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**Datasheet for the decision  
of 13 November 2008**

**Case Number:** T 0892/07 - 3.3.10

**Application Number:** 03254232.6

**Publication Number:** 1493430

**IPC:** A61K 7/48

**Language of the proceedings:** EN

**Title of invention:**

Self-tanning compositions comprising a water-soluble vitamin B3 compound and an alpha-hydroxycarbonyl self-tanning agent

**Applicant:**

THE PROCTER & GAMBLE COMPANY

**Opponent:**

-

**Headword:**

Self-tanning compositions/PROCTER & GAMBLE

**Relevant legal provisions:**

EPC Art. 54, 111(1)

**Keyword:**

"Novelty (yes) - use claim - not anticipated by properties or effects inherent in the prior art - combination of features"  
"Remittal (yes)"

**Decisions cited:**

G 0002/88, G 0006/88, G 0010/93, T 0666/89, T 0941/98

**Catchword:**

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Case Number: T 0892/07 - 3.3.10

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.10  
of 13 November 2008

**Appellant:**

THE PROCTER & GAMBLE COMPANY  
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**Representative:**

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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted 15 January 2007  
refusing European application No. 03254232.6  
pursuant to Article 97(1) EPC (1973).**

**Composition of the Board:**

**Chairman:** R. Freimuth  
**Members:** J.-C. Schmid  
F. Blumer

## Summary of Facts and Submissions

- I. The appeal lodged on 15 March 2007 lies from the decision of the Examining Division dated 15 January 2007 refusing European patent application No. 03254232.6 (European publication No. 1 493 430).
- II. The following documents were cited in the examination proceedings:
- (1) DE-A-44 41 470,
  - (2) WO-A-01/00164 and
  - (3) WO-A-00/62740.

In the decision under appeal, the Examining Division held that documents (2) and (3) anticipated the subject-matter of claim 1 of the then pending request.

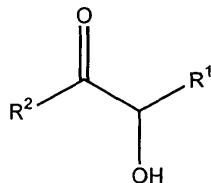
According to the Examining Division, compositions as described in that claim 1, were known from documents (2) and (3) to be used to enhance the coloration of the skin. The skilled person was aware that dihydroxyacetone was the best-known standard example of artificial tanning actives. The amount of 3% used in the examples of document (2) was fairly high and might be expected to tan the skin. The disclosure of a composition containing a tanning amount of a tanning active implied the use of the composition for tanning. Furthermore dihydroxyacetone was explicitly disclosed in document (3) as an artificial tanning active thus clearly indicating the use of the compositions containing dihydroxyacetone as self-tanning compositions.

Since the wording "to synergistically enhance the coloration of the skin" was not suitable to introduce a novelty establishing feature, the subject-matter of claim 1 lacked novelty with respect to documents (2) and (3).

III. At the oral proceedings before the Board held on 13 November 2008 the Appellant (Applicant) no longer maintained the former requests. He submitted a fresh set of eight claims superseding any previous request.

The sole independent claim of that request read as follows:

"1. Use of a cosmetic composition having a pH from 3.0 to 5.5 comprising a water-soluble vitamin B<sub>3</sub> compound and an  $\alpha$ -hydroxyaldehyde self-tanning agent conforming to the formula;



wherein R<sup>1</sup> is H, CH<sub>2</sub>OH, CHOHCH<sub>2</sub>OH, CH(OH)CH(=O), CH(OCH<sub>3</sub>)CH(=O), CH(NH<sub>2</sub>)CH(=O), or CH(NH-Phenyl)CH(=O); and R<sup>2</sup> is H or CH<sub>2</sub>OH as a self-tanning composition, wherein said water-soluble vitamin B<sub>3</sub> compound is niacinamide or niacinamide N-oxide."

IV. The Appellant submitted that the amendments in claim 1 were supported by the application as filed. The pH of the compositions have been specified according to page 4, line 12 of the application as filed while the vitamin B<sub>3</sub> has been restricted to niacinamide or

niacinamide N-oxide according to page 8, lines 2 and 6 of the application as filed.

The subject-matter of claim 1 was novel with respect to document (1) on account of the presence of niacinamide or niacinamide N-oxide in the compositions used.

Document (2) disclosed cosmetic compositions that provide good moisturisation, hydration, skin feel, skin softness and/or skin smoothness exemplified inter alia by working examples 7, 20, 33 and 48 comprising niacinamide and dihydroxyacetone. Dihydroxyacetone was an ingredient which can be used for many purposes. From the penultimate paragraph on page 12 in combination with the two last paragraphs of page 2 of document (2), it was clear that dihydroxyacetone was used in the compositions disclosed in document (2) as a thermosensitive skin benefit agent to provide good moisturisation, hydration, skin feel, skin softness and/or skin smoothness. The compositions disclosed in document (2) were therefore not disclosed as self-tanning compositions.

Document (3) disclosed no specific composition comprising the combination of niacinamide with dihydroxyacetone. The compositions described in document (3) were disclosed for regulating the condition of mammalian skin, especially for regulating visible or tactile discontinuities in skin. An optional ingredient was a tanning active, e.g. dihydroxyacetone. However, the adding of a tanning active in the compositions did not change the disclosed intended use of the composition, which thus remained the treatment

of the skin for regulating visible or tactile discontinuities.

The subject-matter of the claims were therefore novel with respect to documents (1) to (3).

- V. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the claims 1 to 8 submitted during the oral proceedings before the Board.
- VI. At the end of the oral proceedings the decision of the Board was announced.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Scope of examination on appeal*

While Article 111(1) EPC gives the Boards of Appeal the power to raise new grounds in ex-parte proceedings where the application has been refused on other grounds, proceedings before the Boards of Appeal in ex-parte cases are primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons), other objections normally being left to the Examining Division to consider after a referral back, so that the Appellant has the opportunity for these to be considered without loss of an instance.

In the present case the Board, thus, restricts itself to examine whether the amended claims meet the formal requirement of Article 123(2) EPC and that of novelty which is stated in the decision under appeal as being the sole ground for refusal of the application.

3. *Amendments (Article 123(2) EPC)*

Claim 1 is based on original claim 1, wherein the pH of the compositions has been specified according to page 4, line 12 of the application as filed and the vitamin B<sub>3</sub> has been restricted to niacinamide and niacinamide N-oxide according to page 8, lines 2 and 6 of the application as filed.

3.1 Claim 1 therefore does not extend the subject-matter claimed beyond the content of the application as filed, thus satisfying the provision of Article 123(2) EPC.

3.2 Dependent claims 2 to 8 are backed up by original claims 2, 3 and 5 to 9, thus satisfying also the requirement of Article 123(2) EPC.

4. *Novelty*

4.1 Document (1)

Novelty of the claimed subject-matter with respect to document (1) was not objected to in the decision under appeal. The Board on its own sees no reason to take a different view, since that document does not disclose any composition comprising niacinamide or niacinamide N-oxide.

4.2 Document (2)

4.2.1 Document (2) discloses compositions comprising niacinamide and dihydroxyacetone (examples 7, 20, 33 and 48). The compositions are disclosed in that document to provide good moisturisation, hydration, skin feel, skin softness and/or skin smoothness (page 1, first paragraph, page 3, second paragraph). The compositions are also disclosed to be useful in mitigating damage caused by exposure of the skin to ultra violet radiation or to water, or caused by shaving or exfoliation (page 27, first full paragraph). However, document (2) is silent about any use of these compositions for imparting tan to the skin.

4.2.2 The Examining Division nonetheless held that document (2) anticipated the subject-matter claimed because the disclosure of a composition containing a known tanning active, namely dihydroxyacetone, implied the use of the composition for tanning.

4.2.3 A claim to the use of a known product for a particular purpose, which is based on a technical effect which is described in the application, should be interpreted as including that technical effect as a functional technical feature, and is accordingly not open to objection under Article 54(1) EPC provided that such technical feature has not previously been made available to the public even though such technical effect may have inherently taken place in the course of carrying out what has previously been made available to the public (see decision G 2/88, OJ EPO 1990, 93, point 10.3 of the reasons and G 6/88, OJ EPO, 1990, 114, point 9 of the reasons).



As regards novelty, the question to be decided is thus what has been made available to the public, and not what may have been "inherent" in what was made available to the public. A line must thus be drawn between what is in fact made available, and what remains hidden or otherwise has not been made available. Emphasis should thus be put on the distinction between information equivalent to a claimed invention which may be made available (lack of novelty), or may not have been made available but obvious (novel, but lack of inventive step) (see G 2/88, *loc. cit.*, point 10, last paragraph and point 10.3 of the reasons).

4.2.4 In the present case, the Board notes that the tanning effect of the compositions of examples 7, 20, 33 and 48 of document (2) comprising niacinamide and dihydroxyacetone is nowhere disclosed in that document, but remains hidden. Thus, the considerations whether or not the claimed tanning effect inherently arises when carrying out the teaching of document (2) are not relevant in the assessment of novelty, with the consequence that the Examining Division's argumentation concerning lack of novelty with respect to document (2) in the appealed decision cannot stand.

4.3 In view of the above, the Board concludes that the use of the compositions according to claim 1, and by the same token those of dependent claims 2 to 8 have not been made available to the public by document (2).

4.4 Document (3)

4.4.1 Document (3) discloses a skin care composition comprising vitamin B<sub>3</sub>, in particular niacinamide (claims 1 to 4, 9). The composition

- preferably has a pH comprised in the range of from about 4 to about 7 (page 9, lines 4 to 9),
- may comprises *inter alia* a tanning active (see page 38, line 8),
- dihydroxyacetone being one of the possible tanning actives (page 38, line 11), and
- is disclosed for use to make a medicament for regulating the condition of mammalian skin (claim 10, page 1, first paragraph) or for improving skin appearance and/or feel (page 5, lines 17 to 18).

4.4.2 The Examining Division held that the disclosure of a composition containing a tanning agent was equivalent to the disclosure of the purpose of the finished composition to be used as a self tanning composition, whereas the Appellant was of the opinion that the use disclosed for that composition remains the same whether or not this optional tanning agent is present in the composition.

The Board notes an inconsistency in the assessment of the prior art documents by the Examining Division which on the one side held that document (3) discloses self-tanning compositions comprising niacinamide and dihydroxyacetone for objecting to novelty and, on the

other side discarded that document as representing the closest prior art in the assessment of inventive step during preceding examining proceedings, thereby conceding that document (3) was not considered as a tangible disclosure of self-tanning compositions. For that reason the novelty objection raised does not appear convincing.

4.4.3 Nevertheless, the general principle consistently applied by the Boards of Appeal for concluding lack of novelty is that there must be a direct and unambiguous disclosure in the state of the art which would inevitably lead the skilled person to subject-matter falling within the scope of what is claimed. However, in deciding what can be directly and unambiguously derived from a document, its different passages can only be combined if there is a direct pointer for combining them (see e.g. T 666/89, OJ EPO 1993, 495 and in particular T 941/98, point 5 of the reasons, not published in OJ EPO).

4.4.4 Neither in the working examples of document (3) nor in its general description there is a disclosure of a composition comprising niacinamide and dihydroxyacetone for the claimed use.

To arrive at the claimed subject-matter it is necessary to select the required pH for the composition, to choose the option that a tanning agent is present, to specify dihydroxyacetone as the tanning agent and, even assuming that a use as a self tanning composition were disclosed in that document, to select that particular use among all others described in that document.

Document (3), however, does not contain any pointer leading the skilled person directly and unambiguously to that particular combination of features within the ambit of document (3) which combination is specified in claim 1 as amended.

4.4.5 Accordingly, the subject-matter of claim 1, and that of dependent claims 2 to 8 is novel with respect to document (3).

5. *Remittal*

Having so decided, the Board has not, however, taken a decision on the whole matter since the decision under appeal dealt solely with the issue of novelty of claim 1 according to the then pending request.

Under these circumstances, the examination not having been concluded and the Appellant having requested remittal, the Board considers it appropriate to exercise the power conferred on it by Article 111(1), second sentence, second alternative, EPC to remit the case to the Examining Division for further prosecution.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
  
2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 8 of the sole request submitted during the oral proceedings before the Board.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

R. Freimuth