

Ireland

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(1) APPLICABLE LAW

1 Patent law in Ireland is governed by the Patents Act 1992 (the ‘1992 Act’) as amended by the Patents (Amendment) Act 2006 (the ‘2006 Act’). The Patents Rules 1992¹ 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 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), 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 2006 amendments to the 1992 Act give effect to certain provisions arising under the TRIPS Agreement, the European Patent Convention, 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 Patent Rules.² Regulation (E.C) No. 816/2006 adjusted obligations arising under the TRIPS Agreement to allow for the issuance of compulsory licenses with respect to the manufacture of pharmaceutical products for export to countries with public health problems. This regulation has been transposed into Irish law.³

3 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.

4 There has historically been very little patent litigation in Ireland, 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 United Kingdom, 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

¹ As amended by the Patent (Amendment) Rules 2006 S.I No. 412 of 2006 and the Patent (Amendment) Rules 2009 S.I No. 194 of 2009.

² Section 6, s. 18, s. 19 (m), S.I No. 194 of 2009.

³ European Communities (compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems) Regulations 2009, S.I No. 408 of 2008.

Trademarks (the ‘Controller’), shall be taken of the EPC, the Patents Cooperation 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.⁴ On this basis, the Irish courts can be expected to have regard to the decisions of the European Patent Office.

⁴ Patents Act 1992 s. 129. References to sections in this chapter are to the relevant section of the 1992 Act unless otherwise indicated.

(2) VALIDITY

(2.1) GENERAL

5 The law on validity in Ireland is substantially identical to the law under the EPC. Sections 9–14 (patentability) and 57–62 (revocation) constitute the relevant statutory provisions of the 1992 Act and are closely modelled on Chapter I of Part II of the EPC. Sections 9–14 set forth the bases upon which one may ground an application for a patent in Ireland (novelty, inventive step, industrial application), as well as operating in tandem with sections 57–62 to set forth the bases upon which a party can seek to have an Irish patent revoked. However, there are some minor points of divergence between the 1992 Act and the EPC:

Article 53(a)

6 Article 53(a) of the EPC provides that ‘European patents shall not be granted in respect of: inventions the publication or exploitation of which would be contrary to “ordre public” or morality.’ In both the EPC and in the TRIPS Agreement, the French term *ordre public* is used in the English text on the basis that it is not directly analogous to the English term ‘public order’.

7 However, the corresponding provision of the 1992 Act uses the English term.⁵ The term ‘public order’ as interpreted in the Irish courts in other contexts,⁶ is somewhat broader than the French law concept of *ordre public*. The Irish courts may, however, have regard to the terms of the EPC, and the somewhat different meaning to be ascribed to the term *ordre public*, in interpreting this provision.

Article 55(1)(a)

8 The 1992 Act provides that a disclosure shall not be taken into account for the purposes of the state of the art where it is a consequence of ‘breach of confidence or agreement in relation to, or the unlawful obtaining of the matter constituting, the invention’.⁷ This is arguably narrower than the EPC provision that a disclosure must be a consequence of ‘an evident abuse in relation to the applicant or his legal predecessor’.

9 As regards the interpretation of the provisions of the 1992 Act, as mentioned above, there is very little patent litigation in Ireland, so it is impossible to say how the Irish courts will interpret many of the provisions. However, where no Irish case law exists on any given provision, guidance may be sought from the decisions of the courts of other states under the EPC, in particular the UK courts, and from the decisions of the EPO.

(2.1.1) Inventive Step

10 The issue of the requirement for a patent to have an inventive step (and therefore for it not to be obvious) was recently dealt with by the Irish courts in *In the matter of Irish Patent*

⁵ Section 10(a).

⁶ *State (Lynch) v. Cooney* [1982] I.R. 337.

⁷ Section 12(1).

number 65535.⁸ This was a case in which Ivax International BV sought to revoke a patent which covered GlaxoSmith Kline's (GSK's) *Seretide* asthma product.

11 In considering the revocation petition the Irish High Court adopted the four step obviousness test laid down in the United Kingdom case of *Windsurfing International v. Tabur Marine (Great Britain) Ltd.*⁹ However, ultimately the test applied by the Irish Court was not on all fours with the test set out in *Windsurfing* and later in *Pozzoli S.P.A. v. B.D.M.O. S.A.*¹⁰

12 When applying step (iii) of the *Windsurfing* test (the issue of what is, or what is not, obvious to a person skilled in the art) the Irish Court diverged from the test as originally set forth in *Windsurfing*. The Irish Court stated in *GSK* that '*where a member of the team has a piece of prior art properly so considered, it is to be expected for him or her to share it with the team. As the team will have different sub-specialities, I see no reason why they would not add to the discussion as to the prior art, provided the team remains uninventive*'.¹¹ This suggests that in the circumstances where a person skilled in the art would actually be a team of people rather than an individual, the Irish Court will imbue "the skilled person" with the communal pieces of prior art present within the group, as opposed to considering whether the inventive step in question constitutes an inventive step over each piece of prior art when considered in isolation against the common general knowledge. On this basis '*the normally skilled but unimaginative addressee in the art*',¹² as described in the *Windsurfing* test may become possessed of a particularly comprehensive and holistic knowledge of the relevant art.

13 The Irish High Court also approved the analysis of the concept of obviousness (in terms of obvious to try) set out by Walker LJ in *Conor Medsystems v. Angiotech Pharmaceuticals*.¹³ In this case the Irish Court found that where a patent does not address the fact that it overcomes well known prejudices in the field to which the patent relates, those prejudices could not have been so decisively overwhelming as to make the patent non-obvious to try.

14 The Irish Court in *GSK* also adopted the approach of Kitchin J in *Generics v. Lundbeck*, that obviousness must be considered by reference to the weight attached to any one particular factor in light of all the relevant circumstances. Therefore, the issue of obviousness will always be influenced by the facts of the case.

15 Although the Irish Court applied the UK test for obviousness in the *GSK* case it did express a preference towards the EPO's *problem/solution* approach towards obviousness. Therefore it is possible that this approach may be afforded consideration by the Irish courts in the future.

(2.1.2) Short-Term Patents

16 In addition to a full patent, Irish law provides for a more limited form of patent protection known as a short term patent, which is granted for a period of ten years.

17 A short-term patent will be available for an invention that is 'new and susceptible of industrial application provided it is not clearly lacking an inventive step'.¹⁴ The criterion of

⁸ [2009] IEHC 277.

⁹ [1985] RPC 59.

¹⁰ [2007] FSR 37.

¹¹ [2009] IEHC 277.

¹² *Ibid.*

¹³ [2008] RPC 716.

¹⁴ Section 63(4).

‘not clearly lacking an inventive step’ is clearly a lower standard than the requirement for a full patent, namely that it ‘involves an inventive step’.¹⁵ However, the disclosure obligation in a short-term patent application is higher. For a full patent, the patentee is required to disclose the invention ‘in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art’.¹⁶ However, an applicant for a short-term patent must disclose ‘the invention and the best method of performing it known to the applicant’.¹⁷ A short-term patent may not include more than five claims.

18 The application procedure for a short-term patent is streamlined, and the Patents Office does not carry out a search before granting the application.¹⁸ As a result, a short-term patent is significantly cheaper to obtain. However, the consequence of this is that a patentee is required to have a search carried out and furnish the results of that search to the alleged infringer¹⁹ before he or she can enforce the short-term patent by litigation.

19 As discussed below, litigation in respect of short-term patents is generally brought in the Circuit Court rather than the High Court.²⁰ The effect of this is to reduce the costs involved in litigating short-term patents.

(2.2) PARTIAL INVALIDITY

20 Under section 59(3) of the 1992 Act, in any application for revocation of a patent, the Court or Controller (as the case may be) may, if they believe the grounds for revocation affect the patent only in part, make an order that the patent be revoked unless the specification is amended appropriately to excise the invalid part within a specified time.

21 In addition, in infringement proceedings, the Court may grant an injunction in respect of a partially valid patent, if that portion is infringed, but can only grant an award of damages and/or costs if the plaintiff proves that the patent was framed in good faith and with reasonable skill and knowledge. As a condition of granting any relief in respect of a partially invalid patent, the Court may direct that the specification be amended. Such an application for amendment can be made regardless of whether all issues in the proceedings have been determined.

¹⁵ Section 9(1).

¹⁶ Section 19(1).

¹⁷ Section 63(7)(b)(i).

¹⁸ Section 65(1).

¹⁹ Section 66(1).

²⁰ Section 66(4).

(3) INFRINGEMENT

(3.1) STATUTORY PROVISIONS

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

(3.2) WHAT ACTS CONSTITUTE DIRECT INFRINGEMENT?

23 Section 40 of the 1992 Act 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;*
- (b) 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;*
- (c) 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.*

This provision closely mirrors the provisions of Article 26 of the CPC.

24 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 and importing.

25 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.²¹ However, this was in the context of somewhat different wording in the equivalent UK provision, and in Ireland, it is likely that an offer in Ireland to sell goods anywhere in the world would constitute infringement under section 40(a).²² By contrast, 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).

²¹ *Kalman v. PCL Packaging (UK) Limited* [1982] FSR 406.

²² See Clark & Smith, *Intellectual Property in Ireland*, 2nd edn (2005), 108.

26 As regards importing, it appears from the UK case law,²³ 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,²⁴ but it is difficult to say if this would be followed in Ireland.

27 Section 40(c) prohibits certain dealings with products ‘obtained directly’ by a patented process. In the UK, it has been held that when the patented process produces an intermediate product, which undergoes further steps that deprive it of its essential characteristics, the ultimate result of the process will not infringe the process patent.²⁵ As regards biotechnological inventions, 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. . . extend[s] to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics’.

²⁶ This is a somewhat wider test than that in respect of traditional inventions.

28 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 or she may also have a third party repair it on his or her behalf. However, if the repair amounts to the effective replacement of the product, this will constitute an infringement by making the patented product.²⁷

(3.3) 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’. The section goes on to provide that a court, in interpreting the claims, shall have regard to the Protocol on the Interpretation of Article 69 of the European Patent Convention, which is scheduled to the 1992 Act. This provides that:

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 patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

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

²³ *Sabaf v. MFI Furniture* [2004] UKHL 45.

²⁴ *Waterford Wedgwood plc v. David Nagli Ltd* [1998] FSR 92.

²⁵ *Pioneer Electronics v. Warner Music* [1997] R.P.C. 757.

²⁶ European Communities (Legal Protection of Biotechnological Inventions) Regulations 2000, implementing Directive 98/44/EC of the European Parliament and of the Council of 6 Jul. 1998.

²⁷ *Solar Thompson Engineering v. Barton* [1977] RPC 537.

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'.²⁸ This test was approved by the Irish Supreme Court in *Ranbaxy Laboratories Ltd & ors. v. Warner Lambert Company*.²⁹ In *Novartis AG. v. The Controller of Patents, Designs and Trademarks*,³⁰ 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.³¹

32 In the most recent authoritative judgment of the House of Lords in the United Kingdom, *Kirin-Amgen Inc. v. Hoechst*,³² 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 The doctrine of equivalents has fallen out of favour in the Irish courts. Under the pre-1993 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.³³ 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 United States jurisprudence. In *Amgen*, the House of Lords rejected a formal doctrine of equivalents as contrary to the terms of Article 69 of the EPC. Lord Hoffman pointed out that the doctrine of equivalents is a necessary reaction to an excessive literalism in interpreting claims. The question of if 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

²⁸ *Catnic Components Ltd v. Hill & Smith Ltd* [1982] RPC 183; see also *Kirin-Amgen Inc. v. Hoechst* [2004] UKHL 46.

²⁹ [2005] IESC 81.

³⁰ [2007] IEHC 442.

³¹ *Improver v. Remington Consumer Products* [1990] FSR 181.

³² [2004] UKHL 46; approved in *Ranbaxy Laboratories Ltd & ors. v. Warner Lambert Company* [2005] IESC 81.

³³ *Farbwerke Hoechst A.G. v. Intercontinental Pharmaceutical (Eire) Ltd* [1968] FSR 187.

judgment on *Ranbaxy Laboratories Ltd & ors. v. Warner Lambert Company*, the Irish High Court affirmed Lord Hoffman's approach.³⁴

34 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 whilst regard may be had to the description and drawings, these may only be used to 'interpret' the claims.

35 There is no doctrine of 'file-wrapper' estoppel in Irish law. In a recent English decision, the UK Court of Appeal took the view that it was permissible to have regard to the prosecution history of a patent, in so far as same was available to third parties, in order to resolve an ambiguity.³⁵ However, that decision was distinguished and confined to its particular facts in the recent decision of the Irish Supreme Court in *Ranbaxy Laboratories Ltd & ors. v. Warner Lambert Company*³⁶ in which the 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 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.*³⁷ The approach has been affirmed by the Irish High Court in *Ranbaxy Laboratories Ltd. & ors. v. Warner Lambert Company*.³⁸ The chief question posed within the Ranbaxy litigation was if 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

³⁴ [2007] IEHC 256.

³⁵ *Rohm & Haas Company v. Collag* [2002] FSR 28.

³⁶ [2005] IESC 81.

³⁷ [2007] R.P.C 4.

³⁸ [2007] IEHC 256.

to solely seek a patent for a racemic mixture when it was known that the single enantiomers held greater potential for potency.

37 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.

38 In addition, there is a specific statutory defence³⁹ in which a person can show that he or she 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.

(3.4) INDIRECT INFRINGEMENT

39 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.

40 The scope of section 41(1) 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.

41 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.⁴⁰ 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 or her actions in carrying out the experiment will not constitute infringement. However, the actions of his or her suppliers in supplying the essential means to put the invention into

³⁹ Section 55.

⁴⁰ Section 41(3).

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.

42 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. Further, there do not appear to be any substantive UK or commonwealth decisions on the point.⁴¹ The concept of a ‘staple commercial product’ comes from US law, in which the test focuses on if there are alternative ways in which the product as sold could be used.

43 The indirect infringement provisions of the 1992 Act are directed towards persons supplying the primary infringer. This was not generally regarded as infringement under the prior law. However, under the pre-1992 law, it was accepted that when a third party joins in a common design to infringe, he or she will be liable as a joint tortfeasor. Similarly, when a third party induced another to infringe a patent, or conspired with them to infringe the patent, he or she could be liable. It is unclear how far these forms of liability have survived the 1992 Act. However, if they do, they provide a form of quasi-indirect infringement that is somewhat wider than the terms of section 41.

⁴¹ The point was raised but not decided before the Federal Court of Australia on an interlocutory application in *Hexal Australia Pty Ltd v. Roche Therapeutics Inc* [2005] FCA 1218 (31 Aug. 2005). The concept was raised in *Cranway Ltd v. Playtech Ltd* [2009] EWHC 1588. However, because the defendant companies were successful in their counter-claim for the invalidity of the patent, the Court only gave a brief outline of the arguments arising under the infringement action.

(4) FURTHER DEFENCES TO INFRINGEMENT

(4.1) EXPERIMENTS

44 ‘Acts done for experimental purposes relating to the subject-matter of the relevant patented invention’ will not constitute infringement of a patent.⁴² The UK case law⁴³ draws a distinction between experiments whose purpose is to discover new information, which are permitted under this defence, and experiments whose sole purpose is to confirm and provide additional evidence of properties that are already known, which are not. This is particularly important in the pharmaceuticals field. A pharmaceutical product must be specifically authorized for sale, and in order to seek an authorization, the relevant regulatory bodies (in Ireland, the Irish Medicines Board) will require that extensive testing and clinical trials be carried out on the product. Such tests and trials may not be possible without infringement of an existing patent, meaning that the requirements for a product authorization cannot be fulfilled until after expiry of the patent. In the case of ‘generic’ pharmaceutical products that are bioequivalent to patented products, it may take a number of years to complete the authorization process, and if the process can only be commenced on expiry of a patent, this can effectively extend a patentee’s period of marketing exclusivity for the period after the expiry of the patent and the supplementary protection certificate.

45 A specific exemption for acts done in conducting the necessary studies, tests, and trials for the purpose of obtaining a product authorization for a generic pharmaceutical product has been provided by Directive 2004/27/EC, and implemented in Ireland with effect from 30 January 2006 by the European Communities (Limitation of Effect of Patent) Regulations 2006.

(4.2) PRIOR USE

46 As mentioned above, there is a specific statutory defence for a person who ‘in the State before the date of filing of the patent application or, if priority was claimed, before the date of priority, does in good faith an act which would constitute an infringement of the patent if it were then in force, or makes in good faith effective and serious preparations to do such an act’.⁴⁴

47 A number of points need to be highlighted. First, the 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 (discussed above).

48 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.

49 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

⁴² Section 42(b).

⁴³ *Monsanto v. Stauffer* [1985] R.P.C. 515.

⁴⁴ Section 55(1).

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. However, there is no right to grant a license 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 or she builds further on the work done before the relevant date.

(4.3) EXHAUSTION

50 As a Member State of the European Union, 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 European Court of Justice (ECJ) case law, and its implications in Ireland, is reasonably clear.

51 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 or her patent rights to prevent or hinder the importation of that product into a second Member State or prevent its sale there.

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

(4.4) EXTEMPOREANEOUS PREPARATION OF MEDICINES

53 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'.⁴⁵

54 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.

(4.5) PRIVATE ACTS

55 'Acts done privately for non-commercial purposes' do not constitute infringement.

56 In the UK, 'privately' has been interpreted as 'the opposite of 'publicly' and to be used in the sense of denoting that the act was done for the person's own use'.⁴⁶ However, this does not preclude acts done in the context of a business being done privately.

⁴⁵ Section 42(c).

⁴⁶ *Smith Kline & French Laboratories v. Evans* [1989] FSR 513.

57 To avail of the defence, acts must also be done for 'non-commercial purposes'. This is a subjective test, and the fact that the acts will have commercial benefit will not prevent the defence applying if their purpose was non-commercial. However, when there is any commercial purpose, even if it is secondary, the defence will not apply. No guidance is available on the meaning of commercial in this context, but the same UK case held that acts done for the purpose of court proceedings were not done for commercial purposes. This was despite the fact that the court proceedings were taken in the context of the defendant's business.

(5) COURT SYSTEM

(5.1) COMPETENT COURTS

58 Patent litigation is heard in the High Court, sitting in Dublin, usually in the Commercial List (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

59 The High Court has full original jurisdiction in civil matters. Unless application is made to 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.

60 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.

61 Procedures in the High Court are governed by the Rules of the Superior Courts 1986⁴⁷ (RSC), as amended. Order 94 RSC deals specifically with patent litigation.

Commercial Court

62 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 Rules of the Superior Courts have made provision for the discovery of electronically stored information in searchable form without significant cost to the party from whom discovery is requested.⁴⁸ This provision will further aid the progression of cases by facilitating expeditious discovery in complex cases.

63 The Commercial Court has jurisdiction over commercial cases with a value in excess of one million euro. In addition, it has jurisdiction in respect of a number of specific subject areas, including patents, regardless of the value of the case.

64 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 experience of patent litigation.

65 Procedures in the Commercial List of the High Court are governed by Order 63A RSC.

⁴⁷ S.I. No. 15 of 1986.

⁴⁸ Rules of the Superior Courts (Discovery) 2009 S.I No. 93 of 2009.

Supreme Court

66 Decisions in the High Court (both in the Chancery List and the Commercial Court) may be appealed to the Supreme Court.

67 The Supreme Court is the Court of final appeal, and hears appeals in all areas of law, both civil and criminal. 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.

68 The Supreme Court is a collegiate court, and generally sits as a Court of three, five, or seven judges, who will decide the case by a simple majority. In patent cases, the Court is likely to sit with three or at most, five judges.

Circuit Court

69 Circuit Court proceedings relating to short-term patents will generally be heard in the Circuit Court.

70 The Circuit Court is a court of local and limited jurisdiction. Its monetary jurisdiction is normally limited to EUR 38,092, although this does not apply in patent cases.⁴⁹ 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.

(5.2) PATENTS OFFICE

71 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.

72 Proceedings before the Controller are governed by the Patent Rules 1992.⁵⁰

(5.3) CONSERVATORY MEASURES

(5.3.1) Products and Assets

73 There is no specific provision for the seizure of infringing goods or equipment used in the manufacture of those goods, except when the purpose of the seizure is to preserve evidence that may be required at the hearing of the case. However, the general power of

⁴⁹ Section 66(4).

⁵⁰ S.I. No. 179 of 1992.

the Court to grant interim and interlocutory injunctions may be used to restrain the marketing and use of such goods and equipment pending trial.

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

75 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 until the next motion day (during the Court term, this is usually the following Monday). At that point, the Court will hold an *inter partes* hearing to determine whether to extend the order until the date of trial.

76 The *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.

77 The conditions for the grant of such a *Mareva* injunction may be summarized as follows:

- (a) 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 an order for damages after trial.
- (b) 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.
- (c) 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 disposed of either by moving them out of the jurisdiction, or by dissipating them in the jurisdiction.
- (d) The balance of convenience must favour the grant of the injunction.

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

- (a) The plaintiff must make full and frank disclosure of all matters in his or her 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.
- (b) The plaintiff should give particulars of his or her claim and the amount thereof, fairly stating the points made against it by the defendant.
- (c) 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.
- (d) The plaintiff must give some grounds for believing that there is a risk of the assets been 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.

- (e) The plaintiff must give an undertaking in damages in the event that he or she 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.

79 The procedures for applying for a *Mareva* order are the same as those for applying for other interim and interlocutory injunctions (see below).

(5.3.2) Evidentiary

80 The Court may grant an order *ex parte*, known as an *Anton Piller* order, directing the defendant to allow the plaintiff, attended by his or her solicitor, to enter the 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 is not like a search warrant, and cannot be enforced without the defendant's consent. However, when the defendant does not consent, he or she will be in contempt of court.

81 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.

82 Because the order is applied for *ex parte*, the courts require that the applicant make full and frank disclosure of all material facts to the court, 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.

83 Like a *Mareva* order, an *Anton Piller* order will initially last only until the next motion day, when an *inter partes* hearing will be held to determine if the order should be extended until the trial of the action. 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 or she 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 when he or she suffers loss due to an improperly granted order.

84 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 or her possession.
- (d) There must be a real possibility that these will be destroyed before an application *inter partes* can be made.

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

(5.4) PROCEEDINGS

(5.4.1) Pre-trial Proceedings

86 Not applicable.

(5.4.2) Ordinary Proceedings

87 The procedures that apply to litigation in Ireland will vary depending on the subject matter of the proceedings and the court in which they are taken. The procedures set out below are those that apply to infringement proceedings. The procedures for revocation proceedings are somewhat different and are discussed briefly at the end of this section.

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

(5.4.2.1) High Court Procedure

89 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.

90 Great care is required in preparing a warning letter in patent cases, because there is a possibility that the plaintiff may incur liability as a result. Section 53 of the 1992 Act as amended provides as follows:

- (1) *Where any person (whether entitled to or interested in a patent or not) by circulars, advertisements or otherwise threatens any other person with proceedings for infringement of a patent, any person aggrieved thereby may bring proceedings in the Court against him for any such relief as is mentioned in subsection (2).*
- (2) *Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of a patent, the plaintiff shall be entitled to the following relief, that is to say a declaration to the effect that the threats complained of were unjustifiable;*
 - (a) *an injunction against the continuance of the threats; and*
 - (b) *such damages, if any, as have been sustained by him by reason of the threats.*
- (3) *Proceedings may not be brought under this section as regards—*
 - (a) *a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process, or*
 - (b) *a threat, made to a person who made or imported a product for disposal or used a process, to bring proceedings for an infringement alleged to consist of doing anything else in relation to that product or process.*
- (4) *For the purposes of this section a notification of the existence of a patent or a patent application does not of itself constitute a threat of proceedings.*

(5.4.2.1.1) Non-Commercial Court Procedure

91 The pre-trial procedures in the High Court are dominated by the exchange of formal documents called 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.

92 The proceedings in the High Court are commenced by issuing a plenary summons⁵¹ 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).⁵² When the defendant resides outside the European Economic Area (EEA), it is necessary to seek the leave of the Court to serve the summons outside the jurisdiction.⁵³ Specific provision is made for service in countries party to the Brussels and Lugano Conventions (i.e., members of the European Union and the European Free Trade Association). The service of documents outside the jurisdiction but within the EU can be effected by a transmitting agency, a diplomatic agent, registered post or direct service.⁵⁴

93 The plenary summons contains very little detail of the nature of the plaintiff's claim, usually limited to setting out the remedies sought.

94 A defendant is required to enter an appearance within eight days of service on it of the plenary summons.⁵⁵ However, if the defendant does not do so, he or she may subsequently enter an appearance at any time up to the date when judgment is entered against him or her. Again, special provision for time limits for the filing of an appearance is made when the plenary summons has been served in a country subject to the Brussels or Lugano Conventions. When the summons has been served out of the jurisdiction by leave of the court, a longer time will generally be set by the Court for entry of an appearance.

95 The plaintiff is required to deliver a statement of claim within twenty-one days of the date of the appearance by the defendant.⁵⁶ 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.⁵⁷

96 If a defendant does not consider that the statement of claim contains sufficient detail of the plaintiff's claim, it is open to the defendant to serve a notice for particulars, seeking additional particulars of the claim made by the plaintiff.⁵⁸ The notice will call on the plaintiff to reply within twenty-one days, and in the absence of a reply, the defendant may apply to the Court for an order compelling the plaintiff to provide the particulars sought. However, the Court will not grant such an order before the defence is delivered unless it is of the opinion that the particulars sought are necessary or desirable to allow the defendant to prepare his or her defence.

⁵¹ Order. 1 RSC. References to orders in this chapter are to the relevant order of the RSC, unless otherwise indicated.

⁵² Order 8.

⁵³ Order 11.

⁵⁴ Order 11D as amended by Rules of the Superior Courts (Service of Proceedings (Regulation (EC) No. 1393/2007)) 2009, S.I No. 280 of 2009.

⁵⁵ Order 12.

⁵⁶ Order 20.

⁵⁷ Order 94, Rules 4 and 5.

⁵⁸ Order 19 Rule 7.

97 A defendant has twenty-eight days from the date of delivery of the statement of claim to file his or her defence.⁵⁹ 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 or her defence. The defence sets out the facts on which the defendant relies in his or her defence and the basis for that defence. When the defendant disputes the validity of the patent or counterclaims for revocation, he or she must deliver with his or her defence particulars of the objections on which he or she relies to support such invalidity.⁶⁰ 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.⁶¹ When one of the grounds of invalidity is lack of novelty, the particulars must give details of the previous publication or user alleged.⁶² Once the defence has been filed, the plaintiff may serve a notice for particulars, in the same manner as the defendant, in respect of any point raised in the defence.

98 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.⁶³

99 It is open to the plaintiff to deliver a reply to defence, which must be delivered within fourteen days of delivery of the defence.⁶⁴ 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.⁶⁵ When no reply is delivered, pleadings are closed once the time for delivery of a reply has expired.⁶⁶

100 As mentioned, relatively short time limits are laid down for the delivery of the various pleadings. However, these are rarely complied with in practice, and it is difficult for one party to force the other to comply with them. It is open to the plaintiff to apply for judgment in default of appearance⁶⁷ or judgment in default of defence⁶⁸ when the defendant has failed to deliver either document. It is also open to the defendant to 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.⁶⁹ However, these applications are not generally made until some time after the deadlines for delivery of pleadings have passed, and they will not usually be granted when the other party can provide an explanation for the delay. Even when no explanation is forthcoming, these remedies are rarely granted on the first application. Thus, it can often take up to eighteen months for all pleadings to be delivered.

101 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.⁷⁰ Discovery is a procedure whereby the parties can be compelled to disclose documents in their possession, custody, or power that are relevant to any matter at issue in the case. Documents are defined broadly so as to

⁵⁹ Order 21.

⁶⁰ Order 94 Rule 7.

⁶¹ Order 94 Rule 8.

⁶² Order 94 Rule 9.

⁶³ Order 94 Rule 12.

⁶⁴ Order 23.

⁶⁵ Order 23 R. 6.

⁶⁶ Order 27 Rule 11.

⁶⁷ Order 13.

⁶⁸ Order 27 Rule 9.

⁶⁹ Order 27 Rule 1.

⁷⁰ Order 31.

include documents in writing such as letters, agreements, notes and emails, maps and drawings, photographs, audio and video recordings, and information stored in digital form.

102 The parties must first seek to agree the terms of discovery between them. Discovery is requested by letter specifying precisely the categories of documents sought and the reasons why these are relevant, 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.

103 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.⁷¹ At this point, the case will be listed in the uncertified Chancery List of the High Court. Once the case is ready to be heard, the plaintiff must file a certificate of readiness. Once a certificate of readiness is filed, the case can be allocated a date for hearing.

104 The trial is an oral hearing in open court, at which the judge hears evidence from witnesses for both parties, as well as legal argument on the points raised in the case.

105 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.

(5.4.2.1.2) Commercial Court Procedure

106 The Commercial Court was established in 2004 as a division within the High Court to hear commercial cases. The Commercial Court's procedures are designed to redress a number of the perceived weaknesses in the High Court procedure, in particular delay in High Court proceedings, and the inefficiency resulting from the failure to properly narrow down the issues between the parties. All patent matters are eligible to be heard in the Commercial Court.⁷²

107 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.⁷³ 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, and to date, there has been a reluctance to exercise that discretion when proceedings have been in being for some time in the High Court. Thus, an application to transfer to the Commercial Court is often made as soon as the proceedings are issued.

108 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 the judge of the Commercial List, and if the application is successful, all further motions and applications relating to the case are made to that judge.

⁷¹ Order 36 R 11.

⁷² Order 63A R 1.

⁷³ Order 63A R 4.

109 The Commercial Court judge has a wide discretion as to how the case should proceed once it has entered the Commercial List. 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 minimise the cost of those proceedings’.⁷⁴ All cases in the Commercial Court are subject to an initial directions hearing.⁷⁵ 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 or she 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 or she may also make a range of specific orders to facilitate the efficient running of the case. A typical initial direction would specify the dates on which pleadings are to be delivered and discovery requested and completed.

110 For particularly complex cases, the judge may direct that the case be subject to case management.⁷⁶ This involves the holding of a case management conference. The conference is attended by the judge and 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 are defined clearly, precisely and concisely;
- pleadings, affidavits, and statements of issue are served; and
- particulars and replies, admissions or requests for admissions, notices to admit documents or facts, and replies are served or delivered.

111 At the case management conference, the judge may fix a timetable for completion of preparation of the case for trial. He or she may also make any order that he or she could have made at the initial directions hearing. When a case is the subject of case management, the judge has the power to penalise delays by disallowing the costs of the party in default and awarding against that party the costs incurred by any other party.

112 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.⁷⁷ 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 arrangements which are deemed necessary. To this end, the parties are required to complete a detailed pre-trial questionnaire which must be lodged in advance of the meeting.

113 Written statements of evidence intended to be relied on by the parties, signed by the witness, must be exchanged in advance of trial.⁷⁸ The purpose of this provision is to exclude the tactic of ‘trial by ambush’ whereby the parties can introduce unexpected evidence at the trial.

⁷⁴ Order 63A R 5.

⁷⁵ Order 63A R 6.

⁷⁶ Order 63A R 14.

⁷⁷ Order 63A R16.

⁷⁸ Order 63A R22.

(5.4.2.2) Revocation Proceedings

114 An application for revocation of a patent may be made to the Controller or to the High Court.⁷⁹ 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. The application may also be made as a counterclaim in a patent infringement suit.

(5.4.2.2.1) *Revocation before the Controller*

115 An application to revoke a patent is made in writing to the Controller.⁸⁰ 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 or she seeks, together with any documents upon which the applicant relies.

116 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.

117 Evidence is given by statutory declaration in the absence of directions to the contrary, but the Controller does have the power to hear *viva voce* evidence in lieu of or in addition to statutory declarations.⁸¹ 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.

118 The decision of the Controller is subject to appeal to the High Court.⁸²

(5.4.2.2.2) *Revocation before the High Court*

119 The application is made by way of petition, accompanied by particulars of the objections on which the petitioner relies in support of invalidity.⁸³ The particulars of objection must include the same details as are required in infringement proceedings as set out above.

120 At this stage, either party may apply to transfer the case to the Commercial Court.

121 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 discovery and inspection of documents, experiments to be conducted by each party, models and exhibits being used by either party, expert witnesses, and exchange of written evidence.

122 At the hearing of the petition, the patentee has the right to begin the hearing and to give evidence in support of the validity of the patent. If the petitioner gives evidence impeaching the validity of the patent, the patentee has the right to reply to this evidence.⁸⁴

⁷⁹ Section 57(1).

⁸⁰ Patent Rules Ord. 41.

⁸¹ Section 92.

⁸² Section 96.

⁸³ Order 94 Rule 23.

⁸⁴ Order 94 Rule 25.

(5.4.3) Preliminary Injunctions

123 Preliminary injunctions may be granted on either an interim or interlocutory basis. An interim injunction is granted on *ex parte* application, and will last only until a motion seeking an interlocutory injunction can be heard. The purpose of an interim injunction is to restrain a defendant from acting in a manner which will cause irreparable harm to the plaintiff in that period.

124 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 again, its purpose is to prevent irreparable harm accruing to the plaintiff during that period.

(5.4.3.1) Interim Injunction

125 To obtain an interim injunction, an applicant must show that there is an immediate threat that he or she 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.

126 An application for an interim injunction is made by *ex parte* application grounded on an affidavit. When possible, a plenary summons (the initiating document in substantive proceedings – see below) should be drafted and issued and should be before the Court considering the application. It is also desirable to have a draft notice of motion for the interlocutory hearing and a draft order prepared at this stage. The ground affidavit should set out all of the facts necessary to satisfy the Court that an interim injunction is appropriate, and should also include an undertaking as to damages. Because an interim injunction is applied for *ex parte* without the defendant having an opportunity to put his case, the courts demand that an applicant make full and frank disclosure of the relevant circumstances when making the interim application, and failure to make proper disclosure will adversely affect the chances of the injunction being continued at the interlocutory stage.

(5.4.3.2) Interlocutory Injunction

127 In order to obtain an interlocutory injunction, an applicant must show:

- (i) that he or she has raised a fair question to be decided at the trial of the action;
- (ii) that damages would not be an adequate remedy for the plaintiff;
- (iii) that the balance of convenience favours the granting of the injunction.

128 The first issue is whether a fair question 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, but rather to ensure that the suit is not merely frivolous or vexatious.

129 A plaintiff must establish that, if no injunction is granted and he or she is subsequently successful at trial, an order for damages would not suffice 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.

130 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.

131 In considering the balance of convenience, the Court will consider, *inter alia*, the conduct of the respective parties to determine where the balance of convenience lies.

132 Another relevant factor is that the Court will often tend to favour that alternative that best serves to maintain the status quo pending trial. The purpose of the interlocutory injunction is to preserve the position of the parties pending the trial of the action, and the Court will adopt the course that best serves that purpose. If an interim application was previously made by the plaintiff, the issue of whether the plaintiff made proper disclosure at that stage will also be relevant.

133 In addition to satisfying these criteria, a plaintiff will be also required to provide an undertaking as to damages before an injunction will be granted.

134 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 Irish courts have recently 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.⁸⁵

135 An interlocutory injunction is applied for by notice of motion and grounding affidavit. These are commonly served on the defendant at the same time as the plenary summons and, when relevant, the interim order. The defendant will have an opportunity to file a replying affidavit or affidavits.

136 The plaintiff's grounding affidavit should disclose all relevant facts, separately address each of the elements of the test set out above, and include an undertaking as to damages. The defendant's replying affidavit should also address the elements of the test, arguing that they are not fulfilled in the particular case.

137 An interlocutory application will normally be heard in a matter of weeks. The hearing is conducted on the basis of the plaintiff's and defendant's affidavits, and oral evidence will not normally be heard.

(5.4.3.3) Defending an Application for an Interlocutory Injunction

138 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.

139 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 with minimal assets which is unlikely to be able to honour it. It may therefore be necessary in such circumstances for a parent company or director of a plaintiff company to give the required undertaking, and if this is not done, a defendant may be able to resist the application.

140 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 of 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.

141 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.

⁸⁵ *Smithkline Beecham Plc and ors. v. Genthon B.V. and ors* - unreported High Court, Kelly J. 28 February.

142 Fifth, when the proceedings could be heard in the Commercial Court, a plaintiff is less likely to obtain an interlocutory injunction. The purpose of the interlocutory procedure is to protect the plaintiff pending trial. However, when, as in the Commercial Court, a trial can be expected to take place within a relatively short period, there is less of a need for interlocutory protection.

(5.4.4) Suspension

143 In practice, most patents that are the subject of litigation in Ireland derive from European patents rather than being initiated in Ireland. As a result, very often EPO opposition proceedings are 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.⁸⁶ There is quite a heavy burden on an applicant seeking to avoid a stay in these circumstances.

(5.4.5) Appeal

144 Decisions of the High Court are subject to appeal in the Supreme Court. There is no further appellate court in Ireland.

(5.4.6) The Supreme Court

145 The Supreme Court has appellate jurisdiction from all decisions of the High Court, with such exceptions as may be prescribed by law.⁸⁷ In the context of patent litigation, this means that every decision of the High Court (including the Commercial Court) is subject to appeal to the Supreme Court. This is not limited to the decision on the merits of the action. A dissatisfied party may also appeal preliminary decisions, such as decisions in respect of preliminary injunctions.

146 The Supreme Court on appeal shows a certain 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 is relying on a transcript of that evidence. The principles applied by the Supreme Court have been 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, this Court is bound by those findings, however voluminous and, apparently, weighty the testimony against them. The truth is not the monopoly of any majority.*
3. *Inferences of fact are drawn in most trials; it is said that an appellate court is in as good a position as the trial judge to draw inferences of fact. . . . I do not accept that this is always necessarily so. It may be that the demeanour of a witness in giving evidence will, itself, lead to an appropriate inference which an appellate court would not draw. In my judgment, an appellate court should*

⁸⁶ *Merck & Co. Inc. v. G.D. Searle & Co.* [2001] 2 ILRM 363.

⁸⁷ Bunreacht na hEireann Art. 34.4.3.

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 – in a case of this kind, was there negligence? I leave aside the question of any special circumstance applying as a test of negligence in the particular case. 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 as to whether or not there was negligence on the part of the individual charged was erroneous, the order will be varied accordingly.*⁸⁸

147 In order to appeal against a High Court order, the appellant must serve a notice of appeal within twenty-one days of the date when the order is perfected. The notice of appeal must state what part or parts of the order are being appealed, and the grounds for the appeal. The original notice of appeal must be lodged in the Supreme Court Office within seven days of service.

148 The appellant must then lodge five books of appeal, which must include all documents on which the appellant will rely in the appeal. He or she must also lodge a certificate of readiness before the appeal will be listed for hearing.

149 There will generally be an initial hearing to fix a date for the hearing of the appeal. The appellant must lodge written submissions not less than four weeks before the hearing date. The respondent must lodge his or her submissions within one week thereafter. The parties must also lodge a book of authorities, containing copies of all authorities, including statutes and case law, on which they will rely during oral argument.

150 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 and witnesses from the High Court hearing. The Court, sitting with three or five judges, then makes its decision by a simple majority.

151 An appeal against the refusal of an *ex parte* application, such as an interim, *Mareva* or *Anton Piller* injunction application, must be made to the Supreme Court within four days of the refusal in the High Court.

(5.5) EVIDENCE

152 The burden of proof in respect of a particular fact is generally, in civil matters, placed on the person asserting that fact. Thus, it will be for a plaintiff to prove those facts that make up his or her case, and it will be for a defendant to prove those facts that ground his or her defence. In each 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’.

153 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 or she has not used the patented process. In this context, the Court must

⁸⁸ *Hay v. O’Grady* [1992] 1 IR 210 at 217.

have particular regard to the defendant's interest in protecting his or her manufacturing and business secrets and, for this reason, may receive the defendant's evidence in the absence of any other party.

154 In practical terms, the issue of who bears the burden of proof is rarely of great importance. If the Court believes that a plaintiff's version of events is more probable, the plaintiff will win on that point. If it prefers the defendant's version, the defendant will win the point. It is only when the Court is unable to decide, either because the probabilities are equally balanced or because no evidence about a particular fact was available, that the burden of proof becomes relevant.

155 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 then cross-examines the witness.

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

157 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 practising solicitor. When a party wishes to rely on a document at this stage, it must be referred to and exhibited in a sworn affidavit.

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

159 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 to test the evidence.

160 There is also specific provision 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'.⁸⁹ 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 or her function is to assist the judge in understanding the evidence before the court.

161 Experiments will often form an important part of the evidence in the patent actions. There are no specific rules of law in relation to the conduct of experiments in patent cases. However, they are normally dealt with in some detail in the directions given by the Court in revocation 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. The other party must then state in respect of each fact whether or not it is admitted. When a fact is not admitted, the person carrying out the experiment will usually 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, or more usually his or her expert witnesses, to

⁸⁹ Section 95.

test the experiment and highlight in evidence any weakness in the experiment or its conclusions.

(5.6) STATUTE OF LIMITATION PERIOD

162 Proceedings can be brought in relation to the infringement of a patent within six years from the date the cause of action accrues.⁹⁰

⁹⁰ Section 11, Statute of Limitations 1957.

(6) REMEDIES

(6.1) GENERAL: OVERVIEW OF AVAILABLE REMEDIES

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

164 In addition, a patentee may claim any of the following reliefs in an infringement action:

- (i) ‘an injunction restraining the defendant from any apprehended act of infringement’;
In order to obtain an injunction, the patentee must demonstrate that damages would not be an adequate remedy for future acts of infringement. In addition, because an injunction is a discretionary remedy, the Court will have regard to the conduct of the parties in determining whether it is appropriate to grant an injunction.
- (ii) ‘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.
- (iii) ‘an account of the profits derived by the defendant from the alleged infringement’;
This is discussed below in the context of damages.
- (iv) ‘a declaration that the patent is valid and has been infringed by the defendant’.⁹¹
The Court will also usually make an order in respect of costs. 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 or her costs. However, there are a number of exceptions to this principle.

165 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’.⁹² 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 or her, and this will not be affected by the fact that the plaintiff subsequently succeeds at trial.

166 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.⁹³ In addition, if the Commercial Court judge is of the opinion that a pleading contains any unnecessary matter, or is of unnecessary length, he or she may award

⁹¹ Section 47(1).

⁹² Order 63A R 30.

⁹³ Order 63A R 15(e).

the costs of the other party in dealing with such unnecessary matter against the offending party.⁹⁴

167 Also, in both the High Court and the Commercial Court, costs will not 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.⁹⁵

168 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.⁹⁶ Thus, even the successful party will usually have to bear a proportion of his or her costs, usually about one-third.

(6.2) DAMAGES AND ACCOUNTS OF PROFITS

169 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.

170 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 loss. When a patentee can demonstrate that he or she has lost sales by virtue of the defendant’s infringement, he or she will be able to claim damages for the profits he or she would have made on those sales. Alternatively, the Court may assess the notional license fee that the infringer would have had to pay to the patentee for the right to do the acts that constitute infringement.

171 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 patentee’s election. For example, a patentee may suffer loss by virtue of infringement of his or her patent in circumstances in which the infringer does not actually make any profit and indeed may make a loss on his infringing business. In these circumstances, damages are clearly preferable. On the other hand, when, for instance, an infringer has launched his or her infringing products in a market where the patentee has not previously marketed them, yielding significant profits without causing any direct damage to the patentee, an account may be more valuable.

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

173 A defendant will have a defence to an order for damages or an account of profits when, at the date of the infringement, he or she ‘was not aware, and had no reasonable grounds for supposing, that the patent existed’.⁹⁷ Further, he or she will not be deemed to have been aware, or to have reasonable grounds for supposing that the patent existed ‘by reason only

⁹⁴ Order 63A R 15(d).

⁹⁵ Order 94 R 13.

⁹⁶ Order 99 R 10(2).

⁹⁷ Section 49(1).

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’.

174 It will be for the defendant to prove that he or she was not aware and had no reasonable grounds for suspecting that the patent existed. The 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 or she 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.

175 A court has a 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.⁹⁸

176 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’.⁹⁹ This defence will not, however, prevent the award of an account of profits.

(6.3) LICENSES

(6.3.1) Exclusive Licenses

177 When an exclusive license is granted, the exclusive licensee will enjoy any right, in respect of the invention, to the exclusion of all other persons including the proprietor.¹⁰⁰ The exclusive license holder can take proceedings in respect of patent infringement committed after the date of the license.¹⁰¹ The proprietor of the patent is added as a defendant to the proceedings unless he or she have been joined as a plaintiff. A proprietor joined as a defendant is not liable for costs unless he or she has made an appearance and taken part in proceedings.¹⁰²

(6.3.2) Voluntary Licenses

178 An application can be made by the proprietor of a patent to the Controller for an entry in the register allowing licenses to be available as of right.¹⁰³ The Controller must be satisfied that the proprietor of the patent is not precluded by contract from granting licenses under the patent. When a voluntary license is granted, the licensee is entitled to compel the proprietor to bring proceedings with respect to the infringement of the patent. The licensee

⁹⁸ Section 49(2).

⁹⁹ Section 49(3).

¹⁰⁰ Section 2.

¹⁰¹ Section 51(1).

¹⁰² Section 51(2).

¹⁰³ Section 68(1).

can mount proceedings in his or her name when the proprietor has refused or failed to do so.¹⁰⁴ The proprietor reserves the right to apply for cancellation of the entry on the register.¹⁰⁵

(6.3.3) Compulsory Licenses

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

180 Where a license is granted, it is given on such terms as the Controller sees fit, provided that, when the patent relates to food or medicine, the Controller shall endeavour to secure that food and medicine shall be available to the public at the lowest prices consistent with the patentee deriving reasonable remuneration.

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

182 The grounds under which a compulsory license is granted have been amended by the 2006 Act and conforms with the TRIPS agreement. The applicant must satisfy as least one of the following grounds:

- (i) that a demand in the state 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 the state 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 the state is unfairly prejudiced.

Under section 70(2), the Controller may also grant a compulsory license if an invention protected by a separate patent cannot be exploited in the state without infringing rights deriving from the patent (known as ‘the first patent’). The proprietor of the second patent will be granted a license 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.

183 A compulsory license 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 2009.¹⁰⁶ The application must outline the amount of pharmaceutical products to be produced, the names of the importing countries, and details of license 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.

¹⁰⁴ Section 68(3).

¹⁰⁵ Section 69(1).

¹⁰⁶ S.I. No. 408 of 2008.

184 A number of points must be considered in respect of compulsory licenses. 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.

185 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.¹⁰⁷ The fact that demand would be greater at a lower price and that that potentially greater demand is not being met is not relevant.

186 In considering if demand is being met on reasonable terms, price will be only 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.

(6.4) CO-OWNERSHIP

187 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.¹⁰⁸ Registered applicants and proprietors can apply the invention to their own benefit without accounting to their co-owners.¹⁰⁹ The absence of concurrence will not restrict a joint proprietor from bringing infringement proceedings.¹¹⁰ However, the co-owner is obliged to join other parties to the proceedings as defendants. In such instances, the co-owner joined as a defendant is not liable for costs unless he or she enters an appearance and takes part in proceedings. Section 80(3) protects co-owners by ensuring that a license cannot be granted, nor a share assigned, in the patent or patent application without the consent of all parties. 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.¹¹¹ 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 regarded 'in the same manner as if the product had been sold by a sole applicant'.¹¹²

¹⁰⁷ Research Corpn's (Carboplatin) Patent [1990] R.P.C. 663.

¹⁰⁸ Section 80(1).

¹⁰⁹ Section 80(2).

¹¹⁰ Section 48(2).

¹¹¹ Section 80(4).

¹¹² Section 80(5).

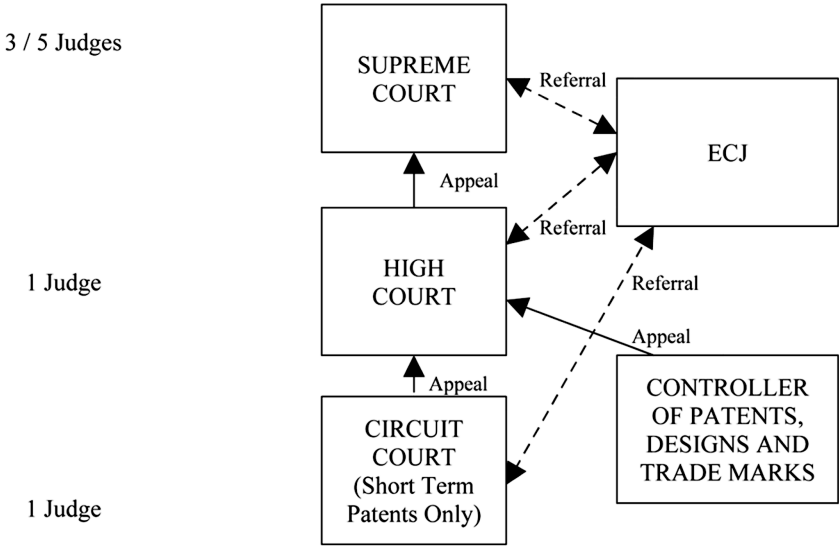
(7) CONCLUSION

188 As an English-speaking jurisdiction, with a fast avenue for resolution of disputes through the Commercial Court, Ireland can be an attractive jurisdiction for patent litigation. Irish patent law and the Irish courts' application of such law follow the principles of European patent law, assisting with consistency in pan-European patent litigation.

(8) TABLES

COURT STRUCTURE FOR PATENT
INFRINGEMENT/INVALIDITY IN IRELAND

IRISH PATENT COURT STRUCTURE



Preliminary (Interim) Injunction Proceedings: First Instance

Introduction	Counterclaim	Oral Hearing	Judgment/ Appeal
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. Advance notice of the intention to bring the motion should be given to the central office.	N/A	Matter can be heard by any judge of the High Court. The hearing is <i>ex parte</i> , and generally takes place at the time the application is made.	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 (usually only about two days).
			Where injunction granted, Respondent has an opportunity to oppose its continuation at the interlocutory hearing.
			If injunction is refused, applicant may appeal <i>ex parte</i> to the Supreme Court within four days of refusal.

Preliminary (Interlocutory) Injunction Proceedings: First Instance

Introduction	Counterclaim	Oral Hearing	Judgment/ Appeal
Issue motion for preliminary injunction in Central Office based on motion and grounding affidavit. Serve these papers on defendant.	Defendant will file replying affidavit to which plaintiff may respond.	Hearing will last a half day to three days (usually takes shorter time in the Commercial Court as judge will usually read papers in advance of hearing).	Single judge, renders judgment, on average within a week of oral hearing.
	Hearing date usually set between two to four weeks from date of motion depending on the number of affidavits served (may be shorter timeline in Commercial Court).		Judgment is subject to appeal within twenty-one days of date of order of judgment being perfected (usually from Central Office).

Commercial Court Proceedings on the Merit: First Instance

Introduction	Defence/ Counterclaim	Oral Hearing	Judgment/ Appeal
At any stage between issue of Plenary Summons and close of pleadings apply to Commercial Court Judge for entry into Commercial Court.	Initial directions hearing at hearing of motion to enter commercial court or shortly thereafter.	Hearing will usually take place within 6 months of pre-trial conference.	Single judge, renders judgment, on average within two weeks of oral hearing.
Apply by Notice of Motion grounded on Affidavit, and Certificate from moving party's solicitor.	Judge directs parties when to deliver pleadings (statement of claim, defence and counterclaim (if applicable) and discovery requests.	Oral hearing varies a great deal and depends on amount of evidence to be produced to the court.	Judgment is subject to appeal within twenty-one days of date of order of judgment being perfected (usually from Central Office).
On return date of motion, Commercial Court judge decides whether to admit case to Commercial Court.	If case subject to case management, judge holds case management conference.		
	Once pleadings exchanged and interlocutory matters dealt with, either party applies for date for pre-trial conference.		
	Written witness statements usually delivered by plaintiff at least one month prior to trial date, and by defendant at least seven days prior to trial date.		

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

Introduction	Defence/ Counterclaim	Oral Hearing	Judgment/ Appeal
Issue summons from Central Office and serve on defendant.	Defendant should file defence within twenty-eight days. Counterclaim is included in defence if applicable.	Case will be listed for hearing once certificate of readiness is served. Hearing will usually take place eight to twelve months after certificate of readiness is filed.	Single judge renders judgment, usually within one month of oral hearing.
Defendant enters appearance within eight 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 evidence to be put before the court.	Judgment is subject to appeal within twenty-one days of date of order of judgment being perfected (usually from Court Office).
Plaintiff serves statement of claim setting out details of claim within twenty-one days.	Plaintiff may serve reply to the defence.		
	Both parties then seek and make discovery of relevant documents.		
	Plaintiff then serves notice for trial and certificate of readiness.		

Preliminary (Interim) Injunction: Appeal

Introduction	Cross Appeal	Oral Hearing	Judgment/ Appeal
Mention appeal orally in Supreme Court within four days of refusal in High Court. No notice of appeal is required.	N/A	The oral hearing is <i>ex parte</i> , and will take place either at the time of or as soon as possible after the application is made.	Panel of three or five judges renders judgment, usually within a short time of oral hearing.
			No further appeal is available. However, the refusal of an interim order will not prevent the applicant seeking an interlocutory injunction at a later stage.
			If the order is granted, the respondent may still oppose it at the subsequent interlocutory hearing in the High Court.

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

Introduction	Cross Appeal	Oral Hearing	Judgment/ Appeal
Serve notice of appeal within twenty-one days of decision, and lodge in Supreme Court Office within seven days.	Where respondent intends to contend that the judgment or order appealed from should be varied, he must serve notice on the Appellant within four days of service of the notice of appeal, although may serve notice after that time.	The length of hearing depends on the length of transcripts and length of oral hearing.	Panel of three or five judges renders judgment, usually within a short time of oral hearing.
	Appellant lodges books of appeal and certificate of readiness in Supreme Court office.	No oral evidence, Supreme Court relies on transcript of High Court hearing.	No further appeal is available.
	Initial hearing to fix date for hearing of appeal.		
	Written arguments submitted by appellant at least four weeks before hearing date, and by respondent within one week thereafter.		

Relationship between Infringement and Validity

Heard together?	Difference between Irish and European Patent?	National Invalidity Proceedings while EPO Opposition Pending
Can be 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.	National invalidity 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. The other party will have an opportunity to cross-examine an expert to test their evidence.	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 Supreme Court
Interim usually about two days.	Interim four days
Interlocutory lasts until trial date.	Interlocutory two to four weeks

Duration of Normal Proceedings (Infringement and/or Invalidity)

First Instance	Appeal to Supreme Court
High Court eighteen months to two years	Six to nine months
Commercial Court six to twelve months	

Costs of Infringement and Invalidity Proceedings-N.B. all estimates are very approximate

Preliminary Injunction	Normal Proceedings (Infringement)	Normal Proceedings (Invalidity)	Normal Proceedings (Infringement and Invalidity)	Appeal (to Supreme Court, in Preliminary Injunction or Normal Proceedings)
EUR 75–95,000	EUR 95–150,000	EUR 95–150,000	EUR 130–190,000	EUR 75–95,000

