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

**Discussion Panel – Young EPLAW – 17 April 2023**

**Panellists:**
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**Moderator:**
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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?

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