EXPLAINING THE INTERACTIONS BETWEEN INTELLECTUAL PROPERTY LAW AND INTERNATIONAL LAW

Dra. Carmen Otero García-Castrillón
Prof. Titular Derecho internacional privado
Universidad Complutense de Madrid

Session 6 - Conceptual Issues in IP Teaching
THIRD ANNUAL MEETING OF THE EIPTN
London, 21st July 2009

INTRODUCTION

- Interaction between IPL and IL has been a reality since, at least, 1893 (PUC)
- Nowadays, the understanding of this interaction has become a must for application and development of IPL.
- Difficulties can be appreciated in an IPL class as much as in the administration.
- Case: Spain: European medicines patents recognized before 7th October 1992: conflicts:
  - ❖ Medicines' industry (innovators vs. Generic producers): civil courts
  - ❖ Innovators vs. administration (OEPM): applications and appeals in the administration & administrative courts.

SPANISH INTERNATIONAL COMMITMENTS ON PATENTABILITY OF MEDICINES

- Before EC membership: procedures
- After EC membership (1986):
  - Incorporation to EPC (10/7/1986):
    - Product patent reservation: art. 167
      - Duration: 15 years (until 10/1992)
      - Effects: lasting all live of patents
    - Reservation formal end: 13/12/2007 (entry into force of 29/11/200 EPC Act eliminating art. 167)
  - If EC intervenes, ECJ competence on Treaty interpretation
- TRIPS: from 1/1/1996: art. 65.1
  - Products and procedures: art. 27.1
  - Protected & protectable subject matter: art. 70.2

MEDICINES PATENTS IN SPAIN

- **Before 7/10/1992**: procedures only.
  - ➢ Generic producers: can use procedures different from patented until 7/10/2012
- **After 1/1/1996**: products and procedures.

➢ Generic producers: can produce european patented medicines with no effects in Spain (*EPC RESERVE*)?

➢ Innovative industry: can get recognition of european patented medicines in Spain (*TRIPS DIRECT EFFECT*)?

IL INTERPRETATION &

NATIONAL CIVIL/ADMINISTRATIVE LAW ISSUE

MEDICINE'S INDUSTRY STRATEGY

- **Innovative**:
  - ➢ Before 7/10/1992: EP applications for Spain include:
  - – Procedural revindications only (EPO President rec.): No product.
  - – Product and procedural revindications: Risks:
    - ▪ Non full validation of the application by the OEPM
    - ▪ If validated (many were), administrative (OEPM) or/and judicial actions could be launched (annulment/inefficacy)
  - ➢ After 1/1/1996: *TRIPS DIRECT EFFECT*
  - – Review of Spanish EP translations before OEPM
  - – Civil patent infringement actions
- **Generics**: After 1996: *EPC RESERVATION*
  - ➢ Civil actions: non-violation & inefficacy/nullity of product patents

TREATY INTERPRETATION
TRIPS DIRECT EFFECT

- No need of prejudicial question before ECJ: mixed agreement (Op. 1/94) & no latter EC action on patents (C-431/05, *Merck*).
- Interpretative criteria: arts.30-31Vienna Convention (1969)
  - ➢ Latter treaty on same issue prevails
  - ➢ Text: clear and unconditional rights
    - Art. 27.1: procedures & products
    - Art. 70.2: **in 1/1/1996 subject matter was**:
      - **Protected** - rights were recognized but had no effects (applications did not follow EPO President's rec.)
      - **Protectable** - rights were not recognized but, for a EP, a "unique invention" exists (applications that followed EP President´s rec.)
    - Art. 1: Members' free choice of means for compliance
  - ➢ Treaty objective and parties' intent: subjective rights' recognition

NOT RECOGNIZING RIGHTS - TRIPS VIOLATION

ADMINISTRATION (OEPM) RESPONSE

APPLICATION OF EPC RESERVATION

- Reviewed translations including new reivindications present in the EP invention are rejected / declared to have no effects

- EPC Reserve is not affected by TRIPS

RESPONSES IN COURT

- Civil Courts: non-violation & violation actions
  - "Retroactive" effects of patents (AP Barcelona, AP Madrid):
    TRIPS DIRECT EFFECT
  - Dismissal (AP Barcelona, AP Madrid): *PREJUDICIAL CHARACTER OF ADMINISTRATIVE ISSUE* (translations)
- Administrative Courts (TSJM): translations review cannot be used to have product revindications published

CONCLUSION

- Understanding and managing the interactions between IL and IPL has become a must for IP lawyers, officials and courts.
- Interdisciplinarity & specialization are two sides of the same coin.
- Sharing, dialoging and acknowledging what we learn from each other are essential means to improve our teaching.

Thank you