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PROTECTIVE LETTERS UNDER SPANISH PATENT LAW

UNITED CAPS FOOD v BORGES BRANDED FOOD

Barcelona Commercial Court No 5, Order 1/2017 (Jan 5th, 2017)

Barely three months before the new Spanish Patent Act comes into force (Apr 1st, 2017), the Barcelona Commercial Court No 5 has rendered an order taking forward the filing of a protective letter (“*escrito preventivo*”), despite this possibility not being explicitly provided for under the current Spanish Patent Act No 11/1986, still in force. The latter will be soon replaced by the new Spanish Patent Act No 24/2015, whose Section 132 introduces for the very first time the so-called ‘protective letters’ (“*escritos preventivos*”) into Spanish Patent Law.

On 2nd Jan, 2017, UNITED CAPS FOOD (‘UCP’), a Luxembourg-based plastic caps-manufacturer, submitted a protective letter before the Barcelona Commercial Court. The protective letter was filed as an anticipatory defense in case a preliminary injunction *inaudita parte* were requested by BORGES BRANDED FOOD (‘BORGES’), be it against UPC herself and/or against her client DEOLEO, for the alleged infringement of utility models no. 153508 and/or no. 1078291. Both relate to **oil dispenser caps** which are currently being used by DEOLEO for olive oil bottling.

By Order 1/2017, the Barcelona Commercial Court No 5 admitted the protective letter as a non-contentious jurisdictional matter (technically known as ‘voluntary jurisdiction’ under Spanish Law), being this admission immediately notified to BORGES. Should any preliminary injunction (‘PI’) being actually requested against UCP/DEOLEO in a three months-term, the Order says, the petition shall not be awarded *without them being previously heard*, except in duly justified urgent cases. Besides, the decision was also reported to the Barcelona Court Registry, so that any future PI application filed on that matter will also be assigned to the same Court and due account shall be taken of the plea submitted by UPC/DEOLEO in ascertaining whether the requested PI should be granted. In the event that the three months-term is expired without any PI being requested by BORGES, the protective letters shall be deprived of any effects.

Protective letters under the forthcoming Spanish Patent Act 24/2015

Section 132 of the new Spanish Patent Act reads as follows:

- 1. Those who can reasonably foresee interim measures being shortly requested inaudita parte against them may appear in a court of competent jurisdiction to hear the case in order to set out defenses to the infringement claims. The Court shall initiate interim proceedings of which the patent holder will be informed. Should the latter actually apply for such measures within the following three months, the Court may take the request forward pursuant to Section 733(1) and 734(3) of the Civil Procedure Code, notwithstanding the possibility for the Court to grant the requested measures without further formalities as provided for in Section 733(2) of the Civil Procedure Code.*
- 2. A right holder who believes that the seized Court lacks jurisdiction to hear the case may submit the request for interim measures before the Court deemed to have jurisdiction, provided the application reports the existence of the protective letter and the Court to whom it has been submitted.*

As the Barcelona Commercial Court argues in its decision, «Section 132 of the Spanish Patent Act No 24/2015 ... validates what has until now been a court and legal practice» [see Order 1/2017, § 4(3)]. The proceedings through which the protective letter has been taken forward by Order 1/2017 are substantially similar to those provided for in Section 132. The latter should be praised for, at least, making clear that protective letters cannot be plainly refused by arguing, as Madrid Commercial Courts have suggested, that their submission is not in accordance with the principle of procedural legality (see Madrid Commercial Court No 1, Order on Jan 29th, 2014).