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D E C I S I O N
of 11 July 1995

Case Number: T 0840/93 - 3.3.2

Application Number: 88103996.0

Publication Number: 0297213

IPC: A61K 7/16

Language of the proceedings: EN

Title of invention:
Oral treatment and use of an oral composition

Patentee:
THE PROCTER & GAMBLE COMPANY

Opponent:
01: Unilever N.V.
02: Henkel Kommanditgesellschaft auf Aktien
03: Goldwell AG
04: Sara Lee/DE N.V.
05: SmithKline Beecham p.l.c.
06: Colgate-Palmolive Company

Headword:
Oral compositions/PROCTER II

Relevant legal provisions:
EPC Art. 76, 111
EPC R. 86(3)

Keyword:
"Late filed requests - not admitted - appeal restricted to
judicial review of the requests considered by the first
instance - pending divisional applications"

Decisions cited:
G 0009/91, G 0010/91, T 0127/85, T 0406/86, T 0295/87,
T 0028/92

Headnote:

In the light of G 0009/91 and G 0010/91 on the purpose of appeals, special attention must be given to late filed requests at the appeal stage when divisional applications are still pending. If the distinction between the subject-matter of the divisional applications is not clear and some of them are still pending before the first instance, it is inappropriate to admit, during oral proceedings at the appeal stage after opposition, new requests which are neither immediately allowable nor bona fide attempts to overcome objections raised.

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DES BREVETS

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Beschwerdeamt

Boards of Appeal

Chambres de recours

Case Number: T 0849/93 - 3.3.2

DECISION
of the Technical Board of Appeal 3.3.2
of 11 July 1995

Appellant:
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Representative: -

Respondent:
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Representative: -

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Respondent: Colgate-Palmolive Company
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 25 May 1993, posted
on 16 July 1993 revoking European patent
No. 0 297 213 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: I. A. Holliday
S. C. Perryman

Summary of Facts and Submissions

I. European patent No. 0 297 213 was granted on the basis of six claims contained in European patent application No. 88 103 996.0. The application was a divisional from European patent application No. 83 303 417.6 (publication No. 0 097 476) which in its turn was derived from US application No. 391 040 filed on 22 June 1982.

II. Six oppositions were filed against the granted patent. The Opposition Division revoked the patent on the grounds of lack of novelty considering US-A-3 934 002 (1) to be the closest prior art. Document (1) relates to oral compositions containing specific bis-biguanides which inhibit the formation of plaque. The compositions of (1) also contain anticalculus agents and examples contain fluorides. Although a pyrophosphate was not the preferred anticalculus agent, the Opposition Division considered that Example XX of (1) disclosed a composition which destroyed the novelty of Claim 1 of both the main and auxiliary request.

Several opponents had raised objection under Article 100(c) that the subject-matter of the divisional application extended beyond that of the originally filed parent application. The Opposition Division, however, considered that the requirements of Article 123(2) were satisfied.

III. The Appellant lodged an appeal against the decision of the Opposition Division; oral proceedings took place on 11 July 1995.

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The grounds of appeal contained considerable argumentation of an alleged prejudice which would have inhibited one skilled in the art from using pyrophosphates and fluorides together in an oral composition.

The Appellant emphasised that the claims of the divisional application related to the use of pyrophosphate salt in the manufacture of a composition for reducing the incidence of dental calculus. Any composition which failed to disclose this use could not prejudice novelty.

In later submissions, received in the EPO on 8 May 1995, the Appellant sought to introduce three further auxiliary requests. At the oral proceedings, the Appellant withdrew the original main request on which the Opposition decision was based. The new main request was the auxiliary request, found to lack novelty by the Opposition Division, amended to specify from 10-70% by weight of a dental abrasive.

The Appellant defended the new main request against the attack under Article 100(c) by the Respondents.

IV. Only one of the Respondents chose to comment on the formal admissibility of the new requests, warning the Board to be wary of auxiliary requests when other divisional applications relating to similar subject-matter are still pending. It was further argued that the new main request did not amount to a bona-fide attempt to meet the objections of the Opposition Division.

Several respondents argued that the new main request which related to the use of an unrestricted "soluble pyrophosphate salt" infringed Article 123(2) EPC. The passage on page 3, lines 23 to 26 of the originally

filed parent application 83 303 417.6 referring to "mixtures of certain pyrophosphate salts" could not be interpreted to mean any soluble pyrophosphate salt selected from...". Furthermore a passage detailing the useful pyrophosphates in the passage bridging pages 9 and 10 of the parent application is headed "Dialkali Metal and Tetra alkali Metal Salts. Finally, it is to be noted that the mixtures specified include the sole use of dialkali metal salts, but the tetraalkali metal salts are never used alone, only in association with a dialkali metal salt.

V. Claim 1 of the main request reads as follows:

"1. Use of a soluble pyrophosphate salt in the manufacture of an oral composition in the form of a dentifrice for reducing the incidence of calculus on dental enamel, the soluble pyrophosphate salt being used in an amount providing at least 1.5% by weight of the composition of pyrophosphate ions ($P_2O_7^{-4}$), the composition additionally having a pH of from 6.0 to 10.0 and comprising a fluoride ion source in an amount sufficient to supply from 50 ppm to 3500 ppm of fluoride ions and from 10% to 70% by weight of a dental abrasive.

VI. The Appellant requested that the decision of the Examining Division be set aside and that the patent be maintained on the basis of the main request filed on 11 July 1995 at the oral proceedings or one of the first, second or third auxiliary requests filed as second, third and fourth auxiliary requests on 8 May 1995.

The Respondents requested that the appeal be dismissed.

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Reasons for the Decision

1. The appeal is admissible.

2. *Pending issues*

Contrary to the Appellant's submission in the grounds of appeal, the objections raised by the Respondents under Article 100(c) EPC at the opposition stage remain in the appeal stage even though the Respondents did not appeal. Indeed they had no reason to appeal since the patent in suit had been revoked on grounds of lack of novelty. The Respondents were not adversely affected by the decision (Article 107 EPC).

3. *Admissibility of the requests*

3.1 As has been stated in the decision of the Enlarged Board of Appeal G 0009/91 (OJ EPO 193, 408 in paragraph 18 of the Reasons) the purpose of the appeal procedure *inter partes* is mainly to give the losing party the possibility of challenging the decision of the Opposition Division on its merits. A patentee who has lost before the Opposition Division thus has the right to have the rejected requests reconsidered by the Appeal Board.

If however the patentee wants other requests to be considered, admission of these requests into the proceedings is a matter of discretion of the Appeal Board, and is not a matter of right. This discretion is the equivalent in appeal proceedings of the requirements under Rule 56(3) EPC that the Examining Division consent

to further amendments. For exercising the discretion in favour of the admission of requests by the patentee that were not before the Opposition Division, there must be good reason.

3.2 The practice of the Boards of Appeal on this has been extremely generous in the past. It has been the practice of the appeal boards to consider not only requests put forward by a patentee on appeal identical to the ones already before the Opposition Division, but also new requests with claims of considerably altered scope, potentially raising issues substantially different from the issues raised by the requests considered by the Opposition Division. One critical factor has been the argument that for the patentee such new requests represent the last chance to obtain any patent for the particular subject-matter.

3.2.1 This last chance argument is normally only decisive for a favourable exercise of the discretion to admit if the requests concerned are such that it is immediately clear that the requirements of Article 123(2) EPC on fair basis, Article 123(3) EPC forbidding extension of the scope of the granted claims, Article 84 EPC on clarity and preferably also Article 54 EPC on novelty are clearly met by the new request(s). Accordingly, it has been the practice of the Boards of Appeal to allow amended or auxiliary requests during the appeal procedure provided that such requests are bona fide attempts to overcome objections raised and furthermore are clearly allowable (see e.g. T 406/86, OJ EPO 1989, 302, Reasons point 3.2; T 295/87, OJ EPO 1990, 470, Reasons point 3; and T 127/85, OJ EPO 1989, 271, Reasons point 7.1). However, this may need reconsideration in the light of recent Enlarged Board decisions G 0009/91, G 0010/91 (OJ EPO 1993, 420) and G 0004/93 (to be published in OJ EPO).

- 3.2.2 To file an appeal not only trying to reverse the decision on one of the requests actually considered by the Opposition Division, but also on the basis of new requests raising issues never considered by the Opposition Division is not in accordance with the above main purpose, as stated by the Enlarged Board of Appeal. The only justification for admitting late filed requests is that otherwise the patentee would be deprived of any opportunity of still getting a patent. The Board considers that as this is a case where the last chance argument does not apply, it should confine itself to its appellate role, and decide only requests which have already been considered by the Opposition Division while exercising its discretion to refuse to allow into the proceedings any requests not considered by the first instance.
- 3.2.3 The alternative of admitting the requests, but referring the matter back to the first instance for further examination is not acceptable in this case, as here there are still pending divisional applications based on the same parent application on which the patent in suit was based. The Board would not wish to increase the number of proceedings in which the same subject-matter is being considered by various instances of the EPO.
- 3.3 In accordance with decision T 28/92 of 9 June 1994 (not published in OJ EPO), the appeal relating to the parent European patent No. 0 097 476 was dismissed and the patent was revoked. During the oral proceedings on 9 June 1994, the Appellant sought to introduce third and fourth auxiliary requests. The present Board refused to admit the said auxiliary requests on the grounds that they were not clearly allowable. Moreover, there were to the Board's knowledge several divisional applications pending based on subject-matter derived from and closely

related to that of the parent patent (see points 2.2 to 2.3 of the decision). The patent in suit in the present appeal stems from one of the divisional applications referred to in decision T 28/92.

3.4 At the time of the present appeal, other divisional applications remain in existence. In addition to European patents Nos. 0 297 211 and 0 297 212, currently the subject-matter of appeal proceedings, two applications Nos. 89 111 576.8 and 90 108 274.3 (publication Nos. 345 821 and 395 117 respectively) are known to be still under examination by the first instance. The Board notes that the said divisional applications do not relate to clearly delineated groups of subject-matter. For example, use claims on the lines of those filed in the present application also feature as auxiliary requests in copending appeal T 98/94 relating to European patent No. 0 297 212.

3.5 In the light of the existence of the said other divisional applications, the present appeal is not the Appellant's final opportunity to save something from the wreckage of the parent patent. Since the divisional applications do not seem to be neatly divided into distinct groups of subject-matter, there is always a possibility that a request could reappear in slightly amended form in another divisional application. Such was the reason for the Board's decision in case T 28/92 to refuse further auxiliary requests (see especially point 2.3).

3.6 Accordingly, with the present appeal, the Board considers its duty to be restricted to a judicial review of the requests refused by the first instance. Since not one of the requests corresponds to those considered by the first instance, the Board has decided to refuse to admit any of them.

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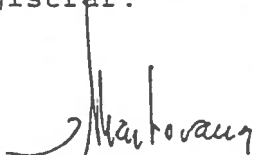
4. Although the Board sees considerable substance in the submission by the Respondents that the requests before the first instance were unallowable under Article 100(c) EPC, as the corresponding requests have been withdrawn in the appeal proceedings, there is no need for the Board formally to make a decision thereon.
5. In the absence of admissible requests submitted or agreed by the Appellant the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:



P. Martorena

The Chairman:



P. A. M. Lançon



