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**Datasheet for the decision
of 13 January 2012**

Case Number: T 1436/08 - 3.3.01
Application Number: 05732157.2
Publication Number: 1708569
IPC: A01N 25/24, A01N 31/04
Language of the proceedings: EN

Title of invention:

Methods for treating ectoparasite infections on the mammalian body

Applicant:

Summers Laboratories Inc.

Headword:

Monohydric aralkyl alcohols/SUMMERS

Relevant legal provisions:

EPC Art. 123(2), 113(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Non-appearance in oral proceedings"
"No comments on objections in the board's communication"
"Main and auxiliary request: amendments - unallowable generalisation"

Decisions cited:

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Catchword:

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Case Number: T 1436/08 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 13 January 2012

Appellant: Summers Laboratories Inc.
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Representative: Walder, Jeremy Thomas
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 12 February 2008
refusing European patent application
No. 05732157.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: P. Ranguis
Members: G. Seufert
D. S. Rogers

Summary of Facts and Submissions

I. The Appellant lodged an appeal against the decision of the Examining Division refusing the European patent application No. 05732157.2.

II. In this decision the following numbering will be used to refer to the documents:

- (1) US 6,793,931 B2
- (3) US 4,368,207
- (5) US 2004/0013700 A1
- (6) Scabies, excerpt from Wikipedia
- (7) Pediatric Dermatology Vol. 18, No. 1, 63-65, 2001

III. The decision of the Examining Division was based on the sole request filed with letter of 11 October 2007.

The Examining Division held that the claimed subject-matter did not extend beyond the application as originally filed, but lacked novelty in view of document (1). Furthermore, it considered that the claims were directed to a method of treatment, which was prohibited under Article 53(c) EPC. The Examining Division also stated that if the claimed method were to be considered novel it would not be inventive in view of a combination of documents (1) and (3).

IV. With the statement setting out the grounds of appeal dated 23 June 2008, the Appellant filed a new set of claims with the two independent claims 1 and 10 reading as follows:

- "1. A method for the killing of ectoparasites, their nymphs, and their eggs, comprising the steps of:
- A) applying a substantially air-impermeable water soluble or water-dispersible, pharmacologically acceptable barrier composition containing at least one monohydric aralkyl alcohol to an area infested with said ectoparasites, nymphs and eggs wherein:
 - a) the composition contains in the range of from 1 to 50%, preferably 1 to 20%, by weight of the at least one monohydric aralkyl alcohol to provide activity against the ectoparasites, their nymphs, and their eggs;
 - b) the composition is formulated so that when applied to the ectoparasites, nymphs and eggs, the composition prevents them from closing their breathing apparatus and in addition clogs their breathing apparatus resulting in suffocation of the ectoparasites and their nymphs and eggs;
 - c) the composition is applied to the infested area in a quantity sufficient completely to saturate all of the ectoparasites, nymphs and eggs; and
 - d) the composition is free from any effective pesticidally active compounds other than any pesticidal activity provided by the at least one monohydric aralkyl alcohol;
 - B) leaving the composition in contact with the ectoparasites, nymphs and eggs for a period in the range of from 2 to 9 minutes until at least most of the ectoparasites, nymphs and eggs have died; and
 - C) removing the composition and the dead ectoparasites and nymphs from the infested area by rinsing the infected area with water or other aqueous based liquid.

10. The use of at least one monohydric aralkyl alcohol in the preparation of a medicament for treating infestations of ectoparasites, their nymphs and their eggs on mammalian skin and hair.

Furthermore, the Appellant filed a declaration of the inventor in support of its arguments that document (1) fails to disclose the step A)c) of claim 1.

V. In a communication accompanying the summons to oral proceedings the Board expressed its preliminary opinion. In particular, the Board raised several objections under Article 123(2) EPC, *inter alia* against claim 10. The Board considered that in claim 10, the feature "monohydric aralkyl alcohol" had been taken out of its original context, in particular from its association with the feature "water soluble or water dispersible, pharmacologically acceptable composition". Furthermore, the Board considered that the claimed subject-matter was neither novel nor inventive in view of document (5), which is a continuation in part of application 10/195 048, which is the application number of document (1). The Board also indicated that the control and eradication of ectoparasites causing diseases like mange or scabies, which were included in the scope of the claims, may be considered as a method of treatment by therapy. A copy of document (5) as well as a copy of document (6) and (7) demonstrating that scabies is a disease caused by ectoparasites and treated by topical application of a pesticidal composition were attached.

- VI. In a letter dated 17 November 2011, the Appellant informed the Board that it did not intend to attend, or be represented at, the oral proceedings. No comments, arguments or amendments in reply to the Board's preliminary opinion were provided.
- VII. In its statement setting out the grounds of appeal, the Appellant argued that the newly filed claim 10 had its basis in the specification as a whole.
- VIII. The Board understands from the Appellant's written submissions that the Appellant requested that the decision under appeal be set aside and that a patent be granted in the following version: As a Main request, upon the basis of claims 1-19 filed under cover of a letter dated 23 June 2008; or as an Auxiliary request, upon the basis of claims 10-19 filed under cover of a letter dated 23 June 2008.
- IX. At the end of the oral proceedings, which took place as scheduled on 13 January 2011 the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. Non-appearance at the oral proceedings before the Board
 - 2.1 According to Article 116(1) EPC, oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at the request of any party to the proceedings. The

Appellant did not request oral proceedings. However, the Board considered it nevertheless appropriate to schedule oral proceedings in order to settle as far as possible any outstanding issues relevant for the decision.

- 2.2 As announced (see point VI above), neither the Appellant nor its representative attended the oral proceedings.
- 2.3 The Appellant was informed of the Board's objections in a communication annexed to the summons to oral proceedings. It could reasonably have expected that during the oral proceedings the Board would consider these objections. By deciding not to attend the oral proceedings the Appellant chose not to avail itself of the opportunity to present its case orally but instead to rely solely on its written arguments (Article 15(3) RPBA). It is also noted that the Appellant did not provide a substantive written response to the issues addressed in the Board's communication.
- 2.4 Hence, the Board concludes that the Appellant had reason and opportunity to present comments on the grounds and evidence on which the Board's decision, arrived at during oral proceedings, is based. Consequently, the requirement of Article 113(1) EPC is fulfilled.

Main Request

3. Amendments

3.1 Claim 10 is directed to the use of at least one monohydric aralkyl alcohol in the preparation of a medicament for treating infestations of ectoparasites, their nymphs and eggs on mammalian skin and hair. This claim is a newly drafted independent claim, which was not present in the set of claims as originally filed. There is also no passage in the originally filed description corresponding to the wording of this new claim.

3.2 In its statement setting out the grounds of appeal the Appellant argued that this claim is "directed to the overall concept of using at least one monohydric aralkyl alcohol in the preparation of a medicament for the treatment of infestations of ectoparasites, their nymphs and eggs and thus has its basis in the specification as a whole".

3.3 As already pointed out in its communication accompanying the summons to oral proceedings, the Board does not agree with the Appellant. The application as originally filed relates to a method for the topical treatment of mammalian skin and hair comprising the application of a water soluble or water dispersible, pharmacologically acceptable composition containing at least one pesticidally-active monohydric aralkyl alcohol (claim 1, page 3, line 20 to page 4, line 2, examples). Throughout the application as filed, the monohydric aralkyl alcohol is never mentioned outside the context of these particular compositions.

Furthermore, according to the application as originally filed, the composition must be in a form that can readily be removed by washing or rinsing with water or other aqueous based liquids (page 5, lines 15-16, page 6, lines 3-6, claim 1 step A)c) of the application as originally filed), which requires that the composition is at least water-dispersible or water soluble. Compositions without these qualities were not envisaged in the application as filed.

- 3.4 The subject-matter of claim 10 is however not restricted to the use of particular compositions. It covers the use of **any** monohydric aralkyl alcohol comprising compositions and thus encompasses technical information which is not directly and unambiguously derivable from the application as filed even if read by the person skilled in the art.
- 3.5 The Board therefore concludes that claim 10 of the Appellant's main request contains subject-matter which extends beyond the application as originally filed contrary to the requirements of Article 123(2) EPC. For this reason alone, the Appellant's main request, which can only be judged as a whole, is not allowable. The auxiliary request based on claims 10-19 must fail for the same reasons.
- 3.6 The Board also notes that the Appellant has not submitted any comments or arguments to rebut the Board's preliminary opinion, expressed in the communication accompanying the summons to oral proceedings, that the claimed subject-matter lacked novelty and inventive step in view of document (5) These objections as well as the objections that claim 1

may be considered as a method of treatment by therapy still apply. In view of the negative outcome with respect to the compliance with Article 123(2) EPC (see point 3.3 - 3.5 above), the Board need not decide upon these further objections.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Schalow

P. Ranguis