

# **Patents**

# in 37 jurisdictions worldwide

2014

**Contributing editor: Frank L Bernstein** 



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#### Patents 2014

# Contributing editor: Frank L Bernstein Kenyon & Kenyon LLP

Getting the Deal Through is delighted to publish the 11th edition of Patents, a volume in our series of annual reports, which provide international analysis in key areas of law and policy for corporate counsel, cross-border legal practitioners and business people.

Following the format adopted throughout the series, the same key questions are answered by leading practitioners in each of the 37 jurisdictions featured. New jurisdictions this year include Canada, Indonesia, Singapore, Sweden and Ukraine.

Every effort has been made to ensure that matters of concern to readers are covered. However, specific legal advice should always be sought from experienced local advisers. Getting the Deal Through publications are updated annually in print. Please ensure you are referring to the latest print edition or to the online version at www. gettingthedealthrough.com.

Getting the Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We would also like to extend special thanks to contributing editor Frank L Bernstein of Kenyon & Kenyon LLP for his continued assistance with this volume.

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London March 2014

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Oliver Schulz, Sandra Pohlman and

Jianyang (Eugene) Yu

Liu. Shen & Associates

Carlos R Olarte and Andrés Rincón

Claus Elmeros and Jens Viktor Nørgaard

#### Publishe

Gideon Roberton gideon.roberton@lbresearch.com

#### Subscriptions

Rachel Nurse subscriptions@gettingthedealthrough.com

#### **Business development managers**

George Ingledew george.ingledew@lbresearch.com

Alan Lee alan.lee@lbresearch.com

Dan White dan white@lbresearch.com



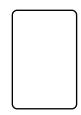


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# Sweden

## Kristian Fredrikson

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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?

The main remedies against an infringer are interlocutory injunctions, injunctions and damages. Such remedies may be obtained through legal proceedings in a common court. A court decision regarding an injunction or damages may be enforced by the enforcement authority after a separate request referring to the court decision.

The Stockholm City Court is the exclusive forum in the first instance for patent infringement proceedings. Court decisions may be appealed to the Svea Court of Appeal in Stockholm and then to the Supreme Court. Appeal requires a granted leave to appeal.

#### 2 Trial format and timing

What is the format of a patent infringement trial?

The patent infringement trial commences with the filing of a writ of summons where the infringement case is outlined and evidence is presented. The writ may also contain a request for an interlocutory injunction. During the preparatory stage of the trial, which then follows, the interlocutory injunction request is decided upon and legal arguments, defences and additional evidence are presented and commented upon. Preparation is mostly done in writing by exchange of briefs, but also orally in at least one preparatory hearing.

The trial ends with a main hearing where evidence and arguments are presented to a panel of judges, usually consisting of two legal judges and two technical judges in the first instance and three legal judges and two technical judges in the appeals court. Documents and live testimony are the main means of evidence. Affidavits are allowed if a witness cannot reasonably appear or if the counterpart agrees to allow it, but affidavits are considered an inferior means of evidence as compared to oral witness statements. Witnesses are regularly cross-examined. Experts on the relevant technology, appointed by each party, are often used. If so, the party is expected to file a written expert statement during the preparatory stage of the trial and the expert is cross-examined during the main hearing.

A trial can be expected to take 12 to 18 months in first instance and another 12 to 18 months in the appeals court. The main hearing is usually scheduled for one, two or three days, but the time required depends on the size and complexity of the case.

## 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 rests with the plaintiff, namely, the patent holder or licensee, who has to prove (ie, clear and convincing evidence) that there is an enforceable patent

right and an infringement. For establishing invalidity, the burden of proof rests with the challenger as plaintiff, who has to prove that the patent right is invalid under the patent regulations.

Unenforceability is not recognised under Swedish law.

#### 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 owner may sue for infringement, as may a licensee, regardless of whether the licence is exclusive or non-exclusive. If a licensee wants to sue, he or she has to inform the patentee in advance.

An alleged infringer may sue for a declaratory judgment of noninfringement. A claim for a declaratory judgment may be brought if it is uncertain whether there exists an infringement and this uncertainty is to the detriment of the alleged infringer.

The Brussels regulation (Council Regulation (EC) No. 44/2001) and the Lugano Convention are applicable in Sweden to the effect that the plaintiff must be domiciled in Sweden to be allowed to sue a patent owner domiciled in a regulation or convention state. According to case law this is not a requirement if the patent owner is domiciled in a non-EC and non-Convention state.

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?

Civil liability for contributory infringement exists in that an injunction or interlocutory injunction may be directed towards a person contributing to an infringement. A contribution does not have to be intended as such; liability applies if the action in question has objectively promoted the infringement.

Liability for contributory infringement also exists insofar as liability for patent infringement includes the offer of means pertaining to something essential in the invention with the knowledge that the means are suitable for and intended to be used with the invention.

The Patents Act also allows for criminal liability for inducing or contributing to patent infringement. Such cases are extremely rare.

Multiple parties practising parts of a patent claim and together practising the whole claim are probably individually liable for infringement or possibly for contributory infringement. There is no law or case law on this situation in Sweden.

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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?

Multiple parties can be joined as defendants in the same lawsuit if individual lawsuits against each of the defendants are based on what are substantially the same grounds. Such grounds are related to the infringed patent, the infringing actions as such and the damages caused by the infringement. No other relationship between the defendants is sufficient or necessary, although defendants can normally be expected to be joined by commercial or corporate relationships as well. From this, it follows that all defendants must normally be accused of infringing the same patent.

#### 7 Infringement by foreign activities

Notwithstanding the above-mentioned laws and policies, how much discretion do the authorities have to approve or reject transactions on national interest grounds?

The offer, sale or use of a product that has been produced outside Sweden by a method patented in Sweden constitutes infringement. Otherwise, activities outside Sweden do not constitute infringement.

#### 8 Infringement by equivalents

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

Swedish courts recognise the doctrine of equivalents. When establishing infringement, the courts consider infringement by equivalent means as a secondary alternative to infringement in the literal wording of the patent claim.

Infringement by equivalent means may be established if

- the supposed infringing object solves the same problem or has the same function as the patented invention;
- the difference between the product or process and the invention is simple enough that the substitution of one with the other is obvious to, and could easily be realised by, the skilled person (so the difference does not comprise a patentable invention in itself; and
- the product or process leads to the same result as the invention.

There cannot be an infringement by equivalent means if the difference between the literal wording of the patent claim and the supposed infringing object pertains to a central feature of the patented invention crucial for its patentability or if the equivalence assessment relates to a feature of the patent claim that has been added during prosecution with the express intent to limit the scope of protection in order to exclude prior art. In addition, inventions of a 'simple nature' (such as simple mechanical inventions) do not enjoy protection outside the scope of the literal claim.

# **9** Discovery of evidence

What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

Under civil procedural law there is a limited duty for a defendant or a third party to disclose particular documents or objects that may serve as evidence under a court order.

Provisions in the Patents Act allow for an infringement investigation, which is a procedure ordered by the court upon request of the patent owner or licensee and where the enforcement authority searches an alleged infringer's premises to secure evidence of infringement. The court may also order an alleged infringer to provide certain information related to the alleged infringement (eg, the names of suppliers, importers and buyers).

Court orders apply regardless of the addressee's nationality. It may, however, prove impossible to enforce such orders in certain jurisdictions.

#### **10** Litigation timetable

What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

A patent infringement trial generally takes between 18 and 24 months from filing of the writ of summons to handing down of the judgment in the first instance and another 12 to 18 months in the appellate court. An interlocutory injunction may take about three months to obtain in the first instance.

#### 11 Litigation costs

What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal?

Costs for a patent infringement procedure vary widely but can normally be expected to amount to between €50,000 and €200,000 in the first instance, depending on the complexity of the case. Of such an amount, approximately one-third is pretrial costs. Costs in the appeals court amount to approximately 60 per cent of the costs in the first instance.

#### 12 Court appeals

What avenues of appeal are available following an adverse decision in a patent infringement lawsuit?

Patent infringement decisions may be appealed to the Svea Court of Appeal, which is the exclusive appeals forum for patent litigation. Leave to appeal is required in all cases, and is normally granted for appeal of final decisions and, more rarely, for appeal of temporary injunctions.

The Supreme Court tries cases on appeal from the appeals court. A leave to appeal is required. The Supreme Court seldom tries patent cases, and there has been just a handful of cases tried during the past 40 years.

#### **13** Competition considerations

To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition, or a business-related tort?

Liability for a competition violation after enforcement of a patent has not yet been established in a case in Sweden, but EU competition case law indicates that it may be possible. Market Court case law indicates that liability for unfair competition is, in practice, not recognised. Liability for business-related tort may exist only in connection with criminal liability.

# **14** Alternative dispute resolution

To what extent are alternative dispute resolution techniques available to resolve patent disputes?

Arbitration may be used to resolve patent disputes. To refer a dispute to arbitration, an agreement between the parties to this effect is required. A decision may be enforced only inter partes, but not against a third party or an authority. It is presumably very unusual to resolve patent disputes by arbitration, while contract disputes regarding licensing or transfer of patents are common.

Mediation may be used to resolve disputes and can be used in patent disputes, although it is not common.

During an infringement process in court, the judge is under a legal obligation to investigate settlement possibilities and to assist the parties in negotiations if possible.

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#### Scope and ownership of patents

#### **15** Types of protectable inventions

Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

The basic requirements for patentability are industrial application, novelty and inventive step, while software, business methods and medical procedures are not patentable. Inventions, the use of which would be contrary to public policy or good morals, are not patentable.

For assessment of patentability, Swedish patent law adheres to the provisions of the European Patent Convention (EPC) and the Swedish Patent Office and Swedish courts adhere to European Patent Office (EPO) case law.

The EC Directive 1998/44/EC on the legal protection of biotechnological inventions has been implemented in Sweden.

#### **16** Patent ownership

Who owns the patent on an invention made by a company employee, an independent contractor, multiple inventors or a joint venture? How is patent ownership officially recorded and transferred?

The main principle is that an invention belongs to the inventor. Under legal and collective employee ownership provisions, ownership of an invention made by the employee as part of his or her employment may be transferred to the employer upon the employer's request. Inventions made outside the scope of employment but still in the employer's general line of business may be subject to transfer or licence upon the employer's request. Inventions made outside the employer's line of business belong to the employee.

An individual employment agreement may stipulate otherwise from that stated above, as provisions in individual employment contracts are applicable except when they are superseded by a collective agreement. Invention provisions are included in some collective agreements, mainly applicable in the industrial and service sectors. The law applies where no collective or individual agreements have been made or where they lack relevant provisions.

The main principle of ownership applies to inventions made by independent contractors and patents thereon, but the parties are free to agree on any allocation of ownership.

Ownership of inventions by multiple inventors and patents thereon is not subject to express regulation in law. Ownership is considered to belong to the inventors collectively. The implications of this are widely discussed in doctrine and are considered analogous to implications in connection with collective ownership in other legal fields. Case law on the subject is scarce.

Ownership is officially recorded in the patent authority's patent registry. Registration is not mandatory and has no legal effect on ownership. It does however affect the possibility of pledging the patent. Ownership is transferred under agreement and is not subject to any formal requirements.

#### Defences

## 17 Patent invalidity

How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

An invalidity action may be brought administratively as an opposition with the patent authority during a period of nine months after grant of the patent. An invalidity action may also be brought as a legal action in court during, or after, the patent term. Invalidation grounds include lack of industrial application, lack of novelty and lack of inventive step, as well as lack of correlation between application documents and the granted patent and insufficient disclosure of the invention in the patent.

The Stockholm City Court is the exclusive court in the first instance for patent invalidity proceedings. Court decisions may be appealed to the Svea Court of Appeal in Stockholm and then to the Supreme Court. Appeal requires a granted leave to appeal.

#### **18** Absolute novelty requirement

Is there an 'absolute novelty' requirement for patentability, and if so, are there any exceptions?

Absolute novelty is required for patentability except for a six-month grace period applicable if the invention has been compromised from it being disclosed because of obvious misuse in relation to the applicant or from the applicant having displayed the invention at an officially recognised international exhibition as defined in the 1928 Paris Convention on International Exhibitions.

#### 19 Obviousness or inventiveness test

What is the legal standard for determining whether a patent is 'obvious' or 'inventive' in view of the prior art?

The legal standard for inventiveness is that the invention 'differs considerably from prior art'. This means that a skilled person would not consider the invention to be evident or near at hand. In practice, the EPO's problem and solution method is often used to assess inventive step.

#### 20 Patent unenforceability

Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

There are no provisions relating to unenforceability of a patent under Swedish law.

#### 21 Prior user defence

Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

Use of an method or device prior to the filing of a patent application for such method or device is a defence from infringement claims, regardless of the type of invention and regardless of whether the use is commercial or not. If such use has become known to an unspecified group of people not bound by particular confidentiality undertakings, it is considered public and thereby novelty-destroying. If it has not become public, it provides the prior user a right to continue the use of the invention in essentially the same way as before. Consequently, commercial use may continue but not be increased or altered. Use, prior to the publication date, may give the right to a compulsory licence if there are exceptional reasons for it.

#### Remedies

#### **22** Monetary remedies for infringement

What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature?

The monetary remedies available are fines (applied in combination with injunctions) and damages. There are two different compensations for damages under the Patents Act. Reasonable compensation is applicable to all infringements and calculated to correspond to a reasonable royalty, based on an existing or fictitious licence market, for the use of the infringed right. Additional compensation for damage suffered is applicable to negligent or intentional infringement and is calculated to correspond to the loss suffered by the patent holder or licensee.

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Damages are intended to compensate actual loss, but tend to be set at the lower end by the courts. Punitive damages are not allowed under Swedish patent law.

#### 23 Injunctions against infringement

To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

A temporary injunction can be obtained by a court order if there is probable cause to believe that an infringement has occurred or is occurring and it may reasonably be expected that a continued infringement deteriorates the value of the patent right. A final injunction against future infringement may be obtained through a court order if such infringement is proved. Under particular circumstances, a temporary injunction may be granted ex parte. Injunctions are combined with a fine, the size of which may vary in proportion to the economic value of the infringement for the infringer.

An injunction is not effective against the infringer's suppliers or customers unless they too are defendants in the court procedure.

#### 24 Banning importation of infringing products

To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

The importation of infringing goods may be blocked by the customs authority after identification of the infringing goods. The customs authorities can detain the goods ex officio or, more often, at the request of a patent proprietor. Such requests may be granted for a year at a time and comprise all intellectual property rights of the proprietor, including patent rights. Upon detaining the goods, the customs authorities will alert the patent proprietor, who has to acknowledge the infringement within a few days. If the patent proprietor and the importer can reach a settlement, the customs authorities will destroy the imported goods.

Otherwise, the patent proprietor has to take legal action in court to establish infringement and obtain an injunction and a decision to destroy the goods. The procedure conforms to EU Council Regulation 1383/2003.

# **25** Attorneys' fees

Under what conditions can a successful litigant recover costs and attorneys' fees?

The main principle for recovering litigation costs, including attorney's fees, under procedural law is that the losing party compensates the winning party in full. Where neither party is fully successful there can be partial compensation, or each party may stand its own cost. The amount and allocation of compensation is decided by the court upon the parties' requests and after assessing whether the compensation claimed is reasonable in relation to the time and effort put in by the party and its attorney. It is not unusual for the courts to reduce the compensation awarded to some extent.

# **26** Wilful infringement

Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate?

There are no civil remedies available in addition to what has been mentioned above. Criminal remedies (fine or imprisonment up to six months combined with damages calculated as indicated in question 22) are available, on the conditions that the patent owner reports the

infringer to the police and that the public prosecutor decides that it is in the interest of the public to pursue the case. The latter is very rare. Criminal law standards for determining wilfulness are then applicable.

#### 27 Time limits for lawsuits

What is the time limit for seeking a remedy for patent infringement?

Apart from the patent's expiry date, there is no time limit for seeking and obtaining an injunction against infringement. As regards temporary injunctions, courts are reluctant to grant one if it is apparent that time is not of the essence as the infringement has been known to the patent owner for some time without the owner taking action. This does not apply to final injunctions.

For obtaining damages, there is a statutory limitation to the effect that damages cannot be recovered for an infringement that took place more than five years before a writ of summons was filed with the court of first instance.

#### 28 Patent marking

Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

Marking of patented products is not required. False patent marking is not prohibited under patent law, but can be expected to be so under marketing law. If so, the use of the false marking would be prohibited by an injunction, by the penalty of a fine and the user being liable for damages.

#### Licensing

#### 29 Voluntary licensing

Are there any restrictions on the contractual terms by which a patent owner may license a patent?

In conjunction with EU competition law, Swedish competition law holds provisions regarding abuse of a dominant position and distortion of competition. Regulation 772/2004/EC and the corresponding Swedish competition legislation may be used to assess whether such provisions are applicable to patent licence agreements.

#### 30 Compulsory licences

Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

A compulsory licence may be obtained by court order. The conditions for such order are that:

- the patent owner has failed, without an acceptable reason, to make use of a patented invention to a reasonable extent in Sweden and more than three years has lapsed from grant and four years from the application being filed;
- the use of an invention depends on a patent and the invention represents important technical progress of vital economic interest over the patented invention;
- the utilisation of a certain plant variety depends on a patent and the plant variety represents important technical progress of vital economic interest over the patented invention; or
- the commercial use of an invention is required due to public interest of exceptional importance.

The terms of a compulsory licence are decided by the court.

A compulsory licence has never been granted under Swedish patent law.

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#### Patent office proceedings

#### **31** Patenting timetable and costs

How long does it typically take, and how much does it typically cost, to obtain a patent?

The minimum time to prosecute a patent application with the Swedish Patent Office is about one year, and the expected time is approximately 18 months. Costs vary widely, but average approximately €9,000 including official fees, which start at about €400. Annual fees start at €20 for the first year and increase incrementally up to €450 for the 20th and last year, making the total amount for 20 years €4,500.

#### 32 Expedited patent prosecution

Are there any procedures to expedite patent prosecution?

The Swedish Patent Office has entered into Patent Prosecution Highway agreements with Japan and the United States related to PCT applications.

The applicant may request expedited handling of the patent application, which is granted on a case by case basis depending on the patent office's workload.

#### 33 Patent application contents

What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

The patent application must include a description with information about how the invention may be utilised to industrial practice. The description must be sufficiently clear to allow for a person skilled in the art to practice the invention. The application must also include clear information about what is claimed as an invention (the claims).

#### **34** Prior art disclosure obligations

Must an inventor disclose prior art to the patent office examiner?

There is no formal obligation for an applicant to disclose prior art, although he or she is expected to disclose the closest prior art. Consequently, there is no sanction for non-disclosure.

# 35 Pursuit of additional claims

May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier filed application? If so, what are the applicable requirements or limitations?

If the original (parent) application contains two or more separate inventions, one or more divisional applications may be filed. Divisional applications enjoy the same filing date as the parent application.

If an additional invention is added to a pending application, a break-out application may be filed. The filing date of such a break-out application is the date of the submission to the patent office containing the additional invention.

Divisional and break-out applications must be identified as such on filing and must also identify the parent application.

There is no formal prohibition against filing new applications drawn from the same invention as disclosed in an earlier filed application. However, due to the absolute novelty requirement, pursuit of additional claims to an earlier disclosed invention would only be possible if the first invention cannot be considered as novel, thus not affecting the second application. If the first application has already

#### Update and trends

There are two significant issues affecting Swedish patent law at the moment. One is the continuing adoption of a unified patent and a unified patent court for the EU. Removal of the need for translation of patent claims and altered patenting strategies may affect the national patent system, although it is still not clear how. The procedural rules of the unified court are causing a lot of attention. The location of a local division of the court in Scandinavia and the effects on local courts by the need for expert judges in the local division are also topics widely discussed in the industry and among patent professionals.

The other issue of topical interest is a recently proposed reorganisation of the courts handling patent and other intellectual property cases as well as competition and market law cases. The proposed court organisation would consist of a single court in the first instance (the Patents and Market Court) and one appeals court, handling civil, criminal and administrative matters related to intellectual property, competition and marketing. The courts are expected to be able to uphold expert knowledge by specialisation more easily than present courts, and to be more effective. The reorganisation in itself is not expected to result in any material change of case law. Similar to the local division of the unified patent court, procedural rules and the need for expert judges in the new courts are topics of wide interest.

been published, inventiveness of the second application shall also be assessed in relation to the first invention (this is not the case before publishing of the first application). Thus, it is usually unlikely that an applicant would be successful in filing additional claims related to an invention in an earlier application unless the first application lacks sufficient disclosure of the part of the invention described in the later application or applications.

# **36** Patent office appeals

Is it possible to appeal an adverse decision by the patent office in a court of law?

An adverse decision may be appealed to the Court of Patent Appeals. The Court's decision may be appealed to the Supreme Administrative Court, subject to leave to appeal.

#### **37** Oppositions or protests to patents

Does the patent office provide any mechanism for opposing the grant of a patent?

A nine-month opposition period commences upon grant of the patent. Opposition is open to everyone except the patent proprietor, and entails a re-examination of the patent. The patent may be re-examined for novelty, inventive step, sufficiency of disclosure, added subject matter and patentable subject matter. Both the patent proprietor and the opponent or opponents are parties to the opposition proceedings. After opposition the patent may be upheld, modified or revoked. The provisions for opposition are, thus, very similar to the provisions in the EPC.

#### **38** Priority of invention

Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

Priority is determined by the first-to-file system. Documents filed the same day enjoy the same priority. Consequently there are few, if any, priority disputes. No dispute resolution mechanism is provided for by the patent office.

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#### **39** Modification and re-examination of patents

Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

The patent office provides for a re-examining procedure (see question 37). The office also provides a procedure for modification of the patent in order to limit the scope of protection, or revocation on the patent owner's request. A request for modification may not be approved unless the invention after modification is still clearly described and does not comprise anything in addition to what was filed with the original application.

As an alternative to declaring a patent invalid in its entirety, a court may amend the patent claims during invalidity procedures if the patent is found to be only partly invalid. The amended patent

must conform to the requirements that the invention is still clearly described and does not comprise anything in addition to what was filed with the original application. The amendment must not expand the scope of protection.

#### 40 Patent duration

How is the duration of patent protection determined?

The duration of patent protection is 20 years from the filing date. Medicinal products and plant protection products may enjoy an extension of protection of up to five additional years upon the grant of a supplementary patent certificate. A certificate for a medicinal product may also be extended for six months on request if a paediatric investigation plan has been approved in line with EC Regulation 1901/2006/EC.



# Kristian Fredrikson kristian.fredrikson@delphi.se

 Stora Nygatan 64
 Tel: +46 40 660 79 00

 211 37 Malmö
 Fax: +46 40 660 79 09

 Sweden
 www.delphi.se



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