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D E C I S I O N
of 18 September 2002

Case Number: T 0871/97 - 3.3.7

Application Number: 89111576.8

Publication Number: 0345821

IPC: A61K 7/18

Language of the proceedings: EN

Title of invention:

Oral compositions

Applicant:

THE PROCTER & GAMBLE COMPANY

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 76(1)

Keyword:

"Subject-matter extending beyond the content of the earlier application as filed (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0871/97 - 3.3.7

D E C I S I O N
of the Technical Board of Appeal 3.3.7
of 18 September 2002

Appellant: THE PROCTER & GAMBLE COMPANY
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Cincinnati
Ohio 45202 (US)

Representative: O'Connell, Maura
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Dublin 4 (IR)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 22 November 1996
refusing European patent application
No. 89 111 576.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. E. Teschemacher
Members: B. J. M. Struif
B. L. ter Laan

Summary of Facts and Submissions

I. European patent application 89 111 576.8 filed on 14 June 1983 and published as EP-A-0 345 821 on 13 December 1989, is a divisional application from earlier patent application 88 103 996.0 (hereafter referred to as "parent application II") published as EP-A-0 279 213 on 4 January 1989. Parent application II again is a divisional application of the earlier application 83 303 417.6 (hereafter referred to as "parent application I"), published as EP-A-0 097 476 on 4 January 1984.

II. The appeal lies against the decision of the examining division to refuse the application in suit on the basis of six claims as the sole request in view of *inter alia* the following documents:

D1: US-A-3 934 002

D2: US-A-2 811 097

Claim 1 reads as follows:

"An oral anti-calculus composition in the form of a toothpaste comprising:

a) from 10% to 70% of a dental abrasive selected from precipitated silica and silica gels;

b) an amount of a fluoride source sufficient to supply from 50 ppm to 3500 ppm of fluoride ions;

c) an amount of a soluble pyrophosphate salt sufficient to provide in composition at least 1.5% by weight $P_2O_7^{-4}$

selected from mixtures of disodium diacid pyrophosphate with either or both of tetrasodium pyrophosphate and tetrapotassium pyrophosphate and wherein the levels of the pyrophosphate species (on an unhydrated basis) are from 0.5 to 13.8% by weight disodium diacid pyrophosphate, from 0% to 6% by weight of tetrasodium pyrophosphate and from 0% to 4% by weight tetrapotassium pyrophosphate; and

d) water;

wherein the pH of the composition is from 6.0 to 10.0".

Claims 2 to 6 are dependent on claim 1.

The decision was based on the following reasons:

- (a) The sole request was considered to meet the requirements of Articles 123(2) and 76(1) EPC.
- (b) The claims were considered to be novel.
- (c) As to inventive step, D1 was considered to be the closest prior art document. As claim 1 differed from D1 only by the selected abrasive, the technical problem to be solved was to provide an alternative oral care composition similar to that of D1.

There was no evidence on file that the selected silica possessed any particular anti-calculus effect or that it was critical to select the particular mixture of pyrophosphates in order to allow the presence of free fluoride and/or the particular abrasive in the oral care composition

having the claimed pyrophosphate ion concentration.

III. On 20 January 1997, a notice of appeal against the above decision was filed, the prescribed fee being paid on the same day. In the statement of grounds of appeal, filed on 21 March 1997, the appellant (applicant) argued to inventive step in substance as follows:

D1 or D2 could both be considered as the closest prior art document.

In D1 no precipitated silica or silica gel was used and none of the examples thereof used both the pyrophosphate salts and a fluoride ion source simultaneously to yield the required minimum $P_2O_7^{4-}$ concentration.

In D2 there was no indication to use the claimed mixture of tetrapotassium pyrophosphate, tetrasodium pyrophosphate and disodium pyrophosphate in order to provide the minimum threshold of tetrabasic pyrophosphate ion concentration.

Thus, even a combination of D1 and D2 would not lead to the claimed oral composition and render the claimed subject-matter obvious.

IV. In a communication issued on 13 June 2002, the board expressed its preliminary view and raised an objection under Article 76(1) EPC to claim 1, feature (d), of the sole request. It was pointed out that the combination of features as now claimed appeared only to be disclosed with respect to a specified range of water (parent application II, page 5, lines 1 to 21).

- V. By letter of 26 June 2002, the appellant withdrew his request for oral proceedings and announced that he would not be attending the oral proceedings on 18 September 2002. No comments, in particular regarding the supporting disclosure in parent application II for the amended claims, were given.
- VI. The oral proceedings were held on 18 September 2002 in the absence of the appellant according to Rule 71(2) EPC.
- VII. The appellant had requested in writing that the decision under appeal be set aside and that the patent be granted on the basis of claims 1 to 6 underlying the decision under appeal as the sole request.

Reasons for the Decision

- 1. The appeal is admissible.

Article 76(1) EPC

- 2. According to Article 76(1) EPC, a European divisional application may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed. All features disclosed in the divisional application must have been disclosed in the description, claims or drawings of that earlier application. In this respect, it is questionable whether the generalized term "water" in the claimed tooth paste composition can be derived from this earlier application.

- 2.1 The application immediately preceding the application

in suit, is European patent application No. 88 103 996.0, published as EP-A-0 297 213 (request form no. 1001, page 4, no. 34; parent application II). Thus, parent application II is the earlier application within the meaning of Article 76(1) EPC. Parent application II contains five use claims and one process claim as well as the description of parent application I. Claims 1, 3 and 6 of parent application II read as follows:

"1. Use of a soluble pyrophosphate salt in the manufacture of an oral composition for reducing the incidence of calculus on dental enamel, the soluble pyrophosphate salt being used in an amount providing at least 1.5% by weight of the composition of pyrophosphate ions ($P_2O_7^{-4}$) and the composition additionally comprising a fluoride ion source in an amount sufficient to supply from 50 ppm to 3500 ppm of fluoride ions."

"3. Use of a soluble pyrophosphate salt according to Claim 1 and 2 wherein the composition is in the form of a dentifrice which in addition contains a silica dental abrasive."

"6. A process for reducing the incidence of calculus on dental enamel comprising contacting the enamel surfaces in the mouth with a composition comprising a soluble pyrophosphate salt capable of providing at least 1.5% by weight of the composition of pyrophosphate ions ($P_2O_7^{-4}$) and a fluoride ion source in an amount sufficient to supply from 50 ppm to 3500 ppm of fluoride ions."

2.2 Although these claims relate to different categories in the form of use and process claims compared to the composition claims in suit, a voluntary restriction in scope is not binding, so that the appellant was free to formulate claims of a different category, provided that such amended claims can be derived from other parts of parent application II.

In said use and process claims the specified composition does not contain the following components of a toothpaste in combination, as now claimed: 10 to 70% by weight of a selected dental abrasive, a selected mixture of pyrophosphate salts in specific amounts, and water, and wherein the composition has a pH value of 6 to 10. Consequently, these claims do not provide a proper basis from which the claimed components in combination can directly and unambiguously be derived.

2.3 As regards the description, parent application II refers to the following general disclosure under the headline "Summary of the invention":

"The present invention embraces an oral composition in the form of a mouthwash, liquid dentifrice or toothpaste comprising:

a) from about 0% to about 70% of a dental abrasive selected from the group consisting silica, alumina, calcium pyrophosphate, insoluble metaphosphates and thermosetting polymerized resins;

b) an amount of a fluoride source sufficient to supply from about 50ppm to 3500ppm of fluoride ions;

c) an amount of a soluble pyrophosphate salt selected

from the group consisting of dialkali metal and mixtures of dialkali metal and tetraalkali metal pyrophosphate salts sufficient to provide at least about 1.5% $P_2O_7^{-4}$; and

d) from **about 2% to about 95%** water

wherein the pH of said composition is from about 6.0 to about 10.0 and the composition does not contain more than about 4.0 $K_4P_2O_7$ " (page 5, lines 1 to 21; emphasis added).

2.3.1 According to this broadest aspect of the invention relating to an oral composition in the form of a toothpaste, the essential features include, in particular, a specified range of about 2% to about 95% by weight of water. Consequently, this paragraph does not provide a basis for the generalized feature "water" without specifying the amount thereof.

2.3.2 The detailed description of parent application II makes further reference to water in the following respect:

"Water is another **essential component** of the compositions of this invention. Water employed in the preparation of commercially suitable oral compositions should preferably be of low ion content and free of organic impurities. Water comprises from **about 2% to about 95%**, preferably from about 20% to about 95% of the compositions of this invention. When in the form of toothpastes, the amount of water is preferably from about 2% to about 45%, while mouthwashes preferably contain from about 45% to about 95%" (page 10, lines 23 to page 11, line 5; emphasis added).

2.3.3 Whilst in the above passage water is disclosed as an essential component of the composition, the amount thereof is indicated to be from about 2 to about 95 % by weight of the composition. Consequently, this disclosure is in line with the broadest aspect stated above defining water as an essential feature and requiring a specific range for it (point 2.3.1). Furthermore, when in the form of a toothpaste, reference is made to a preferred range of 2% to 45% by weight of water which also lies within the required range of 2 to 95% by weight.

2.3.4 Moreover, examples I and II disclose toothpaste compositions which include 16.484 % by weight of water which is also within the required range.

Since the description does not contain any further information from which it could be concluded that the amount of water would be redundant in this respect, the possibility to omit this feature could not be derived therefrom.

2.4 However, the claims on file cover embodiments not restricted to any amount of water, such as below 2% by weight, so that the claimed feature d) "water" constitutes a broadening vis-à-vis the disclosure of parent application II.

2.5 From the above it follows that the toothpaste composition disclosed in parent application II does not provide a basis for the toothpaste composition now being claimed, in particular with respect to the generalized component "water" without any restriction as to the amount thereof. By omitting the amount of water from the disclosed context, the content of the

claim is changed in a way that could not be derived from parent application II.

- 2.6 The appellant cannot rely on the disclosure of the claims of parent application I since the earlier application, which forms the basis of disclosure under Article 76(1) EPC, is parent application II. Thus, if the disclosure of parent application I has been changed by voluntarily replacing the former claims by a completely amended set of claims when filing parent application II, these lacking former claims no longer form part of the reservoir of disclosure from which amendments of the parent application II can be derived under Article 76(1) EPC.
3. For the above reasons, the claimed subject-matter does not comply with the requirements of Article 76(1) EPC. Consequently, the application in suit has to be refused.

Inventive step

4. In view of the deficiencies indicated above, there is no basis on which inventive step could be discussed. Furthermore, it is not apparent in which way the objections under Article 56 EPC addressed in the board's communication could be overcome.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Spigarelli

R. Teschemacher