

19 September 2018

PATENTS ACT 1977

APPLICANT Merck Sharp & Dohme Corp

ISSUE Whether Patent Number EP(UK)0736030 B1
should be revoked under Section 73(1A) of the
Patents Act

HEARING OFFICER Dr L Cullen

DECISION

- 1 An Official letter, dated 21 November 2016, explained that the invention of claims 1-4 of the above patent was not new or did not involve an inventive step and that revocation of the UK Patent under Section 73(1A) of the Patents Act (hereafter the Act) might therefore be necessary^{1,2}. This letter also referred to the impact of such an action on the granted UK Supplementary Protection Certificate (SPC) derived from this basic patent, SPC/GB06/007.
- 2 The proprietor provided two responses, dated 08 December 2016 and 21 December 2016, to this Official letter, making observations and submitting proposals for amendment of the specification.
- 3 An expired patent has relevance for third parties. A patent that has expired can still be used to claim damages for infringements that took place while the patent was in force. A patent that has expired can also serve as the basic patent for an SPC, as in this case. Article 15 of the SPC Regulation³

¹ For documents related to this case including request for opinion and supporting documents - see entry for patent EP(UK)0736060 on the IPSUM (Online Patent Information and Document Inspection Service) database provided by the UK IPO.

² For full text of combined opinion concerning EP(UK)0736060 and SPC/GB06/007 - see Combined Opinion 9/16+10/16 published on the www.gov.uk website.

³ Regulation (EC) 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the Supplementary Protection Certificate for Medicinal Products

indicates that an SPC will be invalid if the patent is revoked or limited in such a manner that the product which is the subject of the SPC is no longer protected by the claims of the basic patent⁴. Thus, it is relevant for the Comptroller to consider whether revocation of such a patent is necessary, given that the effect of revocation is that the right concerned will be deemed never to have existed.

- 4 The amendments proposed in the letter dated 21 December 2016 are allowable under Section 76 of the Act.
- 5 I am satisfied that the proposed amendments distinguish the claimed invention from the cited disclosure. I therefore allow the specification to be amended as proposed, and make no order for revocation of the UK patent.
- 6 The proprietor, in their letter dated 8 December 2016, also referred to the situation regarding SPC/GB06/007 which relies on EP(UK) 0736030 B1 as basic patent. This granted SPC, which came into force on 20 December 2014 and is due to expire on 19 December 2019, relates to a particular Tetrahydrofuran antifungal – posaconazole – which is claimed in original claim 6 of the basic patent. This claim has now been proposed as new claim 1. As noted already, the amendments proposed in the letter dated 21 December 2016 are allowable. I am satisfied that granted SPC/GB06/007 derives from this amended claim 1 and that the product for which the certificate was granted will continue to be protected by the claims of the amended patent. Thus it is not necessary for the Office to publish any notification under Article 17, in so far as it relates to Article 15, of the SPC regulation^{3,5}.

Dr L Cullen

Deputy Director, acting for the Comptroller

⁴ Art 15(1)(c) of the SPC Regulation reads:

“The certificate shall be invalid if:

(a) ...;

(b) ...;

(c) the basic patent is revoked or limited to the extent that the product for which the certificate was granted would no longer be protected by the claims of the basic patent or, after the basic patent has expired, grounds for revocation exist which would have justified such revocation or limitation.”

⁵ Art 17(1) of the SPC Regulation reads:

“(1) If the certificate lapses in accordance with point (b), (c) or (d) of Article 14, or is invalid in accordance with Article 15, notification thereof shall be published by the authority referred to in Article 9(1).”