



Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets

# Patent Litigation in Europe

An overview of national law and practice in the  
EPC contracting states

3rd edition  
2013

European Patent Academy

## Acknowledgments

This study has been compiled by the European Patent Academy with the kind support of the respective national patent offices and members of the judiciary. It provides an overview of patent litigation practice in the member states of the European Patent Organisation.

The newly-added section on the Unified Patent Court has been drafted with the kind support of the Principal Directorate Patent Law and Multilateral Affairs (PD 5.2).

Although the study has been prepared with great care, it cannot be guaranteed that the information it contains is always accurate and up to date. The content was last updated on 31 May 2013.

The information is not meant to be a comprehensive study or to provide legal advice. Further information may be obtained from the respective national patent offices. For further information about the European Patent Academy, go to [www.epo.org/academy](http://www.epo.org/academy).

In the sections devoted to each member state, the national patent office is referred to simply as “the Patent Office”, regardless of its official title.

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## Contents

Foreword	4	IT	Italy	59	
AL	Albania	7	LI	Liechtenstein	63
AT	Austria	9	LT	Lithuania	65
BE	Belgium	13	LU	Luxembourg	67
BG	Bulgaria	15	LV	Latvia	69
CH	Switzerland	17	MC	Monaco	73
CY	Cyprus	21	MK	Former Yugoslav Republic of Macedonia	75
CZ	Czech Republic	23	MT	Malta	77
DE	Germany	25	NL	The Netherlands	79
DK	Denmark	29	NO	Norway	83
EE	Estonia	31	PL	Poland	87
ES	Spain	33	PT	Portugal	89
FI	Finland	37	RO	Romania	93
FR	France	39	RS	Serbia	95
GB	United Kingdom	41	SE	Sweden	97
GR	Greece	45	SI	Slovenia	99
HR	Croatia	47	SK	Slovakia	101
HU	Hungary	49	SM	San Marino	103
IE	Ireland	53	TR	Turkey	105
IS	Iceland	55	UPC	The Unified Patent Court	109



## Foreword

The success story of the single European patent began in October 1973 when seven countries signed the European Patent Convention (EPC) in Munich, providing the legal framework for a single, harmonised patent granting procedure in Europe.

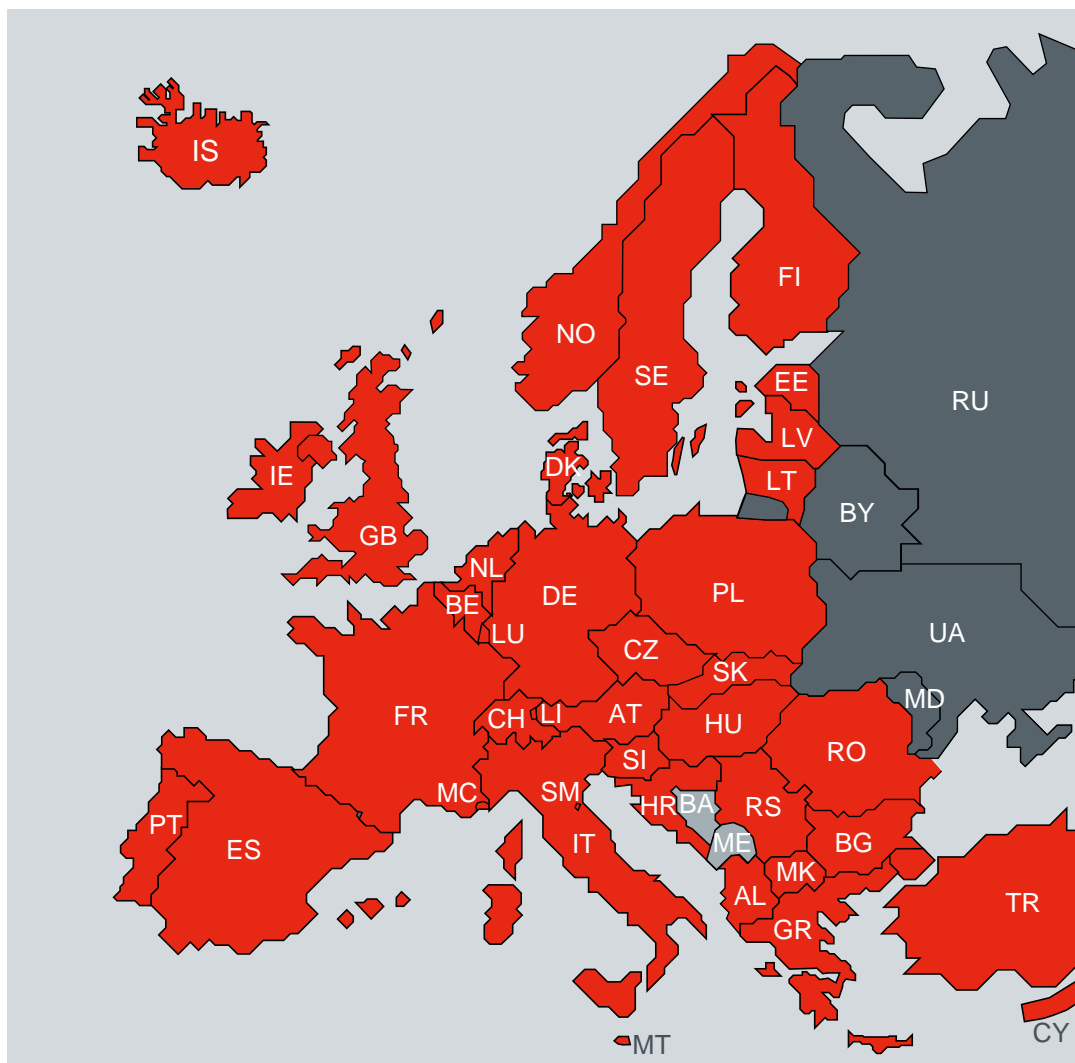
Forty years later, this milestone was crowned by the entry into force of the EU Regulations on unitary patent protection, as well as the signature of the Unified Patent Court Agreement, by 25 EU Member States.

The Academy of the European Patent Organisation, better known as the European Patent Academy, has been active for many years in supporting the harmonisation of patent enforcement and litigation practice throughout Europe by offering training and exchange platforms for key users of the patent system.

In this framework the Judicial Training Unit of the Academy, in partnership with the national patent offices of the 38 EPC contracting states has compiled the study “Patent Litigation in Europe”.

The third edition provides a valuable overview of the litigation practice with regard to patents in each country. Furthermore, it includes information on the current status of the future Unified Patent Court.

Raimund Lutz  
Vice-President  
DG 5 Legal/International Affairs



EPC Contracting States (1 October 2013)



## Albania

### a. Albanian Patents and Trademarks Office

#### Opposition

Post-grant opposition is available. Any person may file notice of opposition with the appeal board within nine months from the date of publication of the grant of a patent (Art. 33(1) PA). A copy of the opposition is sent to the owner of the patent, who may submit written observations within three months from the date of receipt of the notification (Art. 33(3) PA). Both parties have the right to participate in the opposition proceedings, to submit essential materials and to provide oral explanations in support of the notice of opposition (Art. 33(4) PA). The appeal board decides whether to revoke the patent in whole or in part or reject the opposition (Art. 33(5) PA).

#### Appeal

A Patent Office decision rejecting a patent application may be appealed to the appeal board within three months from the date of receipt of notification, subject to payment of a fee. The appeal board's decision may be appealed to the court within a period of 30 days from the date of receipt of notification (Art. 28(3) PA). The parties may appeal an appeal board decision revoking a patent or rejecting an opposition to the court within 30 days from the date of receipt of the decision (Art. 33(6) PA).

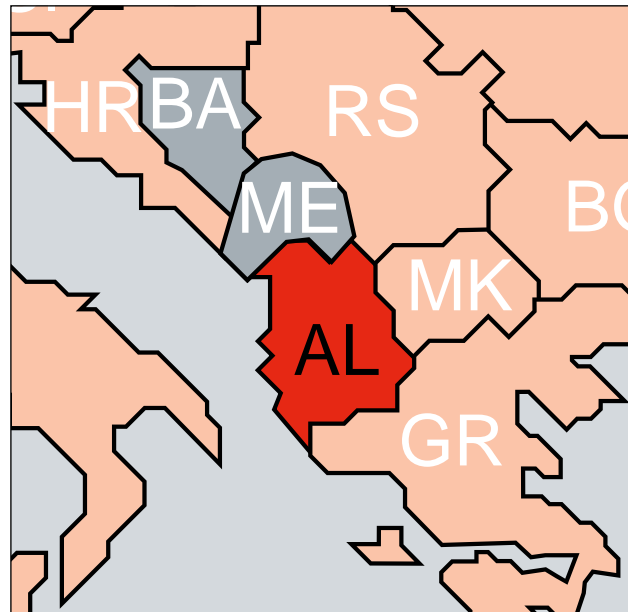
### b. Civil procedure

#### Infringement

The patent proprietor or applicant may institute legal proceedings against any person who has infringed, is infringing or threatens to infringe the patent or patent application (Art. 53(1) PA).

#### Declaration of non-infringement

Any interested party may bring an action before the court against the owner of the patent in order to prove that a particular act does not constitute infringement (Art. 54(1) PA). The action may be brought jointly with an action for revocation (Art. 54(4) PA).



#### Revocation

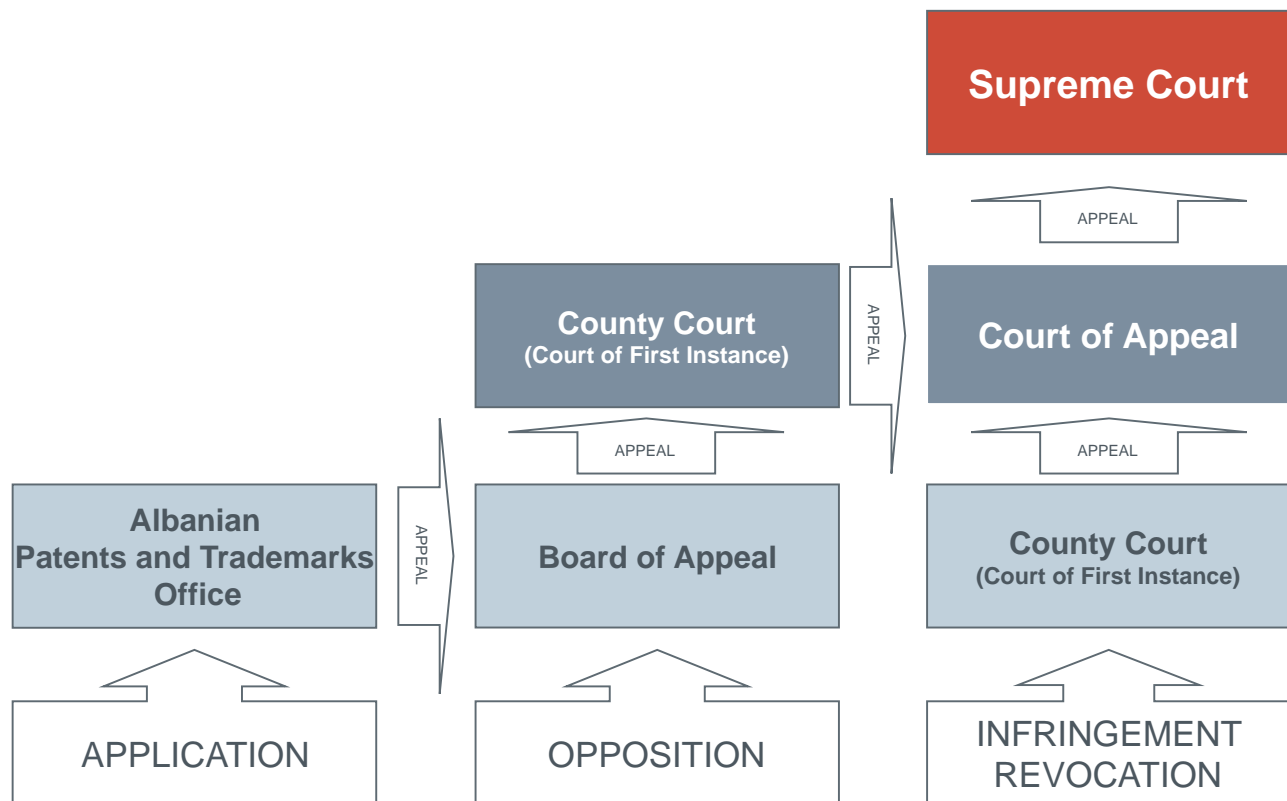
Any person who considers that a granted patent does not fulfil the criteria may file an action for revocation in the court against the proprietor of the patent. Where the validity of a patent has been contested, the court may revoke or limit the patent (Art. 73(1) PA). The court may request the owner of the patent to provide references to any prior art or other evidence relied on (Art. 73(3) PA). Decisions of the court are recorded in the patent register (Art. 74(3) PA).

#### Compulsory licence

May be granted by the Patent Office in cases of non-working or insufficiently working patented inventions (Art. 50(1) PA), and is subject to the payment of remuneration to the owner of the patent (Art. 50(8) PA). A non-voluntary licence is revoked if the circumstances which led to its granting cease to exist (Art. 50(7) PA).

Bibliography

- Law No. 9947 of 7 July 2008 on Industrial Property [cited as: PA]
- "Patents throughout the World", 2009 Thomson Reuters/West, Chapter 5 on Albania, 12/2004





# Austria

## a. Austrian Patent Office

### Opposition

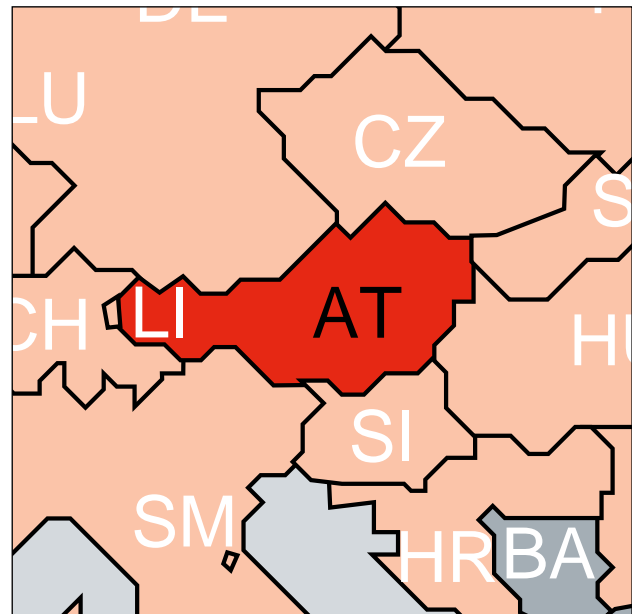
Anyone may file a notice of opposition within four months from the date on which mention of grant is published (Section 102 PA).

- The decision is taken by the “Senate” (Head of Technical Department, one examiner and one further member who, depending on the case, has to be technically or legally qualified (Section 62(3), (4) PA)).
- If the opposition is withdrawn, the proceedings are closed.
- Furthermore, after publication of the application anyone can make observations on the application (Section 101b PA).

### Appeal

The appeal must contain a formal request and be substantiated. Every decision of a technical or legal department can be contested by an appeal. There are *ex parte* (e.g. negative decision on a patent application) and *inter partes* proceedings (e.g. appeal against an opposition procedure). Appeals must be lodged within two months of notification of the decision which is challenged; the opposing party will be notified and will have the opportunity to submit objections (Section 71 PA).

- Preliminary decisions (Section 71(4), (5) PA): the department which issued the decision at first instance can deal with the appeal by preliminary decision within two months of the appeal being lodged. It may refuse the appeal, set the original decision aside, or amend it. However, after notification of the preliminary decision, any party may request that the appeal be heard by the Board of Appeal. In such a case the preliminary decision will then be set aside. In the absence of a request, the appeal is considered to be settled.
- Board of Appeal: appeal from the decision of the Technical and Legal Department (Section 70(1) PA). New facts and evidence may only be introduced to support or refute facts and evidence submitted at first instance (prohibition of amendment - Section 71(6) PA). A case of serious procedural defect will be referred back to the first instance. Members of the Patent Office who took part in previous decisions during the grant procedure are excluded from proceedings before the Board of Appeal.



AT

- Supreme Patent and Trademark Chamber (second instance): Further ordinary appellate body for the decisions of the Board of Appeal (Sections 70(2), 74(1), 145a PA) and a first-instance appellate body for the decisions of the Nullity Department (Sections 70(3), 74(1), 138 PA). Appeals have suspensive effect. The Chamber is composed of a chairman and a deputy chairman and of further members who have to be legally and technically qualified (Section 74 PA). The Chamber, with the chairman and/or deputy chairman presiding, deliberates and makes decisions in senates, each consisting of five members, i.e. the person(s) presiding, two legally qualified persons and two technically qualified persons. The Chamber does not consider any new evidence in the case.

### Restoration

Available in case of failure to observe time limits (Section 129 PA – subject to exceptions).

### Nullity

The Nullity Department functions as the first instance. It is composed of two legally and three technically qualified members of the Patent Office (Section 63 PA).

- The proceedings can be continued if the action is withdrawn (Section 112(1) PA).
- Decisions have retroactive effect. Partial nullification is available.
- Any party which considers itself adversely affected by a decision of the Nullity Department may appeal directly to the Supreme Patent and Trademark Chamber, within two months from the decision (Sections 70, 74, 138 PA).

### Declaratory decisions (Section 163 PA)

Any person who industrially produces, places on the market, offers for sale or uses an article, industrially applies a process or intends to take such measures may apply to the Nullity Department for a declaratory decision against the owner of a patent or its exclusive licensee, to the effect that the subject-matter of the process or product marketed or to be marketed is neither partially nor wholly covered by the patent.

- The owner of a patent or its exclusive licence may apply to the Nullity Department for a declaratory decision against any person who industrially produces, places on the market, offers for sale or uses an article, industrially applies a process or intends to take such measures, to the effect that the subject-matter of the process or product marketed or to be marketed is partially or wholly covered by the patent.

### Compulsory licence

May be issued by the Nullity Department in the case of a dependent patent, non-working, and public interest (Section 36 PA). Under certain circumstances a patent may be revoked if the grant of a compulsory licence for non-working is not sufficient (Section 47 PA).

### b. Civil procedure

#### Infringement

Infringement disputes are dealt with before the Commercial Court of Vienna. Any person who has suffered infringement of one of the rights belonging to him under a patent or who fears that such infringement might take place may bring an action (Section 147 PA) (registered and non-registered patent owner, exclusive licensee).

Claim is subject to civil law; however, criminal proceedings (Section 159 PA) before the Regional Court for Criminal Matters in Vienna may also be initiated in the case of wilful infringement.

- Invalidity of a patent may be used as a defence, which will be considered by the court as a preliminary issue (Section 156 PA). The court will suspend proceedings if it thinks that nullity is probable. Optionally, it may request a report from the Patent Office on whether nullity is likely (Section 156(3) PA). Subsequently, the defendant has one month to apply for nullification of the patent at the Patent Office. After one month the claimant may re-establish the infringement proceedings and the court has to take the decision irrespective of the question of validity.

- If the Patent Office or the Supreme Patent and Trademark Chamber has taken a decision on the validity or effectiveness of a patent different from that of the court in infringement litigation, an action for a re-trial (Section 530(1) of the Code of Civil Procedure) may be based thereon (Section 156(6) PA).
- Remedies: preliminary injunction, destruction of infringing products, publication of the decision, compensation, damages (Sections 148-152 PA).

Appeal: The decision at first instance may be followed by the usual stages of appeal available in civil cases. Appeal on points of law and fact is available from the decision of the Commercial Court of Vienna at first instance. Incomplete assessment will be referred back to the first instance for completion of the procedure for the taking of evidence.

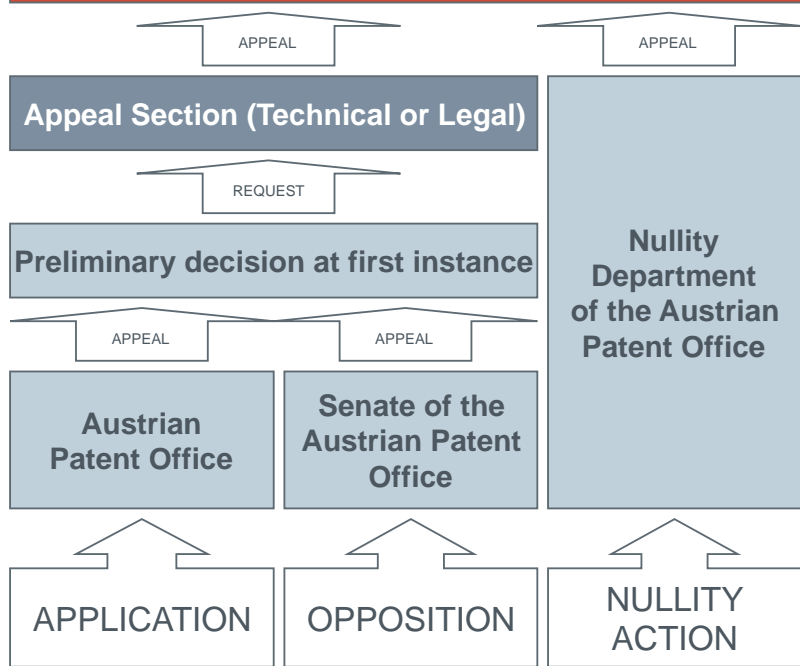
### c. Other

As of 2014 basic changes will enter into force concerning jurisdiction on industrial property. Details were not definite at the time of going to press.

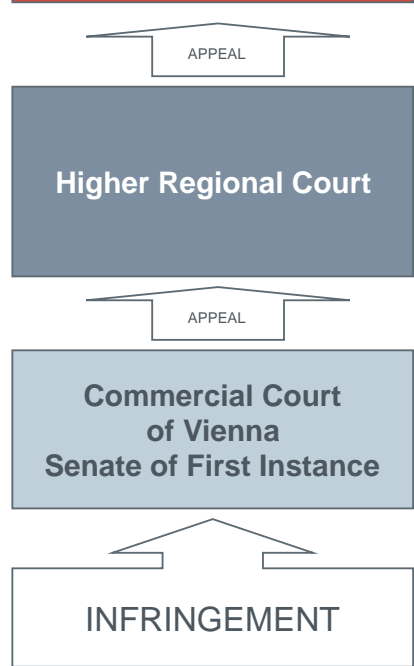
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- Patent Act - Patentgesetz 1970, BGBl 1970/259 as last amended by I 2009/135 - [cited as: PA]; translation provided by WIPO
- “Presentation of the national proceedings with regard to the validity and enforcement of patents”, Austrian Patent Office, EUROTAB 3/2007
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 14 on Austria, 5/2005
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Austria, No. 110, March 2007

# Supreme Patent and Trademark Chamber



# Supreme Court



AT



# Belgium

## a. Belgian Office for Intellectual Property

### Opposition

No pre- or post-grant opposition procedure is available. The findings of the search report and the written opinion delivered by the European Patent Office have no formal influence on the grant procedure. It is up to the applicant to decide, at his own risk, on the basis of the search report and the written opinion, if he still wants his patent granted.

### Appeal

No possibility of appeal.

### Compulsory licence

May be granted in cases of non-working and dependent patents (Art. 31 PA). The request has to be filed with the Minister responsible for intellectual property, who will decide on it in co-operation with the Compulsory Licence Commission (Art. 33 PA). The parties should in principle decide on their own on the conditions of the licence. If no agreement is reached, the court will decide (Art. 33, 34 PA). A compulsory licence may also be granted in case of public health interests (Art. 31bis PA). The request has to be filed with the Minister responsible for intellectual property, who will decide on it after consulting a bioethics committee and hearing the title holder. The Minister also makes a proposal concerning the conditions of the licence. The decision is taken by royal decree after consultation of the Council of Ministers on the basis of the proposal of the competent Minister.

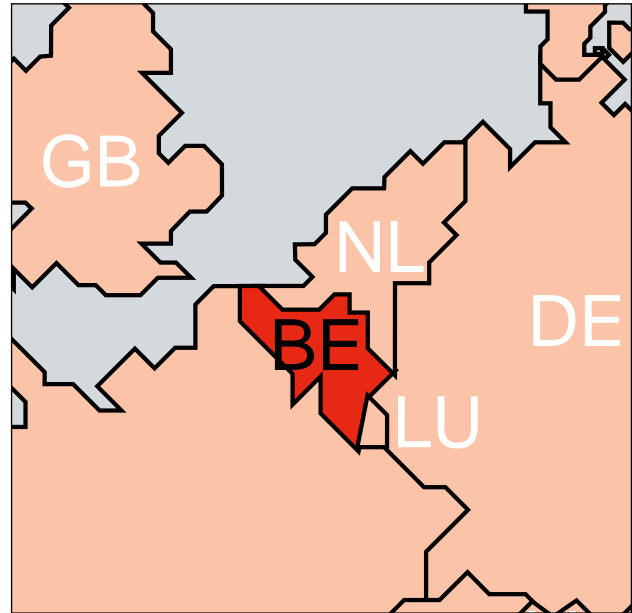
### Restoration

Possible in limited cases where a patent has lapsed because of non-payment of renewal fees for legitimate reasons (Art. 41 PA).

## b. Civil procedure

### Claim for transfer

Where an application has been made for an invention taken from an inventor unlawfully or in violation of a legal or contractual obligation, the injured party may claim before the court the transfer of the application or the granted patent (Art. 9 PA).



BE

### Infringement

Civil action can be brought by the owner or usufructuary of a patent (by the compulsory licensee if the owner does not bring an action) (Art. 52(2) PA).

- At first instance five commercial courts have exclusive jurisdiction in patent matters: Tribunaux de commerce/Rechtbanken van koophandel established at the seat of the five Courts of Appeal (Antwerp, Brussels, Ghent, Liege and Mons). If only an injunction is demanded, the plaintiff has the choice to introduce the case at first instance (i) before the President of the Tribunal de commerce/Rechtbank van koophandel (dealt with “as in summary proceedings”) or (ii) before a chamber of that court, where the tribunal is composed of one legally qualified judge and two “juges consulaires”. If damages are demanded (either separately from the injunction or not), the plaintiff has to introduce the case at first instance before a chamber of the court. In appeal proceedings the court is composed of one judge or three legally qualified judges.
- Invalidity can be used as a defence or counterclaim. Nevertheless it is possible for an action for infringement and a related action on validity to be separately introduced before two courts. In such a case, one of the parties can ask the second judge to join the cases in the hands of the first judge (with a so-called “exception of incompetence”). When the actions for infringement and for validity are pending before the same judge, he can take the initiative to join the cases (Article 856 Judicial Code).
- Infringement proceedings become barred five years after the infringement was committed (Art. 54 PA).
- Remedies: injunction, compensation, damages, publication of decisions and assignment of benefits (Art. 52(4), 53 PA).

- Appeal: The parties in a trial always have the right to appeal the decision of the court of first instance. The appeal has to be made within one month from service of the judgment (Article 1051 Judicial Code). The Court of Appeal will conduct a full rehearing of the matter (limited to the points which have been appealed by the opposing parties). The defendant on appeal has the right to file a so-called “incidental appeal” with respect to those elements which have not been appealed by the claimant (Article 1054 Judicial Code).

Criminal sanctions are also available (Article 8 of the Law of 15 May 2007). Criminal sanctions may include custodial sentences and/or monetary fines.

### Revocation

Patents can be revoked by the five commercial courts (Tribunaux de Commerce/Rechtbanken van koophandel). Revocation is retroactive (Art. 50(1) PA). Partial revocation is possible (Art. 49(2) PA).

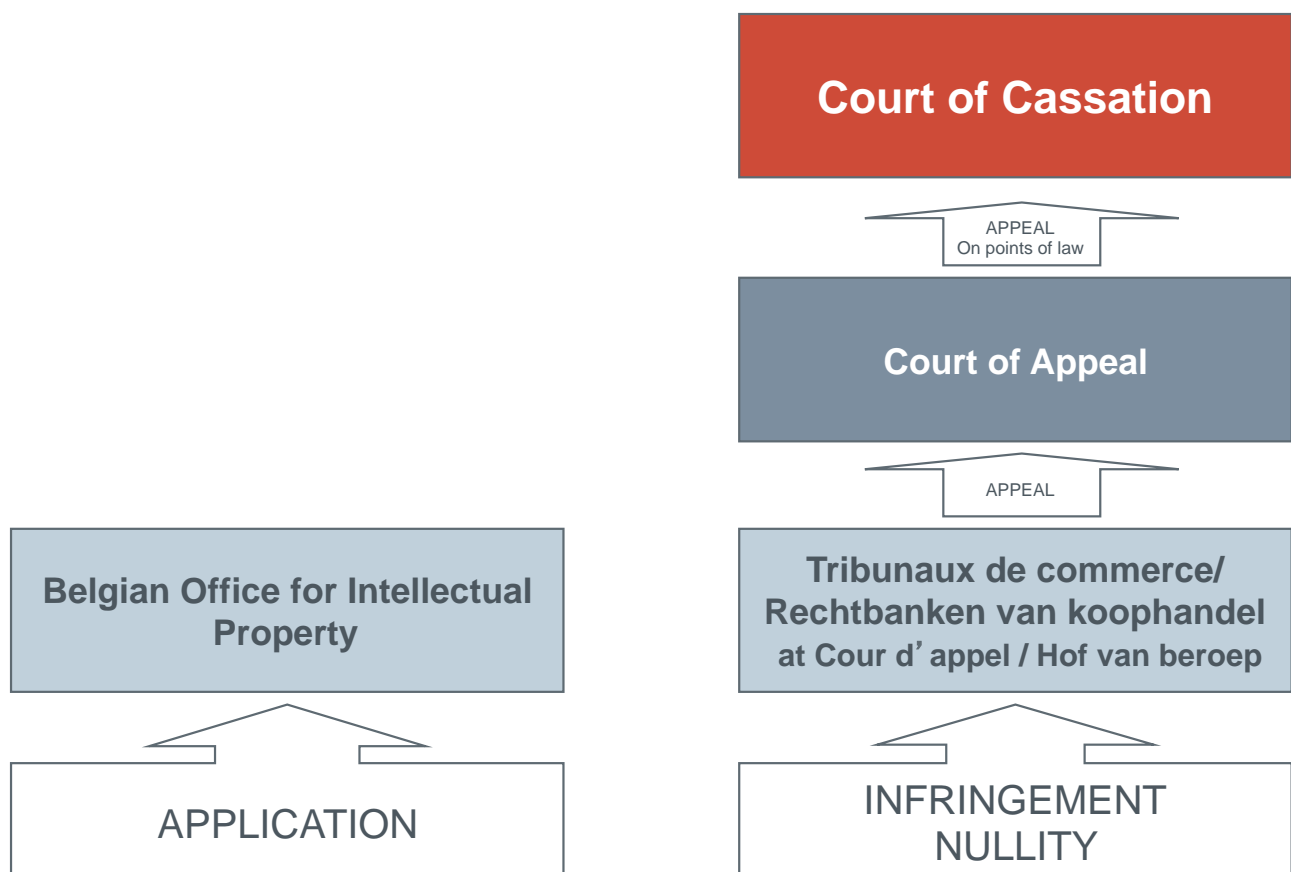
- Appeal: Revocation decisions may be appealed before a Court of Appeal. An appeal against the revocation of a patent does not have suspensive effect.
- Annulment: After the appeal procedure mentioned in the second paragraph, an appeal before the “court of cassation” can be lodged based only on “points of law”. An appeal before the court of cassation against revocation of the patent has suspensive effect (Art. 51(2) PA).

### c. Other

Arbitration is available except in litigation concerning compulsory licences and forfeitures.

### Bibliography

- “Lois du 28 mars 1984 sur les brevets d’invention” - Patent Law - as last amended on 28 January 1997 [cited as: PA]; translation provided by WIPO
- Judicial Code (10 October 1967): English translation not available
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 21 on Belgium, 12/2002



# Bulgaria

## a. Patent Office of the Republic of Bulgaria

### Opposition

No pre- or post-grant opposition procedure is available.

- However, within three months following publication of the application, any persons other than parties to the application proceedings may file written substantiated objections as to the patentability of the subject-matter of the application (Art. 46(d) PA).

### Appeal

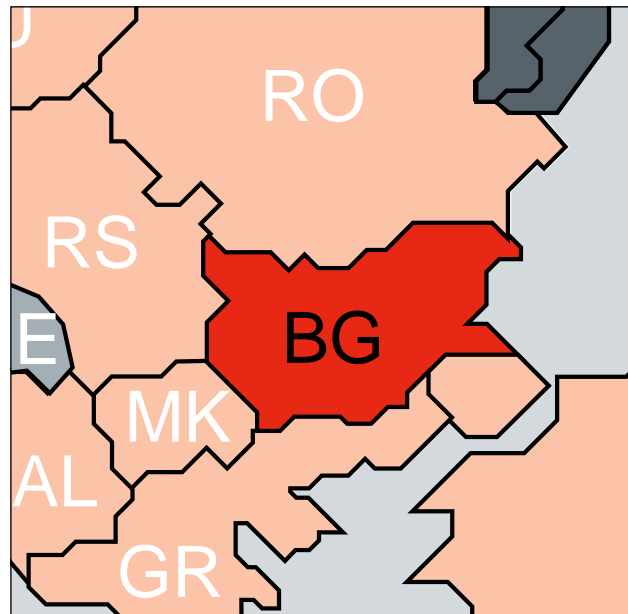
The decision of the Examination Department to refuse to grant a patent and to suspend the patent application procedure may be appealed, within three months from the date of receiving the decision, before a specialised (three-member) board of the Disputes Department appointed ad hoc by the President of the Patent Office (Art. 55(1), 57(2) PA). The Disputes Department begins proceedings within one month of receipt of the appeal (Art. 58 PA). The application may be referred for renewed consideration (Art. 58(3) PA) – the re-examined decision may be subject to further appeal to the Disputes Department (Art. 58(4) PA). The final decisions of the Disputes Department must be confirmed by the President (Art. 58(6) PA).

### Nullity

The Disputes Department also considers requests for invalidation of a granted patent, these being heard by a specialised (five-member) board appointed ad hoc by the President of the Patent Office (Art. 26(3), 55(2), 57 PA). The Disputes Department begins proceedings within one month of receipt of the request for invalidation. Anyone can file a request for invalidation of a granted patent; there is no time limit for this. The interested parties may participate in the proceedings. Written and oral evidence is admissible. The Disputes Department sends a copy of the request to the patent owner or to the parties concerned and gives them a three-month time limit to respond (Art. 58(2) PA). The decisions of the Disputes Department must be confirmed by the President. Partial invalidation is possible (Art. 26(5) PA). Invalidation has retroactive effect (Art. 26(6) PA). If the action is withdrawn, proceedings do not continue.

### Review by court

Any party adversely affected by a decision of the Disputes Department may, within three months following receipt of the decision, bring an appeal before the Sofia Administrative Court (Art. 59 PA). Further appeal is possible to the Supreme Administrative Court within fourteen days after the date of receipt of the lower court's decision.



BG

### Compulsory licence

May be granted by the Patent Office in cases of non-working, dependent patents and public interest (Art. 32, 55(2) No.3 PA). Disputes concerning the amount of remuneration for the grant of a compulsory licence are settled by the Sofia City Court (Art. 66 PA).

### Restoration

By the Patent Office in case of non-payment of a renewal fee (Art. 26(2) PA).

## b. Civil procedure

### Infringement

The patent owner and the holder of an exclusive licence may institute patent infringement proceedings at the Sofia City Court, as may the holder of a compulsory licence if the patent owner does not exercise his own right to institute infringement proceedings within six months of receipt of a written invitation to do so from the licensee. Any licensee may join patent infringement proceedings instituted by the patent owner, and the same applies to the patent owner when proceedings have been instituted by the licensee (Art. 27 PA).

- Where the defendant in an infringement action has filed a request for nullity of the patent with the Patent Office, the court suspends proceedings until a final decision is taken on the request (by the Patent Office or, if appealed, by the courts) (Art. 64(2) PA).
- Where the action is instituted by the applicant prior to the grant of a patent, the proceedings are suspended until a decision is taken by the Patent Office (Art. 64(3) PA).
- In both cases the Patent Office is required to reach a decision within one year following the date of notification of the suspension of court proceedings (Art. 64(4) PA).

- Opinions from experts are possible, but they are not binding on the court.
- Remedies: preliminary injunction, damages, destruction of infringing products, declaration that an act has infringing character (Art. 28 PA).
- Administrative penal provisions are available with regard to a person who publishes the essential features of a secret patent application under Art. 24 PA or files an application abroad contrary to the patent secrecy provisions of Art. 25 PA, and also with regard to a person who marks a product as protected by a patent without identifying the patent upon request as referred to in Art. 28a(5).

**Declaration of non-infringement**

Not available.

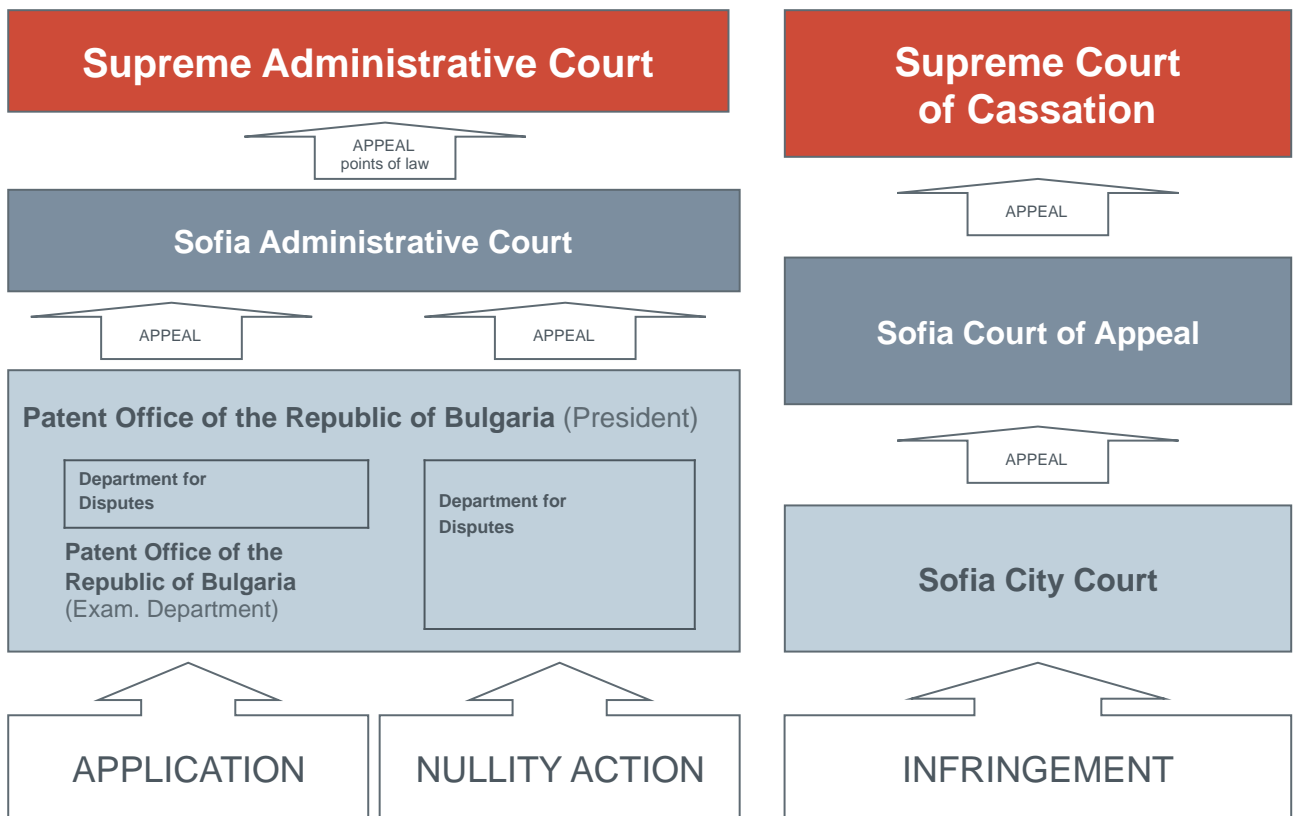
**c. Other**

**Arbitration and mediation**

According to the Civil Procedure Code, in court proceedings the parties to a property dispute may agree that it may be resolved by a court of arbitration. There is also a Mediation Centre within the Bulgarian Chamber of Commerce and Industry. The law stipulates mediation as an alternative form of settlement for legal and non-legal disputes. Mediation will not be an option if law or other legislative acts stipulate a different way of settlement.

**Bibliography**

- Law on Patents and Utility Model Registration (title amended, State Gazette No. 64/2006; in force as from 9 November 2006 – as amended; promulgated in State Gazette No. 27/2 April 1993; supplemented, No. 83/1 October 1996; amended, No.11/29 January 1998; amended, No. 81/14 September 1999; amended, No. 45/30 April 2002; amended, No.66/9 July 2002; supplemented, No. 17/21 February 2003; amended, No. 30/11 April 2006; amended, No.64/8 August 2006; amended, No. 31/13 April 2007; amended No. 59/20 July 2007) [cited as: PA]; translation provided by BPO
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 30 on Bulgaria, 4/2004
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# Switzerland

## a. Swiss Federal Institute of Intellectual Property

The Swiss Patent Office is the competent authority for patent applications in Switzerland and Liechtenstein. Switzerland and Liechtenstein have the same patent regulations based on the Patent Treaty (Treaty between the Swiss Confederation and the Principality of Liechtenstein on Patent Protection of 22 December 1978 – OJ EPO 1980, 407). A Swiss patent is valid in Liechtenstein, and a Liechtenstein patent is equally valid in Switzerland. The two countries form a unified territory of patent protection.

### Opposition

Any person may, within nine months of publication of the entry in the Patent Register, give notice of opposition to the grant of the patent (Art. 59c PatA). Opposition may be based only on the grounds that the invention is not patentable or that it is excluded from patenting (Art. 59c PatA).

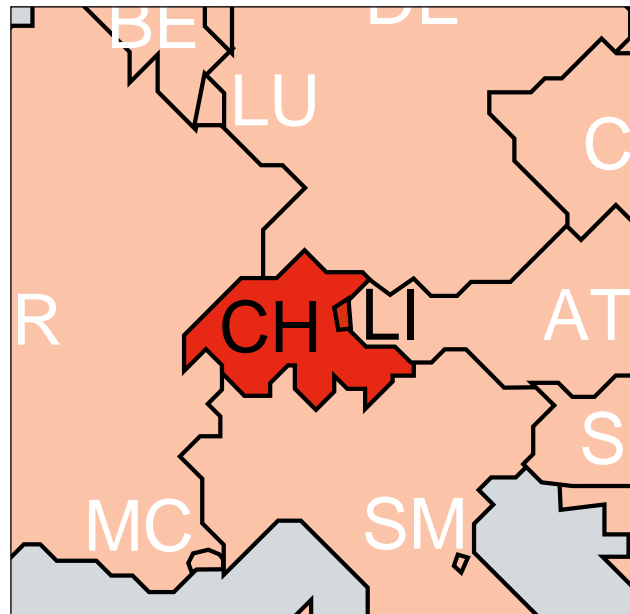
### Further processing/re-establishment of rights

These are available in case of failure to observe time limits. A request for further processing (Art. 46a PatA) has to be made to the Patent Office within two months of receiving notice from the Office of failure to comply with time limits laid down by law, but not later than six months from expiry of the said time limit. In the case of re-establishment of rights, the patent applicant or proprietor must provide prima facie evidence of having been prevented from observing a time limit through no fault on his part. A request has to be made to the Patent Office within two months of the removal of the cause of non-compliance with the time limit, but not later than 12 months after expiry of the unobserved time limit (Art. 47 PatA). In both cases, the omitted act must be carried out within these time limits.

### Appeal

The decisions of examiners, legal services and opposition divisions may be appealed to the Federal Administrative Court. An appeal may be brought by the person who is concerned as a party to the proceedings that resulted in the decision appealed against, or by the person whom the decision appealed against has excluded from the procedure. In opposition proceedings, the opposing party may appeal only insofar as he has been admitted as a party to the opposition proceedings (Art. 59c(3) PatA).

- Further appeal to the Swiss Federal Court is available.



CH

## b. Civil procedure

In patent matters only, the Principality of Liechtenstein has a common court structure with Switzerland. The Court of Second Instance (“Obergericht”) has competence for patent issues in Liechtenstein at first instance. Appeals against its judgments in patent matters can be filed with the Swiss Federal Supreme Court in Lausanne.

On 1 January 2012, the new Swiss Federal Patent Court Act entered into force and created a specialised court in Switzerland which is responsible for resolving disputes regarding patent law infringements and legalities. Instead of the 26 cantonal civil courts, the Swiss Federal Patent Court is now exclusively competent for all patent validity and infringement disputes in Switzerland. However, the 26 cantonal courts still have some remaining competence in other civil patent matters, either alternatively to or shared with the new Patent Court.

As a lower court of the Swiss Federal Supreme Court, the Swiss Federal Patent Court ensures the necessary specialist knowledge and effective legal protection for inventions. The court comprises both legally and technically qualified judges. The applicable procedural law essentially follows the Swiss Civil Procedure Code. Special provisions are made for the special conditions of patent law procedure.

### Infringement

Action may be taken by the patentee or exclusive licensee under civil or penal law against a person who uses the patented invention unlawfully (Art. 66 PatA).

- Competence: the Federal Patent Court has exclusive nationwide jurisdiction over infringement disputes and actions for issuing a licence in respect of patents (Art. 26(1) PatCA).
- Where a preliminary question or plea on the validity of the patent in a civil litigation case is put before a cantonal civil court, proceedings before the cantonal court will be suspended. The judge will set the party who made the claim a reasonable deadline for filing the validity action before the Swiss Federal Patent Court. The cantonal court stays the proceedings until a final and absolute decision has been rendered on the action (Art. 26(3) PatCA). Where the defendant party files a counterclaim for nullity of a patent, the cantonal court refers both actions to the Federal Patent Court (Art. 26(4) PatCA).
- Remedies: injunction, suspension, seizure, confiscation or destruction of products manufactured unlawfully; additionally, publication of the judgment can be ordered; the infringer may also be liable for damages (Art. 69-73 PatA).
- Criminal proceedings: upon request of the injured party, additional criminal proceedings may be instituted at the criminal court against a party who wilfully commits an infringement (Art. 81 PatA). If the accused party claims the nullity of a patent, the court may grant him a sufficient period to bring an action for nullity, with a warning of the consequences of his failure to do so (Art. 86 PatA).

### Declaration of non-infringement

Any person demonstrating a legitimate interest may request a declaratory judgment as to the infringing character of one or more acts (Art. 74 No. 3 PatA).

### Nullity/revocation

Any person having a legitimate interest may claim the nullity of a patent before the Swiss Federal Patent Court (Art. 26 PatA; Art. 26(1) PatCA).

- Partial nullification is available (Art. 27 PatA).
- If the grant of licences does not suffice to meet the demand of the Swiss market, after a period of two years from the grant of the first licence any person demonstrating an interest may take action before the Swiss Federal Patent Court for cancellation of the patent due to non-working (Art. 38 PatA).

### Compulsory licence

Any interested party may apply in cases of non-working, dependent patents and public interest (Art. 36-40e PatA).

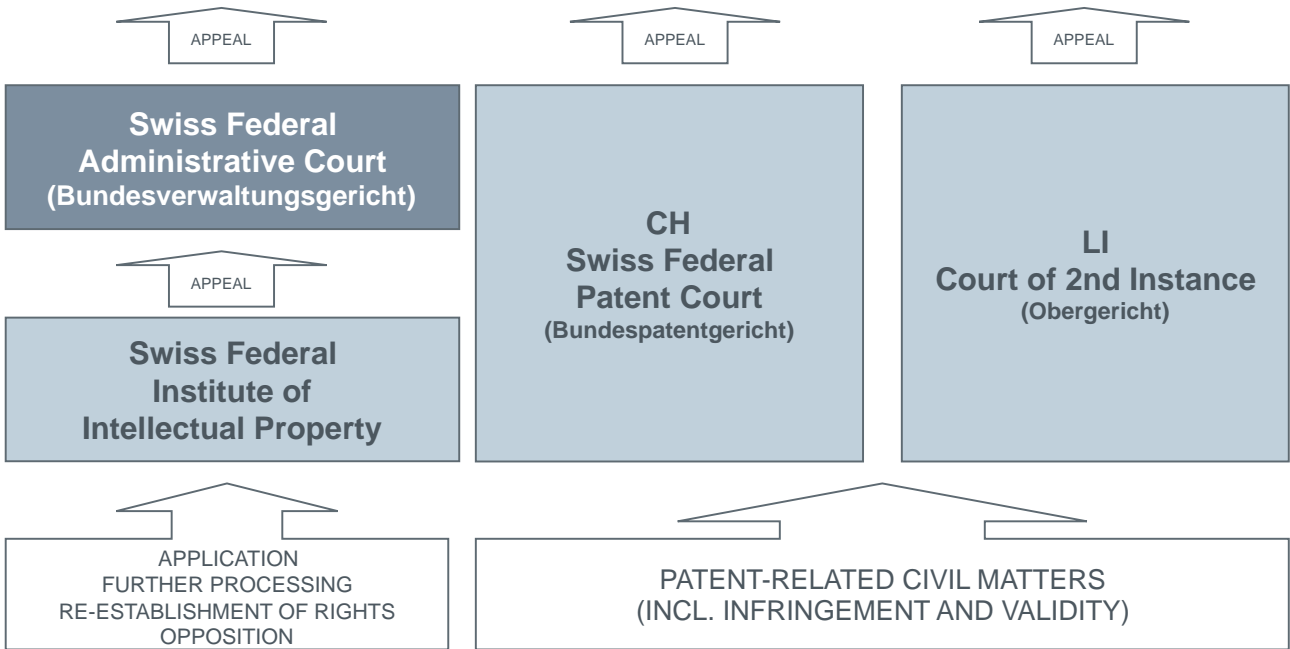
### Appeal

A further ordinary appeal may be filed with the Swiss Federal Supreme Court in Lausanne, regardless of the value in dispute. The Swiss Federal Supreme Court is generally bound by the findings of fact by the lower-instance court, and its reviews are usually confined to points of law.

### Bibliography

- Federal Act on Patents for Inventions of 25 June 1954 (Patents Act; PatA SR 242.14). An official English translation of the PatA is available on the government website [www.admin.ch](http://www.admin.ch)
- Federal Act on the Federal Patent Court of 20 March 2009 (Patent Court Act; PatCA SR 173.41). An official English translation of the PatCA is available on the government website [www.admin.ch](http://www.admin.ch)
- Swiss Civil Procedure Code of 19 December 2008 (CPC SR 272). An official English translation of the CPC is available on the government website [www.admin.ch](http://www.admin.ch)
- “Specialised patent court launched”, Rainer Schalch/Brendan B. Bolli, e-paper of 1 December 2009, [www.managingip.com](http://www.managingip.com)
- “Unified procedures to simplify IP cases”, Rainer Schalch/Brendan B. Bolli, e-paper of 1 June 2010, [www.managingip.com](http://www.managingip.com)
- “The Enforcement of Patent Rights in Switzerland”, Fritz Blumer, ILC Studies, Volume 23, Patent Enforcement Worldwide, pp. 205-229, Oxford and Portland 2005
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Switzerland, No. 107, September 2006
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 160 on Switzerland, 5/2005
- Swiss Federal Institute of Intellectual Property: <https://www.ige.ch/en.html>

# Swiss Federal Supreme Court (Bundesgericht)



CH



# Cyprus

## a. Department of Registrar of Companies and Official Receiver

### Opposition

No pre- or post-grant opposition procedure is available.

### Appeal

Any person may file an appeal to the Supreme Court against acts of the Registrar. The judicial review by the Supreme Court is an administrative procedure, which takes place before two instances.

- (i) There is a review before one Supreme Court judge and
- (ii) a further appeal before five Supreme Court judges. The time limit for a review is 75 days, and 14 days for an appeal from a review.

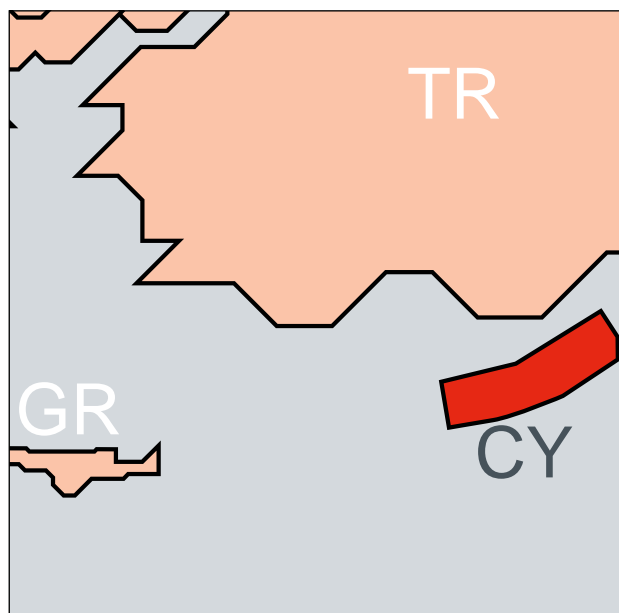
### Compulsory licence

May be granted in cases of non-working, refusal to grant a licence for a product for which demand in Cyprus is not (or not reasonably) met, dependent patents, economic needs, unfair conditions imposed by the proprietor, or public interest (Art. 49-51 PA).

- The proprietor of a patent or any other person wishing to oppose an application for a compulsory licence may give the Registrar notice of opposition, which the Registrar considers in deciding whether to grant the application (Art. 52(1) PA).
- Where an application for a compulsory licence is opposed and either the parties consent or the proceedings require an extended examination of documents or any scientific research which cannot in the opinion of the Registrar conveniently be made before him, the Registrar may at any time order the whole proceedings or any issue of fact to be referred to an arbitrator or mediator. The arbitrator or mediator reports his findings to the Registrar, who then proceeds with his decision (Art. 52(2), (3) PA).

### Restoration

Is possible in cases of unintentional non-payment of fees. Decisions may be appealed by any interested person.



CY

## b. Civil procedure

### Infringement

The owner of the patent may institute legal proceedings against anyone who infringes his rights as patentee.

- Unless the licence contract provides otherwise, any licensee may request the proprietor of the patent to institute court proceedings for any infringement indicated by the licensee, who must specify the relief desired. If the licensee proves that the proprietor of the patent has received the request but refuses or fails to institute proceedings within three months of receipt of the request, the licensee may institute proceedings in his own name, after notifying the proprietor of his intention (Art. 61(4) (a), (b) PA).
- The defendant in the infringement proceedings may request the invalidation of the patent in the same proceedings. The provisions and requirements of the invalidation procedure apply (Art. 61(3), 58 PA).
- Infringement actions become statute-barred five years from the act of infringement (Art. 61(1) PA).
- The Supreme Court of Cyprus at First Instance may decide to stay any proceedings brought before it in respect of unauthorised acts performed in relation to an invention that is the subject of a published application until a final decision has been made by the Registrar to grant or to refuse a patent on the application (Art. 28(2) PA).
- Remedies: injunction, damages.
- Appeal to the Supreme Court of Cyprus:
  - (i) There is a review before one Supreme Court Judge and
  - (ii) a further appeal before five Supreme Court judges.

### Invalidation

The Supreme Court of Cyprus at First Instance may, on the application of any person, invalidate a patent, in whole or in part, on any of the grounds named in Art. 58 PA. Invalidation works retroactively (Art. 59 PA).

- If the action is withdrawn, the invalidation proceedings will not continue.

### Declaration of non-infringement

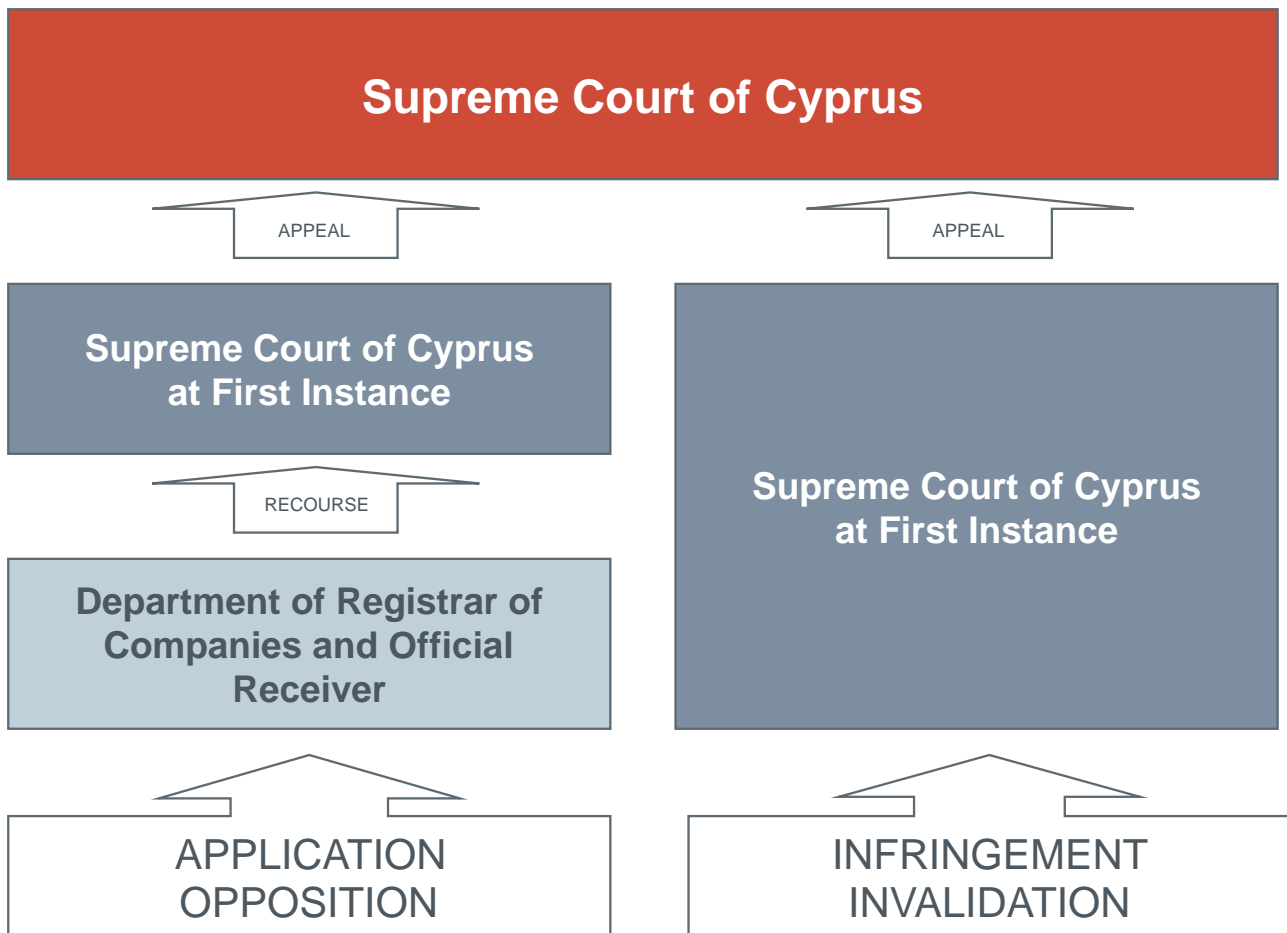
Any interested party has the right to institute proceedings against the proprietor of the patent. The Supreme Court may declare that the performance of a specific act does not constitute infringement of a patent (Art. 62(1) PA).

- The patent proprietor has to prove that the act in question does not constitute infringement. If infringement proceedings are already pending, the defendant in the infringement proceedings may not institute proceedings for a declaration of non-infringement (Art. 62(2) PA).

### Bibliography

- Patents Law - No. 16(1) of 1998 as amended by law 21(I)/1999; 153(I)/2000; 163(I)/2000; 122(I)/2006 [cited as: PA]; translation provided by WIPO
- "Patents throughout the World", 2008 Thomson Reuters/West, Chapter 43 on Cyprus, as reviewed and updated by Ms Vicky Petrides, 3/2007
- "Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the world", edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Cyprus, No. 91, May 2002

CY



# Czech Republic

## a. Industrial Property Office

### Opposition

No pre- or post-grant opposition procedure is available.

- Any person may submit observations concerning the patentability of the invention after the application is published (Section 32(1) PA). The Patent Office takes such observations into consideration when carrying out the full examination of the application. Those who submit observations do not become party to the proceedings for the application. However, the applicant is informed of any observations submitted (Section 32(2) PA).
- Furthermore, third parties may, within 36 months as from the filing date of the application for an invention, request substantive examination of a patent application (Section 33(2), (3) PA).

### Revocation

Any person may file a request for revocation of a patent with the Patent Office (Section 23 PA).

- The request may be filed even after lapse of the patent
  - proof of legal interest is necessary (Section 23(4) PA).
- Revocation has retroactive effect (Section 23(3) PA).
- Partial revocation is available (Section 23(2) PA – will be carried out as an amendment of the claims).

### Declaratory proceedings

Any person proving legal interest may file a request with the Patent Office to determine whether the production process, the given products, their exploitation or their presence on the market fall within the scope of the patent (Section 67 PA). The Patent Office does not decide on infringement as such.

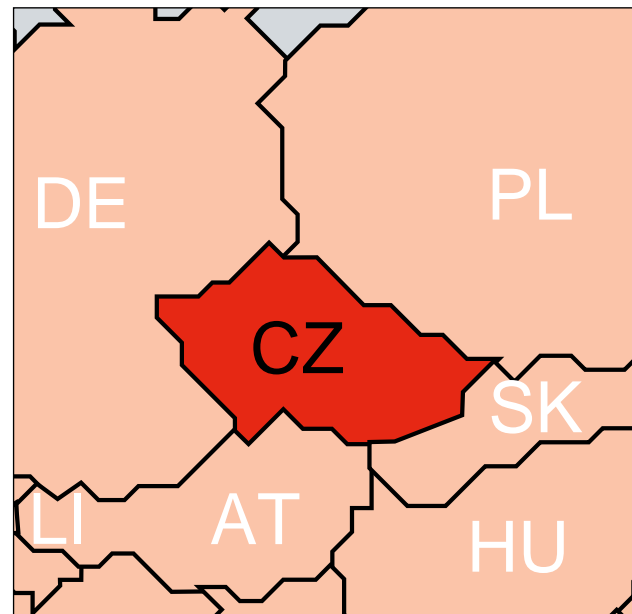
### Compulsory licence

May be granted by the Patent Office in cases of non-working and serious public interest (Section 20 PA).

### Appeal

Patent Office decisions may be appealed to the President within one month of their notification (Section 68 PA). The President decides on the appeal on the basis of the proposals of the expert commission that he establishes. The appeal has suspensive effect. The President's decisions are generally final, but:

- they can be reviewed by the Municipal Court in Prague, in proceedings initiated by the filing of a claim. The claim has to be filed within two months of notification of the challenged decision. The claim does not have suspensive effect. The court may revoke the contested decision, return the matter to the Patent Office for further



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proceedings, or dismiss the claim. In case of a complaint of inaction against the Patent Office, the court may oblige the Office to issue a decision within a prescribed time limit.

- no ordinary appeal is available against the decision of the court. The decision may be contested only through an annulment (“cassation”) complaint filed with the Supreme Administrative Court in Brno.

## b. Civil procedure

### Infringement

Claims resulting from the imminent or existing infringement of industrial property rights acquired to the prejudice of their beneficiary fall within the exclusive competence of the Municipal Court in Prague (Section 6, Act No. 221/2006).

- Proceedings are initiated at the request of either the patent owner or another person entitled to use the rights (Section 75 PA).
- The court may itself decide or alternatively may suspend the proceedings until the Patent Office decides (see “Declaratory proceedings” above). However, the court is not bound to follow a final decision of the Patent Office. The court usually takes its decision on the basis of an authorised expert’s opinion or reports made by independent experts.
- The invalidity of a patent cannot be used as a defence (separate procedure – see “Revocation”).
- Representation by a lawyer is not obligatory.
- Remedies: right to information, preliminary injunction, recall of products from the market, permanent removal, destruction (products and tools), pecuniary compensation, damages (Sections 3, 4, 5, Act No. 221/2006 Coll., Section 75 PA).

## Appeal

May be made to the High Court in Prague.

## Further appeal

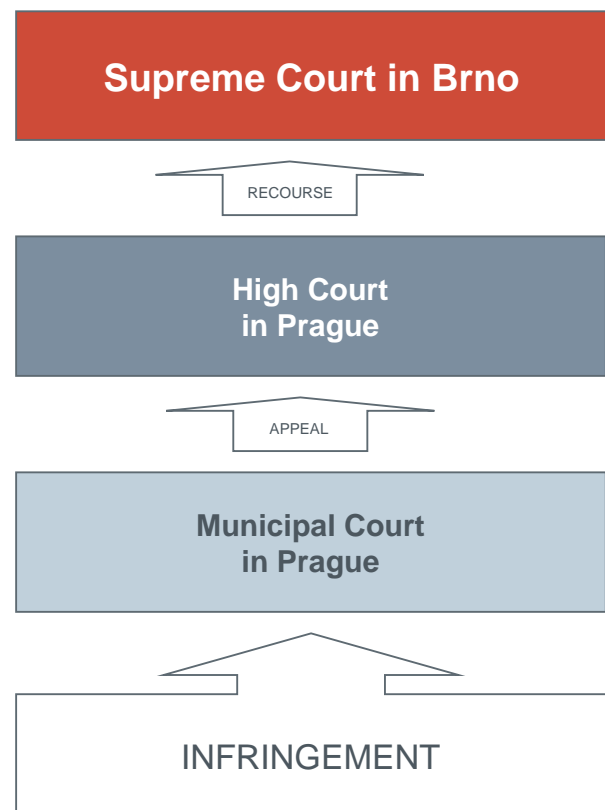
Recourse to the Supreme Court in Brno is available as an extraordinary legal remedy.

## Other IP matters

Decisions on all other unspecified IP matters are also taken by the Municipal Court in Prague (Section 39(2) Courts and Judges Act). Protection against the infringement of industrial property rights can also be sought within protection against unfair competition (in this case competence rests with the regional courts). In both cases the admissible legal remedy is an appeal to the High Court. Recourse to the Supreme Court in Brno against the decisions of the High Court is available as an extraordinary legal remedy.

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- Act No. 527/1990 Coll. on Inventions and Rationalisation Proposals, as follows from amendments implemented by Act No. 519/1991 Coll., Act No. 116/2000 Coll. Act No. 207/2000 Coll. and 3/2001 Coll. [cited as: PA]; translation provided by WIPO
- Act No. 221/2006 Coll. of 25 April 2006 on Enforcement of Industrial Property Rights and on the Amendment of Industrial Property Protection Acts [cited as: Enforcement of Industrial Property Rights Act]; translation provided by WIPO
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 44 on the Czech Republic, 4/2004
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on the Czech Republic, No. 100, March 2005
- “The Enforcement of Patent Rights in Czech Republic”, Ivo Telec, ILC Studies, Volume 23, Patent Enforcement Worldwide, pp. 253-267, Oxford and Portland 2005
- “Presentation of the national proceedings with regard to the validity and enforcement of patents” (CZ), EURO-TAB 7/2007





# Germany

## a. German Patent and Trade Mark Office

### Opposition

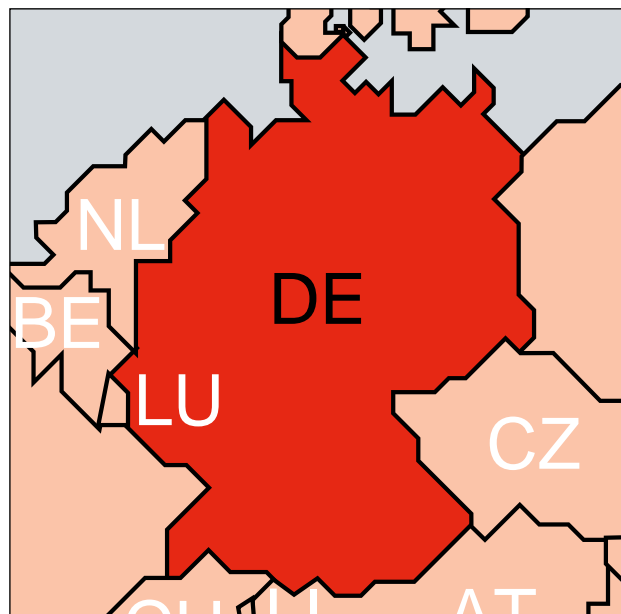
Any person may file notice of opposition within three months of the date of publication of the grant (Section 59(1) PatG) (no restitutio in integrum in case of failure to observe the three-month time limit).

- Opposition may be based only on the allegation that one of the grounds for revocation exists (Sections 59(1), 21 PatG). Grounds of usurpation may be invoked only by the injured party (Section 59 (1) PatG). The facts which justify the opposition must be stated in detail.
- Anyone against whom an action for infringement of a patent has been brought may intervene in opposition proceedings which are already pending. In cases where the period for opposition has expired, the intention to intervene must be declared within three months of the action being brought. The same applies to a third party who proves both that the proprietor of the patent has demanded that he cease alleged infringement of the patent and that he has instituted proceedings for a ruling that he is not infringing the patent (Section 59(2) PatG).
- Patent Divisions (three technical members, additional legal member in case of particular legal difficulty) at the Patent Office have competence for opposition proceedings (Section 61 PatG). Under certain conditions the Federal Patent Court (Appeal Chamber – three technical members and one legal member) may decide on the opposition (Section 61(2) PatG). If the opposition is withdrawn, the proceedings are continued (Section 61 PatG).

### Appeal

Appeal against the decision on the application may be filed within one month after receipt of a decision of rejection (Section 73 PatG). The appeal must be filed with the Patent Office (reasons for appeal are not compulsory). If the appellant is not opposed by another party to the proceedings and if the authority whose decision is contested finds the appeal justified, the authority will rectify its decision (Section 73(3), (4) PatG). If the appeal is not found to be justified, it will be transferred to the Federal Patent Court without comment as to its merits before the expiration of one month.

- The Federal Patent Court is an autonomous and independent federal court hearing appeals from decisions of the Patent Office's Examining Sections or Patent Divisions and actions for declaration of nullity of patents and for compulsory licences (Section 65(1) PatG). The Federal Patent Court decides as Appeal Chamber or Revocation Chamber (Section 66 PatG). The Appeal Chamber is responsible for appeal hearings (Beschwerdesenat - Section 66(1) No.1 PatG).



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- Further appeal against decisions of the Federal Patent Court (restricted to points of law) may be made to the Federal Supreme Court within one month, but only if the Patent Court decision specifically grants leave to appeal (mandatory leave - Section 100(1), (2) PatG) unless the appeal is based on procedural deficiencies (such as disregarding the right to be heard), when no leave is required (Section 100(3)).

### Restoration

Through a petition to the Patent Office or the Federal Patent Court, any right lost through failure to observe a period fixed by law, through no fault of the party concerned, can be restored (Section 123 PatG – subject to further exceptions). The petition should be made within two months after removal of the cause of delay. The decision on reinstatement is not appealable.

## b. Revocation/nullity and licensing

### Nullity

Strict separation from infringement proceedings.

- Anyone may bring a nullity action (grounds of usurpation may be invoked only by the injured party (Section 81(3) PatG)). The action may be based on the allegation that one of the grounds for revocation listed in Section 21(1) PatG applies or that the scope of the patent has been broadened (Section 22 PatG).
- There is no time limit for a nullity action.
- Proceedings will not continue if the action is withdrawn.
- At first instance, considered by a Revocation Chamber ("Nichtigkeitssenat" - Section 66(1) No. 2 PatG) of the Federal Patent Court consisting of two legal and three technical members.
- Decisions have retroactive effect.

- Appeal may be made to the Federal Supreme Court within one month of delivery of the full judgment (Section 110 PatG) for a review of points of law and fact. (Under the revised law enacted on 1 September 2009 and applicable to all nullity actions instituted from then on, the review is restricted to points of law. New facts can be brought forward only if certain conditions are met [e.g. no negligently late presentation of the new facts] (Section 110 PatG).)

#### Compulsory licence

A non-exclusive compulsory licence may be granted by the Federal Patent Court at the request of a party (subject to further conditions - Section 24 PatG).

- The decision may be appealed to the Federal Supreme Court within one month (Section 110 PatG).

#### c. Civil procedure

##### Infringement

Infringement claims are subject to civil law (Sections 139-141 PatG). Additionally, imposition of criminal sanctions is possible (criminal action on complaint of the aggrieved party, except in cases of public interest, where prosecution is ex officio (Section 142 PatG)).

- Invalidity may not be used as a defence or counterclaim defence - the validity of the patent is not subject to verification by a civil court.
- Infringement proceedings may be stayed if opposition or revocation proceedings have been instituted and are likely to succeed (the decision rests with the court).
- Remedies: claims for injunctive relief or actions for damages, destruction, recall of a product, information, submission or inspection, and claims to compensation for damages (Sections 139–140d PatG).
- The competent courts for all claims based on German patent law are the District Courts (LG, “Zivilkammern der Landgerichte” – Section 143 PatG ). The Federal States have stipulated that specific District Courts are wholly or partially competent for hearing all patent actions in the State concerned without regard to the value in dispute: LG Mannheim (Baden-Württemberg); LG Munich I and LG Nuremberg-Fürth (Bavaria); LG Berlin (Berlin, Brandenburg), LG Hamburg (Bremen, Hamburg, Mecklenburg-Western Pomerania, Schleswig-Holstein), LG Düsseldorf (North Rhine-Westphalia); LG Frankfurt (Hessen, Rhineland-Palatinate); LG Braunschweig (Lower Saxony); LG Leipzig (Saxony); LG Magdeburg (Saxony-Anhalt); LG Erfurt (Thuringia); LG Saarbrücken (Saarland).
- The standard limitation period for actions for patent infringement is three years (Section 141 PatG, Section 195 BGB).

The standard limitation period commences at the end of the year in which the claim arises and the claimant ob-

tains knowledge of the infringement and of the identity of the infringer or would have obtained such knowledge if he had not shown gross negligence (Section 141 PatG, Sections 195, 199(1) BGB). Irrespective of such knowledge, claims become statute-barred ten years after they arise or thirty years from the date of the infringement (Section 141 PatG, Sections 195, 199(3), (4) BGB).

- Appeal to the Higher District Court (“Oberlandesgericht” – OLG).
- Legal review by the Federal Supreme Court is possible, only if leave to seek review is granted by the Higher District Court or if on appeal the decision of the Higher District Court not to grant leave is set aside by the Federal Supreme Court (Sections 543-545 ZPO).

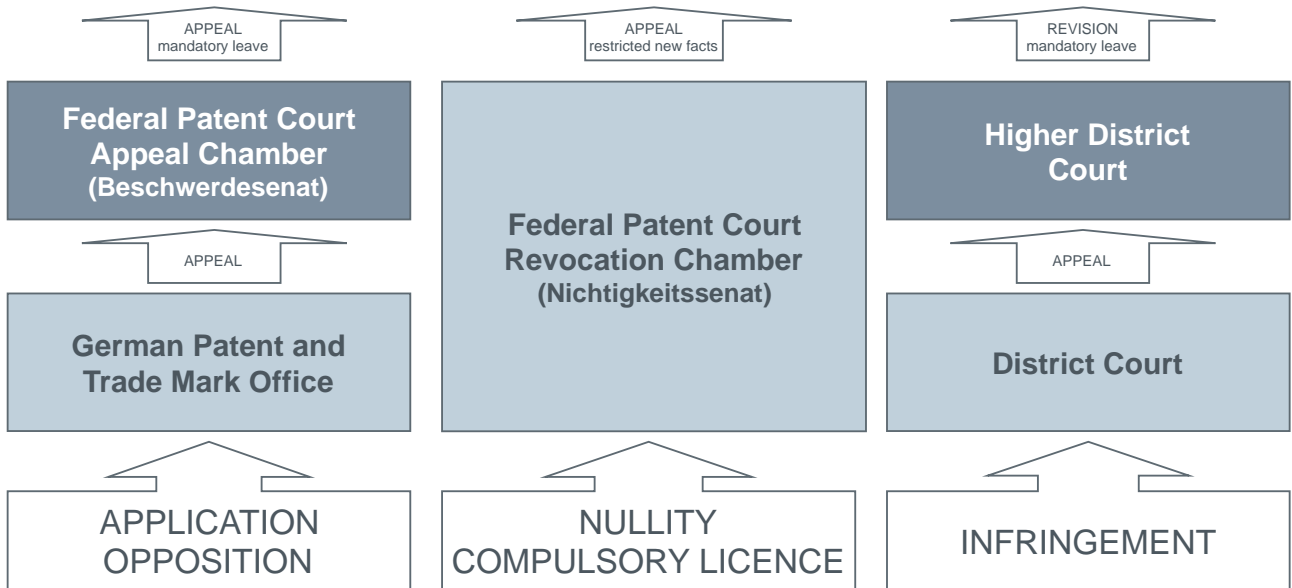
#### Declaratory judgment on non-infringement

Is available in civil proceedings (Section 256 ZPO).

#### Bibliography

- Patent Act as promulgated on 16 December 1980 (Federal Gazette 1981 I, p.1), last amended by Article 2 of the Law of 24 August 2007 (Federal Gazette I, p. 2166 with future effect, amendment by Article 40 G. of 23 November 2007 I, p. 2614 (No. 59) not yet taken into account) [cited as: PatG]; translation provided by WIPO
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- “The Enforcement of Patent Rights in Germany”, Hans Marschall, ILC Studies, Volume 23, Patent Enforcement Worldwide, pp. 109-138, Oxford and Portland 2005
- “Presentation of the national proceedings with regard to the validity and enforcement of patents” (DE), EURO-TAB 9/2007
- “Patentrecht”, Dr Christian Osterrieth, 2 ed., Munich 2004

## Federal Supreme Court (10<sup>th</sup> Civil Board)



DE



# Denmark

## a. Danish Patent and Trademark Office

The law of Denmark covers the autonomous outlying regions of Greenland and the Faroe Islands; however, the EPC has not been approved for those regions and does not in any way cover them.

### Opposition

Post-grant opposition is available. It must be filed within nine months from publication of the grant (Section 21 PA). The opposition may be considered by the Patent Office even if the opposition is withdrawn or the patent has lapsed (Section 23(2) PA).

- A third party may also file pre-grant observations on an application. They will be considered by the examiner, and the applicant is informed of them.
- If a third person claims before the Patent Office to be entitled to the invention, the Office may invite him to bring the case before the court within a specific period (Section 17 PA). If that happens, the grant proceedings can be suspended until a final decision in the legal proceedings has been given (pre-grant disputes – Section 17(2) PA).

### Appeal

Final decisions of the Patent Office may be appealed to the Board of Appeal (Section 24 PA). Any party may bring an action within two months. New evidence not previously used may be submitted. The Board is independent of the Office.

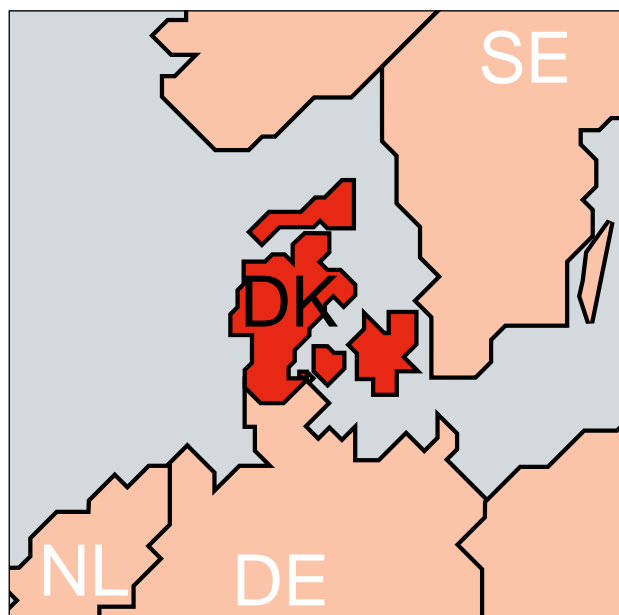
- An unfavourable decision of the Board of Appeal may be appealed to the Maritime and Commercial Court and further to the Supreme Court.

### Re-examination

Any person, at any time after expiry of the opposition period of nine months after grant, may file a request for administrative re-examination. If opposition proceedings are pending, a request may not be filed until after the final decision on the opposition is taken. Re-examination cannot be requested if court proceedings in relation to the patent are pending; in such a case the Patent Office suspends consideration of the request. The Office may consider the request even if the request is withdrawn (Section 53b PA).

### Restoration

Is possible in case of failure to observe time limits set by the Patent Office. However, it is not possible in case of failure to observe the two-month term for filing an appeal with the Maritime and Commercial Court against a decision of the Board of Appeal.



DK

## b. Civil procedure

### Infringement

Civil actions must be brought to the Maritime and Commercial Court. The panel of the Maritime and Commercial Court uses both legally and technically qualified judges.

- Action should be brought by the injured party or, at the request of the injured party, by public authorities (Section 57 PA).
- Invalidity of the patent may only be raised as a defence if a claim for revocation is made against the proprietor of the patent under special proceedings summoning the patentee before the court (the defendant may adduce the nullity of the patent only against the owner of the patent if a claim is raised and is properly communicated – Section 61 PA).
- Remedies: fines, damages, confiscation of infringing products, additional decision on prevention of the abuse of products manufactured in accordance with the patent, imprisonment. The patent owner may also seek a preliminary injunction at the City Court (Section 58, 59, 62 PA).

### Invalidation

Any person may institute proceedings for full or partial invalidation of a patent at any time after grant (Section 52 PA). The action may be brought before the Maritime and Commercial Court.

- Partial invalidation is available.
- Invalidation proceedings concerning a patent in respect of which opposition or re-examination is pending may be suspended by the Court until a final decision on the opposition or re-examination has been taken by the Patent Office (Section 53a, 53b PA).

- Proceedings on the grounds that the patent has been granted to a person other than the one entitled to it may be instituted only by the person claiming entitlement. Such proceedings must be brought within one year after the entitled person obtained knowledge of the grant of the patent and of the other circumstances on which the proceedings are based. If the proprietor received the patent in good faith, action may not be brought later than three years after grant (Section 52(4) PA).

**Compulsory licence**

Can be granted by the Maritime and Commercial Court, e.g. in cases of non-working, dependent patents or public interest (Sections 45-48 PA). The Court may, at the request of either party, modify the conditions of a compulsory licence or even revoke it.

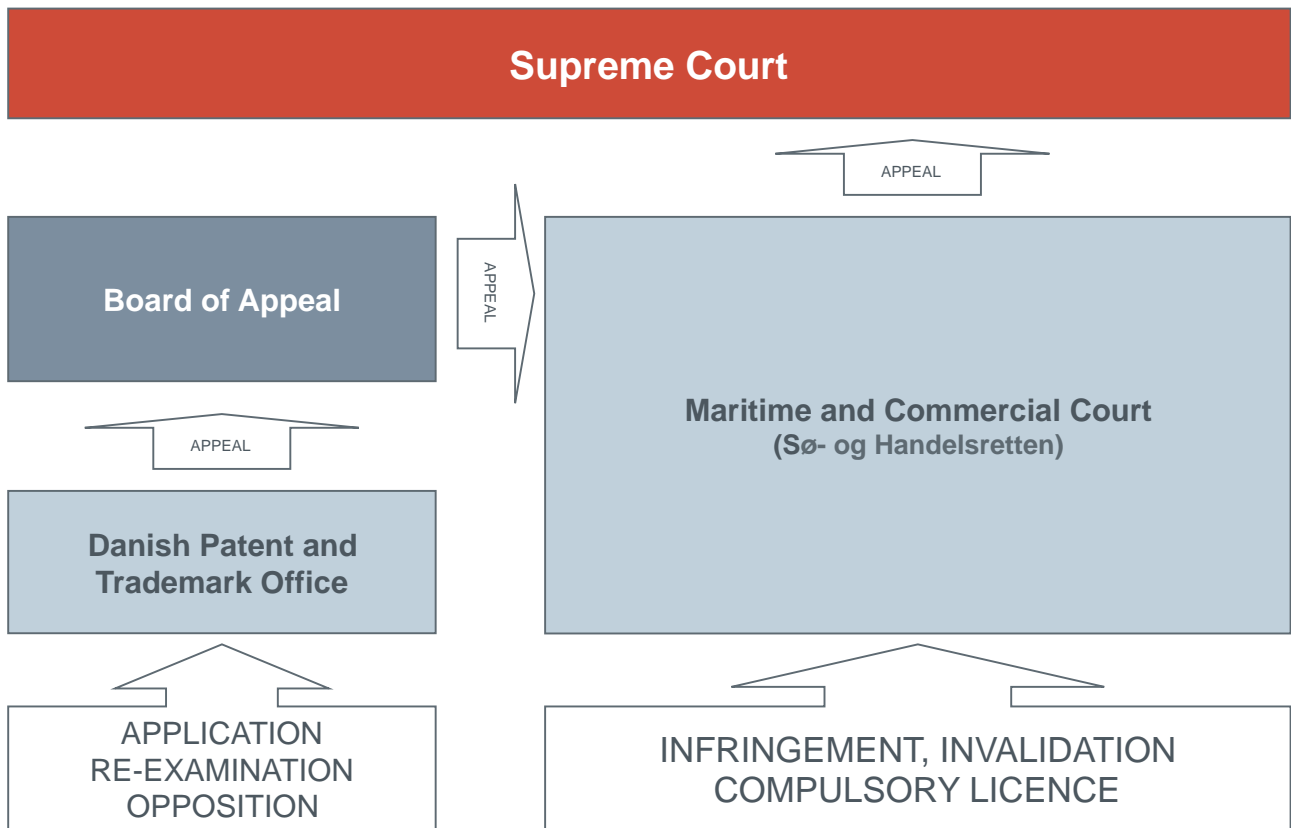
**Declaratory judgement on non-infringement**

Can be achieved through a civil lawsuit against the patent owner.

**Bibliography**

- The Consolidated Patents Act (Consolidated Act No. 108 of 24 January 2012) [cited as: PA]; translation provided by WIPO
- “Presentation of the national proceedings with regard to the validity and enforcement of patents” (DK), EURO-TAB 28/2007
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Denmark, No. 102, September 2005
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 45 on Denmark, 5/2005

DK



# Estonia

## a. Estonian Patent Office

### Opposition

No pre-grant opposition procedure is available. Post-grant opposition is available at the Board of Appeal.

- Any person may file an application for revocation with the Board of Appeal and request the revocation of a patent within nine months of the publication date of the notice of issue of the patent (Section 50 PA). The person who filed the revocation application or the proprietor of the patent may contest the decision of the Board of Appeal at the Harju County Court within three months of the date on which the decision was made (Section 50(6) PA).

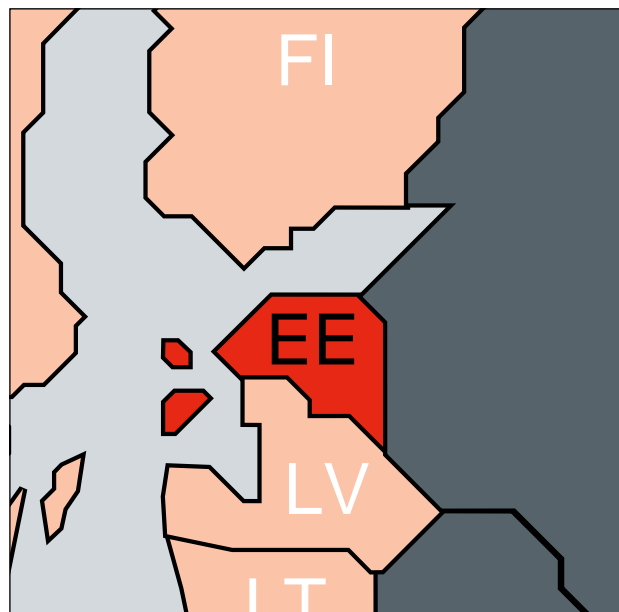
### Appeal

An applicant may file an appeal against a decision of the Patent Office with the Board of Appeal (Section 30 PA).

- Any applicant may file an appeal within two months of the date on which the decision is made (Section 30(2) PA). The Board of Appeal has the right to dismiss an appeal, or to require the Patent Office to annul its decision and to continue the proceedings, taking into account the circumstances set forth in the Board's decision (Section 30(3) PA).
- Harju County Court (civil court) is responsible for all substantive matters of patent law and for appeals against the decisions of the Board of Appeal. (Harju County Court is located in Tallinn, seat of the Estonian Patent Office.) Other county courts are responsible for infringement cases only.

### Restoration

Is possible if the Patent Office has terminated the processing of the patent application by having deemed it to be withdrawn, provided that failure to perform the acts was due to force majeure or some other impediment independent of the applicant (Section 29 PA).



EE

## b. Civil procedure

### Infringement

Civil county courts have jurisdiction (jurisdiction over the place of alleged infringement – according to the general rules of civil procedure).

- The patent owner may bring the action (Section 53 PA).
- Criminal sanctions are available, but separate criminal proceedings have to be started (Sections 219, 226 Penal Code).
- Opinions from experts are possible, but are not binding on the court.
- Nullity of a patent can be used as a counterclaim (Section 54(6) PA). The court has to suspend the infringement proceedings until the final decision on revocation is reached. If the patent is revoked, the action for alleged infringement will be discontinued.
- Remedies: compensation, termination of unlawful use (Section 53 PA).
- Appeal: an ordinary appeal may be filed at the Court of Appeal.

### Declaration of non-infringement

May be requested by any person at the Harju County Court. Action must be filed at the court against the patentee (Section 54(5) PA).

### Revocation

Any person who considers that a granted patent does not fulfil all the criteria for patentability (Section 8 PA) may file an action for revocation in the Court against the proprietor of the patent (Section 49(4) PA).

- Action may be brought to the Harju County Court even after the patent has lapsed (Section 49(5) PA).

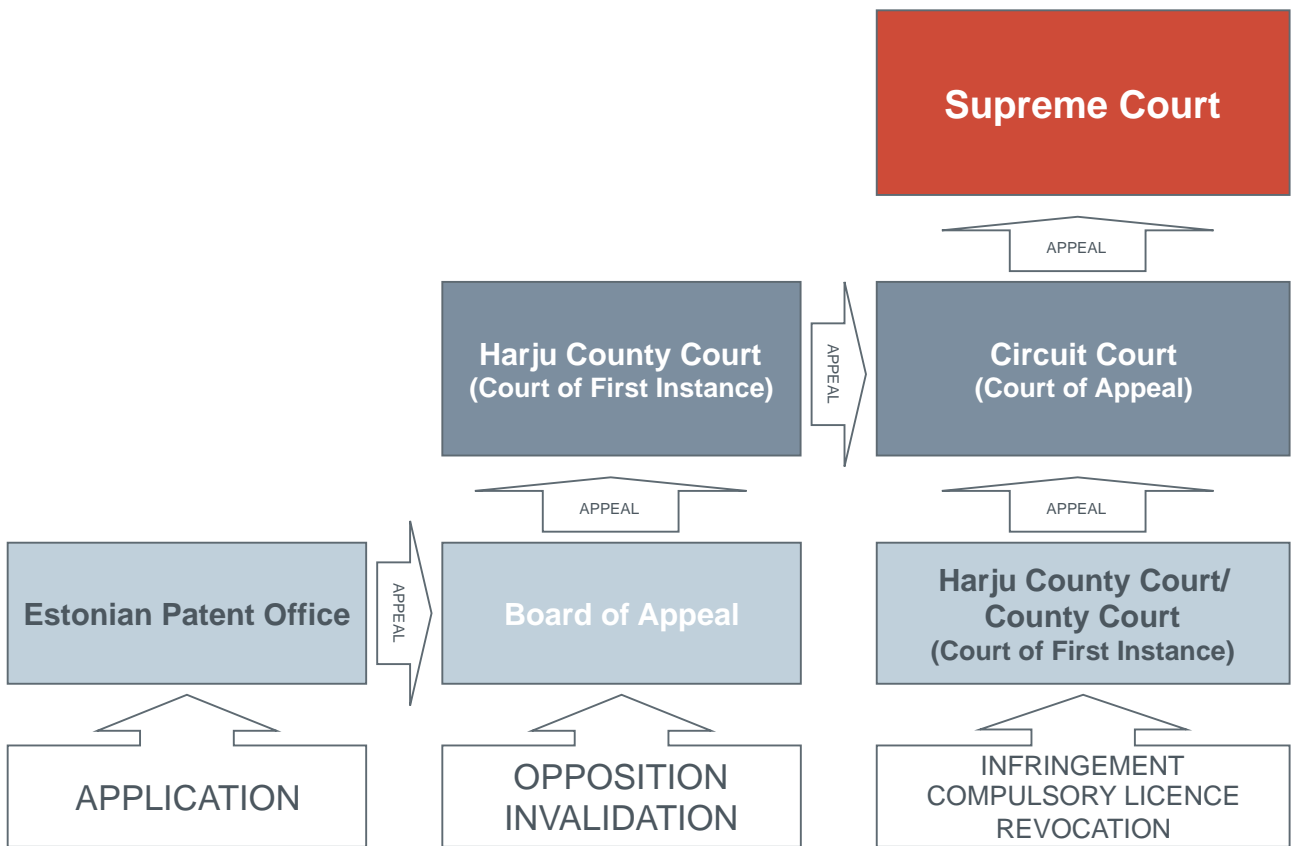
- A patent may be partially revoked. The decision of the Court has retroactive effect (Section 49(6) PA).
- If the action is withdrawn, the court will end the proceedings. No ex officio actions are provided for by Estonian law.

**Compulsory licence**

May be granted by the County Court in cases of non-working, economic importance for Estonia, and public interest (Section 47 PA). Government use of a patent without the authorisation of its owner in situations of national emergency or other circumstances of extreme urgency is possible (Section 47 PA).

**Bibliography**

- Patent Act - passed on 16 March 1994 (RT I 1994, 25, 406; consolidated text 1 January 2012) [cited as: PA]
- “Patents throughout the World”, Chapter 53 on Estonia, 4/2004
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the world”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Estonia, No. 111, May 2007





# Spain

## a. Spanish Patent and Trademark Office

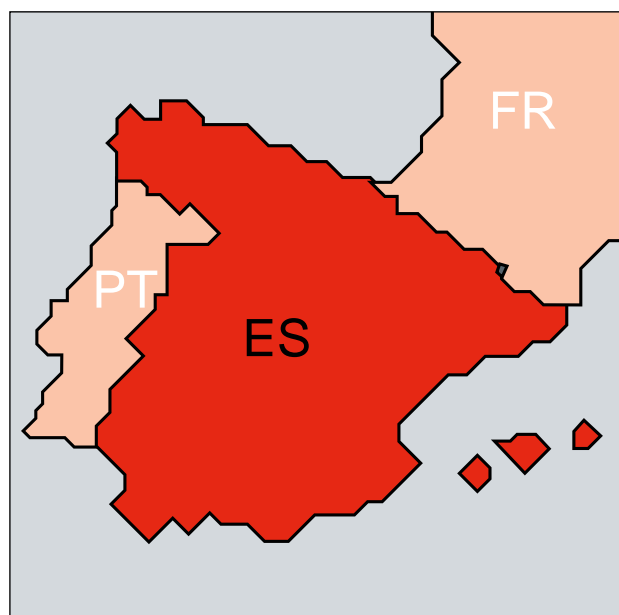
### Opposition

Any interested party may file notice of pre-grant opposition against applications which have undergone substantive examination within a period of two months from the date of publication of the request for substantive examination in the Official Gazette.

- In such cases, opposition may not be founded on the grounds of lack of right to apply for the patent, which constitutes an issue that would have to be settled by the Spanish civil courts.
- The Patent Office informs applicants of any oppositions it receives and supplies them with its findings on novelty, inventive step and sufficiency.
- The Patent Office sets a two-month time limit for applicants to reply or to make appropriate amendments to the application.
- If the applicant files additional comments or makes amendments to the application, these are once again subjected to re-examination by the Patent Office, which in addition informs the applicant of the existence of any possible objection that might prevent the patent from being granted. A supplementary one-month period is then provided for the applicant to make additional comments or amendments to the application.

Applications processed in the general grant procedure and hence without substantive examination of the invention are not subject to opposition.

- However, in such cases, any third party may file observations referring to the Patent Office's prior art report. The time limit for submitting third-party observations is two months from the date of publication of the resumption of the general grant procedure in the Official Gazette.
- The Patent Office informs the applicant of the existence of any such observations, to which he may reply. Therefore, the applicant will be granted an additional two-month period within which he may also make additional remarks concerning the prior art report or suggest any amendments to the claims.



### Appeal

Any interested party may lodge an appeal with the Patent Office's Appeals Section against the Office's decisions to grant or refuse.

- If the appeal is not settled within the three-month period from the date on which it was lodged, the request to overturn the decision may be presumed to have been dismissed. Therefore, the lack of an administrative decision within the legal term will not prevent the appellant from pursuing his legal claims.
- Against the decision to grant/reject an appeal, the petitioner may take legal action before the Spanish Contentious-Administrative Courts within a period of two months from publication of the decision.
- The lodging of a contentious-administrative appeal does not have suspensive effect for the Patent Office's decision.

### Restoration

The applicant may request the restoration of a patent right in case of non-payment of renewal fees if the owner proves that failure to pay was due to force majeure. A claim of force majeure may be brought only during the six months following publication of the expiry of the patent in the Official Gazette. The request for restoration will be published in the Official Gazette and may be objected to by any interested party.

- The decision to restore a patent right will be taken without prejudice to the rights of third parties. The action for recognition of third-party rights in such cases will have to be brought before the Spanish Civil Courts.

ES

### Re-establishment of rights

A patent applicant or owner, or any other party to proceedings before the Patent Office, who, despite taking all due care required by the circumstances, has not been able to observe a time limit in relation to the Office will upon request have his rights re-established if the non-observance in question has the direct consequence of causing the loss of a right.

- The request for re-establishment must be filed within two months from the date of removal of the cause of the failure to meet the applicable time limit, provided that the request is filed within twelve months from the date of expiry of the applicable time limit.
- The omitted time limit must be fulfilled and the fee for the re-establishment of rights must be paid when re-establishment of rights is requested.
- The request must state the reasons for failure to comply with the time limit in spite of due care, and must be accompanied by any declaration or other evidence in support of this statement.

### Compulsory licence

The Spanish Patent Act provides for compulsory licences, which may be granted in cases of non-working of the invention, public interest and dependence between patents.

#### b. Civil procedure

### Infringement

The owner of a patent registration and the exclusive licensee may take civil and criminal actions for infringement. Civil actions are aimed at preventing or redressing damages, whilst criminal actions seek punishment of the person held responsible for the crime. It is frequent to find infringement actions taken in joint proceedings with revocation actions brought by the defendant as counterclaims. During both civil and criminal proceedings, the Court may request expert evidence from public bodies and institutions, possibly with the collaboration of Patent Office experts.

- In civil proceedings, the titleholder of the patent may resort to the following remedies: injunction, compensation for damages, seizure and destruction of infringing goods or the filing of notices in public registries.
- Spanish public security forces may proceed against crimes against IP rights, acting on the basis of their own investigations. Such crimes may also be prosecuted as a result of the crime being reported by any third party to the public security forces, which then conduct the necessary investigations to seek evidence of the reported crime.

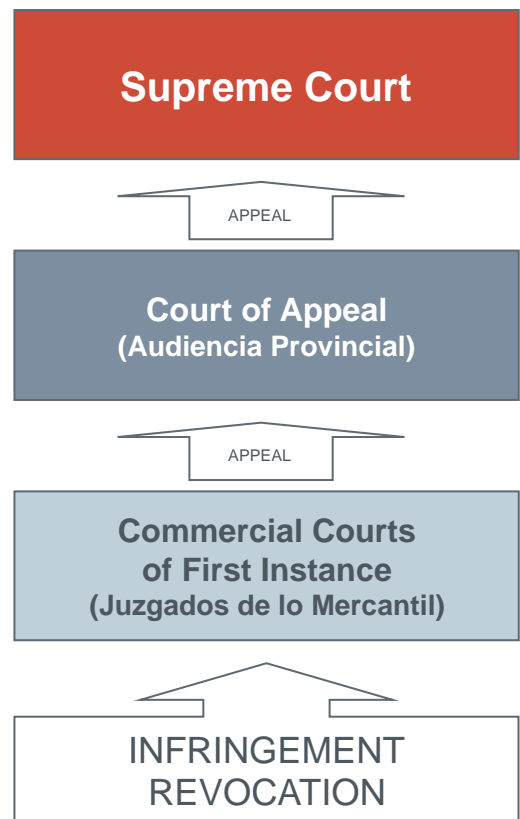
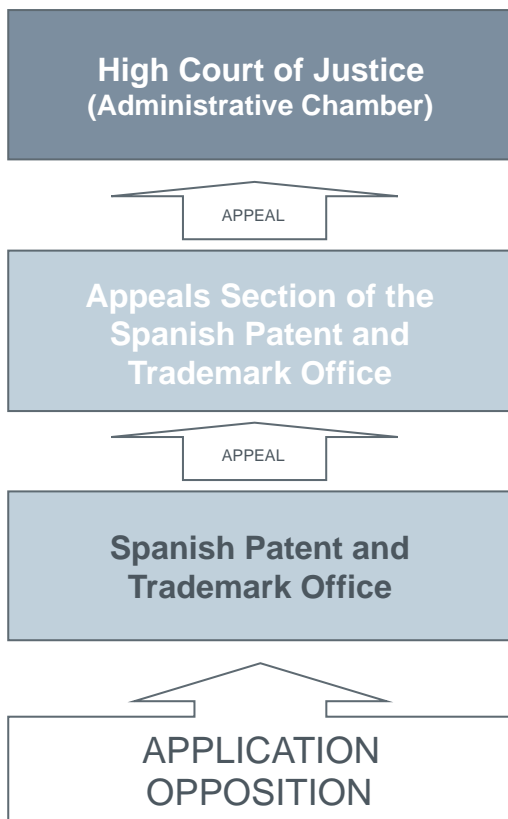
### Revocation

- Revocation actions can be brought by anyone except in cases of lack of right to the patent, where only the person who claims a better right to the invention would be entitled to act.
- A verdict declaring the revocation of a patent may not affect agreements already enforced.
- The Spanish courts may declare partial revocation of the patent.

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- "Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World", edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Spain, No. 104, January 2006
- "Patents throughout the World", 2008 Thomson Reuters/West, Chapter 154, Spain 5/2005
- Enforcing IP rights, Miguel Vidal-Quadras



ES



# Finland

## a. National Board of Patents and Registration of Finland

### Opposition

A post-grant opposition procedure is available. Within nine months from the date of the grant of the patent anyone may file notice of opposition (Section 24 PA).

The Patent Office may take an opposition into account even if it is withdrawn or after the patent has lapsed. If the opposing party withdraws his opposition, he may not appeal against the Patent Office's final decision (Section 24(5) PA). Anyone may file pre-grant observations which are of importance for the examination of the application. The Patent Office notifies parties of the possibility of filing an opposition if the patent is granted (Section 26a PD).

### Appeal

Appeals against final decisions of the Patent Office may be filed with the Market Court within 60 days (Section 27 PA). Appeal may be filed by the applicant, proprietor or opponents or by persons claiming to be the owner of the invention (Sections 26 and 54 PA).

Further appeal may be made to the Supreme Administrative Court within 30 days after receipt of the decision of the Market Court. However, leave has to be given first.

### Restoration

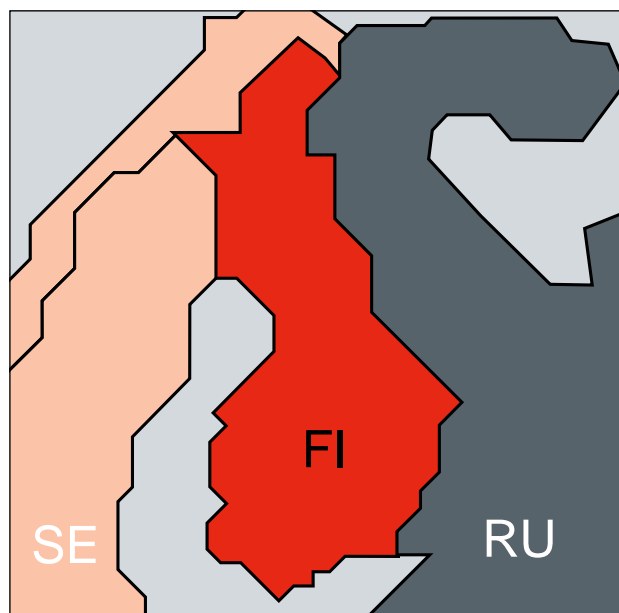
Available in cases where time limits laid down in the Patents Act and its Regulations are not observed by the applicant or proprietor. It must be requested within two months after removal of the cause of non-compliance, and not later than within one year from expiry of the time limit (Section 71a PA).

## b. Civil procedure

### Infringement

The patent owner may bring a civil action to the Market Court. A licensee may sue the infringer in his own name, provided that he duly notifies the owner.

- A dispute on infringement, entitlement, compulsory licensing, a declaratory judgment or compensation relating to a European patent may not be heard by the Market Court if the same dispute between the same parties is pending before the court of another country that is party to the EPC. If the competence of the foreign court is contested, the Market Court postpones its hearing of the case until the question of competence has been finally decided upon by the foreign court.
- In patent infringement matters the Market Court may ask the Patent Office for an opinion.



Nullity can be used as a defence, provided that a nullity action against the patent is pending or will be brought to the court within a period determined by the Market Court. Infringement and nullity actions are as a rule dealt with in the same proceedings. However, the Market Court may stay the infringement proceedings until the counterclaim for nullity has been decided if there are particular reasons for doing so.

Remedies: damages, compensation, interlocutory injunction, destruction, seizure, alteration or surrender of the infringing articles (Sections 57–60a PA).

Appeal: decisions and judgments of the Market Court may be appealed against before the Supreme Court, provided that the Supreme Court grants leave to appeal.

### Nullity

Any person who suffers prejudice on account of the patent, or a public authority appointed by the government for reasons of public interest, may institute proceedings for the invalidation of a patent. The action must be brought before the Market Court.

- In patent invalidation matters the Market Court may ask the Patent Office for an opinion.

### Compulsory licence

May be granted by the Market Court in cases of non-working, public interest, dependent patents and prior use (Sections 45–50 PA).

### Declaration of non-infringement

May be issued by the Market Court. Any person carrying on or intending to carry on commercial activities may bring an action against the patent owner (Section 63 PA).

## Bibliography

- Patents Act - No. 550 of 15 December 1967, as amended by Acts No. 575/71 of 2 July 1971, No. 407/80 of 6 June 1980, No. 387/85 of 10 May 1985, No. 801/91 of 10 May 1991, No. 577/92 of 26 June 1992, No. 1034/92 of 13 November 1992, No. 1409/92 of 18 December 1992, No. 593/94 of 28 June 1994, No. 717/95 of 21 April 1995, No. 1695/95 of 22 December 1995, No. 243/97 of 21 March 1997, No. 650/00 of 30 June 2000, No. 990/04 of 19 November 2004, No. 896/05 of 18 November 2005, No. 295/06 of 21 April 2006, No. 684/2006 of 21 July 2006, No. 392/10 of 14 May 2010, No. 954/10 of 12 November 2010, No. 478/11 of 13 May 2011, No. 743/11 of 17 June 2011, No. 863/11 of 22 July 2011 and No. 101/13 of 31 January 2013 [cited as: PA]; translation provided by Finnish Patent Office
- Patents Decree - No. 669 of 26 September 1980, as amended by Decrees No. 505 of 14 June 1985, No. 583 of 26 June 1992, No. 71 of 21 January 1994, No. 595 of 28 June 1994, No. 104 of 15 February 1996, No. 246 of 1 April 1997, No. 674 of 13 July 2000, No. 1200 of 19 November 2004, No. 144 of 16 February 2006, No. 1118 of 29 November 2007, No. 603 of 11 September 2008 and No. 1097 of 27 October 2011 [cited as: PD]; translation provided by Finnish Patent Office

### Supreme Administrative Court

APPEAL  
leave has to be given

### Market Court

APPEAL

### National Board of Patents and Registration of Finland

APPLICATION  
OPPOSITION

### Supreme Court

APPEAL  
leave has to be given

### Market Court

INFRINGEMENT  
NULLITY

# France

## a. National Industrial Property Institute

### Opposition

No pre- or post-grant opposition procedure is available.

- However, third parties may, within three months from the date of publication of the application, submit written observations that may affect the patentability of the invention (R. 612-63 IPC). Such observations are communicated to the applicant, who can submit his counter-observations or a new wording of the claims (within three months) (R. 612-64 IPC).

### Appeal

Action for annulment of any decisions regarding the grant, refusal or maintenance of patents should be filed with the Paris Court of Appeal (L. 411-4, R. 411-19 IPC).

- The action may be brought within one month by the applicant or patent proprietor or by a third party having an interest in the proceedings and residing in France, within two months if the party resides in overseas administrative departments of France, and within three months if the party resides in another country outside France (R. 411-20, R. 411-24 IPC). The action has suspensive effect.
- Further appeal can be made to the Supreme Court (L. 411-4(2) IPC).

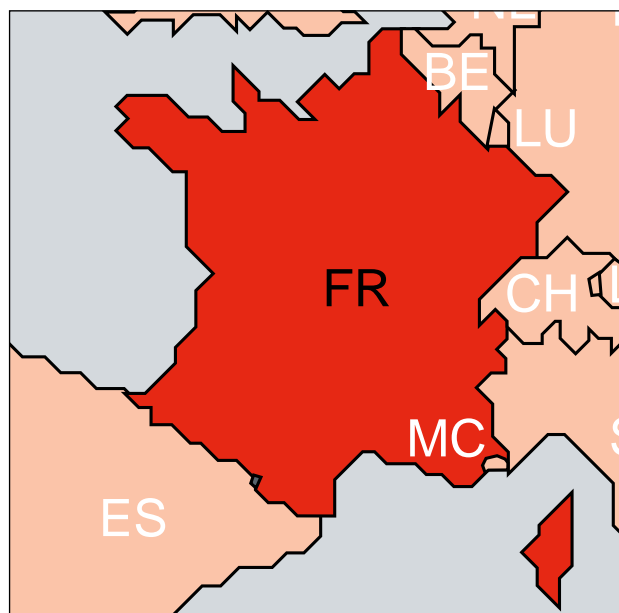
### Restoration

Appeal for re-establishment of rights may be submitted by an applicant who has failed to comply with time limits laid down by the Patent Office (L. 612-16, R. 613-52 IPC). The applicant must apply to the Director of the Patent Office within two months of the time when the legitimate reason for failure was observed. The act that has not been carried out must be accomplished within that period. The appeal is admissible only within a period of one year from expiry of the unobserved time limit. The appeal does not have suspensive effect. The decision may be contested by appealing to the Court of Appeal.

## b. Civil and criminal procedure

### Infringement

Patent infringement in France gives rise to both civil (L. 615-1 IPC) and criminal liability (L. 615-12; L. 615-14 IPC provides for a maximum of three years' imprisonment and a fine of EUR 300 000 or, if the offence is committed by an organised criminal group or if the products are considered dangerous for the health and security of humans or animals, a maximum of five years' imprisonment and a fine of EUR 500 000).



- Action may be brought by the owner of the patent or a licensee (if the patentee fails to do so – L. 615-2 IPC).
- All patent litigation matters fall under the special jurisdiction of the first-instance court in Paris (Tribunal de grande instance de Paris) and the Paris Court of Appeal (L. 615-17 IPC; Art. D 211-6 Code of Judicial Organisation). Infringement cases are tried by three legally qualified judges, who do not have formal technical or scientific training. Judges at the Tribunal de grande instance deal exclusively with IP cases, and the court has the power to appoint experts.
- Infringement actions may also be brought in respect of acts committed before grant but after the application became open to public inspection. The Court will then postpone its decision until the patent has been granted (L. 615-4 IPC).
- “Saisie-contrefaçon” is available – if a claimant does not already have evidence in its possession, the President of a court of first instance may be asked for an order of saisie-contrefaçon, a means of obtaining evidence that favours the patentee, e.g. inspection of the defendant’s premises (L. 615-5 IPC).
- Nullity of a patent can be raised as a counterclaim or defence.
- Remedies: civil and criminal penalties – damages, fines, interim injunction, confiscation, seizure, publication of the decision, recall of the infringing products from the channels of commerce or removal from the channels of commerce, destruction of the infringing products.
- Appeal: the losing party has one month (two months for a foreign party) to file an appeal against the decision at first instance. In the Court of Appeal the parties will follow the same stages of procedure as at first instance (full rehearing).

- Further appeal (“cassation”) to the Supreme Court is available but restricted to points of law. If the Supreme Court disagrees with the Court of Appeal’s decision, that decision is quashed and the case remanded to the Court of Appeal for further consideration.

### Revocation

The validity of a patent can be disputed only by initiating a nullity action before a court of general jurisdiction (Tribunal de grande instance de Paris). An invalidity action can be brought only after the patent has been granted.

- Any party which considers that a patent is invalid and should not have been granted can initiate an invalidity action; the public prosecutor may act ex officio (L. 613-26 IPC). Revocation decisions have retroactive and absolute effect (L. 613-27 IPC). Revocation may also be partial (L. 613-25, L. 613-27 IPC - claims limitation).

### Compulsory licence

May be granted by the Tribunal de grande instance.

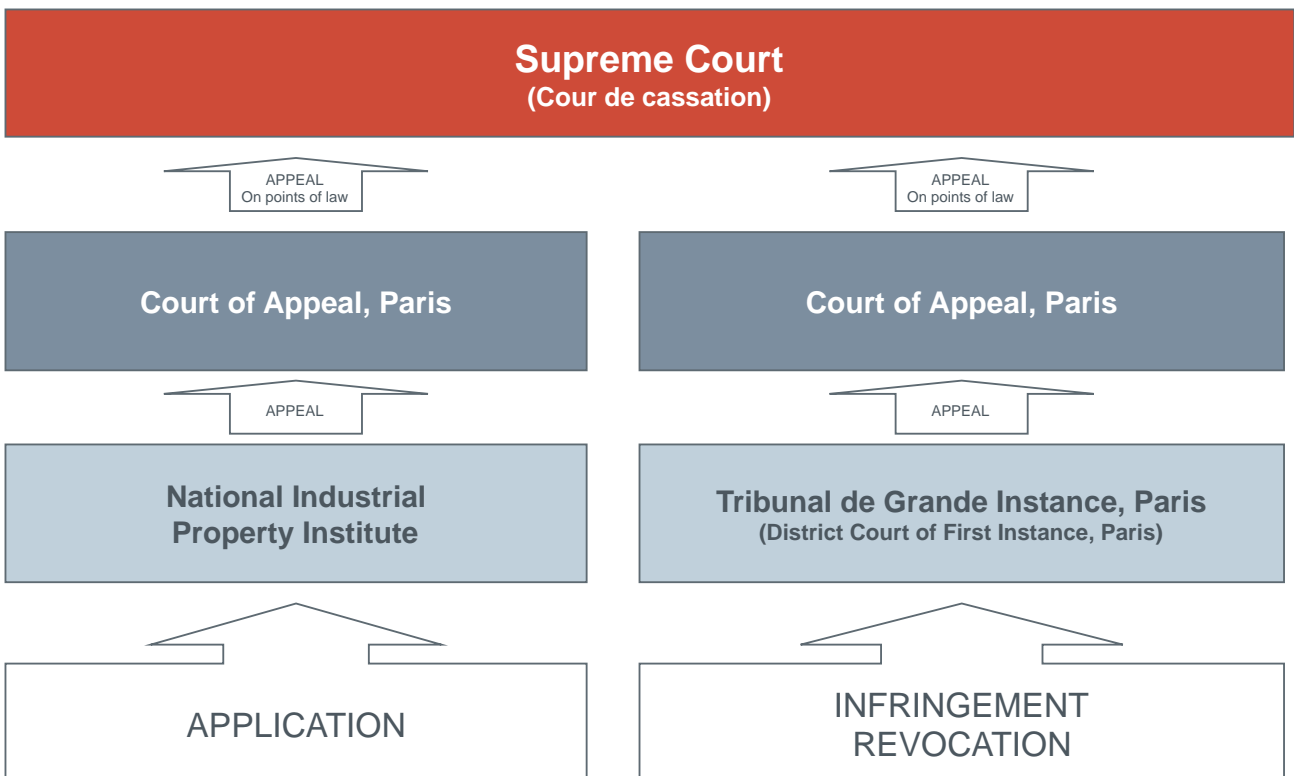
### Declaration of non-infringement

Anyone who proves they are working on an invention that may infringe an existing one has the right to request a judgment that such use does not infringe a certain patent (L. 615-9 IPC). The court’s declaration does not exclude a later suit for infringement or nullity.

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- “Patent Infringement Litigation in France”, Pierre Véron, Mitteilungen der deutschen Patentanwälte 2002, vol. 9, 93.Jg./2002, p. 386-403
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 60 on France, 12/2002
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FR





# United Kingdom

## a. UK Intellectual Property Office

Patents granted by the Patent Office cover England, Wales, Scotland, Northern Ireland and the Isle of Man. The Office also operates as a tribunal dealing with ownership issues (e.g. entitlement, inventorship, compensation of employees, joint applicant disputes), technical issues (e.g. revocation, declarations of non-infringement) and licences (e.g. applications to decide on the terms of licences which can be given under a patent and applications for a compulsory licence under a patent). The Office also decides various opposition matters, e.g. opposition to post-grant corrections and amendments, and surrender.

### Opposition

No opposition procedure is available. A third party may only file pre-grant observations on the patentability of the application (Section 21 PA). The Patent Office will consider such observations, but the observing party does not become a party to the proceedings.

### Compulsory licence

May be granted by the Patent Office (Section 48 PA). Grant may be opposed by any person (Section 52 PA).

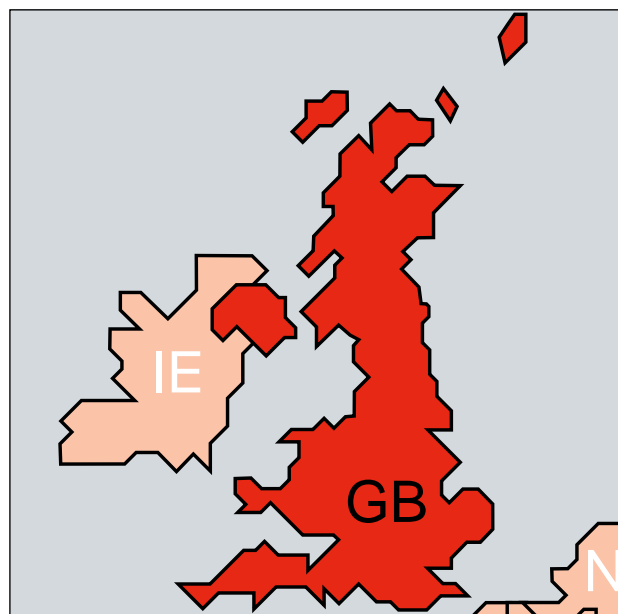
### Other

A claimant can choose to launch proceedings before either the Patent Office or the courts in a dispute concerning employee compensation, or when requesting a declaration of non-infringement or seeking revocation of a patent.

### Revocation

The validity of a patent may be challenged before the Patent Office (in its capacity as a tribunal), in the Patents County Court or the Patents Court.

- Anyone may apply to revoke a patent (Section 72 PA). The Patent Office may also revoke patents on its own initiative (i) where the invention formed part of the state of the art under Section 2(3) (Section 73(1) PA) or (ii) where there is a GB patent and a European patent (UK), the patents being for the same invention with the same priority date and the applications having been filed by the same applicant or his successor in title (Section 73(2) PA). In either situation, before any revocation occurs the proprietor of the GB patent is given an opportunity to make observations and to amend the specification so as to exclude any matter which may give reasons for the revocation or so as to prevent there being two patents for the same invention.



### Infringement

The Patent Office can also hear infringement claims if the parties agree on that course of action (Section 61(3) PA) – but in practice this has never happened. The proprietor of the patent may make claims for damages and for a declaration that the patent is valid and has been infringed (the Patent Office has more limited remedies than the courts).

- If it appears to the Patent Office that the question of infringement referred to it would more properly be determined by the court, it may decline to deal with it, and the court then has jurisdiction to determine the question (Section 61(5) PA).
- Patent infringement is not a criminal offence.

### Declaration of non-infringement

A declaration that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the Patent Office in proceedings between the person performing or proposing to perform the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor (Section 71 PA).

### Appeal

A general appeal against all decisions of the Patent Office should be filed with the Patents Court within a period specified by the Hearing Officer, usually within 28 days from the date of the decision.

## b. Civil procedure

### Infringement

The patent owner or exclusive licensee may bring a civil action to the court of his choice (Sections 61(1), 66, 67 PA).

- The proceedings may be instituted against any person who is alleged to have performed an act of direct or indirect infringement under Section 60(1), (2) PA.
- Remedies: injunction against future infringements, compensation by damages, destruction of infringing materials. The court will not, in respect of the same infringement, both award damages to the proprietor of a patent and order that he be given an account of the profits (Section 61(2) PA).
- Invalidity of a patent may be used as a defence in an infringement action and the defendant may counterclaim for revocation of the patent. However, if the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court or the Patent Office may grant relief in respect of that part of the patent which is found to be valid and infringed or reduce the damages (subject to further conditions – Section 63 PA).
- Patent infringement is not a criminal offence.

### Courts

In relation to patent disputes, there is no formal separation of jurisdiction between the Patents County Court and the Patents Court, and both form part of the Chancery Division of the High Court.

- Normally, less complicated cases will be considered by the Patents County Court. There is no legal limitation on jurisdiction due to the complexity of the facts but it will only consider cases up to GBP 500 000 in damages. The Patents County Court cannot consider appeals on decisions by the Patent Office.
- The Patents Court has the jurisdiction to transfer to the Patents County Court any proceedings which it is satisfied should have been filed there. The Patents County Court may also transfer proceedings to the Patents Court. If a party wishes proceedings transferred from one court to another, it needs to make an application to the relevant court.

### Appeal

To the Court of Appeal. There is no automatic right of appeal; a party must ask the trial judge for permission. If permission is refused, an application for permission can be presented to the Court of Appeal, where a single Lord Justice will consider whether to grant permission to appeal.

- The appeal panel of three judges normally includes a judge specialised in patent cases. An appeal is not a rehearing; facts are taken to be as found by the judge at the first instance, and the appeal examines whether that judge correctly applied the law to those facts.
- Further appeal can be filed with the Supreme Court. Permission to do so is given by either the Court of Appeal itself, or by the Supreme Court on application to it. The appeal can only be on an important question of law.

## c. Other

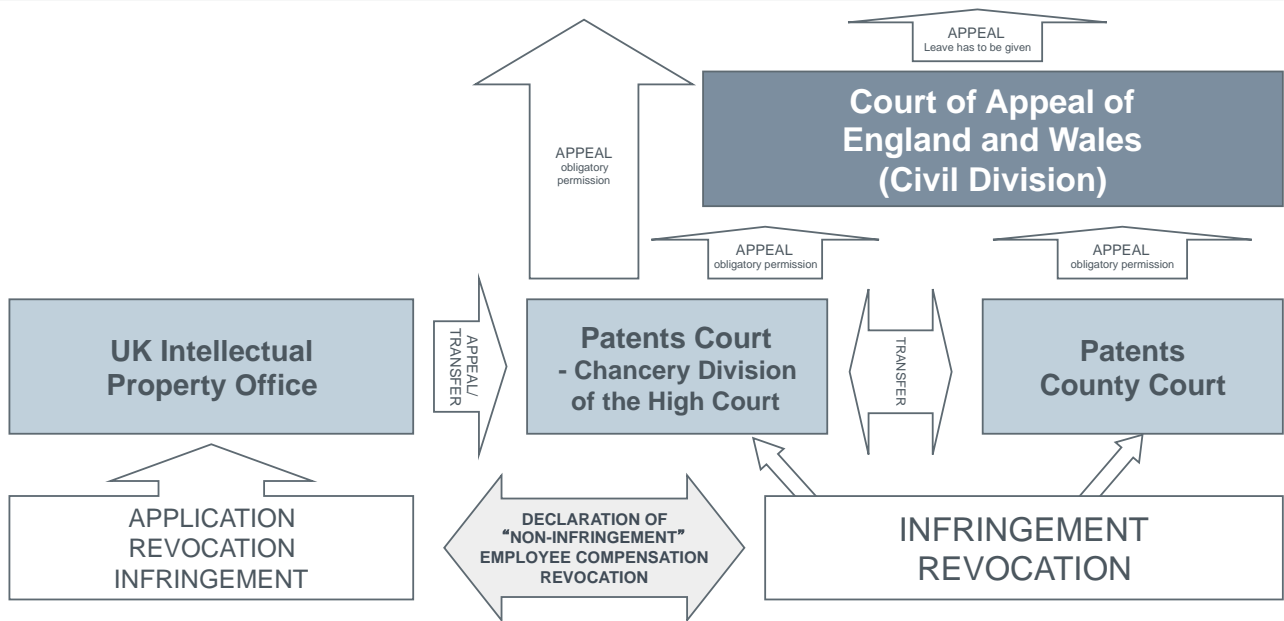
The United Kingdom comprises three separate jurisdictions:

- (1) England and Wales - as shown in the diagram
- (2) Scotland - patent actions are brought before the Outer House of the Court of Session
- (3) Northern Ireland - patent actions are brought before the Northern Ireland High Court

### Bibliography

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- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 176 on United Kingdom, 7/2007
- “International Civil Procedure”, edited by Shelby R. Grubbs; authored by World Law Group Members Firms, The Hague, London, New York 2003
- “Intellectual Property”, David I. Bainbridge, 6th edition, Harlow – England, London, New York 2007
- “Presentation of the national proceedings with regard to the validity and enforcement of patents” (UK), United Kingdom Intellectual Property Office, EUROTAB 25/2007
- “Intellectual Property: Patents, Copyright, Trademarks and Allied Rights”, by Cornish & Llewelyn, 5th ed., Thomson, Sweet & Maxwell 2003

# Supreme Court





## Greece

### a. Industrial Property Organisation

#### Opposition

- No pre- or post-grant opposition procedure is available.
- No observations can be made by third parties; third parties may only obtain copies of the application and search report (Art. 7(12), (13) PA).

#### Appeal

- No appeal is available.
- A Patent Office decision refusing a patent application for lack of susceptibility of industrial application or for exclusion from patentability (Art. 8(2) PA) can be contested following a petition for annulment before the Council of State.

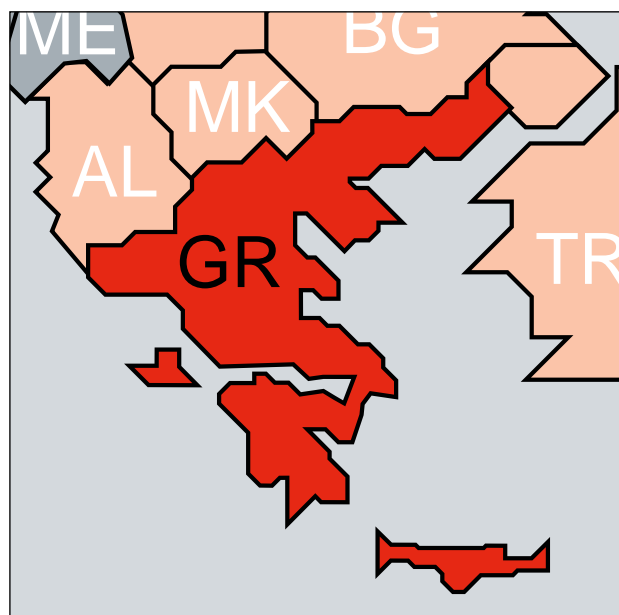
#### Restoration

Is not provided for.

### b. Civil procedure

#### Infringement

- The Civil Court of First Instance is competent (the Civil Court in Athens and the Civil Court in Thessaloniki are the only courts in Greece competent in patent litigation matters (Law No. 2943/2001)). Additionally, both courts have judges specialising in IP law.
- Infringement claims may be brought to the court before the patent is granted; however, in such a case the court may postpone the proceedings until the patent has been granted (Art. 17(3) PA).
  - The owner or the exclusive licensee may bring a civil action (Art. 17(1), (3) PA).
  - No criminal sanctions are provided for.
  - Invalidity may be raised as a defence following an objection. In the case of a pending invalidity action, the court trying the infringement case is not obliged to stay proceedings. Infringement cases are tried according to the provisional measures procedure, which is speedy, whereas an invalidity action takes some time before a decision is issued on the merits of the case.
  - The infringement is statute-barred after five years from the date on which the owner of the patent noted the infringement or the damage and the person who is obliged to give compensation, and at most twenty years after the infringement took place (Art. 17(4) PA).



- Remedies: injunction, damages, payment of the derived benefits, recall or removal from the channels of commerce, destruction of infringing products (Art. 17(1), 17B, 17D PA).
- Ordinary appeal: to the Civil Court of Appeal of Athens or Thessaloniki. Under certain circumstances an annulment (“cassation”) complaint can be filed at the Supreme Court.

#### Nullification

- Nullification may be requested during the entire life of a granted patent. The patent will be invalidated by the court on grounds named in Art. 15 PA (lack of novelty, unpatentability, scope of the patent or insufficient disclosure).
- A nullification action may be brought before the competent civil court by any person having a legitimate interest (Art. 15 §2 PA).
  - Patentees who are not residents of Greece are sued or may bring action in the courts of the capital (Art. 15 §2 PA).
  - The nullification of a granted patent has retroactive effect and also entails nullification of licences granted under that patent.
  - Partial nullification is available (Art. 15 §3 PA)

#### Declaration of non-infringement

Is not available.

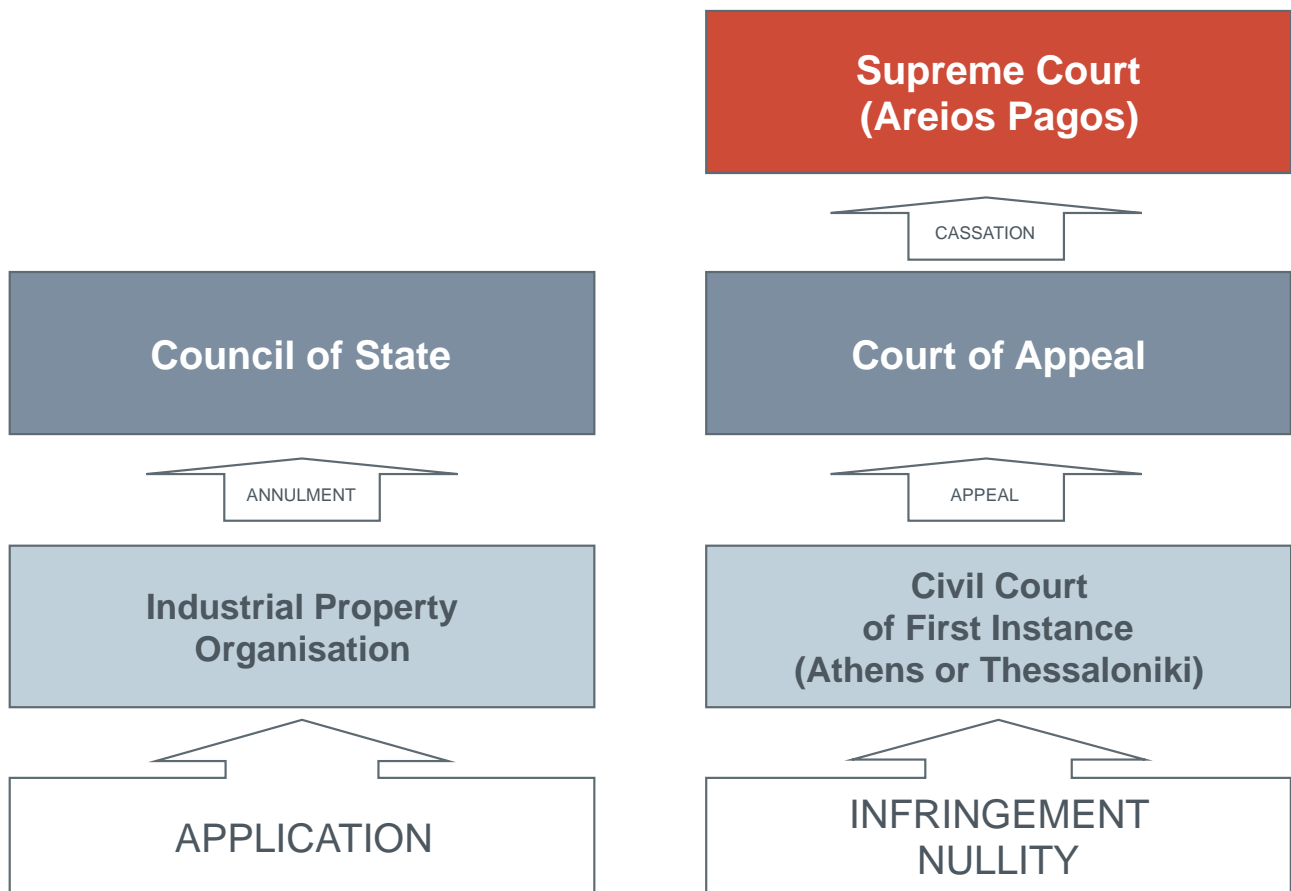
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### Compulsory licence

The competent court for the grant of a compulsory licence is the three-member Court of First Instance at the place of residence of the petitioner (Art. 13(10) PA). A compulsory licence may be granted in cases of non-working, dependent patents or public interest such as national defence or public health (in the latter case the licence is granted by a competent minister) (Art. 13, 14 PA).

### Bibliography

- Law 1733/1987 on Technology transfer, inventions and technological information, as amended [cited as: PA]; translation provided by Greek Patent Office
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- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 67 on Greece, 12/2002



## Croatia

### a. State Intellectual Property Office of the Republic of Croatia

#### Opposition

No pre- or post-grant opposition procedure is available in the case of patents. In the case of consensual patents (patents which are granted without substantive examination – Art. 41, 42 PA) any person may, within six months, file notice of opposition to the grant of a consensual patent (Art. 43 PA). The applicant for a consensual patent may, within six months from receipt of notification of the opposition, file a request for the grant of a patent on the basis of the substantive examination procedure. If the applicant for a consensual patent does not file a request, SIPO rejects the patent application (Art. 44, 45 PA).

#### Appeal

The boards of appeal for industrial property rights are responsible for deciding on appeals against the decision issued by the Patent Office at first instance (Art. 88-94 PA). The appeal should be filed within 30 days from the date of communication of the decision.

- Administrative disputes may be brought before Croatia's Administrative Courts of First Instance in accordance with ADA. On appeal the High Administrative Court (second instance) will examine the legality of the Administrative Court's first-instance judgment.

#### Nullification

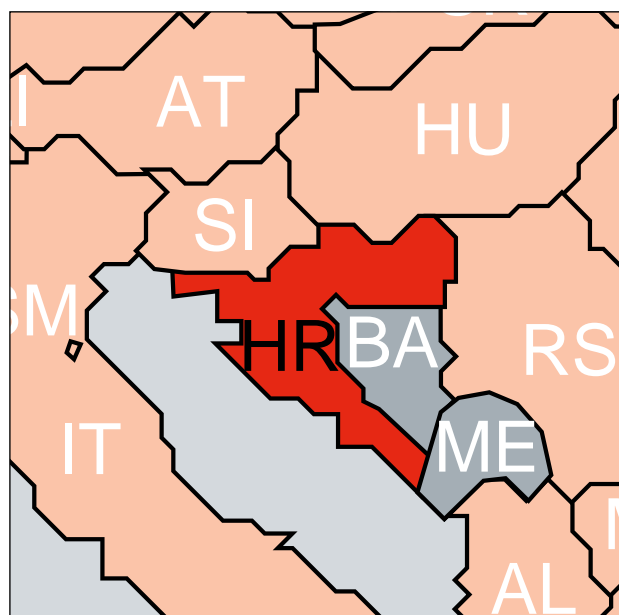
A decision to grant can be declared null and void if it is established that the conditions stipulated by law for granting a patent are not satisfied. A request can be submitted by anyone and at any time throughout the life of the patent, and should be filed with the Patent Office (Art. 79-83 PA). The proceedings may be continued even if the request for nullification is withdrawn by the person who filed it (Art. 82 PA).

#### Revocation

The decision on the grant of a patent may be revoked prior to expiry of the term of a patent for deficiencies in the deposited viable biological material (Art. 85-86 PA).

#### Reinstatement

Is possible in case of failure to observe prescribed time limits (Art. 57 PA).



### b. Civil procedure

#### Infringement

The patent owner or exclusive licensee is entitled to bring a civil action before the competent civil court (Commercial Courts in Zagreb, Rijeka, Osijek and Split) against any person who infringes the patent by performing any of the infringing activities (Art. 95 PA).

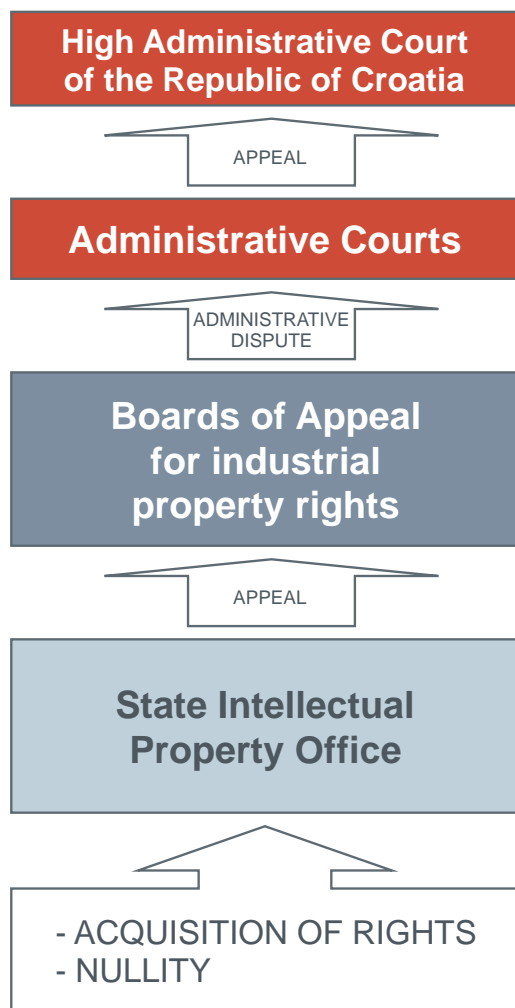
- The burden of proof rests with the defendant if the subject-matter of the infringement is a patent-protected process (Art. 95.h PA).
- If a nullity action is pending, the judge may decide to wait for the final decision on nullity, but he is not obliged to do so (Art. 95.m PA).
- Nullity can be used as a defence.
- Remedies: provisional measures (Art. 95.j PA), prohibition of certain acts (Art. 95.c and 95.f PA), damages (Art. 95.e and 95.f PA), seizure (Art. 95.j and 95.k PA) and destruction (Art. 95.d PA).
- An action for damages for infringement of a patent may be initiated within three years from the day of learning of the infringement and the infringer, but not after expiry of five years from the day on which the infringement was committed (Art. 95.e PA). An action for infringement of a patent may be initiated within five years from the day on which the infringement was committed.
- Appeal: ordinary appeal can be brought to the High Commercial Court of the Republic of Croatia.

### Compulsory licence

May be granted by the Commercial Court in Zagreb in cases of insufficient exploitation of a patent, national emergencies, the need for protection from unfair market competition, exploitation of another patent or protected plant variety, cross-licensing, and for the manufacture of pharmaceutical products intended for export to countries having public health problems (Art. 67.a–69.a PA).

### Bibliography

- Patent Act - Patent Act and Amending Patent Act and Act on Amendments to the Patent Act (OG No. 173/2003 of 31 October 2003, OG No. 87/2005 of 18 July 2005, OG No. 76/2007 of 23 July 2007, OG No. 30/2009 of 9 March 2009, OG No. 128/2010 of 17 November 2010, OG No. 49/2011 of 29 April 2011) [cited as: PA]; translation provided by the Croatian Patent Office
- Administrative Disputes Act (OG No. 20/2010 of 12 February 2010, OG No. 143/2012 of 20 December 2012) [cited as: ADA]
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HR



# Hungary

## a. Hungarian Intellectual Property Office

### Opposition

No pre- or post-grant opposition procedure. During the patent grant procedure any person may file observations with the Patent Office on the patentability of the application. Such observations will be considered by the examiner. The person making observations is not a party to the proceedings and has no right to request a review of the Patent Office's decision; however, he is notified of the outcome of the observations (Art. 71 PA).

### Modification/withdrawal of a Patent Office decision

The Patent Office may modify or withdraw its final decisions if a request for review is made and only until that request is transmitted to the court (Art. 53/A(3) PA). Decisions on the following matters can be reviewed: grant of a patent, decisions on lapse of patent protection and restoration, revocation, decisions on non-infringement, decisions on translation issues for European patents, and Patent Office decisions on compulsory licences under the Doha system (816/2006/EC). The court will terminate the proceedings if the Office withdraws its decision on:

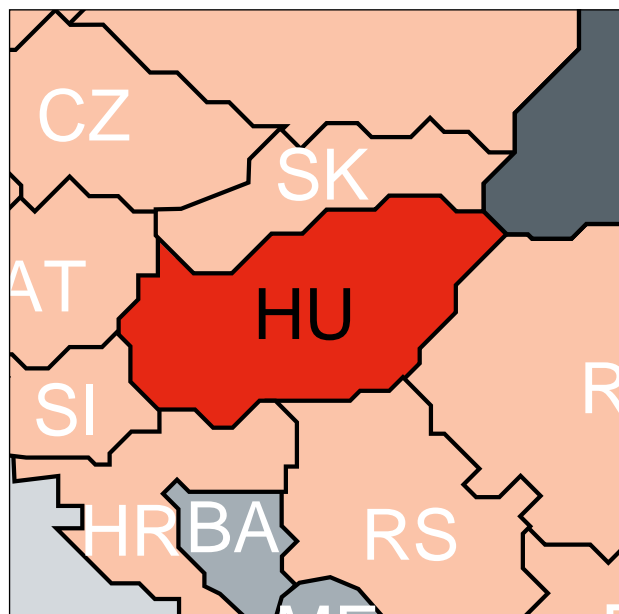
- suspending proceedings or on the entry in the Patent Register;
- excluding or limiting the inspection of files, against which independent legal remedy is admissible under the provisions of the Public Administrative Procedures Act;
- denying persons the legal status of a party to the proceedings, apart from those who have submitted a request for the institution of proceedings during the court proceedings.

If the Patent Office alters its decision, the court proceedings may continue only in respect of matters still pending.

### Revocation

Anyone (except the patentee) may make a request for revocation to the Patent Office (Art. 80, 42 PA). If a patent has been granted to a person not entitled to it, only a person who is thus entitled may make a request (Art. 80(2) PA).

- A decision is taken by a panel of three Patent Office employees (two technically qualified employees from the Patent Department, one lawyer – Art. 46(2) PA). The patent can be revoked (*ex tunc*) or limited, or the request can be refused. If the request is withdrawn, the proceedings can be continued *ex officio* (Art. 81(3) PA). If the request for revocation is rejected by a final decision, no new procedure on the same grounds may be instituted by any person (Art. 42 PA).
- In revocation proceedings and in actions for a decision on non-infringement, the Patent Office examines the facts within the framework of the request, on the basis



of the allegations or statements of the parties and of data substantiated by them (Art. 47(2) PA). In both procedures, the parties may request accelerated proceedings if patent infringement proceedings are initiated or a request for provisional measures is filed and the fact is proved (Art. 81/A, 83(4) PA).

### Decision of non-infringement

Any person who believes that infringement proceedings may be initiated against him may apply. The decision is taken by the Patent Office. The request can be filed only prior to any infringement proceedings being instituted. Infringement proceedings may not be instituted in respect of a product where the declaration has been issued (Art. 37 PA). (For further information on non-infringement proceedings, see also the last paragraph under Revocation.)

### Restoration

The Patent Office may restore a patent which lapses due to non-payment of renewal fees. A request must be lodged within three months after expiry of a grace period (Art. 40 PA).

## b. Civil procedure

### Judicial review of Patent Office decisions

Only the Budapest-Capital Regional Court is competent to hear requests for the review of Patent Office decisions in accordance with the rules of non-contentious civil procedure (Art. 88, 86, 85 PA). The Patent Office is not a party to the court proceedings; however, it can submit its opinion in writing. The request has to be made within 30 days of the date of communication of the decision of the Patent Office, which forwards it to the Budapest-Capital Regional Court within 15 days (Art. 85(6), (9) PA).

- A request can be made by any party, by any person excluded from, or limited in, the inspection of files or by any person whose legal status as a party to the proceedings has been denied (Art. 85(4) PA). The public prosecutor may request the review of decisions of grant or revocation. Any other party to proceedings before the Patent Office may submit an independent request for review of the decision or a provision of the decision relating to him (Art. 85(5) PA).
- Any person having a legal interest may intervene in the proceedings, until the court's decision becomes final (Art. 93(1) PA).
- The Budapest-Capital Regional Court sits in a chamber consisting of three professional judges, two of them having a technical university degree or the equivalent (Art. 87 PA).

If the court amends Patent Office decisions, the judgment replaces the Patent Office's decision (Art. 100(1) PA). The court repeals a decision and orders the Patent Office to start new proceedings if:

- the decision was taken with the participation of a person who could be objected to on the grounds of incompatibility/exclusion;
- substantive rules of procedure which cannot be remedied by the court were infringed during the proceedings before the Patent Office (Art. 100(2) PA).

If a party requests a court decision on a matter which was not the subject of the proceedings before the Patent Office, the court will refer the request to the Patent Office. If the request is referred the court will, if necessary, repeal the Patent Office's decision (Art. 100(3) PA).

- The review of a decision taken in *ex parte* proceedings before the Patent Office will be handled in *ex parte* proceedings before the court; in the case of *inter partes* proceedings before the Patent Office, the same parties take part in the court proceedings, as plaintiff and defendant.

### Infringement

Action must be brought before the Budapest-Capital Regional Court (Art. 104 PA). Claims are subject to private law. Criminal sanctions are available in separate proceedings. The action may also be filed before the grant of a patent; however, the proceedings will be suspended until the final decision on the grant is reached (Art. 36 PA).

- The court usually suspends its proceedings if the validity of the patent is questioned (revocation proceedings pending at the Patent Office); however, there is no legal obligation to do so.
- Remedies: denunciatory measures, injunction, surrender of enrichment, seizure, destruction, damages (Art. 35, 35/A PA), provisional and precautionary measures (Art. 104 PA).

### Compulsory licence

May be granted by the Budapest-Capital Regional Court in cases of lack of exploitation or a dependent patent (Art. 31-33 PA). Additionally, the Patent Office grants compulsory licences under the Doha system (Art. 33/A PA).

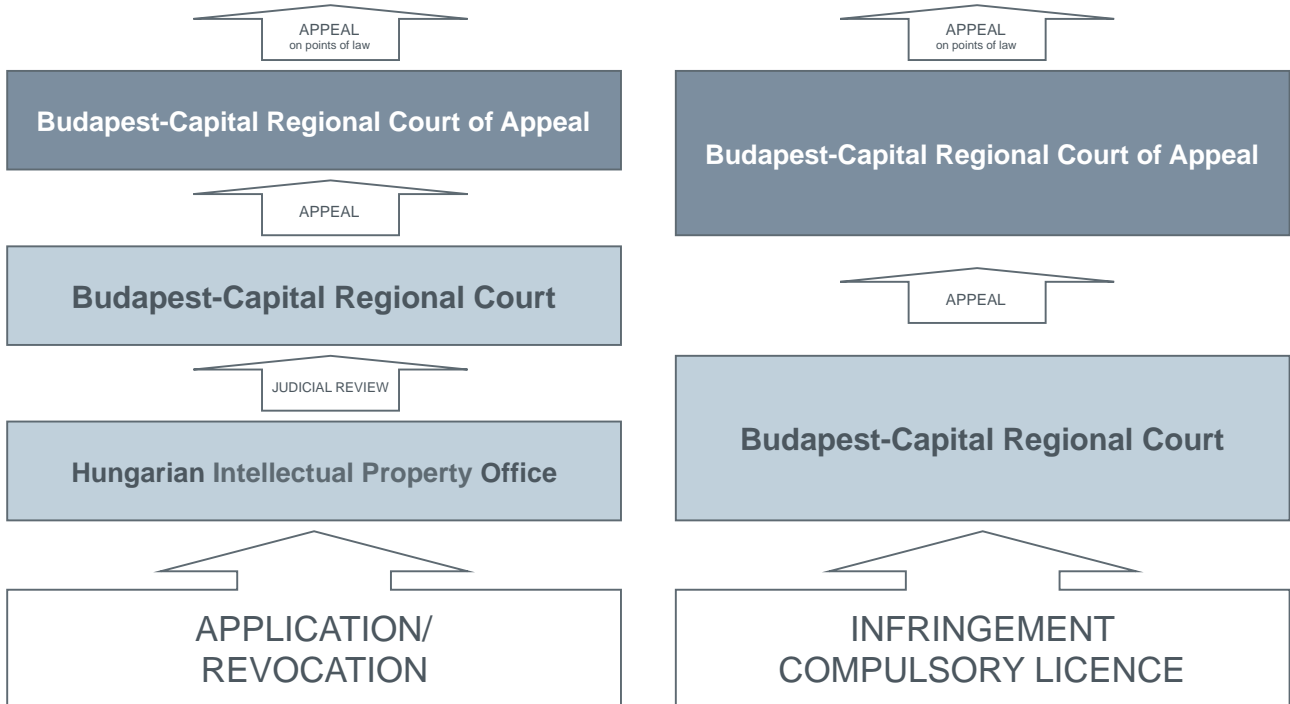
### Appeal

Ordinary appeal from the decisions of the Budapest-Capital Regional Court to the Budapest-Capital Regional Court of Appeal. Further appeal to the Curia of Hungary only on important points of law; this is not an ordinary remedy available against all decisions. IP matters are decided by the civil division.

### Bibliography

- ACT XXXIII of 1995 on the Protection of Inventions by Patents - consolidated text of 1 April 2013 [cited as: PA]; translation provided by the Hungarian Patent Office
- "Patents throughout the World", 2008 Thomson Reuters/West, Chapter 76 on Hungary, 4/2004
- "Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World", edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Hungary, No. 107, September 2006
- "Presentation of the national proceedings with regard to the validity and enforcement of patents" (HU), Hungarian Patent Office, 2007, EUROTAB 8/2007
- "The Enforcement of Patent Rights in Hungary", Zoltan Bercesi, ILC Studies, Volume 23, Patent Enforcement Worldwide, pp. 269-281, Oxford and Portland 2005

# Curia of Hungary





# Ireland

## a. Irish Patents Office

### Opposition

No formal pre- or post-grant opposition procedure is available. A third party may only oppose the restoration of a patent or amendments to a granted patent (Sections 36(5), 38(5) PA).

### Appeal

All decisions or orders of the Controller can be appealed to the High Court (Section 96 PA).

- The notice of appeal to the High Court must be given within three months of the date of the order or decision that is to be appealed (Section 96(6) PA).
- Further appeal to the Supreme Court may only be based on a question of law (Section 96(7) PA).

### Restoration

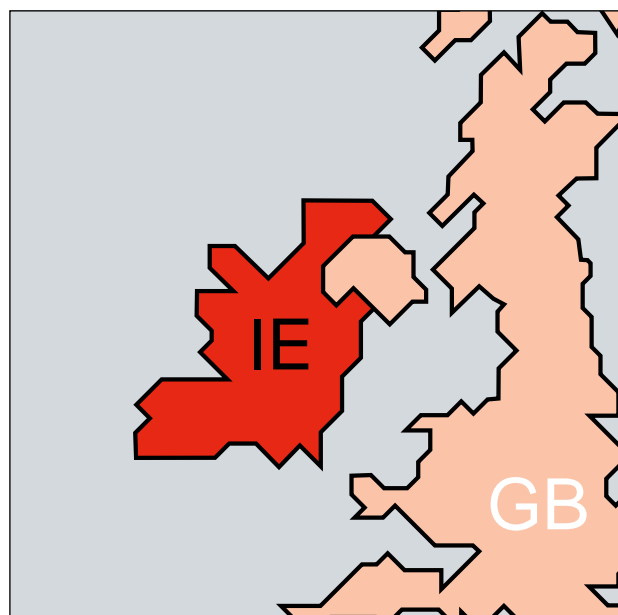
In cases of non-payment of renewal fees, lapsed patents may be restored (Section 37(1) PA).

### Reinstatement of applications

Where an application for a patent is refused or is treated as having been withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of the Act or rules made thereunder, the applicant may request the Controller to reinstate the application. The application for reinstatement must be made within a prescribed time and the Controller must be satisfied that the said failure to comply occurred despite reasonable care having been taken to so comply (Section 35A Patents Act 1992 as amended by the Patents (Amendment) Act 2006).

### Compulsory licence

May be granted by the Patent Office in cases of non-working, dependent patents and public interest (Section 70-75 PA).



## b. Civil procedure

### Infringement

Civil action should be brought before the High Court (Section 47(1) PA).

- The patent owner or the co-owner may bring the action (Sections 47(1), 48 PA). An exclusive licensee has the right to institute proceedings in respect of any infringement of the patent committed after the date of the licence (Section 51(1) PA).
- Invalidity may be used as a defence (Section 61 PA).
- In an action or proceedings for infringement or revocation of a patent, the High Court or the Supreme Court may, if it thinks fit, and must, if requested by all parties to the proceedings, call in the aid of an assessor specially qualified in the opinion of the Court, and try the case wholly or partially with his assistance (Section 95 PA).
- Remedies: injunction, an order requiring the defendant to deliver up or destroy any product covered by the patent, damages, account of profits, declaration that the patent is valid and has been infringed by the defendant (Section 47(1)(a)-(e) PA).
- The Court may not, in respect of the same infringement, both award damages to the proprietor of a patent and order that he be given an account of the profits (Section 47(2) PA).
- Infringement proceedings in respect of a short-term patent may be brought before the Circuit Court (irrespective of the amount of the claim). The proceedings may not be instituted until the patent proprietor has made a request for a search report from the Controller and has received a copy of it (Section 66 PA).

IE

### Declaration of non-infringement

A declaration that the use by any person of any process, or the making or use or sale by any person of any product, does not and would not constitute an act of infringement of a patent may be made by the Court in proceedings between a party and the proprietor of the patent or the holder of an exclusive licence under the patent, notwithstanding the fact that no assertion to the contrary has been made by the proprietor or licensee (Section 54 PA).

- The validity of a patent in whole or in part may not be called into question in proceedings for a declaration made by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent must not be deemed to imply that the patent is valid.

### Revocation

Any person may apply to the High Court or the Controller for the revocation of a patent (Sections 57(1), 59(1) PA) (subject to further exceptions – Section 57(2) PA).

- An application may be filed even if the patent has lapsed (Section 57(3) PA).
- If proceedings with respect to the patent are pending in the Court, no application for revocation may be made to the Controller without the leave of the Court (Section 57(5) PA).
- If an application is made to the Controller and the Controller has not disposed of an application, the applicant

may not apply to the Court for revocation unless either the proprietor of the patent agrees that the applicant may do so or the Controller certifies in writing that in his opinion the matter would more properly be determined by the Court (Section 57(6) PA).

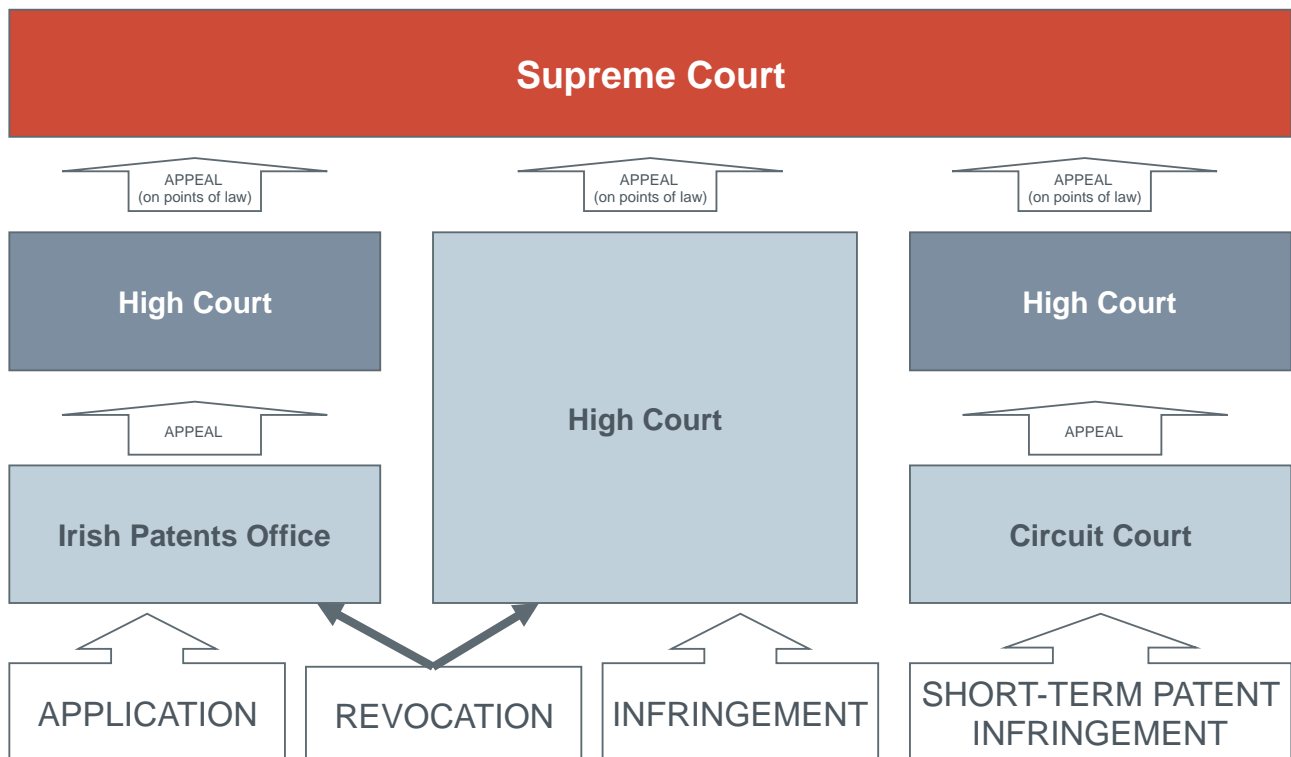
- Partial revocation is available (Section 59(3) PA).
- If it appears to the Controller that an invention for which a patent has been granted was described in an earlier patent, he may on his own initiative by order revoke the patent. The owner should be given an opportunity to make observations and to amend the patent specification (Section 60(1) PA).

### Appeal

From the decisions of the High Court at first instance, appeal may be lodged directly with the Supreme Court (restricted to points of law) – Section 96(7) PA.

### Bibliography

- Patents Act 1992, No. 1 of February 27 1992 [cited as: PA]
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Ireland, No. 104, January 2006
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 82 on Ireland, 5/2005



## Iceland

### a. Icelandic Patent Office

#### Opposition

Post-grant opposition is available (Section 21(1) PA). Anyone may file notice of opposition against the grant of a patent within nine months after publication of the grant. The opposition must be made in writing and must be reasoned. The fact of filing will be published. Opposition may be filed only on certain grounds (Section 21(2) PA).

- The owner of the patent will be notified of the opposition filed and will be given an opportunity to file his arguments (Section 23(1) PA).
- The Patent Office may accept opposition for processing even though a patent has lapsed or will cease to have effect due to its termination, the opposition has been withdrawn, or the opponent is deceased or has lost the right to proceed with such a case (Section 23(2) PA).

Pre-grant observations on a patent application may also be filed (Section 29 PR).

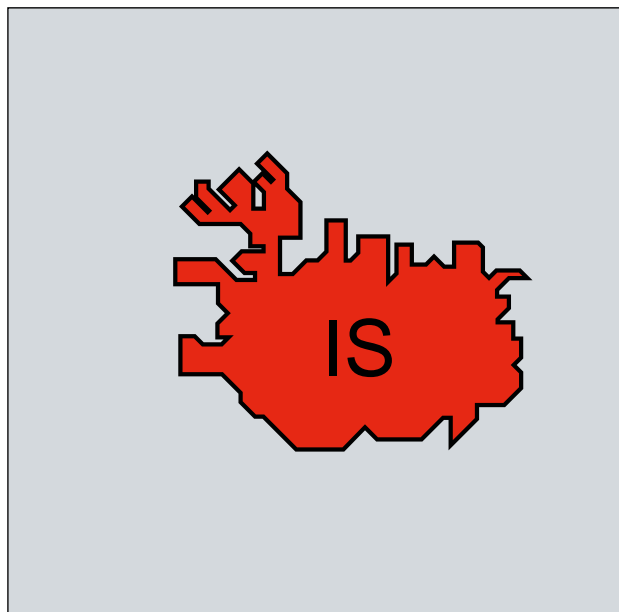
- The applicant will be informed and the Patent Office will take the observations into consideration.
- If the observation concerns a third-party claim of entitlement, the person concerned will be invited to bring the matter before Court within a set time limit (Section 17 PA). If such a matter is proceeded with, the Patent Office proceedings will be postponed until a Court decision has been given (Section 17(2)).

#### Appeal

An appeal against a final decision of the Patent Office concerning an application or a granted patent may be lodged with the Board of Appeal (Section 24 PA).

There are restrictions as to the persons who can legitimately file an appeal:

- The applicant may file an appeal against a final decision concerning a patent application.
- The patent owner may file an appeal against a decision reached in opposition proceedings which declares the patent invalid or maintains its validity in amended form.
- The opponent may file an appeal against a decision reached in opposition proceedings according to which the patent continues to be valid unamended or may continue to be valid with amendments. If the opponent withdraws his appeal, the case may nonetheless be examined if special circumstances support this course of action.



An appeal may also be lodged against decisions other than those mentioned in Section 24 (Section 67 PA).

The persons who may legitimately file an appeal under Section 67 PA are:

- an applicant, a patent holder, a person requesting invalidation or other parties with legitimate interests.

An appeal to the Board of Appeal, based on either Section 24 or 67 PA, must be lodged within two months from notification of the decision concerned (Sections 25(1) and 67(1) PA). Proceedings concerning Patent Office decisions which may be appealed to the Board of Appeal may not be brought before the courts until the decision of the Board of Appeal has been given (Section 25(3) PA).

A further appeal may be brought to the Reykjavik City Court against decisions of the Board of Appeal refusing a patent application or declaring a patent to be invalid, within two months from the date on which the party concerned was notified of the decision (Section 25(3) PA). An ordinary appeal from the decision of the Reykjavik City Court can be brought to the Supreme Court.

#### Restoration

No restoration is possible in case of failure to observe the time limit for lodging appeal with the Board of Appeal.

## b. Civil procedure

### Infringement

Action in infringement cases is to be brought before the Reykjavik City Court (Section 64 PA determines the competence of the Court). There is no chamber specialising in IP rights.

- Proceedings must be brought by the injured party (Section 57(3) PA).  
On complaint of an aggrieved party, criminal proceedings may be instituted against intentional infringement according to the LCP rules of procedure.
- In each particular case, the Chairman of the Reykjavik City Court can decide if a claim should be decided by a single judge or by a panel of three judges (two of whom can be technically qualified) (Section 2 ACP; Section 3 LCP). Court-appointed experts are further allowed upon request of either party, subject to ACP or LCP rules. The expert's opinion has a persuasive effect on the court's decision, but is not formally binding.
- In infringement proceedings, invalidity may be raised as a defence, provided that revocation of the patent has been or is requested (Section 61 PA).
- If the patent owner institutes proceedings for infringement of a patent and the defendant wishes to claim revocation of the patent, the defendant must inform the Patent Office and registered licensees that he intends to claim revocation. In this case revocation must be claimed within a prescribed period (Section 63(3) and (4) PA).
- Remedies: injunction, compensation, damages, alteration and destruction of infringing products (Sections 57-59 PA).
- Infringement action may also be brought in respect of commercial exploitation of the invention made without the consent of the applicant before the grant of the patent but after the application has been made available to the public (subject to further restrictions) (Section 60 PA).

Appeal: ordinary appeal may be filed with the Supreme Court, which acts as the court of second instance according to ACP and LCP rules.

### Declaration of non-infringement

Not available.

### Compulsory licence

Requests for the grant of compulsory licences may be made to the Reykjavik City Court in cases of non-working or dependent patents, prior commercial exploitation and public interest (Sections 45-48 PA). The Court decides on the grant and scope of the licence, the compensation for the owner of the patent and any further issues (Section 50 PA).

### Revocation

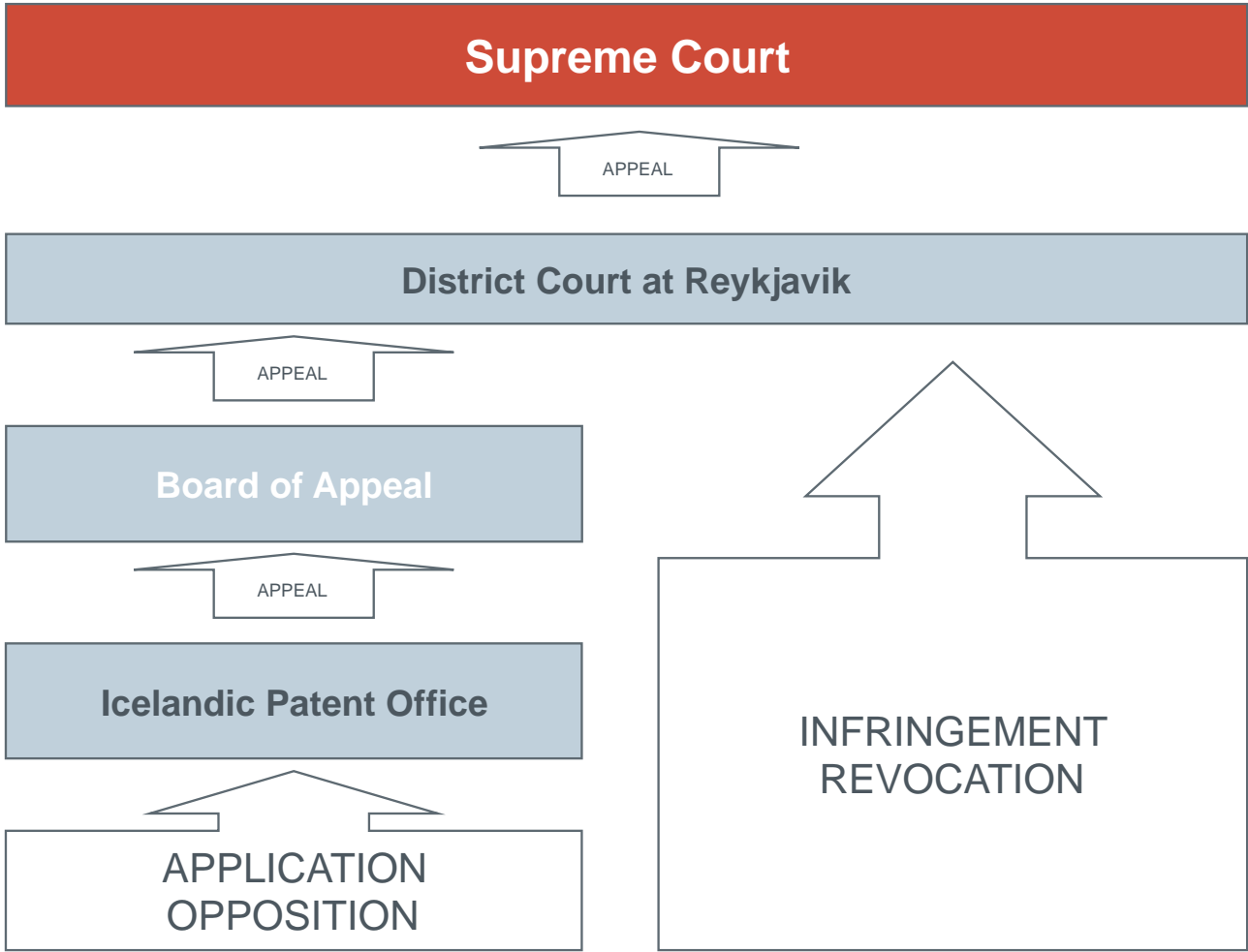
Revocation proceedings may be instituted by any person, subject to one exception (Section 52(3) and (4) PA). The Patent Office should be informed (Section 63(1) PA).

- Proceedings on the grounds that the patent has been granted to a person other than the one entitled to it may only be instituted by the person claiming entitlement, within one year after the entitled person obtained knowledge of the grant of the patent and of the other circumstances on which the proceedings are based (Section 52(4) PA). Furthermore, if a patent has been granted to a person other than the one entitled to it, the court transfers the patent to the entitled person if he so claims (Section 53 PA).
- A patent may be revoked by decision of the Reykjavik City Court (Section 52 PA). In each particular case the court will decide on the retroactivity of the final decision.

### Bibliography

- Patents Act No. 17/1991, with amendments according to Acts No. 92/1991, No. 67/1993, No. 36/1996, No. 91/1996, No. 132/1997, No. 82/1998, No. 28/2002, No. 72/2003, No. 22/2004, No. 53/2004, No. 54/2004, No. 12/2005, No. 127/2005, No. 108/2006, No. 167/2007, No. 98/2009, No. 25/2011 and No. 126/2011 [cited as: PA]; translation provided by the Icelandic Patent Office
- Regulation on patents No. 477/2012 [cited as: PR]; translation provided by the Icelandic Patent Office
- Act on Civil Procedure No. 91/1991 [cited as: ACP]; translation provided by the Ministry of the Interior
- Law on Criminal Procedure No. 88/2008 [cited as: LCP]; translation provided by the Ministry of the Interior







# Italy

## a. Italian Patent and Trademark Office

### Opposition

No pre- or post-grant opposition procedure is available. Third parties may only submit petitions during the examination process, pointing out the existence of prior patents; however, the observations will not have any further legal impact.

### Appeal

Appeal from refusal of the application must be filed within 60 days after notification by the Patent Office. The Appeal Committee will hear the interested parties or their agents and a Patent Office representative. The Appeal Committee is considered a judicial instance, as declared by the Constitutional Court. Any appeal from a decision of the Committee will therefore not go to an administrative court but to the Supreme Court.

### Compulsory licence

May be granted by the Patent Office in cases of non-working and dependent patents. Inability to obtain a contractual licence must be proven. The owner and those who have the right in the patent may start opposition proceedings. If reconciliation between the parties on granting of a compulsory licence is unsuccessful, the Ministry of Production Activities will take a decision (Art. 70-73 IPA).

### Restoration

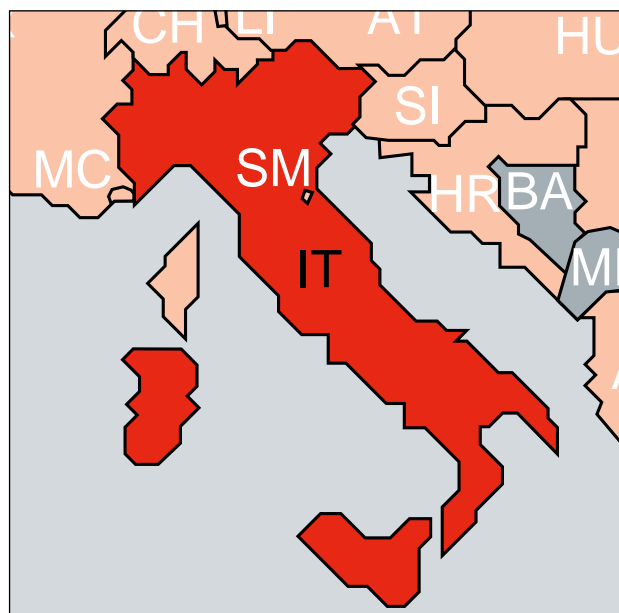
Restricted to cases of failure to observe time limits set by the Patent Office.

## b. Civil procedure

Legislative Decree 1/2012, converted into Law 27/2012, has established 21 Business Courts (district courts and appellate courts), with a Court of Appeal in each region, apart from Aosta. Each of these has jurisdiction for cases in corporate, competition and intellectual property law and public procurement. In Rome and Milan the Business Court is composed of two sections, one dealing with company and public procurement law cases, the other with IP, competition and public procurement law as well. Only professional and experienced judges are appointed to the specialised sections.

### Infringement

Civil and criminal actions are available. A civil action may be brought by a patentee, a patent applicant or the licensee (in the latter case, depending on the terms of the licensing contract) (Art. 120 IPA, modified by D. lgs. 131/2010).



- An action will be heard by the specialised division of the civil courts.
- During the investigative phase, and even in urgent cases, an expert appointed by the Court can be required to give an expert opinion on the existence of the infringement or the validity of the patent during the court proceedings. The judge is not bound by the evidence of the technical expert. The judge will evaluate it and may challenge it. However, if the judge does not agree with the expert, he has a duty to justify why he has rejected the expert's evidence.
- The expert can also be appointed to calculate damages caused by the infringement.
- A panel consisting of three judges will take the decision.
- The criterion for jurisdiction is based on the Brussels Regulation: the forum commissi delicti (the place where the infringing activity is carried out) or where damages have been incurred (Supreme Court decision 95/1996: where the initial damage occurred). If a nullity action is pending before a different court, staying of the proceedings is not compulsory. Invalidity will be decided in the same section of the proceedings, and the burden of proof is on the defendant.

### Remedies:

- Urgent measures: description and/or seizure of products; inhibition of manufacture, trade and use of products; recall of products from trade; civil penalties for non-compliance with or delay in execution of court orders; order to provide information, including third parties acting on a commercial scale, on the origin and distribution networks of the goods or on the provision of services (discovery implementing the Enforcement Directive).

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- Final measures: definitive inhibition of manufacture, trade and/or use of the products; recall of products from trade; seizure of infringing products. With regard to machinery and products: removal or destruction; assignment in property to the right holder; seizure until the expiration date of the IP right; award of product to the right holder on payment of a price; publication of the decision, or destruction of infringing articles; civil penalties for non-compliance with or delay in execution of court orders. Publication of the decision, order to pay compensation damages.
- Infringement can also be punished with a fine or imprisonment in criminal proceedings.

#### **Declaration of non-infringement**

Declaratory judgment on non-infringement is available, also as an urgent measure (Art. 76 et. seq. IPA).

#### **Nullity**

A nullity action may be brought by any interested party or a public prosecutor (Art. 76 et. seq. IPA).

- Nullity actions are judged by the same courts as infringement actions.
- If the action is withdrawn, the proceedings may be continued.
- Partial nullification is available; nullification has retroactive effect (*ex tunc*) (Art. 77 IPA).
- The burden of proof lies with the person contesting the patent.

#### **Appeal**

Questions both of law and of fact can be appealed to the territorially competent Court of Appeal (see Civil procedure above).

A collegiate body of three judges will review the decisions rendered by the Court of First Instance.

Further appeal: The Supreme Court may review the decisions rendered by the lower courts exclusively on matters of law. No specialist section has been established in the Supreme Court.

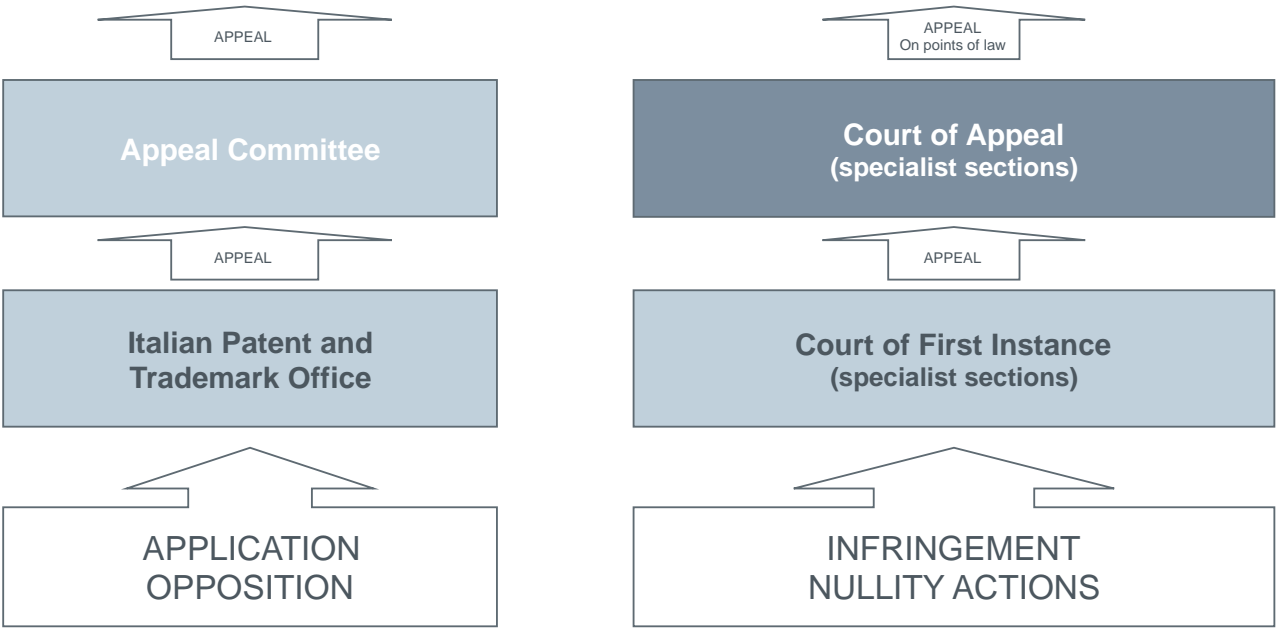
#### **c. Other**

- Arbitration may be resorted to. A judicial statement during the trial procedure is provided for, but it is not compulsory and is seldom successful.
- As the decisions concerning liability and the calculation of damages may be separate, the parties often settle once liability has been decided on and before damages are calculated.

#### **Bibliography**

- Industrial Property Code - Codice della proprietà industriale, 2005 [cited as: IPA]; D. lgs. 10 February 2005, No. 30
- Legislative Decree of 27 June 2003, No. 168 – Institution of Specialized Courts for Industrial and Intellectual Property located at the Courts of Appeal and Tribunals according to Art. 16 of the Law of 12 December 2002, No. 273, as modified by Decree No. 1/2012, converted (with amendments) in Law No. 27/2012 (D.L. 24 January 2012, No. 1, supplemented by D.L. 24 March 2012, No. 29, and converted, with amendments, into Law 24 March 2012, No. 27, in force from 25 March 2012
- “Italy turns a new leaf in IP legislation”, The New Industrial Property Code and Other Provisions Against Piracy and Counterfeiting, Decrees No. 30/2005 and No. 35/2005) - [http://www.sib.it/engsib/sibprima/issues/SIB03\\_05%20Client%20alert.pdf](http://www.sib.it/engsib/sibprima/issues/SIB03_05%20Client%20alert.pdf) (as on 1 December 2007)
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- “The Enforcement of Patent Rights in Italy”, Giovanni Casucci, IIC Studies, Volume 23, Patent Enforcement Worldwide, pp. 189-203, Oxford and Portland 2005
- “Das neue italienische Gesetzbuch für das gewerbliche Eigentum”, Vincenzo Di Cataldo, pp. 185-196, GRUR Int 2007, vol. 3

**Supreme Court**  
(Corte di Cassazione)

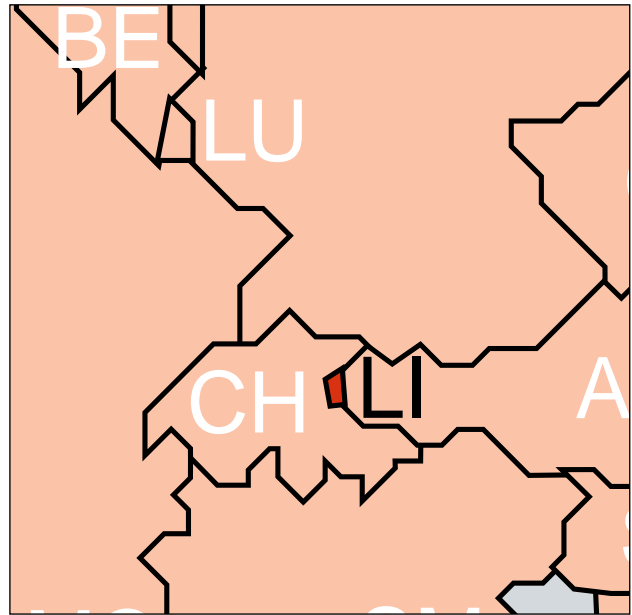


IT



## Liechtenstein (see Switzerland page 17)

The Swiss Patent Office is the competent authority for patent applications in Liechtenstein.







# Lithuania

## a. State Patent Bureau of the Republic of Lithuania

### Opposition

No pre- or post-grant opposition procedure is available.

- After publication of a patent application any person may inspect it (Art. 27 PL).

### Appeal

The Patent Office's Appeals Division is responsible for settling all pre-grant disputes between the applicant and the examiner with respect to the filing date, the priority date, the examination findings and refusal to grant a patent (Art. 51 PL). The appeal has to be filed within three months after the decision date.

- The applicant may appeal to the Vilnius County Court against the decision of the Appeals Division within three months.
- The decision of the Vilnius County Court can be appealed to the Court of Appeal. Annulment ("cassation") is possible and will be dealt with in the Supreme Court of Lithuania, but this court does not rule on points of fact, only on the application of the law.

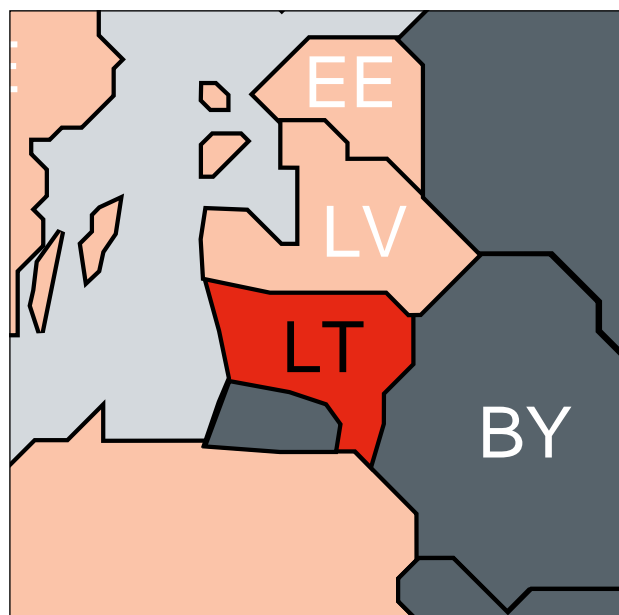
## b. Civil procedure

The Vilnius County Court is solely responsible for disputes regarding: (1) decisions of the Patent Office's Appeals Division; (2) assignment of a patent application or patent ownership to a different person; (3) full or partial invalidity of a granted patent; (4) infringement of a patent application for which provisional protection is granted; (5) infringement of a granted patent; (6) declaration of non-infringement of a patent; (7) granting, revocation and change of conditions for compulsory licences (as described in Articles 48 and 49 PL); (8) revocation of a patent (Art. 51 PL).

### Infringement

Infringement proceedings must commence in the Vilnius County Court.

- The action may be brought by the applicant, the proprietor or an exclusive licensee.
- Provisional protection will be provided for a published patent application from the date of its publication until the date of patent grant (Art. 26 PL). The applicant provisionally acquires the rights of the owner of the patent; he can apply for the application of remedies, such as the recognition of rights, and can require the termination of infringing acts as well as compensation for the material damage incurred, etc. (Art. 52 PL).
- Experts can be involved in the proceedings; however, their opinion is not binding on the court.
- Invalidity can be used as a defence. If the invalidity



procedure is already pending, the court will suspend the infringement proceedings until the question of invalidity or revocation is resolved.

- Remedies: temporary or permanent injunction, damages, expenses (Art. 52 PL).

### Invalidation

On request any person concerned may institute proceedings to invalidate a patent (Art. 63 PL).

- Partial invalidation is available. Invalidation has retroactive effect (Art. 63 PL).
- If the action is withdrawn, the proceedings will not be continued.

### Declaration of non-infringement

Any person concerned may institute court proceedings against the owner and request the court to declare that the performance of a specific act does not constitute infringement of the patent (Art. 59 PL). If the person concerned proves that the acts performed by him do not constitute infringement of the patent, the court issues a decision of non-infringement.

### Appeal

Decisions of the Vilnius County Court can be appealed to the Court of Appeal within thirty days after the decision date. Annulment ("cassation") is possible and will be dealt with in the Supreme Court of Lithuania (on questions of the application of the law).

### Compulsory licence

May be granted by the Vilnius County Court. Applicants must demonstrate that:

(1) they have applied unsuccessfully to the owner of the patent for a biological invention or the holder of a plant variety right to obtain a contractual licence;

(2) the plant variety or the biological invention constitutes significant technical progress of considerable economic interest compared with the invention claimed in the patent or the protected plant variety (Art. 48 PL).

- Compulsory licences concerning pharmaceutical products may be granted by the Ministry of the Economy.
- An invention may be exploited with the authorisation of the Government (Art. 50 PL): the Government may adopt a resolution to permit a person to market, without the consent of the owner of a patent, a patented invention within the territory of the Republic of Lithuania if: (1) an invention protected by a patent is related to public needs, national security, public health protection or the development of economically important sectors; (2) the court determines that a method for exploiting an invention employed by the proprietor or licensee is anti-competitive.

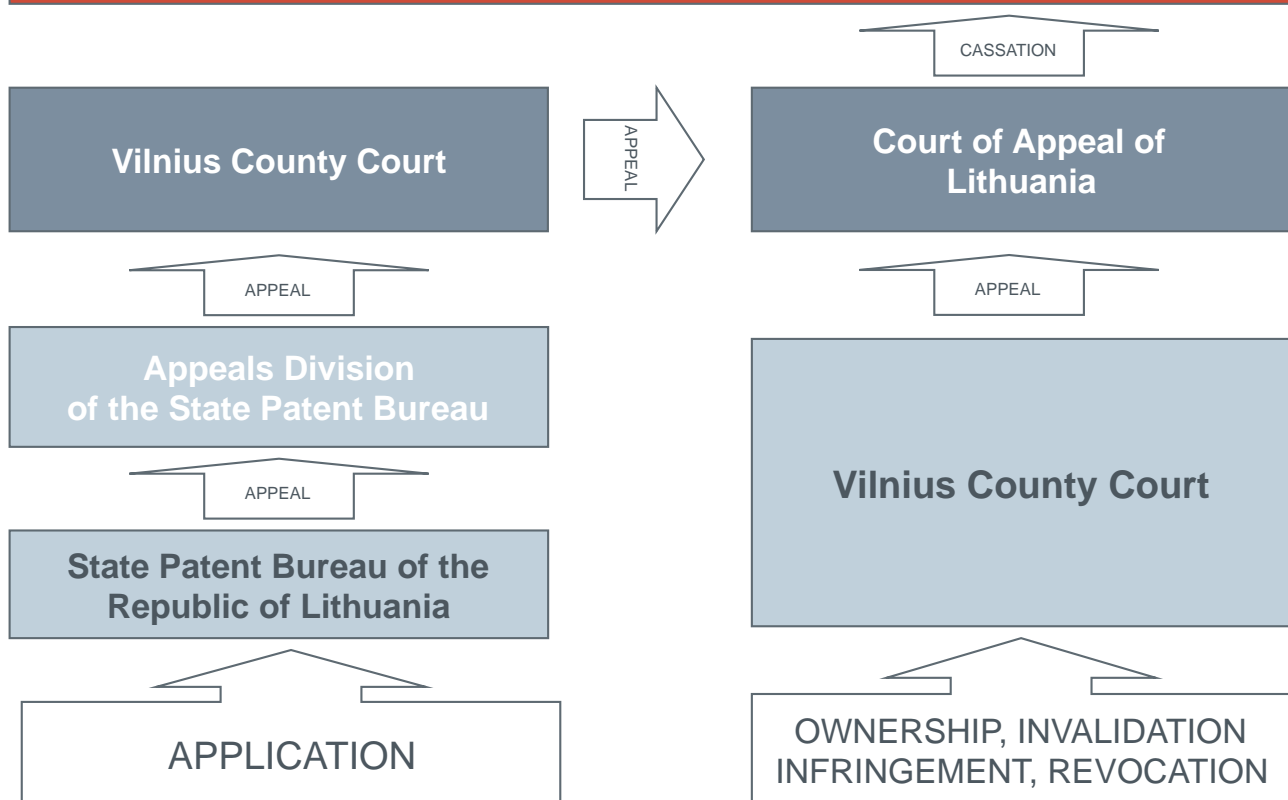
### c. Other

The patent law of the Republic of Lithuania has been recently revised to implement provisions of the Patent Law Treaty, and a new wording of the Patent Law has been enacted by Lithuanian Parliament.

### Bibliography

- Patent Law of the Republic of Lithuania of 18 January 1994, No. I-372; new edition of the Patent Law of the Republic of Lithuania in force since 3 February 2012 [cited as: PL]; translation of new edition of PL provided by the Lithuanian Patent Office

## The Supreme Court of Lithuania



# Luxembourg

## a. Intellectual Property Office

### Opposition

No pre- or post-grant opposition procedure is available.

- However, third parties may make observations on the patentability of the invention from the date on which the application is laid open to public inspection and up to the date on which the patent is granted (Art. 34-1 PA). The applicant may comment on them within four months, and these comments will be delivered to the party who made the observations (Art. 34-2 PA).
- The observations have no legal impact; they are only a measure for public consultation on the findings.

### Appeal

An appeal may be lodged with the Minister of Economic Affairs and Foreign Trade within three months of notification of the decision concerned (Art. 91 PA).

- An appeal with the Minister cannot be used by third parties to challenge the validity of a granted patent.
- Further appeal may be filed at the Administrative Court within three months of notification of the decision.

### Restoration

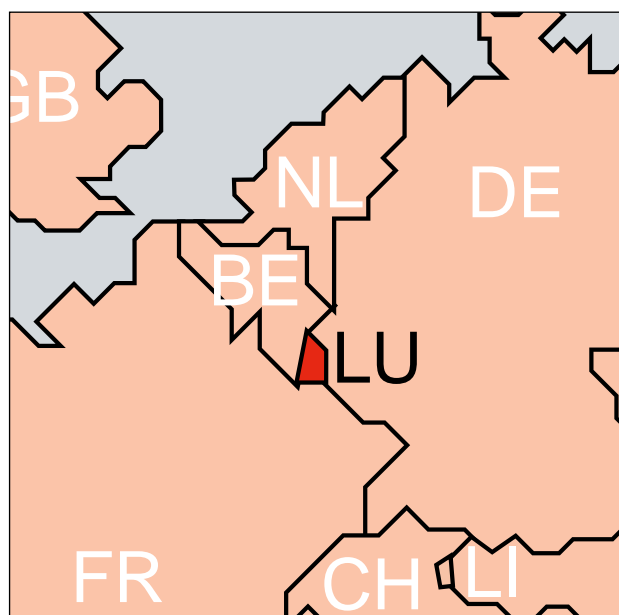
By the Patent Office, in case of failure to observe time limits despite all due care required by the circumstances (Art. 40 PA). In case of non-payment of renewal fees, individual reinstatement by ministerial order is available (Art. 67, 70 PA).

## b. Civil procedure

### Infringement

Action is subject to civil law and may be brought by the owner (Art. 76, 77-1 PA). However, the holder of an exclusive exploitation right may, except as otherwise stipulated in the licensing contract, institute infringement proceedings if, after notification, the owner of the patent does not institute such proceedings. The patentee is entitled to take part in the infringement proceedings instituted by the licensee (Art. 77-2 PA). No criminal action is possible.

- Infringement proceedings are heard by the District Court, regardless of the value of the claim (Art. 80 PA).
- Nullity may be used as a defence or counterclaim in infringement proceedings (the claim must be recorded in a register) (Art. 80-3 PA). The court is not obliged to stay the infringement proceedings if the nullity issue is raised.
- Action is statute-barred after three years from the last infringing act.
- Remedies: injunction, compensation for damages, prohibition from continuing the infringement, confiscation, destruction, and publication of the court decision (Art.



79, 80, 81 PA).

- Appeal: ordinary appeal may be filed with the Court of Appeal within 40 days after notification of the first-instance decision. Further appeal to the Court of Cassation may be filed within two months after notification of the decision.

### Nullification

An action for nullification of the patent may be directed, after grant, to the court of the elected domicile of the patent owner (Art. 73, 74 PA). Action may be brought even if the patent has lapsed (Art. 74 No. 6 PA).

- Anyone may bring an action. The public prosecutor may apply ex officio for nullification of a patent (Art. 74, No. 5 PA).
- Partial nullification is possible (Art. 73-2 PA).
- Nullification has retroactive effect.
- Appeals: ordinary appeal may be filed with the Court of Appeal within 40 days after notification of the decision. Further appeal to the Court of Cassation may be filed within two months after notification of the decision.

### Compulsory licence

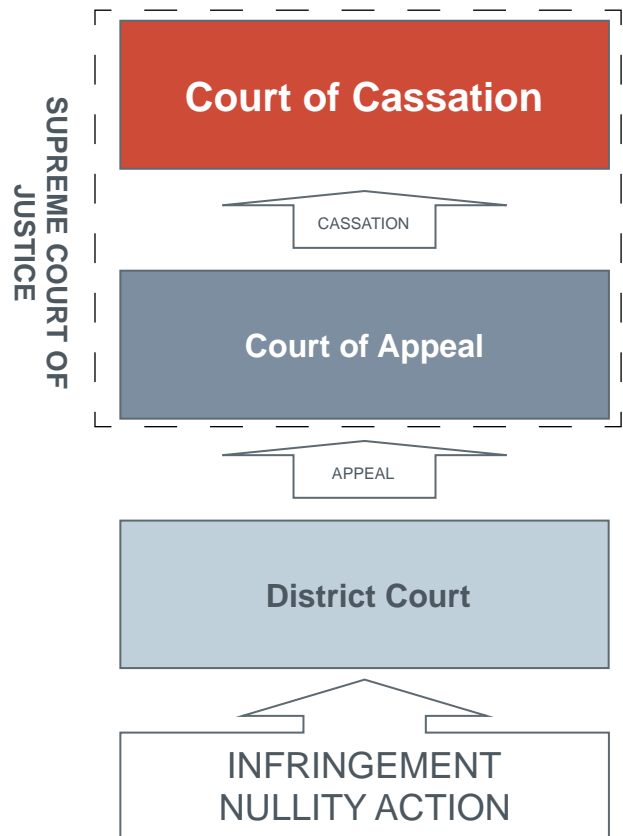
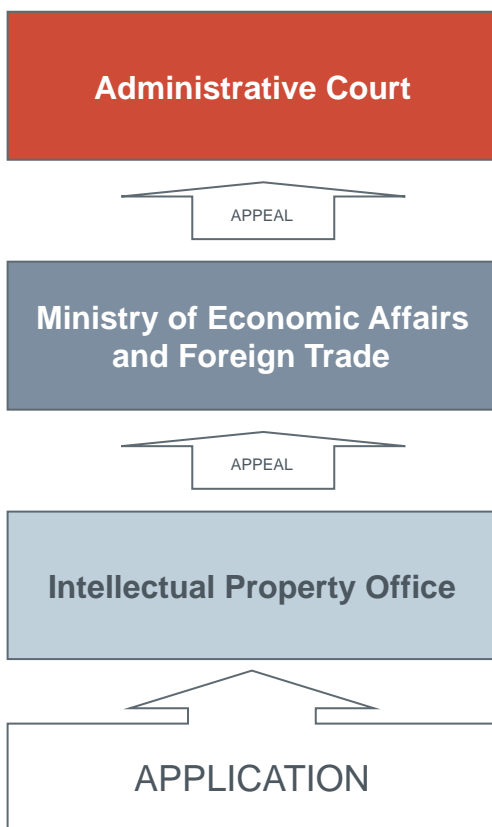
May be granted by the court in cases of non-working, dependent patents and public interest (ex officio - order by the Grand Duke on advice of the State Council; in such cases the question of remuneration will be considered by a court - Art. 59-66 PA).

**c. Other**

Directive 2004/48/EC has been implemented by the law of 22 May 2009.

**Bibliography**

- Patent Law 20 July 1992 - as amended on 24 May 1998 [cited as: PA]; translation provided by WIPO
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Luxembourg, No. 104, January 2006
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 134 on Luxembourg, 12/2002



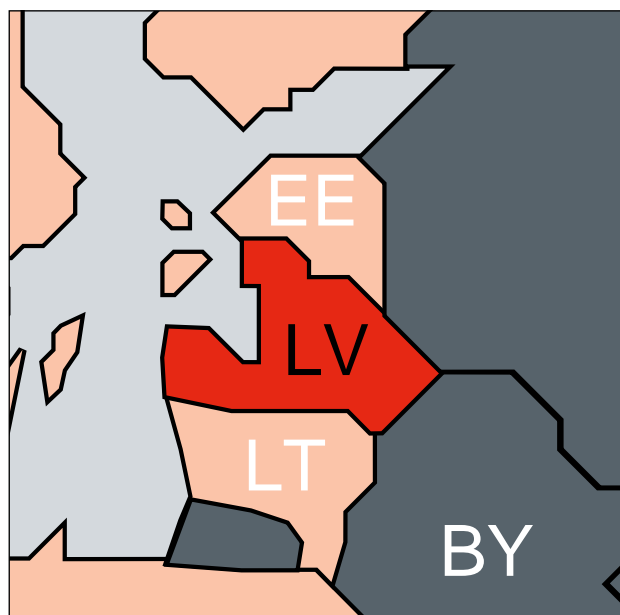
# Latvia

## a. Patent Office of the Republic of Latvia

### Opposition

No pre-grant opposition procedure is available.

- An opposition against the grant of a patent (post-grant opposition) can be examined by the Patent Office's Board of Appeal if the request is filed within the first nine months after publication of notification of the grant of the patent (Section 41(1) PL). Opposition against the grant of a patent may be filed only on the following grounds: lack of industrial use, subject of an invention and non-patentable subjects, biotechnological inventions, clarity and completeness of the description of the invention, clarity and conciseness of the claims, their support in the description or amendments beyond the original filing (Section 41(2) PL).
- The grant of a patent may be contested in court on the basis of other requirements of the Patent Law, according to the procedures specified by the Civil Procedure Law (Section 41(3) PL). Opposition against the grant of a patent may be lodged by any person. The Board of Appeal informs the owner of the patent that opposition has been filed and sets a period of three months for the filing of a reply (Section 41(4) PL).
- The opposition is examined within three months after receipt of a reply from the owner of the disputed patent or after expiry of the period set for the filing of a reply. The appellant and the owner of the disputed patent are invited to the meeting of the Board of Appeal where the opposition against the grant of the patent is examined. They are entitled to file the necessary documents and materials, and to provide oral explanations (Section 42(3), (4) PL).
- The Board of Appeal announces the operative part of the decision at the end of the meeting, but a substantiated written decision is sent to the persons concerned within one month. If a decision of the Board of Appeal does not satisfy the participants in a case, any such person within a period of six months after receipt of the true copy of the decision may appeal that decision to the court, according to the procedures specified by the Administrative Procedure Law (Section 42(7) PL).



### Appeal

- If an applicant or another addressee of a Patent Office decision (the owner of the patent, the former owner of the patent, the successor in title, the licensee) disagrees with the results of the review of the application or with a Patent Office decision taken at another stage of the patent grant procedure, he is entitled, within three months from the date of receipt of the decision and after payment of the appropriate State fee, to file a substantiated written appeal with the Patent Office. The filing of an appeal suspends execution of the Patent Office's decision (Section 39 PL).
- If the revocation or amendment of a decision concerns the rights or legal interests of a third person, or if the decision has not been revoked or amended within a period of two weeks after the filing of an appeal, the Patent Office transfers the appeal for review by the Board of Appeal (Section 40(2) PL).
- Every appeal is reviewed by an uneven number of members of the Board of Appeal, but by not less than three members. At least one of them must be a lawyer and at least one of them must be a specialist who is not an employee of the Patent Office. If necessary, the Board of Appeal may invite independent experts to provide an opinion in case of disputes (Section 25(3) PL).
- The parties may seek rejection of a member of the Board of Appeal (Section 25(4) PL).
- An appeal is examined within three months after its receipt at the Patent Office (Section 42(2) PL).
- If a decision of the Board of Appeal does not satisfy the parties, any party may appeal that decision to the court within six months after receipt of the true copy of the decision, according to the Administrative Procedure Law (Section 42(7) PL).

### Appeal according to the rules of civil procedure

Any interested person may dispute the granted patent, according to the Civil Procedure Law, irrespective of whether the decision of the Board of Appeal has been filed with the court. If such a claim has been filed before an administrative matter regarding a decision of the Board of Appeal is reviewed, the administrative proceedings are suspended until the claim has been adjudicated (Section 42(9) PL).

### Restoration

- An applicant who fails to observe a time limit may request continued maintenance of records (Section 45(1) PL).
- A request for continued maintenance of records must be filed not later than two months after receipt of notification from the Patent Office regarding failure to observe the time limit or of notification regarding the loss of rights, if the activities provided for in the unobserved time limit have been carried out and the State fee for the continued maintenance of records has been paid. If the activities provided for have not been carried out or the State fee for the continued maintenance of records has not been paid, the request is deemed to have been withdrawn (Section 45(2) PL).
- If the request for continued maintenance of records is satisfied, failure to observe the time limit has no legal consequences (Section 45(3) PL).
- Continued maintenance of records may not be requested if the two-month time limit, the time limit for the filing of appeals and oppositions or the time limit for the annual payment of the State fee by which the translation of the European patent claims in Latvian is to be filed has not been observed, or if a request for re-establishment of rights or for the change or attachment of priority or for the re-establishment of priority rights has been filed (Section 45(4) PL).

### Re-establishment of rights

- If the applicant or the owner of the patent fails to observe a time limit specified in the Patent Law in relation to the activities in the Patent Office, the direct consequences of such failure are refusal of the patent application, the patent application being deemed withdrawn, the revocation of the patent or the loss of other rights. The applicant or the owner of the patent may then request re-establishment of the relevant rights by filing a request with the Patent Office (Section 46(1) PL).
- The request for re-establishment must be filed within two months after removal of the reason for failing to observe the time limit, but not later than within one year after the end of the specified time limit. The request for re-establishment is deemed to have been filed once the State fee for re-establishment of rights has been paid (Section 46(2) PL).

- Re-establishment of rights is not applicable in case of failure to observe time limits for filing an appeal, an opposition, a request for re-establishment, the copy of the previous application, a request for the change or attachment of priority or a request for continuance of record-keeping, or for payment of the State fee for the patent application (Section 46(5) PL).

### b. Civil procedure

#### Infringement

- The patent owner or licensee can bring an action to the Riga Regional Court concerning the infringement of exclusive rights of the owner. The licensee has the right to bring a claim to court regarding illegal use of a patent, with the consent of the owner. The consent of the owner is not necessary if he does not bring the claim to court, even though the exclusive licensee has invited him to do so in writing (Section 62(1), (2) PL). The dispute will be reviewed by the court in accordance with civil law procedure (Sections 62(2), 65 PL).
- Responsibility for patent infringement arises only from the date a patent is granted and only for acts performed after that date.
- A person against whom a claim is brought to court in relation to illegal use of a patent may not object to the claim purely on the basis that the patent is not being exploited or its use has to be discontinued for other reasons. The defendant may bring a counterclaim to court for invalidation of the patent in conformity with the Patent Law. In such cases, patent infringement may be established if the patent is declared valid (Section 63(3) PL). As a result, nullity can be used as a counterclaim.
- In an infringement case the patent owner or exclusive licensee has to prove the fact of patent infringement and the guilt of the infringer (exception: when patents are granted for a process of making a new product – any identical product is considered as manufactured according to the patented process, unless otherwise proved) (Section 63(1), (2) PL).
- Action for infringement is barred after three years from the date when the aggrieved party discovers or should have discovered the fact of the infringement (Section 67(1) PL).
- Remedies: compensation for the losses incurred and moral damages, seizure of infringing products, allotment of the profits to the aggrieved party (Section 64 PL, Section 250.17 CPL).
- Parties may submit an appellate complaint regarding a judgment (supplementary judgment) of the Riga Regional Court (Section 413 CPL).

### Nullity

- A nullity action may be brought to the Riga Regional Court, based on the grounds of Sections 56, 57 and 65 PL. The action may be brought by any person (Section 57(2) PL).
- Exception: if the patent has been granted to a person who had no right to receive it, nullity may be requested by a person who has the right to the invention in accordance with Section 12 PL. Partial invalidation is available (Section 58(1) PL).
- Nullity has retroactive effect: the invention is deemed to lose the legal protection provided for in the Patent Law as from the filing date of the patent application to the extent that the patent has been declared invalid (Section 59(1) PL).
- If the action is withdrawn, the proceedings will be continued.

### Compulsory licence

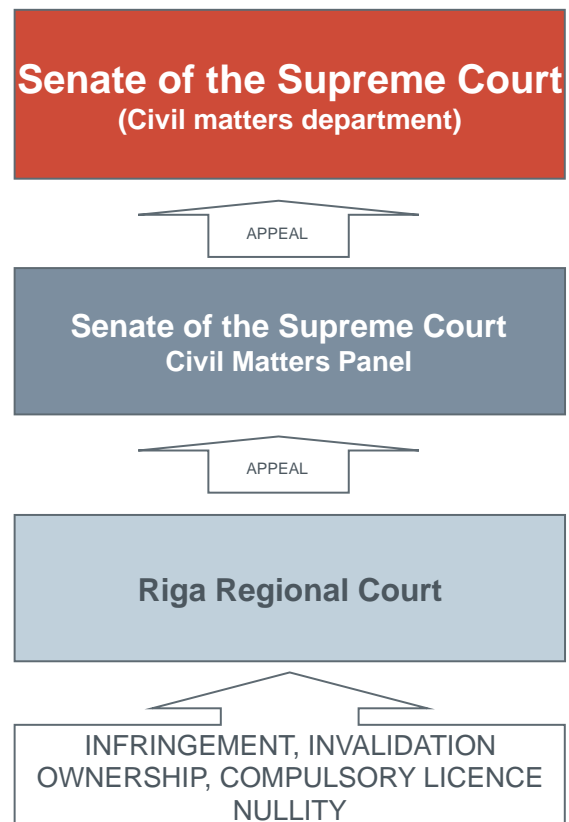
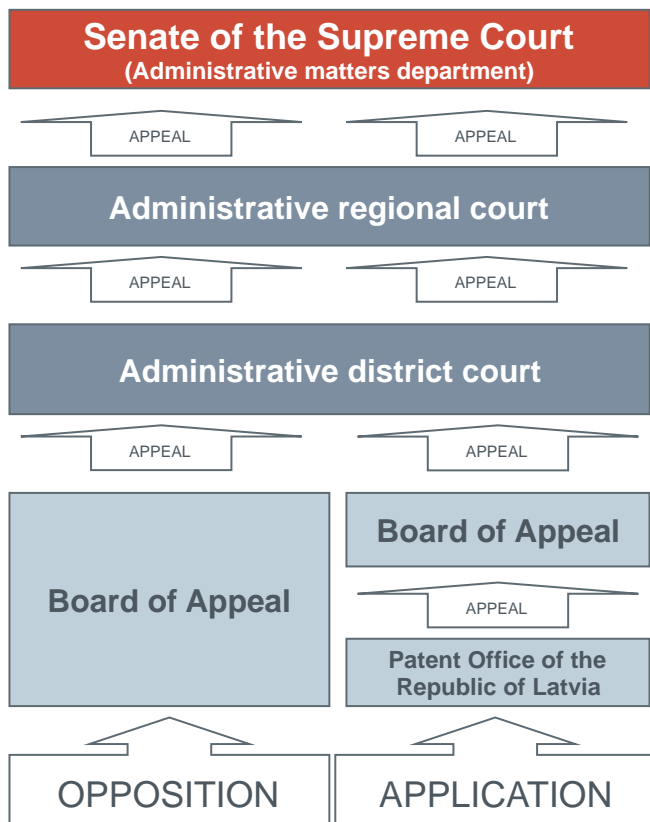
May be granted by the Administrative Court in cases of non-working and vital importance for ensuring the interests of Latvian citizens. A compulsory licence is granted for utilisation in the internal market of Latvia. The owner of a compulsory licence has to pay compensation to the owner of the patent, in an amount to be determined by the court in the light of the economic value of the licence, the extent of utilisation of an invention and other circumstances (Section 54 PL).

### Declaration of non-infringement

Any person may lodge an action with the court for a declaration of non-infringement. Determination of the non-existence of an infringement will be reviewed by the Riga Regional Court as the Court of First Instance according to civil procedures (Section 65(2) PL).

### Bibliography

- Patent Law of 15 February 2007, entered into force on 1 March 2007, published: Vestnesis, 27 February 2007, No. 34 [cited as: PL]; translation provided by Latvian Patent Office
- "Patents throughout the World", 2008 Thomson Reuters/West, Chapter 97 on Latvia, 12/2005
- "Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World", edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Latvia, No. 109, January 2007



LV





# Monaco

## a. National Patent Office of Monaco

### Opposition

No opposition procedure is available.

### Appeal

There is no possibility of appeal against the decision on the application.

- Third parties will only learn of the patent at the end of the filing stage, at which time it will be announced in a decree by the State Ministry (Art. 11, Law 606). However, this announcement may be subject to an action at the Supreme Court (Art. 89-92 of the Constitution) for abuse of power based on failure to respect the terms of Art. 6 of Law 606. To date there has been no such action.

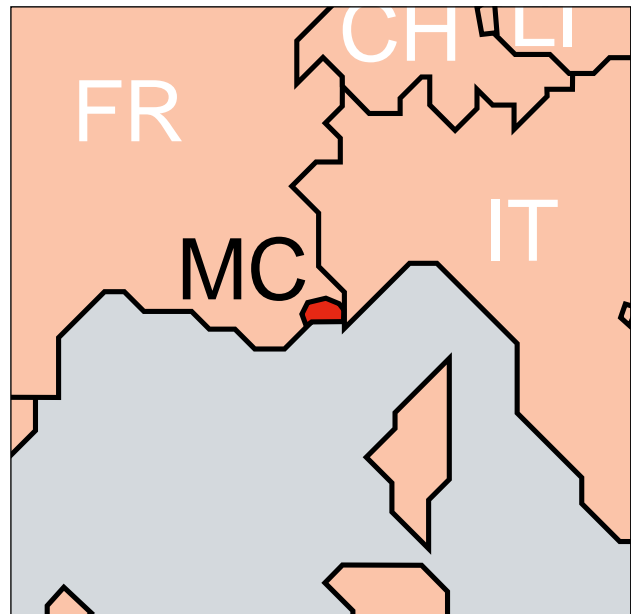
### Restoration

There is no provision for this.

## b. Civil procedure

### Infringement

- Civil and criminal proceedings are provided for.
- Criminal sanctions (Law 606, 20 June 1955) include fines and imprisonment in case of recidivism. These actions can be brought before a first-instance criminal court, but only by the infringed party.
- The owner of the patent may request a detailed description by a bailiff of infringing goods with or without seizure of same. In such cases the requester must institute civil or criminal proceedings within one week.
- Remedies: seizure, damages, confiscation of infringing articles, fine, imprisonment.
- Invalidity may be used as a defence both in the first-instance civil court (Art. 382, Civil Procedure Code) and in the first-instance criminal court (Art. 48, Law 606).
- There are no opposition proceedings for national patents, so infringement proceedings are not affected. However, in the case of a European patent designating Monaco, a stay could be declared at the discretion of the judge. This situation has never occurred.
- Appeals are heard at the Court of Appeal of Monaco for both civil and criminal proceedings.
- A further appeal may be lodged before the Court of Judicial Review following the general principles of law and procedure.



### Compulsory licence

May be granted by the court.

### Nullification

Any interested party may request nullification before the court.

- Nullity actions do not have to be lodged as separate proceedings. Although a nullity action may be lodged on its own, it can also be introduced during the first-instance infringement proceedings. Before criminal proceedings a nullity action can be raised only in defence of criminal infringement proceedings.
- Representation is mandatory in civil proceedings (Art. 179 CPC) and discretionary in criminal proceedings.
- If the action is withdrawn in civil proceedings, the proceedings will, if the parties agree, also be withdrawn (Art. 412 CPC).
- A judgment of nullity has retroactive effect (Art. 24, Law 606).
- Appeals may be lodged at the Court of Appeal.

### Declaration of non-infringement

There is no provision for this.

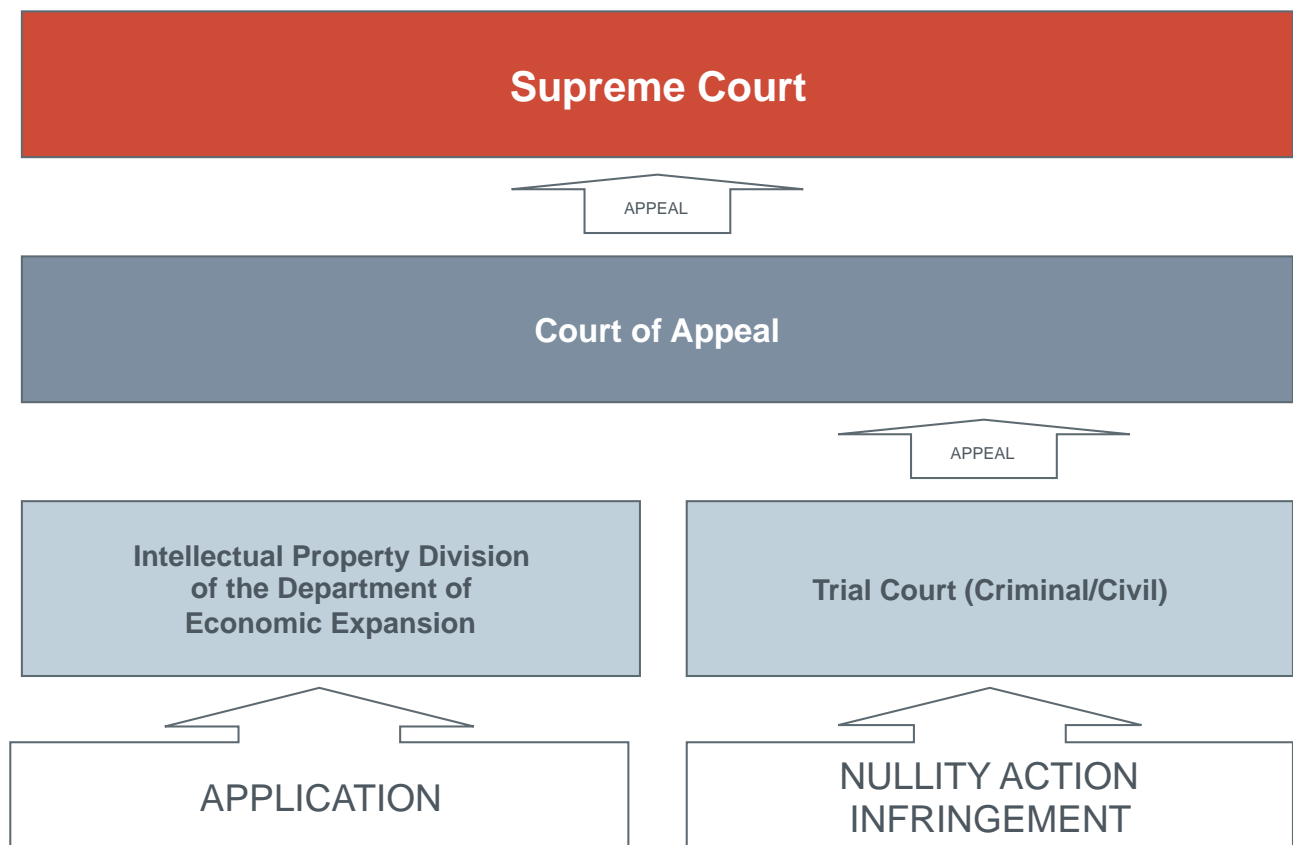
## c. Other

### Recent developments

- A reform of the national patent law is currently being discussed at government level.
- There are currently no plans to introduce specialised jurisdiction in the field of IP or patents.
- A study on arbitration is currently being examined. This could, in the short term, allow for an alternative resolution of IP litigation.

## Bibliography

- Law 606 of 20 June 1955 on patents of invention [cited as: Law 606]
- Code de procédure civil [cited as: CPC]
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Monaco, No. 83, April 1999
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 114 on Monaco, 12/2002



## Former Yugoslav Republic of Macedonia

### a. State Office of Industrial Property

#### Opposition

No pre- or post-grant opposition procedure is available. Patents are granted without examination for patentability.

#### Appeal

Patent Office decisions are final (Art. 19(1) PA). Administrative disputes may be brought before the Administrative Court of the Republic of Macedonia within 30 days from the date of the decision. Decisions of the Administrative Court can be appealed before the Supreme Court of the Republic of Macedonia.

#### Nullity

According to Art. 275 PA, the Patent Office will declare a decision to grant a patent null and void if it establishes that the conditions stipulated by Articles 25(3), 27 and 30 for granting a patent are not satisfied. The procedure may be initiated at any time throughout the life of a patent by the party concerned or ex officio.

#### Restoration

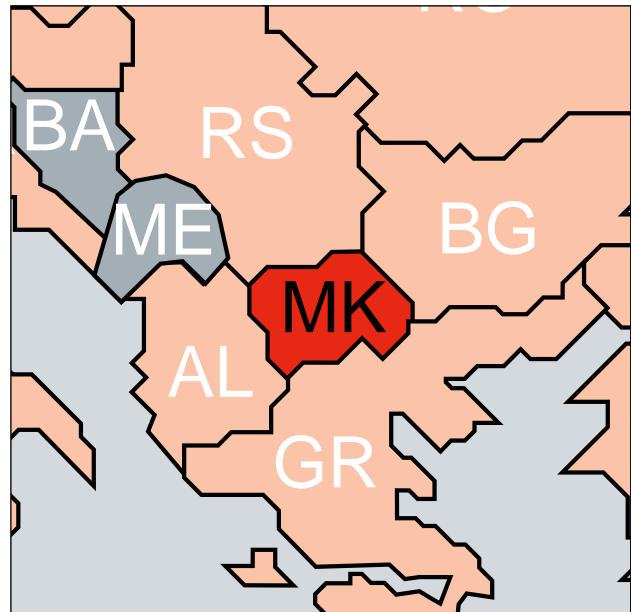
Available in case of failure to observe prescribed time limits in spite of exercising all due care required by the circumstances (Art. 268 PA).

### b. Civil procedure

#### Infringement

The patent owner may bring a civil action before the competent civil court (Art. 291(1) PA). Proceedings may be instituted against any person who is alleged to have performed an act of infringement under Art. 298(1) PA.

- Remedies: determination and cessation of the violation, compensation by damages, confiscation and destruction of infringing materials, alternative measures (the competent court may order payment of cash compensation to the damaged party as an alternative measure if the person was acting unintentionally and without negligence, and if implementation of the relevant measures would have caused him disproportionate damage and if the damaged party is satisfied with the cash compensation), civil punishment (if rights acquired on the basis of the Patent Law are violated, intentionally or with ultimate negligence, the holder of the right may ask for payment of the regular compensation increased to 200%, regardless of whether, due to the violation, he has suffered property loss in that amount), publication of the verdict (Art. 298, 299, 300, 301, 303 and 304 PA).



- The inventor may ask to be named in the application and other documents by filing a lawsuit to the competent court (Art. 306 PA). This is a separate procedure.

#### Compulsory licence

May be granted by the competent court in cases of insufficient exploitation, national emergencies, public interest in the area of public health (in the pharmaceutical industry), food, protection and promotion of the environment or if it is of particular interest to a certain industrial field or if it is necessary for implementing the judicial and administrative procedure related to protection of competition (Art. 97, 101(1) PA).

#### Courts

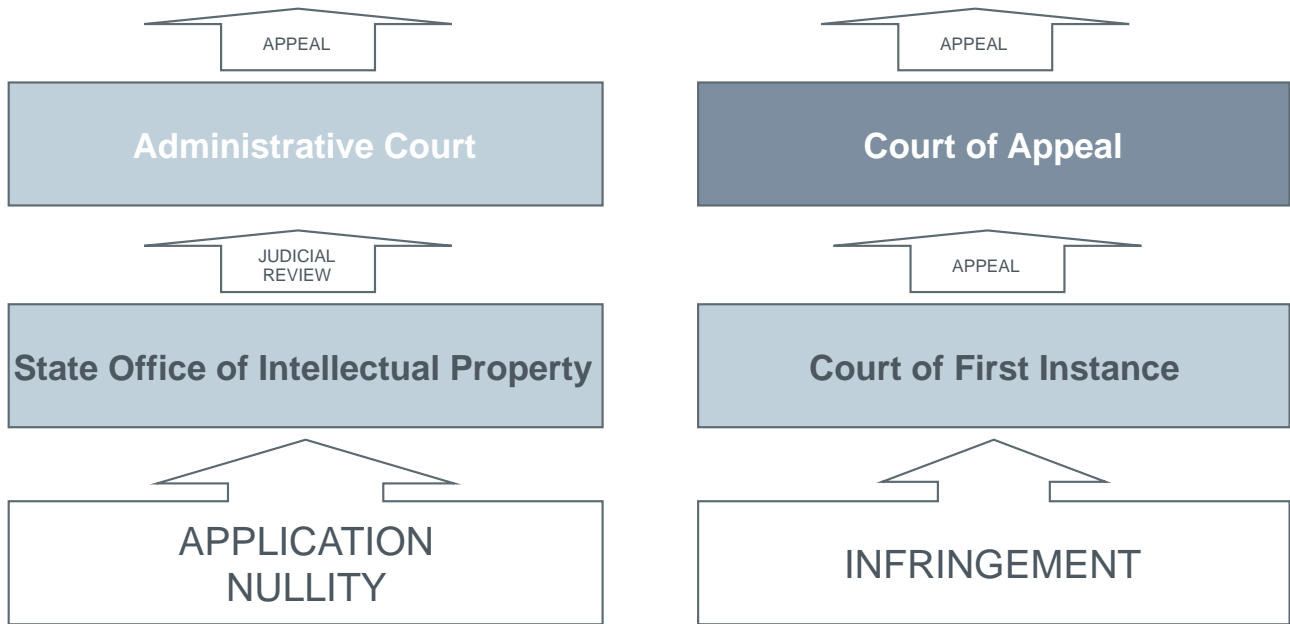
Specialised departments of 13 Courts of First Instance with enhanced competence have jurisdiction over cases related to intellectual property law.

- The Courts of Appeal are competent to decide on appeals against decisions of the Courts of First Instance.
- The Supreme Court is competent to decide at third and final instance on appeals against decisions of the Courts of Appeal.

#### Bibliography

- Law on Industrial Property No. 21/09 of 2009 [cited as: PA]
- Patent Regulations No. 92/09 of 2009

# Supreme Court



# Malta

## a. Industrial Property Registrations Directorate

### Opposition

No pre- or post-grant opposition procedure is available. A pre-grant opposition procedure is planned.

### Appeal

Decisions refusing the grant of a patent are appealable. Any appeal has suspensive effect (Section 58 PA).

- Notice of appeal is to be filed with the Office of the Comptroller of Industrial Property within two months from notification of the decision concerned. Grounds/ reasons must be indicated.
- Within three months the Comptroller may consider the appeal to be admissible and well-founded and rectify his previous decision. The applicant should be informed of the rectified decision within a further three-month period; otherwise the applicant may lodge an appeal with the Court of Appeal within two months from expiry of the two-month period from notification of the decision to be appealed against, or within two months from notification from the Comptroller that he has not rectified his decision, whichever period expires earlier.
- If the Comptroller rectifies his decision in full, no further appeal is available. In the case of partial rectification, the part that is not rectified is still appealable.

### Restoration

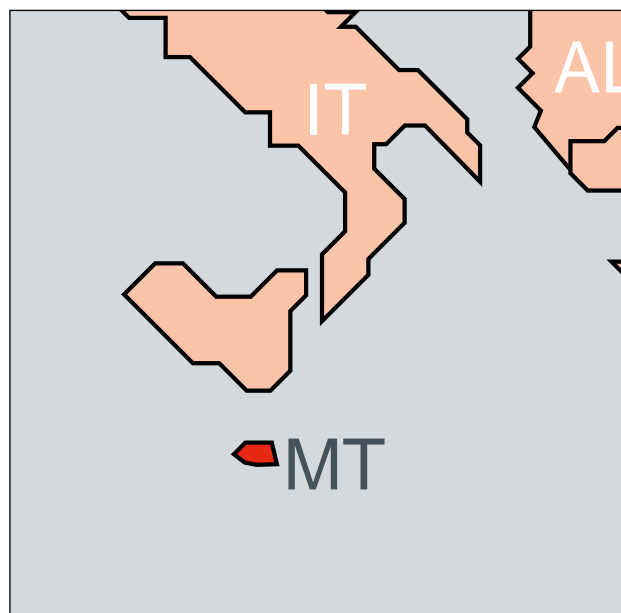
In case of failure to observe time limits or pay renewal fees, a request for restoration of rights may be made in writing to the Comptroller within two months from removal of the cause of non-compliance with the time limit or within the year immediately following expiry of the unobserved time limit, whichever is the earlier (Section 46 PA). An appeal against the refusal of an application for restoration can be filed within two months (Section 58 PA).

## b. Civil procedure

### Infringement

Infringement actions are to be brought before the Civil Court, First Hall (Section 48 PA).

- The Court may stay proceedings for infringement in respect of a patent application until a final decision has been made by the Comptroller to grant or refuse a patent on that application.
- The defendant in infringement proceedings may in the same proceedings request nullification of the patent concerned on any of the grounds for nullification. In such a case the Comptroller will be made a party to the proceedings (Section 48(4) PA).



- Infringement actions become statute-barred after five years from the date on which the aggrieved party became aware of the infringement.
- Patent infringement is also a criminal offence; proceedings may be initiated on complaint (Section 50 PA).
- Remedies: injunctions, damages, confiscation of the machinery and other means used to infringe the patent, as well as of the infringing articles and the apparatus destined for their manufacture, and their delivery up to the owner of the patent.
- Appeal: further ordinary appeal to the Court of Appeal.

### Declaration of non-infringement

Any interested party may institute proceedings before the First Hall of the Civil Court against the owner of a patent for a declaration that the performance of a specific act does not constitute infringement of the patent. Licensees have to be informed of the proceedings by the patentee and have the right to join them (Section 49 PA).

### Invalidation

A request for invalidation of a patent may be filed with the Civil Court, First Hall (Section 44 PA). Action may be taken during the lifetime of a patent and after the patent has lapsed.

- Invalidation has retroactive effect (subject to some exceptions – final and enforced decisions prior to invalidation; contract concluded prior to the invalidation decision, in so far as it has been performed before that decision).
- Partial invalidation is available.

### Compulsory licence

May be requested at the Civil Court, First Hall, by any person who proves his ability to work the patent invention in Malta if the patented invention is non-working or is insufficiently worked in Malta (Section 39 PA). The Court will direct the Comptroller to grant a compulsory licence.

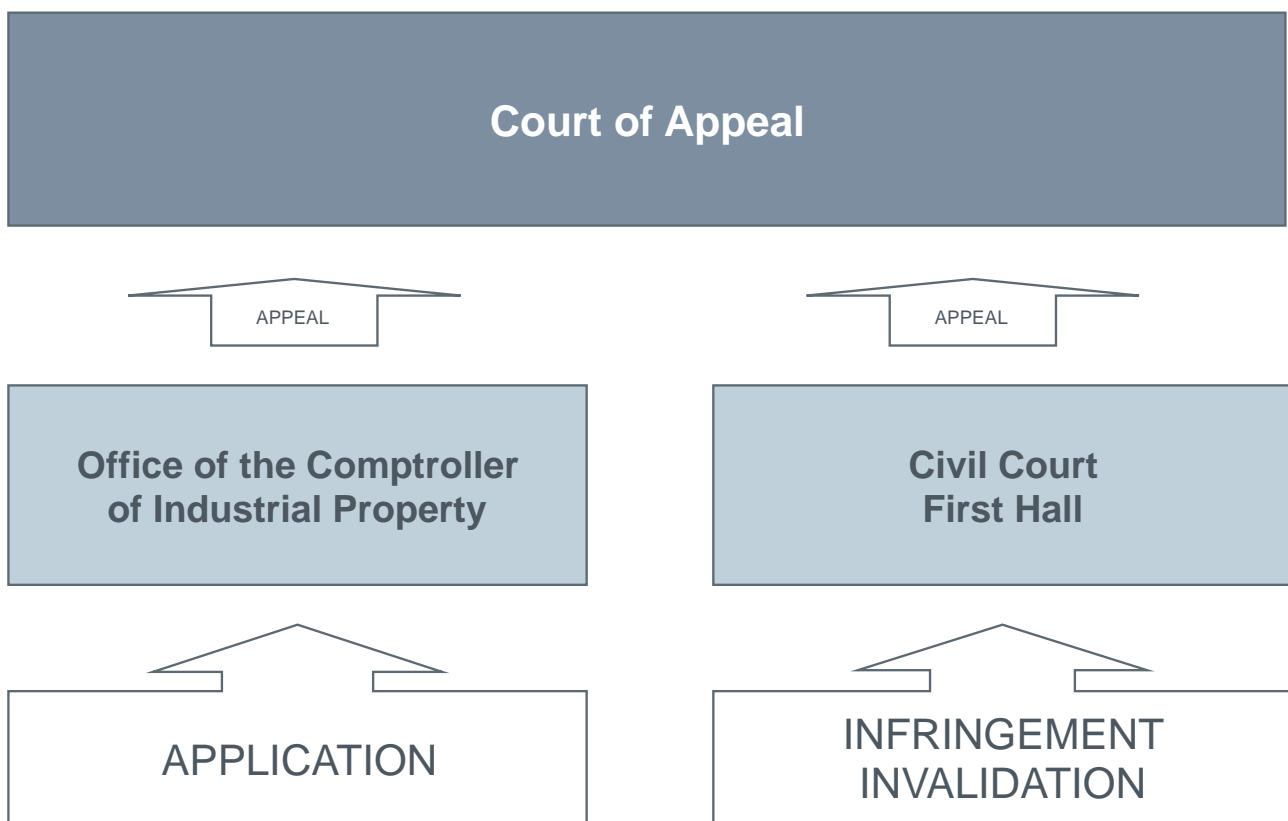
- Furthermore, the Minister responsible for IP may authorise the licence in cases of national security or public safety (Section 40 PA).

### c. Other

The introduction of a Patent Appeal Tribunal is planned.

### Bibliography

- Patents and Designs Act, making provision for the registration and regulation of patents and designs. 1 June 2002, ACT XVII of 2000, as amended by Acts IX of 2003 and XVIII of 2005 [cited as: PA]
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Malta, No. 93, December 2002
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 110 on Malta, 12/2002



## The Netherlands

### a. Netherlands Patent Office

#### Opposition

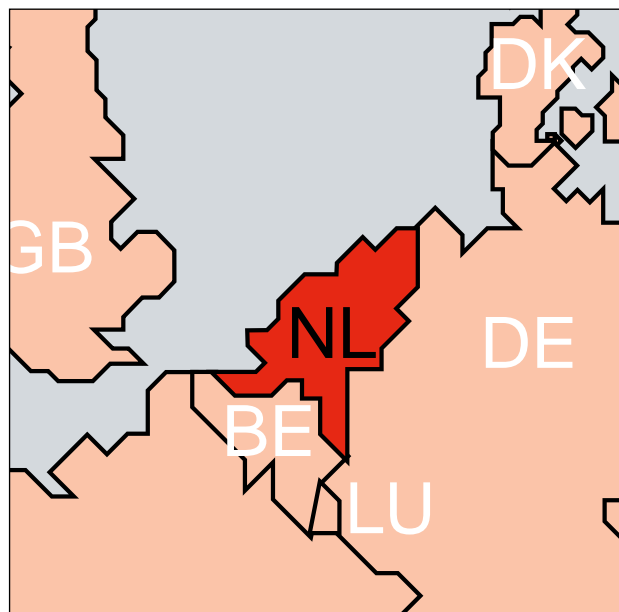
No opposition procedure is available.

- For national patents the “advice procedure” (Art. 84–86 PA) is available. Any person may request the Patent Office in a written statement to provide reasons why the claims of a national patent are invalid. The patent owner may file a response to the petitioner’s objections within a time limit set by the Patent Office. The case will be orally presented before a committee of the Patent Office (one lawyer, two technicians and a secretary). After the hearing, the written advisory report is given within two months. The advisory report consists of a reasoned evaluation of the objections stated in the request. When the invalidity case is continued in court, in general the judges follow the advice of the Patent Office, but it is not legally binding on the court.

#### Restoration

A request for restoration has to be filed within two months of discovery of the lapse, and within one year of the lapse of the patent, if the patent lapsed because of failure to observe time limits or to pay fees, despite the taking of all due care required by the circumstances (Art. 23 PA).

- The decision on restoration may be appealed (“bezwaar”) within six weeks after receipt of the decision. The appeal will be reviewed by a legal advisor of the Patent Office. On the final decision of the Patent Office on “bezwaar”, a further appeal (“beroep”) may be filed, within six weeks, at the Hague District Court (Administrative Chamber). The decision of the District Court can be further appealed at the Council of State (“Raad van State”). The Council has a special department for administrative procedures and is the highest court for administrative disputes.



### b. Civil procedure

#### Infringement

The District Court (Civil Chamber) and the Court of Appeal (Civil Chamber) in The Hague are designated as court of first and second instance respectively, responsible for dealing with disputes regarding patents (Art. 80, 70 PA). The judges working on patent cases are specialised IP judges (legally qualified, some having a technical background).

- A claim is subject to private law (certain special provisions for patent disputes are found in Art. 1019–1019i of the Code of Civil Procedure - implemented on the basis of the Enforcement Directive 2004/48/EC). Furthermore, in first-instance patent cases the parties can request accelerated court proceedings.
- Infringement proceedings can be brought only after grant of the patent.
- Infringement claims for damages and surrender of profits can be initiated: by the proprietor (on behalf of himself and licensees or pledgees) or by licensees or pledgees only, provided they have been authorised by the proprietor (Art. 70(6) PA). Only the patent owner may sue for the suspension of infringing acts (Art. 70(1) PA).
- A search report on prior art relating to the subject-matter of the patent, as published by the Patent Office or the EPO, is obligatory when pursuing infringement proceedings (Art. 70(2) PA). Furthermore, the Patent Office is obliged to provide the court with all information and technical advice that it may require for a decision in legal proceedings (Art. 87 PA).

- Invalidity may be used as a defence (as an estoppel - the infringement claim will be dismissed if the court considers the patent to be invalid), or a counterclaim for nullity may be made. As a rule, the claim for infringement and counterclaim for nullity are not bifurcated. Where it appears to the court that a decision on an infringement may be affected by invalidity proceedings which have been or may be instituted, the court may stay the infringement proceedings, with or without setting a time limit. It may also do so where a decision on infringement may be affected by proceedings instituted on different grounds, as well as when opposition is pending before the EPO (Art. 83 PA). The judge may declare the patent wholly or partially invalid outside of the infringement proceedings.
- Remedies: provisional injunction, permanent injunction, damages, legal costs, compensation, recall and surrender of infringing goods, provision of information on suppliers, (professional) customers, turnover and profits, denunciatory measures, penalties (Art. 70, 71 PA and Art. 1019–1019i of the Code of Civil Procedure - implemented on the basis of the Enforcement Directive 2004/48/EC).

### Nullity

A nullity request has to be made by the District Court (Civil Chamber) in The Hague (Art. 80, 75 PA). In the case of national patents an advisory report from the Patent Office on the validity of national patents is required (Art. 76, 84-86 PA).

- Any party can institute nullity proceedings at any time against a patent that is in force (Art. 75 – subject to exceptions).
- Nullification has retroactive effect, but this will not influence decisions given in infringement proceedings relating to the nullified patent, where such decisions have become final and have been executed prior to nullification. Partial nullification is available (Art. 75(5), (6) PA).
- The writ initiating nullification proceedings must be recorded in the Patent Register within eight days (Art. 75(4) PA).

### Declaration of non-infringement

Interested parties may request this at the District Court in The Hague (Art. 80(2) PA).

### Compulsory licence

May be granted in civil or administrative procedure.

- Administrative procedure: The Minister of Economic Affairs may grant a compulsory licence in the case of public interest (Art. 57(1) PA). An administrative appeal lies from this decision. First there is an objection (“bezwaar”) to the Minister, then an administrative appeal (“beroep”) against the Minister’s decision to the Hague District Court (Administrative Chamber). Further appeal (“hoger beroep”) may be made to the Council of State (“Raad van State”).
- Civil procedure: If a compulsory licence founded on non-use (Art. 57(2) PA) or dependence (Art. 57(4) PA) is not granted by the patentee, a third party can start a civil procedure. Then the District Court of the Hague (Civil Chamber) can grant the compulsory licence. The decision may be appealed before the Hague Court of Appeal (Civil Chamber) and after that before the Supreme Court (“Hoge Raad” – Civil Chamber).

### Bibliography

- Patents Act of 13 December 1994 [cited as: PA]; translation provided by WIPO
- “The Enforcement of Patent Rights in the Netherlands”, Jan J. Brinkhof, ILC Studies, Volume 23, Patent Enforcement Worldwide, pp. 171-187, Oxford and Portland 2005
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on The Netherlands, No. 108, November 2006
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**Council of State  
(Raad van State)**

**Supreme Court  
(Hoge Raad)**

NL



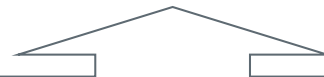
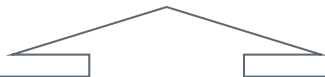
**District Court  
of The Hague  
- Administrative Chamber**

**The Hague  
Court of Appeal  
- Civil Chamber**



**Netherlands  
Patent Office**

**District Court  
of The Hague  
- Civil Chamber**



**APPLICATION  
RESTORATION**

**INFRINGEMENT, INVALIDATION  
DECLARATION OF  
NON-INFRINGEMENT**



# Norway

## a. Norwegian Industrial Property Office

### Opposition

No pre-grant opposition procedure is available, but it is possible to file a protest. A protest to the grant of a patent will not result in any litigation party rights (Section 35 PR).

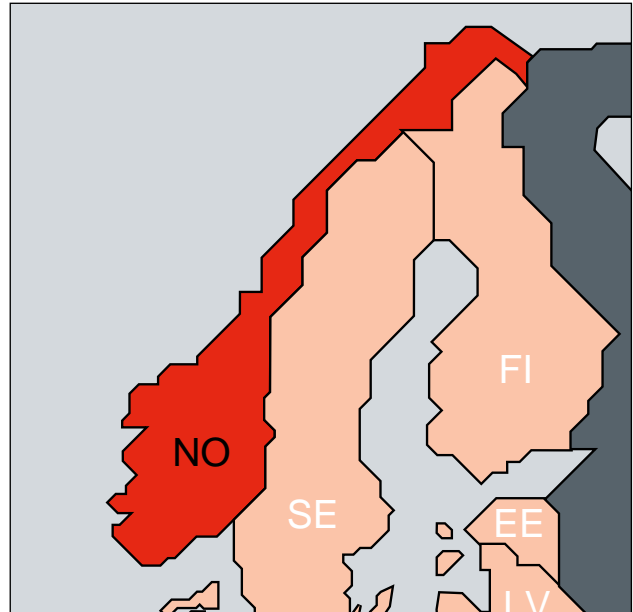
Post-grant opposition: Any person (including the holder) may file notice of opposition to a granted patent. Notice must be filed in writing, must state the grounds for opposition and must reach the Patent Office within nine months from the date of grant of the patent. Under special circumstances, the Patent Office may grant a short additional time limit for the filing of arguments (Section 24 PA). There is no opposition fee.

- Opposition founded on the claim that the patent has been granted to someone other than the person entitled to it may only be filed by the person claiming entitlement.
- The patent holder will be notified of the opposition and may file his observations within the set period (normally three months).
- Even if the opposition is withdrawn, processing may be continued, provided that there are special reasons for doing so.
- If the opposition is based on a possible breach of Section 1b PA (public order), the time limit for filing opposition is three years (Section 24, second paragraph, PA). Opposition filed after expiry of the nine-month general opposition period is subject to an opposition fee (of NOK 5 000).

### Appeal

If the Patent Office's final decision on an application has gone against the applicant, he may file an appeal against the decision with the Board of Appeal (Section 26 PA).

- If the Patent Office's final decision in an opposition case has gone against the patent holder or the opponent, the party against whom the decision has gone may file an appeal with the Board of Appeal.
- Appeal must be filed within two months from the date on which the decision was sent to the party concerned (Section 27 PA), and the appeal fee (NOK 5 200) must be paid on demand.
- If the appellant withdraws the appeal, it may still be considered ex officio.
- A decision of the Board of Appeal refusing a patent application, revoking a patent or maintaining a first decision to revoke a patent may be further appealed to the District Court of Oslo - not later than two months from the date on which the applicant or the patent holder was notified of the decision. Thus it is only the applicant/holder who can bring the decision before the Court. A third party must file a claim for invalidity in civil procedure. He cannot contest the decision to grant a patent.



NO

### Re-establishment

Applicants/patent holders who have failed to comply with a time limit prescribed in or pursuant to the PA can, upon request, have their rights re-established if certain requirements are met (Section 72 PA). The request must be filed with the Patent Office, and the fee is NOK 2 500.

## b. Civil procedure

The following issues must be brought before the Oslo District Court (Section 63 PA): (1) right to an invention for which a patent application has been filed; (2) decision in which the Patent Office's Board of Appeal has refused an application for a patent, has revoked a patent or confirmed a first-instance decision to revoke a patent; (3) request for patent limitation; (4) invalidation or transfer of a patent; (5) compulsory licences; (6) request for amendment of administrative review.

### Infringement

Civil action must be brought before the District Court where the defendant habitually resides. Criminal action may be brought at the request of the aggrieved party (restricted to intentional and negligent infringement).

- The patent owner or the licensee (with notification of the owner) may sue the infringer.
- A decision of non-infringement may not be based on the invalidity of a patent or the conditions for transfer being fulfilled without a prior judgment stating the invalidity or transfer of the patent. A dismissal may, however, be based on the patent having been revoked or transferred (Section 61 PA).
- If a nullity action is pending, the proceedings in the infringement case are stayed. There is also the possibility of joining the cases, based on the merits of the cases.

- Remedies: destruction, confiscation or alteration of products, damages, compensation, fine, imprisonment (Sections 57–62 PA).

Appeal: An appeal from a judgment of the Oslo District Court must be filed within one month with the Borgarting High Court, and the case must involve claims in excess of NOK 125 000.

- Further appeal to the Supreme Court must be filed within one month. The appeal will be subject to the approval of the Appeals Division of the Supreme Court and will be allowed only if the case has importance beyond the actual case or if other reasons make it especially important.

### Validity

Validity actions may be brought to the Oslo District Court on the grounds listed in Section 52 PA.

- Anyone may bring an action; legal proceedings on the grounds that the patent has been granted to someone other than the party entitled to it may only be brought by the party claiming entitlement (such proceedings must be brought within one year from the date on which the entitled party obtained knowledge of the grant of the patent and of the other facts on which the proceedings are based).
- Validity actions may be brought during the entire lifetime of the patent (subject to exceptions).

### Compulsory licence

May be granted by the Competition Authority and the Oslo District Court in cases of non-working, dependent patents and public interest (Sections 43-50a PA). In addition, compulsory licences may be granted in accordance with the decision of the WTO Council in respect of certain pharmaceuticals, as implemented in the Patent Regulations, Sections 97, 98 and 99.

### c. Other

From 1 January 2008 the Patents Act was amended so that anyone may request administrative review, which may result in invalidity or limitation. The request must be filed with the Patent Office, and the fee is NOK 8 000. The Oslo District Court may, subject to appeal, review the decision on validity or limitation.

### Patent limitation

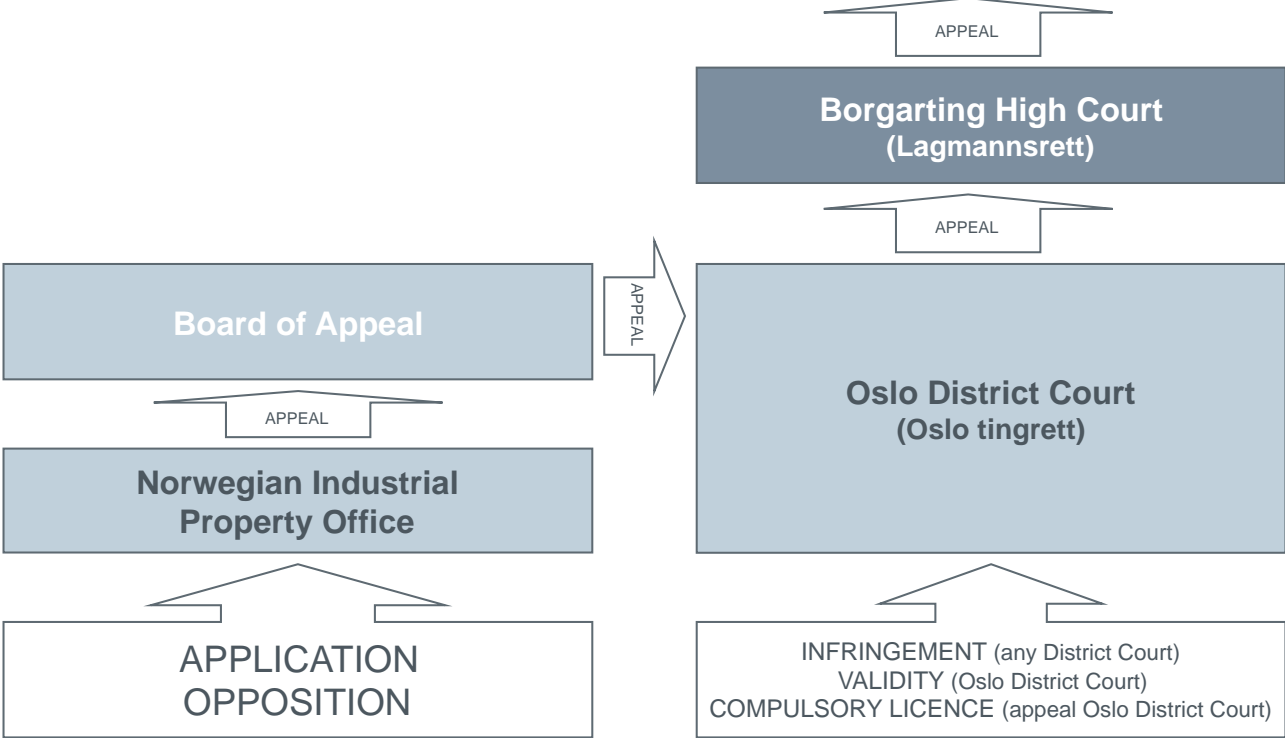
A patent holder may request that the patent claims or the description be amended in order to limit the extent of protection (Section 39a-e PA). The request must be filed with the Patent Office, and the fee is NOK 6 300.

### Bibliography

- Patents Act - Act No. 9 of 15 December 1967, Act No. 104 of 20 December 1996, Act No. 127 of 19 December 2003 as last amended by Act. No 8 of March 2010 (entered into force on 1 July 2010) [cited as: PA]; translation provided by WIPO and the Norwegian Patent Office
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 126 on Norway, 12/2002
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Norway, No. 108, November 2006

**Supreme Court  
(Høyesterett)**

NO



NO

# Poland

## a. Patent Office of the Republic of Poland

### Opposition

Post-grant opposition is available. Notice of opposition may be filed within six months from the date of publication of the mention of the grant in the official bulletin. Any interested party may give reasoned notice of opposition to a final decision of the Patent Office on the grant of a patent, a right of protection or a right in registration (Art. 246 IPL).

- The right holder will be informed that an opposition has been filed, and the Patent Office will invite him to file his observations within a fixed time limit (Art. 247 IPL). If the applicant disagrees with the claims and finds them to be unjustified, the opposition proceedings will be settled in litigation proceedings before the Patent Office (Art. 247(2) IPL).

A complaint against the decision may be lodged with the Administrative Court within 30 days.

### Re-examination

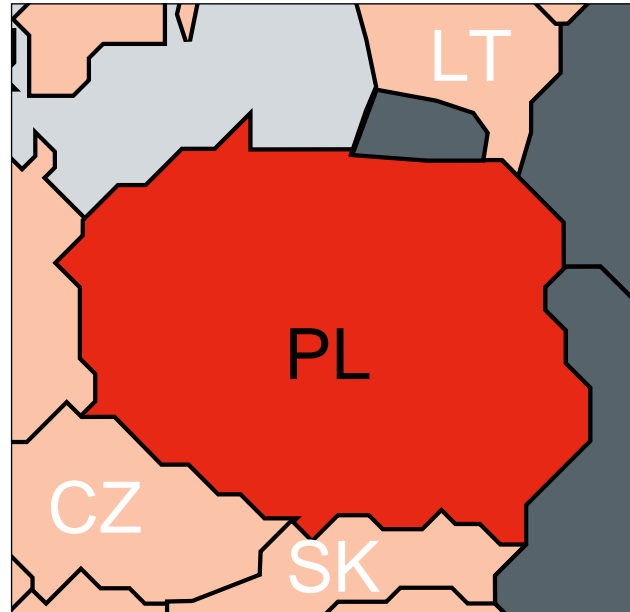
The applicant may apply for re-examination of any matter decided by the Patent Office (Art. 244 IPL). The matter will be re-examined by an expert appointed by the President of the Office.

- The time limit for submitting a request for re-examination of the matter in which a decision has been made is two months in the case of an issued order and one month from a day on which the party has been served with the decision or the order.
- The Patent Office takes a decision in which it either maintains the appealed decision/order or reverses it in whole or in part and decides on the merits. Where the request is disregarded and the appealed decision/order maintained, the time limit for performing the act specified in the appealed decision/order starts to run again.

### Judicial review

The IPL provides for two ways of instituting judicial review proceedings:

- For decisions made and orders issued by the Patent Office on issues which are explicitly listed by the IPL (Art. 257, 255 IPL), a party can file a complaint through the Patent Office with the Administrative Court in Warsaw (contentious administrative appeal). There is no need for re-examination proceedings at the Patent Office.
- All other decisions made and orders issued by the Patent Office are subject to complaint to administrative courts (Art. 248 IPL – non-contentious administrative appeal) only if the decision was reached within prior re-examination proceedings.
- The President of the Patent Office appoints an expert to examine whether or not the complaint is justified. Fol-



lowing examination of the complaint, the Patent Office either admits the complaint in full or conveys the reply to the complaint together with the files of the case to the Administrative Court (Art. 249 IPL).

- The complaint has to be made within 30 days from the decision.
- Decisions of the Administrative Court can be subject to annulment (“cassation”) proceedings at the Supreme Administrative Court.

### Compulsory licence

May be granted by the Patent Office only under certain circumstances, in cases of national emergency, abuse of patent rights or dependent patents (Art. 82 IPL).

### Restoration

An applicant may apply if he has missed a time limit for responding to an office action. The request must be submitted within two months from the date on which the reason for non-compliance ceased to exist, but not later than within six months from the date of expiry of the time limit (Art. 243 IPL).

### Nullity

A patent may be declared invalid at the request of any person having a legitimate interest who is able to prove that the statutory requirements for the grant of a patent have not been satisfied. There is no restriction on the time limits for any requests (Art. 89 IPL).

- Additionally, the General Prosecutor or the President of the Patent Office may, in the public interest, request that a patent be invalidated or intervene in a pending invalidation action (Art. 89(2) IPL).
- The decision will be taken in the litigation proceedings at the Patent Office. Partial nullification is available.

**b. Civil procedure**

**Infringement**

Civil action has to be brought by the patentee, his assignee or licensee to the District Court. Jurisdiction is mainly determined by the defendant’s domicile or place of business (Art. 27, 30 of the Polish Code of Civil Procedure (CCP)).

- The procedure is governed by provisions of the CCP on litigation or commercial matters. Criminal sanctions are available upon request.
- Action should be brought within three years from the date of infringement. Claims become barred five years after the date on which the infringement was committed.
- At first instance the case will be heard by one judge (legally qualified, no technical background required).
- Nullity can be used as a defence in infringement proceedings, but invalidation of the patent has to be the subject of separate special litigation proceedings before the Patent Office.
- Remedies: court decision to recall goods from the channels of commerce, destruction of goods, preservation of evidence or claims, publication of judicial decisions, pecuniary compensation.

**Appeal**

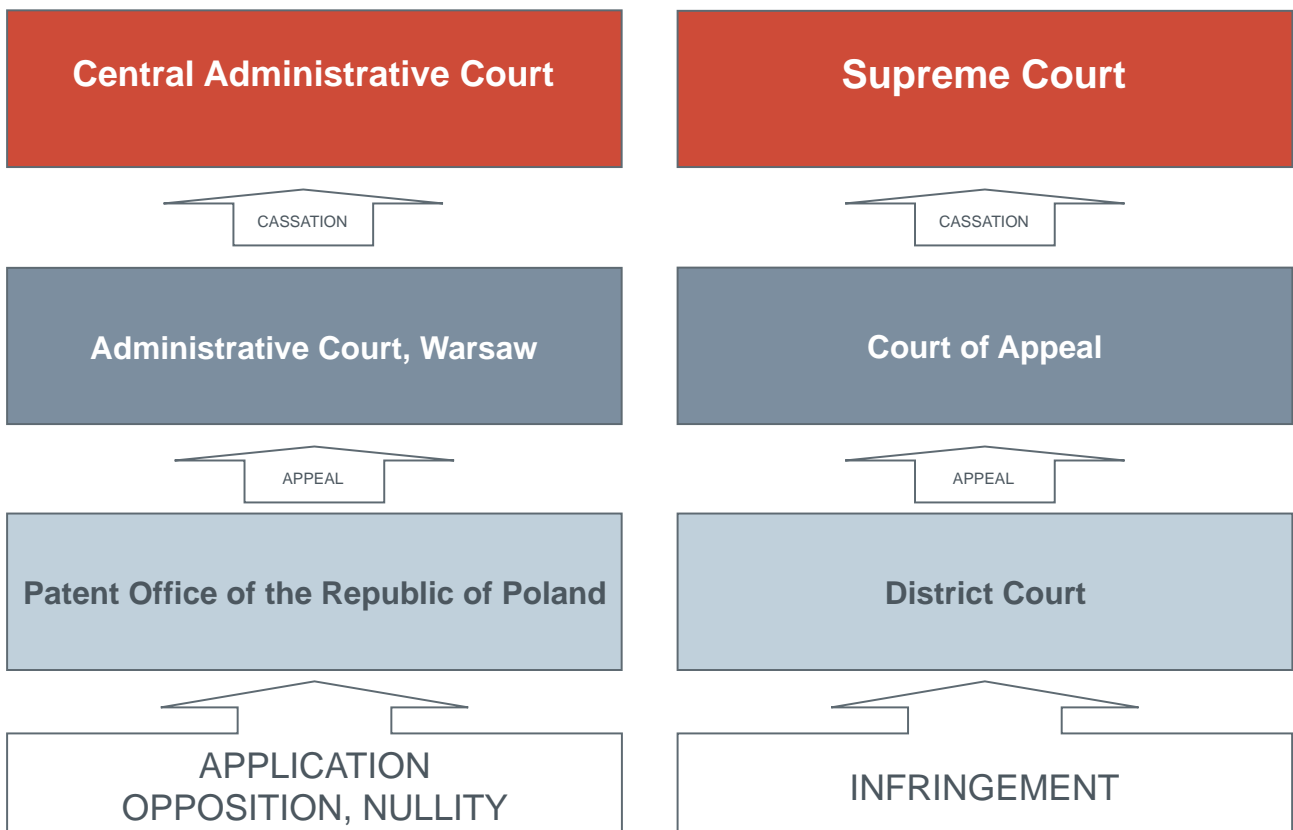
Action should be brought to the Court of Appeal (Art. 367 CCP).

- The Court of Appeal will hear the case only within the motions contained in the appeal; only the nullity of the proceedings will be considered (Art. 378 CCP).
- New evidence may be presented only if this was not possible before the first instance.
- Appeal is heard by a panel of three judges (all legally qualified).

Further appeal to the Supreme Court is restricted to breaches of substantive law or violation of procedural regulations (Art. 398 et seq.).

**Bibliography**

- Act of 30 June 2000 – Industrial Property Law (Journal of Laws of 2003, No. 119, item 1117, as amended) [cited as: IPL]; translation provided by the Polish Patent Office
- Code of Civil Procedure [cited as: CCP]
- “The Enforcement of Patent Rights in Poland”, Janusz Fiolka, ILC Studies, Volume 23, Patent Enforcement Worldwide, pp. 233-251, Oxford and Portland 2005
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Poland, No. 101, June 2005
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 134 on Poland, 12/2005





## Portugal

### a. Portuguese Institute of Industrial Property

#### Opposition

Pre-grant opposition system

- Opposition may be filed within two months of the date of publication of the patent application in the Industrial Property Bulletin. The applicant will be notified by letter that opposition has been filed, and from that moment has two months to reply. Only then will the Patent Office take a decision on the opposition.
- Even if no opposition is filed, the Patent Office does not issue its final decision before the opposition period has expired.

#### Appeal

After publication of the final decision, any interested party may appeal to the Intellectual Property Court in Lisbon (with jurisdiction for all territory and in operation since 30 March 2012) within two months from publication. The judge may uphold or revoke the initial decision.

- Further ordinary appeal to the Court of Appeal in Lisbon within 30 days from the date of the decision.
- The administrative decision may also be appealed to the Arbitration Court (ARBITRARE) as an alternative to judicial appeal.

#### Restoration

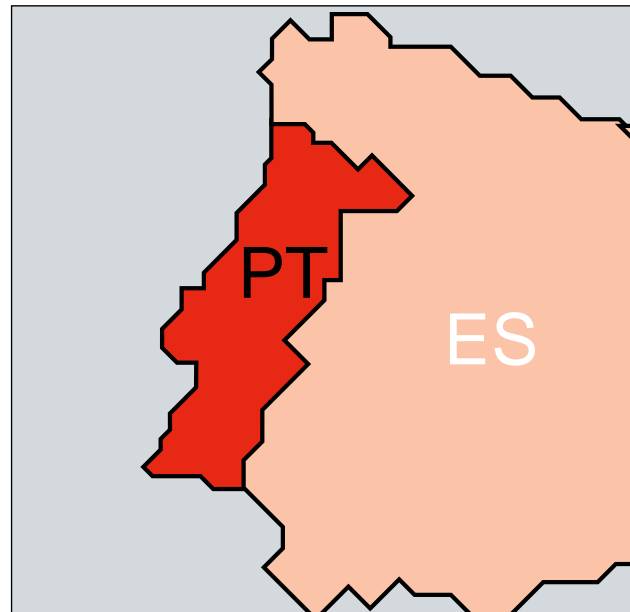
Is possible in case of failure to observe time limits set by the Patent Office. Exceptions: non-payment of renewal fees and restoration of opposition proceedings. In 2008 the possibility of restoration of right of priority was introduced, subject to special conditions.

### b. Civil procedure

#### Infringement

Criminal infringement proceedings can be conducted in any criminal court of first instance (criminal action according to jurisdiction of the court where the infringement takes place); civil infringement proceedings can be conducted in the Intellectual Property Court (with jurisdiction for all territory and in operation since 30 March 2012).

- Action may be brought by the patent holder, his licensee or any person who considers himself adversely affected.
- Expert opinions are allowable. The Court may ask the Patent Office to indicate an expert or ask other institutions (e.g. universities). The Court usually follows the opinion of the expert, but the opinion of an expert or any other expertise does not legally bind the Court.
- No judicial decision based on provisional protection can be issued before a final decision to grant or refuse the patent, which is taken by the Patent Office.



- Invalidity of a patent may be used as a defence. The Court will wait for the final decision on nullity if a previous action has to deal with a demand for nullity, or at the request of one of the parties the case may be sent to the Court where the first action was lodged (bearing in mind that, for cases lodged since 30 March 2012, jurisdiction lies exclusively with the Intellectual Property Court). If there is no previous action the court will simultaneously decide on validity, infringement and also the award of damages if requested for any of the parties.
- Remedies: damages, seizure of infringing articles, fine and imprisonment (for criminal infringement).
- Appeal: to the Lisbon Court of Appeal within 30 days, or 45 if the facts declared proven are also disputed, in both cases from the date of the decision. Further appeal only on points of law to the Supreme Court, within 30 days from the date of the decision. Appeal to the Supreme Court of Justice depends on the value of the lawsuit, but because damages are also dealt with together with validity and infringement, the cases normally go to the Supreme Court.
- The Arbitration Court (ARBITRARE) is also available as an alternative to judicial courts, with appeal to the Lisbon Court of Appeal when parties agree to that in the arbitration agreement.

#### Nullity

- At first instance, exclusive jurisdiction rests with the Intellectual Property Court in Lisbon.
- Appeal to the Supreme Court depends on the value of the lawsuit and is admissible only in some cases. If the first-instance decision is upheld without a dissenting vote in the Lisbon Appeal Court and with full acceptance of all the arguments of the Intellectual Property Court, there will be no appeal to the Supreme Court. However,

appeal to the Supreme Court is always possible in order to clarify important points of law or contradictions in case law. In these cases, appeal to the Supreme Court is mandatory for the Public Prosecutor Services even if the parties do not appeal.

- In nullity actions, it is possible to bring counterclaims of infringement. As a rule, the court will decide on both, and also on the award of damages if requested by one of the parties.
- Invalidity proceedings may be initiated by any interested party or by the Public Prosecutor Services during the entire lifetime of a patent.
- Partial nullification is possible.
- The decision of the Court has retroactive effect (*ex tunc*).

#### **Declaration of non-infringement**

Procedure as under Nullity.

#### **Compulsory licence**

May be granted by the Patent Office in cases of non-working patents. In cases of public interest the licence will be granted by the Government.

#### **c. Other**

#### **The new Portuguese Intellectual Property Court -**

##### **Main aspects**

The Portuguese Intellectual Property Court came into operation on 30 March 2012. It is based in Lisbon and has jurisdiction over actions concerning the validity and infringement of intellectual property rights (including all types of injunction), as well as appeals against Patent Office decisions.

More specifically, the new court is competent to assess, *inter alia*:

- civil proceedings in which the cause of action is related to copyright and related rights as well as author's rights and related rights
- civil proceedings in which the cause of action is related to IPR
- proceedings for invalidity and revocation provided for in the Portuguese IP Code
- appeals against Patent Office decisions (decisions that grant or refuse any IPR, and other decisions)
- civil proceedings in which the cause of action is related to internet domain names or to trade names
- civil proceedings in which the cause of action is related to unfair competition
- injunctions, measures for preserving evidence and for the request for information when required in the scope of the protection of IPR and copyright

This court also functions as a Community trade mark and Community design court, competent for disputes referred to in Articles 80 to 92 of Regulation (EC) No 6/2002 of 12 December 2001 and Articles 95 to 105 of Regulation (EC) No 207/2009 of 26 February 2009.

At second instance, the Court of Appeal of Lisbon continues to be competent.

For all the actions mentioned above, the new court will address only new cases, as old cases will remain in the commercial court.

More detailed information on the court can be found in Law No. 46/2011 of 24 June and Decree No. 84/2012 of 29 March.

#### **Bibliography**

- Industrial Property Act
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 135 on Portugal, 12/2005

**Court of Appeal of Lisbon**  
(Tribunal da Relação de Lisboa)



**Intellectual Property Court of Lisbon or ARBITRARE**



**Portuguese Institute of Industrial Property**

**APPLICATION OPPOSITION**

**Supreme Court of Justice**



**Court of Appeal of Lisbon**  
(Tribunal da Relação de Lisboa)



**Intellectual Property Court of Lisbon**

**CIVIL INFRINGEMENT, NULLITY**

PT



## Romania

### a. State Office for Inventions and Trademarks

#### Opposition

Post-grant opposition procedure is available (as an appeal from the decision of the Examination Board (Art. 51 PA).

- Any interested persons may file notice of opposition to a Patent Office decision to grant a patent within three months (two months for plants) of communication of the decision.
- If the opposition action is withdrawn, the proceedings will be continued.

#### Revocation

Any interested third person is entitled to apply to the Patent Office, in writing, on valid grounds, for revocation of a patent. Action may be brought within six months from publication of the mention of grant (Art. 52 PA).

- Where the grounds for revocation relate to only a part of the patent, the patent may be revoked in part. The opposition or revocation request must be settled by the Board of Appeal within three months of its registration.
- If the revocation action is withdrawn, the proceedings may be continued ex officio.
- Not applicable to plants.

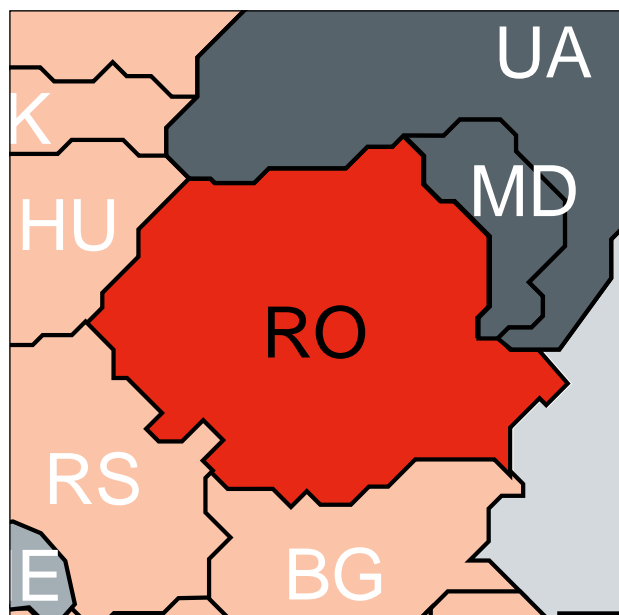
#### Appeal

Any decision taken by the Patent Office may be appealed within three months from communication (Art. 51 PA).

- The appeal will be dealt with by a Patent Office board of appeal.
- Judicial review: further appeal against the board of appeal's decision may be lodged with the Municipal Court of Bucharest within 30 days from communication, and further to the Court of Appeal of Bucharest (30 days) – Art. 57 PA.
- The Municipal Court of Bucharest has specialised IP judges (judges at the Municipal Court of Bucharest are trained in the area of IP, but there is no specialised IP section).

#### Reinstatement/re-establishment

Is possible in the case of justified non-payment of annual fees or failure to observe time limits set by the Patent Office (Art. 37, 44 PA).



### b. Civil procedure

#### Infringement

Action may be brought by the patent owner as well as the licensee authorised to use the rights arising from the patent (Art. 64 PA).

- The action will be considered by ordinary courts of first instance (Art. 63 PA) (litigation concerning inventor, patent ownership or other rights arising from the patent is subject to the jurisdiction of the ordinary courts of first instance).
- Infringement is also considered a criminal offence and is punishable by a fine or imprisonment. The proceedings are initiated ex officio - Art. 59 PA.
- Expert opinions are permissible and binding on the court (if appointed by the court).
- Invalidity of a patent can be used as a defence.
- Remedies: damages under civil law, seizure, destruction, criminal sanctions (imprisonment, fine).
- Appeal: the decision may be appealed to a Court of Appeal.

#### Declaration of non-infringement

Not available.

#### Nullity

Invalidation of a patent granted by the Patent Office may be requested at the Municipal Court of Bucharest after the time limit for revocation by the Patent Office has elapsed (Art. 55 PA).

- A request can be made during the entire lifetime of a patent.
- The decision may be appealed within 15 days to the Court of Appeal in Bucharest (Art. 55 PA).
- Partial annulment is available.

- If the nullity action is withdrawn by the claimant, the proceedings will not be continued.
- Appeal: ordinary appeal to the Court of Appeal of Bucharest is available.

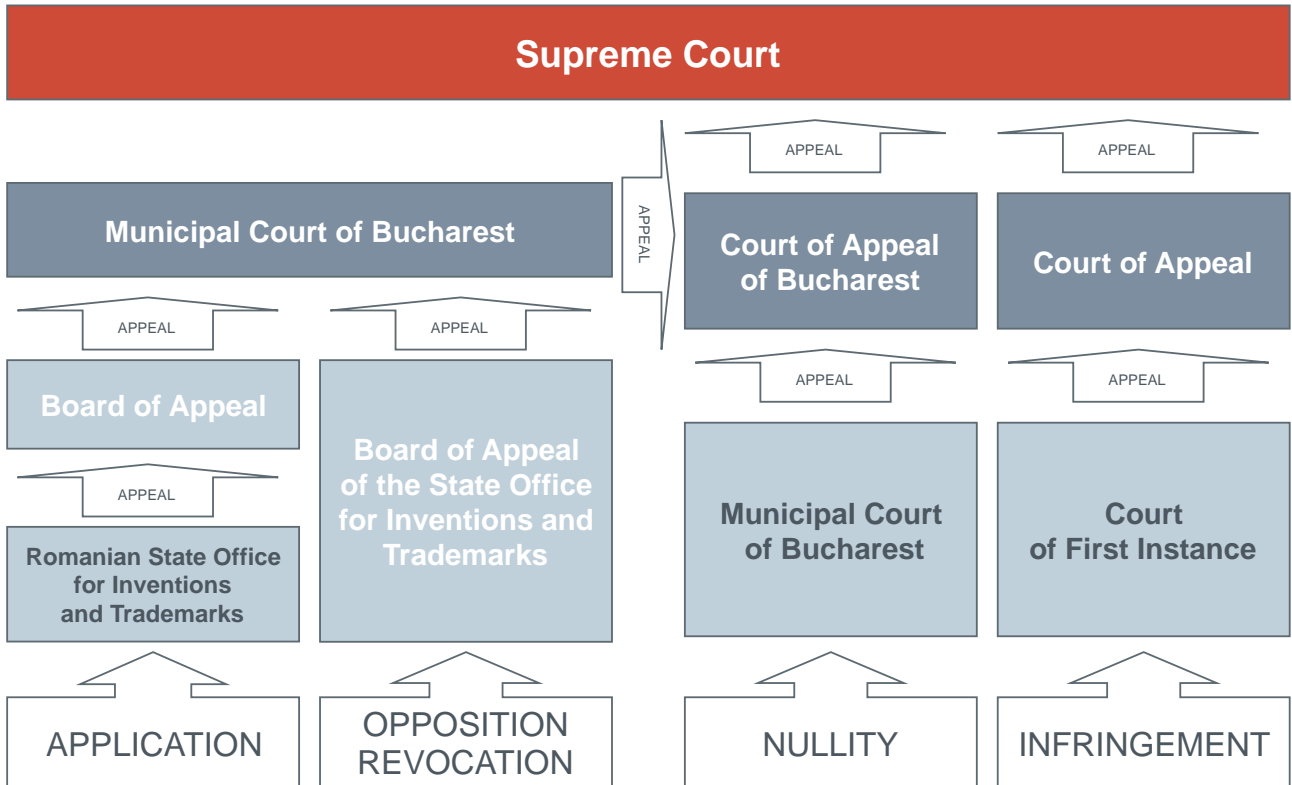
**Compulsory licence**

May be granted upon request by the Court of Bucharest in cases of non-working, national interest or emergency, and dependent patents (Art. 46 PA).

**Bibliography**

- Patent Law No. 64/1991 - as last amended by Law No. 28/2007 [cited as: PA]; translation provided by Romanian Patent Office
- "Patents throughout the World", 2008 Thomson Reuters/West, Chapter 137 on Romania, 5/2005

RO



## Serbia

### a. Intellectual Property Office of the Republic of Serbia

#### Opposition

Not available.

#### Appeal

- Patent Office decisions may be appealed with the Government within 15 days from receipt of the decision, unless the Patent Law provides otherwise (Art. 67 PL).
- The Patent Office's findings pursuant to the provisions of the Patent Law may not be appealed, unless the Patent Law provides otherwise.

#### Revocation

- The validity of a patent may be challenged before the Patent Office.
- At any time any third person is entitled to submit a request for revocation.
- On valid grounds for revocation, the Patent Office will revoke a decision on the grant of a patent (Art. 128 PL).
- On the basis of the revocation proceedings, the Patent Office will either take a decision to revoke the decision to grant the patent in full or in part or refuse the request for revocation. The Patent Office will publish particulars of the revoked patent in the Official Gazette within three months from the date on which the decision becomes final (Art. 131 PL).

#### Compulsory licence

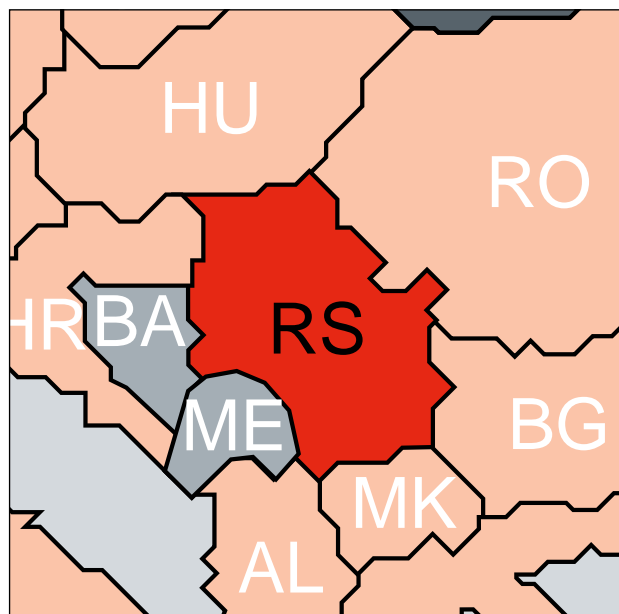
At the request of an interested party, a non-exclusive compulsory licence may be granted by the authority competent in the field in which the invention is designed to be employed (subject to further conditions, Art. 26 PL).

#### Re-establishment of rights

- Available upon request for re-establishment of rights (subject to further conditions, Art. 73 PL).
- The request may be submitted no later than 12 months after failure to perform the action concerned.

#### Continued processing

- Available upon request for continued processing (subject to further conditions, Art. 74 PL).
- The request may be filed within three months from receipt of notification from the competent authority that the applicant or the right holder failed to comply with the time limit set by that authority.



#### Urgent procedure

An application may be examined in an urgent procedure in the event of judicial proceedings or if inspection, surveillance or customs procedures have been initiated at the request of the court or the competent market inspection authority or the customs authority (Art. 105 PL).

#### Courts

- Administrative dispute proceedings may be instituted against a Government decision on an appeal within 30 days from receipt of the decision (Art. 67 PL).
- Extraordinary remedies are allowed against decisions of the Administrative Courts. The Supreme Court of Cassation decides on extraordinary legal remedies (Art. 144 PL).

### b. Civil procedure

#### Infringement

- The owner of a patent or holder of an exclusive licence is entitled to institute civil proceedings against any person infringing his right (Art. 132 PL).
- Remedies: establishment of the fact that a patent infringement exists, damages under civil law, publication of the court decision at the expense of the defendant, seizure, destruction, supply of information on third parties involved in the infringement, criminal sanctions.
- The competent court in civil cases between natural persons is the Higher Court at first instance; the competent court between legal persons is the Commercial Court.
- Appeal: decisions may be appealed to a Court of Appeal and the Commercial Appellate Court.
- In IPR cases, review is always allowed (as an extraordinary remedy); the Supreme Court of Cassation decides on reviews.

### Particular civil action

(1) Action for establishment of the right to protection

In a civil action, the inventor, his successor in title or employer is entitled to require the court to establish his right to the protection of a given invention or to establish that he is the right holder, instead of or together with the person who has already filed an application for that invention. This action may be brought before the right has been granted, or prior to expiry of the right if the decision to grant a patent has already been taken by the competent authority (Art. 140 PL).

(2) Action for the protection of employers' or employees' rights.

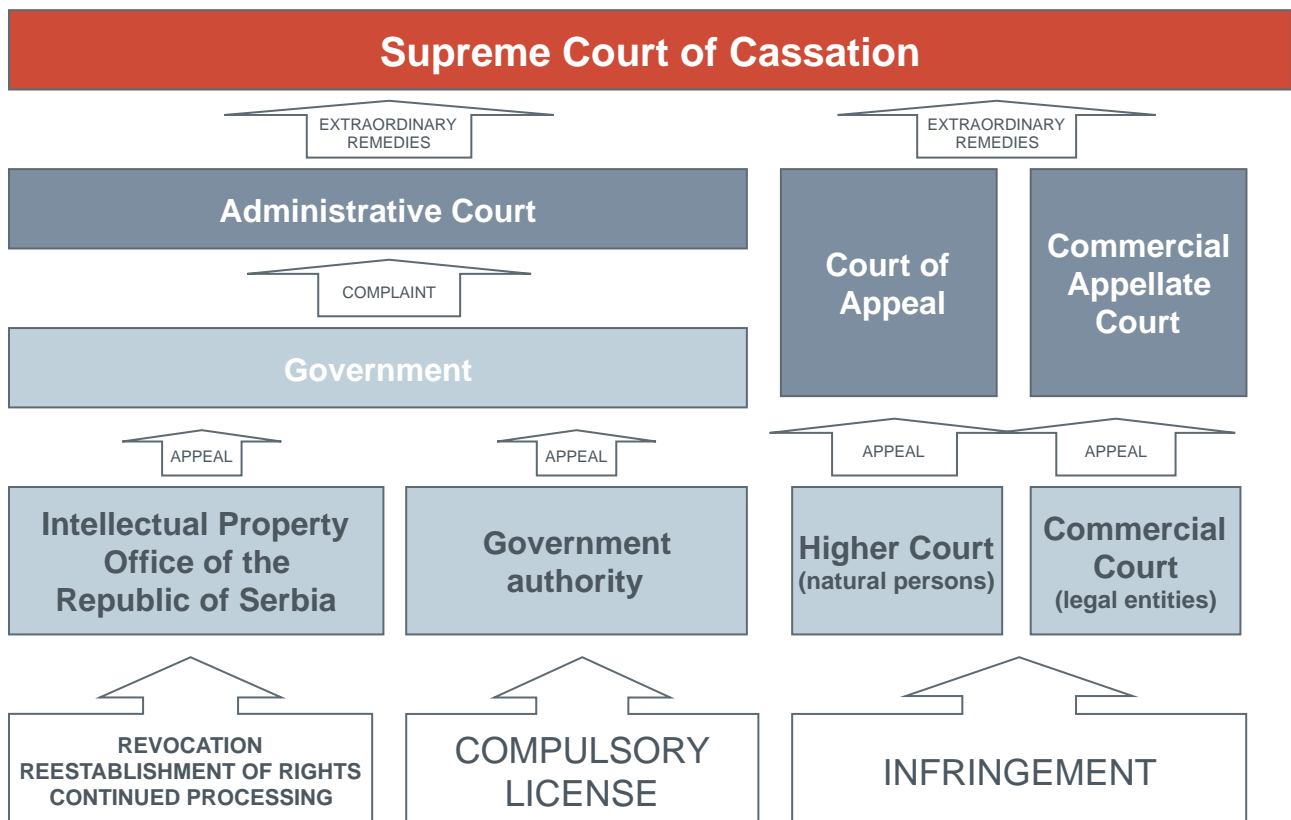
An employer and/or an employee entitled to the protection or commercial use of an invention made in the course of his employment may institute court proceedings for the establishment and protection of his rights. Legal proceedings for the establishment of employees'/employers' rights may be instituted within two years from the date of publication of the patent application, but not after expiry of two years from the date of termination of the employment during which the invention was made (Art. 141 PL).

(3) Action for recognition of the status of inventor

If the patent/petty patent application or any other document provided by the law has designated any other person as an inventor, the inventor is entitled to institute civil proceedings requesting the court to establish his status as inventor or to order the entry of his name in the patent documents and registers kept by the Patent Office. There is no time limit for the institution of proceedings (Art. 142 PL).

### Bibliography

- Law on Patents (OG RS No. 99/11) [cited as PL]





# Sweden

## a. Swedish Patent and Registration Office

### Opposition

Post-grant opposition is available. Anyone may file notice of opposition within nine months from the date on which the patent was granted (Section 24(1) PA).

- The patent proprietor is given the opportunity to file a response within four months from the date on which the Patent Office sent the opposition (Section 24(2) PA).
- If the opposition is withdrawn by the opponent, the process may still be continued if there are particular reasons (Section 24(3) PA).
- In the event that opposition is not filed with the Patent Office within nine months after grant, the patent may only be wholly or partly nullified by the court.

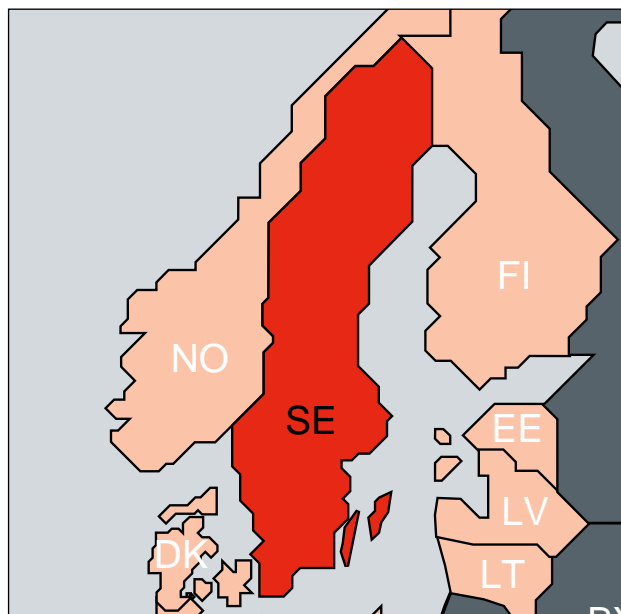
### Appeal

A final Patent Office decision on a patent application may be appealed by the applicant if the decision is not in his favour. A final decision on an opposition to a patent is appealable by the proprietor of the patent and by the opponent if the decision is not in favour of the appealing party. If the opponent withdraws his appeal, it may still be considered if there are particular reasons (Section 26(1) PA).

- The appeal should be filed with the Patent Office within two months from the date of the decision; however, it will be considered by the Court of Patent Appeals (CPA – a special independent court) (Section 27(1) PA).
- Further review: by the Supreme Administrative Court. The appeal must be received by the Supreme Court within two months from the CPA's decision (Section 27(2) PA). Leave from the Supreme Administrative Court is required.

### Restoration

Within certain time limits, in the case of pre-grant dismissal as a result of non-response to the formal report, or post-grant in the event of non-payment. Decisions are appealable to the CPA.



SE

## b. Civil procedure

### Infringement

All proceedings must follow the general Swedish Code on Judicial Procedure.

- The Stockholm City Court has exclusive jurisdiction for patent litigation (within the Stockholm City Court there is a specific division for handling all IP matters – some judges are specialised in dealing with IP matters) (Section 65 PA).
- Patent infringement cases are heard by four judges (two legally trained and two technically qualified), and decisions are taken by majority (Section 66 PA).
- The patent owner may bring an action for infringement.
- Nullity may be used as a defence or counterclaim; in that case, however, it may only be considered after an invalidity claim has been raised. The Court orders the party asserting invalidity to bring action within a certain period of time. If patent infringement action and patent invalidity action are brought in the same court proceedings and if it is suitable to decide independently on whether there is patent infringement, a separate judgment may be rendered on this issue at the request of one of the parties. If a separate judgment is rendered, the Court may decide that invalidity proceedings are to be stayed until the judgment has taken legal effect (Section 61(2)(3) PA).
- Criminal actions are brought only at the complaint of the aggrieved party.
- Remedies: preliminary relief, compensation, destruction of infringing articles (Sections 57-62 PA).
- At the preparatory stage the courts are required to investigate the possibility of settling the case.

### Nullity

Court action may be brought by anyone who suffers damage or by a public authority designated by the government (Section 52 PA).

- A patent may not be declared invalid on the grounds that the person who has obtained it was entitled to only a part of it.
- Partial nullification is available.
- If the action is withdrawn, the proceedings will not be continued.

### Declaration of non-infringement

Any person who carries on or intends to carry on an activity may bring an action to the City Court of Stockholm against the proprietor of the patent for a declaratory judgment in order to establish whether a specific patent constitutes an obstacle to that activity (Section 63 PA).

### Compulsory licence

Request to the City Court of Stockholm. May be granted in cases of dependent patents, public interest and, exceptionally, in cases of prior use in good faith (Sections 45-50 PA).

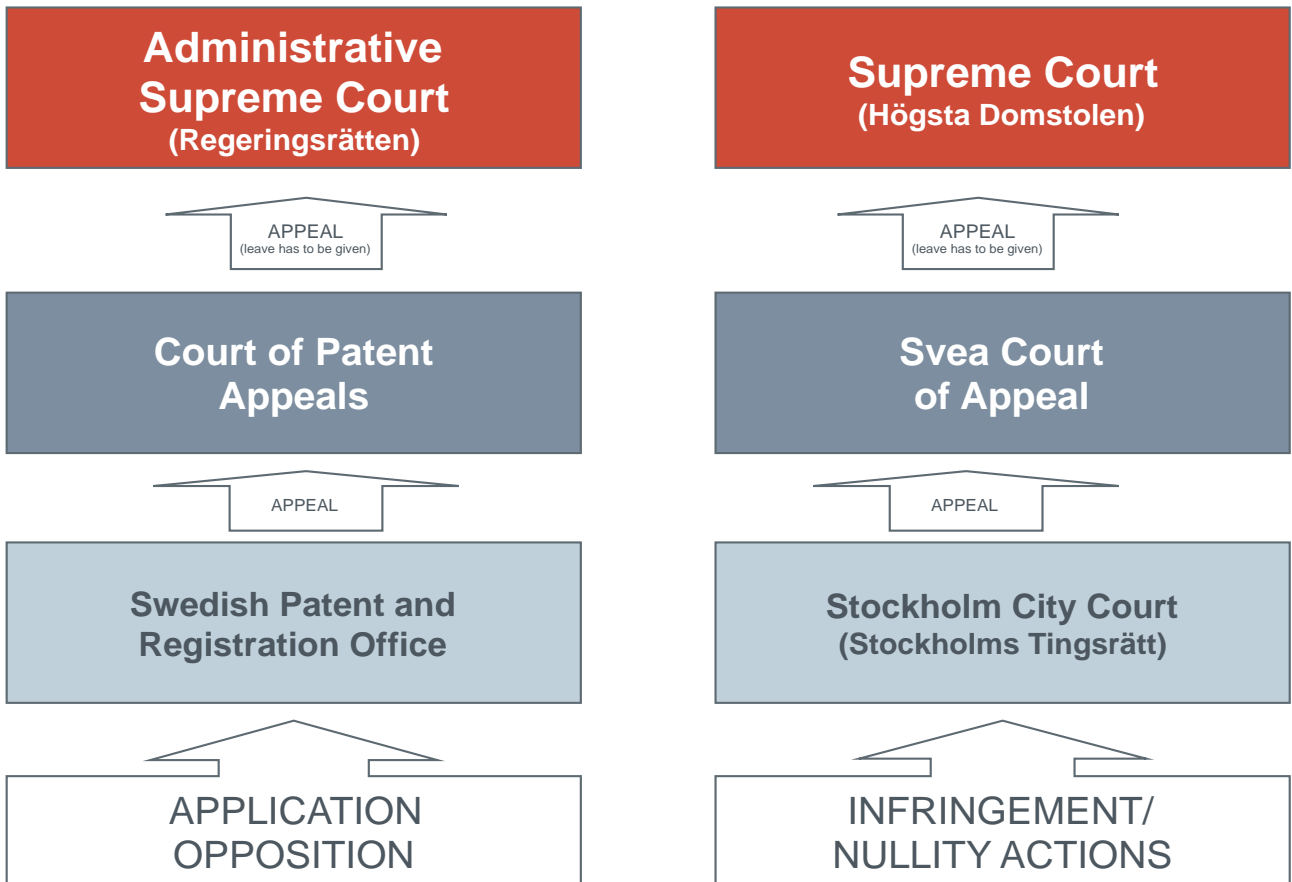
### Appeal

To the Court of Appeal. Further appeal to the Supreme Court. However, special leave is required.

### Bibliography

- The Swedish Patent Act - Act No. 837 of 1967, as amended by Acts Nos. 149 of 1978, 433 of 1983, 937 of 1984, 233, 1156 of 1986, 1330 of 1987, 296 of 1991, 1688 of 1992, 1406 of 1993, 234, 1511 of 1994, 1158 of 2000 and 159, 161 of 2004 [cited as: PA]; translation provided by WIPO
- "Presentation of the national proceedings with regard to the validity and enforcement of patents" (SE), EURO-TAB 27/2007
- "Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World", edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Sweden, No. 102, September 2005,
- "Patents through the World", 2008 Thomson Reuters/West, Chapter 159, Sweden 3/2007

SE



# Slovenia

## a. Slovenian Intellectual Property Office

### Opposition

No pre- or post-grant opposition procedure is available.

### Judicial review

If a patent application is refused, an action for judicial review may be lodged with the Administrative Court of the Republic of Slovenia in Ljubljana within 30 days from the date on which the applicant or his representative received the decision of refusal (Art. 71 IPA).

### Restoration

Available on justifiable grounds in case of failure to observe time limits set by the Patent Office, e.g. non-payment of renewal fees (Art. 68, 110 IPA).

### Further processing

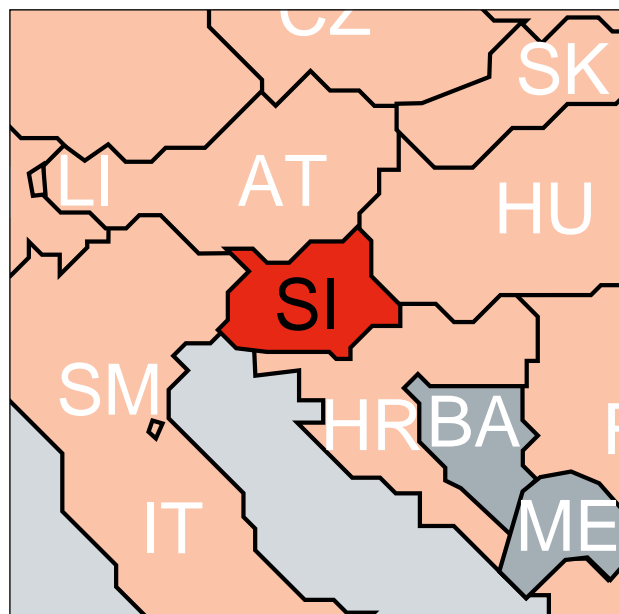
An applicant who has failed to comply with a time limit for fulfilling obligations in proceedings for acquiring a right may request that the unobserved time limit be deemed to have been complied with, that legal consequences of such non-observance be set aside and that the Patent Office continue the proceedings for acquiring the right (Art. 67 IPA).

## b. Civil procedure

### Infringement

Entitlement to sue for infringement rests with the patent holder or exclusive licensee or with professional associations established for the protection of industrial property rights (Art. 120a IPA).

- A civil action may be filed with the District Court in Ljubljana (ordinary court - responsible for all IP cases in Slovenia), which has exclusive jurisdiction over all patent infringement cases in Slovenia (Art. 121 IPA). Patent infringement is also a criminal offence (in which case one of the county courts is competent).
- Where the infringement action relates to infringement of a national patent which has not been examined for substantive patentability requirements, the court will suspend proceedings until the Patent Office issues a declaratory decision on whether the written evidence filed by the patent holder meets the patentability requirements (Art. 122(2) IPA).
- Nullity of a patent can be used as a defence or counterclaim.
- Remedies: preliminary injunction (special provisions), claimant may claim prohibition of infringement, recall of infringing goods from the channels of commerce, restoration of the previous situation, irrevocable removal of infringing goods from the channels of commerce,



destruction of infringing goods, destruction of means of infringement that are owned by the infringer and intended or used exclusively or principally for infringement, publication of judgment, surrender of infringing goods against reimbursement of production costs, damages according to general tort law (all the claims may be decided in a separate or the same civil procedure) (Art. 121, 121a IPA).

- An infringement lawsuit becomes statute-barred three years after the date on which the claimant became aware of the infringement and of the identity of the infringer, and no later than five years after the damage occurred.
- Appeal: ordinary appeal may be filed within 15 days at the Ljubljana High Court. A further extraordinary appeal to the Supreme Court is available (restricted to points of law).

### Nullity

Any interested party may, at any time during the entire lifetime of the patent or after the patent has expired, bring an action for invalidation to the District Court in Ljubljana (Art. 111, 112 IPA). The court immediately notifies the Patent Office of the receipt of an action and of the final decision (Art. 72 IPA). The court submits its judgment together with confirmation that it is legally binding on the Patent Office for execution.

Nullification has retroactive effect. Partial nullification is available.

### Patent ownership

At any time during the life of the patent, the inventor may bring a civil action to be declared the owner of the patent (Art. 118 IPA).

### Compulsory licence

May be granted by the court in cases of public interest, or if the court determines that the owner or licensee is abusing the right to a patent (Art. 125 IPA).

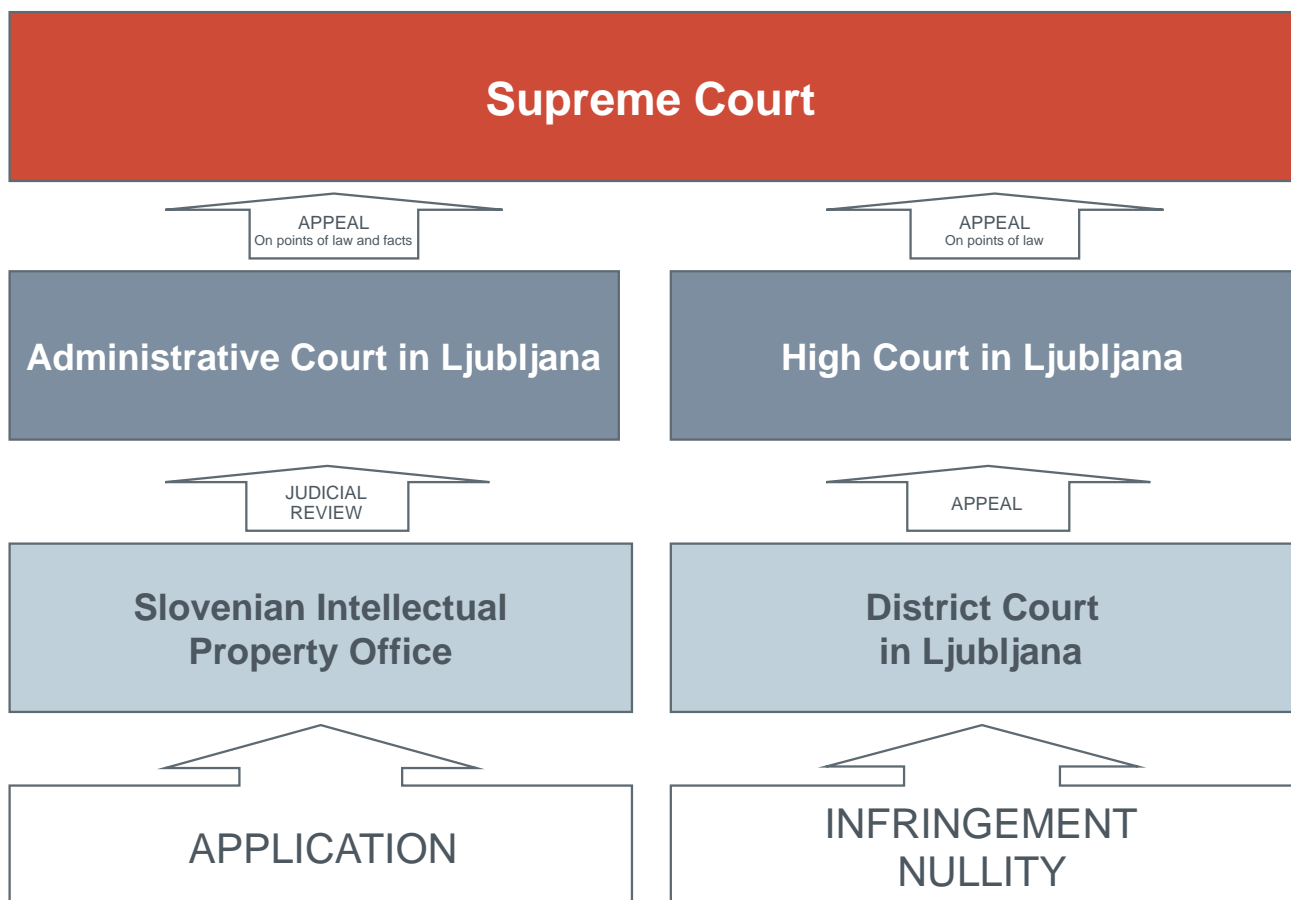
### Declaration of non-infringement

Not available.

### Bibliography

- Industrial Property Act of 23 May 2001 as last amended on 6 February 2006 - as in force from 11 March 2006 [cited as: IPA]; translation provided by Slovenian Patent Office
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Slovenia, No. 106, June 2006
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 150 on Slovenia, 4/2003

SI



# Slovakia

## a. Industrial Property Office of the Slovak Republic

### Opposition

No pre- or post-grant opposition procedure is available.

- After publication of the application any person may file observations on the patentability of its subject-matter. These observations will be taken into consideration during substantive examination. The persons filing them do not become parties to the application proceedings (Art. 42 PA).
- Third parties may, within 36 months from the filing date, request substantive examination of a patent application (Art. 43 PA).

### Revocation

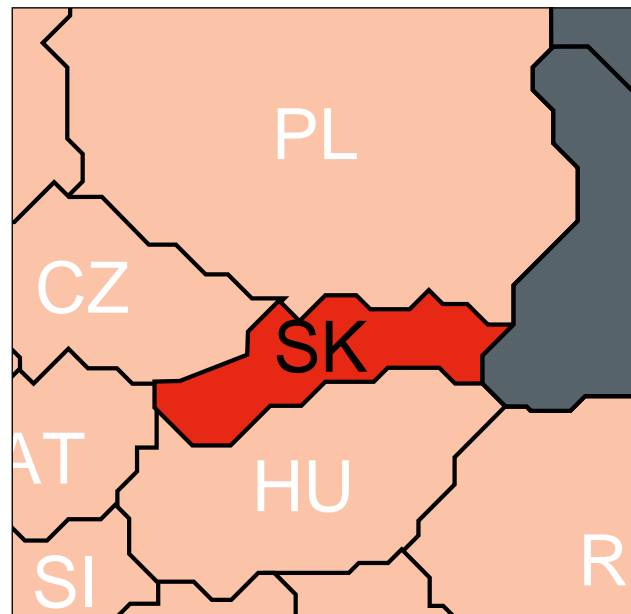
The Patent Office's Disputes Procedure Department is competent for taking decisions at first instance. The proceedings may be initiated at the request of a third party or ex officio (Art. 46 PA).

- The request can be made during the entire lifetime of a patent (even after the patent has lapsed if the person requesting revocation proves legal interest).
- Partial revocation is available (amendment of patent claims, description, drawings – Art. 46(2) PA). Revocation has retroactive effect.
- The Patent Office delivers the revocation request to the patent owner and invites him to respond within a set time (Art. 47 PA).

### Appeal

An appeal against a Patent Office decision may be lodged with the Office within 30 days from delivery of the decision (Art. 55 PA). Only a party to the proceedings or a person who may be directly affected is entitled to appeal. Once lodged, an appeal has suspensive effect. The President of the Office decides on appeals on the basis of the proposals of the Appeal Commission's experts (three external and two internal members). Extraordinary remedies:

- Renewal of the proceedings: will be ordered by the Office upon request, but only in certain cases (new facts, irregular practices of the administrative authority, untrue evidence). Must be requested within three months by the party which has the facts giving rise to renewal, but at the latest within three years from the date of validity of the decision.
- Review of the decision on an appeal: if the decision is contrary to the binding legal rules, the Patent Office may amend the previous decision or declare it null and void. This is subject to further appeal.



- Proceedings at the request of a prosecutor: if the decision is unlawful, a request must be submitted within three years from the date of validity of the decision.
- It is possible to initiate a civil action for review of a Patent Office decision.
- Judicial review: The final administrative action may be contested by an annulment ("cassation") complaint or a request for new proceedings filed at the Regional Court. The action can be filed for an alleged illegality within two months of notification of the challenged decision.

### Determination proceedings

On request, the Patent Office will determine whether the subject-matter stated and described in the request falls within the scope of protection of a certain patent (Art. 49 PA). Parties to pending court proceedings (e.g. infringement) will be the parties to the determination proceedings.

### Restoration

Is available in cases of justified failure to observe statutory time limits or time limits set by the Patent Office (Art. 52 PA).

## b. Civil procedure

### Infringement

The first-instance district courts in Banska Bystrica, Bratislava I and Kosice I have competence to hear and adjudicate infringement cases (Art. 33 PA).

- The person whose rights have been infringed or jeopardised is entitled to bring an action (Art. 32 PA).
- There is no compulsory representation before the first and second instance.
- Remedies: preliminary injunction, removal of the consequences of the infringement, prevention of further infringements, destruction, information on the origin of the product, compensation for damages (actual damage and loss of profits), compensation for the costs of the proceedings (Art. 32, 32a, 33, 34, 54 PA).
- If a request for revocation is filed during infringement proceedings, the court suspends the infringement proceedings until the Patent Office decides on the revocation request.

### Compulsory licence

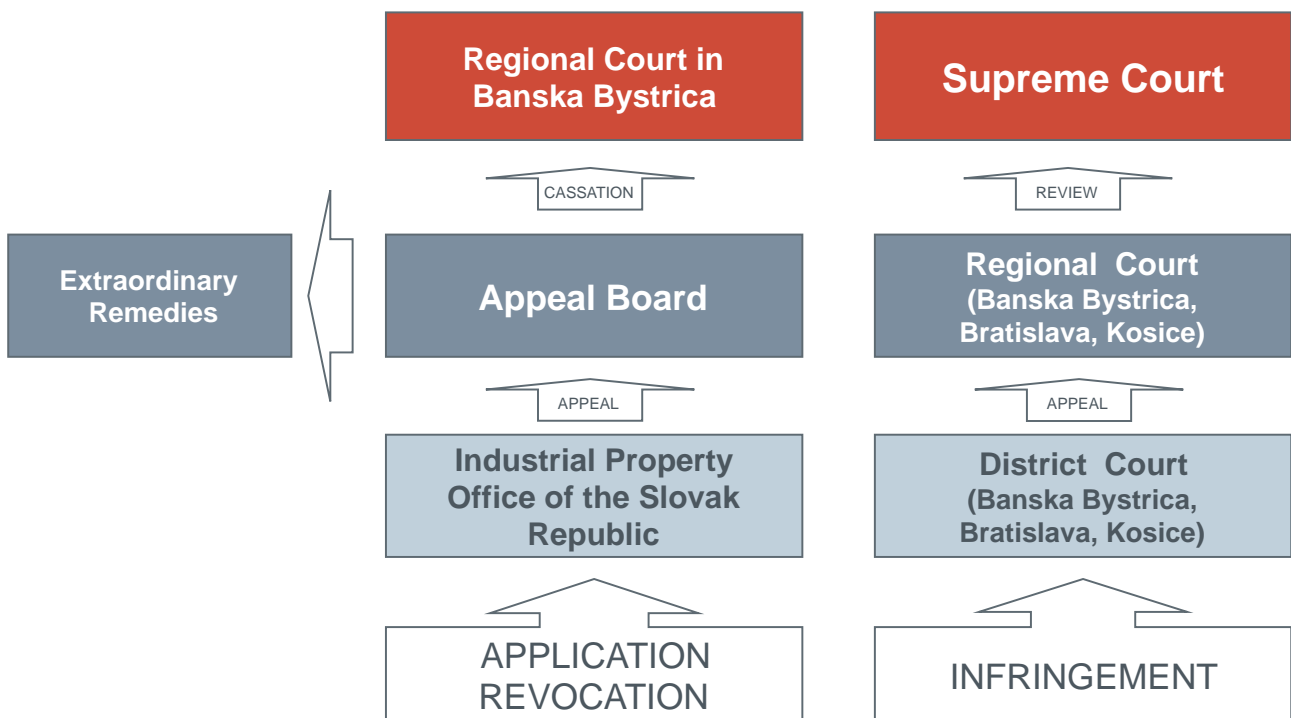
The competent court may grant a non-exclusive licence in cases of non-working and public interest (Art. 27, 28 PA).

### Declaration of non-infringement

Available in civil procedure by negative action in accordance with Art. 80(c) of the Civil Procedure Act.

### Bibliography

- Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and amended Acts as Amended by Act No. 402/2002 Coll. [cited as: PA]; translation provided by Slovakian Patent Office
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Slovakia, No. 105, March 2006
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 149 on Slovakia, 4/2004
- “Presentation of the national proceedings with regard to the validity and enforcement of patents” (SK), Slovakian Patent Office, EUROTAB 30/2007



## San Marino

### a. Patent and Trademark Office of the Republic of San Marino

#### Opposition

No opposition procedure is available. Third parties may only submit observations on the patentability of the invention. Third parties do not become parties to the proceedings before the Patent Office.

#### Appeal

Appeal from refusal of the application must be filed within 60 days after notification by the Patent Office.

The appeal must be addressed to the Administrative Judge of First Instance. The Judge of Administrative Appeal is competent to deal with appeals against decisions of the Administrative Judge of First Instance.

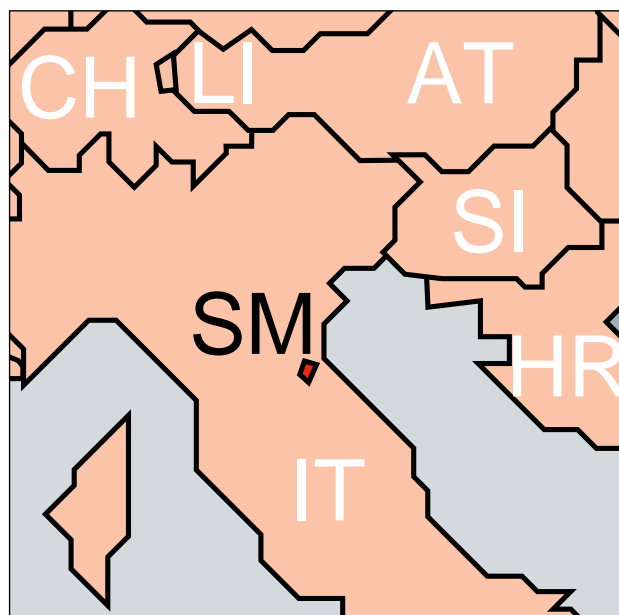
The San Marino legal system provides that, in order to be final, administrative judgments must meet the so-called “doppia conforme” requirement (two concordant decisions). According to this principle, if the first-instance judgment differs from the appeal judgment, a third-instance judgment must be pronounced by the Judge of Third Instance for Administrative Matters.

#### Restoration

Available in case of failure to observe time limits.

#### Compulsory licence

May be granted by the Patent Office in cases of unexploited patents within a period of four years from the date of filing. Those who wish to obtain a compulsory licence must address a reasoned request to the Patent Office. The owner of the patent may start opposition proceedings against the grant of a compulsory licence. The decision on the opposition may be referred to arbitration.



### b. Civil and criminal procedure

#### Infringement

Civil and criminal proceedings are provided for. The owner of the patent may request a detailed description by a bailiff of infringing goods with or without seizure. In such cases the requester must institute civil proceedings within 30 days.

Actions will be heard by the Commissario della Legge (Law Commissioner).

During the investigative phase an expert appointed by the Law Commissioner may be required to give an expert opinion on the existence of the infringement or the validity of the patent. Remedies: injunction, seizure of infringing products, publication of the decision, destruction of infringing articles, compensation, damages.

#### Appeal

The Law Commissioner’s decision may be appealed to the Judge of Civil Appeal.

The San Marino legal system provides that, in order to be final, civil judgments must meet the so-called “doppia conforme” requirement (two concordant decisions). According to this principle, if the first-instance judgment differs from the appeal judgment, a third-instance judgment must be pronounced by the Judge of Third Instance in Civil Matters. Infringement can also be punished with a fine in criminal proceedings.

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### Nullity

Any interested party may request nullity before the Law Commissioner. A judgment of nullity has retroactive effect. The Law Commissioner's decision may be appealed to the Judge of Civil Appeal.

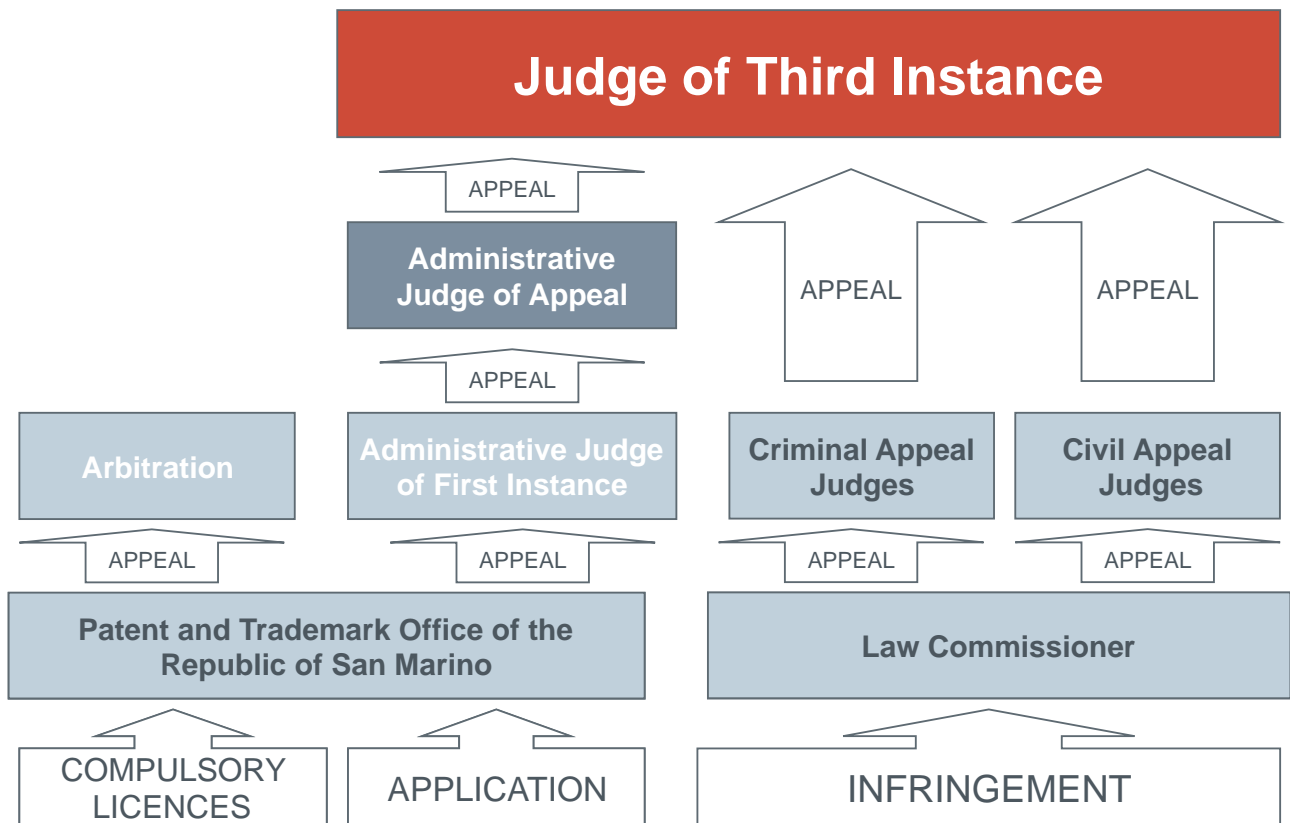
### Declaration of non-infringement

Not available.

### Bibliography

- Law No. 79 of 25 May 2005 - Industrial Property Consolidation Act
- Law No. 114 of 20 July 2005 - Amendments to Law No. 79 of 25 May 2005 - Industrial Property Consolidation Act
- Regulation No. 5 of 2 July 2007 - Regulation for the Practice of the Profession of Industrial Property Attorney

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# Turkey

## a. Turkish Patent Institute

### Opposition

The Patent Office has introduced a system of pre-grant observations and opposition aimed at the restoration of rights. Pre-grant observations:

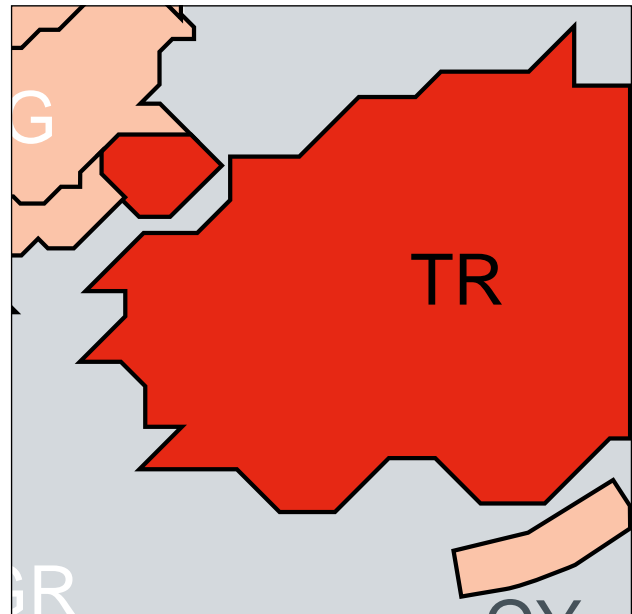
- In the case of patents with pre-grant examination, any third party may, within six months from the date of publication of the search report for the patent application, submit to the Patent Office written objections that may affect the patentability of the invention (Art. 62 PA).
- In the case of patents without pre-grant examination, anyone may, within the same period, file written observations on the search report. These will be communicated to the applicant, who may respond to them (Art. 60 PA).

Oppositions aimed at the restoration of rights:

- Restoration of a previous stage of the proceedings: available in cases where objections are lodged by an applicant who has an objection to formal deficiencies in the administrative procedure for the grant of a patent (Art. 70 PA). If the objections are well-founded, the effect of this action will be annulment of the administrative action pertaining to the grant of the patent retroactively to the stage of the procedure where the deficiency concerned occurred and resumption of the procedure from that stage onwards so as to perform all such actions anew (Art. 71 PA).
- Due to a negative third examination report: if a patent application is refused because of a negative third examination report, opposition for restoration may be lodged (Art. 62 PA). The applicant is required to submit his comments regarding the report.

### Re-establishment

Re-establishment in respect of time limits is available. A request may be filed by an applicant who, due to force majeure, has failed to observe a time limit laid down by the Patent Office for the payment of renewal fees (Art. 134 PA).



### Appeal

With respect to decisions taken by the Patent Office in registration procedures, an applicant or third party may appeal to the Re-examination and Evaluation Board (President, Vice-President, two further members appointed by the President).

- Generally, there is no further appeal from the decisions of the Patent Office in patent cases. An appeal from a decision of the Re-examination and Evaluation Board can be made to the Ankara Specialised IPR Civil Court (first-instance court in civil judiciary) within 60 days after notification of the decision. This court examines the decisions of the Re-examination and Evaluation Board on points of both law and fact.

## b. Civil procedure

### Infringement

Actions can be brought to specialised IPR Civil Courts in Ankara, İstanbul and İzmir and to the general civil courts of first instance (numbered first or third) where specialised IPR civil courts do not exist – depending on the domicile of the claimant or on the place where effects of infringement have occurred.

- Proceedings may be instituted by the proprietor of a patent or an exclusive licensee, unless otherwise provided in the contract; in any case the patent owner has to be informed (Art. 137, 148 PA).
- In any proceedings based on infringement, the court cannot take into consideration any defence regarding invalidity unless the defendant brings a counteraction based on invalidity. According to Turkish law, counteraction means an independent case rather than an ordinary defence.

TR

- Remedies: cessation of actual infringement and prevention of probable infringement, damages, determination of evidence, seizure, destruction, pecuniary measures, disclosure by means of publication of the court judgment (Art. 137-145 PA).
- Criminal proceedings: There are no criminal sanctions for patent infringement for two reasons:
  - (1) The Constitutional Court has abolished the criminal effect of Art. 136/I-a and b PA (direct infringement regarding product patents) by decision No.: E.: 2005/57, K.: 2009/19; dated 5 February 2009.
  - (2) The new Turkish Criminal Code No. 5237, Art. 5, has abolished the enforceability of Art. 73/A PA (all criminal sanctions regarding patents).

#### **Nullity**

Patents can be invalidated only by decision of a court (Art. 129 PA) – competent specialised IPR courts or the general civil courts.

- The inventor, his successor, persons adversely affected or interested official authorities, acting through the public prosecutor, may bring a nullity action before the courts (Art. 130 PA).
- A nullity action may be instituted during the entire lifetime of a patent and within five years subsequent to the termination of a patent right (Art. 130(2) PA).
- The court’s decision has retroactive effect (Art. 131 PA). Partial nullification is allowed (Art. 129(3) PA).

#### **Compulsory licence**

The competent courts (specialised IPR civil courts or the general civil courts of first instance) may grant compulsory licences in cases of non-working, dependent patents and public interest (Art. 99, 100 PA).

#### **Declaration of non-infringement**

May be issued by the court. Prior to the initiation of proceedings, the claimant must require the owner of the patent to express his views through a notice served by the notary public. Service of notice is a pre-condition for the institution of an action.

#### **c. Other**

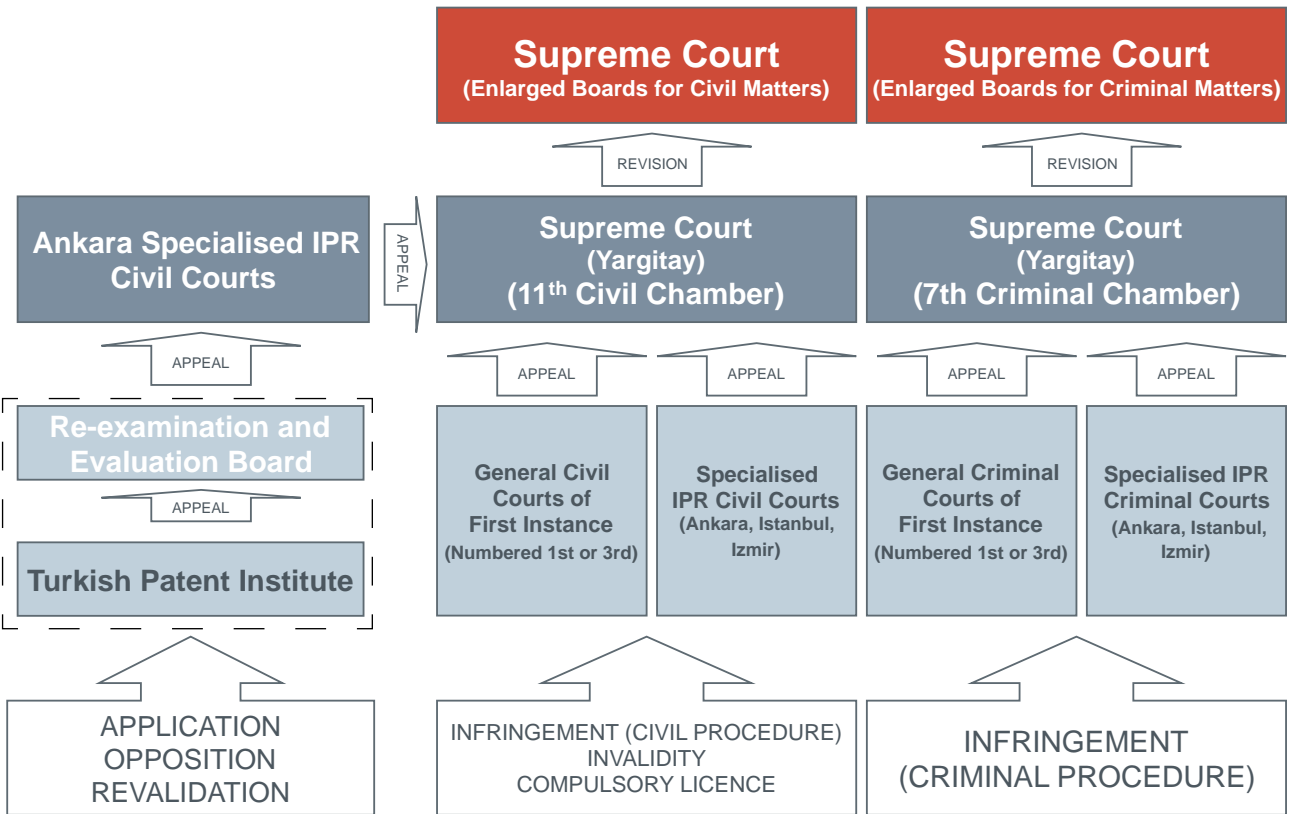
In total there are 22 specialised IPR courts in Ankara, İstanbul and İzmir (seven civil and six criminal IPR courts in İstanbul, four civil and two criminal in Ankara, one civil and one criminal in İzmir). These courts are the first-instance courts dealing with all intellectual and industrial property cases. General civil courts of first instance and general criminal courts at first instance are competent to deal with IPR cases where specialised IPR courts do not exist. (If there are one or two general civil or criminal courts, the first is competent to deal with IPR cases. If there are three or more

general civil or criminal courts, the third is competent to deal with IPR cases.)

The Supreme Court examines the decisions taken by the courts of first instance both on points of law and on points of fact. It has 23 civil chambers and 15 criminal chambers. The Eleventh Civil Chamber examines appealed decisions in IPR civil cases. The Seventh Criminal Chamber examines appealed decisions in IPR criminal cases.

#### **Bibliography**

- Decree-Law No. 551 pertaining to the protection of patent rights, in force as from 27 June 1995, as amended by Law No. 4128 of 7 November 1995 [cited as: PA]; translation provided by Turkish Patent Office
- “Presentation of the national proceedings with regard to the validity and enforcement of patents” (TR), Turkish Patent Office, EUROTAB 34/2007
- “Manual for the Handling of Applications for Patents, Designs and Trademarks throughout the World”, edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Turkey, No. 106, June 2006
- “Patents throughout the World”, 2008 Thomson Reuters/West, Chapter 169 on Turkey, 12/2002



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## The Unified Patent Court

The Unified Patent Court (UPC) will be a specialised patent court common to the European Union's Member States. It will be established to settle disputes relating to European patents and unitary patents (European patents with unitary effect).

The UPC is based on an international agreement signed by 25 Member States (the UPC Agreement of 19 February 2013), which will enter into force once ratified by at least 13 Member States, including the three in which the highest number of European patents had effect in 2012, i.e. France, Germany and the United Kingdom.

The UPC will comprise a Court of First Instance, a Court of Appeal and a Registry. The decentralised Court of First Instance will comprise a central division – with seat in Paris and a section in London and one in Munich – as well as a number of local and regional divisions set up in the Member States. The common Court of Appeal will have its seat in Luxembourg.

A training centre for judges will be set up in Budapest. A patent arbitration and mediation centre will be shared between Lisbon and Ljubljana.

### Competence *ratione materiae*

The UPC will have exclusive competence to hear infringement actions, actions for declarations of non-infringement, actions for provisional and protective measures and injunctions, revocation actions, actions for damages or compensation derived from the provisional protection conferred by a published European patent application, actions relating to rights based on prior use of an invention and actions for compensation for licences of right. It will also deal with counterclaims for revocation and other defences (e.g. counterclaims relating to licences, Bolar exemption). Finally, it will hear actions (ex parte) against decisions which the EPO takes when carrying out tasks related to unitary patent protection.

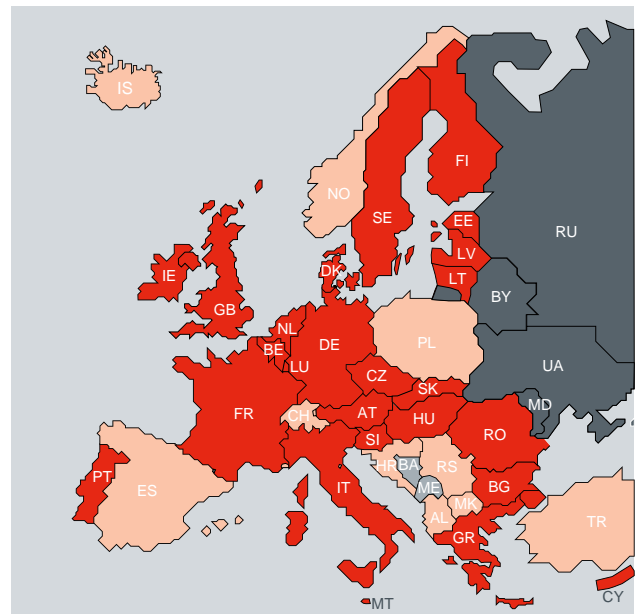
The UPC will also deal with the infringement and validity of supplementary protection certificates issued for products protected by a European patent or a unitary patent.

The national courts of the Member States will remain competent for actions which do not come within the exclusive competence of the UPC, e.g. cases relating to compulsory licensing.

### Competence *ratione loci*

As regards the competence of the particular divisions of the Court of First Instance, infringement actions and actions for provisional and protective measures and injunctions will in general be brought before either:

- the local division hosted by the Member State where the actual or threatened infringement has occurred or may occur, or the regional division in which the Member State participates, or



- the local division hosted by the Member State where the defendant is domiciled, or the regional division in which this Member State participates.

The central division of the Court of First Instance will hear

- actions for declarations of non-infringement
- revocation actions
- actions (ex parte) against decisions of the EPO
- actions which would have been brought to a local or regional division in a Member State, if that State neither sets up a local division nor participates in a regional division.

The central division may also hear infringement actions in the following cases:

- a plaintiff may bring an infringement action before the central division against a defendant domiciled outside the Member States;
- where a revocation action is already pending at the central division, the patent proprietor may bring an infringement action before the central division;
- finally, where an infringement action is pending before a regional division and the infringement has occurred in the territories of three or more regional divisions, the defendant may request that the action be referred to the central division.

Parties may agree to bring actions before the division of their choice (except ex parte actions, which will be heard by the central division).

### Allocation of cases to the central division's seat and sections

The central division's seat in Paris will deal with cases relating to patents in Classification Sections B (performing operations; transporting), D (textiles; paper), E (fixed constructions), G (physics) and H (electricity).

The section in London will deal with patents in Classifi-

cation Sections A (human necessities) and C (chemistry, including pharmaceuticals), while the section in Munich will deal with patents in Classification Section F (mechanical engineering).

#### **Discretion of local and regional divisions to deal with counterclaims for revocation**

When the defendant raises a counterclaim for revocation in the course of infringement proceedings, four options are available to a panel of a local or regional division. It may:

- deal with the whole case (infringement action and counterclaim for revocation) once a technically qualified judge has been allocated to it,
- refer the counterclaim to the central division and deal with the infringement action,
- refer the counterclaim to the central division and stay the infringement action, or
- refer the whole case to the central division.

#### **Revocation and amendments**

The UPC may revoke a European patent or a unitary patent, either in full or in part, only on the grounds listed in Articles 138(1) and 139(2) EPC. If the grounds for revocation affect the patent only in part, the patent will be limited by a corresponding amendment of the claims and revoked in part. Decisions will have retroactive effect.

#### **Parallel proceedings at the UPC and at the EPO**

A party may bring a revocation action to the UPC

- without having to start opposition proceedings at the EPO beforehand or
- even though he has already started opposition proceedings at the EPO.

Where parallel proceedings are pending, the UPC will have discretionary power to either stay its proceedings or proceed with the case. The UPC may in particular stay proceedings when a rapid decision may be expected from the EPO. In any event, where an action has been brought before the UPC, a party will have to inform the UPC of any opposition, limitation or revocation proceedings pending at the EPO.

#### **Role of the CJEU**

The UPC will apply EU law in its entirety and respect its primacy. As any national court, whenever a question of interpretation of EU law arises, the UPC will send a request for a preliminary ruling to the Court of Justice of the European Union (CJEU).

#### **Composition of panels**

At first instance, a panel of a local and regional division will in general be composed of three legally qualified judges. A fourth technically qualified judge will often be allocated to the panel (on request by a party or when a counterclaim for revocation is to be dealt with).

All panels of the UPC will have a multinational composition. At first instance,

- on the panel of a local division hearing more than 50 cases per year, two judges have to come from the State hosting the division and one from another State;
- on the panel of a local division hearing fewer than 50 cases per year, one judge has to come from the State hosting the division and two from other States;
- on the panel of a regional division, two judges have to come from States hosting the division and one from another State.

In the central division, a panel will in general comprise two legally qualified judges (who are nationals of different Member States) and one technically qualified judge. Only when it hears actions (ex parte) against decisions of the EPO will the panel sit in a composition of three legally qualified judges of different nationalities.

Parties may agree to have their case heard by a single legally qualified judge.

In the Court of Appeal, a panel will sit in a multinational composition of five judges (three legally and two technically qualified). Only in ex parte cases will the panel sit in a composition of three legally qualified judges.

#### **Parties to proceedings and representation**

Actions may be brought by the patent proprietor and by the holder of an exclusive licence. In addition, any other natural or legal person, or any body concerned by a patent and entitled to bring actions in accordance with its national law, may bring actions before the UPC.

Parties must be represented either by lawyers (attorneys-at-law) or by members of epi with appropriate qualifications in patent litigation. Representatives may be assisted by patent attorneys who may address the UPC.

#### **Powers of the UPC and award of damages**

Inspired by Directive 2004/48 on the enforcement of IPR, the UPC Agreement provides the UPC with wide powers to issue orders and impose measures, procedures and remedies. The UPC may for example:

- order provisional measures to preserve evidence
- order the inspection of premises
- order a party to produce evidence (even inaudita altera parte)
- appoint court experts
- order a party not to remove from its jurisdiction any assets, or not to deal with any assets (freezing orders)
- grant provisional and protective measures against an alleged infringer, including seizure and delivery up of products suspected of infringing a patent.

Where the UPC finds that a patent has been infringed, it may

- grant permanent injunctions aimed at prohibiting continuation of the infringement

- order corrective measures such as recalling the infringing products from the channels of commerce or even their destruction
- order the infringer to communicate information such as origin and distribution channels of the infringing products, quantities produced and identity of any third person involved in the production or distribution of the infringing products.

The UPC may also award the injured party damages appropriate to the harm actually suffered as a result of the infringement. However, damages must not be punitive.

### Appeal and rehearing

An appeal against a decision of the Court of First Instance may be brought before the UPC's Court of Appeal by any party which has been unsuccessful, in whole or in part, in its submissions. The appeal may be based on points of law and matters of fact.

Very exceptionally – in the event of a fundamental procedural defect or on discovery of a decisive and unknown fact (based on an act which has subsequently been held to constitute a criminal offence) – the Court of Appeal may set aside a final decision of the UPC and re-open the proceedings for a new trial and decision.

### Opt-out scheme

The UPC Agreement provides applicants and patent proprietors with a possibility to opt out from the exclusive jurisdiction of the UPC. The opt-out scheme is available for:

- any European patent granted before the end of a seven-year transitional period (which will start on the date of entry into force of the UPC Agreement) and
- any European patent application filed before the end of the seven-year transitional period.

The opt-out scheme only concerns European patent applications and European patents. For unitary patents there is no possibility to opt out from the exclusive jurisdiction of the UPC.

An opt-out must be notified to the UPC's Registry by the applicant or the patent proprietor no later than one month before the end of the seven-year transitional period. The Registrar will be responsible for keeping and publishing a list of opt-out notifications, so that third parties can ascertain in advance that a particular application or patent will not fall under the jurisdiction of the UPC.

Where an opt-out has not been notified for a European patent application or European patent and proceedings in respect of that patent are brought before the UPC, an opt-out for that patent can no longer be notified. This applies whether proceedings have been brought by the applicant, the patent proprietor or a third party.

Where a patent proprietor has notified an opt-out for a particular European patent, litigation relating to that patent must be brought before the national courts or other compe-

tent authorities of the Member States.

Applicants and patent proprietors may withdraw their opt-out at any moment.

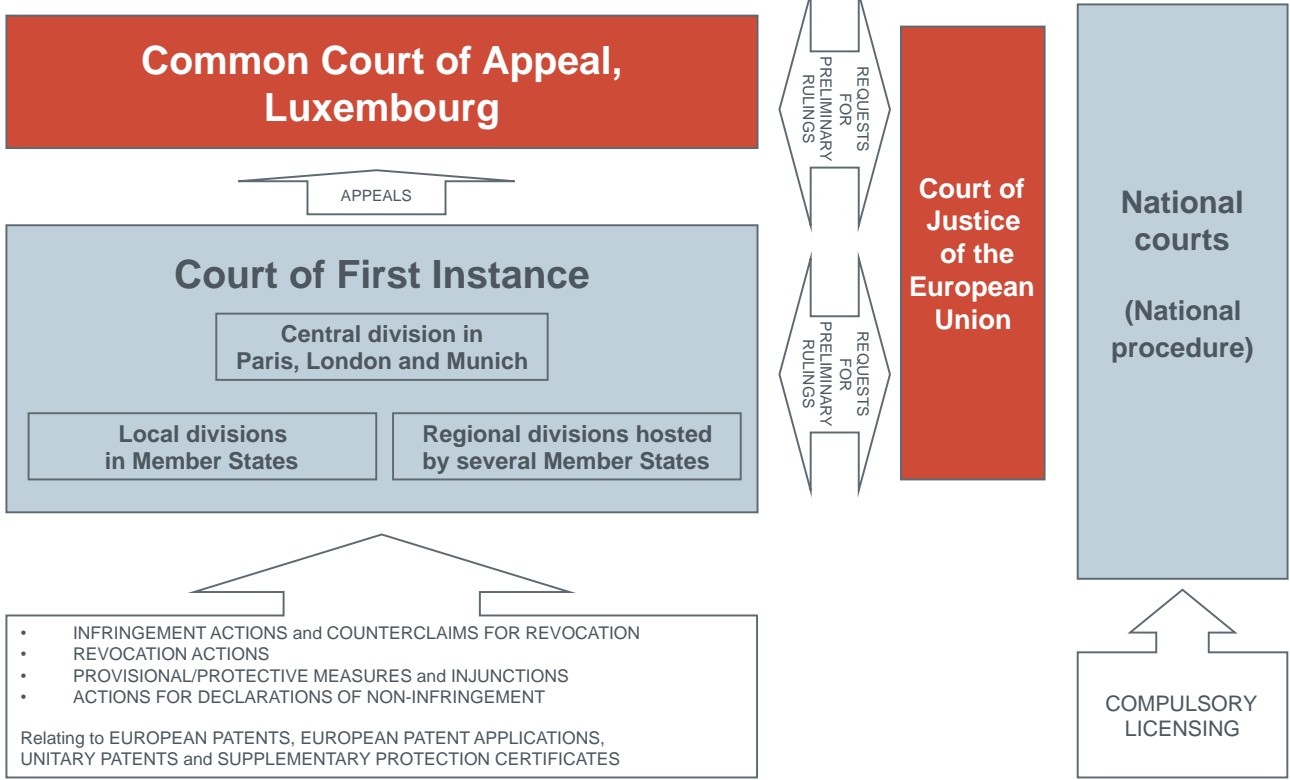
### Choice of forum during transitional period

As regards European patents, a seven-year transitional period is provided in which plaintiffs – whether patent proprietors, licence holders or third parties – may freely decide to initiate infringement actions and revocation actions either before the UPC or before the national courts or other competent authorities of one or more Member States.

Once a plaintiff has chosen a particular forum (having jurisdiction under either national law or the UPC Agreement), that forum will have exclusive jurisdiction to deal with the action. Where proceedings are pending before a national court at the end of the seven-year transitional period, the action will be dealt with by the national court concerned.

### Period of limitation

Actions relating to all forms of financial compensation may not be brought more than five years after the date on which the applicant became aware, or had reasonable grounds to become aware, of the last fact justifying the action.



UPC









**European Patent Academy**  
**European Patent Office**  
Bob-van-Bentham-Platz 1  
80469 Munich  
Germany  
Tel. +49 (0)89 2399-5454  
Fax +49 (0)89 2399-5449  
academy@epo.org

[www.epo.org/academy](http://www.epo.org/academy)

**Published and edited by**  
European Patent Academy  
European Patent Office  
Munich  
Germany

**Responsible for the content**  
Dir. 5.4.4

**Design and production**  
EPO Graphic Design Munich

**Printing**  
EPO Repro Munich