

## Intellectual Property - Austria

Court clarifies legal aspects of supplementary protection certificates

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In its decision of February 16 2011 (17 Ob 5/11a) the Austrian Supreme Court thoroughly examined the legal effects of a supplementary protection certificate for medicinal products and its interrelation with patent rights. The decision is complex, but provides valuable information on related proceedings for injunctive relief.

### Facts

The first claimant was the holder of a European patent with an expiry date of June 1 2009. He had been granted a supplementary protection certificate (SPC 2) to this patent (for a subsequent medicinal product) until June 1 2014. The second claimant was his licensee.

The defendant considered SPC 2 to be void as it identified another supplementary protection certificate (SPC 1) which - according to the defendant - was based on the same active ingredient. Thus, the defendant argued that SPC 2 could not have been issued under the rules of EU Regulation 469/2009 on supplementary protection for medicinal products.

Following the expiration of the patent, the defendant applied for the stay of an interim injunction that had been issued during the term of the patent. The defendant argued that as the patent has expired, only SPC 2 governed the issue and that this was to be regarded as invalid.

### Decision

First, the Austrian Supreme Court pointed out that a supplementary protection certificate granted under EU Regulation 1768/92 is - due to the lack of any transitional provisions - governed by EU Regulation 469/2009 concerning supplementary protection for medicinal products. However, the conditions for obtaining a certificate must be determined according to the legal situation at the time of issuance; thus, the application of EU Regulation 469/2009 shall not cause any benefit or detriment to the holder of the supplementary protection certificate.

The court held that the limited means available to it in a proceeding for an interim injunction does not, generally speaking, permit it to deviate from the assumption of validity of a patent or supplementary protection certificate. Thus, the court based its decision on the validity of the supplementary protection certificate. The defendant was unable to provide sufficient evidence indicating otherwise.

Due to a change in the law, the decision on the conditions under which an interim injunction can be stayed is now governed by the general terms of the Austrian Enforcement Act (rather than by the Patent Act). While the Enforcement Act does provide for the possibility to stay enforcement if sufficient monetary security is offered, the court held that such relief is not available in patent (and supplementary protection certificate) cases, as the consequences of continuation of an infringement cannot be foreseen with sufficient certainty.

### Comment

The detailed examination of legal aspects of supplementary protection certificates is welcome. Contrary to previous case law and doctrine, the Austrian Supreme Court denied the applicability of security payments to patent law claims, contradicting the common opinion that damages in patent infringements can be calculated.

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