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Is the ECJ's judgment in Medeva in line with EPC (2000)?

Miquel Montaña (Clifford Chance) · Thursday, January 12th, 2012

The recent judgment from the ECJ of 24 November 2011 in case C-322/10 (“Medeva”) has surprised the patent community, since the ECJ appears to have changed the view expressed in its judgment of 16 September of 1999 in case C-392/97 (“Farmitalia”), where the Court declared that it was not for the ECJ, but for national Courts, to decide whether or not a product (for example, a combination of two active ingredients) was “protected” by the “basic” patent. Taking into account that patent law has not yet been harmonized throughout the European Union (“EU”), the answer given by the ECJ in the Farmitalia case appeared to make sense. The fact that the Farmitalia decision might lead some national Courts to apply the so-called “infringement test”, and other national Courts to apply the so-called “literal” test, was simply undesired collateral damage caused by this lack of patent law harmonization.

To prevent national Courts from applying contradictory tests (“infringement test” v. “literal test”), in Medeva the ECJ has now decided that it is for the ECJ to decide the meaning of “protected” in the context of article 3 a) of the SPC Regulation, and that the correct test should be the “literal test.” These conclusions may be questioned on a variety of grounds. First, they do not seem to be aligned with the principle of legitimate expectations, since relying on the Farmitalia decision, many national patent offices and national Courts had been applying the “infringement test” to decide whether or not a combination was “protected” by the basic patent. This sudden change of criteria may leave the EU exposed to potential damages claims from the companies whose legitimate expectations could be affected.

Second, the Medeva decision may lead to a very odd situation. In countries where the “infringement test” is applied, the patentee will be entitled to prevent third parties from marketing a combination that would fall within the general scope of protection of the “basic” patent until the patent expires since, under national law, the combination would be “protected”. In contrast, after the patent has expired, the patentee will not be able to enforce an SPC based on the “basic” patent, since, under EU law, the combination would not be “protected”. This appears to be too much of a contradiction even for an edifice with such a complex structure as the EU.

Finally, the “literal test” applied by the ECJ does not quite seem to fit with the spirit that inspired the drafters of the EPC (2000), in force since 13 December 2007, which deleted the phrase “the terms of” from article 69.1 of the EPC, which governs the

“extent of protection” of European patents. According to the initial wording of article 69, “1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.” As mentioned, the words “the terms of”, which clearly supported the “literal test”, were deleted in the amendment that came into force on 13 December 2007.

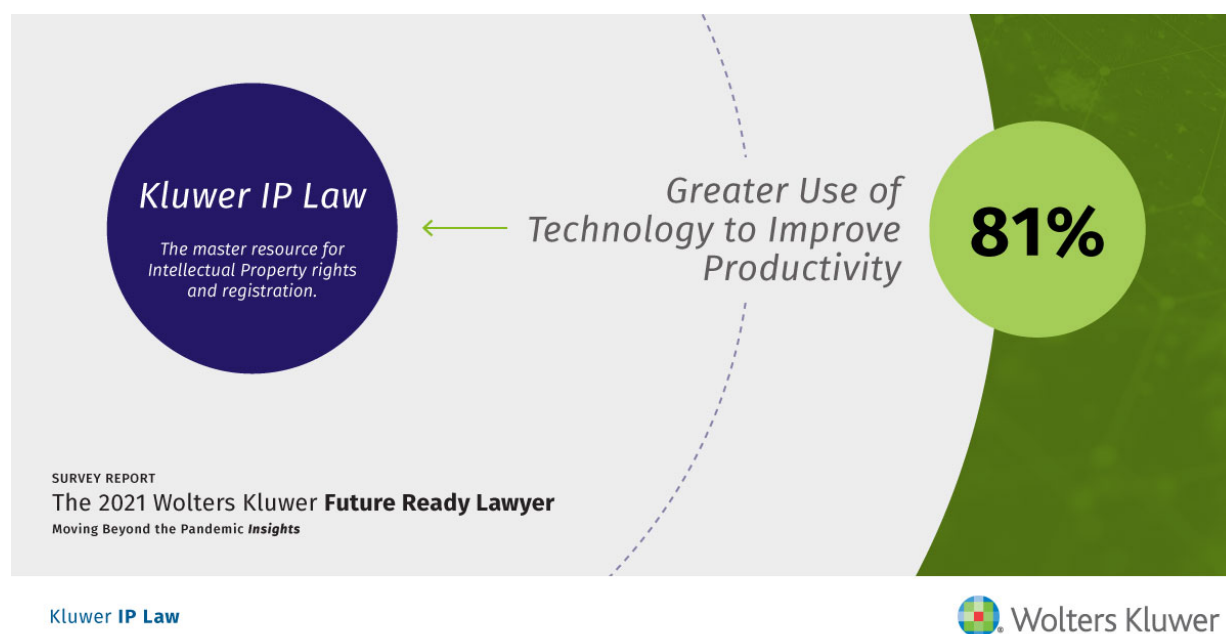
All in all, if the ECJ wished to harmonize the interpretation of article 3 a) of the SPC Regulation throughout the EU, it would have been preferable not to embark on the narrow path that the contracting parties to the EPC abandoned in year 2000.

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