



NEWSLETTER



Enlarged Board of Appeal of EPO announces new decision on claims directed to the use of substances/compositions in therapy

On February 19, 2010 the Enlarged Board of Appeal issued a decision under case no. G 02/08. The decision contains important guidelines regarding the drafting of patent claims related to the use of a substance or composition in methods for the treatment of the human or animal body by therapy.

The decision contains answers to the following questions:

1. **A** Where it is already known to use a particular medicament to treat a particular illness, can this known medicament be patented under the provisions of Art. 53(c) and 54(5) EPC 2000 for use in a different, new and inventive treatment by therapy of the same illness?
1. **B** If yes, is such patenting also possible where the only novel feature of the treatment is a new and inventive dosage regime?
2. Are any special considerations applicable when interpreting and applying Art. 53(c) and 54(5) EPC 2000?

The Enlarged Board of Appeal answered question 1 as follows: where it is already known to use a medicament to treat an illness, Article 54(5) EPC 2000 does not exclude that this medicament be patented for use in a different treatment by therapy of the same illness. It was further concluded that such patenting is also not excluded where a dosage regime is the only feature claimed which is not comprised in the state of the art.

Regarding the second question the Enlarged Board of Appeal pointed out that where the subject matter of a claim is rendered novel only by a new therapeutic use of a medicament, such claim may no longer have the format of a so-called Swiss-type claim as instituted by decision G 05/83.

That is to say, the use of a substance or composition for treatment in therapy from now on has to be claimed in line with Art. 54(5) EPC by using the claim

format of: "Substance/Composition X for use in the treatment of disease Y...". The new decision further allows adding elements of the treatment by therapy, such as a dosage regimen, to the claim format of Art. 54(5) EPC.

It is important to note that the Enlarged Board of Appeal has set a time limit of 3 months after publication of the present decision in the Official Journal of the European Patent Office in order that future applicants comply with this new situation. In any case, it is advisable to use the correct claim format under Article 54(5) EPC from now on. This recommendation is in line with our usual claim drafting practice.

For more information, please contact our office.



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