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**Datasheet for the decision
of 22 June 2006**

Case Number: T 0400/05 - 3.3.02

Application Number: 01118476.9

Publication Number: 1166801

IPC: A61K 47/04

Language of the proceedings: EN

Title of invention:

Preparations containing silicon dioxide to improve the taste thereof

Applicant:

WARNER-LAMBERT COMPANY LLC

Opponent:

-

Headword:

Taste of medicinal preparation/WARNER-LAMBERT

Relevant legal provisions:

EPC Art. 76(1)

Keyword:

"Validity of divisional application (no); subject-matter of divisional extends beyond the content of the earlier application"

Decisions cited:

T 0514/88, T 0873/94

Catchword:

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Case Number: T 0400/05 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 22 June 2006

Appellant: Warner-Lambert Company LLC
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Morris Plains
NJ 07950 (US)

Representative: Mansmann, Ivo
Warner-Lambert Company
Legal Division
Patent Department
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 19 November 2004
refusing European application No. 01118476.9
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: H. Kellner
J. Willems

Summary of Facts and Submissions

- I. European patent application No. 01 118 476.9, filed as a divisional application in respect of the earlier (parent) application No. 94 917 447.8, the latter based on PCT/US94/05651 as published (WO 94/28870), was refused by a decision of the examining division on the basis of Article 97(1) EPC. The decision was taken on the ground that the subject-matter of the divisional application extended beyond the content of the earlier application as filed (Article 76(1) EPC).

The wording of claim 1 of the set of claims as filed in the divisional application in suit and as requested before the examining division reads:

"A pharmaceutical preparation with little to no objectionable taste comprising an effective amount of a bitter tasting mixture of active ingredients absorbed onto a carrier consisting essentially of silicon dioxide, except mixtures comprising an antihistamine and decongestant."

- II. The examining division considered that the masking of the bitter taste of any active ingredient by means of silicon dioxide constituted a generalisation of the fact that the subject-matter of the parent application as filed consistently and repeatedly related to chewable cold/sinus preparations with little or no objectionable taste comprising an antihistamine and a decongestant.

Even the last sentence on page 4 of the parent application, stating that "Additional bitter taste

actives such as the antitussive dextromethorphan hydrobromide and the analgesics meclofenamic acid, aspirin, ibuprofen and the like may also be incorporated in the tablet" could not form a basis for the teaching as requested in the divisional application within the meaning of Article 76(1) EPC, as it was clear from that passage that it related to additional actives, ie in addition to those mentioned earlier in the paragraph, namely a decongestant and an antihistamine.

- III. The appellant lodged an appeal against the decision of the examining division and filed grounds of appeal.
- IV. Oral proceedings took place on 22 June 2006 in the absence of the appellant's representative, because although duly summoned nobody appeared.
- V. The appellant's arguments in the written procedure may be summarised as follows:

The patent application in suit represented the correct teaching which resulted from the original general discovery that ingredients with a bitter and/or numbing mouth feel in a pharmaceutical composition could be masked by bringing these ingredients onto an absorbent material, especially silicon dioxide, by forming an adsorbate of the components.

The last sentence on page 4 of the parent application was the best generalisation that could be imagined for this teaching.

That sentence would not make any logical sense if the bitter taste of any additional drugs (see eg the phrase: "...and the like") were not masked in accordance with the invention.

Additionally, the interpretation made by the examining division in the present case would generally restrict an invention to the exact wording of an application, which in the appellant's opinion would violate Article 69(1) EPC in the cases where the application clearly provided for a wider interpretation of the claims by means of the disclosure in the description and the drawings.

Even though, in the present case, claim 1 in the original application was narrow with respect to the active ingredients, the description taught a much broader scope from the very beginning. In other words; the present claims could have been filed at the original filing date with the full support of the description. Therefore it must be possible to prosecute the invention in a properly filed divisional application, as long as it found full support in the original specification and fulfilled all other requirements for the filing of divisional applications.

According to decisions T 514/88, OJ EPO 1992, 570 and T 873/94, OJ EPO 1997, 456 it was acknowledged that the claims of a divisional application might differ and even be broader than those granted in the parent application. The decisive question resulting from these decisions was therefore with respect to the disclosure of the earlier patent specification in its totality, what scope had been taught and what had been described

in a way that a person skilled in the art undoubtedly understood and correctly interpreted.

At the end of the grounds of appeal, the appellant "suggested as an auxiliary request to insert the %-limits of a SiO₂ according to claim 1 of the granted parent patent in claim 1 of the present appealed application".

- VI. The representative of the appellant (applicant) requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims as filed in the divisional application.

Reasons for the Decision

1. The appeal is admissible.
2. With respect to the finding on the disclosure of the description of the earlier application as the basis for the currently requested claim 1, particularly the last sentence on page 4 of the parent application
"Additional bitter taste actives such as the antitussive dextromethorphan hydrobromide and the analgesics meclofenamic acid, aspirin, ibuprofen and the like may also be incorporated into the tablet", the board has no reason to depart from the conclusion of the examining division in the impugned decision and the reasoning under Article 76(1) EPC.
3. The arguments set out in that decision correctly deal with the content of the parent application (earlier

application) in stating what the person skilled in the art recognised as its teaching and disclosure.

The appellant's counter-arguments, however, are focussed

- on the question under Article 69(1) EPC of what role the description can play for the determination of the extent of the protection conferred by a European patent application in relation to the claims
- and on the question as to the way in which a description is able to support claims explicitly filed together with that description within the meaning of Article 84 EPC.

With respect to the latter, however, the appellant de facto claims support in the description as filed in the earlier application for other claims that were not filed in that earlier application but represent the much broader teaching allegedly disclosed in that description.

Consequently, the board considers that the appellant's arguments do not relate to questions of Article 76(1) EPC.

Furthermore, the board can only come to the conclusion that the examining division did no more than decide on the basis of the decisions cited by the appellant T 0514/88 (*loc cit*) and T 0873/94 (*loc cit*). In fact, the examination division in the impugned decision

- determined exactly what scope had been taught in the description of the earlier application and

- what had been described in a way that a person skilled in the art undoubtedly understood and correctly interpreted, and based its decision on its findings.

The only remaining counter-argument in the appeal was that if a patent was granted on basis of the description of the parent application and if that description contained any information going beyond the subject-matter of the granted patent, claims of the divisional application might differ and even be broader than those granted in the parent case.

But the present case, as the examining division stated correctly, did not correspond to such a situation.

4. The "suggestion" at the end of the grounds of appeal "as an auxiliary request to insert the %-limits of a SiO_2 according to claim 1 of the granted parent patent in claim 1 of the present appealed application", in the absence of any separate sheets of paper containing such a set of claims, is understood by the board as an indication of what kind of auxiliary request the appellant intended to introduce during the oral proceedings.

Since no representative of the appellant attended the oral proceedings, such an auxiliary request was not filed.

As an additional remark, the board states that the same arguments would apply to the subject-matter of any such "auxiliary request" as to that of the set of claims

filed in the divisional application. These arguments are set out in this decision under points 2 and 3 above.

5. Since a decision can only be taken on a request as a whole, none of the other claims in the request needs to be examined.

In these circumstances the appeal must be dismissed because the subject-matter of the divisional application extends beyond the content of the earlier application as filed and thereby fails to meet the requirements of Article 76(1) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Townend

U. Oswald