

Enforcing patents in Denmark

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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?

Denmark ratified the European Patent Convention as late as 1st January 1990. Since that date most patent protection in Denmark has been established by way of a European patent designating Denmark. A European patent application that designates Denmark has the same effect in Denmark as a national application filed at the Danish Patent Office from its date of filing. Thus, when a patent is granted it confers the same right on the patent holder as a national patent.

In order to secure provisional protection before grant, the patent applicant must file a translation of the patent claims into Danish. Once a translation has been filed, an applicant has the right to reasonable compensation in cases of infringement from the date when the translated claims are made available to the public. Obviously, filing a translation also serves as a warning to potential infringers.

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

A patent holder seeking to enforce its rights in Denmark can file an infringement suit with one of the two Danish high courts, where the case will be tried before three legally qualified judges. Due to the small number of litigation cases in Denmark, we have no specialist patent courts. In order to compensate for the lack of technical expertise in the high courts, the courts nominate neutral expert witnesses, who normally include an experienced patent

attorney and one or more technical experts in the relevant field, preferably university professors.

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?

The parties put a series of questions in writing to the experts, who may also be asked to conduct or supervise experiments relevant to the case. The experts then present written testimony containing their answers to the questions.

During the final court hearing, the expert witnesses are cross-examined. The experts may not express any opinion of legal character, ie, they may not state whether the patent is infringed or not. The judges then reach a decision, based on the written testimony and the cross-examination of the expert witnesses.

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

The validity of the patent-in-suit is not automatically an issue – at least not an issue raised by the court. But the defendant party may, and often does, file a counterclaim for invalidity at the same high court. The counterclaim should be supported by new prior art and/or arguments challenging novelty and inventive step. If an invalidity suit is filed, the proceedings are consolidated, unless the parties agree to a bifurcation. The validity suit proceeds much like the infringement suit, ie, it includes written testimony from expert witnesses and cross-examination, followed by a court decision taken by the judges.

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

No formal pre-trial discovery is permitted in Denmark. The parties are able to request

voluntary information from each other, such as samples of an alleged infringing product for further investigation, but they have no obligation to meet any requirements in this respect. Instead, a company that wants to sue an infringer will normally investigate publicly available information, such as the file history of the patent-in-suit and patent databases. A company may also consult experts in the technical field, such as university professors. Where technical experts are consulted prior to a trial, it is important for the company to keep clear some selected experts to act as court – appointed witnesses in the later trial.

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

The extent of protection conferred by a European patent is determined by the terms of the claims (Article 69 EPC). The Protocol on the Interpretation of Article 69 is an integral part of the Convention, but attempts to harmonise the interpretation of equivalents in the contracting states have been unsuccessful. However, the doctrine of equivalents cited in the Protocol's last sentence is much in harmony with the situation according to Danish case law.

Thus, the protection conferred by the claims in a European patent enforced in Denmark extends beyond the literal wording of the claim to cover, to some extent, products, processes, etc, that are equivalent in structure, technical function, use, etc. The decision is taken on a case-by-case basis on a balanced overall judgment, taking into account all essential steps in a process (if the patent relates to a process) or all essential elements (if the patent relates to a product). The protection must combine fair protection for the patent holder and a reasonable degree of certainty for third parties.

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?

Only a few cases relating to the enforcement of patents within new technical fields, such as biotech or software, have reached the courts, and these have not yet given rise to any diverging trend that would suggest that such patents may be more difficult to enforce.

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?

During the final hearing of a case in high

court the parties plead their case primarily based on legislation and decisions of Danish courts. However, if the case concerns a European patent, then relevant decisions from European case law will be cited and the evaluation from the European Patent Office of the validity of a patent will be referred to. The decisions and opinions of foreign courts in similar cases would, however, normally have little effect on the final decision in a Danish court.

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

It takes two to three years from the start of the proceedings in an infringement case before a decision can be expected from the high court. The parties may request an extension of the time limits set by the court during the preparatory work, and these extensions are widely granted by the court. The plaintiff may object if the defendant abuses this privilege and deliberately delays the case unduly.

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

It is possible, and in most cases recommended, to seek a preliminary injunction in the city court. The formal request for injunction is filed at the city court where the alleged infringer is resident. The case is tried before one judge, who is unlikely to be familiar with patent cases.

In injunction proceedings, testimonies are allowed from experts consulted by only one of the parties, and both parties will normally support their case with expert testimonies. The final hearing is often very comprehensive, since the parties have a legitimate interest in presenting as many technical details as possible; this is normally allowed by the city court. In an injunction case, a challenge from the defendant on the validity of the patent will, according to present practice, be taken into consideration only if new prior art anticipating the novelty of the invention is presented to the court.

A decision of the city court to grant a preliminary injunction must be confirmed afterwards in a confirmatory action in the high court.

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

In an injunction case in a city court one can expect a decision within one to six months. The timeframe depends on the

circumstances and the desire of the parties to speed up or delay the case.

In an infringement case in high court a decision may be taken within six to 24 months, depending on the circumstances and the parties' willingness to speed up preparation of the case by, for example, getting a statement from the court-nominated patent expert and technical expert witnesses.

12. 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?

A decision of the city court to grant or reject a preliminary injunction may be appealed to the high court. In an appeal relating to a preliminary injunction, testimonies from one-sided experts are also allowed. The timeframe for an appeal case, following a preliminary injunction case, depends on the circumstances and the desire of the parties to speed up or delay the case, but it is possible to have an appeal decision within another three to nine months.

An infringement decision from the high court may be appealed to the Supreme Court, from which it may take several years to get a decision.

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

The official fee for an injunction case is modest, whereas a larger fee depending on the value of the case must be paid for an infringement case before the high court. In principle, the losing party must pay the winner's legal expenses, but the amount to be paid is set by court by way of an estimate, and this estimate seldom reflects the winner's actual costs. The losing party normally pays the expenses of the expert witnesses.

It should be added that since pre-trial discovery is not possible in Denmark, the costs are smaller than in countries where pre-trial discovery is allowed. However, there are, of course, costs for the preparatory work of a suit, involving both a patent attorney and an attorney at law, and possible expert witnesses. Naturally, the cost varies depending on the technical field, but generally pharmaceutical cases are the most expensive to prepare.

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

Only attorneys-at-law can represent the parties in a Danish court. A specialist

representative is not formally required by the court, but the patent attorney plays an important role as adviser and assessor to the attorney at law and the client in technical matters both during the pre-trial preparation of the suit and during the final hearing.

The patent attorney is responsible for drafting the written questions which are the basis for the testimonies presented by the court-nominated experts, and the patent attorney also contributes during the drafting of the pleading documents. Written declarations and testimonies are also often given by a patent attorney, who may be nominated by the court as an expert witness.

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

The Danish Patents Act was amended on 1st January 2006 in accordance with Directive 2004/48/EC from the European Union, which enumerates a number of minimum requirements. According to the amended Act, any person who intentionally or negligently infringes an exclusive patent right must pay remuneration for the use and compensation for any damages caused by the infringement. In aggravating circumstances, in particular if the infringement is with intent to gain a significant and obviously unlawful profit, the penalty may increase to imprisonment.

In practice, this means that the patent holder has the right to reasonable compensation for the use of the patented invention, which would frequently be based on a normal licence fee within the relevant field, as well as damages for the unauthorised use. The compensation is based on an estimate made by the court and in this connection it should be noted that compensation is generally very modest in Denmark.

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

A European patent holder seeking to enforce its patent in Denmark can, in principle, opt for mediation as an alternative to litigation. The chance of solving a conflict through mediation before litigation must be evaluated on a case-by-case basis, taking the subject matter of the patent and the purpose of the litigation into account.

17. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement?

Denmark signed the London Agreement on

the application of Article 65 EPC on 17th October 2000. On 4th June 2003, the Danish Parliament amended the Danish Patents Act in order to implement the London Agreement so that it will be compulsory to translate the claims into Danish, while the description must be available in English. The date of deposit of the instrument of ratification and thus of entry into force of the amendment to the Patents Act will be decided by the competent minister.

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

The European patent holder can strengthen its position by having the patent re-examined by the Patent Office. This system, introduced in 1993, permits administrative re-examination of both Danish and European patents which have been registered in Denmark. The patent holder can amend the claims and description of its patent in order to take newly discovered and relevant prior art into account. This procedure may improve the chances of success in a preliminary injunction suit.

If a European patent application is still pending, it is also possible to speed up the right to enforcement by filing an application for a utility model, preferably with a limited scope, that is tailor-made for an infringement suit. A utility model right can be enforced in the same way as a patent right, provided that the utility model has been examined by the Patent Office. In most cases it is possible to have an examined utility model granted within a few months and then to file a suit for preliminary injunction against an infringer at the city court.

A potential countermove from a defendant sued for infringement is to challenge the validity of the patent in high court or to request administrative re-examination at the Patent Office in order to have the patent invalidated or the scope of protection limited. However, where infringement proceedings are brought before a court prior to a final decision on re-examination, the Patent Office will temporarily shelve the prosecution of the re-examination case pending the decision from the court.

Because the climate for preliminary injunctions is generally favourable in Denmark, we have also seen an increase in the number of non-infringement suits filed by prospective defendants.

Finally, the rules on compulsory licences should be mentioned. These state that the owner of a patent, the use of which is

dependent on a patent which belongs to another person, may obtain a compulsory licence for use of the protected invention of the latter patent if the former invention represents an essential technical progress of substantial economic importance. The same applies in the case of the non-working of a patent within the EU. These rules have rarely been utilised in practice, but they probably have a preventive effect.