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Is "imminence" required in the main proceedings?

Miquel Montañá (Clifford Chance) · Friday, May 3rd, 2013

One of the remedies introduced by Directive EC 2004/48, of 29 April 2004, was preliminary injunctions aimed at prohibiting acts of infringement when there are indicia indicating that an act of infringement may be “imminent.” It is the nature of preliminary injunctions, which require an element of urgency, that patentees may be required to prove the need of a provisional prohibition before the main case is resolved. This is where the “imminent” requirement comes into play.

Against this background, in a recent case the parties discussed whether or not “imminence” is also a requirement for upholding an action aimed at prohibiting acts of infringement that have not yet taken place. In its judgment 18/2013 of 21 January 2013 (*Eisai Co. Ltd, Eisai Farmacéutica S.A. and Pfizer S.A. v. Mylan Pharmaceuticals S.L.*) the Court of Appeal of Barcelona (Section 15, Judge Rapporteur Mr Luis Garrido Espa) concluded that “imminence” is not a requirement for upholding a “prohibition” action in the main proceedings. In particular, the Court noted that “for upholding a prohibition action, it would not be necessary to reach the conviction that the infringement appears as *imminent* (notwithstanding the fact that when regulating preliminary injunctions, Article 134.1 of the Patent Act alludes, due to the foundation of all preliminary injunctions, to the *imminence* of the infringing acts)”. The Court added that, “it must be sufficient, in a reasonable assessment, a founded risk that the infringement may materialise, for the sole will of the agent, insofar as it may be deduced from the preparatory acts carried out. The infringement that one tries to avoid, in this case, through the prohibition action is not the marketing of the generics at any time, but its launch onto the market before the complainant’s patent rights expire”.

After applying this legal test to the facts of the case, the Court concluded that in relation to this specific case the “prohibition” action could not be upheld, since the Court considered that both before the litigation and in the course of the litigation the defendant had assumed a firm undertaking not to launch before the patent’s expiry. Does this mean that the “prohibition” action should be upheld when a defendant refuses to accept an undertaking not to launch until the patent expires? The answer will be provided by another Spanish Court shortly. So this blog entry is to be continued...

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