

**Internal distribution code:**

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

**Datasheet for the decision  
of 26 March 2019**

**Case Number:** T 2297/16 - 3.3.01

**Application Number:** 10006974.9

**Publication Number:** 2311452

**IPC:** A61K31/401, A61K31/198,  
A61K31/7008, A61K31/405,  
A61K9/06, A61P17/04, A61P17/10,  
A61P31/10, A61K8/73, A61Q19/00,  
A61K8/60, A61K8/44, A61K8/49,  
A61Q3/00, A61Q5/02, A61Q19/02,  
A61Q19/08, A61K9/00, A61K45/06,  
A61K31/4045, A61Q5/00

**Language of the proceedings:** EN

**Title of invention:**

Topical composition comprising n-acetyl glucosamine

**Patent Proprietor:**

Yu, Ruey J.  
Van Scott, Eugene J.

**Opponent:**

The Procter & Gamble Company

**Relevant legal provisions:**

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

**Keyword:**

Divisional application - added subject-matter (no) - after amendment

Appeal decision - remittal to the department of first instance (yes)



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 2297/16 - 3.3.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.01**  
**of 26 March 2019**

**Appellant:**  
(Patent Proprietor 1)

Yu, Ruey J.  
655 Stump Road  
Chalfont, PA 18914 (US)

**Appellant:**  
(Patent Proprietor 2)

Van Scott, Eugene J.  
3 Hidden Lane  
Abington, PA 19001 (US)

**Representative:**

Grünecker Patent- und Rechtsanwälte  
PartG mbB  
Leopoldstraße 4  
80802 München (DE)

**Respondent:**  
(Opponent)

The Procter & Gamble Company  
One Procter & Gamble Plaza  
Cincinnati, Ohio 45202 (US)

**Representative:**

Gill Jennings & Every LLP  
The Broadgate Tower  
20 Primrose Street  
London EC2A 2ES (GB)

**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 26 July 2016  
revoking European patent No. 2311452 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**           A. Lindner  
**Members:**           R. Hauss  
                          P. de Heij

## Summary of Facts and Submissions

I. European patent No. 2 311 452 (the patent in suit) issued from European patent application No. 10 006 974.9, which is a divisional of European patent applications Nos. 00 902 347.4 (published as WO 00/40217), 04 029 094.2 and 09 001 844.1.

The root application No. 00 902 347.4 and all divisionals in that sequence were filed with the same description but with different sets of claims.

II. The patent in suit was granted with a set of five claims. Independent claim 1 reads as follows:

*"1. Use of a water-containing composition consisting of N-acetyl-glucosamine or an isomeric form thereof in a cosmetic formulation with water and a vehicle selected from a solution, cream, and lotion for topically alleviating or improving a cosmetic condition of the skin, wherein the cosmetic condition is selected from changes associated with aging of skin."*

III. The patent was opposed under Article 100(a), (b) and (c) EPC on the grounds that the claimed subject-matter lacked novelty and inventive step and was not patentable pursuant to Article 53(c) EPC, that it was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, and that it extended beyond the content of the earlier application No. 00 902 347.4 as filed.

IV. With a letter dated 3 May 2016, the patent proprietors submitted an amended main request and three auxiliary requests, thus requesting the maintenance of the patent in amended form.

V. In the course of the oral proceedings before the opposition division which took place on 4 July 2016, the patent proprietors submitted two new sets of claims as auxiliary requests 1 and 5. The former auxiliary requests 1, 2 and 3, still pursued, were re-numbered as auxiliary requests 2, 3 and 4, respectively.

VI. The **main request** consisted of the claims as granted (see point II above for the wording of claim 1) and an amended passage intended to replace paragraph [0013] of the description.

Independent claims 1 and 2 of **auxiliary request 1** read as follows:

*"1. Use of a water-containing composition consisting of N-acetyl-glucosamine or an isomeric form thereof in a cosmetic formulation with water and a vehicle selected from a solution for topically alleviating or improving a cosmetic condition of the skin, wherein the cosmetic condition is selected from changes associated with aging of skin."*

*2. Use of a water-containing composition consisting of N-acetyl-glucosamine or an isomeric form thereof in a cosmetic formulation with water and a vehicle selected from a cream and lotion for topically alleviating or improving a cosmetic condition of the skin, wherein the cosmetic condition is selected from changes associated with aging of skin."*

Claim 1 of **auxiliary request 2** reads as follows:

*"1. Use of a water-containing composition consisting of N-acetyl-glucosamine or an isomeric form thereof in a cosmetic formulation with water formulated as solution, cream or lotion for topically alleviating or improving a cosmetic condition of the skin, wherein the*

*cosmetic condition is selected from changes associated with aging of skin."*

Claim 1 of **auxiliary request 3** reads as follows:

*"1. Use of a water-containing composition consisting of N-acetyl-glucosamine in a cosmetic formulation with water and a vehicle selected from a solution, cream and lotion for topically alleviating or improving a cosmetic condition of the skin, wherein the cosmetic condition is selected from changes associated with aging of skin."*

Claim 1 of **auxiliary request 4** reads as follows:

*"1. Use of a water-containing composition consisting of N-acetyl-glucosamine in a cosmetic formulation with water formulated as solution, cream or lotion for topically alleviating or improving a cosmetic condition of the skin, wherein the cosmetic condition is selected from changes associated with aging of skin."*

Claim 1 of **auxiliary request 5** reads as follows:

*"1. Use of a water-containing composition consisting of N-acetyl-glucosamine or an isomeric form thereof in a cosmetic formulation with water and a vehicle selected from a cream for topically alleviating or improving a cosmetic condition of the skin, wherein the cosmetic condition is selected from changes associated with aging of skin."*

VII. The decision under appeal is the decision of the opposition division, announced on 4 July 2016 and posted on 26 July 2016, revoking the patent.

- VIII. In the decision under appeal, the opposition division ruled, after comparing the claimed subject-matter with the content of the root application (European patent application No. 00 902 347.4 as filed), that the claims as granted (main request) as well as the claims of auxiliary requests 1 to 5 contained added subject-matter, in contravention of Article 123(2) EPC *[sic]*.
- IX. The patent proprietors (appellants) lodged an appeal against that decision, their claim requests being identical to the sets of claims previously pending in the opposition proceedings as the main request and auxiliary requests 1 to 5.
- X. On 25 February 2019, in reply to a summons to oral proceedings dated 7 November 2018, the opponent (respondent) withdrew its request for oral proceedings and stated that it would not be represented at the oral proceedings.
- XI. Oral proceedings before the board were held on 26 March 2019 in the absence of the respondent, in accordance with Article 15(3) RPBA and Rule 115(2) EPC.
- XII. The respondent's arguments (as presented in writing) may be summarised as follows:
- Claim 1 of the main request was based on multiple selections from the application as filed. This concerned the following technical features:
- (i) Water-containing;
  - (ii) consisting of;
  - (iii) N-acetyl-glucosamine (NAG) or an isomeric form thereof;
  - (iv) the vehicle being limited to solution, cream and lotion;
  - (v) the cosmetic use.
- This objection was not overcome by the amendments made in the auxiliary requests.



XIII. The appellants' arguments may be summarised as follows:

The appellants referred to several passages of the description of the root application, *inter alia* to the formulation examples and to test result 4 on page 24, that, in their view, provided basis for the claimed subject-matter. The same arguments applied to the independent claims of auxiliary requests 1 to 5.

XIV. The appellants requested

- that the decision under appeal be set aside and that the case be remitted to the department of first instance for further examination on the basis of the highest-ranking request found to meet the requirements of Article 76(1) EPC; or, in the alternative,

- that the patent be maintained on the basis of the set of claims of

(a) the main request as filed on 3 May 2016,

or - in order of preference - on the basis of one of the sets of claims of

(b) auxiliary request 1 as filed on 4 July 2016 during oral proceedings before the opposition division;

(c) auxiliary request 2 as filed on 3 May 2016, renumbered on 4 July 2016;

(d) auxiliary request 3 as filed on 3 May 2016, renumbered on 4 July 2016,

(e) auxiliary request 4 as filed on 3 May 2016, renumbered on 4 July 2016,

(f) auxiliary request 5 as filed on 4 July 2016 during oral proceedings before the opposition division.

XV. The respondent requested that the appeal be dismissed or, in the alternative, that - should any of the sets of claims be found to meet the requirements of Articles 123(2), 123(3) and 76(1) EPC and of

Rule 80 EPC, the case be remitted to the opposition division for the discussion of sufficiency of disclosure, novelty and inventive step.

## **Reasons for the Decision**

### 1. Admissibility of the appeal

The appeal complies with Articles 106 to 108 EPC and Rule 99 EPC and is therefore admissible.

### 2. Main request - added subject-matter

#### 2.1 According to the notice of opposition, the respondent's objection under Article 100(c) EPC was that the subject-matter of the patent in suit extended beyond the content of the earlier application No. 00 902 347.4 (the root application) as filed. Thus, the objection related to non-compliance with Article 76(1), second sentence, EPC.

The issue of compliance with Article 123(2) EPC was addressed in the notice of opposition only by the rather general statement "All of the above-mentioned objections under Article 76(1) EPC are also applicable under Article 123(2) EPC", without consideration of the fact that the root application and the divisional application No. 10 006 974.9 had different claims.

According to the decision under appeal in the passages concerning the issue of added subject-matter, the claimed subject-matter was compared for support to the content of "the originally filed (parent) application", i.e. the root application (see points 3.1.1, 3.1.4 and 3.1.6 of the decision under appeal).

- 2.2 Hence, although the decision under appeal, the appellants' statement setting out the grounds of appeal and the reply of the respondent all incorrectly refer to the "requirements of Article 123(2) EPC", the issue of both the opposition proceedings and the appeal proceedings was in fact whether the claimed subject-matter met the requirements of Article 76(1) EPC, as it allegedly extended beyond the content of the root application as filed. The board will therefore assess the same issue.
- 2.3 Claim 1 of the main request relates to a specific cosmetic use of a water-containing composition consisting of N-acetyl glucosamine or an isomeric form thereof in a cosmetic formulation with water. The formulation vehicle may be selected from three alternative embodiments: a solution, a cream or a lotion.
- 2.4 The root application as filed relates to topical compositions containing N-acetyl aldosesamines, N-acetyl amino acids and/or related N-acetyl compounds and a suitable vehicle, useful for cosmetic or dermatological purposes (page 1, paragraph 1). The compositions may contain further topical agents (page 12, line 19 to page 16, line 2) and may be in any form suitable for use on skin, nails or hair, such as a solution, gel, lotion, cream, ointment, shampoo, spray, stick, powder or masque (page 16, lines 6 to 9).
- 2.4.1 The description of the root application from page 17 onwards, describing examples and test results, does not describe a formulation in the form of a lotion containing N-acetyl glucosamine or an isomeric form thereof.

- 2.4.2 In the remaining part of the description (page 1, line 1 to page 17, line 24), N-acetyl glucosamine is only mentioned twice, in lists including other possible choices for the mandatory N-acetyl compound (page 6, line 3 and page 7, lines 13 to 14). According to section 3 on pages 16 to 17, different kinds of vehicles may be selected and there is no statement to the effect that the presence of water is mandatory. While it is mentioned that a lotion may be prepared by first dissolving the N-acetyl compound "in water, ethanol, propylene glycol, diisopropyl adipate and/or another vehicle", it cannot be derived from that statement that a lotion as envisaged in the application is required to contain water.
- 2.4.3 The board therefore considers that the root application as filed does not contain a specific disclosure of a lotion containing water and N-acetyl glucosamine (or an isomeric form thereof).
- 2.5 For this reason at least, claim 1 of the main request does not meet the requirements of Article 76(1) EPC.
3. Auxiliary requests 1 to 4 - added subject-matter
- 3.1 The objection set out in points 2.4 and 2.5 above equally applies to claim 2 of auxiliary request 1 and claim 1 of each of auxiliary requests 2 to 4, all relating to a lotion containing water and N-acetyl-glucosamine or an isomeric form thereof.
- 3.2 As a consequence, the claims of auxiliary requests 1 to 4 do not meet the requirements of Article 76(1) EPC.

4. Auxiliary request 5 - added subject-matter

*Requirements of Article 76(1) EPC)*

- 4.1 The section relating to test results on page 24 of the description of the root application, in point 4: "Effect of N-acetyl-glucosamine on skin", discloses a 10% N-acetyl glucosamine cream. The board considers that it is universally accepted that a cream is a topical vehicle which, by definition, contains water. It can be inferred from this direct and unambiguous disclosure that a composition consisting of N-acetyl glucosamine and a cream base (including water) was specifically envisaged by the inventors (as also shown in formulation example 1 on page 17, line 26 to page 18, line 4 disclosing creams containing 1%, 5% and 10% N-Acetyl- $\alpha$ -D-glucosamine).
- 4.2 In addition to that combination of technical features, claim 1 of auxiliary request 5 defines "N-acetyl-glucosamine or an isomeric form thereof", does not specify a concentration and furthermore relates to the use of the composition for topically alleviating or improving a cosmetic condition of the skin selected from changes associated with aging of skin.
- 4.2.1 The description of the root application, on page 7, contains a general disclosure to the effect that N-acetyl aldoses may be present as isomeric form. This feature evidently applies to any N-acetyl aldose with isomeric forms, and therefore to N-acetyl glucosamine.
- 4.2.2 Furthermore, paragraph 1 on page 1 of the root application provides a general disclosure of the use of the contemplated compositions in alleviating or improving various cosmetic conditions and dermatological disorders including signs of aging and

changes or damage to skin, nail and hair associated with intrinsic aging and/or extrinsic aging. It is apparent that the use for topically alleviating or improving a cosmetic condition of the skin selected from changes associated with aging of skin is disclosed in combination with any embodiment of the application, including the N-acetyl glucosamine cream described on page 24 (and irrespective of whether the actual test results mentioned on page 24 relate to a cosmetic or dermatological use).

- 4.2.3 By not mentioning any particular concentration of N-acetyl glucosamine, claim 1 of auxiliary request 5 constitutes an intermediate generalisation with respect to the N-acetyl glucosamine cream described on page 24. In the present case, the board has no reason to believe, however, that the concentration of 10% N-acetyl glucosamine is closely associated with the other technical features or linked to a particular property of the cream composition. Thus it is acceptable that claim 1 is not restricted to a particular concentration, the stated use requiring, in any case, an effective concentration.
- 4.3 Dependent claims 2 to 4 relate to specific changes associated with the aging of skin. These are mentioned on page 4, line 27 to page 5, line 8 and page 11, line 29 to page 12, line 17 of the root application as filed in the context of improvement of skin conditions by topical application of, *inter alia*, N-acetyl aldosesamines such as N-acetyl-glucosamine.
- 4.4 For these reasons, the board considers that the claims of auxiliary request 5 do not contain added subject-matter extending beyond the content of the root application as filed.

4.5 Since the description of the further divisionals in the sequence (i.e. application Nos. 04 029 094.2 and 09 001 844.1 as filed) is identical to the description of the root application No. 00 902 347.4 (see point I above), the same conclusion applies with regard to added subject-matter in respect of these further divisionals.

4.6 For these reasons, the board arrives at the conclusion that the claims according to auxiliary request 5 meet the requirements of Article 76(1) EPC.

*Requirements of Article 123(2) EPC*

4.7 Since the description of application No. 10 006 974.9 as filed is identical to the description of the root application No. 00 902 347.4 (see point I above), the same considerations apply with regard to added subject-matter.

4.8 As a consequence, the board arrives at the conclusion that the requirements of Article 123(2) EPC are met.

5. Remittal of the case

Since both parties requested the remittal of the case to the opposition division for further prosecution, the board finds it appropriate to remit the case under Article 111(1) EPC.

## 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 for further prosecution on the basis of the set of claims of auxiliary request 5.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated