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Either/or – must the patentee chose between a PI or a main action in Denmark?

Anders Valentin (Bugge Valentin) · Thursday, February 10th, 2022

In a recent decision, the appellate court upheld a ruling whereby the patentee had forfeited the opportunity to obtain a PI because it chose to file a main action first – even though the main action had been suspended pending EPO opposition proceedings.

This decision could have farreaching consequences as it may entail that a patentee is forced to file a PI action “too soon”, i.e., at a time when the patentee may not (yet) have sufficient evidence of the infringement as the patentee may now otherwise risk being barred from obtaining intermediary relief due to “formal passivity”.

A Danish court of law may only grant a PI if the patentee proves that its legal position may be jeopardized if it is forced to await the outcome of a main action (“periculum in mora”).

In the present case, the patentee had firstly filed a main action against defendant 1 claiming, inter alia, a permanent injunction after opposition proceedings had been filed at the EPO and on that basis the Danish Maritime and Commercial High Court decided to stay the action.

The defendant did not outright contest infringement but stated instead that there “is no evidence in this case which supports the allegation that the defendant has carried out any patent-infringement activity in Denmark, neither with re-gard to the relevant technical nor the geographical scope of the patent-in-suit.”

While the main action was pending, the patentee successfully obtained additional evidence through US discovery and filed an application for a PI in Denmark, citing, inter alia, the need to obtain interim relief while the main action was pending. The PI application was filed 15 months after the main action had been filed and 6 months after it had been stayed, but only a few weeks after the new evidence from US discovery had been made available for filing in Denmark.

The Danish Maritime and Commercial High Court turned down the patentee’s PI application finding formal passivity – i.e., no periculum in mora. The court held that the disputed actions at the center of the main action were essentially those cited in the PI application. The court deemed that the patentee could have filed the PI application at the time it filed the main action, i.e., 15 months earlier.

The court dismissed the patentee’s argumentation that decisive evidence of patent infringement in Denmark was only obtained after filing the main action (from the US discovery) and that, moreover, the infringing actions in Denmark of defendant 2 (an affiliate company of defendant 1)

had only come to light through the US discovery.

In its reasons for upholding the decision, the appellate court remarked that at the time the patentee filed the main action, it had argued that the evidence filed showed that defendant 1 infringed and so there should be no need – in the view of the appellate court – to await documents from the US discovery proceedings.

The appellate court failed to address the fact that the infringing actions of defendant 2 had only come to light through US discovery and available for filing three weeks before the PI application was filed.

BUGGE VALENTIN's comments:

With these decisions the Maritime & Commercial Court and the appellate court seem to have adopted a somewhat strict interpretation of the balance of when a patentee suspects infringement and when the patentee has sufficient evidence of infringement to file a PI action.

Both instances emphasized that the patentee must have been of the opinion (when the main action was filed) that it had sufficient evidence to prove in-fringement. This suggests that the courts assess the criterion (of formal passivity) somewhat formalistically without due consideration of the many practicalities necessary to prepare and initiate legal action (including, in this case, the fact that the disputed product was not freely available to purchase).

Another interesting point is that in the preparatory works to the Danish rules on preliminary injunction, it is stated that the criterion regarding that the ability of the party to enforce his right will be lost if the party has to await a full trial, is usually fulfilled in cases regarding infringement of IPR, i.e., it is essential of IPR holders to stop infringements.

Nonetheless, neither the Maritime and Commercial High Court nor the High Court (Eastern Division) seems to have included this in their assessment, and we call to mind that the main case was stayed, thus rendering the patent proprietor without, essentially, any options to stop the alleged infringing activities.

The decisions show that formal passivity can be invoked as a defence in preliminary injunction proceedings, even when the PI application is based on new evidence. The courts have made it clear that what is important is not the novelty of the evidence, but whether the application for a preliminary injunction is related to allegations/claims of infringements invoked previously.

Consequently, we believe that patent proprietors must consider carefully that when they allege patent infringement, the clock starts ticking.

Reported by Patris Hajrizaj

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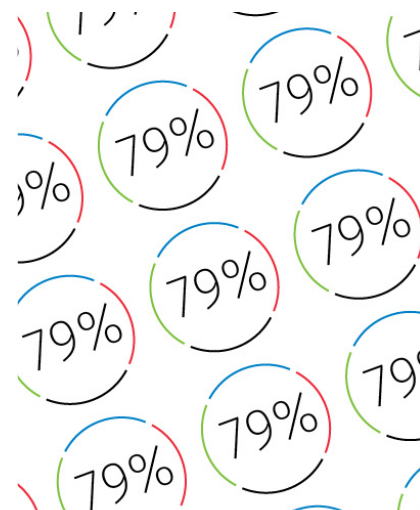
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