

## **RECENT DECISION OF THE ENGLISH HIGH COURT CONCERNING "NEW USE" CLAIMS**

A recent decision of the English High Court (Bristol-Myers Squibb v Baker Norton and Napro 1998) concerning second medical use claims, represents a continuation of the debate surrounding the controversial EPO Mobil decision G02/88 and is relevant also to non-medical claims.

The present case was an action for infringement of EP (UK) 584001, and a counterclaim for its revocation. The patent related to a 3-hour infusion of a known compound (Taxol) which had been publicly proposed for the same therapeutic purpose (treatment of cancer), although results had not been presented in the prior art. The patentee argued that novelty was conferred by the disclosure in the patent of a previously unknown effect of Taxol, namely that such a short infusion causes an unexpected reduction in an adverse side effect. They supported this argument with reference to the Mobil decision and another EPO case (T290/86, ICI). The patent also asserted that 3-hour infusion was efficacious in the treatment of cancer, which was not known from the prior art, although no evidence to support this efficacy was provided.

The Court held that the patent was invalid on the grounds of lacking both novelty and inventive step. The reduction in the adverse side effect when using a known 3-hour infusion of Taxol represented a mere discovery and not a (novel) second medical indication. Thus, this case was distinguished from the Mobil decision, in which it was found that, if a newly discovered technical effect has not previously been made available to the public, then the claimed invention is novel even if the effect may have inherently taken place in a previous disclosure.

The present decision represents a further erosion of the importance of the Mobil decision, and follows two post-Mobil EPO decisions (Dow T958/90 and American Cyanamid T279/93) in which the EPO Board of Appeal has sought to draw a distinction between genuine new uses and mere discoveries about old uses. All three decisions represent a departure from Mobil.

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We must therefore reiterate our advice that it is becoming harder to get Mobil-type claims accepted at the EPO and, even if granted, they may not be enforceable in the UK. The present decision also highlights the importance of including data in a patent application to support any assertions regarding a new effect.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem. Please note that all our Newsletters can be found on our website at [www.eric-potter.com](http://www.eric-potter.com).

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