

Kluwer Patent Blog

Spanish Supreme Court clarifies requirements for the publication of judgments

Miquel Montaña (Clifford Chance) · Tuesday, July 11th, 2017

One of the remedies established in case of patent infringement in the Spanish Patents Act that was in force until 31 March 2017 was “the publication of the judgment finding against the infringer of the patent, at this party’s expense, through announcements and notifications to the interested persons. This measure will only be applicable when the judgment so states expressly.”

One of the contentious issues in some patent cases has been how wide these announcements and notifications should be and, in particular, in which type of media. Another point of discussion has been whether the full judgment should be published or only the holding of the decision. The recent judgment of 3 May of 2017 from the Spanish Supreme Court already discussed from another angle in a previous blog has shed light on this point. In this case, the complainant had requested that the defendant be ordered to do the following things, among others: “[...] to publish the judgment which is handed down, at its expense, in a general newspaper distributed nationwide, and in a magazine of the canning sector, and through direct communication of the judgment to its clients of vegetable preserves.”

In a judgment of 27 November 2012, Commercial Court number 1 of Murcia upheld the patent infringement actions and ordered the defendant to publish “the heading and the holding of the present judgment in a magazine of the canning sector, and through direct communication of the judgment to its clients of vegetable preserves.” This judgment was revoked by the Court of Appeal of Murcia in its judgment of 27 May 2014, which dismissed the infringing actions filed by the complainant and upheld the nullity counterclaim filed by the defendant. In the judgment of 3 March 2017 mentioned at the beginning, the Supreme Court then revoked the second instance decision and reinstated the conclusions reached by the Court of First Instance. For the purpose of this blog, the legal grounds confirming the order to publish the judgment are of particular interest:

“1. Mivisa also appealed the decision of the commercial court ordering the publication of the heading and holding of the judgment. The justification for publication argued by the claimant and accepted by the first instance judgment was that it had an informative effect for operators in the canning sector and a deterrent effect with regard to other companies considering committing infringing conduct. The court reduced the scope of publication to a canning sector magazine and direct notification of the judgment to vegetable preserve clients.

As we will see, the court’s decision was a considered one, in line with the end sought by the measure.

In the event of infringement, Article 63.1.f) of the Patent Act envisages that “publication of the judgment finding against the infringer of the patent, at the defendant’s expense, in the form of announcements and notification of the interested parties” can be requested and ordered.

As the first instance judgment quite rightly states, it is not an effect that follows on automatically from the upholding of the infringement. It must be justified in view of the end sought, which may be to contribute to the effectiveness of the cessation and the removal of the effects of the infringement or, potentially, to compensate for harm caused. In any event, the publication, in view of the content thereof and the measures used, must be appropriate and proportionate.

In relation to the trademark infringement, we already stated in judgment 697/2009, of 6 November, cited by judgment 505/2012, of 23 July:

“The publication of the judgment, designed to specifically compensate for the harm caused to the right over the sign and, in turn, to remove the effects of the infringement, is not mandatory (...). Indeed, the reference to “interested parties” underlines the fact that the announcements and notifications must perform an empirical, and not always concurrent, function in relation to the same. This means that the usefulness of the publication must be demonstrated, as a means of re-establishing the damaged image of the sign and ensuring cessation of all of the effects of the infringement or any other that merits protection”.

In our case, if we take into account the fact that it is the infringer who manufactures the cans used by different canning companies, the advertising ordered by the commercial court judgment makes sense. It is not indiscriminate advertising, aimed at the public in general, but focuses instead on the actual or potential clients for these cans, the canning companies.

The direct notification of the clients of the defendant, for whom it manufactured the cans that infringe the claimant’s patent, facilitates the dissemination of the knowledge among affected and interested parties, as well as contributing to the removal and cessation of effects. Likewise, publication in a magazine in the canning sector ensures that potential clients are informed.”

All in all, this recent judgment has further clarified the requirements that must be fulfilled for the publication of a judgment declaring patent infringement. However, it remains to be seen whether the criteria expressed in this judgment will be automatically applicable to patent infringement actions commenced after 1 April 2017, when the new Spanish Patents Act came into force. This is because the relevant provision of the new Patents Act has a slightly different wording: “[...] Exceptionally the judicial body will also be able, at the petition of the patent owner, to order the publication of the judgment finding against the infringer of the patent, at the said party’s expense, through announcements and notifications to the interested persons.”

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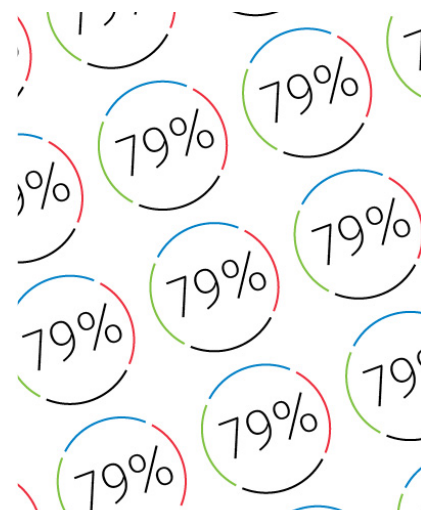
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