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**Datasheet for the decision
of 8 November 2018**

Case Number: T 1119/17 - 3.3.07
Application Number: 11808085.2
Publication Number: 2793805
IPC: A61K8/22, A61K8/81, A61K8/891,
A61Q11/00
Language of the proceedings: EN

Title of invention:
ORAL CARE WHITENING COMPOSITIONS

Applicant:
Colgate-Palmolive Company

Headword:
Dental surface adhesion enhancing agent/COLGATE-PALMOLIVE

Relevant legal provisions:
EPC Art. 123(2), 84, 83

Keyword:
Amendments - added subject-matter (no)
Claims - clarity after amendment (yes)
Sufficiency of disclosure - (yes)



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Case Number: T 1119/17 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 8 November 2018

Appellant: Colgate-Palmolive Company
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 5 December 2016
refusing European patent application No.
11808085.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman J. Riolo
Members: E. Duval
Y. Podbielski

Summary of Facts and Submissions

- I. The appeal of the applicant (appellant) lies from the decision of the examining division to refuse European patent application No.11808085.2.
- II. The decision was based on a main request and on an auxiliary request, both filed on 20 October 2016.

The invention defined in claim 1 of the main request related to:

"A non-aqueous oral care composition comprising:
a peroxide component comprising a peroxide source in the amount of about 0.01% to about 5% of the total weight of the composition; and
an adhesion system comprising:
 a hydrophobic component comprising a silicone adhesive; and
 a dental surface adhesion enhancing agent which comprises cross-linked polyvinylpyrrolidone which is not complexed with a peroxide source,
wherein the composition when applied to the teeth is sufficiently viscous to form an adherent, continuous layer on a dental surface and deliver an effective amount of said peroxide source to a tooth surface".

The following documents were cited in the decision:

D1: US 2008/0213730

D2: WO 2005/018593

D3: WO 2006/071677

The examining considered that neither the main request nor the auxiliary request complied with the

requirements of Article 123(2) EPC, and that in both requests the expression "dental surface adhesion enhancing agent" contravened the requirements of Articles 83 and 84 EPC.

III. In its statement setting out the grounds of appeal dated 13 April 2017, the appellant requested that the decision under appeal be set aside, that the compliance of the main request or, as an auxiliary measure, of the auxiliary requests 1-4, all filed with the grounds of appeal, with Articles 83, 84 and 123(2) EPC be confirmed, and that the case be remitted to the examining division to perform an additional search on the basis of said main request or auxiliary requests 1-4.

The following documents were submitted by the appellant with the statement setting out the grounds of appeal:

Annex I: google search results

D4: US 6,613,812

D5: US 2005/0036956 A1

D6: US 2005/0063923 A1

IV. In a communication pursuant to Article 15(1) RPBA issued on 24 October 2018, the Board expressed the view that the main request did not comply with the requirements of Article 123(2) EPC; this objection was however considered to be suitably addressed in auxiliary request 1. As to the requirements of Article 84 EPC, the Board shared the conclusions of the examining division and regarded the expression "dental surface adhesion enhancing agent" as unclear; this deficiency was here again suitably addressed, this time by an amendment carried out in auxiliary request 4.

V. By letter of 2 November 2018, the appellant filed an amended set of claims as the new main request and requested that the case be remitted to the examining division for further examination.

Claim 1 of the main request read as follows:

"A non-aqueous oral care composition comprising:
a peroxide component comprising
 a peroxide source in the amount of 0.01% to 5% of
 the total weight of the composition, wherein the
 peroxide source is complexed with cross-linked
 polyvinylpyrrolidone; and
an adhesion system comprising:
 a hydrophobic component comprising a silicone
 adhesive; and
 a dental surface adhesion enhancing agent, which
 consists of an additional amount of cross-linked
 polyvinylpyrrolidone which is not complexed with a
 peroxide source
wherein the composition when applied to the teeth is
sufficiently viscous to form an adherent, continuous
layer on a dental surface and deliver an effective
amount of said peroxide source to a tooth surface".

Reasons for the Decision

Main Request

1. Article 123(2) EPC
- 1.1 Claim 1 of the main request differs from claim 1 of the application as filed in that the following features are introduced:
 - (i) the peroxide source is complexed with cross-linked polyvinylpyrrolidone
 - (ii) the dental surface adhesion enhancing agent consists of an additional amount of cross-linked polyvinylpyrrolidone (hereinafter: cPVP) which is not complexed with a peroxide source.
- 1.2 Feature (i) finds basis in dependent claims 3 and 4, or alternatively paragraph [0022], of the application as filed. Feature (ii) finds basis in dependent claims 6 and 7, or alternatively paragraph [0023], of the application as filed, wherein additionally the expression "comprises" is replaced with the expression "consisting of".
- 1.3 Before concluding whether the amendments derive directly and unambiguously from the above passages of the application as filed, these passages must be properly interpreted, in particular regarding the statement "the dental surface adhesion enhancing agent comprises an additional amount of cross-linked polyvinylpyrrolidone" (emphasis added by the Board; cf. claim 6 or paragraph [0023]). The Board agrees with the appellant that the skilled reader would check for an antecedent basis for this "additional amount" of cPVP,

i.e. would determine what could be the "first amount". The Board also agrees with the appellant in that the skilled person would understand the first amount to be that of claim 4 or paragraph [0022], i.e. the cPVP complexed with the peroxide source. Contrary to the conclusions of the examining division, the mention of an "additional amount" of cPVP in paragraph [0023] cannot be read in isolation but rather establishes a connection with the mention of cPVP immediately before i.e. in paragraph [0022]. This interpretation is not contradicted by the exemplary composition (Formula I) of page 9, which indeed comprises [a first amount of] PVP-H₂O₂ complex and [an additional amount of] cPVP.

Thus the Board interprets paragraphs [0022]-[0023] such that the adhesion enhancing agent may comprise uncomplexed (cf. claim 7) cPVP in addition to the cPVP used to complex the peroxide source, and not such that the cPVP may be present in addition to an undefined adhesion enhancing agent.

- 1.4 Claim 1 thus incorporates both the features of paragraph [0022] (feature (i)) and of paragraph [0023] (feature (ii)) of the application as filed; these features are to be read, in the application as filed, in combination following the reasoning above.

Regarding feature (ii), the "dental surface adhesion enhancing agent" is furthermore now defined as consisting of (rather than merely comprising) said additional amount of uncomplexed cPVP. The Board regards the amendment of the expression "comprises" into "consists" as allowable in the present case, considering that (uncomplexed) cPVP is the only compound to be identified as an adhesion enhancing agent in the application as filed (cf. [0023]). This

limitation regarding the adhesion enhancing agent does not affect the possibility of the presence of other components (e.g. those of example 1, or the further materials of paragraph [0027]) in the composition of claim 1, since the composition generally remains defined using the open-ended expression "comprising".

Lastly, regarding feature (i), the restriction of the breadth of the peroxide component (to those complexed with cPVP) in the claimed openly defined composition may have the effect of *broadening the scope of protection*, since the upper limit of 5% does not apply to all peroxides anymore but only to those complexed with cPVP (as noted in the decision under appeal regarding the then pending auxiliary request 1). This, however, does not entail an *extension of subject-matter* under Article 123(2) EPC: the possibility for the peroxide source to be complexed with cPVP was disclosed, directly and unambiguously, in claim 4 as filed, such that no subject-matter is added in this respect.

1.5 Accordingly the main request satisfies the requirements of Article 123(2) EPC.

2. Article 84 EPC

2.1 Claims lack clarity if the exact distinctions which delimit the scope of protection cannot be learnt from them. In the context of the present oral care compositions, this entails that the public cannot be left in doubt as to which compositions are covered by the claim.

2.2 The examining division took the view that the expression "dental surface adhesion enhancing agent"

was unclear, since it had no generally accepted meaning. The Board shares this opinion and is not aware of any commonly accepted definition for the expression "dental surface adhesion enhancing agent". The evidence (D1-D3, D5, D6) submitted by the appellant, in an attempt to show that this expression is common in the field, is unconvincing, as it consists of patent publications stemming from the appellant himself or the same inventors and does not constitute proper evidence of the content of common general knowledge.

2.3 However, as a result of the amendment of the expression "comprises" into "consists of", the "dental surface adhesion enhancing agent" is now fully defined as consisting of uncomplexed cPVP. Consequently, the feature "dental surface adhesion enhancing agent" is not anymore relevant for defining the boundaries of the claim. In light of this limitation, the grounds for refusing the application for non compliance with the requirements of Article 84 EPC do not apply to the amended main request.

2.4 Accordingly the amendments carried out in the main request overcome the objection of lack of clarity raised in the decision under appeal.

3. Article 83 EPC

The examining division concluded that the claimed subject-matter was not sufficiently disclosed for the same reasons as those given for the lack of clarity: the skilled person, in the absence of guidance as to which compounds could be used as "dental surface adhesion enhancing agent", could not rework the claimed invention. The Board notes that the limitation of this

component as consisting of uncomplexed cPVP overcomes this objection.

Accordingly the criteria of Article 83 EPC are met.

Remittal to the department of first instance

4. For the present application, filed under the PCT, the EPO, acting as International Search Authority, issued a declaration of non-establishment of International Search report under Article 17(2)(a) PCT because of excessive non-compliance with the substantive provisions. The declaration indicated that a search may be carried out during examination before the EPO should the problems which led thereto be overcome.

The appellant requests that the decision under appeal be set aside and that the case be remitted to the examining division to perform an additional search on the basis of said main request.

Remittal is taken into consideration by the boards in cases where a first instance department issues a decision solely upon one particular issue which is decisive for the case against one party and leaves other essential issues outstanding. If, following appeal proceedings, this party's appeal on the particular issue is allowed, the case is normally remitted to the first instance department for consideration of the undecided issues.

In the present case, the Board allows the appellant's appeal based on the amended main request, since this request overcomes the objections under Articles 123(2), 83 and 84 EPC laid out in the decision under appeal. Accordingly the case should be remitted for further

examination. This should include that the examining division perform a search, as announced in the declaration under Article 17(2) (a) PCT.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairman:



S. Lichtenvort

J. Riolo

Decision electronically authenticated