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IP infringement is (almost) always urgent, says the Court of Turin

Daniela Ampollini (Trevisan & Cuonzo) · Thursday, March 21st, 2013

By decision of 21 February 2013, the Court of Turin clarified the test for *prima facie* case in search proceedings and the test for urgency in search proceedings and preliminary proceedings in general. In the case at issue, 4B-Four Bind had obtained an *ex-parte* search order aimed at inspecting post-print binding machines of competitor KGS, alleged to be infringing 4B's patents. During the *inter-partes* hearing which took place after the execution of the search, KGS argued that the legal requirements of *prima facie* case and urgency had not been met and this gave the court the occasion to extensively clarify, also in general terms and not only by reference to the specific circumstances involved, the criteria to be followed in this respect. As regards the *prima facie* case for the grant of a search order, the Court stated that *"Considering the reduced invasiveness, for the juridical sphere of the defendant, of a measure aimed at collecting evidence such as the measure of search is (...), a reduced level of prima facie case (i.e. a reduced likelihood that the claim is granted in the merit) is sufficient, and such a level of prima facie case may in fact coincide with the mere uncertainty as to the resolution of the dispute"*. As regards the requirement of urgency, as far as search orders are concerned, the court specified that such a requirement mainly has to do with the right of the claimant to obtain the evidence of the infringement. In other words, as long as the search is virtually the only way to obtain the requested evidence, no additional "urgency" should be required. But even more interesting is the passage of the decision in which the court dwells on the requirement of urgency in general and, therefore, also in relation to preliminary injunctions: *"In the presence of an ongoing infringement of an intellectual property right, the danger in delay (...) may easily be presumed in consideration of the peculiarity of the phenomenon of infringement; in such a case the danger in delay (i.e. the significant gap of efficacy incurring between the grant of an immediate measure and the grant of a measure which is postponed until the conclusion of merits proceedings) exists intrinsically as the linkage to the sphere and the products of a competitor irreversibly causes a drainage of clientele and a devaluation and discredit of commercial image; It remains of course possible to demonstrate that, in the specific case, contrary to what normally happens, no sufficiently appreciable danger in delay exists"*. Furthermore, on KGS' objection that, in any event, the inexistence of the urgency requirement would have been demonstrated by delay in seeking relief, as the applicant had been aware of the infringement for a long time, the Court replied what

follows: *"No provision of law establishes a deadline for the commencement of preliminary proceedings to react to an infringement of industrial property rights; instead, it is reasonable to allow the interested party an adequate timeframe for deliberation, also with a view to allowing the same to consider options aimed at avoiding the dispute and in any event appropriately prepare for litigation; the passing of time in preliminary proceedings may become relevant only in case irreversible effects have been produced, in such a way that the requested measures are useless; no tolerance can per se be inferred by a delay in the filing of the action, based on the general juridical irrelevance of silence; at the most, the delay in filing the action may cause a joint liability of the harmed party for having concurred in aggravating the harm; however it cannot exclude the existence of the harm deriving from the ongoing violation"*. In summary, a rather generous approach in allowing preliminary proceedings, which does not seem to be in line with that of other more restrictive courts, such as for instance the Court of Milan.

This entry was posted on Thursday, March 21st, 2013 at 1:38 pm and is filed under Italy, Procedure
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