Should national nullity proceedings be stayed until parallel EPO opposition proceedings are resolved?

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As the readers will know, the complex architecture of the European patent system allows third parties to challenge the validity of a patent by filing an opposition before the European Patent Office ("EPO"), by filing a revocation action before national Courts, or by using both routes. In some cases, this has given rise to the co-existence of parallel proceedings before the EPO and before Spanish Courts where the validity of the patent has been discussed.

In some of these cases the patentee requested the suspension on the proceedings on the grounds that it would not be efficient to prosecute the national case, since the time and resources invested in the case would have been wasted in the event that the patent were ultimately revoked by the EPO. Since neither the European Patent Convention nor the Spanish Civil Procedure Law contain a clear legal basis allowing Spanish Courts to stay the national nullity proceedings in this type of situation unless the parties agree, patentees have tried to use article 100 of EC Regulation 40/94 (i.e. the Community Trademark Regulation) via analogy. However, these attempts have not been successful, as our Courts have found that said article cannot be applied to patent cases.

The recent revocation by the EPO of patents relating to products such as Fosamax and Lescol has highlighted the inefficiencies of the Spanish "way", as the revocation came at a time when the parties and the judicial system had invested vast resources in the prosecution of national proceedings where the validity of the patent was also discussed. All in all, it would be desirable for Spain to follow the path of other European countries where the Judge may stay the proceedings unless there are specific circumstances that justify pursuing parallel validity proceedings.