

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2017-07-25
Docket Number / Aktenzeichen:	X ZB 5/16
Name of Decision / Name der Entscheidung:	Phosphatidylcholin

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# FEDERAL COURT OF JUSTICE

## ORDER

X ZB 5/16

of

25 July 2017

in the appeal proceedings

Phosphatidylcholin

Patent Act Sec. 38

a) A patent application shall be rejected if the subject matter of the claim filed for examination by the applicant goes beyond the content of the application as originally filed and this deficiency is not remedied by the applicant after request by the Examining Section (continuation of Federal Court of Justice, order of 17 September 1974 X ZB 17/73, GRUR 1975, 310 Regelventil).

b) The inclusion of a feature according to which the claimed preparation must not contain a certain substance does not automatically constitute an inadmissible extension (differentiation from Federal Court of Justice, judgment of 12 July 2011 X ZR 75/08, GRUR 2011, 1109 Reifenabdichtmittel).

Federal Court of Justice, order of 25 July 2017 - X ZB 5/16 –

Federal Patent Court

The X. Civil Senate of the Federal Court of Justice ordered on 25 July 2017 by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Dr. Grabinski and Dr. Deichfuß as well as the judge Dr. Marx

that:

On appeal, the order of the 14<sup>th</sup> Senate (Technical Board of Appeal) of the Federal Patent Court, pronounced on 11 September 2015, is set aside.

The case is referred back to the Patent Court for further hearing and decision.

Grounds of the order:

1           A.     The appeal is directed against the rejection of a patent application.

2           The application, filed on 16 May 2001 and published as DE 101 23 771 A1, is entitled "Use of electrolytes to strengthen the barrier function of the skin". Independent claim 1, as last claimed, reads as follows:

Cosmetic, non-therapeutic use of

a)     5 - 30 wt.% NaCl

b)     5 - 30 wt.% glycerol

in each case based on the total weight of the preparation,

c)     these preparations being free from phosphatidylcholine<sup>1</sup>

d)     in hand protection creams, cleansing milks, sun protection lotions, nourishing creams, day or night creams

to strengthen the barrier function of the skin.

<sup>1</sup>characteristic "said preparations being free of phosphatidylcholine" not originally disclosed.

3           The Patent Office rejected the application on the grounds that the disclaimer under letter c of the claim was not originally disclosed. The principles of the "Winkelmesseinrichtung" decision of the Federal Court of Justice could not be applied to the examination procedure. If the disclaimer had to be disregarded, the subject matter according to claim 1 at least did not prove to be new compared to the teaching of the German patent applications 198 57 491, 198 57 490 and 198 57 489.

4           The applicant's appeal was unsuccessful. With its appeal on points of law, which was allowed by the Patent Court, the applicant continues to pursue its claim from the appeal instance.

5           B.     The admissible appeal leads to the annulment of the contested decision and to the remittal of the case to the Patent Court.

6           I.     The application, in the version to be assessed in the appeal and appeal proceedings, is directed to the cosmetic use of sodium chloride and glycerol in skin care products.

7           1.     In the description of the application, the importance of the composition of the epidermis for the barrier function of the skin is explained at the beginning. Skin care products are known per se. Their effect is essentially based, in the case of ointments and creams, on a covering of the treated skin areas and, in the case of caring cleansing products, on an efficient refatting with sebum lipid-like substances. However, the contribution of these products to the regeneration of a physiologically intact horny layer is limited. Insofar as intercellular lipid mixtures, such as ceramides or ceramide analogues, are increasingly being added to topical preparations to support natural skin regeneration, these are usually very expensive raw materials whose effect is also usually less than hoped for.

8           Against this background, the application concerns the technical problem of providing skin care preparations which more effectively maintain or restore the barrier properties of the skin.

9           2.     In order to solve this problem, the version of claim 1 last submitted by the applicant proposes the use of a preparation containing sodium chloride and glycerol, the characteristics of which can be divided as follows:

1.     Cosmetic, non-therapeutic use of
  - a)     5 - 30% by weight of NaCl
  - b)     5 - 30% by weight of glycerolin hand protection creams, cleansing milks, sun protection lotions, nourishing creams, day or night creams for strengthening the barrier function of the skin,
2.     wherein the weight data refer to the total weight of the preparations,
3.     these preparations being free from phosphatidylcholine.

10          3.     The following technical teaching is to be taken from the protective claim of this claim:

11          a)     To strengthen the epidermal barrier, the skilled person is instructed to add 5-30% by weight each of sodium chloride and glycerin based

on the total weight of the preparation. According to the information in the published application (paras. 23-26), this active system surprisingly stimulates the skin's own metabolism of lipids and proteins, which must be constantly formed to maintain the epidermal barrier.

12           b)     As skin care preparations, the application only covers hand protection, nourishing, day and night creams as well as cleansing milks and sun protection lotions. With regard to the forms of the preparations, the claim does specify lotion or milk on the one hand and cream on the other, thus specifying emulsions or emulsion-gel structures. However, the composition of these cosmetic preparations in detail - with the exception of the specifications from features 1 and 3 - is left to the skill and discretion of the skilled person. The claim, moreover, covers any preparation which contains the indicated proportions of table salt and glycerol and is suitable for cosmetic use. The description states in this regard (paras. 29 and 33), the preparation according to the invention can be composed as usual and, depending on the specific use and structural design, can contain cosmetic auxiliaries, such as preservatives, bactericides, perfumes, substances to prevent foaming, dyes, pigments, thickeners, surface-active substances, emulsifiers, emollient, moisturizing and/or moisture-retaining substances, fats, oils, waxes or other usual components of a cosmetic formulation, such as antioxidants (paras. 39 ff.), UVB or UVA filters (par. 31).

13           c)     The claimed subject matter is limited according to feature 3 only to the extent that the preparations must be free from phosphatidylcholine. These are phospholipids composed of fatty acids, glycerol, phosphoric acid and choline and are classically known as lecithins. They are components of the cell membrane of animal and vegetable organisms, are industrially obtained mainly from soy (crude) oil and are used, among other things, as emulsifiers.

14           II.     The Patent Court gave the following main reasons for its decision (Federal Patent Court, GRUR 2016, 583):

15           The amended version of claim 1, according to which the preparations are free of phosphatidylcholine, exhibits a feature not disclosed by origin that impermissibly extends the subject matter of the application. The applicant had

already conceded in the proceedings before the German Patent and Trademark Office that the inclusion of this feature extended the claim beyond the content of the documents originally filed and had not contested the corresponding finding of the Examining Division in the appeal proceedings. Since it had not remedied the defect of the inadmissible extension in the grant proceedings, the application had had to be rejected. The case law of the Federal Court of Justice, according to which a feature not originally disclosed but merely limiting the claimed subject matter of the patent may in principle remain in the claim, but may not be used to support the patentability of the subject matter of the invention (Federal Court of Justice, judgment of 17 February 2015 X ZR 161/12, BGHZ 204, 199 marginal no. 42 Wound treatment device), can only claim validity for the opposition or nullity proceedings and the utility model cancellation proceedings, but cannot be transferred to the grant proceedings. In the latter, the interest of the general public in ensuring that only valid patents are granted is paramount. The applicant's legitimate interest in the grant of adequate protection of his invention is already taken into account by the fact that the Examining Section first points out the deficiency and requests the applicant to remedy it, and that a rejection by decision is only issued if the applicant does not comply. In concrete terms, the applicant had not been able to show any legally relevant benefit that the inclusion of a feature not open to origin could have. The decision practice of the European Patent Office on the admissibility of disclaimers does not justify a different assessment.

16           III.     This assessment does not stand up to legal scrutiny. 1.

17           1.     The starting point of the Patent Court is correct, according to which an application must be rejected if the subject matter of the claim filed by the applicant for examination goes beyond the content of the application as originally filed and this deficiency is not remedied by the applicant after a request by the Examining Section (Benkard/Schäfers, Patent Act, 11th ed. (Benkard/Schäfers, 11th edition Sec. 38 marginal no. 39 f.; Busse/Keukenschrijver, Patent Act, 8th edition Sec. 38 marginal no. 34, Schulte/Moufang, Patent Act, 10th edition Sec. 38 marginal no. 19 f.; Mes, Patent Act, 4th edition Sec. 38 marginal no. 21; Stortnik in BeckOK, PatR, 5th edition Sec. 38 marginal no. 52a).

18           a)       Amendments to the particulars contained in the application in the course of the examination procedure are inadmissible if they extend the subject matter of the application (Sec. 38(1) Patent Act). The right to the grant of a patent with the seniority brought about by the application exists solely within the scope of the subject matter of the application as originally filed. If a corresponding deficiency is not remedied by the applicant after request by the Examining Section, this leads to rejection of the application (Sec. 48 sentence 1 in conjunction with Sec. 45(1) sentence 1 Patent Act). In the interest of legal certainty, the law wants to exclude that the patent is granted with an inadmissibly amended content (cf. Federal Court of Justice, order of 17 September 1974 X ZB 17/73, GRUR 1975, 310, 312 Regelventil, on Sec. 26(5) Patent Act old version) and therefore requires the removal of an inadmissible amendment at any stage of the examination procedure.

19           b)       Contrary to the view of the appeal, it is not necessary to follow the case law of the Federal Court of Justice according to which, in the case of a granted German or European patent whose subject matter goes beyond the content of the application as originally filed, a declaration of invalidity or cancellation is not required if the amendment consists in the insertion of a feature which is not obvious from the origin and which leads to a mere restriction of the subject matter applied for (Federal Court of Justice, judgment of 17 February 2015 X ZR 161/12, BGHZ 204, 199 marginal no. 48 with further references wound treatment device), to be transferred to the examination procedure. This case law takes into account the fact that after the grant of the patent the proprietor is prevented from deleting the feature which is not disclosed in the originally filed documents as belonging to the invention, because this would lead to an extension of the scope of protection and thus in turn would fill a ground for revocation or nullity (Sec. 22(1) Patent Act, Art. 123(3), Art. 138(1) (d) EPC, Art. II Sec. 6(1) No. 5 German Act on International Patent Conventions). This difficulty does not exist in the examination procedure. Before the final decision of the authority, the applicant not only has the possibility to cancel the insertion of a feature which is not obvious from the origin; he is rather obliged to do so, because otherwise the application must be rejected.

20           2.       However, the Patent Court's assumption, shared by the appeal,



that the inclusion of feature 3 in claim 1, according to which the preparations are free from phosphatidylcholine, inadmissibly extended the subject matter of the application is incorrect.

21 To determine an impermissible broadening, the claim presented for examination must be compared with the contents of the original documents. The claim must not be directed to subject matter which the application documents as originally filed do not reveal as belonging to the invention from the point of view of a skilled person. According to this requirement, the insertion of feature 3 in claim 1 did not lead to an inadmissible amendment.

22 a) The originally filed application documents disclose the cosmetic use of a preparation containing up to 30% by weight each of common salt and glycerol. Further express specifications regarding the composition of the preparation are not to be taken from the application, they result only indirectly from the indication that the preparation is to serve the cosmetic use in creams, milks or lotions. The documents mention several groups of substances from which the lipid phase of the emulsion can be selected. If oil is to be used for this purpose, a number of substance groups are listed from which it can be selected. In addition, as already mentioned, the description contains a comprehensive catalog of further substances which may, but need not, be present in the preparation, depending on the desired uses.

23 b) Phosphatidylcholine is mentioned, although not under this designation, in the originally filed application documents in only two places. First, soybean oil, a source of lecithin, is mentioned as one of numerous fatty acid glycerides, which in turn are listed as one of several groups of substances that may be chosen as the oil phase for the emulsion (para. 47). Second, lecithin is listed as one of several dozen possible emulsifiers (para. 55).

24 c) Accordingly, there is no indication from the application documents that phosphatidylcholine is a necessary component of the preparation or that its addition is even considered advantageous. This is confirmed by the fact that preparations 1 to 3, listed as examples in the description, each contain five percent by weight glycerol and seven percent table salt, but no phosphatidylcholine (paras. 101-103).

25           The inclusion of feature 3 in the claim also does not result in the claim now being directed, contrary to the original application documents, to a composition which may only consist of certain components (see in this respect Federal Court of Justice, judgment of 12 July 2011 X ZR 75/08, GRUR 2011, 1109 marginal no. 35 et seq. Reifenabdichtmittel). Rather, the feature merely expresses that, from the multitude of possible compositions of the preparation possible according to the original application documents, those containing phosphatidylcholine are excluded. It thus merely serves to delimit the subject matter of the application from the state of the art as disclosed in the German published application documents DE 198 57 489 to 492, in each of which skin protection preparations are described which, in addition to salts and humectants, also contain saturated or unsaturated phosphatidylcholine as a necessary component.

26           Such a limitation of the claim is in line with the criteria developed by the Enlarged Board of Appeal of the European Patent Office on the admissibility of a disclaimer to establish novelty over the state of the art (EPO, Enlarged Board of Appeal, decisions of 4 April 2004 G 1/03 and 2/03, OJ EPO 2004, 413 and 448 Disclaimer/PPG and Disclaimer/GENETIC SYSTEMS; decision of 30 August 2011 G 2/10, OJ EPO 2012, 367 Disclaimer/SCRIPPS). Accordingly, the admissibility of a disclaimer in the sense of a negatively worded technical feature intended to exclude certain embodiments or ranges of a broadly defined feature (EPO OJ 2012, 376, 390, at 2.2 of the grounds for the decision) is precluded if the restriction thus brought about proves to be technically relevant (EPO OJ 2004, 413, 441, at 2.6.1 of the grounds for the decision; EPO OJ 2012, 376, 403, at 4.4.2 of the grounds for the decision). In the case in dispute, however, there are no indications that the limitation of the subject matter by feature 3 is accompanied by or intended to achieve an additional technical effect or that the skilled person obtains new technical information as a result.

27           3.       Accordingly, the decision of the Patent Court cannot be upheld insofar as it based the appeal against the refusal to grant a patent on the fact that the subject matter of patent claim 1 was inadmissibly extended compared to the originally filed application documents by the inclusion of feature 3. The footnote added to the claim by the applicant is thus dispensable.

28            Since the Senate is precluded from making its own decision on the merits  
(Sec. 108(1) Patent Act), the case must be referred back to the Patent Court.

29            IV.     The Senate did not consider it necessary to hold an oral hearing  
(Sec. 107(1) half-sentence 2 Patent Act).

Meier-Beck

Gröning

Grabinski

Deichfuß

Marx

Previous instance:

Federal Patent Court, judgment of 11 September 2015 – 14 W(pat) 30/13 –