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Newsflash

SPCs for functionally defined products

In a series of decisions and reasoned orders handed down in November 2011 (collectively referred to as "*Medeva et al.*") the CJEU ruled that an SPC was only available for products which are identified in the claims.

In the absence of any further guidance in terms of what tests must be met in order to determine whether a product is properly "identified", these decisions have been heavily criticised and given rise to further referrals.

In the decision C-443/12 handed down on December 12, 2013 the CJEU has finally provided guidance. Thus, the product does not have to be literally identified in the claims. It may also be functionally defined, as long as upon proper construction of the claims in light of the description (in accordance with Article 69 EPC and its protocol) it is clear that the claims relate to the active ingredient in question.

The head note of the decision reads as follows:

> *"Article 3(a) ... must be interpreted as meaning that, in order for an active ingredient to be regarded as 'protected by a basic patent in force' within the meaning of that provision, it is not necessary for the active ingredient to be identified in the claims of the patent by a structural formula. Where the active ingredient is covered by a functional formula in the claims of a patent issued by the European Patents Office, Article 3(a) ... does not, in principle, preclude the grant of a supplementary protection certificate for that active ingredient, on condition that it is possible to reach the*

> *conclusion on the basis of those claims, interpreted inter alia in the light of the description of the invention, as required by Article 69 of the Convention on the Grant of European Patents and the Protocol on the interpretation of that provision, that the claims relate, implicitly but necessarily and specifically, to the active ingredient in question, which is a matter to be determined by the referring court."*

It is very comforting to note that the CJEU took note of the constructive criteria.

The new decision should dispel many of the uncertainties generated by *Medeva et al.*