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# Datasheet for the decision of 6 October 2021

**Case Number:** T 2208/18 - 3.3.07

**Application Number:** 09708641.7

**Publication Number:** 2249792

**IPC:** A61K8/44, A61K8/21, A61Q11/00, A61P1/02, A61K31/198

**Language of the proceedings:** EN

**Title of invention:**
ORAL CARE PRODUCT AND METHODS OF USE AND MANUFACTURE THEREOF

**Applicant:**
Colgate-Palmolive Company

**Headword:**
ORAL CARE PRODUCT AND METHODS OF USE AND MANUFACTURE THEREOF/ Colgate-Palmolive Company

**Relevant legal provisions:**
RPBA Art. 12(4)

**Keyword:**
Admission of new requests in appeal proceedings (No)

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Office européen des brevets

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**Case Number: T 2208/18 - 3.3.07**

# D E C I S I O N
# of Technical Board of Appeal 3.3.07
# of 6 October 2021

| | |
|---|---|
| **Appellant:** (Applicant) | Colgate-Palmolive Company<br>300 Park Avenue<br>New York, NY 10022 (US) |
| **Representative:** | Wibbelmann, Jobst<br>Wuesthoff & Wuesthoff<br>Patentanwälte PartG mbB<br>Schweigerstrasse 2<br>81541 München (DE) |
| **Decision under appeal:** | **Decision of the Examining Division of the European Patent Office posted on 20 February 2018 refusing European patent application No. 09708641.7 pursuant to Article 97(2) EPC.** |

**Composition of the Board:**

| | |
|---|---|
| **Chairman** | E. Duval |
| **Members:** | D. Boulois |
| | A. Jimenez |

## Summary of Facts and Submissions

I. The appeal lies from the decision of the examining division to refuse European patent application n° 09 708 641.7. The decision was a decision according to the state of the file referring to the communication of the examining division dated 26 January 2018, based on the set of claims 1-7 filed with letter of 22 December 2017.

Independent claims 1 and 2 of this set of claims read as follows:

"1. Use of an effective amount of arginine, in free or salt form, and an effective amount of fluoride, present in a single composition, for the manufacture of a medicament for administration to the oral cavity of a subject for treating, reducing or inhibiting early enamel lesions, wherein the medicament is a dentifrice composition, wherein the early enamel lesions are detected by quantitative light-induced fluorescence (QLF) or electrical caries monitoring(ECM), the dentifrice composition having a base formulation comprising precipitated calcium carbonate and/or dicalcium phosphate dihydrate and wherein the arginine is provided in an amount of from 1 to 10 wt% based on the total weight of the dentifrice composition, the weight of the arginine being calculated as free base form."

"2. A dentifrice composition for use in treating, reducing or inhibiting early enamel lesions, the treatment, reduction or inhibition comprising administrating the dentifrice composition to the oral cavity of a subject, wherein the dentifrice composition

has a base formulation comprising precipitated calcium carbonate and/or dicalcium phosphate dihydrate, the dentifrice composition further comprising an effective amount of arginine, in free or salt form, and an effective amount of fluoride, present in a single composition, wherein the arginine is provided in an amount of from 1 to 10 wt% based on the total weight of the dentifrice composition, the weight of the arginine being calculated as free base form."

II. The documents cited during the examination proceedings included the following:
D1: WO 00/78270 A1
D3: WO 97/32565 A1

III. According to the communication dated 26 January 2018 referred to in the decision under appeal, documents D1 and D3 were novelty-destroying for the subject-matter of claims 1-5.

Moreover, the subject-matter of claims 1-7 lacked an inventive step in view of document D1 alone or D3 in combination with D1. The difference between D1 or D3 and claims 6 and 7 was that the composition of the claims further comprised a potassium salt. The technical effect achieved by this difference was considered to be the depolarization of the nerve fiber membranes essential for nerve impulse transmission. The problem to be solved was therefore the provision of an improved composition for use in treating early enamel lesions. The solution according to claims 6 and 7 was to add a potassium salt to the composition, and this solution was obvious in view of D1 alone (see p. 3,l. 10-14) or of D3 in combination with D1.

IV. The applicant (hereinafter the appellant) filed an appeal against the decision of the examining division.

V. With the statement setting out the grounds of appeal dated 20 June 2018, the appellant submitted a new main request and auxiliary requests 1 and 2.

Independent claims 1 and 2 of the main request read as follows, with the modifications in comparison to the claims which were the subject of the decision on the state of the file shown in bold:

"1. Use of an effective amount of arginine, in free or salt form, and an effective amount of **sodium monofluorophosphate**, present in a single composition, for the manufacture of a medicament for administration to the oral cavity of a subject for treating, reducing or inhibiting early enamel lesions, wherein the medicament is a dentifrice composition, wherein the early enamel lesions are detected by quantitative light-induced fluorescence (QLF) or electrical caries monitoring (ECM), the dentifrice composition having a base formulation comprising precipitated calcium carbonate and/or dicalcium phosphate dihydrate and wherein the arginine is provided in an amount of from 1 to 10 wt% based on the total weight of the dentifrice composition, the weight of the arginine being calculated as free base form."

"2. A dentifrice composition for use in treating, reducing or inhibiting early enamel lesions, the treatment, reduction or inhibition comprising administrating the dentifrice composition to the oral cavity of a subject, wherein the dentifrice composition has a base formulation comprising precipitated calcium carbonate and/or dicalcium phosphate dihydrate, the

dentifrice composition further comprising an effective amount of arginine, in free or salt form, and an effective amount of **sodium monofluorophosphate**, present in a single composition, wherein the arginine is provided in an amount of from 1 to 10 wt% based on the total weight of the dentifrice composition, the weight of the arginine being calculated as free base form."

Independent claims 1 and 2 of auxiliary request 1 comprised a further restriction of the base formulation to calcium carbonate:
"the dentifrice composition having a base formulation comprising precipitated calcium carbonate ~~**and/or dicalcium phosphate dihydrate**~~".

Independent claims 1 and 2 of auxiliary request 2 comprised a further restriction of the base formulation to dicalcium phosphate dihydrate:
"the dentifrice composition having a base formulation comprising ~~**precipitated calcium carbonate and/or**~~ dicalcium phosphate dihydrate".

VI. A communication expressing the board's preliminary opinion of the board was sent to the applicant. The preliminary opinion of the Board was that the new main request and auxiliary requests 1 and 2 should not be admitted into the appeal proceedings.

VII. With a letter dated 17 September 2021, the appellant withdrew its request for oral proceedings and requested a decision on the state of the file.

VIII. The appellant's written arguments can be summarised as follows:

New requests (new claims) were submitted in order to address comprehensively the issues raised by the examining division. The fact that these new requests included limitations vis-a-vis the previously pending claims did not imply that the applicant agreed with any notion expressed by the examining division.

The independent claims 1 and 2 of the main request limited the "effective amount of fluoride" to the "effective amount of sodium monofluorophosphate" This limitation "narrowed" the present invention to the preferred fluoride source.

The auxiliary requests were directed separately to precipitated calcium carbonate and dicalcium phosphate.

IX. Requests

The appellant requested that the decision under appeal be set aside and that the case be remitted to the examining division with the order to grant a patent on the basis of the set of claims of the main request or alternatively of auxiliary request 1 or 2 filed with the statement setting out the grounds of appeal on 20 June 2018.

## Reasons for the Decision

1. Admittance of the requests into the appeal proceedings

1.1 The Board notes that the decision on the state of the file was taken on a given set of claims on the grounds of novelty and inventive step, and on request of the

appellant after having been summoned to oral proceedings before the examining division (cf. the written submission of the appellant dated 29 January 2018).

1.2 In the appeal proceedings, the appellant has filed three new sets of claims which are different from the set of claims filed during the examination proceedings, which prevents the Board to review the decision taken by the examination division. More particularly, the feature "an effective amount of sodium monofluorophosphate" has been introduced in claim 1 of all requests. This introduction has a clear and important incidence on the discussion on novelty and even more on inventive step and constitutes a fresh case.

Claim 1 of auxiliary requests 1 and 2 comprises a further difference with regard to the base formulation restricted respectively to "precipitated calcium carbonate" and "dicalcium phosphate dihydrate".

1.3 According to Article 12(4) RPBA 2007, a board of appeal has the power to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first-instance proceedings. This provision reflects the principle that appeal proceedings are not intended as a continuation, let alone a replacement, of the first-instance proceedings. Parties to EPO proceedings are not at liberty to forgo the proceedings before a department of first instance and take their case directly to a board of appeal for further prosecution. They can rely on the boards of appeal for a judicial review of the first-instance decision, not for a continued or new full examination of the merits of the application.

1.4 In the present case, the appellant had the opportunity to file new requests during the examination proceedings, such as those submitted in the appeal proceedings, after the confirmation of the negative opinion of the examining division as stated in its communication dated 26 January 2018. Yet the appellant refrained from doing so and requested instead a decision according to the state of the file on the same set of claims considered in the communication of the Examining Division. It appears that, by doing so, the appellant preferred to discontinue the still-ongoing proceedings before the Examining Division and to prosecute its case instead directly before the Board of Appeal with substantially amended requests. Article 12(4) RPBA 2007 is however intended to prevent this situation. Thus, the present case is one where the appellant could and should have presented its new requests in the first-instance proceedings, and consequently the Board may exercise its power under Article 12(4) RPBA 2007 to hold them inadmissible.

The Board issued furthermore a preliminary opinion which was negative with regard to the admission of the main request and auxiliary requests 1 and 2 into the appeal proceedings. The appellant did not provide any argument in answer to the Board's opinion.

1.5 Consequently, the main request and auxiliary requests 1 and 2 are not admitted into the appeal proceedings (Article 12(4) RPBA 2007).

1.6 In the absence of any admissible request in the appeal proceedings, the appeal has thus to be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar: The Chairman:

B. Atienza Vivancos E. Duval

Decision electronically authenticated