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**Datasheet for the decision
of 28 September 2006**

Case Number: T 1445/04 - 3.3.06
Application Number: 96908067.0
Publication Number: 0814767
IPC: A61K 7/50
Language of the proceedings: EN

Title of invention:
Hair conditioning composition

Patentees
UNILEVER PLC, et al

Opponents:
KPSS-Kao Professional Salon Services GmbH
HENKEL KGaA
Cognis Deutschland GmbH
L'OREAL

Headword:
Rinsed-off/UNILEVER

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Subject-matter extending beyond the content of the
application as filed (main request and auxiliary request 1):
yes - omission of an essential feature"

Decisions cited:
-

Catchword:
-



Case Number: T 1445/04 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 28 September 2006

Appellants:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 14 October 2004
revoking European patent No. 0814767 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P.-P. Bracke
Members: G. Raths
J. Van Moer

Summary of Facts and Submissions

- I. This appeal is from the decision of the Opposition Division to revoke the European patent No. 0 814 767 relating to a hair conditioning composition.
- II. Four oppositions had been filed on the grounds of Article 100 (a) and (b) EPC, in particular for lack of sufficiency of disclosure (Article 83 EPC), lack of novelty (Article 54 (1) (2) EPC) and inventive step (Article 56 EPC) relying, *inter alia*, on the following documents:
- (4) WO-A-91/17975 and
(7) EP-A-0 636 356.
- III. In its decision the Opposition Division stated that the proprietors withdrew the main request. Further, it found that the invention was sufficiently disclosed.
- With respect to novelty, the subject-matter of Claim 1 of auxiliary request 1 was not novel in view of document (7).
- In respect of auxiliary request 2, the Opposition Division found that the requirements of Article 123(2) EPC were not met.
- IV. The proprietors (hereinafter appellants) filed an appeal against this decision and submitted a main request as well as auxiliary requests 1 and 2. All these requests were replaced at the beginning of the oral proceedings, which took place on 28 September 2006, by a new main request and a new auxiliary request 1.

Claim 1 of the new main request reads as follows:

"1. A method of conditioning hair which comprises applying to wet hair after washing a transparent hair conditioning composition comprising a transparent aqueous dispersion of:

(i) a hair conditioning compound comprising a substantially water-insoluble quaternary ammonium material having two C₁₂₋₂₈ alkyl or alkenyl groups connected to the quaternary ammonium head group via at least one ester linkage, and;

(ii) a solubilising agent which is cetyl trimethylammonium chloride

characterised in that when the hair conditioning composition is formulated with water to a concentration of 1 wt% of the hair conditioning compound (i), the compound (i) is substantially present in solution."

Claim 1 of the new auxiliary request 1 differs from Claim 1 of the new main request in that the words "and then rinsing off" are inserted between "after washing" and "a transparent hair conditioning composition".

- V. The appellants argued that the reasoning of the Opposition Division to make a technical distinction between *rinse-off* and *leave-on* methods of hair conditioning was incorrect. Only the end-user would decide whether the formulation is *left-on* or *rinsed-off*. The *rinsing-off* step would not be an essential feature to the invention. The *rinsing-off* of the composition would not contribute to the technical solution of the problem.

VI. The opponents (respondents) requested that the main request and the auxiliary request 1 filed at the oral proceedings before the Board should be disregarded because they were not submitted in due time, and then refuted the arguments of the appellants.

(a) They argued that the invention could not be carried out by a person skilled in the art and that, therefore, the requirements of Article 83 EPC would not be fulfilled.

(b) The skilled person and the end user would make a distinction between *leave-on* and *rinse-off* hair conditioning methods. They referred to the documents

(S) Karlheinz Schrader, "Grundlagen und Rezepturen der Kosmetika", 2. verbesserte und erweiterte Auflage, Hüthig Buch Verlag Heidelberg, 1989, Seite 723.

(29) Josef Koester, Eigenschaften und Anwendung kationischer Haarpflegeadditive, Parfümerie und Kosmetik, 72, Jahrgang, Nr. 4/91, pages 218-225;

(30) D. Hollenberg et al., Haarkosmetik, Möglichkeiten zur Beeinflussung der Haarstruktur durch Pflegeprodukte, 1994, pages 151-168; and

(31) Kosmetik, Entwicklung, Herstellung und Anwendung kosmetischer Mittel, herausgegeben von Wilfried Umbach, Georg Thieme Verlag, 1988, page 255.

All these documents mention *leave-on* and *rinse-off* methods. At variance, the passage on page 15, lines 15

to 19 of the application as filed would only disclose *rinse-off* and not *leave-on* hair conditioning methods. The *rinsing-off* step as well as the period of letting the conditioner on the hair would be missing in the claim.

Therefore, the subject-matter of Claim 1 of the main request and of the auxiliary request 1 would contravene Article 123(2) EPC, would further not be novel, *inter alia*, over document (7) and would not involve an inventive step.

VII. The appellants request that the decision under appeal be set aside, that a favourable decision be taken in regard of Article 83 and 123(2) EPC and of novelty and the case be remitted to the first instance for further prosecution.

The respondents request that the appeal be dismissed.

Reasons for the decision

1. Procedural issues

1.1 At the beginning of the oral proceedings before the Board, the appellants submitted a new main request and a new auxiliary request 1.

1.2 Respondent 1 objected that the new main request and the new auxiliary request 1 were not filed in due time and requested that these requests should therefore be disregarded. It referred to Article 10a(2) of the Rules of Procedure of the Boards of Appeal.

1.3 Article 10a(2) of the Rules of Procedure of the Boards of Appeal, OJ EPO 2004, 541, states that

"[t]he statement of the grounds of appeal and the reply shall contain a party's complete case".

1.4 As the Board, in this case, has however admitted the new main request and the new auxiliary requests into the proceedings, the Board finds it appropriate to comment on the circumstances of the present case.

1.4.1 Component (ii) of Claim 1 as granted was defined in the following terms:

"(ii) a solubilising agent which comprises a cationic surfactant".

Claim 6 as granted read:

"A hair conditioning composition according to any one of the preceding claims, in which the solubilising agent is cetyl trimethylammonium chloride."

1.4.2 Component (ii) of Claim 1 of the main request and of the auxiliary requests 1 and 2 filed together with the statement setting out the grounds of appeal had been defined as follows:

"(ii) a solubilising agent comprising a cationic surfactant".

1.4.3 Component (ii) of Claim 1 of the new main request and of the new auxiliary request filed at the beginning of the oral proceedings had been defined as follows:

"(ii) a solubilising agent which is cetyl trimethylammonium chloride".

This wording differs from the wording of Claim 1 of the main request and of the auxiliary requests 1 and 2 defined under point 1.4.2 (known to the respondents before the opening of the oral proceedings before the Board) in that the definition is more concise.

The definition of the solubilising agent of claim 6 as granted was incorporated in Claim 1 of the new main request and the new auxiliary request 1 filed at the oral proceedings before the Board.

1.5 In this case, the Board admits the new main request and the new auxiliary request 1 into the proceedings since Claim 6 had also been present in the main request and auxiliary requests 1 and 2 as filed with the statement setting out the grounds of appeal. The solubilising agent had now been defined as cetyl trimethylammonium chloride.

The amendment was concise, clear and unambiguous and did not require further examination for understanding the meaning of the claim. So, the respondents could reasonably be expected to understand the meaning of the amendment without undue burden. In this case, the respondents were not unfairly prejudiced by the late introduction of both requests.

2. Article 83 EPC

The Board is satisfied that the requirements of Article 83 EPC are met. Since the appeal fails for other reasons, no detailed arguments have to be given.

3. Article 123(2) EPC

3.1 Main request

3.1.1 The respondents argued that Claim 1 had been amended in a way that it contained subject-matter which extended beyond the content of the application as filed.

The objection concerned the passage of Claim 1 reading as follows:

"A method of conditioning hair which comprises applying to wet hair after washing a transparent hair conditioning composition..."

The respondents pointed to the following passage in the application as filed:

"The hair conditioning compositions of the invention are intended particularly for post-wash use. The composition is **applied to wet hair after washing** in a suitable amount, eg in the range 5 to 10 grams/head, **left for about a minute and then rinsed off.**" (emphasis added)
(page 15, lines 15 to 19)

The respondents argued that this passage disclosed a *rinse-off* method, but not a *leave-on* method.

The appellants however argued that the sentence

"The hair conditioning compositions of the invention are intended particularly for post-wash use."

would imply that the post-wash use would comprise a *leave-on* method as well as a *rinse-off* method. The passage following this sentence would only exemplify one post-wash method i.e. the *rinse-off* method, but would not limit the post-wash method to the *rinse-off* method. Also, the post-wash method would comprise either application of a hair conditioning composition to wet hair or the *leave-on* method or the *rinse-off* method.

3.1.2 The Board does not agree with the reasoning of the appellants.

Considering the passage on page 15, lines 16 to 19 of the application as filed, the question is whether each feature of the method i.e.

- 1) "applied to wet hair after washing"
- 2) "left for about a minute" and
- 3) "then rinsed off" (see the emphasis added under point 3.1.1)

can individually be extracted of this set of features and used independently from the other two features to characterise the method which is claimed, or whether all the three features form one indivisible embodiment.

3.1.3 In order to answer this question the Board examined whether the feature "left for about a minute" is of technical relevance for the definition of the claimed method or not.

Document (29) discloses that hair conditioners are divided up in two types of compositions:

(A) compositions which are *rinsed-off* like intensive cures left for 10 to 15 minutes on the hair, or quick cures (rinsing) left for 1 to 5 minutes on the hair (page 219, columns 2 and 3, tables lines 10 to 16 from the bottom);

(B) compositions which are *left-on* the hair.

Hence, the skilled person makes a distinction between compositions (A) which are left on the hair for a certain time and then *rinsed-off* and compositions (B) which are left on the hair and **not** *rinsed-off*.

Even more, according to document (31), page 255, under the heading "Haarpflegemittel, die ausgespült werden", within the group of hair conditioning compositions which are *rinsed-off* a difference is made between those applied to wet hair, massaged and carefully rinsed (Haarspülungen) and those which are also applied to wet hair, massaged but left on the hair for up to 10 minutes (Kurpackungen) and then *rinsed-off*.

So, the feature relating to the time of letting the composition on the hair is of technical importance.

The time feature "left for about a minute" in combination with being applied on wet hair and afterwards being *rinsed-off* decides on the category. In this case, the composition belongs to the category (A) i.e. a rinsing composition not being intended to be used as "Kurpackung". It follows that all three features

- 1) "applied to wet hair after washing"
- 2) "left for about a minute" and
- 3) "then rinsed off"

form an indivisible embodiment.

- 3.1.4 Therefore the omission of the essential features "left for about a minute" and "*rinsed-off*" is an inadmissible extension of the subject-matter of Claim 1.

The subject-matter of Claim 1 contravenes Article 123(2) EPC.

- 3.2 Auxiliary request 1

The reasoning under points 3.1.1 to 3.1.3 applies *mutatis mutandis* to the subject-matter of Claim 1 of auxiliary request 1, since, here, the essential feature "left for about a minute" has been omitted.

Therefore, also the subject-matter of Claim 1 of auxiliary request 1 contravenes Article 123(2) EPC.

4. For the above mentioned reasons, none of the requests meets the requirements of the EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P.-P. Bracke