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A new decision on second medical use – Vericore Limited vs. The Danish Board of Appeals

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In a recent decision rendered by the Danish Maritime and Commercial Court, a Danish patent invalidated administratively in both the first and second instance by the Danish Patent Office was held invalid by the Danish Maritime and Commercial Court also. The European sister patent had likewise been invalidated at the EPO Technical Board of Appeals (T 0708/02).

In 2003, the Danish Patent Office granted a Danish patent (based on a Danish patent application) to the company Vericore Limited concerning the use of certain pyrethroid compunds for the manufacture of a composition for the control of sealice infestation in fish such as salmon.

The Danish Patent Office ruled that claims of the type second medical use are allowable if the therapeutic use is novel and inventive and consequently a patent may be granted for an invention consisting in the ascertainment that a known compound with a known use also provides a certain other and surprising, specific therapeutic use. In that connection, the Danish Patent Office stated that:

“By therapeutic use is meant a defined, real treatment of a pathological condition. A therapeutic use is therefore novel if a different sickness is treated or if a different group of patients is treated. This group of patients must in its physiological or pathological condition be clearly distinguishable from the hitherto treated group and there must be a functional correlation between this special condition and the result of the treatment.

The sickness treated in D7 and the patent-in-suit is sea lice infestation, independent of the actual life phase of the sea lice. The difference in the pathological treatment between D7 and the patent-in-suit can only be seen as the discovery of the fact that the efficacy of the pyrethroid compounds in the treatment of sea lice infestation is not only due to the effect on mature sea lice, but also due to the effect on immature sea lice. Such a discovery can not be considered a novel technical feature in the pathological treatment, but only an explanation of an effect obtained with the known treatment. This in itself does not constitute novelty in terms of patentability. […]

As the contents of claim 1 of the patent-in-suit concern neither a different pathology from the one treated in D7 nor a patient group distinguishable from the one treated in D7, claim 1 is not novel over D7”.

Against this background and with reference also to the fact that the European sister patent had been

invalidated for similar reasons, the Danish Patent Office invalidated the patent-in-suit and on appeal The Danish Board of Appeals concurred.

The decision of the Danish Board of Appeal was then brought before the Maritime and Commercial Court in its acapacity as specialty court for patents and it upheld the invalidation:

“As Vericore on the present documentary basis is found not to have proven that the use of pyrethroid compunds (as stated in the patent-in-suit according to case law on claims for second and further medical indications – which case law still applies after the enactment of Art. 54(5) EPC) including the decision G 02/08 from the EPO Enlarged Board of Appeal) possesses neither a sufficient degree of specification or novelty to be patentable, there are no grounds to reverse the decision of the Danish Board of Appeal”.

The decision has not been appealed and is therefore final.

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