

Provisional patent protection: are you really protected?

Carlos Maíllo Carbajo

From the filing of a patent application until the grant of the corresponding patent several years may pass. However, it has been generally considered that an action for infringement cannot be brought against an alleged infringer until the patent is actually granted. Indeed, this has been recently reaffirmed in the *fungolimod case*, where Novartis tried to enforce a non-granted patent application against several generic companies across Europe. Novartis' claim was rejected by the national courts in almost all cases, notwithstanding the fact that the EPO's Board of Appeal had already ordered the Examining Division to grant the patent application.

This delay between the filing and the grant of a patent creates a —sometimes very long— time gap during which a third party could engage in infringing activities long before the applicant can act upon it. To provide the applicants with a safeguard against this kind of situations, patent laws of most countries contemplate a **provisional protection right** conferred by the pre-grant publication of the patent application.

Probably the most important characteristic of this right is that it only **works retrospectively** — once the patent is granted and enforced against an infringer before a court, the provisional protection gives the proprietor the opportunity to claim *back-damages* from as early as the date of publication of the application, or even before if the infringer was notified of the filing and content of the application previous to its publication. On the contrary, if the patent application is never granted —or revoked in post-grant procedures— the applicant is not entitled to any provisional protection right. Logically, the scope of the provisional protection is also determined retrospectively by the scope of the claims granted —or amended after opposition or limitation.

It must be highlighted that this is not a minor right, as in some cases a significant part of the infringing activities takes place before the patent is granted; thus, opening the time window for collecting damages can be paramount to provide an appropriate compensation for the losses caused by the infringement.

The other key issue to bear in mind is that there are some requirements for obtaining provisional protection, in particular **language requirements**, which vary depending on the national law of each country and the type of patent application under consideration but generally entail the publication of the claims in a national language of the country.

In **Spain**, for example, the requirements for obtaining provisional protection by the different types of patent applications are set out in separate articles of the Spanish Patent Law 24/2015 —Articles 67, 154, and 170 for national, European, or international (PCT) patent application, respectively.

These articles establish that while a **national patent application** will automatically generate a provisional protection right upon its publication, the situation for European or PCT applications is rather more complex.

In the case of a direct **European patent application**, provisional protection will only ensue in Spain from the date of publication of a Spanish translation of the claims. Thus, the publication of a European patent application —be that in English, French, or German— will not confer

provisional protection in Spain unless the applicant provides a Spanish translation of the claims and pays the corresponding fee to the Spanish Patent and Trademark Office (SPTO).

In the case of a **PCT application**, there are different scenarios. If the PCT application is published in Spanish, the right to provisional protection will be automatically established in Spain. On the contrary, if the PCT application is published in any other language, the applicant will have to provide a Spanish translation and pay the corresponding fee. Importantly, the extension of the translation to be provided will depend on the route that the PCT then follows. If the PCT is to be directly entered into the Spanish national phase, a translation of the whole PCT application will be required. On the other hand, if the PCT is to be entered through the Euro-PCT route to obtain a European patent that would be subsequently validated in Spain—which is by large the most common route followed by applicants—only a translation of the claims will be required; however, in this latter case, the translation cannot be filed before the PCT has entered the European regional phase, therefore an early entry may be advisable if possible infringement activities are suspected.

As can be seen, measures can be taken to try maximizing the damages derived from provisional protection in an eventual infringement action before a Spanish court, and the best course of action can only be determined case by case. However, the reality is that patent applicants very rarely make use of them.

And what about the new **unitary patent** system launching this June? Will it affect the provisional protection right of European patent applications? More particularly, will it simplify the language requirements for obtaining provisional protection in all the countries covered by a unitary patent? Arguably, one of the main objectives of this new patent system is to ease the translation burden associated with the national validations—while with the classic validation route the proprietor may have to provide translations of the patent specification or claims in different languages, in requesting the unitary effect a single translation of the granted text is required. Thus, one would expect that a similar provision would be in place for obtaining provisional protection in all the countries covered by the unitary patent. However, apparently this is not to be the case. The new system does not have any special regime regarding the provisional protection of unitary patents beyond that it will be dealt with by the Unified Patent Court (UPC). Accordingly, the national translation requirements for establishing provisional protection in each country will apply regardless of whether the granted European patent follows a classic validation route or the new unitary route. Incidentally, this will generate quite a peculiar situation in many UP countries where more stringent translation requirements will apply for obtaining provisional protection than for obtaining definite protection through a Unitary Patent.

Finally, it seems worth remembering that, apart from the provisional protection right, there are additional tools that applicants can use to minimize their *defenselessness* during the long patent prosecution path. Perhaps the most obvious ones, are those mechanisms that allow accelerating the patent prosecution process—i.e., reducing the patent pending gap—, such as the EPO's PACE programme. But also, applicants may combine their patent applications with **utility models** to quickly obtain an enforceable right while the examination of the patent application is still ongoing. This double protection strategy is indeed a very common in some countries, such as in Germany, but not so much in Spain, probably because the Spanish Patent Law was traditionally very restrictive regarding the type of inventions covered by utility models—which were basically *objects*. However, with its recent reform, the law now allows the protection of chemical compositions with utility models, and it is expected to be extended to pharmaceutical substances and compositions in the near future according to the new draft law. In any case,

double protection strategies should be planned very carefully as utility models are published fast, which sometimes can have undesired consequences for the prosecution of the patent.

In sum, every applicant with a pending patent application that becomes aware of a possible infringer is well advised to use all the mechanisms that patent laws provide to make the most of their rights, and more precisely, they should make sure that their provisional protection rights are consolidated in all the countries of interest in order to maximize the damages that may be collected in future infringement actions before national courts or the UPC.