

# Kluwer Patent Blog

## Barcelona Court of Appeal writes penultimate word on "imminence"

Miquel Montaña (Clifford Chance) · Tuesday, July 2nd, 2013

On 10 June 2013 the Court of Appeal of Barcelona handed down a very interesting decision that appears to have written the penultimate word in the long saga of decisions discussing the meaning of “imminence.”

As discussed in other blogs, although the so-called “Enforcement Directive” (Directive 2004/48/EC) was meant to strengthen the protection of intellectual property rights across the European Union (“EU”), in some areas (for example, preliminary injunctions) it had the opposite effect. This was due to the introduction of a new requirement (imminence) that was not previously present in the patent laws of some EU member states. For example, in Spain, in the early 2000s, Courts would order a preliminary injunction provided that the applicant met the “*periculum in mora*” (danger in the delay) and “*fumus boni iuris*” (prima facie evidence showing likelihood of success) requirements. No “imminence” was required.

After the implementation of the Enforcement Directive, article 134.1 of the 1986 Patents Act states that a preliminary injunction prohibiting an act may be ordered “[...] *when rational indicia exist to suppose the imminence of said acts.*”

Since the coming into force of this reform, Spanish Courts have struggled to draw the thin line between what it is “imminent” and what it is not. In our blog of 27 December 2012, we discussed the decisions of 1 August 2012 and 13 December 2012 from Commercial Court number 1 of Barcelona. The first decision ordered an “ex parte” preliminary injunction that was then lifted by the second decision, as the Judge understood that at the hearing when the defendant was heard, the latter undertook not to launch their product for as long as the patent in question remained in force.

In the decision of 10 June 2013 announced at the outset of this blog, the Court of Appeal of Barcelona (Section 15) revoked the latter decision after considering that: i) contrary to what the Judge of First Instance had assumed, at the hearing of the preliminary injunction the defendant did not assume a firm undertaking not to launch; ii) although each of the indicia alleged to prove “imminence”, taken alone, would have been insufficient to meet this requirement, the combination of indicia alleged, taken together, was sufficient to assume that the defendant could launch their product onto the market before the expiry date of the patent. As a consequence, the Court of Appeal reinstated the preliminary injunction ordered by the Court of first instance in its Decision of 1 August 2012.

According to the Court of Appeal, the requirement that infringement is “imminent” has the following meaning:

The first characteristic is “clarity.” According to the Court, it is not sufficient for infringement to be possible or even probable. An additional element is required, infringement must be “imminent,” that is, the acts must show that “*infringement will take place effectively and soon.*”

The Court then found that “imminence” requires two characteristic notes: (i) on the one hand, a qualified probability that the event is to take place; (ii) on the other hand, proximity in time.

In relation to the “qualified probability” requirement, the Court found that the possibility to order a preliminary injunction that in practice anticipates the protection of the patent calls for a cautious interpretation of the indicia filed to prove “imminence.” According to the Court, it is not sufficient to prove that it is more likely than not that the defendant may launch its product before the patent expires. The applicant must show that there is a “very qualified probability” that the defendant may launch.

Moving on to the “proximity in time” requirement, the Court noted that this is a “relative” concept that must be assessed taking into account the time normally required to obtain a preliminary injunction. Against this background, the Court noted that some days or a few weeks would show this “proximity”, whereas years would not show this proximity in time. According to the Court, it would be safe to consider that there is an “imminent” threat of infringement when an application for a preliminary injunction is filed approximately two months before the date when the defendant is expected to launch its product. However, the Court preferred to leave it open, as it considered that the proximity in time required will depend on the specific circumstances of each case.

Finally, the Court considered that the indicia filed must be conclusive, in other words, the traditional threshold of evidence (“*more probable than not*”) would not be sufficient to show that there is an “imminent” threat of infringement. Therefore, according to the Court this fourth characteristic requires “[...] *conclusive indicia on the risk of infringement, so that we cannot consider sufficient those indicia that may be equivocal or less than certain.*”

After announcing the fourth characteristic that, according to the Court, would define the “imminence” requirement, the Court examined the specific facts of the case at hand:

The first indicia examined by the Court was the fact that the defendant had obtained an authorization to market a product that would infringe the patent. According to the Court, although obtaining a marketing authorization is not in itself an act of infringement, this act must be interpreted in the context of the other indicia alleged.

The second indicia analyzed was the fact that the defendant had failed to answer two warning letters sent by the patentee. The Court noted that although it is doubtful whether the defendant was required to respond in the short time frame given (6 days), it is very relevant that the defendant opted not to give an undertaking when it filed its writ of opposition against the preliminary injunction ordered “*ex parte.*” According to the Court, this fact allows one to form the view that the infringement “*was probable.*” However, the Court felt that “*an additional plus*” was required.

The third indicia considered was the fact that the patent is due to expire in 2019. The Court noted that in the absence of a specific justification, the fact that the marketing authorization was obtained seven years ahead of the expiry date of the patent was “*an additional datum that confers strength*”

*to the indicia examined before.”*

The Court then dealt with the argument that according to the so-called “sunset clause” the marketing authorization would expire within 3 years unless the defendant launched its product. Again, the Court found that although this fact, taken alone, would not be sufficient, it “[...] *contributes to give consistency to the idea that an authorization obtained so far in advance is indicative of the wish to market immediately.*”

Finally, the Court examined the transcendence that offering and / or obtaining price could have had. Since, in its Decision of 1 August 2012, Commercial Court number 1 of Barcelona had prohibited the defendant from making a price offer to the Ministry of Health, the Court of Appeal noted that this prohibition prevents one from knowing whether or not the defendant would have made a price offer in the absence of the Decision of 1 August 2012. According to the Court of Appeal “*the irruption of the preliminary injunction has prevented us from ascertaining a fact that could have founded a favorable judgment on the imminence of the infringement with greater certainty,*” that is, whether or not the defendant would have made a price offer.

In any event, taking all the indicia discussed together, the Court of Appeal concluded that this combination of indicia, in the case at hand, showed that the risk of infringement was imminent. According to the Court, to a lesser extent, the opposition filed by the defendant against the preliminary injunction ordered “*ex parte*” further confirmed that there was an imminent threat of infringement.

In conclusion, although the criteria expressed in this very interesting decision have shed some further guidance on how to interpret the blurring contours of the frontiers of “imminence,” it is doubtful whether these criteria will be here to stay. For example, the “clarity” of the indicia that this decision appears to require does not seem to find support in the wording of the Enforcement Directive. The Directive simply requires indicia of imminence. It does not require these indicia to be particularly qualified, persuasive or clear. Also, the introduction of an additional requirement (“clear” indicia of imminence) in addition to the new requirement (“imminence”) introduced by the Directive appears to fly in the face of the winds that inspired the Directive, which, as mentioned, was meant to make preliminary injunctions easier to obtain. It was not meant to place stumbling blocks in the way of intellectual property rights’ owners needing urgent protection from the Courts.

All in all, it does not seem to be possible to craft magic tests of imminence that may fit all cases. So, like in the case at hand, in future cases Courts are expected to continue to make “ad hoc” analyses based on the specific combination of indicia discussed in each case.

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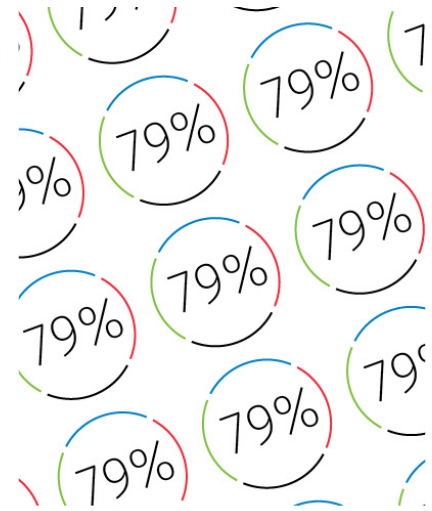
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