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**Datasheet for the decision
of 18 February 2009**

Case Number: T 1453/06 - 3.3.02

Application Number: 99940086.4

Publication Number: 1104281

IPC: A61K 7/26

Language of the proceedings: EN

Title of invention:

Incorporation of exogenous lactic bacteria into the oral microflora

Applicant:

SOCIETE DES PRODUITS NESTLE S.A.

Opponent:

-

Headword:

Lactic bacteria/SOCIETE DES PRODUITS NESTLE S.A.

Relevant legal provisions:

EPC Art. 123(2), 111

Relevant legal provisions (EPC 1973):

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Keyword:

"Article 123(2) (yes): basis for claim 1 in the original application"

"Remittal (yes): undecided issues"

Decisions cited:

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Catchword:

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Case Number: T 1453/06 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 18 February 2009

Appellant: SOCIETE DES PRODUITS NESTLE S.A.
Case postale 353
CH-1800 Vevey (CH)

Representative: Straus, Alexander
Patentanwälte
Becker, Kurig, Straus
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 2 March 2006
refusing European application No. 99940086.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: A. Lindner
J.-P. Seitz

Summary of Facts and Submissions

- I. European patent application No. 99 940 086.4 was refused by a decision of the examining division of 3 February 2006 on the basis of Article 97 EPC on the grounds that the subject-matter of claim 1 was not in accordance with the requirements of Article 123(2) EPC.
- II. The decision was based on claims 1-14 of the sole request filed at the oral proceedings of 3 February 2006.

Independent claim 1 of this request reads as follows:

"1. Use of lactic bacteria capable of displacing pathogens of the teeth or preventing their attachment characterized in that said lactic acid bacteria:

- i) is not part of the resident microflora of the mouth,
- ii) is capable of adhering directly to the pellicle of the teeth, i.e. having a percentage of adhesion to saliva-coated hydroxyapatite beads of at least 1.96 after adhesion during 45 min at 37°C, and
- iii) is less acidifying than pathogenic strains,

for the preparation of a composition intended for the prophylaxis or the treatment of dental caries, dental plaque and periodontal infection."

III. The arguments in the decision may be summarised as follows:

Feature ii) of claim 1 was not in accordance with the requirements of Article 123(2) EPC, as the value of 1.96 (percentage of adhesion) had been arbitrarily selected from specific screening tests involving a specific strain. This value was then generalised to constitute the lower end of a range which was applicable to any bacterial strain. Such a generalisation was not allowable under Article 123(2) EPC.

IV. The appellant (applicant) lodged an appeal against said decision.

V. The appellant filed a new main request together with the statement of the grounds of appeal dated 3 July 2006.

VI. In the official communication of 19 June 2008, the board raised objections under Articles 83 and 123(2) EPC in connection with the new main request.

VII. With his letter dated 27 October 2008, the appellant filed a new main request. The independent claim 1 reads as follows:

"1. The use of lactic bacteria that is not part of the resident microflora of the mouth, and that is low acidifying and is capable of adhering directly to the pellicle of the teeth, for the preparation of a composition intended for the prophylaxis or the treatment of dental caries, dental plaque and

periodontal infection, wherein at least one lactic bacteria is selected from the group consisting of the strains CNCM I-1984, CNCM I-1985, CNCM I-1986, CNCM I-1987 and LMG P-18997."

- VIII. In connection with the amendments made in claim 1, the appellant essentially argued that the requirements of Article 123(2) EPC were met, as the subject-matter of claim 1 was now a combination of original claims 1 and 6.
- IX. The appellant requested that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution on the basis of claims 1-20 filed with letter dated 27 October 2008. Oral proceedings were requested as an auxiliary request.

Reasons for the decision

1. The appeal is admissible.
2. Claim 1 - Article 123(2) EPC:

The subject-matter of claim 1 is a combination of original claims 1 and 6. Original claim 6 is a dependent claim referring back to any of the preceding claims including original claim 1. As a consequence, the subject-matter of claim 1 of the main and sole request meets the requirements of Article 123(2) EPC.

3. Remittal to the first instance:

3.1 Although Article 111(1) EPC does not guarantee an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party should where possible be given the opportunity to have two readings of the important elements of the case. The essential function of an appeal is to consider whether the decision which has been issued by the first-instance department is correct. Hence, a case is normally referred back if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is taken into consideration by the boards in cases where a first-instance department issues a decision solely upon some particular issues which are decisive for the case and leaves other essential issues outstanding. If, following appeal proceedings, the appeal on the particular issues is allowed, the case is normally remitted to the first-instance department for consideration of the undecided issues.

3.2. The observations and comments made above apply fully to the present case. The examining division decided that the subject-matter of claim 1 was not allowable under Article 123(2) EPC, but left out other essential issues such as novelty or inventive step (Articles 52(1), 54, 56 EPC) as well as the assessment of the further claims in general. These issues, however, form, inter alia, the basis for the examination of the application and

must therefore be considered as essential substantive issues in the present case.

- 5.3. Thus, in view of the above considerations, the board has reached the conclusion that, in the circumstances of the present case, it is necessary to remit the case to the examining division for further prosecution on the basis of the set of 20 claims filed on 27 October 2008.

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 main request filed with letter dated 27 October 2008.

The Registrar:

The Chairman

N. Maslin

U. Oswald