BL O/026/12

27 January 2012

PATENTS ACT 1977

APPLICANT	Optinose AS
ISSUE	Whether patent application GB 1103477.4 covers the same invention as GB 2453389 B
HEARING OFFICER	Phil Thorpe

DECISION

Introduction

1 This decision relates to a single issue – do the claims in one application that has not yet been granted relate to the same invention as claimed in another granted patent belonging to the same applicant.

2 The application in issue is UK patent application GB 1103477.4. It is a divisional application to UK patent application GB 0723370.3 ("the parent"). The parent was granted on 6 July 2011 as GB 2453389 B. The divisional application was published as GB 2477225 A. Both cases share the same priority date and the applicant in both cases is Optinose AS.

3 The divisional application has not been granted because the applicant has been unable to persuade the patent examiner that there is not conflict between the claims of the parent and the divisional. The matter has subsequently come before me to decide on the basis of the papers on file.

The Law

4 The examiner has based his objection on Section 18(5) of the Patents Act which states:

> Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications.

5 The tests for determining under section18(5) whether two UK applications relate to the same invention are the same as for deciding under section 73(2)

whether a UK patent conflicts with a European patent (UK). The phrase "for the same invention" under both section18(5) and section73(2) is regarded as embodying the long-standing principle that the same monopoly should not be granted twice over. Thus it covers not only the situation where respective applications contain claims explicitly including all of the same features (including the case where these are claims dependent on quite distinct main claims) but also where the claims differ in their wording but their scope does not differ in substance.

6 Three authorities have been referred to in the course of the examination of the application. These are *Maag Gear*,[1] *Arrow Electric Switches Ltd's Applications*[2] *and Kimberley-Clark Worldwide Inc's Patent*[3].

7 It is not necessary to review these cases in detail. Rather it is sufficient in this instance to note that in both *Arrow Electric Switches Ltd's Applications* and *Kimberley-Clark Worldwide Inc's Patent* it was found that where the respective patent applications were directed to distinct inventions, A and B, it is allowable for one of the applications to contain a claim to the combination of A and B. (However, it would not have been allowable for both applications to contain such a claim). Hence a claim to the combination A and B in one application would be allowable even though it fell entirely within the scope of a claim to just A in another application.

8 In *Maag*, which was also a decision of the Comptroller under section 73(2), it was observed that even though claim 1 of a UK patent was not explicitly limited to a particular construction set out in claim 1 of an European patent (UK), that particular construction was the only construction described and illustrated in the UK patent. Thus, the Hearing Officer construed claim 1 of the UK patent as protecting a device including that construction and accordingly found the claim to be directed to the same invention as that claimed in the European patent (UK).

The invention

9 The invention relates to a nasal inhaler. With reference to the figure 4 of the description (shown below), the inhaler includes a detachable nose piece 5 for insertion into the nostril of the user. The nose piece 5 includes a container C containing for example a medicament. The container is ruptured by a rupturing mechanism 23 in order to release the medicament into the airflow once the nose piece and container has been fitted to the body of the inhaler. The inhaler also includes a mouth piece 15 through which the user exhales. Flow through the inhaler from the mouthpiece is prevented by valve 51 until a predetermined pressure is built up upstream of the valve. Once that pressure has been achieved, the valve will then open allowing the exhaled air flow to pass through the inhaler, entraining the substance contained in container C, and then exit through the nose piece into the nostril of the user.

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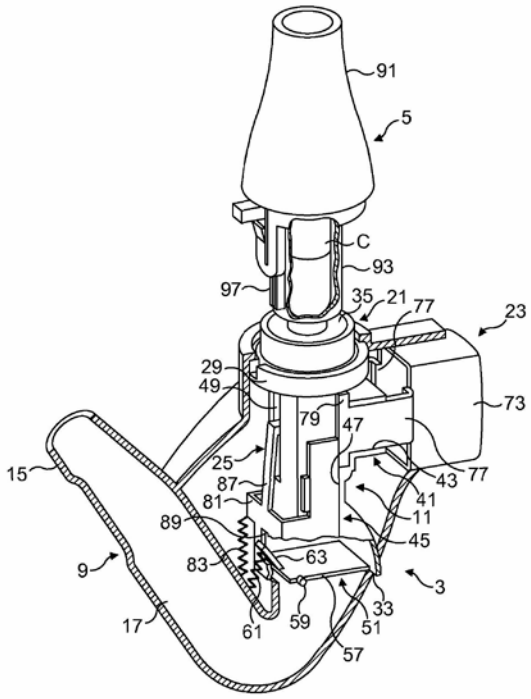
[1] Maag Gear Wheel and Machine Co Ltd's Patent [1985] RPC 572
[2] Arrow Electric Switches Ltd's Applications 61 RPC 1 (1944)
[3] Kimberley-Clark Worldwide Inc's Patent (BL O/279/04)

10 If the nose piece is not fitted, or is not properly fitted, then an interlocking mechanism prevents operation of both the rupturing mechanism and the valve.



11 The latest claim set of the divisional, GB1103477.4, was filed on 28 July 2011. Claim 1 reads as follows:

> "1. *A nasal delivery device for delivering particulate substance to the nasal airway of a subject, the delivery device comprising:*
>
> > *a body assembly including a mouthpiece unit which includes a mouthpiece through which the subject in use exhales, and a substance-supply unit which is fluidly connected to the mouthpiece unit and configured to receive a replaceable nosepiece unit which includes a nosepiece and contains a container containing particulate substance, wherein the substance-supply unit is actuatable to provide particulate substance for delivery to the nasal airway of the subject and the substance-supply unit includes a valve unit which is operable between a first, closed configuration in which a fluid communication path with the mouthpiece is closed, and a second, open configuration in which the fluid communication path is open."*

12 Also relevant is claim 3 which reads:

> *"*3. The delivery device of claim 1 or 2 wherein the substance-supply unit includes an interlock mechanism which is configured to lock the valve unit in the closed configuration when the nosepiece unit is not fitted to the body assembly and allow operation of the valve unit when the nosepiece unit is fitted to the body assembly.*"*

13 The claims of the parent which are relevant to this matter are claims 1 and 5 which read as follows:

> "1. *A nasal delivery device for delivering particulate substance to the nasal airway of a subject, the delivery device comprising:*
>
> > *a body assembly including a mouthpiece unit which includes a mouthpiece through which the subject in use exhales, and a substance-supply unit which is fluidly connected to the mouthpiece unit and configured to receive a replaceable nosepiece unit which includes a nosepiece and contains a container containing particulate substance, wherein the substance-supply unit is actuatable to provide particulate substance for delivery to the nasal airway of the subject*; wherein the delivery device is configured to prevent operation until a nosepiece unit is fitted to the body assembly."
>
> "5. *The delivery device of any claims 1 to 4, wherein the substance-supply unit includes a valve unit which is operable between a first, closed configuration in which a fluid communication path with the mouthpiece is closed, and second, open configuration in which a fluid communication path with the mouthpiece is open."*

14 Claim 3 of the divisional, when read with claim 1, shares much of the wording of claim 5 of the parent when also read with the claim 1 from which it is dependant. The common wording is shown above in italics.

15 The final part of claim 1 of the parent also requires that the "delivery device is configured to prevent operation until a nosepiece unit is fitted to the body assembly ". This requirement is however prima facia also a requirement of claim 3 of the divisional if it is considered that locking the valve in the closed position is a way of preventing operation of the delivery device. The applicant however argues that it would be wrong to construe the operation of the device in this way.

16 Rather it argues that the limitation provided by claim 3 is merely to lock the valve in the closed position when the nose piece is not fitted to the body. This it argues is not the same as preventing operation of the delivery device. I do not find the applicant's argument at all persuasive. It is possible that I have failed to pick up some particular nuance and it is perhaps unfortunate that we did not have the advantage of a hearing to explore this line of argument further. I could have sought further guidance from the applicant but for reasons that will soon become apparent I have chosen not to do so. Rather for the purposes of this decision I will say only that I am not persuaded by the applicant's argument. I will proceed therefore on what to me seems a very sound basis that locking the valve in the closed position is sufficient to prevent operation of the delivery device. Hence in my opinion the invention set out in claim 3 of the divisional falls entirely within the scope of claim 5 of the parent.

17 But even if the divisional application has a claim that falls clearly within the scope of a claim in the parent application then it is not necessarily fatal to the

divisional application. This is clear from *Arrow Electric Switches Ltd's Applications* and *Kimberley-Clark Worldwide Inc's Patent*. However if the two claims are coterminous or like, in *Maag,* if in substance they relate to the same invention then there would be conflict. However in this instance I do not believe that there is conflict. I will explain why.

18 Claim 3 as it is currently worded explicitly requires that the interlock mechanism is configured to lock the valve unit in the closed position when the nose piece is not fitted to the body of the device. Claim 5 of the parent on the other hand is broader in that it does not specify how the operation of the delivery device is prevented. It is perhaps worth noting here that I have construed the phrase "operation" in the context of the operation of the delivery device to include the steps of inserting the nose piece into the housing as well as the step of the user rupturing the container held within the nose piece. I find support for this construction in the description especially on pages 36 and 37. Hence adopting this construction I believe that as noted the delivery devices set out in the embodiments present at least two ways of preventing operation of the device. The first (which for convenience I shall refer to as method A) is to prevent operation of the rupturing mechanism. The second (method B) is to prevent operation of the valve. In the particular embodiment both the valve and the rupturing mechanism are prevented from operating if the nose piece is not attached. The scope of claim 5, as it is currently worded, therefore extends at least to cover arrangements that have just method A or just method B or a combination of the two. Thus it is considerably broader in substance than claim 3 of the divisional which is limited to method B. Hence the claims are not coterminous nor do they in substance relate to the same invention. I have also considered the other claims and, whilst there is considerable overlap between the two claim sets, there is no obvious conflict between the claims.

Conclusion

19 The claims in patent application GB 1103477.4 do not conflict with the claims in granted patent GB 2453389 B.

20 The examiner has indicated that the issue of conflict is the only outstanding objection against GB 1103477.4. I have now determined that there is no conflict and therefore I refer the case back to the examiner for grant.

Appeal

21 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

Phil Thorpe.