France

PATENTS

Swiss claims

The General Hospital Corporation v. Air Liquide
Tribunal de Grande instance of Paris
December 11, 2002

A judgment handed down by the District Court of The Hague (The Netherlands)[1] decided on an action for infringement instituted by The General Hospital Corporation in Boston against companies of the Air Products group where the issue of validity of a method for treating a disease was raised.

The action was based on EP 0 560 928 which includes Swiss-type claims on a therapeutic use of a gaseous mixture ("use of gaseous mixture for the production of medicament X for the treatment of disease Y") as well as a product claim ("gaseous mixture for use in a method for treating a disease') and a process claim ("a method for providing an inhalable medicament).

The District Court of The Hague noted that even if the preparation of a medicament is generally accepted as susceptible of industrial application – and therefore patentable through a Swiss-type claim – in the present case however the medicament (a gaseous mixture) could only be prepared by or under the supervision of a doctor at the patient's bedside.

The Dutch Court concluded that the process subject-matter of the Swiss claim was in fact a method for a therapeutic treatment, unpatentable under the European Patent Convention, even if the device used by the doctor during the preparation is susceptible of industrial application.

The District Court of The Hague however decided to stay the proceedings concerning the product claim until the European Patent Office handed down a decision in the opposition proceedings against the patent at issue.

A decision on same European patent 0 560 928 to The General Hospital Corporation was handed down on December 11, 2002 by the Presiding Judge of the Tribune/de Grande instance of Paris. This decision is one of the first handed down in France about the validity of Swiss-type claims aimed at covering in fact a method for a therapeutic treatment.

The General Hospital Corporation instituted an action for infringement based on the French part of EP 0 560 928 against two companies of the Air Liquide group before the Tribunal de Grande Instance of Paris. It requested the Presiding Judge of this Tribunal/ to issue an interim injunction pursuant to Article L. 615-3 of the French Intellectual Property Code. This article allows the plaintiff in an infringement action to submit the case to the Presiding Judge of the Tribunal" acting and ruling in summary proceedings" in order to have the alleged infringer enjoined from carrying on the allegedly infringing acts provisionally and under penalty or authorized to continue said acts subject to the deposit of a guarantee.

The injunction shall be granted only if the substantive action for infringement "appears well founded' and is instituted "within a short time' as of the day on which the patentee became aware of the allegedly infringing acts.

The two companies of the Air Liquide group argued notably in their defence that the plaintiffs' substantive action for infringement was not well founded as required by Article L. 615-3 of the French Intellectual Property Code in order to obtain an interim injunction. The companies asserted *inter alia* that the Swiss-type claims on a therapeutic use of a gaseous mixture relied on against them were not patentable because they aimed at covering methods for treating human body excluded from patentability by Article 52(4) of the European Patent Convention.

The French judge considered this argument as founded and held that

> "considering the wording of the disputed independent claims and the need for a doctor to be present to use this method of treatment (the marketing authorization of the product at issue providing that the prescription of nitric oxide in neonatology must be control ed by a doctor specialized in newborn intensive care and that the recommended initial dosage for a perioperative use must be adapted according to the patients clinical state and appraised only by a doctor), the requirement for an action to be well founded provided for in Article L. 615-3 of the French Intellectual Property Code is not met in the present case; Va/id/1y of the patent at issue notably will be debated with regard to va/ici/1y of claims 2 and 7 and claims depending thereon".

In conclusion, the judge held that the substantive action for infringement appears not to be well founded with regard to the serious risk of invalidity of the patent claims and refused consequently to issue an interim injunction against the defendants.

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1 [2000] E.I.P.R N-125.