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Court of Appeal of Barcelona revisits to what extent validity may be analysed in preliminary injunction proceedings

Miquel Montañá (Clifford Chance) · Monday, November 12th, 2018

Over the last decade, one of the topics typically discussed in patent proceedings in Spain has been to what extent the validity of the patent may be analysed in preliminary injunction proceedings. In the mid-2000s, the Judges in charge of the Commercial Courts at the time, with jurisdiction to deal with patent cases in Barcelona, used to take the view that in preliminary injunctions life is too short to examine validity in depth. Therefore, they considered that only indicia should be examined. They added that in the case of examined patents, validity should be presumed unless the party alleging the nullity of the patent should file very robust indicia supporting the invalidity grounds. The Court of Appeal of Barcelona confirmed this line of analysis in a saga of decisions handed down from 4 January 2006 onwards.

More recently, some first instance Commercial Courts had become increasingly open to holding profound validity discussions in the context of preliminary injunction proceedings. Experts were examined and cross-examined and, as a result, not much was left for the hearing of the main proceedings, which was basically a reiteration in the form of a *déjà vu* of the hearing of the preliminary injunction proceedings. However, a recent judgment from the Court of Appeal of Barcelona dated 16 October 2018, which confirmed a preliminary injunction ordered by Commercial Court number 1 of Barcelona on 28 July 2017, has established that the depth of the analysis carried out by the Court of First Instance went beyond what the Court of Appeal considers reasonable. For the purpose of this blog, the most interesting aspect of this decision may be found in paragraph 17, where the Court of Appeal wrote the following:

"*17. We believe the summary we have just made of the terms under which the dispute arose and the response given to it is indicative that the decision appealed has gone beyond what we consider reasonable as regards the scope of analysis of the validity of the patent in an interim injunction procedure related to an infringement action, especially when considering that the patent was granted in adversarial proceedings and has been in force over a very extended period of time without having been disputed. This leads us to consider the depth of the analysis undertaken by the appealed decision to be excessive and, therefore, the scope within which this Court is invited to provide a response to the grounds supporting the appeal to be just as excessive because it displaces to the interim injunction proceedings the examination of issues which, due to their depth, should only be inherent in declarative proceedings.*"

The main teaching of this decision, which has added its grain of salt to this interesting debate, is that something must be left for the main proceedings.

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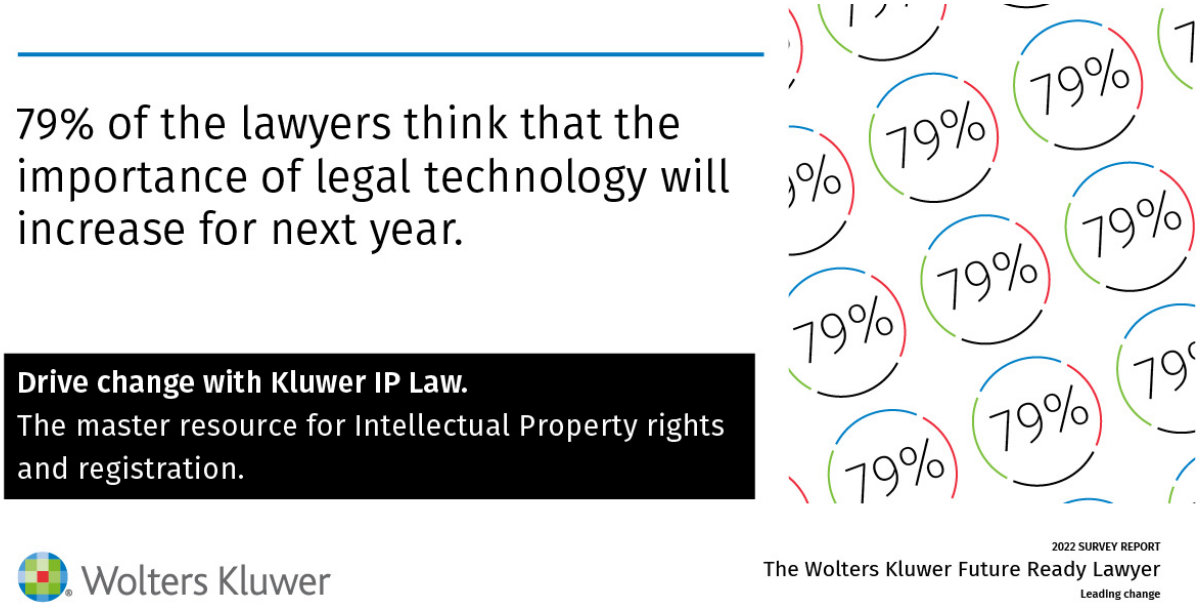

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