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If you want to obtain a “saisie-contrafaçon” inspection in Spain, you’d better do your homework first

Miquel Montaña (Clifford Chance) · Monday, September 19th, 2016

Earlier this year, the Commercial Courts of Barcelona published a decision which shows that patent owners cannot obtain “*Diligencias para la comprobación de hechos*” (“Proceedings for the Verification of Facts”; a procedure roughly equivalent to the French “*Saisie-contrafaçon*”) in Spain unless they carefully prove that the application fulfils certain conditions. In particular, in its Decision of 8 January 2016 written by His Honour Judge Alfonso Merino Rebollo, Barcelona Commercial Court number 1 rejected an application for “*Diligencias*” because the Court considered that in the case at hand, the fulfilment of such conditions had not been established.

In the Legal Grounds of the Decision, the Court cited a Decision of 19 July 2007 from the Barcelona Court of Appeal (Section 15) which clarified that, in order to obtain a “*Diligencias*” order, the applicant must fulfil three conditions. First, the applicant must show that it would have “*locus standi*” or entitlement to exercise the actions derived from the patent. Second, that in the circumstances of the case, the infringement of the patent may be presumed, that is, that there are *indicia* of the alleged infringement. The Court added that the ordering of such inspections is not automatic. Rather, it is subject to judicial control in order to verify that there is “just cause” for resorting to this instrument, which requires the applicant to file “precise data in order to be able to presume the likelihood of the infringement, in light of the circumstances of the case”. Third, that it is not possible to verify the existence of the illegal behavior without having recourse to the “*Diligencias*.”

Applying these Legal Grounds to the facts of the case, Barcelona Commercial Court number 1 found that the first condition was fulfilled, as the applicant was the owner of the patent on which the application was based. Moving on to the second condition (i.e. “just cause”), the Court reached a negative conclusion because, among other reasons, it noted that the applicant had not made any comparison between the allegedly infringing product and the claims of the patent and it had not filed a report proving the existence of “objective *indicia*” of patent infringement. The Court added that although the applicant had alleged that, in the course of similar proceedings carried out in France, it had confirmed that the product did infringe the patent, the applicant had not filed any evidence proving this.

In relation to the third condition, the Court found that this had not been proven either. The applicant had alleged that the product marketed by the defendant was very expensive and bulky and that the applicant did not have the capacity to obtain a sample on its own. Again, the Court found that the applicant had not filed any evidence proving this.

So the teaching of this Decision is very clear: Do not take it for granted that you will obtain a “*Diligencias*” order in Spain, even if you have obtained a “*Saisie-contrafaçon*” order in France, where the requisites appear to be more relaxed. If you want to obtain a “*Saisie-contrafaçon*” inspection in Spain, you’d better do your homework first.

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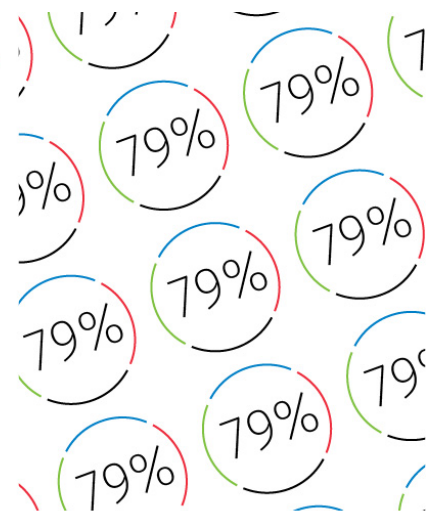
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