SUPREME COURT OF NORWAY

J U D G M E N T

given on 26 June 2025 by a division of the Supreme Court composed of

Justice Bergljot Webster
Justice Espen Bergh
Justice Erik Thyness
Justice Knut Erik Sæther
Justice Thom Arne Hellerslia

HR-2025-1232-A, (case no. 24-200967SIV-HRET)
Appeal against Borgarting Court of Appeal's judgment 21 October 2024

Merck Sharp & Dohme LLC	(Counsel Knut Sverre Skurdal Andresen)
v.	
The State represented by The Norwegian Board of Appeal for Industrial Property Rights	(The Office of the Attorney General represented by Stein-Erik Jahr Dahl)

(1) Justice **Hellerslia:**

Issues and background

(2) The case concerns administrative limitation of a patent under section 39 a of the Patents Act. The question is whether what is referred to as a "dependent patent claim" may be limited without limiting the patent as such.

(3) Merck Sharp & Dohme LLC (MSD) is a U.S. pharmaceutical company. The company has held the patent NO 321999 (the 999 patent), which covers the active ingredient sitagliptin. Sitagliptin is used in the treatment of type 2 diabetes. The patent expired in July 2022. Based on this patent, MSD was granted supplementary protection certificates (SPCs) for two pharmaceutical products in Norway. One was the mono product Januvia with sitagliptin as the only active ingredient. The second was the compound product Janumet containing both sitagliptin and metformin. Januvia had SPC protection until 23 September 2022 and Janumet until 8 April 2023.

(4) The 999 patent includes multiple claims. Claim 1 sets out a general formula for a group of chemical compounds, commonly referred to in patent law as a Markush structure. Claims 2 through 19 describe specific variants of the formula in Claim 1, and are thus narrower in scope than Claim 1.

(5) On 29 January 2020, MSD submitted a request to the Norwegian Industrial Property Office (NIPO) to limit Claims 3 and 15 to include the combination of the active ingredients sitagliptin and metformin. NIPO rejected the request on 30 October 2020, stating that the amendments did not constitute a genuine limitation of the patent, as Claim 1 remained unchanged.

(6) MSD appealed against NIPO's decision to the Norwegian Board of Appeal for Industrial Property Rights (the Board of Appeal). In connection with the appeal, MSD submitted an alternative set of claims, which introduced new limitations in Claims 1, 5 and 6, in addition to the original limitations in Claims 3 and 15. The limitations in Claims 1, 5 and 6 were of a different nature than those in Claims 3 and 15.

(7) The Board of Appeal rejected MSD's appeal in a decision dated 16 September 2021. However, the Board of Appeal disagreed with NIPO's reasoning that patent limitations cannot be made solely to dependent claims. Instead, the Board of Appeal argued that the requested amendments would broaden the scope of the patent protection.

(8) MSD brought the Board of Appeal's decision before Oslo District Court for review. In its judgment of 10 March 2022, the District Court declared the decision invalid, finding that the requested amendments would not broaden the scope of the patent protection, contrary to the Board of Appeal's conclusion.

(9) In a new decision of 5 May 2022, the Board of Appeal once again rejected MSD's appeal, this time on the grounds that the amendments lacked support in the patent description.

(10) Again, MSD brought the decision before the court. In its judgment of 25 July 2022, Oslo District Court declared the Board of Appeal's new decision invalid, this time based on the parties' joint application for annulment.

(11) The Board of Appeal issued another decision on 1 December 2022 – the one currently under review – once again rejecting MSD's appeal. This time, the Board of Appeal agreed with NIPO's assessment that the amendments of Claims 3 and 15 did not represent a genuine limitation of the patent's protection. The alternative set of claims was also rejected, as it could not be granted in its entirety.

(12) MSD sought the court's review of this decision as well. On 8 March 2024, Oslo District Court ruled in favour of the State represented by the Board of Appeal, and MSD was ordered to cover the State's costs.

(13) MSD appealed to Borgarting Court of Appeal, which, on 21 October 2024, ruled as follows:

> "1. The appeal is dismissed.
>
> 2. In costs before the Court of Appeal, Merck Sharp & Dohme will pay NOK 106,375 to the State represented by the Norwegian Board of Appeal for Industrial Property Rights within two weeks of service of this judgment."

(14) The Court of Appeal – like the District Court – found that the principal set of claims did not represent any limitation of the patent protection, and that the alternative set of claims had to be rejected because it could not be granted in full. The alternative set of claims did involve a limitation of the scope of the patent protection, but only as concerned the amendments of Claims 1, 5 and 6.

(15) MSD has appealed to the Supreme Court, challenging the application of the law.

The parties' contentions

(16) The appellant – *Merck Sharp & Dohme LLC* – contends:

(17) Section 39 a of the Norwegian Patents Act allows for the limitation of dependent patent claims without simultaneously limiting the associated independent claim. This interpretation is supported by the wording – which refers to "the patent claims" – and the legislative history and structure of the Act. NIPO has previously accepted amendments of dependent claims. Legal literature and Nordic law do not clearly express otherwise. Policy considerations also support this interpretation.

(18) The corresponding provision in Article 105a of the European Patent Convention (EPC) allows for the amendment of dependent claims in isolation. This is supported by Rule 95 of the Implementing Regulations, as well as the guidelines from the European Patent Office – the EPO Guidelines for Examination. EPO practice also reflects this interpretation.

(19) The interpretation of Article 105a of the EPC should carry decisive weight in interpreting section 39 a of the Patents Act. This follows from the presumption principle, as well as from the broader goal of legal uniformity in patent law, a principle supported by both the

legislature and case law. Moreover, under Protocol 28, Article 3(4) of the EEA Agreement, Norway is legally obligated to comply with the substantive provisions of the EPC. Based on the legal effects of Article 105a, it qualifies as a substantive provision.

(20) If the main set of claims is not accepted as a limitation of the patent protection, the alternative claim set nonetheless constitutes such a limitation. There is no legal basis for requiring causality between the limitations made to independent and dependent claims.

(21) Merck Sharp & Dohme LLC asks the Supreme Court to rule as follows:

> "1. The decision from the Norwegian Board of Appeal for Industrial Property Rights of 1 December 2022 in case 20/00139 B is invalid.
>
> 2. The State represented by the Norwegian Board of Appeal for Industrial Property Rights is, within two weeks of the service of this judgment, to pay costs before the Court of Appeal and the Supreme Court to Merck Sharp & Dohme LLC."

(22) The respondent – *the State represented by the Norwegian Board of Appeal for Industrial Property Rights* – contends:

(23) According to the wording of section 39 a of the Patents Act, the amendment of the patent claims must entail a limitation to the scope of the patent protection. Therefore, dependent patent claims – such as Claims 3 and 15 in the present case – may not be limited alone without also limiting the affiliated independent patent claim. The preparatory works, also, clearly express that the amendment must constitute a genuine limitation of the patent protection. This interpretation is supported by legal literature and policy considerations.

(24) International law binding on Norway does not impose any requirements regarding national rules on administrative patent limitation. This is also the case for Article 105a of the EPC, which solely governs the right to file a request with the EPO for a limitation of a European patent. Accordingly, the presumption principle does not apply. Moreover, this provision is not a substantive provision binding on Norway under the EEA Agreement, Protocol 28. The consideration of legal uniformity carries limited weight, since national rules on administrative patent limitation vary between different countries. Moreover, the practice cited by the EPO only applies to its first-instance body.

(25) The alternative set of claims can also not be accepted, as there is no connection between the amendments of Claims 3 and 15 and the limitation of the scope of the patent protection in Claims 1, 5 and 6.

(26) The State represented by the Norwegian Board of Appeal for Industrial Property Rights asks the Supreme Court to rule as follows:

> "1. The appeal is dismissed.
>
> 2. The State represented by The Norwegian Board of Appeal for Industrial Property Rights is awarded costs."

My opinion

The Supreme Court's jurisdiction

(27) The case concerns the application of the law, more specifically the interpretation of section 39 a of the Patents Act. The parties agree that the requested amendments of Claims 3 and 15 would limit these claims. They also agree that the amendments would not constitute a limitation of the total scope of the patent protection under Claim 1. The question before the Supreme Court is thus limited to the general application of the law. Accordingly, it does not require an assessment of factual circumstances where "the specific professional knowledge and broad experience" of the administrative authority calls for judicial restraint – such as in evaluating whether the ordinary conditions for patentability under section 2 of the Patents Act are met, see Rt-1975-603 *Swingball* page 606.

Administrative patent limitation

(28) A patent application must contain a *description* of the invention and *patent claims* defining the invention for which protection is sought, see section 8 subsection 2 first sentence of the Patents Act. According to the same provision, the patent claims must be clear and concise. The clarity requirement must be viewed in context with section 39 first sentence, stating that it is the content of the patent claims that determines the scope of protection, while the description only may serve as guidance, see section 39 second sentence. Since a patent grants an exclusive right to commercially exploit the invention for a limited period, see section 1 subsection 1, the interest of both the patent holder and third parties implies that the scope of protection is as foreseeable as possible.

(29) Following the grant of a patent, the patent claims may not be amended to *extend* the scope of the protection, see section 19 subsection 2. However, it is possible to *limit* the protection, both administratively under sections 39 a to 39 e, and by the courts upon application from the patent holder in connection with an action for invalidity, see section 52 subsection 1 last sentence.

(30) The possibility of administrative limitation was introduced in 1995. The background was that, if it later turns out that the patent should not have been granted, and the issue concerns only to parts of the patent, the remaining part can only be maintained if the scope can be limited to one or more of the patent claims. The right to reduce the scope of the claims would therefore increase the chances of maintaining – or "saving" – the patent, see Proposition to the Odelsting no. 59 (1994–1995) pages 17–18 and 37.

(31) The provision – which has later been adjusted – was given the following wording and included as a new section 39 a subsection 1:

> "A patent holder may request that the patent claims, and if necessary the description be amended in order to limit the scope of the patent protection (patent limitation)."

(32) For the interpretation of the provision, the distinction between independent and dependent patent claims is central.

Independent and dependent patent claim

(33) The Patents Act does not itself use the terms "independent" and "dependent" patent claims. However, the distinction is described in section 7 subsection 3 of the Patent Regulations,:

> "A patent claim may be either independent or dependent. Dependent claims relate to embodiments of an invention described in another claim within the application, and therefore include all the features of that claim. Dependent claims must begin with a reference to the preceding claim or claims to which it relates."

(34) Internationally, "independent" and "dependent" claims are used to describe the same distinction, see for example Rule 43 of the Implementing Regulations to the European Patent Convention (EPC).

(35) Since a dependent claim includes all the features of an independent claim, there can be no infringement of the dependent claim without also infringing the independent claim. The clear starting point, therefore, is that dependent claims do not affect the scope of patent protection. Here, I refer to Are Stenvik, *Patentrett* [patent law], 4th edition, 2020, page 74. The same source sets out that dependent claims are primarily of interest as fall-back claims if the validity of the patent is challenged. In Norwegian Official Report 1963:6 *Betenkning angående nordisk patentlovgivning* [report on Norwegian patent law], page 186, another purpose is mentioned – namely, that by specifying embodiments, dependent claims may help prevent others from covering these embodiments with a subsequently filed dependent patent.

(36) An additional purpose of a dependent claim – and of relevance to the present case – may be to specify combinations of the main active ingredient and another ingredient in a pharmaceutical product, in a manner sufficiently precise to ensure that the patent holder meets the requirements for obtaining a supplementary protection certificate (SPC) for the combination product. The SPC is a legal mechanism under EU law, distinct from the EPC, that offers extended protection for pharmaceutical products. It is specifically designed to address the delay between patent filing and market authorisation. Regulation (EC) No 469/2009 of the European Parliament and of the Council on such certificates applies as Norwegian law, see section 62a of the Patents Act. According to Article 3(a), a condition for obtaining a certificate is that the product is protected by a basic patent in force. The Court of Justice of the European Union has held that the combination must be "necessarily and specifically" referred to in the patent claims, which means that the specific combination must be identifiable by a person skilled in the art if it is not explicitly mentioned, see the Grand Chamber judgment of 25 July 2018 in Case C-121/17 *Teva*, paragraph 57. It is therefore not sufficient that the product falls within the scope of the patent protection, see Stenvik, page 350 et seq.

(37) The question in our case is whether section 39 a of the Patents Act permits the limitation of a dependent claim in isolation, or whether this may only occur in conjunction with a limitation of the corresponding independent claim. The key issue, as I see it, is whether international sources should carry decisive weight in the interpretation. Therefore, before turning to the international sources, I will consider what constitutes a natural interpretation regardless of those sources.

Domestic sources of law for the interpretation of section 39 a of the Patents Act

(38) Section 39 a subsection 1 currently reads:

> "A patent holder may request that the patent claims, and if necessary the description, be amended in order to limit the scope of the patent protection (patent limitation)."

(39) In my view, the *wording* clearly indicates that the provision does not allow for the amendment of a dependent claim in isolation. While it refers to the possibility of requesting amendments of "the patent claims", without distinguishing between independent and dependent claims, it also imposes a substantive requirement: the claims may only be amended "in order to limit the scope of the patent protection (patent limitation)". At the same time, the description may, "if necessary", be amended upon request, which must be understood in the light of section 39 second sentence.

(40) *The preparatory works* to the provision are relatively limited, see Proposition to the Odelsting no. 59 (1994–1995), and do not elaborate on this particular point in the statutory text. The appellant has noted that the explanatory notes to the provision state that the key consideration is that amendments must not result in an extension of the scope of patent protection, see page 37. Although it is an independent requirement that amendments must not constitute an extension, see section 39 b subsection 1, section 39 a clearly requires that the amendment must constitute a limitation.

(41) The provision was amended in 2019 to clarify that the description may not be amended in isolation. At the same time, section 39 b was revised so that NIPO is no longer required to assess whether sections 1 and 2 of the Patents Act are fulfilled for the limited patent. These amendments were made to align the legal framework more closely with the EPC, as well as Swedish and Finnish law, see Proposition to the Storting no. 52 L (2018–2019) page 26. However, the same source emphasises that NIPO must still assess whether the request entails "a genuine limitation of the patent." In the explanatory note to the legislative amendment on page 44, this is expressed as follows:

> "That a patent limitation may only be granted where there is a genuine limitation of the patent already follows from subsection 1, which states that the request must concern an amendment that results in a 'limitation of the scope of the patent protection'. It is therefore unnecessary to further specify in the statutory text that NIPO may only grant the request where it involves a genuine limitation of the patent protection.

(42) I have already mentioned the *purpose* of administrative limitation. Amendments of the patent claims that do not limit the scope of the patent will, as a general rule, not contribute to preserving the patent.

(43) I also refer to the *broader legal context*, particularly the relationship to section 52 subsection 1 final sentence of the Patents Act, which states that in invalidity proceedings, if the patent is partly invalid, the courts may maintain the patent "in limited form by amending the patent claims in accordance with a request from the patent holder". This possibility was introduced in 2007, following Norway's accession to the EPC, which in Article 138(3) states that the patent holder must have the right to limit the patent. The purpose of this amendment mirrors that of administrative patent limitation under section 39 a – to provide an opportunity to preserve an otherwise invalid patent by limiting it – which gives little reason to assume that the right to limit dependent claims should be treated differently. In the explanatory notes to

the amendment in Proposition to the Odelsting no. 33 (2006–2007), it is stated that the amendment must result in a genuine limitation. Dependent claims are mentioned, but primarily in connection with amendments of independent claims, see page 20.

> "It is further a requirement that the limitation occurs through an amendment of the patent claims, and that the amendment effectively results in a limitation of the scope of the patent protection. The amendment may for example consist of merging an independent claim with one or more dependent claims, or with parts of such claims. The amendment may also consist of incorporating provisions from the description into the patent claims."

(44) *Administrative practice* is inconsistent and limited. In a few cases, NIPO has accepted amendments of dependent claims, but in the present case, both NIPO and the Board of Appeal have concluded that such amendments are not permitted.

(45) I further understand *legal literature* to presuppose that dependent claims may not be amended in isolation. I refer to Stenvik, page 110, which states that an amendment under section 39 a must entail a genuine limitation, meaning that something previously covered by the patent claims is no longer covered. It is further noted that limitation may occur by incorporating additional features into independent claims from dependent claims or from the description, or by replacing general formulations with specific ones. It is natural to read this in conjunction with the statement on page 74, which I have previously addressed in my discussion of independent and dependent patent claims, that from a protection perspective, a dependent claim has no value.

(46) In my view, the domestic legal sources clearly suggest that dependent claims may not be amended in isolation, although they offer only limited discussion of the *relevant policy considerations*. It could be argued that third-party interests carry little weight, as long as the protection is not extended or does not include anything that was not disclosed in the original application, see section 39 b subsection 1. However, neither the wording of the provision nor the preparatory works place particular emphasis on such considerations. The requirement in section 39 a, that the amendment must constitute a limitation of the patent, is a distinct requirement in addition to those in section 39 b.

International conventions and foreign law

(47) The European Patent Convention (EPC) of 1973 was ratified by Norway in 2007. It establishes a European patent application system, whereby an applicant may obtain patent protection in all Contracting States through a centralised examination of the application by the European Patent Office (EPO). Patents granted by the EPO are referred to as *European patents*.

(48) National rules on European patents are set out in Chapter 10a of the Patents Act. For a European patent to have effect in Norway, it must be designated for Norway, a translation must be submitted to NIPO and the prescribed fee must be paid, see section 66 b subsection 1, and section 66 c subsection 1. If the patent is thereby validated in Norway, it has the same effect as patents granted by NIPO and is subject to the same conditions, see section 66 b subsection 1, and Article 2(2) of the EPC. Furthermore, section 66 b subsection 2 provides that a decision from the EPO to limit a European patent has the same effect in Norway as corresponding decisions made by NIPO. The patent in our case – the 999 patent – is not a European patent, which means that only NIPO has the authority to limit it.

(49) The European Patent Office's authority to limit a European patent was introduced in connection with the revision of the EPC in 2000, largely for the same purpose as section 39 a of the Patents Act, see the proposal from the President of the EPO dated 8 November 1999, CA/PL 29/99, point 5. Article 105a, first and second sentences, reads as follows:

> "At the request of the proprietor, the European patent may be revoked or be limited by an amendment of the claims. The request shall be filed with the European Patent Office in accordance with the Implementing Regulations."

(50) Thus, as with section 39 a, it is a requirement that the patent becomes limited. According to the Implementing Regulations, to which the provision refers, the EPO must examine "whether the amended claims constitute a limitation vis-à-vis the claims as granted…", see Rule 95 subsection 2. As opposed to the appellant, I do not see that this wording presupposes that dependent claims may be limited in isolation.

(51) However, the EPO has issued guidelines for the processing of applications. The guidelines for the processing of requests for patent limitation are as follows, see point 4.3.1 in Part D Chapter X-3:

> "The term 'limitation' is to be interpreted as meaning a reduction in the extent of protection conferred by the claims. Mere clarifications or changes made to protect a different subject ('*aliud'*) are not to be considered as limitations.
>
> More particularly, the limitation of a dependent claim only, without any independent claim being limited, is acceptable. However, it is not permissible to introduce non-limiting amendments in the description or in the claims that are not a consequence of the limitation of the claims (for example tidying up unclear claims, making amendments of improve the patent or cosmetic changes). Likewise, adding dependent claims in limitation is not permissible if not directly caused by the limitation introduced in the claims."

(52) Despite the description of "limitation" in the first paragraph, it is clear from the second paragraph that a dependent claim may be limited in isolation. The guidelines are issued by the President of the EPO, based on Article 10(2)(a) of the EPC, stating that the President may adopt internal administrative instructions. The Boards of Appeal, however, are independent and may not be instructed, see Article 23(3). I therefore proceed on the basis that the guidelines do not apply to these, but are limited to ensuring uniform practice in the first instance. A reservation must be made for the possibility that the guidelines have incorporated practice from the Boards of Appeal, but I am not aware of any such decisions relevant to our question.

(53) Practice from the first instance within the EPO appears to follow the interpretation in the guidelines. However, the case law is not extensive – 23 cases have been presented over the more than ten years the guidelines have had this wording – and the decisions are not reasoned.

(54) Although there is no authoritative clarification, the wording of the guidelines and the cited case law suggest that a request to the EPO for the limitation of a dependent claim in isolation is likely to be accepted. The question, then, is what implications this has for the interpretation of section 39 a of the Patents Act.

(55) A preliminary question is whether Norway is bound by this interpretation under the *EEA Agreement*. Part IV of the EEA Agreement, concerning competition rules and other joint

provisions, refers in Article 65(2) to Protocol 28 on intellectual property. Article 3 of Protocol 28 concerns "community patents", which was a long-standing initiative that ultimately did not bear fruit. The work on a common EU patent has continued, but in a form that does not include all EU Member States, nor the EFTA States. When the EEA Agreement was concluded, it was still anticipated that the EFTA States might join the "Community patent" system. Therefore, Protocol 28 included a condition that the EFTA States, in their national legislation, must follow "the substantive provisions" of the EPC, see Articles 3(3) and 4.

(56) However, I do not consider Article 105a to constitute a substantive provision under Protocol 28. The provision is found in Part V of the EPC, governing the "Opposition and limitation procedure", rather than in Part II on "Substantive patent law", which contains the core provisions on patentability, entitlement and the legal effects of patents and patent applications. While it is true that the limitation of a patent has substantive implications, the same can be said of other provisions outside Part II, such as those governing the handling of invalidity oppositions. It has long been understood that Norwegian substantive patent law has been fully harmonised with the EPC since the early 1990s, see Proposition to the Storting no. 53 (2006–2007) regarding consent to ratification of the EPC, page 8. The ratification therefore resulted in only marginal amendments to Chapters 1 and 2 of the Patent Act, see Proposition to the Odelsting no. 33 (2006–2007) page 19. Furthermore – as I will return to – Article 105a does not impose obligations on national law, unlike provisions of a purely substantive nature. I also note that Article 105a was only introduced into the EPC during the 2000 revision; that is, after the EEA Agreement was concluded. Therefore, the provision was not among those considered when the EEA Agreement was entered into. In my view, Norway has thus not, through the EEA Agreement, undertaken an obligation to adopt the same rules for administrative patent limitation as those set out in the EPC.

(57) The next question is whether the *presumption principle* requires that section 39 a must be interpreted in the same manner as Article 105a of the EPC. The principle entails that Norwegian law must, as far as possible, be interpreted in conformity with our international obligations. However, Article 105a concerns the EPO's handling of European patents and does not obligate the Contracting States to adopt identical national rules.

(58) Finally, a relevant question is whether *considerations of legal uniformity* should lead to a corresponding interpretation. Although the EPC does not, in this respect, impose obligations on the Contracting States' national patent law, legal uniformity is an independent consideration in the field of patent law. See Rt-2008-1555 *Biomar* paragraph 51, which stresses the significance that developments within Europe are characterised by uniform regulation and practice in the patent field. It is also stated that this must be based on an independent assessment – particularly with regard to which instance within the EPO has issued the decision – when determining the weight to be given to EPO practice. The judgment concerned a situation from before Norway's accession to the EPC, but dealt with substantive patent rules, which Norway was in any case obliged to follow under the EEA Agreement.

(59) Stenvik, also, refers to EPO practice as an important legal source, see pages 45–46. Arne Ringnes does the same in his article *Høyesterett og immaterialretten* [the Supreme Court and intellectual property law] in Tore Schei et al. (eds.), *Lov, sannhet, rett. Norges Høyesterett 200 år, 2015*, [Law, truth, justice. The bicentennial of the Supreme Court of Norway], page 888. At the same time, he notes that EPO practice is fragmentary and partly characterised by a formalistic approach that may be foreign to Norwegian legal tradition.

(60) Considerations of legal uniformity are particularly compelling with respect to substantive patent provisions, but in my view, they also carry weight for other provisions with a clear substantive aspect, such as the possibility of patent limitation. For European patents validated in Norway, the patent holder may obtain a limitation based on EPO practice by submitting a request to the EPO, which has effect for the European patent as such, and thereby also for the national patent, see section 66 b subsection 2 of the Patents Act. It may be argued that it should not be decisive whether the application is decided by the EPO or by NIPO. However, for patents not granted by the EPO – as in the present case – it is not possible to apply to the EPO for patent limitation.

(61) Nonetheless, equal treatment of European patents, regardless of whether the case is decided by NIPO or the EPO, is only one aspect of the consideration of legal uniformity. Another aspect concerns legal uniformity with the national patent laws of other countries. The same patent is often granted in multiple countries, even when it is not a European patent. The information on foreign law presented in this case shows that there is no common approach to the issue at hand. Switzerland – and, as I understand it, also Germany – does not accept limitation of dependent claims alone, in contrast to France and the United Kingdom. The other Nordic countries have similar wording in their patent legislation as that found in section 39 a of the Patents Act. However, no case law from the Nordic countries has been presented regarding the interpretation of this provision.

Overall assessment

(62) In weighing legal sources more closely, I consider it significant, on the one hand, how clear the domestic sources are, and on the other hand, how authoritative the interpretation of the EPC is, and whether this corresponds to the patent laws of other countries.

(63) The wording in section 39 a clearly suggests that dependent claims may not be limited in isolation. This interpretation is supported by the preparatory works to subsequent amendments. However, a similar wording in Article 105a of the EPC has been understood differently in the EPO's guidelines and in EPO practice, although no decision from the Boards of Appeal exists. The patent laws of other countries vary.

(64) The legislature has not always chosen the alternative that aligns with the EPC. In Proposition to the Storting 52 L (2018–2019), the Ministry opted for a divergent solution regarding the consequences of missing a deadline, see section 72 of the Patents Act. This question also has a substantive side. The Ministry notes in its assessments on pages 15–16, that policy considerations argue for a more lenient rule, that the consideration of harmonisation carries less weight when it comes to procedural rules, and that there is no legal uniformity in this area.

(65) The legislature has not conducted a comparable assessment in the present context. The background appears to be that the Ministry assumed that the EPO evaluates whether a genuine limitation of the patent exists, see the mentioned proposition, page 22 – an assumption that does not appear entirely accurate. The preparatory works therefore do not address the considerations for or against allowing the amendment of a dependent patent claim in isolation. Nor have these considerations been sufficiently clarified by the parties in the present case. The same applies to factors that may be particularly relevant to the underlying purpose of the amendment request – as I understand it – namely, to safeguard an SPC approval in the light of

the requirements established by the Court of Justice of the European Union. In a technical field such as this, one that governs private law rights while also considering societal interests, I believe there is good reason to exercise caution before extending the statutory provision beyond its wording and the considerations explicitly addressed by the legislature.

(66) The solution does not appear to be clear, but I have concluded that section 39 a of the Patents Act must be understood to mean that the scope of patent protection must be genuinely limited. The provision therefore does not allow for a dependent patent claim to be limited in isolation.

Individual assessment

(67) The *principal* set of claims involves an amendment of Claims 3 and 15. The parties agree that the amendments entail limitations of these claims, respectively by inserting in Claim 3 a specific combination of sitagliptin "and a biguanide, such as metformin", and in Claim 15 by inserting a specific combination of sitagliptin "and metformin".

(68) The parties further agree that Claim 3 is a dependent claim. The description of the claim falls entirely within the scope of the independent Claim 1 and refers to that claim. The parties do not agree, however, on whether Claim 15 is a dependent claim. It is undisputed that the wording of Claim 15 also falls entirely within the scope of Claim 1, see section 7 subsection 2 second sentence of the Patent Regulations. However, the claim does not explicitly refer to Claim 1, see the third sentence of the same provision. In any event, the parties agree that Claim 15, both before and after the amendment, falls within the scope of Claim 1. Accordingly, the amendment of Claim 15 also does not constitute a limitation of the scope of the patent protection.

(69) Since neither the amendment of Claim 3 nor of Claim 15 results in any limitation of the overall scope of the patent protection, the Board of Appeal was correct in not granting the request for amendment.

(70) The *alternative* claim set entails a limitation of the scope of the patent protection. In addition to the amendments of Claims 3 and 15, amendments have also been made to Claims 1, 5 and 6, where the description of the phenyl group in the chemical formula for sitagliptin has been altered from "phenyl which is unsubstituted or substituted with …" to "phenyl which is substituted with …". The amendments of Claims 1, 5 and 6 could, in isolation, be accepted, as the scope of Claim 1 – the independent claim – would be limited. However, the amendments of Claims 3 and 15 are unrelated to these amendments. I do not find that amendments falling outside the scope of section 39 a may be accepted merely because they are submitted alongside amendments that fall within the scope of the provision, when the amendments are not interconnected.

(71) Furthermore, a request for amendments may only be granted in full or rejected, see Proposition to the Odelsting no. 59 (1994–1995) page 37. The Board of Appeal was also correct in rejecting the request involving the alternative set of claims.

Conclusion and costs

(72) Against this background, I have concluded that the appeal must be dismissed.

(73) The State represented by the Board of Appeal is entitled to compensation for its legal costs under the main rule in section 20-2 subsection 1 of the Dispute Act. Although the outcome is not entirely clear, I find no grounds to grant an exemption in a matter of this nature. The State has claimed costs in the amount of NOK 299,700. This claim reflects a slightly higher number of hours than claimed by the appellant, which is likely due to a change of counsel. However, the change was not due to circumstances on the State's part. The costs appear both necessary and reasonable, and the claim is upheld.

(74) I vote for this

J U D G M E N T :

1. The appeal is dismissed.

2. In costs before the Supreme Court, Merck Sharp & Dohme LLC will pay to the State represented by the Norwegian Board of Appeal for Industrial Property Rights NOK 299,700 within two weeks of the service of this judgment.

(75) Justice **Sæther:** I agree with Justice Hellerslia in all material respects and with his conclusion.

(76) Justice **Bergh:** Likewise.

(77) Justice **Thyness:** Likewise.

(78) Justice **Webster:** Likewise.

(79) Following the voting, the Supreme Court gave this

J U D G M E N T :

1. The appeal is dismissed.

2. In costs before the Supreme Court, Merck Sharp & Dohme LLC will pay to the State represented by the Norwegian Board of Appeal for Industrial Property Rights NOK 299,700 within two weeks of the service of this judgment.