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The great paradox: will mandarins splatter onto patent cases across Europe?

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One of the points sometimes debated in patent cases is the date when a claim for patent infringement becomes "time-barred" (i.e. the date on which it "prescribes"). The traditional position adopted by the courts in countries like Germany and Spain is that in the case of continuing acts of infringement, the time-barred period (e.g. 5 years in Spain) does not start running until the last act of infringement has ceased. For example, in a judgment handed down on 25 March 2018, Barcelona Commercial Court No. 4 rejected a "prescription" objection raised by a company that had started marketing the allegedly infringing product in 2007, but which had not been sued for patent infringement until 2016. The rationale for dismissing the objection was that – again – in the case of "continuing" acts of infringement, the clock does not start ticking until the last act of infringement has ceased.

While the judge was drafting the judgment on this case, the Spanish Supreme Court (Judge Rapporteur, Ignacio Sancho Gargallo), in a case dealing with a registered plant variety (a mandarin called "Nadorcott") sent to the Court of Justice of the European Union (the "CJEU") in Luxembourg a set of "preliminary ruling" questions dealing with the interpretation of Article 96 of the "Plant Variety Regulation" (Regulation 2100/94), which reads as follows:

"Claims pursuant to Articles 94 and 95 shall be time barred after three years from the time at which the Community plant variety right has finally been granted and the holder has knowledge of the act and of the identity of the party liable or, in the absence of such knowledge, after 30 years from the termination of the act concerned".

In particular, in the decision handed down on 7 March 2018, the Spanish Supreme Court referred the following questions to the CJEU:

"1) Does Article 96 of the Plant Variety Regulation oppose an interpretation whereby an action under Articles 94 and 95 of the Plant Variety Regulation is time barred if filed more than three years after grant and after acquiring knowledge of the act and the identity of the liable party, although the acts of infringement still persist at the time of filing the action?

2) If the answer to 1) is negative, is Article 96 of the Plant Variety Regulation to be interpreted in such way that prescription only applies to those specific acts of infringement carried out prior to the three-year period, but not to those acts carried out within the last three years before the action?

3) If the answer to 2) is affirmative, does this imply that the cease and desist actions and damages actions can only be successful in respect of the acts of infringement comprised within the three-year period?"

Although these questions were raised in the narrow niche field of plant varieties, it is possible that the CJEU's answers might spill over to cases dealing with intellectual property rights across Europe, such as patents. This would be a major paradox since, as readers are well aware, the Commission and the European Union ("EU") member states turned EU Regulation 1257/2012 of the European Parliament and of the Council of 17 December 2012, on the implementation of enhanced cooperation in the area of the creation of unitary protection, into an "empty shell" (i.e. substantive patent law is not governed by EU law but by national law) in an attempt to prevent the CJEU from formulating opinions on substantive patent law.

All in all, patent owners and patent practitioners who are not plant variety *aficionados* should keep a close eye on how this case develops.

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