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**Datasheet for the decision  
of 16 October 2020**

**Case Number:** T 1121/17 - 3.3.07

**Application Number:** 12809970.2

**Publication Number:** 2793807

**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:**  
Oral Care Whitening Compositions / COLGATE-PALMOLIVE

**Relevant legal provisions:**  
EPC Art. 123(2), 83, 84  
RPBA 2020 Art. 11

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

**Decisions cited:**

G 0002/10

**Catchword:**

The criteria set out in the Guidelines for Examination in the European Patent Office (November 2016 update) at paragraph H.IV.3.5, concerning the allowability of amendments under Article 123(3) EPC, are inappropriate for the assessment of compliance with Article 123(2) EPC (see point 1.5.1 of the reasons).



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Case Number: T 1121/17 - 3.3.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.07**  
**of 16 October 2020**

**Appellant:** Colgate-Palmolive Company  
(Applicant) 300 Park Avenue  
New York, NY 10022 (US)

**Representative:** Wibbelmann, Jobst  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 13 December  
2016 refusing European patent application No.  
12809970.2 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** A. Uselli  
**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 12809970.2 (hereinafter "the application").
- II. The decision was based on a main request and one auxiliary request, both filed by letter dated 12 October 2016.

The invention defined in claim 1 of the main request related essentially to a non-aqueous oral care composition comprising:

- a peroxide source in defined amounts; and
- an adhesion system comprising
  - a hydrophobic component and
  - a dental surface adhesion enhancing agent (hereinafter "enhancing agent") optionally comprising cross-linked polyvinylpyrrolidone (hereinafter "cPVP") which is not complexed with the peroxide source.

In claim 1 of the auxiliary request, the peroxide source was limited to a cPVP-hydrogen peroxide complex.

The following documents submitted by the appellant were cited in the decision:

D1: US 2008/0213730  
D2: WO 2005/018593  
D3: WO 2006/071677

- III. The examining division decided in particular as follows:

- (a) The main request did not comply with the requirements of Article 123(2) EPC because the application as filed did not disclose the possibility that cPVP be used on its own as the enhancing agent.

Furthermore, the expression "dental surface adhesion enhancing agent" used in the main request contravened the requirements of Articles 83 and 84 EPC.

- (b) Regarding the auxiliary request, as a consequence of the restriction of the breadth of the peroxide source component, the composition could contain other peroxide sources in amounts which were excluded from the claims as originally filed. The criteria of Article 123(2) EPC were thus not met.

The auxiliary request contravened the requirements of Articles 83 and 84 EPC for the same reasons as the main request.

IV. With its statement setting out the grounds of appeal, the appellant defended its case on the basis of a main request and auxiliary requests 1-6, all filed with said grounds of appeal.

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

- V. The Board set out its comments in a communication pursuant to Article 100(2) EPC dated 7 May 2020.
- VI. With its reply dated 7 September 2020, the appellant filed an amended main request and amended auxiliary requests 2-5.

Claim 1 of the main request read as follows:

"A non-aqueous oral care composition comprising:  
a peroxide source in the amount effective to deliver 0.01% to 5.5% of hydrogen peroxide by weight of the composition, wherein the peroxide source comprises a crosslinked polyvinylpyrrolidone-hydrogen peroxide complex; 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 hydrogen peroxide,

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."

- VII. The appellant's arguments can be summarised as follows:

(a) Regarding Article 123(2) EPC, paragraph [0023] of the original application (see also original PCT claim 3) disclosed that the peroxide source could be complexed with cPVP. The subsequent paragraph [0024] (and original PCT claims 4 and 5) disclosed that the enhancing agent comprised an additional amount of cPVP. When reading both paragraphs, it

would be apparent to a skilled person that the expression "additional amount" in paragraph [0024] (and original PCT claims 4 and 5) did not mean that there was an unspecified "additional component" comprised by the enhancing agent in addition to cPVP, but meant that a further amount of cPVP was used in addition to the amount which was complexed with the peroxide source.

A skilled person reading claim 4 or paragraph [0024] of the original application would check for the antecedent basis for this "additional amount", i.e. would determine what could be the "first amount". This "first amount" could be found in original PCT claim 3 and paragraph [0023] which defined that the peroxide source/hydrogen peroxide was complexed with cPVP. The expression "in some embodiments" used in both paragraphs [0023] and [0024] did not mean that these embodiments could not be combined. Rather, the term "additional amount" established a clear link between the two paragraphs. Furthermore, the back-reference in PCT claim 4 to "any foregoing claim", including original PCT claim 3, provided a direct link between these two embodiments.

Claim 1 additionally specified that the enhancing agent *consisted of* an additional amount of cPVP. Basis for this amendment could be found in Example 1, Formula I, which demonstrated that the enhancing agent was not required to comprise a further unspecified component. All components of Formula I could be allocated to the terms in the claims, leaving no doubt that uncomplexed cPVP represented the only enhancing agent in Formula I. It was also immediately evident to a skilled person that

Formula II did not contain an enhancing agent and actually represented a comparative example.

The feature that the peroxide source comprise a cPVP-hydrogen peroxide complex was disclosed in paragraphs [0023] and [0024] of the original application. This restriction of the breadth of components did not have the effect of broadening the scope of protection beyond the original application.

- (b) Regarding clarity, the expression "dental surface adhesion enhancing agent" was not an unclear result-to-be achieved type of definition of the compound, but a functional definition, which was different from the result which was achieved by the claimed subject-matter. The meaning of this expression was known in the art, and a straightforward search would have directly provided several patent documents with information on enhancing agents (see Annex 1 and documents D5, D6 and D1). The application provided an example of an enhancing agent, namely cPVP, and indicated (with reference to D4) a test for measuring adhesiveness of the enhancing agent. Lastly, claim 1 defined the overall adhesiveness of the composition.

VIII. 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 the main request filed on 7 September 2020, or, alternatively, on the basis of one of the auxiliary requests 1 (filed with the grounds of appeal), 2-5 (filed on 7 September 2020) and 6 (filed with the grounds of appeal) so that examination of the application can be continued.



## 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 amount of hydrogen peroxide delivered is specified to be by weight of the composition,
  - (ii) the peroxide source comprises a crosslinked polyvinylpyrrolidone-hydrogen peroxide complex, and
  - (iii) the 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 paragraph [0025] of the application as filed.
- 1.3 Regarding features (ii) and (iii), the application as filed discloses:
  - that the peroxide source may comprise a complex of hydrogen peroxide and cPVP (see paragraph [0023] and claim 3), and
  - that the enhancing agent may comprise "an additional amount" of cPVP which is not complexed with hydrogen peroxide (see paragraph [0024] or claims 4 and 5).

The Board agrees with the appellant that the skilled reader would check for an antecedent basis for this

"additional amount" of cPVP of paragraph [0024], i.e. would determine what could be the "first amount". The Board also agrees with the appellant that the skilled person would understand the first amount to be that of claim 3 or paragraph [0023], i.e. the cPVP complexed with the hydrogen peroxide. Contrary to the conclusions of the examining division, the mention of an "additional amount" of cPVP in paragraph [0024] cannot be read in isolation but rather establishes a connection with the mention of cPVP immediately before i.e. in paragraph [0023]. Accordingly, the Board does not interpret paragraphs [0023]-[0024] such that the uncomplexed cPVP may be present in addition to an undefined enhancing agent, but rather such that the uncomplexed cPVP may be present as enhancing agent in addition to the hydrogen peroxide complex of cPVP present as peroxide source.

Claim 1 incorporates both the features of paragraph [0023] (feature (ii)) and of paragraph [0024] (feature (iii)) of the application as filed. These features are to be read, in the application as filed, in combination following the reasoning above.

- 1.4 Regarding feature (iii), the "dental surface adhesion enhancing agent" is furthermore defined, in claim 1 of the main request, 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, for the following reasons. Firstly, (uncomplexed) cPVP is the only compound to be explicitly identified as an enhancing agent in the application as filed (see paragraph [0024]).

Furthermore, according to the examining division, examples I and II teach that other compounds must play the function of an enhancing agent; the examining division did not identify which other compounds it referred to. The Board does not share this view, and rather agrees with the appellant that example I teaches the use of cPVP as sole enhancing agent. In the application as filed, the function of each of the components in Formulation I of example 1 can be explained without speculating that one of these components other than cPVP must be an enhancing agent:

- both the silicone adhesive and the silicone fluid are part of the hydrophobic component in the adhesion system (see claims 1 and 12 of the application as filed),
- the PVP-H<sub>2</sub>O<sub>2</sub> complex is part of the peroxide source (see claim 3),
- the gelled mineral oil is part of the adhesion system (see claim 15 or paragraph [0055]), and
- there is no basis for supposing that the flavor and the commonly known sweetener sodium saccharin are used for any other purposes.

Consequently, the sole component of Formula I acting as enhancing agent is cPVP. As to Formula II, which contains the same components as Formula I except cPVP, the Board agrees with the appellant that it does not contain an enhancing agent and actually represents a comparative example, which is consistent with paragraph [0052].

Accordingly, the definition of the enhancing agent as consisting of uncomplexed cPVP does not add subject-matter.

1.5 Lastly, the examining division raised, with respect to the then pending auxiliary request, an objection under Article 123(2) EPC against the limitation of the nature of the peroxide source (i.e. feature (ii)).

1.5.1 The reasoning in the decision under appeal (see paragraph 2.2) starts with the following general considerations:

"A composition which is specified in a claim as comprising a component in an amount which is defined by a numerical range of values is subject to an implicit proviso excluding the presence of that component in an amount outside of that range. An amendment restricting the breadth of that component, for instance by narrowing down a generic class or a list of chemical compounds defining that component, has the consequence of limiting the scope of this implicit proviso. However, a composition which is defined as comprising the components indicated in the claim is open to the presence of any further components, unless otherwise specified. Therefore, in a claim directed to such an openly defined composition, the restriction of the breadth of a component present therein may have the effect of broadening the scope of protection of that claim,"

The above passage appears in the Guidelines for Examination in the European Patent Office (November 2016 update) at paragraph H.IV.3.5, which concerns the allowability of amendments under Article 123(3) EPC. In the appealed decision, the above passage is followed by:

"with the consequence that such amended claim contains subject-matter which extends beyond the content of the application as originally filed, contrary to the requirements of Article 123(2) EPC. Restricting the breadth of the component means that certain materials are no longer explicitly limited by the claim, and therefore can be present in amounts which were excluded from the claim as originally filed." (emphasis added)

The Board finds that the above criteria is inappropriate for the assessment of compliance with Article 123(2) EPC. The relevant question for the purposes of Article 123(2) EPC is whether the amendments remain within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, from the whole of the application as filed (according to the "gold standard" of G 2/10, OJ 2012, 376). An amendment having the effect of broadening the scope of protection of a claim as originally filed, for instance by generalising it so as to allow the presence of some materials in amounts which were originally excluded from the claim, does not infringe Article 123(2) EPC if the amended subject-matter derives directly and unambiguously from the application as filed as a whole.

- 1.5.2 In the case at hand, the examining division found that, as a result of the following amendment in claim 1 of the auxiliary request underlying the appealed decision:
- "a peroxide source in the amount effective to deliver 0.01% to 5.5% of hydrogen peroxide by weight of the composition; wherein the peroxide source is a crosslinked polyvinylpyrrolidone-hydrogen peroxide complex" (addition emphasized by the Board),

the range of 0.01% to 5.5% only limited the amount of cPVP-hydrogen peroxide while the claimed composition allowed for the presence of other peroxide sources in amounts which were excluded from the claim as originally filed.

However the above amendment resulted from the literal incorporation of dependent claim 3 into claim 1, and therefore did not present the skilled person with new technical information, irrespective of any alleged broadening of the scope of the claim.

In the present main request, claim 1 still contains the feature that the peroxide source be present in the amount effective to deliver 0.01% to 5.5% of hydrogen peroxide by weight of the composition. The additional feature that the peroxide source *comprises* a cPVP-hydrogen peroxide complex does not lead to a generalisation of the claim, because the range of 0.01% to 5.5% still applies to the peroxide source as a whole, and is in any case directly and unambiguously derivable from paragraph [0023] of the application as filed.

1.6 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 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. It follows from the above that the main request overcomes the grounds for the refusal, under Articles 123(2), 84 and 83 EPC, set out in the decision under appeal.

Article 11 RPBA 2020 provides that the Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. Such special reasons are apparent in the present case because the examining division has not taken an appealable decision on essential outstanding issues with respect to e.g. novelty and inventive step.

Additionally, no search report was established for the present application. Instead, the EPO, acting as International Search Authority under the PCT, issued a "Declaration of non-establishment of International Search Report" under Article 17(2)(a) PCT for reasons including those which eventually led to the refusal of the application. The declaration indicated that a search may be carried out during examination before the EPO should the problems which led thereto be overcome.

Under these circumstances, the Board considers it appropriate to accede to the appellant's request for remittal of the case to the examining division for further prosecution. Upon remittal, the examining



division may have to carry out a search, as indicated in this 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:



B. Atienza Vivancos

A. Uselli

Decision electronically authenticated