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Aktenzeichen / Case Number / N^o du recours : T 144/83
 Anmeldenummer / Filing No / N^o de la demande : 79 300 879.8
 Veröffentlichungs-Nr. / Publication No / N^o de la publication : 5636

Bezeichnung der Erfindung: Method and product for inducing anorexia
 Title of invention:
 Titre de l'invention :

Klassifikation / Classification / Classement : A 61 K 31/445

ENTSCHEIDUNG / DECISION
 vom / of / du 27 March 1986

Anmelder / Applicant / Demandeur : E.I. Du Pont De Nemours and Co.

Patentinhaber / Proprietor of the patent /
 Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Appetite suppressant/DU PONT

EPÜ / EPC / CBE Art. 52(1), 52(4), 53(b) and 57 EPC.

"Cosmetic treatments", "industrial application",
 "essentially biological processes".

Leitsatz / Headnote / Sommaire

The fact that a chemical product has both a cosmetic and therapeutic effect when used to treat the human or animal body does not render the cosmetic treatment unpatentable (as in the present case where it may be used to cause loss of weight or to cure obesity).

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Case Number: T 144 / 83

DECISION
of the Technical Board of Appeal 3.3.1
of 27 March 1986

Appellant: E.I. du Pont de Nemours and Company
1007 Market Street
Wilmington, Del. 19898
USA

Representative: Hildyard, Edward Martin
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Decision under appeal: Decision of Examining Division 001 of the European Patent
Office dated 11.03.83 refusing European patent
application No 79 300 879.8 pursuant to Article 97(1)
EPC

Composition of the Board:

Chairman: K. Jahn
Member: G. Szabo
Member: F. Benussi

Summary of Facts and Submissions

I. European patent application 79 300 879.8 filed on 18 May 1979 and published on 28 November 1979 with publication number 5636, claiming priority of the earlier applications on 19 May 1978 and 6 April 1979 (US-907 825 and 27 270) was refused by decision of the Examining Division 001 of the European Patent Office dated 11 March 1983. The decision was based on Claims 1 to 3 filed on 20 October 1980. Claims 1 and 2 were worded as follows :

- " 1. A method of improving the bodily appearance of a non-opiate-addicted mammal which comprises orally administering to said mammal naltrexone or a pharmaceutically effective salt thereof in a dosage effective to reduce appetite, and repeating said dosage until a cosmetically beneficial loss of body weight has occurred.
2. The method of Claim 1 wherein said mammal is a human being."

II. The stated ground for the refusal was that, as far as the method relates to a cosmetic process, the subject-matter of the claim were not susceptible for industrial application according to Art. 57 EPC. The suppression of appetite with naltrexone involved the ingestion of a drug having a powerful physiological effect. Although there were no distinctions between humans and animals in Art. 52, this could not place an obligation on the Examining Division to treat human beings and animals as equivalents or to allow a claim to the treatment of a human being merely because it might be allowable in case of non-human animals. The treatment of a human being with such a drug was essentially biological in nature and therefore the administration of the same could not be regarded as susceptible to industrial application.

III. The Applicant filed an appeal on 18 May 1983 against the decision of 11 March 1983, already having paid the fee on 11 May 1983, and submitted a Statement of Grounds on 19 July 1983. The Board issued a communication on 9 December 1983 which informed the Appellant that the examination of the appeal would be suspended whilst proceedings were in progress before the Enlarged Board of Appeal concerning the patentability of methods relating to the therapeutic treatment of human and animals in another case (cf. T 17/81, "Nimopidin/BAYER", OJ. 7/1983, 266-268). The Enlarged Board of Appeal then decided that a European patent may not be granted with the above kind of claims but may be granted with claims directed to the use of a substance or composition for preparation of a medicament for a specific, new and inventive therapeutic use. (Gr. 05/82, "Second medical indications/EISAI", OJ. 3/1985, 67).

IV. As regards cosmetic treatments of humans and animals the Appellant presented substantially the following arguments in support of the appeal :

- a) The subject-matter of the invention is in the field of cosmetics and the claim is specifically directed to an improvement in the appearance of the user's body through loss of weight. The correct and normal approach to the construction of a method claim is to ascertain the purpose of following the steps of the method.
- b) There might be extreme cases where the loss of weight is also necessary on medical grounds. The term "therapy" is, however, well distinguished from cosmetic treatments. The preponderant motive for losing weight in the human species is solely directed to an improvement in appearance. Conversely, it may also be necessary in practice that an animal should gain weight. Such methods are expressly approved by the Guidelines for Examination

in the EPO (C-IV, 4.3) as being patentable, provided that the method is "technical and not essentially biological". As to what is technical and therefore not essentially biological, the Guidelines cite the use of growth inhibiting and stimulating substances on plants (Ibid, C-IV, 3.4).

- c) The administration of a synthetic chemical substance to a living organism cannot in itself be regarded as biological in nature. Furthermore, the claims need not necessarily be restricted to industrial application (cf. Guidelines C-IV, 4.5). The word "industry" should be given a broad interpretation and the benefit of any doubt should be exercised in favour of the Applicant, in particular in ex parte cases.
- V. The Appellant requests in effect that the decision of the Examining Division be set aside and a European patent granted in the case.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. There is no formal objection to the current version of the claims, since it is adequately supported by the original documents. Claim 1 relies on the main claim as filed and on page 4, lines 26 to 32. The rest of the claims is as originally filed.
3. The subject-matter of the application is not unpatentable in consequence of Art. 52(4) EPC. According to the provision of

this article methods for treatment of the human or animal body by therapy shall not be regarded as susceptible to industrial application. Such exclusions from patentability must be construed narrowly and should not apply to treatments which are not therapeutic in character.

As far as the language of the main claim is concerned, it clearly covers a method of cosmetic use and is unrelated to the therapy of human or animal body in the ordinary sense. This is because loss of weight, like gain of weight, is normally not dictated as a desirable effect by medical considerations at all. Cosmetic treatment is "designed to beautify hair, skin, complexion etc. ... or intended to improve appearance (cf. Oxford Concise Dictionary, Tenth Impression, 1980). Therapy, on the other hand, clearly relates to the treatment of a disease in general or to a curative treatment in the narrow sense as well as the alleviation of the symptoms of pain and suffering.

4. It must be admitted that the cosmetic treatment of the human or animal body, which alone is claimed in the present application, is adjoined to the therapeutic use without a sharp distinction in some cases. It may even be difficult to distinguish between the cosmetic and therapeutic effect, i.e. losing weight and curing obesity. This should not, however, be allowed to work to the disadvantage of an applicant who, according to the wording of his claims, seeks patent protection for cosmetic treatment but not for the therapeutic treatment as such. The fact that a chemical product has both a cosmetic and therapeutic effect when used to treat the human or animal body does not render the cosmetic treatment unpatentable.

5. It is the view of the Board that the invention also complies with the requirements of Article 57 EPC. According to the

.../...

article the invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry. That this is the case of the present invention is not in doubt since it can be used by enterprises whose object is to beautify the human or animal body. Such enterprises in the cosmetic field - such as cosmetic salons and beauty parlours - are part of industry in the sense of Article 57 EPC, since the notion of concept "industry" implies that an activity is carried out continuously, independently and for financial gain. The Board has already decided that "the professional use of such inventions in a cosmetic salon is an industrial application in the sense of Article 57 EPC" (cf. unreported decision in case T 36/83, of 6 May 1985).

6. The Board is, therefore, unable to follow the reasoning in the decision of the Examining Division which suggests that a physiological effect produced by a chemical agent is "essentially biological in nature" and therefore not of an industrial character. It is the view of the Board that Article 53(b) EPC does not necessarily exclude such processes from consideration, unless they are "essentially biological processes for the production of plants and animals". A claim for the treatment of a plant without creating a new species or variety was accordingly approved by the Board (cf. "Propagating material/CIBA-GEIGY, T 49/83, OJ. 3/1984, 112). The process claimed in the present case therefore satisfies the requirements of the EPC as far as industrial applicability (Art. 57) and exceptions to patentability (Art. 53) are concerned.

7. Since the refusal of the application on grounds of lack of industrial applicability was not accompanied by any reasoning and conclusion as to the other criteria of patentability, a substantive examination is still outstanding in these respects. In view of all these circumstances the Board feels obliged to use its power under Article 111(1) EPC to remit the case to the Examining Division for further prosecution.

Order

It is decided that :

1. The contested decision is set aside.
2. The case is remitted to the Examining Division for further prosecution.

The Registrar

26/3
J. R. Bee
Frankenberg 1.4.83

The Chairman

[Signature]