

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 15 November 2007**

Case Number: T 0263/04 - 3.3.07

Application Number: 97914603.2

Publication Number: 0893983

IPC: A61K 7/00

Language of the proceedings: EN

Title of invention:
Hair cosmetic composition

Patent Proprietors:
KAO CORPORATION

Opponents:
01) Henkel KGaA
02) The Procter & Gamble Company

Headword:
-

Relevant legal provisions:
EPC Art. 56, 123(2)
EPC R. 57a

Keyword:
"Amendments - allowable (yes)"
"Inventive step (no) - (Main Request and Auxiliary Request)"

Decisions cited:
T 0766/91

Catchword:
-



Case Number: T 0263/04 - 3.3.07

DECISION
of the Technical Board of Appeal 3.3.07
of 15 November 2007

Appellants: HENKEL KGaA
(Opponents 01) VTP (Patente)
D-40191 Düsseldorf (DE)

Representative: -

Respondents: KAO CORPORATION
(Patent Proprietors) 14-10, Nihonbashi Kayabacho 1-chome
Chuo-Ku, Tokyo 103 (JP)

Representative: Kindler, Matthias
Hoffmann Eitle
Patent- und Rechtsanwälte
Arabellastrasse 4
D-81925 München (DE)

Party as of right: The Procter & Gamble Company
(Opponents 02) One Procter & Gamble Plaza
Cincinnati, OHIO 45202 (US)

Representative: Kohol, Sonia
Procter & Gamble Technical Centres Limited
Patent Department
Rusham Park
Whitehall Lane
Egham, Surrey TW20 9NW (GB)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
23 December 2003 concerning maintenance of
European patent No. 0893983 in amended form.

Composition of the Board:

Chairman: S. Perryman
Members: G. Santavicca
B. Struif

Summary of Facts and Submissions

I. The appeal lies from the interlocutory decision of the Opposition Division, according to which, account being taken of the amendments made by the proprietor during the opposition proceedings, European patent 0 893 983 (application N° 97 914 603.2) and the invention to which it relates were found to meet the requirements of the EPC. That decision was based on a set of amended claims 1 to 8 filed with letter dated 20 February 2003 and identified as the Main Request, independent Claims 1 and 8 reading as follows:

"1. Use of a hair cosmetic composition comprising fine particles of a water-insoluble polymer or inorganic material, which have an average particle diameter not smaller than 0.2 μm , but smaller than 1 μm , and wherein the fine particles are surface-treated with a cationic compound or/and the composition further comprises a cationic compound for imparting gloss or luster to the hair."

"8. A method of imparting gloss or luster to hair, which comprises applying the hair cosmetic composition as defined in any of the claims 1 to 7 to the hair."

II. The patent had been opposed by two opponents on the grounds that the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC) and that the claimed subject-matter lacked novelty and an inventive step (Article 100(a) EPC) having regard *inter alia* to the following documents:

D1: EP-A-0 538 762;
D3: EP-A-0 590 604;
D9: US-A-5 441 728;
D10: JP-A-05 310 533 (in the form of a German translation enclosed in the letter of opponents 01 dated 4 November 2003, identified as document D10b).

III. In the decision under appeal, the opposition division found that the amended patent fulfilled the requirements of the EPC, on the basis of reasoning which can be summarised as follows:

- (a) Since the term "water-soluble polymer" was known to the skilled person, and since the patent in suit disclosed many such polymers and exemplified their use in a number of compositions, that had not been contested, the ground of insufficiency of the disclosure did not prejudice maintenance of the patent.
- (b) Three documents had been used to attack the novelty of the claimed subject-matter: D3, D9 and D10b. However, D3 neither disclosed particles having an average size as defined in Claim 1 nor that the particles had been treated with propylene imine to become cationic. With respect to D9, two selections were necessary to arrive at the claimed subject-matter, namely a first selection of a suitable water-soluble polymer and a second selection of a suitable range for the particle size. Finally, the water-insoluble particles used in the only composition of D10b comprising a cationic polymer (Example 3), had a particle size of 4.5 μm . A combination of Example 3 with the general disclosure of D10b relating to the

particle size was not admissible for assessing novelty. Therefore, none of D3, D9 and D10b directly and unambiguously disclosed the claimed use, which thus was novel.

- (c) As regards inventive step, documents D10b and D9 disclosed the closest prior art. Starting from any of D9 and D10b, which both addressed the improvement of gloss of hair, the problem to be solved was to provide a further improved gloss of hair. It had not been contested that that problem had been solved. Neither D9 nor D10b, let alone their combination with D1 and D13, would however give any hint to the skilled person towards a further improvement of gloss and lustre of the hair. Therefore, the claimed subject-matter of the patent in suit was not obvious.

- IV. On 20 February 2004, opponents 01 lodged an appeal against that decision and paid the appeal fee. In their statement setting out the grounds of appeal, received on 29 April 2004, the appellants maintained the grounds of opposition under Article 100a EPC, namely lack of novelty over D3 and D9, and lack of an inventive step over D9 and D10.

Opponents 02 did not lodge an appeal and thus are party as of right pursuant to Article 107 EPC, second sentence.

- V. In their response to the statement setting out the grounds of appeal, the patent proprietors (hereinafter, the respondents) argued against the arguments of the appellants and enclosed an amended set of Claims 1 to 8 as the Auxiliary Request (letter dated 15 September

2004). Independent Claims 1 and 8 of the Auxiliary Request read as follows (emphasis added by the Board to show the amendments to the claims underlying the decision under appeal):

"1. Use of a hair cosmetic composition comprising fine particles of a water-insoluble polymer or inorganic material, which have an average particle diameter not smaller than 0.2 μm , but smaller than 1 μm , and wherein the fine particles are surface-treated with a cationic compound **selected from cationic surfactants and cationic polymers** or/and the composition further comprises a cationic compound **selected from cationic surfactants and cationic polymers** for imparting gloss or luster to the hair."

"8. A method of imparting gloss or luster to hair, which comprises applying the hair cosmetic composition as defined in any of the claims 1 to 7 to the hair."

- VI. By letter dated 19 June 2007, the parties were summoned to oral proceedings, to be held on 15 November 2007.
- VII. In response to the summons, opponents 02 (party as of right pursuant to Article 107 EPC) announced, by letter dated 1 August 2007, that they would not be represented at the oral proceedings.
- VIII. In a communication faxed on 20 September 2007 to prepare the oral proceedings, the concerns which the Board then had in relation to some of the arguments, evidence or requests presented were made known to the parties.

- IX. By letter dated 10 October 2007, the respondents informed the Board and the opposing parties that nobody would attend the fixed oral proceedings and that they withdrew their request for oral proceedings.
- X. Oral proceedings were held on 15 November 2007, in compliance with Rule 71(2) EPC, in the announced absence of the respondents and of opponents 02.
- XI. The arguments of the appellants can be summarised as follows:

Main Request

- (a) According to D3, the hair spray composition prepared according to Example 47 and used as illustrated in Example 48 contained particles of water insoluble polymer having an average size of 0.2 micrometer, which had been surface treated with propylene imine to attach amino alkyl groups on the surface of those particles. The nitrogen atoms were protonated at the disclosed pH so that propylene imine acted as a cationic compound. Consequently, the particles had been surface treated with a cationic compound to attach cationic groups on the surface. That treatment led to an improved gloss as shown in Table 7. The argument of the respondents that the treatment led to an amide was not made plausible. The argument that the quantity of propylene imine was not sufficient to change the anionic character of the polymer of the particles played no role, since Claim 1 merely required that the particles be surface treated with a cationic

compound. Therefore, the claimed use was not novel over the art disclosed in D3.

- (b) The claimed use did not involve an inventive step neither over D10b nor over D9 or D1. The closest prior art was illustrated by Examples 3 and 5 of D10b. The shampoo of Example 3 contained a water-insoluble cationic cellulosic polymer together with fine particles of hard silicone P-2 having an average size of 4.5 micrometers. The product of Example 5 contained acetyltrimethylammoniumchloride, a cationic compound, together with hard silicone particles P-3, having a particle size ranging from 1 to 50 micrometers. Thus, the only distinction of the claimed use was the lower particle size. Nevertheless, both compositions of D10b, in particular that of Example 3, were able to impart better than good or almost excellent gloss and dressing ability to the hair, which sought-for properties were the object of D10b. The respondents had not shown any improvement over the use of the compositions exemplified in D10b, nor that the upper particle size was critical. In fact, in Example 6 of the patent in suit, use of particles of indeterminate form having a diameter of 1 micrometer, i.e. outside the claimed range, led to better gloss than particles having a smaller size as used in Example 8, for instance. Furthermore, Claim 1 in suit did not specify the requirement that the particle size distribution should be narrow. However, according to Example 1, Invention Product 8, of the patent in suit, a non-narrow distribution of particle sizes did not lead to excellent gloss. Therefore, the problem to be solved was merely to provide further uses of hair

cosmetic compositions to impart good gloss to the hair. The solution to that problem, however, was obvious already in light of D10b alone, which suggested that the particle size could be made smaller, not only to 2 μm (hairspray of Example 1) but even to greater than 0.1 μm (general preferred disclosure), in order to obtain good hair-dressing ability and gloss. A hint towards use of smaller particle size for obtaining gloss was also apparent from any of D9 or D1. Therefore, the claimed subject-matter was obvious.

Auxiliary Request

(c) Also after the amendments to the claims D10b still disclosed the closest prior art and the problem to be solved remained the same. Thus, the arguments on inventive step against Claim 1 of the Main Request applied *mutatis mutandis* to Claim 1 of the Auxiliary Request, with the consequence that also the claimed subject-matter of the Auxiliary Request was rendered obvious by D10b.

(d) Therefore, the patent in suit should be revoked.

XII. The written arguments of the respondents can be summarised as follows:

Main Request

(a) As regards lack of novelty, the general disclosure of D3 did not mention particles having an average size as defined in Claim 1. Concerning Examples 47 and 48, no evidence had been submitted to

demonstrate that the polymer treated with propylene imine included alkyl amine groups being protonated at the given pH, instead of amide groups as shown by the respondents. Also, even in the case where the iminated polymer included amino alkyl groups as a cationic group being protonated, since the amount of anionic groups in that polymer was in excess to the amount of imine groups, the surface of the polymer particles would not be cationically modified. Furthermore, no evidence had been provided with regard to the average particle size of iminated polymer particles. Therefore, the subject-matter of Claim 1 had not been shown to be directly and unambiguously disclosed by D3.

- (b) As regards D9, the use of the hair cosmetic composition of Claim 1 represented a selection out of two lists. The selection out of a first list for the average particle size and the selection out of a second list for the cationic compound. This combination was not directly and unambiguously disclosed by D9.

- (c) As regards inventive step, D10b disclosed a composition including hardened polyorgano siloxane in powder form in order to obtain a good gloss of the hair. The particle sizes in the Examples of D10b were much higher than the upper limit of 1 μm required by Claim 1. Hence, D10b taught away from the invention defined in Claim 1. D9 concerned the use of particles formed of specifically selected monomers in combination with water-soluble polymers in specific weight ratios. In particular, no hint could be gathered from D9 that if the particle size

was lowered to less than 1 micrometer then the gloss of the hair would be improved. D1 addressed smoothness in the sense of softness of the hair rather than gloss. The cosmetic composition comprised a cationic surfactant, a fat and oil, and an alkyl saccharide surfactant. That composition might further comprise fine particles of an average particle size of 100 μm or below. It was not deducible either from D1 that for an improved gloss of the hair it was important that the particle size of the fine particle was below 1 μm . Therefore, also a combination of D10b, D9 and D1 would not lead the skilled person towards the subject-matter of Claim 1, which consequently was inventive.

Auxiliary Request

- (d) The addition of the further feature "the cationic compound is selected from a cationic surfactant and a cationic polymer" in Claim 1 underlying the decision under appeal had a basis in the application as filed. That additional feature aimed at possibly overcoming the raised ground of lack of novelty over D3 (Rule 57a EPC).

- (e) The propylene imine used in the examples of D3 neither was a cationic surfactant nor a cationic polymer. Furthermore, the appellants had not proven that under the conditions exemplified in D3 propylene imine reacted with itself to form polypropylene imine, a cationic polymer. Therefore, the subject-matter of Claim 1 according to the Auxiliary Request was novel.

(f) Regarding the inventive step, the same arguments developed for the Main Request and the same conclusions applied to the subject-matter of the Auxiliary Request.

XIII. The appellants (opponents 01) requested that the decision under appeal be set aside and that the European patent be revoked.

XIV. The respondents (patent proprietors) had requested in writing that the appeal be dismissed as Main Request, or that the patent be maintained on the basis of Claims 1 to 8 of the Auxiliary Request filed on 15 September 2004.

Reasons for the Decision

1. The appeal is admissible.

Main Request

2. *Amendments*

It is not contested by the Opposition Division and the appellants that the amendments to the claims as granted have a basis in the application as filed. The Board has no reason to take a different position.

3. *Insufficiency of the disclosure*

The appellants have not contested the decision under appeal on the issue that the ground of insufficiency of the disclosure pursuant to Article 100(b) EPC, invoked

during the opposition proceedings, did not prejudice maintenance of the patent in suit. The Board has no reason to take a different position.

4. *Novelty*

4.1 In their statement setting out the grounds of appeal the appellants have maintained their novelty attacks having regard to the disclosures of D3 and D9 but they have no longer pursued the objection of lack of novelty against the claimed subject-matter of the Main Request having regard to D10b raised in their letter dated 4 November 2003. Furthermore, during the oral proceedings before the Board, the appellants have no longer pursued the alleged lack of novelty of the claimed subject-matter of the Main Request having regard to D9. Hence, lack of novelty having regard to D3 is the only remaining attack.

4.2 The novelty attack having regard to D3 is based on Examples 47 and 48, in particular on the imination step and the consequences thereof. The arguments brought forward by the appellants in that respect rely on alleged common general knowledge about imination of acrylic or methacrylic polymers. That common general knowledge is however contested by the respondents. Like for any other fact in dispute, also common general knowledge needs evidence (T 0766/91 of 29 September 1993, Point 8.2 of the Reasons), which has not been submitted by the appellants.

4.3 In view of the controversial dispute about the chemical consequences of the imination step illustrated in Example 47 of D3, evidence of which has not been

submitted by any of the parties, and in view of the fact that the claimed subject-matter nevertheless lacks an inventive step over D10b (Points 5, *infra*), the question whether the claimed subject-matter is novel over the use illustrated in Example 48 of D3 can be left undecided.

4.4 Therefore, the decision of the Board relies on the issue of inventive step, which was discussed by both parties, in particular having regard to D9 and D10b.

5. *Inventive step*

5.1 The patent in suit concerns hair cosmetic compositions which shall be suitable to provide superior natural gloss or lustre to the hair and enhanced hair-dressing ability, and can prevent hair damage and repair damaged hair (Paragraph [0001]).

5.2 These compositions are aqueous and must include amounts of fine particles of a water-insoluble polymer or inorganic material, which have an average particle diameter not smaller than 0.2 μm but smaller than 1 μm (Paragraph [0009]).

Closest prior art

5.3 D9 and D10b have both been cited as documents describing the closest prior art.

5.4 The closest prior art according to the problem-solution approach applied by the Boards of Appeal when assessing inventive step is normally the document having the same purpose or effect as the patent in suit and addressing

the same or a similar problem and requiring the minimum of structural or compositional modifications (case Law of the Boards of Appeal of the EPO, 5th edition, 2006, I.D.3.1 to 3.3). Hence, it has to be decided which of D9 and D10b describes the closest prior art.

5.5 D9 concerns an aqueous hairspray composition comprising:

(i) a water-soluble polymer having a solution viscosity at 10% in water of less than about 20,000 cps at 25°C, the polymer being selected from the group consisting of nonionic, anionic, cationic and amphoteric hair fixatives; and

(ii) a latex of water-insoluble polymeric particles dispersed in water, the average particle size being no larger than about 3 microns, the particles having a glass transition temperature from 250° to 300° K and being formed of monomers selected from the group consisting of styrene, α -methylstyrene, divinylbenzene, C₁-C₂₀ ester of acrylic acid, methacrylic acid, methylmethacrylate, acrylamide, methacrylamide, crotonic acid, maleic acid, vinyl acetate, vinyl neodecanoate and combinations thereof, and the water-soluble polymer to latex particles being present in a weight ratio ranging from about 10:1 to about 1:10 (Claim 1).

In that composition the average particle size can be no larger than 1 μ m (Claim 3), preferably from 0.005 to 1 μ m (column 4, lines 37-38).

D9 also discloses a method for setting hair comprising contacting the hair with the aqueous hairspray composition (Claim 12).

The object of D9 is to provide a hairspray suitable for water-based systems having improved holding and styling characteristics (column 2, lines 32-34). A further object is to provide a hairspray composition for water-based systems that improves glossiness of the hair to counteract resins that usually tend to dull hair (column 2, lines 11-12 and 39-41).

To improve glossiness to counteract dullness imparted by resins deposited upon hair, D9 proposes the use of luster agents, in particular low levels of C₁₀-C₂₀ fatty alcohol esters, more particularly cetearyl octanoate (column 5, lines 63-67).

All of the examples of D9 concern compositions containing particles having a size smaller than 0.2 μm and cetearyl octanoate, and not containing any cationic compound.

- 5.6 D10b concerns a hair cosmetic composition comprising a cured polyorganosiloxane in powder form (Claim 1).

That cosmetic composition should impart excellent lustre and a smooth grip to the hair as well as improve the combability and provide a hair-dressing effect (Paragraphs [0001] and [0003]).

An essential element of the composition is represented by the powdery cured polyorganosiloxane having almost a spherical form and a narrow particle size distribution, so that at least 80% of the particles are within the range of $\pm 30\%$ of the average particle size. The average particle size should range from at least 0.05 μm , to provide good grip and combability, to preferably

100 μm , so that good lustre is provided. Particularly preferred are particles having an average particle size falling within the range of 0.1 to 20 μm (Paragraph [0007], lines 3 to 7 from bottom). The cured silicon particles are insoluble in the solvent (paragraph [0008], second sentence).

As regards the examples, D10b firstly illustrates four ways for synthesizing the polymer particles (Synthesebeispiele 1-4), then their use in cosmetic compositions.

The particles as synthesized are identified as P-1 to P-4 and have, respectively, an average particle size of 2 μm (P-1) and 4.5 μm (P-2), or a particle size ranging from 1 to 50 μm (P-3) of from 0.5 to 10 μm (P-4). Hence, the average diameter of the particles P-3 and P-4 is not disclosed.

If reference is made to the examples concerning particles P-1 and P-2, the following picture can be gathered:

- Example 1 illustrates the composition of a non-aqueous hair spray product, comprising particles P-1 in combination with further silicone fluids and propellants.
- Example 3 illustrates the composition of an aqueous two-in-one shampoo containing *inter alia* particles P-2 and a cationic cellulose as well.
- Example 4 illustrates the composition of a hair treatment product containing *inter alia* particles P-1.

The evaluation of the sought-for aesthetic effects (smoothness, combability, volume, grip, lustre), made by a panel of 10 experts, who ranked the products according to three criteria as follows: very good (3 points), good (2 points), normal (1 point), gave the results illustrated in the Table on page 13 of D10b.

It is in particular apparent from those results that all of the exemplified uses gave a better than good or almost very good result in terms of smoothness, combability, volume, grip and lustre of the hair. In particular, the cosmetic composition of Example 1 containing particles P-1 (average particle size of 2 μm) gives the best overall results, followed by the compositions of Example 3 containing particles P-2 (average particle size of 4.5 μm) and of Example 4 containing particles P-1. The use of particles P-1 (average particle size of 2 μm) always gives a better than good lustre, namely as high as 2.8 (non-aqueous hair spray of Example 1) and 2.4 (aqueous hair treatment composition of Example 4). The use of particles P-2 (average particle size of 4.5 μm) in combination with a cationic cellulosic compound gives a better than good lustre as high as 2.8 (two-in-one shampoo of Example 3).

Example 3 of D10b illustrates an aqueous cosmetic composition comprising fine particles of a water insoluble polymer, whereby the particles have an average size of 4.5 μm , and also a cationic cellulosic compound. That composition has been shown to give an almost very good lustre as well as almost very good hair-dressing properties. Hence, the use of the composition of Example 3 of D10b may represent the

closest prior art. The claimed subject-matter differs from that prior art only in the average size of the particles.

5.7 Since in the present case Claim 1 concerns the use of a composition for a particular purpose, namely to attain good gloss or lustre of the hair, whereby the composition to be suitable needs to have a defined particle size range and the presence of a cationic compound, the closest prior art cannot be represented by a document like D9, which discloses aqueous compositions which are merely suitable for counteracting a dulling effect, i.e. for reducing loss of gloss, by the presence of additional components of the composition, not required in Claim 1, and which neither discloses the particle size nor the presence of a cationic compound.

5.8 Therefore, D10b represents the closest prior art for the purpose of applying the problem solution approach.

Problem and solution

5.9 The patent specification addresses the problem of providing a hair cosmetic composition which imparts excellent natural gloss or lustre to hair and enhanced hair-dressing ability.

5.10 The uses of the compositions exemplified in D10b all give better than good lustre and hair-dressing ability compared to the uses of compositions that were free of the silicone particles.

5.11 The patent in suit does not contain any comparative examples concerning the composition illustrated in Example 3 of D10b, nor examples illustrating the use of particles having an average diameter between 1 and 4.5 μm , e.g. 2 μm . In fact, Comparative product 3 of the patent in suit contains silicone particles having an average diameter of 4.5 μm but not a cationic compound (e.g. cellulosic polymer). Further, the examples of the patent in suit in particular show that:

- (a) The hair spray composition of Example 6, using particles of styrene-divinylbenzene-acrylic acid terpolymer, whereby the particles have indeterminate form and average particle diameter of 1.0 μm (i.e. outside the range defined in Claim 1), nevertheless gives better gloss and enhancing effect (Table 6) than that given by the hair spray composition of Example 8, which contains spherical particles of TiO_2 of average particle diameter of 0.6 μm . Thus, the upper average particle size limit of 1 μm defined in Claim 1 is not critical.
- (b) Instead, the narrowness of the particle size distribution appears to be critical. If the distribution is not narrow so that at least 80% of the particles are within the range of $\pm 30\%$ of the average particle size (as defined in Claim 3), the use of the composition thereof (Invention Product 8) does not lead to the sought-for excellent lustre and hair-dressing abilities (Table 4).

Since the definition of Claim 1 relies on particles having an upper limit of smaller than 1 μm and does not require a narrow distribution for the particle sizes about the average diameter, excellent natural gloss or lustre and enhanced hair-dressing ability cannot be

presumed to be always obtained. Consequently, the ambitious problem stated in the patent in suit cannot be solved within the whole breadth of Claim 1.

Furthermore, it is not apparent that any improvement over the uses of the compositions illustrated by D10b is obtained which could be considered in determining the problem underlying the invention and therefore in assessing inventive step (Case Law, *supra*, I.D.4.2). Thus, the problem to be solved should be reformulated less ambitiously.

- 5.12 Having regard to D10b, the problem to be solved is to provide a use of a further aqueous cosmetic compositions suitable for imparting a good gloss or lustre and hair-dressing ability to the hair.

Character of the solution

- 5.13 There is an explicit disclosure in D10b, that the particle size distribution should be narrow and that the average particle size of the aqueous cosmetic compositions is critical: to obtain good grip and combability, the average particle size should at least be 0.05 μm , whilst to obtain good lustre it should be smaller than 100 μm . Preferably, the average particle size should be within the range from 0.1 to 20 μm (paragraph [0007], last seven lines of page 4/13 of D10b). The examples of D10b reflect the criticality of those parameters, and compositions containing particles P-3 and P-4 do not perform as well as those containing particles P-1 and P-2 (Table of page 13). The examples also show that a particle size smaller than 4.5 μm , say 2 μm , gives good results even in the absence of any cationic compounds. Furthermore, aqueous compositions

containing a cationic compound and particles of average diameter of 4.5 μm give better than good lustre and hair-dressing ability, i.e. the use of a cationic compound is beneficial. Consequently, for the skilled person starting from D10b with the aim of providing further uses of cosmetic compositions leading to good lustre and hair-dressing ability, it would be obvious to try to reduce the size of the particles within the possibilities encompassed by D10b, e.g. from those used in Example 3 of D10b towards the lower limit of the range disclosed (0.1 μm).

5.14 Consequently, the claimed use is obvious over D10b by itself and does not involve an inventive step.

5.15 It follows from the above that the ground of opposition under Article 100(a) EPC prejudices maintenance of the patent in suit amended according to the Main Request.

Auxiliary Request

6. *Amendments*

6.1 Compared to Claim 1 underlying the decision under appeal, Claim 1 according to the Auxiliary Request contains the following amendment "selected from cationic surfactants and cationic polymers", to limit the cationic compound used for the surface treatment of the particles and/or additionally present in the composition. The amendment has a basis in the application as filed (page 8, lines 17-19; page 14, lines 12-17; page 15, lines 10-13; Claims 7 and 8) and restrict the protection conferred by the patent. The amendment aims at overcoming a ground of opposition,

the alleged lack of novelty over D3. Hence, the amended claims fulfil the requirements of Article 123, paragraphs 2 and 3, EPC as well as those of Rule 57a EPC. The Auxiliary Request is thus formally allowable.

6.2 *Novelty*

The appellants did not contest that the claimed use is novel over that disclosed by D3. The Board has no reason to take a different position.

6.3 *Inventive step*

- 6.3.1 D10b is considered to disclose the closest prior art also for the subject-matter of the Auxiliary Request, in particular because the composition according to Example 3 contains a cationic polymer (cationic cellulose). There is no evidence on file that the amended feature provides any technical effect different from that argued for the Main Request. Consequently, the problem to be solved over D10b does not change (Points 5.9 - 5.12, *supra*). Therefore, the reasons given in connection with the Main Request (Point 5.13 - 5.15, *supra*), with respect to lack of an inventive step, apply *mutatis mutandis* to the Auxiliary Request as well, and prejudices the maintenance of the patent in the form of that request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

K. Götz

S. Perryman