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Will the new Spanish Patents Act introduce "protective writs" in Spain?

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In September of 2013 the Spanish Patent and Trademark Office ("SPTO") published a draft Patents Act, which will hopefully be approved by Parliament within the next few months, assuming that the election calendar so permits. During the last year, the draft has received numerous comments from the stakeholders concerned, including the Spanish competition authorities and the "General Council for the Judiciary" ("GCJ"), the administrative organ that governs the Spanish Judiciary.

One of the suggestions made by the GCJ at paragraphs 116-119 of its Report of 24 July 2014 has been the introduction of a procedure roughly equivalent to "protective writs." In particular, the Report contains the following suggestion:

"*116. The last of the suggestions in relation to interim injunctions, as mentioned earlier, has to do with the introduction of a new article, possibly following article 129 of the Draft Bill, with the corresponding adjustment to the numbers of the subsequent ones, designed to address the figure of "protective writs".*

117. This is a procedural instrument used to defend oneself against the possibility of an application for ex parte *interim injunctions, which is recognised in foreign jurisdictions. Based on this instrument, a party that has received an extra-judicial request or fears that it will be the object of an application for interim injunctions that, due to the circumstances of the case, may be granted without a hearing, can appear before the Judge or Court with jurisdiction in order to, first, place itself at the disposal of the latter and, second, offer a preventative justification of its position.*

118. This writ must not limit the possibilities for the Judge or Court to order the interim injunctions without a hearing, or interfere in the possibility for the claimant to choose a Court, insofar as the law so permits.

119. To that end, we have formulated the following proposal for drafting this hypothetical article, which could be titled "Protective Writs":

"1.- Any party who believes that an application for interim injunctions without a prior hearing is to be filed against it, may appear in due legal form before the judicial body or bodies it considers appropriate in order to enquire about said possible injunctions and justify its position in a protective writ.

The Judge or Court will order the opening of interim injunction proceedings, of which the patent

holder will be notified, and, if the application for interim injunctions is filed within a term of three months, the former may order that the proceedings follow their course in accordance with articles 733.1 and 734 LEC, although this will not preclude the adoption of the injunctions without further ado, by means of a ruling pursuant to the terms and timeframes set out in article 733.2 LEC.

2.- A [patent] holder who considers that the Judge or Court before whom the protective writ was presented does not have jurisdiction, may file its application for interim injunctions before the body that it considers to actually hold jurisdiction, and its application must state the existence of the protective writ and the judicial body before which it was presented"."

Assuming that the proposal passes muster at Parliament, the new Patents Act would bring additional legal certainty. At present, whilst the Commercial Courts of Barcelona have been keen to accommodate "protective writs" in patent litigation practice, some Commercial Courts of Madrid have been reluctant to import a procedure that does not appear to have an explicit legal basis at present. This discrepancy has left prospective users of protective writs somewhat in the dark. The new Patents Act would be the right instrument to shed some light, one way or another.

In any event, it is doubtful whether Parliament will have time to debate and, eventually, pass the new Patents Act before the next elections take place. If not, depending on the results of the elections, we might find ourselves back to square 1.

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