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The CJEU rulings of 30 January 2014 on TRIPS: If you don't want to get the wrong answer, don't ask the wrong question

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On 30 January 2014 the Court of Justice of the European Union ("CJEU") handed down two Decisions in response to two preliminary rulings sought by the same Greek Court that referred the questions answered by the CJEU in its Judgment of 18 July 2013 (Case C?414/11, Daiichi Sankyo Co. Ltd, Sanofi-Aventis Deutschland GmbH v DEMO Anonimos Viomikhaniki kai Emporiki Etairia Farmakon). In this case, the Greek Court, which was hearing a matter involving a patent that had been granted on 21 October 1986, sought the guidance of the CJEU on whether under Articles 27 and 70 of the TRIPs Agreement a patent protecting a process to obtain a pharmaceutical product would protect the product as such after the TRIPs Agreement came into force. In particular, the Greek Court asked the following question:

"3) Under Articles 27 and 70 of the TRIPs Agreement, do patents covered by the reservation in Article 167(2) of the [EPC] which were granted before 7 February 1992, that is to say, before the above agreement entered into force, and concerned the invention of pharmaceutical products, but which, because of the aforementioned reservation, were granted solely to protect their production process, fall within the protection for all patents pursuant to the provisions of the TRIPs Agreement and, if so, what is the extent and content of that protection, that is to say, have the pharmaceutical products themselves also been protected since the above agreement entered into force, or does protection continue to apply to their production process only, or must a distinction be made based on the content of the application for grant of a patent, that is to say, as to whether, by describing the invention and the relevant claims, protection was sought at the outset for the product or the production process or both?'

As the readers may know, in the aforementioned judgment of 18 July 2013 the CJEU gave the following answer:

"*A patent obtained following an application claiming the invention both of the process of manufacturing 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*."

As mentioned at the outset, the Greek Court was also busy with two other cases dealing with another patent that, in contrast to the patent involved in the Daiichi case had not been granted

before the TRIPs Agreement came into force but many years later (in particular, on 31 October 2001). This is of most relevance, as Article 70.7 of TRIPs, which was not even cited in the judgment of 18 July 2013, states that:

"*In the case of intellectual property rights for which protection is conditional upon registration, applications for protection which are pending on the date of application of this Agreement for the Member in question shall be permitted to be amended to claim any enhanced protection provided under the provisions of this Agreement. Such amendments shall not include new matter*."

This provision was introduced during the Uruguay Round negotiations (1986-1993) precisely to make it clear that owners of patents that were pending when the TRIPs Agreement came into force would be entitled to amend them to claim the enhanced protection provided by the TRIPs Agreement (i.e. the pharmaceutical product as such).

Going back to the two Greek cases, the actual fact is that the Greek Court, although in both cases it was dealing with a patent granted *after* the TRIPs Agreement came into force, it referred to the CJEU exactly the same questions than in the Daiichi case where, as mentioned, the Greek Court asked the CJEU about the situation of patents granted *before* the TRIPS Agreement came into force. Clearly, the Greek Court did not notice that these questions were irrelevant to decide the two new cases, which did not deal with a patent granted before but after the TRIPS Agreement came into force.

For obvious reasons, the CJEU could not do anything but answer the specific questions raised by the Greek Court in the two new cases which, as mentioned, were identical to the ones asked in the Daiichi case. Thus, the CJEU, after noting that the questions were identical, making use of the possibility provided by Article 99 of the Rules of Procedure, which allow the CJEU to hand down a "Ruling" instead of a "Judgment" when the questions have already been answered in a previous case, handed down two Rulings dated 30 January 2014 (Case C-372/13 and Case C-462/13) repeating the answers provided in its Judgment of 18 July 2013 (Daiichi).

All in all, due to having asked the wrong questions, the Greek Court has been left with answers that will not be of help to decide the case before the Court. The teaching from these two cases is clear: if you do not want to get the wrong answer, do not ask the wrong question!

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