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**Datasheet for the decision
of 4 September 2008**

Case Number: T 0171/04 - 3.3.07

Application Number: 97925064.4

Publication Number: 0912156

IPC: A61K 7/00

Language of the proceedings: EN

Title of invention:

Cooling effect of antiperspirant composition

Patent Proprietor:

Unilever PLC, et al

Opponents:

L'OREAL

Headword:

-

Relevant legal provisions:

EPC Art. 54, 84, 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Novelty (no) (main and auxiliary requests)"

"Amendments - added subject-matter (yes) (auxiliary request)"

"Claims - clarity (no) - support by description (no)

(auxiliary request)"

Decisions cited:

G 0002/88

Catchword:

-



Case Number: T 0171/04 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 4 September 2008

Appellants:
(Patent Proprietors)

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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 02 December 2003 revoking European patent No. 0912156 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: S. Perryman
Members: B. ter Laan
F. Rousseau

Summary of Facts and Submissions

I. The appeal by the patent proprietors (appellants) lies against the decision of the opposition division posted on 2 December 2003 to revoke the patent.

II. Mention of the grant of European patent No. 0 912 156, based on European patent application No. 97 925 064.4, originating from international patent application PCT/EP97/02983 (filed on 5 June 1997 and published on 18 December 1997 under No. WO 97/47273), was published on 29 August 2001. The patent was granted on the basis of seven claims, claim 1 reading:

"Use as a means of skin cooling of an antiperspirant aerosol composition comprising an antiperspirant active, a liquefied volatile propellant, a volatile cyclomethicone liquid carrier, and a silicone polymer that is a silicone gum or a silicone fluid, which silicone fluid has a viscosity of greater than $0.06\text{m}^2/\text{s}$ (60,000 cS)."

Claims 2 to 7 referred to preferred embodiments of claim 1.

III. A notice of opposition against the patent was filed on 29 May 2002, in which the revocation of the patent in its entirety was requested on the grounds of Article 100(a) EPC (lack of novelty as well as lack of an inventive step), Article 100(b) EPC (insufficient disclosure) and Article 100(c) EPC.

The opponents had cited "D1: EP 0 343 843" as novelty destroying, enclosing with the opposition brief D1B: EP-B-0 343 843, published on 8 September 1993.

IV. The decision of the Opposition Division was based on the claims as granted as the main request and three sets of claims submitted as auxiliary requests 1 to 3 during the oral proceedings held on 18 November 2003. Claim 1 of auxiliary request 3 corresponded to claim 1 as granted with at its end the additional words:

"..., which cooling is greater than in the absence of the silicone polymer."

The reasoning of the Opposition Division can be summarized as follows:

- The main request fulfilled the requirements of Articles 83 and 123(2) EPC. However, the subject-matter of claim 1 as granted was not novel over D1A (EP-A-0 343 843) as the criteria for use claims laid down in G 2/88 (OJ 1990, 93), namely that the use as such is new and that it describes a newly discovered technical effect, had not been met.

- The composition of D1A met the composition requirements of claim 1. D1A described the spraying on the skin and taught that when this composition was used, a cooling effect was obtained. The evaluation of the cooling as objectionable in D1A could not be misinterpreted either as a different use of the antiperspirant composition of D1A or as the absence of a cooling effect when the known antiperspirant was sprayed on the skin. Therefore, D1A disclosed the use being claimed, so that novelty was lacking.

- The first and second auxiliary requests did not comply with Article 84 EPC.

- Claim 1 of the third auxiliary request was not novel over D1A for the same reasons as claim 1 of the main request, as there was no reason to believe that when the composition of D1A was sprayed on the skin without containing a silicone polymer the cooling effect would not be reduced as required by claim 1 of this request.

V. On 3 February 2004 the appellants lodged a Notice of Appeal against that decision. The prescribed fee was paid on the same day. The statement setting out the grounds of the appeal was filed on 8 April 2004.

By letter dated 19 October 2004 the opponents (respondents) filed comments on the grounds for the appeal.

In a communication dated 25 June 2008 the Board addressed several issues under Articles 123(2), 83 and 54 EPC, including posing the question if not every composition that evaporates on the skin would create a cooling effect.

The respondents, with a letter dated 1 August 2008, filed an additional document WO 94/21224 as confirmation that the composition of example 5 of D1 was identical to the composition whose use was claimed in the patent in suit.

VI. Oral proceedings before the Board were held on 4 September 2008. The appellants' arguments can be summarised as follows:

- For the novelty of a use claim, two criteria had to be met: the use as such should be new and it should reflect a newly discovered technical effect.
- The compositions of D1, although they were the same as the ones used in the patent in suit, did not produce a cold feeling on the skin because that was due to a high spray rate during application. D1 taught to avoid high spray rates in order to avoid the cooling effect, so that D1 did not disclose the cooling properties of the composition. Therefore, the use as such was novel.
- Also, D1 did not disclose that the particular composition described in present claim 1 might be used for skin cooling, nor that silicone polymers could be used to enhance the cooling effect.
- The graph in the respondents' (opponents') letter dated 17 October 2003, the estimated values of which were given in the table filed with the statement of grounds for the appeal, showed that compositions containing the silicone polymer gave a greater cooling effect than compositions without silicone polymer. Hence, both the use as well as the cooling effect were novel.
- Regarding the auxiliary request, it differed from the main request in the added requirement of a greater cooling effect provided by the silicone

polymer, which was not described in D1. Thus the claimed subject-matter of the auxiliary request was novel.

VII. The arguments of the respondents can be summarized as follows:

- D1 described the compositions the use of which was now claimed. Such compositions were applied to the skin as antiperspirants.
- D1 taught that the composition could have such a strong cooling effect that it might be perceived as undesirable and it sought to reduce it. Hence, D1 did not disclose that the compositions had no cooling effect at all.
- Furthermore, the extent of the cooling effect was not defined in the claims in suit and therefore could not constitute a distinguishing feature over D1.
- Therefore, neither the use nor the effect were new over D1.

VIII. The appellants requested that the decision under appeal be set aside and that the patent be maintained as granted or, as auxiliary request, on the basis of the claims filed as auxiliary request 3 at the oral proceedings before the opposition division.

The respondents requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Novelty of main request

2. Claim 1 of the main request relates to the use of an antiperspirant aerosol composition comprising an antiperspirant active, a liquefied volatile propellant, a volatile cyclomethicone liquid carrier, and a silicone polymer that is a silicone gum or a silicone fluid, which silicone fluid has a viscosity of greater than 0.06 m²/s (60,000 cS). D1B discloses such an aerosol antiperspirant composition, as is not disputed by the appellants. The Board refers to D1B, since this rather than D1A, was submitted with the opposition. There is no significant difference in information content between D1A and D1B.
 - 2.1 The antiperspirant aerosol compositions of D1B are delivered to the skin (see page 2, line 1). D1B aims at and claims such aerosol compositions suitable for delivery through an aerosol delivery system including a valve at a delivery rate of not more than 0.5 g/s without clogging the valve. The advantages of the claimed compositions are stated to include avoiding an objectionable cold feeling due to too large a delivery rate (page 11, line 55). The skilled reader is thus taught that these compositions have a cooling effect, which can be unpleasantly large if the delivery rate is too great. This is confirmed by the remark at the end of Example 6 (page 10, lines 18 to 20) that the Example 1 composition **reduced** (emphasis added) the cold and wet feeling of the product when delivered to the

underarm area. Reducing an effect does not mean eliminating it. Thus D1B discloses the use as a means of skin cooling of an antiperspirant aerosol composition meeting the requirements of claim 1. That this disclosure in D1B is in the context of avoiding the unpleasantness of too great a cooling effect by keeping down the spray rate, does not alter the fact that the cooling effect of applying the compositions is disclosed. Neither the use nor the effect claimed in claim 1 of the patent in suit are therefore novel.

2.2 The appellants' argument that the compositions according to D1B, due to the low spray rate with which they were applied to the skin, had no cooling effect at all is not consistent with what D1B says, and further ignores that what the skilled reader is told by D1B about the cooling effect of its compositions is not limited to a low spray rate, but also includes the information that at high spray rates an objectionable cooling effect is observed. Claim 1 of the patent in suit is not limited to the use of any spray rate, and so spray rate cannot provide any distinction over D1B.

2.3 Claim 1 of the main request is thus not novel over D1B, and the main request does not comply with the requirements of the EPC.

Auxiliary request

3. Claim 1 of the auxiliary request has at its end the added words "... which cooling is greater than in the absence of the silicone polymer."

- 3.1 The application as filed contains no comparison of the claimed compositions to similar ones not containing the silicone polymer. The comparison made is rather to the cooling effect of an "alcoholic deodorant" made up of 50% propane, 0.5% perfume and 49.5% ethanol (comparative example 1; Table 1; Table 2), which is stated to demonstrate that "by using antiperspirant aerosols of the invention a cooling effect similar to if not better than an alcoholic deodorant is obtained."
- 3.2 The only comparison made between otherwise identical compositions, one including a silicone polymer and one not is in evidence filed by the respondents (opponents). Such evidence cannot provide any basis in claim 1 of the added words.
- 3.3 The appellants have referred to paragraph [0044] of the patent in suit, which states that "...Although the Applicants do not wish to be bound by any theory, it is believed that the use of the silicone gum in the antiperspirant compositions causes the propellant which is dissolved in the viscous gum to be conveyed to the skin surface. In prior art compositions propellant is not conveyed to the skin.". This provides no basis for the added words in claim 1, as the prior art composition is not identified, and what is said is not true of D1B.
- 3.4 Claim 1 of the auxiliary request thus does not meet the requirements of Article 123(2) EPC.
- 3.5 Further the added words do not serve to define any clear or supported technical feature. If the cooling is indeed always greater than in a composition without the

silicone polymer, then the feature introduces no restriction and is redundant. Alternatively it might be read as a restriction of claim 1 to those compositions where with the silicone polymer the cooling effect is greater than in the absence of silicone polymer, but the patent contains no guidance as to when this might occur. The amendment thus fails to meet the requirements of Article 84 EPC as to clarity and support.

3.6 Finally if the feature "..., which cooling is greater than in the absence of the silicone polymer." is just describing a property of the compositions already defined in the claim, and is thus redundant, then claim 1 of the auxiliary request lacks novelty for the same reasons as set out above in respect of claim 1 of the main request.

3.7 The Board concludes that the auxiliary request does not meet the requirements of the EPC either.

Order

For these reasons it is decided that:

The appeal is dismissed.

Registrar

Chairman

C. Eickhoff

S. Perryman