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**Datasheet for the decision
of 21 May 2008**

Case Number: T 1392/05 - 3.3.10

Application Number: 95307524.9

Publication Number: 0709083

IPC: A61K 7/48

Language of the proceedings: EN

Title of invention:
Cosmetic compositions

Patentee:
Revlon Consumer Products Corporation

Opponent:
L'OREAL

Headword:
Cosmetic compositions/REVLON

Relevant legal provisions:
EPC Art. 54, 100(c)

Keyword:
"Fresh ground for opposition - extent of power to examine"
"Novelty (yes)"
"Remittal to the first instance for further prosecution"

Decisions cited:
G 0009/91, G 0010/91

Catchword:
-



Case Number: T 1392/05 - 3.3.10

DECISION
of the Technical Board of Appeal 3.3.10
of 21 May 2008

Appellant: Revlon Consumer Products Corporation
(Patent Proprietor) 625 Madison Avenue
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Respondent: L'OREAL
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 30 August 2005
revoking European patent No. 0709083 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: R. Freimuth
Members: J.-C. Schmid
J.-P. Seitz

Summary of Facts and Submissions

I. The Appellant (Proprietor of the patent) lodged an appeal on 31 October 2005 against the decision of the Opposition Division dated 30 August 2005 revoking European patent No. 709 083. Claim 1 of the granted patent read as follows:

"1. A cosmetic composition in the form of a water and oil emulsion comprising:

- (a) from 0.1 to 60% by weight of trimethylated silica;
- (b) from 0.1 to 60% by weight of a volatile solvent having a viscosity of from 0.5 to 100 mPa.s at 25°C;
- (c) from 0.1 to 60% by weight of dimethicone and/or dimethicone copolyol; and
- (d) from 0.1 to 80% of a cosmetically acceptable carrier;

wherein the volatile solvent comprises a volatile silicone and

wherein at least a portion of the trimethylated silica and the volatile silicone are present as a pre-blended mixture."

II. Notice of opposition had been filed by the Respondent (Opponent) requesting revocation of the patent in suit in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC) based *inter alia* on document

- (1) EP-A-0 600 445.

- III. The Opposition Division held that example 12 of document (1) anticipated the subject-matter of claim 1 of the patent as granted. Furthermore, the Opposition Division found that the additional objections brought forward by the Respondent during the oral proceedings for the revocation of the patent-in-suit on the reason of extending the subject-matter of the patent-in-suit beyond the content of the application as filed were *prima facie* not pertinent and, hence, did not admit this fresh ground for opposition under Article 100(c) into the opposition proceedings.
- IV. As regards novelty the Appellant submitted *inter alia* that no dimethicone and/or dimethicone copolyol were disclosed in the composition disclosed in example 12 of document (1).
- V. As regards novelty, the Respondent submitted that example 12 of document (1) disclosed all the essential ingredients present in the claimed composition. Document (1) did not disclose any dimethicone or dimethicone copolyol, but those compounds were comprised within the ambit of the component "organosiloxane" of the composition of example 12. Furthermore the subject-matter of claim 1 extended beyond the content of the application as filed. The Respondent requested that the relevance of this ground for opposition be considered by the Board and the ground be admitted into the proceedings.
- VI. At the oral proceedings before the Board, held on 21 May 2008, the Appellant did not agree to the introduction of the fresh ground for opposition according to Article 100(c) EPC. The discussion

focussed on the question whether the Opposition Division had exercised due discretion in not admitting this fresh ground for opposition into the proceedings.

VII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained as granted, or, subsidiarily, on the basis of auxiliary requests 1 and 2 submitted on 17 April 2008.

The Respondent requested that the appeal be dismissed.

VIII. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Fresh ground for opposition according to Article 100(c) EPC: extent of power to examine*

In opposition as well as in appeal proceedings, the Respondent objected to amendments comprised in claim 1 as granted as extending beyond the content of the application as filed. This objection is therefore based on a ground for opposition according to Article 100(c) EPC.

The only grounds for opposition which were raised and substantiated within the period according to Article 99(1) EPC were novelty and inventive step (Article 100(a) EPC). Following the late introduction of the fresh ground for opposition according to

Article 100(c) EPC in the opposition proceedings, the Opposition Division held that it was *prima facie* not relevant and, thus, exercised its discretion to discard this ground for opposition.

Accordingly, having not been admitted into the proceedings by the Opposition Division, the objection maintained by the Respondent in appeal proceedings to amendments comprised in claim 1 as granted of extending beyond the content of the application as filed remains a fresh ground for opposition in the present appeal proceedings.

The introduction of new grounds for opposition at the appeal stage is governed by G 9/91 (OJ EPO 1993, 408, points 16 and 18 of the reasons) and G 10/91 (OJ EPO 1993, 420, point 3 of the headnote) where it is held that fresh grounds of opposition may be considered in appeal proceedings only with the approval of the proprietor of the patent. Hence, in the present case, the fresh ground of opposition according to Article 100(c) EPC may not be introduced into the appeal proceedings without the approval of the Proprietor of the patent, here the Appellant. As the Appellant did not agree to the introduction of this fresh ground (see point VI above), the Board does not have the power to consider this ground for opposition.

Main request

3. *Novelty*

The main issue to be decided in this appeal is whether or not the decision under appeal was right to find that

the subject-matter of the claims lacked novelty with respect to example 12 of document (1), the Appellant having challenged that finding of the Opposition Division.

Claim 1 is directed to a composition comprising *inter alia* dimethicone or dimethicone copolyol (component (c)) while example 12 of document (1), on which the decision for revoking the patent for lack of novelty refers to, discloses a composition comprising a polyoxyalkylene modified organosiloxane. The Respondent, while acknowledging that document (1) did not disclose dimethicone and dimethicone copolyol, submitted that these specific compounds were within the ambit of the generic term "organosiloxane".

The general principle consistently applied by the Boards of Appeal for concluding lack of novelty is that there must be a direct and unambiguous disclosure in the state of the art which would inevitably lead the skilled person to subject-matter falling within the scope of what is claimed.

An organosiloxane is a compound that comprises siloxane units substituted by any organic moieties whereas dimethicone and dimethicone copolyol are compounds that comprise siloxane units which are specifically disubstituted with methyl groups.

Accordingly, though comprised within the general expression "organosiloxane" found in document (1), there is no specific disclosure in that document of dimethicone or dimethicone copolyol. The disclosed composition comprising a generically defined

"organosiloxane" cannot destroy the novelty of a composition comprising specific polydimethylsiloxane polymers, such as those specified in claim 1 as "dimethicone".

The subject-matter of claim 1 is therefore not anticipated by example 12 of document (1).

4. *Remittal*

Having so decided, the Board has not, however, taken a decision on the whole matter, since the decision under appeal dealt exclusively with lack of novelty of granted claim 1 with respect to example 12 of document (1). The above findings have the effect that the reasons given in the contested decision for revoking the patent no longer apply. The Opposition Division has, however, not yet ruled on novelty with respect to the other cited documents nor on inventive step. It is not the duty of the Boards of Appeal to consider and decide upon questions raised for the first time during the appeal proceedings. Instead, the main purpose of appeal proceedings is to give the losing party the opportunity to challenge the decision of the Opposition Division (cf. G 9/91, loc. cit., point 18 of the reasons). Taking into account that there were also no submissions from either party as regards novelty over other documents or inventive step during appeal proceedings, the Board considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit the case to the Opposition Division for further prosecution.

When reconsidering the case, and more particularly the admissibility of the late filed ground for opposition according to Article 100(c) EPC, the Opposition Division may give a reasoning including factual considerations supporting the finding of whether or not the reasons invoked by the opponent are *prima facie* relevant. A mere statement of the conclusion at which the Opposition Division arrives when exercising due discretion to admit or not that ground for opposition into the proceedings, i.e. whether or not it is *prima facie* relevant, may appear not to be sufficient for the written decision being reasoned within the sense of Rule 111(2) EPC.

Auxiliary requests 1 and 2

5. Since the preceding main request is found to be novel and, thus, remitted to the first instance for the reasons set out above, there is no need for the Board to decide on the lower ranking auxiliary requests 1 and 2.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the patent as granted.

The Registrar

The Chairman

P. Cremona

R. Freimuth