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Goodbye patent, so long litigation

Miquel Montaña (Clifford Chance) · Thursday, March 21st, 2013

The complexities of European patent architecture raise a number of issues relating to the interface between opposition proceedings before the European Patent Office (“EPO”) and infringement proceedings before national courts. A recent case has raised one of such issues, namely: what the impact should be of the revocation of the patent by the EPO in an ongoing infringement action before the national courts.

The debate was sparked by Article 22 of the Spanish Civil Procedure Act, which states that legal proceedings may be terminated without making a decision on costs when there is a supervening loss of object (i.e. the subject matter of the case ceases to exist).

In the case before the Spanish Courts, the patent owner had filed a patent infringement action against several companies that were marketing the patented product in Spain. In their statements of defence, the defendants challenged the validity of the patent, which had also been challenged in parallel before the EPO. Both cases made progress in parallel until the patent was finally revoked by the EPO.

The defendants then asked the Spanish Judge to terminate the validity proceedings with no costs awarded, on the grounds that the patent had been revoked by the EPO and, therefore, the “object” of the litigation had ceased to exist. In contrast, they asked the Spanish Judge to hand down a formal judgment dismissing the infringement action and ordering the complainant to bear the costs of the infringement proceedings.

On the other hand, the patentee contended that since the “object” (i.e. the patent) of the litigation had ceased to exist, both the nullity action and the infringement action should be terminated without an award of costs, as both actions were dependant on an object (the patent) which had ceased to exist.

In its recent judgment of 28 February 2013, Commercial Court number 6 of Barcelona came to the conclusion that since, according to Article 68 of the European Patent Convention, the revocation of a European patent has retrospective effects (i.e. *ex tunc*), after the revocation of the patent, the Judge was no longer able to hand down a judgment on infringement. Therefore, the Court concluded that both the nullity action and the infringement action should be discontinued with no awarding of costs.

So the lesson from this judgment, which is not final, seems to be clear: goodbye patent, so long litigation.

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