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**Datasheet for the decision
of 17 November 2016**

Case Number: T 0158/13 - 3.3.10

Application Number: 00114790.9

Publication Number: 1066824

IPC: A61Q13/00, A61K8/33

Language of the proceedings: EN

Title of invention:

Use of a stimulative perfume composition comprising
anisaldehyde

Patent Proprietor:

SHISEIDO COMPANY LIMITED

Opponent:

Beiersdorf AG

Headword:

Relevant legal provisions:

EPC Art. 53(c), 56, 108

EPC R. 99(2)

RPBA Art. 13(1)

Keyword:

Main request - Exceptions to patentability - (yes)
Auxiliary request 1 - not clearly allowable

Decisions cited:

J 0022/86, T 0220/83, T 0092/93, T 0469/94, T 0401/95,
T 0950/99

Catchword:



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Case Number: T 0158/13 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 17 November 2016

Appellant: Beiersdorf AG
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Respondent: SHISEIDO COMPANY LIMITED
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
7 November 2012 concerning maintenance of the
European Patent No. 1066824 in amended form.**

Composition of the Board:

Chairman P. Gryczka
Members: C. Komenda
F. Blumer

Summary of Facts and Submissions

- I. The appeal of the Appellant (opponent) lies from decision of the Opposition Division to maintain the European patent No. 1 066 824 in amended form according to the then pending 2nd auxiliary request.
- II. Notice of opposition has been filed on the grounds of insufficiency of disclosure (Article 100(b) EPC) of lack of novelty and lack of inventive step (Article 100(a) EPC) and the patent containing amendments going beyond the content of the application as filed (Article 100(c) EPC). The Opposition Division raised a further objection under Article 53(c) EPC on its own motion.
- III. In its decision the Opposition Division referred *inter alia* to the following documents:
- (1) EP-A-0 339 276 and
 - (3) Paul Jellinek: Die psychologischen Grundlagen der Parfümerie, Dr. Alfred Hüthig Verlag, Heidelberg, 1965, pages 97 to 99.

The decision under appeal found that the subject-matter of the claims according to the then pending main, 1st and 2nd auxiliary request did not contain any amendments extending beyond the disclosure of the original application (Article 100(c) EPC), that it was not excluded from patentability according to Article 53(c) EPC and that the original application contained sufficient information to enable the skilled person to carry out the invention over the whole range claimed (Article 83 EPC). Further the Opposition Division held that the subject-matter claimed was novel over the cited prior art (Article 54 EPC). However, the subject-matter of the claims of then pending main and 1st

auxiliary request was found not to involve an inventive step (Article 56 EPC). Starting from document (3) as closest state of the art the Opposition Division decided that the subject-matter of the then pending 2nd auxiliary request involved an inventive step.

The wording of independent claims 1 and 6 of the 2nd auxiliary request on which the decision under appeal was based read as follows:

"1. A non-therapeutic use of a stimulative perfume composition including 0.01 wt% to 50 wt% anisaldehyde for releasing persons from a physiological mental condition of sleepiness, sense of fatigue and inactivity in daily life, and for refreshing and activating their mental condition, wherein said stimulative perfume composition further includes a perfume compound selected from the group consisting of cinnamic aldehyde, eugenol, carvone and heliotropin."

"6. A stimulative perfume composition comprising anisaldehyde as a stimulative agent and a perfume component selected from the group consisting of pepper, cardamom and nutmeg."

IV. With its statement of grounds for appeal the Appellant brought forward its argumentation as to why the subject-matter of the use claims 1 to 5 of the 2nd auxiliary request did not comply with the requirements of Article 53(c) EPC and why the claimed subject-matter did not involve an inventive step in the sense of Article 56 EPC, when starting from document (1) as closest state of the art. No other objections were raised.

V. In its reply to the statement of grounds for appeal the Respondent (patent proprietor) raised an objection to the admissibility of the appeal arguing that the appeal was not reasoned in the sense of Rule 99(2) EPC. It further brought its argumentation as to why the claimed use clearly was directed to only the non-therapeutic use and, consequently, did not relate to subject-matter excluded from patentability under Article 53(c) EPC. Further, it argued that the subject-matter of the claims according to the 2nd auxiliary request on which the decision was based (main request in the appeal proceedings) involved an inventive step.

During the oral proceedings before the Board held on 17 November 2016 the Respondent filed further auxiliary requests 1 and 2.

The wording of claim 1 of the newly filed auxiliary request 1 was based on the wording to claims 1 to 6 on which the decision under appeal was based, wherein in claims 1 and 5 the use for "releasing persons from a physiological mental condition of sleepiness, sense of fatigue and inactivity in daily life, and for refreshing and activating their mental condition" was amended into the use for "refreshing and activating a person's mental condition".

Auxiliary request 2 contained only one claim, the wording of which was identical to the wording of claim 6 of the set of claims on which the decision under appeal was based.

VI. In a communication under Article 15(1) RPBA the Board informed the parties of its preliminary opinion and on the issues to be discussed during the oral proceedings summoned for 17 November 2016 before the Board.

VII. The Appellant (opponent) requested in writing that the decision under appeal be set aside and that the European patent No. 1066824 be revoked.

The Respondent (patent proprietor) requested that the appeal be rejected as inadmissible, subsidiarily, that the appeal be dismissed or that the decision under appeal be set aside and the patent be maintained on the basis of any of auxiliary requests 1 and 2, both as filed during oral proceedings before the Board.

VIII. The oral proceedings before the Board were held in the absence of the Appellant, who had informed the Board in its letter dated 6 September 2016 that it withdrew its request for oral proceedings and that would not attend the oral proceedings. At the end of the oral proceedings the decision was announced.

Reasons for the Decision

1. *Main Request*

2. *Admissibility of the appeal*

2.1 In its reply to the statement of grounds for appeal the Respondent raised an objection to the admissibility of the appeal. In particular, it argued that the statement of grounds for appeal did not clearly indicate, where the decision of the Opposition Division was incorrect. Further, the Appellant had not provided any arguments in relation to the other grounds for opposition dealt with in the decision under appeal. Therefore, it argued that the appeal was not reasoned in the sense of Rule 99(2) EPC.

- 2.2 It is established case law (see Case Law of the Board of Appeal of the European Patent Office, 8th edition 2016, chapter IV.E.2.6.3) that an appeal is adequately substantiated, if the grounds of appeal specify the legal or factual reasons why the impugned decision should be set aside. The arguments must be clearly and concisely presented to enable the Board and the other party or parties to understand immediately why the decision is alleged to be incorrect, and on what facts the Appellant bases its arguments, without first having to make investigations of their own (T 220/83, OJ EPO 1986, 249).
- 2.3 In the present case the Appellant's statement of grounds for appeal contained the argumentation as to why the subject-matter of claims 1 to 5 of the then pending 2nd auxiliary request did not comply with the requirements of Article 53(c) EPC and why it did not involve an inventive step when starting from document (1) as closest state of the art. On the other grounds for opposition no argumentation was provided.
- 2.4 Although the Appellant's statement of grounds for appeal did not explicitly indicate, where the decision of the Opposition Division was incorrect, it nevertheless set out in a clear manner, that the result of the discussion on Article 53(c) EPC and on inventive step could have led to a result different from that adopted in the decision under appeal. Thus, upon reading the decision under appeal and the statement of grounds for appeal it was immediately apparent for the Board and the other party that the decision should be set aside. The argumentation to Article 53(c) EPC and to Article 56 EPC made also clear the Appellant's view that he found the decision under appeal being incorrect

in this respect. The Appellant also did not need to present an argumentation on the other grounds for opposition, since the arguments presented on Article 53 EPC - if accepted by the Board - could have been sufficient to reverse the decision under appeal.

- 2.5 Therefore, the Board concludes that said statement of grounds for appeal meets the requirements of Article 108 EPC and Rule 99(2) EPC with the consequence that the appeal is admissible (see T 950/99, point 1. of the reasons; J 22/86, OJ EPO 1987, 280, point 2 of the reasons).

3. *Amendments (Article 123 EPC) and Article 83 and 54 EPC*

In the decision under appeal, which was based on claims 1 to 6 according to the then pending 2nd auxiliary request, the Opposition Division found that all amendments made during the examination and opposition proceedings fulfilled the requirements of Article 123 EPC. It further ruled that the requirements of Articles 84, 83 and 54 EPC were met.

Since the Appellant did not raise any objections to these findings of the Opposition Division the Board concludes that these objections were no longer maintained. As the Board sees no need for further investigation, the requirements of Article 123, 84, 83 and 54 are deemed to be fulfilled.

4. *Article 53(c) EPC*

- 4.1 In the decision under appeal the Opposition Division found that the subject-matter of claims 1 and 5 of the then pending 2nd auxiliary request met the requirements of Article 53(c) EPC, since it was possible to clearly

distinguish between a non-therapeutic and a therapeutic use of the stimulative perfume. The basic argument was that it was possible to distinguish between persons that only had little sleep and those who suffered from chronic fatigue or depression, and consequently the non-therapeutic use arose from a proper selection of persons on which the stimulative perfume was used.

4.2 However, in the statement setting out the grounds for appeal the Appellant pointed out that it was not possible to distinguish between a therapeutic or non-therapeutic use of the stimulative perfume composition, since the way of administering the composition is the same for a therapeutic and a non-therapeutic use. Moreover, the claimed use covered at least some mental conditions, such as sleepiness, that might or might not be of a pathological nature.

4.3 According to the case law of the Boards of appeal a clear distinction between a therapeutic and a non-therapeutic use is possible, if the group of persons treated can be clearly identified as healthy or as suffering from a pathological condition (see e.g. T 469/94, not published in the OJ EPO, point 4.4 of the reasons).

4.4 In the present case the claims were directed to the non-therapeutic use of a stimulative perfume composition "for releasing persons from a physiological mental condition of sleepiness, sense of fatigue and inactivity in daily life, and for refreshing and activating their mental condition". At least the sleepiness or inactivity in daily life may not only be a physiological condition, but may also arise from a pathological condition. For example, sleepiness or inactivity in daily life may be an early sign of a

depression which cannot be clearly distinguished from a non-pathological condition.

Without a clear and unambiguous distinction between a physiological and a pathological nature of a persons mental condition a clear distinction between therapeutic and non-therapeutic use is also impossible. The mere reference to the claimed use being a "non-therapeutic" use does not, therefore, exclude the therapeutic use.

Even with the wording of the claim, which calls the claimed composition a "perfume" composition a therapeutic use is not excluded, since the patent in suit demonstrated that the administration of the perfume composition leads to a clearly measurable stimulative effect on the brain, as can be determined by an increase of the CNV value.

Since for the use for some of the claimed mental conditions a clear distinction between therapeutic and non-therapeutic use cannot be made the subject-matter of claims 1 and 5 does not fulfil the requirements of Article 53(c) EPC.

4.5 Consequently, the Respondent's main request, which was the maintenance of the patent in suit on the basis of claims 1 to 6 according to the 2nd auxiliary request on which the decision under appeal was based, is not allowable.

5. *Auxiliary Requests 1*

5.1 *Admissibility*

- 5.2 Auxiliary request 1 was submitted at a late stage during the oral proceedings before the Board. Admission into the proceedings of requests filed at such a late stage of the appeal proceedings is a matter of discretion for the Board of Appeal and is not a matter as of right. In exercising due discretion, it is established case law of the Boards of Appeal that crucial criteria are whether or not the amended claims of those requests are clearly allowable and whether or not those amended claims give rise to fresh issues which the other party can reasonably be expected to deal with properly without unjustified procedural delay (see T 92/93, point B of the reasons; T 401/95, point 5.2 of the reasons, neither published in OJ EPO).
- 5.3 The fresh amendment introduced in claims 1 and 5 of auxiliary request 1 restricted the claimed method to the use for "refreshing and activating a person's mental condition". The granted version, however, claimed the use for "releasing persons or animals from a physiological mental condition of sleepiness, sense of fatigue and inactivity in daily life, and for refreshing and activating their mental condition". According to the granted version of claims 1 and 5 the group of persons to be treated with the claimed compositions obviously had to suffer from a physiological condition of sleepiness, sense of fatigue and inactivity in daily life, whereas this restriction is no longer present according to the fresh amendment. Therefore, the Board has doubts as to whether this amendment may extend the protection conferred beyond that of the patent as granted thereby infringing the provisions of Article 123(3) EPC.
- 5.4 Thus, auxiliary request 1 is not clearly allowable with the consequence that the Board exercises its discretion

not to admit this request into the proceedings Article 13(1) RPBA).

6. *Auxiliary request 2*

6.1 Auxiliary request 2 contained only one claim, the wording of which was identical to the wording of claim 6 of the set of claims on which the decision under appeal was based.

6.2 Since the amendment corresponded to a deletion of claims 1 to 5 of the 2nd auxiliary request on which the decision under appeal was based the Board sees no reason not to admit this late filed request into the proceedings.

6.3 The Board notes that the Appellant has not raised any objections to the subject-matter of claim 6 of the then pending 2nd auxiliary request. Since the Opposition Division found that the subject-matter of claim 6 of the then pending 2nd auxiliary request fulfilled the requirements of the EPC the Board sees no reason to further investigate into this issue.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent on the basis of auxiliary request 2 (claim 1) as filed during oral proceedings before the Board, and a description yet to be adapted.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated