



Rx IP UPDATE

CANADIAN PHARMACEUTICAL INTELLECTUAL PROPERTY LAW NEWSLETTER

1

Court Summarily
Dismisses
Prohibition
Proceeding in View
of Previous
Proceeding
Involving Different
Patent

Patented Medicines
Prices Review
Board (PMPRB)
Matters

2

Recent Court
Decisions

3

New Court
Proceedings

Court Summarily Dismisses Prohibition Proceeding in View of Previous Proceeding Involving Different Patent

In a February 16, 2006 decision relating to the medicine fenofibrate (LIPIDIL SUPRA) (*Fournier v. Cipher*, 2006 FC 208), a Prothonotary summarily dismissed a prohibition proceeding pursuant to section 6(5)(b) of the *Patented Medicines (Notice of Compliance) Regulations* ("Regulations"). That section permits a Court to dismiss a prohibition proceeding "on the ground that the application is redundant, scandalous, frivolous or vexatious or otherwise an abuse of process".

In a previous proceeding between the same parties involving a different patent (475), the Court determined that Cipher's allegation of non-infringement was justified, and the decision was affirmed on appeal. In a subsequent proceeding relating to the same product but a different patent (576), Cipher again alleged non-infringement. Fournier commenced a prohibition proceeding and Cipher brought a motion for summary dismissal. The Prothonotary dismissed Fournier's application, finding that issue estoppel applied, including on the basis that "there has been a disposition of the legal issues relating to the essential elements of the 475 Patent which are the same in the 576 Patent" and that there was no basis for the Court to exercise its discretion to permit the proceeding to continue to a hearing on its merits.

Patented Medicines Prices Review Board (PMPRB) Matters

The Patented Medicines Prices Review Board will hold a public hearing on June 7, 2006 to determine whether Janssen-Ortho is selling or has sold RISPERDAL CONSTA (risperidone) in any market in Canada at a price that is or was excessive and, if so, what order (if any) should be made. A pre-hearing conference will be held on April 21, 2006.

Notice of Hearing

The PMPRB will hold a public hearing on May 19, 2006, to determine whether 3M Canada is selling or has sold AIROMIR (inhaler) in any market in Canada at a price that is or was excessive and, if so, what order (if any) should be made.

Notice of Hearing

Recent Court Decisions

Patented Medicines (Notice of Compliance) Regulations

Abbott v. Pharmascience (clarithromycin (BIAXIN BID)), February 2, 2006

Judge dismisses Abbott's application for an Order of prohibition, finding that use of a claimed product during production as an intermediate is not infringement for the purpose of the Regulations.

Full Judgment (2006 FC 120)

Apotex v. Syntex and Roche (naproxen slow-release (NAPROSYN SR)), February 9, 2006

Court of Appeal dismisses Syntex and Roche's appeal of a Judge's decision. The Judge had affirmed a Prothonotary's dismissal of a motion to strike the patentee Defendant Syntex from a section 8 damages action brought by Apotex.

Court of Appeal Decision (2006 FCA 60)

Motions Judge's Decision (2005 FC 1310)

Prothonotary's Decision

Pfizer v. Canada (Minister of Health and Attorney General) (amlodipine besylate (NORVASC), amlodipine besylate/atorvastatin calcium (CADUET)), February 16, 2006

Judge dismisses Pfizer's application for judicial review of the Minister's refusal to add Pfizer's patent to the Patent Register. The Minister had rejected the patent for listing in connection with NORVASC and CADUET on the basis that the patent excludes amlodipine besylate alone and the combinations exclude atorvastatin.

Full Judgment (2006 FC 210)

Pfizer v. Ratiopharm (amlodipine besylate (NORVASC)), February 17, 2006

Judge dismisses Pfizer's application for an Order of prohibition, finding the patent is not a valid selection patent and that Pfizer had failed to disprove Ratiopharm's allegation of invalidity for obviousness double patenting.

Full Judgment (2006 FC 220)

New Court Proceedings

Patented Medicines (Notice of Compliance) Regulations

Medicine: **quinapril hydrochloride/hydrochlorothiazide (ACCURETIC)**
Applicants: Pfizer Canada Inc and Parke, Davis & Company LLC
Respondents: Novopharm Ltd and The Minister of Health
Date Commenced: February 3, 2006
Comment: Application for Order of prohibition until expiry of Patent No 1,341,330. Novopharm alleges invalidity.

Medicine: **quinapril hydrochloride (ACCUPRIL)**
Applicants: Pfizer Canada Inc and Parke, Davis & Company LLC
Respondents: Novopharm Ltd and The Minister of Health
Date Commenced: February 3, 2006
Comment: Application for Order of prohibition until expiry of Patent No 1,341,330. Novopharm alleges invalidity.

Medicine: **venlafaxine hydrochloride (EFFEXOR XR)**
Applicants: Wyeth Canada and Wyeths
Respondents: Ratiopharm Inc and The Minister of Health
Date Commenced: February 10, 2006
Comment: Application for Order of prohibition until expiry of Patent No 2,199,778. Ratiopharm alleges non-infringement and invalidity.

Medicine: **galantamine hydrobromide (REMINYL)**
Applicants: Janssen-Ortho Inc and Janssen Pharmaceutica NV
Respondents: Ratiopharm Inc and The Minister of Health
Date Commenced: February 10, 2006
Comment: Application for Order of prohibition until expiry of Patent No 2,310,950. Ratiopharm alleges non-infringement and invalidity.

Medicine: **galantamine hydrobromide (REMINYL)**
Applicants: Janssen-Ortho Inc and Janssen Pharmaceutica NV
Respondents: Novopharm Limited and The Minister of Health
Date Commenced: February 10, 2006
Comment: Application for Order of prohibition until expiry of Patent No 2,310,950. Novopharm alleges non-infringement and invalidity.

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Other Proceedings

Subject Matter: polypeptide heterologous to a filamentous fungus
Plaintiff: Novozymes A/S
Defendants: Genencor International, Inc, DSM NV, Altia Group Ltd and Zymogenetics, Inc
Date Commenced: January 25, 2006
Comment: Claim arising from a conflict proceeding in which the Commissioner awarded conflict claims to Genencor. The conflict proceeding related to Patent Applications Nos 532,180, 516,993, 506,712, 527,634 and 535,952.

Medicine: diltiazem hydrochloride sustained release (SANDOZ DILTIAZEM CD)
Plaintiffs: Biovail Corporation and Laboratoires des Produits Éthiques Ethypharm
Defendants: Sandoz Canada Inc, Andrx Corporation and Andrx Pharmaceuticals Inc
Date Commenced: February 3, 2006
Comment: Patent infringement action relating to Patent No 2,111,085.

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