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**D E C I S I O N**  
**of 29 November 2005**

**Case Number:** T 0580/01 - 3.3.02

**Application Number:** 87117405.8

**Publication Number:** 0273202

**IPC:** A61K 47/00

**Language of the proceedings:** EN

**Title of invention:**

Use of hydroxycarboxylic acids to enhance therapeutic effects of topical compositions for fungal infections and pigmented spots

**Patentee:**

Van Scott, Eugene J., Dr., et al

**Opponents:**

The Procter & Gamble Company  
Unilever PLC/Unilever NV

**Headword:**

Hydroxycarboxylic acids/VAN SCOTT

**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

"Disclaimer (not accepted) "

**Decisions cited:**

G 0001/03, G 0002/03

**Catchword:**

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Case Number: T 0580/01 - 3.3.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.02  
of 29 November 2005

**Respondent:**  
(Opponent 01)

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**Decision under appeal:** Interlocutory decision of the opposition  
division of the European Patent Office posted  
19 February 2001 concerning maintenance of the  
European patent No. 0273202 in amended form.

**Composition of the Board:**

**Chairman:** U. Oswald  
**Members:** H. Kellner  
J. P. Seitz

## Summary of Facts and Submissions

- I. European patent No. 0 273 202 based on application No. 87 117 405.8 was granted with 21 claims.

Claim 1 as granted reads as follows:

"Use of

- a topical dermatologic agent together with
  - an enhancing effective amount of at least one compound selected from the group consisting of hydroxycarboxylic acids and ketocarboxylic acids and esters, lactones, or salt forms thereof,
  - wherein the composition must not contain reductive diphenols together with a plant extract,
- for the preparation of a topical dermatologic therapeutic composition with enhanced therapeutic effect  
for use in the treatment of fungal infections, and pigmented spots including pigmented age spots, melasma, and lentigines."

- II. Opposition was filed against the granted patent under Article 100(a) EPC for lack of novelty and inventive step and under Article 100(b) EPC for insufficiency of disclosure.

The following document was cited *inter alia* during the proceedings before the opposition division and the board of appeal:

- (1) CHEMICAL ABSTRACTS vol. 103, No. 2, 15 July 1985, abstract No. 11494k, Columbus, Ohio, USA;  
& RO-A-79 428

The original text referred to by this abstract was cited under

(1a) RO-A-79 428

and its translation into the English language under (1b).

III. By its interlocutory decision under Article 106(3) and 102(3) EPC, pronounced on 31 January 2001 and posted on 19 February 2001, the opposition division found that account being taken of the amendments made by the patent proprietor during the opposition proceedings with respect to the fourth auxiliary request, the patent met the requirements of the Convention.

However, neither the set of claims of the main request nor the sets of claims of the first, second and third auxiliary requests filed in writing and during the oral proceedings met the requirements of the EPC.

The subject-matter of the main request and the subject-matter of the first auxiliary request was not new with respect to each of three different documents disclosing all the characteristics of the patentee's claimed use of hydroxycarboxylic acids.

The question of admissibility of the disclaimer, however, contained in all sets of claims of all requests and in the claims as granted and relating to "reductive diphenols together with a plant extract", by the opposition division was finally answered in the affirmative.

*Prima facie* it considered that this disclaimer was necessary to establish novelty over the prior art and that it was broader than the disclosure of the prior art which was to be excluded from the scope of the claims. Therefore, the disclaimer contravened Article 123(2) EPC.

Nevertheless, the opposition division continued, "in G01/93, it was said that an added feature,  
- which did not provide a technical contribution to the subject-matter of the claimed invention  
- but merely limited the protection conferred by the patent as granted  
- by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed  
was not considered as subject-matter which extended beyond the content of the application as filed within the meaning of Article 123(2) EPC".  
In the present claim 1 the disclaimer only limited the scope of protection and did not provide a technical contribution.

Therefore, it was considered that the disclaimer contained in the granted claim 1 (and in claim 1 of all the further requests to be examined before the opposition division) could be accepted under Article 123(2) and (3) EPC.

With respect to the sets of claims of the second and of the third auxiliary request the opposition division noted that they contained features that did not fulfil the requirements of Article 123(2) EPC.

IV. The appellant (patentee) lodged an appeal against said decision and filed grounds of appeal.

It stated in writing that the subject-matter of the main request, being the same as before the opposition division and containing claim 1 as granted, not only met the formal requirements of the EPC, but was also new and inventive.

The cited documents did not disclose an enhancing effect of

- hydroxy carboxylic acids and
- ketocarboxylic acids and
- esters, lactones or salt forms thereof

for topical dermatological agents in topical compositions

for use in the treatment of fungal infections and pigmented spots.

Neither was the teaching of the main request obvious to a person skilled in the art.

The subject-matter of the first and second auxiliary requests was restricted with respect to the subject-matter of the main request and therefore met all the requirements of the EPC.

V. Claim 1 of each auxiliary request contains the same disclaimer as claim 1 of the main request, but there was no comment on this by the appellant because the opposition division had accepted this disclaimer and had given reasons for that.

VI. Together with the summons to oral proceedings, a communication was sent out drawing the parties' attention to the decisions of the Enlarged Board of Appeal with respect to disclaimers G 1/03, OJ EPO 2004, 413, and G 2/03, OJ EPO 2004, 448, and to the principle of prohibition of *reformatio in peius* that had to be observed in the current case.

The fact that problems relating to Article 123(2) EPC had been discussed in the oral proceedings before the opposition division was emphasised.

VII. The appellant (patentee), with a letter of 16 September 2005, filed a complete set of claims in order to clarify the main request as defined in the grounds of appeal.

Neither the appellant nor the respondent (opponent) 02 filed any additional arguments in the appeal proceedings after receipt of the communication.

VIII. The arguments of the respondents submitted during the proceedings can be summarised as follows:

Respondent 02 in writing saw no reason to differ from the conclusion which was, in its opinion, correctly arrived at by the opposition division during oral proceedings with respect to the main request.

The auxiliary requests on file concerning the appeal procedure contravened Article 123(2) EPC because the teaching that an antifungal agent was to be used together with at least one compound selected from a



group of particularly defined substances was not disclosed in the patent as granted.

Respondent 01 stated that the disclaimer already discussed by the opposition division and relating to "reductive diphenols together with a plant extract" was again present in all the requests of the patentee.

Since all these requests represented amended sets of claims, Article 123(2) EPC was relevant in any case. Its provisions, however, were not met with respect to said disclaimers.

Additionally, respondent 02 submitted that the subject-matter of the requests was not new in view of each of several documents cited during the procedure.

- IX. On 29 November 2005, oral proceedings took place before the board in the presence of the representative of respondent (opponent) 01; duly summoned, the appellant and respondent (opponent) 02 had informed the board in advance that they did not wish to attend the hearings.
- X. The appellant (patentee) requested in writing that the decision under appeal be set aside and that the European patent No. 0 273 202 be maintained on the basis of either his main request filed with letter dated 16 September 2005, or one of his two auxiliary requests filed with letter dated 2 July 2001 together with the statement of grounds of appeal.

The respondent (opponent 01) requested that the appeal be dismissed.

The respondent (opponent 02) requested (see letter dated 16 January 2002) that the patent be revoked (sic).

### **Reasons for the Decision**

1. The appeal is admissible.
  
2. The patent in suit refers to the
  - use of a topical dermatologic agent
  - together with an enhancing effective amount of another agent
  - for the preparation of a topical dermatologic therapeutic composition
  - for use in the treatment of fungal infections, and pigmented spots.
  
- 2.1 As regards its subject-matter as now claimed in amended form, there is a disclaimer that "the composition must not contain reductive diphenols together with a plant extract".
  
- 2.2 This disclaimer finds no basis in the application documents as filed. It is derived from the disclosure of document (1) (see lines 5 to 7 of the abstract).

Claim 1 of each of the requests on file includes the said disclaimer and claim 1 of the patent as granted as well.

2.3 Since the use of a topical dermatologic agent for the preparation of a topical dermatologic therapeutic composition is claimed, the patent in suit relates to the technical field of medicaments.

2.4 Document (1) however relates not only to the technical field of medicaments as well; it also deals in general with the treatment of the same illness to be cured as in the patent in suit, namely dermatose.

Therefore, document (1) cannot be regarded as an accidental disclosure and the addition of the disclaimer contravenes Article 123(2) EPC.

3. In these circumstances, the arguments of the opposition division cannot hold:

The Enlarged Board of Appeal, in its decision G 1/03, only referred to the anticipation to be accidental or not. If not, a disclaimer derived from its disclosure contravened Article 123(2) EPC.

Any question whether the disclaimer referred to features that provided technical contribution to the subject-matter of the claimed invention was not to be discussed.

4. Accordingly, claim 1 of the main request as well as claim 1 of both the first and second auxiliary requests do not fulfil the provisions of Article 123(2) EPC.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

A. Townend

U. Oswald