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Finland: Should interim injunction decisions for utility models follow patents? (MAO:434/15, 18 June 2015)?

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Inspired by several Finnish companies, like many other interest groups, having expressed their concern regarding the level of renewal fees of the Unitary Patent, I thought of writing about a slightly different protection regime that provides not only fast but also low-cost protection for technical inventions, namely, utility models. First I have a question for all of you interested in IP enforcement and interim injunctions: do you think that interim injunctions in cases involving utility models should be granted on grounds and standards different to those applicable to patents? If you do not have a view on this, see what the Finnish Market Court considers and as we will see the main emphasis is on the so-called ‘claim requirement’.

As opposed to trade mark and design protection, there is no EU-wide utility model specific protection, despite the fact that the Commission made a proposal for a Directive to this end in 1999, but it was later withdrawn. However, there is some EU legislation on this topic such as the 2004 Directive on the enforcement of intellectual property rights, which provides EU-wide remedies and penalties against infringements of utility models and Regulation (EU) No 608/2013 concerning customs enforcement of intellectual property rights, which also applies to utility models.

As a background to our case, the following requirements must be fulfilled in order to grant an interim injunction in Finland:

1. Claim requirement: the right-holder shall establish that he/she has a right enforceable against the counterparty. The evaluation of the fulfilment of the claim requirement is based on probability assessment.

2. Danger requirement: it is required that the counterparty by deed, action, or negligence, or in some other manner, hinders or undermines the realisation of the right holder’s right or decreases essentially the value or significance of said right. It is generally not required to prove actual existence of danger but a claim to that effect suffices.

3. Comparison of interest/undue inconvenience: the court considers the interests of both parties and assesses whether the defendant would suffer undue inconvenience in comparison to the benefit to be secured the interim injunction.

Typical evidence in the interim injunction phase includes approximately the same material as used

in the main proceedings, with the exception of oral evidence that is (except in exceptional circumstances) provided at later phases. Additional documentation includes the official patent or utility model documentation, cease and desist letters, if any, expert evidence, technical drawings and similar, financial analysis on the harm to the patent holder (e.g., in the form of sales statistics or similar), and could include in addition, supporting foreign judgements, if available. But how is the situation different if you compare utility models to patents?

In the recent case, the Finnish Market Court deemed that the differences were the following:

Regarding the first requirement that the plaintiff must have an enforceable right against the other party, the Market Court cited the earlier Supreme Court precedents (namely 1994:132, 1994:133, 1998:143, 2000:94 and 2003:118). In the last one, the Supreme Court stated that when this interim injunction would lead to so-called advance enjoyment of the rights being the subject of the claims in the main proceedings (*ennakkonautinta*), the requirements for the probability of the existence of the right claimed by the applicant have to be considerably higher than in cases of other kinds of interim measures, say, seizures. So in other words, the mere existence of a patent creates a strong presumption that there is such enforceable right. We have criticized this view elsewhere as in cases with complex facts it leads to a situation that it is very difficult to get interim injunctions in the first place, but this discussion is outside the scope of this posting. However, it is interesting to note that in this particular case the Market Court stated that the same principle of *ennakkonautinta* does not apply to utility models due to the fact that novelty and inventiveness are not searched in the registration phase. So in case of utility models, this strong presumption created by patent as registered right is not directly applicable and it is easier to revoke with appropriate evidence. Otherwise regarding grounds for interim injunction, the danger requirement and comparison of interest/undue inconvenience, the Market Court did not seem to find any differences between utility models and patents.

So in conclusion, at least according to the Finnish Market Court, utility models and patents are in deed different when it comes to the question of claim requirement but we will let you know if the situation changes due to appeal.

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