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**Datasheet for the decision
of 6 December 2023**

Case Number: T 1408/21 - 3.3.07

Application Number: 14897204.5

Publication Number: 3166572

IPC: A61K8/02, A61Q11/00

Language of the proceedings: EN

Title of invention:
ANTI-CALCULUS ORAL COMPOSITIONS

Patent Proprietor:
The Procter & Gamble Company

Opponent:
Trösch, Dominique

Headword:
Anti-calculus oral compositions / PROCTER & GAMBLE

Relevant legal provisions:
EPC Art. 100(c), 123(2)

Keyword:
Amendments - added subject-matter (yes)

Decisions cited:

G 0002/10, T 1511/07, T 1731/18, T 1621/16, T 1937/17



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Case Number: T 1408/21 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 6 December 2023

Appellant: Trösch, Dominique
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 28 June 2021
rejecting the opposition filed against European
patent No. 3166572 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairwoman Y. Podbielski
Members: E. Duval
J. Lécaillon

Summary of Facts and Submissions

I. The appeal was filed by the opponent (appellant) against the decision of the opposition division to reject the opposition filed against the patent in suit.

II. Claim 1 of the patent as granted pertained to:

"An oral composition comprising:

(a) from 20wt% to 60wt% of a calcium-containing abrasive, wherein the calcium-containing abrasive is selected from the group consisting of calcium carbonate, dicalcium phosphate, tricalcium phosphate, calcium orthophosphate, calcium metaphosphate, calcium polyphosphate, calcium oxyapatite and combinations thereof;

(b) a calcium-catching phosphate source in an amount sufficient to provide at least 100mM of phosphate ions, PO_4^{3-} , wherein the calcium-catching phosphate source is selected from the group consisting of pyrophosphate source, polyphosphate sources, polyphosphorylated inositol sources, polyphosphonate sources and combinations thereof;

(c) no more than 10wt% of a humectant; and

(d) at least 5wt% of water;

wherein the oral composition has a pH from 9.0 to 11."

III. Regarding the ground for opposition of Article 100(c) EPC, the opposition division decided that claim 1 of the patent did not result from the undisclosed combination of multiple selections from independent lists in the application as filed.

IV. The opponent (appellant) lodged an appeal against the opposition division's decision.

V. In their reply to the appeal, the patent proprietor (respondent) defended their case on the basis of the patent as granted as the main request, and filed auxiliary requests 1-3.

In claim 1 of auxiliary request 1, the pH range is amended to "from 9.5 to 11".

Claim 1 of auxiliary request 2 differs from claim 1 as granted in that the amount of abrasive is "25wt% to 60wt%" and the amount of humectant "no more than 5wt%".

Auxiliary request 3 combines the amendments of both auxiliary requests 1 and 2.

VI. The Board set out its preliminary opinion in a communication under Article 15(1) RPBA.

VII. Oral proceedings were held before the Board on 6 December 2023.

VIII. The parties' requests were the following:

(a) The appellant requested that the decision under appeal be set aside and that the patent be revoked.

(b) The respondent requested that the appeal be dismissed and the patent thus be maintained as granted, or, subsidiarily, that the patent be maintained on the basis of one of auxiliary requests 1-3 filed with the reply to the appeal.

IX. The respondent's arguments regarding added subject-matter may be summarised as follows:

Claim 1 of the application as filed provided for the combination of features (a)-(d) and the pH requirement. The lower limit of the calcium-containing abrasive of 20 wt% was presented as the narrowest value and hence as most preferred in claim 11 as filed and could also be found at page 4, line 17. A basis for the lower limit of the pH range being 9.0 was to be found at page 9, line 11, as well as in claim 10 as filed. The amendments carried out in claim 1 of the main request were not associated with an undisclosed technical contribution, and were akin to an allowable shortening of a list. Furthermore, the examples of the patent were consistent with the amended values.

In addition, with respect to auxiliary request 1, the lower limit of 9.5 for the pH was the narrowest and thus most preferred value in claim 10.

Hence neither the main request nor auxiliary requests 1-3 introduced added subject-matter.

X. The appellant's arguments regarding added subject-matter may be summarised as follows:

Claim 1 as granted involved multiple selections from independent lists, in particular the amount of calcium-containing abrasive being from 20 to 60 wt% (as opposed to 1 to 60 wt%), and the pH value being from 9.0 to 11 (as opposed to 8 to 11).

Regarding the amount of abrasive, claim 11 and page 4 (lines 17) of the application as filed disclosed several ranges, wherein all lower thresholds may be

combined with all upper thresholds, thus resulting in numerous partially overlapping ranges, i.e. a non-converging list lacking any statement of preference. Similarly, claim 10 and page 9 (lines 10-11) of the application as filed showed several isolated thresholds for the pH range, resulting in a further non-converging list. It could not be derived from the examples which of the ranges were preferred.

The fact that the values 9.5 and 20% were the narrowest lower thresholds mentioned respectively in claim 10 as filed for the pH and claim 11 for the amount of abrasive did not express any preference for these values. Furthermore, claim 11 did not mention 60 wt% as upper value, such that the range 20-60 wt% could not be based thereon.

Accordingly, the main request and each of auxiliary requests 1-3 introduced added subject-matter.

Reasons for the Decision

1. Main request (patent as granted), Article 100(c) EPC
- 1.1 Claim 1 of the main request differs from claim 1 of the application as filed in that:
 - (i) the amount of calcium-containing abrasive is amended from 1-60 wt% to 20-60 wt%;
 - (ii) the calcium-catching phosphate source is limited to pyrophosphate source, polyphosphate sources, polyphosphorylated inositol sources, polyphosphonate sources and combinations thereof;
 - (iii) the amount of humectant is amended from no more than 20 wt% to no more than 10 wt%; and

(iv) the pH is amended from 8-11 to 9.0-11.

1.2 Under Articles 100(c) and 123(2) EPC, amendments can only be made 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 (following the "Gold standard" of G 2/10).

The relevant question is thus whether the combination of features of claim 1 of the main request, i.e. not only the combined presence of components (a)-(d) but also their amounts and the pH, can be derived directly and unambiguously from the application as filed as a whole. Contrary to the respondent's position, this question cannot be answered by simply looking at the amendments to the lower limits for the amount of abrasive (1 wt% to 20 wt%) and for the pH (8 to 9.0). The subject-matter of claim 1 is defined, among others, by the ranges 20-60 wt% and 9.0-11 in combination, and not simply by the values 20 wt% and 9.0.

1.3 For the following reasons the Board comes to the conclusion that the application as filed does not disclose an amount of abrasive in the range 20-60 wt% in combination with a pH of 9.0-11.

1.3.1 Regarding feature (i), the application as filed discloses an amount of abrasive of "5wt%, 10wt%, 15wt%, 20wt% or 25wt% to 35wt%, 40wt%, 50wt%, 55wt% or 60wt%" (see page 4, lines 16-18), or "from 10wt%, 15wt%, or 20wt% to 40wt%, 50wt% or 55wt%" (see claim 11).

Thus neither page 4 nor claim 11 of the application as filed disclose the claimed range of 20-60 wt%, but

instead present lists of lower limits and upper limits. The range 20-60 wt% results from a combination of the lower limit 20 wt% mentioned on page 4 or claim 11 with the upper limit 60 wt% of page 4 or claim 1 as filed.

1.3.2 As to feature (iv), the application as filed discloses a pH in the range of 8 to 11 (see claim 1 and page 9, line 10) and additionally lists of lower and upper pH limits (see claim 10 and page 9, line 11: "8.0, 8.5, 9.0 or 9.5 to 10.5, 10.7, 11.0 or 11.3"). The range 9.0-11 is not mentioned as such in the above passages of the application as filed, but results from the combination of the lower limit 9.0 of page 9 or claim 11 with the upper limit 11 of claim 1 or page 9.

1.4 Thus, for each of the features (i) and (iv) above, starting from the disclosure in the application as filed of a general range and of lists of further particular lower and upper limits, numerous partially overlapping sub-ranges may be created. The particular range 20-60 wt% for the amount of abrasive (i) represents a first selection from the list of ranges which may emerge from the endpoints shown in claims 1 and 11 and page 4 as filed. The range 9.0-11 for the pH represents a further selection from a second list of ranges that may be created on the basis of the endpoints shown in claims 1 and 10 and page 9 as filed. In the absence of any pointer to the particular combination of claim 1 of the main request, these amendments represent added subject-matter.

1.4.1 In this respect, the situation bears resemblance to the case underlying T 1511/07 (see point 2.1 of the reasons), which held that although the selection of explicitly disclosed borderline values defining several (sub)ranges, in order to form a new (narrower) sub-

range, was not contestable under Article 123(2) EPC when the ranges belong to the same list, the combination of an individual range from this list with another individual range emerging from a second list of ranges and relating to a different feature was not considered to be disclosed in the application as filed, unless there was a clear pointer to such a combination (see also T 1731/18, point 1.5 of the reasons, and the Case Law of the Boards of Appeal, 10th edition, 2022 II.E.1.6.2.a). If anything, the situation in the present case is worsened by the presentation in claims 10 and 11 and pages 4 and 9 as lists of upper and lower limits rather than defined ranges (see the Case Law of the Boards of Appeal, 10th edition, 2022 II.E.1.6.2.c).

- 1.4.2 The Board does not consider that the application as filed contains any pointer to the claimed combination of the ranges 20-60 wt% for the abrasive and 9.0-11 for the pH.

The compositions of examples 1-10 comprise 20, 32 or 50 wt% calcium carbonate, contain a particular humectant (sorbitol) in an amount of either 0 wt% (examples 1-6 and 8-10) or 17 wt% (example 7, which thus falls outside the claimed scope), and have pH values ranging from 9.1 to 10.4 (see tables 1 and 3, pages 14-17). In the Board's view, these examples do not point to the claimed combination of ranges anymore than they point to broader ranges.

The respondent saw an implicit statement of preference for the lower limit 20 wt% in the fact that it is the narrowest upper limit stated in claim 11 as filed, and in the fact that it is the narrowest value for the lower limit disclosed in the application as filed which still complies with all of the examples. However, this

alleged preference for the lower limit of 20 wt%, even if it were to be accepted, is not seen as a pointer to the range 20-60 wt% specified in claim 1 of the main request. Additionally, claim 11 as filed cannot point to this range, considering that the amount of abrasive in claim 11 is 55 wt% at most.

Likewise, the appellant infers from the application as filed a preference for the pH value 9.0 on the ground that it represents the most preferred value in the application as filed which still encompasses all of the examples of the present invention. However, neither claim 10 nor page 9 express any preference for the range 9.0-11.

- 1.5 The respondent further relied on decision T 1621/16 and expressed the view that the multiple selections were not associated with an undisclosed technical contribution. The technical effect and thus the invention remained the same, namely to balance anti-calculus efficacy with cleaning efficacy. Claim 1 of the main request did not single out a new invention through the amendments, but simply provided a more restricted version of each of the relevant features.

This reference to T 1621/16 does not help the respondent's case. Firstly, the numerous ranges, conceivably created from the general ranges and lists of upper and lower limits disclosed in the application as filed respectively for the pH and the amount of abrasive, are only partially overlapping and do not amount to lists of converging alternatives, i.e. lists of options ranked from the least to the most preferred, wherein each of the more preferred alternatives is fully encompassed by all the less preferred and broader options in the list (see point 1.4 of the reasons in

T 1621/16). Consequently, the conclusions of T 1621/16 regarding such convergent lists are in any case not relevant to the present case (see also T 1731/18, point 1.6 of the reasons). Secondly, T 1621/16 does not call into question the established criterion according to which, to meet the requirements of Article 123(2) EPC, the application as filed must include a pointer to the combination of features resulting from the multiple selections. Such a pointer is missing in the present case for the reasons given above (see 1.4.2). Lastly, the Board agrees with the conclusion set out in T 1937/17 (see point 4.3.1 of the reasons) that the criteria set out in T 1621/16 based on the notion of technical contribution are of no relevance when deciding on the allowability of amendments under Article 123(2) EPC. In the present case, after the amendment, the skilled person is presented with new technical information, namely the undisclosed combination of the ranges 20-60 wt% and 9.0-11, whether the corresponding technical effect is the same or not.

1.5.1 Accordingly, the main request introduces added subject-matter.

2. Auxiliary requests 1-3, Article 123(2) EPC

In auxiliary requests 1-3, the pH range is amended to "from ~~9.0~~ 9.5 to 11" (claim 1 of auxiliary requests 1 and 3; amendments emphasised by the Board) and/or the amount of abrasive is "~~20~~ 25wt% to 60wt%" (claim 1 of auxiliary requests 2 and 3).

These amendments do not modify the assessment given above for the main request, because the application as filed lacks any pointer to the claimed combination of ranges for the amount of abrasive and the pH.

A lower pH threshold of 9.5 is the narrowest value shown on page 9 (line 11) of the application. The range 9.5-11 is however not disclosed as such in the application as filed, but results from the combination of this lower threshold with the broadest upper pH limit of 11. No preference is expressed in the application as filed for the range 9.5-11.

Likewise, the range 25-60 wt% for the amount of abrasive results from the combination of the narrowest lower limit of 25 wt% of page 4 (line 17) with the broadest upper limit of 60 wt%. No preference is expressed either in the application as filed for the range 25-60 wt%.

Accordingly, claim 1 of each of auxiliary requests 1-3 infringes Article 123(2) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairwoman:



S. Sánchez Chiquero

Y. Podbielski

Decision electronically authenticated