Kluwer Patent Blog

“AVELUMAB SPC Case”: A key U-turn in French case law

Matthieu Dhenne (Ipsilon) · Monday, July 4th, 2022

25 May 2022, the Paris Court of Appeal overturned the refusal of the French National Institute of Industrial Property (INPI) to grant an SPC on avelumab. This is a reversal of the “nivolumab” case law on the interpretation of Article 3(a) of Regulation (EC) No 469/2009 (hereafter the SPC Regulation).

In this case, Dana-Farber Cancer Institute had filed an SPC application (FR17C1046) 17 November 2017, which was based on the European patent EP 1 210 424 (hereafter EP’424) filed on 23 August 2000, and on the MA for avelumab (EU/1/17/1214) granted to Merck Europe B.V. on 20 September 2017.

Avelumab is an anti-PD-L1 monoclonal antibody, the active ingredient of Bavencio (Pfizer), which is indicated for the treatment of cancer, as it disrupts the PD-1/PD-L1 interaction in vivo.

It should be noted that EP’424 does not relate to avelumab as such. Indeed, avelumab is claimed in a subsequent patent EP 2,785,375 (hereinafter EP’375) filed on 21 November 2012 by Merck Patent GmbH and is the basis of another SPC application (FR20C1068). EP’424 relates primarily to PD-L1, as an isolated polypeptide (claim 12), as well as generally to “an antibody that selectively binds to a polypeptide of claim 12” (claim 17) and “an antibody that selectively binds to a polypeptide of SEQ ID NO: 2 or 4 [i.e. PD-L1]” (claim 27).

On 3 February 2021, the INPI rejected the granting of the SPC pursuant to Article 3(a) of the SPC Regulation. The office considered, following the Royalty Pharma judgment of the Court of Justice of the European Union (CJEU) in case C-650/17, that avelumab, although implicitly and necessarily covered by the functional definition used in claims 17 and 27 of the basic patent, was nevertheless not specifically identifiable in the patent, having been developed after the filing date of the basic patent through an independent inventive step.

The Court of Appeal overturned this decision by holding that the methods of generating and identifying an antibody directed against a given antigen were routine techniques for the person skilled in the art at the priority date, and, therefore, when the targeted antigen is already known, the discovery of an antibody binding to that antibody does not involve an inventive step. The Judges also noted that in the case of EP’375, filed 11 years after the filing date of EP’424 and granted for avelumab, the inventive step was finally recognised by the EPO because of the cross-species reactivity of avelumab, and not because of its ability to bind to PD-L1, the Examining Division

having initially concluded that there was no inventive step. The Court concludes that it follows from these elements, based on the general knowledge of the person skilled in the art and the state of the art at the priority date of the EP'464 patent, that the human monoclonal antibody avelumab was specifically identifiable by the person skilled in the art in the light of the teachings of the said patent, by routine experiments known and well mastered, which may be long and tedious, but do not involve an independent inventive step.

This ruling may, at first sight, be surprising. Indeed, in a very close recent case, the Court confirmed the decision of the INPI by a judgement of 19 January 2021. In this case, it was a confirmation of a decision of the INPI to reject a SPC application for nivolumab, an anti-PD-1 monoclonal antibody. The Judges considered that while nivolumab implicitly and necessarily fell within the scope of the invention covered by the basic patent, the preparation of monoclonal antibodies required more than routine operations. They also pointed out that it took three years after the filing of the basic patent to file a patent specifically for nivolumab, which was a strong indication that an inventive step independent of the basic patent was necessary to arrive at nivolumab.

In my view, there are two main reasons for this reversal of case law. Firstly, the consideration of the criteria resulting from the European Patent Convention (EPC) and the Directives and the case law of the European Patent Office (EPO), in accordance with the "independent inventive step" criterion from the Royalty Pharma case law, which was decisive. Secondly, in the nivolumab case, the Court of Appeal also considered that the SPC did not comply with Article 3(c) of the SPC Regulation, so that the assessment of compliance with Article 3(a) became a secondary issue.

In any case, this reversal of case law is fundamental and should facilitate the fulfilment of the requirements of Article 3(a) of the SPC Regulation in relation to monoclonal antibodies in France, especially in relation to the Medeva (C-322/10) and Eli Lilly cases.

This entry was posted on Monday, July 4th, 2022 at 8:55 am and is filed under antibodies, Biologics, France, Pharma, Pharmaceutical patent, SPC
You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.