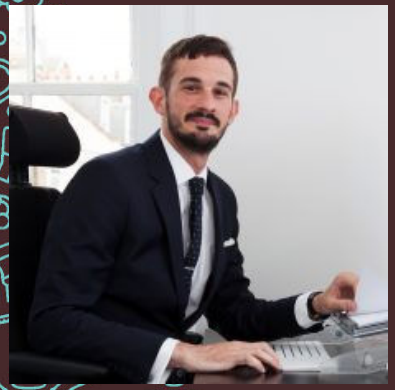
BRISTOWS

AIPPI Rapid Response Seminar
The Supreme Court decision in Pregabalin

Claire Baldock
Boult Wade Tennant



Stuart Baran
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Agenda

1. Introduction (Brian)
2. Plausibility in light of the Supreme Court ruling (Claire)
3. Abuse of Process (Brian)
4. Construction and Infringement (Stuart)
5. Questions and Discussion chaired by Brian

Introduction

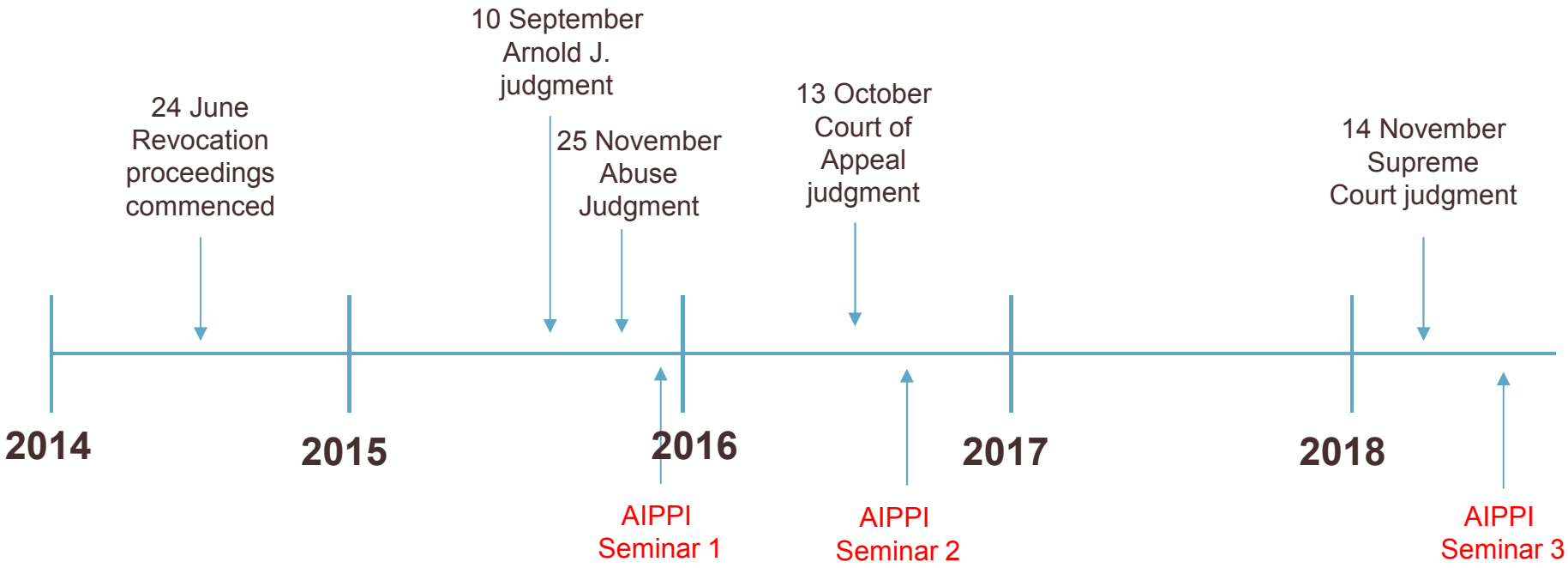
Background

- Warner-Lambert owned a patent with Swiss-type claims directed to the use of pregabalin to treat pain (claim 1) and neuropathic pain (claim 3)
- Various generics companies obtained MAs to sell pregabalin. Pain was carved-out from the label
- The generics companies also challenged the validity of the pain patent

Issues

- Was the patent valid? In particular, did the teaching render the treatment of pain or neuropathic pain plausible?
- Was a post-judgment amendment to *"…neuropathic pain caused by injury or infection of peripheral sensory nerves"* allowable?
- How should Swiss-type claims be construed? How should the Court resolve the issue of allowing free competition for the non-patented indication whilst reserving the patented indication to the patentee?

Timeline


24 June
Revocation
proceedings
commenced
10 September
Arnold J.
judgment
25 November
Abuse
Judgment
13 October
Court of
Appeal
judgment
14 November
Supreme
Court judgment
2014
2015
2016
2017
2018
AIPPI
Seminar 1
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Seminar 2
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Seminar 3

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Chartered Patent Attorneys and Chartered Trade Mark Attorneys

AIPPI Rapid Response Seminar

Plausibility and the Lyrica Saga

Claire Baldock
5 December 2018

Plausibility and the Lyrica Saga

Claire Baldock **5 December 2018**

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Plausibility

- What is the test?
- What is its judicial history?
- How is it applied in the Lyrica case?
- What have we learned from this?

Plausibility and the Lyrica Saga

Claire Baldock **5 December 2018**

What is the plausibility test?

- Not a statutory test
- Developed by judiciary as a pre-requisite to evaluation of inventive step, industrial application and sufficiency of disclosure
- Where an invention relies on a particular technical effect, the application as filed must contain information which renders the effect **plausible** to the skilled reader in light of common general knowledge
- This information need not be in the form of experimental data or, in the case of a pharmaceutical, a clinical trial
- Confirmatory data generated after the filing date may be taken into account when the technical effect is **plausible** from the application as filed

The judicial history

- **T0409/91 – EXXON/fuel oils (1994)**
  "… the extent of the patent monopoly as defined by the claims should correspond to the technical contribution to the art in order for it to be supported or justified."

- **T0939/92 - AGREVO (1996)**
  A technical effect needs to be "credible" across the scope of the claim for inventive step to be recognised.

Prendergast's Applications – Neuberger J. (2000)
[In the case of a medical use claim] "…the specification must provide by way of description, enough material to enable the relevant skilled man to say this **medicament does treat the condition alleged**. Pure assertion is insufficient.

A high bar perhaps?

More judicial history

- **T0609/02 – SALK (2004)**
- (Technical effect) – "Under Article 83 EPC, unless this is already known at the priority date, the application must disclose the suitability of the product to be manufactured for the claimed therapeutic application"

- "…a simple verbal statement in a patent specification that compound X may be used to treat disease Y, is not enough to ensure sufficiency of disclosure in relation to a claim to a pharmaceutical"

- "The patent must provide some information in the form of, for example, experimental tests, to the avail that the claimed compound **has a direct effect on the metabolic mechanism specifically involved in the disease**, this mechanism being either known from the prior art or demonstrated in the patent *per se".*

Even more judicial history

- **T1329/04 - JOHN HOPKINS (2006)**

  "The definition of an invention as being a contribution to the art, i.e. as solving a technical problem and not merely putting one forward, requires that it at least be made **plausible** in the disclosure in the application that it solves indeed the problem it purports to solve. Therefore, even if supplementary post-published evidence may in the proper circumstances also be taken into consideration, it may not serve as the sole basis to establish that the application solves indeed the problem it purports to solve."

But then…

- **T1437/07 ALLERGAN (2009)**
  "… just because a patent discloses an effect which in reality has not been achieved, there is no reason – **in the absence of convincing evidence that the effect cannot be achieved** - for the Board to doubt the effect can be achieved."
  AND
- **T0578/06 – IPSEN (2011)**
  "… the establishment of plausibility is only relevant when examining inventive step if the case at hand **allows substantiation of doubts about the suitability of the claimed in invention to solve the technical problem addressed** and when it is thus far from straightforward that the claimed invention solves the formulated problem."

- "The Board accepts that the data referred to in the **post-published literature** …. constitutes proof that the claimed effects are plausible" ???!!!

  A bit off piste?

Most recently

- **T0488/16 - BRISTOL-MYERS (Dasatinib) (2017)**

- " It is established jurisprudence of the Boards of Appeal that the assessment of inventive step is to be made at the effective date on the basis of the information in the patent together with common general knowledge then available to the skilled person."

- " Post-published evidence in support that the claimed subject matter solves the technical problem that the patent in suit purports to solve may be taken into consideration, if it is already plausible from the disclosure of patent that the problem is indeed solved."

  Johns Hopkins principle again!

Plausibility and the Lyrica Saga

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EP-B-0934061
Expiry 16 July 2017

Claim 1

"Use of (S)-3-(aminomethyl)-5-methylhexanoic acid or a pharmaceutically acceptable salt thereof for the preparation of a pharmaceutical composition for treating pain"

Claim 3

"Use according to claim 1 wherein the pain is neuropathic pain

Plausibility and the Lyrica Saga

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Important points to note

- Neuropathic pain is initiated by a primary lesion or dysfunction of the nervous system
- It can be “peripheral” or “central” neuropathic pain depending on where the dysfunction or lesion is located
- The patent showed pregabalin in animal models of inflammatory pain only. Published animal models of peripheral neuropathic pain were mentioned in the patent but no tests results were included
- First instance – Mylan argued not **plausible** pregagalin would treat anything other than inflammatory pain
- WL argued it was common general knowledge that the claimed pain states had the common feature of “central sensitisation” and the inflammatory model had such a component
- Mylan rebutted that it was common general knowledge that **central neuropathic pain** did not have a central sensitisation component

Insufficiency

CA finding:

- The patent demonstrated that pregabalin was likely to be effective in the treatment of inflammatory pain
- Skilled readers would recognise inflammatory pain had a central sensitisation component and that peripheral neuropathic pain had such a component as well
- The results presented would therefore suggest to the skilled person that pregabalin might be effective for peripheral neuropathic pain
- However, animal models did not make use for central neuropathic pain plausible due to lack of central sensitisation component
- Claim 3 insufficient as not plausible across the scope. Claim 1 also insufficient for same reason

Questions for the supreme court

- What role plausibility should play in the statutory test for sufficiency and whether a patent should be held insufficient for lack of plausibility, even though it is in fact enabled across the full scope of the claim?

- If a plausibility test is appropriate, provided there is basis to support the claim across part of its scope, whether later evidence can be used to fill the gap?

Plausibility and the Lyrica Saga

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Warner Lambert

- Requiring plausibility is an inadmissible addition to the text of the Patents Act and European Patent Convention
- EPO case law subsequent to Salk (T0609/02) implied the claimed therapeutic effect may only need to be shown as plausible in the application when the skilled person would regard the effect as “inherently implausible” (T0578/06 – IPSEN and T1437/07 – ALLERGAN)
- It is wrong to require plausibility to be demonstrated across the scope of the claim
- It is wrong to reject post-published data

Plausibility and the Lyrica Saga

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Lord Sumption

(Agreed by Lord Reed and Briggs)

- Sufficiency is a statutory rule but it is a contribution of judges to work out the principles on which it can be applied to Swiss form patents
- The proposition that a product is efficacious for the treatment of a given condition must be *plausible*. It is not made plausible by bare assertion
- It cannot be merely a test of good faith. Such a low threshold would not serve the purpose of barring speculative or armchair claims
- There must be something to cause the skilled person to think there is a reasonable prospect the assertion is true
- Reasonable prospect is based on SALK i.e. **a direct effect on a metabolic mechanism specifically involved in the disease**

Lord Sumption cont'd

(Agreed by Lord Reed and Briggs)

- As per SALK, post-published data cannot render plausible that which is not plausible from the application as filed
- "Since plausibility is one element of the test for sufficiency and it is established a claim must be sufficient across its scope, so it must be plausible across the scope"
- Regeneron v Genentech quoted:
  " … must be possible to make a reasonable prediction the invention will work with substantially everything falling within the scope of the claim or, put another way, the assertion that the invention will work across the scope of the claim must be plausible or credible"

Application to Lyrica case

- The involvement of central sensitisation in both inflammatory and peripheral neuropathic pain does not suggest there may be a common metabolic mechanism at work
- In any case, neither the specification nor the common general knowledge of the art provides any reason for supposing that pregabalin effects the operation of that mechanism
- There is nothing to suggest that pregabalin works with peripheral neuropathic pain by blocking central sensitisation
- The mere fact that the skilled team, faced with an apparent discrepancy between the breadth of the claims and the absence of supporting data in the specification would be encouraged to fill the gaps by carrying out tests of their own, serves only to confirm the absence of any disclosed contribution to the art.
- Claims 1 and 3 insufficient. Even use for peripheral neuropathic pain not made **plausible**

Plausibility and the Lyrica Saga

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Lords Mance and Hodge

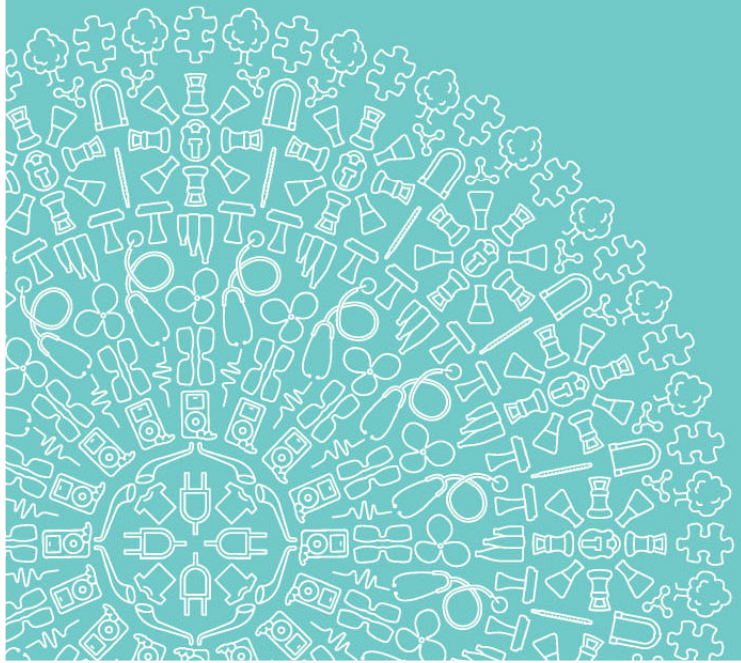
- Lord Sumption's analysis imposes too high a threshold for plausibility
- Applying a standard that the "reasonable prospect" that the assertion is true must involve a showing of a direct effect on a metabolic mechanism specifically involved in the disease (SALK) risks being understood as a requirement to establish a *prima* facie case on the material contained in the specification
- T1437/07 (ALLERGAN) - "…effect should not be doubted in the absence of convincing evidence that effect cannot be achieved and T0578/06 (IPSEN) –"Plausibility only relevant if the case in hand allows the substantiation of doubts about suitability to solve the technical problem" both cited
- Case Law of the Boards of Appeal take account of the ease with which the therapeutic effect can be ascertained using straightforward tests which are known in the prior art (T0950/13 BRISTOL MYERS (2017)
- Treatment of peripheral neuropathic pain **plausible**

What have we learnt?

- The plausibility test still exists
- The technical effect must be plausible to the skilled reader from the application as filed taking account of common general knowledge
- There must be a “reasonable prospect” that the assertion is true (based on link with a metabolic mechanism associated with the disease)
- Plausibility cannot be established by post-published data alone
- Each case turns on its own technical facts and the threshold may vary with the scope of the claim

Is any of this new? Not really
Advice to applicants will be much the same

Abuse of Process

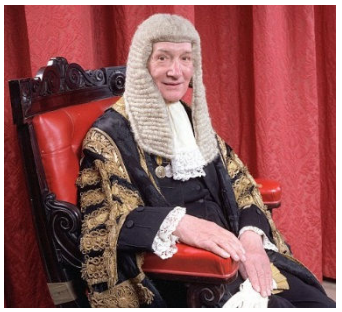


The Law

- General principle in Henderson v Henderson: a party should not normally be allowed to advance in a second proceeding matter it could have advanced in the first; see also Johnson v Gore Wood [2002]

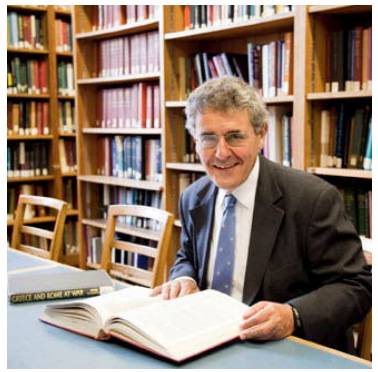
- Applied in patent cases including Windsurfing [1985] and Lubrizol v Esso [1998]:

  "it is a fundamental point of patent litigation that a party must bring before the Court any issues that he seeks to have resolved so as to enable to Court to conclude the litigation between the parties".



The Law (cont.)

Amendments and Discretion: Nikken v Pioneer [2005]



- Distinguishes between three situations in which discretion to amend may be sought:
  a) Before a trial;
  b) After trial, to delete invalid claims/rewrite dependencies
  c) After trial to make validating amendments

- (a) and (b) are not usually problematic; (c) is problematic because it would almost always lead to a second trial
  "…in the real world patentees faced with a real problem about the construction of their claims, ought to face up to them early and decide whether they need an amendment or might need an amendment. This is one of the purposes of the rule, to make people face up to their cases at an early stage, not a late stage."

- Art 138 EPC 2000 was adjudged not to have changed the landscape

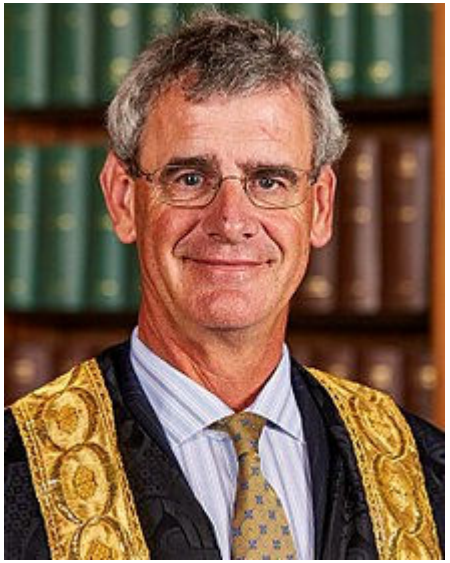
Abuse of Process: Arnold J.

- Claim 1 *"Use of [pregabalin] or a pharmaceutically acceptable salt thereof for the preparation of a pharmaceutical composition for treating pain"*
- Claim 3: *"…wherein the pain is neuropathic pain"*
- Arnold J. rejected Warner-Lambert's contention that "neuropathic pain" in claim 3 was restricted to peripheral neuropathic pain
- Held that claim 3 covered peripheral neuropathic pain and central neuropathic pain and that only the former was plausible
- Therefore claim 3 held invalid
- Application to introduce a new claim to peripheral neuropathic pain made after the trial but rejected by Arnold J. as being too late
- Court of Appeal agreed

Abuse of Process – The Supreme Court

- Follows Nikken

- *"There was ample material upon which the Judge and the Court of Appeal could have concluded that the attempt to make a post-trial amendment was an abuse of process, and no basis on which this court could properly interfere, harsh though the consequences might have been if the cross-appeal had failed"*



Abuse of Process – Take-home Points

- Consider amending the patent in suit (centrally or nationally) before litigation commences
- Keep considering possible amendments at all times in the litigation. The use of conditional amendments gives a patentee considerable flexibility
- Mock trials for the most important cases?
- Expect the unexpected; if in doubt raise a flag

Lyrica in the Supreme Court: Infringement

Stuart Baran

THREE NEW SQUARE
INTELLECTUAL PROPERTY

THREE NEW SQUARE

INTELLECTUAL PROPERTY

THREE NEW SQUARE

INTELLECTUAL PROPERTY

	EPO	Dutch law	German law	UK law	French law	Patrick	Jonathan M	Jonathan S	Robert	Michael
s. 60(1)				✗						
s. 60(2)	✗	✗	✗	✓	✗	✗	✗	✗	✗	✗
Sufficiency				✗						
Plausibility				✗						
Abuse				✗						
Patrick				✗						
Jonathan M				✗						
Jonathan S				✗						
Robert				✗						
Michael				✗						

1. Everyone agrees about the result, but not about the law.

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2. **Patrick** agrees with **Jonathan S** on the infringement result, but for different reasons.

3. **Robert** agrees with **Jonathan S** about everything.

4. **Jonathan M** agrees with **Jonathan S**. Except when it's a sham.

5. **Michael** and **Patrick** disagree with **Jonathan S** about the test for infringement, but not about abuse.

6. **David** wishes he hadn't retired.

The three questions

- What has been **decided** about the infringement test?
- What **precedential value** does it have as a test?
- What can we learn from the reasoning about how to approach future infringement claims?

Questions 1 and 2

Absolutely nothing

Questions 1 and 2

- Infringement is *obiter* because patent invalid
- No single definitive test commands a majority among the Justices
- Unanimity on the **result**, but not the **test**

The claim

- “in the preparation/manufacture of”
  - It was accepted by both sides this was a *purpose-limited **process** claim*.
  - Lord Sumption calls it the “critical feature"
- **just magic words** insisted on by the EPO.
- The invention is the same thing it always was
  - But “ordinary interpretation” is working out what the Patentee meant by his/her words
  - **and** claims to be understood in light of spec

Infringement – Lord Sumption

- **No mental element** to s. 60(1)(a) or —(c)
- But there is for s. 60(1)(b) and for s. 60(2)
- Invention is a "class of two members"
  - **Product** and **Process**
- "Invention" needs to be understood and applied by reference to the claim in the Patent
  - [But the claim is to be understood in light of the invention disclosed in the spec: *Actavis v. Lilly]*

Infringement – Lord Sumption

- **Purpose-limited** because it's **"for"** an indication
- But "for" has a well-defined meaning
  - About **objective suitability** for purpose.
  - This can't help in a second medical use case
  - The medicament was always "for" the 2MU
- Q becomes: when/how has the alleged infringer rendered his/her medicament **for** that indication?

Infringement – Lord Sumption

- Manufacturer and supplier of generic medicament is removed from knowledge of its ultimate purpose
- Skinny labels cannot reliably prevent generic being used for patented purpose
- Clear it's foreseeable that some generic medicament will be prescribed in good faith for that patented purpose

Infringement – Lord Sumption

- Parties agreed it was about the generic's **intention**
- Question of what test of intention
  - Actavis (and the Judge) said: **subjective** test. To infringe must subjectively intend to target patented market
  - W-L (and CA) said: **objective** test. Taken to intend use which is **reasonably foreseeable**
  - CA: "all reasonable steps" would negative intent

Infringement – Lord Sumption

- **All reasonable steps** no good
  - no reasonable steps that eliminate all risk
  - Pharmacists can't know what steps were taken
- Intention irrelevant
- The badge of purpose: "**physical characteristics as it emerges from relevant process**"
- "Outward presentation" test
- Fair protection to patentee?

Infringement – Lords Briggs & Hodge

- Not sufficient protection to patentee
- Couldn't even enforce against proven subjective intent to sell for patented purpose unless on packaging
- Consider there must be element of intent: "a legal fiction that it involves no mental element"
- Lord Briggs considered BFP defence – but rejected "non-statutory defence to statutory tort"

Infringement – Lords Briggs & Hodge

- Subjective intent
  - all means by which Gx meant to profit from Patent market - including packaging
  - “Anything from which the Court could properly find such a purpose could be relied upon”
- “The claim cannot just be rewritten”
- If this approach causes problems for pharmacists, that is for Parliament to fix

Infringement – Lord Mance

- Casting vote
- Neither foreseeability nor subjective intent
- Again concerned about unwitting infringement by pharmacists, etc
- Apportionment again – “do all boxes infringe”?
- German law provides some assistance, but:
  - In Germany they’re product claims
  - Can only recover for deliberate/negligent infrt

Infringement – Lord Mance

- Leave open when more positive steps required than a skinny label
- Pure outward presentation "may be going too far in favour of Gx"
- Preferred to leave this open.
- "*Normally should be protected … if the manufr ensures the Gx product is produced, prepared and marketed with a clear limitation to free use*"

Infringement – the best balance?

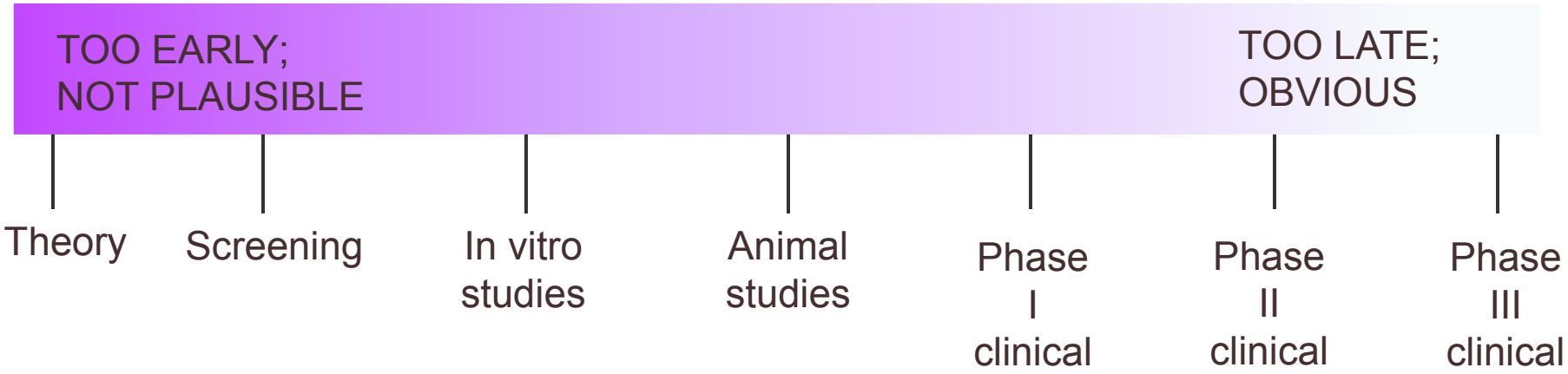
- Lord Justice Floyd's *qualified foreseeability* test
- All the objections are ones of principle
  - Nobody saying it achieves unfair ultimate relief
  - Patentee/Gx both know where they stand
- No great policy danger as Swiss claims are a distinct and lifetime-limited class
- A fudge was always inevitable anyway!

"It is with some unwillingness that I pronounce on the issue at all. All our remarks on it will be obiter, and it is often better to leave a truly contentious and difficult issue to a case where it matters. I also confess that my own view has swung between the two sides."

Lord Mance J.S.C.: [198]

Discussion Points and Questions

Identifying the gap between sufficiency and obviousness



Where the sweet spot is depends on, at least:

1. The disease under consideration
2. Whether the drug is first in class
3. The standards adopted by the patent offices around the world as to plausibility and inventive step

At what point should plausibility be assessed?

- During prosecution?
- As part of a validity challenge and if so, under what category?

What steps should life sciences companies take to avoid infringing Swiss-type claims?

- Is certainty more desirable than fairness?
- Why has the UK actively chosen to move away from a position of consensus?
- Have there been practical problems implementing Floyd LJ's objective test?

What about EPC 2000 claims?

- Direct infringement?
- Indirect infringement: Need to separate out knowledge (in the statute) and purpose (in the claim)
- All bets are on