Not Clearly Abusive to Assert a Patent Under the New PM(NOC) Regulations After a Loss Pursuant to the Old Regulations

October 25, 2018

***Amgen Inc. v. Pfizer Canada Inc.*, 2018 FC 1078**

In the within action, Pfizer sought to have the proceeding dismissed due to Amgen's prior losses in asserting the 537 Patent under the old PM(NOC) Regulations. Amgen had commenced this action under the new PM(NOC) Regulations,seeking to prevent Pfizer from obtaining its Notice of Compliance for a biosimilar of Amgen's NEUPOGEN.

In three prior proceedings under the old PM(NOC) Regulations, Amgen asserted the 537 Patent in applications against Apotex (twice) and Mylan. In the first Apotex application, the Court found the allegations of obviousness were justified. The second proceeding against Apotex was dismissed as an abuse of process. The application against Mylan was discontinued after Mylan advised that it intended to bring a motion to dismiss the application as an abuse of process.

Pfizer, arguing it could rely on the findings of the earlier applications, brought a motion to have the action dismissed under section 6.08 of the PM(NOC) Regulations as an abuse of process.

The Court declined to dismiss the action. The earlier applications only determined whether the second person's allegations were justified. The validity and/or infringement of the patent was not conclusively determined. Since the new PM(NOC) Regulations allow for patent issues to be adjudicated on a full record with a right of appeal, it was not found to be plain and obvious that the within action should be dismissed.

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