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**Datasheet for the decision
of 29 September 2016**

Case Number: T 1806/14 - 3.3.07

Application Number: 10151632.6

Publication Number: 2181693

IPC: A61K8/86, A61K8/22, A61K8/81,
A61K8/25, A61K8/90, A61Q11/00

Language of the proceedings: EN

Title of invention:

Non-aqueous liquid tooth whitening composition

Applicant:

Colgate-Palmolive Company

Headword:

Non-aqueous liquid tooth whitening composition/Colgate-
Palmolive Company

Relevant legal provisions:

EPC Art. 76(1), 111(1)

Keyword:

Claims combination extends beyond the disclosure of the parent
application (no)
Remittal to first instance

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 1806/14 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 29 September 2016

Appellant: Colgate-Palmolive Company
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 19 March 2014 refusing European patent application No. 10151632.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman J. Riolo
Members: D. Boulois
R. Winkelhofer

Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division to refuse European patent application n° 10 151 632.6. The decision was based on one set of claims filed with letter of 7 January 2014 as main request.

Claim 1 of the main request read as follows:

"1. A stable, non-aqueous liquid tooth whitening composition suitable for application to teeth in the oral cavity comprising an anhydrous peroxide compound dispersed in an orally acceptable anhydrous hydrophilic liquid polymer and a adhesion enhancing agent, wherein the composition is homogenous, the anhydrous peroxide compound is PVP/H₂O₂, the anhydrous hydrophilic liquid polymer is polyethylene glycol and the adhesion enhancing agent is a polyvinyl pyrrolidone/vinyl acetate copolymer, which composition when applied topically to tooth surfaces forms an adherent layer containing the peroxide compound which peroxide compound is thereafter released from the layer to effect tooth whitening."

- II. According to the decision under appeal, the main request did not meet the requirements of Article 76(1) EPC.

Compared with the earlier (parent) application as filed, the following additional features were present in claim 1:

- a) The composition was homogenous,
- b) The anhydrous hydrophilic polymer was a liquid polymer,
- c) The anhydrous peroxide compound was PVP/H₂O₂,
- d) The anhydrous hydrophilic polymer was polyethylene glycol (PEG),

e) The adhesion enhancing agent was a polyvinyl pyrrolidone/vinyl acetate copolymer (PVP/VA).

Although each of the original dependent claims 4, 6, 7 and 11 of the parent application contained the individual features b)-e) they only referred to claim 1 and thus could not be combined together. It was also not possible to deduce this combination of features from the examples.

- III. The applicant (hereafter called appellant) filed an appeal against the first instance decision. With the statement of grounds of appeal dated 25 July 2014, the appellant submitted a main request and auxiliary requests 1-4. Apart from the mere correction of spelling mistakes, claim 1 of the main request was identical to claim 1 of the main request discussed in the decision of the examining division.
- IV. A communication expressing the board's preliminary opinion was sent to the applicant. The only concern of the board related to the feature "wherein the composition is homogenous" in claim 1 of the main request. The preliminary opinion of the Board was positive as regards features b)-e) objected by the examining division in its decision.
- V. Oral proceedings before the board of appeal took place on 29 September 2016 in the absence of the appellant.
- VI. The appellant's written arguments can be summarised as follows:

The person skilled in the art would have seriously contemplated combining the features of dependent claims 4, 6, 7 and 11 of the parent application referring only

to claim 1 upon reading the application as a whole and particularly upon viewing examples I to M. The combination of these features was explicitly disclosed in said examples of the parent application. The requirements of Article 76(1) EPC were thus met.

VII. Request

Appellant requests that the decision under appeal be set aside and a patent be granted on the basis of the set of claim filed as main request or auxiliary requests 1-4 with the statement of grounds of appeal dated 25 July 2014.

Reasons for the Decision

1. Main request - Article 76(1) EPC

1.1 The subject-matter of claim 1 of the main request filed with the statement of grounds of appeal is identical on its substance to claim 1 of the main request also discussed before the examining division.

1.2 The subject-matter of claim 1 as filed of the parent application n° 04 780 974.4 read as follows:
"1. A stable, non-aqueous liquid tooth whitening composition suitable for application to a surface of a tooth in the oral cavity comprising **an anhydrous peroxide compound** dispersed in an orally acceptable **anhydrous hydrophilic polymer** and an **adhesion enhancing agent** which composition when applied topically to the tooth surface forms an adherent layer containing the peroxide compound, wherein said peroxide compound is thereafter released from the layer to effect tooth whitening."

As outlined by the examining division in its decision, the following additional features were incorporated in claim 1 of the main request compared with claim 1 as filed of the parent application:

- a) The composition was homogenous,
- b) The anhydrous hydrophilic polymer was a liquid polymer,
- c) The anhydrous peroxide compound was PVP/H₂O₂,
- d) The anhydrous hydrophilic polymer was polyethylene glycol (PEG),
- e) The adhesion enhancing agent was a polyvinyl pyrrolidone/vinyl acetate copolymer (PVP/VA).

A basis for the feature a) relating to the homogenous nature of the composition, namely the feature "wherein the composition is homogenous" can be found explicitly on page 9, lines 1-2 of the parent application 04 780 974.4. Said passage refers generally to the liquid composition of the invention.

As to the features relating to the **anhydrous peroxide compound, the anhydrous hydrophilic polymer** and the **adhesion enhancing agent**, namely features b)-e), a basis can be found respectively explicitly and specifically in dependent claims 6, 4, 7 and 11 of the parent application 04 780 974.4. Dependent claims 6, 4, and 11 were directly dependent from independent claim 1, while claim 7 depended from claim 2 or 6. All said features of dependent claims 6, 4, 7 and 11 constitute preferred embodiments relating to the claimed **anhydrous peroxide compound, anhydrous hydrophilic polymer** and **adhesion enhancing agent**. Their incorporation in claim 1 constitutes therefore a restriction to a specific preferred embodiment and under no circumstances a restriction to a combination of alternative embodiments or an individualisation to a subject-matter not

specifically disclosed in the parent application. The decision of the examining division on this point can thus not be followed.

As to the examining division's argument that this combination was also not deductible from the examples, this argument must fail, since the embodiments of examples I, K, L and M of the parent application and of the present application comprise all features b)-e), namely PVP/H₂O₂, a liquid PEG, and PVP/VA.

1.3 Thus, there is no infringement of the requirements of Article 76(1) EPC.

2. Remittal to the first instance

Although Article 111(1) EPC does not guarantee a party an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party should, whenever possible, be given the opportunity to said consideration by two instances of the important elements of the case. The essential function of an appeal proceedings is to consider whether the decision which has been issued by the first instance department is correct. Hence, a case is normally remitted if further criteria of patentability have not yet been examined and decided by the department of first instance. This is the situation here.

Hence, the Board considers it appropriate to remit the case to the examining division for further prosecution on the basis of the main request.

Order

For these reasons it is decided that:

1. The decision of the first instance is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the main request

The Registrar:

The Chairman:



S. Fabiani

J. Riolo

Decision electronically authenticated