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The Difficult Interface between Opposition Proceedings before the EPO and parallel national proceedings: will the new Spanish Patent Act shed some light?

Miquel Montaña (Clifford Chance) · Friday, September 4th, 2015

One of the tricky consequences of Article 64 of the European Patent Convention (“EPC”), which establishes that the European patent is immediately enforceable after its publication, and Article 99, which provides for “post-grant” oppositions, is that quite often the combination of these two articles fuels two trains that run in parallel where the validity of the patent is revisited. Since the EPC does not contain any provision addressing this situation, this leaves it up to the national laws of contracting parties to the EPC to devise a solution.

In contrast, the Community Trademark Regulation, for example, establishes that a Community trademark court hearing one of the actions envisaged in the Regulation, other than an action seeking a declaration of non-infringement, shall (unless there are special grounds for continuing the proceedings), of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trademark is already in issue before another Community trademark court, on account of a counterclaim, or where an application for revocation or for a declaration of invalidity has already been filed at the OHIM.

This solution does not appear ideal, either, as it may leave the trademark owner with a dormant trademark, at least *inter partes*, for a rather long time, which, in some cases, could not be fair, unless the Court were to order a preliminary injunction to protect the trademark owner while the validity of the trademark is revisited.

Going back to patent cases, in jurisdictions where Judges are given discretion to decide whether or not the stay of the proceedings may be justified by new facts, national Courts may decide whether or not national proceedings should be stayed until the EPO’s parallel opposition proceedings are resolved, taking into account factors such as the likely time scales of the respective proceedings. Unfortunately, in Spain, the Civil Procedure Act seems to be based on the premise that Judges should not be allowed to exercise their common sense. So no matter how unreasonable – under the circumstance of the case – not staying the proceedings would be, the Court simply cannot stay the case unless the two parties agree. In a number of cases, this has caused the parties to spend time and money in useless litigation in scenarios where it was foreseeable that the opposition proceedings before the EPO would end first.

Law 24/2015, dated 24 July, on Patents (the “New Patent Act”) does not provide a solution to this problem either. However, it has introduced a provision that will allow Spanish Judges to have some leeway for manoeuvre, at least when the patent has been limited in parallel proceedings before the EPO

or before the Spanish Patent and Trademarks Office, as the case may be. According to Article 120.4 of the New Patent Act, when the patent is modified outside the proceedings, the patent owner may request that the modified patent become the basis of the proceedings. In these cases, the Judge will hear allegations from the other parties. However, the decision as to whether the modified patent should become the basis of the proceedings will fall to the Judge.

All in all, in some cases, this provision will help to reduce some of the pitfalls raised by the difficult interface between opposition proceedings before the EPO and national proceedings.

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