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**Datasheet for the decision
of 22 April 2009**

Case Number: T 1197/06 - 3.3.07

Application Number: 99953903.4

Publication Number: 1126811

IPC: A61K 7/00

Language of the proceedings: EN

Title of invention:

Stabilisation of body-care and household products

Applicant:

Ciba Holding Inc.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Amendments - added subject-matter (yes)"

Decisions cited:

T 0615/95, T 0942/98

Catchword:

-



Case Number: T 1197/06 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 22 April 2009

Appellant: Ciba Holding Inc.
Klybeckstrasse 141
CH-4057 Basel (CH)

Representative: -

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 28 November 2005
refusing European application No. 99953903.4
pursuant to Article 97(1) EPC.

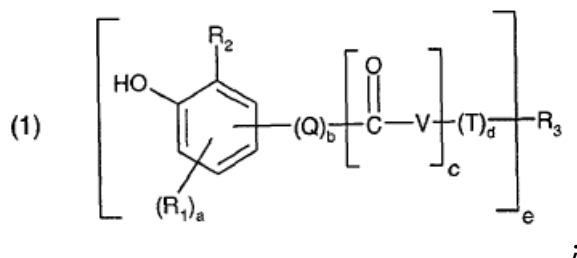
Composition of the Board:

Chairman: S. Perryman
Members: D. Semino
B. ter Laan

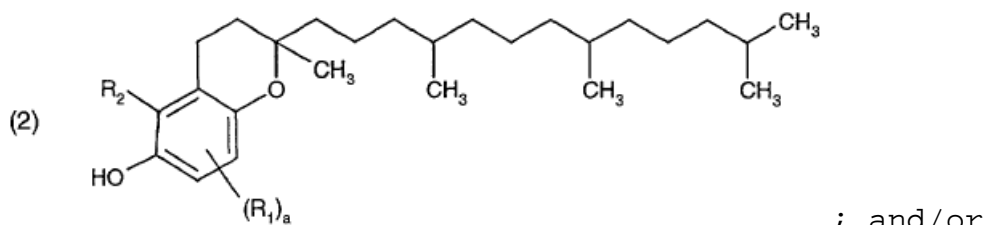
Summary of Facts and Submissions

I. The appeal lies from the decision of the Examining Division refusing European patent application No. 99 953 903.4 originating from international application PCT/EP99/07981 having an international filing date of 21 October 1999 and published as WO-A-00/25731. The application as filed comprised 32 claims. Independent Claim 1 read as follows:

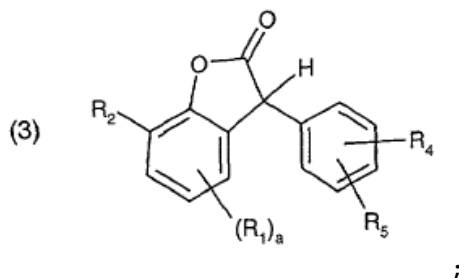
"Use of phenolic antioxidants of formulae



and/or



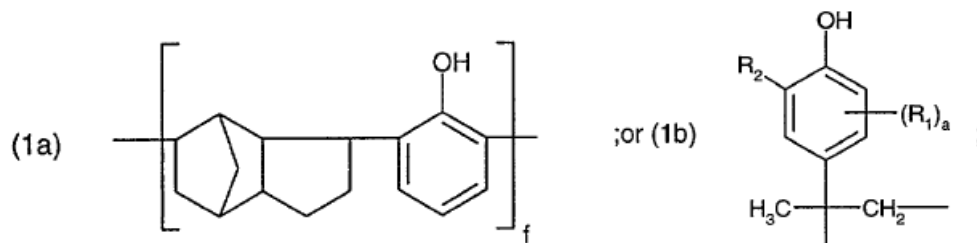
(a₂) an antioxidant of formula



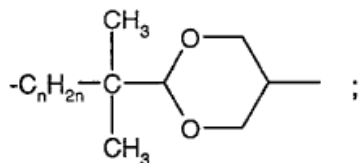
wherein in formulae (1), (2) and (3)

R₁ is hydrogen; C₁-C₂₂alkyl; C₁-C₂₂alkylthio; C₅-C₇cycloalkyl; phenyl; C₇-C₉phenylalkyl; or SO₃M;
R₂ is C₁-C₂₂alkyl; C₅-C₇cycloalkyl; phenyl; or C₇-C₉phenylalkyl;

Q is $-C_mH_{2m}-$; $\begin{array}{c} -CH- \\ | \\ C_mH_{2m+1} \end{array}$; $-C_mH_{2m}-NH$; a radical of formula



T is $-C_nH_{2n}-$; $-(CH_2)_n-O-CH_2-$; $-C_nH_{2n}-NH-C(=O)-$; or a radical of formula (1c)



V is $-O-$; or $-NH-$;

a is 0; 1; or 2;

b, c and d are each independently of one another 0; or 1;

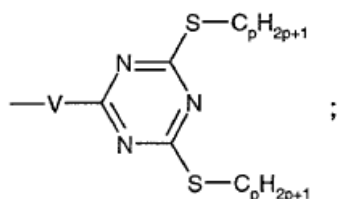
e is an integer from 1 to 4;

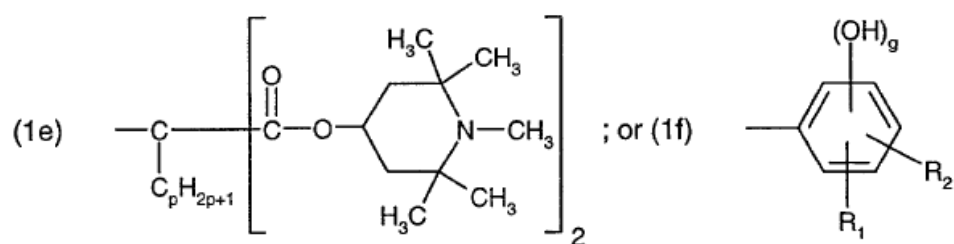
f is an integer from 1 to 3; and

m, n and p are each independently of one another an integer from 1 to 3;

if e = 1, then

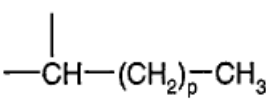
R₃ is M; hydrogen; C₁-C₂₂alkyl; C₅-C₇cycloalkyl; C₁-C₂₂alkylthio; C₂-C₁₈alkenyl; C₁-C₁₈phenylalkyl; a radical of formula (1d)





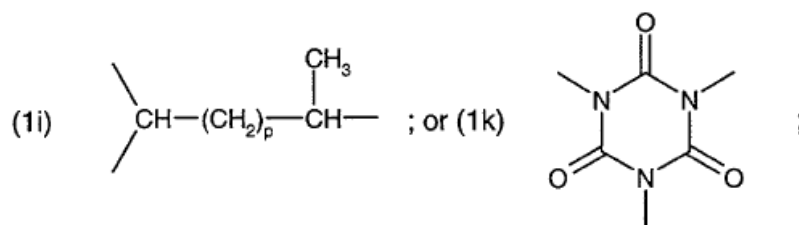
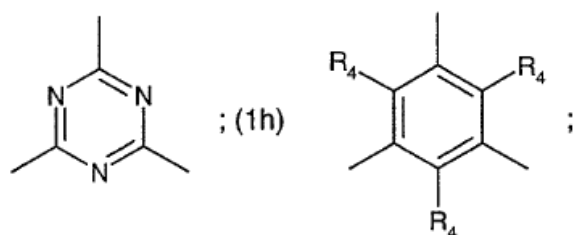
M is alkali; ammonium;

if e = 2, then

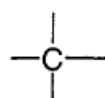
R₃ is a direct bond; -CH₂-; ; -O-; or -S-;

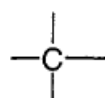
if e = 3, then

R₃ is the radical of formula (1g)



if e = 4, then



R₃ is  ; or a direct bond;

R₄ and R₅ are each independently of the other hydrogen;

or C₁-C₂₂alkyl;

for stabilising body-care and household products."

II. In its decision posted on 28 November 2005 the Examining Division refused the application on the grounds that the application did not comply with the

requirements of Articles 123(2), 54, 56 and 84 EPC. The following documents have *inter alia* been cited:

D5: WO-A-97/27839

D7: DE-A-196 16 570

D8: WO-A-96/03481

The decision was based on a set of claims 1 to 16 filed with letter dated 23 March 2005, wherein independent claim 1 had been limited *inter alia* to a number of uses of antioxidants of formula (1) restricted to those without a carbonyl group.

III. The decision can be summarized as follows:

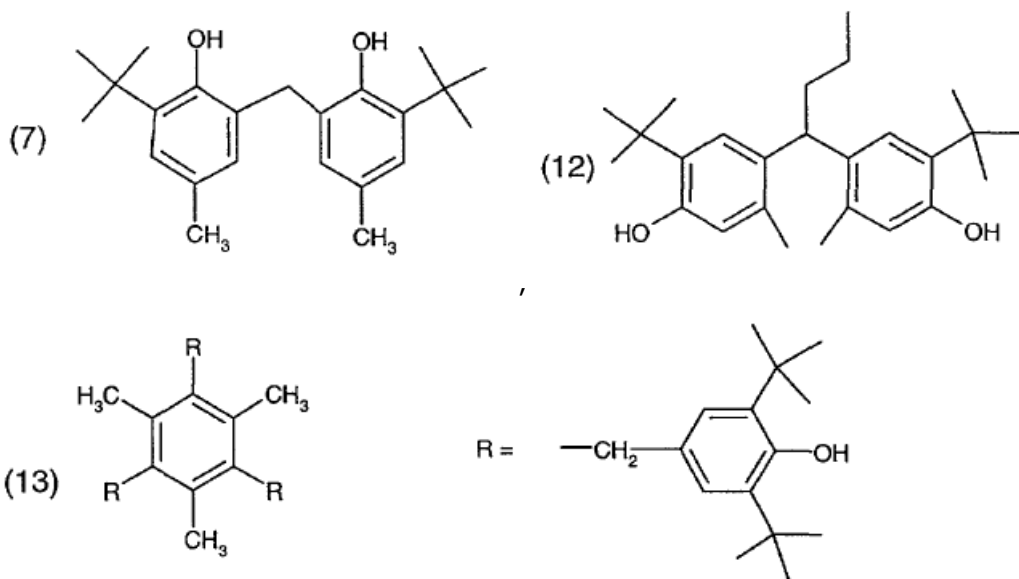
- (a) As regards the amendments made to claim 1, no basis could be found in the application as filed for some of the amendments in the definition of formula (1).
- (b) As regards novelty, D7 and D8 were considered to destroy the novelty of the subject-matter of a number of claims including claim 1.
- (c) As regards inventive step, the subject-matter of the claims was considered not inventive when starting from D5, D7 or D8 as the closest prior art; it was noted in particular that no surprising effects and/or advantages of using compounds without a carbonyl group had been shown, not even in the additional tests filed with letter of 23 March 2005, which did not provide a comparison with the structurally closest compounds.

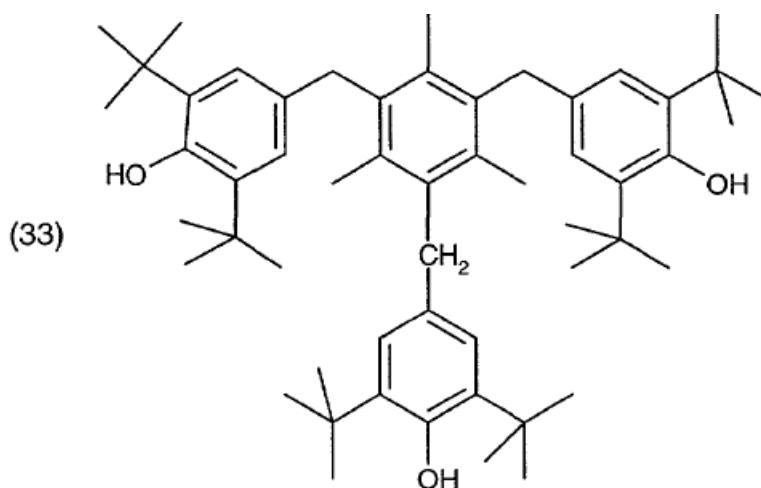
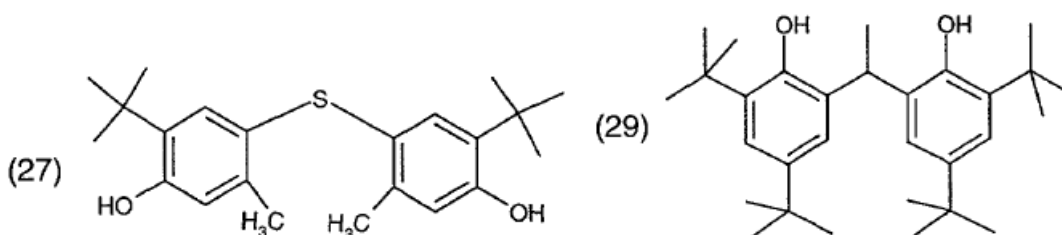
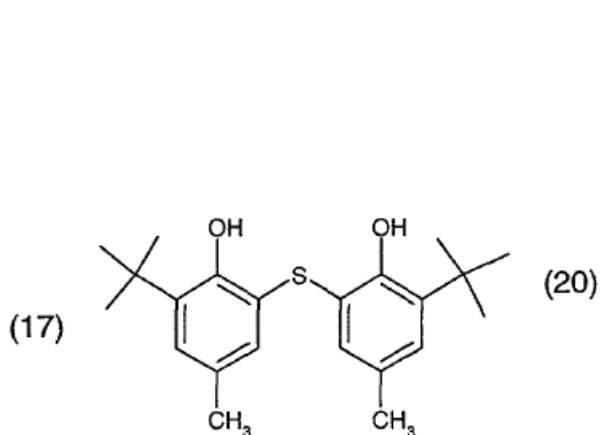
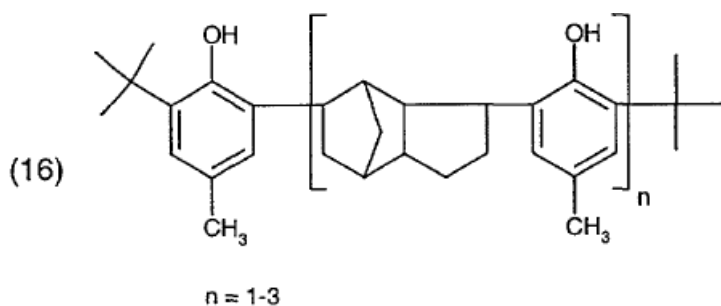
(d) As regards clarity, the phenolic antioxidants defined in some dependent claims were not covered by the general formula (1) of claim 1 rendering the whole set of claims unclear; moreover, there were some unclarities in the definition of the substituents of formula (1) and some of the used symbols were not defined.

IV. On 30 January 2006, the applicants (appellants) filed a notice of appeal against the above decision, the prescribed appeal fee being paid on the same day. With the statement setting out the grounds of appeal filed on 05 April 2006, the appellants submitted a set of claims 1 to 11.

V. In response to a communication of the Board, the appellants submitted with letter of 30 March 2009 a set of claims 1 to 5 as their only request. Amended claim 1 read as follows:

"Use of phenolic antioxidants selected from the compounds of formulae:





and

for preventing photooxidation and autooxidation processes in skin-care products selected from body oils, body lotions, body gels, treatment creams, skin powders, skin protection ointments and shaving lotions, (*sic*)"

VI. Oral proceedings were held on 22 April 2009. At the end of the debate, the applicants confirmed that they did not intend to file any further requests.

VII. The arguments of the appellants can be summarized as follows:

(a) Claim 1 was amended so as to avoid objections under Article 123(2) EPC. In particular the phenolic antioxidants were limited to those without a carbonyl group explicitly mentioned in Table 1 on pages 8-14 of the original application, for which advantages had been shown by means of the additional tests filed with letter of 23 March 2005. Similarly, the products were limited to a number of specific skin-care products, for which the use of the specific antioxidants was not known from the available prior art.

(b) As regards novelty, D7 disclosed the use of phenolic antioxidants for the protection of detergent ingredients in cleaning agents for home care applications, which were clearly different from the selected body care products.

(c) As regards inventive step, D7 disclosed the use of phenolic antioxidants to protect only specific ingredients of the detergents. Quite to the contrary, in the cosmetic body care formulations as used in the claims the complete formulations were protected. According to D8 a specific chemical class of antioxidants containing carbonyl groups was used in fabric care compositions. There

was no incentive for the skilled person to use antioxidants without carbonyl groups in different products. As to D5, it was directed to surfactant based (soaps) personal care applications which were different from the body care formulations covered by the claims.

VIII. The appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 5 submitted with letter of 30 March 2009.

Reasons for the Decision

1. The appeal is admissible.

Amendments

2. Claim 1 of the only request on file stems from claim 1 as originally filed with the following main amendments:

(a) the phenolic antioxidants have been limited from those of generic formulae (1), (2) and (3) to those of specific formulae (7), (12), (13), (16), (17), (20), (27), (29) and (33);

(b) the products in which the phenolic antioxidants are used have been limited from "body care and household products" to "skin-care products selected from body oils, body lotions, body gels, treatment creams, skin powders, skin protection ointments and shaving lotions".

- 2.1 Antioxidants (7), (12), (13), (16), (17), (20), (27), (29) and (33) fall under formula (1) of original claim 1, do not contain a carbonyl group and are mentioned in the original application in Table 1 on pages 8-14 in a list including 27 compounds. Those compounds are listed according to the original application as "examples of antioxidants used according to this invention" (page 8, last line before Table 1) and are not specifically presented as preferred antioxidants. Moreover, the list includes antioxidants with and without a carbonyl group without making any distinction between them. In addition, the original description presents several antioxidants including a carbonyl group as preferred compounds for the uses according to the invention (see in particular page 5, last line to page 6, formulae (3) and (4)).
- 2.2 In the original application the antioxidants were used in household products as well as body-care products. Skin-care products are mentioned as one of the possible classes of body-care products in which the antioxidants according to the invention may be used on original page 28, lines 4-9 and in original claim 23. In both cases skin-care products constitute one of nine listed classes of body-care products. Examples of skin-care products are listed on original page 28, lines 10-13 and in original claim 24, including body oils, body lotions, body gels, treatment creams, skin powders and skin protection ointments. Shaving lotions are mentioned in the original application under a second class of body-care products, namely the preparations containing fragrances and olfactory substances on original page 28, lines 14-15 and in original claim 25. In the original application skin-care products are

nowhere mentioned as preferred products for the uses according to the invention.

2.3 There are two examples in the original application which disclose products comprising antioxidants falling under the combination of the skin-care products of amended claim 1 with the antioxidants listed therein, namely Examples 1b and 1d (page 32), which concern a moisturiser cream, which can be considered as a treatment cream according to present claim 1, comprising antioxidants of formula (7) and of formula (33) respectively. However, apart from that single specific disclosure, which cannot provide a basis for the combination of the nine antioxidants of claim 1 with the specific selection of skin-care products listed therein, there is no disclosure in the original application that could give an indication that the specific combination of antioxidants and products would be preferred or would achieve certain advantages, so as to provide a basis for amendments (a) and (b) in combination.

2.4 The applicants argued that the advantages of the antioxidants not containing carbonyl groups had been shown by means of the additional tests filed with letter of 23 March 2005 during the examination procedure, which were meant to prove that an antioxidant without a carbonyl group has better solubility in a typical cosmetic oil and better fragrance stabilisation than an antioxidant with a carbonyl group according to D5. Those tests show, however, that the selection of specific antioxidants for specific products was made at a date later than the filing date of the application under appeal, since

there is no information in the original application of any possible advantages of the antioxidants without a carbonyl group for specific applications, as claimed in relation to the additional tests.

- 2.5 For these reasons, the selection of nine specific antioxidants out of the huge number covered by original formula (1) and of a specific class of body-care products out of nine disclosed classes results in the singling out of a number of specific combinations which the skilled person could not derive directly and unambiguously from the content of the application as originally filed (see Case Law of the Boards of Appeal, 5th edition, 2006, section III.A.1.1, in particular the guiding principles in T 615/95 of 16 December 1997, point 6 of the Reasons and T 942/98 of 13 February 2001, point 2.2 of the Reasons, both not published in the OJ EPO).

3. In summary, claim 1 of the only request on file has been amended in such a way that it contains subject-matter which extends beyond the content of the application as filed, so that the requirements of Article 123(2) EPC are not met.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

C. Moser

S. Perryman