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# Kluwer Patent Blog

## Clearing the way

Miquel Montaña (Clifford Chance) · Thursday, September 5th, 2013

A long time has already passed since 23 October 2001, when Judge Jacob ordered a preliminary injunction preventing the launch of the first paroxetine generics in England. To cut a long story short, the rationale was that, if there is an obstacle blocking your way into the “garden”, you have to clear the way before entering the “garden”. Otherwise, you may be enjoined. This rationale has since then been followed by Judges in England, but also in other jurisdictions such as Germany.

On 22 July 2013, Commercial Court number 4 of Barcelona handed down an interesting decision wherein the same logic transpires. The patent owner had sent a warning letter to a third party who had obtained authorisation to market a product covered by the patent and who refused to undertake not to launch until the patent expired. According to the third party, the patent in question would be invalid and, therefore, an undertaking not to launch would not be justified.

Against this background, the patent owner filed an application to the Commercial Courts of Barcelona, seeking a preliminary injunction preventing the launch of the generic. On 18 March 2013, Barcelona Commercial Court number 4, to which the case was assigned, ordered an “ex parte” preliminary injunction. The defendant filed an opposition and the Court called the parties to a hearing which took place on 23 and 29 May 2013, during which the defendant developed the arguments against the patent’s validity. On 22 July 2013, the Court handed down a new decision, confirming the preliminary injunction and ordering the defendant to bear the costs of the proceedings. After an exhaustive analysis of the arguments mastered by the defendant to question the validity of the patent, the Court rejected them and noted that, in the context of preliminary injunction proceedings, for a Court to reject a preliminary injunction, the indicia against the validity of the patent must be “very solid.” The Court added that no one had filed an opposition against the patent in question and that, in the only country in the world where a revocation action had been filed (the United States), the Courts had concluded that the patent was valid.

All in all, this decision is in line with other precedents from other European jurisdictions where Judges have found that the best way to successfully resist a preliminary injunction is to clear the way.

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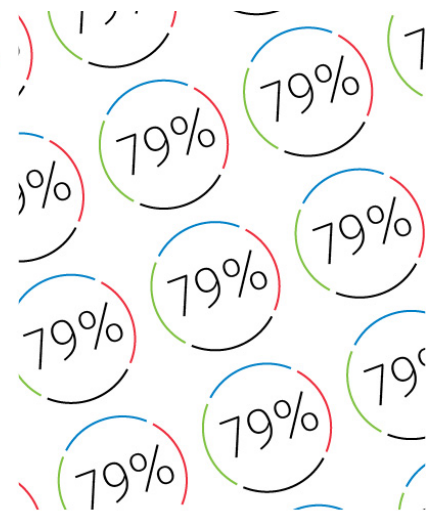
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