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The bumpy road of non-exclusive licensees in Spanish Patent Litigation

Miquel Montaña (Clifford Chance) · Sunday, December 25th, 2016

According to the Spanish Patents Act, as a general rule, non-exclusive licensees do not have locus standi. However, when a third party is infringing the patent, they may require the patent owner to take action. According to the Law, if the patent owner fails to take action within three months, the non-exclusive licensee may then take action on its own. In previous cases, our Courts have interpreted that when a non-exclusive licensee litigates hand-in-hand with the patent owner, the locus standi of the former is unquestionable, as it is entitled to claim its own damages. For example, this was the conclusion reached by the Barcelona Commercial Court number 1 in a Ruling of 31 July 2008, using arguments that were embraced by the Barcelona Court of Appeal (Section 15) in a Ruling of 28 June 2010. In fact, this Court had already advanced in a judgment of 12 June 2001 that it goes without saying that a non-exclusive licensee has locus standi when the complaint has been filed jointly with the patent owner.

Against this background, the judgment of 9 December 2016 from Barcelona Commercial Court number 4, where the Court denied the locus standi of a non-exclusive licensee who had filed a complaint jointly with the patent owner for not having complied with the three-month formal notice, came as a big surprise. Not only because it contradicts the doctrine stemming from the Barcelona Court of Appeal (Section 15) but also because it contradicts the criteria followed by the same Court in previous cases. Yes, it turns out that the very same Court, when another Judge was in charge, who has since then been promoted to the Court of Appeal, at paragraph 77 of its judgment of 20 October 2014, rejected the same locus standi objection, on the grounds that it is clear that licensees and even distributors have a legitimate interest in taking part in judicial proceedings initiated by the patent owner.

So the conclusion of this case is that, as announced in the title of this blog, non-exclusive licensees embarking in patent litigation in this country must be equipped to drive along a bumpy road.

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