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**Datasheet for the decision  
of 12 July 2006**

**Case Number:** T 0782/03 - 3.3.10

**Application Number:** 94301882.0

**Publication Number:** 0619999

**IPC:** A61K 7/42

**Language of the proceedings:** EN

**Title of invention:**

Compositions containing sunscreens

**Patentee:**

IMPERIAL CHEMICAL INDUSTRIES PLC

**Opponent:**

Merck Patent GmbH  
HENKEL KGaA

**Headword:**

Compositions containing sunscreens/ICI

**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

"Main and auxiliary requests 1 and 2: amendment (not allowable)  
- disclaimer - not accidental anticipation"

"Auxiliary requests 3, 4 and 5: not admitted as late filed and  
not clearly allowable"

**Decisions cited:**

G 0001/03, G 0002/93, T 0092/93, T 0401/95

**Catchword:**

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Case Number: T 0782/03 - 3.3.10

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.10  
of 12 July 2006

**Appellant:**  
(Patent Proprietor)

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**Representative:**

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**Respondent I:**  
(Opponent 1)

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**Representative:**

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**Respondent II:**  
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**Representative:**

-

**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office posted 19 May 2003  
revoking European patent No. 0619999 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** R. Freimuth  
**Members:** J.-C. Schmid  
D. S. Rogers

## Summary of Facts and Submissions

- I. The Appellant (Proprietor of the patent) lodged an appeal on 15 July 2003 against the decision of the Opposition Division posted on 19 May 2003 revoking European patent No. 619 999 and filed a written statement setting out the grounds of appeal on 18 September 2003.
- II. Notices of Opposition had been filed by the Respondents I and II (Opponents (1) and (2)) requesting revocation of the patent in suit in its entirety on the grounds of Article 100(a) EPC, in particular on the grounds of lack of novelty and inventive step, and of Article 100(c) EPC, extension of the subject-matter beyond the content of the application as filed, citing *inter alia* document
- (3) G. H. Dahms: "Formulating with a Physical Sun Block", *Cosmetic & Toiletries*, (1992), volume 107, pages 87 to 92.
- III. The Opposition Division held that claim 1 of the then pending main request did not meet the requirements of Article 123(2) EPC and that the subject-matter of claim 1 of the then pending auxiliary requests 1 and 2 was not inventive in view of document (3) which was considered to be the closest prior art.
- IV. At the oral proceedings before the Board, held on 12 July 2006, the Appellant defended the maintenance of the patent in suit in amended form on the basis of a main and five auxiliary requests, the main and auxiliary requests 1 and 2 being submitted on

18 September 2003 as auxiliary requests A, B and C, respectively, and auxiliary requests 3, 4 and 5 being submitted at the oral proceedings before the Board.

Independent claim 1 of the main request read as follows:

"1. A process for the preparation of a composition suitable for topical application to human skin characterised in that an aqueous dispersion of particles of a metallic oxide having an average primary particle size less than 0.2 micrometre is mixed with one or more emulsifiers and an oil phase under conditions in which an oil-in-water emulsion is formed and with a hydrophobic sunscreen and the composition contains up to 10 per cent by weight metallic oxide and up to 7 per cent by weight hydrophobic organic sunscreen provided that said hydrophobic sunscreen does not comprise isoamyl p-methoxy cinnamate, and comprises at least one of octyl methoxycinnamate, octyl triazone, octyl salicylate, and octyl dimethyl PABA."

Claim 1 of auxiliary request 1 differed from claim 1 of the main request in that the composition was amended to read at the end "that said hydrophobic sunscreen comprises octyl methoxycinnamate and does not comprise isoamyl p-methoxy cinnamate."

Claim 1 of auxiliary request 2 differed from claim 1 of the main request in that the particles of metallic oxide were restricted to titanium dioxide and that the composition was amended to read that "the composition contains 1 to 6 per cent by weight of titanium dioxide and up to 7 per cent by weight hydrophobic organic sunscreen provided that said hydrophobic sunscreen does

not comprise isoamyl p-methoxy cinnamate, and comprises 1 to 4 per cent by weight of octyl methoxycinnamate."

Claim 1 of auxiliary request 3 differed from claim 1 of the main request in that the composition was amended to read at the end that "hydrophobic organic sunscreen consisting of at least one of octyl methoxycinnamate, octyl triazone, octyl salicylate, and octyl dimethyl PABA."

Claim 1 of auxiliary request 4 differed from claim 1 of the main request in that the composition was amended so that the last line read that the "hydrophobic organic sunscreen consisting of octyl methoxycinnamate."

Claim 1 of auxiliary request 5 differed from claim 1 of auxiliary request 2 in that the composition was amended so that the last line read as follows: "the composition contains 1 to 6 per cent by weight of titanium dioxide and consisting of 1 to 4 per cent by weight of octyl methoxycinnamate as hydrophobic organic sunscreen."

- V. The Appellant submitted that the disclaimer in claim 1 of the main request and auxiliary requests 1 and 2 had not introduced new subject-matter into claim 1. It had been introduced into claim 1 during the examination proceedings in order to restore novelty over an accidental disclosure of the prior art. As additional amendments, based on the examples, had now been incorporated into claim 1, the disclaimer did not add anymore any contribution to the subject-matter of claim 1 of the main and auxiliary requests 1 and 2.

With respect to auxiliary requests 3 to 5, the Appellant submitted that the disclaimer was rendered superfluous in those requests by the use of the wording "consisting of" and thus could be deleted without infringing Article 123(3) EPC. As regards auxiliary request 3, the Appellant submitted that the wording "consisting of at least one of" was supported by the examples of the original description. As regards auxiliary request 4, the Appellant submitted that the wording "consisting of" was supported by examples 1 and 2 and page 5, line 19 of the description as filed. As regards auxiliary request 5, the Appellant submitted that the further limitation to 1 to 4% by weight was supported by page 6, lines 2 and 3 of the original description.

VI. The Respondents submitted that the claims of the main and auxiliary requests 1 and 2 did not meet the requirement of Article 123(2) EPC, since those requests comprised the disclaimer "does not comprise isoamyl p-methoxy cinnamate", which was not disclosed in the application as filed, but which was based on a document which was not an accidental anticipation. The Respondents requested not to admit auxiliary requests 3 to 5 into the proceedings as being late filed. With respect to auxiliary requests 3 and/or 4, they submitted that the amendment "consisting of at least one..." introduced novel combinations of sunscreen which were not originally disclosed. Furthermore, they submitted that features of the examples could not be generalised on account of interactions between the components of the composition, more particularly with the emulsifier. Thus, examples of the original

application could not provide a support for "consisting of".

Respondent II added that it was put at a disadvantage by the filing of auxiliary requests 3 to 5 at a late stage of the proceedings since it could no longer provide comparative examples. Those comparative examples might have been necessary in view of the restrictions carried out in the claims.

With respect to auxiliary request 5, the Respondents submitted that different interpretations of claim 1 were possible and thus the wording of the claim was not clear, contrary to Article 84 EPC. Furthermore, there was also an infringement of Article 123(2) EPC, since the compositions did not exclude the presence of isoamyl p-methoxy cinnamate.

VII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or, subsidiarily on the basis of auxiliary requests 1 and 2, all these request being filed on 18 September 2003, or on basis of auxiliary requests 3, 4 and 5 submitted at the oral proceedings.

The Respondents requested that the appeal be dismissed.

VIII. At the end of the oral proceedings the decision of the Board was given orally.

## Reasons for the Decision

1. The appeal is admissible.
2. *Article 100(c) EPC: main and auxiliary requests 1 and 2*

Claim 1 of these requests is directed to a process for the preparation of a composition and comprises a disclaimer which excludes a particular sunscreen component, i.e. the isoamyl p-methoxy cinnamate, from the composition which is prepared by the claimed process.

The Appellant and the Respondents concur on the fact that this disclaimer has no basis in the application as filed and that it was introduced into claim 1 during the examination proceedings in order to delimit the claimed subject-matter from document (3). Nor is there dispute between the parties that this document forms part of the state of the art according to Article 54(2) EPC.

- 2.1 Following the decisions G 1/03 and G 2/03 of the Enlarged Board of Appeal (OJ EPO 2004, 413 and 448) a disclaimer based on a state of the art under Article 54(2) EPC is allowable and is considered as not extending the subject-matter of the application as filed, within the meaning of Article 123(2) EPC, when it restores novelty by delimiting a claim from an accidental anticipation. An anticipation is considered accidental when the disclosure of the document in question is "so unrelated and remote that the person skilled in the art would never have taken it into consideration when working on the invention". When an



anticipation is taken as accidental, this means that it appears from the outset that the anticipation has nothing to do with the invention (*loc. cit.*, points 2.2.2 and 2.3.4 of the reasons of the decisions).

2.2 Document (3) relates to the formulation of sunscreen compositions. Thus, document (3) belongs to the same technical field as does the claimed invention and thus is not an accidental anticipation within the meaning of the decisions G 1/03 and G 2/03. Hence, it is not allowable to incorporate a disclaimer into claim 1 to delimit the subject-matter claimed from that of document (3).

2.3 The Appellant's argument, that the disclaimer although retained in the claim, is no longer necessary for restoring novelty over document (3) since new positive limitations have been introduced in claim 1, is an argument in favour of the non-allowability of the disclaimer. A disclaimer should not remove more than is necessary to restore novelty (see G 1/03, point 3 of the reasons). That the Appellant considers it necessary to introduce positive limitations in order to make the subject-matter of the claim novel with respect to the anticipation on which the disclaimer is based, whilst retaining the disclaimer, which has been rendered superfluous for restoring novelty, indicates that more than necessary was removed by the disclaimer in order to restore novelty over document (3), which is contrary to the requirements for allowability of a disclaimer set forth in G 1/03.

2.4 For those reasons, the incorporation of the disclaimer in claim 1 is an amendment which extends the subject-

matter claimed beyond the content of the application as filed, thus justifying the ground for opposition pursuant to Article 100(c) EPC.

Hence, the Appellant's main and auxiliary requests 1 and 2 must be rejected.

3. *Admissibility: auxiliary requests 3 to 5*

3.1 Auxiliary requests 3 to 5 were submitted at the latter stage of the oral proceedings before the Board. Admission into the proceedings of requests filed at such a late stage of the appeal proceedings is a matter of discretion for the Board of Appeal and is not a matter as of right. In exercising due discretion, it is established case law of the Boards of Appeal that crucial criteria are whether or not the amended claims of those requests are clearly allowable and whether or not those amended claims give rise to fresh issues which the other party can reasonably be expected to deal with properly without unjustified procedural delay (see T 92/93, point B of the reasons; T 401/95, point 5.2 of the reasons, neither published in OJ EPO). The fresh amendments introduced in claim 1 of auxiliary requests 3 to 5 are designed to render the disclaimer superfluous which is thus deleted from claim 1.

3.2 *Auxiliary request 3*

3.2.1 The fresh amendment in claim 1 of this request concerns the definition of the sunscreen present in the composition which is amended as "consisting of at least one of octyl methoxycinnamate, octyl triazone, octyl salicylate, and octyl dimethyl PABA". According to the

Respondent this fresh amendment is based on the examples of the original specification which disclose compositions containing those four sunscreens.

- 3.2.2 In order to determine whether or not an amendment offends against Article 123(2) EPC it has to be examined whether technical information has been introduced which a skilled person would not have objectively and unambiguously derived from the application as filed.
- 3.2.3 The examples in the application as filed disclose the preparation of compositions by a particular process. The compositions of examples 1 and 2 comprises 1% and 3% by weight, respectively, of octyl methoxycinnamate, example 3C comprises 3% by weight of octyl triazone, example 4F comprises 3% by weight of octyl salicylate while example 5I comprises 3% by weight of octyl dimethyl PABA. Each composition of these examples is a ready-to-use formulation and, thus, contains numerous other components. A generalisation of the originally disclosed examples has thus been made in the claim since components and ratio thereof which are characteristics of the particular exemplified compositions have been omitted.
- 3.2.4 However, in the Board's judgment the skilled person derives from the disclosure of the compositions disclosed in those examples nothing more than the bare disclosure of their components **in their particular combination and ratios** and, in combination with a particular method of preparation. To separate one component from each of the compositions of those examples and to generalize that component over the

whole scope of the compositions prepared by the process of claim 1 provides the skilled person with technical information which is not directly and unambiguously derivable from the application as filed.

As a consequence the fresh amendment in claim 1 is not based on the implicit disclosure of the examples of the original specification but is an undue generalisation thereof which extends beyond the content of the application as filed.

3.2.5 It follows that auxiliary request 3 is clearly not allowable under Article 123(2) EPC with the consequence that the Board exercises its discretion not to admit this request into the proceedings.

### 3.3 *Auxiliary request 4*

3.3.1 The fresh amendment of claim 1 of this request concerns the definition of the sunscreen present in the composition as "consisting of octyl methoxycinnamate". According to the Respondent this fresh amendment is based on examples 1 and 2 which disclose compositions containing octyl methoxycinnamate and on page 5, line 29 of the original application.

3.3.2 The examples of the original application cannot provide a basis for generalizing a particular component of particular exemplified compositions in the claims (see point 3.2 above). Furthermore, the passage of page 5, lines 29 referred to by the Appellant does not provide a proper basis for the restriction that the sunscreen "consists of" one particular compound since this passage discloses merely that compound as being a

preferred example for sunscreen without specifically disclosing the exclusion of the presence of further sunscreen compounds.

3.3.3 Hence, auxiliary request 4 is not clearly allowable with the consequence that the Board exercises its discretion not to admit this request into the proceedings.

3.4 *Auxiliary request 5*

The fresh amendment of claim 1 concerns the definition of the composition which "contains 1 to 6 % by weight of titanium dioxide and consisting of 1 to 4% by weight of octyl methoxycinnamate as hydrophobic organic sunscreen". The definition of the composition claimed is however vague since it is not clear from the wording of claim 1 whether or not the composition excludes the additional presence of isoamyl p-methoxy cinnamate which was explicitly disclaimed in claim 1 as granted. Therefore this amended claim appears to contravene the requirement of clarity pursuant to Article 84 EPC as regards to the subject-matter for which the protection is sought with the consequence that this amendment may extend the protection conferred beyond that of the patent as granted thereby infringing the provisions of Article 123(3) EPC.

Thus, auxiliary request 5 is not clearly allowable with the consequence that the Board exercises its discretion not to admit this request into the proceedings.

**Order**

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

The appeal is dismissed.

The Registrar

The Chairman

C. Moser

R. Freimuth