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The Court of Turin says “no” to the patentability of intermediates.

Daniela Ampollini (Trevisan & Cuonzo) · Tuesday, May 31st, 2011

By decision of 14 January 2011, the Court of Turin tackled the issue of the patentability of the intermediate, i.e. the chemical product which represents an obligatory passage of the process of synthesis and the structure of which is successively modified to obtain the wanted substance. The case involved Bayer Schering Pharma against Industriale Chimica Srl and concerned a patent claiming a process for the production of drospirenone, which patent also expressly claims the intermediate “Idrox”. Although the Court Expert had concluded that such a claim should be found valid as new and inventive, the Court decided to follow what was many years ago decided by the Italian Supreme Court in the well known cases concerning cimetidine (rulings no. 11094/1990 and 8324/1997), i.e. that the intermediate is not patentable per se as it does not have “an autonomous function and a utility that can conceptually be separated from the process of synthesis which conducts to the production of drospirenone”. The reasoning of the Court on this point does not seem to be particularly convincing. More convincing is in my view what had been stated by the Court of Appeal of Milan in its decision of 16 November 1993. On that occasion, the Milanese Judge, tackling another case which involved the same cimetidine patent, decided differently than the Supreme Court and stated that “if it is true that a product, in order to result in patentable subject matter, must satisfy a human need, there is no reason for excluding that such a goal be performed where a new and inventive product has a function that is purely instrumental to an industrial production process”. In addition, it seems that the Court of Turin, by restating this old case-law of the Supreme Court in the cimetidine case, keeps posing Italian jurisprudence in some contrast with that of the numerous other jurisdictions which admit the patentability of intermediates.

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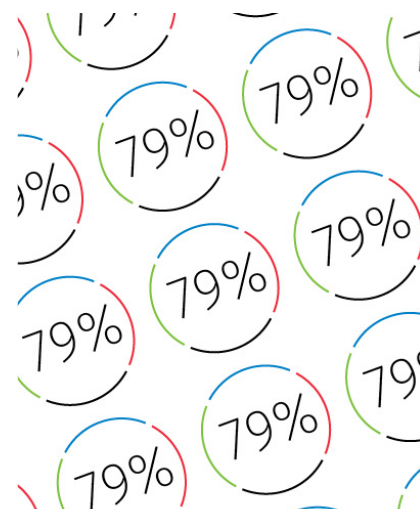
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