

UNITED LABORATORIES, INC.,
Petitioner,

INTER PARTES CASE NO. 2066

PETITION FOR COMPULSORY
LICENSING

- versus -

Letters Patent No. 10264
Issued : January 18, 1977
Assignee : Glaxo Laboratories,
Ltd.
For : 9 α , 21-DIHALO-16
METHYL OR-
METHYLENE-17 α
ACYLOXY-3, 20- DIKETO-
11-OXYGENATED
 Δ^4 OR $\Delta^{1,4}$ -
PREGNANES

GLAXO LABORATORIES, LTD.,
Respondent-Patentee.
x-----x

DECISION NO. 88-6 (PAT.)
February 2, 1988

DECISION

The above-captioned case pertains to a Petition for Compulsory Licensing filed by United Laboratories, Inc. praying that it be granted a compulsory license under Letters Patent No. 10364 issued on January 18, 1977 to Joseph Elks, Gordon Hanley Philipps and Peter John May, assignees to Glaxo Laboratories Ltd., for 9 α , 21- DIHALO-16 METHYL OR-METHYLENE-17 ACYLOXY-3, 20 DIKETO-11-OXYGENATED Δ^4 OR $\Delta^{1,4}$ -PREGNANES.

The records of the case show that Petitioner is a corporation duly organized and existing under the laws of the Republic of the Philippines, with principal offices at 66 United Street, Mandaluyong, Metro Manila, Philippines, while Respondent-Assignee is a British company, with principal offices at No. 60 Rydal Gardin, Wembley, Middlesex, England, which may be served with processes through its Philippine attorney of record, Messrs. Siguion Reyna, Montecillo & Ongsiako, whose office is at A. Soriano Building, 8776 Paseo de Roxas, Makati, Metro Manila, Philippines.

The grounds for the Petition for Compulsory Licensing are:

“That the patented invention relates to medicine (Sec. 34/e/, Republic Act 165, as amended by Presidential Decree No. 1263.)”

Petitioner relied on the following facts to support its Petition:

“1. Philippine Patent No.10364 herein sought to be licensed was granted on January 18, 1977, more than two (2) years prior to the filing of this petition.

2. Philippine Patent No. 10364 relates to anti-inflammatory steroids of the pregnane series, including the compound clobetasol propionate specifically claimed in Claim 18, which are useful as medicines.

3. Petitioner is a domestic corporation with an authorized capital stock of P1, 500,000,000 and has been in the business of manufacturing and selling pharmaceutical products since its incorporation on October 8, 1953.

4. Petitioner possesses the financial, technical and manpower capability to make use of the patented compounds in raw material form, in the manufacture of useful products in pharmaceutical dosage forms.”

A letter enclosing a Notice of Filing for publication in a newspaper of general circulation in the country three (3) times for three (3) consecutive weeks was sent by this Office to the Petitioner by registered mail on July 6, 1987, and a Notice to Answer dated July 3, 1987 was sent to Respondent-Patentee, c/o Messrs. Siguion Reyna, Montecillo & Ongsiako, Respondent's counsel of record, which was received on July 7, 1987.

On July 15, 1987, a Motion for Extension of Time to File Answer requesting an additional period of thirty (30) days from July 22, 1987 within which to file Respondent's Answer was filed by Messrs. Siguion Reyna, Montecillo & Ongsiako, counsel of herein Respondent, and Order No. 87-157 was issued by this Bureau on July 20, 1987 granting said Motion. However, on August 24, 1987, with the prior knowledge and con-sent of Respondent-Patentee, a Notice of Withdrawal as counsel was filed with this Bureau, which Notice was noted and made of record under Order No. 87-196 dated August 27, 1987.

On August 12, 1987, a Manifestation submitting the Affidavit of the Publisher certifying that the Notice of Filing of the Petition for grant of compulsory license as required by the provisions of Section 34-E(2) of Presidential Decree No. 1263 has been effected.

An Appearance in lieu of the former counsel with a Motion for Extension of Time to File Answer was filed by Messrs. Castillo, Laman, Tan & Pantaleon, which Appearance and Motion were simultaneously acted upon under Order No. 87-200 dated September 4, 1987.

Respondent-Patentee, through counsel, filed its Answer on September 4, 1987 specifically denying all the allegations of the Petition and raising certain issues as affirmative allegations and alternative/special defenses.

This case was thereafter set for pre-trial conference on October 6, 1987 at 9:00 A.M. However, on the supposed date of pre-trial conference, counsel for the Petitioner filed a Motion to Dismiss, the contents of which are quoted hereunder:

“Petitioner thru counsel respectfully prays that the above-entitled case be dismissed with prejudice.”

WHEREFORE, finding the Motion to Dismiss to be in order and not contrary to law, morals or public policy, nor does it contravene any existing rule or regulation by this Office, the said Motion is hereby GRANTED and, accordingly, Inter Partes Case No. 2066 is, as it is hereby, DISMISSED, with prejudice.

SO ORDERED.

IGNACIO S. SAPALO
Director