

# Kluwer Patent Blog

## Can a basic patent be amended under Art. 138.3 EPC to overcome a nullity action brought against its SPC?

Miquel Montaña (Clifford Chance) · Tuesday, April 22nd, 2014

The messy case law from the Court of Justice of the European Union (“CJEU”) on supplementary protection certificates (“SPC”) that protect “combinations” of pharmaceutical products has left many patentees that relied in good faith on the criteria laid down by the CJEU in the judgment of 16 September 1999, Case C-392/97 (“Farmitalia”) with patents whose claims are not totally aligned with the new criteria laid down in the judgment of 24 November 2011, Case C-322/10 (“Medeva”), and the ensuing saga. Readers will remember that in Farmitalia the CJEU responded that it was not for the CJEU but for national courts to determine whether or not a product is protected by the basic patent. This was coherent with the fact that the CJEU lacks jurisdiction to interpret the provisions of the European Patent Convention (“EPC”), as the CJEU itself reiterated in the latest wave of its troubled sea of SPC judgments last December.

After the SPC Regulation came into force, the Commission organized a meeting of the experts from the Member States to discuss, among many other aspects, whether article 3 a) of the SPC Regulation requires the two members of a combination to be mentioned in the claims of the basic patent. The conclusion was that it was sufficient for the claims of the basic patent to extend their scope of protection to the combination (i.e. the so-called “infringement test”). This, coupled with the Farmitalia judgment, meant that many applicants did not feel the need to mention the members of a combination in the claims of the basic patent. As a result, over the years the national patent offices of the Member States have granted SPCs on combinations based on basic patents that did not mention the members of the combination in the claims.

All this appeared to change overnight, when the CJEU handed down the ill-famed Medeva judgment, which nobody - even the Court that had referred the preliminary questions to the CJEU - was able to understand. The conclusion that seemed to transpire from the decision was that the “infringement test” did not appear to be the right test. As readers will know, in the latest episode in the saga of SPC judgments published last December, the CJEU pulled back to a more balanced test, the precise contours of which will have to be further clarified in future cases.

Along the road, to try to remedy the collateral damage caused by the CJEU’s inability

to find its way, many patentees have legitimately looked for possible ways to align the scope of protection of their basic patents with the meandering CJEU case law on SPCs. One of the routes explored has been to request the limitation of the claims of the basic patent before national courts (Art. 138.3 EPC), so as to mention the elements of the combination in the claims of the basic patent. This possibility was rejected by Commercial Court number 8 of Barcelona in a Ruling of 21 February 2012. The Court declared the inadmissibility of the writ where the patentee had proposed the limitation of the claims of the basic patent because it considered that there was no connection between the title attacked (i.e., the SPC) and the title requested to be amended (i.e., the basic patent).

This Ruling has now been reversed by the Court of Appeal of Barcelona (Section 15) in a Judgment of 3 April 2014. The Court, after noting that there is a clear connection between the SPC and its basic patent, annulled the Ruling whereby the court of first instance denied leave to proceed for the writ proposing the limitation of the claims of the basic patent, and all subsequent acts, including the judgment revoking the SPC at hand. As a result, the case will be sent back to the court of first instance and the proceedings will have to be resumed at the moment when the writ proposing the limitation of the claims should have been granted leave to proceed. Hopefully, the patentee will end up where it would have been if the CJEU had not veered down its bumpy SPC road after Farmitalia.

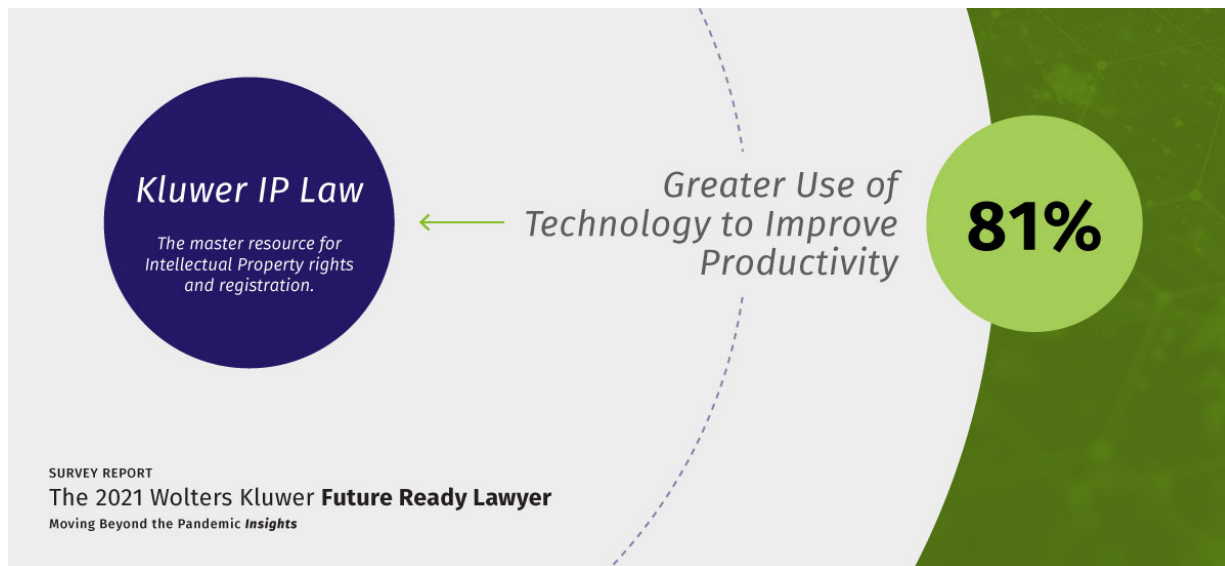
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