T 76/11

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 92 / 82

DECISION

of the Technical Board of Appeal 3.3.1

of 20 June 1983

concerning the submission of a point of law to the Enlarged Board of Appeal

Appellant: Eisai Co.Ltd.
4-6-10, Koishikawa, Bunkyo-ku
Tokyo, Japan

Representative: Eitle Werner, Dipl.-Ing.
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Related appeal proceedings: Appeal T 92/82 dated 18 March 1982 against the Decision of Examining Division 001 of the European Patent Office dated 12 February 1982 refusing European patent application No 78 101 367.7 pursuant to Article 97(1) EPC

Composition of the Board:

Chairman: D. Cadman

Member: G. Szabo

Member: M. Prélot

Summary of Facts and Submissions

I. The European patent application No. 78 101 367.7 filed on 14 November 1978 and published on 30 May 1979 under publication number 0 002 051, claiming priority from the prior application (JP 136 620/77) of 16 November 1977, was refused by decision of Examining Division 001 of the European Patent Office dated 12 February 1982.

II. That decision was based on a single claim, which is still being maintained, for the

"Use of butoxybenzylhyoscyamine bromide in a pharmaceutical composition against deafness and tinnitus".

III. The introductory part of the patent application states inter alia that the above-mentioned compound is already described in an American patent specification (US-A-3 696 110) as a compound suitable for the treatment of gastric cramp, various ulcers and the like.

IV. The principal reason given in the decision of 12 February 1982 for refusing the patent application with that claim is that the claim as currently worded is directed at a treatment of the human body by therapy. Such treatment is not susceptible of industrial application and, pursuant to Article 52(4) and Article 54(5) EPC, is not patentable.

V. By letter dated 18 March 1982 the applicant filed an appeal against that decision and paid the appeal fee; the Statement of Grounds was filed on 14 June 1982.

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VI. The new alternative claim also submitted by the appellant is worded as follows:

"Use of butoxybenzylhyoscyamine bromide in the preparation of a pharmaceutical composition against deafness and tinnitus".

VII. In the course of the appeal proceedings, the Board of Appeal indicated in an interlocutory communication that it doubted whether use claims of the kind in question could be granted. The appellant, on the other hand, expressed the opposite view. He maintained that this was an important point of law to which an unambiguous answer is not given in the Convention, and that viewpoints were to be found in national case law and in the learned writings that might cast doubt on the views previously expressed by the Board of Appeal.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. With the above-mentioned original claim the appellant is seeking the grant of a patent with a claim for the use of a chemical substance for a therapeutic purpose. From the form of that claim the invention appears to be a method for treatment by therapy within the meaning of Article 52(4), first sentence, EPC. As such it would not be susceptible of industrial application and thus, pursuant to Article 52(1) EPC, not patentable.

3. The question as to claims for the use of a substance or mixture of substances for one of the purposes mentioned in Article 52(4), first sentence, EPC being admissible is an important point of law within the meaning of Article 112(1) EPC. That is already clear for the following reason alone:
Use claims represent a category of claim in principle allowed by the Convention (cf. Rule 30(a) EPC). In the field of biochemistry it is often the category particularly suited to that type of invention, since in that field inventions are frequently centred on the teaching that a certain effect is achieved with a certain substance. But in view of Article 52(4), first sentence, EPC, use claims in the field of therapy appear not to be allowable, particularly because, under Article 52(4), second sentence, EPC, products but not uses are patentable and because Article 54(5) EPC provides for product claims for substances or compositions known per se - on condition that the use of the substances or compositions for any method referred to in Article 52(4) is not comprised in the state of the art.

4. The question of the admissibility of use claims in the field in question is of major significance, particularly for the patenting of pharmaceutical inventions. The answer to that question has become the subject of public controversy. Since it is, furthermore, purely a point of law, the Board considers that a decision of the Enlarged Board of Appeal is required on this question under the terms of Article 112(1)(a) EPC.

5. For these reasons: pursuant to Article 112(1)(a) EPC in conjunction with Article 17 of the Rules of Procedure of the Boards of Appeal (OJ EPO 1983, p. 7), the following point of law is referred to the Enlarged Board of Appeal for decision:

> Can a patent with claims directed to the use be granted for the use of a substance or composition for the treatment of the human or animal body by therapy?

The Registrar:
J. Rückerl

The Chairman
D. Cadman