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**Datasheet for the decision
of 23 November 2020**

Case Number: T 0969/19 - 3.3.07

Application Number: 12831671.8

Publication Number: 2755625

IPC: A61K8/00

Language of the proceedings: EN

Title of invention:

SHELLAC BASED SPRAYABLE SUNSCREEN

Applicant:

Mantrose-Haeuser Co. Inc.

Headword:

SHELLAC BASED SPRAYABLE SUNSCREEN/Mantrose-Haeuser Co. Inc.

Relevant legal provisions:

EPC Art. 123(2), 56, 111(1)
EPC R. 103(4)(c), 111(2)
RPBA 2020 Art. 11, 25, 12(2)

Keyword:

Amendments (Yes)
Consisting of - Disclaimer (No)
Remittal to Examining Division

Decisions cited:

G 0002/10, T 0285/00, T 0564/89, T 0284/98, T 0276/06



Beschwerdekammern

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Case Number: T 0969/19 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 23 November 2020

Appellant: Mantrose-Haeuser Co. Inc.
(Applicant) 1175 Post Road East
Westport, CT 06880 (US)

Representative: Forresters IP LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 20 November
2018 refusing European patent application No.
12831671.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman A. Uselli
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° 12 831 671.8. The decision was a decision on the state of the file based on the communication of the examining division dated 2 August 2018 and based on the set of claims filed with letter of 4 July 2018, pages 1, 6-11 of the description as published, page 2 as filed with letter of 11 August 2016 and pages 3-5, 12 filed with letter dated 31 May 2016.

Claim 1 read as follows:

"1. A sprayable topical sunscreen composition consisting of at least 50 wt.% of an alcohol carrier, 5-40 wt.% of at least one sunscreen compound or material which is soluble in the alcohol carrier, a film forming polymer capable of forming a protective coating on the skin to which the composition is applied, the film forming polymer comprising 1-7 wt.% of shellac, and optionally one or more from 2-15 wt.% of a water-insoluble liquid emollient, perfumes, deodorant compounds, astringent salts, antioxidants and insect repellents, wherein the concentrations specified are given in terms of weight of the ingredients based on the weight of the sprayable sunscreen composition as a whole but excluding any propellant that might be present."

- II. According to the communication of the examining division dated 2 August 2018 which formed the basis of the decision on the state of the file, the application did not meet the requirements of Article 123(2) EPC and 56 EPC.

The objections of the examining division can be summarised as follows:

- (a) The amendment filed on 4 July 2018 introduced subject-matter which extended beyond the content of the application as filed, contrary to Article 123(2) EPC. The application as filed did not disclose compositions comprising only what is now listed in claim 1, nor could this information be understood by the skilled person when reading the claims and the description. The ranges in claim 1 as filed did not in any combination add up to 100% but only to 97%, which meant that the list of ingredients was not exhaustive, or in other terms that it described an open and not a closed list. The remaining 3% in the claim as filed did not need to be more alcohol carrier.

- (b) According to the letter of the applicant, claim 1 solved a technical problem that was not as such disclosed in the application as filed. Moreover the solution proposed (i.e. the absence of the flexibilizer) was also not disclosed in the application as filed. According to the jurisprudence of the Boards of Appeal (See Case Law, Ed 2016, II.E.1.14) the reformulation of the technical problem was not in breach of Art. 123(2) EPC provided that the problem and the solution proposed could have been deduced from the application as a whole in the form originally filed. This was not presently the case.

- (c) The substitution of "comprising" with "consisting" was considered equivalent to the introduction of a

disclaimer formulated in positive terms (see for comparison T 0285/00), which was not allowable in case of a prior non accidental disclosure.

(d) The application did not meet the requirements of Article 52(1) EPC because the subject-matter of claim 1 did not involve an inventive step within the meaning of Article 56 EPC.

III. The applicant (hereinafter the appellant) filed an appeal against the decision of the examining division. With the statement of grounds of appeal dated 27 February 2019, the appellant filed a set of claim as main request.

Claim 1 of the main request read as follows, with the modifications in respect of claim 1 of the request of 4 July 2018 in bold:

"1. A sprayable topical sunscreen composition consisting of at least 50 wt.% of an alcohol carrier, 5-40 wt.% of at least one sunscreen compound or material which is soluble in the alcohol carrier, a film forming polymer capable of forming a protective coating on the skin to which the composition is applied, the film forming polymer comprising 1-7 wt.% of shellac, and optionally one or more from **a propellant**, 2-15 wt.% of a water insoluble liquid emollient, perfumes, deodorant compounds, astringent salts, antioxidants and insect repellents, wherein the concentrations specified are given in terms of weight of the ingredients based on the weight of the sprayable sunscreen composition as a whole but excluding any propellant that might be present."

IV. A communication dated 25 September 2020 expressing the Board's preliminary opinion was sent to the appellant. The Board stated that the main request met the requirements of Article 123(2) EPC and envisaged a remittal to the examining division.

V. With a letter dated 9 November 2020, the appellant agreed with the suggestion of the Board to remit the case to the examining division for further prosecution. It withdrew its request for oral proceedings on condition that the Board remits the case to the examining division, and in particular for examination of the ground for refusal under Article 56 EPC.

VI. Requests

The appellant requests that the decision under appeal be set aside and the case be remitted to the examining division for further prosecution on the basis of the set of claim filed as main request with the letter of 27 February 2019.

Reasons for the Decision

1. Main requests - Article 123(2) EPC

1.1 The communication of the examining division dated 2 August 2018 raised three points a), b), c). Point a) related to the concentration ranges in claim 1, while point b) concerned the definition of the technical problem and point c) the term "consisting of".

1.2 As regards point a) of the communication, the ranges of all components of the composition in claim 1 add up to 100%, in view of the feature "**of at least 50 wt% of an alcohol carrier**", which has a basis in the original

application in paragraph [0016] (emphasize added by the Board).

The argument of the examining division that the claimed composition might reach a total amount of components of only 97 wt% thus cannot be followed. As explained by the appellant to the examining division in a letter posterior to the communication dated 2nd August 2018, it is clear that, in view of the feature "of at least 50 wt% of an alcohol carrier", the total amount of components is completed to 100 wt% by the presence of appropriate amounts of an alcohol carrier.

This objection is therefore unjustified.

- 1.3 As regards point b), Article 123(2) EPC is not concerned with the issue of whether or not an objectively reformulated technical problem could be used in the course of the problem and solution approach . It could only come into play if an amended technical problem were incorporated into the description itself (see decisions T 564/89, point 4.3 of the reasons, T 284/98, point 1.3.2 of the reasons, T 276/06 point 4.2 of the reasons).

In the present case, the examining division did not identify or mention any amendment of the description which would have introduced a new technical problem, and the Board did also not identify any in the amended pages of the description, namely page 2 as filed with letter of 11 August 2016 and pages 3-5, filed with letter dated 31 May 2016.

Thus this objection under Article 123(2) EPC is not convincing.

1.4 As regards point c), the replacement of the term "comprising" by "consisting of" is a restricting amendment which may be allowable if it finds a support in the application as originally filed; contrary to what was stated by the examining division in its communication of 2 August 2018, it is not a disclaimer against a prior art document, which has furthermore not been identified by the examining division. Already for this reason, the decision T 285/00 referred to by the examining division is of no relevance.

For the assessment of Article 123(2) EPC, the relevant question remains whether the amendment is within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application as filed (according to the "gold standard" of G 2/10, OJ 2012, 376).

In the present case, with the addition of the feature "a propellant" in the main request filed in the appeal proceedings, claim 1 of the main request lists in any case all the possible components whose presence is presented in paragraph [0009] of the application as filed as mandatory, namely an alcohol carrier, a sunscreen compound, a film-forming polymer, shellac, or the components whose presence is presented as optional, namely one or more from a propellant, a water-insoluble liquid emollient, perfumes, deodorant compounds, astringent salts, antioxidants and insect repellents (see paragraphs [0014], [0015], [0028] and [0030]). There is in any case no teaching in the application as to the presence of a further component, and the use of the term "consisting of" is therefore justified and allowable.

Accordingly, this objection under Article 123(2) EPC is also not convincing.

- 1.5 Thus, none of the reasons put forward by the examining division to support the objections pursuant to Article 123(2) EPC hold good. Furthermore, the Board does not see any other reason to object the subject-matter of the main request having regard to the issue of added subject-matter. Consequently, the main request meets the requirements of Article 123(2) EPC.

2. Main Request - Inventive step

With regard to inventive step, the communication which forms the basis for the appealed decision on the state of the file does not refer to any document and does not comprise any argument or reasoning, and simply asserts that the subject-matter of claim 1 does not involve an inventive step.

It is therefore not possible to understand from this communication why the claimed invention lacks inventive step.

In the Board's view, that part of the decision which concerns inventive step is not reasoned (Rule 111(2) EPC).

3. Remittal to the examining division

The sole reasoned grounds for the refusal set out in the decision under appeal, namely under Article 123(2) EPC, are not justified.

The decision under appeal does not comprise a reasoned decision as regards inventive step.

Under Article 111(1) EPC, the Board may either proceed further with the examination of the application, in particular with respect to Article 56 EPC, or remit the case to the examining division for further prosecution.

Article 11 RPBA 2020 provides that the Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so.

The Board holds that such special reasons are apparent in the present case because the examining division has not taken an appealable decision on essential outstanding issues with respect to at least Article 56 EPC. As recalled in Article 12(2) RPBA 2020, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner. This principle would not be respected if the Board were to conduct a complete examination of the application. Consequently, in the present case, Article 11 RPBA 2020 cannot be interpreted to mean that the Board should carry out a full examination of the application for compliance with the requirements of at least Article 56 EPC for which no reasoned decision of the first instance exists yet.

Under these circumstances, the Board considers it appropriate to allow the appellant's request for remittal of the case to the examining division (Article 111(1) EPC). Accordingly, the Board can accede to the appellant's request that the appealed decision be set aside and that the patent application be remitted to the examining division for further prosecution.

Order

For these reasons it is decided that:

1. The decision of the examining division is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairman:



B. Atienza Vivancos

A. Uselli

Decision electronically authenticated