



PORTUGAL – NEW INDUSTRIAL PROPERTY CODE

The new Portuguese Industrial Property Code was published last 10th December in the Portuguese Official Journal and will be in force as of the 1st July 2019.

However there are two important chapters that will be in force as of 9 January 2019 and 1 January 2019 respectively.

These chapters are related with the following legal aspects:

1. The modification of the Portuguese Law nº 62/2011 regulating through mandatory arbitration the pharmaceutical patent disputes between patentees and generic medicines companies;
2. Trade secrets.

As regard to the modification of the Portuguese Law nº 62/2011 that regulates through mandatory arbitration the pharmaceutical patent disputes between patentees and generic medicines companies we highlight that the new Portuguese Industrial Property Code establishes very important novelties, such as:

- A. Disputes are no longer subject to mandatory arbitration;
- B. Arbitral courts shall have the jurisdiction to assess and decide patent invalidity claims limiting inter partes the effects of this decision.

According with the new Portuguese Industrial Property Code as of January 9, 2019 patent disputes between patentees and pharma generic companies concerning alleged patent infringement by new generic medicines shall be decided either by the Intellectual Property Court or by voluntary arbitration.

According with the new law as of January 9, 2019, the patentee has the option to file a lawsuit in the Portuguese IP Court to enforce the patent or to start voluntary arbitration proceedings. Also in the case the parties do not agree to start arbitration proceedings the patentee must file a lawsuit at the Intellectual Property Court to enforce the patent. Therefore the new law returns pharmaceutical patent disputes to the courts after seven years of a mandatory arbitration system.

The second very important amendment introduced by the new law concerning patent disputes between pharmaceutical companies is related with the discussion whether arbitral courts have jurisdiction to decide about patent invalidity or not. This legal question generated great controversy in arbitral courts and judicial courts in the last seven years.

In fact many arbitral courts refused to decide this question arguing that the invalidity of an IP right can only be declared by judicial courts although and simultaneously other arbitral courts had a different opinion in the sense that patent invalidity could be decided by arbitral courts although with limited inter partes effect. The question was also the object of several judgements taken by the court of Appeal and the Portuguese Supreme Court but remained controversial.

The new Portuguese Industrial Property Code clearly establishes that defendants have the right to claim patent invalidity in arbitral courts although the effect of the decision is limited inter partes. An erga omnes judgement on this question can only be taken by judicial courts.

Concerning trade secrets the new Portuguese Industrial Property Code realize the transposition into national law of EU Directive nº 2016/943 dated 8 June. The new law establish that trade secrets are secret commercial information having economic value arising from the fact that this commercial information is secret and provided that it have been the object of reasonable measures taken by its holder to keep secrecy.

The scope of unauthorized acquisition, access to, use and communication of trade secrets is now legally defined and sanctions are established against illegal acquisition, access and use of third party trade secrets including compensation for damages.

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