

Kluwer Patent Blog

Not accepting an undertaking entails an intention to market the allegedly infringing product

Miquel Montaña (Clifford Chance) · Thursday, October 2nd, 2014

On 12 September 2014, the Barcelona Court of Appeal (Section 15) handed down a decision confirming a preliminary injunction preventing a Spanish company from marketing capsules claimed to be compatible with what is known as the Nespresso® system, which raises a handful of interesting legal points.

The first point of interest discussed was whether or not the appeal proceedings against the first instance decision which had ordered a preliminary injunction should be discontinued after the Court of First Instance (Barcelona Commercial Court number 5) handed down a judgment on the merits, upholding the infringement complaint. After the judgment in the main proceedings came out, the complainant (i.e. the patentee) asked the Court of Appeal to discontinue the appeal proceedings dealing with the preliminary injunction, alleging that the latter had become a moot discussion, after the Court of First Instance handed down a judgment favourable to the patentee in the main proceedings. However, the Court of Appeal disagreed. According to it, the fact that the Court of First Instance had already made a judgment favourable to the complainant (i.e. the patentee) in the main proceedings did not deprive the defendant from having a legitimate interest in obtaining a decision from the Court of Appeal regarding whether or not the preliminary injunction had been correctly ordered. So the Court of Appeal decided to continue with the appeal.

Moving on to the merits of the case, in the writ of appeal filed against the decision that had ordered the preliminary injunction, the defendant argued – among other reasons – that the preliminary injunction should not have been ordered, because at the time it was ordered, the defendant had allegedly ceased marketing the capsules that sparked the litigation. In relation to this question of fact, the Court of Appeal noted that the evidence filed by the defendant was not sufficient to establish that it had discontinued marketing the product. Against this background, the Court noted that it could not be concluded that the application for a preliminary injunction did not really have an “object”, at the time when it was filed. Interestingly, the Court added that “To that we must add that the defendant’s reply to the request to cease the infringing activity made by the applicant of the injunction was not precisely an acceptance of the request, but rather just the opposite: the defendant denied to be infringing, in such a way that conveyed to the patentholder the defendant’s intention to continue committing the potentially infringing activity, thereby justifying the application for the injunction.” This is one of the most interesting aspects of the decision, as it highlights that an application for a preliminary injunction will be justified when the potential defendant does not accept an undertaking and defends itself, alleging non-infringement.

Finally, the Court of Appeal moved to the technical aspects under discussion, on which both parties had filed expert opinions. To make a long story short, the Court found the expert reports filed by the patentee to be more persuasive because, unlike the expert report filed by the defendant, the conclusions reached by the former were supported by the experiments conducted by one of the experts used by the patentee.

The last point of interest is that the Court of Appeal clarified that, although Article 732 of the Spanish Civil Procedure Act (“CPA”) states that the applicant must submit all the evidence with the application for a preliminary injunction, at the hearing, the applicant may still file new documents which are necessary to refute allegations introduced by the defendant in its opposition. This clarification is very helpful, as in the past, some First Instance Judges had made a too strict interpretation of Article 732 of the CPA.

In conclusion, the decision of 12 September 2014 has shed further light on specifying the necessary requirements to order a preliminary injunction and, in particular, it has further clarified that not accepting an undertaking entails an intention to market the allegedly infringing product.

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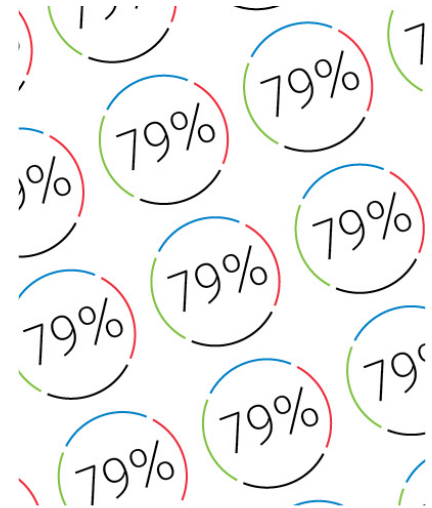
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