

The “subject matter” of a double patenting objection

EPO Board of Appeal decision T1780/12 recently provided us with some guidance as to the extent to which medical use claims can be objected to under the double patenting provisions.

The facts

The decision concerned the interplay between European Patent Application No. 04007843.8 (EP2) and its granted parent, European Patent No. 1096955 (EP1).

EP1 granted with Swiss-type claims (G5/83) i.e. "*The use of X in the manufacture of a medicament for the treatment of disease Y*".

The claims of EP2 were drafted in accordance with Article 54(5) EPC i.e. "*X for the treatment of disease Y*".

Following oral proceeding and by way of a decision dated 27 March 2012, EP2 was refused by the Examining Division (ED) on the grounds that the respective claims covered the "**same subject matter**", which gave rise to a double patenting objection. Incidentally, the composition of the ED was expanded to include a legal member.

In support of their decision, the ED latched onto the then version of the Guidelines for Examination (C-VI, 9.1.6 and C-IV, 7.4) and stated that:

*"It is established practice of the EPO first instance departments not to allow that two applications (or a granted patent and an application) from the same applicant claim the **same subject matter**. This means not only that the conflicting applications must not contain claims of substantially identical scope, but also that one application must not claim the subject matter claimed in the other, even in different words. The difference between the claimed subject matter must be clearly distinguishable."*

On citing G1/05 and G1/06, the ED stated that the refusal of a patent application on the grounds of double patenting was justified because the applicant had no legitimate interest in securing grant for a second patent directed to the "**same subject matter**". The ED held that:

"A claim directed to a second or further medical use claim under Article 54(5) EPC is considered to be directed to the same subject matter as a Swiss type claim"

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directed to the same medical use in the sense that both these claims concern the same invention claimed in a different format."

The ED held that double patenting is concerned with the substantial identity of the claimed subject matter and had nothing to do with the scope of protection conferred by the respective claims.

The ED also argued that the preparatory documents which discussed the intended effect of Article 54(5)EPC 2000 supported their position that the respective claim formats were equivalent.

The Board of Appeal

The Board of Appeal after considering the Grounds of Appeal filed by the appellant overturned the ED's decision. The Board's reasoning was as follows:

On considering the portions of the Guidelines cited by the ED and the obiter dictum cited in G1/05 and G1/06, the Board accepted that an objection could arise if the respective claim sets claimed the "**same subject matter**".

On making reference to G2/88, the Board held that the category of a claim and its technical features constitute its **subject matter** and determines the protection conferred by the claim. With that said, the Board concluded that just because the claims covered the same invention, the therapeutic use of X, did not mean that they covered the same subject matter.

To determine whether the respective claims covered the same subject matter you had to identify and compare the technical features of the claims. To this end, as the claims of EP1 were purpose limited **process** claims whereas the claims of EP2 were purpose limited **product** claims, it was clear that they differed in technical features. The claims of EP1 included the additional technical feature of manufacturing a medicament.

As regards the ED's contention that scope of protection was irrelevant to the present enquiry, the Board disagreed not least because G2/88 made it clear that the claimed subject matter and the scope of protection conferred by a claim are intrinsically linked. On comparing the scope of the respective claims, the Board held that it was clear that the claims of EP2, being purpose limited **product** claims, conferred greater protection than the claims of EP1, which were purpose limited **process** claims.

As a result there was clearly a legitimate interest in having Article 54(5)EPC claims, because they conferred a greater scope of protection.

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As regards the ED's argument that the preparatory documents giving rise to Article 54(5) EPC2000 supported their position, the Board, on reviewing the relevant portion of the preparatory documents, stated that although it might have been the intention of the legislator for claims drafted in accordance with Article 54(5)EPC to match as closely as possible the scope of protection provided by a Swiss type claim it was clear that the respective scopes of protection differed. This was supported by T250/05 where, post grant, an applicant was precluded from reformatting the Swiss type claims to Article 54(5) EPC claims, because post grant you cannot broaden the scope of protection conferred by a European patent (Article 123(3)EPC).

Comment

This decision confirms that there is a definite difference in claim scope between the respective formats of medical use claim.

Although Swiss type claims have been abolished by the Enlarged Board of Appeal (G2/08); they can still be included in applications with a filing date, or priority date if claimed, which predates 28 January 2011.

The benefit of having both formats of claims was highlighted in the UK in *Ranbaxy (UK) Limited vs. AstraZeneca AB*[2011] EWHC 1831 (Pat). In this decision, the patentee opted to enforce their Swiss-type claims instead of their Article 54(5)EPC claims, because the allegedly infringing product was a derivative of the patented product and they wanted to argue infringement on the grounds that during manufacture of the derivative medicament, the patented product was used to give rise to the derivative medicament. Without that claim format, they would not have been able to run this line of argument.

It is worthy to note that in support of our position we sought and filed an opinion by The Rt. Hon. Professor Sir Robin Jacob, a former UK Court of Appeal judge, who provided a learned and detailed analysis of claim scope between the respective claim sets.

It is a shame that the Board did not use this as an opportunity to deal with the bigger issue as to whether double patenting can give rise to the refusal of a European patent application, especially since the Guidelines themselves clearly acknowledge that the EPC does not explicitly deal with double patenting and the case law is conflicting as to which Article of the EPC is to be cited in conjunction with Article 97(2) EPC to refuse a patent application on the grounds of double patenting.

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Interestingly, as the Board had to discuss the meaning of the phrase "**subject matter**" in the context of double patenting, they felt the need to clarify that in the context of double patenting you are comparing the respective claims to one another, whereas when you are considering whether a claim is entitled to claim priority, is entitled to claim divisional status or does not offend the added subject matter provisions you are comparing the claim to the whole content of the priority document, the parent application or the application as originally filed respectively.

Ross Walker was the attorney prosecuting this Appeal. Please feel free to contact him if you have any questions.