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**Datasheet for the decision
of 22 June 2010**

Case Number: T 1663/07 - 3.3.06

Application Number: 97945196.0

Publication Number: 0934056

IPC: A61K 7/50

Language of the proceedings: EN

Title of invention:

Cleansing products

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponents:

Johnson & Johnson Consumer Companies, Inc.
Henkel AG & Co. KGaA
GEORGIA-PACIFIC FRANCE
Unilever PLC
KIMERLY-CLARK WORLDWIDE, INC.

Headword:

Single use cleansing products/P&G

Relevant legal provisions:

RPBA Art. 13(1)(3)

Relevant legal provisions (EPC 1973):

EPC Art. 56

Keyword:

"Inventive step - main request, first auxiliary request (no)"
"Admissibility of late-filed requests - second and third
auxiliary request (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 1663/07 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 22 June 2010

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
26 July 2007 concerning maintenance of European
patent No. 0934056 in amended form.

Composition of the Board:

Chairman: P.-P. Bracke
Members: E. Bendl
U. Tronser

Summary of Facts and Submissions

I. The appeals are from the decision of the Opposition Division to maintain the European patent 0 934 056 in amended form.

II. In opposition proceedings the Opponents raised inter alia objections concerning lack of inventive step and cited among other documents:

D1 = DE-A-2 402 730

D20 = FR-A-2 271 808

D24 = Substitute declaration of David M. McAtee

The Opposition Division considered the then pending main request as unclear, but maintained the patent on the basis of the then pending first auxiliary request.

III. The set of claims as maintained by the Opposition Division contained in total seven claims; the only independent Claim 1 reads as follows:

"1. A method of manufacturing a disposable, single use personal care cleansing and conditioning product, the product comprising:

(A) a water insoluble substrate,

(B) a lathering surfactant, and

(C) a conditioning component comprising,

(i) a water soluble conditioning agent, and

(ii) an oil soluble conditioning agent,

wherein the weight ratio of the lathering surfactant to the conditioning component is less than 40:7;

wherein said water insoluble substrate is selected from the group consisting of nonwoven substrates,

preferably, a nonwoven sheet of fibers selected from the group consisting of rayon fibers, cellulose fibers, polyester fibers, and mixtures thereof; woven substrates; hydroentangled substrates; natural sponges; synthetic sponges; polymeric netted meshes; formed films; and mixtures thereof; wherein said product is substantially free of water, comprising less than 10%, by weight, of water and generally feels dry to the touch, wherein the method comprises the step of separately adding onto or impregnating into the water-insoluble substrate, preferably by spraying, laser printing, splashing, dipping, or coating, the lathering surfactant and the conditioning component."

- IV. Opponent I, thereafter referred to as Appellant I, filed on 04 October 2007 an appeal against the decision of the Opposition Division and paid simultaneously the appeal fee; the grounds of appeal were filed on 30 November 2007. Opponent III, thereafter referred to as Appellant II, filed the appeal on 27 September 2007 together with the payment of the appeal fee; the grounds of appeal were filed on 29 November 2007. Both Appellants objected inter alia as to lack of inventive step.
- V. With the letter of 03 July 2008 the Patent proprietor, thereafter referred to as Respondent, argued that the set of claims as maintained by the Opposition Division, i.e. the main request in appeal procedure, met the requirements of the EPC and filed auxiliary request I. Further arguments and auxiliary requests II and III were submitted with letter of 21 May 2010.

VI. The wording of Claim 1 of the **first auxiliary request** differs from the wording of Claim 1 of the main request in the replacement of the passage "the lathering surfactant and the conditioning component" by the text "the lathering surfactant, the water soluble conditioning agent and the oil soluble conditioning agent".

The wording of Claim 1 of the **second and third auxiliary requests** differed from the main and the first auxiliary request by the addition of the parameters of Claims 2 and 6.

VII. All parties either explicitly withdrew their request for oral proceedings or stated that they would not attend oral proceedings. Thus, oral proceedings were held on 22 June 2010 in the absence of all parties.

VIII. The main arguments of the Appellants with regard to inventive step were as follows:

- The only difference between the closest state of the art, D1/D20, and Claim 1 of the main request is the separate, rather than simultaneous, application of the surfactant and the conditioning components onto the water-insoluble substrate.
- The examples of D24, allegedly showing an improved effect of the patent-in-suit, refer to a different method than presently claimed and cannot serve to demonstrate any effect of the patent-in-suit.

- The patent-in-suit does not make any difference between the simultaneous and the separate application of the components.
- The objective problem underlying the invention is the provision of an alternative method.
- Since the alternative of applying compounds separately instead of simultaneously is "self-evident" to a person skilled in the art, the patent-in-suit does not involve an inventive step.

IX. The Respondent's main argumentation concerning the requirements of Article 56 EPC 1973 was as follows:

Main request

- The effects of the patent-in-suit, exemplified in document D24 by using a combination of a lathering surfactant and an oil-soluble conditioning agent, would also work in a method additionally using a water-soluble conditioning agent.
- Since data have been provided, which show the effect achieved, the burden of proof shifts to the Opponents.
- Even when regarding the objective technical problem as the provision of an alternative method, the invention claimed would still not be obvious.

First auxiliary request

- The same arguments as for the main request apply.

- "In addition, there is no disclosure in any of those documents of separate addition of different types of conditioning agent."

Second auxiliary request

- D20 does not disclose the amount of surfactant and conditioning agent on the basis of the fibrous substrate.
- Coprah diethanolamide, the skin conditioning agent used in D20, is excluded from Claim 1 of the second auxiliary request.

Third auxiliary request

- The third auxiliary request is a combination of the first and second auxiliary request.

X. The Opponents other than Appellants I and II did not file any comments or requests apart from the statements concerning their absence at the oral proceedings.

XI. The Appellants I and II requested in writing to revoke the patent in its entirety.

The Respondent requested in writing to dismiss the appeals or alternatively to maintain the patent on the basis of the first auxiliary request filed with letter of 03 July 2008 or on the basis of either of auxiliary requests II or III, both filed with letter of 21 May 2010.

Reasons for the Decision

1. *Inventive step - main request*

According to the problem and solution approach, which is used by the Boards of Appeal of the European Patent Office in order to decide on the question of inventive step, it has to be determined which technical problem the object of a patent objectively solves vis-à-vis the closest prior art document. It also has to be determined whether or not the solution proposed to overcome this problem is obvious in the light of the available prior art disclosures.

1.1 The Appellants attacked inter alia inventive step of the patent-in-suit starting either from document D1 or from document D20 as the closest prior art. Both documents, D20 and its family member D1, aim at preparing a disposable foaming personal cleansing product containing a foaming agent and at least one conditioning agent. However D20 and D1 are not exactly identical, as can for instance be seen when comparing the examples. For instance Example 4 of D20 differs from Claim 1 of the main request only in the way the lathering surfactant, the oil soluble conditioning agent and the water soluble conditioning agent are applied onto the water insoluble substrate, whereas the examples of D1 are more remote. Thus, D20 is considered to represent the closest state of the art.

1.2 The Respondent argued that applying the lathering surfactant and the conditioning agent separately, instead of simultaneously, onto the water-insoluble substrate results in an increased deposition of the

conditioner on the skin, as demonstrated by document D24.

However, the Board cannot follow the Respondent's reasoning:

The examples described in D24 contain a lathering surfactant and an oil-soluble conditioning agent, but **no water soluble conditioning agent**. Respondent's counter-argument thereto, that compositions comprising the said water-soluble conditioning agent in addition to the oil soluble conditioning agent and the lathering surfactant would behave in the same way as the compositions of D24, has not been proven and no hint, that **separate** application of the conditioning agent and the lathering surfactant to the water insoluble substrate leads to superior results compared to simultaneous application, can be found in the patent-in-suit. On the contrary, the patent-in-suit repeatedly teaches that simultaneous and separate application of the compounds onto the insoluble substrate are equivalent techniques (e.g. see paragraphs [0022], lines 48-49; [0116]; Claim 8, line 52; Claim 9, line 55 of the patent as granted). Thus, the allegedly improved effects do not find a basis in the patent-in-suit and can therefore not be taken into account when discussing the inventive step.

Since no effect vis-à-vis the closest prior art has been shown, the objective technical problem is to be seen in providing an alternative to the method of producing a toilet article described in D20.

- 1.3 As the solution to this problem the method of Claim 1 of the main request has been proposed.
- 1.4 The Board does not have doubts that the provision of such an alternative method has actually been solved by the method proposed in the claims. No objection in this respect has been raised by the Parties.
- 1.5 The remaining question when applying the problem and solution approach is, whether the solution proposed by the patent-in-suit is obvious in view of cited prior art.

As stated above, Example 4 of D20 differs from Claim 1 of the main request only in the fact, that the compounds lathering surfactant, water soluble conditioning agent and oil soluble conditioning agent are admixed prior to application to the water insoluble substrate.

However, when applying at least two compounds to a (water-insoluble) substrate, the alternatives of applying the compounds either one after the other (i.e. separately or sequentially) or at once (i.e. simultaneously) are immediately apparent to any person skilled in the art.

No proof has been filed by the Respondent that the skilled person would expect to encounter problems when using the method of D20, but applying the compounds separately.

Respondent's argument concerning the shift of the burden of proof to the Appellants does also not apply,

given the fact that D24 cannot be considered to furnish convincing proof of the effect alleged to be obtained by the claimed method.

Thus, substituting the simultaneous application shown in D20 by a separate application without demonstrating any unexpected or surprising effect is considered by the Board to be trivial and routine to a person skilled in the art. This variation is regarded not to involve an inventive step. The main request therefore does not meet the requirement of inventive step.

2. *Inventive step - first auxiliary request*

- 2.1 Claim 1 of the first auxiliary request differs from Claim 1 of the main request in the feature that all three compounds, the lathering surfactant, the water soluble conditioning agent and the oil soluble condition agent are separately added onto the water-insoluble substrate. This separate application is also the feature distinguishing Claim 1 of the first auxiliary request from Example 4 of D20. As for the main request, no plausible proof has been submitted, that an effect has been achieved by the said difference.

Consequently, the same line of argumentation as for the main request is valid: the separate application of the compounds to the water-insoluble substrate does not involve an inventive step. Therefore, the requirement of Article 56 EPC 1973 is not met.

3. *Second and third auxiliary request - not admitted by the Board*

3.1 With letter of 21 May 2010 the Respondent submitted auxiliary requests II and III, which contained, compared to the main and first auxiliary request, a combination of Claim 1 with Claims 2 and 6.

Respondent's letter contained only the statement that D1/D20 failed to disclose the amount of surfactant and conditioning agent on the basis of the fibrous substrate and furthermore and that coprah diethanolamide and Lantrol AWS were now excluded as possible skin conditioning agents.

No further explanation, e.g. with regard to the effects caused by the combination of Claims 1, 2 and 6 was given by the Respondent, apart from providing "further distinctions over the prior art".

3.2 Thus, given the late filing and the lack of substantiation the other parties and the Board could not be expected to deal with the amendments without adjournment of the oral proceedings.

Furthermore taking into consideration that no sound reasons were given by the Respondent for filing the amendments at such a late state of the proceedings, the Board decided not to admit the late-filed auxiliary requests II and III into the procedure according to Article 13(1)(3) RPBA (Suppl. OJ EPO 1/2009, page 41).

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

G. Rauh

P.-P. Bracke