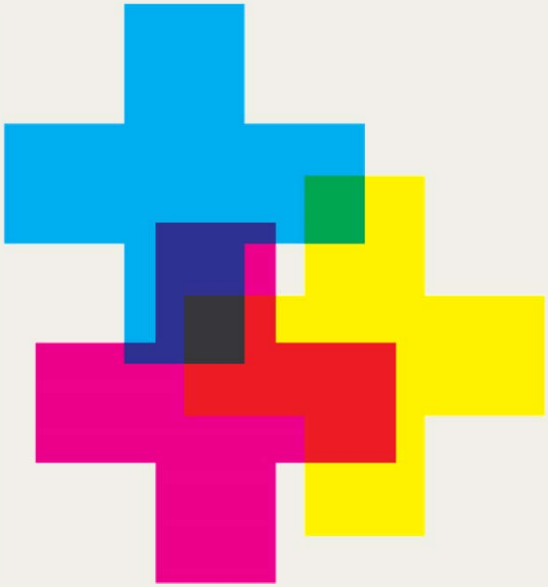
CARPMAELS & RANSFORD

What's the CJEU said this time? A review of the latest SPC musings from Luxembourg

AIPPI

30th March 2015



Presented by

Daniel Wise

Michael Lubienski

Edward Oates

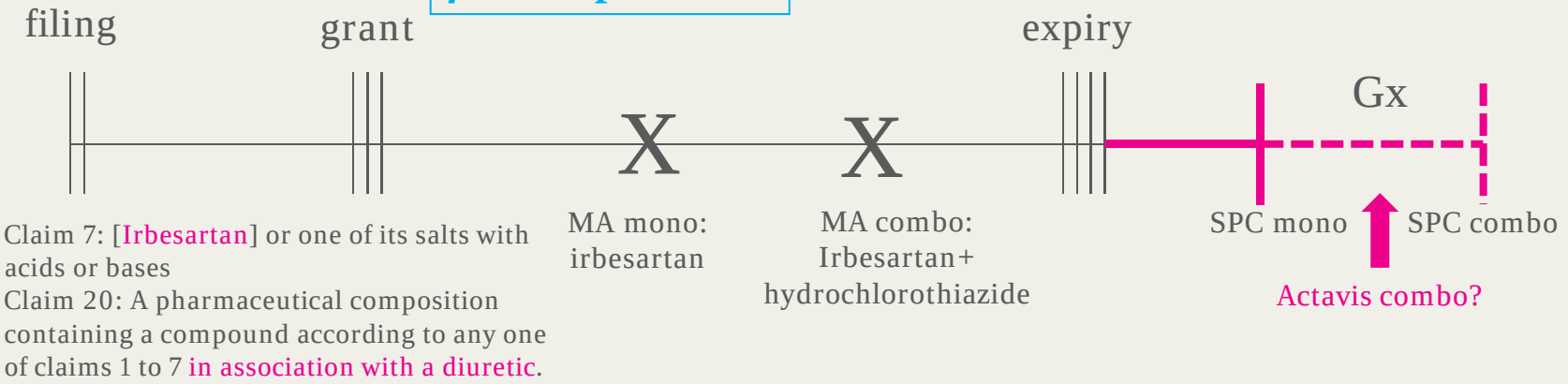
CARPMAELS & RANSFORD

Story so far: *Actavis v Sanofi* (C-443/12)

– Dealt with the "one SPC per patent" fallout from *Medeva* (C-322/10):

> *...where a patent protects a product, in accordance with Article 3(c) of Regulation No 469/2009, only one certificate may be granted for that basic patent (see Biogen, paragraph 28).*

for that product?



– Question referred by the UK High Court:

> *In a situation in which multiple products are protected by a basic patent in force, does the Regulation, and in particular Article 3(c), preclude the proprietor of the patent being issued a certificate for each of the products?*

CARPMAELS & RANSFORD

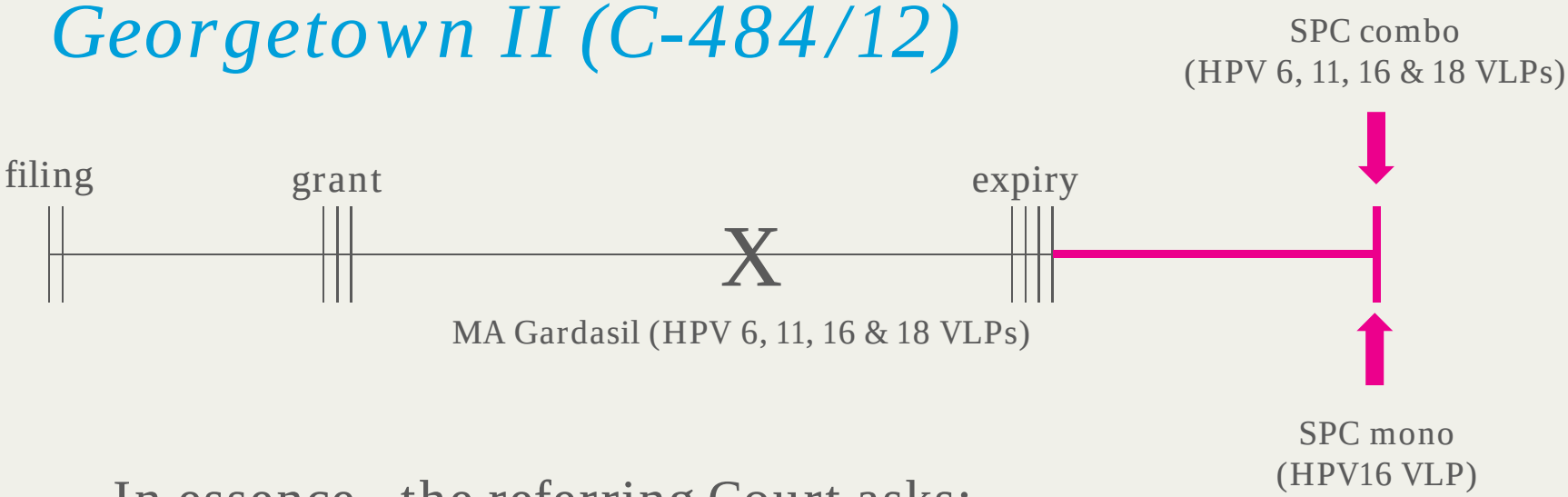
Actavis v Sanofi (C-443/12)

In essence...the referring Court asks:

...where a patent holder has already obtained an SPC for an innovative active ingredient, does Art 3(c) preclude the holder from obtaining an SPC using that patent, for a different medicinal product containing that active ingredient in combination with another active ingredient which is not protected by the patent?

CARPMAELS & RANSFORD

Georgetown II (C-484/12)



- In essence...the referring Court asks:

  ...whether, on the basis of a patent and an MA in respect of a medicinal product consisting of a combination of several active ingredients, where a patent holder has already obtained an SPC for the combination, Art 3(c) precludes the patent holder from also obtaining an SPC for one of those active ingredients which is also protected as such, individually...

CARPMAELS & RANSFORD

Georgetown II – several SPCs per patent (yes)

- The second SPC is allowable in this situation, because (paragraphs 31-35):
  - Nothing in Article 1(b) or 3(c) says otherwise
  - Consistent with the objective of the Regulation, as confirmed by the Memorandum
  - Any rule to the contrary might be circumventable (divisional applications etc.)
  - In this situation, the SPCs would expire on the same date anyway
- So is more than one SPC per patent allowed in all situations?

CARPMAELS & RANSFORD

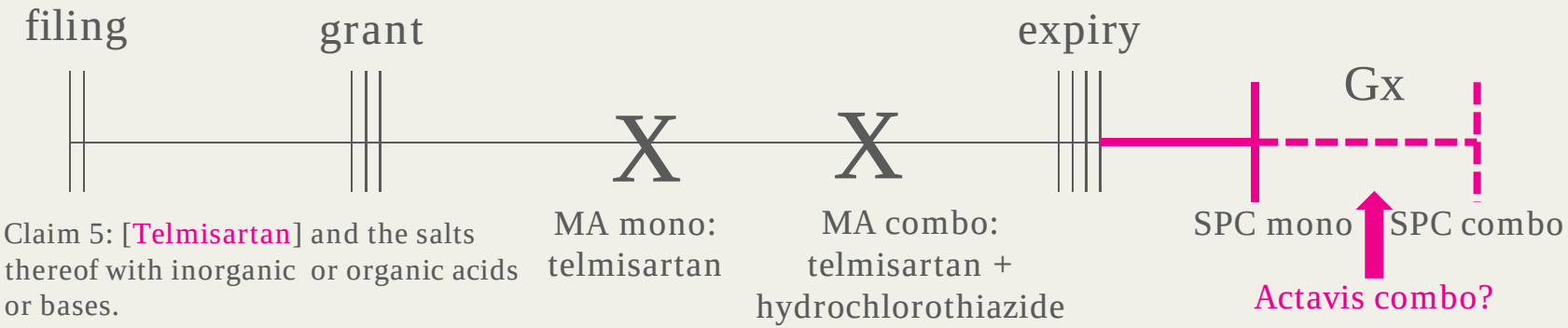
Actavis v Sanofi - several SPCs per patent (no)

- This time, the second SPC is not allowable, because (paras. 30-37):
  - The earlier authorised active ingredient was the "*core inventive advance*" of the patent. In contrast, the active ingredient later authorised in combination with it was "*not protected as such by that patent*"
  - The SPC is supposed to compensate for delay; the patent in question had already enabled its holder to obtain an SPC for its invention, while the second SPC was "*potentially for a longer period of protection*"
  - The first SPC already allowed Sanofi to oppose Actavis' combination product, following the *Novartis* decision (C-442/11)
  - Article 13 means that once this first SPC has expired, the same patent cannot be enforced against the active ingredient even in combination with other active ingredients
  - In some territories, an SPC for the combination might even be enforceable against use of the single (contributory infringement)

CARPMAELS & RANSFORD

Actavis v Boehringer (C-577/13)

– Dealt with facts similar to those in *Actavis v Sanofi* (C-443/12):



– Questions referred while C-443/12 still pending by the UK High Court: (in essence)

1) Does a granted SPC for a mono product preclude the grant of a second SPC to a combination product?

2) Is it allowable to amend a basic patent after grant to satisfy the requirements of the SPC Regulation?

CARPMAELS & RANSFORD

Actavis v Boehringer (C-577/13)

- Questions referred by the UK High Court:

1. (a) If a patent does not, upon grant, contain a claim that explicitly identifies two active ingredients in combination, but the patent could be amended so as to include such a claim could this patent, whether or not such an amendment is made, be relied upon as a "basic patent in force" for a product comprising those ingredients in combination pursuant to Article 3(a) of Regulation No 469/2006/EC ("the Regulation")? (b) Can a patent that has been amended after the grant of the patent and either (i) before and / or (ii) after grant of the SPC be relied upon as the "basic patent in force" for the purposes of fulfilling the condition set out in Article 3(a) of the Regulation? (c) Where an applicant applies for an SPC for a product comprised of active ingredients A and B in circumstances where, (i) after the date of application for the SPC but before the grant of the SPC, the basic patent in force, being a European Patent (UK) (the "Patent") is amended so as to include a claim which explicitly identifies A and B; and (ii) the amendment is deemed, as a matter of national law, always to have had effect from the grant of the Patent; is the applicant for the SPC entitled to rely upon the Patent in its amended form for the purposes of fulfilling the Art 3(a) condition?

2. For the purposes of determining whether the conditions in Article 3 are made out at the date of the application for an SPC for a product comprised of the combination of active ingredients A and B, where (i) the basic patent in force includes a claim to a product comprising active ingredient A and a further claim to a product comprising the combination of active ingredients A and B and (ii) there is already an SPC for a product comprising active ingredient A ("Product X") is it necessary to consider whether the combination of active ingredients A and B is a distinct and separate invention from that of A alone ?

3. Where the basic patent in force "protects" pursuant to Article 3(a): (a) A product comprising active ingredient A ("Product X"); and (b) A product comprising a combination of active ingredient A and active ingredient B ("Product Y"), and where: (c) An authorisation to place Product X on the market as a medicinal product has been granted; (d) An SPC has been granted in respect of Product X; and (e) A separate authorisation to place Product Y on the market as a medicinal product has subsequently been granted. Does the Regulation, in particular Articles 3(c), 3(d) and/or 13(1) of the Regulation preclude the proprietor of the patent being issued with an SPC in respect of Product Y? Alternatively, if an SPC can be granted in respect of Product Y, should its duration be assessed by reference to the grant of the authorisation for Product X or the authorisation for Product Y?

4. If the answer to question 1(a) is in the negative and the answer to question 1(b)(i) is positive and the answer to question 1(b)(ii) is negative, then in circumstances where: i) in accordance with Art 7(1) Regulation, an application for an SPC for a product is lodged within six months of the date on which a valid authorisation to place that product on the market as a medicinal product has been granted in accordance with Directive 2001/83/EC or Directive 2001/82/EC; ii) following the lodging of the application for the SPC, the competent industrial property office raises a potential objection to the grant of the SPC under Article 3(a) of the Regulation; iii) following and in order to meet the aforesaid potential objection by the competent industrial property office, an application to amend the basic patent in force relied upon by the SPC applicant is made and granted; iv) upon amendment of the basic patent in force, said amended patent complies with Article 3(a); does the SPC Regulation prevent the competent industrial property office from applying national procedural provisions to enable (a) suspension of the application for the SPC in order to allow the SPC applicant to apply to amend the basic patent, and (b) recommencement of said application at a later date once the amendment has been granted, the said date of recommencement being - after six months from the date on which a valid authorisation to place that product on the market as a medicinal product was granted but - within six months of the date on which the application to amend the basic patent in force was granted?

CARPMAELS & RANSFORD

Actavis v Boehringer (C-577/13)

In essence...the referring Court asks:

...whether Article 3(a) and (c) of Regulation No 469/2009 must be interpreted as meaning that, where a basic patent includes a claim to a product comprising an active ingredient for which the holder of that patent has already obtained an SPC, as well as a subsequent claim to a product comprising a combination of that active ingredient and another substance, that provision precludes the holder from obtaining a second SPC for that combination.

If that question is answered in the negative, the national court is also seeking to ascertain how the duration of the 'combination SPC' is to be determined, for the purpose of Article 13(1) of that regulation

CARPMAELS & RANSFORD

Actavis v Boehringer - several SPCs per patent (no)

- The second SPC is <u>not</u> allowable, because (paras. 26-38):
  - *"[...] it is common ground in the main proceedings that, in that combination, telmisartan, which is the innovative active ingredient of Boehringer's basic patent, is the sole subject-matter of the invention".*
  - *"Boehringer did not, in any event, contribute to the discovery of hydrochlorothiazide, which is a molecule within the public domain, and the claim relating to that substance does not constitute the subject-matter of the invention".*
  - *"Article 3(a) and (c) of Regulation No 469/2009 must be interpreted as meaning that, where a basic patent includes a claim to a product comprising an active ingredient which constitutes the sole subject-matter of the invention, for which the holder of that patent has already obtained an SPC, as well as a subsequent claim to a product comprising a combination of that active ingredient and another substance, that provision precludes the holder from obtaining a second SPC for that combination".*

CARPMAELS & RANSFORD

Actavis v Boehringer - several SPCs per patent (no)

- What didn't "*constitute the subject matter of the invention*"?

  > 37 [...] *it cannot be accepted that the holder of a basic patent in force may obtain a new SPC, potentially for a longer period of protection, each time he places on the market in a Member State a medicinal product containing, on the one hand, an active ingredient, protected as such by the holder's basic patent and constituting the subject-matter of the invention covered by that patent, and, on the other, another substance which does not constitute the subject-matter of the invention covered by the basic patent.*
  >
  > *38 It follows that, in order for a basic patent to protect 'as such' an active ingredient within the meaning of Articles 1(c) and 3(a) of Regulation No 469/2009, that active ingredient must constitute the subject-matter of the invention covered by that patent.*

- So the hydrochlorothiazide *per se* did not
- But what about the combination itself? Not discussed in these quotes
  - Why was there only one "sole" subject matter of the invention in the patent?
  - Can the combination also be "subject matter of the invention" if it is inventive in its own right?
    - E.g. if supported by data showing it is better than prior art combinations?
  - What prior art do you consider for this assessment?
    - The combination is already inventive because of the presence of telmisartan
    - So do you add telmisartan to the actual prior art?

CARPMAELS & RANSFORD

What about post grant amendments?

- No answer:

  In view of the answer given to Questions 2 and 3, from which it is apparent that a second SPC, such as that at issue in the main proceedings, should not have been granted to Boehringer for the telmisartan-hydrochlorothiazide combination, irrespective of whether a new claim to hydrochlorothiazide was added to the basic patent after it had been granted, following a recommendation by the UK IPO, there is no need to answer Questions 1 and 4.

- Are we likely to see this issue again?
  - What if the patentee can argue that the combination is "subject matter of the invention covered by the patent"?
  - What about amendments to address *Medeva* "specified in the wording of the claims" objections for mono SPCs?
    - Practice amongst national patent offices is variable, especially for biologics
      - Might need to add claim features to specify how they are made (*Georgetown)*
    - Not made any clearer by *Lilly v HGS* (C-493/12): do the claims "*relate, implicitly but necessarily and specifically, to the active ingredient*"?
    - Even in chemical cases, do you need to/can you add a dependent claim that specifies the particular compound if claim 1 has a Markush formula?

AIPPI

C-631/13 Forsgren

Michael Lubienski

30th March 2015

Inspired by patients.
Driven by science.

Any opinions expressed herein are those of the speaker and do not necessarily represent the views of GSK nor UCB

C-631/13 Forsgren – new CJEU SPC decision

- Judgement of 15 January 2015
- Concerns MA for Synflorix® – multivalent (10) pneumococcal polysaccharide (PS) vaccine conjugated to various carrier proteins:
  - 8x PS-PD (protein D from non-typeable Haemophilus influenzae [ntHi])
  - PS-DT (diphtheria toxin)
  - PS-TT (tetanus toxin)
  - Indication for pneumococcal invasive disease and otitis media in children
- Concerns patent covering protein D (PD) as a vaccine antigen – which may be fused to carbohydrate
- Patent gives information as to the immune activity of protein D **[B cell activity]**
- MA states that there was insufficient data in the file to give an ntHi otitis media indication, but that PD acts as a carrier protein for the pneumococcal PS **[T-helper cell activity]**
- Data since grant of MA supports Synflorix also protecting against ntHi otitis media – PD acts as an antigen in its own right despite being conjugated
- SPCs granted to Product Description “Protein D” in DE, FR and others

C-631/13 Forsgren – new CJEU SPC decision

Questions referred to the CJEU by AT court:

1. **Under Article 1(b) and Article 3(a) and (b) of [Regulation No 469/2009], provided that the other conditions are met, may [an SPC] be granted for an active ingredient protected by a basic patent (in this case, Protein D) where that active ingredient is present in a medicinal product (in this case, Synflorix) as part of a covalent (molecular) bond with other active ingredients but none the less retains an effect of its own?**

2. **If Question 1 is answered in the affirmative:**

(a) **Under Article 3(a) and (b) of [Regulation No 469/2009], may [an SPC] be granted for the substance protected by the basic patent (in this case, Protein D) where that substance has a therapeutic effect of its own (in this case, as a vaccine against the *Haemophilus influenzae* bacterium) but the marketing authorisation for the medicinal product does not relate to that effect?**

(b) **Under Article 3(a) and (b) of [Regulation No 469/2009], may [an SPC] be granted for the substance protected by the basic patent (in this case, Protein D) where the marketing authorisation describes that substance as a 'carrier' for the actual active ingredients (in this case, pneumococcal polysaccharides), where the substance, as an adjuvant, enhances the effect of those substances, but where that effect is not expressly mentioned in the marketing authorisation for the medicinal product?**

C-631/13 Forsgren – new CJEU SPC decision

Answers for use by AT court:

1. **Articles 1(b) and 3(a) of Regulation (EC) No 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products must be interpreted as not precluding, in principle, the possibility that an active ingredient can give rise to the grant of a supplementary protection certificate where the active ingredient is covalently bound to other active ingredients which are part of a medicinal product.**

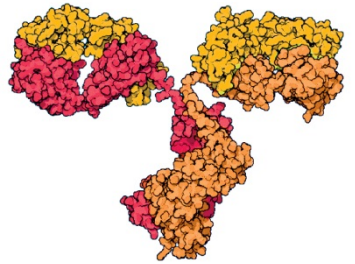
2. **Article 3(b) of Regulation No 469/2009 must be interpreted as precluding the grant of a supplementary protection certificate for an active ingredient whose effect does not fall within the therapeutic indications covered by the wording of the marketing authorisation.**

Article 1(b) of Regulation No 469/2009 must be interpreted as meaning that a carrier protein conjugated with a polysaccharide antigen by means of a covalent binding may be categorised as an 'active ingredient' within the meaning of that provision only if it is established that it produces a pharmacological, immunological or metabolic action of its own which is covered by the therapeutic indications of the marketing authorisation, a matter which it is for the referring court to determine, in the light of all the facts of the dispute in the main proceedings.

C-631/13 Forsgren – Implications (1)

- A protected product can now only be one which is in some way an active as defined by the MA.
- Perhaps the decision was in response to the European Commission requesting a simple SPC system where there was no need to look beyond the MA as to whether a product was an active ingredient; but has this been achieved?
  - Qu. 2a. What happens if the MA is later varied to amend indication / active ingredient definition?
  - Qu. 2b. What does **'active ingredient'** producing an action **"of its own"** mean – particularly in the context of a conjugate?
  - Qu. 2b. What does an action **"covered"** by the therapeutic indications of the MA mean? Indirectly related OK?
  - What happens to the Art 3d test – the MA is the first MA to place the product on the market – can you now ignore previous MAs where a component is present but is not apparently "an active ingredient"

C-631/13 Forsgren – Implications (2)



- Phrasing a SPC Product Description must now take into account Art 3a (the Patent claim relates specifically to the Product) and Art 3b (the Product is an active ingredient [?as defined by the MA within an “Active Ingredients” section or enough to be associated with a licensed therapeutic indication]).
- Immediate application: for an antibody drug conjugate MA, an SPC can have a Product Description only to the drug or only to the antibody (if the patent similarly claims drug or Ab, respectively).

C-631/13 Forsgren – Implications (3)

- The decision constitutes a separation of the Medicinal Product and Plant Protection SPC Regulations.
- Previously these have been thought of as analogous, and clarifications relating to one Regulation have been thought applicable to the other.
- Plant Protection Art 1(3) defines “active substance” with respect to a technical, extrinsic test [substances…having…action…against harmful organisms or on plants…].
- Hence in C-11/13 Bayer Cropscience the safener (indirectly) is an active substance as well as the herbicide with which it is combined [as it protects the plant from the harmful effects of the herbicide].
- Post Forsgren we are to interpret “active ingredient” in the Medicinal Product SPC regulation as being defined with respect to a regulatory, intrinsic (to the MA) test.

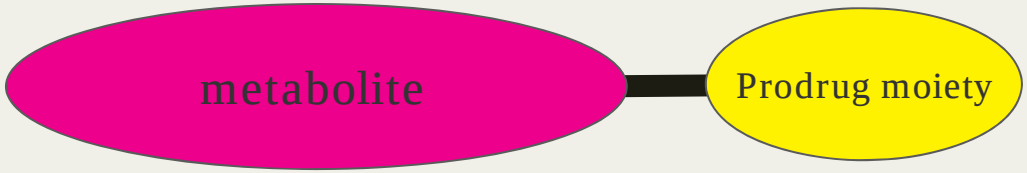
C-631/13 Forsgren – What next?

- The CJEU has given Forsgren a chance to obtain SPC protection back in the AT court.
- Conjugation makes no difference to PD being a potential active ingredient.
- But [Qu 2a] ntHi otitis indication not covered by the MA (though ? what happens if the MA is later varied to include the ntiHi otitis indication?)
- However, Re: Qu 2b, CJEU helpfully states that protein D is neither an excipient nor an adjuvant according to the MA – it is thus possible for carrier proteins to be accepted as active ingredients.
- CJEU also accepted that the pneumococcal PS by themselves do not have an immunological effect on their own (at least in children). Conjugation of PS to PD carrier protein is a prerequisite for the activity.
- Presumably Qu 2b “of its own” does not mean “on its own” and thus the carrier protein itself helping the anti pneumococcal-PS immune response when conjugated may (indirectly) make it an active ingredient relative to the pneumococcal indications covered by the MA?

CARPMAELS & RANSFORD

Whatever next?

- *C-631/13 Forsgren* highlights the following
  - Increased reliance on the technical content of the MA
    - Close coordination with reg dept.
    - Process claims?
  - Effect of MA variations
    - Can an MA variation render an invalid SPC valid?
      - "at the material time" (paragraph 9)
    - Basis for SPCs
  - Repercussions on Article 3(d) and Article 13
    - Simultaneously liberating and restrictive?



CARPMAELS & RANSFORD

Whatever next?

- *C-443/12 Actavis v Sanofi* highlights the following
  - Further clarity required on circumstances under which more than one SPC can be based on a single patent
  - *Georgetown II* versus *Actavis v Sanofi* & *Actavis v Boehringer*
  - When is an active ingredient the "subject-matter of the invention", a "core inventive advance" or a "totally separate innovation"?
    - Concept of independent validity of dependent claims.
      - Treat main claim as hypothetical prior art?
      - Surprising effects of combo
      - Combo non-obvious for another reason
      - Novelty-only prior art situations
      - Ownership

CARPMAELS & RANSFORD

Whatever next?

- *C-443/12 Actavis v Sanofi* highlights the following
  - What effect do post-grant patent amendments have on SPC validity?
    - Opposition amendments
    - Relevance of timing?
  - And what about other sorts of amendment?
    - Term
    - Product definition
    - MA

CARPMAELS & RANSFORD

Whatever next?

- Third party MAs
- Decision date v notification date
- Effect of product definition
  - No legal requirement
  - Does it function like a patent claim?
    - Treated like one during examination: breadth, clarity etc.
    - What if you have a medicinal product that contains several different "products"?

      multivalent vaccines (*Georgetown*)
      conjugated active ingredients (*Forsgren*)
  - E-16/14 *Pharmaq SA v Intervet International*
  - *If an SPC has been granted with a product definition that is not strictly limited to the specific strain of the virus authorised to be placed on the market as a medicinal product, a) will such an SPC be valid, or b) will the SPC be valid; such, however, that the scope of protection pursuant to Article 4 does not extend beyond the specific virus strain authorised?*
  - Also *Teva v Boehringer*

CARPMAELS & RANSFORD

Thank you for listening...

These are presentation slides only. The information contained in these slides does not constitute definitive advice, nor do they constitute the view of companies or organisations associated with the speakers.