

PATENTS

How Do Patents Work in Slovakia?

What rights does a patent provide and what conditions must be met in order to gain patent protection in Slovakia? Speaking to Dagmar Cechvalova, who has more than 50 years of experience in the patent field, she reveals all the basics behind patent filing.

What rights does a patent provide?

Patents grant their proprietors the right to prevent third parties from using an invention as defined by the claims in a certain territory where the patent has been granted. For products, the use means producing, importing, selling or using, by other means, the product which falls within the scope of the claims; whereas for methods, it is understood as performing the method defined in the claim. Protection for method claims also cover products, directly obtained by such methods. One should bear in mind, personal use is excluded from the scope of protection in most jurisdictions, including Slovakia.

Patent rights are mostly not understood correctly by most of the businesses within Central Europe, including in Slovakia. The proprietors typically

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believe a granted patent gives them an exclusive right to use a certain invention, which actually is not the case. A granted patent might depend on other rights, so freedom to use it might be influenced by other parties.

How long does patent protection last?

Term of protection for granted patents is up to 20 years since its filing for most jurisdictions, provided the maintenance fees are paid. This is not different for Slovakia. The protection for pharmaceutical composition can last up to 25 years from filing of the base patent application under the Supplementary Protection Certificate regimen. For utility models in Slovakia, the term of protection is up to 10 years from filing.

How are patent rights enforced?

In Slovakia, the patent rights

are enforced via the courts and their decisions. There is a central court responsible for all patent related matters. The process might be quite cumbersome, because opposite to trademarks, courts have not gathered extensive experience in patent related cases, especially for patent protected methods. To come to a conclusion in infringement cases, the court relies heavily on expert opinions of patent office examiners. In some cases, external court appointed experts are used. Those might, however, have limited experience with and sometimes an incorrect understanding of the scope of protection of the patents. Because of this, a good local patent attorney is a must when starting an infringement case in Slovakia for proprietors who want to get quick and effective results.

Before infringement proceedings, it is also advisable to perform a background

check on the potential infringer to understand what to expect. One should also be aware that most small and medium enterprises managers may not speak the same language as their opposition, however, this is slowly changing.

We also do not have a positive experience with cease and desist letters, as most accused infringers rather risk hearing the court's decision, as they are aware of the fact the resulting penalties are typically quite limited and monetary compensation related to loss of profit might be hard to prove.

What conditions must be met to obtain patent protection?

For patents, there are three main conditions that must be met to get a granted patent for inventions, which includes: novelty, inventive steps and industrial application.

This does not differ for utility models, so the inventiveness hurdle is technically the same as for patents. The difference is in the excluded subject matter - such as for utility models methods for producing chemical and pharmaceutical compounds, or the medical use of compounds and technical solutions related to products comprising biological material

and methods for production and use of biological material - are excluded, in addition to the subject matter excluded from patent protection.

Patents undergo substantive examination, thus the request must be submitted within the 36 months of filing. For utility models, applications are subject to a substantive search and the search report is published with the publication

nullified in subsequent action taken by third parties. Many proprietors are not aware of this fact and falsely believe having a strong right after their utility model is registered.

What practical steps do you have to take to obtain patent protection?

On paper, the process of obtaining a patent is quite simple in Slovakia. You have

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of the application, however, there is no office action taken that relates to the results of the search performed ex-officio. Based on the published report, any party can file an opposition and technically prevent utility models from being registered should they not meet the conditions for novelty, inventive step and industrial applicability. This process often leads to the registration of utility models, which are 'weak' and can be

to file a patent application which meet the requirements, pay the filing fees, request the substantive examination within 36 months and undergo the examination process. In real life, this is far from easy. Many of the applicants are not aware of the current invention space and subsequently, they fail to pass the substantive examination due to lack of novelty and/or inventive step.

We often see applicants

approaching a patent attorney only after they face an office action, which they are not able respond to. In many cases, this is simply too late and even the best patent attorney does not manage to save their application. It is, therefore, more than recommended to talk to a patent attorney, experienced in the related field as soon as possible, in order to increase the probability to get the patent granted. The patent attorney will help determine the most effective filing strategy respecting the scope of protection, in the respective jurisdictions they would like to get protection in; they will also research the prior art, as well as draft the application in a way to include various backup scenarios if the search that is performed by the authorities produce results influencing the grant proceedings. When selecting a patent attorney, we recommend evaluating their work by looking at their references, as well proceedings from cases they represent. Unfortunately, the proceedings in front of the Slovak Patent Office are not freely available via the internet, so it might be a good idea to have a look at cases they represent in front of the European Patent Office via the European Patent Register, for example. **LM**

About Dagmar Cechvalova

Dagmar Cechvalova has more than 50 years of experience in the patent field and is one of the longest-serving patent attorneys in Slovakia. She founded inventa Patent and Trademark Agency 30 years ago and grew it to become one of the leading patent service firms in Slovakia, managing the largest patent portfolio for her clients. She is a qualified Slovak and European Patent Attorney, as well as European Trademark and Design Attorney, member of EPI, INTA, AIPPI and GRUR. Mrs Cechvalova served many years as the president of the Slovak Chamber of Patent Attorneys as well as a EPI board member. In her professional work, she focuses on inventions related to chemistry, biochemistry as well as green technologies.

In addition to patents, inventa provides its services in the trademark field, processes annuity payments, providing a broad range of services in the field of counterfeits and provides consulting services in the field of IP valuation. inventa puts special focus on the technical qualification of its patent attorneys, so they are fully capable to provide services to its clients in various subject fields, including genetics, biotech, pharma as well information technologies and artificial intelligence.

