

Ireland

Administrative procedure

Opposition

No formal pre- or post-grant opposition procedure is available. A third party may only oppose the restoration of a patent or amendments to a granted patent (Sections 36(5), 38(5) PA).

Appeal

All decisions or orders of the Controller¹ can be appealed to the High Court (Section 96 PA).

The notice of appeal to the High Court must be given within three months of the date of the order or decision that is to be appealed (Section 96(6) PA).

The Court of Appeal, established on 28th October 2014, occupies an appellate jurisdictional tier between the High Court and the Supreme Court. The Court has jurisdiction to hear appeals in civil proceedings from the High Court which prior to the Thirty-third Amendment of the Constitution would have been heard by the Supreme Court. Exceptions are those cases in which the Supreme Court has permitted an appeal to it on being satisfied that the appeal meets the threshold set out in Article 34.5.4° of the Constitution (a 'Leap Frog' appeal).

Further appeal to the Supreme Court may only be based on a question of law (Section 96(7) PA).

Civil procedure

Infringement

Civil actions should be brought before the High Court (Section 47(1) PA).



The patent owner or the co-owner may bring the action (Sections 47(1), 48 PA). An exclusive licensee has the right to institute proceedings in respect of any infringement of the patent committed after the date of the licence (Section 51(1) PA).

Invalidity may be used as a defence (Section 61(1)(a) PA).

In an action or proceedings for infringement or revocation of a patent, the High Court or the Supreme Court may, if it thinks fit, and must, if requested by all parties to the proceedings, call in the aid of an assessor specially qualified in the opinion of the Court, and try the case wholly or partially with his assistance (Section 95 PA).

The Court may not, in respect of the same infringement, both award damages to the proprietor of a patent and order that he be given an account of the profits (Section 47(2) PA).

Infringement proceedings in respect of a short-term patent may be brought before the Circuit Court (irrespective of the amount of the claim). The proceedings may not be instituted until the patent proprietor has made a request for a search report from the Controller and has received a copy of it (Section 66 PA).

¹ "The Controller" is the Controller of Patents, Designs and Trade Marks. The Controller executes his statutory functions as set out under the Patents Act, 1992 (as amended), the Trade Marks Act, 1996 (as amended), the Industrial Designs Act, 2001, the Copyright and Related Rights Act, 2000, the various Statutory Rules and Regulations made under these Acts; and the European Communities (Supplementary Protection Certificate) Regulations. Decisions under these Acts, Rules and Regulations rest with the Controller in his statutory capacity, subject to certain rights of appeal to the High Court.

The Copyright and Other Intellectual Property Law Provisions Act 2019, which was signed into law and is expected to commence at the end of 2019, will extend the jurisdiction of the Circuit Court and the District Court to hear intellectual property claims, permitting right holders to bring lower value intellectual property infringement claims for relief in civil proceedings within the limits of these courts. The Circuit Court has jurisdiction in actions in contract and tort where the claim does not exceed EUR 75 000. The monetary limit of jurisdiction of the District Court is EUR 15 000.

NOTE 1: In the case of patents most proceedings are of high value and have to be taken before the High Court. This situation will continue because for patents, an 'intellectual property claim' "means any proceedings instituted, application or reference made, or appeal lodged, under the Patents Act 1992 other than an application under section 47, 49, 50, 51, 52, 53, 54, 57, 74, 86, 91(2), 95, 96, 108(4), 123 or 124 of that Act."

Nullity/counterclaim for revocation

Any person may apply to the High Court or the Controller for the revocation of a patent (Sections 57(1), 59(1) PA) (subject to further exceptions – Section 57(2) PA).

An application may be filed even if the patent has lapsed (Section 57(3) PA).

If proceedings with respect to the patent are pending in the Court, no application for revocation may be made to the Controller without the leave of the Court (Section 57(5) PA).

If an application is made to the Controller and the Controller has not disposed of an application, the applicant may not apply to the Court for revocation unless either the proprietor of the patent agrees that the applicant may do so or the Controller certifies in writing that in his opinion the matter would more properly be determined by the Court (Section 57(6) PA).

Partial revocation is available (Section 59(3) PA).

If it appears to the Controller that an invention for which a patent has been granted was described in an earlier patent, he may on his own initiative by order revoke the patent. The owner should be given an opportunity to make observations and to amend the patent specification (Section 60(1) PA).

Section 38(1) PA provides for post-grant amendment of the patent claims by the proprietor unless proceedings on patent validity are already in train before either the Controller or the Court.

Section 38(1) PA amendments do occur on a regular basis, e.g. 6 cases per year.

Amendments under Section 38(2) PA arising directly from validity proceedings before either the Controller or the Court also occur, but on a very infrequent basis, e.g. one case every few years.

Remedies

Injunction, an order requiring the defendant to deliver up or destroy any product covered by the patent, damages, account of profits, declaration that the patent is valid and has been infringed by the defendant (Section 47(1)(a)-(e) PA).

Other actions

A declaration that the use by any person of any process, or the making or use or sale by any person of any product, does not and would not constitute an act of infringement of a patent may be made by the Court in proceedings between the person and the proprietor of the patent or the holder of an exclusive licence under the patent, notwithstanding the fact that no assertion to the contrary has been made by the proprietor or licensee (Section 54 PA).

The validity of a patent in whole or in part may not be called into question in proceedings for a declaration made by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent must not be deemed to imply that the patent is valid.

Appeal

From the decisions of the High Court at first instance, appeal may be lodged directly with the Supreme Court (restricted to points of law) – Section 96(7) PA.

Parallel proceedings

There are no formal provisions as such, but we believe there have been a few instances where cases before an Irish court have been put on hold pending the outcome of proceedings before the EPO.

Arbitration/mediation

There is no provision in Irish law affording the Controller the power to offer any form of arbitration or mediation.

Enforcement

There are no provisions in the Patents Act covering these issues – they are all dealt with by the rules of the Court. Patent-specific infringement actions are provided for in Section 47 PA, as mentioned previously.

Compulsory licence

May be granted by the Irish Patents Office in cases of non-working, dependent patents and public interest (Section 70-75 PA).

Relevant national law

Patents Act 1992, No. 1 of February 27 1992 [cited as: PA]

Competent authorities or courts



