

Patents in Europe 2008

Slovenia

Živko Mijatović & Partners

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1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

According to Article 27 of the Industrial Property Law, a European patent owner seeking protection in the Republic of Slovenia shall enjoy, as from the date of grant of the European patent, the same rights as the owner of a patent granted by the Intellectual Property Office (IPO) of Slovenia. Therefore, a European patent owner enjoys the following exclusive rights:

- To prevent third parties from making, using, offering for sale, selling or importing the products protected by its patent; and
- To prevent third parties from using a patented process and from offering for sale, selling or importing products obtained directly through the patented process.

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

Slovenia does not have specialist patent courts. The Ljubljana District Court decides on all matters of patent infringement; its decisions may be appealed before the Supreme Court in Ljubljana. Although the courts are not specialised in patent matters, acceptable levels of expertise are secured by requesting experts' reports on important issues.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

The Civil Procedure Law does not provide for

the cross-examination of witnesses during the trial. However, witnesses may be examined and the evidence obtained during such examination will be taken into account along with other evidence when issuing the final decision. Witnesses can be examined by the parties' representatives, but direct questions are put to them by the judge. However, the proceedings are mostly based on written evidence.

There are no restrictions on the use of evidence from experts. Nevertheless, the only relevant evidence is that presented by the parties before the issuance of the first instance decision.

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

While the same court is responsible for deciding on patent infringement and invalidity, these two proceedings are always separate. During invalidity proceedings the party that filed the request for invalidation must submit evidence showing that the legal conditions for grant of a patent were not met at the time of grant. During infringement proceedings, the plaintiff must prove that its patent has been infringed by the actions or products of the defendant; it can do so by providing evidence in the form of, for example, experts' opinions, a comparison of the products in question and product samples.

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

Slovenian law does not provide for pre-trial discovery. Evidence is presented to the court upon filing the lawsuit or later on during the hearings. Evidence cannot be presented after the issuance of the first instance decision, except where it was unavailable before this time.

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

The Slovenian courts will issue their decisions upon considering all evidence, statements and proof presented in the petitions and in the hearings. The doctrine of equivalents, if it has been presented to the court, will be taken into account alongside all other evidence presented to the court. The doctrine of equivalents will only influence the court's decision together with the other evidence: it cannot be the sole basis for the court's decision.

7. Are there certain types of patent rights that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

Software-related patents are more difficult to enforce due to the fact that only experts can provide information on whether the defendant's product or process is infringing the plaintiff's patent.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

The Ljubljana District Court is not bound by the decisions of other courts. However, such decisions – and especially the experts' opinions included in those decisions – will be taken into account along with all other evidence. Where decisions of other courts are submitted to the Ljubljana District Court, they will be considered alongside all other evidence; but once again, they cannot be the sole basis for the court's decision.

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

The Ljubljana District Court will take into account the decisions of foreign courts alongside all other evidence presented when issuing its decision. The reasoning of foreign courts cannot represent the sole basis for the court's decision, but will be considered as non-binding evidence which may influence the final decision to some degree.

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

The usual delaying tactic that defendants use is to file an invalidation claim against the patent in suit after the initiation of infringement proceedings. In such cases,

the court must suspend the infringement proceedings until it has decided on the patent's validity.

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

The court will order provisional measures to secure non-monetary claims if the claimant can show probable grounds to believe that:

- It is or will be the owner of a protected patent right;
- Its patent right is being infringed or will be infringed in the future;
- There is a danger that the enforcement of claims will become impossible or difficult without such provisional measures; and
- The provisional measures are necessary to prevent damage that would be difficult to repair.

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

First instance proceedings last approximately two to three years. They can take longer if a claim for invalidation is filed, as this will suspend the infringement proceedings until the court has decided on the validity of the patent. Court proceedings can be terminated in a shorter period of time if an amicable settlement is reached during the proceedings.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

An appeal against a first instance decision may be filed within 15 days of receipt. An appeal can be filed against violations either of procedural rules or of the material rules applied during the trial proceedings. No new evidence can be presented during second instance proceedings, unless it was not possible to present it during the first instance proceedings.

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

The administrative fees payable during court proceedings depend on the value of the dispute. The value of the matter is specified by the plaintiff and therefore the total costs involved in the proceedings can vary from case to case. Nevertheless, the parties involved should expect that the costs will total over Euros 2,000.

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

The parties can defend their own interests in court proceedings. However, in commercial trials, it is usual for parties to use the services of an attorney at law. Members of the Law Office who have not passed the bar exam can represent the parties, although they cannot make any monetary claim for doing so.

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

During civil proceedings for patent infringement, the claimant can request:

- Cessation of the infringement and prohibition of future infringement;
- The recall of infringing items from channels of trade, taking into account the interests of *bona fide* third parties, or the irrevocable removal of such items from channels of trade;
- The destruction of infringing items or their surrender to the plaintiff against reimbursement of the costs of their production;
- The destruction of means of

infringement owned by the infringer and intended or used exclusively or principally for infringement;

- Rectification of the situation caused by the infringement; and
- Publication of the judgment.

The infringer must pay damages to the rights owner in an amount to be determined under general rules on compensation for damages, or in an amount which is equal to an agreed or customary licence fee.

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

Patent disputes can be resolved outside the courts through settlement agreements between the parties.

18. Has your jurisdiction signed up to the London Agreement on Translations? If not, how likely is it that it will do so?

Slovenia has signed the London Agreement. However, no change in respect to translation requirements will occur from 1st May 2008 onwards – that is, the translation of patent claims into Slovenian will still be required from 1st May 2008, as in the past.



Marija Tomić specialises in patent prosecution, mainly in the biotechnology and pharmaceutical fields.

Before joining Živko Mijatović & Partners, Ms Tomić worked for several years as an assistant at the University of Belgrade Faculty of Biology and as a researcher at the Institute for Soil, also in Belgrade. She holds an MSc in biology and has published a number of scientific papers in internationally recognised journals. She has also acted as a patent adviser and translator for different law firms in Serbia.

Ms Tomić has participated in several seminars on obtaining, enforcing and evaluating intellectual property rights in Europe.

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