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TRIPS traps troops

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One of the topics most hotly discussed before the Spanish Courts over the last few years is whether the legal effects of the TRIPS‘ provisions on patents are governed by Community law or by the national law of each Member State. The debate was sparked in 2003, when a German manufacturer of generic pharmaceuticals filed a revocation action against the Spanish part of patent EP 409,281, which covers Calcium Atorvastatin, the world’s top-selling pharmaceutical drug. The complaint was based on the argument that the product claims of this patent were contrary to the Spanish Reservation to the European Patent Convention, which did not expire until 7 October 1992. The patentee responded that, although the application had been filed while the effects of the Reservation were still in force, Articles 27.1 and 70 of TRIPS allowed the patentee to add product claims. This prompted the debate as to whether the TRIPS’ provisions on patents may be directly applied by national Courts.

On 26 October 2006, the Court of Appeal of Madrid (Section 28) handed down a landmark decision rejecting the revocation action on the grounds that Articles 27.1 and 70 of TRIPS can be directly applied by the Spanish Courts. The Court noted that since patent law had not been harmonised by the European Community, the effects of TRIPS’ provisions on patents within the Spanish legal system were not governed by Community law but by Spanish Constitutional law. Being the home of some of the fathers of International Law, such as Fray Francisco de Vitoria, it is not surprising that Spain has a long-standing tradition of recognising the “direct effect” of international treaties. Interestingly, eleven months later, the European Court of Justice handed down its judgment of 11 September 2007, in which they reached the same conclusion as the Court of Appeal of Madrid (Section 28). Since then, a string of additional judgments have followed, which have treaded on the footprints of that forerunner decision (Judgments of 17 January 2008, 30 June 2008, 10 December 2008 and 27 May 2009 from the Court of Appeal of Barcelona (Section 15)). These judgments have trapped the troop of generic companies that had filed revocation actions against pharmaceutical patents filed before 7 October 1992 that included product claims.

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