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Will the Spanish Patent Office accept the modification of an SPC's term after the Incyte judgment?

Miquel Montaña (Clifford Chance) · Monday, January 8th, 2018

Readers will recall that, in its judgment of 6 October 2015 (Case C-471/14, *Seattle Genetics*), the CJEU concluded that the relevant date for calculating the term of a supplementary protection certificate (“SPC”) is not the date on which a marketing authorisation (“MA”) is granted, but the date when the addressee is notified of the decision to grant the MA. After this judgment was published, some patent owners across Europe tried to rectify the term of their SPCs before the relevant authorities. In certain countries this has proved to be an uphill battle, as the competent authorities have considered that they do not have any obligations in relation to administrative procedures that have already ended. For example, in Spain, rectifying the term of an SPC has been “mission impossible”.

This is likely to change. The Court of Justice of the European Union (“CJEU”), in its recent judgment of 20 December 2017 (Case C-492/16, *Incyte Corporation vs. Szellemi Tulajdon Nemzeti Hivatala*), in response to a request for a preliminary ruling referred by the Budapest High Court, concluded that Article 18 of Regulation 469/2009, as read in light of Recital 17 of Article 17(2) of Regulation 1610/96, must be interpreted, so as to reflect the correct term of an SPC pursuant to the interpretation laid down in the *Seattle Genetics* judgment, as meaning that the holder of an SPC may, under Article 18 of Regulation 469/2009, bring an appeal for rectification of the duration stated in the certificate, provided that the certificate has not expired.

Although the English translation uses the word “appeal”, from the context of the decision and the translations into other European Union languages (the language of this case was Hungarian), it is clear that what the judgment is actually referring to is a “course of action” for rectifying the duration stated in the certificate. The only limitation is that the certificate must not have expired.

Unfortunately, the CJEU did not fully answer the questions referred by the Budapest High Court. Despite the fact that the latter had explicitly asked the CJEU to clarify whether the industrial property authority of a Member State which is entitled to grant an SPC is required in order to rectify the date of expiry of the SPC “of its own motion”, the CJEU concluded that “[...] insofar as it is common ground that, in the case in the main proceedings, Incyte brought an appeal for rectification of the duration of the SPC before the authority that granted the SPC, it is not necessary to ascertain, in addition, whether such authority could be required to make such a rectification ex officio in the absence of such an appeal being brought by the holder of the certificate.”

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