

Global Patent Litigation

Supplement 30, 2016

Highlights

In this Supplement 30 of *Global Patent Litigation* the following three significant chapters have been fully revised and updated:

- The European Patent Convention (EPC)
- Belgium
- Ireland
- Israel

Written by renowned patent litigators in **The European Patent Convention (EPC), Belgium, Ireland & Israel** these chapters provide a quick and comprehensive overview of the main features of patent law and patent litigation in these jurisdictions. Following the usual blueprint of *Global Patent Litigation*, each chapter describes how a patentee can enforce the patent, highlighting possible pitfalls and remedies and thus enabling you to make an informed decision when litigating in these jurisdictions.

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In this thirtieth supplement of *Global Patent Litigation* you will find the updated chapters of **The European Patent Convention (EPC), Belgium, Ireland & Israel**

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This monograph has been reviewed by the Author and is up-to-date as of July 2016.

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Ireland

(1) APPLICABLE LAWS

1 Patent law in Ireland is governed by the Patents Act 1992, as amended (the ‘1992 Act’). The Patents Rules 1992, as amended, (the ‘Patents Rules’) prescribe procedures to be observed in connection with patents granted under the 1992 Act. The terms of the 1992 Act are closely modelled on the provisions of the European Patent Convention (the EPC) and the Community Patent Convention (the CPC), and one of the stated objectives of the 1992 Act was to enable ratification of the EPC as well as the Patent Co-Operation Treaty.

2 The provisions of the 1992 Act apply equally to national Irish Patents, granted by the Irish Patent Office for a duration of twenty years, and to European Patents designating Ireland, granted by the European Patent Office (EPO). This is made clear by section 119 of the 1992 Act which provides that a European patent designating Ireland shall be treated for the purposes of the 1992 Act as if it were a patent under that Act.

3 Part III of the 1992 Act, however, includes special provisions in respect of Irish ‘short-term patents’. A short-term patent is granted for a term of ten years, can have a maximum of five claims, and is subject to a requirement that the invention is ‘new and susceptible of industrial application *provided it is not clearly lacking an inventive step*’ (emphasis added); i.e., a lower standard of inventive step applies. A short-term patent and a regular Irish patent (or Irish designated European Patent) cannot coexist in respect of the same invention. Short-term patents are not examined for novelty or inventive step before being granted, and no infringement proceedings can be initiated in respect of a short-term patent until an appropriate search report is commissioned and provided to the alleged infringer. Finally, short-term patents have a special ground of revocation which is that the claims of the patent are not supported by the description.

4 Ireland has also acceded to or ratified a number of other international treaties relating to patents namely the International Convention for the Protection of Industrial Property (‘the Paris Convention’), the Strasbourg Convention on the Unification of Certain Points of Substantive Law on Patents for Inventions, the Strasbourg Agreement concerning the International Patent Classification, the Budapest Treaty on the International Recognition of the Deposit of Micro-Organisms for the Purposes of Patent Procedure, the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), the Agreement on the Application of Article 65 of the Convention on the Grant of European Patents done at London on 17 October 2000 (the ‘London Agreement’), and is a signatory to the Patent Law Treaty. Although ratification/accession binds the state, such treaties do not have any automatic effect in Irish domestic law without implementing legislation. The 1992 Act was amended by the Patents (Amendment) Act 1996 to give effect to certain provisions arising under the TRIPS Agreement, the EPC and the Patent Law Treaty. Procedures outlined in the Budapest Treaty and Patent Co-operation Treaty have been applied in the 2009 amendments to the Patents Rules (S.I No. 194 of 2009 Patents (Amendment) Rules 2009). Regulation (EC) No. 816/2006 adjusted obligations arising under the TRIPS Agreement to allow for the issuance of compulsory licences with respect to the manufacture of pharmaceutical products for export to countries with public health problems. This

regulation has been transposed into Irish law (European Communities (Compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems) Regulations 2008, S.I No. 408 of 2008). The 1992 Act was further amended by the Patents (Amendment) Act 2012 to give effect to the London Agreement.

5 Ireland has a common law legal system, similar to that which exists in England and in a number of other former British colonies, including Canada and Australia. This means that Irish law is derived not only from the statutes passed by the Irish parliament and its predecessors, but also from the decisions of the Irish courts. Thus, in considering the 1992 Act, it is always necessary to keep in mind the possibility that judicial decisions may have elaborated on the meaning of specific provisions, or that particular judicially developed doctrines may be relevant.

6 There has historically been relatively little patent litigation in Ireland, in particular patent litigation that progresses to a full trial and judgment, so there is very little case law on the interpretation of the 1992 Act. In interpreting the Act, the Irish courts can be expected to have regard to the decisions of courts in other jurisdictions, and, in particular, in the UK, which has a very similar legal system. In addition, the 1992 Act provides that judicial notice, and notice by the Controller of Patents, Designs and Trademarks (the ‘Controller’), shall be taken of the EPC, the Patents Co-operation Treaty and any other international treaty relating to patents to which the state may become a party and which shall be designated for this purpose, as well as any decision or expression of opinion of any ‘competent authority’ on any question arising under or in connection with the EPC (section 129 of the Patents Act 1992). On this basis, the Irish courts can be expected to have regard to the decisions of the EPO.

(2) ENTITLEMENT

7 According to section 16(1) of the 1992 Act, the right to a patent shall belong to the inventor or his successor in title. Under section 16(2) of the 1992 Act, if two or more persons have made an invention independently of each other, the right to a patent for the invention shall belong to the person whose patent application has the earliest date of filing. Ireland therefore operates a 'first to file' system rather than a 'first to invent' system.

(2.1) COMPENSATION

8 There is no statutory provision in Ireland which provides for compensation of employees where an invention has been made in the course of their employment.

(2.2) DERIVATION

9 The applicant for a patent need not be the inventor. Where someone other than the inventor makes the application, however, it is necessary to identify the inventors within sixteen months after the priority date or, where there is no priority claimed, the date of filing the application. Section 17(2) of the 1992 Act states that where the applicant is not the sole inventor, or the applicants are not the joint inventors, a statement must be made indicating the derivation of his or their right to be granted the patent. Where such a statement is required but is not provided within the timeframe, the application is deemed to be withdrawn.

(2.3) APPLICANT

10 According to section 15 of the 1992 Act, any person may make an application for a patent either alone or jointly with another. According to section 16 of the 1992 Act, the right to a patent belongs to the inventor of the invention in question or his successor in title.

11 Under 17(3), a person who alleges that another person has been incorrectly named as sole or joint inventor may request the Controller to make a finding to that effect. Rule 7 of the Patents Rules 1992 states that the onus is on the person making such a request to provide a statement setting out fully the facts relied upon in claiming that he himself should have been mentioned as inventor, or that another person should not have been so mentioned.

(2.4) EMPLOYEE

12 Section 16 of the 1992 Act states that where the inventor is an employee, the right to a patent shall be determined in accordance with the law of the state in which the employee is wholly or mainly employed or, if the identity of such state cannot be determined, in accordance with the law of the state in which the employer has his place of business to which the employee is attached.

13 In Ireland, the patent legislation does not make provision for these situations and so the common law position prevails. Section 39 of the UK Patents Act 1977 provides some guidance as it was enacted to put on a statutory footing the common law position in the UK at that time. It stated that an invention of an employee would, as between employer and employee, be taken to belong to an employer where:

- (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or
- (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

14 Under common law, an express provision to the contrary is required to displace the otherwise implied term that the employee is acting as a trustee of the employer and that the employer is therefore entitled to the product of the employee's work, in this case being the invention.

15 An examination of the facts is required in each particular case to determine whether the employer or employee is entitled to the patent.

(2.5) EDUCATION/RESEARCH

16 There is no specific legislative provision on where IP ownership vests when an invention comes about in the context of education or research. The provisions relating to employees will be relevant assuming the person carrying out the research is employed by the institution. See section 2.4. Employee.

17 An Intellectual Property Protocol (the 'Protocol') was published by the Department of Jobs, Enterprise and Innovation and the Minister for Research and Innovation in 2016. The Protocol, which updates a Protocol published in 2012, aims to help industry to access the research and development done in Ireland's universities, institutes of technology and other public research institutions and deals with the ownership of IP, but it does not have a legally binding effect.

(2.6) TEAMWORK

18 The inventor holds the right to a patent. Under section 17(1) of the 1992 Act, the inventor or joint inventors have a right to be mentioned in the specification of a patent granted for the invention and also have a right to be mentioned in any published patent application. Rule 7(1)(a) of the Patents Rules 1992 provides for the making of an application by a person who alleges he ought to have been mentioned as a joint inventor of an invention.

19 Section 80 of the 1992 Act provides that where a patent is applied for by or granted to two or more persons, each person is entitled to an equal undivided share in common in the

patent application or patent, unless there is a contrary agreement in force between those persons.

(2.7) ENTITLEMENT CLAIMS

20 Under section 81 of the 1992 Act, any person may refer to the Court the question of whether by operation of law or otherwise he is, either alone or jointly, entitled to any patent granted or to be granted in the state for an invention. The Court may make any order to give effect to its decision, as it considers expedient, including an order for apportionment.

21 Such an application must be made within two years from the date of the grant of the patent, unless it is shown that a person registered as proprietor of the patent knew at the time of the grant, or of the transfer or assignment of the patent to him, that he was not entitled to the patent.

(3) SCOPE OF PROTECTION

(3.1) CLAIMS, DESCRIPTION AND DRAWINGS

22 Section 45 of the 1992 Act provides that ‘the extent of the protection conferred by a patent or a patent application shall be determined by the claims; nevertheless, the description and drawings shall be used to interpret the claims’.

23 The section goes on to provide that the High Court, in interpreting the claims, shall have regard to the Protocol on the Interpretation of Article 69 of the EPC, which is a schedule to the 1992 Act. This provides that:

General Principles

Section 45 should not be interpreted in the sense that the extent of the protection conferred by a patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of certainty for third parties.

Equivalents

For the purpose of determining the extent of protection conferred by a patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

(3.2) PATENT AS GRANTED

24 Section 45(2) of the 1992 Act provides that the terms of the claims of the patent as granted, or as amended in accordance with section 38 of the 1992 Act, shall determine the extent of protection conferred, subject to the proviso that the provision is not to be construed as providing to an applicant protection greater than that sought at the date of publication.

25 Section 56(1) of the 1992 Act provides that once a patent is granted, damages for infringement in respect of acts committed prior to the date of publication of the notice of the grant of the patent but after the date of publication of the application can be sought. Section 45(2) of the 1992 Act also provides that for the period up to the grant of a patent, the extent of the protection conferred by the patent application shall be determined by the latest filed claims contained in the publication. Section 56(3) of the 1992 Act says that:

In considering the amount of any damages to be awarded in proceedings under this section, the Court shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 28, that a patent would be granted conferring on the proprietor of the patent protection from

an act of the same description as that found to have infringed those rights, and if the Court finds that it would not have been reasonable so to expect, it shall reduce the damages to such an amount as it thinks fit.

(3.3) INTERPRETATION OF STATE OF THE ART

26 Section 9(1) of the 1992 Act states that in order for an invention to be patentable, it must be new. Section 11(1) of the 1992 Act goes on to say that an invention shall be considered to be new if it does not form part of the state of the art. As such, the protection afforded by a patent is limited to that which is novel when viewed in light of the state of the art.

27 Under section 11(2) of the 1992 Act, the state of the art is defined as comprising ‘everything made available to the public (whether in the state or elsewhere) by means of a written or oral description, by use, or in any other way, before the date of filing of the patent application’.

28 In *Glaxo Group Ltd v. The Patents Act* ([2009] IEHC 277), Charleton J considered section 11(2) and the determination of the state of the art. He held that it is clear that under section 11(2), the state of the art extends beyond the boundaries of the state and must be considered globally. Charleton J summarized his task in this regard by reference to a passage from the English case of *British R. Syndicate Limited v. Minerals Separation Limited* ([1909] 26 R.P.C. 124 at 128):

To arrive as closely as it can as the mental attitude of a well-instructed representative of the class to whom the specification is addressed, and no more. In other words, in the performance of this part of its task it has to ask itself what ought fairly to be considered to be the state of knowledge in the trade or profession at the date of the patent with respect to the matters in question, and if any facts or documents or such that in ordinary probability they would not be known to competent members of such trade or profession, they ought not to be taken, either for against the public on the one hand, or the inventor on the other, as forming part of public general knowledge.

(3.4) CRITERION FOR SCOPE OF PROTECTION

29 Section 45 of the 1992 Act provides that ‘the extent of the protection conferred by a patent or a patent application shall be determined by the claims; nevertheless, the description and drawings shall be used to interpret the claims’.

30 In interpreting the equivalent provision, the UK courts have applied ‘a purposive construction rather than a purely literal one’ by enquiring if:

persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked (*Catnic Components Ltd v. Hill & Smith Ltd* [1982] RPC 183; see also *Kirin-Amgen Inc. v. Hoechst* [2004] UKHL 46).

This test was approved by the Irish Supreme Court in *Ranbaxy Laboratories Ltd & ors. v. Warner Lambert Company* ([2005] IESC 81). In *Novartis AG. v. The Controller of Patents, Designs and Trademarks* ([2007] IEHC 442), the High Court heard an appeal against a decision of the Controller to refuse the grant of a Supplementary Protection Certificate (SPC) to the applicant. In determining if a combination product was protected by the patent, the Court adopted a purposive construction of the relevant claims. The decision of the Controller was upheld.

31 In considering if a variation on an invention infringes a patent, the UK courts have used the following questions as guidelines:

- (1) Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no –
- (2) Would this (i.e., that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art. If no, the variant is outside the claim. If yes–
- (3) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention. If yes, the variant is outside the claim (*Improver v. Remington Consumer Products* [1990] FSR 181).

32 In the House of Lords in the UK decision in *Kirin-Amgen Inc. v. Hoechst* (2004) UKHL 46; approved in *Ranbaxy Laboratories Ltd & ors. v. Warner Lambert Company* [2005] IESC 81), the Court emphasized that these questions are merely guidelines, useful in some situations, but not in others. Reference must be had in each case to the ‘principle of purposive construction’, asking ‘what the person skilled in the art would have understood the patentee to mean’.

33 This approach was approved by the Irish High Court in *Ranbaxy Laboratories Ltd & ors. v. Warner Lambert Company* ([2007] IEHC 256) and most recently in *Medinol Ltd v. Abbott Ireland & Others* ([2011] IEHC 218) where McGovern J held that he was satisfied that he should use a purposive construction so as to avoid ‘... the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge’ (as per Diplock L.J. in *Catnic Components Ltd. v. Hill and Smith Ltd.* [1982] R.P.C. 183 at 242–243). The court has to identify the notional ‘person skilled in the art’ and then identify the relevant common general knowledge of that person. The court should then look at the inventive concept of the claim in question, and if it cannot readily be identified, it should be construed. The question, McGovern J held, was ‘what would a person skilled in the art have understood the patentee to have used the language of the claim to mean?’

34 The Irish and UK courts have recently developed a business efficacy approach to patent construction, an approach traditionally applied in the field of commercial contracts. The contract is read from the perspective of interested parties. When conflict arises between competing constructions, the contract is constructed in a manner that yields to commercial commonsense, under an assumption that a workable business arrangement was intended. The applicability of the test to patent construction was explored by the English Court of Appeal in *Ranbaxy UK Ltd. v. Warner-Lambert Co.* ([2007] R.P.C 4). The approach has been affirmed by the Irish High Court in *Ranbaxy Laboratories Ltd. & ors. v. Warner Lambert Company.* ([2007] IEHC 256) The chief question posed within the Ranbaxy litigation was whether the patent covered only racemic mixtures of the relevant compound (in which case, Ranbaxy’s product did not infringe) or if it extended to also cover a wider range of molecules, including the single enantiomers making up the racemic mixture. The

Court held that it would have been ‘irrational’ of the skilled addressee to solely seek a patent for a racemic mixture when it was known that the single enantiomers held greater potential for potency.

(3.5) ROLE OF PROSECUTION HISTORY

35 There is no doctrine of ‘file-wrapper’ estoppel in Irish law. In *Ranbaxy Laboratories Ltd & ors. v. Warner Lambert Company*. ([2005] IESC 81), the Irish Supreme Court found that expressions of opinion of the patentee as to the correct construction of the claims are not admissible as an aid to their construction. In reaching that conclusion, the Court cited the statement in *Kirin-Amgen* that:

Construction, whether of a patent or any other document, is of course not directly concerned with what the author meant to say. There is no window into the mind of the patentee or the author of any other document. Construction is objective in the sense that it is concerned with what a reasonable person to whom the utterance was addressed would have understood the author to be using the words to mean. Notice, however, that it is not, as is sometimes said, ‘the meaning of the words the author used’, but rather what the notional addressee would have understood the author to mean by using those words. The meaning of words is a matter of convention, governed by rules, which can be found in dictionaries and grammars. What the author would have been understood to mean by using those words is not simply a matter of rules. It is highly sensitive to the context of and background to the particular utterance. It depends not only upon the words the author has chosen but also upon the identity of the audience he is taken to have been addressing and the knowledge and assumptions which one attributes to that audience.

On that basis, the Court refused to admit evidence of correspondence between the patentee and patent offices in various jurisdictions.

36 The UK Court of Appeal has also recently clarified, in *Actavis UK Ltd & Ors v. Eli Lilly & Company* [2015] EWCA Civ 555, that the patent prosecution history will not serve as an aid to claim construction in UK proceedings.

(3.6) EQUIVALENTS

37 The doctrine of equivalents has fallen out of favour in the Irish courts. Under the pre-1992 Irish legislation, the Irish courts had applied a doctrine of equivalents, finding infringement through the use of a substance that was a chemical equivalent of the substance referred to in a claim, on the basis that a person who did not obtain the desired result using the chemical named in the claim could be expected to try the alternative used by the defendant (*Farbwerke Hoechst A.G. v. Intercontinental Pharmaceutical (Eire) Ltd [1968] FSR 18*). However, this was in the context of a statutory provision which included specific reference to ‘obvious chemical equivalents’. The UK experience has been that the courts will admit equivalents to a limited extent but have not been prepared to go as far as adopting a doctrine of equivalents of the type found in US jurisprudence. In *Kirin-Amgen*, the House of Lords rejected a formal doctrine of equivalents as contrary to the terms of Article 69 of the EPC ([2004] UKHL 46). Lord Hoffman pointed out that the doctrine of equivalents is a necessary reaction to an excessive literalism in interpreting claims. The

question of whether a patent is infringed is to be determined solely by considering if it is within the claims, but always bearing in mind that the claims are to be given a purposive rather than purely literal interpretation. In the 2007 judgment in *Ranbaxy Laboratories Ltd & ors. v. Warner Lambert Company*, the Irish High Court affirmed Lord Hoffman's approach ([2007] IEHC 256).

38 Despite the incorporation of the Protocol, it is clear from the wording of section 45 that the specification remains of secondary importance in defining the scope of the patent. The claims set out the full extent of the protection conferred by the patent, and while regard may be had to the description and drawings, these may only be used to 'interpret' the claims.

(3.7) NON-INVENTIVE APPLICATION OF STATE OF THE ART

39 There is no Irish decision on the so-called *Gillette* defence. However, the principles on which it is based apply equally in Irish law. If the alleged act of infringement forms part of the prior art, or a non-inventive variation thereof, the logical consequence must be that either the act complained of is outside the scope of the patent or that the patent is at least partially invalid because of anticipation. It is difficult to see how an Irish court would reach a different conclusion.

40 In addition, there is a specific statutory defence (section 55 of the 1992 Act) in which a person can show that he did an act alleged to constitute infringement, or made in good faith effective and serious preparations to do such an act before the filing date or the priority date, as appropriate. This defence is somewhat narrower than the *Gillette* defence, applying only to the acts of the defendant, rather than the entirety of the prior art. However, it may be useful in certain cases in which the *Gillette* defence would not apply by virtue of the fact that the defendant's prior acts do not form part of the prior art, for example, because they were not in the public domain.

(3.8) TRANSLATIONS

41 According to section 23(1)(c)(i) of the 1992 Act, in order to establish a date of filing of a patent application, a description of the invention for which a patent is sought (even where this description does not comply with other requirements of the Act) or a reference to a previously filed application by the applicant or his predecessor in title must be filed. According to section 23(2) of the 1992 Act, it is immaterial whether the description of the invention is in, or is accompanied by a translation into, a language which is accepted by the Patents Office in accordance with any prescribed requirements.

42 When claiming priority in the state under section 26 of the 1992 Act, an applicant wishing to take advantage of a previous application may have to file a copy of the previous application. If such an application is in a foreign language, a translation in English may also be required at filing.

43 For European Patents, under section 120(6) of the 1992 Act, an application for a European patent designating Ireland but published in French or German by the EPO under the EPC will be treated for the purposes of an infringement claim as being published

subject to the conditions of publication in section 28 of the 1992 Act as soon as an English translation of the claims of the application has been filed at and published by the Patents Office. An applicant may however bring proceedings for infringement in respect of an act done before publication of the translation by the Patents Office if, and only if, before the doing of that act he has sent by post or delivered to the person alleged to have done the act, a translation in English of the said claims.

44 Section 121 of the 1992 Act states that the language of the proceedings shall determine the language of the text of a European patent or application. For the purposes of any proceedings under the 1992 Act before the Controller or the High Court, the authentic text of the European patent or application is that which is in the language of the proceedings. Where the language of the proceedings is French or German, a translation in English shall be treated as the authentic text for the purposes of any proceedings under the Act (other than proceedings for the revocation of the patent) if the claims as translated confer a narrower protection than that conferred in French or German. If such a translation resulting in a narrower protection occurs, the owner or applicant for the patent may file a corrected translation. If, before a corrected translation is filed, a person commences in good faith to do an act which would not infringe the original translation but would infringe the amended translation, subsections 121(5)–121(8) of the 1992 Act will apply. The person infringing has the right to continue to do the now-infringing act, notwithstanding the publication of the corrected translation. He may not grant a licence to another to do such an act, but if such an act was done or preparations made to do it in the course of a business, he may authorize that act to be done by any partner in that business, or assign the right (or transmit on death, or in the case of a body corporate on its dissolution) to any person who acquires that part of the business in the course of which the act was done or preparations made to do it.

45 Regarding the conversion of a European patent application filing, under section 122(2) of the 1992 Act, the conditions for treatment of a withdrawn European patent application as a national patent application include the filing of an English translation of the application where the application was previously in German or French.

(3.9) NATIONAL (NON-EUROPEAN) PATENTS

46 According to section 119 of the 1992 Act, a European patent designating Ireland shall, from the publication of the mention of its grant in the European Patent Bulletin, be treated for the purposes of the 1992 Act as if it were a patent under that Act, granted in pursuance of an application under that Act. The proprietor of a European patent designating Ireland shall, as respects Ireland, have the same rights and remedies and be subject to the same conditions as the proprietor of a patent granted under the 1992 Act.

This is in accordance with Article 66 of the EPC which states that:

A European patent application which has been accorded a date of filing shall, in the designated Contracting States, be equivalent to a regular national filing, where appropriate with the priority claimed for the European patent application.

(4) INFRINGEMENT

(4.1) DIRECT INFRINGEMENT

(4.1.1) Products

47 The substantive law on infringement of patents is set out in Chapter VI of the 1992 Act, sections 40–46.

48 Section 40 of the 1992 Act prevents direct use of an invention. In relation to products, section 40(a) provides as follows:

40.—A patent while it is in force shall confer on its proprietor the right to prevent all third parties not having his consent from doing in the State all or any of the things following:

- (a) making, offering, putting on the market or using a product which is the subject-matter of the patent, or importing or stocking the product for those purposes.

49 A number of points arise with respect to international dealings in a patented product. The territorial scope of the patents legislation is limited to the territory of the state, so doing any of the prohibited acts outside the state will not constitute infringement. However, this distinction may not be entirely clear in the context of offering or importing.

50 It is established that, when an offer is made by means of telecommunications, it will constitute an offer made at the place where the offer is received. Thus, when an offer is made by e-mail sent from outside the state to a person in the state, it will constitute an offer made in Ireland. The same will be true of offers made on Internet sites, on television and in print publications with an international circulation, which includes Ireland, except to the extent that each of these makes clear that they are not available to persons in Ireland. In one UK decision, it was held that, to constitute infringement, an offer had to be made in the state to dispose of goods in the state (*Kalman v. PCL Packaging (UK) Limited* [1982] FSR 406).

51 As regards importing, it appears from the UK case law (*Sabaf v. MFI Furniture* [2004] UKHL 45), that when property in goods passes outside the jurisdiction, it is the purchaser rather than the vendor who imports the goods, even when the vendor arranges for their transport. There is some authority for the contrary view in the context of trans-shipping through the jurisdiction (*Waterford Wedgwood plc v. David Nagli Ltd* [1998] FSR 92), but it is difficult to say if this would be followed in Ireland.

52 The purchaser of a patented product may repair the product without infringing the patent. This is based on the patentee's implied consent to repairs by the purchaser. He may also have a third party repair it on his behalf. However, if the repair amounts to the effective replacement of the product, this will constitute an infringement by making the patented product (*Solar Thompson Engineering v. Barton* [1977] RPC 537).

53 Section 40(c) prohibits certain dealings with products 'obtained directly' by a patented process. It states that a proprietor of a patent can prevent others from offering, putting on the market, using or importing, or stocking for those purposes, the product obtained

directly by a process which is the subject matter of the patent. In the UK, it has been held that a product obtained directly by means of a patented process does not cease to be the product so obtained if it is subjected to further processing which does not cause it to lose its identity, there being no such loss where it retains its essential characteristics (*Pioneer Electronics v. Warner Music* [1997] R.P.C. 757 and, more recently, *Medimmune Ltd v. Novartis Pharmaceuticals UK Ltd & Anor* [2011] EWHC 1669).

(4.1.2) Processes

54 Section 40(b) of the 1992 Act in relation to processes provides that while a patent is in force it shall confer on its proprietor the right to prevent all third parties not having his consent from:

55 using a process which is the subject matter of the patent, or, when the third party knows, or it is obvious to a reasonable person in the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent, offering the process for use in the state.

56 By contrast to the position under 40(a) in respect of products, to constitute infringement under section 40(b), it is necessary to offer the process for use in the state. However, this does not necessarily require that the infringer actually enter the state. It is likely that the delivery outside the state of the means to perform the patented process, with the intention or understanding that the process would be performed in the state would suffice to infringe section 40(b).

57 Section 46(1) of the 1992 Act provides that if the subject matter of a patent or patent application is a process for obtaining a new product, the same product when produced by a person other than the proprietor or applicant, as the case may be, shall, in the absence of sufficient evidence to raise an issue as to whether the product was obtained by that or another process, be deemed to have been obtained by the process which is such subject-matter. In respect of such patents, therefore, the burden essentially shifts to the defendant to show it is not infringing.

(4.1.3) Absolute Product Protection

58 Section 40 of the 1992 Act provides, in effect, absolute product protection to holders of patents of products per se. Although it has not been specifically recognized by the Irish courts, the general principle of absolute product protection, as set out in, for example, *Friction Reducing Additive/MOBIL OIL III* [1990] OJ EPO 90, would therefore apply. The principle is, however, subject to Regulation 8 of the European Communities (Legal Protection of Biotechnological Inventions) Regulations 2000 (S.I. 247 of 2000) (the 'Biotech Regulations') which purports to restrict the protection afforded to a patent containing or consisting of genetic information by reference to the function it performs (see section 4.1.6 below on Products Containing or Consisting of Genetic Information).

59 However, note also that section 49(1) of the 1992 Act states that in a patent infringement case, no damages shall be awarded against a defendant who proves that he was not aware of the patent at the date of the infringement, and had no reasonable grounds for supposing that the patent existed.

(4.1.4) *De Minimis*

60 Irish patent legislation does not make provision for a *de minimis* rule, and no case law has been decided on this point. The fact that only a small amount of an infringing product is contained in another product or that only a low level of infringement has taken place is not relevant in deciding whether or not there has been infringement contrary to the Patents Act.

61 The level or degree of infringement is however something that could be considered by a court in deciding on the level of damages to award for infringement.

(4.1.5) Biological Material

62 Section 10(1)(b) of the 1992 Act states that a patent shall not be granted in respect of a plant or animal variety or an essentially biological process for the production of plants or animals other than a microbiological process or the products thereof.

63 Specific provisions for the biotechnology field are laid down in the European Communities (Legal Protection of Biotechnological Inventions) Regulations 2000 (S.I. 247 of 2000) (the 'Biotech Regulations') which transpose Directive 98/44/EC on the legal protection of biotechnological inventions in Ireland.

64 Regulation 4(1) of the Biotech Regulations states that an invention is patentable even if it concerns a product consisting of or containing biological material or a process by means of which biological material is produced. According to Regulation 6, a patent will not be granted in respect of a biotechnological invention, the commercial exploitation of which would be contrary to public order or morality, and specific examples are given of things that will not be regarded as patentable on this basis.

65 As regards biotechnological inventions, Regulation 7 states that when:

the subject-matter of a patent is a biological material having specific characteristics as a result of the invention, the protection conferred by the patent shall extend to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

This is a somewhat wider test than that in respect of traditional inventions.

(4.1.6) Products Containing or Consisting of Genetic Information

66 Directive 98/44 also contains provisions relating to the scope of protection for material containing genetic information which permits its multiplication or propagation. This has been transposed into Irish law by Regulation 8 of the Biotech Regulations which states that:

if the subject matter of a patent is a product containing or consisting of genetic information, the protection conferred by the patent shall extend, subject to Regulation 5(1), to all material in which the product is incorporated and in which the genetic information is contained and performs its function.

Regulation 5(1) states that the human body, at the various stages of its formation and development, and including the sequence or partial sequence of a gene, shall not be patentable.

(4.2) INDIRECT (CONTRIBUTORY) INFRINGEMENT

67 Indirect infringement is dealt with in section 41 of the 1992 Act as follows:

- 41–(1) A patent while it is in force shall also confer on its proprietor the right to prevent all third parties not having his consent from supplying or offering to supply in the State a person, other than a party entitled to exploit the patented invention, with means, relating to an essential element of that invention, for putting it into effect therein, when the third party knows, or it is obvious in the circumstances to a reasonable person, that the said means are suitable and intended for putting that invention into effect.
- (2) Subsection (1) shall not apply when the means referred to therein are staple commercial products, except when the third party induces the person supplied to commit acts which the proprietor of a patent is enabled to prevent by virtue of section 40.

68 The scope of section 41(1) of the 1992 Act is limited to a supply *in the state* for the purposes of putting the invention into effect *in the state*. Thus, a foreign supplier who provides the means to put an invention into effect, provided that supply takes place outside the state, will not be liable, and neither will a supplier in the state where it is intended that the invention be put into effect outside the state.

69 The section applies where a supply is made to a person other than a ‘person entitled to exploit the patented invention’. However, persons availing of the defences discussed below for private non-commercial acts, experimental uses and extemporaneous preparation in a pharmacy are not deemed to be persons entitled to exploit the patented invention (section 41(3)). This may substantially limit these rights in certain cases. For example, a researcher proposing to carry out an experiment, which without the experimental purposes defence would constitute infringement, will need to obtain the means of carrying out that experiment. His actions in carrying out the experiment will not constitute infringement. However, the actions of his suppliers in supplying the essential means to put the invention into effect may. By contrast, a person who has a right to do an act by virtue of his having done the act prior to the filing date does qualify as a person entitled to exploit the invention.

70 The concept of a ‘staple commercial product’ is not defined in the 1992 Act, and was not previously used in Irish law. The concept has yet to be considered by the Irish courts.

71 The issue of secondary infringement, including the meaning of ‘staple commercial product’, has recently been considered in detail by the English High Court in *Nestec SA & Ors v. Dualit Limited & Ors* ([2013] EWHC 923 (Pat)). Arnold J first considered the correct scope of the phrase ‘means relating to an essential element’ and, after considering the competing authorities (Arnold J noted, at paragraph 168, that ‘Unhappily, the Supreme Court of the Netherlands and the Bundesgerichtshof (Federal Court of Justice) in Germany have adopted different approaches to this question.’), favoured the test applied in the

German courts; i.e., the means in question must contribute to implementing the technical teaching of the invention. He rejected the contention that a feature could only be an essential element of the claim for this purpose if it served to distinguish the subject matter of the claim from the prior art (i.e., was novel in its own right).

72 In considering what constitutes a ‘staple commercial product’, Arnold J accepted an interpretation (that had also been applied to the equivalent German provision) that the phrase should mean products that are of a kind which is needed every day and can be generally obtained. Arnold J also held that whether the means constituted a staple commercial product fell to be judged as at the date of the alleged infringement rather than the date of the patent.

73 Finally, in considering the requirement that the means are ‘suitable for putting the invention into effect’ Arnold J found that the relevant test was whether a person who purchases the means (in that case coffee capsules) for use together with a product (the relevant kind of Nespresso machine) thereby ‘makes’ a system falling within the relevant claim of the Patent. On the facts, Arnold J found that the capsules were not means suitable.

(4.3) UNFAIR COMPETITION

74 There is no recognized law of ‘unfair competition’, as such, in respect of patent infringement under Irish law.

75 The term ‘unfair competition’ has, however, been used by the courts in England as a broad term encompassing a variety of actions including the common law torts of passing off and injurious falsehood (see, for example *Erven Warnink BV v. J Townend & Sons (Hull) Limited* [1979] AC 731 per Lord Diplock). It has also been used as a synonym for passing off (See *Arsenal Football Club plc v. Reed (No 2)* [2003] EWCA Civ 696 per Aldous LJ). Article 10bis of the Paris Convention for the Protection of Industrial Property also provides, in general terms, for the protection of unfair competition.

76 While it is possible, therefore, in principle to copy a product that is not patented or in respect of which the patent has expired, that copying may in theory give rise to an action under passing off if it results in confusion as to the origin of the new product. For a claim in passing off to be successful, the following must be shown: (i) goodwill or reputation attached to product, (ii) a misrepresentation leading or likely to lead the public to believe that the product being offered is a product of the owner of the invention and (iii) damage to the goodwill or reputation by virtue of that confusion (see, for example, *McCambridge v. Joseph Brennan Bakeries* [2012] IESC 46).

(4.4) UNJUSTIFIED THREATS

77 Section 53 of the 1992 Act provides a remedy for groundless threats of infringement proceedings. It states that where any person threatens any other person with proceedings for infringement of a patent, any person aggrieved thereby can bring proceedings in the High Court for any of the reliefs set out in section 53(2) and shall be entitled to relief unless the defendant proves that the acts in respect of which the proceedings were threatened constitute or would constitute an infringement of a patent. The reliefs set out are as follows:

- (a) a declaration to the effect that the threats complained of were unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as have been sustained by him by reason of the threats.

A notification of the existence of a patent or a patent application does not by itself constitute a threat of proceedings for the purposes of section 53.

(4.5) ANTITRUST ISSUES

78 The protection or enforcement of patent rights may, in limited cases, be contrary to competition law. Both Articles 101 and 102 of the Treaty on the Functioning of the European Union and the equivalent sections 4 and 5 of the Irish Competition Act 2002 (as amended) are relevant in that regard. The tension between the enforcement of patent rights and the protection of competition law has recently received considerable attention from both the European Commission (see, for instance, its Statement of Objections regarding Samsung's seeking of injunctions against Apple in various Member States on the basis of its mobile phone 'standard-essential patents') and the Court of Justice of the European Union (see, for instance, Case C-457/10P in which the court largely confirmed a fine imposed by the Commission on AstraZeneca in respect of regulatory practices adopted by AstraZeneca, including the making of deliberately misleading representations to the patent offices of certain Member States in order to obtain or maintain supplementary protection certificates, that were found to be an abuse of a dominant position). Agreements between pharmaceutical companies and manufacturers of generic drugs have also come under the spotlight in recent times. The UK's Office of Fair Trading has recently accused GlaxoSmithKline of paying generic manufacturers to delay the production of a generic equivalent of its antidepressant paroxetine. The Irish Competition Authority has not, however, taken any enforcement action in respect of the protection or enforcement of patent rights, and no Irish case law has dealt with the issue.

79 Commission Regulation 772/2004/EC ('the Regulation') – the block exemption that regulates anti-competitive aspects of agreements relating to technology transfer agreements (including pure patent licences and mixed patent know-how licences) – is also relevant. The Regulation approves certain contractual provisions that are considered to have certain positive attributes that might otherwise be deemed anti-competitive. The Regulation also sets out a 'black list' of clauses that are considered anti-competitive. The blacklisted clauses are divided into those that apply when the parties to the agreement are competing undertakings and those that apply when they are not competing undertakings.

(5) FURTHER DEFENCES TO INFRINGEMENT

(5.1) INVALIDITY

80 It is common for defendants to infringement proceedings to contest the validity of the patent. The most common grounds on which the validity of a patent is challenged are that the subject matter is not patentable, that the specification does not disclose the patent in a sufficiently clear and complete manner for it to be carried out by a person skilled in the art, or that the matter disclosed in the specification goes beyond that disclosed in the application as filed.

81 Section 61(1)(a) of the 1992 Act states that the validity of a patent may be put in issue by way of a defence in proceedings for infringement under section 47 or 56 of the 1992 Act.

82 Under section 57 of the 1992 Act, any person may apply to the Court or the Controller for the revocation of a patent, subject to the provisions of sections 57 and 58. Revocation proceedings are often taken as a counterclaim in proceedings for the enforcement of a patent.

83 Section 50(1) of the 1992 Act provides that if in proceedings for infringement of a patent the validity of the patent is put in issue and it is found that the patent is only valid in part, the Court may grant relief in respect of that part of the patent which is found to be valid and infringed. Section 50(2) of the 1992 Act qualifies this by providing that the plaintiff must prove that the specification of the patent was framed in good faith and with reasonable skill and knowledge, and makes any such award subject to the discretion of the Court as to costs and as to the date from which damages should be reckoned.

84 *Medinol Ltd v. Abbott Ireland & Others* ([2010] IEHC 6 and [2011] IEHC 218) is a recent Irish case where the defendants counterclaimed that the patent claims in question was invalid on the grounds of obviousness, lack of novelty and added matter.

(5.2) RESEARCH EXEMPTION

85 Acts done for experimental purposes 'relating to the subject matter of the relevant patented invention' will not constitute infringement of a patent (section 42(b)). The UK case law (*Monsanto v. Stauffer* [1985] R.P.C. 515.) draws a distinction between experiments whose purpose is to discover new information, which are permitted under this defence, and experiments whose purpose is to demonstrate to third parties evidence of properties that are already known or to ensure that a product functions as claimed, which are not permitted. Experiments which aim to establish whether a process, which is known to work under certain conditions, will function under different conditions are permissible. A correlation between the purposes and the subject of the experiment is also required; therefore, an experiment performed with the intention of invalidating another patent will not be exempt from infringement. A specific application of the research exemption is the so-called Bolar exemption.

(5.3) BOLAR EXCEPTION

86 Article 10.6 of Directive 2001/83/EC of the European Parliament and of the Council of 6 November 2001 (as amended) and Article 13.6 of Directive 2001/82/EC of the European Parliament and of the Council of 6 November 2001 (as amended), which provide for the so-called ‘Bolar’ exemption, were initially so transposed into Irish law by S.I. No. 50 of 2006 European Communities (Limitation of Effect of Patents) Regulations 2006. These Regulations introduced section 42(g) of the 1992 Act which provides for a ‘Bolar’ type research exemption, stating that the rights conferred by a patent shall not extend to:

- (i) acts done in conducting the necessary studies, tests and trials which are conducted with a view to satisfying the application requirements of paragraphs 1, 2, 3 and 4 of Article 10 of Directive 2001/83/EC (as amended) for a marketing authorization in respect of a medicinal product for human use; or
- (ii) acts done in conducting the necessary studies, tests and trials which are conducted with a view to satisfying the application requirements of paragraphs 1–5 of Article 13 of Directive 2001/82/EC (as amended) for a marketing authorization in respect of a veterinary medicinal product;
- (iii) any other act which is required as a consequence of the acts referred to in subparagraph (i) or (ii) for the purposes specified in those subparagraphs, as appropriate.

87 The Intellectual Property (Miscellaneous Provisions) Act 2014 (the ‘2014 Act’) introduced new *Bolar* style provisions (section 42(h)) into the Patents Act 1992 that expand upon and coexist with the previous *Bolar* style provisions (section 42(g)). The new provisions are broader and explicitly apply to acts done in conducting studies, tests, experiments and trials (including clinical trials and field trials) with a view to satisfying the application requirements for a marketing authorization or similar instrument required by Irish law or the laws of any other state to sell or supply or offer to sell or supply a medicinal or veterinary medicinal product. It is now clear that the Irish *Bolar* style exemption purports to apply to studies, tests, etc. in respect of new medicines as well as generics/biosimilars and those done with a view to obtaining a foreign, including a non-EU, marketing authorization (as well as an Irish marketing authorization).

(5.4) LICENCE

88 Depending on its scope and duration, the existence of a valid licence in respect of a patent would provide the licensee with a defence to infringement proceedings in respect of that patent.

(5.5) COMPULSORY LICENCE

89 Similarly a valid compulsory licence would prevent activities that would otherwise constitute infringement of the patent from being actionable, provided those activities were

permitted by the terms of the licence. This is subject to comments below on the European doctrine of exhaustion of rights, at section 5.7. Exhaustion.

(5.6) PRIVATE PRIOR USE

90 There is a specific statutory defence under section 55 of the 1992 Act for a person who prior to the priority date, in Ireland, did in good faith an act which would constitute an infringement of the patent if it were then in force, or made in good faith effective and serious preparations to do such an act.

91 Per section 55(1) of the 1992 Act, acts claimed to constitute prior use must be done within the state. Where acts have been done outside the state, the user will have to fall back on the *Gillette* defence as discussed above. The requirements of good faith are unclear in this situation. An example of a situation in which acts could not be said to be done in good faith is when they constitute a breach of a duty of confidentiality owed to the patentee.

92 Per section 55(2) of the 1992 Act, when the conditions of the defence are satisfied, the relevant person has a number of rights, namely the right to continue to do the relevant act, and, when the act was done or preparations made in the course of business, the right to assign that right, to pass it on death, and in the case of an individual, to authorize a business partner to do the act. Section 55(4) allows for any disposals made by virtue of the right of continued use to carry with them an implied licence for further dealings in that product. However, there is no right to grant a licence to a third party to do the relevant acts. In addition, only the specific acts done prior to the relevant date can be continued. A prior user cannot therefore rely on this defence if he builds further on the work done before the relevant date.

(5.7) EXHAUSTION

93 As a Member State of the EU, the European doctrine of exhaustion of rights applies in respect of patent rights in Ireland. There is no Irish case law dealing with the doctrine, but the Court of Justice of the European Union case law, and its implications in Ireland, are reasonably clear.

94 The doctrine of exhaustion means that where a patented product is put on the market in one Member State of the EU by or with the consent of the patentee, the patentee cannot then use his patent rights to prevent or hinder the importation of that product into a second Member State or prevent its sale there.

95 It is necessary that the patentee consents to the initial marketing of the patented product. Thus, marketing of the product under a licence will normally exhaust the patentee's rights, but this is not the case when it was marketed under a compulsory licence. By contrast, the fact that the patentee originally marketed the product without the benefit of patent, for example, because he did not own a patent in the country where the product was originally marketed, will not prevent his rights being exhausted.

(5.8) FARMERS PRIVILEGE

96 The ‘farmer’s privilege’ refers to the long-standing agricultural practice of retaining seeds from the previous year’s harvest for the purposes of re-sowing. Farmers have an implied right to use the seed from their harvest to re-sow it on their own farm.

97 Regulation 10(1)(a) of the European Communities (Legal Protection of Biotechnological Inventions) Regulations, 2000 provides for a derogation for the use by a farmer of the product of his harvest for propagation or multiplication by him on his own farm, where there has been a sale or other form of commercialization of plant propagating material to the farmer by the proprietor of the patent or with the consent of the proprietor of the patent for agricultural use, subject to conditions corresponding to the derogation set out in Article 14 of Council Regulation EC No. 2100/94 on Community plant variety rights.

98 There is also a derogation at Regulation 10(1)(b) for the use for an agricultural purpose by a farmer of protected livestock, where there has been a sale or other form of commercialization of breeding stock or other animal reproductive material to the farmer by the proprietor of the patent or with the consent of the proprietor of the patent. According to Regulation 10(2), this includes making the animal or other animal reproductive material available for the purposes of pursuing the agricultural activity of the farmer, but not sale within the framework or for the purpose of a commercial reproduction activity.

(5.9) FURTHER EXCEPTIONS TO INFRINGEMENT

Private and Non-commercial Purposes

99 Section 42(a) of the 1992 Act states that ‘acts done privately for non-commercial purposes’ are not captured under the exclusive rights awarded by a patent. Aldous J considered the meaning of ‘privately’ in *Smith Kline & French Laboratories v. Evans Medical Ltd* ([1989] FSR 513) to be inclusive of both commercial and non-commercial situations, and ‘denoting that the act was done for the person’s own use’.

Innocent Infringement

100 Innocent infringement was successfully raised as a defence in *Lux Traffic Controls Ltd v. Pike Signals Ltd* ([1993] RPC 107). On foot of this decision, a court is likely to allow a reasonable time period from the time of notice for the defendant to investigate assertions by an alleged patentee and to cease infringement. As mentioned below, there is a statutory restriction under section 49(1) on the award of damages or an account of profits for innocent infringement.

Extemporaneous Preparation of Medicines

101 There is a specific defence for the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription issued by a registered medical practitioner or acts concerning the medicine so prepared (section 42(c)). The defence is quite restricted, and includes five separate elements, namely: (i) extemporaneous

preparation; (ii) for individual cases; (iii) in a pharmacy; (iv) in accordance with a medical prescription; and (v) issued by a medical practitioner. If any of these elements is not present, the defence will not be available. The defence does not extend to veterinary medicines, or (as in the UK), to prescriptions issuing from a dental practitioner. Medicines prepared prior to a specific request are not exempt.

Vessels, Aircraft or Land Vehicles

102 Sections 42(d) and (e) of the 1992 Act (as amended) provide that use of patented inventions (so long as they relate exclusively to the needs of the vessel) on certain vessels, aircraft or land vehicles temporarily or accidentally entering the state is exempt from infringement. For vessels, this also includes entry to territorial waters (with the extent of territorial protection defined in section 117 of the 1992 Act). The vessels must be registered in any of the countries of the Union of Paris for the Protection of Industrial Property or a member of the World Trade Organization other than the Ireland.

Declaration of Non-infringement

103 Section 54 of the 1992 Act refers to the power of the High Court to make a declaration as to non-infringement. This provision is not so much a defence as a pre-emptive step before commencing activity which could potentially be challenged as infringing. An allegation of infringement does not need to have been made in order to obtain a declaration. The costs of both sides must be paid by the party seeking the declaration unless for 'special reasons' the High Court thinks fit to order otherwise. The validity of the patent cannot be challenged in the proceedings though a party seeking a declaration of non-infringement is not prohibited from separately seeking the revocation of the patent in question.

Restriction on Damages

104 Certain restrictions apply to awards of damages for infringement. These are described in section 8.9.6. Damages.

(6) LICENSING

(6.1) VOLUNTARY LICENCES

105 An application can be made by the proprietor of a patent to the Controller for an entry in the register allowing licences to be available as of right (section 68(1)). The Controller must be satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent. When a voluntary licence is granted, the licensee is entitled to require the proprietor to bring proceedings with respect to the infringement of the patent. The licensee can mount proceedings in his name if the proprietor refuses or neglects to do so within two months (section 68(3)). The proprietor retains the right to apply for cancellation of the entry on the register (section 69(l)).

(6.2) COMPULSORY LICENCES

106 In certain circumstances, a third party may apply to the Controller for a compulsory licence of a patent. A compulsory licence cannot be sought until three years after the date of the publication of notice of grant.

107 Sections 70–75 of the 1992 Act as amended by the 2006 Act provide the framework for the grant of compulsory licences. A compulsory licence is a non-exclusive licence and cannot be assigned by the licensee.

108 The grounds under which a compulsory licence is granted were amended by the 2006 Act and conform with the TRIPS Agreement. The applicant must satisfy as least one of the following grounds:

- (i) that a demand in Ireland for the subject matter of the patent is not being met or is not being met on reasonable terms; or
- (ii) that a demand in Ireland for a product which is protected by the patent is being met by importation other than from a member of the World Trade Organization;
- (iii) that the establishment or development of commercial or industrial activities in Ireland is unfairly prejudiced.

109 Under section 70(2), the Controller may also grant a compulsory licence if an invention protected by a separate patent (known as ‘the second patent’) cannot be exploited in Ireland without infringing rights deriving from the patent (known as ‘the first patent’). The proprietor of the second patent will be granted a licence to the extent necessary for the exploitation of the invention concerned, when the Controller is satisfied that the invention involves an important technical advance of considerable economic significance in relation to the invention claimed in the first patent.

110 A compulsory licence can also be acquired under the European Communities (compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems) Regulations 2008 (S.I. No. 408 of 2008 giving effect to Council Regulation (EC) No. 816/2006). The application must outline the amount of pharmaceutical products to be produced, the names of the importing countries, and details of licence applications that have been made in other countries. The applicant

must have evidence of a specific request from an authorized representative of the importing country, a non-governmental organization or a competent organ of the United Nations. The Controller considers the application on the strength of the supporting evidence.

111 A number of points must be considered in respect of compulsory licences. First, as a consequence of European Community law on the free movement of goods, references to the state must be read as references to working within the EEA, and similarly importation must be read as importation from outside the EEA.

112 In considering if demand is being met, it is necessary to consider demand at the price at which the patentee is making the product available, provided that price is reasonable (Research Corp'n's (Carboplatin) Patent [1990] R.P.C. 663). The fact that demand would be greater at a lower price and that that potentially greater demand is not being met is not relevant.

113 In considering if demand is being met on reasonable terms, price will only be one factor to consider, though obviously an important one. In considering what is a reasonable price, it will be necessary to include a reasonable profit element, recognizing the monopoly that the patent confers.

114 If the Controller is satisfied that an applicant for a compulsory licence has presented a prima facie case, he will serve a copy of the application papers on the patentee and advertise the application in the Patents Office Journal. Interested parties, including the patentee, then have three months in which to lodge an opposition. The decision of the Controller (or, if necessary due to technical points being at issue, an arbitrator) can be appealed to the High Court.

Exclusive Licences

115 When an exclusive licence is granted, the exclusive licensee will enjoy any right in respect of the invention granted by the exclusive licence to the exclusion of all other persons including the proprietor (section 2). The exclusive licence holder can take proceedings in respect of patent infringement committed after the date of the licence (section 51(1)). The proprietor of the patent is added as a defendant to the proceedings unless he has been joined as a plaintiff. A proprietor joined as a defendant is not liable for costs unless he has made an appearance and taken part in proceedings (section 51(2)).

(7) PATENTS AS PART OF ASSETS

(7.1) ASSIGNMENT

116 The person registered as the applicant for a patent or the proprietor of a patent has the power to assign the application or the patent. A person becoming entitled to an interest in a patent or a patent application by assignment or otherwise must apply to register his interest in the Register of Patents (section 85(1)). An application for the registration in the Register of the title of any person becoming so entitled may also be made by the assignor, mortgagor, licensor or other party to the instrument by which the assignment is made. This interest will be registered once the Controller is satisfied upon proof of title that the person is entitled to be so registered. Particulars of the instrument or event by which he derives title will also be registered (section 85(3)). A document in respect of which no entry has been made in the register shall only be admitted in court as evidence of the title of any person to a patent application or patent or share of or interest in a patent application or patent if the court so directs (section 85(7)).

(7.2) CO-OWNERSHIP

117 Section 80 of the 1992 Act outlines the rights and obligations that arise when a patent is applied for by, or is granted to, two or more persons. Unless a contrary agreement is in place, a co-owner holds an equal undivided share in common (section 80(1)). Registered applicants and proprietors can apply the invention to their own benefit without accounting to their co-owners (section 80(2)). The absence of concurrence will not restrict a joint proprietor from bringing infringement proceedings (section 48(2)). However, the co-owner is obliged to join the other co-owners to the proceedings as defendants. In such instances, the co-owner joined as a defendant is not liable for costs unless he enters an appearance and takes part in the proceedings. Section 80(3) of the 1992 Act protects co-owners by ensuring that a licence cannot be granted, nor a share assigned, in the patent or patent application without the consent of all the applicants/proprietors. A supplier is not guilty of indirect infringement when they supply a co-applicant or co-proprietor with the essential means for putting an invention into effect (section 80(4)). Similarly, infringement will not arise when a product is purchased from one of two or more registered co-owners of a patent. The purchaser is entitled to deal with it 'in the same manner as if the product had been sold by a sole applicant' (section 80(5)).

(7.3) SURRENDER

118 Under section 39 of the 1992 Act, a proprietor of a patent may at any time by written notice given to the Controller offer to surrender his patent. Rule 40 of the Patent Rules 1992 further prescribes the procedure that is involved. Under the rules, the offer to surrender the patent must state the name and address of the proprietor, the number of the patent, and the reasons for making the offer to surrender the patent, and must be accompanied by a declaration that no action for infringement or proceeding for the revocation of the patent is pending in any court. The Controller advertises the offer to

surrender, giving a three-month time period within which any person who wishes to do so can give notice of opposition to the surrender and provide a statement setting out fully the facts upon which the opponent relies. The Controller notifies the proprietor of the patent and provides him with a copy of the notice and statement of opposition. Within three months, the proprietor may file a counter-statement. The Controller will ultimately make a determination on the objection. If the Controller is satisfied that the patent may properly be surrendered, he accepts the offer and a notice of acceptance is published in the Patents Office Journal. From the date of publication of this notice, the patent ceases to have effect.

(7.4) SECURITY RIGHTS

119 Section 79 of the 1992 Act provides that ‘the rules of law applicable to the ownership and devolution of personal property shall apply in relation to patent applications and patents as they apply in relation to other choses in action.’ As such, patent applications and patents can be mortgaged.

120 Under section 85(1) of the 1992 Act where a person becomes entitled to an interest in a patent application or patent as a mortgagee, he shall apply to the Controller for the registration of notice of his interest in the register.

(7.5) ATTACHMENT

121 The rules of law applicable to the ownership and devolution of personal property apply to patent applications and patents as to other choses in action. As a chose in action, a patent or patent application is not capable of being seized in execution of a writ of *fiery facias* to satisfy a judgment debt. It might, however, be possible for a creditor to seek to attach a patent or profits deriving from a patent, such as licence fees or royalties, by way of an application for the appointment of a receiver by way of equitable execution under Order 45, rule 9 RSC. This, however, would be a novel application and its prospects very uncertain.

(8) PATENT LITIGATION

(8.1) PLAINTIFF

(8.1.1) Owner

122 Under section 47(1) of the 1992 Act, civil proceedings for infringement of a patent may be brought by the proprietor of the patent.

(8.1.2) Co-owner

123 Section 48 of the 1992 Act deals with proceedings for infringement where a patent has more than one owner. It states in section 48(2) that one of two or more joint proprietors of a patent may bring proceedings for infringement without the concurrence of the other proprietors, but shall not do so unless all the others are made parties to the proceedings as defendants. Any co-owner that is made a defendant shall not be liable for any costs or expenses unless he enters an appearance to the proceedings and takes part.

(8.1.3) Exclusive Licensee

124 The definition of ‘exclusive licence’ in section 2 of the 1992 Act states that such a licence confers on the exclusive licensee, to the exclusion of all other persons, including the proprietor of the patent, any right in respect of the invention. Pursuant to section 51 of the 1992 Act, this includes the right to take proceedings for any act of infringement committed after the date of the licence. In any proceedings taken by an exclusive licensee under section 51, the proprietor is to be added as a defendant unless he is joined as a plaintiff in the proceedings.

(8.1.4) Non-exclusive Licensee

125 The 1992 Act does not contain a right equivalent to the right of exclusive licensees under section 51 for non-exclusive patent licensees, so a non-exclusive licensee has no right under Irish law to bring a patent infringement claim.

(8.1.5) Other

126 Patent infringement is only actionable by the proprietor of the patent or any person to whom he has granted an exclusive licence in respect of the invention.

(8.2) LIMITATION PERIODS

127 Patent infringement is a form of tort. Proceedings can therefore be brought in relation to the infringement of a patent within six years from the date the cause of action accrues (section 11, Statute of Limitations 1957).

(8.3) COMPETENT COURT/VENUE

128 Patent litigation is heard in the High Court, sitting in Dublin, usually in the Commercial List of the High Court (commonly called the Commercial Court) or the Chancery List. In addition, litigation in respect of short-term patents is heard in the Circuit Court, and the Controller has certain quasi-judicial functions in respect of patents.

High Court

129 The High Court has full original jurisdiction in civil matters. Unless application is made to enter the case into the Commercial Court, patent cases will be entered in the Chancery division. There is no specialist patent court. Prior to 2004, the Chancery division dealt with the bulk of patent litigation in Ireland.

130 The case will be heard by a single judge, sitting alone without a jury. The judge will usually have experience of hearing commercial litigation but may not have any experience in specific patent or intellectual property matters. The Court may (and shall on the request of all parties to the proceedings) call in the aid of a suitably qualified assessor and try the whole or part of the case with his assistance (section 95(1)). Procedures in the High Court are governed by the Rules of the Superior Courts 1986 (RSC) (S.I. No. 15 of 1986.), as amended. Order 94 RSC deals specifically with patent litigation.

Commercial Court

131 The Commercial Court is a division of the High Court established in 2004 to provide a fast-track procedure for hearing certain types of commercial litigation. Although established as a division of the High Court, it has quite separate and distinct procedures from traditional High Court procedures, in particular, a focus on precise and concise pleadings and case management by the judge throughout the case. Commercial Court cases will be heard much more quickly than in the Chancery List. The 2009 amendments to the RSC have made provision for the discovery of electronically stored information in searchable form where it is held in such form and can be produced as such without significant cost to the party from whom discovery is requested (RSC (Discovery) 2009, S.I. No. 93 of 2009). This provision facilitates expeditious discovery in complex cases.

132 The Commercial Court has jurisdiction over commercial cases with a value in excess of EUR 1 million. In addition, it has jurisdiction in respect of a number of specific subject areas, including patents, regardless of the value of the case. Most major patent litigation is heard by the Commercial Court.

133 Like the Chancery List, the case will be heard by a single judge sitting without a jury. The judge in the Commercial Court will generally have some experience of patent litigation. Procedures in the Commercial List of the High Court are governed by Order 63A RSC.

Court of Appeal

134 Decisions in the High Court (both in the Chancery List and the Commercial Court) may be appealed to the Court of Appeal, a new court introduced in July 2014. The Court

of Appeal hears appeals in all areas of law, both civil and criminal. The Court of Appeal usually sits in divisions of three judges, taken from a panel of up to ten judges, however where it would be in the interests of justice and necessary for the expeditious determination of that matter the President of the Court of Appeal may nominate a judge to sit alone.

Supreme Court

135 The Supreme Court is the court of final appeal and, since the introduction of the Court of Appeal in 2014, hears appeals from the Court of Appeal in circumstances where the Supreme Court certifies that it is satisfied that: (a) the Court of Appeal decision involves a matter of general public importance, or (b) in the interests of justice it is necessary that there be an appeal to the Supreme Court. It is also possible, in limited circumstances, to appeal directly from the High Court to the Supreme Court where there are exceptional circumstances warranting a direct appeal.

136 It is a non-specialist court, and the judges hearing an appeal from the High Court in a patent matter may not have any experience in patent law.

137 The Supreme Court is a collegiate court, and generally sits as a court of three or five judges, who will decide the case by a simple majority.

Circuit Court

138 Proceedings relating to short-term patents will generally be heard in the Circuit Court.

139 The Circuit Court is a court of local and limited jurisdiction. Its monetary jurisdiction is normally limited to EUR 75,000 although this does not apply in patent cases (section 66(4)). In addition, a given Circuit Court only has jurisdiction to hear cases that relate to its specific geographical area. Because of the limit on its monetary jurisdiction, the Circuit Court does not normally deal with particularly complex litigation. The judge hearing the case is unlikely to have experience in patent matters.

(8.4) PATENT OFFICE

140 Proceedings for revocation of a patent may be brought before the High Court or before the Controller of Patents, Designs and Trade Marks (through the Patents Office), although when proceedings are pending before the High Court in respect of a patent, no application may be made to the Controller without the prior leave of the Court. The Controller is not a judge, but exercises a judicial function. Evidence before the Controller is normally by way of written statutory declaration, although the Controller does have power to examine witnesses and hear oral evidence. An appeal lies to the High Court from the decision of the Controller. Proceedings before the Controller are governed by the Patents Rules 1992 (S.I. No. 179).

(8.5) PROVISIONAL MEASURES

(8.5.1) Attachment

(8.5.1.1) General Comments

141 The rights conferred by Article 7 of Directive 2004/48/EC were not provided for in the Irish implementing regulations (S.I. No. 360/2006 – The European Communities (Enforcement of Intellectual Property Rights) Regulations 2006) presumably as those rights were considered to be already available under Irish law. (The explanatory memorandum to the European Communities (Enforcement of Intellectual Property Rights) Regulations 2006 says that they transpose into Irish law those aspects of Directive 2004/48/EC which are not currently available under Irish law.) Although there are no provisions explicitly providing for the seizure of infringing goods or equipment used in the manufacture of those goods, recourse may be had to regular interim and interlocutory injunctions (which may be used, for instance, to restrain the marketing and use of such goods and equipment pending trial, subject to the requirements that there is a serious issue to be tried, damages are an inadequate remedy and the balance of convenience favours the granting of the injunction (see section 8.9.1. Injunction), Mareva injunctions (see section 8.5.1.2. Assets) and Anton Piller injunctions (see section 8.5.1.3. Evidence)).

(8.5.1.2) Assets

142 The Court has power to grant an injunction preserving the defendant's assets pending trial of the action. The purpose of this order, known as a *Mareva* or *freezing* injunction, is to ensure that the defendant does not dissipate his assets so as to frustrate the plaintiff's claim for damages.

143 The application is initially made on an *ex parte* basis (i.e., without the other party being present or being given notice of the application). The order will last only for a small number of days at the end of which the action will come back before the court. At that point, the Court will hold an *inter partes* hearing to determine whether to extend the order until the date of trial.

144 A *Mareva* injunction does not give a plaintiff any right in the nature of security over the assets frozen. A judgment ranks as an unsecured debt, and the plaintiff will have no priority as against other unsecured creditors of the defendant as regards the assets that are the subject of the order.

145 The Supreme Court in *O'Mahony v. Horgan* ([1995] 2 I.R. 411 at 418) established criteria that should be established before such an injunction will be granted the conditions for the grant of such a *Mareva* injunction may be summarized as follows:

- The Court must have jurisdiction over the substantive subject matter of the case. The *Mareva* order is ancillary in nature and will not be granted unless the Court has power ultimately to make substantive orders such as an order for damages after trial.
- The plaintiff must establish that there is a 'substantial question to be tried' on the merits of the case. However, in some cases, the higher standard of a 'good arguable case' has been required.

- The plaintiff must establish that there is ‘a real risk’ that the defendant’s assets will be dissipated with the intention that they would not be available to meet any order ultimately made. The fact that assets are likely to be dissipated in the ordinary course of business or in payment of lawful debts will not be sufficient. Assets may be dissipated either by moving them out of the jurisdiction, or by disposing of them in the jurisdiction.
- The balance of convenience must favour the grant of the injunction.

146 A number of additional points can be made in respect of the plaintiff’s obligations in seeking the injunction:

- The plaintiff must make full and frank disclosure of all matters in his knowledge that are material for the Court to know. This is because the initial application is made *ex parte*, without the defendant being heard. If the Court is of the view that full disclosure has not been made, it may refuse to extend the order at the interlocutory stage.
- The plaintiff should give particulars of his claim and the amount thereof, fairly stating the points made against it by the defendant.
- The plaintiff must normally give some grounds for believing the defendant has assets within the jurisdiction. This is not strictly necessary, as the courts have jurisdiction to make a *Mareva* order in respect of assets outside the jurisdiction, subject to the proviso that such an order will only bind the defendant personally and not third parties outside the jurisdiction.
- The plaintiff must give some grounds for a belief that there is a risk of the assets being removed or dissipated. However, the courts have recognized that direct evidence of an intention to dissipate assets will not generally be available at the interlocutory stage and have been prepared to consider all of the circumstances of the case in assessing this intention.
- The plaintiff must give an undertaking in damages in the event that he should fail at trial. This is an undertaking that, if the injunction is granted but subsequently is found to have been wrongly given, the plaintiff will compensate the defendant for any losses incurred as a result of the injunction.
- It was accepted by the Irish High Court in *Deutsche Bank AG v. Murtagh* ([1995] 2 I.R. 122) that, where such an order was warranted by the facts, the court has jurisdiction to restrain the dissipation of assets held abroad so as to ensure that a defendant did not take action designed to frustrate subsequent orders of the court, and to make ancillary orders, including orders requiring a defendant to swear an affidavit in respect of assets held outside the jurisdiction. This is what is known as a worldwide *Mareva* injunction.
- The procedures for applying for a *Mareva* order are the same as those for applying for other interim and interlocutory injunctions (see below).

(8.5.1.3) Evidence

147 The Court may grant an order *ex parte*, known as an *Anton Piller* order, directing the defendant to allow the plaintiff, attended by his solicitor, to enter the defendant’s premises to inspect documents or evidence specified in the order and to copy or remove same so that they may be preserved for use as evidence at the hearing of the matter. The order cannot be enforced without the defendant’s consent. However, when the defendant does not consent, he will be in contempt of court.

148 The courts have recognized the potential for abuse of *Anton Piller* orders and will be particularly sensitive to ensure that any order is executed correctly. A plaintiff will normally be required to give undertakings as to the manner in which the order will be executed, and a court may order damages against a plaintiff when it is of the opinion that the order has been enforced in an incorrect, excessive or oppressive manner.

149 Because the order is applied for ex parte, there is a high onus on the applicant to make full and frank disclosure to the court of all material facts, erring on the side of excessive disclosure. As with a *Mareva* order, failure to make full disclosure may lead to the order being discharged, and an award of damages against the plaintiff.

150 Like a *Mareva* order, an *Anton Piller* order will be made returnable before the court within a short period of a few days at most, when an *inter partes* hearing will be held. However, the nature of the *Anton Piller* order is such that, once it is executed, the plaintiff has received the benefit of the order, in that he will have had a chance to inspect and copy any relevant evidence. The subsequent discharge of the order cannot reverse this. However, the plaintiff must give an undertaking in damages before an *Anton Piller* order can be granted, so damages can be granted to the defendant if he suffers loss due to an improperly granted order.

151 The conditions for obtaining an *Anton Piller* order are as follows:

- (a) The plaintiff must have an extremely strong prima facie case on the merits.
- (b) The actual or potential damage to the plaintiff must be very serious.
- (c) There must be clear evidence that the defendant has incriminating documents or articles in his possession.
- (d) There must be a real possibility that these will be destroyed before an application *inter partes* can be made.

152 The procedures for applying for an *Anton Piller* order are the same as those for applying for other interim and interlocutory injunctions (see below).

(8.5.2) Preliminary Injunction Proceedings

153 Preliminary injunctions may be granted on either an interim or an interlocutory basis. Please see section 8.9.1. Injunction regarding the specific requirements applicable to injunctions in Ireland.

(8.5.2.1) Ex Parte Proceedings

154 An interim injunction is granted on ex parte application, and will usually last only for a very short period of a few days until a motion seeking an interlocutory injunction can be heard *inter partes*.

(8.5.2.2) Inter Partes Proceedings

155 An interlocutory injunction is sought by way of a motion on notice to the other party. An interlocutory injunction will remain in force until the conclusion of the case and its purpose is to prevent irreparable harm accruing to the plaintiff during that period.

(8.6) EVIDENCE

(8.6.1) Preservation/Seizure of Evidence

156 As noted at section 8.5.1.3. Evidence, in exceptional circumstances, the court may grant an order *ex parte*, known as an *Anton Piller* order, directing the defendant to allow the plaintiff, attended by his solicitor, to enter the defendant's premises to inspect documents or evidence specified in the order and to copy or remove the same so that they may be preserved for use as evidence at the hearing of the matter.

(8.6.2) Gathering Evidence

157 The rights conferred by Article 6 of Directive 2004/48/EC were not provided for in the Irish implementing regulations (S.I. No. 360/2006 – The European Communities (Enforcement of Intellectual Property Rights) Regulations 2006), as with Article 7, presumably as those rights were considered to be already available under Irish law. One important measure in that regard is what is known as a *Norwich Pharmacal* Order. A *Norwich Pharmacal* Order is an order that a court can make for disclosure of documents or information by a party, in exceptional circumstances, usually in order to obtain information as to the identity of alleged wrongdoers. The first such order was granted by the House of Lords in 1974 in *Norwich Pharmacal Co. & Others v. Customs and Excise Commissioners* ([1974] AC 133), an English case concerning the alleged patent infringement by unknown importers of the chemical which was the subject of the patent. In *Megaleasing UK Ltd v. Barrett*, the Irish Supreme Court accepted that the Irish courts have jurisdiction to make *Norwich Pharmacal* Orders, holding that '[t]he remedy should be confined to cases where very clear proof of a wrongdoing exists and possibly, so far as it applies to an action for discovery alone prior to the institution of any other proceedings, to cases where what is really sought is the names and identity of the wrongdoers rather than the factual information concerning the commission of the wrong' ([1993] IRLM 497 at 504). *Norwich Pharmacal* Orders have more recently been made in Ireland in 2005, for example, in *EMI Records (Ireland) Ltd & Ors v. Eircom Ltd & Anor* ([2005] IEHC 233), against Internet service providers to disclose the names and addresses and phone numbers of people who had allegedly infringed the plaintiffs' copyright by uploading music tracks onto file sharing networks.

158 Article 3 of the European Communities (Enforcement of Intellectual Property Rights) Regulations 2006 provides, in addition, a basis for seeking a court order that information regarding the origin and distribution networks of goods or services which infringe an intellectual property right has to be disclosed to the claimant by specified persons including the alleged infringer, any person who was found in possession of infringing goods or using infringing services on a commercial scale, or who is identified as being involved in the production, manufacture or distribution of infringing goods or the provision of the infringing services.

159 More generally, the burden of proof in respect of a particular fact in civil matters is generally placed on the person asserting that fact. Thus, it will be for a plaintiff to prove those facts that make up his case. The burden of proof is the 'balance of probabilities'. This requires the person bearing the burden to convince the court that the facts alleged are 'more probable than not'.

160 One specific exception to this principle in patent cases relates to processes for the production of a new product. In the absence of evidence to the contrary, such a product will be deemed to have been produced by the patented process. Thus, when the plaintiff can prove that the defendant has manufactured the new product, it will be for the defendant to prove that he has not used the patented process. In this context, the court must have particular regard to the defendant's interest in protecting his manufacturing and business secrets and, for this reason, may receive the defendant's evidence in the absence of any other party.

161 At trial, evidence is introduced by sworn oral testimony given by witnesses present before the court. Each party is free to call any witnesses they choose and in any order they choose. Each witness is examined in turn by counsel for each party, with the party calling the witness examining them first. This is known as examination-in-chief, and is subject to strict rules on the manner in which questions may be put. The other party may then cross-examine the witness.

162 Documentary evidence can generally only be introduced at trial when a witness is able to verify the document being relied on.

163 In preliminary hearings before the trial of an action, evidence is given by sworn affidavit. This is a form of written testimony, which must be sworn and witnessed before a Commissioner for Oaths or a practicing solicitor. When a party wishes to rely on a document at this stage, it must be referred to and exhibited in a sworn affidavit.

164 In the Commercial Court, written witness statements are exchanged before the trial. The judge may direct that the witness statements be verified on oath and treated as the evidence in chief of the relevant witness.

(8.6.3) Experts

165 Expert witnesses play a significant role in patent litigation. Both parties will generally call at least one expert witness who will give evidence in relation to the various specialist matters that are likely to arise. Like any other witness, the other party will have an opportunity to cross-examine an expert.

166 There is also specific provision in the 1992 Act for the court, if it thinks fit, to '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 of the 1992 Act). An assessor, who will be an independent expert in the relevant field, can be particularly useful when a judge may have no previous experience in the field of science or engineering to which a patent relates. The assessor is not a witness in the case. His function is to assist the judge in understanding the evidence before the court.

167 Experiments will often form an important part of the evidence in patent actions. There are no specific rules in relation to the conduct of experiments in patent cases. However, they may be dealt with in the directions given by the court in revocation or infringement proceedings. Normally, the party proposing to conduct an experiment will give notice to the other party of the facts that the party proposes to establish by experiment and call on them to admit the facts. When a fact is not admitted, the person who wishes to prove it by carrying out an experiment is likely to be required to permit the other party to inspect the experiment, or when it has already been carried out, a repetition thereof. This allows that party to test the experiment and bring evidence in respect of any weakness or deficiency in the experiment or its conclusions.

(8.6.4) Inspection

168 Any party to proceedings may serve notice to inspect documents or other evidence and in the absence of consent this may be ordered by the court (Order 31 RSC).

(8.7) PROCEEDINGS ON THE MERIT

(8.7.1) Infringement Proceedings

169 Before issuing proceedings, it is normal to issue a warning letter to the defendant, setting out the nature of the plaintiff's claim and calling on the defendant to admit liability. Failure to send a warning letter may have consequences in costs. Even when the plaintiff is successful, or when the defendant subsequently admits liability, failure to send a warning letter may result in a costs order being made against the plaintiff, although this will depend on the particular circumstances of the case.

170 Great care is required in preparing a warning letter in patent cases, in light of the groundless threats provisions in the 1992 Act (section 53).

Non-commercial Court Procedure

171 The pre-trial procedures in the High Court are dominated by the exchange of formal pleadings. The purpose of the pleadings is to set out each party's case and to narrow the issues for trial to those that are actually in dispute between the parties. However, they may be only partially effective in doing this.

172 The proceedings in the High Court are commenced by issuing a plenary summons (Order 1 RSC) that must normally be served on the defendant within twelve months of the date of issue (although it is possible to extend this time when the plaintiff can show that reasonable efforts have been made to serve the defendant or that other good reasons exist for extending time) (Order 8 RSC). When the defendant resides outside the European Economic Area (EEA), it is necessary to seek the leave of the court to serve notice of the summons outside the jurisdiction (Order 11 RSC). Specific provision is made for service in countries party to the (Recast) Brussels Regulation (Regulation (EU) No 1215/2012) (the 'Brussels Regulation') and the Lugano Convention (i.e., members of the EU and the European Free Trade Association). The service of documents outside the jurisdiction but within the EU is governed by Regulation EC 1393/2007 (Order 11D RSC, as amended by RSC (Service of Proceedings (Regulation (EC) No. 1393/2007)) 2009, S.I. No. 280 of 2009).

173 The plenary summons contains very little detail of the nature of the plaintiff's claim, usually limited to setting out the basic cause of action and the remedies sought.

174 A defendant is required to enter an appearance within eight days of service on it of the plenary summons (Order 12 RSC). However, if the defendant does not do so, he may subsequently enter an appearance at any time up to the date when judgment is entered against him. The time limit for the filing of an appearance when the plenary summons has been served in a country subject to the Brussels Regulation or the Lugano Convention is thirty-five days (Order 12 rule 2(3) and 2(4) as amended by S.I. No. 506 of 2005: RSC (Jurisdiction, Recognition, Enforcement and Service of Proceedings) 2005). When the

summons has been served out of the jurisdiction by leave of the court, the court may order the time for entry of an appearance, typically thirty-five days.

175 The plaintiff is required to deliver a statement of claim within twenty-one days of the date of the appearance by the defendant (Order 20 RSC). The statement of claim will outline the facts giving rise to the cause of action and the basis of the claim for damages. A plaintiff must include particulars of the infringements of the patent relied on, including specifying which of the claims in the specification are alleged to be infringed and give at least one example of each type of infringement relied on (Order 94 RSC, Rules 4 and 5).

176 If a defendant does not consider that the statement of claim contains sufficient detail of the plaintiff's claim, he may serve a notice for particulars, seeking additional particulars of the claim made by the plaintiff (Order 19 Rule 7). In the absence of a reply within the specified time limit, the defendant may apply to the court for an order compelling the plaintiff to provide the particulars sought.

177 A defendant has twenty-eight days from the date of delivery of the statement of claim to file his defence (Order 21 RSC). Strictly speaking, this period is not extended when the defendant files a notice for particulars, but a defendant will often wait for replies to particulars before filing his defence. The defence sets out the facts on which the defendant relies in his defence and the basis for that defence. When the defendant disputes the validity of the patent or counterclaims for revocation, he must deliver with his defence particulars of the objections on which he relies to support such invalidity (Order 94 RSC Rule 7). These particulars should state every ground on which the validity of the patent is disputed and clearly define every issue which it is intended to raise (Order 94 RSC Rule 8). When one of the grounds of invalidity is lack of novelty, the particulars must give details of the previous publication or user alleged (Order 94 RSC Rule 9). Once the defence has been filed, the plaintiff may serve a notice for particulars seeking additional particulars of any point raised in the defence.

178 At the hearing of the action, no evidence may be admitted in proof of any alleged infringement or ground of invalidity other than those set out in particulars of infringement and particulars of objections included in the statement of claim and defence respectively (Order 94 RSC Rule 12).

179 It is open to the plaintiff to deliver a reply to the defence, which must be delivered within fourteen days of delivery of the defence (Order 23 RSC). However, in many cases this will not be necessary. When the plaintiff delivers a reply to defence, the pleadings are deemed to be closed once the reply is delivered (Order 23 RSC Rule 6). When no reply is delivered, pleadings are closed once the time for delivery of a reply has expired (Order 27 RSC Rule 11).

180 As mentioned, relatively short time limits are laid down for the delivery of the various pleadings. However, outside of the Commercial Court, these are rarely complied with in practice and frequently one party or the other will have to apply to court to compel the other part to comply with procedural steps. The plaintiff can apply for judgment in default of appearance (Order 13 RSC) or judgment in default of defence (Order 27 RSC Rule 9) when the defendant has failed to deliver either document. Similarly, the defendant can apply to dismiss proceedings for want of prosecution when the plaintiff has failed to deliver a statement of claim or take some other required step (Order 27 RSC Rule 1). However, these applications are typically not made until some time after the deadlines for delivery of pleadings have passed, and the other party will always be allowed some time to comply. Thus, it can often take up to eighteen months or longer for all pleadings to be delivered.

181 Once the pleadings have closed, it is usual for the parties to seek discovery of documents from each other and sometimes also from third parties (Order 31 RSC Rule 12 as amended). Discovery is a procedure whereby the parties can be compelled to disclose documents in their possession or power that are relevant to any matter at issue in the case and necessary either for disposing fairly of the case or for saving costs. The test for what is relevant to a particular category of documents is determined by reference to the ‘Peruvian Guano’ test which refers to a:

document relating to the matters in question in the action, which not only would be evidence upon any issue, but also which it is reasonable to suppose contains information which may – not which must – either directly or indirectly enable the party requiring the affidavit either to advance his own case or to damage the case of his adversary. (See *Compagnie Financiere du Pacifique v. Peruvian Guano Co.* (1882) 11 Q.B.D. 55, English High Court, Brett L.J., at p. 63.).

Limits have been placed on this test in Ireland, and discovery cannot be used for a general trawl through the other side’s documents – see, for example, *Hannon v. Commissioner of Public Works* [2001] IEHC 59 which emphasized that the Court must decide as a matter of probability as to whether any particular document is relevant to the issues to be tried. Similarly, there must be some proportionality between the extent or volume of the documents to be discovered and the degree to which the documents are likely to advance the case of the applicant or damage the case of his or her opponent – see, for example, *Framus v. CRH plc* [2004] 2 I.R. 20.

182 ‘Documents’ in this context is to be interpreted very broadly and covers both paper documents (e.g., typed or handwritten notes, drafts, letters, drafts, diaries, inventors’ notebooks, handbooks, brochures, invoices, reports, studies and briefs) and electronic documents and data (e.g., documents and data on computers, power point presentations, emails, voicemail and metadata).

183 The parties must first seek to agree the terms of discovery between them. Discovery is requested by letter specifying the categories of documents sought and the reasons why these are relevant and necessary, and specifying the period of time which is being allowed for discovery. The period allowed must be reasonable and, in any event, cannot be less than twenty-one days. If discovery is refused on the basis of this request, the party seeking discovery may then apply to court for an order directing the respondent to make discovery.

184 The principles outlined above concerning the discoverability of various categories of documents have recently been applied by the Irish High Court in a number of Irish patent cases in which it has made orders for discovery; see, for example, *AstraZeneca AB & the Patents Act 1992* [2014] IEHC 189 and *Norton (Waterford) Limited t/a Teva Pharmaceuticals Ireland v. Boehringer Ingelheim Pharma GmbH* [2015] IEHC 318 and [2015] IEHC 332.

185 Once the pleadings are closed, the plaintiff may take steps to have the case set down for trial. To do this, the plaintiff must first deliver a notice of trial to the defendant, giving at least twenty-one days’ notice of trial, and then lodge a copy of this, along with books of pleadings and a setting down docket, in the Central Office of the High Court (Order 36 RSC Rule 11). Once the case is ready to be heard, the plaintiff must file a certificate of readiness following which the case will appear in a list to be allocated a date for hearing.

186 The trial is an oral hearing in open court, at which the judge hears evidence from witnesses for both parties, including cross-examination by the opposing counsel, as well as legal argument.

187 The overall timescale involved from the issue of a warning letter to the hearing of the trial can vary greatly due to delays along the way and may be from two to four years.

Commercial Court Procedure

188 As discussed above, the Commercial Court was established in 2004 as a division within the High Court to hear commercial cases. Most major patent cases are dealt with in the Commercial Court. The Commercial Court's procedures are designed to redress a number of the perceived weaknesses in the High Court procedure, in particular delay and inefficiency resulting from the failure of the parties to properly narrow down the issues between them. All patent matters are eligible to be heard in the Commercial Court (Order 63A RSC Rule 1).

189 Proceedings cannot be initiated directly in the Commercial Court. Rather, proceedings are commenced in the High Court under the procedures set out above and may subsequently be transferred to the Commercial Court (Order 63A RSC Rule 4). The Commercial Court Rules provide that the case may be transferred at any time up to the close of proceedings. However, admission to the Commercial Court is at the discretion of the Commercial Court Judge. In practice, applications for admission are often refused where there has been delay, so an application to transfer to the Commercial Court is usually made very soon after the proceedings are issued.

190 The application to transfer the case to the Commercial Court is made by way of motion on notice to the other parties to the proceedings. The application can be made by the plaintiff or the defendant. If the plaintiff wishes to transfer the case to the Commercial Court immediately, this motion may be issued and served on the defendant at the same time as the plenary summons. The motion is heard by a judge of the Commercial Court, and if the application is successful, all further proceedings take place in that list.

191 The Commercial Court judge has a wide discretion as to how the case should proceed once it has entered the Commercial Court. At all stages of the proceedings, the judge has a broad power to give any direction or order that 'appears convenient for the determination of the proceedings in a manner which is just, expeditious and likely to minimize the cost of the proceedings' (Order 63A RSC Rule 5). In all cases in the Commercial Court, there is an initial directions hearing (Order 63A RSC Rule 6). This may take place at the hearing of the application to enter the case in the Commercial List, or at a later date which will be fixed at that hearing. The judge will give directions to facilitate the proceedings. He may direct that the proceedings follow the standard course of pleadings followed by an oral hearing as outlined above or may dispense with formal pleadings and ask the parties to proceed by way of a statement of issues or affidavit evidence without oral evidence at trial. He may also make a range of specific orders to facilitate the efficient running of the case. A typical initial directions order would specify the dates on which pleadings are to be delivered and sometimes also the dates by which discovery is to be requested and a date for the hearing of any disputes on discovery and further directions. The principles outlined in the section above in relation to the limits of discovery in Ireland apply equally in the Commercial Court as in the regular High Court.

192 For particularly complex cases, the judge may direct that the case be subject to case management (Order 63A RSC Rule 14). This involves the holding of a case management conference. The conference is chaired by the judge and attended by the solicitors for each party and may also be attended by the parties and by counsel. The purpose of the conference is to ensure that the proceedings are brought to trial in a just, expeditious and

cost-effective way. The judge will be seeking to ensure that, as soon as possible in advance of the trial:

- relevant issues of fact and law are defined clearly, precisely and concisely;
- all pleadings, affidavits and statements of issue are served;
- any particulars and replies, admissions or requests for admissions, notices to admit documents or facts, and replies are served or delivered;
- all intended interlocutory applications are made; and
- all directions have been complied with.

193 At the case management conference, the judge may fix a timetable for completion of preparation of the case for trial and make any further directions to facilitate the efficient determination of the proceedings. The court has the power to penalize delays by disallowing the costs of the party in default and awarding against that party the costs incurred by any other party.

194 Once the pleadings, affidavits or statements of issue, as directed by the judge at the initial directions hearing, have been exchanged, either party may apply to fix a date for a pre-trial conference (Order 63A RSC Rule 16). When the proceedings are subject to case management, the date will be set by the judge chairing the case management conference. The purpose of the pre-trial conference is to allow the judge to confirm what steps are still required in order to bring the case to trial, how long the trial is likely to take, and to formalize any other necessary arrangements. To this end, the parties are required to complete a detailed pre-trial questionnaire which must be lodged in advance of the meeting.

195 Written statements of evidence intended to be relied on by the parties, signed by the witness, must be exchanged in advance of trial (Order 63A RSC Rule 22). The purpose of this provision is to exclude the tactic of ‘trial by ambush’ whereby the parties can introduce unexpected evidence at the trial. The written statements may by agreement be treated as the evidence in chief of that witness, but the witness may also give oral evidence and be cross-examined.

196 Proceedings before the Circuit Court in respect of short-term patents and before the Controller also follow different procedures, which are not discussed here.

(8.7.2) Invalidity Proceedings

197 Invalidity is frequently raised as a defence to infringement proceedings. See also section 8.7.4. Revocation Proceedings for separate revocation proceedings.

(8.7.3) Entitlement Proceedings

198 Under 17(3) of the 1992 Act, a person who alleges that another person has been incorrectly named as sole or joint inventor may request the Controller to make a finding to that effect. Rule 7 of the Patents Rules 1992 states that the onus is on the person making such a request to provide a statement setting out fully the facts relied upon in claiming that he himself should have been mentioned as inventor, or that another person should not have been so mentioned.

199 A decision of the Controller in such an application can be appealed to the High Court under section 96 of the 1992 Act.

Revocation Proceedings

200 An application for revocation of a patent may be made to the Controller or to the High Court (section 57(1)). However, when proceedings with respect to a patent are pending in the High Court, no application for revocation may be made to the Controller in relation to the patent without the leave of the Court (section 57(5)). The application may also be made as a counterclaim in a patent infringement suit.

201 Before seeking revocation, the patentee should be given an opportunity to voluntarily surrender the patent as otherwise there may be cost implications. Rule 42 of the Patents Rules 1992 (as amended) says:

If, in proceedings before the Controller under section 57, the proprietor of a patent offers to surrender it under section 39, the Controller shall, in deciding whether costs should be awarded to the applicant for revocation, consider whether proceedings might have been avoided if the applicant had given reasonable notice to the proprietor before the application was filed.

In *Re Irish Patent No. 52364* ([2005] IEHC 114), however, which related to a revocation action in respect of an SPC, Kelly J held that failure to do so was not fatal to the award of costs. Section 60 of the 1992 Act gives the power to the Controller to seek revocation on his own initiative.

Revocation before the Controller

202 An application to the Controller to revoke a patent is made in writing (Rule 41, Patents Rules 1992). The application must be accompanied by a statement setting out fully the grounds for revocation, the facts upon which the applicant relies and the relief which he seeks, together with any documents upon which the applicant relies.

203 The Controller will send a copy of the application to the proprietor of the patent, who has three months to contest the application by filing a counter-statement setting out fully the grounds upon which the application is contested. Once the counter-statement has been filed, the applicant has three months to file evidence in support of the case, and the proprietor has a further three months thereafter to file evidence in reply. Thereafter, no further evidence may be given except by leave or direction of the Controller.

204 Evidence is given in writing by statutory declaration in the absence of directions to the contrary, but the Controller does have the power to hear *via voce* evidence in lieu of or in addition to statutory declarations (section 92). For this purpose, the Controller has a broad power to summon witnesses, to examine witnesses on oath or affirmation, and to require witnesses to produce documents. The decision of the Controller is subject to appeal to the High Court (section 96).

Revocation before the High Court

205 The application is made by way of petition to the High Court, accompanied by particulars of the objections on which the petitioner relies in support of invalidity (Order 94 Rule 23 RSC). The particulars of objection must include the same details as are required in infringement proceedings as set out above.

206 After the proceedings are issued, either party may apply to transfer the case to the Commercial Court.

207 Unlike infringement proceedings, there is no prescribed course by which the revocation action proceeds, so even when the case is not transferred to the Commercial Court, it is necessary to apply to the court for directions on how the case should proceed. These directions will set out a timeline for progressing the case. A typical order for directions would deal with the delivery of any notices for further particulars arising from the particulars of objection, replies to those, the delivery of points of defence to the petition and particulars of objection and any requests for further particulars arising from that. There would typically also be directions as to requests for discovery and inspection of documents and any experiments to be conducted by each party. In the Commercial Court, as is the case with infringement proceedings (described above), the parties will be required to exchange written statements outlining the essential elements of any witness as to fact or expert witness on whose oral evidence they intend to rely at trial.

208 Revocation proceedings may also be brought by way of a counterclaim in infringement proceedings.

(8.7.4) Suspension of Proceedings

209 In practice, most patents that are the subject of litigation in Ireland derive from European patents rather than national patents. As a result, EPO opposition proceedings are often also in being when a revocation action is commenced in Ireland. A petition for revocation of a patent is therefore often met with an application for a stay pending the opposition proceedings at the EPO. In these circumstances, the Court will start with the premise that a stay should be granted and then consider if there are reasons why it should be refused (*Merck & Co. Inc. v. G.D. Searle & Co.*[2001] 2 ILRM 363). There is quite a heavy burden on an applicant seeking to avoid a stay in these circumstances.

(8.8) CUSTOMS SEIZURES

210 The Revenue Commissioners also have a role to play in the enforcement of a patentee's rights, especially in restraining dealings with goods which infringe a patentee's national or European patent, as the designated 'competent customs department' in Ireland under Regulation (EU) No. 608 of 2013 and the Irish implementing regulations (Statutory Instrument No 562 of 2013) (together, the 'Regulations').

211 Under the Regulations, a patent holder may make an application to the Revenue Commissioners to take action to prevent the import into or transit through the EU of goods suspected of infringing the patent. The Regulations provide for destruction by the Revenue Commissioners of such goods, unless the infringement is contested by the holder or the declarant of the goods, and for their detention by the Revenue Commissioners for a specified period in which the rights holder can take further action in respect of the goods.

(8.9) REMEDIES

212 The principal remedy in civil proceedings in Ireland is an award of damages (discussed below).

213 The following reliefs are also available in an infringement action (section 47(1)):

- (a) an injunction restraining the defendant from any apprehended act of infringement;
- (b) an order requiring the defendant to deliver up or destroy any product covered by the patent in relation to which the patent is alleged to have been infringed or any article in which the product is inextricably comprised. An order for delivery up is only likely to be granted in the context of an injunction restraining future infringement. This is an ancillary form of relief, and the courts will not extend it beyond what is necessary for the protection of the patentee. In particular, an order will not be granted in respect of goods which can be used in both an infringing and a non-infringing manner;
- (c) an account of the profits derived by the defendant from the alleged infringement.

This is discussed below under the heading of damages.

- (d) a declaration that the patent is valid and has been infringed by the defendant;
- (e) costs.

This is described in more detail in section 8.9.8. Order for Costs.

(8.9.1) Injunction

Interim Injunction

214 To obtain an interim (*ex parte*) injunction, an applicant must show that there is an immediate threat that he will suffer irreparable harm in the period between the date of application and the date on which an interlocutory injunction application would be heard, and that the balance of convenience favours the granting of the injunction.

215 An application for an interim injunction is made by *ex parte* application usually grounded on an affidavit setting out all of the facts necessary to satisfy the court that an interim injunction is appropriate, and including an undertaking as to damages. Because the application is made *ex parte* without the defendant present, the applicant must make full and frank disclosure of all relevant matters when making the interim application, and failure to do so will adversely affect the chances of the injunction being continued at the interlocutory stage.

Interlocutory Injunction

216 In order to obtain an interlocutory injunction, i.e., an injunction pending the trial of the proceedings, an applicant must show that:

- (i) there is a serious issue to be decided at the trial of the action;
- (ii) damages would not be an adequate remedy for the plaintiff;
- (iii) the balance of convenience favours the granting of the injunction.

217 The first issue is whether a serious issue has been raised. This is quite a low standard, and does not require the plaintiff to show a probability of success at trial. The court's purpose at this stage is not to form a view on the merits of the case.

218 A plaintiff must establish that, if no injunction is granted and he is subsequently successful at trial, an order for damages would not compensate for the loss suffered up to

the date of trial. This may be because it will be impossible to calculate the plaintiff's loss, or because the defendant does not have the financial means to satisfy a judgment.

219 The court will also consider if damages would be an adequate remedy for the defendant if the injunction were granted and subsequently found to be unjustified at trial. When damages cannot compensate the plaintiff, but can compensate the defendant, this will tend to favour the granting of the injunction.

220 In considering the balance of convenience, the court will consider all relevant factors to determine where the balance of convenience lies.

221 The court will often tend to favour that alternative that best serves to maintain the *status quo* pending trial because the purpose of the interlocutory injunction is to preserve the position of the parties pending the trial of the action.

222 In addition to satisfying these criteria, a plaintiff will be also required to provide an undertaking as to damages.

223 In practice, it is quite difficult to obtain an injunction in patent cases, on the basis that it is difficult to demonstrate that damages are not an adequate remedy. However, the High Court has confirmed that there is no 'inherent hostility' to the grant of injunctions in patent cases and that the tests set out above apply without modification in such cases (*Smithkline Beecham Plc and ors. v. Genthon B.V. and ors—unreported High Court*, Kelly J. 28 February 2003).

224 An interlocutory injunction is applied for by notice of motion and grounding affidavit. The defendant will have an opportunity to file a replying affidavit or affidavits.

225 An interlocutory application will normally be heard within a matter of weeks of the commencement of the proceedings. The hearing is conducted on the basis of the plaintiff's and defendant's affidavits, and oral evidence will not normally be heard, although there is scope for cross-examination of deponents.

Defending an Application for an Interlocutory Injunction

226 A defendant may defend an application for an interlocutory injunction in a number of ways. First, it is open to the defendant to argue that the tests for grant of an interlocutory injunction are not satisfied.

227 Second, a defendant may argue that the undertaking as to damages offered is insufficient. In this context, the financial standing of the party offering the undertaking will be relevant. A court will not generally grant an injunction where the undertaking as to damages is being given by a company which is unlikely to be able to honour it. It may therefore be necessary in such circumstances for a fortified undertaking to be offered or for a parent company of a plaintiff company to give the required undertaking to reduce the risk of the defendant successfully resisting the application on this basis.

228 Third, when the plaintiff has delayed in bringing the action, this may be taken into account by the court in refusing an application for an interlocutory injunction. The basis for an interlocutory injunction is that the plaintiff needs urgent protection, which is obviously undermined if the plaintiff has not moved with all reasonable haste to seek the remedy.

229 Fourth, a court will generally not grant an injunction when the defendant has offered an undertaking in respect of the matters covered by the injunction.

230 If a date for the trial of the action within a relatively short timeframe is possible, such as can normally be obtained in the Commercial Court, an early trial may be ordered instead, depending on the circumstances.

(8.9.2) Intermediaries

231 No specific provisions have been enacted under Irish law to implement Directive 2004/48/EC insofar as it requires injunctive relief to be available against an intermediary whose services are being used by a third party to infringe a patent. The acts that constitute direct and indirect patent infringement are enumerated in sections 40 and 41 of the 1992 Act and, as set out above, interlocutory injunctions are available in cases of alleged patent infringement in accordance with established principles. (This can be contrasted with the position regarding injunctions against intermediaries in respect of third-party copyright infringement where, in circumstances where provisions of the Irish Copyright and Related Rights Act 2000 limited the obligations of internet service providers to removal of offending material upon notification, new provisions were required to be introduced into the 2000 Act to allow for the making of appropriate injunctions against such intermediaries. This amendment was made by the European Union (Copyright and Related Rights) Regulations 2012.)

(8.9.3) Right to Information

232 As noted above, the Irish courts can make what is known as a *Norwich Pharmacal* Order, which is an order in an action for disclosure of documents or information by a party, usually in order to obtain information as to the identity of alleged wrongdoers. A *Norwich Pharmacal* Order will only be granted in exceptional circumstances.

233 In addition, as also noted above, Directive 2004/48/EC and Irish transposing Regulations (The European Communities (Enforcement of Intellectual Property Rights) Regulations 2006), provide a basis for seeking a court order for disclosure of information regarding the origin and distribution networks of goods or services which infringe an intellectual property right.

(8.9.4) Corrective Measures (Recall, Destruction, Etc.)

234 As mentioned above, the court can order the defendant in infringement proceedings to deliver up or destroy any product in relation to which the patent is alleged to have been infringed or any article in which the product is inextricably comprised.

(8.9.5) Reasonable Compensation

235 Please see section 8.9.6. Damages

(8.9.6) Damages

236 Damages are the primary remedy in civil proceedings in Ireland. Generally, the purpose of damages is to compensate the plaintiff rather than to punish the defendant. Punitive damages will only be available in very limited circumstances.

237 It is for the plaintiff to demonstrate the extent of the loss suffered. A number of methods are available for this purpose. Loss of profits may be a useful method of calculating damages. When a plaintiff can demonstrate that he has lost sales by virtue of the defendant's infringement, he will be able to claim damages for the profits he would have made on those sales. Alternatively, the court may assess the notional licence fee that the infringer would have had to pay for the right to do the acts that constitute infringement.

238 An account of profits is available in patent cases as an alternative to damages. Whereas damages are calculated to compensate the plaintiff for the loss suffered, an account of profits is calculated by reference to the profit that the defendant has made by wrongdoing. This sum may be more or less than the amount of damages recoverable, and this will influence the plaintiff's election.

239 Damages and an account of profits are available in the alternative, and it is for the plaintiff to elect which he will seek. In order to allow the plaintiff to make this election, he can require disclosure of relevant financial information from the defendant, including accounts and sales figures.

240 It is a defence to an order for damages or an account of profits if the defendant proves that, at the date of the infringement, he 'was not aware, and had no reasonable grounds for supposing, that the patent existed' (section 49(1)). Further, he will not be deemed to have been aware, or to have reasonable grounds for supposing that the patent existed 'by reason only of the application to a product of the word "patent" or "patented" or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the relevant patent accompanied the word or words in question' (section 49(1)).

241 This defence will not be available merely by virtue of the fact that the patent number did not appear on the product when there are other circumstances that should have suggested to the defendant that a patent might exist. When a patentee becomes aware of an infringing product, it is important that he immediately notify the infringer of the existence of the patent in order to rule out the possibility of this defence being raised, at least in respect of the period after that notification.

242 A court has the discretion, when it sees fit, to refuse to award any damages or make any order in respect of any infringement committed during a period when renewal fees were due and had not been paid (section 49(2)).

243 In addition, when the specification of a patent has been amended, damages will not be awarded in respect of an infringement committed before the date of the decision allowing the amendment, 'unless the court is satisfied that the specification of the patent, as originally published, was framed in good faith and with reasonable skill and knowledge' (section 49(3)). This defence will not, however, preclude the award of an account of profits.

(8.9.7) Disclosure of Judgment

244 Judgment is handed down by the judge in open court, either immediately following the hearing of a matter or, more usually in complex matters, in a reserved judgment some weeks afterwards.

(8.9.8) Order for Costs

245 The court will usually make an order in respect of the legal costs of proceedings. This is in the court's discretion but the general principle is that 'costs follow the event', so that the

party who succeeds at trial will have an order that the unsuccessful party is liable for his costs.

246 The Commercial Court Rules provide that, when the court hears an interlocutory application, it ‘shall make an award of costs save where it is not possible justly to adjudicate upon liability for costs on the basis of the interlocutory application’. Thus, if the plaintiff seeks an interlocutory injunction and this is refused, an order for the costs of the injunction application may be made against him, and this will not be affected by the fact that the plaintiff subsequently succeeds at trial.

247 The Commercial Court also has a discretion to make a costs order against any party who delays proceedings by failing to advance any aspect of the proceedings, failing to be properly prepared for any pre-trial hearing or failing to deliver any necessary papers for use by the judge. In addition, if the Commercial Court judge is of the opinion that a pleading contains any unnecessary matter, or is of unnecessary length, he may award the costs of the other party in dealing with such unnecessary matter against the offending party.

248 Also, in both the Commercial and Chancery Lists of the High Court, costs will not normally be allowed in respect of allegations raised in the pleadings that are not proven or that the Court considers were not reasonable and proper issues to be raised.

249 Costs are not usually paid on a full indemnity basis. Rather, the paying party must pay all such costs as were necessary or proper for the attainment of justice or for enforcing or defending the rights of the other party. Thus, even the successful party will usually have to bear a proportion of his own costs.

250 See above also the special provisions with regard to the costs of proceedings for a declaration of non-infringement.

(8.10) CRIMINAL ENFORCEMENT

251 The European Communities (Customs Action against Goods Suspected of Infringing Certain Intellectual Property Rights) Regulations 2005 set out a number of offences for the contravention of the provisions of Council Regulation (EC) No. 1383/2003. Both of these instruments are described in more detail at section 8.8 above on Customs Seizures.

(8.11) APPEAL

252 Article 34.4.1 of the Constitution of Ireland (Bunreacht na hÉireann) provides that the Court of Appeal shall, save as otherwise provided by Article 34, and with such exceptions and subject to such regulations as may be prescribed by law, have appellate jurisdiction from all decisions of the High Court, and shall also have appellate jurisdiction from such decisions of other courts as may be prescribed by law. There is, therefore, in general, an unlimited right of appeal from the High Court to the Court of Appeal.

253 In the context of patent litigation, this means that every decision of the High Court (including the Commercial List of the High Court) is subject to appeal to the Court of Appeal. This is not limited to the decision on the merits of the substantive action. A party may also appeal preliminary decisions, such as decisions in respect of preliminary injunctions.

254 The Court of Appeal was established in 2014, though the principles applied by the Supreme Court in assessing High Court appeals prior to the establishment of the new court structure under the Court of Appeal Act 2014 should continue to be instructive of the approach that the Court of Appeal will adopt when considering appeals. Historically, the Supreme Court would show a degree of deference to the views of the High Court judge on questions of fact, on the basis that the judge has had the opportunity to hear witnesses giving evidence in person, whereas the Supreme Court had to rely on a transcript of that evidence. The principles applied by the Supreme Court were summarized as follows:

- (1) An appellate court does not enjoy the opportunity of seeing and hearing the witnesses as does the trial judge who hears the substance of the evidence but, also, observes the manner in which it is given and the demeanour of those giving it. The arid pages of a transcript seldom reflect the atmosphere of a trial.
- (2) If the findings of fact made by the trial judge are supported by credible evidence, the appellate court is bound by those findings, however voluminous and, apparently, weighty the testimony against them.
- (3) An appellate court should be slow to substitute its own inference of fact where such depends upon oral evidence or recollection of fact and a different inference has been drawn by the trial judge. In the drawing of inferences from circumstantial evidence, an appellate tribunal is in as good a position as the trial judge.
- (4) A further issue arises as to the conclusion of law to be drawn from the combination of primary fact and proper inference. If, on the facts found and either on the inferences drawn by the trial judge or on the inferences drawn by the appellate court in accordance with the principles set out above, it is established to the satisfaction of the appellate court that the conclusion of the trial judge was erroneous, the order will be varied accordingly – see *Hay v. O’Grady* [1992] 1 IR 210 at 217.

255 In order to appeal against a High Court order, the appellant must lodge a notice of appeal with the Office of the Registrar of the Court of Appeal within ten days (for an expedited appeal) or within twenty-eight days (for an ordinary appeal) of the date when the order is perfected.

256 The notice of appeal must set out: (i) particulars of the decision that it is sought to appeal; (ii) in the case of an expedited appeal, the category of expedited appeal to which the appeal relates; (iii) the grounds of the appeal; (iv) the orders sought from the Court of Appeal; (v) a list of the documents intended to be relied on by the appellant in the appeal; and (vi) particulars of the appellant and of the respondent.

257 Expedited appeals are defined categories of appeals which of their nature are required, or are amenable, to being prepared for hearing and decided relatively quickly, and include an appeal against the making or refusal to make an interlocutory order.

258 Notice of appeal must be served by appellant on other parties within four days of issue by the Court office (expedited appeal) or within seven days of issue (ordinary appeal).

259 A respondent’s notice in response to the appeal must then be lodged and served by each respondent on appellant and every other respondent within seven days (expedited appeal) or twenty-one days (ordinary appeal).

260 Not later than four days before the date fixed for the directions hearing, the appellant must lodge an indexed and paginated directions booklet for the Court’s use. At the

directions hearing, the judge may exercise a range of powers including fixing any issues to be determined in the appeal; fixing the times for delivery and lodgement of written submissions identifying and addressing the issues arising in the appeal; and fixing a date and allocating a time for the hearing of the appeal or any part of it.

261 The appellant must lodge in triplicate an indexed and paginated appeal booklet not later than fourteen days before the appeal hearing and serve the booklet on each respondent affected by the appeal. An agreed indexed book of authorities must be handed into court in triplicate at the appeal hearing.

262 At the hearing of the appeal, counsel for each party makes oral submissions. The Court of Appeal does not hear witnesses, instead relying on the evidence from the High Court hearing.

(8.12) THE SUPREME COURT

263 In certain limited circumstances, a further appeal to the Supreme Court may be possible, though only very exceptional patent infringement cases would potentially be suitable.

264 The Supreme Court, subject to such regulations as may be prescribed by law, has appellate jurisdiction from a decision of the Court of Appeal if the Supreme Court is satisfied that (i) the decision involves a matter of general public importance, or (ii) in the interests of justice it is necessary that there be an appeal to the Supreme Court (Article 34.5.3 of the Constitution of Ireland – Bunreacht na hÉireann).

265 A ‘leapfrog’ appeal from the High Court to the Supreme Court is also possible where the Supreme Court certifies that it is satisfied that there are exceptional circumstances warranting a direct appeal to it, in addition to it being satisfied that the High Court decision involves a matter of general public importance or an appeal to the Supreme Court is necessary in the interests of justice.

266 In addition to having a narrower and much more focused caseload under the new regime, the Supreme Court has now also been given significantly enhanced case management powers that mirror those of the Court of Appeal and in some instances go further – e.g., certain applications (including applications for leave to appeal to the Supreme Court) may be determined otherwise than with an oral hearing, i.e., as paper applications only. This is exceptional in Irish procedure.

267 The procedure for bringing an appeal to the Supreme Court is similar to that for bringing an appeal to the Court of Appeal, set out above. Notice of application for leave to appeal must be lodged for issue with Office of Registrar of the Supreme Court within twenty-eight days from date of perfection of the order appealed against, with a copy of the order and any written judgment if available. The notice as issued must be served by the appellant on the other parties within seven days of issue. Each respondent served with the notice must lodge and serve on the appellant and every other respondent a Respondent’s Notice within fourteen days of service. A respondent who seeks to vary the decision or order of the court below (i.e., to cross-appeal) may only do so by way of separate notice of appeal. Written submissions may be required and the Court may direct an oral hearing.

268 If the Court grants leave to appeal, a certificate issues specifying the grounds on which leave is given, and may be accompanied by directions. Where the appellant then lodges notice of intention to proceed with the appeal, the appeal is listed for a directions hearing before a case management Judge, copies of the directions booklet must be lodged and written submissions exchanged. Appeal books and a certificate of readiness must then be filed by the appellant.

269 No application for interlocutory relief (including any relief by way of a stay or security for costs) may be made to the Supreme Court before the determination of the application for leave to appeal.

270 At the hearing of the appeal, counsel for each party makes oral submissions. The Supreme Court does not hear witnesses, instead relying on the evidence from the High Court hearing. The court, sitting with three or five judges, then makes its decision by a simple majority.

(9) CONCLUSION

271 Patent law in Ireland is governed by the Patents Act 1992 as amended. Ireland has also ratified or acceded to a number of international treaties relating to patents.

272 While there have been relatively few judgments on the merits in patent cases from the Irish courts, partly due to the fact that many cases settle before reaching a final judgment, case law from other jurisdictions, particularly the courts of England and Wales with which Ireland shares a common law tradition, are regularly cited and have persuasive, but not binding, effect. The courts are also required to take notice of any decision of, or expression of opinion under the EPC, by a competent authority on any question concerning the convention.

273 It should also be noted that Ireland has signed the International Agreement on a Unified Patent Court and confirmed its intention to establish a local division of the Unified Patent Court. Ratification of this agreement by Ireland will require a constitutional referendum.

Preliminary (Interim) Injunction Proceedings: First Instance

Introduction	Defence/ Counterclaim	Oral Hearing	Judgment/Appeal
<p>If time permits, issue plenary summons from the central office. Have grounding affidavit sworn. Draft notice of motion and draft order and have all of these available before the court.</p>	<p>N/A</p>	<p>Urgent matters can be heard by any available judge of the High Court. The hearing is ex parte.</p>	<p>Judgment is generally given immediately, or within a very short time. Applicant serves the order along with plenary summons, notice of motion and grounding affidavit on the defendant as soon as possible. Injunction lasts until interlocutory hearing on notice (usually only about 2 days).</p>
			<p>Where injunction granted, Respondent has an opportunity to oppose its continuation at the interlocutory hearing.</p>

Preliminary (Interlocutory) Injunction Proceedings: First Instance

Introduction	Defence/ Counterclaim	Oral Hearing	Judgment/Appeal
<p>Issue plenary summons from the Central Office.</p> <p>Issue motion for preliminary injunction in Central Office grounded on affidavit. Serve these papers on defendant.</p>	<p>Defendant will file replying affidavit to which plaintiff may respond.</p>	<p>Hearing will normally last a 1/2 day to 3 days.</p>	<p>Single judge, renders judgment, on average within a week of oral hearing.</p>
	<p>Hearing date usually set between 2 and 4 weeks from date of motion depending on urgency and the number of affidavits served (may be shorter timeline in Commercial Court).</p>		<p>Judgment is subject to appeal within 10 days of date of order of judgment being perfected (expedited appeal)</p>

Commercial Court Proceedings on the Merits: First Instance

Introduction	Defence/ Counterclaim	Oral Hearing	Judgment/Appeal
<p>Issue plenary summons from the Central Office.</p> <p>Apply without delay to Commercial Court for entry into Commercial Court. Apply by Notice of Motion grounded on affidavit, and certificate from moving party's solicitor.</p>	<p>Initial directions hearing at hearing of motion to enter Commercial Court or shortly thereafter.</p> <p>Judge directs parties when to deliver pleadings (statement of claim, defence and, if applicable, request for particulars and replies) and discovery requests.</p>	<p>Hearing will usually take place within 9 months of initial directions hearing.</p>	<p>Single judge, renders judgment, on average within 2 weeks of oral hearing.</p>
		<p>Oral hearing varies a great deal and depends on the amount of issues in dispute and the evidence to be produced to the court.</p>	<p>Judgment is subject to appeal within 10 days (expedited appeal) or 28 days (ordinary appeal) of date of order of judgment being perfected</p>
<p>On return date of motion, Commercial Court judge decides whether to admit case to Commercial Court.</p>	<p>There may be a case management conference.</p>		

Introduction	Defence/ Counterclaim	Oral Hearing	Judgment/Appeal
	<p>Once pleadings exchanged and interlocutory matters dealt with, either party may apply for pre-trial conference.</p>		
	<p>Written witness statements usually delivered by plaintiff at least 1 month prior to trial date, and by defendant at least 7 days before trial date.</p> <p>Written legal submissions exchanged 1–2 weeks before trial date.</p>		

Normal (High Court) Proceedings on the Merits: First Instance

Introduction	Defence/ Counterclaim	Oral Hearing	Judgment/Appeal
Issue summons from Central Office and serve on defendant.	Defendant should enter an appearance within 8 days and file a defence within 28 days of service of statement of claim. Counterclaim is included in defence if applicable.	Case will be listed for hearing once certificate of readiness is served. Hearing will usually take place 8–12 months after certificate of readiness is filed.	Single judge renders judgment, usually within 3 months of oral hearing.
Plaintiff serves statement of claim setting out details of claim within 21 days.	Either party may serve a notice for particulars seeking additional information on any matter in the statement of claim or defence.	The length of oral hearing varies a great deal and depends on the amount of issues in dispute and the evidence to be put before the court.	Judgment is subject to appeal within 10 days (expedited appeal) or 28 days (ordinary appeal) of date of order of judgment being perfected
	Plaintiff may serve reply to the defence.		
	Both parties may then seek discovery of relevant documents.		
	Plaintiff then serves notice for trial and certificate of readiness.		

Preliminary (Interlocutory) Injunction, Commercial Court and Normal Proceedings: Appeal to Court of Appeal

Introduction	Cross Appeal	Oral Hearing	Judgment/Appeal
Issue notice of appeal within 10 days (expedited appeal) and serve on other parties within 4 days (expedited appeal) of issue of issue.	Issue notice of appeal within 10 days (expedited appeal) and serve on other parties within 4 days (expedited appeal) of issue of issue.	The length of hearing depends on the issues in the appeal but typically of shorter duration than the High Court hearing	Divisions of three save for interlocutory matters which can be dealt with by the President or any other judge nominated by the President sitting alone. Judgment usually within a short time of oral hearing.
Notice in response to the appeal must then be lodged and served by each respondent on appellant and every other respondent within 7 days (expedited appeal) or 21 days (ordinary appeal).	Initial directions hearing: fixing any issues to be determined in the appeal; fixing the times for delivery and lodgement of written submissions identifying and addressing the issues arising in the appeal; and fixing a date and allocating a time for the hearing of the appeal or any part of it.	No oral evidence, Court of Appeal relies on transcript of High Court hearing.	Appeal to the Supreme Court may be available in exceptional circumstances, where the Supreme Court is satisfied that (i) the decision involves a matter of general public importance, or (ii) in the interests of justice it is necessary that there be an appeal to the Supreme Court

Preliminary (Interlocutory) Injunction, Commercial Court and Normal Proceedings: Appeal to Supreme Court

Introduction	Cross Appeal	Oral Hearing	Judgment/Appeal
<p>Appeal is possible from either Court of Appeal where the Supreme Court is satisfied that (i) the decision involves a matter of general public importance, or (ii) in the interests of justice it is necessary that there be an appeal to the Supreme Court;</p> <p>or</p> <p>Directly from High Court where the Supreme Court additionally certifies that it is satisfied that there are exceptional circumstances warranting a direct appeal to it.</p> <p>Notice of application for leave to appeal must be lodged for issue with Office of Registrar of the Supreme Court within 28 days from date of perfection of the order appealed against, with a copy of the order and any written judgment if available. The notice as issued must be served by the appellant on the other parties within 7 days of issue.</p>	<p>Notice of application for leave to appeal must be lodged for issue with Office of Registrar of the Supreme Court within 28 days from date of perfection of the order appealed against, with a copy of the order and any written judgment if available. The notice as issued must be served by the appellant on the other parties within 7 days of issue</p>	<p>The length of hearing depends on the issues in the appeal but typically of shorter duration than the High Court hearing.</p>	<p>Court usually sits in divisions of 3 or 5 judges. Judgment usually within a short time of oral hearing.</p>

Introduction	Cross Appeal	Oral Hearing	Judgment/Appeal
Respondent's Notice to be served within 14 days of service		No oral evidence, Court of Appeal relies on transcript of High Court hearing.	

Relationship between Infringement and Validity

Heard Together?	Difference between Irish and European Patent?	National Invalidity Proceedings while EPO Opposition Pending
Can be and are usually heard together in one action. However, separate actions are also possible.	European Patent takes effect in Ireland in the same way as a patent granted under the 1992 Act. Amendment, revocation and partial invalidity found by the EPO under the EPC take effect in the State as though amended, revoked or found partially invalid under the 1992 Act.	Standalone national invalidity/revocation proceedings will normally be stayed pending resolution of EPO opposition.

Role of Experts

Party Experts	Experts Appointed by Court	Expert Opinion of (European) Patent Office
Both parties will generally call at least one expert witness, who will give evidence in relation to specialist matters. Each party will have an opportunity to cross-examine the expert witnesses put forward by the opposing party.	Court can appoint an assessor to assist the court in trying the case. The assessor is not a witness. Function is to assist the judge in understanding the evidence, including expert evidence, from the parties.	N/A

Duration of Preliminary Injunction Proceedings

First Instance	Appeal to Court of Appeal
Interim hearing usually takes place in a day and last until the interlocutory hearing, which could take place between a couple of days and a couple of weeks later.	No sooner than 48 hours later – notice to make an ex parte application to the Court of Appeal must be lodged not later than 48 hours before the application is intended to be made, together with the original and three copies of any affidavit grounding that application and any exhibits.
Interlocutory hearing usually takes between 1 and 3 days and lasts until trial date.	Appeal filed within 10 days (expedited), number of months before appeal would likely be heard.

Duration of Normal Proceedings (Infringement and/or Invalidation)

First Instance	Appeal to Court of Appeal
High Court 18 months to 2 years	Approximately one year.
Commercial Court 6–12 months (may be longer if case is very complex, especially if it relates to infringement and invalidity)	

Costs of Infringement and Invalidation Proceedings-N.B. All Estimates are Very Approximate

Preliminary Injunction	Normal Proceedings (Infringement)	Normal Proceedings (Invalidity)	Normal Proceedings (Infringement and Invalidation)	Appeal (to Court of Appeal, in Preliminary Injunction or Normal Proceedings)
EUR 85,000– EUR 110,000	EUR 110,000– EUR 175,000	EUR 110,000– EUR 175,000	EUR 150,000– EUR 220,000	EUR 75,000– EUR 95,000

