

Internal distribution code:

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

**Datasheet for the decision
of 7 February 2014**

Case Number: T 1345/10 - 3.3.10
Application Number: 05291800.0
Publication Number: 1764081
IPC: A61K8/41, A61K8/35, A61K8/49,
A61Q17/04
Language of the proceedings: EN

Title of invention:

Sunscreen composition comprising a dibenzoylmethane, an aminohydroxybenzophenone, a triazine and a triazole as UV filters

Applicant:

Johnson & Johnson Consumer France SAS

Headword:

Relevant legal provisions:

EPC Art. 123(2), 84
EPC R. 139

Keyword:

Amendments - added subject-matter (yes)
- main request, auxiliary requests IV to VI
Claims - clarity (no) - auxiliary requests I to III

Decisions cited:

T 0337/95, T 0068/85

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1345/10 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 7 February 2014

Appellant: Johnson & Johnson Consumer France SAS
(Applicant) 1, rue Camille Desmoulins
92787 Issy les Moulineaux Cedex 9 (FR)

Representative: Metten, Karl-Heinz
Boehmert & Boehmert
Pettenkoferstrasse 20-22
80336 München (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 30 December 2009 refusing European patent application No. 05291800.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: P. Gryczka
Members: R. Pérez Carlón
D. Rogers

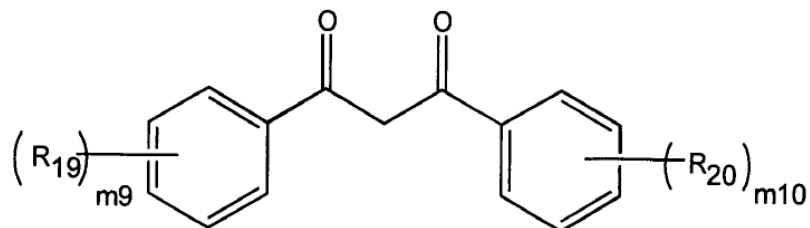
Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division to refuse European patent application EP 05 291 800.
- II. The examining division considered that the then pending main request contained added subject-matter since replacing the term "ethylhexyl triazine" by "ethylhexyl triazone" on page 17 of the description was not an obvious correction in the sense of Rule 139 EPC, and such an amendment did not fulfill the requirements of Article 123(2) EPC. It also decided that the subject-matter of the then pending first auxiliary request was not novel, and that the subject-matter of the then pending second to fourth auxiliary requests was not inventive.
- III. The appellant (applicant) filed with the statement setting out the grounds of appeal a main request, whose description is identical to that of the main request pending in examination proceedings, together with auxiliary requests I to VI.
- IV. The relevant parts of the requests upon which the present decision is based read as follows:

The **main request** includes an amended page 17 of the description, in which the word "triazine" has been replaced by "triazone". Claim 1 of the main request reads as follows:

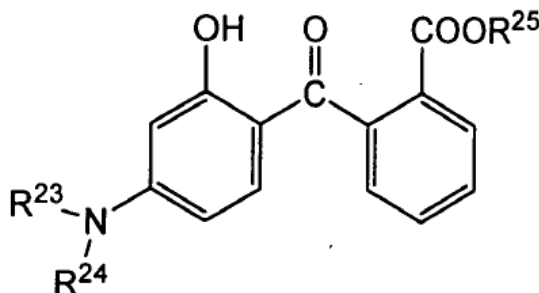
"A composition comprising:

(a) a dibenzoylmethane derivative UV-A absorbing agent of the formula:



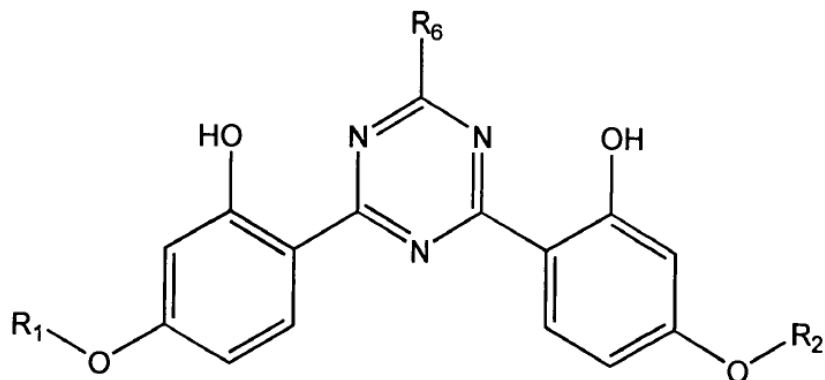
wherein R_{19} and R_{20} , independently, are C_1 - C_8 alkyl or C_1 - C_8 alkoxy, m_9 is 0 to 3 and m_{10} is 1 to 3;

(b) a hydroxybenzophenone of the formula:

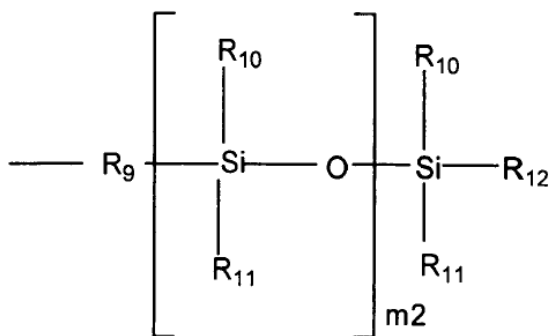


wherein R^{23} and R^{24} independently are hydrogen, C_1 - C_{10} alkyl, or C_3 - C_{10} cycloalkyl, or C_3 - C_{10} cycloalkenyl, wherein the substituents R^{23} and R^{24} , together with the nitrogen atom to which they are bonded, can form a 5- or 6-membered ring; and R^{25} is C_1 - C_{20} -alkyl;

(c) a triazine derivative of the formula:

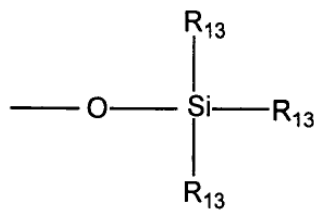


wherein, R_1 and R_2 , independently, are C_3 - C_{18} alkyl, C_2 - C_{18} alkenyl, a radical of the formula $-CH_2-CH(OH)-CH_2-O-$ R_8 , or a radical of the formula (II)



(II)

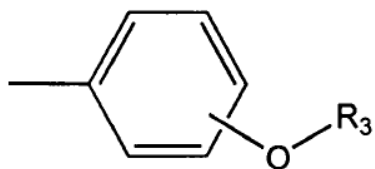
in which R_9 is a direct bond, C_1 - C_4 alkenyl, or a radical of the formula $-C_{m1}H_{2m1}-$ or $-C_{m1}H_{2m1}-O-$; R_{10} , R_{11} and R_{12} , independently, are C_1 - C_{18} alkyl, C_1 - C_{18} alkoxy, or a radical of the formula (III)



(III)

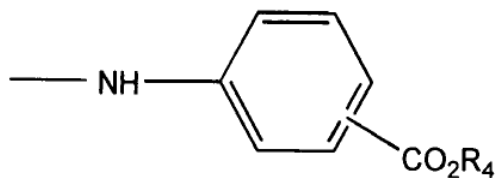
in which R_{13} is C_1 - C_5 alkyl; m_1 is 1 to 4; m_2 is 0 to 5;

R_6 is a radical of the formula (IV)



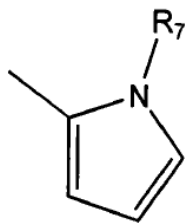
(IV)

or of the formula (V)



(V)

or of the formula (VI)



(VI)

R_3 is hydrogen, C_1 - C_{10} alkyl, or a radical of the formula $-(CH_2CHR_5-O)_{m4}-(CH_2)_qCH_3$ or

$-(CH_2CHR_5-O)_{m4}-(CH_2)_q-O-R_8$ or $-CH(OH)-CH_2-OR_8$;

R_4 is hydrogen, a metal cation, C_1 - C_5 alkyl, or a radical of the formula $-(CH_2)_{m3}-O-R_8$;

R_5 is hydrogen or methyl;

R_8 is hydrogen or C_1 - C_8 alkyl;

R_7 is C_1 - C_{18} alkyl;

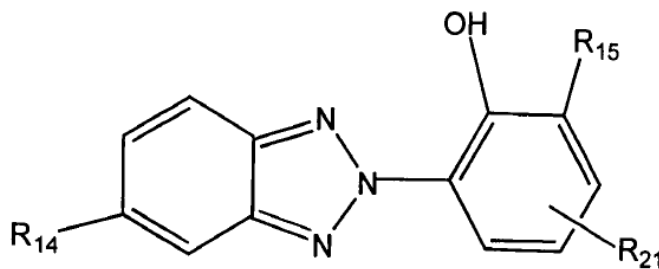
m_3 is 1 to 4;

m_4 is 1 to 16;

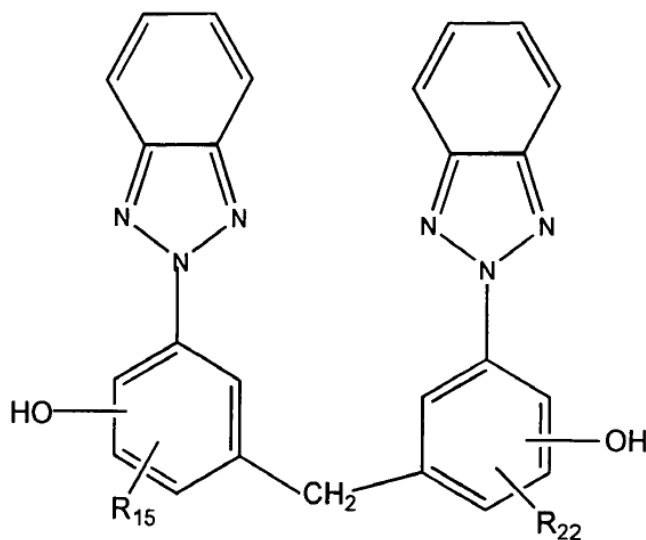
q is 0 to 16;

and

(d) a triazole derivative of the formula (VIII) or (IX):



(VIII)



wherein R_{14} is C_1 - C_{18} alkyl or hydrogen; R_{15} and R_{22} , independently, are C_1 - C_{18} alkyl optionally substituted with a phenyl group, and R_{21} is C_1 - C_8 alkyl;

wherein said dibenzoylmethane derivative UV-A absorbing agent and said hydroxybenzophenone are present in a weight ratio of about 1:1."

Claim 1 of **auxiliary request I** contains, in addition to the features of claim 1 of the main request, the features:

"wherein the combined amount of said dibenzoylmethane derivative UV-A absorbing agent and said hydroxybenzophenone ranges from about 0.5% to about 5% by weight of said composition,

wherein the combined amount of said triazine derivative and said triazole derivative ranges from about 0.5% to about 7% by weight of said composition, and

wherein the ratio of UV-A absorbance, in the range from 320 to 400 nm, to UV-B absorbance, in the range from

290 to 320 nm, of said composition is at least about 0.8."

Claim 1 of the **auxiliary request II** contains all the features of claim 1 of the auxiliary request I and, in addition:

"wherein the composition further comprises one or more UV-B absorbing agents"

Claim 1 of the **auxiliary request III** contains all the features of claim 1 of the auxiliary request II and further restricts the amount of UV-B absorbing agents by the feature:

"wherein the composition further comprises one or more UV-B absorbing agents in an amount from about 0.1% to about 20% by weight of said composition"

Claim 1 of **auxiliary request IV** reads as follows:

"A composition comprising:

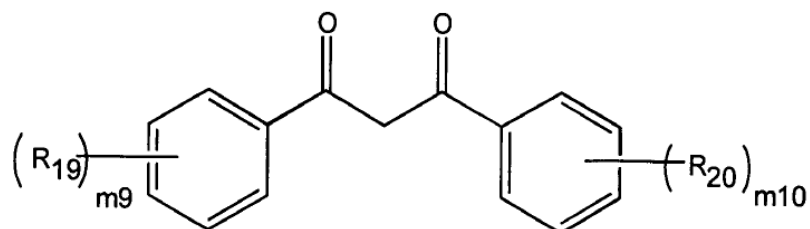
(a) 4-tert-butyl-4'-methoxydibenzoylmethane as said dibenzoylmethane derivative UV-A absorbing agent;

(b) 2(4-diethylamino-2-hydroxybenzyl)-benzoic acid hexylester as said hydroxybenzophenone;

(c) 2,4-bis{[4-(2-ethyl-hexyloxy)-2-hydroxy]-phenyl}-6-(4-methoxyphenyl)-(1,3,5)-triazine as said triazine derivative;

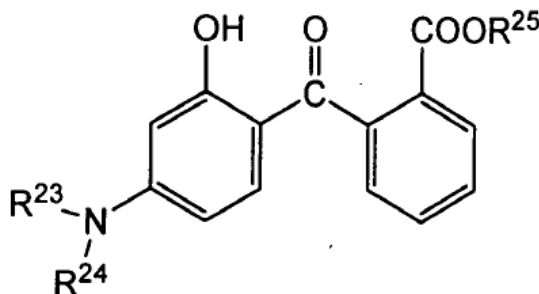
(d) methylene bis-benzotriazolyl tetramethylbutylphenol as said triazole derivative;

wherein a dibenzoylmethane derivative UV-A absorbing agent of the formula:



wherein R_{19} and R_{20} , independently, are C_1 - C_8 alkyl or C_1 - C_8 alkoxy, m_9 is 0 to 3 and m_{10} is 1 to 3;

and a hydroxybenzophenone of the formula:



wherein R^{23} and R^{24} independently are hydrogen, C_1 - C_{10} alkyl, C_3 - C_{10} cycloalkyl, or C_3 - C_{10} cycloalkenyl, wherein the substituents R^{23} and R^{24} , together with the nitrogen atom to which they are bonded, can form a 5- or 6-membered ring; and R^{25} is C_1 - C_{20} -alkyl;

are present in a weight ratio of about 1:1."

Claim 1 of **auxiliary request V** contains, in addition to the features of claim 1 of auxiliary request IV, the feature:

"and further comprising one or more UV-B absorbing agents."

Finally, claim 1 of the **auxiliary request VI** contains, in addition to the wording of claim 1 of the auxiliary request IV the feature:

"wherein the composition further comprises octocrylene as UV-B absorbing agent."

- V. In addition to those issues which were already part of the appealed decision, the board objected in a communication sent with the summons for oral proceedings *inter alia* to the following:

Claim 1 of auxiliary requests I to III was not clear since the feature "wherein the ratio of UV-A absorbance, in the range from 320 to 400 nm, to UV-B absorbance, in the range from 290 to 320 nm, of said composition is at least about 0.8" attempted to define the invention by a result to be achieved which only amounted to claiming the underlying technical problem. Such a functional feature could not be allowed, since the claimed composition could be defined in terms of the chemical structure and the relative amounts of their components without unduly restricting the scope of protection.

Claim 1 of auxiliary requests IV to VI contained added subject-matter. These claims concerned a composition comprising components (a) to (d) wherein a dibenzoylmethane derivative (defined by a Markush formula) and a hydroxybenzophenone (defined by a second Markush formula) are present in a weight ratio of about 1:1, for which no basis could be found in the application as originally filed.

- VI. Under cover of a letter dated 4 September 2013, the appellant informed the board that it would not attend

the oral proceedings. No arguments against the objections raised by the board were provided.

With respect to the issue of added subject-matter in the main request, which had already been part of the appealed decision, the appellant argued that the modification on page 17 of the description "ethylhexyl triazone" was a correction under Rule 139 EPC since the proposed wording was the sole option which a person skilled in the technical field of sunscreen compositions would consider.

VII. The board cancelled the already scheduled oral proceedings.

VIII. The appellant requested (in writing) that the decision be set aside and a patent be granted upon the basis of the main request or, subsidiarily, upon the basis of any one of auxiliary request I to VI, all the requests having been filed with the statement setting out the grounds of appeal.

Reasons for the Decision

1. The appeal is admissible.

Main request, amendments:

2. The appellant argued that the amendment on page 17 of the description replacing "ethylhexyl triazine" by "ethylhexyl triazone" was the correction of an obvious error fulfilling the requirements of Rule 139 EPC, since nothing else could have been intended than what was offered as said correction.

The question arises, however, whether, as argued by the appellant, "ethylhexyl triazone" is the only possible correction of this error.

As explained by the examining division, the error could have its origin not only in the naming of the moiety "triazine", but also in the name of the substituent "ethylhexyl" or in that a term between "ethylhexyl" and "triazine" was missing. Even though ethylhexyl triazone is a well known chemical in the technical field of sunscreen compositions to which the present application relates, it cannot be excluded that other chemical compounds based on triazines are also used in the same field (see for example the application itself: compound (c) of claim 1 is a triazine derivative). Therefore, although the skilled reader would consider ethylhexyl triazone as a possible correction, the board fails to see that this would be the only possibility for such a correction, even in the field of sunscreen technology.

For this reason, the board concurs with the examining division that the amendment on page 17 of the description of the application does not fulfill all the requirements for correction of errors of Rule 139 EPC. It must, thus, be examined whether such amendment fulfills the requirements of Article 123(2) EPC.

The appellant has, however, not contested that the term "ethylhexyl triazone" is not disclosed in the application as originally filed.

The main request contravenes, thus, the requirements of Article 123(2) EPC with the consequence that said request is not allowable.

Auxiliary requests I to III, clarity:

3. Claim 1 of auxiliary requests I to III contains the feature "wherein the ratio of UV-A absorbance, in the range from 320 to 400 nm, to UV-B absorbance, in the range from 290 to 320 nm, of said composition is at least about 0.8".

Article 84 EPC in combination with Rule 43(1) EPC stipulates the requirements that the claims shall be clear and define the matter for which protection is sought in terms of the technical features of the invention. Those requirements serve the purpose of ensuring that the public is not left in any doubt as to which subject-matter is covered by a particular claim and which is not (see T 337/95, OJ EPO 1996, 628, points 2.2 to 2.5 of the reasons).

4. The functional technical feature in claim 1 "wherein the ratio of UV-A absorbance, in the range from 320 to 400 nm, to UV-B absorbance, in the range from 290 to 320 nm, of said composition is at least about 0.8" attempts in fact to define the invention by the result to be achieved which amounts in essence to the effect sought by the claimed compositions (see page 1, lines 8-9 "the compositions provide an excellent balance of UV-A and UV-B absorbance").

As a general rule, claims which attempt to define the invention by a result to be achieved which only amounts to claiming the underlying technical problem should not be allowed. Exceptionally, such a technical feature may be expressed in general functional terms (see T 68/85, OJ EPO 1987, 228, headnote) if, from an objective point of view,

- i) such feature cannot otherwise be defined more precisely without unduly restricting the scope of the claim, and
- ii) the skilled person can reduce such a feature to practice without undue burden.

In the present case, the claimed compositions can be defined in terms of the chemical structure and the relative amounts of their components without unduly restricting the scope of protection. For this reason, and in the absence of any counter-argument from the side of the appellant, the board concludes that the functional feature "wherein the ratio of UV-A absorbance, in the range from 320 to 400 nm, to UV-B absorbance, in the range from 290 to 320 nm, of said composition is at least about 0.8" renders claim 1 of auxiliary requests I to III unclear and, thus, these requests are not allowable.

Auxiliary requests IV to VI, amendments:

5. Claim 1 of auxiliary requests IV to VI claims a composition comprising four particular components (a) to (d), wherein a dibenzoylmethane derivative (defined by a Markush formula) and a hydroxybenzophenone (defined by a second Markush formula) are present in a weight ratio of about 1:1. The Markush formulae, although embracing compounds (a) and (b), respectively, are not restricted to these compounds, with the consequence that claim 1 of the auxiliary requests IV to VI concerns, *inter alia*, a composition comprising (a) to (d) which further contains additional dibenzoylmethane and hydrobenzophenone compounds defined by the Markush formulae, whereby the later are present in a relative amount of 1:1 by weight. This is

an embodiment for which the applicant has not provided any basis in the application as originally filed, nor could the board find any such basis.

Claim 1 of the auxiliary requests IV to VI extends, thus, beyond the content of the application as originally filed (Article 123(2) EPC) and said requests are, therefore, not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated