

# Preliminary Injunctions pertaining to patents: which control of the validity of the title?

By Michel Abello and Jérôme Tassi, lawyers. **Loyer & Abello**

The Law of 29 October 2007 deeply modified the regime of preliminary injunctions in the field of patents. While the judge previously had to examine the seriousness of the action on the merits, only the likelihood of infringement is now required according to the new text. The Court of cassation lately specified that the judge in charge of summary proceedings shall take into account the serious grounds concerning the validity of the title.



Michel Abello, lawyer

Jérôme Tassi, lawyer

## ABOUT THE AUTHORS

Michel Abello is the managing partner and co-founder of the law firm Loyer & Abello and is specialized in Intellectual Property Law. Graduated from the Ecole Centrale Paris and from University Paris II, he worked for twelve years as a Patent Attorney before registering at the Paris Bar in 2003.

Jérôme Tassi is Lawyer at Loyer & Abello. Loyer & Abello has been awarded "Rising team" in Patent law at the "Trophés du Droit" 2014.

Prior to the Law of 29 October 2007, the former Article L.615-3 of the Intellectual Property Code established two conditions for obtaining a preliminary injunction (hereafter "PI"): the action on the merits had to (i) appear serious and (ii) have been introduced in a short period of time starting from the knowledge of the infringement facts by the patent holder. The law of 29 October 2007 concerning the fight against infringement modified the regime of the PI by mentioning that "the jurisdiction can only order the requested measures if the elements of proof, reasonably available to the plaintiff, makes plausible that his rights are violated or that such a violation is imminent."

**"IT IS DISPROPORTIONATE TO GRANT A PI WITHOUT EXAMINATION OF THE GROUNDS OF INVALIDITY."**

### The change operated by the law of 29 October 2007

Following this modification, the interpretation of the text was subject to debate. On the one hand, for some authors, the new redaction of the text resulted in the reduction of the control of the judge in charge of PI<sup>1</sup> who would now only have

to evaluate the likelihood of infringement, to the exclusion of the title validity. Such a literal interpretation significantly reinforces the rights of the patentee which could obtain a PI on the basis of a patent of uncertain validity.

In Belgium, the Court of cassation has adopted this thesis in admitting the validity of a PI pronounced on the basis of the Belgian part of a European patent, even though this patent had been invalidated by the European Patent Office. The Court noted that

there was a pending appeal in front of the Board of appeal and that this appeal had a suspensory effect.<sup>2</sup>

### The theory of "obvious invalidity"

To our knowledge, the President of the Court of First Instance of Lyon was the first one to apply this text. He stated that "unless the invoked title is obviously invalid, the judge in charge of preliminary injunction shall limit himself to verify, in addition to the plaintiff's right to act, the existence or the imminence of an infringement of rights

conferred on him by the title"<sup>3</sup>. In this case, the judge denied examining the claims for invalidity on the ground that the patent had been granted by the French National Intellectual Property Office which performs a minimum validity control.

The Paris Court of Appeal followed this position, holding that "this law has only subordinated the measures of Article L.615-3 to the plausible character of the infringement of the protected rights and not to the likelihood of validity of the patent from which they are derived; that before the judge in charge of preliminary injunction, who is judge of the obviousness, only the obvious invalidity of the title can make the imminent infringement of rights implausible."<sup>4</sup> In respect with a patent in the pharmaceutical field, the Court of Appeal added that "except setting itself up as a man of science", it could hardly examine the claims of lack of inventive step raised by the defendant. The same justification led the court, in other cases, to not study the claims of insufficiency of description or extension of the subject-matter of the application beyond the content of the application as filed<sup>5</sup>.

The position adopted by those decisions is very favorable to the patentee, be-

## KEY POINTS

- The control of the validity of a patent by the judge is an essential question for PI. If the judge does not consider the grounds on the validity of the title, an interdiction could be pronounced on the basis of a patent of questionable validity
- Case law was divided between a validity control limited to obvious invalidity of the patent and examination of the invalidity claims raised by the alleged infringer.
- The Court of cassation lately took position in favor of the second thesis, in accordance with the principle of proportionality.

cause it seems that only an obvious lack of novelty could be taken into account to deny the PI. The position of the patentee is also reinforced by the fact that the prohibition measures are often asked in trials against generic drugs or when the content of patents has been incorporated into standards. In those cases, it is difficult to challenge the existence of an infringement so the defendant often finds himself deprived of arguments if he cannot challenge the validity of the asserted patent.

### The thesis of "serious challenge"

On the other hand, it was argued that the law of 29 October 2007 is the transposition of the Community Directive n°2004/48 of 29 April 2004 on the enforcement of intellectual property rights. According to Point 22 of the explanatory memorandum of the Directive, "It is also essential to provide for provisional measures to immediately put an end to the infringement without waiting until a decision on the merits, in observance of the rights of the defence, ensuring the proportionality of the provisional measures in accordance with the specificities of the case in question". In interpreting the French text in accordance with the purposes of the directive,

it could seem disproportionate and inconsistent with the rights of the defence to grant a PI without examining the seriousness of the invalidity grounds raised by the defendant.

Some judges have thus maintained the requirement of the examination of the seriousness of the invalidity grounds. The Paris Court of Appeal thus stated as a principle in a decision of 23 May 2013 that "the judge in charge of preliminary injunction must rule on the serious challenges that are raised before him against the requested measures and these challenges can pertain to the validity of the title; he is responsible for assessing the seriousness of the challenge which then deprives the alleged infringement of any obvious character."<sup>6</sup>

### The debate resolved by the Court of cassation

The divergence of opinion between the different French Courts was fortunately recently clarified by the Court of cassation. The Court had to examine an appeal decision having decided that "only the manifest nullity of the title can make the imminent infringement to his rights implausible". In its decision of 21 October 2014, the Court approves the reasons of

the first instance judgment upheld by the decision of the Court of appeal indicating that "in view of these findings and appreciations, highlighting that Patent EP 532 did not encounter, at this stage, any serious ground for invalidity, and that the companies Institut FürRundfunktechnik, Audio MPEG and SISVEL proved the plausible infringement of this patent"<sup>7</sup>.

In other terms, the Court of cassation confirms the decision, but rejects the obvious invalidity the thesis and takes position in favor of a control by the judge in charge of PI of the seriousness of the grounds for cancellation. This case will hopefully put an end to the case law fluctuations on this essential question for right holders and practitioners.

This patent-related solution is meant to be applied *a fortiori* to all other intellectual property rights, the examination of the validity of a trademark or of a design being less complex than that of a patent.

## CONDITIONS OF THE PROHIBITION MEASURES

Prior to the Law of 29 October 2007	Since the law of 29 October 2007
1) Seriousness of the action on the merits 2) Action on the merits brought after a brief delay subsequent to the knowledge of the infringement facts	Likelihood of the infringement of rights (including examination of the seriousness of the grounds for invalidity of the patent since the decision of 21 October 2014)

<sup>1</sup> In France, the President of the Paris First Instance Court has exclusive jurisdiction for patent cases in summary proceedings

<sup>2</sup> Belgium, Court of cassation, 5 January 2012.

<sup>3</sup> Court of First Instance of Lyon, 17 June 2008.

<sup>4</sup> Court of Appeal of Paris, 21 March 2012; also Paris Court of Appeal, 10 January 2014.

<sup>5</sup> Court of Appeal of Paris, 13 December 2012.

<sup>6</sup> CA Paris, 23 May 2013; see also Paris Court of First Instance, 18 March 2010.

<sup>7</sup> Cass. Com., 21 October 2014.