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February 2010

The EPO Enlarged Board Maintains the Status Quo for Second Medical Uses

The European Patent Convention (EPC) does not allow the patenting of methods of therapy. The legislators did not want patents to stop physicians treating patients.

To balance this exception, the original EPC stated that an applicant could claim a product (a substance or composition) for the first use in therapy, even if the product was already known. However, it did not explicitly allow an applicant to claim a product for a second, different medical use. The Enlarged Board of Appeal (EBA) addressed this in G5/83. It decided that second and subsequent medical uses could be patented, using the artificial "Swiss type" claim. This claim read, "Use of product X for the manufacture of a medicament for treatment of Y."

The wording of the EPC 2000 changed, in the light of this decision. Under the new convention, a product could be patented for any medical use, not merely the first one.

Uncertainty remained regarding the subsequent use that might be patentable. The EBA has addressed this issue, in decision G2/08.

The decision does not change a great deal. The EBA decided that the majority of existing case law was correct, and that a second medical use could be claimed if it was novel and inventive over the first. There are no other limitations on how the second medical use should differ from the first.

The EBA held that, in Europe, if a product is known to treat a disease, an applicant can claim that product to treat the same disease, using different dosage regimens, modes of administration or patient groups. All that is required is that the distinction from the known treatment is inventive.

The EBA also abolished the "Swiss type" claim. No application may have "Swiss type" claims if it has a priority or filing date three months after the decision is published (yet to happen). G2/08 has rendered this claim form redundant.

Finally, the EBA made the observation that there must be a complete fit between allowable methods and products for use in unallowable methods. Therefore, if the EPO argues that any invention is a method of therapy using a product, that invention must be able to be claimed, as the product "for use" in that method.

This decision does not substantially change the established case law. However it clarifies that applicants are allowed claims to second medical uses, distinguished by features other than the disease being treated. We expect that the decision will make prosecution of those claims less difficult than previously.