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**Datasheet for the decision
of 27 July 2010**

Case Number: T 2193/08 - 3.3.10

Application Number: 00989549.1

Publication Number: 1250120

IPC: A61K 7/48

Language of the proceedings: EN

Title of invention:

High unsaponifiables and methods of using the same

Patentee:

International Flora Technologies, Ltd.

Opponent:

-

Headword:

Saponification of jojoba oil/INTERNATIONAL FLORA TECHNOLOGIES

Relevant legal provisions:

EPC Art. 54, 111(1), 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Amendments (allowable) - no added subject-matter"

"Novelty (yes)"

"Remittal - outstanding issues"

Decisions cited:

G 0010/93

Catchword:

-



Case Number: T 2193/08 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 27 July 2010

Appellant: International Flora Technologies, Ltd.
1151 North Fiesta Boulevard
Gilbert, AZ 85233-2238 (US)

Representative: Maiwald Patentanwalts GmbH
Elisenhof
Elisenstrasse 3
D-80335 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 7 July 2008
refusing European patent application
No. 00989549.1 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: R. Freimuth
Members: J. Mercey
F. Blumer

Summary of Facts and Submissions

- I. The appeal lodged on 5 September 2008 lies from the decision of the Examining Division dated 7 July 2008 refusing European patent application No. 00989549.1 with the European publication No. 1 250 120 and International publication No. WO 01/49257.
- II. The decision of the Examining Division was based on five requests. The Examining Division found that the then pending main, first and second auxiliary requests contained subject-matter which extended beyond the content of the application as filed, thus contravening the provisions of Article 123(2) EPC, and that the subject-matter of the third and fourth auxiliary requests lacked novelty (Article 54 EPC) over the disclosure of document:

(10) EP-A-482 344.

In addition to document (10), the following nine documents were cited during examination proceedings:

- (1) FR-A-2 471 775,
- (2) US-A-5 759 555,
- (3) WO-A-94 21764,
- (4) US-A-3 887 537,
- (5) GB-A-755 114,
- (6) GB-A-558 820,
- (7) FR-A-2 762 512,
- (8) WO-A-01 21605 and
- (9) EP-A-689 828.

III. In a communication dated 4 May 2010 pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal, the Board indicated that the original disclosure for a large number of amendments made to the claims as then on file appeared to be missing (Article 123(2) EPC).

IV. At the oral proceedings before the Board held on 27 July 2010, the Appellant submitted a main request, this request superseding all previous requests. The main request consisted of a single claim which read as follows:

"1. A method for producing a carrier composition comprising a mixture of polar hydrophilic salts (saponifiables) and non-polar, lipophilic materials (unsaponifiables),

wherein the composition is produced by the reaction of aqueous alkali metal hydroxides with an organic lipid composition containing a proportion of unsaponifiable material of greater than 6 wt.-%, based on the total weight of the organic lipid composition, and

wherein the organic lipid composition is jojoba oil."

V. The Appellant submitted during the oral proceedings before the Board that claim 1 found support at page 11, lines 7 to 16, together with page 10, line 1 and page 6, lines 18 to 20 of the application as filed, and thus complied with the requirements of Article 123(2) EPC. The Appellant argued that the subject-matter of claim 1 was novel over each of the documents (1) to (10), more

particularly over document (10) because said document did not disclose an aqueous saponification reaction.

VI. The Appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the main request submitted at the oral proceedings before the Board.

VII. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

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

2.1 The method of producing a composition comprising a mixture of polar hydrophilic salts and non-polar, lipophilic materials of this single claim is based on page 11, lines 7 to 16 of the application as filed. Support for the composition created by this method (see page 11, line 11) being a "carrier" composition may be found on page 10, line 1 of the application as filed. That the proportion of unsaponifiable materials in the starting organic lipid composition of "greater than 6%" (see page 11, lines 13 to 15) corresponds to "greater than 6 wt.-% based on the total weight of the organic lipid composition" is supported by page 6, lines 18 to 20 of the application as filed.

2.2 Therefore, the amendments made to the claim do not generate subject-matter extending beyond the content of

the application as filed and the Board concludes that the requirements of Article 123(2) EPC are satisfied.

3. *Novelty*

- 3.1 Document (10) discloses (see Examples 3 and 4) the saponification of jojoba oil with potassium hydroxide. However, said document does not disclose a hydrolysis with an aqueous alkali metal hydroxide, such that the subject-matter of claim 1 is novel thereover.

Documents (1), (2) and (7) all disclose jojoba oil, but none of these documents discloses the hydrolysis thereof.

Documents (3) to (6), (8) and (9) disclose oils, but not jojoba oil, let alone the hydrolysis thereof.

- 3.2 Therefore, the Board concludes that the subject-matter of claim 1 is novel within the meaning of Articles 52(1) and 54 EPC over the disclosures of all documents presently in the proceedings, namely over documents (1) to (10).

4. *Remittal*

Having so decided, the Board has not, however, taken a decision on the whole matter, since substantial amendments have been made to independent claim 1, which amended claim was presented at the oral proceedings before the Board. The decision under appeal dealt exclusively with amendments which contravened the provisions of Article 123(2) EPC and lack of novelty of claim 1 over the documents cited according to the then

pending requests, and did not consider claim 1 in the present form as such a request was never submitted to the first instance. The amendments leading to the fresh claim 1, in particular the change to a method for producing a composition by hydrolysis, have the effect that the reasons given in the contested decision for refusing the present application no longer apply.

Thus, the Board considers that the substantial amendments made by the Appellant remove all the objections on which the decision under appeal was based and that present claim 1 generates a fresh case not yet addressed in examination proceedings and requiring reexamination.

While Article 111(1) EPC gives the Boards of Appeal the power to raise fresh issues in *ex-parte* proceedings where the application has been refused on other issues, 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), fresh issues 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.

Under these circumstances, the examination not having been concluded, the Board considers it appropriate to exercise the power conferred on it by Article 111(1) 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 the main request submitted at the oral proceedings before the Board.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

R. Freimuth