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**Datasheet for the decision
of 20 January 2011**

Case Number: T 2285/09 - 3.3.10

Application Number: 03078256.9

Publication Number: 1389465

IPC: A61K 36/63

Language of the proceedings: EN

Title of invention:

Use of an extract from the leaves of *Olea Europaea* as an antiradical

Patentee:

B & T S.r.l.

Opponent:

L'OREAL
Société Industrielle Limousine d'Application

Headword:

Use of an extract from the leaves of *Olea Europaea*/B & T

Relevant legal provisions:

EPC Art. 123(2)(3)

Relevant legal provisions (EPC 1973):

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Keyword:

"Main and auxiliary requests 1 and 2: added subject-matter (yes) - amendment by deletion of feature disclosed in combination only"

"Auxiliary requests 3 to 12: extension of protection conferred (yes) - amendment to product-by-process feature by addition of process step"

Decisions cited:

T 0331/87, T 0552/91, T 0288/92, T 0223/96, T 0307/05

Catchword:

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Case Number: T 2285/09 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 20 January 2011

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 5 November 2009
revoking European patent No. 1389465 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Gryczka
Members: J. Mercey
J.-P. Seitz

Summary of Facts and Submissions

I. The Appellant (Proprietor of the Patent) lodged an appeal against the decision of the Opposition Division dated 5 November 2009 revoking European patent No. 1 389 465. Claim 1 of the granted patent read as follows:

"Use of an extract from the leaves of *Olea Europea*, obtainable by dipping the leaves into water, as an antiradical for the preparation of cosmetic products for skin protection against UV rays."

II. Notice of Opposition had been filed by the Respondents I and II (Opponents I and II respectively) requesting revocation of the patent in its entirety on the grounds of *inter alia* extending the subject-matter of the patent in suit beyond the content of the parent application as filed (Article 76(1) EPC).

III. The Opposition Division held that the subject-matter of claim 1 of the then pending main request, namely the patent as granted, and of the then pending auxiliary requests 1 and 3 to 11, extended beyond the content of the parent application as filed (Article 76(1) EPC), since there was no disclosure therein of an extract obtainable by dipping the leaves into water without also additionally subjecting the infusion to ultrasounds. Furthermore, claim 1 of the then pending auxiliary request 2 led to an extension of the protection conferred by the patent as granted and thus offended against Article 123(3) EPC, since an extract obtainable by extraction with water with the aid of ultrasounds was not necessarily the same as one

obtainable by dipping the leaves into water and subjecting the infusion to ultrasounds.

- IV. With letter dated 14 December 2010, the Appellant submitted twelve auxiliary requests superseding all auxiliary requests on file.

Claim 1 of auxiliary request 1 was identical to claim 1 of the main request, namely the patent as granted.

Claim 1 of auxiliary request 2 differed from claim 1 of the main request in that the use was additionally specified as being a cosmetic use.

Claim 1 of each of auxiliary requests 3 to 12 differed from claim 1 of the main request *inter alia* in that the extract was defined as being "obtainable by dipping the leaves into water and subjecting the infusion to ultrasounds".

- V. The Appellant argued that claim 1 of the main request and of the auxiliary requests 1 and 2 found a basis in the parent application as filed. More particularly, although conceding that an extract obtainable only by dipping the leaves into water was not explicitly disclosed in the parent application as filed, it argued that the step of subjecting the infusion to ultrasounds was not described in said application as being essential, and could thus be deleted, in particular since the feature was not indispensable for the function of the invention in the light of the technical problem it solved, citing the decision T 331/87 (OJ EPO 1991, 21) in this respect. It further submitted that the subject-matter of claim 1 of these requests was

allowable, since it fell within that of claim 1 of the parent application as filed, which related to the use of an extract from the leaves of *Olea Europea* obtainable by any means.

The Appellant submitted that claim 1 of each of the auxiliary requests 3 to 12 did not lead to an extension of the protection conferred by the patent as granted, since each of these claims was directed to the same or more limited subject-matter than claim 1 of the patent as granted. The application as filed described that the step of subjecting the infusion to ultrasounds merely accelerated the extraction and thus did not modify the nature of the extract obtained. The Appellant further relied upon the experimental reports (15) and (20), filed with letters dated 3 March 2010 and 14 December 2010, respectively, to demonstrate that the treatment with ultrasounds merely accelerated the extraction but did not result in qualitatively different compositions. The Appellant argued also that, in any case, the burden of proof lay with the Respondents to demonstrate that the amended claims led to an extension of the protection conferred. Furthermore, claim 1 as granted was open with regard to the process defining the extract, such that it did not exclude the presence of additional process steps which not alter the nature of the product.

During the oral proceedings before the Board held on 20 January 2011, the Appellant withdrew its written submission that the Opposition Division had committed a procedural violation.

VI. Respondents I and II argued that the main request and the auxiliary requests 1 and 2 contained subject-matter extending beyond the content of the parent application as filed, contrary to the requirements of Article 76(1) EPC, since there was no disclosure therein of an extract obtainable by dipping the leaves into water without also additionally subjecting the infusion to ultrasounds.

The Respondents also submitted that claim 1 of the auxiliary requests 3 to 12 extended the protection conferred by the patent as granted and thus offended against Article 123(3) EPC. They argued that the use of ultrasounds was capable of influencing both the quality and the quantity of the product obtained when extracting leaves of *Olea Europea*, such that the product mixture obtainable by additionally subjecting the infusion to ultrasounds may be different from that obtained by merely dipping the leaves into water.

VII. The Appellant requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or, subsidiarily, that the case be remitted to the department of first instance for further prosecution on the basis of any of the auxiliary requests 1 to 12 submitted with letter dated 14 December 2010.

The Respondents requested that the appeal be dismissed.

VIII. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request and auxiliary requests 1 and 2

2. *Article 76(1) EPC*

- 2.1 The patent in suit is based on European patent application No. 03 078 256.9 which is a divisional application of the earlier European patent application No. 99 102 534.7. For the requirements of Article 76(1) EPC to be fulfilled, it is thus necessary that the content of the patent in suit does not go beyond the content of the parent application as filed.

- 2.2 In accordance with the established jurisprudence of the Boards of Appeal, the relevant question to be decided in assessing whether an amendment adds subject-matter extending beyond the content of the parent application as filed, is whether the proposed amendment was directly and unambiguously derivable from the parent application as filed, either explicitly or implicitly, implicit disclosure meaning no more than the clear and unambiguous consequence of what is explicitly disclosed.

- 2.3 Claim 1 of the main request and of auxiliary requests 1 and 2 is directed to the use of an extract from the leaves of *Olea Europea*, obtainable by dipping the leaves into water. The claim thus defines the extract which is used by virtue of the process for obtaining it.

The only passages in the parent application as filed which describe how the extract may be obtained are at

page 2, lines 14 to 15, said passage requiring that the extract is prepared by dipping the leaves into water, and subjecting the infusion to ultrasounds, and claim 14, which requires that the extract is obtained by extraction with water, with the aid of ultrasounds.

2.4 There is thus no disclosure in the parent application as filed for the use of an extract obtainable exclusively by dipping the leaves into water without the aid of ultrasounds, said two steps being disclosed in combination only, such that subject-matter has been added which extends beyond the content of parent application as filed.

2.5 According to the Appellant, who conceded that an extract obtainable exclusively by dipping the leaves into water was not explicitly disclosed in the parent application as filed, such an extract was nevertheless implicitly disclosed therein.

2.5.1 In support of this argument, the Appellant submitted that the step of subjecting the infusion to ultrasounds was not described in the parent application as filed as being essential, and could thus be deleted.

However, the passages at page 2, lines 14 to 15 and claim 14 of the parent application as filed do not indicate that the step of subjecting the infusion to ultrasounds is optional, but rather these two process steps are only disclosed in combination with each other. Said passage on page 2 also clearly indicates that the second process step has a technical effect, since it is described as accelerating the extraction, such that it cannot be viewed as a non-technical feature. Hence, the

Appellant's argument that this feature could be deleted because it was not "essential" must fail.

- 2.5.2 The Appellant further submitted that the feature was not indispensable for the function of the invention in the light of the technical problem it solved, since the invention lay in the use of an aqueous extract as opposed to the prior art alcoholic extracts. As such, the essential feature was that the extract was an aqueous extract, not that it was obtainable by subjecting the aqueous infusion to ultrasounds, such that this process step may be deleted.

However, the disclosure requirement of Article 76(1) EPC requires merely that the subject-matter of the divisional shall not extend beyond the content of the parent application as filed. The distinction between features which are allegedly "dispensable" or "indispensable" in order to solve a technical problem is irrelevant to the question of what is directly and unambiguously disclosed in the parent application as filed. Hence, this argument of the Appellant must also be rejected.

- 2.5.3 Finally, the Appellant argued that the subject-matter of claim 1 of these requests fell within that of claim 1 of the parent application as filed, which related to the use of an extract from the leaves of *Olea Europea* obtainable by any means.

However, merely because the claimed subject-matter falls within the subject-matter disclosed in the parent application as filed does not mean that said restricted subject-matter is actually disclosed therein (see

T 288/92, point 3.1 of the reasons, not published in OJ EPO), for which the only criterion to be applied is whether the proposed amendment, even if it results in a restriction of the claimed subject-matter, is directly and unambiguously derivable from the parent application as filed.

- 2.6 For these reasons, the Board concludes that claim 1 of the main request and auxiliary requests 1 and 2 is amended in such a way that subject-matter extending beyond the content of the parent application as filed is added, contrary to the requirement of Article 76(1) EPC, there being neither an explicit nor an implicit disclosure in the parent application as filed for the use of an extract from the leaves of *Olea Europea*, obtainable by dipping the leaves into water only, with the consequence that the main request and auxiliary requests 1 and 2 are not allowable.

Auxiliary requests 3 to 12

3. *Article 123(3) EPC*

- 3.1 Article 123(3) EPC requires that the claims of a patent as granted may not be amended during opposition/appeal proceedings in such a way as to extend the protection conferred. In order to decide whether or not an amendment of the patent in suit satisfies that requirement, it is necessary to compare the protection conferred by the claims before amendment, i.e. as granted, with that of the claims after amendment. In that respect, it is established Case Law that a very rigorous standard, namely that of "beyond reasonable doubt" is to be applied when checking the allowability

of amendments under Article 123(3) EPC (see, for example, T 307/05, points 3.3 and 3.4 of the reasons, not published in OJ EPO), such that the slightest doubt that the scope of the patent as amended could cover embodiments not covered by the unamended patent would preclude the allowability of the amendment.

- 3.2 Claim 1 of auxiliary requests 3 to 12 is directed to the use of an extract from the leaves of *Olea Europea*, obtainable by dipping the leaves into water and subjecting the infusion to ultrasounds.

Claim 1 of the patent as granted is directed to the use of an extract from the leaves of *Olea Europea*, obtainable by dipping the leaves into water.

- 3.3 Thus the question to be answered is whether claim 1 of the amended auxiliary requests covers the use of an extract which was not covered by claim 1 as granted. It thus needs to be examined whether the addition of the feature of subjecting the infusion to ultrasounds may result in a different extract than that obtainable by dipping the leaves into water only.

- 3.4 The difficulty associated with determining the scope of protection conferred by a feature defined in terms of a "product-by-process" lies in defining the precise contribution of each process step to the nature of the product obtained (see T 223/96, point 17 of the reasons, not published in OJ EPO and T 552/91, point 5.2 of the reasons, OJ EPO 1995, 100).

- 3.5 That ultrasounds have a technical effect on the extraction of the leaves in water is uncontested, since

it is explicitly mentioned in the parent application as filed (see page 2, lines 14 to 17) that ultrasounds accelerate the extraction and that a process including the use of ultrasounds allows to obtain an extract containing 7% by weight of oleoeuropeine. In addition, it cannot be excluded that ultrasounds also have an effect on the relative amounts and type of components which are extracted, thus resulting in extracts having a different composition than those obtainable by merely dipping into water. The Appellant may thus now have extended the scope of protection to embodiments which were not covered by the claims as granted.

3.6 For the following reasons, the Board is not convinced by the Appellant's submissions that the amendments did not extend the protection conferred.

3.6.1 The Appellant relied upon the experimental reports (15) and (20) (see point V above) to show that the use of ultrasounds merely accelerated the extraction but did not result in qualitatively different compositions.

However, even if these experiments show that under specific conditions (for example, temperature and ultrasound frequency), the same type of extract, insofar as its components can be detected by HPLC 215nm UV, can be obtained by dipping the leaves into water with or without ultrasounds, these tests do not show beyond all reasonable doubt, that under any conditions encompassed by the definition given in claim 1 for the process by which the extract may be obtained, the additional step of subjecting the infusion to ultrasounds would not lead to an extract which would not be obtainable by dipping the leaves into water only.

3.6.2 The Appellant submitted that the burden of proof lay with the Respondents to show that the amendments did in fact extend the protection conferred.

However, it is the Proprietor/Appellant who amended the patent as granted who is responsible for demonstrating, beyond all reasonable doubt, that said amendment does not extend the protection conferred.

3.6.3 The Appellant argued that claim 1 as granted, which related to the use of an extract obtainable by dipping the leaves into water included the use of an extract obtainable by additionally subjecting the infusion to ultrasounds, since the claim was open with regard to the process defining the extract, and thus did not exclude the use of an extract obtainable via additional process steps, insofar as these additional process steps did not alter the nature of the extract, as was the case when subjecting the infusion to ultrasounds.

However, at least for the reason that the additional step of subjecting the infusion to ultrasounds does indeed potentially affect the nature of the extract obtained (see point 3.5 above), this argument must be rejected.

3.7 For these reasons, the Board concludes that claim 1 of the auxiliary requests 3 to 12 is amended in such a way that there are considerable doubts that the extent of the protection conferred has thereby not been extended. The Board therefore has to conclude that claim 1 of auxiliary requests 3 to 12 offends against

Article 123(3) EPC and, consequently, these requests cannot be allowed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

P. Gryczka