

PRELIMINARY INJUNCTIONS AND PROTECTIVE LETTERS - Personal Considerations by Bernabé Zea

On the last 'Patent Monday', which was held in Barcelona on 16.09.2019, Judge Florencio Molina López of the Commercial Court No. 5 of Barcelona (Patent Section) presented the lecture "*El escrito preventivo: criterios judiciales*" ("Protective Letters: Judicial Criteria"). Within the frame of this lecture there was an interesting debate on different aspects of preliminary injunctions and, specifically, on protective letters.

There is no doubt that the topic of protective letters is polemic in Spain. This has been the case since, before the current Patent Law came into force, the lawyer Xavier Huarte (Grau & Angulo) submitted one such letter to the Commercial Court No. 4 of Barcelona, and it was accepted by Judge Luis Rodríguez Vega, then in charge of the Court and currently in Section 15 of the second instance Court of Barcelona (Audiencia Provincial de Barcelona). It's worth mentioning that both were present at this 'Patent Monday' session.

Even today the use of this legal tool continues to generate controversy and leads to uncertainties; depending on how the latter are resolved, the protective letters will have more or less usage.

I do not intend to bring in to question the adequacy of the current judicial system for the general procedure of patent infringement claim: presentation of the claim in the competent court, transfer to the alleged infringer, response by the defendant, pre-trial hearing, and oral hearing, to finally reach a decision of first instance.

Nor do I dispute the need for preliminary injunctions, which as an exception, in certain situations are granted *inaudita parte*. An adequate defence of the interests of the owners may, in some cases, require an unreasonable period of time in the general procedure.

However, preliminary injunctions and all they entail, should be considered only in cases of emergency and therefore, in my opinion, it would be advisable for them to disrupt as little as possible the aforementioned general infringement procedure, which are well established.

In this context, protective letters should simply be an appropriate tool to avoid the defencelessness of the potential patent infringer to whom *inaudita parte* preliminary injunctions can be applied.

Currently, these documents are only regulated by Article 132 of Law 24/2015, of 24 July, on Patents:

Protective Letters.

1. A person who can foresee preliminary injunctions being requested inaudita parte against him or her may appear in legal form before the judicial body or bodies he or she considers competent to hear such possible injunctions and set out his or her position by means of a protective letter.

The Judge or Court shall initiate proceedings for preliminary injunctions by which the patent owner of the patent will be notified. If within a period of three months

such preliminary injunctions are applied for, the Judge or Court may take the request as provided for in Articles 733.1 and 734.3 of the Civil Procedure Code, notwithstanding the possibility for it to grant the requested measures without further formalities by means of an order in the terms and time limits provided in Article 733.2 of the said Law.

2. The owner who considers that the Judge or Court before which the protective letter was presented is not the competent one, may submit the request for preliminary injunctions before the one he or she deems to be competent, provided that the application reports the existence of the protective letter and the Court to which it was submitted

The first controversy that arose during the debate was precisely, whether the protective letter could allow the alleged infringer to choose the forum in which to settle the foreseeable infringement dispute, since the submission of the protective letter would be prior to the application for interim measures. Point 2 of the article seems to be open to interpretation in the sense that a court receiving the protective letter may reclaim the preliminary injunction order if the plaintiff brings it before another court.

As far as I could see, the opinions were varied. However, I cannot find arguments to defend that the jurisdiction of the infringement claim should be chosen by the alleged infringer.

I do not see any relevant technical reasons that would prevent the court chosen by the owner from taking over the preliminary injunctions proceedings. In such a situation, if it is possible to maintain the general procedure, i.e. the power of the owner to choose the court where to file the infringement claim among the possible competent courts, why should this be different in the case of preliminary injunctions?

The other point, even more controversial, is the notification of the protective letter to the patent owner. What was discussed on the 'Patent Monday' was whether or not it was necessary to transfer the contents of the document to the patent owner, instead of simply notifying its existence.

After analysing it, my position is even more radical. What is the need for notifying the patent owner of the writ? In the general procedure, the patentee decides who to sue for possible infringement of their rights, based on the information at their disposal. No one informs the owner beforehand whether or not a third party is preparing the defence against their possible claim. Why should the situation be different in the case of possible preliminary injunctions? Is there any practical difficulty to retain these pleadings in court and only address them once the request for preliminary injunctions arrives?

Obviously, with the text of the current Law, the notification of the existence of the protective letters to the owner of the patent is unavoidable; but would it be possible to avoid the notification of its content to the owner? If the notification is made, the general procedure is completely altered. Instead of the owner preparing the claim, and the alleged infringer preparing his defence in the light of the plaintiff's arguments, the opposite situation would arise: the infringement claim would be prepared once the defendant's arguments are known.

Understandably there are situations where maintaining the structure of the general infringement procedure is impossible, because giving the defendant time to prepare the defence would slow down the proceedings; but there is no need to go to the opposite extreme.

During the 'Patent Monday' discussion, lawyer Oriol Ramon (Vidal-Quadras & Ramon) offered up a possibility that seems quite reasonable to me, although I evidently do not know its legal feasibility. The protective letter cannot really prevent the request for preliminary injunctions; the only thing it avoids is that the injunctions are agreed upon without the Judge having access to the defense of the alleged infringer. Thus, the Law should be interpreted in the sense that only the person who had actually filed a petition for preliminary injunctions would be entitled to access the contents of the letter. What is the point of providing this highly confidential information to those who have not yet filed a petition for preliminary injunctions?

Just to summarize, in my opinion, the submission of the protective letter should be able to be made in any competent court, but in no way should it affect the possibilities of the plaintiff in choosing the forum in which to carry out the request for preliminary injunctions, and the subsequent demand. The existence of the document should not even be notified to the owner of the patent, much less the transfer of its contents. The document should simply be available for consultation by the Judge who receives an *inaudita parte* request for preliminary injunctions. Thus, the Judge, in a procedure as close as possible to the general one, could decide whether to adopt the preliminary injunctions *inaudita parte* having at least a first idea of the defendant's arguments, or to convene a hearing to hear the defendant.

If there were consensus on the aforementioned, since the procedure contained in the Law does not address this, could we not be innovative as Luis Rodriguez Vega and Xavier Huarte were at the time and look for an alternative? Could not there be a formal commitment from the alleged defendant before the court to ensure the delivery of the arguments within a few hours, after a simple phone call? Would it not be easier to deliver justice if the Judge could have the arguments of both parties, without delaying the procedure, before agreeing on *inaudita parte* preliminary injunctions?