EIP

Supreme Court holds Pfizer pregabalin patent invalid

Actavis and NHS England eligible to claim under cross-undertaking in damages.

The Supreme Court decision in the litigation of Warner-Lambert (Pfizer) against Actavis and Mylan has been handed down this morning. Read the full judgment and press summary here.

Background

Warner-Lambert (part of the Pfizer group) had a second medical use patent for the use of pregabalin in the treatment of neuropathic pain. The examples in the patent specification were typical models of inflammatory pain, but the patent claimed treatment of all kinds of pain (in claim 1), and all kinds of neuropathic pain (in claim 3). (There are two main classes of neuropathic pain – central neuropathic pain and peripheral neuropathic pain). Both at first instance in the Patents Court, and on appeal at the Court of Appeal, the patent was found to be invalid for insufficiency, because the information in the patent did not make it plausible that pregabalin could be used to treat all kinds of pain. The information made plausible use for some kinds of pain, such as inflammatory pain and peripheral neuropathic pain, but not for many others, including central neuropathic pain. Thus claim 1 and claim 3 were held to be invalid as only partially plausible.

The Actavis pregabalin at issue (sold under the brand name Lecaent) had a "skinny label", that is, the drug information on the package insert referred only to the off-patent indications (epilepsy and generalised anxiety disorder) and not to pain. The Patents Court and Court of Appeal disagreed about how second medical use claims in the Swiss form (which are purpose-limited process claims) should be construed for infringement. In the Patents Court Mr Justice Arnold had in his initial interim decisions thought that

"subjective intent" from the alleged infringer was required for infringement – the generic manufacturer must actively intend, not merely foresee, that some of their product would be used for the treatment of pain, i.e. the patented indication must be actively targeted by the manufacturer. But in the final decision (that was the subject of the appeal to the Court of Appeal and then the Supreme Court) Mr Justice Arnold applied what he understood to be the test that the Court of Appeal had set out in their interim appeal decision, namely that, for infringement to occur, administration of the alleged infringing product (i.e. from a specific generic manufacturer) for the claimed indication of pain had to be intended by someone (for example the treating doctor or pharmacist) and that this intentional administration had to be foreseeable to the manufacturer. Since there was no such intentional administration (generally the doctor intended administration of pregabalin generally, not pregabalin from any specific source, while the pharmacist generally would be unaware of the indication for which pregabalin was being prescribed), there was no infringement. In the Court of Appeal's final judgement Lord Justice Floyd said that this was the incorrect test (and that Mr Justice Arnold had misunderstood the test set out in the Court of Appeal interim judgment); instead the test should be that if the generic manufacturer knew or could foresee that at least some of the prescriptions written generically for pregabalin to treat pain would be fulfilled with their product, then they would infringe, unless they had taken all reasonable steps in their power to prevent their product from being used to treat pain.

In summary, the Supreme Court has upheld the overall outcome of the lower courts that the relevant claims of the patent are not valid, and, even if they were valid, would not be infringed under the facts of the present case. There are four speeches in the judgment, Lord Reed agreeing with the speech of Lord Sumption, and Lord Mance, Lord Hodge, Lord Briggs giving separate speeches.

Patent validity – plausibility

The Supreme Court unanimously upheld the finding of the Patents Court and Court of Appeal that the patent specification does not make it plausible that pregabalin would be effective to treat all kinds of pain, or all kinds of neuropathic pain (both central and peripheral). A majority (Lord Sumption, Lord Reed and Lord Briggs) went further to say that the patent specification does not make it plausible that pregabalin would even be effective to treat peripheral neuropathic pain, while a minority (Lord Hodge and Lord Mance) held that the plausibility standard was met in respect of peripheral, but not central, neuropathic pain (so that the underlying decision of Arnold J was correct). On either view claims 1 and 3 were invalid. Therefore, the invalidity of the patent, as decided by the two lower courts, was upheld. Only the claim relating to inflammatory pain was held to be valid (but pregabalin is not licensed for treatment of inflammatory pain.)

This decision upholds the "plausibility" standard in UK patent law. The patent must make it plausible that the invention works, otherwise it is invalid for insufficiency. The plausibility must derive only from material in the specification or known at the time of filing – lack of plausibility cannot be remedied by later evidence or information. The judgment confirms that the "plausibility" threshold is low, but required to prevent over-broad or speculative claiming, particularly in the medical and chemical fields (notwithstanding that "plausibility" or "plausible" is not to be found in either the UK Patents Act or the European Patent Convention).

Infringement of second medical use claims

Since the patent was held invalid, the comments on infringement are obiter (non-binding), and the Supreme Court was divided on how infringement of Swiss form claims should be interpreted. It was unanimous however that there would have been no infringement on the facts of the present case, had the patent claims been held to be valid. However, the split makes it hard to know how UK Courts will interpret second medical use claims in future. This is even more so since the judgment explicitly only applies to Swiss claims, and the scope of EPC 2000 second medical use claims remains formally undecided in the UK.

Lord Sumption and Lord Reed disagreed both with the first instance decision of the Patents Court (Mr Justice Arnold), and with the decision of the Court of Appeal (Lord Justice Floyd), and considered that the focus on the mental element of infringement of a Swiss claim was erroneous. They held that the intention of the alleged infringer, whether subjective or objective, is irrelevant and that the sole criterion of infringement is whether the product as it emerges from the manufacturing process, including any labelling or accompanying leaflet, is presented as suitable for the uses which enjoy patent protection. This is referred to as the "outward presentation" test and was not a position advanced before the Supreme Court by any party, but nevertheless considered by Lord Sumption to be the correct approach. He saw many difficulties both conceptual and practical if the state of mind of the manufacturer or some other person (whether subjective intent or foreseeability) was relevant to the question of infringement. Lord Sumption was equally scathing of both the subjective intent test originally adopted by Arnold J ("No rational scheme of law could depend on such considerations as these") and the foreseeability test that can be negatived by taking all reasonable steps, as advanced by Floyd LJ ("It is right to add that the Court of Appeal's compromise is likely to be legally uncertain and practically unworkable.")

Effectively, Lord Sumption has laid down that a skinny label, by itself, is sufficient to avoid infringement of a Swiss form claim, notwithstanding that a significant proportion of such

product will likely end up being used for the indication that is omitted from the package insert.

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Lord Sumption suggests that the solution for the policing of second medical use claims endorsed by Mr Justice Arnold, namely that, as he ordered in this case, Clinical Commissioning Groups should issue instructions that for the patented indication the drug should be prescribed with reference to the brand name of the originator, so that other manufacturers' drugs are not dispensed, is not the way forward, stating "It is by no means clear that it will always be appropriate to meet problems arising in relation to second medical use patents by guidance of this kind." He also observed "What is, however, clear is that whatever steps are taken to limit the leakage of generic pregabalin into the patent-protected market, it is foreseeable that some generic pregabalin will be supplied in good faith by pharmacists to meet prescriptions which are intended by the prescribing doctors for the treatment of neuropathic pain."

Lord Briggs and Lord Hodge took a completely different view. They aligned with the initial view of Arnold J in his interim decisions that the test is whether the alleged infringer subjectively intended to target the patent-protected market – in the present case there was no subjective intent, and therefore likewise no infringement.

Lord Mance, who would have had the deciding "vote", had the infringement question not been obiter anyway, expressed a middle ground position with some hesitation. His speech aligns more with the "outward presentation" test put forward by Lord Sumption, but with the caveat that "there might be some circumstances in which a generic manufacturer could or should be expected to go further, by a notice positively excluding the patent-protected use."

Outlook

Both Actavis and NHS England received a cross-undertaking in damages from Pfizer at the time that the Patents Court ordered the prescribing guidance to be issued. The patent being held invalid, that guidance should not have been issued, and pregabalin should have had the right to be prescribed and dispensed generically at all times since generic versions were available. It is to be expected that there will be claims against Pfizer for the losses incurred as a result of the excess prescription costs to the NHS, and the loss of sales for Actavis. These excess prescription costs are estimated at over £500m.

By Darren Smyth