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A preliminary injunction can be based on a patent application

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In a decision of 3 June 2022, opposing NOVARTIS and BIOGARAN, the Tribunal Judiciaire de Paris accepted the admissibility of a request for provisional measures based on a European patent application. This solution, however surprising it may seem at first sight, could nevertheless be justified.

The decision under review is an order rendered in a case between NOVARTIS and BIOGARAN concerning a marketing authorization obtained by the latter for the active substance fingolimod used as a monotherapy for the treatment of very active forms of relapsing-remitting multiple sclerosis. The European patent application n° EP 2 959 894, which covers the said specialty, had been invoked by its proprietor (NOVARTIS) as the basis for its request for provisional measures, immediately after the EPO Board of Appeal had ordered the Examining Division to grant the patent on the basis of only one of the 11 claims submitted to the Office, even though the patent had not yet been granted. However, the Judge accepted the admissibility of such an action based on the European patent application, while considering that the single claim at issue was apparently neither new nor inventive so that interim measures were not justified.

This position seems, at first sight, surprising. The interpretation of Article L. 615-3 of the IPC questionable. While it is true that this text refers to "*the rights conferred by the title*", it is also true that this title is, in principle, understood as the patent granted. Thus, Article L. 615-4 expressly provides that "*the court hearing an infringement action based on a patent application shall stay the proceedings until the patent is granted*". The interpretation adopted could also contradict Article L. 614-9 of the same Code, which lists exhaustively the rights arising from the application and does not mention those provided for by Article L. 615-3.

However, on closer examination, the position adopted in the decision commented on could be consistent with the texts and logical, and not dangerous, provided that the applicant provides sufficient guarantees. Indeed, the patent right arises from the filing of the application. Thus, in the case of a European patent application, Article 67(1) of the EPC states that "*as from its publication, the European patent application shall provisionally afford the applicant, in the Contracting States designated in the application, the protection provided for in Article 64*". Article 64 which states "*the rights conferred by the patent". In the light of these texts, the "rights conferred by the title*", referred to in Article L. 615-3 of the IPC, should include both the patent and the published application. All the more so since, if Article L. 614-9 provides for a stay of proceedings, it is only for the specific case of an infringement action (and not for provisional measures), and above all, it does not expressly refer to the "*published*" application, but only to "*the application*". Moreover, as

surprising as it may seem, the solution adopted by the commented decision is not new, in that it had already been adopted by the French case law. Moreover, the action for preliminary injunction tends to be similar to the action for infringement, as much from the point of view of its effects as of the conditions of its admissibility.

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