



International report - Stronger patent protection for patent applicants and owners

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The draft IP Law introduces provisions to strengthen the protection of the rights of both patent applicants and patent owners (for further details please see "TPI finally publishes new draft law").

The current Patent Decree-Law provides that a patent applicant benefits from all of the protection enjoyed by a patent owner. However, the decree-law sticks with this basic principle and does not go into detail. Therefore, the protection of patent applicants' rights has become a matter for the IP courts.

At parliamentary commission meetings regarding the previous law amending the decree-law, it was strongly demanded that protection for patent applications be limited. However, a draft provision of that law stated that patent applicants would not be entitled to file civil or criminal actions in case of infringement; rather, only an action for compensation could be filed. The difference between that law and the new law is drastic.

The draft IP Law provides that the protection given to a patent owner is also given to a patent applicant as of publication of the application. Accordingly, a patent applicant can prevent third parties from:

- producing, selling or importing a product which is the subject of a patent application;
- using a process which is the subject of a patent application;
- proposing that others use a process patent whose use is known or should be known to be prohibited; and
- selling, using or importing products which are obtained directly via the procedure subject to the patent application.

On the other hand, the draft law explicitly states that as of the publication of a patent application, the applicant can file a civil action against infringement of the invention. If the infringing party has been informed of the application or its scope, the publication condition does not apply.

In this respect a patent applicant, just like a patent owner, is entitled to ask the competent court to:

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- determine whether the action in question constitutes an infringement of rights;
- prevent the infringement;
- stop the infringing action;
- remove the infringing material and any immaterial compensation;
- seize the products whose use and manufacture are prohibited, as well as any devices, machines and other instruments used in connection thereto;
- assign the property rights in the seized materials to the plaintiff;
- take measures to prevent the continuation of infringement;
- at the expense of the violating party, change the form of the seized materials, remove the infringing trademarks or destroy them if this is unavoidable in order to prevent infringement;
- and
- if a justified reason or interest exists, at the expense of the infringing party, have the final ruling published fully or as an abstract in a daily newspaper and notified to the interested parties.

Similarly, the patent applicant is also entitled to demand a precautionary injunction in case of an infringing action or a threat of infringement.

The explicit protection provided for pending patent applications is appropriate, considering the patent office's lengthy examination procedure, the years that patents spend in the application phase and the reduction of the 20-year protection term.

Obviously the effectiveness of these provisions will depend on the interpretation and approach of the IP courts. However, as the decree-law also rules on the protection of a patent application, to date most IP courts have not granted preliminary injunctions in the case of pending applications.

On the other hand, while granting protection to patent applications, the draft law for the first time introduces a provision stating that the scope of the protection provided by the patent application is determined by the claims in the application, as published, until the patent is granted. However, the patent, as filed or maintained with amendments in opposition or invalidity proceedings, determines the protection provided by the application retrospectively.

By this provision, the legislature imposes responsibility on the patent applicant or owner in case of enforcing the patent at the application phase or before the patent reaches its final scope of protection. As the final scope of protection of a patent, after opposition or invalidation proceedings, will have a retroactive effect, third parties will be entitled to file actions for compensation due to enforcement of the patent with a wide scope.

There may be some consequences of enforcing the patent or application before its scope is finalised; however, this approach is much more balanced compared to the application having no protection at all, particularly in light of the lengthy examination process (now doubled due to the post-grant opposition procedure introduced by the draft law).

The provision stating that the scope of protection be determined by pending claims at the application phase should remove any hesitation on the part of the IP courts to grant preliminary injunctions based on the rights arising from the application.

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