

# Kluwer Patent Blog

## **Court of Appeal of Barcelona alerts that you may not extend provisional measures already adopted against other products “as you go”**

Miquel Montaña (Clifford Chance) · Thursday, June 18th, 2020

One of the most salient features of Spanish patent litigation, in comparison to other countries, such as the United Kingdom, is its extreme rigidity. Judges do not seem entitled to have a sip of water during Court hearings unless a specific provision of the law empowers them to do so. A recent Decision dated 19 May 2020 from the Court of Appeal of Barcelona is highly illustrative of such rigidity. Although the facts of the case were so convoluted that it would be impossible to expound them within the narrow bounds of this blog, the main points of interest may be summarized as follows:

The patent holder, on the eve of the 2019 edition of the Mobile World Congress, filed an application for provisional measures asking the Judge to seize some models of mobile phone handsets expected to be exhibited during the fair. At the same time, the applicant requested the Judge to carry out some “saisie-contrefaçon” type investigations to find out whether other mobile phone handsets that the applicant had not been able to purchase fell within the scope of protection of the applicant’s patent and, if so, “extend” the provisional measures (i.e. seizure and preliminary injunction orders) also against this second group of handsets. The First Instance Judge decided to “bifurcate” the proceedings (i.e. one procedure dealing with the application for provisional measures and another procedure dealing with the application for the “saisie-contrefaçon” inspection), which resulted in a saga of different decisions, an explanation of which would require forcing the readers to navigate a complex labyrinth, which is unnecessary for the purposes of this blog.

The main point of interest discussed in the appeal before the Court of Appeal of Barcelona was whether the First Instance Judge was empowered to “extend” against the second group of handsets (i.e. those investigated during the “saisie-contrefaçon” inspection) the provisional measures initially adopted against the first group of handsets. To put this debate in context, it is worth mentioning that Art. 733.2, second paragraph, of the Civil Procedure Act allows the judge to adopt provisional measures (e.g. a preliminary injunction) “ex parte” when the applicant justifies special reasons of urgency. On the other hand, Art. 732.2 reads as follows:

*“When provisional measures are requested in relation to processes initiated by lawsuits seeking the prohibition or cessation of illegal activities, it may also be*

*proposed to the court that, urgently and without giving notice of the request to the defendant, it commission reports or order investigations that the applicant cannot carry out and that are necessary to resolve the request.”*

To sum-up, in its recent Decision of 19 May 2020, the Court of Appeal of Barcelona has highlighted that this investigation procedure cannot be “decomposed” from the provisional measures procedure, because its objective is to clarify the facts so that the judge can decide whether or not the provisional measures may be adopted. This interesting decision has also highlighted that if, for example, a provisional measure has already been adopted against product A, and from the aforementioned investigation procedure it turns out that product B also falls within the scope of protection of the patent, the provisional measures already adopted cannot be “extended” to product B. The patent holder must file a new application for a preliminary injunction requesting the adoption of provisional measures against product B also. The most interesting paragraphs of the decision read as follows:

2. *Once the measures for the verification of facts or provisional measures have been ordered, they cannot be extended, as it is not legally envisaged for this kind of procedure. Measures for verification in relation to patents are regulated in articles 123 et seq of the Patent Act, and there is no provision for extension once they have been ordered. With regard to interim injunctions, the parties can request modification of the same, pursuant to article 743 of the Civil Procedure Act (LEC), but such modification must be carried out in accordance with the terms of article 734 LEC.*
3. *Therefore, if the patent holder wants to request the examination of new products by means of this kind of measures, after they have been ordered, it has to apply for new verification measures, which must be processed in accordance with the terms of the law. As such, we must confirm the decision of the judge to reject the extension of the procedures once the measures initially requested had already been ordered and, even more so, when they had already been carried out.*

[...]

5. *On the other hand, although also related to the above, Spanish legislation does not allow for the possibility of such a flexible provisional process. The object of the same, that is, the measures to be adopted, regardless of the procedure for doing so, must be specified in the application and cannot be migrated or extended depending on the outcome of the investigations carried out in the provisional process itself, because this would violate legal certainty and the rights of the parties. The provisional measures, once adopted, can be modified, but only in the terms established by the legislator. What the legislator has not regulated is an open or progressive provisional process, a la carte, at least in the context of civil procedure. If, as a result of the measures for the verification of facts, it transpires that a product may infringe the applicant’s patent, it, having been informed of the outcome of the procedures, can submit a new application for provisional measures, but cannot change the previous one. If this occurs as a result of investigation measures ordered in the provisional proceedings, the applicant may request the modification of the measures ordered in the manner envisaged in the LEC. What the judge cannot do is order measures depending on the outcome of the procedures, without a party requesting it.”*

Fair enough. But by the time the applicant is able to file a fresh application for provisional measures, have it processed, and obtain a decision, the 110,000 participants in the Mobile World Congress will already be back home.

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