

European Patent Office Board of Appeal Ends Use of Swiss-Type Claims for Pharmaceutical Patents

February 22, 2010

The European Patent Office (EPO) Enlarged Board of Appeal (EBA) announced the end of Swiss-type claims in a decision published February 19. It held 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 5/83.” EBA decision G 2/08, point 7.1.3.

Swiss-type claims were instituted by decision G 5/83 in 1984 and were intended to constitute a narrow exception to Article 54(5) EPC 1973, which only allowed patent protection for the first medical indication of a known composition in medicament form. Decision G 5/83 allowed for patent protection of subsequent medical indications of a known medicament. The EBA reasoned that the EP legislator did not intend to exclude subsequent medical indications from patent protection. The Swiss-type claim took the form: “Use of [a known substance or composition] for the manufacture of a medicament for use in [new therapeutic application].”

The EP legislator subsequently promulgated Article 54(5) EPC 2000, which completely closed the Article 54(5) EPC 1973 loophole that limited patent protection only to the first medical indication of a known composition in medicament form. Article 54(5) EPC 2000 was changed to allow for patent protection of subsequent medical indications of a known medicament. Since the new legal framework allows for such patent protection, the EBA has since determined that the G 5/83 Swiss-type claim was no longer needed. Decision G 2/08 allows for a simplified claim form: “[Known substance or composition] for use in [new therapeutic application].”

It is important to note that this change will not apply retroactively. It will only apply to applications having a priority date three months after the publication of decision G 2/08 in the *Official Journal of the European Patent Office*.

Moreover, decision G 2/08 generally considered the Swiss-type claim form and the new claim form that must be used as similar in scope. However, it is not clear how national courts will interpret the comparative scope of these claim forms.

Decision G02/08 is available online at

[http://documents.epo.org/projects/babylon/eponet.nsf/0/1c9976e4866080a2c12576cf00417e3e/\\$FILE/G_2_08_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/1c9976e4866080a2c12576cf00417e3e/$FILE/G_2_08_en.pdf).

If you have any questions or would like more information on any of the issues discussed in this LawFlash, please contact any of the following Morgan Lewis attorneys:

Philadelphia

Louis W. Beardell, Jr.	215.963.5067	lbeardell@morganlewis.com
Christopher I. Halliday	215.963.5337	challiday@morganlewis.com

San Francisco

Robin M. Silva	415.442.1379	rsilva@morganlewis.com
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Washington, D.C.

Robert Smyth	202.739.5139	rsmyth@morganlewis.com
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