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Protective writs in Spain?

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As the readers may know, what is referred to as a “protective writ” is an anticipatory defensive mechanism that a person that fears to be sued for patent infringement may use in countries such as Germany, the Netherlands or Belgium to put Courts on notice of the non-infringement arguments relied on by the hypothetical future defendant. Their purpose is to make it more difficult for the patentee to obtain an “ex parte” preliminary injunction.

A Decision of 18 January 2013 handed down by Commercial Court number 4 of Barcelona, upheld by a Decision of 8 February 2013 from the same Court, has sparked the debate as to whether “protective writs” are now available also in Spain. For the reasons set out below, this does not appear to be the case. The facts of the case may be summarised as follows:

In December 2012, a patent owner sent a warning letter to a generics company that had obtained a marketing authorisation to market a product falling within the scope of protection of one of the patents owned by the former. The addressee of the warning letter sent a response questioning the validity of said patent for lack of inventive step. In parallel, it filed a “protective writ” before the Commercial Courts of Barcelona explaining the reasons why, in its opinion, the patent was invalid.

The case was assigned to Commercial Court number 4 of Barcelona. On 18 January 2013, the Court made a decision noting that although “protective writs” are not established by Spanish law, it would be convenient and useful to try to find a suitable procedure to accommodate these types of petitions. In particular, the Court noted that the admission of this mechanism would serve a twofold purpose. First, it is a convenient mechanism, as it would allow the Judge to limit the adoption of “ex parte” preliminary injunctions to cases where this would be especially justified, as the Judge would know the defendants’ arguments in advance. Second, it is a useful mechanism, as it would allow the Judge to call the parties to a hearing and resolve the preliminary injunction application much quicker, as it would not be necessary to serve the application on the defendant’s registered address. It could be served directly on the defendant’s representative before the Court.

In relation to the procedural vehicle to channel the “protective writ”, the Court decided to apply via analogy an old procedure taken from the 1881 Civil Procedure Act. Following this procedure, the Court decided to notify the Decision of 18 January 2013 to the patentee’s lawyers, so that the patentee was aware that, if it were to apply for an “ex parte” preliminary injunction, it would only be adopted “ex parte” in cases of ” duly justified extreme urgency.”

The Court added that, in the future, in this case any notifications would be made directly on the defendants' representative at Court.

Although the patentee would have been entitled to file a "motion for reconsideration" against this decision, it did not do so. It consented to the decision, which, in any event would speed up a hypothetical future preliminary injunction procedure. In contrast, the party that had filed the "protective writ" did file a motion for reconsideration based, among other arguments, on the allegation that the "protective writ" should not have been served on the patentee.

On 8 February 2013, the Court handed down a new decision dismissing the motion for reconsideration. In the decision, the Court highlighted that one thing is to try to look for a possible legal basis to try to accommodate a person's interest in filing a "protective writ", and a very different thing is to do so in a clandestine way, hiding the existence of this procedure to the patentee. In particular, the Court noted that it is a basic principle of Spanish Civil Procedure Act that all Court decisions must be notified to the persons that may be affected by such decisions.

In parallel, it turned out that the company that had sent the "protective writ" had obtained marketing authorisation and price to market a product falling within the patent's scope of protection. The patentee filed an application for a preliminary injunction, which was ordered "ex parte" by the same Court on 18 March 2013. After hearing the defendant, the preliminary injunction was upheld by the same Court on 22 July 2013.

More recently, Commercial Court number 5 of Barcelona handed down a Decision of 3 June 2013 based on similar arguments. But again, this decision was consented by the patentee, which avoided any judicial debate around the legal admissibility of this mechanism under Spanish law.

All in all, it does not seem that these cases may be interpreted as generally opening the door to "protective writs" in Spain. The acquiescence of the patentees avoided any debate about its legal admissibility in these specific cases. If in future cases patentees question the legality of this procedure, Spanish Courts may of course come to different conclusions.

This entry was posted on Thursday, October 17th, 2013 at 4:29 pm and is filed under Spain
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