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Practical cross-border insights into patent law

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1 Patent Enforcement

1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

The Commercial Court in Prishtina has exclusive jurisdiction to hear patent infringement cases.

1.2 Can the parties be required to undertake mediation before commencing court proceedings? Is mediation or arbitration a commonly used alternative to court proceedings?

In principle, the parties are not required to mediate before commencing court proceedings. However, the parties may opt for mediation, or the court may refer the parties to mediation, after the lawsuit is filed. Mediation and arbitration are more common in contract-related disputes than in infringement cases.

1.3 Who is permitted to represent parties to a patent dispute in court?

General provisions on representation are applicable to patent disputes. Hence, litigants can opt for self-representation or have an attorney at law represent them.

1.4 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

To commence proceedings, a party must file a lawsuit which includes the statement of claim. Evidence should be filed before the pre-trial procedure ends.

The fees for commencing a patent infringement dispute are prescribed by the Administrative Instruction No. 01/2017 for the Unification of Court Fees. As from March 2017, the fee for filing a patent infringement lawsuit is EUR 50.

Generally, it takes 12 months for proceedings to reach trial from commencement. After the trial is conducted, it usually takes four weeks for the judgment to be issued.

1.5 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

The general rule is that each party has to provide evidence to support its claims. There are, however, mechanisms to compel a party to disclose or submit relevant documents or materials to its adversary.

Before commencing proceedings, the patentee may request that the court issues an interim measure for the preservation of evidence. The patentee will need to prove that there is an existing or threatened infringement, and that the evidence may be hard to obtain at a later time. Under certain circumstances, such interim measures for the preservation of evidence can be ordered *ex parte*. The measures imposed should be fair, equitable, proportionate and affordable.

After commencing the proceedings, upon request of one party, the court may order the other party to submit evidence in their possession which is relevant for the adjudication of the case.

1.6 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

The parties have to file a statement of claim, a statement of defence, a rejoinder and a counter-rejoinder. They also have to gather and submit the evidence that they intend to present during the trial.

1.7 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

The judge opens the trial and identifies the issues in dispute which will have to be decided. Then, the judge identifies the parties present and determines whether there are any procedural obstacles.

Each party is then invited to present their case, evidence and final statements. In more complicated cases, parties are allowed to submit their final statements in writing within a certain period of time after the trial.

In principle, the evidence or facts that were not presented or disclosed during the pre-trial stage cannot be presented during

the trial, unless the parties prove that it was impossible for them to present those facts or evidence at an earlier time. This applies to both the evidence that existed before the pre-trial stage as well as to evidence that came into existence after the pre-trial stage.

1.8 How long does the trial generally last and how long is it before a judgment is made available?

The trial usually lasts only a few hours. If it cannot be finished within a day, it may continue on another day. It usually takes up to four weeks after the trial for the judgment to become available to the parties.

1.9 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

Patent infringement cases are considered urgent. However, there is no shorter, flexible or streamlined procedure available.

1.10 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

Judgments are made available to the public. The court will periodically publish its judgments on its official website.

1.11 Are courts obliged to follow precedents from previous similar cases as a matter of binding or persuasive authority? Are decisions of any other jurisdictions of persuasive authority?

The judges of the first instance Commercial Court are not obliged to follow precedents from previous similar cases. However, in case of conflicting first instance decisions, the appellate level of the Commercial Court will issue consistent judgments in similar cases.

1.12 Are there specialist judges or hearing officers, and if so, do they have a technical background?

The judges usually do not have a technical background. The judges are experienced in commercial law in general and are not required to have a technical background to decide patent disputes.

1.13 What interest must a party have to bring (i) infringement, (ii) revocation, and (iii) declaratory proceedings?

Only the patent holder or an exclusive licensee have a standing to sue for patent infringement.

Any person can initiate revocation/invalidation actions before the Intellectual Property Office (the IPO). The defendant in an infringement proceeding may also request invalidation of the patent prior to the court decision.

According to the Law on Contested Procedure, declaratory proceedings can be initiated only if specifically provided for in the relevant law (which is not the case with the Law on Patents) or if a party has an interest that the court decides on this matter, i.e. that it declares non-infringement before the patentee initiates court proceedings. Patent enforcement cases are relatively infrequent in Kosovo, so the case law has not yet answered the question of what interest a party must have to bring declaratory proceedings.

1.14 If declarations are available, can they (i) address non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

Declaratory claims can only address the existence or non-existence of a right.

1.15 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of, but not all of, the infringing product or process?

Yes, under the patent law, patent holders may prevent third parties from offering or supplying the product consisting of an essential element of the patented invention, if the third party knew or ought to have known that the product in question was intended to exploit the patented invention, provided that such product is not a staple product.

1.16 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

Yes, the act of importation of the product produced by using a patented process may constitute patent infringement.

1.17 Does the scope of protection of a patent claim extend to non-literal equivalents (a) in the context of challenges to validity, and (b) in relation to infringement?

The content of patent claims is not strictly limited to their wording. This means that the scope of protection provided by a patent should not be limited only to cases of complete or identical infringement of patent claims. The doctrine of equivalents only applies in relation to infringement and not in the context of challenges to validity.

1.18 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition? Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

A defence of patent invalidity can be raised by the defendant during the court proceedings. Kosovo applies a bifurcated system. Once the invalidity of a patent is raised, the court or the defendant will ask the IPO to decide on the validity of the patent within an expedited procedure. The court will stay the proceedings pending the IPO's decision on the patent validity.

1.19 Is it a defence to infringement by equivalence that the equivalent would have lacked novelty or inventive step over the prior art at the priority date of the patent (the "*Formstein* defence")?

Patent litigation is infrequent in Kosovo, so the case law does not answer this question.

1.20 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

A patent may be declared invalid if:

- On the filing date of the patent application or on the priority date if claimed, the invention was not new, did not include an inventive step, was not industrially applicable, or the subject matter was excluded from patentability.
- The invention was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
- The subject matter was extended beyond the content of the patent application as filed or, if the patent was granted on the basis of a divisional application, beyond the content of the earlier application as filed.

1.21 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

Yes, the court may stay infringement proceedings pending resolution of validity by the IPO as the only competent institution to decide on the validity of a patent.

1.22 What other grounds of defence can be raised in addition to non-infringement or invalidity?

The following grounds of defence can be raised in addition to non-infringement or invalidity:

- exploitation of the invention for private and non-commercial purposes;
- acts carried out for research, development and experimental purposes relating to the subject matter of the invention;
- direct and individual preparation of a medicine in a pharmacy on the basis of an individual medical prescription;
- prior user rights;
- exhaustion of rights; and
- statute of limitations.

1.23 (a) Are preliminary injunctions available on (i) an *ex parte* basis, or (ii) an *inter partes* basis? In each case, what is the basis on which they are granted and is there a requirement for a bond? Is it possible to file protective letters with the court to protect against *ex parte* injunctions? (b) Are final injunctions available? (c) Is a public interest defence available to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device? *(Please cross-refer to your answer to question 3.2 if compulsory licensing may be available in this scenario).*

(a) Preliminary injunctions are available on both an *ex parte* and *inter partes* basis. The preliminary injunction is granted if:
- The patentees prove that their patent has been infringed or that it is being attempted or threatened to be infringed.
- The issuance of the injunction is intended to be fair, equitable, proportionate and affordable.

The issuance of the preliminary injunction is almost always subject to payment of a deposit/bond. The filing of protective letters with the court to protect against *ex parte* injunctions is not available.

(b) Final injunctions are granted if the patent is found to have been infringed on the merits.

(c) There is no legal provision which provides for the possibility to invoke public interest as a defence against a patent infringement claim. To the best of our knowledge, the case law also does not answer this question.

1.24 Are damages or an account of profits assessed with the issues of infringement/validity or separately? On what basis are damages or an account of profits assessed? Are punitive/flagrancy damages available?

Damages are assessed together with the issues of infringement/validity. However, it is possible to request a separate assessment of damages or an account of profits.

When determining the amount of damages, the court will take into account all relevant aspects such as adverse economic consequences, including lost profits incurred by the injured party, any unjust profit of the infringer and, where appropriate, other aspects such as economic factors and the moral prejudice caused to the right holder. As an alternative to this, in certain cases, compensation may also be calculated as a lump sum on the basis of factors such as the amount of compensation or fees that would have been attainable if the infringer had sought a licence to use the patent.

With the aim of reducing the scale of infringement, the law provides punitive provisions and penalty amounts. However, they are not regularly applied in practice.

1.25 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

If not enforced voluntarily, court orders can be enforced through private bailiffs. A request for compulsory execution of the judgment has to be filed with a licensed bailiff.

1.26 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

The patent holder may ask the court to:

- confirm the existence of infringement and prohibit future infringing acts; and
- order the seizure and destruction of infringing products.

Under certain circumstances, the court may replace the order for the seizure and destruction of infringing goods with monetary compensation for the injured party.

The patent holder may also:

- claim damages;
- request publication of the court decision; and
- ask the court to order the infringer to disclose the identity of third persons involved in the production and distribution of infringing goods and of their channels of distribution.

The courts do not grant cross-border relief.

1.27 How common is settlement of infringement proceedings prior to trial?

Disputes are often settled during the pre-trial stage.

1.28 After what period is a claim for patent infringement time-barred?

Infringement claims, claims relating to the seizure and destruction of goods, as well as claims for damages may be filed within

three years from the date the right holder became aware of the infringement and the infringer, and no later than five years from the date the infringement occurred.

1.29 Is there a right of appeal from a first instance judgment, and if so, is it a right to contest all aspects of the judgment?

A first instance judgment can be appealed within seven days from the receipt of the judgment, at the appellate level of the Commercial Court, on the grounds that the first instance violated procedural provisions, did not determine the relevant facts or wrongfully applied substantive provisions.

1.30 What effect does an appeal have on the award of: (i) an injunction; (ii) an enquiry as to damages or an account of profits; or (iii) an order that a patent be revoked?

An appeal will not affect the award of an injunction since the first instance decision on injunctive relief is enforceable. The opposing party can request suspension of enforcement under certain circumstances. An appeal will, however, have a suspensive effect on an award on the merits and invalidation decisions. If an appeal is filed, the decision of the first instance cannot be considered final and enforceable.

1.31 Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

At the appellate stage, cases are generally decided by way of a review by the panel of three judges. However, under certain circumstances, the appellate instance may schedule a hearing and re-hear the case entirely. New evidence can be submitted only if the party proves their objective inability to present this evidence during the first instance trial.

1.32 How long does it usually take for an appeal to be heard?

It usually takes 12–16 months from the filing of an appeal to the issuance of the decision.

1.33 How many levels of appeal are there? Is there a right to a second level of appeal? How often in practice is there a second level of appeal in patent cases?

There is only one level of appeal. The decision issued by the appellate instance of the Commercial Court is final and binding. An extraordinary appeal can be brought before the Supreme Court in special circumstances, i.e. if the dispute value exceeds EUR 30,000.

1.34 What are the typical costs of proceedings to a first instance judgment on: (i) infringement; and (ii) validity? How much of such costs are recoverable from the losing party? What are the typical costs of an appeal and are they recoverable?

The costs depend on many factors, including the complexity and duration of the proceedings. The court fees are not high, but attorney's fees vary significantly.

As a rough estimate, the average costs of first instance proceedings would be about EUR 7,000–8,000. Considering that all evidence is gathered during the first instance proceedings and that the court usually does not schedule a hearing in the appeal procedure, the costs of an appeal are around half the costs of the first instance trial.

Typically, litigation costs are awarded against the losing party who must reimburse the other party. Attorney's fees are usually granted only in the amount specified by the Regulation of the Chamber of Advocates.

1.35 For jurisdictions within the European Union: What is the status in your jurisdiction on ratifying the Unified Patent Court Agreement and preparing for the unitary patent package? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

This is not applicable to our jurisdiction.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant, and if so, how?

Once the filing date is assigned, the patent application cannot be amended if such amendments result in the extension of the subject matter beyond the content of the application as originally filed. After grant, a patent can be amended by submitting the evidence on patentability. Once the grant decision is issued, a patent holder, who has filed a patent application for the same invention in any other office, i.e. the European Patent Office (the EPO), must submit to the local IPO written evidence confirming the patentability of the subject matter, before the expiry of the ninth year of the patent term. If the IPO considers that the patentability requirements are met only partially, the IPO will amend the patent claims and reissue amended patent specifications as per the patentee's request.

2.2 Can a patent be amended in *inter partes* revocation/invalidity proceedings?

A patent can be amended in *inter partes* in invalidity proceedings. If the IPO finds that the patent should be invalidated partially, the IPO will amend the patent claims and, upon the payment of the prescribed fee, re-issue amended patent specifications.

2.3 Are there any constraints upon the amendments that may be made?

The amendments should not extend the subject matter of the invention beyond the content of the application as originally filed.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

The Law on Protection of Competition can limit the contractual terms in general. Namely, the rules on anticompetitive agreements and the abuse of a dominant position are also relevant to

patent licensing. The Law on Obligations also provides certain limitations to the licensed patent rights.

3.2 Can a patent be the subject of a compulsory licence, and if so, how are the terms settled and how common is this type of licence?

Yes, under certain circumstances, an interested party may request from the court to obtain the licence for the exploitation of the patented invention. This request cannot be filed before the expiration of a period of four years from the filing date of a patent application or prior to the expiry of three years from the issuance of the grant decision.

Compulsory licences may be issued if the invention has not been used or has not been sufficiently used in Kosovo, and if the exploitation of the invention is necessary in situations of urgency (national security, public interest protection in the field of health, food supply, environmental protection or specific commercial interests) or when it is necessary to remedy a practice which was determined in judicial or administrative proceedings as anti-competitive.

The scope and duration of the compulsory licence is determined by the court. To the best of our knowledge, so far there have been no requests for granting a compulsory licence to a party.

4 Patent Term Extension

4.1 Can the term of a patent be extended, and if so, (i) on what grounds, and (ii) for how long?

It is possible to extend the 20-year patent term for inventions related to pharmaceutical and plant products that require a marketing authorisation. A supplementary protection certificate (SPC) is available for such products for an additional maximum period of five years.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable, and if not, what types are excluded?

The following subject matter is excluded from patentability:

- discoveries, scientific theories and mathematical methods;
- aesthetic creations;
- schemes, rules and methods for playing games and for intellectual or business activities;
- computer programs;
- claims relating to the presentation of information, without a technical character or effect;
- inventions contrary to public interest and humanity and moral principles;
- human cloning methods, human clones and methods that modify the genetic integrity of human embryo cells;
- uses of human embryos for industrial or commercial purposes;
- processes for modifying the genetic identity of animals;
- claims relating to animal breeds and plant varieties, and essentially biological processes for the production of plants or animals;
- the human body, at various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene;
- diagnostic or surgical methods or methods of treatment practised directly on the human or animal body, except for the products, in particular substances or compositions used in such methods; and
- substances obtained through nuclear transformations for military purposes.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

No such duty is prescribed by law.

5.3 May the grant of a patent by the Patent Office be opposed by a third party, and if so, when can this be done?

The IPO publishes a patent after it is granted. Therefore, third parties can only request an invalidation of the patent. A procedure to oppose a pending patent application is not provided by law.

5.4 Is there a right of appeal from a decision of the Patent Office, and if so, to whom?

IPO decisions can be appealed within 30 days from the receipt of the decision before the Commission of Appeals, which is competent to review and decide on IPO decisions as the first instance decision maker. The party can request judicial review of the Commission's decision by filing a lawsuit before the competent court, within another 30-day deadline.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

Disputes over entitlement to priority arise in invalidity proceedings and are resolved by applying the first to file rule. Ownership disputes are resolved in court.

5.6 Is there a "grace period" in your jurisdiction, and if so, how long is it?

There is a grace period of six months before the filing date, if the invention was disclosed as a consequence of an evident abuse in relation to the applicant or his legal predecessor. The grace period also applies if the applicant or his legal predecessor displayed the invention at an official, or officially recognised, international exhibition, provided that the applicant indicates in the patent application, at the time of its filing, that the invention has been so displayed, and submits a corresponding certificate within four months from the filing date.

5.7 What is the term of a patent?

The term of validity is 20 years from the application filing date, if the patent is properly maintained. If the patentee does not submit the evidence on patentability by the end of the ninth year of protection, the patent will expire on the last day of the 10th year.

5.8 Is double patenting allowed?

No such provisions are included in the law.

5.9 For jurisdictions within the European Union: Once the Unified Patent Court Agreement enters into force, will a Unitary Patent, on grant, take effect in your jurisdiction?

This is not applicable to our jurisdiction.

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products, and if so, how quickly are such measures resolved?

Customs actions and measures against goods suspected of infringing patent rights are prescribed by the Law on Customs Measures for the Protection of Intellectual Property Rights. Customs may detain goods suspected of infringing patent rights either *ex officio* or pursuant to a customs watch application filed by the patent holder.

After the customs watch application has been approved, Kosovo Customs will detain the goods entering or leaving the territory of Kosovo, as well as goods in transit suspected of infringing patent rights. In case the importer does not agree that the detained products infringe the patent in question and, therefore, does not consent to their destruction under the accelerated procedure, the patentee can initiate legal actions. In this case, Customs will detain the goods until the case is decided by the court.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

The provisions of the Law on Protection of Competition can be deployed against the patentee. However, up until now, no such arguments were raised before the competent authorities.

7.2 What limitations are put on patent licensing due to antitrust law?

Patent licensing and assignment agreements, as well as other contracts related to patent rights, are subject to competition law provisions, just as any other transactions and arrangements.

7.3 In cases involving standard essential patents, are technical trials on patent validity and infringement heard separately from proceedings relating to the assessment of fair reasonable and non-discriminatory (FRAND) licences? Do courts set FRAND terms (or would they do so in principle)? Do courts grant FRAND injunctions, i.e. final injunctions against patent infringement unless and until defendants enter into a FRAND licence?

Patent litigation does not happen on a regular basis in Kosovo. Therefore, the case law does not answer this question.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

The new patent law entered into force in Kosovo on February 4, 2022. An important change brought by the new law relates to SPCs. While the previous law included provisions related to SPCs, they never entered into force because they were subject to Kosovo's potential EU membership. Under the new law, the SPC provisions are not subject to Kosovo's eventual EU accession. The SPC chapter includes provisions regarding the SPC subject matter, examination and application processes, exceptions to SPC rights and conditions for obtaining and invalidating an SPC.

8.2 Are there any significant developments expected in the next year?

No significant developments can be foreseen, because patent infringement and invalidity cases are irregular in Kosovo, just as they are in most other developing Eastern European jurisdictions. The number of national patent applications is also not particularly high. Kosovo is not a signatory state of the Patent Cooperation Treaty (PCT) or European Patent Convention (EPC). The only way to obtain a patent in Kosovo is to file a national patent application with the Kosovo IPO.

8.3 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Enforcement of patent rights is relatively infrequent in Kosovo. It is a relatively new jurisdiction, so no general practice or enforcement trends have yet become apparent.

Kujtesa Nezaj-Shehu has more than 15 years of experience in intellectual property, with her practice focusing on contentious and non-contentious patent, trademark, industrial design and copyright matters. She has successfully represented leading multinational companies across various industries, including oil, automotive, apparel, and food and beverage, in numerous IP matters, with a particular focus on enforcement of IP rights before the local customs authorities, courts and the Kosovo Industrial Property Office, where she is a certified Patent and Trademark Agent. Kujtesa is a certified trainer of the Kosovo Bar Association and regularly provides training on trademarks to Bar members. She was also a consultant in several USAID projects involving the preparation of trademark and patent manuals for attorneys and judges, and she has also provided training for judges from courts of different instances. Kujtesa is also listed as an arbitrator with the Alternative Dispute Resolution Center of the American Chamber of Commerce in Kosovo.

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SDP KOSOVË is a legal firm specialising in intellectual property protection, based in Prishtina, Kosovo, since 2007. As a firm of two attorneys at law and three authorised trademark and patent attorneys, we provide a full range of intellectual property services, including prosecution and enforcement of patents, trademarks and industrial designs and advising clients on anti-counterfeiting strategies. We represent clients before the courts and the Kosovo Industrial Property Office, as well as the local customs authorities. We service some of the world's major companies, such as one of the world's leading oil manufacturers, a major U.S. sportswear company, a well-known multinational fast fashion company and one of the world's largest pharmaceutical corporations. SDP KOSOVË is a member of the International Trademark Association.

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