Barcelona Appeal Court sheds some light on the difficult interface between national infringement proceedings and parallel EPO opposition proceedings

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For many years, due to the rigidity of Spanish civil procedure, it was very difficult, if not impossible, to accommodate in national infringement proceedings events that may have taken place in parallel proceedings where the validity of the relevant patent was discussed, namely, opposition proceedings before the European Patent Office (“EPO”). For example, when the patent was revoked in opposition proceedings, the effect on national infringement proceedings was clear: the termination of the proceedings. On the contrary, the effect was far from clear when in opposition proceedings the patent was maintained in amended form.

The new Patents Act that came into force on 1 April 2017 tried to alleviate this anomaly by introducing article 120.4, which reads as follows:

“[…]
when, due to supervening circumstances, the patent is modified outside the proceedings, the patentee will be able to request that the patent as modified serve as the basis for the proceedings. In these cases, the Judge or Court must grant the other parties to the proceedings the opportunity to present allegations.”

Although this provision is certainly better than nothing, it left some loose ends. For example, it does not clarify whether or not the Judge or Court must accept that the patent as amended become the basis for the national infringement proceeding.

Against this background, the judgment of 16 October 2020 from the Barcelona Appeal Court (Section 15), which sheds some light on the interpretation of this provision, must be most welcome. The main facts of the case can be summarized as follows:

Corning Optical (“Corning”) filed an infringement action against Huawei based on a European patent. Commercial Court number 4 in Barcelona, in a judgment of 9 April 2018, upheld the infringement action filed by Corning and dismissed the revocation counterclaim filed by Huawei. The latter then filed an appeal to the Barcelona Court of Appeal (Section 15).

Huawei requested the suspension of the appeal procedure until the EPO Board of Appeal resolved an appeal that was pending against a decision from an Opposition Division that had found the patent to be invalid. Although Spanish courts are normally very reluctant to suspend national infringement proceedings when there is a parallel opposition procedure pending before the EPO, this time, due to the proximity of the date of the hearing of the EPO appeal, the Barcelona Court of Appeal (Section 15) made an exception and suspended the national appeal proceedings. At the end of the oral hearing, the Board of Appeal announced that the patent had been found to be valid in a limited form. In other words, it upheld the validity of one of the sets of claims proposed by the patentee in its auxiliary requests.

In view of this, the defendant (Huawei) requested the Barcelona Court of Appeal (Section 15) to find that the EPO decision had caused a “supervening lack of object” in the Spanish infringement proceedings (i.e. the patent no longer existed with retrospective effect) and, as a result, upheld the appeal against the judgment that had found the claims as granted to be infringed.