

Iceland

Administrative procedure

Opposition

Post-grant opposition is available.

Anyone may file notice of opposition against the grant of a patent within nine months after publication of the grant. An opposition must be made in writing and must be reasoned (Section 21(1) PA). Opposition must be accompanied by the prescribed fee and should opposition be received from more than one party the cases may be combined (Section 21(2) PA). It may be filed only on certain grounds (Section 21(3) PA) and the fact of filing shall be published (Section 21(4) PA). If the patent was granted in English, the Icelandic Intellectual Property Office (hereinafter the "ISIPO") may require an Icelandic translation thereof (Section 21(5) PA).

The patent owner will be notified of the filed opposition and will be given an opportunity to file his arguments (Section 23(1) PA).

The ISIPO may accept to process the opposition although a patent has lapsed or will cease to have effect due to its termination, the opposition has been withdrawn, or the opponent is deceased or has lost the right to proceed with such a case (Section 23(2) PA).

Pre-grant observations on an application may also be filed (Section 29 PR).

An applicant will be informed and the ISIPO will take the observations into consideration, however, the party submitting the observations will not become party to the proceedings.

If the observation concerns a third-party claim of entitlement, the person concerned will be invited to bring the matter before Court within a set time limit (Section 17 PA). If such a matter is proceeded with, the ISIPO proceedings will be postponed until a court decision has been given (Section 17(2) PA).

Appeal

An appeal against a final decision of the ISIPO concerning an application or a granted patent may be lodged with the Board of Appeal (Section 24 PA).



There are restrictions as to the persons who can legitimately file an appeal:

- a) The applicant may file an appeal against a final decision concerning a patent application.
- b) The patent owner may file an appeal against a decision reached in opposition proceedings which declares the patent invalid or maintains its validity in amended form.
- c) The opponent may file an appeal against a decision reached in opposition proceedings according to which the patent continues to be valid unamended or may continue to be valid with amendments. If the opponent withdraws his appeal, the case may nonetheless be examined if special circumstances support this course of action.

An appeal may also be lodged against decisions other than those mentioned in Section 24 (Section 67 PA).

The persons who may legitimately file an appeal under Section 67 PA are: an applicant, a patent holder, a person requesting invalidation or other parties with legitimate interests.

An appeal to the Board of Appeal, based on either Section 24 or 67 PA, must be lodged within two months from notification of the decision concerned (Sections 25(1) and 67(1) PA). Proceedings concerning the ISIPO decisions which may be appealed to the Board of Appeal may not be brought

before the courts until the decision of the Board of Appeal has been given (Section 25(3) PA).

A further appeal may be brought to the Reykjavik City Court against decisions of the Board of Appeal refusing a patent application or declaring a patent to be invalid, within two months from the date on which the party concerned was notified of the decision (Sections 25(3) and 64 PA).

An ordinary appeal from the decision of the Reykjavik City Court may be brought to the Appeal Court, which acts as the court of second instance according to Act on Civil Procedure (ACP) and Law on Criminal Procedure (LCP) rules. Decision of the Appeal Court can be referred to the Supreme Court if the Supreme Court so permits.

Civil procedure

Infringement

Infringement actions are to be brought before the Reykjavik City Court¹. There is no chamber specialising in IP rights.

Proceedings must be brought by the injured party (Section 57(3) PA).

On complaint of an aggrieved party, criminal proceedings may be instituted against intentional infringement according to the LCP rules of procedure.

In each case, the Chairman of the Reykjavik City Court can decide if a claim should be decided by a single judge or by a panel of three judges (two of whom can be technically qualified) (Section 2 ACP; Section 3 LCP). Court-appointed experts are further allowed upon request of either party, subject to ACP or LCP rules. The expert's opinion has a persuasive effect on the court's decision, but is not formally binding.

Infringement actions may also be brought in respect of commercial exploitation of the invention made without the consent of the applicant before the grant of the patent but after the application has been made available to the public (subject to further restrictions) (Section 60 PA).

Nullity/counterclaim for revocation

In infringement proceedings, invalidity may be raised as a defence, provided that revocation of the patent has been or is requested (Section 61 PA).

If the patent owner institutes proceedings for infringement of a patent and the defendant wishes to claim revocation of the patent, the defendant must inform the ISIPO and registered licensees that he intends to claim revocation. In this case revocation must be claimed within a prescribed period (Section 63(3) and (4) PA).

Revocation proceedings may be instituted by any person, subject to one exception (Section 52(3) and (4) PA). The ISIPO should be informed (Section 63(1) PA).

Proceedings on the grounds that the patent has been granted to a person other than the one entitled to it may only be instituted by the person claiming entitlement, within one year after the entitled person obtained knowledge of the grant of the patent and of the other circumstances on which the proceedings are based (Section 52(4) PA). Furthermore, if a patent has been granted to a person other than the one entitled to it, the court transfers the patent to the entitled person if he so claims (Section 53 PA).

A patent may be revoked in whole or in part by decision of the Reykjavik City Court (Section 52 PA). If a patent is revoked in its entirety or in part by the court, the effect shall be based on the date of filing (Section 52(5) PA). In cancellation cases, the patent owner is obliged to inform the judge of requests that have been submitted for patent limitation (Section 40.b(4) PA).

A patent owner may request limitation of the scope of protection of his patent either as a counterclaim in court proceedings or before the ISIPO. Limitation allows the patent claims and, if necessary, also the description and/or drawings to be modified (Section 40.a(1) PA).

It is not possible to file a limitation request if a patent is the subject of enforcement actions, a mortgage or a court case or if the time limit for opposition has not expired (Section 40.a(2) PA).

Limitation of a patent in proceedings before the ISIPO takes effect from the date of application and enters into force when notice of the amendment is published (Section 40.b(3) PA).

¹ Section 64 PA determines the competence of the Court.

Remedies

Injunction, compensation, damages, alteration and destruction of infringing products (Sections 57-59 PA).

Other actions

Not available.

Appeal

An ordinary appeal may be filed with the Appeal Court, which acts as the court of second instance according to ACP and LCP rules. A decision of the Appeal Court may be referred to the Supreme Court if the Supreme Court so permits.

Parallel proceedings

A decision to stay national proceedings when there are parallel proceedings before the EPO or possibly the Court of Justice of the European Union (CJEU) is taken on a case-by-case basis.

The ISIPO stays proceedings on a regular basis in case of EPO oppositions and/or appeals or proceedings before the CJEU which may possibly have an impact on national procedures.

Limited case law is available from national courts in relation to patents. Supreme Court case No. 506/2016 concerned the granting of a Supplementary Protection Certificate (SPC) with negative effect. The decision was based on a judgment from the EFTA Court in case No. E-05/17, which was in line with the judgment of the CJEU in case No. C-125/10.

A patent holder may, according to Section 40.a PA (cf. item (b) above), request limitation of the scope of protection of a validated European patent. If he has, however, previously submitted a comparable request to the EPO, the ISIPO will postpone the processing of the request until the EPO's decision is available (Section 60 PR).

Arbitration/mediation

Not available.

Enforcement

During enforcement procedures, sheriffs and their legally trained assistants render assistance in collecting evidence following a court order (Section 2 ACE²).

If a sheriff lacks the competence to take action, the Minister of Justice appoints another competent person (Section 2(3) ACE).

The petitioner sends a district court order permitting collection of evidence to the sheriff in the area of office where the evidence is to be collected (Section 10 ACE).

The sheriff collects evidence by means of a search at the respondent's premises (Section 12 ACE).

A petitioner's request for collection of evidence must be sent to the district court of the respondent's home venue (Section 5 ACE).

As soon as possible after receiving the case for a decision, the district court judge issues a court order specifying whether evidence is to be collected (Section 9 ACE).

The petitioner must, within four weeks from when evidence becomes available to him, initiate legal action against the respondent on the basis of the evidence. If no legal action has been initiated when the period expires, the petitioner must return the evidence collected (Section 21 ACE).

Damages or other remedies are decided by the courts in accordance with ACP procedures.

After a final decision of the court, the parties in question are responsible for enforcing any awards for compensation or damages. Requests for seizure or injunction are handled by sheriffs and their legally trained assistants in accordance with the ASI rules of procedure. Enforcement of orders for destruction of infringing products is ordered by the courts, e.g. to the Directorate of Customs.

Compulsory licence

Requests for the grant of compulsory licences may be made to the Reykjavik City Court in cases of non-working or dependent patents, prior commercial exploitation and public interest (Sections 45-48 PA). The Court decides on the grant and scope of the licence, the compensation for the owner of the patent and any further issues (Section 50 PA).

Relevant national law

Patents Act No. 17/1991, with amendments according to Acts No. 92/1991, No. 67/1993, No. 36/1996, No. 91/1996, No. 132/1997, No. 82/1998, No. 28/2002, No. 72/2003, No. 22/2004, No. 53/2004, No. 54/2004, No. 12/2005, No. 127/2005, No. 108/2006, No. 167/2007, No. 98/2009, No. 25/2011, No. 126/2011, 40/2018 and 32/2019 [cited as: PA];

Regulation on Patents No. 477/2012 [cited as: PR];

Act on Civil Procedure No. 91/1991 [cited as: ACP];

Law on Criminal Procedure No. 88/2008 [cited as: LCP];

Act on Collection of Evidence Relating to Alleged Violations of Intellectual Property Rights No. 53/2006 [cited as: ACE];

Act No. 31/1990 on seizure, injunction etc. [cited as: ASI].

Competent authorities or courts

