Kluwer Patent Blog

More on Scope of Validity Review in the Context of Preliminary Injunctions

Miquel Montañá (Clifford Chance) · Tuesday, August 7th, 2012

One of the recurrent topics in patent litigation in Spain is whether or not a Court can review the validity of a patent in the context of preliminary injunction proceedings. According to some Courts, life is too short in preliminary injunction proceedings. If the Court had to embark upon analysing the validity of the patent, what would be left for the main proceedings?

This view has been combated on the grounds that the Patent Act states that the validity of the patent may be challenged by the defendant in any type of proceedings. Preliminary injunction proceedings should not be an exception, as the Patent Act does not foresee such an exception.

For the readers' benefit, it should be clarified that, under Spanish law, the defendant must develop and prove all the arguments to oppose the preliminary injunction at an oral hearing, which typically lasts not more than four to five hours. This means that the applicant and the Judge learn for the first time at this hearing the arguments raised against validity. For example, any expert opinions filed to challenge the validity of the patent are filed at this hearing. In practice, this forces the applicant to review such expert opinions on the go. Also, assuming that the Judge would accept the statements of their authors at the hearing, the applicant must improvise questions to be asked to such experts on the spot. Not surprisingly, in its judgment of 24 January 2011, the Barcelona Court of Appeal (Section 15) took the view that, in this situation, the applicant would only be allowed to defend the validity of the patent properly if the Judge kept the analysis of validity to a minimum or if the Judge suspended the hearing to allow the applicant to prepare a proper defence. The problem of the latter alternative is, of course, that it does not quite fit with the summary nature of preliminary injunction proceedings.

Another recent example of the position of the Spanish Courts on this matter can be found in the judgment of 14 June 2012 of the Commercial Court of Granada. In this case, the Court had ordered an "ex parte" preliminary injunction on 14 November 2011. The defendant filed an opposition based mainly on the alleged lack of inventive step of the patent and "added matter". In particular, the defendant alleged that the fact that the patentee had voluntarily filed a self-limitation request before the European Patent Office under Article 105 bis of the European Patent Convention would prove the fragility of the patent. Also, the defendant contended that the invalidity of the patent had been declared by a first instance judgment in Germany.

In its judgment of 14 June 2012, the Commercial Court of Granada, based on the decision of 14 October of 2011 from the Granada Court of Appeal, highlighted that invalidity can only be accepted as a grounds for opposition in preliminary proceedings when the lack of validity is crystal-clear. The Court added that the burden of proving invalidity is on the defendant, who must file very clear indicia which allow the Court to provisionally see the possible nullity of the patent.

After assessing the indicia filed by the defendant, the Court concluded that a self-limitation before the EPO does not necessarily amount to an implicit acceptance that the patent, as granted, may not be valid. As the Court noted in its previous decision, there may be opportunistic reasons (for example, to not waste time and money defending the claims as granted) which may lead a patentee to request the limitation of its patent. With regard to the German precedent, the Court found that a first instance decision which does not have any effects in Spain is not sufficient to destroy the presumption of validity of a patent which was examined by the EPO.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please subscribe here.

This entry was posted on Tuesday, August 7th, 2012 at 10:02 am and is filed under Procedure, Spain, Validity
You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.