Inputs from Member States and Regional Patent Offices to the Thirty-Eighth Session of the Standing Committee on the Law of Patents

Respondent Information

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Last Name:

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Country:

Estonia

IP Office

The Estonian Patent Office

Job title

Adviser of the Patent Department

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Disclaimer:

The information provided in response to this questionnaire is understood to be submitted on behalf of the Member State or regional organization concerned, through its competent authority and in accordance with its applicable official internal procedures.
It is assumed that the person completing and submitting the questionnaire is duly authorized to do so and that the information reflects the official position or practice of the Member State or organization, to the extent possible.

I confirm that I have read and understood the statement above and that I agree with its contents.

A. Prior Art

1. How is prior art defined under the applicable national or regional law?

Patents Act
§ 8 (1) The state of the art is held to comprise all the technical information made available to the public by means of written or oral description, by use, or in any other way, in any part of the world before the filing date of a patent application or before the date of priority if priority is claimed.

2. Against which date is prior art assessed under the applicable law?

Filing date, priority date, grace period

3. Which types of information may constitute prior art under the applicable law, and how is it determined whether such information is considered to form part of the prior art?

Any information provided to the public through a written or oral description (Internet, data bases, publications, exhibitions or other public events).

4. Does the applicable law provide for any category of prior art that is taken into account for patentability purposes notwithstanding that it was not publicly available before the relevant filing or priority date (sometimes referred to as "secret prior art")?

Yes

If yes, please indicate, where applicable, the types of information or documents concerned (for example, earlier-filed patent applications), the relevant date(s) for determining such prior art, as well as any limitations, exclusions, or special rules applicable to such prior art. : Secret prior art is understood to mean information contained in patent applications or utility model applications submitted to the national Office before the priority date. As an exception to be taken into account, patent applications classified after 18 months from the filing date of the patent application or, in the case of a priority claim, the priority date, provided that they have not been withdrawn, deemed to be withdrawn or rejected before the due date.

5. Please provide any additional information that may be relevant to the understanding or application of prior art under the applicable law, including where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Procedural instructions, 2020 (available only in Estonian)

Please upload any document that may be relevant to the understanding or application of prior art under the applicable law.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

B. Novelty

1. How is the requirement of novelty defined under the applicable national or regional law?

Patents Act
§ 8 (2) An invention is considered to be new if it does not form part of the state of the art.

3. Does the applicable law apply an absolute novelty requirement, or does it provide for any limitations or qualifications to novelty (for example, relative novelty or other restricted approaches), apart from any grace period mechanisms addressed separately in this survey?

If a technical solution (analogue) is found during the search that is identical to the invention specified in the independent claim, this means that the invention defined by the
independent claim lacks novelty. In case of non-compliance with the novelty criterion defined by the original independent claim, it may be possible that the invention is still new with the features set out in the dependent claims when the invention is specified (limited, the scope of protection is restricted)

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The Patent Office's opinion on the lack of novelty does not lead to a refusal to register the utility model. This explanaition is given in Procedural instructions, 2020 (available only in Estonian)

C. Inventive Step

1. How is the criterion of inventive step or non-obviousness defined under the applicable national or regional law?

Patents Act
§ 8 (4) An invention is considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

2. For the purposes of assessing inventive step or non-obviousness under the applicable law, what is the relevant date and what prior art or information is taken into account?

The same as for novelty

3. What is the standard applied under the applicable law to determine whether an invention involves an inventive step or is non-obvious, in particular as reflected in the concept of the "person skilled in the art", focusing on how the standard is understood or applied, rather than its formal legal definition?

There is no clear definition at the regulatory level. The generally accepted understanding is that: the term "person of skill in the art" refers to a hypothetical person in patent law who is used as a criterion for assessing the inventive step of an invention and the adequacy of the description.
This is not a specific expert, but a legal standard that helps determine whether an invention is sufficiently novel and understandable.
This person is not a leading scientist, but a specialist in their field with an average level of general knowledge.

4. Are there any specific rules, limitations, or contextual factors that apply to the assessment of inventive step or non-obviousness under the applicable law?

No

Please indicate, where relevant, whether such rules or factors include geographic or territorial considerations affecting the relevance of prior art (for example, distinctions between domestic and foreign disclosures, uses, or publications, or territorial conditions applicable to particular categories of prior art) or any other particular considerations relevant to the assessment.

***Responses should be limited to such contextual factors asthey relate to the assessment of inventive step or non-obviousness, without restating general rules on what constitutes prior art.*:**

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

A utility model is considered to possess an inventive step when, due to its difference from the prior art, its useful technical characteristics or other useful properties become obvious when using the invention (Utility Models Act (§ 7)).
A utility model has an inventive step whenever the applicant has credibly explained this in the description of the invention and it is not in obvious conflict with the laws of nature.

D. Grace Period Mechanisms and Pre-Filing Disclosures

1. Does the applicable law provide for any mechanism under which certain disclosures made before the filing or priority date do not prejudice the patentability of an invention, in particular with respect to novelty and/or the legal effect on prior art?

Yes

If yes, please identify the relevant legal provisions (in primary and/or secondary legislation) and describe their operation.: Patents Act § 8 (3) In determining the state of the art, any information disclosing the subject matter of an invention is not taken into consideration, provided that a corresponding request is submitted, if such information is disclosed by a person who is entitled to the patent or another person with the knowledge of the said person within twelve months before the filing date of the first patent application or registration application of a utility model containing the invention in the Republic of Estonia or abroad.

2. What is the duration of the mechanism referred to in question 1, during which the covered disclosures do not prejudice the patentability of the invention?

12 months from the filing date or priority date. This could be any publicly available information such as databases, publications, the Internet, exhibitions or any other public events.

3. Where such a mechanism exists, which categories of disclosures are covered by it?

The Office accepts the fact of disclosure of the invention if it has been made by the applicant or by another person with the applicant's permission. The most common applications of this legal provision are the disclosure of the nature of the invention t in scientific articles or at officially recognized exhibitions.

4. Are there any formalities or procedural requirements that must be fulfilled in order to rely on the mechanism identified in question 1?

Yes

Please describe any such requirements, where applicable, including, for example, the need to file statements, declarations or notices, to submit certificates or other supporting evidence, or to comply with any timing or notification requirements or any information relating to the burden of proof. **:** The request shall be filed together with the patent application or not later than two months before the publication of the patent application. If another person acquired the information unlawfully or the information was published unlawfully or without the knowledge of the person who has the right to apply for the patent, the request may be filed in the course of examination of the patent application or in case the patent is contested. The applicant must indicate the date of disclosure and as much precise information as possible about the source or event of disclosure, for example, the date the invention was displayed as an exhibit at an exhibition and the name and location of the exhibition.

5. Does the applicable law provide for prior user rights or other protections for third parties who may be affected by an invention that has benefited from a graced pre-filing disclosure?

Yes

If yes, identify the relevant legal provisions (including any provisions in primary and/or secondary legislation), and describe the conditions under which such rights or protections arise (for example, good-faith use of the invention prior to the filing or priority date), as well as how such rights or protections operate. **:** After the publication of a patent application, when the patent application becomes publicly available, third parties may, on their own initiative, send letters to the Patent Office containing comments and opinions on the patent application. If the letter concerns a dispute over authorship or the right to apply, the sender of the letter will be informed that an application must be submitted to the Board of Appeal in accordance with the prescribed procedure to resolve these issues. Patents Act (§ 23, § 48, § 49, § 50)

6. Please provide any additional information that may be relevant, including, where applicable, any guidance (e.g. patent office manual/guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Procedural instructions (available only in Estonian)

Please upload any document that may be relevant to grace period mechanisms and/or pre-filing disclosures.

7. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

In the case of a utility model, the request must be submitted in the application for registration of utility model. The request will be taken into account when performing a prior art search. In the course of further proceedings, the request may be submitted only if another person acquired the information unlawfully or the information was published unlawfully or without the knowledge of the person entitled to register the utility model (Utility Models Act, § 7(2)).

Final review before submission

Confirmation of submission

I am aware that by clicking "Submit" below, my responses will be sent to the SCP Secretariat.