

# ARTICLE

## PRELIMINARY INJUNCTION ON THE BASIS OF A PATENT APPLICATION – ANOTHER FRENCH ODDITY?

Patent Law | 22/06/22 | François Pochart Pierre-Olivier Ally

In an interim order dated 3 June 2022, the President of the Paris Judicial Court:

- Ruled that a **motion for interim injunction based on Article L.615-3 of the French IP Code** (the "IPC") on the basis of a patent application was admissible. According to the Judge of summary proceedings, the fact that Article L.615-3 of the IPC refers to "**the rights conferred by the title**" does not exclude legal standing to as "the term 'title' covers the basis of the infringement action, i.e., the published patent application or the patent, when it has been granted"; and
- Nevertheless, rejected the requested **interim measures** insofar as there **are serious doubts as to the validity** of the patent application.

As a reminder, this dispute concerns the reference product GILENYA®, which contains fingolimod hydrochloride as an active ingredient and is indicated as a monotherapy for the treatment of very active forms of relapsing-remitting multiple sclerosis (MS). GILENYA® is covered by European patent application EP 2 959 894 (the "**EP'894**" application), owned by Novartis AG. The period of commercial exclusivity for GILENYA® lapsed on 22 March 2022.

In a nutshell, the EP'894 application was filed on 16 July 2015 and is still under examination before the European Patent Office. In the case at hand, Novartis filed an appeal on 22 December 2020 before the EPO Board of Appeal against a rejection decision issued by the Examining Division. According to the minutes of the oral proceedings, which were held on 8 February 2022, the Board of Appeal ordered the Examining Division to grant the patent on the basis of one of the claims submitted by Novartis and remitted it to the Examining Division for adaptation of the description. The written decision was published in the EPO Register on 3 June 2022.

This is the context in which the interim order of 3 June 2022 has been rendered. This unusual case raises many questions about the scope of the rights conferred by a patent application to its holder.

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Pursuant to Articles L.613-1 and L.615-4 of the IPC, the Judge of summary proceedings ruled that the owner of a patent application is a "*person with standing to sue for infringement*" (cf. art. L.615-3 of the CPI) and thus ruled that the motion for a preliminary injunction based on the EP'894 patent application was to be considered admissible. This decision of the Judge of summary proceedings seems very surprising insofar as Article L.615-3 of the IPC requires the existence of a title (and not a mere application).

Indeed, the following articles of the IPC and the EPC are very clear on the fact that a patent application is not a "title". For instance:

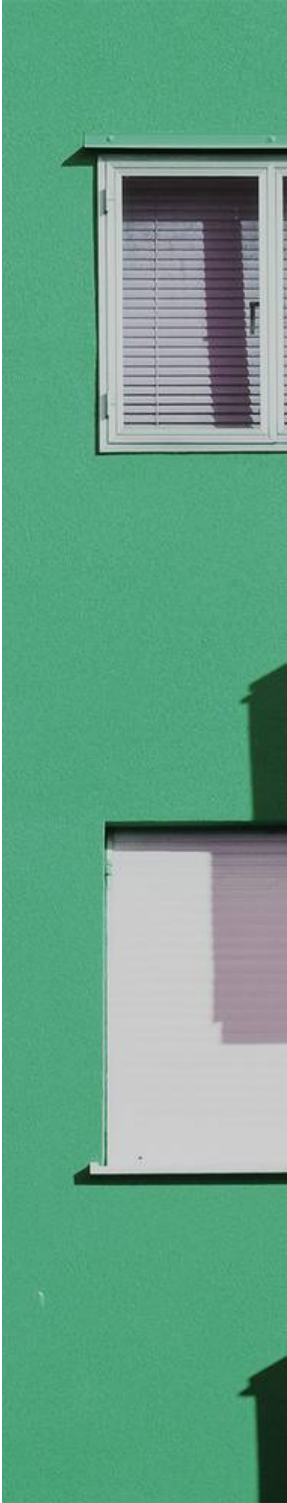
Art. L.611-1, paragraph 1 of the IPC: "*Any invention may be the subject of an industrial property **title granted** by the Director of the National Institute of Industrial Property **which confers on its owner or his successors in title an exclusive right of exploitation.***"

Art. L.611-2 of the IPC: "*Industrial property **titles** protecting inventions are:*

*1° **Patents for invention, granted** for a period of twenty years from the day of filing of the application [...]*".

Art. L.611-7 of the IPC: "*1. [...] The employer shall inform the employee who is the author of such an invention when the latter is the subject of **an application for an industrial property title and when the title is granted, if applicable.***"





Art. 64(1) of the EPC: "A European **patent** shall, [...], confer on its proprietor, from the **date of publication of the mention of its grant**, in each Contracting State in respect of which it is granted, **the same rights as would be conferred by a national patent granted in that State.**"

Furthermore, the term "title" of article L.615-3 of the IPC which replaced the term "patent" by the adoption of Law No. 2014-315 was opted for to simply extend the applicability to SPCs and utility certificates.

Biogaran had also brought to the attention of the Judge the provisions of Article L.614-9 of the IPC, which precisely lists the rights conferred by a European patent application as follows:

*"The rights defined in Articles L. 613-3 to L. 613-7, L. 615-4 and L. 615-5 of this Code may be implemented from the date on which a European patent application is published in accordance with Article 93 of the Munich Convention."*

Article L.615-3 of the IPC is thus not included in the list of provisions of this article. Biogaran then argued that preliminary injunction measures based on a European Patent application are clearly not admissible.

In any event, the President seems to have been convinced that motions for preliminary injunction should be declared admissible, as a patent application could be considered to be tantamount to a "title" and the owner of a patent application also has standing to bring an infringement action. Surprisingly, the Judge did not provide any reason in her decision with regards to the arguments raised on the basis of Article L.614-9 of the IPC. Nevertheless, the Judge ruled that the preliminary injunction should be dismissed on the grounds that the defendant raised serious arguments on the validity of the patent application.

To our knowledge, such a solution has never been adopted by French judges. On the contrary, French case law goes in the opposite direction, in particular the Paris Court of Appeal in a decision of 12 December 1997 in which the Court ruled that:

*"Considering that **Article L614-9 of the IPC, relating to the effects in France of European patents, exhaustively lists the rights that may be exercised as from the publication of the European patent application**; that among these rights providing the applicant for a European patent with provisional protection, **there is no right provided for by Article L615-3 of the IPC to request, in the form of summary proceedings, a preliminary injunction, subject to a fine, on the continuation of acts alleged to be infringing or the subordination of such continuation to the lodging of guarantees intended to ensure the compensation of the patentee,***

*Considering that it follows that **the first instance Judge was right to declare IOMEGA inadmissible to act in summary proceedings on the basis of the two aforementioned patent applications.**"*

Prior to the grant of a title by a patent office, the right to injunct does not seem to exist. In addition, an injunction based on a patent application could lead to an absurd and unacceptable situation in which the alleged infringer could not, before grant, commence a revocation action or opposition proceedings and thus not be able to challenge the validity of the so-called "title" enforced against it. Moreover, the latter would also not be able to file a counterclaim for revocation in the context of the infringement action on the merits initiated within the month following the order for preliminary injunction insofar as these proceedings will automatically be stayed pursuant to the last paragraph of Article L.615-4 of the IPC. Thus, the alleged infringer would find itself in a totally unbalanced situation.

Finally, it is interesting to underline that in its recent judgment (C-44/21) of 28 April 2022 which specifically related to interlocutory injunctions, the CJEU construes Directive 2004/48/EC of the European Parliament and of the Council as follows, mentioning in particular that:

*"[...] filed European patents enjoy a presumption of validity from the date of publication of their **grant**. Thus, **as from that date, those patents enjoy the full scope of the protection guaranteed, inter alia, by Directive 2004/48.**"*

As such, we understand that the CJEU rightly believes that, as far as preliminary injunctions are concerned, Directive 2004/48/EC offers protection to holders of granted patents.

Similarly, in the various jurisdictions in which this case is pending, Novartis has so far been unsuccessful in its motions for preliminary injunction, such as in the Netherlands, Germany, the UK and Finland.

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