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**Datasheet for the decision
of 29 July 2015**

Case Number: T 0711/11 - 3.3.10

Application Number: 04739158.6

Publication Number: 1624853

IPC: A61K8/18, A23L1/303

Language of the proceedings: EN

Title of invention:

SKIN TREATMENTS

Applicant:

Unilever PLC
Unilever N.V.

Headword:

Relevant legal provisions:

EPC Art. 56, 111(1), 113(1)
EPC R. 103(1)(a), 115(2)

Keyword:

Reimbursement of appeal fee - (no)
Remittal to the department of first instance - (no)
Right to be heard - non-attendance at oral proceedings
Inventive step - obvious modification

Decisions cited:

T 0341/92

Catchword:



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Case Number: T 0711/11 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 29 July 2015

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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 10 November 2010 refusing European patent application No. 04739158.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: J. Mercey
C. Schmidt

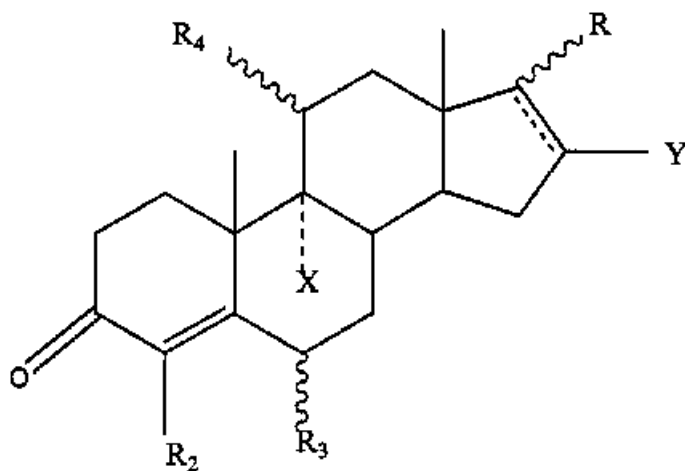
Summary of Facts and Submissions

I. This appeal lies from the decision of the Examining Division refusing European patent application No. 04 739 158.6 with the European publication No. 1 624 853 and International Publication No. WO 2004/103320.

II. Claim 1 of the main request underlying the contested decision reads as follows:

"A composition comprising (i) an LXR activator other than 25-hydroxycholesterol and (ii) retinoic acid and/or a metabolic precursor thereto, wherein the retinol metabolic precursor is selected from the group consisting of retinyl esters, retinol, retinal and retinoic acid, preferably retinol or retinyl ester and mixtures thereof."

Claim 1 of auxiliary requests 1 and 2 underlying the contested decision each specifies that the activator comprises a compound of formula (A):



(A)

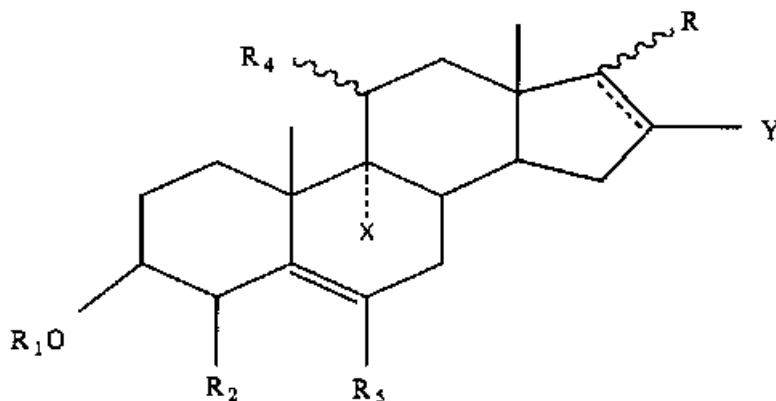
III. In the decision under appeal, the Examining Division held that the subject-matter of claim 1 of each of the then pending auxiliary requests 1 and 2 did not involve an inventive step over document:

(3) US-A-5 587 367

the sterols of formula (A) being merely very close structural equivalents to those used in the compositions of document (3) in combination with retinoic acid for the same purpose. The Examining Division also indicated that subject-matter of the then pending main request and auxiliary requests 1 and 3, insofar as it did not relate to a composition comprising (i) a compound of formula (A) had for reasons of lack of unity not been searched (Rule 64 EPC) and was therefore not allowable under Rule 137(4) EPC (2000). In addition, claim 1 of each of auxiliary requests 1 and 2 was considered not to meet the requirements of Article 84 EPC, since there were doubts as to whether all the possible combinations of substituents of formula (A) would result in an LXR activator, such that the invention could not be performed over the whole scope of the claim.

IV. Together with its Grounds for Appeal dated 10 March 2011, the Appellant (Applicant) filed a new main request and two auxiliary requests, claim 1 of the main request and of auxiliary request 1 being identical to claim 1 of the main request on which the decision of the Examining Division was based.

Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that the activator is defined as comprising a compound of formula (B):



(B)

wherein;

R represents a hydrogen, a hydroxyl, a keto, an acetyl, a C₁ to C₁₀, substituted or unsubstituted, branched or unbranched, saturated or unsaturated alkyl group;

R₁ represents a lower alkyl group, a hydrogen or COR₆;

R₂ represents a hydrogen, a halogen or hydroxyl group;

R₃ represents a hydrogen, a hydroxyl, a halogen, a keto or lower alkyl group;

R₄ represents a hydrogen, a hydroxyl, or a keto group;

R₅ represents a hydrogen, a hydroxyl, a halogen or lower alkyl group;

R₆ represents a lower alkyl group.

X represents a hydrogen, a methyl or a halogen;

Y represents a hydrogen, a hydroxyl, an acetyl or a keto group,

wherein the lower alkyl group is a straight or branched chain radical of up to four carbon atoms.

- V. The Appellant submitted that the Examining Division had committed a substantial procedural violation, since it had not provided adequate reasoning as to why the subject-matter of the then pending main request and auxiliary request 1 lacked unity, stating merely that

"the claims are not unitary with the original filed claims in the International and European phases" without indicating how it arrived at this decision. Since claim 1 of the present main request and auxiliary request 1 was identical to claim 1 of the main request before the first instance, the Appellant requested that the case be remitted to the Examining Division for further examination, reimbursement of the appeal fee being equitable by reason of a substantial procedural violation.

The Appellant further submitted that should the Board decide to exercise the competence of the Examining Division and examine the requests for inventive step, then the subject-matter of the main request and auxiliary request 1 was inventive, since document (3) did not disclose anywhere that 25-hydroxycholesterol was an LXR-activator, such that it was not obvious to use other LXR-activators in combination with retinoic acid to treat chrono- and photoageing of the skin. In addition, the fact that the claimed compositions were for use in treating the dermis as opposed to the epidermis rendered them inventive, since document (3) disclosed the use of the compositions described therein for the treatment of epidermic keratinisation disorders only.

- VI. In a communication dated 26 February 2015 accompanying the summons to oral proceedings, the Board indicated *inter alia* why the subject-matter of all the present requests would not appear to be inventive.

- VII. In response to the summons to oral proceedings, the Appellant indicated that it would not be attending and requested a decision based on the state of the file, the Appellant's requests being that the decision under

appeal be set aside and the case be remitted to the Examining Division for further prosecution or alternatively, that a patent be granted on the basis of the main request or on the basis of either of auxiliary requests 1 or 2, all requests filed with letter dated 10 March 2011. It also requested reimbursement of the appeal fee owing to the aforementioned substantial procedural violation.

VIII. At the end of the oral proceedings, which were held on 29 July 2015 in the absence of the Appellant, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Request for Remittal (Article 111(1) EPC), Substantial Procedural Violation and Reimbursement of Appeal Fee (Rule 103(1) (a) EPC)*
 - 2.1 The Appellant requested remittal of the case to the first instance for further examination, since the Examining Division found that the subject-matter of the then pending main request and auxiliary request 1 lacked unity without, however, providing adequate reasoning. Thus, a substantial procedural violation had been committed justifying remittal of the present main request and auxiliary request 1, claim 1 of both these requests being identical to claim 1 of the main request before the Examining Division. The subject-matter of auxiliary request 2 was now directed to compositions comprising compounds of formula (B) which had not been searched, only compositions comprising compounds of formula (A) having been searched, such that this

- request should also be remitted to the first instance for search and examination.
- 2.2 A reimbursement of the appeal fee may be ordered if the Board deems the appeal allowable and if such reimbursement is equitable by reason of a substantial procedural violation (Rule 103(1)(a) EPC).
- 2.3 In the present case, however, the necessity for the Appellant to file an appeal also arose by virtue of the Examining Division's reasoned decision with respect to lack of inventive step of the subject-matter of claim 1 of each of the then pending auxiliary requests 1 and 2, relating to a composition comprising a compound of formula (A) as LXR activator. Compositions comprising compounds of formula (A) were also specifically claimed in claim 2 of the then pending main request, said claim being dependent on claim 1 which related to compositions comprising an LXR activator in general. Thus, even if it was not explicitly stated in the contested decision, it was evident therefrom that the subject-matter of at least claims 1 and 2 of the then pending main request necessarily did not involve an inventive step either.
- 2.4 Thus, lack of unity was not the sole ground given in the contested decision for refusing the application. The Appellant would in any case have had to file an appeal in view of the reasoned ground of lack of inventive step for the subject-matter of claim 1 of each of auxiliary requests 1 and 2, which applied equally to the subject-matter of claim 1 of the main request, and this regardless of whether another ground for refusal, namely lack of unity, was adequately reasoned or not. In addition, the then pending auxiliary request 3 was indeed refused for lack of

unity only. However, the subject-matter of said request is no longer subject-matter of the present appeal proceedings such that any lack of reasoning in the contested decision with respect to refusal of this request has no negative consequences for the Appellant in the present appeal proceedings. The Board thus holds that reimbursement of the appeal fee is not equitable.

2.5 Furthermore, there is no necessity to remit the case to the first instance, the Board being in a position to exercise its power under Article 111(1) EPC to carry out examination of the case, at least with respect to inventive step, for the subject-matter of all requests. This is because claim 1 of each of the present main request and of auxiliary request 1 is identical to claim 1 of the main request on which the decision of the Examining Division was based, and encompasses compositions comprising compounds of formula (A) for which reasons of lack of inventive step over document (3) were given in said decision. With regard to auxiliary request 2, despite the compositions comprising compounds of formula (B) having not been formally searched and not yet examined by the first instance, the Board indicated in its communication dated 26 February 2015 (see point VI above) why said compositions were not inventive over document (3).

3. *Right to be Heard (Article 113(1) EPC)*

3.1 In the communication of the Board dated 26 February 2015 (see point VI above), it was indicated why the subject-matter of all the requests on file, including that directed to the compositions comprising a compound of formula (B), was not inventive.

- 3.2 In response to said communication, the Appellant indicated merely that it would not be attending the oral proceedings, provided no additional arguments as to why the claimed subject-matter should now be considered to fulfil the requirements of Article 56 EPC, and requested a decision on the basis of its submissions thus far. The oral proceedings were held in the absence of the Appellant pursuant to Rule 115(2) EPC.
- 3.3 Hence, the absent - albeit duly summoned - Appellant was aware from the proceedings to date of the actual criteria on which it would be judged (see T 341/92, OJ EPO 1995, 373, point 2.3.3 of the reasons).
- 3.4 The present decision is thus based on facts upon which the Appellant has had an opportunity to present comments, such that the Board is satisfied that it complies with the requirements of Article 113(1) EPC.

Main request and auxiliary requests 1 and 2

4. *Inventive Step*

- 4.1 Claim 1 of present auxiliary request 2 relates to a composition comprising a compound of formula (B) as LXR activator, other than 25-hydroxycholesterol (see point IV above). Claim 1 of each of the main request and auxiliary request 1, which is identical to claim 1 of the main request before the Examining Division, relates to a composition comprising an LXR activator in general. In case this embodiment according to auxiliary request 2 lacked inventive step, such a line of requests would mandatorily result in the conclusion that the subject-matter of claim 1 of each of the main request and auxiliary request 1, which embrace this

embodiment, cannot involve an inventive step either. For this reason, it is appropriate that the subject-matter of claim 1 of auxiliary request 2 is examined first as to inventive step.

- 4.2 Compositions comprising a compound of formula (A) were found in the contested decision to lack an inventive step over document (3) (see point III above), compounds of formula (B) differing from those of formula (A) only in that they possess the group OR_1 , such as hydroxyl, instead of a keto group at position 3 of the cholesterol skeleton.
- 4.3 Document (3) discloses a cosmetic composition having a synergistic effect (see col. 1, lines 9 to 16) comprising a sterol which is capable of inhibiting the biosynthesis of cholesterol at any stage, such as a sterol carrying on the cholesterol structure or on a derived structure at least one oxygenated substituent, such as OH, oxo or carbonyl, other than the hydroxyl in position 3, e.g. in position 4, 20, 22, 23, 25 or 26, for example, 25-hydroxycholesterol (see col. 19, lines 41 to 57), together with retinoic acid or derivative thereof e.g. its esters, all trans- or 13-cis-retinoic acid, retinol and retinal (see col. 2, lines 23 to 25 and 31 to 38) for combating ageing of the skin, be it photo-induced or chronological (col. 21, lines 44 to 45).
- 4.4 Although the compositions comprising a compound of formula (B) according to auxiliary request 2 have not formally been searched (see point III above), the Board holds that document (3), which was considered by the Examining Division to be the closest prior art for the compositions comprising a compound of formula (A), is even closer to the compositions comprising a compound

of formula (B). This is because document (3) (see col. 19, lines 49 to 57) relates to compositions comprising sterols carrying on the cholesterol structure or on a derived structure a hydroxyl in position 3, compounds of formula (B), when R₁ is hydrogen, also possessing a hydroxyl group at position 3, whereas those of formula (A) possess a keto group at this position.

4.5 In view of this state of the art, the problem underlying the application in suit would appear to be the provision of alternative compositions for combating chrono- and photoageing of the skin.

4.6 As the solution to this problem, claim 1 of auxiliary request 2 proposes compositions comprising a compound of formula (B), other than 25-hydroxycholesterol, said compounds differing from the sterol specifically mentioned in document (3), namely 25-hydroxycholesterol, in that *inter alia* the hydroxyl group is at position 4 (i.e. R₂), 20, 22, 23 or 26 of the cholesterol skeleton.

4.7 Finally, it remains to be decided whether or not the proposed solution to the problem underlying the present application is obvious in view of the cited prior art.

4.7.1 Document (3) (see col. 19, lines 41 to 57) itself teaches that sterols useful in the compositions described therein for combating chrono- and photoageing of the skin, may carry on the cholesterol structure or on a derived structure at least one oxygenated substituent, such as hydroxyl, other than the hydroxyl in position 3, and that this substituent may be at position 4, 20, 22, 23, 25 or 26. Hence, at least those compositions comprising compounds of formula (B) wherein R₂ is a hydroxyl group or wherein the group R is -C(CH₃)-(CH₂)₃-CH(CH₃)-CH₃ substituted by a hydroxyl

group at one or more of positions 20, 22, 23 or 26 of the cholesterol skeleton, do not involve an inventive step over document (3).

4.8 For the following reasons the Board cannot accept the Appellant's arguments in support of inventive step.

4.8.1 The Appellant submitted that document (3) did not disclose anywhere that 25-hydroxycholesterol was an LXR-activator, such that it was not obvious to use other LXR-activators in combination with retinoic acid to treat chrono- and photoageing of the skin, it not being possible to predict which sterols were LXR activators and which were not.

However, as indicated in point 4.7.1 above, document (3) teaches that structural derivatives of 25-hydroxycholesterol which fall under the general formula (B) according to claim 1 of the present auxiliary request 2 may be used in combination with retinoic acid to treat chrono- and photoageing of the skin, such that it is irrelevant whether document (3), either alone or in combination with another document, teaches that 25-hydroxycholesterol, or derivatives thereof, are also indeed LXR-activators.

4.8.2 The Appellant argued that document (3) disclosed the use of the compositions described therein for the treatment of epidermic keratinisation disorders only, whereas the compositions according to the application in suit were for use in treating the dermis.

However, document (3) discloses not only the treatment of epidermic keratinisation disorders (see col. 21, lines 16 to 34), but also the treatment of other dermatologic disorders, combating ageing, be it

photoinduced or chronological, and preventing or healing scars of epidermic and/or **dermic** atrophy (see col. 21, lines 42 to 50, emphasis added), the present application stating that the compositions may be used for treating both dermal and/or epidermal thinning (see page 13, line 21 and page 16, line 3). Thus, this argument of the Appellant does not convince the Board.

4.9 For these reasons, the subject-matter of claim 1 of auxiliary request 2 is not allowable for lack of inventive step pursuant to Article 56 EPC.

4.10 In these circumstances, since the process defined in claim 1 of auxiliary request 2 is encompassed by claim 1 of each of the main request and auxiliary request 1, these requests share the fate of auxiliary request 2 in that they too are not allowable for lack of inventive step pursuant to Article 56 EPC.

5. *Other issues*

The Examining Division also found that one or more of the then pending requests did not fulfil the requirements of Article 82 (and dependent Rules 64 and 137(4) EPC (2000)) and Article 84 EPC (see point III above).

In view of the negative conclusion in respect of inventive step for the subject-matter of all requests as set out in point 4 above, a decision of the Board on these issues, or a remittal to the first instance for examination thereof, is unnecessary.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated