

# **EXPLAINING THE INTERACTIONS BETWEEN INTELLECTUAL PROPERTY LAW AND INTERNATIONAL LAW**

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# 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 7<sup>th</sup> 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.30-31 Vienna 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