

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen  
(D) [ ] No distribution

**Datasheet for the decision  
of 2 February 2010**

**Case Number:** T 0008/06 - 3.3.10

**Application Number:** 97934083.3

**Publication Number:** 0918504

**IPC:** A61K 7/42

**Language of the proceedings:** EN

**Title of invention:**

Use of genistein as a preventive agent against ultraviolet radiation induced skin photodamage and cancer

**Patentee:**

MOUNT SINAI SCHOOL OF MEDICINE

**Opponent:**

BEIERSDORF AG

**Headword:**

Use of genistein/MOUNT SINAI SCHOOL OF MEDICINE

**Relevant legal provisions:**

EPC Art. 113(2)  
RPBA Art. 13

**Keyword:**

"Late-filed requests (not admitted) - clearly not allowable"

**Decisions cited:**

T 0153/85

**Catchword:**

-



Case Number: T 0008/06 - 3.3.10

**DECISION**  
of the Technical Board of Appeal 3.3.10  
of 2 February 2010

**Appellant:**  
(Opponent)

BEIERSDORF AG  
Unnastrasse 48  
D-20245 Hamburg (DE)

**Respondent:**  
(Patent Proprietor)

MOUNT SINAI SCHOOL OF MEDICINE  
OF THE CITY UNIVERSITY OF NEW YORK  
One Gustave L. Levy Place  
New York  
NY 10029-6574 (US)

**Representative:**

Gardner, Rebecca Katherine  
Dehns  
St Bride's House  
10 Salisbury Square  
London EC4Y 8JD (GB)

**Decision under appeal:**

Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
24 November 2005 concerning maintenance of  
European patent No. 0918504 in amended form.

**Composition of the Board:**

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

## Summary of Facts and Submissions

- I. The Appellant (Opponent) lodged an appeal on 24 December 2005 against the interlocutory decision of the Opposition Division, posted on 24 November 2005, which found that the European patent No. 918 504 in the form as amended during the oral proceedings of 20 October 2005 met the requirements of the EPC.
- II. A notice of opposition was filed against the granted patent requesting revocation of the patent in suit in its entirety. The patent was opposed under Article 100(a) EPC for lack of novelty and inventive step and under Article 100(c) EPC on the ground of extending the subject-matter beyond the content of the application as filed.
- III. The Opposition Division held *inter alia* that the requirement of Article 123(2) EPC was met for claim 1 of the then pending main request, which comprised the proviso "said medicament not being merely a sunscreen", objected to under Article 100(c) EPC by the opponent.
- IV. At the oral proceedings before the Board held on 2 February 2010 the Respondent (Patent Proprietor) defended the maintenance of the patent in suit on the basis of a new main request and a new auxiliary request submitted during the oral proceedings, these requests superseding any previous request. Independent claim 1 of the new main request reading as follows:
- "1. Use of a therapeutically effective amount of genistein for the preparation of a topical chemopreventative medicament for the treatment of human

skin in order to inhibit UVR-induced aging or UVR induced photocarcinogenesis by chemoprevention, said medicament applied at a time sufficiently close to the time of UVR exposure to inhibit said aging or photocarcinogenesis".

Claim 1 of the auxiliary request differed from claim 1 of the main request only in that the alternative relating to the photocarcinogenesis was removed, i.e. the wordings "or UVR induced photocarcinogenesis" and "or photocarcinogenesis" were deleted.

V. According to the Appellant, the scope of claim 1 of the main and auxiliary requests was broadened with respect to the scope of the granted claims by the deletion of the proviso "said medicament not being merely a sunscreen". Claim 1 now comprised the possibility for the medicament to be merely a sunscreen. The indication of the mode of action of the inhibition of UVR-induced aging or UVR induced photocarcinogenesis, i.e. by chemoprevention, did not exclude mere sunscreens. Chemoprevention was a broad term and merely meant prevention by a chemical compound and thus was not exclusively related to a physiological action. Claim 1 thus encompassed pure sunscreens all the more so because the patent-in-suit expressively mentioned in paragraph [0018] the possibility of incorporating UV blockers.

VI. According to the Respondent, the feature "not being merely a sunscreen" qualified the mode of action of genistein, i.e. it acted chemopreventatively to counter the harmful effects of ultraviolet radiation and was not a mere sunscreen. However, the claim already

specified that the medicament was a chemopreventative agent, hence the medicament could not be a mere sunscreen. There were only three possibilities, i.e. the medicament was purely chemopreventative, was purely sun-blocker or was both. The medicament being just a sunscreen would have been the only way of extending the scope of protection, i.e. a medicament having exclusively sun blocking effect, but this possibility was excluded from the scope of the claim, since the claim stipulated that the medicament inhibited UVR-induced aging or UVR induced photocarcinogenesis by chemoprevention. The mode of action, i.e. by chemoprevention, was a technical feature characterizing the medicament. This feature represented a limitation by the mechanism of action of the medicament, which was a technical effect restricting the scope of the claim by excluding those medicaments not having this mode of action. That the medicament was acting by chemoprevention representing a technical effect was also apparent from the fact that the identification of the mode of action, by chemoprevention, permitted changes in the mode of therapy, as for example at what moment in time the medicament was to be topically applied to the skin. The deletion of this proviso did not contravene Article 123(3) EPC.

VII. The Appellant requested that the decision under appeal be set aside and that the patent be revoked.

The Respondent requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims of the main request, or subsidiarily on the basis of the claims of the

auxiliary request, both requests being filed during the oral proceedings before the Board.

VIII. At the end of the oral proceedings the decision of the Board was announced.

### **Reasons for the Decision**

1. The appeal is admissible.

#### *Main and auxiliary request: Admissibility*

2. These requests were filed during oral proceedings before the Board. Admission into the proceedings of a request 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 (cf. Article 13 of the Rules of Procedure of the Boards of Appeal). In exercising due discretion, it is established jurisprudence of the Boards of Appeal that one important criterion is whether or not the amended claims of those requests are clearly allowable (see T 153/85, OJ EPO 1988, 1, points 2.1 and 2.2 of the reasons), and, in addition, whether admitting such requests would otherwise violate the principle of procedural economy.

In the present case, the objections which may have prompted these requests, namely lack of disclosure in the application as filed of the proviso "said medicament not being merely a sunscreen", have been known to the Respondent since the beginning of the appeal proceedings. The Opposition Division decided on

this issue, i.e. that a basis could be found in the application as filed for this proviso, and the Appellant raised objections thereto in the statement setting out the grounds of appeal. Therefore these requests were not induced by objections, facts or evidence freshly raised at the oral proceedings before the Board and no other reasons have been given for the filing of these requests at this late stage of the proceedings.

3. The Appellant objected that the deletion of the proviso "said medicament not being merely a sunscreen", in claim 1 of both requests extended the protection conferred by the granted patent, contrary to the requirement of Article 123(3) EPC. The question which arises is therefore whether these requests are clearly allowable under Article 123(3) EPC.

Article 123(3) EPC requires that the claims of a patent may not be amended during opposition/appeal proceedings in such a way as to extend the protection conferred. In order to decide whether or not an amendment of the patent in suit satisfies this requirement, it is necessary to compare the protection conferred by the claims as granted with that of the claims after amendment.

### 3.1 *Scope of claim 1 as granted*

Claim 1 as granted is subject to a proviso, namely "said medicament not being merely a sunscreen". According to the Respondent, this meant that sunscreens acting exclusively by blocking UV radiations were excluded. Hence this proviso in granted claim 1

excludes from the protection conferred the preparation of medicaments being only sunscreens. This finding was not contested by any Party.

### 3.2 *Scope of claim 1 as amended*

Claim 1 as amended differs from claim 1 as granted mainly in that the proviso had been deleted. With the deletion of the proviso, claim 1 no longer explicitly requires that the medicament is not a mere sunscreen.

3.2.1 According to the Respondent the feature "in order to inhibit UVR-induced aging [or UVR induced photocarcinogenesis] by chemoprevention" indicated the mode of action of the medicament which action therefore comprised necessarily a physiological action, thereby excluding pure UVR blocking action, as a mere sunscreen would do.

3.2.2 Claim 1 is formulated according to the Swiss-type claim format which is designed to protect a further new and inventive therapeutic application, in the present case, the preparation of a medicament for the inhibition of UVR-induced aging. Claim 1 further stipulates that the therapeutic application is achieved by chemoprevention.

However, the mode of action of a medicament is not a technical feature in a Swiss-type claim, but is merely a technical insight into how the medicament may work. The indication of the mechanism of action of a medicament does not add any new technical feature to the Swiss-type claim, because the mechanism of action necessarily underlies the therapeutic use of that medicament. In the present case, the technical effect



which is achieved by the topical application of the medicament comprising genistein, irrespective of any mechanism of action, is simply the prevention of UVR-induced aging, which is a technical feature already indicated in the claim. Accordingly, the Respondent's attempt to promote a technical insight, here the mechanism of action, into a "technical effect" cannot succeed, the actual technical effect underlying the use of genistein for preparing the medicament being the prevention of aging.

3.2.3 The Respondent's further argument that the discovery of the mechanism of action opened new ways of treating UVR-induced aging cannot change the above findings, because the technical features reflecting these new modes of treatment, which would exclude the medicament from being merely a sunscreen, are not reflected in the claims. As regards the mode of treatment, claim 1 requires merely that the medicament be applied "at a time sufficiently close to the time of UVR exposure to inhibit said aging", which requirement does not exclude the medicament from being a sunscreen.

3.2.4 Therefore, the Board concurs with the Appellant that claim 1 as amended covers the possibility of the medicament being a mere sunscreen, all the more so because paragraph [0018] of the patent-in-suit foresees that the composition comprises UV blockers.

3.3 Thus, claim 1 as amended according to either request encompasses the preparation of mere sunscreens, which embodiment was excluded from claim 1 as granted. Hence, the deletion of the feature "said medicament not being merely a sunscreen" in claim 1 has the effect of

broadening the scope of the amended claim vis-à-vis claim 1 as granted with the consequence that claim 1 of the main and the auxiliary request has been amended in such a way as to extend the protection conferred by the granted patent contrary to the requirement of Article 123(3) EPC.

4. Since claim 1 is not in keeping with the requirements of Articles 123(3) EPC, the late filed main and auxiliary request are clearly not allowable, with the consequence that the Board exercises its discretion not to admit these requests into the proceedings for reasons of procedural economy.
  
5. Article 113(2) EPC stipulates that the instances of the EPO shall examine and decide upon a European patent only in the text submitted to it, or agreed, by the proprietor of the patent. In the present case, the Proprietor-Respondent agreed only to the text of the patent in suit submitted as main and auxiliary request at the oral proceedings before the Board (see point IV above). However, that main and auxiliary request are not admitted into the proceedings for the reasons given above. The Respondent, during the debate of the oral proceedings before the Board, neither submitted nor agreed to any other text of the patent in suit. Thus, in the absence of any valid request in the proceedings, the patent in suit must be revoked since there is no text qualifying under Article 113(2) EPC and, thus, no text on which the patent in suit may be maintained.

**Order**

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

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

The Registrar

The Chairman

C. Rodríguez Rodríguez

R. Freimuth