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**Datasheet for the decision
of 22 May 2025**

Case Number: T 2052/22 - 3.3.10

Application Number: 16166619.3

Publication Number: 3085683

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A21D2/14, C09K3/18

Language of the proceedings: EN

Title of invention:

COMPOSITION COMPRISING AN EXTRACT AND BIO-DERIVED 1,3-
PROPANEDIOL AS NON IRRITATING SOLVENT

Patent Proprietor:

Primient Covation LLC

Opponent:

DSM Nutritional Products AG

Headword:

Relevant legal provisions:

EPC Art. 54(2), 76(1), 123(2)

RPBA 2020 Art. 13(1)

EPC R. 79(1), 132

Keyword:

Novelty - main request (no)

Divisional application - auxiliary request - added subject-matter (yes)

Amendment to appeal case - amendment overcomes issues raised (no) - amendment gives rise to new objections (yes)

Extension of time limit for replying to the notice of opposition - not relevant for the present appeal proceedings

Decisions cited:

T 0990/96, T 1085/13, T 2319/14, T 0041/16

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 2052/22 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 22 May 2025

Appellant: Primient Covation LLC
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 July 2022
revoking European patent No. 3085683 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: M. Kollmannsberger
T. Bokor

Summary of Facts and Submissions

- I. The patent proprietor appealed the Opposition Division's decision to revoke the patent pursuant to Article 101(3)(b) EPC.
- II. The patent relates to compositions comprising biologically derived 1,3-propanediol (in the following referred to as "PDO") and an extraction product, as well as a process for their preparation. The compositions are used as cosmetics or for personal care.
- III. The patent was opposed under Article 100(a) EPC for lack of novelty and inventive step and under Article 100(c) EPC for unallowable amendments. In opposition proceedings, the patent proprietor defended the patent in an amended form, a main request (MR) and twelve auxiliary requests (AR1 - AR12).
- IV. The Opposition Division concluded that the patent proprietor's main request as well as AR1 were not allowable because process claim 4 extended beyond the original disclosure, Articles 76(1) and 123(2) EPC. AR2 and ARs 6-9 were found not allowable because composition claim 1 lacked novelty over D4, Article 54 EPC. ARs 3-5 and 10-12 were found not allowable because a feature present in the independent use or composition claims was considered to extend beyond the original disclosure, Articles 76(1) and 123(2) EPC. Ultimately none of the requests was held allowable and the patent was revoked pursuant to Article 101(3)(b) EPC.

V. The following documents are referred to in the present decision:

D4: JP 05-221821

D4a: English translation of D4

D14: Notice from the EPO concerning the opposition procedure as from 1 July 2016, OJ 2016, A42

VI. Claim sets

The claims of the appellant's main request in appeal (MR) as well as of auxiliary requests 1-3 (AR1-AR3) were underlying the Opposition Division's decision. The claim of auxiliary request 4 (AR4) was amended with submission of 25 July 2023. All other requests were withdrawn later in the proceedings and need not be addressed in this decision.

The MR contains two independent claims, whereby the wording of process claim 4 is not relevant for the present decision. Independent claim 1 reads as follows:

Claim 1:

*"A composition comprising 1,3-propanediol and an extraction product, wherein:
the 1,3-propanediol is biologically-derived, has a purity level of less than 400 ppm total organic contaminants and has a concentration of peroxide of less than 10 ppm;
the extraction product is a natural extract; and
the natural extract is selected from the group consisting of botanical extracts, vegetal extracts, protein extracts, marine extracts, algae extracts and milk extracts."*

In auxiliary request 1 (AR1) claim 1 is unamended. There are amendments in the independent process claims which are not relevant for the present decision.

Auxiliary request 2 (AR2) contains only claim 1 as independent claim, the process claims are omitted.

The only independent claim of auxiliary request 3 (AR3) is a use claim and is worded as follows:

"Use of 1,3-propanediol in a composition comprising said 1,3-propanediol and an extraction product, wherein:

said 1,3-propanediol is biologically-derived and contains only renewable carbon and not fossil fuel based or petroleum based carbon, has a purity level of less than 400 ppm total organic contaminants and has a concentration of peroxide of less than 10 ppm; wherein said extraction product is a botanical, vegetal, protein/peptide, marine, algae or milk extract; and

wherein said 1,3-propanediol is employed as a chemical solvent for extraction or diluent of said extraction product."

Auxiliary request 4 (AR4) contains a single claim which is worded as follows:

"Use of a composition comprising 1,3-propanediol and an extraction product, wherein:

said 1,3-propanediol is biologically-derived and contains only renewable carbon and not fossil fuel based or petroleum based carbon, has a purity level of less than 400 ppm total organic contaminants and has a concentration of peroxide of less than 10 ppm:

wherein said extraction product is a botanical, vegetal, protein/peptide, marine, algae or milk extract;

wherein said 1,3-propanediol is employed as a chemical solvent for extraction or diluent of said extraction product, and

wherein the use of said composition is as a personal care or cosmetic composition for reducing skin irritation compared to compositions in which said 1,3-propanediol is replaced by-propylene glycol."

- VII. In its statement setting out the grounds of appeal and in the further course of the appeal proceedings the appellant submitted essentially the following:

The claims of all requests underlying the decision of the Opposition Division were novel over D4, in particular due to the impurity profile recited therein and due to the feature "biologically derived". The Opposition Division's novelty objection followed an incorrect application of the relevant case law.

The added matter objections under Article 76(1)/123(2) EPC were not justified.

The claims also defined inventive subject-matter, however, since the Opposition Division had not decided on inventive step, the case should be remitted to the Opposition Division for further prosecution.

- VIII. In its reply to the statement setting out the grounds of appeal and in the further course of the appeal proceedings the respondent (opponent) submitted essentially the following:

The composition claims were not novel over D4. Neither the impurity profile, nor the feature "biologically derived" could distinguish the claims from the compositions disclosed in D4.

The process and use claims extended beyond the original disclosure, contrary to Article 76(1)/123(2) EPC.

Auxiliary request 4 was late filed and should not be admitted into appeal proceedings.

During opposition proceedings the Opposition Division wrongly granted an extension of the time limit for the patent proprietor to reply to the notice of opposition. The Board should clarify how the Notice from the EPO concerning opposition proceedings (D14) is to be applied by the Opposition Divisions, but there is no formal request for the Board to establish whether a substantial procedural violation has occurred.

- IX. In a communication pursuant to Article 15(1) RPBA the Board informed the parties about the issues to be discussed at oral proceedings and its preliminary opinion that the appeal was likely to be dismissed.
- X. Oral proceedings took place on 22 May 2025.
- XI. The parties final requests requiring the Board's decision were the following:

The appellant requested to set aside the appealed decision and to maintain the patent on the basis of its main request, or on the basis of any of the auxiliary requests 1 to 4. The main request and auxiliary requests 1-3 were underlying the appealed decision, while AR4 was amended with submission of 25 July 2023.

The respondent requested the appeal to be dismissed. They furthermore requested that the newly filed auxiliary request 4 not be admitted to appeal proceedings. Furthermore, the respondent requested the Board to address the Opposition Division's incorrect handling of the request for extension of the time limit for the proprietor to reply to the notice of opposition.

XII. The decision was announced at the end of the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

The appellant's main request (MR)

2. Novelty over D4 (Article 54(2) EPC)

2.1 Claim 1 requires *a composition comprising 1,3-propanediol and an extraction product, wherein the 1,3-propanediol is biologically-derived, has a purity level of less than 400 ppm total organic contaminants and has a concentration of peroxide of less than 10 ppm.*

2.2 D4 discloses a composition comprising PDO and olive oil, see paragraph [0020] (the references are to the translated version D4a). It was undisputed that olive oil is an extraction product according to the claim. The novelty discussion focused on the two possibly distinguishing features underlined above, namely (i) the concentration limits for "*total organic contaminants*" and "*peroxide*", and (ii) the PDO being "*biologically-derived*".

2.3 Concentration limits

- 2.3.1 The Opposition Division held that this feature could not provide novelty since, following decision T 0990/96, the disclosure of a low-molecular compound made the compound available in all degrees of purity.

In the Board's view, this reasoning does not stand up to scrutiny. Firstly, the cited case law refers to claims directed to a single compound, and not to claims defining a composition. Secondly, as submitted by the appellant, the cited case law has been superseded in the meanwhile by the conclusions made in T 1085/13.

- 2.3.2 Nevertheless, novelty of the claim over D4 cannot be based on the concentration limits. The concentration limits are not, in fact, truly limiting features of the claimed composition, for the reasons set out below.

The claim defines a composition in an open form ("*comprising*"). Maximum concentration limits for impurities present (or not) in only one of the ingredients, the PDO, do not translate into technical features of the claimed composition. The present claim covers compositions containing *less than* 400 ppm of "*total organic contaminants*" and *less than* 10 ppm of peroxide, e. g. in case the extract or other optional ingredients do not add any of these components. However, the claim also covers compositions containing *more than* 400 ppm of "*total organic contaminants*" and *more than* 10 ppm of peroxide because these components may be introduced as by-product of the extract or of any other ingredient or even expressly added.

Thus, for the claimed composition as a whole these concentration features are meaningless. They do not effectively limit the claimed composition at all.

2.3.3 The appellant stated that D4 is silent as to the content of the impurities defined in the claim, either as a part of the individual components or finally in the overall compositions. This is indeed the case; it is not known whether the PDO used in D4 complies with the impurity profile defined in the claim, and it is also not known whether and how much of these impurities are present in the composition disclosed in paragraph [0020] of D4. However, this does not render the claim novel over D4, since the claim covers both compositions that adhere to the concentration limits of the impurities as well as compositions that do not. The compositions defined in the claim are indistinguishable from the cited composition in D4, no matter whether and in which concentrations the latter contains the impurities defined in the claim.

2.3.4 The appellant argued that such an analysis was fundamentally flawed. In the appellant's view the Board's analysis compared apples with pears since a comparison between the claim and D4 would have to be made on the basis of disclosed features, and not on the basis of undisclosed features like the possible impurity content in D4. The appellant compared the situation with a comparison when assessing comparative tests in the course of an inventive step analysis. They referred to decisions T 2319/14 and T 0041/16, which made it clear that in such a situation, a proper comparison had to be made between compositions only differing in the distinguishing feature of the claim, while leaving the other ingredients constant. Such a comparison, when applied to the present case, would

have to conclude that the present claim is novel over D4 based on the concentrations of the impurities, which were simply not disclosed in D4.

This argument is unconvincing. When analysing comparative experiments in order to establish whether an additional feature of a claim (e. g. an ingredient in a composition) results in a certain technical effect, it is correct that like must be compared with like. Only the distinguishing feature of the claim versus the prior art should make the difference between two compositions to be compared. However, the prerequisite for such an analysis is that there actually exists a feature of the claim which distinguishes any claimed composition from the prior art compositions, i. e. that the claim is novel over the prior art due to this feature. In the present situation, however, there is no distinguishing feature of the claim versus the prior art, since the feature relied on by the appellant is not a feature of the claimed composition, but only of an ingredient to the composition. In a physical composition falling under the claim this feature is not retrievable anymore and for this reason the skilled person cannot distinguish the claimed composition from the composition disclosed in D4. It may be possible to distinguish specific compositions inside the claim from specific compositions disclosed in D4, but there is no feature shared by all claimed compositions that would distinguish them from the compositions in D4.

2.4 *"Biologically-derived"*

- 2.4.1 The PDO used in D4 may be obtained chemically or by fermentation from glycerin, see paragraph [0005]. Glycerin may be obtained from biological or from

petrochemical sources. The disputed issue is whether PDO obtained by fermentation from glycerin, as disclosed in D4, is "*biologically-derived*" as required by the claim already by virtue of it being produced via a biological (as opposed to a chemical) process, or whether the feature "*biologically-derived*" requires that the PDO is obtained from biological sources altogether. In the latter case the glycerin would have to be obtained from animals or plants and its carbon atoms would have to reflect the atmospheric distribution of carbon isotopes, in particular with respect to ^{14}C . The latter scenario is not directly and unambiguously disclosed in D4.

- 2.4.2 The Opposition Division referred to paragraph [0045] of the patent, in particular to the first sentence of this paragraph, and interpreted the definition "*biologically-derived*" as being directed to the preparation process only, not requiring a specific type of starting glycerin. Since the PDO in D4 may be obtained by a fermentation process from glycerin it considered the feature to be disclosed in D4.
- 2.4.3 The appellant submitted that the description defined "*biologically-derived*" and various similar expressions used as synonyms in paragraphs [0045] to [0047] of the patent. The claim required the carbon atoms of the PDO to be essentially extracted from the atmosphere, by means of plant photosynthesis. The Opposition Division had stopped at the first sentence of paragraph [0045]. This passage continued to define that "*biologically derived*" compounds are composed of carbon from atmospheric carbon dioxide. This meant that the distribution of ^{14}C carbon atoms of the PDO needed to correspond to the distribution found in the atmosphere, and this feature of the claim was not found in D4.

2.4.4 The respondent pointed to paragraphs [0045], [0046] and [0058] of the description of the patent which, in its view, gave contradictory definitions of the term "biologically derived". The most general description was given in paragraph [0058] and it was not appropriate to read anything more into the claim as what was stated there.

2.4.5 The patent contains a section on the biologically derived PDO, paragraphs [0058] to [0072]. Paragraph [0058] states: "*Biologically derived means that the 1,3-propanediol is synthesized by one or more species or strains of living organisms, including particularly strains of bacteria, yeast, fungus or other microbes.*"

While the description of the patent at other places does indeed state that "biologically derived" compounds contain carbon from the atmosphere (paragraphs [0045], [0067]), this is not the only possible interpretation of this claim feature derivable from the description.

2.4.6 Therefore, in the Board's view the term "biologically derived" in the claims is not restricted to compounds having an atmospheric carbon isotope distribution, but covers also compounds obtained via a biological process, as opposed to a chemical one.

2.4.7 Since the PDO in D4 may be produced by biological means, i. e. by fermentation from glycerin, see paragraph [0005], the feature "biologically derived" does not establish novelty over D4 either.

2.5 Thus, the Board concludes that claim 1 of the appellant's main request lacks novelty over D4.

Auxiliary requests 1 and 2

3. Claim 1 of AR1 and AR2 is the same as claim 1 of the main request. Thus, these requests are equally not allowable for lack of novelty.

Auxiliary request 3 (AR3)

4. Unallowable amendments, Article 76(1)/123(2) EPC

- 4.1 Claim 1 of AR3 is a use claim. The use is defined in the following way:

"Use of 1,3-propanediol in a composition comprising said 1,3-propanediol and an extraction product, wherein [definition of the 1,3-PDO and the extraction product, omitted] wherein said 1,3-propanediol is employed as a chemical solvent for extraction or diluent of said extraction product"

- 4.2 The Opposition Division concluded that this claim did not comply with the provisions of Articles 76(1)/123(2) EPC due to the definition of the 1,3-PDO as containing only renewable carbon atoms. The respondent raised various other objections under Articles 76(1)/123(2) EPC and also argued that the claim extended the protection with respect to the granted patent, Article 123(3) EPC.
- 4.3 The parent application as filed does not contain any use claim. Thus, the claimed use would have to be disclosed in the description of the parent application.
- 4.4 The appellant pointed to paragraph [0052]. This passage discloses that PDO is *is employed as a chemical solvent*

for extraction or diluent of said extraction product,
the same wording that is used in the claim.

- 4.5 However, the claim is not drafted as an extraction process or as the use of 1,3-PDO for extracting a product. The claim is directed to the *use* of one ingredient *in a composition* comprising two ingredients. Apart from not being entirely clear what this actually means, such a use is not disclosed in paragraph [0052] of the parent application as filed.
- 4.6 Thus, auxiliary request 3 is not allowable already for this reason alone. The other objections raised by the respondent need not be decided upon.

Auxiliary request 4 (AR4)

5. Admittance (Article 13(1) RPBA)
- 5.1 Auxiliary request 4 was filed on 26 July 2023, as a reply to the respondent's reply to the appellant's statement setting out the grounds of appeal. The admittance of this request into the proceedings is thus governed by Article 13(1) RBPA.
- 5.2 An amendment of a parties appeal case under Article 13(1) RPBA is at the discretion of the Board. Regarding amendments to the patent, one criteria mentioned in this Article for the exercise of the discretion is whether it has been demonstrated that any such amendment, *prima facie*, overcomes the issues raised by another party or by the Board and does not give rise to new objections.
- 5.3 The claim of AR4 defines a "*use of a composition comprising 1,3-propanediol and an extraction product,*

wherein (...) said 1,3-propanediol is employed as a chemical solvent for extraction or diluent of said extraction product, and wherein the use of said composition is as a personal care or cosmetic composition for reducing skin irritation compared to compositions in which said 1,3-propanediol is replaced by propylene glycol.

- 5.4 In the Board's view it is immediately apparent that this request does not overcome the problem under Articles 76(1)/123(2) EPC present in AR3. It is likewise *prima facie* apparent that the amendments carried out with respect to the granted claims result in an unclear wording of this claim contrary to Article 84 EPC, and this lack of clarity resulting from an amendment during opposition is objectionable (G 3/14). The claim defines the use of a composition as a cosmetics "*for reducing skin irritation*" compared to other compositions. It is unclear which use is defined by this wording, in particular what the reference to other compositions is intended to define. It may even appear that the claim defines a therapeutic use of a composition ("*for reducing skin irritation*") excluded from patent protection under Article 53(c) EPC.
- 5.5 Thus, this request raises more problems than it solves and, already for this reason alone, it is not admitted into appeal proceedings under Article 13(1) RPBA.
6. In summary, there is no allowable request on file based on which the patent could be maintained under Article 101(3)(a) EPC. The Opposition Division's decision to revoke the patent under Article 101(3)(b) EPC is thus confirmed.
7. Extension of a time limit during opposition proceedings

The respondent requested the Board to decide on whether the Opposition Division rightly granted the extension of the time limit for the patent proprietor for replying to the notice of opposition. The aim of this request appears to be a clarification of the application of the provisions of Rule 132 EPC to the time limit under Rule 79(1) EPC, and in particular a clarification of the corresponding Notice from the EPO concerning opposition proceedings as from 1 July 2016 (D14). The respondent also sought clarification on whether the decision on the grant of the extension of this time limit may be delegated from an Opposition Division to a formalities officer, see point 10.1.3 of the respondent's reply to the appellant's grounds of appeal.

The Board fails to see the relevance of this question for the present appeal proceedings and therefore finds it inappropriate to address this issue. The procedure before the Opposition Division is closed. The Opposition Division issued a decision on the merits of the case and revoked the patent. Even assuming that the time limit was unduly extended, this circumstance did not appear to affect the substantive outcome of the opposition proceedings or the issues to be decided in the present appeal proceedings. The division took the submissions of the patent proprietor in its decision into account and nevertheless revoked the patent. There is no legal basis to retroactively remove the submissions from the proceedings (CLBA 10th Edition 2022, V.A.3.4.4).

Thus, the Board does not need to decide this question.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated