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Spanish Supreme Court clarifies that its case law on TRIPS is not affected by the ECJ Daiichi Judgment

Miquel Montaña (Clifford Chance) · Thursday, February 6th, 2014

The readers will recall that on 18 July 2013, the European Court of Justice (“ECJ”) handed down its controversial judgment in case C-414/11 *Daiichi Sankyo Co. Ltd, Sanofi-Aventis Deutschland GmbH v. DEMO Anonimos Viomikhaniki kai Emporiki Etairia Farmakon*. In this judgment the ECJ, making a 180° twist in relation to the criteria endorsed in Opinion 1/1994, in its judgment of 14 December 2000 and in its judgment of 11 September 2007, concluded that TRIPS’ provisions on patents now fall within the realm of the European Union (“EU”) common commercial policy.

This is a rather surprising conclusion to reach, taking into account that in paragraph 46 of its judgment of 11 September 2007 the ECJ justified exactly the contrary, on the grounds that “the Community has not yet exercised its powers in the sphere of patents or that, at the very least, at the internal level, the exercise has not to date been of sufficient importance to lead to the conclusion that, as matters now stand, that sphere falls within the scope of Community law.”

Has this status quo changed since then? Sure, but exactly in the opposite direction to the one required by the ECJ to find that TRIPS’ provisions on patents fall within the scope of EU law! As the readers know well, the EU legislative bodies removed substantive patent law from Regulation (EU) No 1257/2012 (nicknamed for this reason the “empty shell”) to try to prevent the ECJ from putting its hands on the yet to come European patent with unitary effect. Obviously, the new wording of article 207(1) TFEU that came into force on 1 December 2009 (the justification used by the ECJ to change its position) does not change the fact that, in 1994, the ones responsible for applying TRIPS’ provisions on patents were the Member States, and not the then-called EC. This is why, for example, on 18 November 1997 the TRIPS Council interviewed the delegate of the Kingdom of Spain, and not a delegate of the EC, to monitor whether or not Spain was complying with TRIPS’ obligations on patents. His reply was that there was no reason to worry because, under Spanish law, TRIPS’ provisions on patents are self-executing and, therefore, the Spanish Courts would have the obligation to apply these provisions directly. Can anyone imagine the ECJ now saying that, overnight, the Spanish Courts must “undo” what they did from 1995 onwards to cause Spain to comply with TRIPS (i.e. apply its provisions directly)? This would be too much even for those accustomed to the extravagant ECJ decisions on patents, which probably explains why the judgment of 18 July 2013 circumvented the thorny “direct effect” debate.

In its judgment, the ECJ also concluded that “a patent obtained following an application claiming the invention both of the process of manufacture of a pharmaceutical product and of the pharmaceutical product as such, but granted solely in relation to the process of manufacture, does not, by reason of the rules set out in Articles 27 and 70 of the Agreement on Trade-Related Aspects

of Intellectual Property Rights, have to be regarded from the entry into force of that agreement as covering the invention of that pharmaceutical product.” This conclusion encouraged a Spanish manufacturer of generic medicines to file a nullity action against a judgment of 21 November 2011 from the Administrative Chamber of the Supreme Court, which upheld an appeal filed by the owner of a European patent against a decision from the Spanish Patent and Trademark Office that had rejected to publish a revised translation filed by the patentee. In particular, the patent owner had filed a revised translation that included the product claims granted by the European Patent Office (“EPO”), which had been excluded from the first translation due to the EPO Communication of 13 May 1992 (advising applicants to exclude product claims in countries that had made a Reservation under article 167 of the EPC).

In its Decision of 17 January 2014, the Administrative Chamber of the Supreme Court rejected this nullity action. The Supreme Court, quite rightly, pointed out that the ECJ’s reply to the question referred to it by the National Court in the Daiichi case was driven by the specific factual and legal background of the national Greek patent discussed in that case. In particular, the Supreme Court noted that the Daiichi judgment did not discuss, for example, the problems raised by the revised translations of article 70.4 of the EPC. In fact, one cannot see how the ECJ could have interpreted article 70.4 (revised translations) or article 167 (Reservations) of the EPC, taking into account that 5 months later, the ECJ highlighted in paragraph 40 of its judgment of 12 December 2013 (Case C-493/12 *Eli Lilly Ltd v. Human Genome Sciences Inc*) that “40. With regard to the requirements laid down by the EPC, it should, however, be noted that the Court does not have jurisdiction to interpret the provisions of that convention, since, unlike the Member States, the European Union has not acceded to the convention. The court cannot, therefore, provide further guidance to the referring court concerning the manner in which it is to determine the extent of the claims of a patent issued by the EPO.”

All in all, this interesting Decision of 17 January 2014 shows that the response given by the ECJ to the questions raised by the Greek Courts in the Daiichi case cannot be easily extrapolated beyond the specific factual and legal framework from whence those questions arose.

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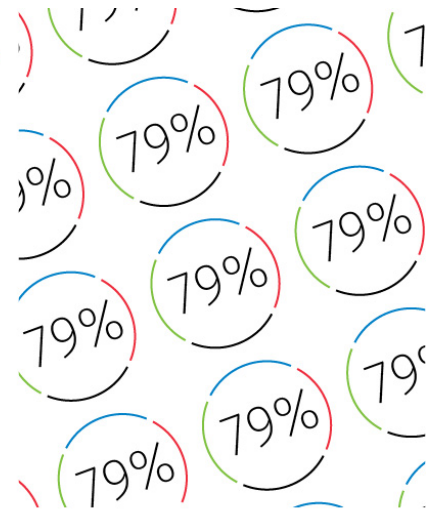
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