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**Datasheet for the decision
of 6 June 2014**

Case Number: T 0803/10 - 3.3.02
Application Number: 05017803.7
Publication Number: 1595543
IPC: A61K31/549, A61K31/513,
A61P35/00
Language of the proceedings: EN

Title of invention:

Antineoplastic pharmaceutical compositions comprising
taurolidine or taurultam and 5-fluorouracil

Applicant:

ED. GEISTLICH SÖHNE AG FÜR CHEMISCHE INDUSTRIE

Headword:

Taurolidine and fluorouracil/ ED. GEISTLICH

Relevant legal provisions:

EPC Art. 53(c), 54(4), 111(1)

Keyword:

"Scope of claim -
differing when a "suitable for" feature is removed (yes)"

Decisions cited:

G 0005/83, G 0001/05

Catchword:

./.



**Beschwerdekammern
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Case Number: T 0803/10 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 6 June 2014

Appellant: ED. GEISTLICH SÖHNE AG FÜR CHEMISCHE INDUSTRIE
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 3 November 2009
refusing European patent application No.
05017803.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: U. Oswald
Members: H. Kellner
L. Bühler

Summary of Facts and Submissions

- I. European patent application No. 05 017 803.7, published as EP 1 595 543, was refused by a decision of the examining division on the basis of Article 97(2) EPC, for reason of prohibition of double patenting acknowledged in the decision of the Enlarged Board of Appeal G 0001/05 (OJ EPO 2008, 271). The application in suit relates to the earlier application No. 00 304 737.0 and to the patent resulting from the earlier application, published as EP 1 066 830 B1 (parent patent).

The wording of claim 1 of the main request before the examining division reads as follows:

"A pharmaceutical composition comprising taurolidine, taurultam, taurultam-glucose or a mixture of any of the foregoing together with 5-fluorouracil."

- II. The wording of independent claims 1 and 10 in the patent (parent patent) having resulted from the earlier application is:

"1. Use of a tumour-inhibiting methylol transfer agent selected from taurolidine, taurultam, taurultam-glucose and mixtures of any of the foregoing in the preparation of a medicament for treating tumours of the central nervous system.

10. A pharmaceutical composition comprising a methylol transfer agent as defined in claim 1 and the antineoplastic agent 5-fluorouracil, optionally in association with a pharmaceutically accepted carrier,

diluent or excipient, for administration to a mammal at risk of central nervous system tumour growth."

- III. The examining division held the scope of claim 10 of the parent patent to be identical to the scope of claim 1 of the application in suit. Therefore, the same subject-matter was claimed and the current claim 1 was not allowable because it was a general procedural principle that two patents should not be granted to the same applicant for the same invention.
- IV. The applicant (appellant) lodged an appeal against the decision of the examining division and filed grounds of appeal together with three sets of claims as main and auxiliary requests. The set of claims of the main request was identical to the set of claims decided by the examining division.
- V. In a communication dated 17 September 2013, the board pointed out that it tended to conclude that the subject-matter of claim 1 of the main request differed from that of claim 10 of the parent patent. In such a case the *ratio decidendi* of decision G 0001/05 did not apply.

The board indicated that it intended to remit the case to the first instance for further prosecution if the appellant was ready to withdraw its request for oral proceedings.

- VI. With its letter of 3 October 2013, the appellant withdrew its request for oral proceedings on the understanding that the case would be remitted back to the first instance for further prosecution.

VII. In conclusion from its letter of 3 October 2013, the appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution.

Reasons for the Decision

1. The appeal is admissible.
2. The divisional application in suit has the filing date of 5 June 2000 and was pending on 13 December 2007 when EPC 2000 entered into force. According to Article 1 No. 1 and 3 of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 (OJ EPO 2007, 197), revised Articles 53(c), 54(4) and (5) EPC 2000 apply to the application in suit.
3. *The patent resulting from the earlier application (parent patent)*
 - 3.1 The date of publication and mention of the grant of the parent patent is 30 November 2005. Thus, the patent was granted before 13 December 2007. Based on the transitional provisions as cited above, revised Article 53(c) EPC 2000 and Article 54(5) EPC 1973 apply (disregarding the fact that Article 54(5) EPC 1973 misleadingly refers to Article 52(4) EPC 1973). In addition, Enlarged Board of Appeal decision G 0005/83 (OJ EPO 1985, 64), establishing the second medical use claim in the "Swiss-type" format is applicable.

- 3.2 Claim 10 including a reference to claim 1, at the first view seems to be a dependent claim.

However, claim 1 is written in the form of a second-medical-use-type claim and claim 10 relates to a pharmaceutical composition, a different claim-category. Moreover, claim 10 does not refer to claim 1 *in toto*, but only to the "methylol transfer agent as defined in claim 1", meaning that only one component of the composition is to be defined by reference to claim 1 to be "selected from taurolidine, taurultam, taurultam-glucose and mixtures of any of the foregoing".

Therefore, claim 10 is not a use-claim in disguise, but a product-claim taking on the definition of one component of the composition according to claim 1. Accordingly, claims 1 and 10 of the patent are independent claims of different patent-categories.

Disregarding the optional part of the claim and replacing the reference to claim 1, claim 10 of the parent patent can be read:

"A pharmaceutical composition comprising taurolidine, taurultam, taurultam-glucose or a mixture of any of the foregoing and the antineoplastic agent 5-fluorouracil, for administration to a mammal at risk of central nervous system tumour growth."

- 3.3 Thus, claim 10 relates to a pharmaceutical composition and is to be regarded under the provisions of either Article 53(c), second sentence, EPC 2000 or Article 54(5) EPC 1973.

The final half sentence, "for administration to a mammal at risk of central nervous system tumour

growth", thus, is not to be read as the indication of the illness to be cured in the sense of a second-medical-use-type claim according to Article 54(5) EPC 2000 together with Article 53(c) EPC 2000, because Article 54(5) EPC 2000 does not apply.

- 3.4 Taking into account that "treatment" in the pharmaceutical field includes prevention, the wording "for administration to a mammal at risk of central nervous system tumour growth" relates to the use of the composition in a preventive treatment which is in line with the claimed composition being a pharmaceutical one.

Under the applicable provisions, the indication of a use in the product-claim 10 of the parent patent is at least limiting in the sense, that the product has to be suitable for this use.

Leaving away this limitation in the claim automatically results in a broadening of its scope, because an existing limitation is not present any longer.

4. *Application in suit*

Consequently, the scope of the claim to be assessed in the divisional application, which is directed to the pharmaceutical product per se (without indication of the particular use "for administration to a mammal at risk of central nervous system tumour growth"), is broader than the scope of claim 10 of the parent patent.

In such a case, the conclusion of decision G 0001/05, relating to the prohibition of double patenting

(OJ EPO 2008, 271, point 13.4 of the Reasons) does not apply. Additionally, but with no prejudice to the assessment of the opposition division, it is indicated that subject to the claimed subject-matter fulfilling the requirements of the EPC, the applicant can legitimately pursue a more general teaching in a divisional application after having obtained patent protection for a more limited embodiment (cf. G 0002/10, OJ EPO 2012, 376, point 4.5.5 of the Reasons).

5. Accordingly, the reasons of the examining division do not hold good with respect to the main request on file. Other reasons for the refusal than the prohibition of double patenting acknowledged in decision G 0001/05, however, are not considered in the decision under appeal.

The board has therefore decided to exercise its discretion under Article 111(1) EPC, and remits the case to the first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:



N. Maslin

U. Oswald

Decision electronically authenticated