

Enforcing patents in Ireland

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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?

The holder of a European patent may bring civil proceedings to enforce its rights in Ireland. Ireland recently transposed into national law the EC Directive on the Enforcement of Intellectual Property Rights, which had the effect of harmonising enforcement procedures throughout the European Union. Thus the holder of a European patent can expect to have similar enforcement remedies available to it in Ireland as in other member states.

In practice, civil proceedings commence after the claimant has issued a letter before action and the allegedly infringing party has been given an opportunity to remedy any damage caused. The onus rests upon the plaintiff rights holder to prove its case, although certain presumptions of ownership and the subsistence of rights in the plaintiff (until the contrary is proved) may apply in certain circumstances.

As a general rule, the patent owner may commence proceedings to enforce its rights in the event that a third party makes, offers for sale, puts on the market, imports or uses a product or process which is the subject matter protected by the patent, without the patent owner's consent. However, patent owners should be aware that there are certain limitations placed on their right to commence court proceedings to enforce their rights under a patent, such as where the allegedly infringing act is done for private or non-commercial purposes and where acts are done for experimental purposes.

2. Does your jurisdiction have specialist patent courts? If not, what level of

expertise can a patent owner expect from the courts?

Ireland does not have specialist patent courts. Choosing the right court is thus a key early consideration for patent owners. In general, patent infringement proceedings will be commenced in the High Court, in either the chancery division or in the relatively new Commercial List, the latter commonly referred to as the Commercial Court.

Although the High Court has general jurisdiction to hear patent claims, the Irish Commercial Court has been conferred with specific jurisdiction over intellectual property disputes both at first instance and on appeal. However, specific permission from the Commercial Court has to be obtained before bringing proceedings before it. There are a number of advantages for parties involved in patent proceedings to make such an application for entry into the Commercial Court. The Commercial Court rules have been designed to provide for strict timeframes and more efficient and less costly trials, important factors in any patent case. In addition, the judges in the general High Court may not have had any significant patent litigation experience, whereas the judges of the Commercial Court are more likely to have been involved in such cases. An application to have the claim heard by the Commercial Court is made by a motion to the court on notice to the other parties to the proceedings at the commencement of proceedings or shortly thereafter. Given its specific jurisdiction for IP disputes, most if not all future patent cases are likely to be brought in the Commercial Court.

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?

Yes, cross-examination of witnesses at trial is possible. The Commercial Court does, however, favour – where possible – the

exchange of written statements based on agreed evidence between the respective parties' experts. The Commercial Court may also require the parties to set out their cases in writing and use the witness statements, sworn under affidavit, as the main evidence of the witnesses. It is a unique feature of the Commercial Court to allow parties to exchange witness statements and expert reports pre-trial, aimed at reducing the length of proceedings.

If a matter is pursued in the chancery division of the High Court, then the more traditional method of oral argument and cross-examination of witness at trial is likely, and the case can therefore probably be expected to progress more slowly.

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

Yes, infringement and invalidity are usually dealt with simultaneously: any defence mounted to a claim for infringement on grounds that the patent is invalid would generally and logically be coupled with a counterclaim by the defendant for invalidity of the patent.

The burden of proof is on the party alleging infringement of its rights under the patent to demonstrate, on the balance of probabilities (that it is more likely than not), that the patent has been infringed. A defendant may seek to argue, in response to a claim that its actions have infringed the patent owner's rights, that the existing patent is invalid. In that case the defendant bears the burden of proof to show on the balance of probabilities that the patent is invalid.

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

There are no specific rules governing pre-trial discovery in relation to patent disputes.

As a general rule, when legal proceedings are issued, the right to obtain discovery arises automatically and both parties are required to provide full discovery of all documents relating to the dispute which are, or have been, in their possession, custody or power, except those documents protected by privilege. Discovery may be effected voluntarily, by agreement between the parties or by order of the court following a successful application by one or other party. As a general rule, discovery will be required in respect of all documents relevant to matters in issue in the proceedings and which are necessary for the fair disposal of the proceedings or to save costs.

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

The Irish courts have not adopted a doctrine of equivalents in patent proceedings and the doctrine does not as such form part of Irish patent law.

The Irish courts have, on the other hand, endorsed the purposive approach to construction of patent claims in line with the approach under Article 69 of the Protocol to the European Patent Convention. The purposive approach, being narrower than the approach taken when applying the doctrine of equivalents, means that patent claims will be construed by the Irish courts objectively through the eyes of the skilled addressee.

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?

There are no specific legal rules relating to biotech or computer software-related patents as such which makes them more difficult to enforce in Ireland: the rules governing enforcement of patents are indiscriminate. Practically speaking, however, if the subject matter constitutes newly emerging technology, and the patent rights are complex and require specialised expertise to assist in their enforcement, they may be regarded as more difficult, costly or time consuming to enforce than patents for a more traditional subject matter.

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?

As a general rule, Irish courts are bound by the doctrine of precedent such that lower courts will be bound by decisions of the superior courts.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

There have been only a limited number of patent cases decided in Ireland; thus, there is a likelihood that particular points of patent law may not have been considered by an Irish court. In the absence of any existing Irish case law on a particular issue, Irish courts may look to the case law of other, particularly common law, jurisdictions for guidance. Historically, Irish courts have demonstrated a preference to follow the decisions of the English courts.

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

In the High Court, a defendant may repeatedly miss deadlines in an attempt to delay the court proceedings. However, if the matter has been transferred to the Commercial Court, which for the reasons mentioned above is now likely to be the case for most patent proceedings, such delay tactics, if adopted, are a dangerous strategy for a defendant. In the Commercial Court interim costs orders will be made to penalise late compliance with time limits. If a plaintiff brings any such tactics to the attention of the court it will result in swift and stern measures by the court against the defendant to move the case on.

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

In the High Court, an application may be made for an interlocutory injunction restraining the defendant from any possible or actual act of infringement. The principles upon which an injunction will be granted are well settled in Ireland and apply to patent cases in the same way they apply to other cases. Basically, the claimant must demonstrate that there is a serious question to be tried and that damages would be an inadequate remedy. The grant of an injunction is a discretionary power and the court will assess whether to exercise that power according to the balance of convenience. The plaintiff is also likely to be required to give an undertaking as to damages (to cover the situation where it is ultimately determined that it should not have obtained the injunction). Injunctions are more common in the High Court in general, as judges in the Commercial Court may be more inclined to grant a speedy and early trial rather than interlocutory injunctive relief.

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

The Commercial Court, in operation since January 2004, has been widely acclaimed as a major success with regard to the speed at which it brings matters to trial. The system of rigorous case management which it has employed and its ability to offer early hearing dates have ensured the speedy resolution of disputes – the average time from start to finish of a case at the end of the last legal term was a mere nine weeks, with the allocation of a trial date taking approximately five weeks from institution of proceedings.

This is a marked improvement from the chancery division of the High Court which can take as long as 18 months to hear a case. In either court, however, complex and contested patent cases will still be likely to take longer than the typical commercial or IP dispute.

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?

An aggrieved party may appeal a decision of the High Court only on a point of law to the Supreme Court. There is no avenue for appeal on a question of fact.

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

This is very difficult to answer as there have not been enough patent trials in Ireland to give an informed view.

15. Who can represent parties in court? Is specialist representation required?

Parties are represented by qualified solicitors and barristers – we have a two-tier system as in the United Kingdom, where solicitors prepare the case and barristers argue it before the court at trial. Although specialist representation is not required it is advisable to use a solicitor and barrister with experience in patent disputes, in addition to a patent agent where the technology covered by the patent is complex.

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

The remedies typically available on a finding of patent infringement include: order for delivery up or destruction of infringing goods; an injunction preventing further infringement; damages or an account of profits; and costs.

Punitive damages are generally not available in a patent infringement case. Furthermore, an award of damages will not be awarded against an innocent infringer who was genuinely not aware, nor should have been aware, of the existence of the patent.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

Recent law reforms have encouraged the use of alternative dispute resolution (ADR) as a means to solve IP-related conflicts. Arbitration and mediation are the most common ADR procedures in Ireland. In

arbitration, the dispute is settled by an impartial expert or arbitrator who issues a binding decision. Mediation, on the other hand, does not involve a binding decision but helps bring both parties towards an amicable resolution.

ADR procedures have the advantage that a greater degree of control is retained by the parties. In addition to the time and cost-effective benefits of ADR, the arbitrator/mediator is usually an expert in the field of the dispute and confidentiality is assured. There are many institutions that offer ADR advice and expertise; however, the WIPO Arbitration and Mediation centre is the best international institution as it focuses on IP and technology-related disputes.

A patent dispute is often centred on specific technical details, such as modifications to mechanical inventions or alterations to chemical entities. As such, it can often be a highly complex matter that involves a qualitative examination of the state of the art, on which the parties simply cannot agree. Thus, unfortunately, litigation may often be the only realistic option available.

18. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is it that it will do so?

Ireland has not yet acceded to the London Protocol or the EPLA.

19. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?

Under the Brussels Regulation, which has now succeeded the Brussels Convention on the Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters 1968, a defendant must be sued in his home state. However, there is an exemption in tort law that allows the defendant to be sued in the country in which the patent infringement takes place. So, for example, an Irish domiciled defendant infringing a French patent may be sued either in France or in Ireland. Although this may lead to a split in proceedings if the defendant challenges the validity of the patent (as validity is a matter for the courts in the country where the patent is registered), where to sue can be an important consideration in multi-jurisdictional disputes. Although not uniquely an Irish point, it means that it is open to a plaintiff to decide on the courts where it is most likely to obtain the fastest and most effective relief.