

Internal distribution code:

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

**Datasheet for the decision
of 12 April 2011**

Case Number: T 1001/07 - 3.3.04

Application Number: 04386026.1

Publication Number: 1532982

IPC: A61K 35/78

Language of the proceedings: EN

Title of invention:

Pharmaceutical ointment for the complete therapy of
dermatologic diseases

Applicant:

Kapaj, Thelleza Skender

Opponent:

-

Headword:

Ointment/KAPAJ

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Added matter - yes"

Decisions cited:

T 0260/85

Catchword:

-



Case Number: T 1001/07 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 12 April 2011

Appellant: Kapaj, Thelleza Skender
3 Komotinis Street
115 26 Ampelokipi
Athens (GR)

Representative: -

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 31 January 2007
refusing European patent application
No. 04386026.1 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. Rennie-Smith
Members: B. Claes
G. Alt

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse the European patent application No. 04386026.1 (publication No. 1 532 982) entitled "*Pharmaceutical ointment for the complete therapy of dermatological diseases*". The application as filed contained 10 claims. Claim 1 read:
- "1. Pharmaceutical ointment for use in the therapy of dermatologic diseases consisting of Vaseline, Hydrochloric Acid solution 37%, Boric Acid, and **Oil of Black Cedar** in the following proportions:
- 1000gr of Vaseline used as an excipient
 - 100 - 150ml of Hydrochloric Acid solution 37%
 - 30gr of Boric Acid
 - 30gr **Oil of Black Cedar**"
- (emphasis added by the board)
- II. The examining division refused the application because claim 1 did not comply with the requirements of Articles 83 and 84 EPC. The term "Black Cedar" could be understood as three different unrelated plant species which resulted in the fact that the subject-matter of the claim was not clearly defined (Article 84 EPC) and not disclosed in the application in a manner sufficient for a skilled person to put it into practice (Article 83 EPC).
- III. With the notice of appeal filed by fax on 21 March 2007, which also constituted the statement of grounds of appeal, the appellant requested "the cancellation" of the decision and submitted a set of claims 1 to 10, further documents (Da) to (De) and arguments why these

claims met the requirements of the EPC. Claim 1 of this set of claims read:

"1. Pharmaceutical ointment for use in the therapy of dermatologic diseases consisting of Vaseline, Hydrochloric Acid solution 37%, Boric Acid, and **Oil CADE** in the following proportions:

- 1000gr of Vaseline used as an excipient
 - 100 - 150ml of Hydrochloric Acid solution 37%
 - 30gr of Boric Acid
 - 30gr **Oil CADE (oil of Juniperus Oxycedrus)**."
- (emphasis added by the board).

- IV. Further documents and arguments were filed by the appellant with a letter dated 15 October 2007.
- V. Oral proceedings were held on 12 April 2011, during which the appellant, although duly summoned, was not present. On 13 April 2011, the appellant attended the EPO, spoke with the board's registrar, and informed him she had been ill the previous day. The appellant had not informed the board, on or before the day of the oral proceedings, that she could not attend.
- VI. The following documents are referred to in this decision:

D1: Internet printout of SeeMeGarden "Black Cedar Thuja occidentalis Nigra" dated 19 Mai 2006
(<http://www.seemegarden.com/viewPlant.php?plantId=141>)

D2: Database Chemical Abstracts Service, Columbus, Ohio, US; 1932, Deforge *et al.*, Accession No. 26:38191.

D3: Bouhlal *et al.* (1988), *Parfums, cosmétiques, arômes*, No 83, pages 73-82.

Da: Internet printout of Wikipedia "Genévrier" dated 20 March 2007 (<http://fr.wikipedia.org/wiki/GenÃ©vrier>).

Db: Extract from unspecified English encyclopaedia:
"**cade** [keid] *s bot.* Zederwacholder *m (Juniperus oxycedrus)*: ~ oil, oil of ~ *med. vet.* Wachholderteer, Kaddigöl, kranewittöl."

Dc: Extract from unspecified French encyclopaedia:
"**CADE** n. m. Sorte de genévrier. *Huile de cade*, liquide noir et puant, inflammable, qui s'emploie les plaies de cheveux, les maladies de la peau, etc."

Dd: Undated internet printout of "Henriette's Herbal Homepage": The Dispensatory of the United States of America: "Oleum Cadinum. U.S., Br."

De: Certificate of analysis dated 2 June 2006.

VII. The appellant's arguments that are relevant for the present decision can be summarised as follows:

- "Black cedar" was an accepted common plant name and therefore the term "**oil of black cedar**" was clear. The words "cedar, cedre, Zeder, cade" were indicated in every dictionary with the scientific name "Juniperus" which was a common tree in the waste places and stony hill-sides of the Mediterranean districts of Northern Africa, Spain, Portugal and France. The oil produced from this tree was called "**oil of cade**" ("cade" was "cedar"

in French) and had been known to the ancient Greeks and Romans, who obtained it by warming the wood of cedar. The most common sort [sic] of the tree was the Juniperus oxycedrus. Reference was made to documents (D3) and (Da) to (De).

- Oil of black cedar (oil cade) was found "in the market" where the appellant bought it for the preparation of the ointment (document (De)) and could there also be found as Juniperus oxycedrus – oil cade.

- The present patent application claimed priority from the Greek patent application 20030100419 filed on 15 October 2003. The claims of the Greek priority application were amended on 4 December 2003. These amendments had not been attached by the Greek Office to the priority certificate provided to the EPO. The pharmaceutical ointment comprising oil of black cedar (oil cade) disclosed in the Greek priority application filed on 15/10/2003 was the same as the ointment disclosed in the present European patent application (and in document (D3)). The omission of the term "**oil cade**" in the European application was due to the translator who had translated only the first term appearing in claim 1 of the Greek priority application.

- The "**oil of black cedar**" in the specification and in claim 1 was synonymous with "**oil of cade**" indicated in the specification of the Greek patent application from which the present application claimed priority.

VIII. The appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 10 filed on 21 March 2007 (see point 3, below).

Reasons for the Decision

1. The appeal is admissible.

Procedural issues

2. Oral proceedings were held pursuant to Article 116(1) EPC at the instance of the board. Although the appellant had been duly summoned, she did not appear before the board, which only proceeded to confer and subsequently announce its decision after making all possible efforts to ensure the appellant was not in the premises or had not gone to another address of the EPO. Had the appellant informed the board in advance that she was unable to attend, the oral proceedings could have been postponed.

3. The appellant has requested "the cancellation" of the impugned decision with the notice of appeal dated 21 March 2007, which also constituted the statement of grounds of appeal. At the same time the appellant submitted a set of 10 claims. Claim 1 of this request comprised amendments as compared to claim 1 as originally filed (see section II, above). In accordance with established practice of the boards of appeal, the request as filed with the letter dated 21 March 2007 is

considered the sole claim request on file (see section VIII, above).

Claim 1 - Article 123(2) EPC

4. Article 123(2) EPC requires that the application shall not be amended so as to contain subject-matter which extends beyond the content of the application as filed.
5. The present claim 1 refers first to "Oil CADE" and subsequently to "Oil CADE (oil of *Juniperus Oxycedrus*)" instead of to "Oil of Black Cedar" on both occasions in the claim as originally filed.
6. There is no explicit basis in the application as filed for either of the expressions "Oil CADE" or "oil of *Juniperus Oxycedrus*". Based on evidence contained in documents (D1) to (D3), the examining division found, in the decision under appeal in the context of the assessment of compliance with Articles 83 and 84 EPC, that the term "Black Cedar" was not an accepted common denomination for any particular plant species. In fact, it established that document (D1) referred to Black Cedar in its scientific denomination as being *Thuja occidentalis* Nigra, document (D2) as being *Nectandra pisi*, whereas according to the priority document for the application Black Cedar was equivalent to CADE, which according to document (D3) corresponded to *Juniperus oxycedrus*.
7. In accordance with established case law of the boards of appeal, the relevant question to be decided in assessing whether an amendment adds subject-matter extending beyond the content of the application as

- filed is whether the proposed amendment is "**directly and unambiguously**" derivable from the application as filed (see Case Law of the Boards of Appeal of the European Patent Office, 6th Edition 2010, III.A.7).
8. In view of the above finding by the examining division, and contrary to the argument of the appellant that the term "Black Cedar" is synonymous with either of the terms CADE or *Juniperus oxycedrus*, there exists no unambiguous technical correspondence for these terms in the relevant technical field. The board therefore necessarily concludes that neither "Oil CADE" or "Juniperus Oxycedrus" is directly and unambiguously derivable from the application as filed.
 9. The appellant has argued that oil of black cedar (oil cade) was found "in the market" where the appellant bought it for the preparation of the ointment (document (De)) and could there also be found as *Juniperus oxycedrus* – oil cade. Document (De), a certificate of analysis dated 2 June 2006 for a certain batch of "cade oil" ordered by a person different from the appellant, has been filed in this context.
 10. It is accepted in the case law of the boards of appeal that a disclosure *implicit* in the patent application, i.e. what the person skilled in the art would consider *necessarily* implied by the patent application as a whole, is also relevant when assessing the requirements of Article 123(2) EPC. For an overview of the case law relating to the definition of the notion "skilled person" the board refers to the publication "Case Law of the Boards of Appeal of the EPO", 6th Edition, 2010, chapter I.D.7.

11. The board accepts that it may well be that for the production of her ointment the appellant has in fact always used oil derived from the species *Juniperus oxycedrus*. Nevertheless, in view of the finding in point 8, above, it cannot be accepted by the board that this establishes that it would be considered necessarily implied by the skilled person that the patent application equates Black Cedar with Cade or *Juniperus oxycedrus*. Accordingly, this argument must fail.

12. The appellant has furthermore referred to the Greek patent application 20030100419 which was filed on 15 October 2003 and from which the present application claims priority. The appellant argued that the claims of this application had been amended before the Greek patent office on 4 December 2003. These amendments had however not been attached by the Greek Office to the priority certificate provided to the EPO. The pharmaceutical ointment comprising oil of black cedar (oil cade) disclosed in the Greek priority application filed on 15 October 2003 was the same as the ointment disclosed in the present European patent application. The omission of the term "**oil cade**" in the European application was due to the translator who translated only the first term appearing in claim 1 of the Greek priority application.

13. Also in the context of this argument, the board emphasises that the relevant reference point for assessing the compliance of amendments with the requirements of Article 123(2) EPC is the application as filed. It notes that neither of the documents

representing the European application, be it in the Greek language or the English language, refers to oil CADE but instead refers to oil of Black Cedar, although it is true that the priority document as filed in the Greek language makes reference to oil CADE (see e.g. example 2 and claim 1). However, it has been established in the case law of the boards that "the content of the application as filed" as referred to in Article 123(2) EPC does not include any priority documents (see e.g. decision T 260/85, OJ 1989, 105). Such document can therefore not be taken into account when assessing compliance of claimed subject-matter with the requirements of Article 123(2) EPC. Also this argument must therefore fail.

14. Accordingly and in view of the above considerations the board decides that claim 1 does not meet the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

P. Cremona

C. Rennie-Smith