

# Patents

*Contributing editor*  
Richard T McCaulley Jr



2016

GETTING THE  
DEAL THROUGH 

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## Patent enforcement proceedings

### 1 Lawsuits and courts

**What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?**

Patent rights must be enforced before the Intellectual Property Court, which is a court specialised in IP rights with the exclusive competence to decide on the enforcement actions – and validity actions – regarding any IP right and also unfair competition.

There is an exception for the actions related to pharmaceutical patents and generic medicines, which are subject to mandatory arbitration, according to Law 62/2011, of 12 December. Upon the publication of a marketing authorisation application for a generic product the patent holder has a 30-day period to start an arbitration action (institutionalised or ad hoc).

Patent infringement is a criminal offence and a criminal complaint before a criminal court is also available, although this route is rarely used.

### 2 Trial format and timing

**What is the format of a patent infringement trial?**

The typical form of a patent trial is the live and oral questioning of the witnesses or expert witnesses appointed by the parties, in order to evidence the facts alleged in the statement of claim and statement of defence.

The witnesses respond to questions from the parties' lawyers – examination in chief and cross-examination – and also from the judge. The evidence includes documentary evidence and testimonial evidence and could also include affidavits, legal opinions and expert opinions.

Disputes are decided by a single judge – in the first instance – and a typical patent infringement trial could last between 18 months and two years. A preliminary injunction could take between three and eight months.

In the mandatory arbitrations for the enforcement of pharmaceutical patents, the main action could last up to one year and a preliminary injunction between two and five months.

### 3 Proof requirements

**What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?**

For establishing infringement the burden of proof lies with the claimant (patent holder). There is a reversal of the burden of proof regarding process patents of a new product, as established by law: 'if a patent is for a manufacturing process of a new product, the same product manufactured by a third party shall be considered to have been manufactured by the patented process unless proven otherwise.'

For invalidity and unenforceability of a patent the burden of proof lies with the party that alleges the facts which underlie the invalidity and unenforceability.

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### 4 Standing to sue

**Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?**

The patent holder or a licensee/sub-licensee (if this is contemplated in the respective licence or sub-licence contract) has standing to sue.

Before an action is brought by the patent holder against the infringer, the accused infringer can file a declaratory action for non-infringement of the patent, as an anticipatory defence measure.

After a patent infringement action is submitted against the infringer its defence should be filed in such action and may include a counterclaim, notably for the invalidation of the patent.

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### 5 Inducement, and contributory and multiple party infringement

**To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?**

Although there is no legal provision for contributory infringement, there are legal provisions related to contribution of third parties to patent infringement, apart from the infringer. In particular, within the measures to preserve evidence, the materials and instruments – in the possession of a third party – used in producing and distributing the infringing products can be seized.

Multiple parties may be jointly liable for infringement if each practises only some of the elements (or steps) of a patent claim, but together they practise all the elements (or steps).

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### 6 Joinder of multiple defendants

**Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing all of the same patents?**

The rules on the coalition of defendants in the Civil Procedural Code state that multiple parties can be joined as defendants in the same lawsuit basically if there is the same and only cause of action against them.

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### 7 Infringement by foreign activities

**To what extent can activities that take place outside the jurisdiction support a charge of patent infringement?**

A cross-border injunction will be an available measure to deal with these activities.

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### 8 Infringement by equivalents

**To what extent can 'equivalents' of the claimed subject matter be shown to infringe?**

The doctrine of equivalents is regularly invoked in patent litigation cases and is also regularly considered and applied by the courts and arbitral tribunals.