

OFFICE OF THE DIRECTOR GENERAL

Bayer Schering Pharma Aktiengesellschaft
{formerly Bayer Healthcare AG},
Appellant,

-versus-

Pharmasia-Cuvest, Inc.
Appellee.

Appeal No. 14-09-18

Inter Partes Case No. 11-2007-00117 Petition
for Cancellation
Patent No. 26419
Date Issued: 15 July 1992
For: Infusion Solutions of 1-Cyclopropyl
6-Fluoro-1,4 Dihydro 4-Oxo-7
(1-Piperazine-Zinyl)-Quinolone-3-
Carboxylic Acid

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DECISION

Bayer Schering Pharma Aktiengesellschaft {formerly Bayer Healthcare AG} ("Appellant") appeals Decision No. 2009-01 dated 25 January 2009 issued by the Director of the Bureau of Legal Affairs ("Director") canceling the registration of the Appellant's Letters Patent No. 26419 for "Infusion Solutions of 1-cyclopropyl-6-fluoro-1, 4-dihydro-4-oxo-7-(1-piperazine-zinyl)-quinolone-3-carboxylic acid".

Records show that on 15 July 1992, the Appellant was issued Letters Patent No. 26,119. On 03 May 2007, the Pharmasia-Cuvest, Inc. ("Appellee") filed a "PETITION FOR CANCELLATION OF LETTERS PATENT NO. 26419" claiming that the invention is not novel and/or lacking in inventiveness and is identical to the subject matter of Letters Patent No. 24099, which is the "infusion solutions to address the instability of ciprofloxacin." According to the Appellee, Letters Patent No. 24099 was granted on the basis of an application that was filed on 17 September 1984 which is earlier than the filing date of the corresponding application of Letters Patent No. 26419 which was filed on 23 October 1986.

The Appellee submitted the following evidence to support its petition:

1. Affidavit of Jorge Cesar M. Sandiego, executed on 25 April 2007;¹
2. Letters Patent No. 26419;²
3. Letters Patent No. 24099;³ and
4. Curriculum Vitae of Jorge Cesar M. Sandiego.⁴

The Appellant filed an "ANSWER" on 03 October 2007 alleging that the petition is already barred by *laches* under Sec. 28 of Rep. Act No. 165,⁵ which allows a maximum period of three (3) years from the date of publication of the issuance of the patent within which a petition for the cancellation of a patent or any claim thereof must be filed. The Appellant contended that while *ciprofloxacin* may be known in the art, a subsequent composition claim or claims containing *ciprofloxacin* in combination with other elements based on a distinct and different inventive concept can qualify as novel and inventive. The Appellant asserted that Letters Patent No. 24099 addresses the problem of instability while its invention addressed, among other things, the problem of toxicity. According to the Appellant, there is no equivalence in term of scope, inventive concept or teaching between the claims or claimed invention of its patent and those of Letters Patent No. 24099 and that the validity of its patent has been affirmed in other jurisdictions. The Appellant further claimed that the Appellee is seeking relief in bad faith because it knew of the existence of the Appellant's patent, and yet, without awaiting the final resolution on the issue of the validity of this patent, it embarked on selling products covered by the Appellant's patent.

The Appellant's evidence consists of the following:

1. Copy of the Federal Court judgment in Canada between Bayer Ag, Bayer Healthcare AG and Bayer, Inc. and Novopharm Limited and The Minister of Health, dated 24 March 2006;⁶
2. Canadian Patents Nos. 1,228,547 and 1,282,006;⁷
3. Affidavit of Dr. Luis Abola, executed on 28 September 2007;⁸
4. Affidavit of Rosella L. Fernandez (with annexes), executed on 03 October 2007.⁹

In canceling the registration of Letters Patent No. 26419, the Director ruled that the invention is not inventive and is within the knowledge of a person skilled in the art. Further, the Director ruled that Patent No. 26419 is not novel as it is already the subject of an earlier issued patent. She also held that the decision in the court of Canada cited by the Appellant refers to a different patent.

Dissatisfied, the Appellant filed on 04 March 2009 a "NOTICE OF AND MEMORANDUM ON APPEAL (WITH PRAYER TO RESTRAIN EXECUTION OF THE DECISION)" reiterating its arguments in the Bureau of Legal Affairs. The Appellant claims that its patent had passed the patent examination and enjoys a presumption of novelty while the Appellee has not presented a clear demonstration that the invention is not novel. According to the Appellant, at the time it filed its patent application, there was no public knowledge of the specific formulation and permutation of the composition covered by the application. The Appellant asserts that the immediate execution of the assailed decision should be restrained.

The Appellee filed its comment alleging that the petition was properly filed and that Letters Patent Nos. 24099 and 26419 both refer to "infusion solutions". According to the Appellee, the invention is not inventive and within the skill of person skilled in the art.

This Office noted that this case stems from a petition to cancel Letters Patent No. 26419. The term of protection of this patent, however, expired last 15 July 2009.¹⁰ Accordingly, the expiration of the term of protection of the Appellant's patent has rendered the petition to cancel this patent moot and academic. There is no more actual case or controversy which this Office must adjudicate. In one case, the Supreme Court has ruled that:

"For a court to exercise its power of adjudication, there must be an actual case or controversy - one which involves a conflict of legal rights, an assertion of opposite legal claims susceptible of judicial resolution; the case must not be moot or academic or based on extra-legal or other similar considerations not cognizable by a court of justice. A case becomes moot and academic when its purpose has become stale, such as the case before us.¹¹

This Office, thus, deems it unnecessary to pass on the other arguments raised by the parties.

WHEREFORE, premises considered, the instant appeal is hereby DISMISSED. Let a copy of this Decision as well as the records be furnished and returned to the Director of the Bureau of Legal Affairs for appropriate action. Further, let also the Director of the Bureau of Patents and the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this Decision for information, guidance, and records purposes.

SO ORDERED

April 07, 2011, Makati City

RICARDO R. BLANCAFLOR
Director General

¹ Exhibit "A".

² Exhibit "B".

³ Exhibit "C".

⁴ Exhibit "D".

⁵ AN ACT CREATING A PATENT OFFICE, PRESCRIBING ITS POWERS AND DUTIES, REGULATING THE ISSUANCE OF PATENTS, AND APPROPRIATING FUNDS THEREFOR.

⁶ Annex "A".

⁷ Annexes "A-1" and "A-2".

⁸ Annex "B".

⁹ Annex "C".

¹⁰ Under Sec. 21 of Rep. Act No. 165, the law in force at the time Letters Patent No. 26419 was issued, the term of a patent shall begin on the date when the patent is issued as shown on the face thereof and shall expire seventeen (17) years thereafter.

¹¹ *Dean Jose Jaya, et al. vs. Presidential Commission on Good Government, et al.*, G. R. No. 96541, 24 August 1993.