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**Datasheet for the decision  
of 4 May 2021**

**Case Number:** T 1287/19 - 3.3.07

**Application Number:** 09792822.0

**Publication Number:** 2346475

**IPC:** A61K8/19, A61K8/24, A61K8/34,  
A61K8/42, A61K8/49, A61K8/55,  
A61Q11/00

**Language of the proceedings:** EN

**Title of invention:**

PERSONAL CARE COMPOSITIONS PROVIDING ENHANCED COOLING SENSATION

**Patent Proprietor:**

The Procter & Gamble Company

**Opponent:**

Colgate-Palmolive Company

**Headword:**

Personal Care Cooling Compositions / PROCTER & GAMBLE

**Relevant legal provisions:**

EPC R. 99(2)  
RPBA 2020 Art. 13(1)  
EPC Art. 84, 123(2)

**Keyword:**

Admissibility of appeal - (yes)

Late-filed request - circumstances of appeal case justify  
admittance (yes)

Claims - clarity - main request, auxiliary request 1 (no)

Amendments - added subject-matter - auxiliary request 2 (no)

Remittal - special reasons for remittal

**Decisions cited:**

T 1843/09, G 0001/03



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Case Number: T 1287/19 - 3.3.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.07**  
**of 4 May 2021**

**Appellant:** The Procter & Gamble Company  
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**Respondent:** Colgate-Palmolive Company  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 27 February  
2019 revoking European patent No. 2346475  
pursuant to Article 101(3)(b) EPC.**

**Composition of the Board:**

**Chairman** D. Boulois  
**Members:** E. Duval  
P. Schmitz

## **Summary of Facts and Submissions**

- I. European patent 2 346 475 (hereinafter "the patent") was granted on the basis of 9 claims.

Independent claims 1 and 6 of the patent related respectively to personal care compositions for oral care use comprising essentially:

- (a) a flavor composition comprising defined non-menthol coolant(s),
- (b) a calcium ion source selected from defined calcium salts (claim 1), or a calcium transport agent selected from defined compounds (claim 6), and
- (c) an orally-acceptable carrier.

- II. An opposition was filed against the patent on the grounds that its subject-matter lacked novelty and inventive step, it was not sufficiently disclosed and it extended beyond the content of the application as filed.

- III. The opposition division took the decision to revoke the patent. The decision was based on a main request filed on 28 January 2019.

In the appealed decision, reference was made among others to the following document:

D5: WO 2010/019729 A1

- IV. In particular, the opposition division decided that:

- (a) Claim 1 of the main request omitted the feature "in an amount sufficient to potentiate and/or modulate cooling and other sensory experience provided by

the non-menthol coolant(s)" of claim 5 of the application as filed. As a result, claim 1 of the main request did not comply with the provisions of Article 123(2) EPC.

Furthermore, the provisos introduced in claims 1 and 6 in view of D5, prior art under Article 54(3) EPC, did not meet the conditions for undisclosed disclaimers set out in G 1/03, did not address all the novelty pertinent issues in D5 and were neither clear nor concise.

(b) Neither auxiliary requests 1-13 filed on 28 January 2019, nor the three auxiliary requests filed during the oral proceedings before the opposition division, were admitted into the proceedings because they were not clearly allowable.

V. The patent proprietor (appellant) lodged an appeal against the decision of the opposition division.

With its statement setting out the grounds of appeal dated 9 July 2019, the appellant filed an amended main request and 11 auxiliary requests, as well as the additional documents A030-A036.

VI. Following the reply of the opponent (respondent) dated 15 November 2019, the appellant filed on 29 April 2020 a new main request and new auxiliary requests 1-23.

Claim 1 was identical in the main request and in auxiliary request 1, and read as follows:

"1. Personal care compositions for oral care use comprising

- (a) a flavor composition comprising one or more non-menthol coolant(s) selected from menthone glycerol acetal, N-(4-cyanomethylphenyl)-p-menthanecarboxamide and mixtures thereof,
  - (b) a calcium ion source selected from calcium halides, calcium nitrate, calcium nitrite, calcium phosphate, calcium pyrophosphate, calcium polyphosphate, calcium sulfate, calcium carbonate, calcium hypochlorite, calcium formate, calcium acetate, calcium citrate, calcium lactate, calcium maleate, calcium gluconate, calcium tartrate, calcium glycerophosphate, calcium butyrate, calcium isobutyrate, calcium oxalate, calcium peptide, calcium phosphopeptide, calcium oxides or calcium hydroxides, wherein the calcium ion source provides at least 10 ppm to 10,000 ppm  $\text{Ca}^{2+}$  ions by weight of the composition, and wherein the calcium to coolant ratio is at least 0.5 to 1, and
  - (c) an orally-acceptable carrier,
- with the proviso that the personal care composition is not a composition of any one of dentifrice IIIB of Example III of EP-A 2 313 070, dual phase dentifrice of IIIB with IIID, IIIE or IIIF of Example III of EP-A 2 313 070, or dentifrice IVJ of Example IV of EP-A 2 313 070."

Claim 1 of auxiliary request 2 read as follows:

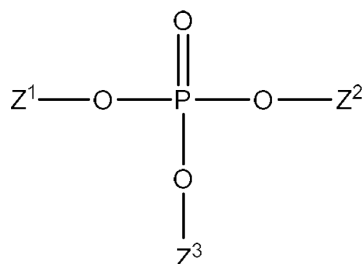
- "1. Personal care compositions for oral care use comprising
- (a) a flavor composition comprising one or more non-menthol coolant(s) selected from menthone glycerol acetal, N-(4-cyanomethylphenyl)-p-menthanecarboxamide and mixtures thereof,
  - (b) a calcium ion source selected from calcium nitrate, calcium nitrite, calcium phosphate, calcium pyrophosphate, calcium polyphosphate, calcium sulfate,

calcium hypochlorite, calcium formate, calcium acetate, calcium citrate, calcium lactate, calcium maleate, calcium gluconate, calcium tartrate, calcium glycerophosphate, calcium butyrate, calcium isobutyrate, calcium oxalate, calcium peptide, calcium phosphopeptide, calcium oxides or calcium hydroxides, wherein the calcium ion source provides at least 10 ppm to 10,000 ppm  $\text{Ca}^{2+}$  ions by weight of the composition, and wherein the calcium to coolant ratio is at least 0.5 to 1, and  
(c) an orally-acceptable carrier."

Claim 5 of auxiliary request 2 read as follows:

"5. Personal care compositions for oral care use comprising

- (a) a flavor composition comprising a menthanecarboxamide as a non-menthol coolant,
  - (b) a calcium transport agent selected from a phytate; an organic phosphate mono-, di- or tri-ester; a polycarboxylate; alkali metal, alkaline earth metal or ammonium salts thereof and mixtures thereof, at a level of at least 0.1 % by weight of the composition, wherein the polycarboxylate is a copolymer of maleic anhydride or acid and methyl vinyl ether, and
  - (c) an orally-acceptable carrier,
- wherein the organic phosphate mono-, di- or tri-ester is represented by the general structure



wherein Z1, Z2, or Z3 are identical or different, at least one being an organic moiety selected from linear

or branched, alkyl or alkenyl groups of from 6 to 22 carbon atoms."

Claim 6 of auxiliary request 2 read as follows:

"6. The personal care composition according to Claim 5, wherein the non-menthol coolant is N-(4-cyanomethylphenyl)-p-menthanecarboxamide."

- VII. The Board gave its preliminary opinion in a communication under Article 15(1) RPBA issued on 22 January 2021.
- VIII. By letter dated 22 March 2021, the appellant additionally filed auxiliary requests 24-29.
- IX. Oral proceedings were held before the Board on 4 May 2021.
- X. The appellant requested that the decision under appeal be set aside and that the patent be maintained in accordance with the main request filed on 29 April 2020, or, alternatively, on the basis of one of the auxiliary requests 1-23 filed on 29 April 2020, or auxiliary requests 24-39 filed on 22 March 2021.
- XI. The respondent requested that the appellant's appeal be rejected as inadmissible or, if the appeal was deemed admissible, that it be dismissed.

The respondent also requested that the main request and auxiliary requests 1-23 filed on 29 April 2020, as well as documents A030-A035, not be admitted into the proceedings.



XII. The appellant's arguments, as far as relevant to the present decision, can be summarised as follows:

(a) Admissibility of the appeal

The statement setting out the grounds of appeal provided reasons for setting aside the decision of the opposition division and thus complied with Rule 99(2) EPC. The respondent's objection rather pertained to admissibility of the individual requests. Accordingly, the appeal should be deemed admissible.

(b) Admittance of the requests filed on 29 April 2020

The new main request and new auxiliary requests 1-23 were filed on 29 April 2020 to address the further submissions of the respondent dated 15 November 2019. In particular, the features "in an amount sufficient to potentiate and/or modulate [...]" had been removed from claims 1 and 6 in reply to the respondent's objections of added subject-matter and under Articles 84 and 83 EPC. The requests before the opposition division did not contain these features, so that their absence was not a new issue. Further, the disclaimers of claim 1 had been reworded in the main request in direct response to the respondent's further objections.

(c) Main request and auxiliary request 1, clarity

The disclaimers were amended to reference the specific examples of D5, thereby simplifying the wording for clarity and conciseness (see T1843/09). The purpose of G1/03 was to make it possible to introduce undisclosed disclaimers, in order, as in the present case, to restore novelty by delimiting a claim against state of the art under Article 54(3) EPC. Here, the disclaimed

embodiments of D5 were characterised by clear technical features. The trade names for ingredients in the examples would be understood by the skilled person. In such a situation, it was necessary to take a pragmatic approach, including using the description of the prior art document, or other documents to guide interpretation, and common sense. Additionally, it was not seen how the examples could be clear enough to be novelty-destroying but not clear enough to be referred to in a disclaimer. Thus, the disclaimers were clear.

(d) Auxiliary request 2, Article 123(2) EPC

The deletion of the feature "in an amount sufficient to potentiate and/or modulate cooling and refreshing sensation provided by the non-menthol coolant(s)" from the claims did not provide new information content. This feature merely defined the effect of the inclusion of the calcium ion source in the composition and was superfluous, since the amount of  $\text{Ca}^{2+}$  ions was defined in claim 1. The further structural features, such as the concentrations of coolants, were preferred features which enhanced the effect. However the precise degree of cooling was not specified in the claims of application as filed, and thus, the removal of this feature did not add subject-matter.

Regarding claim 1, basis could be found on page 10 (lines 30-32) for the amount of calcium ion source. The deletion of calcium halides and carbonates amounted to a shortening of the list of calcium sources but not to a selection. The coolants MGA and G180 were disclosed as preferred on page 10 (lines 2-3 and table).

Regarding claim 5, the copolymer of maleic anhydride or acid and methyl vinyl ether was described as the

preferred polycarboxylate on pages 12 (lines 11-12) and 21 (line 32) of the application as filed, as well as the examples. The menthanecarboxamide coolant was mentioned on page 13 (line 6), and the calcium transport agent had been limited to the compounds of claim 10, which represented the preferred phytate / phosphate / polycarboxylate as confirmed on page 13 (lines 9-10). Lastly, the organic phosphate of claim 5 was derivable from page 24 (lines 6-15). Dependent claim 6 did not introduce any further selection since G180, shown in claim 8 as filed, was identified as preferred in the tables on pages 12-13 and in the examples.

Accordingly, the criteria of Article 123(2) EPC were met.

XIII. The respondent's arguments, as far as relevant to the present decision, can be summarised as follows:

(a) Admissibility of the appeal

For the question whether the appeal was admissible or not, the main request and eleven auxiliary requests filed with the grounds of appeal dated 9 July 2019 were the relevant requests. All of these requests were presented for the first time with these grounds of appeal. These requests included substantial amendments by way of addition of features taken from the description and by introduction of new disclaimers introducing new deficiencies, as compared to the requests underlying the decision, such that a new case had been built. Thus the patentee had not filed any admissible request with the appeal and therefore the appeal had to be rejected as inadmissible.

(b) Admittance of the requests filed on 29 April 2020

None of the 24 requests filed on 29 April 2020 corresponded to any request filed with the appeal or in the opposition proceedings. The requests were not convergent, thus violating procedural economy. Merely because the respondent had highlighted deficiencies in the requests filed with the appeal did not provide an excuse for the appellant to file new requests. Lastly, the individual requests were not *prima facie* allowable. Accordingly, none of the requests filed on 29 April 2020 was admissible.

(c) Main request and auxiliary request 1, clarity

The disclaimers had been drafted to exclude "dentifrice IIIB of Example III of EP-A 2 313 070 [...]" from the scope. Such an abbreviated disclaimer did not comply with the requirements of Article 84 EPC, as it did not enable the reader to ascertain what was covered by the claim and what not.

(d) Auxiliary request 2, Article 123(2) EPC

The deletion of the feature "in an amount sufficient to potentiate and/or modulate cooling and other sensory experience provided by the non-menthol coolant(s)" introduced inadmissible subject-matter, as decided by the opposition division.

Furthermore, claims 1, 5 and 6 of auxiliary request 2 resulted from multiple selections in the application as filed.

Thus claim 1 resulted from the deletion of calcium halide and carbonate, and from the selection of the

range 10-10000ppm and the recited non-menthol coolants. Claim 5 involved an intermediate generalisation of a specific polycarboxylate from page 12 (lines 11-12) of the application as filed, as well as the selection of the calcium transport agents from claim 6, and the selection of menthanecarboxamide which, on page 13 (line 6), was not disclosed in combination with a polycarboxylate, or alkali metal, alkaline earth metal or ammonium salts. Finally, the skilled person would have to select the specific organic phosphates now defined in claim 5 from the many (polymeric) phosphate esters defined on pages 23 to 25 of the application as filed. Claim 6 additionally specified a coolant which was not disclosed as preferred in the application as filed.

## **Reasons for the Decision**

1. Admissibility of the appeal
  - 1.1 With the statement setting out the grounds of appeal dated 9 July 2019, the appellant filed an amended main request and 11 auxiliary requests. These requests were later superseded by those filed on 29 April 2020.
  - 1.2 According to the respondent, none of the requests filed with the grounds of appeal correspond to a request on which a decision was taken by the opposition division. The requests filed with the grounds of appeal include substantial amendments such that a new case has been built. As a result, none of these requests is admissible, and the patentee failed to provide the reasons for setting out the decision impugned, as

required by Rule 99(2) EPC. Therefore the appeal should be rejected as inadmissible.

- 1.3 The Board does not share the respondent's opinion, for the following reasons.
  - 1.3.1 It is not an absolute requirement for admissibility that the appellant should attack the opposition division's decision as flawed. It is settled case law that the grounds for appeal can also be considered sufficient where they refer to new facts which deprive the decision of its legal basis (see T 252/95, T 760/08), particularly where new sets of claims are filed (see T 934/02, T 2226/13). In principle, appellants have two options when it comes to submitting their statement of grounds: they can attack the opposition division's decision as flawed, so that, provided they make a convincing case with respect to all reasons underlying the decision and the board accepts that case, it would be able and obliged to set the decision aside on all counts. Alternatively, they can file amended claims which they consider apt to remedy the deficiencies identified by the opposition division in the decision (see for more details the Case Law of the Boards of Appeal of the European Patent Office, 9th edition, 2019, V.A.2.6.5 c)).
  - 1.3.2 In the present case, the Board finds that the appeal is admissible. The statement setting out the grounds of appeal, and the main request and 11 auxiliary requests filed therewith, were clearly aimed at overcoming the reasons for rejecting the main request in the appealed decision, namely the missing feature and the deficiencies in the disclaimers introduced in view of D5. These new claim requests do not amount to building a fresh case. Thus there is a sufficiently direct link

between the decision under appeal and the statement of grounds of appeal.

- 1.4 Accordingly, the appeal is admissible.
2. Admittance of the main request and auxiliary requests 1-23 filed on 29 April 2020
  - 2.1 The main request and auxiliary requests 1-23 were submitted after the grounds of appeal were filed. They represent an amendment to the appellant's appeal case which, under Article 13(1) RPBA 2020, may be admitted only at the discretion of the Board.
  - 2.2 The Board sees the filing of at least the new main request and auxiliary requests 1-5 as a legitimate reaction to the new objections raised, in the respondent's reply to the appeal, against the requests filed with the grounds of appeal.

The opposition division found that the absence of the feature "in an amount sufficient to potentiate and/or modulate cooling and other sensory experience provided by the non-menthol coolant(s)" introduced added subject-matter. With its grounds of appeal, the appellant initially attempted to address this objection of added subject-matter by re-introducing this feature in all the requests. In its letter dated 15 November 2019, the respondent raised objections under Articles 123(2), 84 and 83 EPC against this feature. In reply, in all of the requests submitted by the appellant on 29 April 2020, the feature has been omitted. The filing of these new requests represents a legitimate reaction to the respondent's new objections. Since the requests on which the opposition took a decision also lacked this feature, its absence in the

requests filed on 29 April 2020 does not lead to the assessment of new issues but only to a review of this aspect of the appealed decision.

Likewise, the reworded disclaimers in the main request and auxiliary request 1 filed on 29 April 2020 are seen as a *bona fide* attempt to overcome the respondent's objections, and do not lead to additional procedural burden.

Accordingly the Board admits the main request and auxiliary requests 1-5 filed on 29 April 2020 into the proceedings.

3. Admittance of documents A030-A035

A030-A035 were filed by the appellant together with its grounds of appeal in support of its arguments regarding the wording of the disclaimers in the claims requests filed therewith. Following the rewording of the disclaimers in the requests filed on 29 April 2020, the appellant no longer relies on these documents. The issue of their admittance is therefore moot.

4. Main request and auxiliary request 1, clarity

4.1 In the course of the opposition and appeal proceedings, the appellant filed several requests in which disclaimers had been introduced into claim 1 excluding a number of compositions in order to establish novelty over D5, prior art under Article 54(3) EPC.

4.2 The disclaimer in claim 1 of the present main request has been reworded as follows:



"with the proviso that the personal care composition is not a composition of any one of dentifrice IIIB of Example III of EP-A 2 313 070, dual phase dentifrice of IIIB with IIID, IIIE or IIIF of Example III of EP-A 2 313 070, or dentifrice IVJ of Example IV of EP-A 2 313 070."

- 4.3 Thus the excluded compositions are defined by referring directly to EP-A 2 313 070, which corresponds to D5. The appellant considers it has thereby simplified the wording for clarity and conciseness, and refers to T 1843/09 (see the Case Law of the Boards of Appeal of the European Patent Office, 9th Edition, 2019, II.E. 1.7.3.b).

In T 1843/09, claim 1 of the main request comprised a disclaimer excluding embodiments defined by direct reference to specific parts of a document D15, prior art under Article 54(3) EPC. Although compliance with Article 84 EPC was not explicitly the subject of this decision, the competent Board found that the disclaimer clearly referred to a specific disclosure in D15 characterised unambiguously by a number of technical features (see point 3.2 of the reasons).

- 4.4 In the present case, the disclaimed embodiments of D5 are not unambiguously characterised by clear technical features. The presence of undefined components and trademarks in the examples of D5 was noted in the appealed decision (see e.g. paragraphs 4.1.6.5-4.1.6.7, or 7.2.2). The Board concurs with the opposition division in particular that the component of example IIIB denoted by the commercial name "Glass H polyphosphate" is not clearly defined. The presence of unspecified "other flavor agents" in the artificial

mint flavor of example III of D5 also renders these compositions unclear.

- 4.5 This lack of clarity in the compositions of the examples of D5 is incorporated into claim 1 of the main request because the disclaimer is drafted by direct reference to these examples. The Board adds that the appellant's choice to resort to disclaimers in order to address the issue of novelty over D5, and its difficulties in drafting these disclaimers appropriately, cannot justify an exception to the requirements of clarity or a pragmatic approach as suggested by the appellant.
- 4.6 The appellant questioned how the examples of D5 could be clear enough to be novelty-destroying but not clear enough to be referred to in a disclaimer. The Board sees no contradiction here. The lack of clarity in D5 noted above (see 4.4) does not concern the features of the composition specified in claim 1 of the main request, namely regarding the non-menthol coolant, the calcium ion source and the orally-acceptable carrier, but rather pertains to components and features of the compositions other than those specified by claim 1. Thus the conclusion that the compositions of D5 as a whole are unclearly defined is not in contradiction with the finding that these compositions unambiguously exhibit the features of claim 1.
- 4.7 Accordingly, the main request does not meet the requirements of clarity of Article 84 EPC. Since claim 1 of auxiliary request 1 is identical to claim 1 of the main request, auxiliary request 1 likewise contravenes Article 84 EPC.

5. Auxiliary request 2, Article 123(2) EPC
- 5.1 Independent claim 1 of auxiliary request 2 finds basis firstly in claim 6 of the application as filed. The question arises as to whether the deletion of the following functional feature of claim 6 as filed introduces added subject-matter.
  - 5.1.1 Claim 6 of the application as filed functionally defines the amount of calcium ion source and/or calcium transport agent to be "sufficient to potentiate and/or modulate cooling and refreshing sensation provided by the non-menthol coolant(s)". The Board agrees with the appellant that this feature merely requires that the amount of calcium ion source be such that it has a potentiating or modulating effect, but does not specify the degree of this potentiation of modulation.
  - 5.1.2 In claim 1 of auxiliary request 2, this functional definition of the amount of calcium is absent. However, the composition of claim 1 is defined in structural terms, not only by the nature of the non-menthol coolant(s) and of the calcium ion source, as well as the ratio of calcium to coolant, but also by an amount of calcium ion source which "provides at least 10 ppm to 10,000 ppm Ca<sup>2+</sup> ions by weight of the composition". This amount of calcium is disclosed on page 10, lines 30-32 of the application as filed, followed by "for potentiating activity". Consequently, the Board agrees with the appellant that these structural limitations of claim 1 of auxiliary request 2 make the above functional definition of the amount of calcium superfluous.
  - 5.1.3 The description as filed (see page 8, lines 23-30) mentions further structural features influencing the

extent of this potentiation effect, such as the concentration of the coolant(s) or their solubilization during use. These further features are not part of claim 1 of auxiliary request 2. However, this passage of the description does not give any reason to doubt the statement on page 10 that the claimed amount of calcium, in the context of the compositions of claim 1, would lead to a potentiating or modulating effect, irrespective of its degree.

5.1.4 If follows that the deletion of the feature "sufficient to potentiate and/or modulate cooling and refreshing sensation provided by the non-menthol coolant(s)" does not infringe Article 123(2) EPC.

5.2 Furthermore, the Board does not consider that auxiliary request 2 involves multiple selections.

5.2.1 In claim 1 of auxiliary request 2, the list of calcium ion sources derives from page 10 (lines 27-30), wherein calcium halides and calcium carbonate were deleted from the list. This deletion does not involve any selection but merely leads to a shrinking of the generic group of calcium ion sources. The calcium to coolant ratio derives from page 10, lines 17-18, and the feature that "the calcium ion source provides at least 10 ppm to 10,000 ppm  $\text{Ca}^{2+}$  ions by weight of the composition" derives, as indicated above (see 5.1), from page 10 (lines 30-32). The non-menthol coolant(s) recited in claim 1 of auxiliary requests 2, namely menthone glycerol acetal (MGA) and N-(4-cyanomethylphenyl)-p-menthanecarboxamide (G-180), are not only recited in claim 8 as filed but also presented as preferred on page 10 (lines 2-4). Accordingly, the combination of these features in claim 1 of auxiliary request 2 does not introduce added subject-matter.

5.2.2 Claim 5 of auxiliary request 2 finds basis in claim 6 of the application as filed. The definition of the flavor composition as comprising a menthanecarboxamide as non-menthol coolant finds basis in page 13 (line 6) of the application as filed, mentioning non-menthol coolant of the menthanecarboxamide type as preferred. This passage on page 13 is made in the context of phytate salts, phosphate salts or carboxylate compounds. In claim 5 of auxiliary requests 2, these phytate salts, phosphate salts or carboxylate compounds, and their amount, are in turn limited based on dependent claim 10 of the application as filed.

The limitation of the polycarboxylate to a copolymer of maleic anhydride or acid and methyl vinyl ether finds basis on page 21 (line 32). Lastly, page 24, lines 6-15, of the application as filed offers a basis for the structural definition for the organic phosphate mono-, di- or tri-ester as in present claim 5. These passages on pages 21 and 24 of the application as filed relate to tooth substantive agents, which are suitable as calcium ion carriers according to page 13, lines 9-11. Additionally, a preference for the copolymer of maleic anhydride or acid and methyl vinyl ether as polycarboxylate is derivable from page 12 (lines 11-12 and table 2) of the application as filed. As to the organic phosphate mono-, di- or tri-ester, the Board agrees with the respondent that its definition in present claim 5, where the at least one organic moiety in  $Z^1 / Z^2 / Z^3$  is unsubstituted, involves a selection from the many (polymeric) phosphate esters defined on pages 23 to 25 of the application as filed. However, the subject-matter of claim 5 is not defined by a combination of this selected calcium transport agent

with any further selection. Accordingly, no new subject-matter is created.

- 5.2.3 Finally, regarding dependent claim 6 of auxiliary request 2, the coolant N-(4-cyanomethylphenyl)-p-menthanecarboxamide (G-180) is disclosed as preferred in the application as filed in table 2 on pages 12-13 and in the examples, in addition to page 10 (lines 2-4).
- 5.3 In conclusion, auxiliary request 2 meets the requirements of Article 123(2) EPC.
6. Remittal to the opposition division

The Board thus finds auxiliary request 2 to comply with the requirements of Article 123(2). As to clarity, auxiliary request 2 does not contain the unclear disclaimers of the higher ranking requests, and the respondent did not raise any objection under Article 84 EPC against this request.

The question arises as to whether the case should be remitted to the opposition division for examination of the further essential issues. The appealed decision did not address the issues of novelty, inventive step or sufficiency of disclosure. The primary object of the appeal proceedings is however to review the decision under appeal in a judicial manner, as recalled in Article 12(2) RPBA 2020. In the Board's opinion, this represents special circumstances in the sense of Article 11 RPBA 2020 for remitting the case to the opposition division for further prosecution.

## 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.

The Registrar:

The Chairman:



B. Atienza Vivancos

D. Boulois

Decision electronically authenticated