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THE EUROPEAN PATENT. SCOPE AND EFFECTS OF THE REVISED TRANSLATION.

Decision of Barcelona Commercial Court Nº. 4 of May 7, 2012

Last May 7, Barcelona Commercial Court no. 4 rendered a decision on a request for injunctive relief which opens up a new front in relation to the consequences of the Spanish reservation to the patentability of chemical and pharmaceutical products.

While indeed a first-instance decision, its importance lies, among other factors, in its setting out what are for now the unanimous criteria of the three commercial courts in Barcelona which, by decision of the General Council of the Spanish Judiciary of November 23, 2011, specialize in patents.

After the Supreme Court had rendered a decision on the question of the incompatibility of the Agreement on TRIPS with the Spanish reservation to the European Patent Convention, it was later asked to decide on whether it would be allowable for the revised translation of the European patent to include claims that were not in the original translation. The Supreme Court held that it would be allowable and also recognized that the Spanish Patents and Trademarks Office had the power to assess the requested revisions.

Thus, the revision of the translation of the patent (Article 12 of Royal Decree 2424/86 of October 10, 1986 on the application of the European Patent Convention) is the route chosen by laboratories to introduce product claims that were not in the original translation.

The problem is that these product claims were not in the set of claims included in the patent as filed and granted for Spain by the European Patent Office.

In the lawsuit concerned, the laboratory that filed the complaint had applied for and obtained a supplementary protection certificate for the medicinal product before filing the request for the revision of the translation. At the time the injunctive relief was requested, the basic patent had lapsed. This discussion hinges on whether the supplementary protection certificate extends the effects of the patent in its original wording (which only contains process claims), or in the wording of the revised translation (which also included product claims).

The court's decision places the source of the dispute in the fact that the request for a revision of the translation is in reality a request for the Spanish Patents and Trademarks Office to amend the patent as granted by the European Patent Office, when the translation cannot be used for this purpose.

The court held that the revised translation extends the protection of the patent as it was granted for Spain, by including product claims that were not granted by the European Patent Office, and affirmed that the Spanish Patents and Trademarks Office does not have the power to modify a granted European patent.

On this subject, Article 11 of above-mentioned Royal Decree 2424/1986 provides as follows *"where a Spanish translation has been submitted, in compliance with the requirements established in the preceding articles, that translation shall be considered legally valid if the European patent application or the European patent confirm, in the translated version, less protection than the protection granted by that application or patent in the language in which the application was filed"*. Article 123.3 of the European Patent Convention in turn states that the European patent may not be amended in such a way as to extend the protection it confers.

In light of all the points outlined above, the decision concluded that the patent's scope of protection cannot be held to be determined by the revised translation and that therefore the request for injunctive relief had to be dismissed.

This decision adds a new twist and marks a definite change in the scenario which directly affects the scope of the pharmaceutical patents that were granted while the reservation made by Spain to the European Patent Office was in force and is a new blow for innovation in the pharmaceutical industry.

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