

**Fordham Intellectual Property Law Institute
Seventeenth Annual Conference
Intellectual Property Law & Policy
Cambridge University – Wednesday 15 April 2009**

Outline for Presentation by Edward Nodder, Bristows

“Preliminary Injunctions Under European Patents Comparative Analysis and Future Plans”

The Present Situation

Applications for preliminary injunctions (“PI’s”) are common in patent cases, particularly in the pharmaceutical sector. This is an area where the patent and regulatory regimes interact closely and originator and generics companies clash frequently.

At present, the equivalent of a Pan-European PI only be built up on a country-by-country basis and requires the lawyers in the individual countries to work together and co-ordinate an effective strategy. Organising such co-ordination programmes is something which I do all the time. It is exceedingly complicated. Here is a table of data based on my experience and which I will develop further in my presentation.

| Country | <i>Ex Parte PI</i> | <i>Inter Partes PI</i> | <i>Time to inter partes decision</i> | <i>Quid Pro Quo for PI</i> |
|----------------|---------------------------|-------------------------------|---|-----------------------------------|
| UK | ✓ | ✓ | Within 7 days | Cross-undertaking in damages |
| Austria | ✗ | ✓ | 4-12 weeks | Bank guarantee |
| France | Very unusual | ✓ | 6-12 weeks | No - damages possible |
| Germany | ✓ | ✓ | 1-3 months | Banker’s Bond |
| Italy | ✗ | ✓ | 8-10 months | Damages for abuse of process |
| Spain | ✓ | ✓ | 3-6 months | Bond |
| Portugal | ✗ | ✗ | Up to a year | None |

It will be powerfully demonstrated that the current situation for PIs in Europe is horribly complex and provides no business certainty. The risks, timescales and practice on PIs vary hugely between jurisdictions. You need a large and experienced multi-jurisdictional team to co-ordinate a strategy which then can only make the best of such a muddle. Inevitably, such teams are expensive.

The Prospects for Change

It seems highly unlikely that quick and coordinated national changes could be introduced to achieve better harmonisation across so many different European jurisdictions, but the hoped for introduction of a brave new European and Community Patents Court ("ECPC") may go a long way to resolve these issues. If adopted in its broadest form, the ECPC would be operative in all 34 contracting states of the EPC.

Consideration given to PIs in the ECPC

I shall explain how a joint EPLAW/IPJA working Committee of Judges and practising lawyers considered possible rules applicable to the ECPC in November 2006. They looked in detail at principles of procedure relating to full infringement and revocation proceedings.

When it came to the issue of PI they recognised that

"there is a possibility for potential conflict between the powers of the national courts to grant preliminary injunctions and the powers of the European Patent Court to order or deny similar relief".

The Committee recommended that the potential for such conflict be reconsidered to avoid forum shopping and conflict between the ECPC and national courts. In particular, they felt that if national courts grant relief to a party contemplating proceedings before the ECPC then such relief should only apply until such time as the ECPC has reviewed the relief. Thereafter it shall be for the ECPC to grant or deny further provisional relief.

Some other important principles of PIs were reviewed by the Committee, as I shall explain, but there is more work to do.

Unanswered Questions

I shall demonstrate that there are many, including:-

- What test will be applied by the ECPC in deciding whether to grant a PI?
- Will the interests of third parties, eg Public Health Authorities, be taken into account and will they be represented?
- Will the decision of the ECPC in relation to a PI always take precedence over that of the national courts?

Closing Remark

From the viewpoint of a practising patent litigation lawyer, a swift, fair and predictable PI procedure is crucial for both originator pharmaceutical and generic companies. Together such companies account for a very large proportion of all the patent litigation in Europe. In my view, despite the excellent work which has so far been done towards an ECPC, not enough attention has yet been focused on PIs.