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Board of Appeal finds Swiss-type claims have different scope to EPC 2000 second medical use claims

A decision (T1780/12) from the EPO technical boards of appeal indicates that Swiss-type claims of the form "Use of [product X] in the manufacture of a medicament for the treatment of [disease Y]" provide a different scope of protection than EPC 2000 second medical use claims of the form "[product X] for use in the treatment of [disease Y]".

Swiss-type claims are widely used in European patents directed to new medical indications of known compounds, so this decision could have important implications for the enforcement of many patents in the national courts across Europe.

For policy reasons, European patent law has long prohibited the patenting of methods of medical treatment on the human or animal body. By way of compensation, the law allows for the patenting of known substances or compositions by reference to their first use in any method of medical treatment. This is an exception to the normal principle of European patent law that the intended use of a product does not usually confer novelty to that product. However, the old EPC 1973 made no specific reference to *further* medical uses of existing compounds already known for a medical use. Instead, it had become established practice to claim further medical indications using the Swiss-type claim format set out above.

On the 13th December 2007, the EPC 2000 rectified this situation by introducing specific protection for further medical uses of known products, under new Article 54(5) EPC, via claims drafted in the form "[product X] for use in the treatment of [disease Y]". It was the intention of the legislator that this new form of claim would afford equivalent protection to that of the previous Swiss-type claim. However, doubts remained on a national level about whether or not the intention of the legislator had been fulfilled and this has now been explicitly challenged by the EPO technical boards of appeal in the decision T1780/12.

T1780/12 concerned a case of double patenting. The applicant already owned a granted patent (EP1) containing a Swiss-type claim. They also applied for a divisional application (EP2) containing an EPC 2000 second medical use claim for the same substance and medical indication.

The Examining Division refused EP2 for double patenting, because it considered that an EPC 2000 second medical use claim is directed to the same subject matter as a corresponding Swiss-type claim. They stated that the intention of the EPC legislator was that the two claim formats were equivalent and dismissed the applicant's arguments that the differing scope of the respective claims was relevant.

The Board of Appeal in question disagreed with the Examining Division, reasoning that the subject matter of a claim is determined by its technical features and its category (i.e. whether it is a claim to a product, process, apparatus or use). Considering the categories of the respective claims, the Board held that claim 1 of EP1 (a Swiss-type claim) was a purpose-limited *process* claim, whereas claim 1 of EP2 (an EPC 2000 second medical use claim) was a purpose-limited *product* claim. It followed directly from this that the subject matter of the two claims was different and so the grant of EP2 could not be prevented for double patenting vis-à-vis EP1.

The Board went further and concluded that the difference in subject matter led to a variance in the protection afforded by both formats of claim. According to the Board, since a claim to a particular physical activity (e.g. a method, process or use) confers less protection than a claim to the physical entity *per se*, it followed that a purpose-limited process claim (i.e. a Swiss-type claim) confers less protection than a purpose-limited product claim (i.e. an EPC 2000 second medical use claim).

It is interesting to see an EPO Board of Appeal reach this conclusion, because it goes against the intention of the legislator that EPC 2000 second-medical use claims should afford equivalent protection to that of Swiss-type claims. The Board made a point to highlight that it was only the *intention* of the legislator that the scope of the claims should be the same and it clearly thought that the intention had not been achieved in practice.

From an enforcement perspective, the scope of protection of these claims may not be the only difference. The UK Patents Act defines the meaning of infringement differently where the invention is a product compared to a process. Given that the EPO boards of appeal have explicitly classified Swiss-type claims as process claims and EPC 2000 second medical use claims as product claims, this could lead to a divergence in the enforcement of EPC 2000 second medical use claims and Swiss-type claims under the UK Patents Act and potentially the national law of other European states.

Following the Board's logic, an EPC 2000 second medical use product claim would be directly infringed by dealings in the product itself (though it would also be necessary to show that the product was intended for use in the specified medical treatment). However, by the same logic, a Swiss-type process claim would only be directly infringed by manufacturing the claimed medicament in the UK, or in dealing with the medicament *obtained directly by means* of the claimed process. Quite how this distinction will manifest itself in practice will be a matter of great interest to those in the pharmaceutical sector.

As such, we continue to recommend that EPC 2000 second medical use claims are included in pending applications wherever possible, alongside Swiss-type claims. For granted patents, it is unlikely that Swiss-type claims can be converted into EPC 2000 second medical use claims, because, according to the Board, this would lead to an impermissible extension of the scope of protection afforded by the patent. However, where a pending divisional application exists, T1780/12 provides comfort that EPC 2000 second medical use claims pursued in the divisional would not conflict for double patenting with a corresponding Swiss-type claim in a granted parent patent.

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