

# Advocate General Jääskinen Gives Georgetown University SPC (Supplementary Protection Certificate) Opinion

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On 14 November 2013, **Advocate General (AG) Jääskinen's** opinion in the Dutch **supplementary protection certificate (SPC)** referral, *Georgetown University* (C-484/12), was released. AG Jääskinen declined to answer the question of whether or not more than one SPC can be granted in relation to the same basic patent. He did, however, advocate that a patent holder should be afforded the choice of which SPC application should proceed when multiple applications are pending simultaneously, and should be able to surrender previously granted SPCs in order to have another granted.

## BACKGROUND

The District Court of The Hague made the Georgetown University reference on 12 October 2012 in respect of a patent protecting four types of human papillomavirus (HPV) (the patent). Georgetown University sought an SPC for HPV16 under the patent. It had, however, previously obtained other SPCs under the patent for a combination of HPV16 and HPV18 and separately for a combination of HPV6, HPV11, HPV16 and HPV18.

The Dutch Patent Office refused the application for an SPC for HPV16, following comments made by the CJEU in respect of Article 3(c) of Regulation 469/2009 (the SPC Regulation) in *Medeva* C-322/10, that only one SPC could be granted per basic patent.

In light of *Medeva* and the historical practice of patent offices across the European Union in granting more than one SPC per patent, the Dutch Court was of the opinion that the correct application of Article 3(c) of the SPC Regulation was not free from doubt. The Dutch court therefore made a reference to the CJEU for clarification as to whether or not the SPC Regulation only permits one SPC per patent and whether or not it is permissible to surrender earlier SPCs to allow the grant of a later one.

## DECISION

AG Jääskinen chose not to analyse the issue of the number of SPCs allowed per patent under Article 3(c) of the SPC Regulation. In his estimation, the views expressed by AG

Trszenjak in respect of *Medeva* provided adequate material for the CJEU to draw its conclusions on that issue.

AG Jääskinen, assuming that only one SPC can be granted per basic patent, recommended that, where multiple SPC applications are pending in respect of the same basic patent, the patent holder should be expressly afforded the choice of which SPC application proceeds through the competent authority. Should a patent holder decline to elect between co-pending applications, the national authorities will need to proceed as stipulated under national law.

Further, AG Jääskinen advised that a patent holder may surrender an SPC in favour of another SPC with the terms of this surrender being exclusively governed by the SPC Regulation, with no national law control. This surrender should not, however, have retrospective effect, meaning that the product in question will have previously been the subject of an SPC, within the meaning of Article 3(c) of the SPC Regulation, to maintain legal certainty.

## COMMENT

The recommendation that patent holders should have the opportunity to elect between co-pending SPC applications, if they cannot all be granted, will be welcomed by patentees. The recommendation that the surrender of SPCs should not have retrospective effect is perhaps not surprising, but does mean that patent holders should exercise caution in surrender strategies to ensure they are not blocked from securing future SPCs by Article 3(c) of the SPC Regulation.

The AG's opinion is not binding on the CJEU, so patent holders should look out for the final decision on this matter.

*After this publication was finalised, the CJEU decision was handed down. The CJEU's decision will be covered in the next Bulletin.*

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National Law Review, Volume III, Number 352

Source URL: <https://natlawreview.com/article/advocate-general-j-skinen-gives-georgetown-university-spc-supplementary-protection>