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**Datasheet for the decision
of 6 October 2015**

Case Number: T 0015/14 - 3.3.02
Application Number: 10166151.0
Publication Number: 2223691
IPC: A61K31/70, A61K31/732,
A61K31/702, A61P37/08
Language of the proceedings: EN

Title of invention:
Immunomodulating oligosaccharides

Applicant:
N.V. Nutricia

Headword:
Immunomodulating oligosaccharides for use in medical
treatment/NUTRICIA

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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Chambres de recours**

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Case Number: T 0015/14 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 6 October 2015

Appellant:
(Applicant)

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 15 July 2013
refusing European patent application
No. 10166151.0 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. 10166151.0, which was published as EP-A-2223691, under Article 97(2) EPC. The application was filed as a divisional application of European patent application No. 04793675.2, which was filed as an international application published as WO 2005/039597 (parent application).

II. The examining division's decision is based on the set of claims as filed with the present divisional application, representing the main and sole request.

The examining division gave as the sole ground for refusal the prohibition of double patenting, in consideration of the provisions in Article 125 EPC in view of European application No. 06111971.5, which was also filed as a divisional application of the same parent application (No. 04793675.2) and in respect of which European patent EP 1 733 730 was granted.

III. The applicant (appellant) filed a notice of appeal against said decision and a statement of grounds thereto. It maintained the set of claims as initially filed.

IV. Claim 1 of the set of claims of the sole request reads as follows:

"1. Composition comprising a therapeutically effective amount of acid oligosaccharide and neutral oligosaccharide, wherein:

- the acid oligosaccharide has a degree of polymerization between 2 and 250 and is prepared from pectin or alginate; and
- the neutral oligosaccharides is selected from the group consisting of fructans, fructooligosaccharides, indigestible dextrans, galactooligosaccharides including transgalactooligosaccharides, xylooligosaccharides, arabinooligosaccharides, glucooligosaccharides, mannoooligosaccharides, fucooligosaccharides and mixtures thereof. [sic] for use in the treatment and/or prevention of an immune system related disorder selected from the group consisting of allergy Type 1, allergy Type 2, allergy Type 3 and allergy Type 4, in a mammal."

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

V. Claim 1 as granted in the "parallel" patent EP 1 733 730 reads as follows:

"1. Use of acid oligosaccharide and neutral oligosaccharide in the manufacture of a composition for the treatment and/or prevention of an immune system related disorder selected from the group consisting of allergy Type 1, allergy Type 2, allergy Type 3 and allergy Type 4, in a mammal, said composition comprising a therapeutically effective amount of acid oligosaccharide and neutral oligosaccharide, wherein:

- the acid oligosaccharide has a degree of polymerization between 2 and 250 and are prepared from pectin or alginate; and
- the neutral oligosaccharide is selected from the group consisting of fructans, fructooligosaccharides, indigestible dextrans, galactooligosaccharides

including transgalactooligosaccharides, xylooligosaccharides, arabinooligosaccharides, glucooligosaccharides, mannoooligosaccharides, fucooligosaccharides and mixtures thereof."

Dependent claims 2 to 13 refer to specific embodiments of the subject-matter of claim 1, specifying the same additional features as claims 2 to 13 of the present application.

VI. The examining division was of the opinion that, according to Enlarged Board of Appeal decision G 1/05, OJ EPO 2007, 362 (point 13.4 of the reasons), the principle of prohibition of double patenting applied to the present case, and that in the absence of a specific provision in the EPC double patenting was prohibited under Article 125 EPC.

In particular, the examining division considered that the granted "parallel" patent (EP 1 733 730) and the present application were directed to the same invention, since the protection conferred by purpose-limited product claims under Article 54(5) EPC 2000 was equivalent to that conferred by the Swiss-type claims for second (or further) therapeutic applications, and cited Enlarged Board of Appeal decision G 2/08, OJ EPO 2010, 456.

VII. The appellant's arguments may be summarised as follows:

The claims of the granted "parallel" patent (EP 1 733 730) were formulated as Swiss-type claims referring to a second medical use whereas the pending claims of the present application were drafted as purpose-limited product claims. The two sets of claims thus related to different categories, namely Swiss-type

method claims and purpose-related product claims respectively, and consequently the scope of protection conferred by the diverse claim formats was different. Enlarged Board of Appeal decision G 2/08 (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 scope of protection of a Swiss-type claim might be very similar to that of a purpose-related product claim, but it was not identical. An application should, however, not be refused for double patenting unless the second patent would be *"for the same subject-matter"* (G 1/05, point 13.4 of the reasons).

- 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. Moreover, the board asked the appellant whether in these circumstances, it wished to maintain its request for oral proceedings.
- IX. With letter of 9 July 2015 the appellant withdrew its request for oral proceedings.
- X. The appellant requested that the decision under appeal be set aside and the case be remitted to the department of first instance for further prosecution on the basis of the set of claims as filed.

Reasons for the Decision

1. The appeal is admissible.
2. Double patenting
 - 2.1 The claims in the set of claims as filed (sole request) in the present application are drafted as purpose-limited product claims, whereas the claims as granted in the patent deriving from the parallel application 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 loophole of 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, thus eliminating any legal uncertainty on 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 "a composition comprising a therapeutically effective amount of acid oligosaccharide and neutral oligosaccharide...for use in the treatment and/or prevention of an immune system related disorder" (see point IV above for the wording of the claim in full).

Claim 1 as granted in the patent deriving from the parallel application is in the Swiss-type form according to G 5/83, since it relates to the "use of acid oligosaccharide and neutral oligosaccharide in the manufacture of a composition for the treatment and/or prevention of an immune system related disorder" (see point V above for the wording of the claim in full).

The definition of the composition and the therapeutic application in claim 1 of the present case is identical to that in claim 1 as granted in the patent deriving from the parallel application.

- 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 having 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 and 307), 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 is whether the subject-matter of the claims of the present application is the same as the subject-matter of the granted claims in the patent deriving from the parallel application.

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 in that the category of the purpose-limited claims under Article 54(5) EPC 2000 is a restricted product claim, whereas the category of a 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 parallel application.

2.5.3 Moreover, as regards the technical features of the two sets of claims, even though the same composition and the same therapeutic application are defined, the granted Swiss-type claims of the parallel application comprise in addition the feature concerning the **manufacture of a composition** (*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 claims as granted in the patent deriving

from the parallel application (drafted in Swiss-type format) is notionally different.

- 2.6 An inspection of the application as filed and the parent application 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 of the patent deriving from the parallel application 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 in the present case would not lead to double patenting.
3. As the decision under appeal is exclusively concerned with the issue of double patenting (item 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