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Strict rules on interest to bring proceedings in Italian interlocutory DJ actions

Daniela Ampollini (Trevisan & Cuonzo) · Monday, February 25th, 2013

In one of my earlier posts I gave the news that, after years of uncertainty as to the admissibility of interlocutory (pre trial) declaratory judgements of non infringement in IP cases (here), the amendments introduced to the Italian IP Code in 2010 made it clear that such proceedings are admissible as now explicitly contemplated by statutory provisions. Therefore, DJ actions can be instituted by means of interlocutory proceedings, leading to a declaration of non infringement after a fast-track process. The courts have now experimented this tool on quite some occasions and it is now clear that in order for motions for interlocutory declarations of non infringement not to be rejected on procedural grounds, some strict requirements have to be met. The most relevant of these requirements appears to be the applicant's interest in bringing proceedings. According to Italian law (Article 100 Civil Procedural Code), one of the conditions of all court actions is that the applicant have an interest in the result at which the action is aimed, which result cannot be obtained without resorting to court. Furthermore, such an interest must be persisting until completion of proceedings. When it comes to interlocutory proceedings, generally speaking, no such interest would persist if the same result can be reached through ordinary proceedings. In a few recent decisions, the Court of Milan has in particular stated that an interlocutory DJ action of non infringement will only succeed if there is an actual threat of reaction by the patent holder and if the alleged infringer refrains from carrying out the potentially infringing activity until the issue of the order of the court in the interlocutory DJ proceedings. Otherwise, the applicant clearly has no interest, as the issue of such an urgent decision will not serve any appreciable purpose, that could not be reached through ordinary proceedings. One example is AstraZeneca v. Ranbaxy, Court of Milan, 6 December 2012. In this case, the motion for interlocutory declaratory judgment of non infringement filed by Ranbaxy was eventually dismissed as the court noted that, in fact, Ranbaxy had not waited for the decision of the court to launch its generic version of the AstraZeneca product, and AstraZeneca, which had initially filed infringement proceedings against Ranbaxy, had meanwhile withdrawn the same.

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