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Legitimate interest in obtaining a Judgment on infringement from a national Court persists even after patent has been revoked by EPO

Miquel Montaña (Clifford Chance) · Thursday, September 4th, 2014

As the readers well know, the European Patent Convention (“EPC”) system allows the validity of European patents to be challenged through two different routes: (i) oppositions filed before the European Patent Office (“EPO”); and (ii) revocation actions filed before national Courts. This system, which has its advantages, has disadvantages as well. For example, it may result in a waste of the time, money and other resources invested into litigating before a national Court if, when the proceedings before the national Court are at an advanced stage, the train that is running in parallel before the EPO leads the patent to the revocation station.

In countries where Judges have discretion to decide whether or not national proceedings may be stayed until the parallel opposition proceedings before the EPO are resolved this is less of a problem, as the Judge may stay the case, thus avoiding an unnecessary waste of time and resources. However, in countries where Judges have less discretion and are bound by unnecessary rigid rules of civil procedure, such as Spain, there is less leeway for Judges to stay the proceedings unless they make a purposive interpretation of the law or apply via analogy the solutions devised for similar situations in regulations applicable to other intellectual property such as European Union trademarks and designs. But so far Spanish Judges have not been keen to stay the proceedings in this type of context unless both parties agree. Since it seems to be in the nature of lawyers to feel that they must systematically oppose any proposals arriving from the other side, no matter how sound they might be, these types of agreements have been very rare in practice, which have caused the two trains to go their own way, sometimes heading nowhere.

This is what happened in a case recently resolved by the Court of Appeal of Barcelona (Section 15) in a decision dated 24 July 2014. While the national proceedings dealing with infringement and validity were well underway, the patent was revoked by the EPO’s Chambers of Appeal. This raised the question as to whether the national proceedings should be discontinued or whether the party seeking the revocation of the patent still had a legitimate interest in obtaining a declaration of non-infringement and nullity. The patent owner asked the Court to discontinue the proceedings on the grounds that according to the EPC the revocation of a European patent has retrospective effect (“ex tunc”). This was opposed by the party that had filed the revocation action arguing that it was entitled to obtain a declaratory judgment from the national Court. After hearing the parties, Commercial Court number 6 of Barcelona handed down a decision on 28 February 2013 ordering the proceedings to be discontinued without awarding costs.

This decision has now been revoked by the aforementioned decision of 24 July 2014 from the Court of Appeal of Barcelona (Section 15). To sum up, according to the Court of Appeal the revocation of the patent by the EPO does not affect the object of the initial infringement action, which was not validity but infringement. According to the Court *“The unenforceability of the patent will have an impact, certainly, on the fortune of the action brought forth, [i.e. the infringement action] but not on determining the conclusion of the proceedings due to a supervening loss of the object of litigation, rather the decision in the lawsuit.”*

In conclusion, if the criteria expressed in this judgment is followed by Spanish Courts in future cases the teaching will be that a party may still have legitimate interest in obtaining a judgment declaring non-infringement even after the patent on which the infringement action was based is no longer in force.

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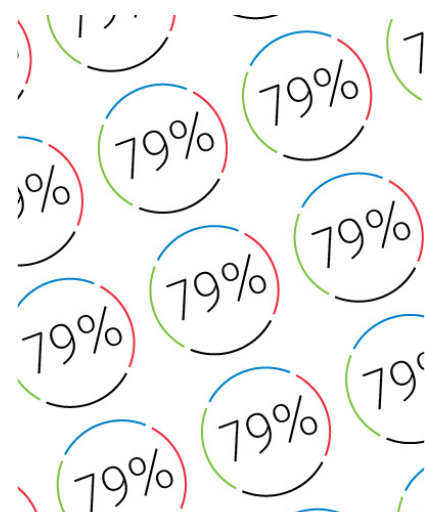
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