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Generics can be sued in the courts of the pharmacies, says the Court of Turin

Daniela Ampollini (Trevisan & Cuonzo) · Tuesday, October 11th, 2011

A recently published decision of the Court of Turin in the case Merck Sharpe & Dohme versus Sandoz (decision of 7 April 2011), concerning dorzolamide hydrochloride timolol maleate eye drops, provides an interesting interpretation of the Italian rules governing territorial jurisdiction in the case of the infringement of pharmaceutical patents. MS&D sued Sandoz before the Court of Turin claiming that the jurisdiction would be based on the fact that samples of the relevant generic of Sandoz' had been purchased in pharmacies located in the Turin area. According to numerous relevant precedents, in such a case, in order to validly establish the jurisdiction of the Court of Turin, the patent holder would have had to name the pharmacists as co-defendants, as the pharmacists (and not the pharmaceutical company) would have been the ones to infringe the patent within the district of the Turin court. Once jurisdiction was in that way established in respect of the pharmacies, and considering that Turin was also the place of the pharmacies' legal seats, the pharmaceutical company could be named as co-defendant before the same court under Art. 33 of the Italian Civil Procedural Code, being responsible of an infringement connected to that carried out by the pharmacies. In this case, however, MS&D only sued Sandoz. The resellers were left out of the dispute. This notwithstanding, and going against numerous precedents, the Court of Turin stated that the venue had been correctly chosen as "the holder of the Marketing Authorisation is responsible for the presence in the market of the medicinal product no less than the pharmacies that enter into the sale and purchase agreements with the final customers (...) Art. 66 IP Code gives the patent holder the exclusive right to prohibit third parties, unless based on his consent, to produce, use, place in the market, sell or import for these purposes the product in question; the infringement of the 'placing in the market' is, at least as far as medicinal products are concerned, a behaviour that is legally imputable to the holder of the Marketing Authorisation, regardless of the specific civil law aspects related to the sale and purchase agreements that are entered into by other subjects, such as the local distributors of the drug". Sandoz was nevertheless successful in the merits and the decision of the Court of Turin presents a number of interesting points in these as well. I will surely comment on them in another post.

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