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An SPC's filing date may affect its duration

Since regulation (EEC) 1768/92 on supplementary protection certificates (SPC) appeared, it has been the object of numerous court actions, which have defined terms such as “product” and “Community”.

According to Article 13 of the regulation, the duration of a certificate is calculated based on the first authorization to place the “product” on the market in the “Community”. In an earlier decision, the German Federal Patent Court (BPatG) stated that this authorization has to comply strictly with Council Directives 65/65/EEC or 81/851/EEC. Hence, a national authorization not complying with the Council Directives should not affect an SPC's duration.

In a recent decision (3 Ni 2/06), the BPatG came to the conclusion that the transitional provisions of Article 19, according to which an SPC can be granted based on national authorizations in new member states not necessarily complying with the Council directives, do not only apply to Article 3b, but also to Article 13 of the Regulation. Hence, not only the right to obtain an SPC (Article 3b), but also the duration of the certificate (Article 13), shall be based on the first authorization in the Community, independent of whether the national standards are in agreement with the Council directives or not. This decision seems to be provoked by the desire for an identical SPC duration throughout the Community.

The countries falling under the term “Community” that are relevant for the calculation of the SPC duration are set on the SPC filing date. As a consequence, the duration of the SPC may depend on the filing date of the SPC, and in some cases the right to obtain an SPC could even be lost completely if the SPC is filed after a country, in which an early authorization was obtained, joins the Community.

While at first glance this decision seems to limit the rights of an SPC applicant, it clarifies the situation with respect to Article 2 of the Regulation, which accorded that generally no SPC

could be granted if the product was marketed in a member state before the authorization complying with the Council directives was obtained.

Hence, while the recent decision clarifies the need for applicants to carefully time their SPC filing, in the still growing community the regulation and its interpretation leaves a wide open area for questions regarding an SPC's validity and possible targets for competitors.