Kluwer Patent Blog

A matter of urgency – PI application turned down for lack of urgency

Anders Valentin (Bugge Valentin) · Monday, February 8th, 2016

In a recent PI case decided by the Danish Maritime & Commercial Court (MCC), the Court ruled on the several aspects pertaining to the presumption of validity of a granted patent together with infringement as well the formal preconditions for granting a PI, i.e. urgency and passivity.

The parties to the case were both active in the business of mink fur production (pelts) and each the proprietor of several patents over which previous litigation had taken place and they were both aware of the other's market presence, including marketing activities and propietary rights. A previous dispute between the parties had lasted 5 years before it was resolved.

The – practically identical – patents-in-suit, on which the PI application was based in the present case, was applied for in 2003 by the company Minkpapir A/S and the patent-in-suit was granted in 2010.

In the spring of 2011, Jasopels began marketing the product-in-suit subsequent to having conducted a freedom-to-operate analysis in order to ensure that, inter alia, the patent-in-suit would not be infringed upon. During the autumn of 2011 the first deliveries of the product-in-suit took place to end customers.

In 2015, Minkpapir filed its application for a PI based on the patents-in-suit at the MCC arguing both literal infringement and infringement by equivalent means.

In its defence, Jasopels argued that the patent-in-suit be held as invalid and hence unenforceable by the MCC, despite the fact that the MCC cannot formally invalidate patents as part of PI proceedings. Moreover, Jasopels argued non-infringement and lack of urgency based on the fact that the product-in-suit had been marketed successfully since 2011.

The MCC firstly, and as a matter of routine, held that as the – practically identical – patents had been granted by the DKPTO and the EPO, respectively, a presumption of validity applied and that no evidence had been presented to the contrary.

As for infringement, the MCC sided squarely with the expert evidence offered by the Minkpapir expert and ruled that neither direct nor indirect infringement had been rendered probable by the patentee.

In addition, and perhaps most importantly in its decision to turn down the PI application, the MCC

observed that taking into consideration the fact that the patentee ”must be assumed to have known of” the product-in-suit ever since it was marketed initially, there was insufficient urgency, thus placing the burden of proof as to when the patentee knew or ought to have known of the initial marketing on the patentee.

In other cases, the Danish courts have found sufficient urgency in circumstances where the rights holder pursued a PI application approximately 1 year after the initial marketing of the product-in-suit and this decision seems to confirm that substantial passivity will constitute a lack of urgency.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please subscribe here.

This entry was posted on Monday, February 8th, 2016 at 12:49 pm and is filed under EPO
You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.