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**Datasheet for the decision
of 11 March 2022**

Case Number: T 2315/19 - 3.3.01

Application Number: 14728500.1

Publication Number: 3003339

IPC: A61K36/9066, A61K45/06,
A61K31/05, A61K31/12,
A61K31/7048, A61P19/02

Language of the proceedings: EN

Title of invention:
COMPOSITIONS FOR USE IN CARTILAGE BREAKDOWN

Applicant:
Société des Produits Nestlé S.A.

Headword:
Oleuropein/NESTLÉ

Relevant legal provisions:
EPC Art. 54, 111(1)

Keyword:
Main request - novelty (yes)
Remittal (yes)



Beschwerdekammern

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Case Number: T 2315/19 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 11 March 2022

Appellant: Société des Produits Nestlé S.A.
(Applicant) Entre-deux-Villes
1800 Vevey (CH)

Representative: Elkington and Fife LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 19 March 2019
refusing European patent application No.
14728500.1 pursuant to Article 97(2) EPC**

Composition of the Board:

Chairwoman M. Pregetter
Members: J. Molina de Alba
L. Bühler

Summary of Facts and Submissions

- I. This appeal by the applicant (appellant) is against the examining division's decision refusing European patent application No. 14728500.1.

The decision is based on the claims of a main request and five auxiliary requests. Claim 1 of the main request reads as follows:

"1. Composition comprising oleuropein for use to inhibit or decrease cartilage breakdown."

- II. In the decision, the examining division considered that the subject-matter of claim 1 of the main request lacked novelty over D1 (US 2010/0056463). Although D1 focused on the anti-inflammatory effect of compositions comprising oleuropein, paragraphs [0165] to [0168] referred to the use of these compositions against cartilage breakdown. The amendments in the auxiliary requests did not overcome the objection.
- III. With its statement of grounds of appeal, the appellant filed the claims of a main request and eight auxiliary requests.
- IV. The board scheduled oral proceedings in line with the appellant's request. In its preliminary opinion, the board held that D1 anticipated the subject-matter of the main request and auxiliary requests 1 and 1a but not that of auxiliary request 2.
- V. Following a telephone conversation with the board, the appellant filed the claims of a new main request and

auxiliary request 1 by a letter dated 8 March 2022. Conditionally, it withdrew all the other claim requests and its request for oral proceedings.

Claim 1 is the only independent claim of the main request. It reads as follows:

"1. Composition comprising oleuropein for use to inhibit or decrease cartilage breakdown, wherein the cartilage breakdown takes place in the context of a pathology with no inflammation component."

VI. The board cancelled the oral proceedings.

VII. The appellant's arguments, where relevant to the present decision, can be summarised as follows:

Claim 1 of the main request had been limited to the treatment of pathologies with no inflammation component. The amendment was supported by page 17, lines 14-17 of the application as filed. As D1 was concerned with the anti-inflammatory effect of oleuropein, the treatment of a pathology having no inflammation component was novel.

VIII. The appellant's final request, as far as relevant to the present decision, was that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution on the basis of the claims of the main request filed with the letter dated 8 March 2022.

Reasons for the Decision

1. The appeal is admissible: it meets the requirements of Articles 106 to 108 and Rule 99(2) EPC.
2. The appellant had requested oral proceedings if the board was not minded to remit the case to the examining division on the basis of any of the claim requests filed on 8 March 2022.

Taking into consideration the appellant's requests and written submissions, the board can take a final decision without holding oral proceedings (Articles 113(1) and 116(1) EPC and Article 12(8) RPBA 2020).

3. The filing of the main request was a direct reaction by the appellant to the telephone conversation held with the board on 4 March 2022. Therefore its admittance is not precluded by Article 13(2) RPBA 2020.
4. *Amendments - Article 123(2) EPC*

The main request complies with Article 123(2) EPC. The basis for its 14 claims in the application as filed is the following:

Claim 1: claim 1 as filed, page 5, lines 22-25 and page 17, lines 21-23.

Claims 2-13: claims 2-13 as filed.

Claim 14: page 19, lines 25-26 and page 22, lines 6-7.

5. *Novelty over D1 - Article 54 EPC*

D1 (see abstract and paragraphs [0013], [0023], [0027], [0142], [0143], [0152], Examples 1 and 2 and claims 5, 20 and 23) discloses the use of compositions comprising oleuropein and additional anti-inflammatory agents for the prevention or treatment of inflammatory disorders.

In paragraphs [0165] and [0166], D1 refers to osteoarthritis in relation to the treatment of cartilage breakdown. Although osteoarthritis has a non-inflammatory origin, the treatment of osteoarthritis referred to in D1 is clearly associated with non-initial, inflammatory stages of osteoarthritis (see paragraph [0027], last sentence). Therefore the subject-matter of claim 1, which is directed to the treatment of cartilage breakdown in the context of a pathology with no inflammatory component, is novel over D1.

6. *Remittal (Article 111 EPC)*

The appellant requested that the case be remitted to the examining division for further prosecution.

The decision under appeal is confined to the assessment of novelty in relation to D1. It follows from point 5 above that the subject-matter of the main request is novel over D1, so the reasons for the refusal have been overcome. Therefore, pursuant to Article 111(1) EPC, the board has discretion to remit the case to the examining division for consideration of undecided issues, such as inventive step, as requested by the appellant.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of the claims of the main request filed with the letter dated 8 March 2022.

The Registrar:

The Chairwoman:



M. Schalow

M. Pregetter

Decision electronically authenticated