

Kluwer Patent Blog

Lifting the fog

Miquel Montaña (Clifford Chance) · Tuesday, October 23rd, 2012

One of the remedies available to intellectual property owners introduced by what is known as the Enforcement Directive was the publication of the judgment where infringement is declared. This remedy was already foreseen in article 63 of the 1986 Spanish Patents Act, which includes among the remedies available to the patent owner, inter alia, “the publication of the judgment condemning the infringer, at the expense of the latter, through announcements and notifications to the interested persons. This measure only will be applicable when the judgment expressly stipulates as much.”

What it is less clear is whether this remedy is also available to third parties filing declaratory non-infringement actions. Since the Spanish Patents Act does not clarify whether this remedy is available in the context of declaratory non-infringement actions and, if so, which would be the test to be applied to decide whether the publication would be warranted, guidance may be sought in the recent case law of other European Courts. Hence the relevance of the very recent Judgment of 18 October 2012 from the English Court of Appeal (Civil Division) on appeal from the High Court of Justice, Chancery Division Patents Court, in the case between Samsung Electronics (UK) Limited and Apple Inc [2012] EWCA Civ 1339. Although it is a designs rather than a patent case, the reasoning of the Court may well be applicable to patent cases.

To put the decision of the Court as far as the publication of the judgment is concerned in context, the relevant facts – for this purpose – can be briefly summarized as follows:

By mid-2011, Apple applied ex parte for a preliminary injunction in Germany arguing that Samsung’s Galaxy 10.1 tablets infringed a Community design registered by Apple in 2004 (Community Design No. 000181607-0001). The preliminary injunction was granted on a pan-European basis without Samsung having had an opportunity to be heard. The preliminary injunction, which also affected Galaxy 8.9 tablets, was later extended to Galaxy 7.7 tablets. These judicial decisions caused massive publicity in the Summer of 2011.

On 8 September 2011, Samsung filed declaratory non-infringement actions in some European jurisdictions where such actions are possible, namely in The Netherlands, in England and in Spain. In England, HHJ Birss QC, sitting as a Deputy Judge of the Patents Court, handed down two judgments favourable to Samsung. In his judgment of 9 July 2012 [2012] EWHC 1882 (Pat) he reached the conclusion that the 10.1, 8.9 and 7.7 tablets did not infringe Apple’s design. In his second judgment, given on 18 July 2012, he decided that Apple should publish a notice on the judgment where non-infringement was declared on the homepage of its UK website and on a page earlier than page 6 in the Financial Times, the Daily Mail, The Guardian, Mobile Magazine and T3 magazine. The Court of Appeal confirmed both decisions through a judgment of 18 October 2012, which is final.

In paragraph 75 of its Judgment, the Court of Appeal (the Judge Rapporteur being Sir Robin Jacob) noted that “it will not always be appropriate” to order the publication of a judgment where non-

infringement has been declared. It added that “Whether or not it is depends on all the circumstances of the case – as I said earlier where there is a real need to dispel commercial uncertainty. It is that test I propose to apply here.”

From then on, in paragraph 78 i) the Court highlighted that “The pan-European injunction in respect of the 10.1 and later the 8.9 and 7.7 obtained ex parte by Apple on 4th August 2011 received massive publicity. ” The Court also noted that after Judge Birss handed down his judgment of 9 July 2012 declaring non-infringement, Apple obtained an order from the German Oberlandesgericht banning Samsung from selling the 7.7 tablet throughout Europe. The Court highlighted that “That order received massive publicity in the press too.”

Applying the “need to dispel commercial uncertainty” test, and in view of the massive publicity received by the German decisions, the Court concluded that the publication order was necessary. In paragraph 84 it wrote that “Of course our decision fully understood actually lifts the fog that the cloud of litigation concerning the alleged infringement of the Apple registered design by the Samsung Galaxy 10.1, 8.9 and 7.7 tablets must have created. And doubtless the decision will be widely publicized. But media reports now, given the uncertainty created by the conflicting reports of the past, are not enough. Another lot of media reports, reporting more or less accurately that Samsung have not only finally won but been vindicated on appeal may not be enough to disperse all the fog. It is now necessary to make assurance doubly so. Apple itself must (having created the confusion) make the position clear: that it acknowledges that the court has decided that these Samsung products do not infringe its registered design. The acknowledgement must come from the horse’s mouth. Nothing short of that will be sure to do the job completely.”

So the teaching from this case is that the publication of a judgment declaring non-infringement may be justified when it is a proportionate measure to lift the fog.

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

Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Tuesday, October 23rd, 2012 at 10:23 am and is filed under [\(Cross-border\) jurisdiction, Procedure](#)

You can follow any responses to this entry through the [Comments \(RSS\) feed](#). Both comments and pings are currently closed.