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"Preparatory acts" and "offering for sale": crossing the red light district

Miquel Montaña (Clifford Chance) · Thursday, November 3rd, 2011

On 6 October 2011, Commercial Court number 5 of Barcelona handed down a judgment that has revisited the fine border between the safe territory of so-called “preparatory acts” and the prohibited region of “offers for sale”.

MSD filed a patent infringement action against a Spanish company that had obtained marketing authorisation and price to market generics of Montelukast, a product protected by a patent until 25 August 2012. In the complaint, the patentee attached a report from a private investigator, who had placed an order with the defendant, which had been accepted by the latter.

In the statement of defence, the defendant argued that their “preparatory acts” were exempted from the realm of patent infringement by the “Bolar” provision. In addition, they argued that the alleged negotiations between the private investigator and the company were merely “preliminary tracts”, but that no “offer for sale” had yet been made. According to the defendant, it had only offered a dossier, but the supply of the product was subject to the prior obtaining of a marketing authorisation by the prospective client.

Upon considering the evidence on record, the Court noted that the defendant had actually requested from the prospective client (i.e. the private investigator) an estimation of the foreseeable sales for the next three years so that the defendant could prepare an offer. Also, the Court noted that the defendant did prepare this offer, which included a 25% discount. From this, the Court concluded that if one prepares an economic offer it is because one is prepared to comply with the conditions negotiated and supply the infringing product. In addition, the Court highlighted that the “Bolar” provision could not exempt the acts carried out by the defendant, because it only covers acts carried out until the marketing authorisation is obtained. According to the Court, the “Bolar” provision would not cover acts carried out after the marketing authorisation is granted.

All in all, this judgment has clarified that the shadow of the “Bolar” provision ends when the marketing authorisation is granted, and that any acts carried out thereafter entail the risk of crossing the red light district.

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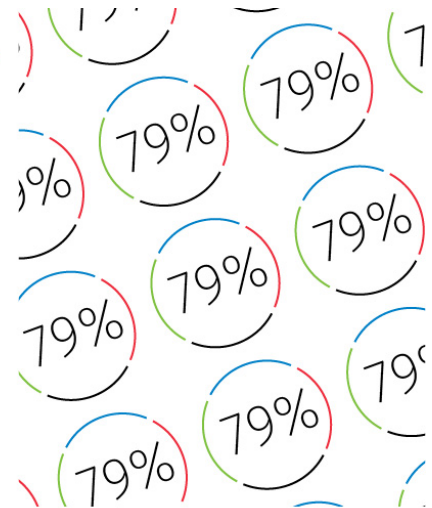
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