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Indicia of infringement: a video might not be sufficient

Miquel Montaña (Clifford Chance) · Monday, April 15th, 2019

A recently published Decision of 9 November 2018 from Barcelona Commercial Court number 5 sheds some light on the indicia that may or may not be sufficient for the purposes of ordering a preliminary injunction “ex parte”. For the readers’ benefit, it will be useful to clarify that under Spanish law, one of the requirements that an applicant for a preliminary injunction must meet is the so-called “fumus boni iuris.” Literally translated from Latin, this means “smoke of good right.” So, the applicant must submit *prima facie* evidence of infringement.

In the case at hand, the patentee requested the Court to order a preliminary injunction “ex parte” alleging that, otherwise, the defendant would be able to exhibit its products in a forthcoming trade fair. For the purposes of proving “fumus boni iuris”, the applicant filed a promotional video regarding the product to be marketed by the defendant (a “welding without cleaning” device). However, the Court considered that the video filed did not contain sufficient detail to carry out the in-depth technical analysis normally required to examine an allegation of patent infringement. The most interesting parts of the decision on this point may be found in paragraphs 3.5-3.7:

“3.5 Unlike under other intellectual property laws, for example, trademark law, where a video of the allegedly infringing act could serve as grounds for the adoption of a preliminary injunction as onerous as the one requested, under patent law, the extremely technical nature of its object requires a direct analysis, one that is precise and rigorous and that ultimately follows certain internationally harmonised standards and guidelines for verification, experimentation and testing by sector (chemical, mechanical, biogenetic, etc).

3.6 The analysis of the infringement under patent law requires that a comparison be done between the scope of the patent’s claims and the disputed working seen to be infringing, determining if it meets each and every one of the elements or characteristics claimed of the former. In such a way that the absence, or any minor change of any element or characteristic in that comparison can determine that no infringement exists. Essentially, it is a comparison which, depending on the specific scope of the science, can reach a high level of detail and precision: a molecule having a lesser or greater quantity or weight of water in a chemical compound; a mechanical tool with a higher or lower number of slots for other components or parts; a genetic variation of a species of vegetable... The

consequences can be very decisive, to the point where often a simple characteristic or element of the claim mark the essential and dividing line between the state of the art and the innovation protected.

3.7 In the present case, the expert report which was submitted, using as a basis a comparison between the claims of the protected patent and a video of the disputed working, does not at all give us either the assurance or sufficient elements with which to do a thorough examination or comparison which might enable us to consider the first prerequisite of the injunction applied for to have been met, namely: reasonable indicia that the allegedly infringing device meets each and every one of the characteristics of the claims of patent ES '786."

Another interesting aspect of the case is that the Court found that there was something fishy in the applicant's behavior. Whereas in 2014, in a similar scenario, the applicant had sent a warning letter to the defendant, the Court found it odd that no warning letter had been sent this time:

"4.11 We consider that the omission behavior on the part of [...], of not having sent a warning letter before filing the request for precautionary measures, in coherence with its own previous acts and, in addition, a few days ahead of an international trade fair, may not be entirely in line with normal diligence and good faith prior to any judicial process."

All in all, the teaching of this case is that unless a video has adequate level of detail, it may not be sufficient to prove indicia of patent infringement in preliminary injunction proceedings.

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