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UK Supreme Court approves 'Skinny Labelling'

The UK's highest court has held that patents directed towards new medical uses for known products must disclose some sound scientific reasoning or directly relevant experimental evidence in support of the claimed use. The test for infringement of such patents is likely to depend primarily on the objective appearance and presentation of an allegedly infringing product, and in particular whether the product is presented as suitable for the patented use. However a number of questions are left unanswered, and this judgment is unlikely to be the final word on the tricky issue of infringement of second medical use patents.

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Court approves 'Skinny Labelling'

The UK Supreme Court has now ruled on the appeal in *Warner-Lambert v Generics UK (trading as Mylan) and Actavis*. The full judgement can be read here. The hearing was held in February 2018 and the Court's judgement has been eagerly awaited as it is the first time the concepts of sufficiency and infringement as applied to 2nd medical use claims have been considered in the UK's highest Court. The judgement is also the first concerning the common practice of so-called 'skinny labelling'.

The case is concerned with Warner Lambert's product Lyrica ® (pregabalin) which is authorised for the treatment of peripheral neuropathic pain, central neuropathic pain, epilepsy, and generalised anxiety disorder (GAD). Its largest market is neuropathic pain. In the patent, Claim 1 is directed to the use in treating pain *per se*, Claim 2 is directed to inflammatory pain and Claim 3 is directed to neuropathic pain. In the proceedings, Warner-Lambert claimed against Actavis for infringement of Claims 1 and 3, Generics UK and Actavis had sought revocation of the patent.

Skinny Labelling

The Summary of Product Characteristics (SmPC) describes how to use a medicine which has obtained regulatory approval in Europe. The document includes a section listing the medical conditions for which the medicine is authorised for use. It is not unusual for several conditions to be listed and they can, condition by condition be covered by several different patents, and some conditions may be covered by no patent. It is standard practice for companies to make generic versions of drugs after the original compound patent has expired. Where a 2nd medical use patent is still in force, the SmPC on the generic product may be amended to remove the text relating to any patented use, and thus seek to avoid infringement. This is referred to as 'skinny labelling'. Usually the medical use removed is of low commercial value and the Patentee does not take any action against the company selling the generic version. In the case of pregabalin, the compound had previously been known as an anticonvulsant (and therefore used in the treatment of epilepsy), the patent in suit is a later patent filing directed to the use in pain, including neuropathic pain.

The issue, in the present case, is that neuropathic pain represents the largest commercial market for pregabalin. Therefore, Warner Lambert took legal action against Actavis for infringement of this second medical use patent, even though the neuropathic pain indication had been removed from Actavis's SmPC. Warner Lambert asserted that Actavis knew that their product would

be used for neuropathic pain and therefore removing the text from the SmPC did not circumvent liability for the infringing activity.

Even though the Supreme Court ruled that the claims in suit are invalid for lack of sufficiency (see below) the Court went on to consider the infringement question. In the decision the Supreme Court considered both direct and indirect infringement.

Direct infringement

With respect to direct infringement, the five membered Court, by a 4/1 majority decision ruled that, if the claims had been found sufficient, there would have been no infringement. Interestingly, the four Justices differed in their reasons for finding non-infringement. Lord Sumption, who wrote the leading judgement, and Lord Reed ruled that an 'outward presentation test' should be applied to the question of infringement, i.e. the intention of the alleged infringer was irrelevant and the sole criterion is whether the product, as it emerges from the manufacturing process, including any labelling, formulation, dosage or accompanying leaflet, is presented for the uses which enjoy patent protection. Lord Sumption, in his judgement, acknowledged that this was not perfect but ruled that this struck the balance between 'a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties' as required by the Protocol on the interpretation of Article 69 of the European Patents Convention. Lord Hodge and Lord Briggs, on the other hand, preferred the view that the test is whether the alleged infringer subjectively intended to target the patent protected market. Lord Mance, who regarded his comments as 'obiter' agreed the infringement test depended on the objective appearance and characteristics as prepared but left open the possibility that the context may make it obvious that these are not to be taken at face value, stating:

"It may be going too far in favour of generic manufacturers to suggest as an absolute rule that a generic product, prepared, presented and put on the market, must always be viewed in isolation by reference only to its own packaging and instructions, and without regard to the realities or of the market for which it is prepared and into which it is being released."

Indirect infringement

'Indirect infringement' is concerned with the position where a person incurs liability for infringement by knowingly supplying to a primary infringer the means of putting the invention into effect. In the present case, the Supreme Court stated that it was unnecessary to explore in detail what this entails. This case concerned a so-called 'Swiss-type claim', i.e. a claim with the general format:

> Use of 'Compound A' for the manufacture of a medicament for the treatment of 'Disease X'

The court decided that the invention is the manufacture of pregabalin for the designated use and not the subsequent use of the product for treating patients. Therefore, there was no indirect infringement. It will be interesting to see how the courts apply this decision to the newer format used in Europe for 2nd medical use claims, i.e.

> 'Compound A for use in the treatment of Disease X'.

Lord Briggs in his section of the judgement referred to 'Swiss-type' claims as a 'closed class', suggesting that further consideration of infringement of 2nd medical use claims in the new format will be required by the courts.

Sufficiency

The sufficiency requirement is that the 'specification shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by the person skilled in the art' [Section 14, UK Patents Act 1977]. This requirement goes to the heart of the 'patent bargain' where the inventor receives a time-limited monopoly in return for disclosing the invention fully to the public. The Supreme Court observed that it had been the contribution of judges to work out the principles of how this provision should be applied to 2nd medical use claims. With a 2nd medical use claim, the skilled man can make the drug product and therefore, he is able to 'practice' the invention. Therefore, if Section 14 is read literally it would allow patents to be obtained on a wholly speculative basis. Thus, the courts have decided, with respect to 2nd medical use claims, that the patentee must also disclose some evidence for regarding this assertion as "plausible".

The Supreme Court regarded this a 'low threshold test'. In the leading judgement Lord Sumption argued that the plausibility had to be satisfied by the disclosure in the specification not from common general knowledge alone. The Supreme Court also stated that this requirement did not require experiments in humans and could be demonstrated in the specification without experimental evidence, if there is no substantial doubt about the theoretical case made for the efficacy of the invention. In the present case the Supreme Court ruled that Claim 1 (directed to pain) and Claim 3 (directed to neuropathic pain) were insufficient since the experimental data provided

did not demonstrate a broad pain indication or a broad use in any neuropathic pain. However, the Court was divided in how the plausibility test should be applied. Lords Sumption, Reed and Briggs found that claims to both peripheral neuropathic pain and central neuropathic pain to be insufficient. However, although Lords Hodge and Mance found the claim to neuropathic pain *per se* to be insufficient, they found that a claim to peripheral neuropathic pain would be sufficient. Although the Supreme Court envisaged a medical use application could be 'sufficient' with no experimental evidence in the application, in the present case there was not uniform agreement across the Justices as to whether claims in the current case were sufficient for 'peripheral neuropathic pain'. Therefore, this author is of the view that having no experimental evidence should only be considered as a last resort and '*in-vitro*' studies with a clear link to the claimed disease should be considered to be the minimum necessary to support a 2nd medical use patent filing.

Amendment ('Abuse of Process')

In the decision of the High Court, Mr. Justice Arnold ruled that Claim 3 (neuropathic pain) was insufficient. In response to this, about 3 weeks after the judge had handed down the judgement, Warner Lambert applied to the court to amend Claim 3. The judge refused his discretion to amend on the ground that the amendment would require a further trial and the amendment should have been made before or during the first instance proceedings. The Court of Appeal and Supreme Court were unanimous in upholding the decision, stating that the late amendment would be an 'abuse of process'.

Comment

This is a welcome decision for companies who manufacture generic versions of pharmaceuticals since it, in effect, approves the 'skinny labelling' approach and puts a high degree of importance on the packaging and leaflets when considering infringement of a 2nd medical use patent. However, there was no majority agreement from the Justices on the test for infringement for a medical use claim.

Two of the Justices proposed the 'outward presentation test', two of the Justices disagreed and stated that the intention of the alleged infringer had to be considered and the other Justice broadly supported the 'outward presentation test' but wanted to leave the test open since it may not always be as simple as just looking at the packaging, documentation etc.

Therefore, it appears The Supreme Court has not yet set a precedent on this point. It should also be noted that the case relates to 'Swiss-type' claims and therefore, the present decision may be of limited use when considering the infringement test for the newer medical use language now used in European patent filings. ■