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**Datasheet for the decision
of 18 March 2019**

Case Number: T 2381/17 - 3.3.07

Application Number: 10195263.8

Publication Number: 2465581

IPC: A61Q7/00, A61K8/49

Language of the proceedings: EN

Title of invention:

Composition for promoting hair growth

Applicant:

Energenesis Biomedical Co., Ltd.

Headword:

Hair growth/ ENERGENSIS

Relevant legal provisions:

EPC Art. 56, 123(2)

Keyword:

Amendments - allowable (yes)
Inventive step - (yes)

Decisions cited:

G 0001/03, G 0001/16



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Case Number: T 2381/17 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 18 March 2019

Appellant: Energensis Biomedical Co., Ltd.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 7 June 2017
refusing European patent application No.
10195263.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman J. Riolo
Members: A. Usuelli
C. Schmidt

Summary of Facts and Submissions

- I. The appeal of the applicant lies from the decision of the examining division to refuse European patent application No.10195263.8. The decision was based on a main request filed during the oral proceedings held on 3 May 2017 and four auxiliary requests filed on 30 March 2017.

The independent claims of the main request read as follows:

"1. A non-therapeutic use of a composition for promoting hair growth in a human for applying to scalp or hair roots of said human, the composition comprising as the sole active ingredient effective on promoting hair growth an effective amount of adenine or salts of adenine."

"2. A method of promoting eyelash and eyebrow growth in a human, comprising applying a composition on the eyelash/eyebrow of said human, wherein the composition comprising as the sole active ingredient effective on promoting eyelash and eyebrow growth an effective amount of adenine or salts of adenine."

"8. A non-therapeutic use of a composition for preventing hair fall in a human for applying to scalp or hair roots of said human, the composition comprising as the sole active ingredient effective on preventing hair fall an effective amount of adenine or salts of adenine."

- II. The following documents were among those cited in the search report:

D1: WO 2008/028773
D6: DE 101 20 606
D9: WO 2008/132101
D10: US 2005/0000040

III. The examining division considered that the subject-matter of the main request differed from the disclosure of document D1 in that adenine was used as the sole active ingredient effective on promoting hair, eyelash and eyebrow growth. The hair growth compositions described in D1 contained ubiquinone and caffeine, a purine derivative. D1 also mentioned adenine as an alternative purine derivative. In the examining division's opinion, in view of the teaching of D1 the skilled person would have envisaged to test compositions containing adenine to verify whether they could be used to promote hair growth. Hence, the subject-matter of the main request was not inventive.

Auxiliary requests 1 and 4 lacked novelty over D1. Auxiliary requests 2 to 4 did not comply with Article 123(2) EPC.

IV. With the statement of grounds of appeal sent on 6 October 2017, the appellant resubmitted the main request rejected by the examining division and filed two auxiliary requests.

In its submissions on inventive step, it referred to the following document, not considered during the first instance proceedings:

E1: WO 2008/028772

V. In the statement setting out the grounds of appeal the appellant underlined that in the compositions disclosed

D1 the agent stimulating the hair growth was a combination of two substances, namely a biochinone and a purine derivative. In all the examples the purine derivative was caffeine. E1 indicated that the biochinone derivatives promoted hair growth. None of the documents on file suggested that adenine alone could be effective in stimulating hair growth. Hence, the main request complied with the requirements of Article 56 EPC.

VI. In a communication pursuant to Article 15(1) RPBA issued on 8 March 2019, the Board expressed the view that the main request complied with Articles 123(2) and 56 EPC. It further informed the appellant that the oral proceedings scheduled to take place on 3 June 2019 were cancelled.

VII. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the main request filed on 6 October 2017 or, in the alternative, on the basis of one of the two auxiliary requests filed on the same date. It also requested oral proceedings in case that this request could not be granted.

Reasons for the Decision

Main request

1. Article 123(2) EPC

1.1 Claim 1 derives from the incorporation in original claim 1 of the feature specifying that adenine is the sole active ingredient effective on promoting hair, and of the disclaimer "non-therapeutic use".

The first modification has a basis on page 6 (lines 13, 14 and 20-26) of the original application. The disclaimer "non-therapeutic use" complies with the Enlarged Board of Appeal's decisions G 1/03 (See Headnote 2.1) and G 1/16 (see Headnotes).

1.2 Corresponding amendments have been introduced also in the other independent claims, namely claims 2 and 8. The subject-matter of the dependent claims have a basis in the dependent claims as originally filed.

1.3 It follows that the main request meets the requirements of Article 123(2) EPC.

2. Inventive step

2.1 Closest prior art

2.1.1 Document D1 relates to cosmetic compositions that activate hair growth. In agreement with the examining division, the Board regards this document as the closest prior art for the assessment of inventive step. The compositions of D1 are characterised by the fact of comprising both a purine derivative (or purine itself) and a biochinone (see page 2, lines 7 to 14 or page 3, lines 5 to 8). Adenine is cited on page 4 as an example of purine derivative. The four compositions exemplified in D1 (see pages 53 and 54) contains caffeine as a purine derivative, and ubiquinone as the biochinone derivative.

2.1.2 The subject-matter of the main request differs from the disclosure of D1 in the use of adenine as the sole active agent to promote the growth of hair, eyelash and eyebrow.

2.2 Technical problem

2.2.1 The effectiveness of adenine-based compositions in promoting hair, eyelashes and eyebrow growth is demonstrated in the examples of the patent application (see in particular, Tables 1 to 4).

2.2.2 Hence, the technical problem underlying the invention can be seen in the provision of a method for promoting hair growth and eyelashes/eyebrow growth.

2.3 Obviousness

2.3.1 D1 does not teach that each of the two components that are necessarily present in the compositions disclosed therein (i.e. purine derivative and biochinone derivative) is active alone in promoting hair growth. In particular, there is no indication in D1 that adenine alone could be effective on promoting hair growth. In this respect, it is also to be noted that D1 does not disclose any single example of composition containing adenine.

2.3.2 Document E1 indicates that the biochinones are known to stimulate the synthesis of keratin in hair (see abstract). On the other hand, several documents cited in the search report suggest that adenine derivatives can be used in hair compositions for various purposes, such as regulating sebum secretion (D6, paragraph [0256]), imparting humidity resistance to straightened hair (D9, page 1, lines 27 to 30) or intensifying the natural hair color (D10, see abstract).

Thus, the Board agrees with the appellant that on the basis of this information the skilled person would infer that in the compositions of D1, the biochinone is

the agent responsible for stimulating the hair growth. In any case, he would find no teaching that adenine is active in stimulating hair growth.

2.4 Hence, the main request meets the requirements of Article 56 EPC.

3. This decision is taken without oral proceedings because the appellant's main request can be granted.

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 with the order to grant a patent on the basis of the main request filed on 6 October 2017 and a description to be adapted.

The Registrar:

The Chairman:



I. Aperribay

J. Riolo

Decision electronically authenticated