

FINNEGAN



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EPO News

On February 19, 2010, an Enlarged Board of Appeals (Board) at the European Patent Office (EPO) concluded that Swiss-style claims will no longer be acceptable at the EPO. Prior to the Board's decision, two types of medical-use claims were accepted by the EPO. The first and broadest type—the first medical-use claim—typically took the following form: “compound [X] for use as a medicament.”

These claims were generally used to cover a recently discovered medical use of a known compound. The second and more narrow type—the Swiss-style claim—typically took the following form: “the use of compound [X] for the manufacture of a medicament for treating of disease [Y].” These claims were generally used to cover a new therapeutic use of a known pharmaceutically active compound. After considering the changes brought about by the European Patent Convention of 2000 (EPC 2000), however, the Board announced that Swiss-style claims may no longer be used when “the subject matter of a claim is rendered novel only by a new therapeutic use of a medicament.” *In re Abbott Respiratory*, G 0002/08 at 44 (EPO Enlarged Board of Appeals 2010). Instead, the Board found that EPC 2000 “unambiguously permits purpose-related product protection for each further new medical use of a substance or composition already known as a medicine [and] the protection is equivalent, as far as the further uses are concerned, to that offered by the ‘Swiss type claim’.” *Id.* The EPO's decision ends twenty-five years of acceptance by the EPO of Swiss-style claims.

Although the Board did not announce a definitive date for the EPO to begin rejecting Swiss-style claims, the Board stated that applicants must stop using Swiss-style claims no later than three

months after its opinion is officially published, which has yet to happen. Further, the Board announced that its decision will not have any retroactive effects. Thus, patents granted with Swiss-style claims will not be impacted.

From the standpoint of EPO practice, the Board's decision did not affect the substantive question of what medical inventions may be patented—it merely modified the acceptable claim form. Additionally, applicants will be able to amend claims in an unacceptable form to comply with EPO guidelines. Finally, rather than using the Swiss-style claims in the future, applicants may use the alternative medical-use claim format, which is typically in the following form: “substance [X] for the treatment of disease.” The EPO generally considers this claim form and Swiss-style claim format to be of similar scope. However, the precise scopes of these two claim types has yet to be established by the European courts.