing date (and the date of priority, if priority is claimed) precedes the date specified in Part four of this Article, and further that it was published as of or after that date.

6. Disclosure of information about an invention (utility model) by an inventor, or a person who has obtained, directly or indirectly, such information from the inventor, shall not affect the recognition of patentability of such invention (utility model) during 12 months before the date of filing the application with the Institution or, if priority is claimed, before the date of priority. At that, the burden of proof of circumstances under which such information was disclosed shall be laid upon a person interested in the application of this Part.

7. An invention shall be deemed to have a level of inventiveness if it is not obvious for a specialist, i.e., it cannot be readily deduced from the level of technology. The contents of applications mentioned in Part five of this Article shall not be taken into account in the course of examination of the level of inventiveness.

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

### **SECTION III. RIGHT TO RECEIVE A PATENT**

#### **ARTICLE 8. RIGHT OF THE INVENTOR**

1. An inventor shall enjoy a right to obtain a patent, unless otherwise provided by this Law.

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

3. In case of revision of terms and conditions of the agreement on the composition of inventors, the Institution shall make changes in applicable documents, according to the procedure specified by the Institution, at the joint request of persons named in the application as inventors and persons who are inventors, but are not stated as such in the application.

4. Natural persons, who have made no creative contribution to the creation of an invention (utility model), but have provided the inventor (inventors) solely with technical, organizational or financial assistance in the course of creation thereof and/or completion of an application, shall not be deemed inventors.

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

The inventor shall enjoy the right to confer his name on an invention (utility model) created by him.

#### **ARTICLE 9. RIGHT OF THE EMPLOYER**

1. The employer of an inventor shall enjoy the right to obtain a patent on an invention (utility model) made for hire.

2. An inventor shall provide the employer with a notice in writing of an invention (utility model) made by him for hire, with a description disclosing the essence of the invention (utility model) in a sufficiently clear and complete manner.

3. Within four months from the date of receipt of notice from the inventor, the employer shall be obligated to file an application for a patent with the Institution or transfer the right to obtain such patent to another person, or take a decision to keep the made-for-hire invention (utility model) as confidential information. Within the same time limit, the employer shall conclude an agreement in writing with the inventor in respect of the amount and conditions of fee payments to the inventor (the inventor's successor) based on economic value of the invention (utility model) and/or any other benefit, which can be derived by the employer.

4. Should the employer fail to meet the requirements stated in Part three of this Article within the specified time limit, the right to obtain a patent on a made-for-hire invention (utility model) shall pass on to the inventor or his successor. In this case, the employer shall retain the preferential right to acquire a license.

5. The period of time, during which the employer or its successor may keep a made-for-hire invention (utility model) as confidential information, if such invention (utility model) is not used, must not exceed four years. Otherwise, the right to obtain a patent on a made-for-hire invention (utility model) shall pass on to the inventor or his successor.

6. Disputes related to conditions of receipt of fees by the inventor of a made-for-hire invention (utility model) and fee amounts shall be settled in court.

#### **ARTICLE 10. RIGHT OF A SUCCESSOR**

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

#### **ARTICLE 11. RIGHT OF THE FIRST APPLICANT**

If an invention (utility model) has been created by two or more inventors independently from one another, then the right to obtain a patent (declarative patent) on such invention, or a declarative patent on a utility model shall be enjoyed by the applicant, whose application has a earlier date of filing with the Institution or, if priority is claimed, an more earlier date of priority, provided that the said application will not be deemed withdrawn, is not withdrawn, and has not been decided on to refuse the patent has been made.

### **SECTION IV. PROCEDURES FOR OBTAINING PATENTS**

#### **ARTICLE 12. THE APPLICATION**

1. A person, who desires to obtain a patent (declarative patent) and is entitled thereto, shall file an application with the Institution.

2. Upon instruction of an applicant, the application may be filed through an intellectual property representative or some other agent.

3. Information contained in an application shall be referred to as state secrets in accordance with the Law of Ukraine "On State Secrets" and regulations adopted on its basis.

If an invention (utility model) has been created with the use of information registered in the Book of State Secrets of Ukraine, or if such invention (utility model) may be considered as



state secrets according to the Law of Ukraine “On State Secrets”, the application shall be filed with the Institution through a special regime and secret body of the applicant or through a competent authority of the local state administration at the registered address (for legal entities) or the place of residence (for natural persons). The applicant’s proposal to declare the invention (utility model) a state secret, with reference to the applicable provisions of the Law of Ukraine “On State Secrets”, shall be attached to the application.

4. An invention application shall concern one invention or a group of inventions linked by a single inventive concept (requirement to the oneness of the invention).

An application for a utility model shall concern one utility model (requirement of the oneness of the utility model).

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

- an application for a patent on an invention subject to the qualification expert examination, or for a declarative patent on an invention (utility model);

- description of the invention (utility model);

- a formula of the invention (utility model);

- drawings (if there are references thereto in the description);

- a synopsis.

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

An inventor shall have the right to require that he be not mentioned as an inventor of the given invention (utility model) in any publication of the Institution, in particular in the information about the application or the patent.

7. The description of an invention (utility model) shall be made according to the established procedure, and shall disclose the essence of the invention (utility model) so clearly and fully that a specialist in the relevant field would be able to produce it.

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

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

10. Other requirements to application-related documents shall be specified by the Institution in accordance herewith.

11. A fee shall be paid for filing an application. A document confirming payment of the fee shall be filed with the Institution together with the application or within two months upon the date of filing the application.

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

### **ARTICLE 13. APPLICATION FILING DATE**

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

- an application for a patent (declarative patent) written in Ukrainian in arbitrary form;
- information about the applicant and his(its) address written in Ukrainian;
- a material making an impression of being a description of the invention (utility model) and a part of the material, which can be recognized as the formula of the invention (utility model), written in Ukrainian or another language. If the description and formula of the invention (utility model) are set out in another language, then the Ukrainian translation thereof must be received by the Institution within two months of the application filing date in order to preserve the application filing date.

2. If the Institution believes that at the moment of receipt, documents and materials contained in the application do not comply with the requirements of Part one of this Article, it shall notify the applicant thereof.

Two months following the receipt by the applicant of notice from the Institution shall be granted for introducing changes in the documents and materials. If inconsistencies are rectified within the said time, then the date of receipt of the amended materials by the Institution will be deemed to be the application filing date. Otherwise, the application shall be deemed not filed, whereof the applicant shall be notified.

If there are references to drawings in an application containing documents and materials mentioned in Part one of this Article, but such drawings have not been received by the Institution as of the date of receipt of the application, the Institution shall notify the applicant thereof, and shall suggest that he either send the drawings or delete the reference thereto from the application.

If the Institution receives the drawings within 2 months of the date of the applicant's receipt of notice from the Institution, then the date of receipt of such drawings by the Institution shall be deemed to be the application filing date. If the applicant fails to make the offered choice within the same time limit, the application shall be deemed not filed, whereof the applicant shall be notified.

A decision determining an application filing date shall be sent by the Institution to an applicant upon receipt of the document confirming payment of the application filing fee in accordance with Part eleven of Article 12 hereof. In case of violation of the requirements of Part eleven of Article 12 hereof, the said decision shall not be sent, and the application shall be deemed to have been withdrawn.

#### **ARTICLE 14. THE INTERNATIONAL APPLICATION**

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

The translation of an international application into Ukrainian and the document confirming payment of the application filing fee must be provided either together with the application or within 2 months after the above mentioned time limits.

The time period, within which the translation of an international application and the document confirming fee payments must be received, may be extended up to 6 months from the date of receipt of the international application. A fee shall be paid for such time extension.

2. The Institution shall send an applicant a notice of acceptance of the international application for examination, subject to compliance with the requirements of Part one of this Article.

3. If at least one of the conditions specified in Part one of this Article is not met within the specified time, the application shall not be accepted for examination, whereof the applicant shall be notified.

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

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

#### **ARTICLE 15. PRIORITY**

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

2. Within three months of the date of filing the application with the Institution, the applicant who desires to exercise his right of priority shall file an application for priority, with reference to the date of filing and the number of the preliminary application, with a copy thereof, if such application has been filed in a foreign country that is a state party to the Paris Convention for the Protection of Industrial Property. Within the specified time limit, the said documents and materials may be amended. If these documents and materials are not filed in a timely manner, the right of priority to the application shall be deemed to have been lost, whereof the applicant shall be notified.

The time periods mentioned in Parts one and two of this Article, which have been missed by the applicant for unforeseen reasons or reasons beyond his control, may be extended by 2 months after the date of expiry of the said periods, subject to the payment of an appropriate fee. Procedures governing the extension of such periods shall be specified by the Institution.

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

A deadline for providing a translation of the preliminary application may be extended up to 6 months of the date of receipt by the applicant of the Institution's inquiry. A fee shall be paid for the extension of such deadline.

3. Priority of several preliminary applications may be claimed in respect of the application as a whole or an individual item of the formula of an invention (utility model). At that, time periods which commencement date is the date of priority shall be calculated from the earliest date of priority.

4. Priority shall extend only onto those features of the invention (utility model), which are stated in the preliminary application, whose priority is claimed.

5. If some features of an invention (utility model) are missing from the formula of the invention (utility model) as 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 processing the preliminary application has not been completed by the Institution, then, upon receipt of an application for priority under Part two of this Article, the preliminary application shall be deemed withdrawn to the extent priority is claimed.

7. Priority of an application singled out from the previous application as proposed by the Institution or upon the applicant's initiative prior to adoption of a decision to issue a patent (declarative patent) or a decision to refuse such patent (singled out application) shall be determined on the basis of the date of filing with the Institution of the preliminary application from which it has been singled out or, if priority is claimed under the preliminary application, on the basis of the date of such priority, provided that the essence of the invention in the singled out application falls within the scope of the essence of the preliminary application as of the date of filing thereof.

## **ARTICLE 16. EXPERT EXAMINATION OF AN APPLICATION**

1. Expert examination of an application shall be carried out by an expert institution in accordance with this Law and rules established by the Institution on the basis of this Law.

In the course of an expert examination, the expert institution shall send notices, inquire and conclusions to the applicant. At that, conclusions of the expert institution shall acquire, upon their ratification by the Institution, the status of decisions of the Institution.

2. On his own initiative or at the request of the expert institution, an applicant may, either in person or through his agent, in the manner prescribed, participate in the consideration of issues which have arisen in the course of the expert examination.

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

At the time of publication of information on the application for a patent on an invention, the said amendments and clarifications shall be taken into account, if they were received by the expert institution 6 months prior to the publication date.

A fee shall be paid for filing requests to amend and clarify an application on an applicant's initiative following his receipt of a decision on the deadline for filing the application.

4. If the applicant has filed additional documents and materials, then it shall be determined in the course of an expert examination whether they fall within the scope of the essence of the invention (utility model) as disclosed in the filed application.

The additional documents and materials do not fall within the scope of the essence of the invention (utility model) as disclosed in the filed application, if they contain indications, which should be included in the formula of the invention (utility model).

Additional documents and materials in the part falling outside the essence of the invention (utility model) as disclosed in the filed application shall not be taken into account in the course of reviewing the application, and may be filed by the applicant as a separate application.

5. Preliminary examination of the application shall take place prior to ascertaining the application filing date. In the course of a preliminary examination, an application, which does not include the applicant's proposal to declare the invention (utility model) to be state secrets, shall be reviewed as to whether it contains materials, which can be declared as state secrets in accordance with the Book of State Secrets.

In case of availability of such data in the application or if an application contains the applicant's proposal to declare the invention (utility model) as a state secret, a State Expert for Secret Matters (hereinafter referred to as the 'State Expert') who is authorized to examine such issues shall be appointed. Such Expert shall be sent materials contained in the application in order to decide on recognizing the invention (utility model) as a state secret.

The State Expert shall send his decision, together with documents and materials contained in the application, to the Institution within one month of his receipt of the documents and materials contained in the application.

A time period, during which a decision on recognizing information in the application a state secret will be in effect, shall be set by the State Expert, taking into account the decree of classification of such information.

If the State Expert has decided to recognize the claimed invention (utility model) as a state secret, he also shall specify individuals, who may access it; and the subsequent examination of the application within the Institution shall be carried out in accordance with secrecy procedures.

The Institution shall notify the applicant of the decision by the State Expert within one month. If an application did not contain a proposal of the applicant to recognize an invention (utility model) as a state secret, but the State Expert has recognized the invention (utility model) as a state secret, then the applicant, in case of dissent, may file with the Institution a substantiated request to declassify the documents and materials of the application, or challenge the decision of the State Expert in court.

6. Examination of the application shall start as at the date of its filing in accordance with Article 13 hereof.

7. Upon filing the application, and if there is a document confirming payment of the filing fee, the formal expert examination of an application shall be carried out, during which:

a) it shall be determined whether an object applied for belongs to the objects specified in Part two of Article 6 hereof, and whether it is among the objects specified in Part three of Article 6 hereof;

b) the application shall be verified as to its compliance with the requirements of Article 12 hereof.

The first notice of a formal expert examination to the applicant, which may be provided in the form of a notice of completion of the expert examination or a requirement to amend the documents and materials of the application, shall be sent within 6 months of the determined application filing date.

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

If the application does not comply with the requirements of Article 12 hereof or the document confirming payment of the application filing fee has not been received, the applicant shall notified thereof in writing.

In case of violation of the requirement of the oneness of an invention (utility model), it shall be suggested to the applicant to advise as to which invention (utility model) should be considered, and, if necessary, to make clarifications to the application. In this case, other inventions (useful models) may become subject matter of separate applications.

The applicant shall be provided an opportunity to amend the documents and materials within two months from the date of notice from the expert institution. If the oneness requirement has not been met within this period, the expert institution in the course of performing a formal expert examination shall consider the invention (utility model) specified first in the formula. If other inconsistencies are not rectified within the same period, and the applicant fails to file a request for the extension of the said period, the applicant shall be sent a decision to refuse the patent.

9. If the application for a patent on an invention meets the requirements of Article 12 hereof, the applicant shall be sent, if there is a document confirming payment of the application

filing fee, a notice of completion of the formal expert examination and a possibility to hold a qualification expert examination of the application.

10. If the application for a declarative patent on an invention meets the requirements of Article 12 hereof, the expert institution, if there is a document confirming payment of the application filing fee, shall start the expert examination of the application as to its local novelty.

In case of the positive outcome of a local novelty expert examination, the Institution shall send the applicant a decision issuing the declarative patent on the invention. Otherwise, the applicant shall be sent a decision refusing the declarative patent.

11. If the application for a declarative patent on a utility model meets the requirements of Article 12 hereof, the applicant shall be sent, if there is a document confirming payment of the application filing fee, a decision issuing a declarative patent on the utility model.

12. Upon expiry of 18 months of the date of filing an application for a patent on an invention, or, if priority is claimed, of the date of its priority, the Institution shall publish in its official bulletin the information, determined by it, about the application, provided that the application has not been withdrawn, is not deemed to have been withdrawn, or has not been decided on to refuse the patent.

Upon solicitation of the applicant, the Institution shall publish information on the application prior to the said date.

Upon publication of information on the application, any person shall have the right to familiarize himself with documents and materials of the application according to the procedure specified.

In case of detection of obvious errors in the published information, the applicant shall have the right to request their rectification.

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

Information on applications, which have been decided by the State Expert to constitute state secrets, shall not be published.

13. Upon solicitation of any person, and if there is a document confirming payment of the fee for the qualification expert examination of the application for a patent on an invention, the said expert examination shall be carried out, during which is verified the compliance of the claimed invention with the patentability conditions as set in Article 7 hereof.

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

Another person may file the said application after the publication of information on the application, but only within three years of the application filing date. At that, such person shall not participate in the resolution of issues related to the application. The qualification expert

examination shall be performed subject to the payment of the appropriate fee. The expert opinion on the basis of results of the qualification expert examination shall be sent to such person.

14. In the course of a qualification expert examination of an invention application, the expert institution shall have the right to require from the applicant to provide additional materials, without which such examination is impossible, or suggest altering the formula of the invention.

An applicant shall have the right to require that the expert institution provide him with copies of patent materials opposing the application within one month upon receipt of the expert institution's inquiry. Copies of such materials shall be provided to the applicant within one month.

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

Should the applicant fail to furnish the materials requested by the expert institution or to file a substantiated application for extension of the said time period, the application shall be deemed to have been withdrawn.

The procedure set out by Part four of this Article shall apply to additional materials relating to the part beyond the scope of the essence of the invention that is set forth in the filed application.

15. If the violation of the invention oneness requirement was found out at the stage of the qualification expert examination of the application, then the examination shall be carried out according to the procedure set out in Part eight of this Article in respect of the invention oneness requirement.

16. If it is determined as a result of the qualification expert examination that the invention, whose essence is expressed in the formula suggested by the applicant, meets the patentability conditions, the applicant shall be sent a decision to issue the patent on the invention. Otherwise, a preliminary decision to refuse the patent shall be sent to the applicant.

Within 2 months upon receipt of a preliminary decision refusing the patent, an applicant may amend materials contained in his application, furnish additional materials, which fall within the scope of the essence of the invention specified in the application.

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

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

A decision to issue or refuse a patent on an invention shall be sent to the applicant.



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

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

19. The time periods specified for applicants by Parts eight, thirteen, fourteen and sixteen of this Article may be extended in the prescribed manner, but not more than by 6 months. A fee shall be paid for filing a request for extension of a time period.

20. If an applicant has missed a time period envisaged by Parts eight, thirteen, fourteen and sixteen of this Article, he may file a request with the expert institution for the renewal of the missed time period within 12 months of the date of expiry of the missed time period. If the applicant has missed the time period for serious reasons, such time period may be renewed. A fee shall be paid for the renewal of missed time periods.

(Article 16 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

#### **ARTICLE 17. WITHDRAWAL OF AN APPLICATION**

An applicant shall have the right to withdraw an application at any time before receiving a decision issuing a patent.

#### **ARTICLE 18. TRANSFORMATION OF APPLICATIONS**

An applicant shall have the right to transform:

- an application for a patent on an invention into an application for a declarative patent on an invention, and vice versa, at any time before his receipt of a decision issuing a patent (a declarative patent), or a decision refusing such patent;

- an application for a patent (declarative patent) on an invention into an application for a declarative patent on a utility model, and vice versa at any time, before his receipt of a decision issuing a patent (a declarative patent), or a decision refusing such patent.

In this case, the determined application filing date and, if priority is claimed, the date of its priority shall be retained.

#### **ARTICLE 19. CONFIDENTIALITY OF AN APPLICATION**

From the date of receipt of an application by the Institution and till the publication of information on the application or publication of information on the issue of a patent, the documents and materials contained in the application shall be deemed confidential information.

Third party access to documents and materials of an application shall be prohibited, unless such access is provided by permission of the applicant or by decision of a competent authority.

Persons guilty of violation of requirements as to the confidentiality of documents and materials contained in an application shall be held liable pursuant to laws of Ukraine.

#### **ARTICLE 20. ALTERATION OF AN APPLICANT**

An applicant shall be altered as a result of assignment of the right to obtain a patent on the basis of a contract or by operation of law, or due to the enforcement of a court decision, or as a result of re-organization or liquidation of a legal entity, etc. The applicant or a person, who has acquired such rights, shall file an application with the Institution, attaching therewith a document or a certified copy of a document constituting the ground for such alteration. If not all applicants are altered, an application for such alteration must be signed by all applicants who filed the application.

Alteration of an applicant may only be possible until the Institution makes a decision issuing a patent.

#### **ARTICLE 21. TEMPORARY LEGAL PROTECTION**

1. Information on an application for a patent on an invention published in accordance with Part twelve of Article 16 hereof shall provide the applicant with temporary legal protections within the scope of the invention's formula, subject to which such information was published.

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

3. Temporary legal protections shall terminate as of the date of publication in the official bulletin of information on the issue of a patent on an invention or a notice of termination of the application processing.

4. Temporary legal protections under an international application shall start as of the date of its publication by the Institution subject to the terms and conditions set forth in Part two of this Article.

#### **ARTICLE 22. REGISTRATION OF THE PATENT**

1. On the basis of a decision on issuing a patent, state registration of a patent shall be effected, for which purpose relevant data will be entered in the Register. The form of the Register and Register keeping procedures shall be determined in the manner prescribed.

2. State registration of a patent (declarative patent) on an invention and a declarative patent on a utility model shall be effected if there is a document confirming payment of the state duty for issuance of the patent. This document must be received by the Institution within 3 months of the date of receipt by the applicant of the decision on issuing a patent.

3. Upon entering information in the Register about a patent (declarative patent) on an invention and a declarative patent on a utility model, any person shall have the right to familiarize himself with such information according to the procedure specified by law.

The information entered in the Register about a patent (declarative patent) on a secret invention and a declarative patent on a secret utility model shall be familiarized with in accordance with the Law of Ukraine "On State Secrets".

4. The information entered in the Register may be rectified and/or clarified upon initiative of the holder of a patent or the Institution.

Upon initiative of the holder of a patent, changes can be made to the Register pursuant to the approved list of possible changes. A fee shall be paid for making changes in the Register regarding a patent (declarative patent) on an invention and a declarative patent on a utility model.

(Article 22 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

#### **ARTICLE 23. PUBLICATIONS ON GRANTS OF PATENTS**

1. Simultaneously with the state registration of a patent (declarative patent) on an invention and a declarative patent on a utility model, the Institution shall publish the information, determined by it, on the issue of the patent (declarative patent) in its official bulletin.

(Paragraph 1 of Article 23 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

2. Not later than in 3 months upon publication of information on the issue of a patent, the Institution shall publish a description of the patent (declarative patent), which will contain the formula and description of the invention (utility model) and the drawings referred to in the description of the invention (utility model).

3. Upon publication of the information on the issue of a patent (declarative patent) on an invention and a declarative patent on a utility model, any person shall have the right to familiarize himself with materials contained in the application according to the specified procedure.

(Paragraph 3 of Article 23 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

4. Information on the issue of a patent (declarative patent) on a secret invention and a declarative patent on a secret utility model shall not be published.

#### **ARTICLE 24. CHALLENGES AGAINST THE DECISION IN RESPECT OF AN APPLICATION**

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

2. Pursuant to specified procedures, an applicant may file an objection against any decision of the Institution in respect of an application within the Appellate Chamber within 6 months of the date of his receipt of the Institution's decision or copies of patent materials sent at his request.

3. A fee shall be paid by an applicant for filing an objection with the Appellate Chamber.

4. The applicant's objection against a decision of the Institution shall be adjudicated by the Appellate Chamber within 4 months upon receipt of such objection.

Based on results of adjudication of the objection, the Appellate Chamber shall pass a decision that will be approved by order of the Institution, and shall be sent to the applicant.

Prior to approval of a decision of the Appellate Chamber, within one month from the date of such decision, the Head of the Institution may bring a protest against this decision, which protest shall be considered within one month. The decision of the Appellate Chamber adopted under the protest shall be final and may be cancelled only by the court.

5. The applicant may challenge a decision of the Appellate Chamber that has been approved by the Institution in court within six months following the receipt of the decision.

(Article 24 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

#### **ARTICLE 25. ISSUE OF A PATENT**

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

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

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

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

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

#### **ARTICLE 26. TRANSFORMATION OF A DECLARATIVE PATENT**

For the purposes of the changing a declarative patent on an invention into a patent on an invention, the holder of a declarative patent on an invention or his successor may submit a request for a qualification expert examination of the application, on which basis the declarative patent was issued. Such a request must be provided to an expert institution not later than within three years of the date of filing the application, on which basis the declarative patent was issued. A fee shall be paid for filing requests.

(Paragraph 1 of Article 26 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

Paragraph 2 of Article 26 has been deleted.

(Pursuant to by Law of Ukraine # 2188-III, dated 21 December 2000)

If a decision to issue a patent on an invention is made as a result of the qualification expert examination, the declarative patent shall be terminated as from the date of publication of information on the issue of the patent on an invention. The Institution shall publish the information about the termination of the declarative patent in the official bulletin. The term of a patent on an invention issued instead of the declarative patent on an invention shall be 20 years from the date of filing the application for the declarative patent on the invention.

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

If a decision to refuse a patent on an invention has been taken as a result of the qualification expert examination of the application, the declarative patent on the invention shall be deemed not to have come into force as from the date of publication of information on its issue, whereof the Institution shall publish information in the official bulletin.

#### **ARTICLE 27. DECLASSIFICATION OF A SECRET INVENTION (UTILITY MODEL)**

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

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

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

(Paragraph 3 of Article 27 as amended  
by Law of Ukraine # 2188-III, dated 21 December 2000)

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

### **ARTICLE 28. RIGHTS RESULTING FROM A PATENT**

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

Rights resulting from a patent (declarative patent) on a secret invention or a declarative patent on a secret utility model shall become effective as from the date of entering the information about it in the appropriate Register.

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

A secret invention (utility model) shall be used by a patent holder in accordance with the requirements of the Law of Ukraine "On State Secrets", and subject to confirmation by the State Expert.

Relations in the course of use of an invention (utility model), for which the patent is held by several persons, shall be determined by an agreement among such persons. If such agreement is absent, each patent holder may use the invention (utility model) at his discretion; however, none of them shall have the right to grant a permit (a license) for using the invention (utility model), and transfer the title to the invention (utility model) to another person without a consent of the other holders of the patent.

The following shall be considered to constitute the use of an invention (utility model):

- manufacture, offering for sale, use or importation, storage, otherwise introducing of a product into business circulation for the above mentioned purposes, which product has been produced with the use of the patented invention (utility model);

- use of a method protected by the patent, or offering thereof for use in Ukraine, if the person offering such method is aware that such use is prohibited without consent of the patent holder or, in view of circumstances, it is in any way obvious;

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

A product shall be recognized to have been manufactured with the use of a patented invention (utility model), if each feature included in an independent item of the formula of the invention (utility model) or a feature equivalent therewith is used.

A method protected by a patent shall be recognized to have been used, if each feature included in an independent item of the formula of the invention (utility model) or a feature equivalent therewith is used.

3. Exclusive rights of the holder of a patent (declarative patent) on a secret invention and a declarative patent on a 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 (declarative patent) on an invention or a declarative patent on a secret utility model shall be entitled to compensation in cash for expenses related to payment of fees envisaged hereunder from a state authority nominated by the Cabinet of Ministers of Ukraine.

Disputes in respect of compensation amounts and monetary compensation payment procedures shall be settled in court.

4. A patent holder may use precautionary markings containing the patent's number on the product or the package of the product manufactured with the use of the patented invention.

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

6. A patent holder may transfer title to an invention (utility model) on a contractual basis to any person, who becomes his successor, and, in respect of a secret invention (utility model), only following confirmation by the State Expert.

7. A patent holder shall grant a permit (license) to any person for the use of an invention (utility model) on the basis of a licensing agreement, and in respect of a secret invention (utility model) such permit shall be only granted following confirmation by the State Expert.

Under a licensing agreement, a patent owner (licensor) shall transfer the right to use a invention (utility model) to another person (licensee), who shall undertake to make payments to the licensor as provided by the agreement and take other action envisaged by the agreement on an exclusive or non-exclusive license agreement.

Under an exclusive licensing agreement, a licensor shall transfer the right to use an invention (utility model) to a licensee in a certain scope within a designated territory and for an agreed period, while reserving the right to use the invention (utility model) in the part that is not transferred to the licensee. In this case, the licensor shall not have the right to grant licenses for the use of the invention (utility model) to another person on the same territory within the scope of the rights granted to the licensee.

Under a non-exclusive licensing agreement, the licensor shall transfer the right to use an invention (utility model) to the licensee, while reserving the right to use the invention (utility model), including the right to grant licenses to other persons.

8. An agreement for the transfer of title to an invention (utility model) and a licensing agreement shall be deemed valid, if they have been executed in writing and signed by the parties.

Transfer of title to an invention (utility model) and granting of a license to use an invention (utility model) shall be binding on any other persons as of the date of publication of information thereof in the official bulletin and entry thereof in the Register.

Fees shall be paid for entering the specified information in the Register and changes to such information as are initiated by parties to an agreement.

(Point 8 of Article 28 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

9. A holder of a patent, except for a patent (declarative patent) on a secret invention or a declarative patent on a secret utility model, shall have the right to submit to the Institution for official publication a statement of 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 the patent shall be reduced by 50 per cent starting from the year, which follows the year of publication of such statement.

(Paragraph 1, Point 9 of Article 28 as amended  
by Law of Ukraine # 2188-III, dated 21 December 2000)

A person who desires to make use of such permit shall be obligated to conclude an agreement on fees with the holder of a patent or a declarative patent. Disputes arising in the course of performing such agreement shall be settled in court.

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

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

#### **ARTICLE 29. RESPONSIBILITIES RESULTING FROM A PATENT**

A patent holder shall pay applicable fees for maintaining the validity of a patent and use the exclusive right resulting from the patent in good faith.

#### **ARTICLE 30. FORCED ALIENATION OF 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 not been used in full in Ukraine during three years following the publication of information on the issue of the patent, or after the date, when use of the invention (utility model) was terminated, then any person who is willing and ready to use such invention (utility model) may bring action in court, seeking obtaining a permit to use the invention (utility model) on non-exclusive license conditions, in case of the refusal of the owner of rights to conclude a licensing agreement.

Unless the patent holder proves that failure to use the invention (utility model) has been caused for serious reasons, the court shall pass a decision to grant an interested person a permit to use the invention (utility model) on non-exclusive license conditions, setting forth the scope of its use, the term of the permit, amounts and procedures for the payment of fees to the patent holder.

2. A patent holder shall be obligated to grant a permit (license) for the use of an invention (utility model) to a holder of a patent that was issued later, if the latter's invention (utility model) is intended for attaining some other objective or has considerable technical and economic advantages, but may not be used without infringing on rights of the owner of the patent



issued earlier. The permit shall be granted in a scope required to use the invention (utility model) by the holder of the patent issued later. In this case, the owner of the patent issued earlier may obtain a license on favorable conditions for using the invention (utility model), which is protected by the patent issued later.

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

4. A holder of the patent (declarative patent) on a secret invention or a declarative patent on a secret utility model may grant a license for using his invention (utility model) only to a person having the right of access to such invention (utility model) granted by the State Expert.

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

5. Disputes related to conditions of granting licenses, payments of compensation and amounts thereof shall be settled in court.

#### **ARTICLE 31. ACTIONS NOT DEEMED TO CONSTITUTE AN INFRINGEMENT UPON RIGHTS**

1. Any person, who used the technological (technical) solution identical to the claimed invention (utility model) in the interests of his activities for commercial purposes in good faith or made considerable and serious preparations for such use prior to the date of filing of an application with the Institution or, if priority is claimed, prior to the date of priority, shall retain the right to gratis continuation of such use or to the use of the invention (utility model) as envisaged by the said preparations (right of prior use).

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

The right of prior use may be assigned or transferred to another person only together with the enterprise or the business practice or the part of the enterprise or business practice, wherein 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 an infringement upon rights resulting from the patent:

- use in a design of, or in the course of operation of, a transport vehicle of a foreign state that is temporarily or occasionally in the waters, air space or within the territory of Ukraine, provided that the invention (utility model) is used solely for the purposes of the specified transport vehicle;

- use without commercial purposes;

- use for scientific or experimental purposes;
- use in case of extraordinary situations (acts of God, disasters, epidemics, etc.);
- use for one-time production of medicines in chemist's shops according to doctors' prescriptions.

3. Introduction in business circulation of a product manufactured with the use of a patented invention (utility model) by any person, who has acquired it without infringing upon rights of the holder, shall not be considered to constitute an infringement upon rights resulting from the patent.

A product manufactured with the use of 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 into circulation after the manufacture by the patent holder or another person under a special permit (license) from the patent holder.

4. Use of an invention for commercial purposes by any person, who has acquired a product manufactured with the use of the patented invention and could not know that such product has been manufactured or introduced in circulation in violation of rights conferred by the patent, shall not be considered to constitute an infringement upon rights resulting from the patent. However, upon receipt of an appropriate notice from the holder of rights, the said person shall cease using the product or pay the holder of rights an appropriate sum, which amount shall be determined according to laws or upon consent of the parties. Disputes related to such payments and payment procedures shall be settled in court.

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

### **ARTICLE 32. TERMINATION OF A PATENT**

1. At any time, a patent holder may renounce a patent in full or in part on the basis of an application filed with the Institution. Such renunciation shall become effective as from the date of publication of information thereon in the official bulletin of the Institution.

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

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

The annual fee for maintaining the validity of a patent shall be paid for each year of its effect starting from the application filing date. The document confirming the first payment of the said fee must be provided to the Institution not later than within 4 months upon the date of publication of information on the issue of the patent. The document confirming payment of fees for each subsequent year must be provided or mailed to the Institution till the end of the current year of effect of the patent, provided that the fee has been paid within last four months of the year.

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

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

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

No fee shall be paid for maintaining the validity of a patent (declarative patent) on a secret invention or a declarative patent on a secret utility model.

### **ARTICLE 33. INVALIDATION OF A PATENT**

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

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

b) existence of features in the formula of an invention (utility model), which were not included in the filed application;

c) violation of the requirements of Part two of Article 37 hereof.

2. In order to have a declarative patent invalidated, any person may file a request with the Institution, requesting an expert examination of the patented invention (utility model) as to its compliance with the patentability conditions. A fee shall be paid for filing such a request.

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

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

(Article 33 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

## **SECTION VII. PROTECTION OF RIGHTS**

### **ARTICLE 34. INFRINGEMENT UPON RIGHTS OF THE PATENT HOLDER**

Any infringement upon rights of a patent holder envisaged by Article 28 hereof shall be deemed to constitute an infringement upon the rights of the patent holder, entailing liability as provided by applicable Ukrainian law.

2. The patent holder may require:

- termination of actions, which infringe upon or threaten to infringe upon his rights, and restoration of the position as was before such infringement;

- payment of damages, including non-received revenue;

- reimbursement for emotional duress;
- taking other actions related to protection of rights of the patent holder as envisaged by legislative acts.

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

#### **ARTICLE 35. DISPUTES TO BE SETTLED IN COURT**

1. Disputes arising from or related to application of this Law shall be settled in a court, court of arbitration or reconciliatory tribunal according to procedures provided by applicable Ukrainian law.

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

- invalidation of a patent;
- authorship of an invention (utility model);
- ascertaining of a patent holder;
- infringement upon property rights of a patent holder;
- conclusion and performance of licensing agreements;
- issue of a forced license;
- the right of prior use;
- fees payable to an inventor;
- compensation.

Courts shall also consider other disputes related to protection of rights conferred by this Law.

### **SECTION VIII. FINAL PROVISIONS**

#### **ARTICLE 36. STATE DUTIES AND FEES**

Amounts and procedures of payment of state duties for issuing patents on inventions (utility models) shall be specified by law.

Amounts of fees as specified by this Law, time periods and procedures of fee payment shall be specified by the Cabinet of Ministers of Ukraine.

Funds received from the payment of fees and state duties for the issue of patents shall be transferred to the State Budget of Ukraine.

Fees provided for by this Law shall be paid into settlement accounts of institutions authorized by the Institution which are part of the state system of legal protection of intellectual property and fulfill, according to their specialization, certain tasks specified in this Law.

Monies as a result of payment of fees provided by this Law shall be deemed to be special-purpose funds and shall be, by orders of the Institution, used exclusively for ensuring the development and functioning of the state system of legal protection of intellectual property, specifically for accomplishing tasks specified in this Law and other regulatory and legal acts in the field of intellectual property.

(Article 36 as restated  
by Law of Ukraine # 2188-III, dated 21 December 2000)

#### **ARTICLE 37. PATENTING OF AN INVENTION (UTILITY MODEL) IN FOREIGN COUNTRIES**

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

2. Prior to filing an application for a protective document in respect of an invention (utility model) with a body of a foreign country, including an international application, an applicant shall be obligated to file an application with the Institution and notify it of his intent to effect such patenting.

In the event that no prohibition has been issued within 3 months following the receipt of such notice by the Institution, an application for a patent on an invention (utility model) may be filed with a body of a foreign country.

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

3. If an invention is patented under the procedures of the Patent Co-operation Treaty, the international application shall be filed with the Institution.

#### **ARTICLE 38. STATE ENCOURAGEMENT OF DEVELOPMENT AND USE OF INVENTIONS (UTILITY MODELS)**

The State shall encourage the development and use of inventions (useful models), provide tax benefits and privileged borrowing conditions for inventors and persons using the inventions (useful models), and shall grant them other privileges according to applicable Ukrainian law.

The honorary title of the Ukraine's Honored Inventor may be conferred upon inventors of highly efficient used inventions (useful models).

### **SECTION IX. TRANSITIONAL PROVISIONS**

1. Applications for patents of Ukraine on inventions with a term of five years without expert examination on the merits (hereinafter referred to as 'five-year term patents') submitted in accordance with Resolution of the Supreme Rada (Parliament) of Ukraine of 23 December 1993 "On Enactment of the Law of Ukraine "On Protection of Rights to Inventions and Utility

models”, processing of which had not been completed before the entry into force of this Law, shall be regarded as applications for declarative patents on inventions, and shall be reviewed by the Institution without a local novelty expert examination.

(Point 1 of Section 1 as amended  
by Law of Ukraine # 2188-III, dated 21 December 2000)

2. In regard to applications for five-year patents, in which respect decisions to issue patents were taken before the entry into force of this Law, but no state registration had been effected, nor had been published the information about the issue of patents, the Institution shall issue declarative patents on inventions and publish information about the issue thereof, if there were paid appropriate fees.

(Paragraph 1, Point 2 of Section 9 as amended  
by Law of Ukraine # 2188-III, dated 21 December 2000)

Holders of five-year patents on inventions may file applications for qualification expert examinations and the transformation of patents according to the procedures established for declarative patents by Article 26 hereof.

3. Valid patents on utility models shall be treated, in respect of the legal regime, including their term, as declarative patents on utility models.

(Section 9 is supplemented with Point 3 pursuant to  
Law of Ukraine # 2188-III, dated 21 December 2000)

## **SECTION X. FINAL PROVISIONS**

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

2. It shall be established that, until the legislation is brought in compliance herewith, other laws and regulations shall apply to the extent they are not inconsistent herewith.

3. Within three months, the Cabinet of Ministers of Ukraine shall submit to the Supreme 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 Supreme Rada of Ukraine of 19 January 1995 “On Approval of the Regulations on the Procedure of Formalizing and Using the Rights to Inventions, Utility Models and Industrial Samples that are State Secrets” (Vidomosti Verkhovnoyi Rady Ukrayiny, 1995, issue 3, page 23);

Paragraphs ten and eleven of Item 3 and Item 4 of the Resolution of the Supreme Rada (Parliament) of Ukraine of 23 December 1993 “On Enactment of the Law of Ukraine “On Protection of Rights to Inventions and Utility Models” (Vidomosti Verkhovnoyi Rady Ukrayiny, 1994, issue 7, page 33; 1997, issue 40, page 269)”.

**L. Kravchuk**  
**President of Ukraine**  
**City of Kyiv**