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**Datasheet for the decision
of 28 November 2011**

Case Number: T 1842/09 - 3.3.10

Application Number: 03012320.2

Publication Number: 1435229

IPC: A61K 7/48, A61K 7/16

Language of the proceedings: EN

Title of invention:

Dermatologic composition for topical-use dermatologic products
and dermatologic products made thereby

Applicant:

EURITALIA S.r.l.

Headword:

Dermatologic composition/EURITALIA

Relevant legal provisions:

EPC Art. 111(1), 113(1), 123(2)
EPC R. 103(1)(a)
RPBA Art. 11

Keyword:

"Substantial procedural violation (yes) - no opportunity to
comment on reasons for refusal"
"Remittal (yes)"
"Reimbursement of appeal fee (yes)"

Decisions cited:

T 0951/92

Catchword:

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Case Number: T 1842/09 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 28 November 2011

Appellant: EURITALIA S.r.l.
(Applicant) Via P.H. Spaak
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Representative: Cicogna, Franco
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 6 May 2009
refusing European patent application
No. 03012320.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: P. Gryczka
Members: J. Mercey
D. S. Rogers

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the Examining Division posted on 6 May 2009 refusing European patent application No. 03 012 320.2.
- II. Claims 1 to 3 of the set of nine claims filed with letter dated 18 July 2008 underlying the contested decision (present sole request) read as follows:

"1. A method for making a topical use dermatologic product starting from sea water and natural and/or synthetic active principles, characterised in that said method comprises at least the steps of sterilizing by gamma radiation said sea water, optionally adding to said sterilized sea water demineralized water to provide a sterilized sea water-demineralized water mixture bringing either said sterilized sea water or said sterilized sea water and demineralized water mixture to an isotonic or hypertonic level with human body liquids, and adding to said sterilized sea water or to said sterilized sea water and demineralized water mixture natural and/or synthetic active principles, said natural and/or synthetic active principles being selected from skin hydratation, freshness feeling, softening and smoothness improving principles and atopic dermatitis curative principles.

2. A topical use dermatological product made by the method according to claim 1, characterized in that said product comprises, as said active principles, and in a mixture of 50 ml sterilized sea water and 450 ml demineralized water, 11% armica, 3% Hamamelis Virginiana water, 2% sea collagen, 2.5% ruscus, 1% pure

escine, 1% polyunsaturated fat acids, all the rates of said active principles being related to 500 ml of said water mixture.

3. A topical use dermatological product made by the method according to claim 1, characterized in that said product comprises, in 50 ml sterilized sea water, as said active principles, 0.75 grams beta-glycyrrhetic acid 18, 0.50 grams allantoin and 1 gram escine."

- III. In the decision under appeal, the Examining Division held that claims 1 to 3 contained subject-matter which extended beyond the content of the application as filed, thus contravening the provisions of Article 123(2) EPC.
- IV. In its Grounds for Appeal, the Appellant submitted that it's right to be heard (Article 113(1) EPC) had been violated by the Examining Division, the application having been refused on grounds on which it had had no opportunity to comment. The Appellant requested that the decision under appeal be set aside, that a patent be granted on the basis of the claims refused by the Examining Division or, alternatively, that oral proceedings be held.
- V. In a communication annexed to the summons to oral proceedings, the Board indicated that it was inclined to support the Appellant's view that the Examining Division committed a substantial procedural violation, and the Appellant was requested to indicate whether it wished the case to be remitted to the Examining Division as a consequence of the substantial procedural violation, or whether it maintained its request for oral proceedings before the Board.

VI. In response to this communication, the Appellant requested that the appeal fee be reimbursed, the application be remitted to the Examination Division for further prosecution, and withdrew its request for oral proceedings, whereupon such proceedings were cancelled.

Reasons for the Decision

1. The appeal is admissible.

Alleged substantial procedural violation by contravention of Article 113(1) EPC)

2. Article 113(1) EPC stipulates that a decision may only be based on grounds or evidence on which the parties concerned have had the opportunity to present their comments. According to the established jurisprudence of the boards of appeal the term "grounds" in Article 113(1) EPC refers to the essential reasoning, both legal and factual, which leads to refusal of an application. In other words, before a decision is issued an applicant must be informed of the case which it has to meet, and must have an opportunity of meeting it (see T 951/92, OJ EPO 1996, 53, point 3 (v) of the reasons).

2.1 In the present case, the decision refusing the application (see point III) is based exclusively on the grounds of Article 123(2) EPC. More particularly, in point 2 of said decision, it was held that the features "sterilization by gamma radiation" and "adding to said sterilized sea water or to sterilized sea water and

demineralized water mixture natural and/or synthetic active principles being selected from skin hydratation, freshness feeling, softening and smoothness improving principles and atopic dermatitis curative principles" in claim 1, and "demineralized water" in claims 1 and 2, were not disclosed in the application as filed. In addition, it was found that there was no basis in the application as filed for a dermatologic product comprising the ingredients of claim 2 made by a process according to claim 1 without diluting with sea water, nor for a dermatologic product comprising the ingredients of claim 3 made by a process according to claim 1 including a dilution step, or made with a gamma radiation sterilization step.

Points 3 to 5 of the decision under appeal are preceded by the wording "As a matter of completeness the Examining Division wishes to note the following" and as such do not form part of the legal and factual reasons underlying the decision.

- 2.2 In its first official communication according to Article 94(3) EPC dated 20 June 2006, the Examining Division indicated that the subject-matter of the claims as originally filed was unclear (Article 84 EPC) and not novel.

With the response dated 28 July 2006, the Appellant filed a new set of twelve claims.

- 2.3 In its second official communication dated 15 April 2008, the Examining Division indicated that the amendments made to claim 1 of "a dilution ratio of substantially 1 to 9" and "natural and/or synthetic

active principles, such as skin cleansing, anti-inflammatory, disinfectant or cosmetic active principles" did not find support in the originally filed documents and thus offended against Article 123(2) EPC. It further objected to the terms "natural and/or synthetic active principles", "denaturated water", "gamma sterilizing process" and "dilution ratio" as rendering the scope of claim 1 unclear (Article 84 EPC).

With the response dated 18 July 2008, the Appellant filed a new set of nine claims, in which *inter alia* the category of previous claim 1 was changed from a product to a method claim, and two product-by-process claims based on Examples 1 and 2, namely claims 2 and 3, were introduced (see point II above). In the newly filed claim 1, the Appellant *inter alia* replaced the feature "gamma sterilizing process" by "sterilizing by gamma radiation", "denaturated water" by "demineralized water" and "such as skin cleansing, anti-inflammatory, disinfectant or cosmetic active principles" by "selected from skin hydratation, freshness feeling, softening and smoothness improving principles and atopic dermatitis curative principles".

3. The above summary of the prosecution history shows that none of the communications of the Examining Division raised an objection under Article 123(2) EPC against any of those features which were found in the decision under appeal to have no basis in the application as filed, namely the features "sterilization by gamma radiation", "demineralized water" or "adding to said sterilized sea water or to sterilized sea water and demineralized water mixture natural and/or synthetic active principles being selected from skin hydratation,

freshness feeling, softening and smoothness improving principles and atopic dermatitis curative principles", all of these features having been introduced into claim 1 only with the response dated 18 July 2008, whereafter the decision to refuse was issued without any further communication under Article 94(3) EPC. Similarly, the product-by-process claims 2 and 3, containing features which were also found in the decision under appeal to offend against Article 123(2) EPC, were also introduced into the set of claims with the response dated 18 July 2008. The absence of an objection under Article 123(2) EPC to any of these features in any of the official communications of the Examining Division did not permit the Appellant to deal, either by amendment or counter-argument, with the particular objections on which the decision under appeal is based. The objections under Article 123(2) EPC raised by the Examining Division in the communication dated 15 April 2008 concerned other features no longer present in the claims on which the decision under appeal is based.

4. Therefore, the decision of the Examining Division was based on reasons, namely the finding that particular features of Claims 1 to 3 violated Article 123(2) EPC, which had not been previously communicated to the Appellant, and on which the Appellant thus did not have the opportunity to comment. This contravenes the requirements of Article 113(1) EPC and thus constitutes a substantial procedural violation (see T 951/92, *ibid.*, Headnotes and point 3 of the reasons).
5. The appeal is thus deemed to be allowable and the Board considers it to be equitable, in view of that

substantial procedural violation, to reimburse the appeal fee (Rule 103(1)(a) EPC).

Remittal

6. The Appellant has requested remittal under Article 111(1) EPC. Moreover, Article 11 RPBA stipulates that the Board will remit the case to the department of first instance if a fundamental deficiency is apparent in the first instance proceedings, unless there are special reasons not to do so. The Board thus finds it appropriate to remit the case to the department of first instance.

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.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

P. Gryczka