

Enforcing patents in the Slovak Republic

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1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

According to Article 63 para 1 of the Slovak Act No 435/2001 Coll on Patents, Supplementary Protection Certificates and on Amendment of Some Acts as Amended (hereinafter referred to as the Patent Act), a European patent shall have the same effects as a patent granted by the Slovak Patent Office. Thus, the owner of a European patent has the exclusive right to use the invention, to authorise others to use the invention, to assign the patent to others or to abandon the patent. In cases of unauthorised interference with the patent rights, the patent owner is entitled to claim that the infringement or jeopardising of its patent right be prohibited and the consequences of infringement removed. The patent owner is also entitled to request that the party that jeopardises or infringes its rights submit data relating to the origin of the product and the circumstances of its placement on the market; and to claim compensation for damage caused, including lost profits and adequate satisfaction, which may be represented by pecuniary compensation. The court may issue a preliminary injunction upon the request of the patent owner.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

There are no special patent courts in the Slovak Republic. However, according to current legislation, three district courts – in Bratislava, Banská Bystrica and Kosice – are entitled to decide cases concerning

intellectual property law, including unfair competition cases, as the courts of first instance. Consequently, the regional courts in Bratislava, Banská Bystrica and Kosice are the courts of second instance. Due to the fact that patent cases are heard by Slovak courts rather rarely, the level of expertise of the judges is average.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

Court proceedings in the Slovak Republic are based on written evidence supported by witness statements. Witnesses may be cross-examined by the other party at trial. There are no restrictions concerning the use of evidence from experts. All evidence must be submitted by the relevant party in the court proceedings before the issuing of the court decision.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

Courts deal with any infringement of patent rights and its consequences. But only the Slovak Patent Office decides on revocation (invalidity) of a patent. It is very usual that in cases of infringement of patent rights the defendant files a request for revocation of the patent and the court then suspends infringement proceedings until the Patent Office decides on the revocation request.

The patent owner should submit in the infringement proceedings before the court (if appropriate) a sample of the product manufactured by the patent owner and a sample of the product, which is manufactured by the infringing person, including the proof that both products are available in the Slovak market, ie, sale receipts.

In invalidation proceedings before the Patent Office, the plaintiff has to prove that: (a) requirements for granting of a patent have

not been met; (b) the invention is not disclosed and described in the patent so clearly and so fully that it can be carried out by a person skilled in the art; (c) the subject matter of the patent exceeds the specification as filed; (d) the scope of protection following from the patent is too broad; or (e) the owner does not have the right to the patent. Therefore, the evidence in invalidation proceedings is rather specialised consisting of quoting a number of registered patents, books, dictionaries and prior art in general.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

According to the Slovak law, there is no pre-trial discovery. Evidence or documents are discovered within an oral hearing.

6. To what extent does any doctrine of equivalents apply in an infringement action?

Slovak courts have not yet applied a doctrine of equivalents in an infringement action based on patent rights. The doctrine of equivalents has been applied in infringement actions based on unfair competition provisions of the Slovak Commercial Code. In such cases, argument based on patent rights is often combined with unfair competition provisions.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

Software-related, biotech and pharmaceutical patents are usually more difficult to enforce than technical patents due to the difficulty concerning the comparison of the solution used by the defendant and the solution protected by the patent. This applies also to patented methods of manufacturing.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

According to the Slovak Constitution, judges are bound by the Constitution, constitutional acts, international treaties and by national legislation. After the accession of the Slovak Republic to the European Union, European law is applicable in the Slovak Republic as well. Decisions and opinions of other courts are not binding, although they may be taken into account if the court has to decide the same or similar matter.

9. To what extent are courts willing to consider the reasoning given by foreign

courts that have handed down decisions in similar cases?

It is possible to file decisions or reasoning given by foreign courts with Slovak courts. However, these are not binding. Such foreign decisions or reasoning may inspire the Slovak judges in some cases, however.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

In patent infringement actions a defendant may file a revocation request, which may substantially delay a case. If the court decides to suspend the case until the Patent Office issues a decision on the revocation request, the plaintiff's position is difficult. The defendant may also propose to the court to ask the ECJ for a preliminary ruling if EU law is applicable in the matter. The plaintiff may challenge each request of the opposing party and finally the court decides.

11. How available are preliminary injunctions and how do you get them?

It is possible to file with the court a request for preliminary injunction. The court has to decide in commercial matters within 30 days of the date of its filing.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

It takes approximately one to one and a half years to get a decision at first instance. There is no legal possibility of expediting the process.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

The defeated party may file an appeal against the first instance's decision within 15 days as of the day of its delivery. In patent infringement proceedings, the appeal should be filed with the regional court in Bratislava, Banská Bystrica or Kosice, according to the local competency. The defeated party may appeal the whole decision or only a part thereof. It is not possible to appeal against the decision's reasoning only. The defeated party has to indicate against which decision the appeal is filed, the extent of the appeal, why the first instance decision or the precedent proceedings were wrong and how the case should be decided. The appeal process takes one and a half to two years.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

The costs of first instance proceedings depend on the complexity of the matter. It usually takes at least 20 hours of lawyers' work to take a case through to a first instance decision. The level of cost increases if any expert opinion is drafted and submitted to the court. Court fees may be considerably high if extensive damages are requested.

15. Who can represent parties in court?

The patent owner may defend its rights in person, but parties may be represented by any individual, attorney at law, notary public and, except for appeals, also by a patent attorney. Generally, there is no compulsory representation before the first and second instance courts, nevertheless a representation by an IP litigation specialist is recommended.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

For a full discussion of this, see the answer to the first question. The remedy called "adequate satisfaction" (see answer to first question above) can be considered as punitive damages. It is intended to indemnify the aggrieved party for any harm that cannot be calculated as damages.