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 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**

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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*
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