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**Datasheet for the decision
of 24 April 2013**

Case Number: T 0899/09 - 3.3.04

Application Number: 04735495.6

Publication Number: 1644013

IPC: A61K 36/00

Language of the proceedings: EN

Title of invention:

Processes for making caralluma extracts and uses

Applicant:

Rajendran, Ramaswany
Rajendran, Kamala

Headword:

Caralluma extracts/RAJENDRAN

Relevant legal provisions:

EPC Art. 84, 113(2), 123(2)
RPBA Art. 13(1)(3)

Keyword:

"Main request - admitted (no)"
"Remittal to the department of first instance (no),
adjournment of oral proceedings (no)"

Decisions cited:

G 0010/93

Catchword:

-



Case Number: T 0899/09 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 24 April 2013

Appellants: Rajendran, Ramaswany + Rajendran, Kamala
No. 5 BDA Domlur
II stage III phase
Bangalore 560 071 (IN)

Representative: Demski, Siegfried
Demski & Nobbe
Patentanwälte
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 12 December 2008
refusing European patent application
No. 04735495.6 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: C. Rennie-Smith
Members: R. Morawetz
M. Montrone

Summary of Facts and Submissions

- I. The appeal of the applicants (hereafter "appellants") lies against the decision of the examining division posted on 12 December 2008, whereby European application No. 04735495.6 had been refused.
- II. The application at issue has the title "Process for making caralluma extracts and uses" and originates from international application PCT/IN2004/000150 published as WO 2004/108148 (hereafter referred to as "application as originally filed").
- III. The decision under appeal was based on a sole claim request which was held to fail the requirements of Articles 54, 56 and 84 EPC.
- IV. With their grounds of appeal the appellants filed a new main request of which claim 1 read as follows:
- "1. A composition for medical, nutraceutical and food applications comprising at least one pregnane glycoside obtained by extraction of plant matters wherein a resinous matter does not exceed 1% w/w."*
- V. By a communication of 29 November 2012 the appellants were summoned for oral proceedings to be held on 24 April 2013. In a communication under Article 15(1) RPBA of 12 March 2013 the board expressed its preliminary opinion on the sole request on file.
- VI. With a letter of 19 April 2013 the appellants filed a new claim request. Claim 1 of this claim request read as follows:

"1. A composition for medical, nutraceutical and food applications comprising at least two pregnane glycosides as the major and chief constituents thereof by weight, wherein the composition is obtainable by a process of extraction of plants matter [sic] and wherein said plant matter comprises one or more of the caralluma group of plants belonging to the Asclepiadaceae family characterised in that the ratios by weight of the pregnane glycosides to each other are substantially equal to that found in the plant matter and in that the resin content is not more than 1.0% by weight."

VII. Oral proceedings before the board were held on 24 April 2013. At the beginning of the oral proceedings the appellants withdrew the claim request filed with their grounds of appeal and made the claims filed with their letter of 19 April 2013 their main request. The board explained that the following amendments of claim 1 lacked basis in the application as filed contrary to the requirements of Article 123(2) EPC: the introduction of the feature "at least two"; the introduction of the feature "by weight" in the context of the "major and chief constituents thereof by weight" and in the context of the "ratios by weight of the pregnane glycosides". Claim 1 was moreover held to lack clarity and technical support in the description as filed (Article 84 EPC) because it was not disclosed how the caratuberside-bouceroside ratio (CB ratio, see page 3, first paragraph of the application as filed) was to be determined and whether the process disclosed resulted in the desired CB ratio since results were only reported for total glycosides. In response the

appellants withdrew the claim request and filed a new main request of which claim 1 reads as follows:

"1. A composition for medical, nutraceutical and food applications comprising one or more caratubersides or their isomers and boucerosides or their isomers as the major and chief constituents thereof, wherein the composition is obtainable by a process of extraction of plant matter and wherein said plant matter comprises one or more of the caralluma group of plants belonging to the Asclepiadaceae family characterised in that the ratio of the caratubersides to boucerosides is substantially equal to that found in the plant matter and ranges from 9:1 to 11:1 and in that the resin content is not more than 1.0% by weight."

VIII. The arguments of the appellants may be summarised as follows:

Main request

Admissibility

The representative's difficulties in receiving instructions from the appellants were the cause for the late filing of the claims on 19 April 2013 and the present request. Claim 1 was based on claims 1, 2, 3 and 29 as originally filed in combination with the disclosure on page 10, lines 18 to 22. Since the board had seen no basis for the introduction of the feature "by weight", the feature had been deleted. It was anticipated that this would result in objections under Article 84 EPC. No possibility to clarify the CB ratio could be seen as the application did not disclose how the CB ratio should be determined.

Remittal of the case to the department of first instance for further prosecution

The objections raised by the board under Articles 123(2) and 84 EPC against the claim request filed with the letter of 19 April 2013 came as a surprise. The applicants had prepared for a discussion of the requirements of novelty and inventive step, not Article 123(2) EPC and Article 84 EPC. It would make sense to remit the case to the examining division in order to allow them to formulate further claim requests.

Adjournment of the oral proceedings and continuation in writing

If remittal could not be granted, the oral proceedings should be adjourned in order to have time to formulate further claim requests. Appeal proceedings were to be regarded as a continuation of the examination proceedings anyway.

- IX. The appellants requested that the decision under appeal be set aside and a patent be granted on the basis of the claims filed during the oral proceedings. As an auxiliary request the appellants requested in order of preference either remittal of the case to the examining division for further prosecution or adjournment of the oral proceedings and continuation of the appeal proceedings in writing.

Reasons for the Decision

Main request

Admissibility

1. The main request now under consideration was filed after discussion and subsequent withdrawal of the previous main request during the oral proceedings and, thus, at a very late stage in the proceedings. The representative submitted that the lack of timely instructions from the appellants was responsible for the late filing of both this and the previous main request. However, these are circumstances extraneous to the appeal proceedings which the board cannot consider legally relevant as reasons for not filing the request at issue earlier. Hence the claims of this request are to be considered a late amendment to the appellants' case.

2. Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) sets out that it is in the board's discretion to admit and consider any amendment to a party's case after it has filed its grounds of appeal. The discretion shall be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. It is established case law of the boards of appeal that the general principle of procedural economy requires that a late-filed request be clearly allowable in that, first, it meets the formal requirements of the EPC and, second, constitutes a promising attempt to counter the objections raised so far and does not give rise to new objections (Case Law of the Boards of Appeal of the European Patent Office,

6th edition 2010, sections VII.E.16.4.1 and VII.E.16.5.4).

3. According to Article 123(2) EPC the European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. In order to determine whether or not an amendment introduces new subject-matter it has to be established whether the overall change in the content of the application results in the skilled person being presented with technical information which is not clearly and unambiguously set out in the application as filed, even when account is taken of matter which is implicit to a person skilled in the art (Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, section III.A.1).

4. The appellants submitted that claim 1 was based on claims 1, 2, 3 and 29 as filed in combination with the disclosure on page 10, line 18 to 22 of the description as filed.

5. The board notes that the application as filed discloses on page 10, lines 18 to 22 that: "*Preferably, said product [i.e. the First Caralluma Extract] contains at least, both said major pregnane glycosides (including the isomers), namely, the caratubersides and boucerosides. Further, preferably said two major glycosides are substantially in the proportions corresponding to the proportions found in the caralluma species of said Groups I and II. That is, the CBR, the ratio of caratubersides and boucerosides therein is preferably 9:1 to 11:1.*" Also according to claim 10 as

filed "*the ratio of the caratubersides to boucerosides, referred to as the CB ratio, is preferentially substantially equal to that found in any of the caralluma species of said Group I or II*". The application as filed, thus, discloses that the ratio of the caratubersides to boucerosides found in the caralluma species of Group I and Group II is 9:1 to 11:1 but does not disclose that this ratio would also be found in any undefined plant matter which comprises one or more of the caralluma group of plants belonging to the Asclepiadaceae. In particular, the application as filed does not disclose that any process of extraction of plant matter, wherein said plant matter comprises one or more of the caralluma group of plants belonging to the Asclepiadaceae, results in a composition characterised in that the ratio of the caratubersides to boucerosides is substantially equal to that found in the plant matter and ranges from 9:1 to 11:1. Claim 1 therefore comprises new technical information that is not directly and unambiguously derivable from the application as filed, contrary to the requirements of Article 123(2) EPC.

6. According to established jurisprudence of the boards of appeal, to satisfy the clarity requirement the composition according to claim 1 has to be defined in such a way that the skilled person can clearly determine which compositions fall within the scope of the claim and which do not (Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, section II.B.1.1.1). In the present case, the composition of claim 1 is characterised in that the ratio of the caratubersides to boucerosides ranges from 9:1 to 11:1. The skilled person must thus know how that

ratio is determined. However the claim neither indicates which quality needs to be measured nor which procedures are used to determine the ratio of the caratubersides to boucerosides. Nor has it been argued by the appellants, let alone shown, that the determination of the ratio of the caratubersides to boucerosides in plant extracts was usual in the art and belonged to the common general knowledge of the skilled person at the priority date of the present application. As a consequence the compositions falling within the scope of claim 1 cannot be clearly and reliably determined and hence claim 1 of the main request lacks clarity.

7. Article 84 EPC also stipulates that the claims must be supported by the description. According to established jurisprudence of the Boards of Appeal this requirement is intended to ensure that the extent of protection as defined by the patent claims corresponds to the technical contribution of the disclosed invention to the art. Therefore the claims must reflect the actual contribution to the art in such a way that the skilled person is able to perform the invention in the entire range claimed (Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, section II.B.4.1). In the present case, the description as filed only reports the total glycoside content of the plant extracts obtained (see Tables I to IV, 5 and 6) but contains no data to indicate that any process of extraction of plant matter results in a ratio of the caratubersides to boucerosides from 9:1 to 11:1. As a matter of fact the ratio of the caratubersides to boucerosides was not determined for any of the plant extracts nor is it disclosed how this should be done.

This was acknowledged by the appellants. The scope of claim 1 is thus broader than is justified by the extent of the description. Therefore the board considers that the subject-matter of claim 1 moreover lacks technical support and also for this reason fails the requirements of Article 84 EPC.

8. For the above reasons the main request shows clear deficiencies with regard to the requirements of Article 123(2) EPC and Article 84 EPC and the board decides, in the exercise of the discretion conferred on it by Article 13(1) RPBA, not to admit the main request into the proceedings.

The appellants' auxiliary request for remittal of the case to the department of first instance

9. At the oral proceedings before the board the appellants submitted that they were surprised that they were required to discuss the requirements of Article 123(2) EPC and 84 EPC of the claim request filed shortly before the oral proceedings with their letter of 19 April 2013 since they had prepared for a discussion of the requirements of novelty and inventive step. Accordingly, they requested the board to remit the case to the department of first instance to allow them to formulate further claim requests to address the objections raised by the board against that claim request.
10. It is settled case law of the boards of appeal that any amended set of claims has to fulfil the formal requirements of the EPC before any meaningful discussion of substantive issues can take place. The

appellants may thus be expected to be prepared to discuss also the requirements of Articles 84 and 123(2) EPC of any amended claim set they wish to have considered by the board, in particular if claim requests are filed at a late stage in the proceedings (see also point 2 above). Therefore the board can see no objective reason why the appellants, after submitting amended claims of their own volition, should have been surprised that the formal requirements of these claims would require discussion. That this discussion took place during the oral proceedings was a direct consequence of the filing of the request three working days before the oral proceedings.

11. A remittal of the case to the department of first instance requires first that the board be convinced that the appeal is allowable in that the decision under appeal needs to be set aside. In the present case the appellants substantiated their appeal by filing with their statement of grounds of appeal amended claims which deprived the contested decision of its basis. At the beginning of the oral proceedings before the board the appellants replaced the claims which had been filed with the statement of grounds of appeal with a new set of claims which they withdrew subsequently. The claim set submitted thereafter was held inadmissible by the board (see points VII and 1 to 7, above). As the case stands there is thus no text submitted or agreed by the appellant in the sense of Article 113(2) EPC on the basis of which the board could allow the appeal and set aside the decision under appeal. In the absence of an allowable request the case can not be remitted to the first instance.

The appellants' auxiliary request for adjournment of the oral proceedings and continuation in writing

12. The reasons given by the appellants for this request were partly the same as those for the request for remittal and have been dealt with above (see points 9 to 10). In addition the appellants submitted that the sole purpose of the appeal proceedings was to continue the examination procedure.

13. Contrary to the appellants' misconception, proceedings before the boards of appeal are not a continuation of the examination proceedings but are according to established jurisprudence primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, point 4 of the reasons). Under Article 12(2) RPBA the statement of grounds of appeal shall moreover contain a party's complete case. Any requests the appellants wanted to have considered in the proceedings before the board should thus have been filed with their statement of grounds of appeal. In the present case the appellants filed a sole request with the grounds of appeal and restricted their submissions to that request without formulating any fall back positions in the form of auxiliary requests. Only shortly before and during the oral proceedings before the board the appellants submitted new claim requests. After due consideration of the circumstances the board can see no compelling reasons why the appellants should be accorded even more time to formulate claim requests when in fact these requests ought to have been filed with their statement of grounds of appeal. The general interest in efficient conduct of the appeal proceedings is reflected in Article 13(3) RPBA which stipulates

that amendments sought to be made after oral proceedings have been arranged will not be admitted if they raise issues which the board cannot reasonably be expected to deal with without adjournment of the oral proceedings. The board considers that Article 13(3) RPBA requires that the request for adjournment and continuation in writing has to be refused.

14. Since none of the appellants' requests is allowable, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

P. Cremona

C. Rennie-Smith