

Kluwer Patent Blog

6 things readers should know about Liconsa v. Boehringer Ingelheim

Miquel Montaña (Clifford Chance) · Tuesday, November 12th, 2019

Our friends from the EPLAW Patent Blog recently published an interesting blog commenting on the judgment of 29 March 2019 from the Court of Appeal of Barcelona (Section 15) where, among other aspects, the requirements for requesting the limitation of a European patent before the Spanish Patents and Trademarks Office (“SPTO”) were discussed. As explained in such blog, the Court came to the conclusion that the limited patent published by the SPTO was not enforceable because the judicial authorization foreseen in article 105.4 of the new Patents Act had not been obtained. For the readers’ benefit, it will be helpful to remember that, according to that article 105 *“4. If judicial proceedings on the validity of the patent are pending and without prejudice to the provisions of article 120, the request for limitation, addressed to the Spanish Patent and Trademark Office, must be authorized by the Judge or Court that handles the proceedings.”*

To avoid confusion and possible misunderstandings among the public, a few clarifications are in order:

The first clarification is that although that blog might convey the impression that the Court of Appeal of Barcelona (Section 15) had the last say on this debate, in reality that judgment is not final. This is because BOEHRINGER INGELHEIM (“BI”) filed an appeal, which is pending before the Supreme Court.

The second clarification is that it is beyond discussion that when BI limited the patent before the SPTO, article 105.1 (*“1. At the request of its owner, the patent whose granting is final may be revoked or limited modifying its claims at any time of its legal life, including the period of duration of supplementary protection certificates as the case may be”*) of the new Patents Act (Law 24/2015), which introduced the possibility to limit patents before the SPTO, had come into force. This is the reason why the limitation was admitted and published by the SPTO.

Third, it is also beyond discussion that the provisions governing how the authorization from the Court (“Court authorization”), that is dealing with a parallel nullity action must be obtained, were not applicable to the case. This is because the judicial proceedings started before the new Patents Act came into force and, therefore, the judicial nullity proceedings were governed by the old Patents Act (Law 11/1986).

Fourth, precisely because the provisions governing how the Court authorization must be obtained were not applicable to the case at hand, the Court dealing with the nullity proceedings never

informed the SPTO that a nullity action against that patent was pending and/or that a limitation had previously been proposed in the course of the judicial proceedings. If such provisions had been applicable to the case, the Court, following such provisions, would have informed the SPTO which, in turn, would then have registered such facts at the registry of the SPTO, as provided by article 72 of the new Patents Act. This is actually the crux of the matter because, according to article 43.1 of the Implementing Regulations which, for the aforementioned reasons, was not applicable to the case either “1. *When judicial proceedings on the validity of the patent which are registered in the Patents Registry are in progress, the SPTO will notify the Judge or Court of the application for limitation, for the appropriate purposes. The denial of the authorization will entitle the owner of the patent to request that the SPTO refund the limitation fee.*” This paragraph makes it very clear that it is the SPTO – not the patent owner – who must communicate the application for limitation to the Court, so that the latter can decide whether or not the authorization may be granted. In the case at hand, the SPTO had not made such communication for the simple reason that the provisions governing the Court authorization were not applicable to the case in the first place and, as result, the Court had not informed the SPTO that a nullity action against that patent was pending and / or that a limitation had previously been proposed before the Court.

Fifth, from the foregoing it is crystal clear that no provisions of the new Patents Act or the Implementing Regulations were infringed by BI when, relying on article 105.1 of the new Patents Act, it proposed an administrative limitation of the patent before the SPTO. It is likewise crystal clear that no provisions were infringed when the SPTO accepted and published the limitation.

Finally, the debate explained in these blogs is a “one-off” that will not arise again in future cases. This is because the facts of the case were unique in the sense that the parties were trapped in the transition between the old and the new Patents Acts and the debate arose because of the different transitional regimes established for different provisions of the new Patents Act.

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