Kluwer Patent Blog

Fingolimod – The Danish Eastern High Court definitively affirms dismissal of a PI application based on a patent application

Anders Valentin (Bugge Valentin) · Monday, October 31st, 2022

In an appeal of a PI decision, the Danish Eastern High Court has ruled to uphold the dismissal of Novartis' application for a preliminary injunction against Glenmark, Zentiva, and Viatris, based on the European patent application 2 959 894. In its decision, the Court firmly stated that a preliminary injunction can only be issued based on a patent in effect.

In the first instance decision, The Maritime and Commercial High Court had decided to try the issue of the applicant's cause of action/legal interest separately (review of the ruling can be read here). As stated, the Maritime and Commercial High Court dismissed the application due to insufficient legal interest and noted that no formal decision to grant had been issued by the EPO. By this, the Maritime and Commercial High Court only rejected enforcement prior to a 'decision to grant' yet left open the possibility of enforcement after a 'decision to grant' – but before the grant of a patent. Thus, the ruling left it unresolved when sufficient cause of action is present in cases of PI proceedings based on patent applications.

With reference to case law of the Danish Supreme Court, the Eastern High Court started off by noting that a patent cannot be subject to judicial review before it becomes effective. In keeping with this, a patent application cannot serve as the basis for a preliminary injunction, as i) a patent right is neither substantiated nor made probable with an application. Consequently, the first criterion for a preliminary injunction is not met, cf. section 413(1)(1) of the Danish Administration of Justice Act. As a preliminary injunction cannot be issued, an applicant for a patent has ii) no legal interest in cases concerning the patent applied for, as there is no cause of action. Accordingly, the legal outcome of an application for a preliminary injunction on the basis of a patent application must be dismissal of the case.

In its decision, the Court noted in an obiter dictum that the question concerned ought to have been considered up front by the Maritime & Commercial High Court and not made the subject of a separate hearing and the High Court seems to indicate that this should have been obvious.

With the High Court's decision, the state of the law has by this decision been laid down definitively: Only a granted patent with effect in Denmark may form the basis of judicial proceedings in Denmark, including preliminary injunctions. In this interim period, Danish utility models may, however, in some cases offer protection, as a quickly granted utility model registration may be used as the basis for an application for a preliminary injunction concerning an

invention, for which a patent application is pending.

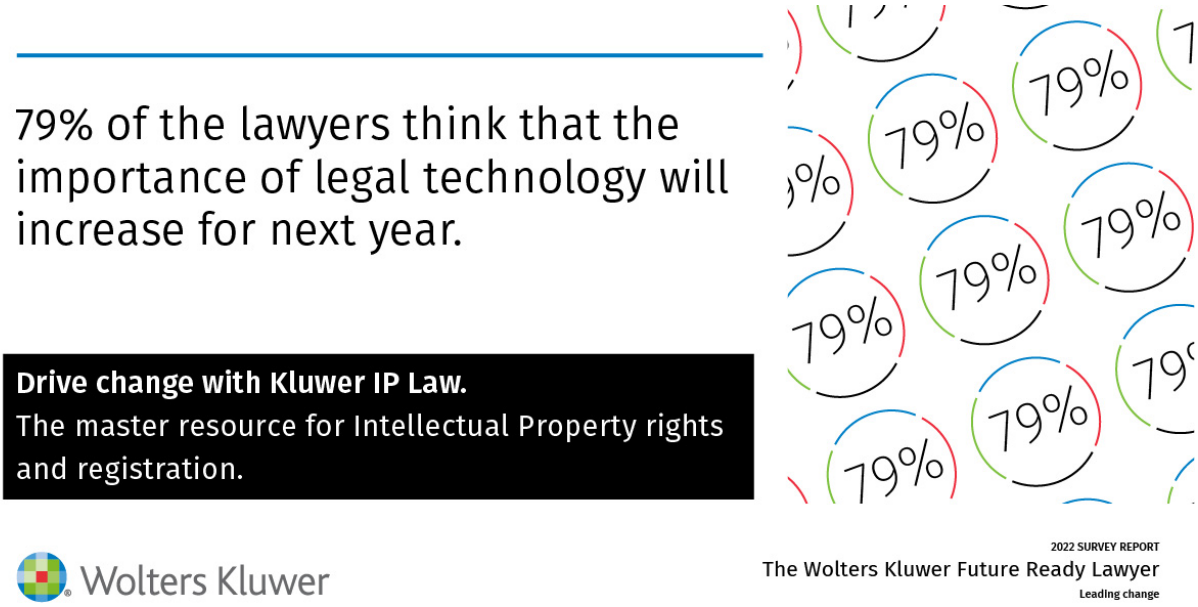
Zentiva and Glenmark were represented by BUGGE VALENTIN

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please subscribe here.

Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.



This entry was posted on Monday, October 31st, 2022 at 9:17 am and is filed under Denmark, Enforcement, Generics, Infringement, Injunction, Litigation, Patents, Pharma, Pharmaceutical patent, Utility model
You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.