

EIP

Neurim v Mylan – Is it finally all wrapped up or is the door still open for round 3?

Following on from Mr Justice Meade’s judgment on the preliminary issues in the re-match between Neurim (and Flynn) and Generics (UK) Ltd (now trading as Viartis but formerly Mylan) concerning a divisional patent and Mylan’s generic melatonin product, which we previously reported on [here](#). This has been followed up with a short judgment from Mr Justice Marcus Smith.

It is clear from each of the judgments in this case that the circumstances are most unusual, nevertheless the Court has been extremely flexible in accommodating the various issues as they have come about. By way of quick summary, in this re-match, the trial concerned a divisional of the parent patent which was previously litigated and heard before Mr Justice Marcus Smith leading to the “Main Judgment” (4 December 2020) and then a “Consequential Judgment” (12 March 2021). Following the Main Judgment, the parent patent was found valid and Mylan (as it was then) to be either threatening to, or actually infringing the parent patent. But by the Consequential Judgment, the parent patent was no more following successful opposition proceedings at the EPO and Neurim withdrawing its appeal against the decision to revoke. A divisional patent was then granted on 30 June 2021, which led to Neurim suing Mylan on this new divisional.

This leads us to now and Mr Justice Marcus Smith taking charge on the suggestion of Mr Justice Meade. Mr Justice Marcus Smith made it clear in this new judgment that the trial of these proceedings concerning the divisional was on the basis only of the materials and arguments that were before him at the earlier trial which culminated in the Main Judgment concerning the parent patent. The case had been referred to him because he

had the advantage of having heard all the evidence and submissions in the first instance. The Judge was also clear that he would only take into consideration re-emphases or re-statements of points that were before him at the earlier trial, rather than new or fresh formulations of points or arguments that could have been taken, but were not taken, by Mylan previously, even if relevant documents or materials were technically before the Court at first instance.

Following a review of the written submissions made to the Judge and considering the materials on the basis as set out above, the Judge was not persuaded that the Main Judgment was wrong nor did he feel compelled to expand on the Main Judgment. He therefore concluded that the divisional was to be found valid and infringed. And permission to appeal was refused for the same reasons as set out in the Main Judgment.

Although the Judge was decisive in his judgment, because the matter was decided on the papers and without oral argument, he has potentially left the door open for round 3 of this match-up, by offering the parties the opportunity to appear before him and persuade him to follow a different course, commenting that “that is the normal course where a ruling is given on the papers, and without an oral hearing”. He has explicitly labelled his judgment as “provisional” until he hears from the parties.

The judgment is available [here](#).