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Datasheet for the decision of 15 October 2015

Case Number: T 0013/14 - 3.3.02

Application Number: 08153777.1

Publication Number: 1944030

IPC: A61K31/496, A61P25/18

Language of the proceedings: EN

Title of invention:
Agent for treatment of schizophrenia

Applicant:
Sumitomo Dainippon Pharma Co., Ltd.

Headword:
Agent for treatment of schizophrenia/SUMITOMO DAINIPPON

Relevant legal provisions:
EPC 2000 Art. 53(c), 54(5)
EPC Art. 111(1), 125

Keyword:
Double patenting (no) - Swiss-type claim and purpose-limited product claim (Article 54(5) EPC 2000) not the same subject-matter
Remittal to the department of first instance (yes)

Decisions cited:
G 0005/83, G 0002/88, G 0001/05, G 0002/08, T 2461/10, T 1780/12, T 0879/12

Catchword:

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Case Number: T 0013/14 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 15 October 2015

Appellant: (Applicant)	Sumitomo Dainippon Pharma Co., Ltd. 6-8, Dosho-machi 2-chome Chuo-ku Osaka-shi Osaka 541-8524 (JP)
Representative:	Vossius & Partner Patentanwälte Rechtsanwälte mbB Siebertstrasse 3 81675 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 26 June 2013 refusing European patent application No. 08153777.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	U. Oswald
Members:	M. C. Ortega Plaza
	M. Blasi

Summary of Facts and Submissions

I. The present appeal lies from a decision of the examining division refusing European patent application No. 08153777.1, published as EP-A-1 944 030, under Article 97(2) EPC. The application was filed as a divisional application of European patent application No. 03792731.6, published as EP 1 535 616, in respect of which a patent was granted with 19 claims ("parent patent").

II. The examining division's decision is based on the set of claims filed with letter of 21 January 2013, representing the main and sole request.

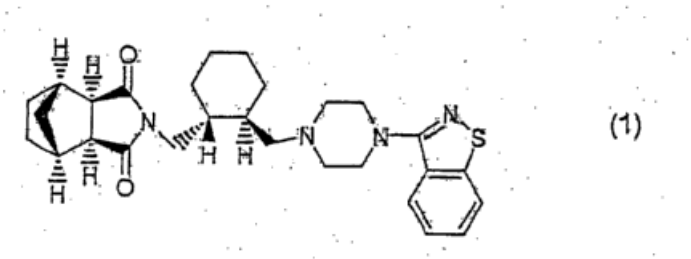
The examining division gave as the sole ground for refusal the prohibition of double patenting, in view of the provisions in Article 125 EPC and having regard to parent patent EP 1 535 616.

III. The applicant (appellant) filed a notice of appeal against said decision and a statement of grounds thereto. With its statement of grounds of appeal it filed a set of claims as main request, which is identical to the set of claims forming the basis of the examining division's decision. With its grounds of appeal the appellant requested reimbursement of the appeal fee under Rule 103(1)(a) EPC for reasons of equity since Article 125 EPC did not constitute a legal basis for refusing the application.

IV. Claim 1 of the set of claims of the main request (sole claim request) reads as follows:

"1. An active compound, namely (1R,2S,3R,4S)-N-[(1R, 2R)-2-[4-(1,2-benzoisothiazol-3-yl)-1-

piperazinylmethyl]-1-cyclohexylmethyl]-2,3-bicyclo[2.2.1]heptanedicarboximide of the formula (1):



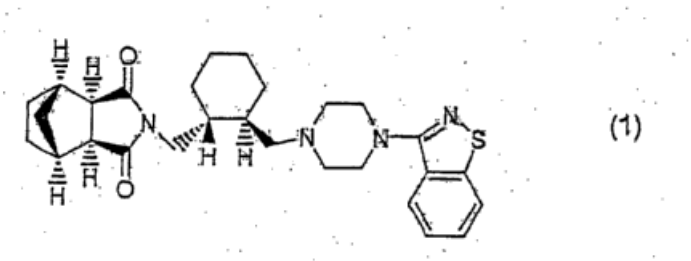
(1)

or a pharmaceutically acceptable salt thereof, for use in a method for improving the negative symptoms and/or cognitive dysfunction of schizophrenia."

Dependent claims 2 to 13 refer to specific embodiments of the subject-matter of claim 1.

V. Claim 1 as granted in the parent patent reads as follows:

"1. Use of (1R,2S,3R,4S)-N-[(1R,2R)-2-[4-(1,2-benzoisothiazol-3-yl)-1-piperazinylmethyl]-1-cyclohexylmethyl]-2,3-bicyclo[2.2.1]heptanedicarboximide of the formula (1):



(1)

or a pharmaceutically acceptable salt thereof in the preparation of an agent for improving the negative symptoms and/or cognitive dysfunction of schizophrenia.

Dependent claims 2 to 9 refer to specific embodiments of the subject-matter of claim 1.

VI. The examining division was of the opinion that according to Enlarged Board of Appeal decision G 1/05, OJ EPO 2008, 271 (point 13.4 of the reasons), the principle of prohibition of double patenting applied to the present case. In the absence of a specific provision in the EPC, double patenting was prohibited under Article 125 EPC.

In particular, the examining division was of the opinion that in the present case the granted parent patent and the application under consideration (the examining division's decision explicitly mentions claims 1-9 of the set of claims filed with the letter of 21 January 2013) were directed to the same invention (as defined by the protection conferred on the proprietor by the set of claims) and did not merely overlap.

VII. The appellant's arguments, as far as relevant for the present decision, may be summarised as follows:

The claims granted in the parent patent were formulated as Swiss-type claims referring to a second medical use, whereas the pending claims of the present divisional application were drafted as purpose-limited product claims in accordance with Article 54(5) EPC 2000. The two sets of claims did not relate to the same subject-matter, at least for the reason that the Swiss-type claims related to the preparation of a medicament, whereas the purpose-limited product claims were not restricted to such a preparation. The method of preparation recited in the Swiss-type claims was a limiting technical feature, thus representing a substantial difference to the purpose-limited product claims. Enlarged Board of Appeal decision G 2/08, OJ EPO 2010, 456 (point 6.5 of the reasons) confirmed this

interpretation, stating that, compared with Swiss-type claims, "*It appears that the rights conferred on the patentee by the claim category under Article 54(5) EPC are likely broader*".

The appellant submitted that an application should not be refused for reasons of double patenting unless the second patent was *"for the same subject-matter"* (G 1/05, point 13.4 of the reasons). It also referred to decision T 1780/12 of 30 January 2014, which held that Swiss-type claims and corresponding purpose-limited product claims did not relate to the same subject-matter, *inter alia* because the claims' categories were different.

VIII. The board issued a communication pursuant to Rule 100(2) EPC and Article 12(1)(c) RPBA. With its communication, the board expressed its intention to set aside the decision under appeal and to remit the case to the department of first instance for further prosecution, and gave reasons thereto.

Additionally, the board expressed the view that the conditions for a full reimbursement of the appeal fee were not fulfilled.

The board also asked the appellant whether under these circumstances it wished to maintain its request for oral proceedings and whether it maintained its request for reimbursement of the appeal fee.

IX. With letter of 9 September 2015 the appellant withdrew its request for reimbursement of the appeal fee. It maintained its request for oral proceedings only as a precautionary measure in the event that the board could not accept its main request to set aside the appealed

decision and to remit the case to the examining division.

X. The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the set of claims filed with the statement of grounds of appeal.

Reasons for the Decision

1. The appeal is admissible.

2. Double patenting

2.1 The claims in the set of claims as filed with the statement of grounds of appeal are drafted as purpose-limited product claims, whereas the claims as granted in the parent patent are drafted in the Swiss-type form.

Claims in the Swiss-type form were instituted for second or further therapeutic applications by virtue of Enlarged Board of Appeal decision G 5/83 (OJ EPO 1985, 60), since Article 54(5) EPC 1973 (now Article 54(4) EPC 2000) allowed purpose-limited product claims for the first medical/therapeutic application only.

2.2 Article 54(5) EPC 2000 (entry into force 13 December 2007) overcame this lacuna in EPC 1973, by allowing purpose-limited product claims for a substance or composition for use in a method referred to in Article 53(c) EPC 2000 and thus eliminating any legal uncertainty as to the patentability of further medical uses.

2.3 Claim 1 of the sole request in the present case is in the form of a purpose-limited product claim according to Article 54(5) EPC 2000, since it relates to "an active compound, namely a compound of the formula (1)... for use in a method for improving the negative symptoms and/or cognitive dysfunction of schizophrenia" (see point IV above for the wording of the claim in full).

Claim 1 as granted in the parent patent is in the Swiss-type form according to G 5/83, since it relates to the "use of a compound of the formula (1)... in the preparation of an agent for improving the negative symptoms and/or cognitive dysfunction of schizophrenia" (see point V above for the wording of the claim in full).

The definition of the active compound of formula (1) as well as of the therapeutic application in claim 1 of the present case is identical to that in claim 1 as granted in the parent patent.

2.4 There is a generally acknowledged principle underlying the EPC which concerns the prohibition of double patenting, namely that the same applicant should not get two patents with the same effective date, for the same designated states, and for the same subject-matter. This principle was accepted by the Enlarged Board of Appeal in its decision G 1/05 (OJ EPO 2008, 271), which stated that *"The Board accepts that the principle of prohibition of double patenting exists on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor"* (see point 13.4 of the reasons).

Moreover, a body of jurisprudence exists dealing with the issue of double patenting (see *inter alia* board of appeal decisions T 1780/12 of 30 January 2014, T 2461/10 of 26 March 2014 and T 0879/12 of 27 August 2014) and confirming the general principle of the prohibition of double patenting in respect of the same subject-matter claimed.

2.5 Hence, what needs to be assessed here is whether the subject-matter of the claims of the present application is the same as the subject-matter of the claims granted in the parent patent.

2.5.1 The subject-matter of a claimed invention involves two aspects: first, **the category or type of the claim**, and second, **the technical features**, which constitute its technical subject-matter (see Enlarged Board of Appeal decision G 2/88 OJ EPO 1990, 93, point 2.6 of the reasons).

2.5.2 The present board agrees with the findings in decisions T 1780/12 and T 0879/12 that the category of purpose-limited claims under Article 54(5) EPC 2000 is a restricted product claim, whereas the category of Swiss-type-form claims is a restricted process claim.

Accordingly, the purpose-limited **product claims** of the present application belong to a different category than the purpose-limited **process claims** of the parent application.

2.5.3 Moreover, as regards the technical features of the two sets of claims, even though the same compound and the same therapeutic application are defined, the granted Swiss-type claims in the parent patent comprise in

addition the feature concerning the **preparation of an agent** (*medicament)* while the claims of the present application do not.

Consequently, the subject-matter of the claims of the present application (drafted as purpose-limited product claims under Article 54(5) EPC 2000) and the subject-matter of the granted claims in the parent (drafted in Swiss-type format) is notionally different.

2.6 An inspection of the application and the parent application as filed shows that *prima facie* there are no reasons under Article 76(1) EPC contrary to the drafting of the claims as purpose-limited product claims.

2.7 Since the subject-matter of claim 1 of the application under appeal and granted claim 1 in the parent patent are notionally different and claims 2 to 13 are dependent on claim 1 (see point IV above), granting a patent on the basis of claims 1 to 13 as filed would not lead to double patenting in the present case.

3. As the decision under appeal is exclusively concerned with the issue of double patenting (see point II above), the board decides to remit the case to the department of first instance for further prosecution (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

The Registrar: The Chairman:

N. Maslin U. Oswald

Decision electronically authenticated