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Datasheet for the decision of 16 September 2019

Case Number: T 1537/18 - 3.3.07

Application Number: 11787628.4

Publication Number: 2629753

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Language of the proceedings: EN

Title of invention:
EXTRACTS OF MICROALGAE AND THEIR APPLICATION

Applicant:
Cutech S.R.L.

Headword:
Microalgae/CUTECH

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

Keyword:
Remittal to the department of first instance

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Case Number: T 1537/18 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 16 September 2019

Appellant: (Applicant)	Cutech S.R.L. Via San Marco, 9/M 35129 Padova (IT)
Representative:	Fabry, Bernd IP2 Patentanwalts GmbH Schlossstrasse 523-525 41238 Mönchengladbach (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 16 March 2018 refusing European patent application No. 11787628.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

I. The appeal lies from the decision of the examining division to refuse European patent application No. 11 787 628.4. The decision was based on a set of claims filed on 26 June 2017.

Independent claims 1 and 2 read as follows:

"1. An extract of *Monodus* sp. obtained by preforming a single solvent extraction, a two-step sequential extraction or a three-step sequential extraction consisting of the following steps:
(a) treating said microalgae
(a-1) in the single solvent extraction with a single solvent selected from the group con sisting of methanol, ethanol, ethyl acetate or water,
(a-2) in the two-step sequential extraction sequentially with two solvents ethyl acetate and ethanol or ethyl acetate and water, or
(a-3) in the three-step sequential extraction sequentially with three solvents ethyl acetate, ethanol and water,
(b) removing the dissolved extracts from the residues and
(c) recovering the pure extracts from the solvent."

"2. A process for obtaining an extract of *Monodus* sp. consisting of the following steps:
(a) bringing said microalgae in contact
(a-1) with a single solvent selected from the group consisting of methanol, ethanol, ethyl acetate or water,
(a-2) sequentially with two solvents ethyl acetate and ethanol or ethyl acetate and water or

(a-3) sequentially with three solvents ethyl acetate, ethanol and water
in an amount suitable to effect that the actives move into the solvent phase, optionally at elevated temperatures,
(b) removing the dissolved extract from the residue, and
(c) recovering the pure extract from the solvent."

II. The decision under appeal can be summarised as follows:

The expression "consisting of the following steps" in claims 1 and 2 did not comply with the requirements of Article 123(2) EPC since in the original application the expression "comprising" instead of "consisting" was used. Claims 4 to 16 did not incorporate the process steps which were included in the claims from which these claims were derived. Hence, claims 4 to 16 also contravened Article 123(2) EPC.

Claim 4 was not sufficiently disclosed since it was clear from the data disclosed in the description that a direct ethyl acetate extract of *Monodus* sp. was not effective in inhibiting melanogenesis (Article 83 EPC).

Claims 5,7,9,11,13 and 15 did not comply with the requirement of Article 84 EPC since they did not specify which extract was used in the treatments defined therein.

III. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of a main request filed with the statement setting out the grounds of appeal on 28 May 2018, or alternatively, on the basis of an auxiliary request filed on the same

date. Oral proceedings were requested as an auxiliary measure.

Claims 1 and 2 of the main request differed from claims 1 and 2 of the request forming the basis of the decision in that the feature "consisting of the following steps" was amended to "comprising the following steps".

Claims 4 to 10 of the main request related to different uses of extracts of *Monodus* sp.. These claims incorporated all the process steps for obtaining the extracts.

IV. On 13 August 2019 the Board issued a communication indicating that the main request complied with requirements of Articles 83, 84 and 123(2) EPC. It further stated that, under the condition that the appellant withdrew its request for oral proceedings, a decision to remit the case to the examining division could be taken in writing.

V. With letter dated 23 August 2019 the appellant withdrew its request for oral proceedings.

Reasons for the Decision

1. The appeal is admissible. It leads to the remittal of the case to the examining division for further prosecution.

Main request

2. In claims 1 and 2 the expression "consisting of the following steps", which was considered by the examining division to contravene the requirements of Article

123(2) EPC, has been replaced by the expression "comprising the following steps" thereby restoring the wording of claims 1 and 2 as originally filed.

The use claims 4 to 10 now include all the process steps for obtaining the *Monodus* sp. extracts.

These amendments render moot the objections raised by the examining division under Article 123(2) EPC, and the Board has no further objections on its side.

3. The objections under Article 84 EPC raised by the examining division are no longer relevant having regard to the amendments made by the appellant in claims 4 to 10. Indeed it is clear that the expression "use of an extract" relates to the extracts obtained by the process defined in these claims.

4. Claim 4 no longer covers the use of a direct ethyl acetate extract of *Monodus sp.* for inhibiting melanogenesis. Thus, the objection raised in point 9 of the decision has also been overcome. The Board therefore comes to the conclusion that the subject-matter of the main request complies with the requirements of Article 83 EPC.

Remittal

5. The main objective of the appeal proceeding is to review the decision of the first instance department. Hence, a case is normally remitted if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In the present case, the decision under appeal is limited to the assessment of the requirements of Articles 123(2), 84 and 83 EPC. Important requirements such as novelty and inventive step have not been considered yet.

6. Accordingly, the Board remits the case to the examining division for further prosecution on the basis of the main request.

7. Since the appellant withdraw its request for oral proceedings, this decision could be taken in writing.

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 J. Riolo

Decision electronically authenticated