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D E C I S I O N
of 10 February 2006

Case Number: T 1168/02 - 3.3.02

Application Number: 97903101.0

Publication Number: 0893986

IPC: A61K 7/42

Language of the proceedings: EN

Title of invention:
Photoprotective compositions

Applicant:
THE PROCTER & GAMBLE COMPANY

Opponent:

-

Headword:
Photoprotective compositions/THE PROCTER & GAMBLE

Relevant legal provisions:
EPC Art. 82, 123(2), 54

Keyword:
"Main request: Admitted into the proceedings"
"Unity of invention given in view of a common general
inventive concept"
"Amendments allowable and novelty (yes) "

Decisions cited:

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Catchword:

-



Case Number: T 1168/02 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 10 February 2006

Appellant:

THE PROCTER & GAMBLE COMPANY
One Procter & Gamble Plaza
Cincinnati
Ohio 45202 (US)

Representative:

Wilding, Richard Alan
Procter & Gamble Technical Centres Limited
Patent Department
Rusham Park
Whitehall Lane
Egham
Surrey TW20 9NW (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 11 July 2002
refusing European application No. 97903101.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: M. C. Ortega Plaza
J. Willems

Summary of Facts and Submissions

I. European patent application No. 97 903 101.0 based on international patent application WO 97/28785 was filed with 10 claims. Claim 1 read as follows:

- "1. A photoprotective composition comprising:
- (a) from 0.1% to 30% of a sunscreen active;
 - (b) from 0.5% to 20% of a hydrophobic, structuring agent selected from the group consisting of saturated C₁₆ to C₃₀ fatty alcohols, saturated C₁₆ to C₃₀ fatty alcohols containing from 1 to 5 moles of ethylene oxide, saturated C₁₆ to C₃₀ diols, saturated C₁₆ to C₃₀ monoglycerol ethers, saturated C₁₆ to C₃₀ hydroxy fatty acids, and mixtures thereof, having a melting point of at least 40°C;
 - (c) from 0.2% to 10% of a hydrophilic surfactant selected from the group consisting of nonionic surfactants, anionic surfactants, cationic surfactants, zwitterionic surfactants, amphoteric surfactants, and mixtures thereof; and
 - (d) from 0.1% to 5% of a thickening agent selected from the group consisting of carboxylic acid polymers, crosslinked polyacrylate polymers, polyacrylamide polymers, polysaccharides, gums, crosslinked vinyl ether/maleic anhydride copolymers, crosslinked poly(N-vinylpyrrolidones), and mixtures thereof, and
 - (e) from 25% to 99.1% water."

II. The following documents were cited inter alia during the proceedings:

- (1) WO 94/02176

- (2) EP-A-0 193 387
- (3) WO 94/15580
- (4) WO 89/10738
- (5) AU-A-5 9330/94
- (6) WO 96/37179
- (7) WO 97/14680
- (8) WO 97/21421
- (9) EP-A-0 747 043
- (10) EP-A-0 754 446.

III. The appeal lies from a decision of the examining division refusing the patent application under Article 97(1) EPC pursuant to the requirements of Articles 82 and 84 EPC.

IV. The examining division considered that the subject-matter claimed (set of claims filed with the letter of 1 May 2002) contravened the requirements of Article 84 EPC since there was an inconsistency between claim 1 and the description concerning the definition of the expression "hydroxy fatty acid". Additionally, according to the examining division's findings, there was also a problem of support for claim 2 as far as it referred to amended claim 1.

With respect to the requirements of Article 82 EPC, the examining division considered that there was a lack of unity *a posteriori* in the light of documents (6) and (7).

As further grounds for its decision, the examining division mentioned that the relevant background, in particular documents (5) to (7), was not cited in the

- description (Rule 27(1)(b) EPC) and that the description had not been adapted to the amended claims.
- V. The appellant (applicant) lodged an appeal against said decision and supported it with arguments in its grounds of appeal. Moreover, it filed with its notice of appeal a main set of claims and a (first) auxiliary request.
- VI. A communication from the board dated 28 January 2005 raised objections within the meaning of Article 123(2) EPC against claims 1 and 2 of the main request and claim 1 of the (first) auxiliary request.
- VII. The appellant filed with its response of 25 April 2005 a new main request, and a first and a second auxiliary requests.
- VIII. A communication from the board dated 16 June 2005 conveyed the board's preliminary opinion in respect of Articles 123(2) and 54(2) and (3) for the requests filed with the letter of 25 April 2005.
- IX. The appellant filed with its response of 17 August 2005 a new main request and first, second and third auxiliary requests.
- X. The appellant was informed in a telephone conversation on 20 September 2005 (followed by a fax) about the rapporteur's non-binding opinion in respect of the requests filed with the letter of 17 August 2005.

- XI. In a telephone conversation on 7 October 2005 the appellant informed the board that it maintained all its requests filed with the letter of 17 August 2005 as well as its request for oral proceedings.
- XII. Oral proceedings were scheduled for 30 January 2006.
- XIII. The appellant filed with its response of 3 January 2006 a new main request (sole request).

Claim 1 of the main request reads:

"1. A photoprotective composition comprising:
(a) from 0.1% to 30% of a sunscreen active comprising zinc oxide;
(b) from 0.5% to 20% of a hydrophobic structuring agent selected from the group consisting of stearyl alcohol, cetyl alcohol, behenyl alcohol, polyethylene glycol ether of stearyl alcohol having an average of 2 ethylene oxide units, and mixtures thereof;
(c) from 0.2% to 10% of a hydrophilic surfactant selected from the group consisting of nonionic surfactants, anionic surfactants, cationic surfactants, zwitterionic surfactants, amphoteric surfactants, and mixtures thereof;
(d) from 0.1% to 5% of a polyacrylamide polymer having a molecular weight from 1,000,000 to 30,000,000; and
(e) from 25% to 99.1% water."

- XIV. In a communication from the board sent by fax on 10 January 2006, the board gave its preliminary opinion in respect of the new main request filed on 3 January 2006 and asked the appellant whether it still maintained its request for oral proceedings.

XV. With the response dated 10 January 2006 the appellant stated that: "On the condition that the board of appeal remits the present case to the first instance for further prosecution, then applicants withdraw their request for oral proceedings before the board of appeal".

XVI. With the official communication dated 16 January 2006 the appellant was informed that the oral proceedings were cancelled.

XVII. The arguments submitted in writing by the appellant may be summarised as follows:

The set of claims filed with the letter of 3 January 2006 should not be considered as filed too late, since its filing was made in an effort to overcome all the objections raised by the board during the appeal proceedings.

The basis for amended claim 1 was to be found in originally filed claims 1, 7 and 8 from which the sunscreens 2-ethylhexyl p-methoxycinnamate and 4,4'-methoxy-t-butylidibenzoylmethane have been deleted. Claims 2 and 3 corresponded to originally filed claims 9 and 10 respectively. The compositions exemplified in the description as originally filed were representative of the subject-matter now claimed.

As regards Article 82 EPC, the examining division's decision was contested by the appellant since the reference to the "prior art" in Rule 30(1) EPC relating to the contribution to be made by the special technical

features could not be considered to include documents under Article 54(3) EPC such as documents (6) and (7). The appellant stressed that for raising an objection of lack of unity *a posteriori* the precondition of an analysis of the technical problem or problems underlying the invention had to be fulfilled. Therefore, documents under Article 54(3) EPC, of which the appellant could not have been aware at the date of filing, could not be taken as relevant for that purpose.

The subject-matter of amended claim 1 related to photoprotective compositions characterised by the simultaneous presence of zinc oxide and a specific thickener class, namely a polyacrylamide polymer. The combination of these features was neither disclosed nor suggested in the state of the art.

XVIII. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the set of claims filed with the letter of 3 January 2006.

Reasons for the Decision

1. *Admissibility*

1.2 The appeal is admissible.

1.3 The late-filed request (set of claims filed with the letter of 3 January 2006) is admitted into the proceedings since it was made in a fair effort to overcome the pending objections pursuant to Articles 123(2) and 84 EPC, raised by the board during

the written proceedings, in order to achieve a proper delimitation vis-à-vis the specific compositions disclosed in a document relevant under Article 54(3) EPC, namely document (6). Moreover, the amendments were of a clear and simple nature and hence easy to handle.

2. *Main request*

2.1 The examining division's decision fails since a lack of unity *a posteriori* by reference to a single inventive concept as mentioned in Rule 30(2) EPC cannot be based on documents forming part of the state of the art within the meaning of Article 54(3) EPC.

2.2 Accordingly, in the absence of other relevant prior art, the subject-matter claimed in the main request must be regarded as linked by a common general inventive concept and shares the same special technical features which define its contribution over the prior art, namely the simultaneous presence of zinc oxide and the specific polyacrylamide polymer thickener. Therefore, the requirements of Article 82 EPC are met. The corresponding adaptation of the description may take place after the assessment of inventive step by the first instance.

2.3 The objections within the meaning of Article 84 EPC raised by the examining division against the expression "hydroxy fatty acid" no longer apply since the expression no longer appears in the claim's wording.

2.4 Claim 1 of the main request is based on originally filed claims 1, 2, 3 and 7 and the originally filed description. In particular, the specification of the

structuring agent present is made according to the originally filed description (page 6, second paragraph, "More preferred structuring agents..." of WO 97/28785 which corresponds to the application as filed), in which one specific meaning has been deleted.

The specification of zinc oxide as a component of the sunscreen active becomes apparent from the reading of the description taken as a whole; specifically the presence of zinc oxide is stressed on page 3, end of third paragraph from the bottom. Claims 2 and 3 correspond to originally filed claims 9 and 10. Therefore, the set of claims of the main request meets the requirements of Article 123(2) EPC.

Finally, the examples are representative of the claimed invention.

- 2.5 None of the cited documents discloses compositions which comprise all the components defined in claim 1 of the main request: in particular the prior art compositions do not comprise simultaneously zinc oxide and a polyacrylamide polymer having a molecular weight from 1,000,000 to 30,000,000.

Therefore, the subject-matter claimed meets the requirements of Article 54(1) (2) and (3).

3. The first-instance decision is based on a much broader set of claims and only concerns the assessment of unity of invention and clarity. Therefore, the board has decided to make use of its discretionary power under Article 111(1) EPC to remit the case to the first instance in order not to deprive the appellant of

having the essential issue of inventive step assessed by two instances.

Moreover, an adaptation of the description to the amended claims (as mentioned in point 2.1 above) and the acknowledgment of prior art pursuant to Rule 27(1)(b) may take place after the first instance's assessment of inventive step for the claimed subject-matter.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the set of claims filed with the letter of 3 January 2006.

The Registrar:

The Chairman:

A. Townend

U. Oswald