Decision in respect of a Request by Novartis AG (SPC 1999/002) for the Grant of a Supplementary Protection Certificate (Medicinal Products) under S.I. No. 125 of 1993 (European Communities (Supplementary Protection Certificate) Regulations, 1993) and Council Regulation EEC No. 1768/92 of 18 June 1992 concerning the creation of a Supplementary Protection Certificate for Medicinal Products

1. Introduction.

The matter in hand relates to a request (SPC 1999/002) for the grant of a Supplementary Protection Certificate from Novartis AG for valsartan or a pharmaceutically acceptable salt or ester thereof in combination with hydrochlorothiazide (HCTZ) and with the product name "Co-Diovan".

2. Background.

A request (1999/002) for the grant of an SPC for *"valsartan or a pharmaceutically acceptable salt or ester thereof in combination with hydrochlorothiazide"* and with the product name "Co-Diovan" was filed on 26 February 1999 by Novartis AG, a Swiss company of Basel, Switzerland.

On the request form, Irish patent 71155 with the title "Acyl compounds" was given as the basic patent in force as required under Article 3(a) of Council Regulation (EEC) No. 1768/92 (Regulation 1768/92). In order to satisfy the Controller that the product was protected by this patent, the Applicant referred in particular to "Valsartan is disclosed in Example 16 and is specifically claimed in Claim 26 of patent 71155".

The Applicant provided under heading 4(i) the required information relating to the first authorisation to place the product Co-Diovan on the market in Ireland, namely Product Authorisation No. 13/91/1 issued by the Irish Medicines Board on 10 December 1998, as well as a facsimile copy of the complete document.

The Applicant also provided on the filing date under item 6(iii) information regarding the identity of the products authorised as indicated under item 4(ii) and a copy of the notice detailing the publication of the authorisation from the official French journal. (In this regard I have noted a typographical error in the transposition of the Product Authorisation details onto the Request for Grant form, namely Product Authorisation number 344 302.8 as published in the French journal appears as 344 302-1 on the Request form.)

On 31 July 2003 the Controller notified the Applicant of certain outstanding requirements relating to the SPC request, in particular:

(i) The product for which an SPC was sought, i.e. "valsartan or a pharmaceutically acceptable salt or ester thereof in combination with hydrochlorothiazide" did not appear to be protected by the basic patent 71155 in force.

(ii) The Irish marketing authorization had been granted for a product containing two active ingredients, namely, valsartan and hydrochlorothiazide, but the basic patent did not appear to protect this combination product.

(iii) An SPC had already been granted for the product 'valsartan' (SPC 1997/012).

On 28 November 2003 the Applicant responded with the following arguments:

(i) Any combination of a compound of formula I with any active ingredient was covered by claims 35 and 36 of the basic patent 71155.

(ii) The product at issue, Co-Diovan, a combination of valsartan and hydrochlorothiazide, fell within the scope of composition claims 35 and 36.

(iii) The limitation of the protection of the certificate to the product as approved should not be confused with the meaning of the term *"product"* as *"protected by the basic patent".*

The Controller wrote to the Applicant on 22 June 2005 and restated the opinion that the request for grant still did not comply with the requirement of Article 3(a) of Regulation 1768/92. The Controller further indicated that, in the absence of a reply indicating that the Applicant would take appropriate action in response to this requirement, the application would be rejected, subject to the Applicant's right to apply for a hearing under Section 90, Patents Act (1992).

On 30 June 2005 the Applicant formally requested a Hearing on the matter and that Hearing took place before me, acting on behalf of the Controller, on 26 October 2005. At the Hearing, the applicant was represented by Ms. Assumpta Duffy of F.R. Kelly & Co.

Arising out of the discussions at the Hearing, Ms. Duffy was invited to supply further documents in support of her case, which she duly furnished to the Office on 11 November 2005, namely; (1) a copy of an article entitled *"ACE inhibitors and diuretics – the benefits of combined therapy for hypertension"* from Postgraduate Medicine – hypertension therapy, published 15 February 1989; (2) an English translation of Decision 124 III 375 issued by the Supreme Court in Switzerland; (3) an English translation of the Decision issued by the Hearing Officer in the Dutch Patent Office in relation to the corresponding Dutch SPC; (4) an English translation of a letter from the Dutch Patent Office dated 19 December 2000 enclosing the granted certificate for the SPC; and (5) an extract from the European Patent Register for European Patent EP0012401.

3. Consideration.

Article 3 of Regulation 1768/92 provides for the conditions for obtaining a Certificate and Article 3(a) in particular requires that "the product is protected by a basic patent in force." Moreover, Article 1(b) provides for the definition of *"product"* as *"the active ingredient or combination of active ingredients of a medicinal product."* At the Hearing it was agreed that the fundamental issue

in question was whether or not the product was protected by the basic patent as required by Article 3(a) of Regulation 1768/92.

In her submission Ms. Duffy outlined that that the product was Co-Diovan, a combination of the angiotensin II antagonist, valsartan, and the diuretic, hydrochlorothiazide (HCTZ). It was agreed that Co-Diovan fell within the definition of *"product"* as set out in Article 1(b) of Regulation 1768/92. Ms. Duffy argued that Co-Diovan was protected in the basic patent 71155 by virtue of independent claim 35 and its dependent claim 36. In particular, she asserted that the term *"comprising"* in claim 35 had a well-established meaning in patent law to the effect *"including the following elements but not excluding others".* Accordingly, she contended that, under the scope of patent 71155, any combination of the compound of formula I in claim 1 with any active ingredient was covered by claims 35 and 36.

She also expressed the view that the combination of HCTZ with a blood pressure reducing agent in a single medicament was well known and commonly used at the priority date of patent 71155. In support of this she cited SPCs 1993/009 and 1993/010 that were granted by this Office on the basis of patent 48922 for the respective combinations of enalapril with HCTZ and lisinopril with HCTZ. I have reviewed these cases and have noted that the combinations of the particular active compound with a diuretic such as HCTZ are explicitly disclosed in both the description and the claims of this patent.

In support of her argument that Article 3(a) of Regulation 1768/92 did not require the product that is the subject of an SPC to be specifically claimed, Ms. Duffy referred to SPC 2000/025. In this case the Office granted a certificate, based on patent 57326, for esomeprazole (the S-enantiomer of omeprazole), whereas the patent itself disclosed omeprazole without reference to the S-enantiomer. I do not believe that this case is analogous to the current one for the reason that omeprazole, being a racemate, is clearly the sum of its enantiomers, and the S-enantiomer is therefore present in omeprazole.

The agent also cited a UK case, where an SPC was granted for *"esomeprazole as magnesium salt trihydrate"*, whereas the corresponding patent (EP 0 124 495) did not specifically mention this formulation. This decision may be accounted for on a number of grounds. Firstly, the allowability of esomeprazole is predicated in the same manner as in the Irish SPC above. Secondly, the patent specifically draws attention to the preferability of the magnesium salt of omeprazole for tablet formulations (page 3, lines 4-5). Thirdly, the patent indicates a wide variety of forms of omeprazole, and specifically the magnesium complex, illustrating methods of preparation for both an anhydrous and a dihydrate form. It is not unreasonable, therefore, to construe the trihydrate as encompassed in the invention of the patentee, who had clearly envisaged a broad spectrum of omeprazole complexes, particularly when the physiological effect would be much the same. In my opinion the background to these two cases of granted certificates is significantly different from the current case where the basic patent 71155 contains no indication whatsoever that valsartan might be combined with any other active ingredient, let alone a specific one such as HCTZ.

Although the Examiner rightly conceded in the official communication of 22 June 2005 that any third party manufacture of Co-Diovan would infringe the basic patent 71155, Ms. Duffy appears to conclude from this that the product itself therefore falls within the scope of the claims. I find it difficult to accept this conclusion. Where there is a combination of active ingredients, e.g. A and B, and only one of these, say A, is identifiable with the invention as disclosed in the description and claims, unauthorised use of the combination would result in infringement of the patent because of the presence of A. However, it must be noted that the patent protects just this one ingredient A. The other ingredient making up the combination has no bearing whatsoever on the question of infringement because it is not identifiable with the invention and so is not protected by the patent. In such a case, for example, it might be expected that the amount of any damages awarded would be based solely on the infringed ingredient rather than on the combination.

Ms. Duffy also asserted that, while Co-Diovan was not specifically disclosed in the basic patent, it is not excluded from the scope of the claims in view of the presence of the term *"comprising"* in claim 35. She argued that the expression *"as active compound"* in claim 35 was not restricted to a sole active compound and the term *"comprising"* in the claim did not exclude the possibility that one or more additional active compounds may be present in the composition.

On this issue of the scope of the claims or the extent of protection, it is appropriate to consider the relevant sections of the Act. Section 20 provides for the claims as follows: *"The claim or claims shall define the matter for which protection is sought, be clear and concise and be supported by the description."* Furthermore, Section 45(1) provides the statutory basis for determining the extent of protection: *"The extent of the protection conferred by a patent or a patent application shall be determined by the terms of the claims; nevertheless, the description and drawings shall be used to interpret the claims."* Section 45(3) requires that in the interpretation of 45(1) regard shall be taken to the directions contained in the Protocol on the Interpretation of Article 69 of the European Patent Convention and this is set out in the Second Schedule to the Act as follows: "*Section 45 should not be interpreted in the sense that the extent of the protection conferred by a patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these two extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties."*

In the basic patent 71155 upon which the SPC request is based, there is no indication either in the description or the claims to suggest that valsartan might be combined with any other active ingredient, let alone HCTZ. In the

last paragraph of page 44 of the basic patent, the applicant provides for pharmaceutical preparations *"… which contain the compound according to the invention or pharmaceutically utilizable salts thereof…"* and also *"… the pharmacologically active ingredient being present on its own or together with a pharmaceutically utilizable carrier".* In the first paragraph of page 45 is stated *"Thus, pharmaceutical preparations for oral use can be obtained by combining the active ingredient with solid carriers …".* Again, there is no mention of the possibility of combining the active ingredient with any other active ingredient. If it had been the intention of the applicant to provide for this particular embodiment, I feel that at least some reference would have been made to it in the original application and in this respect the interests of third parties have to be considered as provided for in the Second Schedule to the Act.

The objective of the 1768/92 Regulation as outlined in Recital 8 is to provide the holder of both a patent and a certificate an overall maximum of 15 years of exclusivity from the time the medicinal product in question first obtains authorisation to be placed on the market in the Community. In this regard Novartis has already benefited by obtaining a certificate for valsartan (SPC 1997/012) based on patent 71155 that is due to expire on 12/05/2011 i.e. 15 years from the issue of the first marketing authorisation. Whilst more than one certificate may be granted for different medicinal products based on the same patent, this may only be done where the requirement of Article 3(a) is met.

In the present case Novartis have a monopoly for valsartan by virtue of patent IE71155 and what they now seek via this SPC request is a monopoly for the combination of valsartan and HCTZ. The fact that this combination might infringe the monopoly given by the patent simply because one component infringes is not relevant in my opinion.

In a recent similar case that came to a Hearing at this Office, a request for the grant of an SPC (2000/033) by Schering for a product "Mirelle" was rejected under Article 10(2) of 1768/92 on the grounds that the product, namely the

combination of two active ingredients, Gestodene and Ethinyl Estradiol, was not protected by a basic patent in force as required by Article 3(a). In this case the basic patent (58798) only protected the Gestodene and no reference whatever was made in the description or claims to the use of this compound in combination with another active ingredient.

Ms. Duffy also drew my attention to a decision 124 III 375 issued by the Supreme Court in Switzerland where an SPC was granted for the combination of active ingredients fosinopril and HCTZ despite the fact that this combination was not specifically claimed in the basic patent (EP 0 053 902). However, having examined this patent, I have noted that such a combination is disclosed on page 3, lines 41 & 42 of the description as follows: *"The compounds of the invention can also be formulated in combination with a diuretic for the treatment of hypertension."* Furthermore, on page 3, line 47 HCTZ is given as a specific example of such a diuretic. As previously stated, no similar disclosure exists anywhere within the description in the present case. In response to a question concerning applications for a similar certificate in other EU jurisdictions, Ms. Duffy stated that, following a Hearing at the Netherlands Industrial Property Office, a certificate had finally been granted and she agreed to supply a copy of the decision. This document was submitted on 11 November 2005 as mentioned previously. In summary, the Hearing Officer felt that the wording of claim 35, which provided for *"contains"* rather than *"encompasses"*, was sufficient to cover the composition of valsartan with HCTZ, given that the combination of HCTZ with a hypertensive agent was well known in the prior art. I find this decision surprising, particularly as the Hearing Officer made the following comment in the decision *"… [the] Office adheres to the explicit points of reference which can be found in the claims and description of the basic patent"* in respect to determining what is protected by the basic patent within the framework of Regulation 1768/92. He remarked further *"should a broader explanation of the patent and the certificate based thereupon be justified, then within the frame of an infringement procedure the judge should decide this."*

Having regard to Recital 6 of 1768/92, which states that *"a uniform solution at community level should be provided for …"*, it seems reasonable to briefly review other similar case law within the EU. Referring to the UK case 2002/APP/0072 mentioned by the Examiner in the official communication of 22 June 2005, Ms. Duffy observed that it was not relevant due to the fact that no marketing authorisation was deemed to have been granted for the combination product. However, the certificate was also rejected on the grounds that the combination product was not protected by the basic patent. This decision appears consistent with the interpretation of *"protected by a basic patent in force"* in Article 3(a) of Regulation 1768/92 as meaning that the product (in this case the active ingredient or combination of active ingredients) is expressly referred to in a patent claim or is covered by a general definition of the invention in the patent. In a different case in Sweden, a request by AB Hässle for a certificate for a combination of two active ingredients, felodipin and metoprolol, was rejected on the grounds that the product was not protected by the basic patent. Once again, there was no mention or suggestion in either the claims or the description that any active compound in addition to felodipin would be contained in the pharmaceutical preparation.

4. Decision.

The request for the grant of a Supplementary Protection Certificate (Application No. 1999/002) by Novartis AG for valsartan or a pharmaceutically acceptable salt or ester thereof in combination with hydrochlorothiazide (HCTZ) and with the product name "Co-Diovan" is rejected under Article 10(2) of Council Regulation (EEC) No. 1768/92 on the grounds that the product is not protected by a basic patent in force as required by Article 3(a) of the same regulation.

_____

Dr. Michael Lydon
Hearing Officer
10 March 2005