

# Prima facie assessment for PI proceedings, third party liability and CJEU'S *Phoenix Contact* judgment

Discussion Panel – Young EPLAW – 17 April 2023

Panellists:

Callum Beamish – Senior Associate (Barrister), Powell Gilbert LLP (UK)

Jan-Caspar Maiers – Associate, Wildanger Kehrwald Graf v. Schwerin (DE)

Louis Bidaine – Associate, Stibbe (BE)

Maria Giulia De Rosa – Associate, BonelliErede (IT)

Moderator:

Max von Leitner – Associate, HOYNG ROKH MONEGIER (DE)

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# Introduction – Overview of Topics

- Requirements for PIs
- Assessment of validity and infringement
- Liability for compensation
- Strategic considerations

# Requirements for a Preliminary Injunction

# Overview – Requirements for Preliminary Injunction

- BE – Urgency requirement. Balance of convenience
- IT – The interplay between prima facie likelihood of success and danger in delay
- DE – Prima facie clear-cut case on infringement and validity on top of urgency requirement
- UK – Serious issue. Adequacy of damages. Balance of convenience

Preliminary Injunctions – assessment of  
validity and infringement – *Phoenix Contact*

# Overview – Preliminary Injunctions – assessment of validity and infringement – *Phoenix Contact*

- DE – Traditionally high bar for both infringement and validity. Will *Phoenix Contact* impact caselaw on validity assessment and further divide German patent litigation courts into rather cautious and rather PI-friendly venues?
- UK – Not a mini-trial (hard to use invalidity as shield), “serious issue” a low bar
- BE – Towards a more detailed assessment of validity and infringement
- IT – The assessment of prima facie likelihood of success (validity and infringement) and the role of the Court Technical Advisor (CTA)

Liability for compensation – what happens if a preliminary injunction is found to be wrongly granted? *Bayer, Mylan*

# Overview – liability for compensation – what happens if a PI is found to be wrongly granted?

- Art 9(7) of Enforcement directive
- CJEU: *Bayer* (Case C-688/17), *Mylan* referral (Case C-473/22)
- UK – Cross-undertakings in damages. Third parties can be included. Loss caused by Order – patent not treated as invalid *ab initio* in Counterfactual
- IT – No objective/strict liability (except for trade secrets). Use of security, abuse of process and liability for unfair damage
- BE – Pre/post-Bayer case law rejects objective / strict liability (SC appeal pending in *Mylan/Novartis*)
- DE – Plaintiff must compensate defendant for any damage caused by enforcing a PI if the order is overturned



# Strategic Considerations for Preliminary Injunctions

# Overview - Strategic Considerations for Preliminary Injunctions

- IT – Pros and cons of interim proceedings in Italy
- UK – Favourable jurisdiction for PIs on pharma patents. Strict liability for compensation
- BE – Patent-friendly jurisdiction. Low risk of enforcing PI
- DE – PIs are traditionally the exception, not the rule, but recent Munich caselaw, backed by *Phoenix Contact*, might offer new opportunity for risk-taking plaintiffs

# Thanks - any questions?



LinkedIn QR:



Powell   
Gilbert



WILDANGER



 HOYNG  
ROKH  
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**Louis Bidaine**  
Associate – Intellectual Property  
T +32 2 533 52 28  
M +32 497 19 84 78  
louis.bidaine@stibbe.com



**BonelliErede**

with LOMBARDI