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**Datasheet for the decision
of 5 June 2018**

Case Number: T 0761/14 - 3.3.10

Application Number: 00976694.0

Publication Number: 1139974

IPC: A61K8/64, A61Q19/00

Language of the proceedings: EN

Title of invention:

SOY DEPIGMENTING AND SKIN CARE COMPOSITIONS

Patent Proprietor:

JOHNSON & JOHNSON CONSUMER COMPANIES, INC.

Opponent:

Beiersdorf AG

Headword:

SKIN CARE COMPOSITIONS/JOHNSON & JOHNSON

Relevant legal provisions:

EPC Art. 56

RPBA Art. 12(2), 13(1), 13(3)

Keyword:

Main request: Inventive step (no) - obvious alternative
auxiliary requests - admitted (no)

Decisions cited:

Catchword:



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Case Number: T 0761/14 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 5 June 2018

Appellant: JOHNSON & JOHNSON CONSUMER COMPANIES, INC.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
4 February 2014 concerning maintenance of the
European Patent No. 1139974 in amended form.

Composition of the Board:

Chairman P. Gryczka
Members: J.-C. Schmid
T. Bokor

Summary of Facts and Submissions

I. The Appellant (Proprietor of the patent) lodged an appeal against the interlocutory decision of the Opposition Division which found that the subject-matter of claim 1 of the European patent No. 1 139 974 as granted did not meet the requirement of inventive step and that the patent could only be maintained in amended form on the basis of the then pending 4th auxiliary request.

Claim 1 of the patent as granted reads as follows:

"1. A cosmetic method for increasing skin firming and skin elasticity and reducing signs of skin ageing comprising applying a skin composition comprising a non-denatured soy milk having protease inhibitory activity and a stabilising system, said stabilising system comprising an antioxidant, a chelating agent or a preservative, topically to the skin."

II. Notice of opposition had been filed by the Respondent requesting revocation of the patent-in-suit in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC), insufficient disclosure (Article 100(b) EPC), and extension of the subject-matter of the patent-in-suit beyond the content of the application as filed (Article 100(c) EPC).

III. The following documents were cited in the opposition proceedings:

- (1) WO-A-99/30729 and
- (2) WO-A-96/28008.

According to the Opposition Division, the subject-matter of the patent as granted did not extend beyond the content of the application as filed. The patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The subject-matter of claim 1 of the patent as granted was novel over document (1). With respect to inventive step, document (2) represented the closest prior art to the invention. In the absence of any indication, it could not be concluded that the soy protein extract present in the cosmetic compositions of document (2) had been denatured. The only difference between the subject-matter of claim 1 of the patent as granted and the disclosure of document (2) was the use of soy milk instead of the purified soy protein extract. The objective technical problem underlying the patent was to provide an alternative method for increasing skin firming and skin elasticity and reducing signs of skin ageing. The proposed solution of substituting soy protein extract by soy milk in the cosmetic composition was obvious. The Opposition Division therefore concluded that the subject-matter of claim 1 of the patent as granted lacked an inventive step.

The Opposition Division furthermore found that the claims of the 4th auxiliary request met the requirement of the EPC and decided to maintain the patent on that basis.

- IV. In its notice of appeal dated 31 March 2014, the Appellant requested that the decision of the Opposition Division be set aside, and that the patent be maintained on the basis of the Main Request (maintenance of the patent as granted) or auxiliary Requests 1 to 3 as filed on 31st October 2013, or "on

the basis of such further amended claims as may be submitted during the appeal process".

In the statement of the grounds of appeal dated 13th June 2014, the Appellant submitted the following requests:

(1) that the decision of the Opposition Division to maintain the patent-in-suit is set aside and the patent be maintained as granted (main request)

(2) oral proceedings, if the main request cannot be granted,

(3) that the patent-in-suit be maintained on the basis of the Auxiliary Request 4 as maintained by the opposition division, also according to the principle of the [prohibition of] Reformatio in peius, if the main request cannot be granted.

No other request was mentioned in the statement setting out the grounds of appeal.

- V. During the oral proceedings held on 5 June 2018 before the Board, the Appellant defended the patent of the basis of the main request. At the oral proceedings, the Appellant requested also that the patent be maintained on the basis of auxiliary requests 1 to 3, which were considered by the Opposition Division in the impugned decision. According to the Appellant, auxiliary requests 1 to 3 were not explicitly withdrawn in the statement of ground of appeal, and therefore had been still pending in the appeal proceedings. Therefore, they should be admitted in the appeal proceedings. With respect to inventive step, document (2) represented the closest prior art to the invention. This document made no reference to the use of soy milk, let alone the use of non-denatured soy milk having protease inhibitory activity, for slowing skin ageing and/or increasing its activity. Furthermore, prior to the priority date of

the patent, commercially available soy protein extracts were inevitably denatured.

Accordingly, there was no reason why the skilled person would have looked at the possibility of using a non-denatured soymilk having protease inhibitory activity for increasing skin elasticity and reducing skin ageing. The subject-matter of claim 1 of the patent as granted involved therefore an inventive step.

VI. According to the Respondent, document (2) was the closest prior art to the invention. The claimed method of increasing skin firming and skin elasticity and reducing signs of skin ageing differed from the method disclosed in document (2) only in that the cosmetic composition comprised soy milk instead of a soy extract. It was however obvious to use soy milk instead of a soy protein extract, since the soy milk would contain the same active ingredient as the extract. There was no reason to denature the soy milk, all the more because document (2) required an elastase inhibitory activity for the soy protein extract. The subject-matter of claim 1 lacked therefore an inventive step.

VII. The Appellant requested that the decision under appeal be set aside and the patent be maintained as granted, or subsidiarily, that the patent be maintained in an amended form on the basis of auxiliary requests 1 to 3 as filed on 31st October 2013.

The Respondent requested that the appeal be dismissed.

VIII. At the end of the oral proceedings held on 5 June 2018, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request: claims as granted

2. *Inventive step*

- 2.1 *Closest prior art*

The Board considers, in agreement with the parties, that document (2) represents the closest prior art to the invention, and takes it as the starting point in the assessment of inventive step.

Document (2) describes a cosmetic method for improving skin elasticity and skin firming, and reducing skin ageing (page 1, lines 1 to 3; page 15, lines 4 to 6). The composition described for that use in the form of a topical application includes two components, an anti-glycan agent and an anti-elastase agent. The anti-elastase agent may be natural, for example an extract of soy, in particular a soy protein extract. The cosmetic composition further comprises anti-oxidants and/or preservatives (see composition 1, claims 1, 5, 6, 10).

According to the Appellant, the soy extract required by document (2) was necessarily denatured, since before the priority date of the patent-in-suit any commercially available soy extract was denatured.

Notwithstanding that this assertion of the appellant is not proven by documentary evidence in the file, the disclosure of document (2) must be taken as it stands,

i.e. the cosmetic composition of document (2) comprises purified soy proteins extracts. Document (2) is silent on the question whether or not the purified protein extract is denatured. According to document (2), one of the components of the cosmetic composition must have elastase inhibitory activity, and may be for instance soy protein extract or alpha-1 anti-trypsin agent (see claims 5 and 6; page 4, lines 22 to 29). Trypsin and elastase are enzymes pertaining to the class of proteases. In the opinion of the Board, if the soy milk used in document (2) were denatured, it would appear highly unlikely for it to have such activity.

2.2 *Technical problem underlying the invention*

According to the Appellant, the technical problem to be solved is to provide an alternative method for increasing skin firming and skin elasticity and reducing signs of skin ageing.

2.3 *Proposed solution*

The proposed solution is the process of claim 1 characterized by using a composition comprising a non-denatured soy milk having protease inhibitory activity.

2.4 *Success*

In view of example 4 of the patent-in-suit, it is credible that the method of claim 1 provides an alternative to the method of document (2) for increasing skin firming and skin elasticity and reducing signs of skin ageing. This finding has not been contested by the Respondent.

2.5 *Obviousness*

It remains to be decided whether or not the proposed solution to that objective technical problem is obvious in the light of the prior art, namely whether the skilled person would have contemplated the replacement of the soy protein extract present in the cosmetic composition of document (2) by a non-denatured soy milk having protease inhibitory activity in order to provide an alternative method for increasing skin firming and skin elasticity and reducing signs of skin ageing.

The proteins present in the purified soy extract are also present in non-denatured soy milk, with the consequence that non-denatured soy milk also has elastase inhibitory activity. Hence, the skilled person would have regarded non-denatured soy milk having protease inhibitory activity as an obvious alternative, which is also a natural agent having elastase inhibitory activity as required by the cosmetic compositions of document (2) to increase skin elasticity and to reduce skin ageing. He would therefore have arrived at the subject-matter of claim 1 without exercising an inventive activity.

3. According to the Appellant, it was clear from the statement of page 15, lines 19 to 21 of document (2) that the purified soy protein extract used in the cosmetic compositions of document (2) has no effect on the elasticity and the firming of the skin.

However, document (2) teaches that elastases are the enzymes responsible for the degradation of elastin by hydrolysis and therefore contribute to the degradation of the elastic properties of the skin, their presence in the skin increasing with age (see document (2); page 3, lines 1 to 10). Document (2) furthermore teaches

that the second agent is chosen among compounds that inhibit elastase activity (see page 4, lines 22 to 24) and that a soy protein extract having elastase inhibitory activity is chosen as a preferred embodiment (see page 7, lines 5 and 6). Therefore, document (2) clearly teaches that the soy protein extract must have elastase inhibitory activity, with the consequence that it has an impact on the skin firming and elasticity, and even more so when it is combined with an anti-glycation agent.

The section of document (2) of page 15, lines 19 to 21, pointed out by the Appellant, indicates that a composition comprising soy protein extract without anti-glycation agent has only a negligible effect on the elasticity and firmness of the skin, **compared** to the results obtained with a composition comprising both. Quantifying relative results should not be confused with absolute values. Accordingly, it cannot be concluded from the passage of document (2) referred to by the Appellant that the soy protein extract used in the exemplified composition has a negligible effect on the elasticity and firmness of the skin. Furthermore, as opposed to the method of claim 1 of auxiliary request 4, which was considered by the Opposition Division to involve an inventive step, claim 1 of the patent as granted does not exclude the use of cosmetic compositions comprising an anti-glycation agent.

Therefore, the Appellant's arguments on inventive step based on lines 19 to 21 on page 15 of document (2) does not convince the Board with respect to claim 1 of the main request.

4. The Appellant furthermore argued that the skilled man would only have contemplated denatured soy milk, whereas claim 1 of the main request required that the soy milk must not be denatured.

However, in the light of document (2) no reason is apparent to the Board why the skilled person would have taken the supplemental step of denaturing the soy milk. On the contrary, document (2) rather motivates the skilled not to carry out the additional step of denaturing the milk, given that the anti-elastase inhibitory activity of the proteins present in the soy milk has to be preserved.

Hence, this argument of the appellant is also rejected.

5. Hence, the Board comes to the conclusion that claim 1 of the main request does not fulfil the requirement of Article 56 EPC.

Auxiliary request 1 to 3, admission

6. After the discussion on the main request, at the oral proceedings before the Board, as the Chairman was closing the debate asking the parties to confirm their requests, the Appellant further requested the maintenance of the patent on the basis of auxiliary requests 1 to 3, which were rejected by the Opposition Division in the impugned decision.

The Respondent requested that auxiliary requests 1 to 3 not be admitted into the appeal proceedings.

According to Article 12(2) of the RPBA, the statement setting out the grounds of appeal should contain the Appellant's complete case. Any amendment to a party's

case may only be admitted under the board's discretion (Article 13(1) RPBA).

The Appellant's statement of the ground of appeal does not include any argument regarding auxiliary requests 1 to 3. There is also no mention of these requests. On the contrary, it is clearly stated that "*if the Board is unable to grant the Main Request*", the patent should be maintained on the basis of the 4th auxiliary request, implying that at the time of filing the grounds of appeal the appellant no longer sought the maintenance of the patent on the basis of the auxiliary requests 1 to 3. The Board also notes that these request were not mentioned at the start of the oral proceedings either.

Hence, the Board finds that the re-introduction of the auxiliary requests 1 to 3 in the appeal proceedings represents an amendment to the Appellant's case in the sense of Article 13 RPBA. The respondent justly asserts that it is being caught by surprise by this reinstatement of requests, and that he cannot be expected to provide arguments on fresh issues arising therefrom. The same applies for the Board.

Reinstating these requests in the appeal proceedings at the oral proceedings before the Board would therefore have compelled the Board either to deal on the spot with the Appellant's hitherto unknown reasons why the decision under appeal to reject these requests were incorrect, or to adjourn the oral proceedings, which is clearly contrary to procedural economy. This latter would also be contrary to the explicit provisions of Article 13(3) RPBA, stipulating that amendments shall not be admitted if they raise issues that cannot

reasonably be expected to be dealt with without the adjournment of the oral proceedings.

The Board, therefore, decides not to admit these requests into the proceedings under Article 13(1) RPBA.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

P. Gryczka

Decision electronically authenticated