

NEW FORMAT OF “SECOND MEDICAL USE” CLAIMS AT THE EPO

As you may be aware, significant changes are being made to the European Patent Convention which will come into force (as “EPC2000”) in December 2007. This is one of a series of newsletters which highlight some of the most relevant changes.

When EPC 2000 comes into force, a new form of “second medical use” claim will become available: “*Compound X for use in treating disease Y*”. This is a use limited product claim, and may be thought of as a claim to “*Compound X packaged and presented for use in treating disease Y*”, in line with current first medical use claim practice. However, unlike present first medical use claims, the claim would be novel over the disclosure of Compound X for use in treating any other disease.

This claim format is in contrast to the currently allowable “Swiss type” second medical use claims of the form “*Use of compound X for the manufacture of a medicament for treating disease Y*”, which can be thought of as a process claim.

Thus, it is possible that the new claim format provides a broader scope of protection than the old claim format.

Although the EPO has indicated that the same patentability criteria will be applied to both second medical use claim formats, it is not clear how national courts will interpret the claims in an infringement (or, indeed, validity) situation.

It is our understanding that both claim formats will be available under EPC 2000, and we advise that, where appropriate, both formats are used in the same application.

It is our understanding that the new format will be allowable in patents granted after December. Thus, it may be appropriate to include claims of the new format in all applications which will lead to a patent grant after EPC 2000 has come into effect. Moreover, it may be appropriate to consider deferring grant, so that the new claim format can be included in a pending application which will be granted after December.

Please ask your usual contact at Eric Potter Clarkson LLP for further information.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson LLP. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

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