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Decision finding that “Swiss claims” were affected by Spain’s Reservation to the EPC now revoked

Miquel Montaña (Clifford Chance) · Monday, June 18th, 2018

In July 2017, the Patents Court of Barcelona handed down a decision finding that “Swiss-type” claims were affected by the Reservation made by Spain when it ratified the European Patent Convention (“EPC”), whereby European patents, insofar as they confer protection on chemical or pharmaceutical products *“as such”*, shall be ineffective in Spain. In particular, the decision lifted a preliminary injunction that had been ordered *“ex parte”*, based on claim 16 of the patent asserted, and which read as follows:

“Use according to claim 15, wherein the pharmaceutical composition is for treating hypercholesterolemia, hyperlipoproteinemia and atherosclerosis”.

This decision caused an earthquake within Spanish patent circles for several reasons.

First, because of the clarity of the case law from the Supreme Court, which in many previous judgments had already rejected the proposition that “Swiss-type” claims were affected by Spain’s Reservation to the EPC. However, to be fair to the Court, it must be said that the judgment of 18 July 2013 from the Court of Justice of the European Union (“CJEU”), with regard to TRIPS and pharmaceutical patents in the *Daiichi* case, caused a lot of confusion among Spanish Courts. For a more elaborated discussion on the formidable paradoxes raised by that judgment readers will find an article by this author in *IIC - International Review of Intellectual Property and Competition Law* (2017) 48: 784-812. It is also fair to add that on 19 December 2016 the Court of Appeal of Barcelona (Section 15) had published a decision in another somewhat similar case (albeit dealing with EPC 2000 “product-limited-by-use” claims), which was probably less clear than it could have been.

The second reason why the decision shocked the patent community was because of the astronomical damages caused by the lifting of the preliminary injunction. In a scenario where prudence normally leans towards maintaining the status quo, this decision followed a different path.

Now all this is history. For in a decision dated 16 May 2018, the Court of Appeal of Barcelona (Section 15) revoked that controversial decision and reiterated that “Swiss-type” claims were not affected by Spain’s Reservation to the EPC. In spite of

upholding the appeal, the Court of Appeal noted that the preliminary injunction could not be reinstated because the Supplementary Protection Certificate had already expired.

All in all, this case is a rather harsh and sad illustration of the astronomical damages that may be caused by the lifting of a preliminary injunction and the impossibility of effectively remedying a judicial error in cases where the intellectual property right asserted is subject to an expiry date, such as in the case of patents.

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