

BIOTECCanada Successfully Intervenes in Supreme Court Case Upholding the Validity of Selection Patents

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In the recent case of *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, the Supreme Court of Canada considered the validity of selection patents, an important instrument for the protection of beneficial technological advances, especially in the pharmaceutical and biotechnology industries. A selection patent is a patent over one or more members selected from a class of compounds which was the subject of an earlier patent. The selection arises from the discovery of an unexpected property in the selected member(s). Selection patents provide an incentive for researchers to examine a known class of compounds to look for a compound having special advantages.

In making its appeal to the Supreme Court, Apotex, a generic drug company, took the position not only that the particular selection patent at issue (a patent for the anti-clotting drug Plavix made by Sanofi) was invalid, but that selection patents by their very nature are inherently invalid and should be abolished.

BIOTECCanada, represented by Torys LLP, applied for and was granted intervener status to make written and oral submissions to the court regarding the importance of selection patents to the biotechnology industry and to the promotion of innovation.

The case was heard in April of last year in front of a courtroom packed with members of industry, patent law specialists and the media. The Supreme Court released its decision in November of last year, refusing Apotex's appeal and upholding the validity of selection patents.

The court held that a selection patent "does not in its nature differ from any other patent" and its validity should be determined by the usual criteria under the *Patent Act*. The court held that a new class member with special advantages can be patented and noted the importance of providing economic encouragement for research and development, particularly in fields of pharmaceuticals and biotechnology. In the course of considering the validity of selection patents, the court also refined and commented on the basic tests for patentability, including modest amendments to the questions of obviousness and novelty.