

Case Report: Paris Court of Appeal in Syngenta v INPI (30 May 2014) and French Supreme Court in Boehringer Ingelheim v INPI (26 November 2013)

Limit your basic patent before your SPC is rejected.

Two decisions from the Paris Court of Appeal in Syngenta v INPI (30 Mai 2014) and the French Supreme Court in Boehringer Ingelheim v INPI (26 November 2013) have shed some light on the difficulties facing SPC applicants in France, seeking to strategically amend their basic patent.

Following the Medeva C-322/10 ruling from the CJEU, it is necessary for the subject matter of the SPC to be specified in the wording of the claims of the basic patent.

Some patentees, who did not have the requisite compounds stated in the claims of their basic patent, but had them in their description, sought to limit their claims, as is now allowed by the EPC 2000, so as to “import” the right combinations into the claims.

In the two aforementioned cases, the patentees first faced a rejection from the French Patent Office on the basis of a breach of the Medeva rule. They subsequently appealed against the rejection to the Court of Appeal and sought in the meantime to limit their claims so as to redraft them to comply with the Medeva rule.

A limitation under the EPC being retroactive and French appeals leading to a re-examination of all relevant facts including new facts, the patentees thought that they could lead the Court of Appeal to re-examine the rejection from the French PTO *de novo* and obtain that such rejection be set aside on the basis of the amended patent.

The French Patent Office should have then re-examined the SPC application and granted the SPC on the basis on the new claims.

The Supreme Court and the Court of Appeal reminded the patentees, that in matters of appeals from a decision of the French Patent Office, the Court of Appeal is acting under a judicial review of the decisions of the administrative body that is the French Patent Office. As a result they could only review the validity of its decisions, on the basis of the facts as they existed at the time that the decisions were taken.

Hence the subsequent limitation of the patent, even if retroactive, was too late.

The decisions of the French Patent Office were thus confirmed by the appellate Courts and as the deadlines for (re)applying for an SPC had long lapsed, the patentees were left with no SPCs.

However, had the patentees delayed the examination and rejection of the SPCs, long enough for the basic patents to be purposely limited, the outcome could have been entirely different.

These rulings thus highlight the importance of the timing of SPC applications and patent limitation proceedings.

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