CJEU Introduces an "Invention" Test for Combination Products to be Eligible for SPC Protection

The CJEU has today issued its long-awaited decision in Joined Cases C-119/22 (*Teva*) and C-149/22 (*Merck*), relating to the criteria for assessing the availability of SPCs for "fixed" combination products. The full text of the judgment can be found here.

The decision clarifies that a medicinal product consisting of two active ingredients, A+B, must be considered a different "product" within the meaning of the SPC Regulation to the individual monotherapies, and as such it is possible to obtain separate SPCs to both (i) a monotherapy A and (ii) combination therapy A+B based on the same patent. However, the decision goes on to impart an "invention test" to the availability of combination SPCs. Thus, to obtain an SPC to the combination A+B, it will now be necessary to demonstrate that the ***combination*** of ingredients constitutes a feature required to solve the technical problem underlying the basic patent.[2]

Background to the referrals

The referrals arise from proceedings involving Merck Sharp & Dohme Corp as the SPC holder. The Finnish proceedings relate to an SPC directed to the product Janumet® (a combination of sitagliptin and metformin), based on EP1412357. The Irish proceedings relate to an SPC directed to the product Inegy® (a combination of ezetimibe and simvastatin), based on EP0720599.

In both cases, the basic patents related to the development of a single new active ingredient (sitagliptin in the case of EP1412357, and ezetimibe in the case of EP0720599). SPCs had already been obtained by Merck in each case to those single active ingredients (monotherapy SPCs). However, in each case the patents described and claimed combinations of the new active ingredient with other medicinal substances that were already known at the priority date (sitagliptin + metformin in EP1412357; ezetimibe + simvastatin in EP0720599). In neither patent were any data provided showing a particularly beneficial effect to therapy involving the combination treatments (e.g. any evidence of synergy). Rather, the specific claims directed to the combination products were novel and inventive because sitagliptin and ezetimibe, respectively, were novel and inventive in their own right.

The challenges brought by Teva (in the Finnish proceedings) and Clonmel Healthcare (in the Irish proceedings) were that under such circumstances, an SPC should not be granted for the combination products, because such SPCs would either infringe the provisions of Article 3(a) or 3(c) of the SPC Regulation.

A combination product is a separate "product" within the meaning of Article 3(c)

Article 3(c) of the SPC Regulation requires that:

"A[n SPC] shall be granted if … the product has not already been the subject of a certificate"

Apparent contradictions in the previous case law [1] meant that it was unclear whether a combination product A+B could be considered a new "product" within the meaning of Article 3(c) in circumstances where (a) an SPC had already been obtained to monotherapy A based on the same basic patent, and (b) the subject-matter of the "invention" covered by the basic patent was the monotherapy A, rather than the combination A+B.

Thus, the CJEU was asked to consider whether Article 3(c) of the SPC Regulation precludes the grant of an SPC for a combination product A+B where A has already, alone, been the subject of an earlier SPC and is the only product to have been disclosed for the first time by the basic patent (B being already known at the priority date).

The answer provided to this question by the CJEU is a clear and emphatic "no".

In the decision, the CJEU has emphasised the importance that the concept of "product" as applied to the SPC Regulation cannot be dependent on context. In particular, the term "product" appears in all four of the substantive conditions for granting of an SPC set out in Articles 3(a)-(d) of the SPC Regulation. The CJEU noted that it would be undesirable for the term "product" to have a different meaning or scope when considering each of the different conditions of Article 3.Turning to how the term "product" should be consistently defined, the CJEU considered that Article 1(b) of the SPC Regulation provides a "strict" definition of this term, namely

"the active ingredient or combination of active ingredients of a medicinal product"

The CJEU held that it follows from this definition that whether two products are identical or not depends **only** on the comparison of the active ingredient or ingredients that they contain, irrespective of their therapeutic applications (or any other context-dependent factors). Thus, a combination product A+B must be considered as a different "product" from a monotherapy product A.

On this basis, the CJEU held that an SPC to a combination product A+B cannot be denied under Article 3(c) on grounds that an earlier SPC to a monotherapy product A has already been granted.

Furthermore, the CJEU noted that each of the conditions of Article 3 of the Regulation are separate and cumulative. Article 3(c) is concerned only with whether a certificate has previously been granted for a product. It does not refer to the basic patent

at all. Thus, it would be improper for an analysis under Article 3(c) to require a consideration of what is disclosed in the basic patent.

A combination product must fall under the "invention" of the basic patent in order to satisfy Article 3(a)

The CJEU then turned to a consideration of Article 3(a), which requires that

"the product is protected by a basic patent in force"

The previous leading cases on Article 3(a) are C-121/17 (Teva) and C-650/17 (Royalty Pharma). Taken together, these decisions suggested that Article 3(a) is satisfied provided that the following two conditions are met:

- The product must, from the point of view of a person skilled in the art and in the light of the description and drawings of the basic patent, necessarily fall under the invention covered by the basic patent.
- The person skilled in the art must be able to identify the product specifically in the light of all the information disclosed by that patent, on the basis of the prior art at the filing date or priority date of the patent concerned.

The CJEU was asked to consider whether, for a combination product A+B, where A is a new active ingredient disclosed in the basic patent and B is a previously known active ingredient, the requirements of the *Teva* test (above) are satisfied by (i) a mere express mention of the combination A+B in the claims of the basic patent, and if not, by (ii) an express mention of the combination A+B in the claims of the basic patent coupled with a teaching in the specification that A can be used in combination with B.

The answer to question (i) is given as "no" and the answer to question (ii) is given as "yes", with the important caveat that the combination A+B must necessarily fall "*under the invention covered by the same patent*".

Thus, the CJEU has introduced (or at least, formalised) a new hurdle to the protection of combination SPCs: the combination A+B must fall under "the invention" of the basic patent. In other words, it is **not** sufficient for a basic patent to claim or describe a combination A+B unless there is an invention associated with that combination which ***goes beyond*** the invention of the monotherapy alone.

In coming to this conclusion, the CJEU justifies its position with reference to the purpose of the SPC Regulation, namely to encourage research into new medicinal products, and not merely to extend the scope of protection conferred by a basic patent. Therefore, the CJEU has taken the stance that it is only justifiable to obtain an SPC to a combination product if there is some ***additional invention*** involved in arriving at the combination therapy, beyond the discovery of a new monotherapy and combining this new active ingredient with any known active ingredient.

The CJEU has not provided precise guidance as to what might constitute an "invention" in the context of combination therapies outside of specifying that the combination of ingredients should constitute a feature required to solve the technical problem underlying the basic patent. But it seems that a useful rule of thumb would be to consider whether a claim to a combination A+B would be granted in a patent by the European Patent Office if ***both*** compounds A and B were previously known. One situation which is explicitly mentioned by the CJEU as sufficient to meet the requirements of the invention test is evidence of an unexpected synergistic effect between A and B.

Practice points

The conclusions of the CJEU relating to Article 3(a) are likely to be disappointing to innovator companies. Compared to the previous granting practice of national patent offices, the introduction of the "invention test" will represent a high new bar to obtaining SPCs for combination products.

That said, the present decision is clear in its conclusions and has resolved some apparent discrepancies in the previous case law. The additional certainty and guidance provided by the CJEU is, at least, welcome.

The key take-home message for rights holders from this decision is that there may now be divergence between what is considered an "invention" for the purposes of obtaining a patent to combination products at the EPO on the one hand, and what is considered an "invention" for the purposes of obtaining SPCs to combination products at national patent offices on the other. In particular, the "invention test" to obtain a combination SPC will often be a higher burden to overcome than for a corresponding claim in a patent application to meet the requirements of inventive step.

It will also now likely be of benefit to applicants to pursue claims to a monotherapy A and claims to a combination therapy A+B in ***separate patent applications***, which may include a divisional application, rather than to have claims to A and A+B in the same application. That way, if a patent claims ***only*** a combination therapy A+B rather than also claiming the monotherapy A, it may well prove more feasible to argue that "the invention" underlying such a patent is the *combination* of active ingredients. Most ideally, such combination claims would be present in an entirely separate application (*i.e.* not a divisional) with an explanation as to why the combination constitutes an invention. However, where that is not possible, it would be advantageous to divide existing applications and pursue claims to combination therapies of interest via bespoke divisional applications.

Finally, whilst this decision of the CJEU does resolve some of the tension in the previous case law, there is also one key unanswered question posed by the new "invention test". Namely, at what stage must evidence that the combination of active ingredients constitutes a new invention be provided? Must this evidence be provided in the application as filed, or can post-filing data be taken into account? It will be interesting to see if this issue now arises in SPC grant proceedings, and if so how it is handled by national courts.

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Footnote: Summary of answers to the referred questions

The questions referred by the Finnish and Irish Courts can be summarised in essence as follows:

- Does Article 3(c) of the SPC Regulation precludes the grant of an SPC for a product consisting of two active ingredients (A+B) where A has already, alone, been the subject of an earlier SPC and is the only one to have been disclosed for the first time by the basic patent (B being already known at the priority date)?
- Must Article 3(a) of the SPC Regulation be interpreted as

meaning that it suffices that a product A+B is expressly mentioned in the claims of the basic patent in order for that product to be regarded as being protected by that patent, within the meaning of Article 3(a)?

- Must Article 3(a) of the SPC Regulation be interpreted as meaning that a product consisting of A+B is protected by the basic patent, within the meaning of Article 3(a), where A and B are expressly mentioned in the claims of that patent and the specification teaches that A may be used as a medicinal product alone or in combination with B, which was a known active ingredient at the priority date?

The answer provided by the CJEU to questions (1) and (2) is a clear "no".

The answer to question (3) is "yes", with the important caveat that the combination A+B "necessarily falls under the invention covered by the same patent".

[1] On the one hand, decisions C-443/12 (Actavis I) and C-577/13 (Actavis II) held that Article 3(c) must necessarily preclude grant from the same patent of both (i) a first SPC arising from a marketing authorisation (MA) for monotherapy A, and (ii) a second SPC arising from a (later) MA for combination therapy A+B, if the combination does not "constitute the subject-matter of the invention covered by that patent" (what became known as the "core inventive advance" test). However, later decisions C-121/17 (Teva) and C-650/17 (Royalty Pharma), which were primarily concerned with Article 3(a), rejected the nation that any "core inventive advance" test should apply to an assessment of the validity of an SPC, creating an apparent contradiction to be resolved.

[2] This decision is concerned with applications for a combination SPC of A+B based on authorisation of A+B. This is not the same as applications for a single active SPC of A or B, which can (under certain circumstances) also be based on authorisation of A+B – see our main SPC briefing.

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