Kluwer Patent Blog

Does a Markush formula with plain bonds comprise both the racemate and its enantiomers?

Miquel Montañá (Clifford Chance) · Wednesday, March 21st, 2012

In recent years, the Commercial Courts of Barcelona have been called on to decide whether a claim depicting a Markush formula that did not show the stereochemistry of the compound protects only the racemate or also its enantiomers. The debate emerged in the context of an application for a preliminary injunction filed by Novartis based on a patent relating to Rivastigmine. Claim 1 of this patent contains a Markush formula where the stereochemistry of the compound is not depicted. According to the patentee, in the absence of signs limiting the scope of protection to the racemate or one of the enantiomers, the claim would generally protect the racemate and its enantiomers. On the contrary, the defendants alleged that in the absence of signs showing that the formula specifically designates Rivastigmine, the claim would protect the racemate only.

On 30 November 2010, Commercial Court number 1 of Barcelona ordered a preliminary injunction against the defendants based on the provisional conclusion that, in the absence of a limitation, a Markush formula using plain bonds would encompass both the racemate and its enantiomers. This decision has now been confirmed by the Court of Appeal of Barcelona (Section 15) which, on 9 February 2012, handed down a judgment confirming the preliminary injunction.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please subscribe here.

Kluwer IP Law

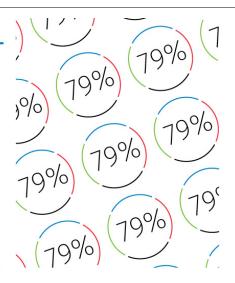
The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how Kluwer IP Law can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT The Wolters Kluwer Future Ready Lawyer

Leading change



This entry was posted on Wednesday, March 21st, 2012 at 11:28 am and is filed under Scope of protection, Spain

You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.