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**Datasheet for the decision
of 18 March 2009**

Case Number: T 1626/07 - 3.3.10

Application Number: 02254217.9

Publication Number: 1269981

IPC: A61K 7/44

Language of the proceedings: EN

Title of invention:

Sunscreen compositions containing a dibenzoylmethane derivative

Applicant:

JOHNSON & JOHNSON CONSUMER COMPANIES, INC.

Headword:

-

Relevant legal provisions:

EPC Art. 54

Keyword:

"Novelty (yes)"
"Remittal"

Decisions cited:

-

Catchword:

-



Case Number: T 1626/07 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 18 March 2009

Appellant: JOHNSON & JOHNSON CONSUMER COMPANIES, INC.
Grandview Road
Skillman
New Jersey 08558 (US)

Representative: Mercer, Christopher Paul
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 2 May 2007
refusing European application No. 02254217.9
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: R. Freimuth
Members: P. Gryczka
F. Blumer

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the Examining Division refusing the European patent application No. 02254217.9 published under the publication No. EP 1 269 981.
- II. The Examining Division held that the subject-matter of claims 1 and 9 of the application as filed (then pending main request) and that of claim 1 of the then pending auxiliary request lacked novelty in view of documents:

(1) C. Bonda et al., "A new photostabilizer for full spectrum sunscreens", *Cosmetics and Toiletries*, Vol. 115, No. 8, pages 37-45 (published in 2000) and

(2) US-A-5 993 789

which disclosed all the features of the claimed composition and of the method of stabilizing a composition.

In the course of the examination proceedings reference was also made to document

(3) D.L. Smith, "Regulatory FDA meeting Report (9):
Units of Measure

for converting the UV irradiation unit "MED" used in documents (1) and (2) into Joules/cm² used in the patent application.

III. During the oral proceedings held in front of the Board on 18 March 2009, the Appellant replaced the previously filed requests by a single request consisting of claims 1 to 8 of the application as filed.

Claim 1 thereof reads as follows:

"1. A method of stabilizing a composition comprising a dibenzoylmethane derivative UV-A absorbing agent, said method comprising the steps of:

(a) adding to said composition:

(i) a diester or polyester of a naphthalene dicarboxylic acid; and

(ii) a benzophenone derivative;

(b) exposing said composition to at least 50 Joules/cm² of sunlight or simulated sunlight;

wherein (i) and (ii) are present in amounts sufficient to provide a PFA value after said exposing step that is minimally 60% of the PFA value before said exposing step."

Claims 2 to 8 are dependent on claim 1.

IV. The Appellant argued that the method according to claim 1 as filed was novel with regard to the disclosure of documents (1) and (2) since these documents did not disclose the combination of a diester of a naphthalene dicarboxylic acid and a benzophenone derivative for stabilizing a composition comprising a dibenzoylmethane derivative.

V. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of

claims 1 to 8 of the request submitted during the oral proceedings before the Board.

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

Reasons for the Decision

1. The appeal is admissible.

Novelty

2. The claimed method of stabilizing a composition requires "exposing said composition to at least 50 Joules/cm² of sunlight or simulated sunlight" (claim 1, step (b)).

Documents (1) and (2) disclose a stabilized composition containing the same ingredients as those defined in claim 1, namely avobenzone which is a dibenzoylmethane derivative (page 4, line 7 of the application as filed), oxybenzone which is a benzophenone derivative (page 5, lines 16 and 17 of the application as filed) and a diester of a naphthalene dicarboxylic acid (see document (1), table 2, compositions E and F; document (2), column 6, lines 3 to 7).

These compositions have been exposed respectively to an UV irradiation of 25 MED (figure 13 in document (1)) or 5 MED (document (2), figure 6, column 7, line 41). These irradiations expressed in MED units correspond, according to the highest conversion factor disclosed in document (3), respectively, to irradiations of

0,525 Joules/cm² and 0,105 Joules/cm² (document (3), top of page 4, 1 MED=21 mJ/cm²) and are, thus, lower than the feature of "at least 50 Joules/cm²" required by step (b) of claim 1.

Therefore, documents (1) and (2) do not disclose step (b) of the claimed method.

Consequently, the subject-matter of claim 1 and, for the same reasons, that of dependent claims 2 to 8 is novel with regard to the disclosure of documents (1) and (2) (Article 54 EPC).

Remittal

3. Having so decided, the Board has not, however, taken a decision on the whole matter, since the appealed decision dealt exclusively with the issue of novelty with regard to documents (1) and (2). Under these circumstances the Board considers it appropriate to exercise the power conferred to it by Article 111(1) EPC to remit the case to the Examining Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 8 of the request submitted during the oral proceedings before the Board.

The Registrar:

The Chairman:

C. Rodriguez Rodriguez

R. Freimuth