

Bird & Bird

Patent Litigation Jurisdiction Comparator

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Contents

1. Where can patent infringement actions be started? Is there a choice of venue?	3
2. Are the judges' specialists? Do they have technical backgrounds?	7
3. How long does it take from starting proceedings to trial?	10
4. Can a party be compelled to disclose documents before or during the proceedings?	13
5. How are arguments and evidence presented at the trial?	19
6. How long does the trial generally last and how long is it before a judgment is made available? Are judgments publicly available?	23
7. Can a defence of patent invalidity be raised? Are infringement and validity issues heard together?	27
8. Are infringement proceedings stayed pending resolution of validity in the national patent office (or, if relevant, the EPO) or another court?	31
9. Are preliminary injunctions available? If they are, can they be obtained <i>ex-parte</i> ? Is a bond necessary? Can a potential defendant file protective letters?	35
10. Are final injunctions available as of right? Is a bond necessary?	42
11. What other remedies are usually ordered if a patentee is successful?	45
12. Would the tribunal consider granting cross-border relief?	48
13. Is there a right of appeal from a first instance judgment? How long between judgment at first instance and hearing the appeal?	51
14. Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?	54
15. What is the cost of a typical infringement action to first instance judgment? If the issues of invalidity and infringement are bifurcated, what is the cost of the invalidity action? Can the winner's costs be recovered from the losing party? How much is the cost of an appeal?	58

1. Where can patent infringement actions be started? Is there a choice of venue?

Australia

Patent infringement actions are primarily heard by the Federal Court of Australia (Federal Court). While State and Territory Supreme Courts also have jurisdiction to hear patent infringement matters, infringement proceedings are typically brought in the Federal Court because there are numerous judges with patent (and other IP) expertise and technical qualifications.

Belgium

Patent infringement proceedings may be brought in the Brussels Enterprise Courts (French or Dutch speaking), which courts have exclusive competence on patent matters. There is no choice of venue.

China

Specialised IP Courts in Beijing, Shanghai, Guangzhou and Hainan and specialised IP tribunals established within designated local intermediate courts have jurisdiction over invention and utility model patent disputes. With respect to design patents, in addition to the above courts, low level courts, i.e. district courts specifically designated by the Supreme People's Court would also have jurisdiction over design patent disputes. Specifically, for patent infringement disputes, the above IP courts/tribunals will assume jurisdiction if it sits in (a) the place where the infringement took place or the place affected by the infringement; or (b) the domicile of the defendant.

So, a plaintiff could choose to file an infringement action in the place where the alleged infringer manufactures, uses, sells, offers for sale or imports the infringing products. Alternatively, they could choose to file in the domicile of defendant(s).

Czech Republic

Patent infringement actions must be started at the Municipal Court in Prague. There is no choice of venue.

Finland

Patent infringement actions should be brought before the Market Court which has exclusive jurisdiction in such cases, except for certain situations that fall under the jurisdiction of the Unified Patent Court.

France

Civil actions and claims relating to patents shall be brought exclusively before the Court of Paris ("*Tribunal judiciaire de Paris*" at first instance and "*Cour d'appel de Paris*" on appeal).

This is an exclusive jurisdiction of the Paris court, meaning there is no choice of venue. In the case of patents and supplementary protection certificates, the President of the Paris Judicial Court also has exclusive jurisdiction to carry out an infringement seizure anywhere on French territory.

Germany

Regional Courts

Patent infringement actions in Germany are initiated in Regional Courts (German: "*Landgericht*"). In order to maintain a specialized judiciary, the legislator selected 12 Regional Courts, in which patent litigation chambers were established. These have exclusive jurisdiction for patent disputes. Patent litigation chambers currently exist at the Regional Courts of Munich I, Nuremberg-Fürth, Mannheim, Frankfurt, Saarbrücken, Erfurt, Leipzig, Magdeburg, Düsseldorf, Braunschweig, Berlin and Hamburg. Out of these, Munich, Düsseldorf, Mannheim and Hamburg are most regularly seized.

Choice of Venue

In addition to the Defendant's place of business, the place of jurisdiction for the tort is of practical importance in patent infringement cases. It is given at any place where a patent infringement has been committed (e.g. where the attacked embodiment has been offered or put on the market). Since this is often the case throughout the territory of Germany, an infringement action can be brought in the forum of choice.

Hong Kong

A patent infringement action can be commenced in the Court of First Instance (“**CFI**”) of the High Court of Hong Kong in the Intellectual Property Specialist List (the “**IP List**”).

The IP List was established on 6 May 2019. Practice Direction 22.1 (Intellectual Property List) provides that CFI has the discretion to transfer the matter to the IP List or remove it from the IP List (in which case the matter would be heard by a CFI judge not on the IP List), whether upon a party's application or on its own motion. If both parties consent, any party may apply to have the case transferred to or removed from the IP List by a letter signed by both parties with grounds in support and addressed to the judge in charge of the IP List.

Hungary

On first instance, the Metropolitan Court of Budapest has exclusive jurisdiction for patent infringement actions. There is no choice of venue.

Ireland

The High Court of Ireland has jurisdiction to hear infringement actions commenced under the Patents Act 1992 (as amended). Patent infringement proceedings are generally dealt with by the commercial division of the High Court, known as the Commercial Court.

The Intellectual Property Office of Ireland (“**IPOI**”) has no jurisdiction to hear patent infringement actions. Applications for revocation of a patent can be brought to the High Court or the Controller of Intellectual Property (Controller).

Under Order 63A of the Rules of the Superior Courts (as amended) “**RSC**”, intellectual property (IP) proceedings which include proceedings instituted under the Patents Act 1992 may be assigned to the Intellectual Property & Technology List, a specialist sub-division of the Commercial Court. Generally, in matters before the Commercial Court the value of the claim should exceed €1,000,000; however, there is no such threshold for IP proceedings.

It is preferable that patent infringement actions are entered into the IP & Technology List in the Commercial Court which benefits from efficient case management procedures, specialised judiciary, and a faster track to trial. In the alternative, the High Court can result in stagnated proceedings and much higher costs overall.

Actions for infringement of a short-term patent (which last for a maximum of 10 years) may be brought in the High Court or Circuit Court which normally has a monetary jurisdiction of up to €75,000 regardless of the value of the claim.

The Irish Government announced its intention to set up a local division of the Unified Patent Court (“**UPC**”). However, although Ireland signed the UPC agreement in 2013, it must hold a referendum to amend the Irish constitution and ratify the UPC. A referendum was due to take place on 7 June 2024, but this has been deferred and no alternative date has been confirmed by the Irish Government.

Italy

Infringement proceedings must be brought before one of the 22 “Specialised Divisions in Company Matters” as these have exclusive jurisdiction over all intellectual property cases sitting in the main Italian Courts.

Infringement actions can be initiated before the Specialised Division of the Court in either, the district where the defendant has its registered office/domicile, or the district where the unlawful act occurred (so called “*forum commissi delicti*”).

Netherlands

Patent infringement proceedings are heard by specialised courts, namely the District Court of The Hague (first instance) and Court of Appeal of The Hague (second instance). The District Court of The Hague has exclusive jurisdictions to hear inter alia claims for PIs, invalidity, DNIs and entitlement.

Poland

As of 1 July 2020, the Regional Court in Warsaw is exclusively competent in the first instance in all patent cases, utility models, software, and technical know-how related infringement and/or entitlement matters, except invalidation matters which must be brought before the Polish Patent Office (“PPO”). There is no choice of venue.

Singapore

Patent infringement actions can only be started in the General Division of the High Court of Singapore. There is no choice of venue.

Slovakia

Patent infringement actions are handled by the District Court in Banská Bystrica. There is no choice of venue.

Spain

Patent infringement actions may be started in either the domicile of the defendant, or the place where the infringement occurs.

The following courts have jurisdiction:

- Barcelona Commercial Courts No. 1, 4 and 5.
- Madrid Commercial Courts No. 6, 7, 8, 9,10, 11 and 13.
- Valencia Commercial Court No. 2 and 4.
- Bilbao Commercial Court No. 2.
- Granada Commercial Court No. 1 and 2.
- La Coruña Commercial Courts No. 1.
- Las Palmas Commercial Court No. 1.

If the defendant is not located in Spain or if the infringement takes place across the whole country, the claimant can choose any of these cities. If there are several courts in the same city, the specific court will be randomly assigned.

Sweden

Patent infringement actions must be started at the Patent and Market Court (PMC) in Stockholm. There is no choice of venue.

United Kingdom

Patent infringement proceedings may be brought in the Patents Court or the Intellectual Property Enterprise Court (“IPEC”). The IPEC is intended primarily for smaller or simpler cases, where the total legal costs recoverable by a successful party are capped at £60,000 for the final determination of liability, and at £30,000 for enquiries as to damages or accounts of profits. There is a limit of £500,000 on the financial remedies available. Infringement claims may also be brought in the UK Intellectual Property Office (“UKIPO”), but injunctions are not an available remedy there.

UPC

The UPC is a single court. It has exclusive jurisdiction over infringement and validity disputes for unitary patents and European patents (non-opted-out during a transitional period running until 1 June, 2030, possibly extended to 2037). It will also have exclusive jurisdiction over SPCs (Supplementary Protection Certificates) obtained for products protected by a European patent (with or without unitary effect).

Choice of Venue

During the transitional period, the UPC and national courts will share jurisdiction over infringement and validity issues relating to non-opted-out European Patents. A claimant will therefore be able to choose between the jurisdiction of the UPC or that of a national court.

Within the UPC's jurisdiction, the applicant may choose a local, regional or central division (located in Paris, Milan and Munich) subject to various rules. This choice will depend on the very specific case and should be analysed carefully to determine the best forum if different divisions may have competence. Generally, infringement cases will begin in a local or regional division, whereas revocation cases will begin in a central division.

2. Are the judges' specialists? Do they have technical backgrounds?

Australia

The Federal Court has an Intellectual Property National Practice Area with a specific sub-area for Patents & Associated Statutes. There are 16 judges allocated to the Patents & Associated Statutes sub-area that hear patent matters and have extensive patent experience.

In the Federal Court there are some judges who have specific technical backgrounds.

Belgium

Within the Brussels Enterprise Court and Appeal Court, there are specific chambers which deal with intellectual property (including patent) matters. The Court is either composed of a single judge or a panel of three judges.

With such centralisation comes an increasing level of specialism, but our judges usually do not have a technical background.

China

Most of the judges who will hear IP cases have no technical background. However, the IP courts/tribunals can appoint technical investigation officers to assist the judge panel on adjudicating complicated technical issues.

The technical investigation officers can conduct investigations, and attend evidence preservation and assessment with respect to the technical issues of the case. In the hearing of a patent infringement case, a technical investigation officer could sit next to the judge panel and could also raise questions on technical issues to the parties attending the hearing.

Czech Republic

Judges in patent infringement cases are specialised in intellectual property law in general (excluding copyright). Normally, they do not have technical background.

Finland

Generally, in patent infringement proceedings before the Market Court, the court is composed of three judges with legal background and one Market Court Engineer who has a postgraduate degree in technical sciences and expertise in patent matters.

If the matter does not require technical expertise, the court also has quorum consisting of three legally trained judges. Market Court judges are subject to additional qualification requirements, meaning that they need to have knowledge of the matters falling within the Market Court's jurisdiction. Also, a maximum of two expert members may be involved if the nature of the case so requires.

Some exceptions to the composition of the court apply based on the nature and complexity of the case.

France

At the Court of Paris, several judges (1st instance and appeal court) are dedicated to IP litigations but they have no technical background.

Germany

Germany has a bifurcated system. This means that infringement issues are dealt with by the Regional Court, while validity will be handled by a different panel (either before the EPO or the national instances). German

nullity actions are brought before a special court, the Federal Patent Court (first instance). In nullity actions, the panels (Senates) consist of two legal judges and three technical judges with formal technical training.

The Regional Court judges handling infringement proceedings are specialized in cases relating to patent infringement and have gained significant experience in infringement issues concerning different technical issues. However, they usually do not have a technical background.

Hong Kong

Yes, there are judges with technical backgrounds designated to hear IP proceedings from time to time.

Hungary

In the main infringement proceedings, the Metropolitan Court of Budapest sits in a panel consisting of three professional judges, two of whom have a technical university degree or equivalent qualification.

Ireland

Irish judges are generally assigned to lists which align with their experience and background. Judges assigned to the IP and Technology List have experience in the area. Notably judges can also call a specialist assessor to assist them when necessary.

Italy

Judges do not have technical backgrounds which is why they almost always appoint a Court Technical Expert (“CTE”), i.e., a patent attorney skilled in the field, who is requested to draft a report on the validity and/or infringement of the patent at issue. Judges generally tend to rely on this report, though they are not bound by it.

However, as they belong to a Specialised Division, these judges are generally skilled in dealing with patent matters.

Netherlands

There are specialised patent judges in the District Court of The Hague and the Court of Appeal of The Hague. Several of the full-time and part-time judges have technical backgrounds.

Poland

The judges dealing with patent infringement cases (in the civil court) do not have technical backgrounds and are not technical specialists. Thus, in most patent infringement cases the court appoints a court expert (or a scientific institute) to assist with the assessment of technical arguments and relies heavily on the opinion of such appointed expert. Private expert opinions are also commonly used, but they cannot replace a court’s expert’s opinion.

In validity proceedings, two members of adjudicating panels of the PPO (composed of three persons) have technical backgrounds in the relevant field.

Singapore

Intellectual Property cases in the General Division of the High Court will generally be heard by judges with a specialisation in IP disputes.

The judges generally do not have technical backgrounds.

Slovakia

Given the special competence of the District Court in Banská Bystrica with respect to patent claims, there is a small group of judges who deal with patent matters although they are not fully specialized. The judges do not generally have technical background.

Spain

The judges have a specialisation in intellectual property as well as in other commercial matters.

The judges do not have technical backgrounds.

Sweden

Yes, there are specialist judges at the Patent and Market Court. The panel typically comprises two judges and two technical members (Ch. 4, § 1 of Act (2016:188) on the Patent and Market Court). If needed, the panel can include an additional judge or an additional technical member. If no technical expertise is required, the panel may comprise only of judges.

United Kingdom

In the Patents Court, there are designated judges and deputy judges who have scientific backgrounds. The judge in the IPEC also has a technical background. There are specialist patent judges in the Court of Appeal but currently there is no specialist in the Supreme Court.

UPC

First and second instance judges are exclusively specialised in patents and most were experienced in patent litigation from their national courts prior to appointment to the UPC. Technical judges must have technical expertise and a university degree in their field. Many are former patent attorneys.

A pool of judges has been set up, comprising both legally and technically qualified judges.

In a revocation action/counterclaim or declaration of non-infringement, the judges' panel (1st instance) includes one technical judge having skills in the technical field concerned. The allocation of a technical judge may be requested by a party or at the initiative of the judges' panel.

The Court of Appeal is composed of a panel of five judges including two technical judges.

3. How long does it take from starting proceedings to trial?

Australia

The aim of the Federal Court is to bring cases to trial within 12-18 months of commencement.

Belgium

There are different types of patent proceedings in Belgium with varying timelines;

- *Ex parte* preliminary relief: a matter of days
- *Inter partes* preliminary injunctions: +/- 3 months
- Proceedings on the merits:
 - Cease and desist actions: 4 -12 months
 - Actions also allowing damages claims 12-15 months

China

In simple cases, the aim of the Courts is to bring a case to trial within 6 to 12 months of the date the complaint was filed. For complicated cases it could take years, especially in circumstances where a defendant challenges the service or the jurisdiction issues, and/or initiates invalidation against the patent-in- suit.

Czech Republic

Patent infringement cases take approximately 12 – 24 months in the first instance. There may be more oral hearings during that time. The first hearing usually takes place after several months up to one year from the start of the proceedings. The duration varies depending on the workload of the judges, complexity of the case and activity of the parties. Involvement of expert witnesses may generally delay the proceedings.

Finland

The Market Court is bound by obligation to process cases within a reasonable time and without undue delay. Apart from some exceptional situations, the cases are dealt in the order they are brought to the Market Court.

In 2023, the average length of proceedings in the Market Court in IPR matters was around 6 months. However, it is not unusual for a complex patent matter to last over a year.

France

The Judicial Court of Paris usually brings cases to trial within about 2 years of commencement of proceedings.

Germany

The duration of infringement proceedings varies depending on the forum and the workload of the judges. Generally, infringement courts aim to set the hearing 12-15 months after initiating an action.

Hong Kong

Before a case goes to trial, it has to will go through court procedures including request for admissions, interrogatories, discovery, case management summons, case management conference, exchange of witness statements, filing of expert reports, and pre-trial review (for more complex cases). The court aims to try all cases in the IP List within 18 months of filing.

In certain cases, it is possible for the court to order a speedy trial or issue directions in relation to the timely conduct of the proceedings.

Hungary

The duration of patent infringement proceedings is typically 2-3 years at the first instance. The time will vary depending on the complexity of the case and the strategy of the parties.

The defendant in a patent infringement action may file a counterclaim for revocation before the court hearing the infringement case. In this case, the court shall hear the patent infringement case as a matter of priority.

If the defendant in the patent infringement action certifies that it has brought an action for revocation for the same patent before the Hungarian Intellectual Property Office (“**HIPO**”) prior to commencement of the main infringement proceedings, the proceedings for patent infringement *shall* be stayed until a final and binding decision has been issued in the separate revocation proceedings. However, if a bifurcated revocation action has been filed at the HIPO after the commencement of the main infringement proceedings, the court has the discretion to stay the latter proceedings until a final decision on the validity of the patent has been rendered in the bifurcated revocation proceedings.

If an infringement action is brought against a European patent validated in Hungary and an opposition against the European patent is pending before the EPO, the main infringement proceedings shall be stayed only *in especially justified cases*.

If the main infringement proceedings are stayed then this might delay the final judgment by an additional 2-3 years.

Ireland

In the IP and Technology List, the expected time from starting proceedings to trial is 12 to 18 months. However, in urgent cases, such as when an injunction application has been refused on the basis that the proceedings are concluded expeditiously, the trial may take place in less than one year. It can take longer for proceedings to reach trial if extensive discovery is required or there are other interlocutory disputes.

Italy

Infringement proceedings on the merits generally take around 2 to 3 years to reach the first instance judgment, but the timing also depends on the Court and the appointed Judge.

Netherlands

There are two procedural regimes for patent cases: the accelerated regime and the regular regime.

The aim of the accelerated regime is to have a hearing within one year, by setting fixed deadlines and fixing the hearing date at the outset of the proceedings. However, with a large influx of cases at the moment this period is more likely to fall between 12 and 18 months.

The regular regime has no fixed deadlines, and hence the time to a hearing date varies between cases. Furthermore, a hearing date is set in principle only after the written phase has closed. A final hearing may usually be expected to be between 12 and 24 months from commencement of proceedings.

Poland

The duration of patent infringement proceedings is typically 2-3 years in the first instance. The time will vary depending on the complexity of the case and the activity of the parties to the proceedings.

Infringement proceedings can start in two ways – either by submitting a pre-trial preliminary injunction request or going straight for the statement of claims.

Typically, 3-6 months after a statement of defence is filed, the court will schedule a hearing (or a closed session in preliminary injunction proceedings). Further rounds of submissions, hearings and evidentiary motions are scheduled by a court if needed (which is usually the case).

Singapore

On average it takes around 2-3 years for a case to reach trial.

Slovakia

It may take from a few months to a year from the submission of the claim to the first hearing. However, it is rather uncommon in Slovakia that the court will decide on the merits already at the first hearing. Based on our experience, it usually takes from one to two years for the first instance court to deliver its decision. In appellate proceedings, the overall duration of the proceedings usually reaches three or more years. Slovak law does not prescribe any time limits for the final decision.

Spain

On average it takes around 12 to 18 months for a case to reach trial.

Sweden

There is usually a preparatory hearing within 3-5 months of the summons. The trial may take place within 18 months of the summons, but it sometimes takes substantially longer.

United Kingdom

The aim of the Patents Court and the IPEC is to bring cases to trial within 12 months of commencement, however, due to the large number of cases in the lists it is, at present, often taking longer.

UPC

The Court has set itself a target duration of 12 to 14 months from the opening of the case to the first instance hearing (and the same duration in the case of an appeal) and this is being achieved so far.

4. Can a party be compelled to disclose documents before or during the proceedings?

Australia

There are several ways to compel a party to disclose documents.

If a party believes that it may have a claim or the right to obtain relief, but it does not have sufficient information to decide whether to bring proceedings, it can seek preliminary discovery of documents from the opposing party.

Once proceedings have begun, a party can still seek discovery of documents from the other party by making an application with the court, on the basis that discovery will facilitate the just resolution of the proceeding as quickly, inexpensively and efficiently as possible. However, the parties do not have a guaranteed right to discovery. The Court will not approve expansive or unqualified requests. If the Court orders discovery, the parties have a continuing obligation to make discovery.

Parties can also use ‘Notices to Produce’ to compel the other party to produce a document or thing, within its “control” (i.e., possession, custody or power).

Belgium

There is no discovery or disclosure obligation before or after commencing proceedings. Both parties are in principle required to prove the allegations that they put forward.

However, Belgian law does allow the courts to compel a party to disclose relevant documents during the proceedings (article 877 Judicial Code) or even before the proceedings (evidence of infringement may have to be disclosed during so-called *saisie contrefaçon* proceedings).

China

Unlike most common law systems, there is no discovery system. However, a party may seek an evidence preservation order from the court by showing that the evidence to be preserved will otherwise be lost or difficult to obtain in the future.

Particularly, where documentary evidence is under the control of the counterparty, one could request the court to order the other party to produce that piece of evidence.

If the court grants the application and the other party refuses production without justified reasons, the court could draw adverse inferences.

Czech Republic

Czech law does not recognise disclosure/ discovery procedure as it is known in common law jurisdictions. According to Czech law, the court may however order any person to provide a document necessary for the proceedings. In addition, the patent owner may request information about distribution networks and amount and price of the infringing goods or services. It is also possible (but not common) to request seizure of evidence samples before the proceedings on the merits are started.

Finland

Yes. The court may compel any party, including persons not directly involved in the trial, to produce such documents that may have evidentiary relevance. The party making a document production request shall describe and specify the documents to be produced in a detailed manner, and overly broad or unspecified requests (so-called fishing expeditions) are likely to be rejected. Generally, trade secrets do not need to be disclosed unless important reasons so require.

France

France has implemented the so called “IPR Enforcement Directive” n°2004/48/EC including the right of information. The court may order, upon request from the claimant, that information on the origin and distribution networks of the goods or services which are alleged to infringe be provided by the defendant, and/or any other person found in possession of the alleged infringing goods, using the alleged infringing services or providing services used in alleged infringing activities.

The right of information is independent from the infringement seizure – it is usually ordered as an additional measure to a seizure proving an infringement if not all the relevant information has been gathered during the seizure and may be ordered during the proceedings (on the merits or in interim proceedings). However, this right of information does not serve to prove the materiality of the infringement. The judges will consider the seriousness of the request and whether it is proportionate and respects confidentiality to order the communication of information.

The forced production of evidence may be ordered on a more general basis under the Code of civil proceedings. It follows directly from the general principle of the collaboration of the parties in the determination of the truth. However, the burden of proof is quite high to order force production of evidence.

Germany

The German Code of Civil Procedure contains possibilities for the Court to order the disclosure of documents that are relevant for the proceedings. However, this is rather seldom and not as extensive or common as for example in the USA or in the UK. In particular, the Court will have to determine whether the disclosure is proportionate and weigh up the relevant interests (i.e. trade secrets). Note that there are also provisions in German law to keep information confidential.

Hong Kong

In patent infringement cases, the scope and timing of discovery are determined at the hearing of the case management summons. Mutual discovery of documents without a court order under Order 24 rule 1 of the Rules of High Court (Cap. 4A) does not apply to patent infringement cases. Generally, a defendant’s obligation to give discovery is confined to the issues raised in the particulars of the infringement.

Parties may apply for pre-action disclosure of documents by originating summons, supported by an affidavit specifying the documents in respect of which the order is sought. The person against whom the order is sought shall be made defendant to the summons. Upon application, CFI would only order disclosure of documents if it is of opinion that the order is necessary either for fairly disposing the cause or matter or for saving costs.

After the commencement of proceedings and upon application by either party, CFI could also order a person who is not a party to the proceedings to disclose documents if that person is likely to have or have had the documents in his possession, custody or power.

Hungary

Where, in the course of patent infringement proceedings, one of the parties has already produced reasonably available evidence, the court *may*, at the request of the party producing the evidence, require the other party to present the documents and other exhibits in his possession.

The Civil Procedure Code contains provisions on *evidentiary predicament*. The three alternative conditions for relying on this are as follows: [The plaintiff renders it probable that] (i) the defendant controls all data which is considered indispensable for its motion for the presentment of evidence and proves that it has taken appropriate measures to obtain such data, (ii) evidencing of factual claims is beyond the plaintiff’s means, while the opposing party can be expected to refute the facts alleged, or (iii) the reasons for the plaintiff’s failure to produce evidence are attributable to the defendant. In each case, the defendant can put forward contrary arguments in which case the evidentiary predicament would not be successful. The practical implication of an evidentiary predicament situation is that the court may recognise factual claims asserted by the plaintiff as true if it has no doubt as to their authenticity.

Preliminary taking of evidence *shall* also be admissible before instituting proceedings for patent infringement if the patentee has demonstrated the fact or danger of patent infringement probable to a reasonable extent.

Ireland

Yes. A party can be compelled to disclose documents before and during the proceedings.

1. Duty to preserve.

In the first instance, where litigation is contemplated or ongoing, each party has an obligation to identify and preserve documents that may be relevant to the issues in the litigation.

2. Norwich Pharmacal Order

It is well settled in Ireland that the Courts have jurisdiction to make an Order for Discovery in an action that has been instituted solely for the purpose of establishing the identity of the wrongdoer on the basis that it may be of considerable value towards the attainment of justice. The person seeking the Order must have a genuine intention of commencing proceedings and must establish clear proof of a wrongdoing. An Order of this nature may only be sought for the purpose of establishing the identities of the wrongdoers, rather than obtaining factual information concerning the commission of the wrong. This was confirmed by the Irish Supreme Court in *Megaleasing UK Limited v Barrett (No.2)* [1993] ILRM 497.

Prior to 2023 there was uncertainty as to the Irish position with respect to such orders. It remains the case in Ireland that this relief is exceptional. The Court of Appeal recently confirmed in *Blythe v. The Commissioner of An Garda Síochána* [2023] IECA 255 that the threshold to establish “very clear proof of the existence of a wrongdoing” was too high of a barrier. However, the Court of Appeal did not accept that the position in Ireland was the same as that in England and Wales (i.e. that the plaintiff must simply demonstrate a “good arguable case” against the alleged wrongdoer) and instead confirmed that the appropriate test in Ireland is whether the applicant can demonstrate that it has a “strong case” against the alleged wrongdoer i.e. has the applicant shown that it is likely to succeed at trial. The Court confirmed that the Norwich Pharmacal jurisdiction should be “strictly limited” to disclosure sought for the purpose of bringing a claim, as opposed to material required to prove that claim. In rare cases, such as fraud, a Norwich Pharmacal Order may be granted to gather additional information needed to plead the claim against prospective defendants.

3. Anton Piller Order

The Court may also grant Anton Piller Orders (preservation orders where documents and items may be seized by the moving party) where there is a serious risk that articles or documents vital to a party’s case may be imminently destroyed or otherwise disposed of.

4. Voluntary Discovery during the course of Proceedings

Discovery is a key component of the litigation process in Ireland. Either party to litigation is entitled to seek discovery of documents (the definition of which is broad and includes electronic information). The documents must be:

- In the possession, power or procurement of the other party;
- Relevant to the issues in the case; and
- Necessary for the fair disposal of the case or for the saving of costs.

Where discovery is to be sought, parties must write to each other first and seek to agree on the categories of documents to be discovered (this is referred to as voluntary discovery). If the categories cannot be agreed, the parties can apply to the court for an order requiring the other party to make discovery of the categories of documents sought. Discovery motions can be hard fought in IP cases.

Discovery must be made on affidavit and there is an ongoing obligation to discover documents falling within the scope of the discovery order (or the agreed discovery) that are in the power, possession or procurement of a party. All documents within the power, possession or procurement of a party must be listed and scheduled in the affidavit of discovery, including privileged documents. However, privileged documents need not be handed over to the other side.

As part of the discovery process, it is possible to request samples and/or to request an order for inspection. Where the interests of justice require, the inspection may be limited to solicitors, counsel, patent agents and/or independent experts. Interrogatories can also be useful to obtain admissions in respect of a defendant’s product or process. Leave is not required from the Court to serve interrogatories in the course of proceedings before the Commercial Court.

Discovery process for matters in the IP and Technology List

(i) Provision of Product or Process Description

Order 94 Rule 14 RSC provides that where a party to proceedings in the IP and Technology List notifies another party of its intention to deliver full particulars of the features of the product or process alleged to infringe or breach another party's rights and any necessary drawings or other illustrations, it will not be necessary for the notifying party to make discovery of documents relating to the features of the product or process which is the subject matter of the notification, unless the judge, for special reasons to be set out in the Court's order, otherwise orders.

(ii) Alleged Commercial Success

Where a patentee intends to rely upon the commercial success of a patent in proceedings concerned with its validity, unless the Court, for special reasons to be set out in the Court's order, otherwise orders, under the revised Rules it is unnecessary for the patentee to make discovery of categories of documents relating to the issue of commercial success, provided that the patentee has offered to deliver within a reasonable time a schedule containing specific information relating to the commercial success of the product in question.

Italy

Being a civil law country there is no disclosure system. However, a party may apply to the court where there is a specific document (confirming their claims) which is in the control of the adverse party. The Judge may order the adverse party to exhibit the document or to provide information about the document(s), subject to the protection of confidential information.

It follows that the patent proprietor could try to obtain information on the infringement that could be impossible to collect otherwise (including, to a certain extent, the accounting documents of the infringer to quantify the compensation for damages).

There is also a tool, "*descrizione*", which allows the patentee to collect evidence of the infringement which would be very difficult (or impossible) to collect during the proceedings on the merits.

This is a kind of judicial inspection, generally ordered *ex parte* by the Judge, who permits a bailiff and – if needed – a technical expert to access the premises of the alleged infringer and collect evidence of the suspected infringement. Under certain circumstances, they may collect evidence to prove the extent of infringement, such as samples of the infringing products, documents, and account information.

There is then a hearing where the parties discuss the confirmation/revocation/amendment of the order. The patentee must then file for main infringement proceedings to use the evidence gathered during the *descrizione*.

Netherlands

There is no general "disclosure" or "discovery" requirement.

However, the court may order a party to disclose specific documents or evidence upon a claim by the other party. This is possible both pre-action and during proceedings. The Court assesses the interests of the party involved in the disclosure and the relevance of the material. This may include an assessment on the likelihood of infringement based on the evidence reasonably available and the confidentiality of the material. Only specific documents can be sought.

The Court may also at any stage of the proceedings order any party to disclose certain documents or to clarify certain assertions.

Poland

A defendant can be compelled to disclose documents before and during the proceedings, whereas a plaintiff can be compelled to disclose documents only during the proceedings and only in exceptional cases.

There are several different legal measures which allow for obtaining evidence or documents for the purposes of the proceedings e.g., preservation of evidence and/or disclosure of evidence.

Under certain conditions a plaintiff may request preservation of evidence (including by obtaining evidence from the defendant or third parties using subpoenas) prior to the commencement of or during the trial, when there is a threat that obtaining, or access to the evidence may become impossible or too difficult at a later stage.

The plaintiff is required to substantiate its claims, so when there is no other option to obtain certain evidence, or it is impossible or excessively difficult to present, or prove some facts or when there is a risk of destruction of evidence, the court will likely accept preservation of evidence requests.

The plaintiff may request access to different types of information or documents, e.g. on the origin and distribution networks, shipment details or bank, financial or commercial documents, or other document necessary for the purpose of proving facts.

The defendant will only have to disclose information/documents, if it is specifically obliged to do so by the court (if evidence collection measures are requested by the plaintiff and then accepted by the court).

Singapore

A party can be compelled to disclose documents before or during the proceedings.

Before proceedings, the court may order pre-action discovery against a party on the basis that the documents are necessary to allow the would-be claimant to identify the proper party to sue or to ascertain if he has a cause of action.

During proceedings, parties to the action are generally under an obligation to disclose all documents which are relevant and necessary for determination of the issues at trial.

Spain

There are pre-trial ex parte proceedings. The patentee can request the inspection of the premises of the potential infringer and an independent expert is appointed who will issue a report. If the expert considers that there is a patent infringement, the Report will be delivered to the patentee who has to file the infringement action in 20 working days.

A party can only be compelled to disclose specific documents that are clearly identified (for instance, agreements of the adverse party with third parties; documents of release of batches, etc.).

Sweden

Yes, both before and during the proceedings. If the patent holder shows it can reasonably be expected there is an infringement, the court can issue a decision (“infringement investigation”) to seize documentation from the infringer (Swedish Patent Act Ch. 9, Section 59a-h). It is also possible for a party to have the Court order information, under the Code of Judicial Procedure Ch. 38, section 4.

Slovakia

In general, the court may compel any person (including a party to the proceedings) to present evidence that is in the disposal of such person, if the court finds it necessary to establish the state of facts. However, such evidence must be specified beforehand, meaning that the requesting party must have knowledge of the evidence and that it is at the disposal of a particular person. Also, there are limited means of enforcement if the evidence is not submitted. In any case, Slovak law does not recognize disclosure/discovery as in common law jurisdictions.

United Kingdom

The current disclosure scheme in operation in the Patents Court (which was first introduced in January 2019 as a pilot, but is now a permanent part of the Civil Procedure Rules) requires Initial Disclosure of key/limited documents which are relied on by the disclosing party and are necessary for other parties to understand the case. These must be given with the statements of case.

Before the Case Management Conference, the parties are required to discuss “Extended Disclosure” and jointly complete a Disclosure Review Document setting out the issues, if any, for disclosure and the scope of the searching to be done in relation to each issue, using Models A to E. The court will be proactive in directing which is the appropriate Model and need not accept without question the Model proposed by the parties.

This scheme does not operate in relation to IPEC proceedings. Instead, disclosure is dealt with at the Case Management Conference on an issue-by-issue basis in accordance with the IPEC’s costs-benefit analysis.

Pre-action disclosure is also possible, but is not common.

UPC

A party may apply for an order to produce specific evidence from the opposing party or a third party both before and during the proceedings. It will have to provide sufficient evidence to support its claim.

The Rules of Procedure (RoP) contain a special provision (in the context of the determination of damages and compensation) where the Court may require a party to give access to its books (“Request to Lay Open Books”).

The communication of documents/evidence is subject to the protection of confidential information.

5. How are arguments and evidence presented at the trial?

Australia

Parties can present their arguments by way of written submissions and oral submissions.

Any affidavit evidence that is relied on by a party will be formally ‘read’ at the hearing, and the person that gave the affidavit will then usually be required for cross-examination.

Belgium

Parties exchange written briefs and supporting exhibits in successive rounds before an oral hearing is held where the parties are then able to verbally present their case. Witness hearings are possible but rare.

China

A Court may arrange a separate evidence exchange hearing before the substantive trial. During the evidence exchange hearing, the evidence would be cross-examined by the other side on the grounds of authenticity, relevance, and admissibility.

In the substantive trial hearing, both parties normally present their arguments and evidence through opening statements, evidence examination, debate, and closing statements.

It is also a common practice for a Court to require parties to provide post-trial closing statements within one or two weeks after the trial hearing. Through this submission the parties can address the issues raised by the Court or the other side during the trial hearing.

Czech Republic

Arguments and evidence are normally presented together with written submissions of the parties before the first oral hearing. At the hearing, the parties discuss the case and previously submitted evidence. It is also possible to hear witnesses and/or experts.

Finland

All arguments and evidence are presented orally during the trial phase. This means that the parties should give their opening and closing remarks orally and present the main points of their written evidence orally as well. Necessary technical or similar details may be quoted orally from the written materials, but otherwise the parties should refrain from reading lengthy quotations from written materials.

Usually, a trial at the Market Court consists of each party’s opening remarks, presentation and commentary of written evidence, hearing of witnesses and possible party-appointed experts, and finally of the parties’ closing arguments. After the closing arguments, each party is expected to comment upon the other party’s claim for legal costs at the trial.

France

Arguments and evidence are presented by way of written submissions up to the oral hearing. At the oral hearing, the parties will present their claims and means of defence, including law, facts and arguments before the court. The claimant speaks first, then the defendant. The judges may ask the parties questions on specific aspects of the claim.

Germany

Most factual evidence has already been introduced by the time of the hearing through prior written submissions. The oral hearing basically serves to clarify open questions for the court. Thus, the presiding judge often introduces the panel’s view of the case, indicating the critical issues that shall be discussed in the oral hearing.

Parties can submit their own party expert opinions. It is possible, though not common, to hear party experts at the hearing.

The Court can also decide to appoint a neutral Court expert who shall issue an expert opinion. They can then be ordered to explain their expert opinion in an oral hearing and be questioned by the Court and the parties.

Hong Kong

At trial, the parties must be represented by counsels (or solicitor advocates), who will present the arguments and evidence to the court on behalf of the parties. All claims are proved or disproved through witnesses and documentary evidence. The scope of evidence to be adduced and the timetable for the filing of evidence are determined at the hearing of a case management summons.

Except with the leave of the judge hearing any action or other proceeding relating to a patent, no evidence shall be admissible in proof of any alleged infringement not raised in the particulars of infringements.

Expert evidence is vital in patent litigation cases. Expert evidence may be adduced with the leave from the court under O.38 r.36 of Cap. 4A to provide opinions on technical issues, save for those permitted to be given by affidavit. Experts are required to make a declaration of duty to the court. The court will usually give directions on how the expert report is to be prepared, and whether by single or joint experts.

Hungary

In the main infringement proceedings, arguments and evidence must be presented in writing. Usually, both parties have the opportunity to submit two pieces of written submissions (complaint, defence, rejoinder, adjudication). After the exchange of written submissions, the court holds a preparatory oral hearing in which the scope of the proceedings is discussed. Once the scope has been defined, the court may close the preparatory phase and proceed to the phase on the merits at the same hearing. The second phase is intended for the evaluation of evidence and handing down a decision. A hearing usually lasts 2-4 hours. If there is a need for further hearings, then the next hearing is usually scheduled within 3-4 months. It is also possible to request the court to obtain expert opinion from a judiciary expert or to admit submission of an opinion from a private expert. If the expert opinion is unclear or contradictory, then the court may summon the expert and ask questions. The parties can also suggest questions to be asked, but there is no cross examination.

Ireland

In Ireland, legal argument is centred on oral evidence and is adversarial in nature. The Court will also direct the parties to provide written legal submissions.

A variety of evidence may be submitted to the Court including:

1. Documentary Evidence

Documentary evidence is a commonly used form of evidence. A party who wishes to rely on a document may be required to “prove” the document by oral evidence. However, generally parties consent to the documents being admitted into evidence without the need for formal proof.

2. Witness Evidence

Witness evidence is normally provided as oral evidence and is subject to cross-examination. Deponents of affidavits in interlocutory and summary applications can be cross-examined with leave of the court.

- *Affidavit Evidence*: in certain circumstances (e.g. interlocutory motions), evidence is given on affidavit.

The opposing party can apply for the deponent of the affidavit to appear before the court for cross examination.

- *Witness Statement*: when a witness is due to provide oral evidence at trial, they are usually required to provide a witness statement in advance containing a precis of the oral evidence which they will give at trial.

- *Expert Evidence*: independent experts play a crucial role in patent proceedings in Ireland. They provide an expert report or expert witness statement before the hearing. Further, experts are invariably

required to give oral evidence and are subject to cross-examination. While experts are instructed by a paying party, they must remain independent and have an overriding duty to the court. The expert must adopt the attributes of the person skilled in the art.

Italy

Patent proceedings are mainly constituted by written pleadings and different hearings, rather than one trial.

The arguments and evidence are presented within precise deadlines provided both by the governing law and the Judges on the case.

Netherlands

Parties present their arguments and evidence by way of written submissions which are filed before the oral hearing.

At the oral hearing, each party has a fixed time to make oral submissions (usually around one and a half hours for initial submissions and then a few minutes for rebuttal submissions). The Court may ask questions to the parties and optionally to the experts present at the hearing.

Recently, it is also possible for the Court to convene short witness hearings at the first oral hearing. Other witnesses are usually heard only after the first decision of the Court, if the Court finds that further evidence is necessary following the detailed statements of the parties.

Poland

In general, both parties are obliged to present all their arguments and to submit evidentiary motions upfront in the statement of claims, or the response to it respectively. The court may consider evidentiary motions submitted at a later stage only in exceptional cases if the party proves that it was not possible to submit them at the earlier stage, or if the need to submit them could have not been reasonably foreseen.

A preparatory hearing may be ordered by the court before the trial, but this measure is relatively new in Polish law and is still quite uncommon. Instead of a preparatory hearing, the court usually schedules the first ordinary oral hearing for the parties to present their arguments, usually followed by more oral hearings before a judgment is then issued.

However, trials are primarily conducted in written form and the written pleadings of the parties are of great importance, whereas the hearings, witness testimonies, cross-examination of court experts, etc. have a more supplementary role.

Singapore

Factual witnesses are required to submit affidavits containing their evidence, while any expert witnesses are required to submit expert reports, prior to trial. Both factual and expert witnesses may also be required to appear at the trial to give evidence under cross examination.

Factual witnesses are typically examined in turn. If there is more than one expert witness for any issue, it is becoming more common all such expert witnesses to be examined together in a caucus.

Trial is typically mainly for the purpose of evidence taking and while an opportunity may be given to make oral submissions, this is usually kept to a minimum. At the end of trial, the parties will be given time to prepare their closing submissions taking into account the evidence led at trial. There may also be an opportunity to make reply submissions. The court will then make its decision.

Slovakia

All relevant arguments and evidence should be presented to the court as soon as possible (typically in the first written submission). New evidence may be proposed during the oral hearing, up to when the court closes the so-called “evidencing phase” of the proceedings. It is common to refer to written submission and filed evidence. Oral argument is fairly limited and the courts are not in the habit of going into much detail during the hearing.

Spain

The trial begins with the cross examination of experts or witnesses (if there are any). Then after the cross examinations the parties present their final pleadings.

Sweden

A large part of the presentation of arguments and evidence will be in writing. The Court is normally provided with a set of physical files containing evidence, prepared by both parties’ counsel. All arguments and evidence will however be presented at the oral hearing too.

United Kingdom

Parties present their arguments by way of oral submissions by their advocates. Experts and witnesses of fact are called to briefly confirm their written evidence after which they are submitted to be cross-examined. Re-examination of the oral evidence given in cross-examination is allowed afterwards.

In the IPEC, the court may determine the claim without a trial if all parties consent. If there is a trial, the Enterprise Judge will determine the amount of time allocated to each party and for cross-examination of any of the witnesses and experts.

UPC

The procedure (at first instance and on appeal) is initially written. There is then an interim procedure where the judge-rapporteur makes all necessary preparations for the final hearing. (This can include requests for the parties to provide further clarification on specific points; answer specific questions; produce evidence; and lodge specific documents.) Finally, the parties are invited to a final stage, which is oral: they will develop the main elements of the case (witnesses and experts may also be heard under the supervision of the President). This final oral hearing is followed by the decision.

6. How long does the trial generally last and how long is it before a judgment is made available? Are judgments publicly available?

Australia

Trials for patent infringement may last anywhere between 5-7 days. If there is a cross-claim for invalidity, such matters can run anywhere between 10 and 15 days.

A judgment can usually be expected some 6 to 12 months after the conclusion of the trial. Judgments are typically published on the Federal Court website within 24 hours of them being delivered.

Belgium

Oral hearings are short. Usually there are one or two days of hearings (180 minutes per hearing).

In principle, judgments on the merits of the case are to be rendered within one month's time, but in practice, courts tend to postpone this term at least once before rendering their judgment. In principle, judgments should be made available but in practice this proves more difficult as there is no public database.

China

Depending on the complexity of the case, a Court may schedule more than one trial hearing for a case, and those hearings are usually listed for one day each time. It could take a court several months from the date of hearing to render a judgment.

Since 2013, China has been taking efforts to improve judicial transparency by requiring courts to publish judgments on an open-access database established by the Supreme People's Court ("SPC") but note that judgments uploaded to the SPC database are mostly judgments that have become final and binding.

Judgments that involve national secrets, trade secrets, or individual privacy normally would not be disclosed to the public, although in practice we have seen that sometimes the court would publish judgments that have the confidential or privacy information redacted.

Czech Republic

An oral hearing typically lasts a few hours. Although the court should aim to decide after the first hearing, in complex cases, there are often more oral hearings several weeks or months apart. The decision is announced after the final hearing. The written judgement should be delivered to the parties within 30 days after announcement of the decision, the deadline can be however extended up to 90 days.

Court decisions are always announced publicly but not all decisions in patent infringement cases are available online. A court decision can be requested based on the Freedom of Information Act (No. 106/1999 Coll., as amended).

Finland

This depends heavily on the number of witnesses and experts to be heard, as well as on the amount of written evidence. If there are only a few persons to be heard at the trial and a limited amount of written evidence, the trial may only last a day. In more complex cases, it may last a few days, but trials lasting more than a few days are exceptional.

In principle, judgments of the Market Court should be issued within 30 days from the end of the main hearing. In practice, however, it usually takes a few months before the judgments are made.

The Market Court publishes summaries of judgments and decisions at their website, paying attention to privacy of the parties by e.g. redacting their names. Furthermore, anyone can access the judgments in their entirety by contacting the court. However, certain parts of the judgment may be deemed confidential, in which case they won't be made available to the public.

France

The oral hearings generally last 1 to 3 hours. The judges will deliberate separately after the oral hearing but would not render their decision at the end of the oral hearing.

The judgments are generally communicated to the parties 1 to 3 months from the oral hearing.

The judgments are made publicly available, but the court does not publish them. Judgments are typically available on private dedicated web platforms.

Germany

An infringement hearing typically lasts a few hours, though it can take an entire day in complex cases.

The court's aim is to deliver their decision within 2-4 weeks after the hearing. In some cases, the decision grounds are already available then.

Judgments are not generally publicly available; however, some decisions are made available in anonymized form. Typically, judgments are made available on private dedicated web platforms.

Hong Kong

The duration of a trial depends on the complexity of the case, ranging from a few days to more than a month. Judgments may be handed down in a few days or a few months' time.

Judgments are generally available on the Hong Kong Judiciary website.

Hungary

The oral hearing typically lasts a few hours. If the main phase is closed, then the decision is announced at the (final) hearing. The written judgment shall be issued in writing within 30 days of the announcement of the decision and is delivered to the parties within 3 days. The court has the discretion to postpone the announcement of the judgment for 30 days, but this is rarely used in patent infringement proceedings.

As a general rule, court hearings are open to the public, so judgments are also announced publicly. Written judgments are published after anonymisation.

Ireland

Hearings for interlocutory injunctions generally last anywhere between 3 days and 2 weeks. Interlocutory injunction proceedings are normally heard, and decisions handed down, within six to twelve weeks of being issued. This can be expedited depending upon the circumstances and at the discretion of the Court.

The main action lasts anywhere between 2-6 weeks depending upon the amount of evidence at play. The expected timeline for the main infringement action would be 18 months. This will also depend upon preliminary matters like any motions for discovery, interrogatories etc. which can considerably delay the time to trial.

This timeline can lengthen considerably if the main infringement is appealed to the Court of Appeal. The current timeline for a case being heard by the Court of Appeal is between 9 – 18 months (depending on the complexity of the appeal). Further, it may take an additional 12 months for the Court of Appeal to issue its decision.

Irish Superior Court judgments are publicly [available](#).

Italy

Judgments are generally issued 2-3 months after the filing of the final pleadings.

The judgments are made available to the public.

Netherlands

The oral hearing (trial) usually takes about half a day.

At the end of the hearing, the Court indicates a date for the judgment (usually within 6 – 18 weeks from the hearing). However, it is possible that the actual decision is postponed.

Judgments are publicly available, but some confidential information may be redacted. Judgments are usually proactively published shortly after the decision, but otherwise they may be obtained by a request to the Court.

Poland

There is no recognisable ‘trial’ as you would see in some other jurisdictions, such as the UK or the US. Instead, oral hearings are scheduled for not more than one day, and each hearing typically only lasts a few hours. Further hearings (around 3-4 per case) are then scheduled with several weeks or months in between them.

A judgment can be announced right after the last hearing and closing of the trial, or (as is more often the case) within 14 days of the last hearing, which is approximately 2-3 years after the commencement of the infringement action.

The judgments are not publicly available, but some are published in generally available legal databases or the court’s online case law search engine with all applicable confidential information redacted. In addition, it is also possible to obtain access to judgments via a freedom of information request.

Singapore

The length of the trial will depend on the number of witnesses, and they may span multiple days or even weeks.

On average, a written judgment is typically made available within 6 months to a year, depending on the complexity of the matter and the judge’s workload.

Written judgments are publicly available unless subject to a sealing order.

Slovakia

According to Slovak law, the court decision on the merits should be rendered ideally at or after the very first oral hearing. The oral hearing generally lasts from 30 minutes to a few hours. It is however quite common that the court postpones the oral hearing (e. g. when a party to a dispute is exceptionally awarded extra time to submit further evidence).

It would take approximately 30- 60 days from the last oral hearing before the decision is made available in writing. The decisions are publicly available [here](#).

Spain

A trial usually takes anywhere between one to three days. It can take three to four months for judgment to be made available.

The judgments are not always made publicly available, but sometimes the judgments of the first instance are published in the repertoires or in CENDOJ (public data base of the General Council of Judges).

Sweden

The trial normally takes 3-5 days, and the case can roughly be tried within 18 months of proceedings starting but it can take substantially longer.

The judgment is available immediately upon issue, but it must be ordered from the Court.

Certain parts of the case file may be confidential, but the judgments are publicly available.

United Kingdom

On average, a trial of a single patent in the Patents Court will take four to five days. Trials in the IPEC are limited to two days.

A written judgment is generally handed down by the judge within four to eight weeks after the end of the trial, although it can be longer, at which time it becomes public and may be freely disclosed, subject to any confidentiality order. Judgments with parts redacted may be issued in certain circumstances.

The Royal Courts of Justice currently provide copies of most judgments to the National Archives for publication.

UPC

Oral hearings are expected to last one day. In exceptional cases, judges may render their decision at the end of the hearing and provide their reasons later. Judgments should be provided to the parties no later than six weeks after the hearing.

Hearings are public (with some exceptions, in particular to protect confidentiality) and should be video/audio recorded.

The UPC publishes its judgments in a online register accessible to the public.

7. Can a defence of patent invalidity be raised? Are infringement and validity issues heard together?

Australia

A party that has been sued for patent infringement can raise a defence of invalidity, and cross-claim for invalidity.

Infringement and validity issues are normally heard together.

Belgium

Patent invalidity is a common defence in patent cases.

Questions of validity and infringement are handled by the same Court in the same proceedings and are usually resolved within one judgment.

China

Patent invalidity can be raised as a defence (normally called the prior art defence) in patent infringement cases.

There is a bifurcated system, in which patent infringements are adjudicated by civil courts, while patent validity is heard by the Patent Re-examination and Invalidity Department of China National Intellectual Property Administration (“*CNIPA*”).

Czech Republic

It is possible to challenge validity of a patent, however, due to the bifurcated system in the Czech Republic, the invalidity matters are heard by the Industrial Property Office (or, if relevant, the EPO), not the infringement court.

Finland

A defence of patent invalidity may be raised and would typically be heard at the same time as the original claim.

France

Invalidity of a patent may be requested as a defence to an infringement action.

There is no bifurcated system, which means that the infringement and invalidity claims are heard together unless there are exceptional circumstances requiring separate actions.

Germany

Since Germany has a bifurcated system, infringement courts cannot decide on validity issues of the patent in-suit. Instead, these issues are heard by other panels (i.e. EPO or Federal Patent Court).

However, in main proceedings, validity issues can be raised as a reason for staying the proceedings until a decision of the technical panel regarding the validity action of the concerned patent is made.

Also, in preliminary injunction proceedings, the Court will consider validity issues in the context of the ground for an injunction.

Hong Kong

Yes, the validity of a patent may be put in issue by way of defence or counterclaim in proceedings for infringement of the patent. The Defendant will typically bring an invalidity claim in the counterclaim. The court will address both infringement and invalidity in the same action. The grounds on which the validity of a patent may be put in issue are the grounds on which the patent may be revoked under section 91(1) of the Patents Ordinance (Cap. 514). The Registrar of Patents will only deal with revocation in very limited circumstances.

Hungary

For decades, Hungary had a rigid bifurcated system, where validity issues could only be discussed in separate revocation proceedings, the first instance of which was the HIPO. In main infringement proceedings, both the Metropolitan Court at first instance and the Metropolitan Appeal Court at second instance, refused to consider invalidity arguments. The peculiarity of the Hungarian hard bifurcation system was, and to a certain extent still is, that the courts and judges reviewing the HIPO's decision on validity are the same who deal with infringement proceedings based on the same patent.

As of 2022, a defendant may elect to submit a counterclaim for invalidity in the main infringement proceedings. In this case, the proceedings will be expedited, and the court will appoint an expert to provide an assessment on validity. While the Patent Act is silent on this, the bylaws of the HIPO provide that the HIPO is entitled to provide such an assessment.

Ireland

Invalidity may be raised as a defence to infringement proceedings or in stand-alone revocation proceedings. Issues of infringement (if any) and validity are heard during the same proceedings.

A patent may be revoked on the grounds that:

1. the subject-matter of the patent is not patentable under the Patents Act;
2. the specification of the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
3. the matter disclosed in the specification of the patent extends beyond that disclosed in the application as filed;
4. the protection conferred by the patent has been extended by an amendment which should not have been allowed; or
5. the registered proprietor of the patent is not entitled to the patent (by reason of the fact that he is, for example, neither the inventor nor his employer) (section 58, Patents Act).

Additionally, a short-term patent can be revoked if the claims of the patent specification are not supported by the description (section 67, Patents Act).

The burden of proof rests with the person bringing the application for revocation. The applicant must prove their case on the balance of probabilities, as decided by a judge sitting alone without a jury in the High Court or by the Controller.

Further, the Controller can revoke a patent on their own initiative (subject to providing the proprietor with an opportunity to make observations and amend the specification) for inventions that already form part of the state of the art (section 60, Patents Act). A patent application with an earlier filing or priority date, although published after the filing or priority date of the patent being considered, can be taken into account in determining novelty (sections 11(3) and 27(1), Patents Act).

The Controller can also revoke a patent in cases of double patenting where both a national patent and a European patent (designating Ireland and therefore dealt with under the Patents Act) have been granted and one must be elected by the proprietor.

Italy

There is not a bifurcated system. If the patentee starts main infringement proceedings, the defendant may file counterclaims for patent invalidity within the same proceedings.

In other words, infringement and invalidity can be heard within the same proceedings, at the same time. It is very common for alleged infringers to defend by counterclaiming invalidity of the patent.

Netherlands

Invalidity is commonly raised as a defence and/or counterclaim.

Validity and infringement are dealt with in the same proceedings and are not bifurcated.

Poland

As there is a bifurcated system, in general a defence of patent invalidity cannot be raised within the patent infringement proceedings. However, defendants often raise such argument for the additional strategic effect of trying to undermine a substantiation of the patentee's claims in PI proceedings, or to convince the court to stay the main infringement proceedings. In addition, as of 1 July 2023, when examining the legal interest in obtaining preliminary measures, the court will need to take into account the likelihood that the asserted patent will be invalidated. Thus, the parties will be obliged to inform the court on any past or pending nullity proceedings.

Singapore

A defence of patent invalidity can be raised.

Patent infringement and validity issues are typically heard together in the same trial, and the judgment will deal with both issues.

Slovakia

A defence of patent invalidity may be raised only at the Industrial Property Office of the Slovak Republic ("IPO"). In such case, infringement and validity issues would be heard and decided on separately. In theory, Slovak law enables the court to make its own assessment concerning the validity of the patent which might be different from the assessment of the IPO. Pending invalidity proceedings typically have no effect on the infringement dispute. On the other hand, if there is already a decision issued by the IPO declaring invalidity of a patent, the court must take this fact into account.

Spain

A defence of patent invalidity can be raised. Infringement and validity issues are heard together.

Sweden

A defence of patent invalidity may be raised and infringement and validity issues are typically heard together.

United Kingdom

Invalidity can be raised as a defence to an infringement action and is normally accompanied by a counterclaim for revocation, supported by grounds of invalidity.

Validity and infringement are dealt with in the same proceedings and are not bifurcated.

UPC

A patent invalidity (revocation) action may be filed as a stand-alone action or as a counterclaim in a claim for infringement.

In the case of a counterclaim, the local or regional divisions in which the infringement claim was begun have three options: they can (1) rule on the counterclaim together, with the allocation of a technical judge; (2) bifurcation is possible, in which case the counterclaim will be referred to the Central Division, and the local/regional division may (or not) stay the proceedings; (3) they can refer the case entirely to the Central Division.

8. Are infringement proceedings stayed pending resolution of validity in the national patent office (or, if relevant, the EPO) or another court?

Australia

Re-examination of the patent in the Patent Office cannot occur while proceedings are pending in the Court.

Belgium

The fact that opposition proceedings before the EPO are pending, or that invalidity proceedings are pending before another court, forms no bar to raising an invalidity defence before the Belgian courts.

No opposition can be raised before the Belgian patent office, so this cannot trigger any stay of infringement proceedings.

When there are EPO opposition proceedings pending, there is no obligation for the Belgian courts to suspend the national proceedings, even if the opposition relates to the same patent. Our courts have a wide margin of appreciation, taking into account all circumstances, including the status of the pending EPO proceedings.

In principle claims regarding the validity of a national (branch of a) patent are a matter of exclusive jurisdiction for the European court in the country where the patent has been applied for. When claims relating to such patent are pending before a different court nonetheless, it is up to the later seized court that has jurisdiction to rule on whether it will stay the proceedings for reason of *lis pendens*.

China

If a defendant intends to challenge the validity of a patent and use it as a basis to support its application to stay the infringement proceedings in court, the invalidation petition must be filed before the CNIPA within the defence period. The defence period is 15 days for a domestic defendant and 30 days for a foreign defendant, calculated from the date of service of the complaint.

The court overseeing the infringement proceedings would have the discretion to decide whether to grant a stay pending the invalidation. There is a stronger presumption towards a stay in utility model and design patent cases.

Czech Republic

The court may (but does not have to) stay and often does stay the infringement proceedings while the invalidity proceedings are pending. The court may also wait for resolution of the invalidity proceedings without formally staying the proceedings.

Finland

Typically, the infringement proceedings are not stayed pending the outcome of any invalidity proceedings (national or EPO). However, the Market Court may, for a special reason, stay the proceedings of an infringement claim until the counterclaim on validity or EPO proceedings have been finally decided. Such exceptional/special situation might be at hand if, for example, the invalidity claim is likely to be successful or if the infringement suit would require exceptional amount of testimonial evidence.

France

Two situations should be differentiated:

- A court seized of an action for infringement of a French patent covering the same invention as a European patent that was opted-out from the UPC and that was applied for by the same inventor, with the same priority date shall stay proceedings until the date on which the French patent ceases to have effect (at the end of the EPO opposition period or at the end of

the EPO opposition if any), or until the date on which the European patent application is refused, withdrawn or deemed to be withdrawn, or the European patent revoked. This stay is mandatory by law.

- In other cases (typically a claim for infringement involving a French patent or a European patent under opposition) the proceedings are stayed at the court's discretion, depending on whether a stay is in the interests of a good administration of justice.

Germany

A stay of infringement proceedings pending a decision in parallel validity proceedings is possible. This is a discretionary decision for the infringement courts. The Court will consider the chances of success of the validity attack. In principle, a stay will only be ordered if the court concludes that it is highly probable that the patent will be revoked in the parallel validity proceedings.

Hong Kong

A party may, based on forum *non conveniens*, seek to stay proceedings if there is another action pending in another court or an overseas court that has jurisdiction. However, the grant of such stay is unlikely as patent rights in Hong Kong are territorial and are independent of any foreign patents. The decision of foreign courts regarding the validity of foreign equivalent patents or patent infringement will not be binding on Hong Kong courts.

There is one Hong Kong case that has dealt with an application for a stay pending resolution of validity in EPO: *Dyson Technology Ltd & Anor v German Pool Group Ltd & Anor* [2016] HKCU 2995. Dyson applied for a stay of Hong Kong proceeding pending EPO decision. The court refused a stay, principally on the ground that a stay is not justified because of the long duration of pending action.

The Registrar of Patents has the power to conduct a substantive examination on a patent application. For short-term patents, if the patent has not been or is being subjected to a substantive examination, the court may stay the proceedings pending the outcome of the examination by the Registrar.

Hungary

Under the old regime, main infringement proceedings were always stayed if a revocation action was brought at the HIPO. Under the new semi-bifurcated system, which is applicable since 2022, this has become a choice of the defendant. If a preliminary injunction is granted, the defendant has the option of submitting a counterclaim for invalidity in the main infringement proceedings. If the defendant could avoid a preliminary injunction, then it makes sense to file a separate revocation action at the HIPO, as in this case the court has a discretion to stay the main infringement proceedings. If a defendant has commenced such a revocation action prior to the commencement of a main action, then the main action must be suspended until a final and binding decision is taken in the revocation proceedings.

If the action is brought for infringement of a European patent validated in Hungary and an opposition against the European patent is pending before the EPO, the main infringement proceedings *may* be suspended at the discretion of the court in especially justified cases.

Ireland

The High Court found that the default position in Ireland remains that a stay on revocation proceedings in the Irish courts should be granted where there are proceedings concerning the patent in suit pending before the EPO (*Condensed Aminodihydrothiazine Derivative & The Patents Act 1992* [2018] IEHC 467).

Notably, the Court also found that there may be good reasons why the default position should not be adopted. Conclusively, the High Court found that the balance of justice lay in staying the trial pending the determination of the EPO proceedings but refusing to stay the progress of the Irish proceedings up to the point of readiness for trial. Accordingly, a stay was refused with respect to discovery, the carrying out of experiments or the other interlocutory steps that would be required to be taken to put the proceedings in a state of readiness for trial.

Italy

In theory, a stay of the infringement proceedings pending EPO opposition/appeal procedure can be requested, but in practice the Courts very rarely grant it. There are a few decisions stating that the Judges have a discretionary power to stay the proceedings if they consider that there are good chances that the patent will be revoked or amended by the EPO.

According to the case law of the Supreme Court, infringement proceedings should instead be stayed if there are separate pending invalidity proceedings.

Netherlands

The Court has discretion to stay proceedings if opposition proceedings are pending or if other proceedings are pending that may be relevant for the outcome of the case (such as invalidity proceedings between other parties or entitlement proceedings).

Generally, the Courts are reluctant to stay proceedings pending EPO opposition proceedings unless the decision depends on the outcome of the EPO proceedings (for example with multiple auxiliary requests) or the EPO decision will be rendered in the near future. But in each case, this is up to the Court's discretion. The Courts also have the discretion to stay proceedings if UPC invalidity proceedings are pending concerning the same European patent.

Poland

Where the patent's validity is challenged before the PPO (or the EPO), the defendant can request a stay of the infringement proceedings, and courts sometimes do decide to stay the proceedings until the issue of validity is decided, but they are not bound by the defendant's request for a stay. In the event the invalidity action (or even first instance invalidation decision) is brought to the court's attention, e.g. from the 'defence pack' filed by the defendant, the court may consider the infringement claims not credible enough and dismiss the preliminary injunction request.

The courts sometimes appear to proceed slower (instead of granting a formal stay) when they know that invalidation proceedings are under way and there is a good chance the invalidation of the patent will release them from having to decide on the infringement case.

Singapore

Infringement proceedings will not be automatically stayed, but parties can apply to the Court for a stay of proceedings.

If the defendant had applied to the patent office for the patent to be revoked before the infringement action was started and then raises invalidity in defence and/or as a counterclaim, they can apply for the revocation proceedings before the IP Registry to be transferred to the Singapore High Court so that the issues are heard and determined in the same forum.

Slovakia

Infringement proceedings may be stayed until the IPO (or EPO) issues its decision on the validity of the patent and a party may actively file a motion for the court to do so. It is common practice in Slovakia for a court to not stay the proceedings and prefer to assess the issue of validity on its own. However, if the court does so and the IPO later issues a decision with a contradictory assessment of patent validity, that would allow an action for retrial.

Spain

Infringement proceedings will not be stayed pending the resolution of any separate validity issues.

Sweden

Infringement proceedings are not stayed as a general rule in this circumstance. A registered patent is considered valid until invalidated. The Court may decide to try the validity issue first, if that matter has been initiated in connection with the infringement matter, i.e. before the same Court. In that case, the Court will take a preliminary decision on the infringement matter and rule on invalidity.

A judgment to invalidate a patent will therefore contain a preliminary opinion on infringement, if these two issues are heard together.

United Kingdom

Whether proceedings are stayed is a matter of discretion for the court, depending on whether a stay is in the interests of justice. In *IPCom v HTC* [2013] EWCA Civ 1496, the Court of Appeal was of the view that a stay of the national proceedings pending the outcome of the EPO opposition should be the default option provided that there are no other factors to consider.

The issue of a stay does not arise in practice between the court and the UKIPO since any ongoing revocation proceedings before the UKIPO will normally be transferred to the court following the commencement of an infringement action. Further, a decision in relation to a corresponding patent in another country is not binding on the UK court and so an action in relation to such a patent is not a ground for a stay.

UPC

The Court may stay proceedings where it is seized of an action relating to a patent which is also the subject of opposition proceedings or limitation proceedings (including subsequent appeal proceedings) before the EPO or a national authority where a decision in such proceedings may be expected to be given rapidly. This is a discretionary decision of the Court.

9. Are preliminary injunctions available? If they are, can they be obtained *ex parte*? Is a bond necessary? Can a potential defendant file protective letters?

Australia

Preliminary injunctions are available and can be obtained *ex parte* in urgent cases. In deciding whether to grant a preliminary injunction against an alleged infringer, the court will make these enquiries:

(i) Whether the patentee has a *prima facie* case (i.e. there is a probability that the patentee will succeed at the final hearing).

(ii) Whether the balance of convenience favours the granting of the injunction (this involves an assessment of the harm to the applicant and prejudice to the respondent in ordering the injunction).

(iii) Whether damages are likely to be an adequate remedy if an injunction is not granted.

A party does not need to give a bond, but it will need to give the 'usual undertaking as to damages' whereby it undertakes to submit to any order of the Court for the payment of compensation to any person affected by the operation of the injunction.

Protective letters cannot be filed with the Court to protect against *ex parte* injunctions.

Belgium

Preliminary injunctions are available and they are regularly granted.

They can be obtained *ex parte* but only in cases of extreme necessity (urgency). A bond may be imposed by the court, but that is not mandatory.

The Brussels Enterprise Court allows for protective letters to be filed, which are aimed at trying to prevent such relief to be granted on an *ex parte* basis. The legal basis is in the section relating to *ex parte* seizures.

China

Preliminary injunctions are available and can be obtained *ex parte* in emergencies (e.g. imminent or ongoing infringement of patent rights in time-sensitive situations).

A bond is necessary for a preliminary injunction application. The value of the bond must be sufficient to cover the damages the respondent could suffer for enforcing the preliminary injunction.

There is no concept of protective letters, but the defendant can request a reconsideration from the court within 5 days of receipt of the court order granting the preliminary injunction. Protective letters cannot be filed with the Court to protect against *ex parte* injunctions.

Czech Republic

Yes, preliminary injunctions in patent infringement cases are available and are regularly granted.

The proceedings are always *ex parte*.

The claimant must pay a bond in the amount of CZK 50,000 (approximately € 2,000) but the amount can be increased by the court.

Protective letters are not officially recognised by Czech law and there is no register of protective letters. Potential defendants however sometimes file protective letters anyway as the possibility to defend is otherwise limited due to the *ex parte* nature of the proceedings.

Finland

Yes, preliminary injunctions (PI) are available at the Market Court.

The Market Court may grant a PI upon the claimant's application. Such an application shall be processed urgently by the Market Court. Normally, the opposing party must be provided with an opportunity to be heard, but the Market Court may also order the PI *ex parte*, if the purpose of the PI would be compromised by allowing the opposing party a chance to be heard.

If the Market Court does grant the PI, the applicant must within one month file a main action on infringement (unless it has been filed already with the PI application), and also deposit a bond (normally a bank guarantee) as a security against the possible damages caused by the PI which may later be found groundless.

Protective letters are not officially recognised in the Finnish legislation (apart from the UPC protective letters).

France

Preliminary injunctions (PIs) are available for patents.

In theory, PIs can be obtained *ex parte* but such *ex parte* proceedings are exceptional. In practice PIs are almost always *inter partes* proceedings, where the defendant can file written submissions/exhibits and to be represented by their lawyers at a quite comprehensive oral hearing.

Overall, PIs are granted in cases where there is a likelihood of success of the infringement action whilst considering the validity of the patent (if raised as a defence by the alleged infringer). The PI gives rise to a personal assessment by the court of the actual need for a PI. The court would consider whether a PI would be proportionate (weighing up pros/cons of an injunction regarding both the claimant's and the defendant's interests). In contrast to some other countries, the delay in requesting the PI after knowledge of the infringement acts and urgency are not specific requirements for granting a PI.

A bond is not necessary, but it may be ordered by the court.

Protective letters are not provided for by French law.

Germany

Preliminary injunctions are available and can be granted if the necessary conditions are met. For this, the applicant must substantiate a claim for injunction and a ground for injunction.

- A claim for injunction basically requires that the applicant substantiates infringement of the concerned patent by the respondent.
- A ground for injunction basically requires urgency in terms of time and that a general weighing of interests of the applicant and the respondent is in favour of the applicant. In this regard, a core issue is whether the patent's validity is sufficiently secured. According to settled case law, this will usually only be assumed if the patent has already survived opposition or nullity proceedings in the first instance. However, there are various exceptions to this rule, e.g. in cases involving generic market entry.

Preliminary injunctions can also be ordered *ex parte*, though this is rather the exception. In particular, the German Federal Constitutional Court has set high requirements regarding the right to be heard.

If ordered, a preliminary injunction contains an injunction (e.g. no manufacturing, offering, distributing) in the territory of Germany. Said decision will have to be enforced by the Applicant. It is rather common (but not necessary) that a Court will order a bond for enforcing a preliminary injunction decision.

It is possible to file protective letters at a central court register valid for all German courts. These are in force for intervals of 6 months and can be renewed. The Applicant will only learn of the protective letter's existence upon filing a PI request.

Hong Kong

Interlocutory or preliminary injunctions are available to patent proprietors. It can be applied *either inter partes* (where both parties are present in the application hearing) or *ex parte* (where only the applicant is present). *Ex parte* applications would only be granted where the court is satisfied that there is extreme urgency and need for secrecy for an *ex parte* injunction to be granted. The applicant also bears the duty of full and frank disclosure. The court is able to grant an *ex parte* injunction order on the day of application.

The grant of an interlocutory injunction is a matter of discretion of the court. The applicant will need to satisfy the court that:

- there is a serious question to be tried, i.e. the claim is not frivolous or vexatious; and
- there is a balance of convenience, by comparing the risk of injustice caused by denying an interlocutory injunction with that caused by granting it. As recently held in *HKCOLO.net v HongKong Telecommunications (HKT) Ltd [2023] HKCU 157*, “it is not an inflexible rule that whenever a mandatory injunction is sought, the plaintiff must satisfy the court that there is a high degree of assurance that he shall succeed at the trial. It all depends on the circumstances”.

In all interlocutory injunction applications, save for very special circumstances, the court will require the applicant to give a cross-undertaking in damages for any loss suffered by reason of the injunction, if at the end it turns out that the injunction should not have been granted (*King Fung Vacuum Ltd v Toto Toys Ltd [2006] 2 HKLRD 785, [2006] HKCU 2163 (CA)*). In determining whether fortification of the cross undertaking in damages is required, the court will consider the likelihood of a significant loss arising from the injunction and whether the applicant will be able to make good the loss.

There is no procedure under Hong Kong law for potential defendants to file a protective letter to pre-empt an *ex parte* injunction application. However, the defendant may seek confirmation from the applicant that there is no infringement. Alternatively, the defendant can seek a declaration by the court that there is no infringement, or a declaration that the patent is invalid.

Hungary

Preliminary injunctions (“**PI**”) in patent infringement cases are available even prior to commencement of main infringement proceedings.

Preliminary injunctions can be ordered *ex parte*, but only in cases of extreme necessity (for example, urgency). To date, the Metropolitan Court has been reluctant to grant *ex parte* PIs in patent matters. The request for a PI is usually served on the defendant, who has 8 days to respond.

The Metropolitan Court rarely holds a hearing in PI proceedings. The PI decision is usually served on the parties within 2-3 weeks from the filing of the request for a PI. The first instance decision to grant a PI is enforceable regardless of an appeal. The appellate court's review procedure is similar, there are usually no hearings, and the written decision is made within 3-6 weeks.

The grant of the PI is usually subject to the provision of a security. The amount of the security is set on the basis of information provided by the defendant on the potential disadvantages caused by a PI.

Protective letters do not exist under Hungarian law.

Ireland

Preliminary injunctions (“**PI**”) are available from the Irish Court in patent litigation proceedings. Whether a preliminary injunction will be granted by the Irish Court tends to be highly fact sensitive.

In 2019 the Supreme Court decision of *Merck Sharpe & Dohme Corporation v Clonmel Health Care Limited* [2019] IESC 65 (“*Merck Sharpe & Dohme decision*”) reformulated the way in which the Irish courts apply the three-stage test set out in *American Cyanamid Company v Ethicon Limited* [1975] 1 AER 504 and adopted by the Irish courts in *Campus Oil v the Minister for Energy* [1983] IR 88. While the Courts will consider the three factors set out in these decisions, they will also evaluate the risk of injustice which may result in granting or refusing an injunction. While the third hurdle (adequacy of damages) remains an important consideration, it is no longer determinative. It will now be a factor the Court will consider when deciding whether or not the balance of convenience lies with granting the injunction.

Following the *Merck Sharpe & Dohme decision*, the Supreme Court set out eight steps that a court should follow in determining whether to grant an injunction. Distilled down, the key questions a court will consider are:

1. Whether there is a serious/fair issue to be tried; and
2. The balance of convenience.

With respect to the balance of convenience the decision outlined some of the factors that may be considered and weighed in the balance by a court in considering how matters are to be held most fairly pending a trial, and in recognising the possibility that there may be no trial. While the Supreme Court highlighted that the most important element in the balance of convenience assessment is, in most cases, the question of adequacy of damages it also commented that this should not be dispositive, and that weight should be given to other factors. These factors may include:

- presumptive validity of IP rights,
- a preference for preserving the status quo ante, and
- whether the alleged infringer could have “cleared the way” by way of invalidity proceedings.

The Court emphasised that failing to clear the way would not be decisive and recognised that clearing the way may pose some problems for a generic manufacturer. It was nonetheless a factor to be weighed in the balancing exercise.

Since then, there have been a number of PI decisions in Ireland which have applied the *Merck Sharp & Dohme decision* and have highlighted the importance of “clearing the path” for generic entrants.

In March 2023, the Court of Appeal ruled in *Biogen MA Inc. & Biogen International GMBH v Laboratorios Lesvi SL & Neuraxpharm Ireland Ltd.* [2023] IECA 71 that, when assessing clearing the path arguments in the balance of convenience, “*the threshold test is that the case for invalidity must be strong and/or that there have been successive determinations on the merits invalidating the right*” and only then “*it might weigh against the grant of an injunction*”.

In a more recent Court of Appeal decision, *Bristol-Myers Squibb Holdings Ireland Unlimited Company v Norton (Waterford) Limited T/A Teva Pharmaceuticals Ireland* [2023] IECA 173, the principle of clearing the path was given further consideration. In this case, Teva had issued a revocation action on the grounds of invalidity and lack of priority. The purpose of the revocation action was to clear the path. When notice was given during the proceedings of intention to launch, BMS sought an interlocutory injunction restraining entry. The High Court granted a PI, which was appealed. In its judgment in June 2023, the Court of Appeal was firmly of the view that if a generic producer seeks to clear the path, it must do so until “*all arguable objections from the patentee have been eliminated*”, including the conclusion of any appeal. Furthermore, in response to the argument that a generic entrant should get credit for the steps that it had taken to attempt to clear the path, the court dismissed this argument, commenting that no cogent argument was advanced as to what weight, if any, should be given to a generic manufacturer that has tried to clear the path but has ultimately not yet done so. Teva sought leave to appeal that decision to the Supreme Court but was refused.

Since then and in the same case, the High Court at first instance again had to consider an application from BMS to continue the injunction already granted against Teva pending an appeal to the Court of Appeal with respect to the substantive decision which held that the patent in issue was invalid (*Bristol-Myers Squibb Holdings Ireland v Norton (Waterford) Limited t/a Teva Pharmaceuticals Ireland* [2024] IEHC 91). According to the High Court the decision as to the invalidity of patent rendered the previous granted injunction expired. Barrett J commented that “*for what it is worth, there appears to be no reported case in this jurisdiction in which a generic company succeeded in revocation proceedings but was then enjoined from launching its generic product pending appeal*”. In response to this and BMS’ submissions that the path is not cleared until all appeals have been resolved the Court considered this “*a deficient proposition*”. The Court held that while it is “*literally true*” no question could ever arise as to an injunction if the path was fully

cleared i.e. because if the path is fully cleared, that would mean that the patent in issue had been finally held by some appellate court to be invalid, and in that situation, no one could ever bring an application for an injunction. Accordingly, the Court held that “*while clearing the path is a factor, its limitations and its context need to be borne in mind, which is clear from Merck*”.

The applicant for a preliminary injunction will need to adduce affidavit evidence in support of the application. In Ireland, the granting of preliminary and permanent injunctions is subject to equitable principles and therefore the Court always has discretion whether to order an injunction.

It is not possible to file protective letters with the court to protect against *ex parte* applications.

Italy

Preliminary injunctions are available.

The patent owner can try to obtain a preliminary injunction (and seizure and recall) *ex parte*. However, in complex patents, most Courts are reluctant to grant *ex parte* preliminary injunctions and in almost all the cases, before taking any decision, they will summon both parties.

In granting precautionary measures (such as preliminary injunctions and seizures) the Judge may order the claimant to post a bond before implementing them, but this is very rare.

Protective letters are not available for potential defendants.

Netherlands

Preliminary injunctions are available if there is an “urgent interest” and is fact dependant. Urgent interest is generally deemed to be lacking if the patentee, after gaining knowledge of the infringement, fails to act in a sufficiently expedient manner without a good reason (negotiations on a settlement may be such a good reason). If the patentee lingers for too long, i.e. 2 years, urgent interest can be lost. Whether a preliminary injunction is granted depends upon a weighting of interest, combined with a preliminary substantive assessment of both the infringement and validity.

Ex parte injunctions are technically possible, but are extremely rare in patent matters (as opposed to counterfeit trademark infringement).

The Court may order a bond, but this is not customary. A bond may also be required for the legal costs of the proceedings, depending on the domicile of the claimant. If an injunction is later lifted (in appeal or proceedings on the merits), a party is generally liable for damages caused by enforcing a preliminary injunction. This strict liability regime was considered in line with art. 9(7) of the Enforcement Directive in the CJEU decision (C-473/22) in Mylan/Gilead of 11 January 2024.

Protective letters may be filed before the District Court of The Hague.

Poland

In the past, the majority of preliminary injunction proceedings were *ex parte*, however as of 1 July 2023, as a rule a court needs to hear the obliged party before granting a preliminary injunction so *inter partes* preliminary injunctions became a rule, unless an immediate decision is necessary, e.g. where the injunction is wholly subject to enforcement by a bailiff and surprise effect needs to be maintained or there is other exceptional urgency in which case an *ex parte* injunction can be granted.

In order to obtain the preliminary injunction, the plaintiff must show that the infringement is highly probable and to prove its legal interest in obtaining a PI.

Also as of 1 July 2023, when examining the legal interest the court will need to take into account the likelihood that the asserted patent will be invalidated. Thus, the parties will be obliged to inform the court on any past or pending nullity proceedings. Also, a requirement of urgency was introduced in preliminary

injunction proceedings. Based on it a preliminary injunction request will be dismissed by the court. In case the request is filed more than six months after the applicant became aware of the infringement.

A bond is not required and is very rare. Once the preliminary injunction is granted the defendant can make a bond application, which may be accepted by the court if the defendant is able to substantiate the nature and amount of the damages it may suffer as a result of an unduly granted PI, but, additionally, if it is able to show that the plaintiff will likely be unable to pay the damages if they were awarded.

Protective letters are not formally regulated in the Polish law, but do exist and are being used in IP matters. Due to their informal nature, their influence on the preliminary injunction proceedings is never certain as they might be omitted by the court, i.e. due to the timelapse between the defensive letter being filed and the commencement of the court action itself. Therefore, if the defendant expects a pre-trial preliminary injunction action in Poland, it often sets up informal monitoring of the relevant courts to try to learn in advance about a preliminary injunction request. If the defendant is successful in finding out about any such request, it may file a so-called 'defense pack', i.e. an informal letter containing arguments against the request (primarily based on non-infringement, but potentially also including invalidity arguments and arguments against legal interest of the plaintiff in obtaining a preliminary injunction), that may sometimes provoke doubts on the part of the court as to whether the claims are in fact credible and the patentee has a legal interest in obtaining a preliminary injunction.

Singapore

Preliminary injunctions are available and are granted if (i) there is a serious issue to be tried; that is the claim is not frivolous or vexatious, (ii) if the claimant subsequently succeeds in establishing a right to a permanent injunction, it would not be adequately compensated by an award of damages for the loss sustained in the meantime if a preliminary injunction is not awarded, and (iii) the "balance of convenience" favours an injunction. It can be obtained *ex parte* where there are sufficient reasons for this, such as in cases of urgency.

A bond is not usually required, although the claimant will be required to provide an undertaking as to any damages suffered by the defendant in the event that the preliminary injunction turns out to be wrongly granted.

There is no avenue for a defendant to file protective letters.

Slovakia

Yes, Slovak law allows for preliminary injunctions. Possible claims of preliminary injunctions include a ban on sale, import, offer, storage of goods by virtue of which a patent is being infringed, and a ban on transfer of registration of goods, e.g. of a pharmaceutical product.

Preliminary injunctions may be obtained *ex parte* and a bond is not generally a legal precondition. The court or the opposing party may, however, request that the claimant provides an adequate bond in money.

Protective letters are generally not explicitly recognised by Slovak law. Nonetheless, should a party consider that there is a threat of a preliminary injunction motion, the party can still file a protective letter to the court. The court is, however, not obliged to deal with it.

Spain

Preliminary injunctions are available and can be obtained *ex parte*.

The claimant has to offer a bond, the value of which is decided by the court.

A potential defendant can file protective letters, the existence and content of which is communicated to the patentee.

Sweden

Preliminary injunctions are available and can be obtained *ex parte* in certain circumstances. A bond is necessary for a preliminary injunction application.

Defendants are not able to file protective letters in this context.

United Kingdom

Preliminary injunctions are available and are granted if (i) there is a serious issue to be tried; that is to say there is an arguable case, (ii) the “balance of convenience” favours an injunction or, all things considered, is even, and (iii) the claimant gives a cross-undertaking to compensate the defendant in damages if the injunction is wrongly granted.

Preliminary injunctions are unusual in patent cases and are, in practice, restricted to pharmaceutical cases where a defendant proposes to introduce a first generic product and where the claimant can show that there will be irreparable damage because of irreversible price erosion.

Injunctions are only granted on an *ex parte* basis where the claimant can show that the matter is so urgent that the defendant may not be notified or where there is a real concern that the defendant may dispose of evidence. Protective letters are not available in the UK.

UPC

Provisional injunctions are available against an alleged infringer or against an intermediary whose services are used by the alleged infringer. The Court has the discretion to weigh up the interests of the parties and in particular to take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction. In such provisional measures, the Court could prohibit the continuation of the alleged infringement or make such continuation subject to the lodging of guarantees intended to protect the right holder.

According to the RoP, these measures can be obtained *ex parte*, in particular in cases where any delay could cause irreparable harm to the right holder.

The Court may order the applicant to provide adequate security in the event that the Court revokes the order for provisional measures. The Court shall do so in *ex parte* proceedings unless there are special circumstances.

The order shall be effective only after the security has been given to the defendant in accordance with the Court’s decision.

A potential (future) defendant may lodge before the Court a protective letter providing facts/evidence/arguments against a (potential) application for a provisional injunction. The protective letter shall not be publicly available on the register until it has been forwarded to the applicant (in case provisional measures are applied for). Should no application for provisional measures be filed, the protective letter will be removed from the register within six months from its reception (renewable by payment of extension fee(s)).

10. Are final injunctions available as of right? Is a bond necessary?

Australia

Final injunctions may be granted, as well as any other relief orders that the Court sees fit. Injunctions are discretionary and not available as of right.

A bond is not necessary.

Belgium

Final injunctions are available as of right. Whilst there are a few exceptions, the general rule is that once the courts have found an infringement of a valid patent, they must issue an injunction.

First instance judgments are immediately enforceable, even if an appeal is lodged. A bond is not necessary.

China

Although our Patent Law does not explicitly provide permanent injunction as an available remedy as of right, it is common to see the Courts exercise discretion to grant permanent injunctions if infringement is established.

Normally permanent injunction granted by the first instance court cannot be enforced pending the appeal in the second instance court. However, a patentee could consider filing a request for a temporary injunction under such circumstances and a bond would be required for such an application.

Czech Republic

Yes, final injunctions are available once a decision finding an infringement becomes final. A bond is not necessary. A bond is not necessary.

Finland

Final injunction is one of the remedies available for the patentee. The Market Court may grant a final injunction and in practice, this is the main remedy in case the Market Court finds that a patent has been infringed. In such case, no bond is needed.

France

The court will grant final injunctions if the claimant is successful in its infringement allegations, but this is a matter up to the court's discretion. The Court may order only a part of the requested injunctions if it sees fit.

The court will normally not order any bond.

Germany

An injunction can be lifted, e.g. via an objection (Widerspruch), appeal or in case of changed circumstances. However, it is possible to request a final declaration (German: "Abschlussklärung") from the Defendant, i.e. a declaration that the preliminary injunction is accepted as a legally binding principal title.

Hong Kong

Permanent injunctions are also available to successful plaintiffs in patent infringement proceedings. Same as an interlocutory injunction, the grant of a permanent injunction is within the court's discretion. When a final injunction is granted, the successful plaintiff is not required to provide an undertaking as to damages.

However, the defendant may ask for a stay of permanent injunction pending appeal to consider whether the successful plaintiff is prepared to give a cross-undertaking in damages should the appeal succeed.

Hungary

Final injunctions are available once the judgment has become final, i.e., if no appeal has been filed against the first instance judgment, or after the second instance judgment has been rendered. A bond is not necessary.

After the enforceable decision, there is a possibility to submit an extraordinary appeal to the Curia (former Supreme Court), but the filing of such a request alone does not affect the enforceability of the decision.

Ireland

In Ireland, a final or permanent injunction is a discretionary remedy which is decided by the Court at the final determination of the case (section 47(1), Patents Act). It must be demonstrated to the Court that there is some activity to be enjoined on an ongoing basis. Where infringement and a threatened continuation of such infringement to a material extent, has been established, then the proprietor will have a *prima facie* entitlement to a permanent injunction. However, as a general principle of Irish law, the Irish Courts may refuse to grant a final injunction if it is considered that an award of damages alone is a more appropriate remedy. This would be assessed on a case-by-case basis in accordance with the Court's underlying discretion to grant an injunction.

A bond is not necessary.

Italy

A final injunction is generally granted upon request of the patentee once the infringement is ascertained, usually along with a penalty due by the infringer in case of non-compliance (or delay in complying) with the injunctive relief. In granting the injunction, the Judge has also to take into account the principle of proportionality as well as the interest of third parties (including the public health interest).

A bond is not necessary and in practice is rarely granted.

Netherlands

Final injunctions are almost always available following a finding of infringement. An injunction will only be denied in exceptional cases. A decision may be enforced pending appeal, depending on the circumstances. In exceptional cases, the Court may declare the injunction as provisionally un-enforceable or to condition this upon placing a bond.

Poland

Final injunctions are available once the judgment becomes final, i.e. when no appeal is filed against the first instance judgment or after the second instance court's judgment is rendered.

A bond is not necessary. However, if the judgment of the second instance court is appealed by way of a cassation appeal, the second instance court can make enforcement of its judgment conditional upon a payment of a bond in case the defendant shows that the enforcement of the judgment would cause him irreparable harm.

Singapore

Final injunctions are not available as of right but are typically granted in patent infringement actions if there is any indication that infringement is likely to continue in the absence of an injunction.

A bond is not necessary.

Slovakia

Final injunctions are available and would be included in the statement of claim. During the proceedings, in general, the claimant must provide sufficient evidence that justifies the final injunction.

A bond is not necessary.

Spain

Final injunctions are available as of right and this is the normal consequence of infringement.

The infringement decision can be enforced without a bond.

Sweden

Final injunctions are available as a right and can be ordered and enforced without a bond.

United Kingdom

Final injunctions are almost always granted if the claimant is successful at trial but are a matter for the court's discretion, giving flexibility. Article 3(2) of the Enforcement Directive 2004/48/EC requires the court to refuse to grant an injunction where it would be "disproportionate" to grant one, but the burden to prove this is a heavy one. A bond is not necessary.

UPC

The Court may grant a permanent injunction upon finding an infringement of a patent. An injunction may also be granted against an intermediary whose services are being used by a third party to infringe a patent.

At the defendant's request, the Court may order the applicant to provide adequate security for the legal costs and other expenses incurred by the defendant.

11. What other remedies are usually ordered if a patentee is successful?

Australia

Available remedies that may be ordered include declarations of infringement, damages, or an account of profits, and additional damages (though additional damages are rarely ordered).

Belgium

Available remedies include orders of recall, destruction, confiscation of infringing goods (and items used in their production) and publication of (a summary of) the judgment.

In practice, recall and publication orders occur more frequently than any others.

China

Damages are the most commonly available remedy for patent infringement.

Czech Republic

Available remedies can include recall from the market and/or the destruction of the infringing products, penalty for any breach of judgment or delay in compliance, publication of the decision in newspapers and/or on the infringer's website, compensation for damages, and destruction of the infringing products.

Finland

Other remedies include (i) reasonable compensation for the unauthorised use of the patented invention (hypothetical license fees), (ii) compensation for damages proven to be suffered by the patentee (such as lost sales), (iii) compensation for reasonable legal fees and costs (Finland follows the loser pay principle when it comes to compensation of legal costs). In addition, the patentee may claim (iv) destruction, alteration or seizure of the infringing goods, but these are seldom claimed.

France

The remedies available include financial damages, the delivery up or destruction of infringing goods, recall from commercial channels, appropriate measures for the publication of the judgment, and/or an award of costs.

Germany

In an action on the merits, the Plaintiff can basically request the following remedies:

- Injunction
- Accounting and information
- Determination of obligation to pay damages
- Destruction
- Recall
- Publication of Judgment
- (Compensation claim in case of using a published patent application)

In PI proceedings, the following remedies can be ordered:

- Injunction
- In the case of an *obvious* infringement: information on origin and distribution chain of the attacked product
- Custody for securing the destruction claim

Hong Kong

By virtue of section 80(1) of Cap. 514, a proprietor of a patent (either a standard or a short-term patent) may also seek the following remedies in respect of any infringing act which falls within section 73 (direct use of invention) or section 74 (indirect use of invention) or section 75 (limitation of effect of patent):

- (1) an order for delivery or destruction of any products that infringed the patents;
- (2) an award of damages;
- (3) an account of the profits derived from the infringement; and
- (4) a declaration that the patent is valid and has been infringed by the defendant.

It should be noted that an award of damages and account of the profits shall not be awarded in respect of the same infringement.

Hungary

The following remedies may be requested: delivery up or destruction of infringing goods, recall from commercial channels, publication of the judgment, information on the identity of persons involved in infringement, recovery of unjust enrichment. Compensation of damages (in addition to unjust enrichment) can also be requested but this is subject to the general provisions of the Civil Code. The losing party also has to pay the legal costs to the winning party, but courts have a discretion to reduce the legal fees.

Ireland

Other remedies which may be ordered if a patentee is successful include:

- 1. Damages or an Account of Profits** – the plaintiff may elect for either damages or an account of the defendant’s profits (section 47(1), Patents Act). Generally, damages are awarded only to compensate the loss suffered due to the infringement. In assessing the appropriate “quantum” to be awarded, a Court will therefore seek to place the plaintiff in the same financial position as they would have been in had the infringement not taken place. Loss of profits will, naturally, be central to this determination. The Court may also look to the amount which would have been payable by the defendant as a reasonable royalty for the infringing use. Damages are not generally awarded on a punitive basis in infringement actions.
- 2. Orders for Delivery up or Destruction** – This remedy can only be ordered in respect of patented articles, or of any article in which they are inextricably comprised. The articles must be within the power or possession of the defendant. Infringing goods which have been delivered and sold to third parties will not be within the power or possession of the defendants.

Italy

Available remedies can include recall from the market and/or the destruction/ assignment to the patentee of the infringing products, penalty for any breach of judgment or delay in compliance, publication of the decision in newspapers and/or on the infringer’s website and compensation for damages.

Netherlands

Available remedies include damages (or account of profits), delivery up and/or destruction of infringing goods.

A choice between damages or an account of profits is available if there was wilful infringement or if the infringer could have reasonably known to infringe (there is no defence of a good faith invalidity belief). The infringer is ordered to provide accounts to calculate damages or profits.

Poland

Besides the permanent injunction, available remedies include obtaining an order for the account of unlawfully obtained profits, obtaining an order regarding the unlawful products or materials owned by the infringing party – especially through a withdrawal from the market, destruction, or awarding the products/materials to the plaintiff in lieu of a monetary remedy, an award of damages, and/or publication of the judgment.

Singapore

Other available remedies include damages or an account of profits, at the patentee's election, delivery up or destruction of the infringing goods, and/or a declaration that the patent is valid and has been infringed by the defendant.

Slovakia

Besides final injunctions, a patentee may be also awarded damages and reimbursement of its costs of the proceedings. Concerning the damages, both actual damages suffered, and loss of profits can be compensated. The claimant should calculate and substantiate the claimed amount of damages. Reimbursement of costs of proceedings depends on the ratio of success of the parties to the dispute; the amount is limited by law.

Spain

The available remedies include withdrawal, destruction of goods, communication to relevant authorities or bodies, and declaration of the obligation to compensate damages (deferred to enforcement).

Sweden

Available remedies include damages, the destruction of infringing goods, recall from commercial channels and the publication of notices.

United Kingdom

Available remedies include the delivery up or destruction of infringing goods, damages/an account of profits (calculated in separate proceedings), appropriate measures for the dissemination and publication of the judgment and an award of costs.

The court also has discretionary power to award declarations. Where validity is not in issue, the Patents Court has granted declarations of non-infringement in respect of the foreign counterparts of a UK European patent.

UPC

The Court may order, at the applicant's request, that appropriate measures be taken with regard to products found to be infringing a patent and, in appropriate cases, with regard to materials and implements principally used in the creation or manufacture of those products.

Possible remedies include:

- Financial damages/compensation
- Declaration of infringement
- Publication of the judgment
- Destruction of infringing products
- Recalling infringing products from the channels of commerce
- Information and rendering of accounts
- Award of legal costs

12. Would the tribunal consider granting cross-border relief?

Australia

The tribunal would not consider granting cross-border relief.

Belgium

Cross-border relief would be considered if the factual circumstances allow for it.

China

The tribunal would not consider granting cross-border relief.

Czech Republic

We are not aware of any decision of the Czech courts granting cross-border relief in patent infringement cases so far.

Finland

We are not aware of any cases where cross-border relief would've been granted by the Market Court.

France

Concerning infringement actions, the French supreme court ("*Cour de Cassation*") ruled (on June 29, 2022 - *Hutchinson (FR) vs Global Wheel*) that the French courts may have jurisdiction over acts of infringement committed outside the French territory where the infringement action involves a number of defendants, one of them being domiciled in France and the same product infringes at least the same national part of a European patent (Art. 8(1) EU regulation n°1215/2012 and following the CJEU decision C-616/10 - *Solvay vs Honeywell*) or, independently, in case the claimant is of French nationality where no other rule on territorial jurisdiction applies (Art. 14 French Civil code).

However, it would be contrary to EU Regulation n°1215/2012 and current case law to issue a cross-border relief on the validity of a patent. The French judges would decide on the validity of the FR national part of a European patent only, even raised as a defence to an infringement claim (CJEU decision C-4/03 - *Gat v LuK*).

Germany

If the international jurisdiction of the German court is given, infringement of a foreign patent could be asserted before a German Court. The principle of territoriality of patent law then requires that a German court applies the law of the state in which the patent is in force.

However, there is a considerable risk regarding jurisdiction if the applicable foreign law allows a defence of invalidity in the infringement proceedings. In this case, Article 24(4) of the Brussels Ia-Regulation provides for an exclusive jurisdiction of the Court of the granting member state. The exclusive jurisdiction has been interpreted broadly by the CJEU and covers all cases in which the validity of the IP right is challenged, irrespective of whether this is done by way of an action or by way of a plea (CJEU decision C-4/03 – *Gat/LuK*). Since it is common practice for the infringement defendant to contest the validity of the patent in a lawsuit, insofar as this is admissible, this means that cross-border proceedings in patent disputes are de facto excluded or depend solely on the defence of the defendant.

However, the exclusive jurisdiction of Article 24(4) of the Brussels Ia Regulation has no effect on the jurisdiction for preliminary measures (Article 35 of the Brussels Ia Regulation; cf. CJEU decision C-616/10 – *Solvay/Honeywell*).

Hong Kong

It is not a common practice for Hong Kong courts to grant cross-border or extra-territorial injunctions as patent rights are territorial and infringement in Hong Kong does not necessarily equate to infringement in other countries, except in limited circumstances where there is foreign infringement through the double actionability principles.

The court has the jurisdiction to grant an extra-territorial *Mareva* injunction to prevent the disposal of assets that are subject to the jurisdiction of the Hong Kong courts.

Hungary

We are not aware of any decision by the Hungarian courts granting cross-border relief in patent infringement cases.

Ireland

This tribunal is not applicable in Ireland.

Italy

The grant of cross-border relief is highly disputed, we are not aware of any recent decisions to grant such relief in patent cases.

Netherlands

Cross-border relief is available if the Dutch court has jurisdiction on the matter. This is at least the case if the defendant is domiciled in The Netherlands or if one of the defendants is domiciled in the Netherlands and the claims are sufficiently closely connected.

In the case where the validity of a foreign patent is in issue, the case on the merits needs to be stayed pending a final decision on the validity of the foreign patent. However, the Dutch court can still grant cross border relief on a provisional (preliminary) basis pending the outcome of the validity decision, and courts are generally prepared to grant such relief. The Court conducts a preliminary substantive assessment on the validity of the foreign patent (for example based on the evaluation of the validity of the Dutch equivalent of the patent) to ensure that an invalidity action against the foreign patent will likely not succeed.

Poland

No, the courts would not consider an application for cross-border relief.

Singapore

The courts can, but generally do not grant cross-border relief.

Slovakia

The court may, in theory, grant cross-border relief. Nevertheless, we are not aware of any decision of Slovak courts granting cross-border relief in patent infringement cases so far.

Spain

The courts would not consider granting cross-border relief.

Sweden

The tribunal will not consider granting cross-border relief. The right to a patent registered in Sweden covers amongst other things the manufacture, use, offer for sale, and import into Sweden. The territorial scope covered is Sweden.

United Kingdom

In most cases where validity is raised as a counterclaim, there can be no cross-border relief in relation to a European patent because the other countries designated have exclusive jurisdiction over patent validity. As mentioned in answer to the previous question, where validity was not in issue, the court has granted a cross-border declaration of non-infringement (pre-Brexit). (*Actavis Group HF v Eli Lilly and Company* [2012] EWHC 3316 (Pat)).

However, the Supreme Court held in *Unwired Planet v Huawei* [2020] UKSC 37 that the court can settle the terms of a Fair, Reasonable and Non-Discriminatory (FRAND) licence on a global basis where a UK patent is found to have been infringed.

UPC

Decisions of the Court shall cover, in the case of a European patent, the territory of those Contracting Member States for which the European patent has effect.

A European patent with unitary effect shall prevent any third party from infringing the patent throughout the territories of the participating Member States in which it has unitary effect, subject to applicable limitations.

Therefore, the UPC decisions are intrinsically cross-border between UPC members states.

The Brussels Regulation allows, under certain conditions, cross-border actions between the national courts of EU member states, non-members of the UPC and UPC members. But questions persist as to the relationship between national actions (of EU and non-EU members) and those of the UPC following the Recast Brussels Regulation, which led to the UPC being labelled as a “long-arm jurisdiction”.

13. Is there a right of appeal from a first instance judgment? How long between judgment at first instance and hearing the appeal?

Australia

There is a right to appeal from a first instance judgment - a party can appeal to the Full Court of the Federal Court of Australia.

A party should allow between 4 to 6 months for appeal to be heard (it will be heard during one of the designated sitting periods of the Full Court).

Belgium

A judgment may be appealed to the Appeals Court, located in Brussels. An appeal hearing will usually be scheduled within 15-24 months of lodging the appeal. The appeal deadline starts running from the date of service of the first instance judgment.

China

A judgment may be appealed to the second instance court. The appeal must be filed within 15 days upon receipt of the first instance judgment. For foreign parties, the time limit is 30 days.

After that, it would take several months for the appeal hearing to be scheduled.

Czech Republic

Yes, it is possible to appeal a first instance judgment to the High Court in Prague. The appellate proceedings usually take between 12 – 18 months.

Finland

Yes, but only to the Supreme Court and provided that the Supreme Court grants a leave to appeal. As leaves to appeal are granted in less than 10 % of all applications, it means that the judgment of the Market Court will most likely be final.

The average total length of the proceedings in the Supreme Court is 16-18 months, of which the processing of application for a leave to appeal takes approximately 4-6 months. If the Supreme Court rejects the leave to appeal, the judgement of the Market Court becomes automatically final.

France

It is possible to appeal against a negative decision of the first instance. The case is examined and retried by the court of appeal.

The time between the 1st instance judgment up to the end of the appeal proceedings is typically around 24 months depending on the complexity of the case.

Germany

The first instance judgment can be appealed. The deadline for filing the formal appeal is 1 month following the service of the written decision.

The duration of an appeal depends on the Court and the workload of the judges. Typically, we estimate around 12-15 months.

Hong Kong

Generally, an appeal lies as of right from a decision on a final matter from the CFI.

Appeals from the CFI are heard by the Court of Appeal (“CA”) and take the form of a rehearing.

Leave is not required for an appeal against the final judgment of the CFI (except for appeals concerned solely with legal costs) filed within 28 days from the date of judgment. A notice of appeal shall be served on all parties concerned and the court.

It normally takes four to 12 months for the CA to hear the appeal, depending on whether the points on appeal are complex.

Hungary

A first instance judgment may be appealed to the Court of Appeal of Budapest. An appeal hearing will usually be scheduled within 6-12 months of lodging the appeal. The appeal deadline runs from the date of service of the first instance judgment. The decision on the appeal can be expected within 12 to 24 months.

Ireland

Yes, there is a right of appeal to the Court of Appeal on a first instance judgment from the High Court.

An appeal against a first instance decision on a combined infringement/invalidity action usually takes between 9 – 18 months, depending on the complexity of the appeal and whether an expedited appeal is granted or not. The duration of an appeal hearing before the Court of Appeal would depend on the number of issues involved.

In addition to the above, it may take an additional 12 months for the Court of Appeal to issue its decision depending on a variety of factors including the complexity of the case, judge availability, etc.

Italy

First instance judgments can always be appealed to the Specialised Division of the Court of Appeal within 30 days of the service of the decision by one party, or in the absence of such service, within 6 months of the publication of the judgment.

The appeal judgment can be further appealed before the Supreme Court, but this is rare in patent matters. The Supreme Court may only decide on jurisdiction, competence, violation of the law or lack/contradiction of the reasoning of the judgment, and not on the fact-finding of the lower courts.

Netherlands

There is an automatic right to appeal (no permission or leave to appeal is required). The appeal needs to be instituted within 3 months (or 4 weeks in case of a preliminary injunction). The decision on the appeal can be expected within 12 to 24 months.

Poland

There is a right of appeal from a first instance judgment. The appeal can be filed to the Court of Appeal within two weeks of the first instance judgment with its full written justification (which needs to be expressly requested by the party interested in filing the appeal within one week of the judgment being announced or served).

The appeal may take another 1-2 years to be decided. In some cases, from the judgment on appeal, a cassation appeal to the Supreme Court may be available.

Singapore

An appeal from a first instance judgment may be filed to the Court of Appeal.

Typically, the appeal is heard within 6 months to 1 year of the first instance decision. The Court of Appeal's decision is final.

Slovakia

There is a right of appeal against a first instance decision. The appeal must be filed within 15 days from the delivery of the decision. Slovak law does not regulate the time period within which the appellate court shall pass the final decision. Please note that appellate oral hearings are rather exceptional and occur when it is necessary to repeat or supplement the evidence or where important public interest so requires.

Spain

There is a right of appeal from the first instance judgment to the Court of Appeal.

There is typically 12 to 18 months between the first instance judgment and the appeal hearing.

Sweden

There is a right to appeal a judgment on first instance, this is typically granted by the Patent and Market Court of Appeal.

The appeal must be filed within three weeks of the judgment at first instance. The appeal hearing will normally take place within 3-4 months of filing the appeal.

United Kingdom

A judgment may be appealed if the trial judge or the Court of Appeal considers that the appeal has "a real prospect of success". It takes between nine and 15 months for the appeal to be heard.

UPC

An appeal against a decision of the Court of First Instance may be brought before the Court of Appeal by any party which has been unsuccessful, in whole or in part, in its submissions, within two months of the date of the notification of the decision.

As referred to in 3 above, the first instance procedure are meant to have a duration of up to 12 to 14 months.

14. Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

Australia

An appeal is limited to the issues raised on appeal and is confined to oral and written submissions.

No new evidence can be adduced, and no submissions can be made that were not made at first instance.

Belgium

Appeals are *de novo* proceedings: all aspects of the first instance judgment (de facto and de jure) can be contested in appeal proceedings and new arguments and new evidence may be adduced if supported by the original writ of summons.

China

The appeal court could conduct a *de novo* review of the facts and the law of a case.

New evidence can also be introduced, provided that the new evidence is only available after the first instance proceedings, or if within the evidence adduction period the party had requested the 1st instance court to collect the evidence, but such request was not granted, the second instance court could then examine the issue again and consider that it is necessary to collect that new piece of evidence. .

Czech Republic

An appeal is by way of a review. With certain exceptions, new evidence cannot be adduced on appeal.

Finland

The appeal is mainly by way of a review. The facts of the case and evidence presented are considered to the extent determined in the leave to appeal. The Supreme Court may grant the leave only partially. In general, new evidence cannot be produced during the appeal stage.

When deemed necessary, the Supreme Court may hold oral hearing where the parties, witnesses and experts are heard and other evidence is accepted. Otherwise, the case is decided based on written material.

France

An appeal is by way of a rehearing of the facts and law of the case. The case is re-examined *de novo* by the appeal court.

The parties may bring new arguments and file new pieces of evidence. However, the appeal rehearing is limited to the claims submitted in the first instance unless specific circumstances exist where a new claim may be allowed in appeal proceedings.

Germany

In infringement proceedings, the appellate instance is a second, albeit limited, factual instance whose task is to obtain an error-free and convincing and thus correct decision of the individual case.

The appeal court will basically review the matter based on the facts determined in first instance. New evidence may be introduced in second instance under certain prerequisites (exclusion in case of preclusion/delay).

Hong Kong

An appeal to the CA is by way of a rehearing based on the documents. The CA will consider the materials before the first instance judge (but it will not rehear the witness evidence) and decide whether the judgment being appealed against is wrong.

The CA shall have power to receive further evidence on questions of fact, either by oral examination in court, by affidavit, or by deposition taken before an examiner, but no such further evidence (other than evidence as to matters which have occurred after the date of the trial or hearing) shall be admitted except on special grounds.

The CA in *Johnson Electric International Ltd v Bel Global Resources Holdings Ltd* [2014] 5 HKC 504, which followed *Ladd v Marshall* [1954] 1 WLR 1489, decided that for fresh evidence to be admitted on appeal, it must be established that:

- (1) the evidence could not have been obtained with reasonable diligence for use at the trial;
- (2) the evidence, if given, would have an important influence on the result of the case; and
- (3) the evidence is apparently credible.

However, the court always has the discretionary power to refuse the introduction of fresh evidence if the wider interest of justice so requires.

Hungary

An appeal is heard by a review, i.e., the appellate court does not re-conduct the evidentiary proceedings, but rather verifies whether the court of first instance correctly determined the facts of the case and applied the legal provisions to those facts. The appellate court might confirm the first instance judgment, make a new judgment, or set aside the first instance judgment and instruct the lower court to reconduct the first instance proceedings. As a general rule, no new evidence can be adduced on appeal.

Ireland

An appeal is by way of a review. The standard of review on appeal for infringement and invalidity issues is such that findings of fact made by the trial judge that are supported by credible evidence will not ordinarily be overturned on appeal.

In certain circumstances new evidence can be adduced on appeal. The Supreme Court recently considered, in *Ennis v Allied Irish Bank* [2021] IESC 12, the test for adducing new arguments in (i) appeals from Plenary Judgments and; (ii) appeals from Summary Judgment / Interlocutory Orders.

- **Plenary Judgment:** The Supreme Court confirmed that an appellate Court needs to adopt a “*sensible flexibility*” regarding the possibility of raising new grounds on appeal having regard to the “*interests of justice*”.
- **Summary Judgment / Interlocutory Orders:** the Court outlined a threefold test to determine the admissibility of new evidence: (1) the evidence to be adduced must have been in existence at the time of the trial and must be such that it could not have been obtained with reasonable diligence for use at the trial; (2) it would probably have had an important influence on the result of the case, though it need not be decisive; and (3) the new evidence must be presumed to be believed, that is, it must be apparently credible, though it need not be incontrovertible.

Italy

Appeal proceedings imply a further assessment of the facts and rules of law already dealt with before the first instance Court.

No new claims or objections can be raised on appeal. As for new evidence, the general rule is that parties cannot file new documents at the appeal stage, unless the evidence concerns facts which occurred after the

first instance judgment, or if it is successfully demonstrated that the evidence could not be submitted during the first instance proceedings due to reasons that were beyond the control of the party.

The Court of Appeal may also order that another CTE phase be carried out.

Netherlands

Appeals are *de novo*, i.e. the Appellate Court will evaluate all relevant facts and evidence anew. This may include both new evidence as well as new grounds/arguments, including in principle new infringement allegations or new validity attacks. If necessary, the Appellate Court may also hear witnesses.

A further appeal is possible to the Supreme Court on matters of law or where the decision lacks sufficient reasoning so as to make it incomprehensible. Permission to appeal is not required but appeals to the Supreme Court can only be filed by attorneys admitted to the Supreme Court bar, who would first need to determine that there is an arguable case for Supreme Court review. The Supreme Court also has the possibility to refuse to hear an appeal.

Poland

An appeal is heard by a review, i.e., the appeal court does not re-conduct the evidentiary proceedings, but rather verifies whether the court of first instance correctly determined the facts of the case and applied the legal provisions to those facts.

New evidence may be adduced on appeal, but it must be proved that such evidence could not have been submitted in the first instance.

Singapore

An appeal is by way of rehearing.

New evidence is generally not allowed to be adduced on appeal unless there are sufficient reasons why the evidence could not reasonably have been adduced in the earlier proceedings.

Slovakia

The court deals with the appeal through revision of both the facts and the law of the decision, and may either confirm, change, or revoke the decision. New evidence may be adduced on appeal only exceptionally, mainly where, through no fault of their own, the appellant was unable to adduce it in the proceedings before the court of first instance.

Spain

An appeal is a review of the arguments and evidence, normally there is no hearing, unless new evidence is filed. No new evidence can be filed, unless it was unduly rejected in the first instance.

Sweden

An appeal is heard by way of a review, with new evidence only permitted to be adduced in exceptional circumstances.

United Kingdom

An appeal is by way of a review. New evidence or material is not allowed on appeal unless it could not, with due diligence, have been found for use at the trial, and even then, it is only allowed when it is likely to have a material effect on the appeal.

UPC

New facts and new evidence may only be introduced on appeal when the party concerned could not reasonably have been expected to have produced them during proceedings before the Court of First

Instance. Requests, facts and evidence which have not been submitted by a party during proceedings before the Court of First Instance may be disregarded by the Court of Appeal, which has the discretion to decide.

15. What is the cost of a typical infringement action to first instance judgment? If the issues of invalidity and infringement are bifurcated, what is the cost of the invalidity action? Can the winner's costs be recovered from the losing party? How much is the cost of an appeal?

Australia

Depending on the complexity and range of expert evidence required, a party should expect costs of an infringement and invalidity action to be in the range of €500,000 and €1,252,500.

If the issues of invalidity and infringement are bifurcated (which does not normally occur), a party could anticipate costs of the invalidity action alone to be €380,000 – €940,000.

The winner should anticipate recovering between 60 and 75% of its costs from the losing party.

Costs of an appeal can range from €95,000 - €190,000, depending on the number of issues raised on appeal.

Belgium

The procedural costs, including court costs and costs for service of a writ of summons and judgment through a bailiff, are limited with typical a maximum of €1,000. The attorney's fees depend on the complexity of the case (number of patents; facts of the matter; subject-matter of the case, etc.). Appeal costs amount to a few hundred euros.

Court costs are reimbursed by the losing party. Lawyers' fees can also be recovered from the losing party, but this is capped at a relatively low fee. Costs for technical assistance may be reimbursed as well.

China

The official court fee for the first and second instance proceedings would depend on the value of the claims.

The official fee charged by the CNIPA for patent invalidation proceedings is:

- Invention – €410
- Utility Model – €205
- Design – €205

Normally the losing party would be ordered to pay the court fee. It is at the discretion of the court, but the losing party may also be ordered to partially pay the other costs such as the attorney fees, etc.

The cost of an appeal is very dependent on the specific case and would be difficult to estimate generally.

Czech Republic

The court fee for a patent infringement action is CZK 2,000 (approximately €80) for each non-monetary claim and for monetary claims, it is generally 5 % of the claimed amount. The same court fees apply for an appeal. Attorneys' fees will depend on the complexity of the case.

The winner can recover the costs from the losing party. However, the amount of attorneys' fees that can be recovered is limited by law depending on the value of the claim and number of procedural steps taken in the proceedings. If only non-monetary claims are asserted, the amount recovered will be generally low.

Finland

Costs are highly dependent on the nature and complexity of the case.

Typically, a simple infringement action (excluding preliminary injunction proceedings) would cost around €30,000-50,000 and the same applies to stand-alone invalidity actions. Complex matters in turn would typically cost at least €100,000.

Winner's costs are, as the main rule, recoverable from the losing party.

The appealing process would typically cost approximately the same amount or a bit less than the proceedings in the first instance.

France

Court fees are nearly inexistent in France. However, patent litigations involve attorneys' fees, patent attorneys' fees, bailiff's disbursements. The winning party may recover at least a part of its defence costs from the losing party. The awarding of such costs are at the court's discretion. In practical terms, the parties usually disclose the total amount of their costs going into the trial. There are no separate proceedings regarding the recovery of costs, the judgment will include an order on the costs (if requested).

The costs may vary depending on the level of technical difficulty, the interests at stake and the patent(s) involved. There is no bifurcated system. The costs are generally between €100,000 and €200,000 in total. The costs could be up to €500,000 for more complex matters and are only higher in exceptional cases. The costs largely depend on the complexity of the case and possible judicial and/or private expert's reports, bailiff's reports, etc. The costs include the defence to a revocation action of the infringed patent.

The costs for appeal proceedings are usually around two-thirds of the first instance proceedings.

Germany

Infringement Proceedings

The statutory costs of infringement proceedings depend on the value in dispute, which is suggested by the Plaintiff and later determined by the court. In patent infringement matters, the value in dispute is often between €1 million to €5 million. The maximum value in dispute is €30 million.

First instance infringement proceedings

The Plaintiff has to advance the Court fees (calculated on the basis of the value in dispute).

As an example: For a value in dispute of 5 million EUR, the Court fees would be around €65,000.

The winner can recover costs from the losing party. This mainly concerns statutory attorney's and patent attorney's costs and possibly advanced Court fees. Further costs, such as those for private expert opinions, can be recoverable if these are considered "necessary" – but this is often the subject of a subsequent dispute.

As an example: For a value in dispute of 5 million EUR, the statutory attorney's and patent attorney's fees would be around €92,000.

Second instance infringement proceedings

The Appellant has to advance the Court fees (again, calculated on the basis of the value in dispute).

As an example: For a value in dispute of 5 million EUR, the Court fees on appeal would be around €87,000.

Also on appeal, the winner can recover costs from the losing party. This mainly concerns statutory attorney's and patent attorney's costs and possibly advanced Court fees and/or appeal fees.

As an example: For a value in dispute of 5 million EUR, the statutory attorney's and patent attorney's fees on appeal would be around €103,000.

National Invalidity Action

In nullity proceedings, there is often a "surcharge" on the value in dispute in comparison with parallel infringement litigation (depending on the specific case).

As an example: For a value in dispute of 7 million EUR, the Court fees for a nullity action would be around €133,000.

The "loser pays" system is on the basis of a statutory fee remuneration and also applies to nullity cases.

Hong Kong

Costs in combined infringement and invalidity actions in Hong Kong can vary considerably, depending on the complexity and length of the proceedings, the scale of discovery, the seniority of the barrister(s) and solicitor(s) involved, and the attitude of the parties.

Normally, a successful party can recover its taxed legal costs and disbursements from the unsuccessful party. The normal basis for taxation is party and party basis, i.e. the necessary and proper costs that enable the party to conduct the litigation can be recovered, which normally amount to 50% to 70% of the actual legal costs. Costs may be varied or awarded on a higher scale depending on the case and the conduct of the parties.

If the validity of patent is contested in any proceedings before the court and the patent is found by the court to be wholly or partially valid, the court may grant a certificate certifying the finding and the fact that the validity of the patent was so contested. If so, then in any subsequent proceedings before the court for infringement of the patent concerned, a final order or judgement is made or given in favour of the party relying on the validity of the patent, then that party shall be entitled to his costs on the indemnity basis, namely all costs shall be allowed except insofar as they are of an unreasonable amount or have been unreasonably incurred.

Costs in an appeal can vary considerably. If an appeal is unsuccessful, the appellant may be liable to pay interest at the judgment rate in the case of a monetary judgment, or in other cases, compensate the respondent for the loss suffered as a result of the stay of execution pending appeal.

Hungary

Costs are highly dependent on the complexity of the case.

At first instance, a complex infringement action (excluding preliminary injunction proceedings) could cost around €70,000-140,000. The cost of a separate invalidity action may be estimated to be in a similar range, again depending on the complexity of the case and the activity of the parties to the proceedings.

If there is no claim for unjust enrichment and/or compensation of damages, the court fee for a main infringement action is approximately €100. If there are monetary claims, then the fee is 6% of the claimed amount but there is a cap at approximately €4,000. In appeal proceedings, the fixed amount of the court fee is approximately €130 or if there are monetary claims 8% of the claimed amount with a cap at approximately €6,600.

The prevailing party can recover the costs from the losing party. The courts may reduce the amount of legal fees awarded to the prevailing party.

Ireland

The typical cost of an infringement/invalidity action is in the region of €400,000 – €750,000, plus counsel fees and other outlay.

The level of costs will depend on many factors including the length of proceedings, complexity of the issues, the extent of discovery, interlocutory applications, and so on. Costs are awarded at the conclusion of a case and at the discretion of the judge. The general principle is that costs are awarded to the successful party. In general, about one-half to two-thirds of the total legal costs incurred are recoverable. Where the parties cannot agree on quantum, the assessment of costs can be listed before the Legal Costs Adjudicator, who will settle the figure to be paid.

As a result of the nature of the appeal process, the costs of an appeal are normally significantly less than those at first instance. Cost recovery is dealt with in a similar way to that in the High Court. If a decision is successfully appealed, it will open up the decision on the costs awarded at first instance.

Italy

The cost would be very dependent on the specific case (such as the subject matter, number of patents, procedural issues, etc) and would be difficult to estimate generally.

Netherlands

Depending on the complexity of a case, and on whether both infringement as well as validity are at issue, the costs in first instance are likely to be around €100,000 - €600,000.

The costs for appeal are generally somewhat lower but given the de novo nature of appeal these may approach the first instance costs.

The “reasonable costs” of the prevailing party can be recovered from the losing party. There are indicatory fees for the “reasonable costs” that serve as customary upper limits, which are the same in first instance and appeal: €30,000 for simple cases, €75,000 for normal cases, €150,000 for complex cases and €250,000 for very complex cases. In PI-proceedings the indicatory fees are: €10,000 for simple cases, €40,000 for normal cases, €80,000 for complex cases and €120,000 for very complex cases. The indicatory fees can be raised by up to €15,000 if the court decides to ask prejudicial questions to the CJEU.

Poland

The costs of first instance infringement proceedings may be roughly estimated to be in the range of €80,000-150,000, depending on the complexity of the case, activity of the parties to the proceedings, complexity and number of patents asserted. In addition, there would be a court fee payable of 5% of the value of the monetary claims (if any).

The cost of the invalidity action may be estimated to be in the similar range, i.e., €80,000-150,000, again depending on the complexity of the case and activity of the parties to the proceedings.

The losing party is usually ordered to pay the successful party’s legal costs, which consist of court fees (including the costs of preparing court experts’ opinions and other official fees) and attorneys’ fees. However, the law limits the amount of the attorneys’ fees which may be recovered. The limit is calculated based on the complexity and value of the case, but at the same time using maximum statutory rates which are very low compared to the actual rates applied by law firm.

Thus, in practice, the successful party is likely to receive only about €1,500-2,500 as reimbursement of the attorneys’ fees.

The statutory cost of an appeal (i.e., a court fee) amounts to 5% of the value of the claim, whereas the costs of legal services may be estimated at €50,000-80,000.

Singapore

Costs (both at first instance and on appeal) will be heavily dependent on the number of patents in-suit, whether there is a counterclaim for invalidation of the patents in-suit, the complexity of the matter and how contentious proceedings are.

As a rough ballpark, the estimated cost of a typical patent infringement up to trial would be upwards of €175,000 excluding costs of expert witnesses.

As of 1 April 2022, a claimant can elect for a simplified process to apply to its claim. The simplified process is expected to bring about cost savings for both parties to the suit owing to more active case management by the court and a cap on the length of trial (2 days). Further, the claimant must abandon any claim for monetary relief in excess of S\$500,000 (approximately € 345,000), and party-to-party costs are capped at S\$50,000 (approximately € 34,500) and S\$25,000 (approximately € 17,000) in relation to trial on liability and assessment as to the amount of monetary relief, respectively. Given the caps, this process is generally only suitable for less complex cases.

An appeal to the Court of Appeal against the first instance decision would cost upwards of €55,000 (these estimates exclude tax and disbursements).

The courts will typically order the losing party to pay the costs of the winner, although the amount recovered will usually only be a portion (around ½ to two-thirds) of the winner's costs.

Slovakia

The court fee of a typical patent infringement action (where the value of dispute cannot be calculated in money) is up to €140 for each claimant. The court fee for the appeal is up to €75 for appeal lodged by electronic means.

Where the value of the dispute can be calculated in money, the court fee for of an infringement action is calculated as 6 % of the total value of the dispute. The minimum court fee is €25, and the maximum is €50,000 in commercial disputes. The same applies for an appeal. The court fees are generally reduced when the filings are made via electronic means.

The administrative fee for a patent invalidity action at the IPO (including European patents) is €200. Lawyers' fees would depend on the complexity of the case.

Spain

The costs of an action depends greatly on the complexity of the case but normally it will be anywhere from €60,000 to €100,000 (in lawyers' fees) for invalidity as well as infringement, because the actions are heard together.

Costs are imposed on the losing party. Normally, the courts will not grant the whole range of costs suffered by the winning party, although there are some pending cases in which the winning party was invoking the EUCJ doctrine on costs, so maybe things could change.

Sweden

A typical infringement action tends to cost between €150,000-300,000. This figure remains largely unchanged when the issues of invalidity and infringement are bifurcated.

The winner's costs can be recoverable from the losing party after an appropriate reduction has been made by the Court.

The costs of an appeal can vary greatly depending on the facts of the appeal. There is no set fee for appeals.

United Kingdom

The typical cost of infringement/invalidity action is in the region of £750,000 to £1,250,000 for the Patents Court depending on such matters as the number of patents/claims in dispute, the number and nature of the invalidity attacks, and whether more than one expert is required to give evidence at the trial. Cost budgeting is now required and parties must prepare and exchange costs budgets early in the proceedings (except where the value of the claim is certified to be £10 million or more).

The general rule is that the overall winner can expect to be awarded their costs of the action. The Patents Court adopts an issue-based approach which means that, in practice, a discount will be made for the costs of those issues on which the winner lost. A party in whose favour a costs order is made would normally expect to recover approximately 65–75% of their actual legal costs which are the subject of that order. Where costs budgets have been employed, the winning party is likely to recover at least 80–90% of those costs.

As a result of the nature of the appeal process, the costs of an appeal are normally considerably less than those at first instance. Cost recovery is dealt with in a similar way to that in the Patents Court. If a decision is successfully appealed, it will open up the decision on the costs awarded at first instance.

UPC

Court fees

Court fees consist of a fixed fee possibly combined with a value-based fee.

- Infringement action - The fixed fee is €11,000, to which is added a value-based fee that depends on the value of the dispute (from €0 to up to €325,000).
- Revocation action - The fee is €20,000. The fee could be limited in case of revocation by way of counterclaim as the same fee as the infringement action subject to a fee limit of €20,000.

Appeal

Court fees are mainly determined in the same way as for an action at first instance with a combination of a fixed fee and value-based fee where applicable.

Legal costs

Legal costs will notably depend on the complexity of the issues at stake (number of patents, number of claimants/defendants, legal issues, technical issues, appointment of experts, etc.). The successful party can claim the reimbursement of its reasonable and proportionate legal costs and other expenses, unless equity requires otherwise. These costs will, as a general rule, be borne by the unsuccessful party. A scale of maximum recoverable costs has been set by the Administrative Committee of the UPC according to the value of the dispute.



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