

ARTICLE

A NEW DAMAGES RECORD IN THE FRENCH PEMETREXED CASE: 28 MILLION EUROS

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PROPRIÉTÉ INTELLECTUELLE

Download the judgment - TGI Paris, 3.3., 11 September 2020, Eli Lilly v. Fresenius, RG 17/10421

The patentee (belonging to the Eli Lilly group) had, during prosecution, amended its claims relating to the use of “antifolates” combined with other compounds to inhibit tumour growth to “pemetrexed” (an antifolate). The EPO examiner raised a 123(2) EPC[1] objection on the term “pemetrexed”, and the claims were granted with the term “pemetrexed disodium” instead of “antifolates” [2].

On the **scope of the patent**, the French Court considers that :

(i) the description refers in a general way to antifolates, or to the drug Alimta (pemetrexed disodium). The skilled person knows the active principle is the anion, responsible for both the therapeutic effect and the side effects of the drug : he would understand the invention lies in the combined administration of the active principle, whatever its form, and the other compounds claimed; he would not consider strictly speaking the wording of the claims

(ii) the amendment was made in response to a A123(2) argument, and **was not intended to differentiate from a prior art**

(iii) the invention lies in the combined administration of the active ingredient, whatever its form, with the other substances claimed in the patent.

On the **infringement**: Fresenius uses a diacid solution of pemetrexed, not a pemetrexed disodium. However the Court considers there is **direct infringement**, mostly because, as mentioned above, the claim amendment was not made to differentiate the invention from a prior art, but to answer an A123 argument.

On the **compensation**, the Court sets a new monetary record of **28 million euros** as provisional indemnities: it orders Fresenius to pay

- to Eli Lilly (patentee): 8 million euros as provisional damages to compensate for acts of infringement, based on an increased royalty rate of 25% (instead of the 40% requested by Eli Lilly)
- to Lilly France (distributor, unregistered licensee): 20 million euros as provisional damages to compensate for acts of unfair competition.

The Eli Lilly requests were of 10 million and 30 million €, respectively.

The decision can be appealed.

[1] https://www.epo.org/law-practice/legal-texts/html/caselaw/2019/e/clr_ii_e_1.htm

[2] Other articles about the pemetrexed saga in Europe are available, in particular, on <https://ipkitten.blogspot.com/> or <http://patentblog.kluweriplaw.com/>

