

AIPPI -Workshop XII

IP Litigation throughout Europe

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PRELIMINARY INJUNCTION IN ORDER TO PREVENT AN IMMINENT INFRINGEMENT

□ THE CONTEXT :

- Implementation of article 9 of Directive 2004/48, by the French “anti-infringement” law, October, 29, 2007
- Broadening and reinforcement of the provisional measures already existing in French law

❑ THE PREVIOUS LAW

- Specific procedures and measures already existed as for patents and trademarks.
As for others IP rights : traditional summary proceedings.
- Criteria : seriousness of the action on the merits
- No possibility to obtain provisional measures in case of imminent infringement
- Necessity to first introduce the action on the merits, within a short period of time from the knowledge of the infringement by the owner of the rights
- No proceedings “ex parte”

□ THE NEW FRENCH LAW

- The scope of the preliminary injunction is broader, and applies to all IP rights
- Possibility to obtain preliminary injunction in partes as well as ex parte
- No necessity to first institute an action on the merits
- Possibility to obtain provisional measures in case of imminent infringement

❑ THE MAIN PROVISIONS OF THE NEW FRENCH LAW

“Anyone admissible to institute an action for infringement is entitled to start, before a Court having jurisdiction, against any alleged infringer, summary proceedings in order to obtain any measure in order (...) to prevent an imminent infringement.”

*“The Court having jurisdiction can also order on request (i.e *ex parte*) any urgent measure when the circumstances require that such measure shall be issued without the defendant having been heard, notably when any delay would cause an irreparable harm to the rightholder.”*

“The Court judging whether in partes or ex parte, can only grant the required measures when evidence, reasonably accessible to the plaintiff, make it likely that (...) infringement is imminent.”

□ AS FOR THE RIGHTS UNDER THE THREAT OF AN IMMINENT INFRINGEMENT

- Nature of the rights

- Broadening of the scope of the law since it now includes :
 - Patents (article L 615-3)
 - and trademarks (article L716-6)

But also :

- Plant Variety rights (L 623-27)
- Registered design (L 521-6)
- Geographical names (L722-3)
- Bata bases (L 343-2)

What about copyright ?

Article 808 and 809 Civil Proceedings code :
Normal summary proceedings.

The judge can order appropriate measure
to prevent an imminent harm.

- As for the applicant
 - = “Anyone admissible to institute an infringing action” ... i.e
 - Owner of
 - A published application
 - A granted right
 - Exclusive licensee

- **What about the validity of the rights ?**

- The law doesn't say anything about validity, and only speaks of the "*the likelihood of the infringement or of its imminence*"
- Uncertainty resulted from this wording

- The Presidents of some Courts (Lyon and Strasbourg) strictly read the law.

They just checked whether or not the rights were in force without any assessment of their validity.

- As for the Paris Court, which is now the only one to have jurisdiction in Patents, Community trademarks and Community registered design,

decided to take into consideration any circumstance (such as prior art) seriously challenging the validity of the rights

since it might affect the likelihood of the infringement of the rights.

□ AS FOR THE PROOF OF THE ALLEGED THREAT OF IMMINENT INFRINGEMENT

- The Court can order the measures in partes or ex parte, only if (...)
“it’s likely that the rightholders are about to be infringed”
- The burden of the proof lies on the applicant

- **As for the proof of imminence**

Strict control by French Courts :

- Court of appeal of Lyon, 2009, October 9
President of the Court of 1st Instance of Paris,
2010, August, 19 (patent cases)
- Both rendered in patent cases
- The mere grant of a market authorization for a generic medicinal product does not show proof of the imminence of its launching on French market

- Such proof results from additional circumstances such as
 - Launch of same products in other European countries
 - Petition to French Administration for price fixing
 - Press release showing the product and announcing date of launch on French market

- **Remark** :

Assessment of imminence takes into account

- The imminence of the event to be forbidden (display on a faire ...)
- And the existence of an IP right still in force at that time

(as for generic medicinal products, the event to prevent may happen in a very near future, but at a time when the patent on the princeps has just expired)

- President of the Court of 1st Instance of Paris, 2009, November, 20, (trademark)

Prohibition, in a situation where the alleged imminent event to prevent

(display of a forklift truck on a fair)

was not clearly distinct from the continuance of previous infringing acts already committed

(advertising on the French Market)

- **As for the proof of the infringement**

It is of course difficult to describe a product or a process the alleged infringement of which only appears as imminent

So the proof of the materiality of the infringement is difficult to obtain.

□ AS FOR THE MEASURES THAT CAN BE ASKED FOR

- “any measure to prevent an imminent infringement”
 - Prohibition
 - under penalty
 - Confiscation of the tools

□ PROCEEDINGS

- In partes : summary proceeding
- Period of time to obtain a decision :
about 4 to 8 weeks

- Ex parte :

- President of the Court of 1st Instance of Paris, 2009, November, 20, (trademark)
- 3 conditions checked by the President :
 - Urgency
 - Reason for an exception to the rule of contradiction
 - Likelihood of infringement
- But not the condition of the imminent infringement

- It shows the difficulty of a clear limit between
 - continuance of the infringement already done,
 - and the imminence of the infringement

- **Recourse against the order**

- Special proceedings against the order : petition for revocation of the order
- But of course difficulties to obtain the revocation by the same judge who issued the order to be revoked
- Appeal is possible against the order judging about the petition for request

- **What about the necessity to institute an action on the merits ?**

- **The Directive :**

“Member States shall ensure that the provisional measures referred to in paragraph 1 and 2 are revoked or otherwise cease to have effect, upon request of the defendant, if the applicant doesn’t institute ... proceedings leading to a decision on the merits”.

The said Paragraph 1 relates to interlocutory injunctions intended to prevent any imminent infringement as well as interlocutory injunctions prohibiting the continuation of the alleged infringement.

- The French law :

“When the measures aimed to discontinue an infringement are ordered before the commencement of the action on the merits, the applicant must bring an action ...”

This provision of the French law seems limited to discontinuance of an infringement and not to relate to preventive measures against an imminent infringement.

Does it exclude the necessity to institute the action on the merits when the measures only aim to prevent an imminent infringement ?

- Is it just mere bad wording of a law which has just to be interpreted according to the EC Directive ?
- But French law forbids preventive actions on the merits
- Specified exceptions exists, such as declaratory action for non infringement of Patent
- But not infringing action when infringement is only a threat

Thank you for your patience

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