

MOBILE WORLD CONGRESS - INTELLECTUAL PROPERTY FAST ACTION PROTOCOL 2019

The Commercial Courts of Barcelona have issued for the fifth consecutive year the Intellectual Property Fast Action Protocol in the framework of the Mobile World Congress (hereinafter MWC). The upcoming edition will be held in Barcelona from 25 to 28 February 2019. Every year the MWC brings together the main players in the mobile telephony market to present the sector's most recent innovations and cutting-edge technology in what has become the most important Congress in the sector.

According to the information provided by the Commercial Courts in their report detailing the outcome of the application of the fast action protocol, the 2018 edition ended with a total of 22 protective letters filed, all relating to patent matters. Among the applicants and the concerned parties were technology companies such as SAMSUNG, LG, WIKO, ZTE, HUAWEI and others. In addition, three patent-related requests for preliminary verification of facts¹ were filed against four companies, which were processed within 48 hours.

As for preliminary injunction requests, the Commercial Courts reported the filing of seven *ex parte* requests against eight companies. These requests were processed and resolved within 48 hours, and all were granted. No opposition was filed against the granting of those *ex parte* preliminary injunction requests. Additionally, one request for an *inter partes* (with hearing) preliminary injunction was filed, together with the main complaint. This application was resolved before the start of the Congress. In this case, the measures were granted by the Court but the defendant requested the lifting of same upon providing and depositing the substitute bond established by the Court. The Court granted this petition and suspended the enforcement of the injunction, thus lifting the measures.

The notification and execution of both the preliminary verification of facts and the *ex parte* preliminary injunction requests were carried out during the course of the MWC by a commission formed by the Lawyers from the Administration of Justice, with the collaboration of the event's organizers, GSMA, and the Fira de Barcelona, the event's annual venue. In addition, the Mossos d'Esquadra police force provided assistance and support, accompanied by the Commercial Courts Magistrates.

¹ Foreseen in art. 123 of the Spanish Patents Act. This is an urgent request to the Court to conduct enquiries to substantiate facts that might constitute patent infringement. The requirements for granting are as follows: it must be requested by a person with legal standing to bring legal actions arising from patent rights, there must be some indication of infringement, and finally, it must not be possible to verify the existence of infringement without resorting to these enquiries.

In view of the latest edition of the MWC scheduled for February 2019, a new fast action protocol has been issued. As a novelty, the European Union Trade Mark Courts of Alicante² have joined this protocol for the first time in collaboration with the Commercial Courts of Barcelona concerning matters related to EU Trademarks and Community Designs.

The 2019 protocol foresees the following commitments:

- a) To prioritise and preferentially process emergency preliminary injunction requests (either *ex parte* or *inter partes*) in relation to patents, designs, trademarks, copyrights, and unfair competition acts concerning products and materials which are on display at the MWC.
- b) To resolve and issue any *ex parte* preliminary injunction request within 48 hours. If the measures are processed *inter partes*, the preliminary injunction request will be resolved within a 10-day period.
- c) The Courts will resolve the admission of protective letters filed within 24 hours. The immediate admission and decision on protective letters helps avoid the adoption of *ex parte* preliminary injunctions, thus allowing the defendants to present their arguments against the granting of a preliminary injunction and guaranteeing the Court appearance of the defendants in an *inter partes* hearing.
- d) To assess the urgency legally required to grant preliminary injunctions, the prior conduct of the plaintiffs and the swiftness in filing the request from the moment they had knowledge of any infringement shall be determining factors. In this regard, it is important for the application for urgent preliminary injunctions to be submitted with enough advance-notice, when possible, so that the defendant may be heard.
- e) The Commercial Courts will carry out the immediate enforcement of any preliminary injunctions and/or urgent measures that the European Union Trade Mark Court of Alicante may issue within the scope of its specific competence. To this end, the relevant channels of communication and cooperation between the two Courts will be established.

Finally, looking ahead to the next edition of the MWC coming up in February 2019, we advise:

² The Commercial Courts of Alicante have exclusive jurisdiction throughout the Spanish territory to hear cases based on European Union Trade Marks or Community Designs.

1. Filing protective letters in case a participant at the MWC expects a request for an *ex parte* preliminary injunction to be filed against him. The filing of a protective letter serves two purposes: it will provide the applicant with the possibility of submitting his arguments prior to the potential application for an *ex parte* preliminary injunction, thus submitting in advance the non-infringement arguments and/or justifying the absence of urgency for granting the preliminary injunction. Secondly, the filing of protective letters allows the applicant to inform the Court of his willingness to appear immediately for a hearing in the event that a request for a preliminary injunction is filed, so as to avoid the possibility of an *ex parte* preliminary injunction order.
2. With respect to right holders who have evidence that infringing products will be exhibited at the MWC, we consider it advisable to submit a request for a preliminary injunction with enough advance-notice before the start of the Congress. In that way the measures will be enforceable from the first day, thus preventing infringers from exhibiting products that conflict with the holders' industrial property rights. It is important to highlight that any preliminary injunction request based on patent rights must be accompanied by a thorough technical analysis on how the patent right is infringed in order to justify the adoption of the measures.
3. Additionally, if on the first day of the MWC it is determined that a third party is exhibiting products which may infringe patent rights, the right holder may file on that first day a preliminary injunction request. Additionally, if it is necessary to analyse the potentially-infringing products beforehand in order to prove infringement, the right holder may file a preliminary verification of facts request together with the preliminary injunction. If the preliminary verification of facts is granted by the Court, the seizure of the products will be ordered and carried out. These products will then be analysed by an expert appointed by the applicant who will issue a technical report. In light of the technical analysis, the Court will render a decision regarding the granting of the preliminary injunction that same day.

In past MWC editions, a joint request for a preliminary verification of facts and a preliminary injunction has been used on several occasions by patent holders who suspected that a third party was infringing their patents but had no other way to prove it.

HOYNG ROKH MONEGIER has recognized experience in the MWC's fast-track procedures. If you have any questions, please contact Luis Fernández-Novoa (luis.fernandez@hoyngrokh.com), Jose Antonio Sanmartín (jose.sanmartin@hoyngrokh.com) or Alvaro Velázquez (alvaro.velazquez@hoyngrokh.com).