



E.U. OBSERVATORY ON INFRINGEMENT OF IP RIGHTS

The European Observatory on Infringements of Intellectual Property Rights has released its study for 2015. The study is based on a sample of more than 2.3 million of European companies and considers the use that these companies make of patents, trademarks and industrial designs, both at national and European level.

One of the most compelling findings is that although a modest percentage of SMEs owns one of these types of prior rights, they have almost 32% more revenue per employee than other firms that do not own any Intellectual Property Rights.

About half of EU industries are IPR intensive and they account directly for 26% of all jobs in the EU – around 56 million direct jobs. With the addition of 20 million indirect jobs, one in three of all EU jobs – 35% of all jobs – rely on IPR intensive industries.

NEW SPANISH PATENT ACT

The New Spanish Patent Act was passed on July 13th 2015, but it will not come into force until April 1st 2017.

With the new Law, and due to the introduction of major changes, the Spanish and European patent system will become aligned. Some of the significant changes include the obligation for a substantive examination of all patent applications; also, the novelty required for utility models becomes worldwide and opposition proceedings will be post grant.

This new regulation is not aimed at maximizing the number of patents but rather at implementing a single grant procedure with a substantive examination of novelty and inventive step.



NEW MEMBER OF THE FIRM

Joaquim Ferrer, Registered European Patent Attorney, has recently joined our patent department. He holds a degree in Electronics Engineering from Catalonia Polytechnic University.

With this new hiring we expand our professional capabilities in the electromechanical patent field.



BIZ. BARCELONA

Oficina Ponti, SLP attended Biz. Barcelona, a meeting point for Catalan entrepreneurs, business angels and local and national financial institutions.

On 1st and 2nd June, entrepreneurs and innovative SMEs participated in several conferences, workshops and meetings with financial institutions with the objective of growing their projects and expanding their contacts network.

AGENDA / EVENTS:

15-18.09.2015 European Brand Owners Association. MARQUES. Vienna, Austria.

10-12.11.2015 Asian Patent Attorneys Association. APAA. Annual Meeting. Okinawa, Japan.

29.11-02.12.2015 Asociación Interamericana de Propiedad Intelectual ASIPI. Cartagena de Indias, Colombia.

SPC'S FOR DRUGS



Sònia Girona
Bsc in Chemical Engineering

The requirements for obtaining a Supplementary Protection Certificate (SPC) for medicinal products were laid down in the Regulation (CE) No. 469/2009 of the European Parliament and of the Council of 6 May 2009.

An SPC allows the owner of a patent in force to extend the protection of a product protected by this patent for an additional period of 5 years. Consequently, the holder of a patent and of an SPC based on that patent may obtain an exclusivity period of 15 years from the first marketing authorization.

The recent decision dated March 12, 2015 [Actavis Group PTC EHF, Actavis UK Ltd versus Boehringer Ingelheim Pharma GmbH & Co. KG – High Court of Justice of the European Union (C-577/13)] clarifies that the objective pursued by Regulation (CE) N° 469/2009 is not to compensate the holder for the delay in marketing the invention, nor to compensate the holder for such delay in all its possible commercial forms included in different granted claims, but to compensate him or her for the period of protection of the active ingredient constituting the true object of the invention covered by that patent.

For example, in situations relating to compositions comprising an active ingredient, wherein an active ingredient is the true object of the invention and not the combination of the active ingredient with a second active ingredient, the latest composition would not comply with the requirements for obtaining an SPC. This decision is irrespective of the fact that said combination of active ingredients was covered by a patent in a dependent claim, and also irrespective of the fact that a new marketing authorization for that combination had been granted.

Therefore, in order to obtain an SPC, the product covered by said SPC must constitute the subject-matter of the invention actually covered by the patent (i.e., an active ingredient by itself, or a combination of active ingredients).

In consequence, a second SPC for a composition comprising the true product (i.e., active ingredient) combined with an additional product, such as a second active ingredient, this combination being the object of a dependent claim in the same patent, would not comply with the requirements for obtaining an SPC, even if a new first marketing authorization had been granted by that combination.

In view of this decision of the High Court of Justice of the European Union, the Court trying the case of Actavis versus Boehringer relating to the telmisartan -hydroclorazida combination has held that the second SPC for such combination should not have been granted. That is, the second SPC is not the true object of the invention of the patent and, therefore, the second SPC was not valid.

Considering these recent decisions, the pharmaceutical companies may question whether a granted second or subsequent SPCs based on a same patent are valid.

Therefore, in assessing whether an SPC is infringed, the validity of said SPC should be checked first. In particular, it should be checked whether the SPC has been granted for a true product having a specific pharmacologic, immunologic, or metabolic action.

Finally, we should not forget that the maximum period of exclusivity conferred simultaneously by the patent and by the certificate cannot exceed a total term of fifteen years calculated from the first marketing authorization for said product in a national state or in the European Union [cf. Decision of the Court of Justice of the European Union (C-555/13) for the case Merck Canada Inc. versus Accord Healthcare Limited et al., dated February 13, 2014].

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