

**Internal distribution code:**

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

**Datasheet for the decision  
of 26 November 2009**

**Case Number:** T 2017/07 - 3.3.10

**Application Number:** 99119962.1

**Publication Number:** 1022014

**IPC:** A61K 7/13

**Language of the proceedings:** EN

**Title of invention:**  
Hair dye composition

**Patentee:**  
KAO CORPORATION

**Opponent:**  
Henkel AG & Co. KGaA

**Headword:**  
Hair dye composition/KAO

**Relevant legal provisions:**  
EPC Art. 123(2)(3)

**Keyword:**  
"Main request: extension of protection conferred (yes)"  
"Auxiliary requests 1 to 3: added subject-matter (yes)"

**Decisions cited:**  
T 1208/97, T 0881/01

**Headnote:**

A composition which is specified in a claim to comprise a component in an amount which is defined by a numerical range of values is subject to an implicit proviso excluding the presence of that component in an amount outside of that range.

An amendment restricting the breadth of that component, for instance by narrowing down a generic class or a list of chemical compounds defining that component, has the consequence of limiting the scope of this implicit proviso.

A composition which is defined as comprising the components indicated in the claim is open to the presence of any further components, unless otherwise specified.

In a claim directed to such an openly defined composition, the restriction of the breadth of a component present therein may have the effect of broadening the scope of protection of that claim, with the consequence that in opposition/appeal proceedings such amended claim may extend the protection conferred by the granted patent (Article 123(3) EPC).



Case Number: T 2017/07 - 3.3.10

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.10  
of 26 November 2009

**Appellant:** Henkel AG & Co. KGaA  
(Opponent) Henkelstrasse 67  
D-40589 Düsseldorf (DE)

**Representative:** -

**Respondent:** KAO CORPORATION  
(Patent Proprietor) 14-10, Nihonbashi Kayaba-cho 1-chome  
Chuo-ku  
Tokyo 103-8210 (JP)

**Representative:** Hoffmann Eitle  
Patent- und Rechtsanwälte  
Arabellastraße 4  
D-81925 München (DE)

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
16 November 2007 concerning maintenance of  
European patent No. 1022014 in amended form.

**Composition of the Board:**

**Chairman:** R. Freimuth  
**Members:** J.-C. Schmid  
F. Blumer

## Summary of Facts and Submissions

I. The Appellant (Opponent) lodged an appeal on 11 December 2007 against the interlocutory decision of the Opposition Division, posted on 16 November 2007, which found that the European patent No. 1022014 in the form as amended during opposition proceedings according to the main request met the requirements of the EPC, independent claim 1 reading as follows.

"1. A hair dye composition which comprises (A) an acid dye and (B) alkylene carbonate having 3-5 carbon atoms, said composition exhibiting a pH of 2-6, and having a buffer capacity of 0.007-0.5 gram equivalent/L, wherein the content of the alkylene carbonate is 0.5-50 % by weight, the alkylene carbonate being propylene carbonate, and wherein the composition contains neither benzyloxyethanol nor benzyl alcohol."

II. Notice of opposition was filed by the Appellant requesting revocation of the patent in suit in its entirety on the grounds of lack of inventive step (Article 100(a) EPC).

III. The Opposition Division decided *inter alia* that the subject-matter of the claims as amended during the opposition proceedings neither extended beyond the content of the application as filed nor extended the protection conferred by the European patent, thus fulfilling the requirements of Article 123(2) and (3) EPC, the only amendment with respect to the granted claims being that the alkylene carbonate to be used as component (B) was propylene carbonate, which amendment was considered to be supported by page 3, last line to

page 4, line 3 of the application as filed, the Opponent raising no further objections under Article 123(2) or (3) EPC against these claims.

IV. On 18 August 2008, the Board issued a communication indicating that it appeared that the amendment made in claim 1 of the main request broadened the scope of protection of that claim vis-à-vis to that of claim 1 as granted (Article 123(3) EPC) and that no basis could be found in the application as filed for replacing the original feature "comprising" defining the claimed composition by the fresh feature "consisting of" in the then pending auxiliary requests 1 and 2 (Article 123(2) EPC).

V. At the oral proceedings before the Board, held on 26 November 2009, the Respondent (Proprietor of the patent) defended the maintenance of the patent in suit on the basis of the main request, on which the decision of the Opposition Division was based and on the basis of the auxiliary requests 1, 2 and 3, auxiliary request 1 being filed with the letter of 16 October 2009 while auxiliary requests 2 and 3 being filed with the letter of 30 June 2008.

Claim 1 of auxiliary request 1 differed in essence from claim 1 of the main request in that component (B) read "propylene carbonate, as sole alkylene carbonate having three to five carbon atoms in the composition, in an amount of 0.5 to 50% by weight".

Claim 1 of auxiliary request 2 read as follows:

"1. A hair dye composition consisting of  
(A) an acid dye,

- (B) propylene carbonate in an amount of 0.5 to 50 % by weight,
- (C) optionally an organic or inorganic acid and a salt thereof exhibiting a buffering action in a pH range of 2.0 to 6.0;
- (D) optionally one or more organic solvents selected from the group consisting of phenoxyethanol, phenoxyisopropanol, methylphenoxyethanol, methylphenoxyisopropanol, benzylglycerol, N-benzylformamide, N-methylpyrrolidone, N-ethylpyrrolidone, cinnamyl alcohol, phenethyl alcohol, p-methylbenzyl alcohol, butyl cellosolve, methyl carbitol, ethyl carbitol, propyl carbitol, butyl carbitol, diethylene glycol diethyl ether and dipropylene glycol diethyl ether in an amount of up to 5 wt. % based on the composition of the present invention;
- (E) optionally a water soluble polymer in an amount such that the hair dye composition exhibits a viscosity of 1,000 to 50,000 mPa.s;
- (F) optionally an alcohol or polyol having 2 to 4 carbon atoms in an amount of up to 30 wt.% based on the composition; and
- (G) optionally surfactants, cationic polymers, oily substances, silicone derivatives, perfume bases, preservatives, ultraviolet absorbents, antioxidants, germicides, and/or propellants.

said composition exhibiting a pH of 2-6, and having a buffer capacity of 0.007-0.5 gram equivalent/L, and wherein the composition contains neither benzyloxyethanol nor benzyl alcohol."

Claim 1 of auxiliary request 3 differed from claim 1 of auxiliary request 2 only in that the amount of component (A) in the composition was restricted to "0.2 to 5 % by weight".

VI. According to the Respondent, claim 1 of the main request differed from claim 1 of the patent as granted only by indicating the alkylene carbonate as being propylene carbonate. The wording of Claim 1 left no doubt that the claimed hair dye composition comprised 0.5-50 % by weight of propylene carbonate and that no other alkylene carbonates would be present in the composition.

Since the alkylene carbonate having 3 to 5 carbon atoms was specified in the claim by two sub-definitions, i.e. (B1) by its content of 0.5-50% by weight and (B2) by the alkylene carbonate being propylene carbonate, the combination of these two subordinate clauses to create a single feature in the sense that "the content of the alkylene carbonate being propylene carbonate is 0.5-50% by weight" was a misinterpretation of the claim. The content of the alkylene carbonate in the composition and the type of the alkylene carbonate in the composition were two separate sub-definitions of the alkylene carbonate having 3 to 5 carbon atoms and were to be read as two features independently defining this component. The Respondent took the view that the content of alkylene carbonate was within the range of 0.5-50% by weight and at the same time was propylene carbonate. No other interpretation was possible when carefully reading the relevant part of the claim. Furthermore, it was apparent from paragraphs [0006] and [0010] of the description adapted to claim 1, filed on

19 October 2007 during the first instance proceedings, that the amendment specifying alkylene carbonate as being propylene carbonate expressed that no alkylene carbonate other than propylene carbonate was present in the composition. Therefore, claim 1 of the main request was not amended in a way as to extend the protection conferred by the patent as granted and the requirement of Article 123(3) EPC was fulfilled.

Claim 1 of auxiliary request 1 was amended in order to make clear that propylene carbonate was the sole alkylene carbonate present in the composition. The amendment was supported by the passage starting from page 3, last line to page 4, line 3 of the application as filed. Although it was indicated that component (B) included propylene carbonate it was clear to the skilled reader from this wording that propylene carbonate could be used as the sole alkylene carbonate in the composition, that being illustrated in examples 1, 4, 7 and 8 which disclosed hair dye composition comprising propylene carbonate as the sole alkylene carbonate.

As regards the amendment of the wording "comprising" into "consisting of" in claim 1 of auxiliary requests 2 and 3, each component which could be contained in the hair dye composition was listed in that claim. Component (C) was disclosed in the paragraph bridging pages 5 and 6 of the application as filed; component (D) in the paragraph bridging pages 7 and 8; component (E) in the paragraph bridging pages 8 and 9; component (F) in the third full paragraph on page 9; and component (G) in the paragraph bridging pages 9 and 10. The above-mentioned list of optional components together with the



mandatory components (A) and (B) formed a closed list of components of the hair dye composition according to the present invention. This was apparent from the fact that the application as filed did not mention that further components could be present in the composition. Furthermore the language used in the paragraph bridging pages 9 and 10 of the application as filed "Besides the above components, components commonly used ..... may further be suitably incorporated into the hair dye compositions of the present invention" implied that no further components than those specifically disclosed in the application were contained in the hair dye composition of the present invention. All the components mentioned in the application were reflected in claim 1; this feature amounted to a disclosure of a composition "consisting of" those components. Thus the claimed subject-matter as amended did not extend beyond the content of the application as filed. The requirement of Article 123(2) EPC was therefore fulfilled.

VII. According to the Appellant, the scope of claim 1 was broadened with respect to the scope of the granted claims. Compositions including a content of more than 50% by weight ethylene and/or butylene carbonate or compositions comprising for example 50% propylene carbonate and some ethylene and/or butylene carbonate were excluded from the scope of the granted claims, but were now within the scope of claim 1 of the main request. The Respondent's interpretation with respect to the feature "alkylene carbonate having 3 to 5 carbon atoms" was not convincing and if followed would even render the claim unclear, contrary to the requirement of Article 84 EPC. There was no basis in the

application as filed for the feature that propylene carbonate be present as the sole alkylene carbonate in the compositions, since all sections of the application as filed referred to by the Respondent only provided support for the presence of propylene carbonate, but not *vice versa* for excluding the presence of other alkylene propylene having 3 to 5 carbon atoms from the composition. There was also no basis in the application as filed for the feature that the claimed compositions according to auxiliary requests 2 and 3 consisted exclusively of components (A) to (G). It was clear from the paragraph bridging page 9 and 10 of the application as filed that the compositions were open to the presence of further components since the components listed therein represented merely examples of suitable ingredients without being exhaustive. Moreover, the fact that the compositions as now claimed no longer comprised water was inconsistent with the examples and introduced a lack of clarity into the claim on account of its pH characteristic requiring an aqueous medium.

VIII. The Appellant requested that the decision under appeal be set aside and that the patent be revoked.

The Respondent requested that the appeal be dismissed and the patent be maintained on the basis of the main request, or subsidiarily, that the decision under appeal be set aside and the patent be maintained on the basis of one of the auxiliary requests 1 to 3.

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

## Reasons for the Decision

1. The appeal is admissible.

### *Main request*

2. *Amendments (Article 123(3) EPC)*

- 2.1 Article 123(3) EPC requires that the claims of a patent as granted may not be amended during opposition/appeal proceedings in such a way as to extend the protection conferred. In order to decide whether or not an amendment of the patent in suit satisfies that requirement, it is necessary to compare the protection conferred by the claims before amendment, i.e. as granted, with that of the claims after amendment.

- 2.2 *Composition claims*

- 2.2.1 A composition which is specified in a claim to comprise a component in an amount which is defined by a numerical range of values is characterized by the feature which requires the presence of the component within that range, as well as by the implicit proviso which excludes the presence of that component in an amount outside of that range.

Consequently, the amount of that component present in the composition must not exceed the upper limit of the numerical range indicated. Ignoring that proviso defining the composition would deprive the indication of an upper limit of sense. The above proviso does not have an impact on the scope of the subject-matter

claimed as long as the amount required by the numerical range is present in the composition.

2.2.2 An amendment restricting the breadth of that component, for instance by narrowing down a generic class or a list of chemical compounds defining that component, has the consequence of no longer requiring the presence within that numerical range of those chemical compounds no longer encompassed by the restricted definition of that component and, thus, of limiting the scope of this implicit proviso.

2.2.3 A composition which is defined as comprising the components indicated in the claim is open to the presence of any further components, unless otherwise specified. Thus, in a claim directed to an openly defined composition, the restriction of the breadth of a component present therein may have the effect of broadening the scope of protection of that claim, with the consequence that in opposition/appeal proceedings such amended claim may extend the protection conferred by the granted patent (Article 123(3) EPC).

### 2.3 *Scope of claim 1 as granted*

2.3.1 Claim 1 as granted is directed to a hair dye composition requiring *inter alia* a content of from 0.5 to 50 % by weight of alkylene carbonate having 3-5 carbon atoms. Thus, the content of the alkylene carbonate having 3-5 carbon atoms in the composition according to the claim as granted must not exceed 50% by weight, which finding has never been contested by the Respondent.

Hence, a composition according to claim 1 as granted is subject to the implicit proviso that it contains at most 50% by weight of ethylene, propylene and/or butylene carbonate, i.e. an alkylene carbonate having from 3 to 5 carbon atoms.

#### 2.4 *Scope of claim 1 as amended*

Claim 1 as amended is directed to a hair dye composition "wherein the content of the alkylene carbonate is 0.5-50% by weight, the alkylene carbonate being propylene carbonate".

The fresh feature in that claim now requires that the content of propylene carbonate to be present in the composition should be in the range of 0.5 to 50% by weight, and no longer defines the content of alkylene carbonate having 3 to 5 carbon atoms in the claimed composition. Thus, claim 1 as amended no longer requires that the composition contains at most 50% by weight of alkylene carbonate having 3 to 5 carbon atoms, since the definition of the composition in claim 1 is "open" due to the characterization by the term "comprising".

Therefore, the composition of claim 1 as amended may comprise in addition to an acid dye and propylene carbonate components including other alkylene carbonates having 3 to 5 carbon atoms, i.e. ethylene carbonate and/or butylene carbonate, in any amount with the consequence that the granted upper limit of 50% by weight of alkylene carbonate having 3 to 5 carbon atoms may be exceeded.

2.5 Thus, claim 1 as amended encompasses compositions having a content of more than 50% by weight of alkylene carbonate having 3 to 5 carbon atoms, which embodiment was excluded from the compositions according to granted claim 1.

2.6 The Respondent argued that the composition of claim 1 excluded the presence of any other alkylene carbonate having 3 to 5 carbon atoms, i.e. ethylene and butylene carbonate, on account of two independent definitions, which required on the one hand that the content of alkylene carbonate be in the range of 0.5 to 50% by weight and on the other that the alkylene carbonate be, at the same time, propylene carbonate.

However, by arguing so, the Respondent gives two different meanings to the same term, which is the alkylene carbonate having 3 to 5 carbon atoms. When this feature defines its chemical structure, the alkylene carbonate, in the view of the Respondent takes the exclusive meaning of propylene carbonate, but in the definition of its content in the composition, the same term covers any alkylene carbonate having 3 to 5 carbon atoms, not exclusively propylene carbonate. Giving two different readings for the same term in claim 1, just as they match the Respondent's needs, is arbitrary. Such an interpretation of the claim goes against any sensible reading, since the meaning of a term in a claim may not be changed depending on the reader's whim, and thus cannot be accepted by the Board.

2.7 Nor can the finding that claim 1 as amended encompasses compositions having a content of more than 50% by weight of alkylene carbonate having 3 to 5 carbon atoms

be rebutted on the basis of the description adapted to the claims filed on 19 October 2007, which would allegedly prohibit any alkylene carbonate having 3 to 5 carbon atoms other than propylene carbonate be present in the claimed composition.

The Respondent's interpretation of claim 1 in the light of the description adapted to the claims is inconsistent with the fact that the very same adapted description still comprise the compositions of examples 2 and 5 as falling within the invention, which compositions comprise, in addition to propylene carbonate, also ethylene carbonate, thus disclosing that the compositions claimed may comprise alkylene carbonates other than propylene carbonate.

Moreover, paragraph [0006] of the description, which addresses the hair dye composition comprising a component (B) being an alkylene carbonate having 3 to 5 carbon atoms in total, wherein the content of the alkylene carbonate having 3 to 5 carbon atoms in total is 0.5 to 50% by weight, has been modified to further stipulate that "the alkylene carbonate is propylene carbonate" in order to be in line with claim 1 of the main request; and particularly paragraph [0010] has been amended to read "the component (B) used in the present invention is propylene carbonate." These two adapted paragraphs make plain that the composition as amended comprises 0.5 to 50% by weight of propylene carbonate as component (B). Contrary to the Respondent allegation, they do not stipulate that the composition does not contain alkylene carbonates other than propylene carbonate.

Irrespective of the fact that the adapted description does not support the Respondent's allegation, the Board observes furthermore that an interpretation of claim 1 in the light of the description would amount to a reference to Article 69(1) EPC, the first sentence thereof, however, stipulating that the extent of protection conferred by a European patent shall be determined by the terms of the claims. While it is true that Article 69(1) EPC second sentence states that the description and drawings shall be used to interpret the claims, this does not make it legitimate to read into the claim features appearing only in the description and then relying on such features to provide additional requirements. This would not be to interpret claims but to rewrite them, thereby depriving the claims of their intended function (see T 881/01, point 2.1 of the reasons; T 1208/97, point 4 of the reasons; neither published in OJ EPO).

2.8 Furthermore the Respondent's interpretation that propylene carbonate is the sole alkylene carbonate having three to five carbon atoms to be present in the composition has no basis in the application as filed. Hence, the Respondent's argument that no alkylene carbonate other than propylene carbonate is present in the claimed composition is not based on a sensible interpretation of claim 1 and, thus, fails for that reason as well. That finding is dealt with more specifically in point 3 below concerning claim 1 of auxiliary request 1, where that interpretation is explicitly reflected in the wording of the claim.

2.9 Hence, the Board comes to the conclusion that the presence of ethylene and/or butylene carbonate is not



excluded from the composition of claim 1 of the main request.

- 2.10 Accordingly, the amendment carried out in claim 1 which results in including compositions having a content of more than 50% of alkylene carbonate having 3 to 5 carbon atoms has the effect to broaden the scope of protection of that claim vis-à-vis to that of claim 1 as granted with the consequence that claim 1 of the main request has been amended in such a way as to extend the protection conferred by the granted patent (Article 123(3) EPC). Hence, this request must be rejected.

*Auxiliary request 1*

3. *Amendment (Article 123(2)EPC)*

In order to determine whether or not the subject-matter of a claim in a patent extends beyond the content of the application as filed it has to be examined whether that claim comprises technical information which a skilled person would not have directly and unambiguously derived from the application as filed.

- 3.1 The fresh amendment of claim 1 of this request indicates that propylene carbonate is the sole alkylene carbonate having 3 to 5 carbon atoms in the composition.

According to the Respondent this fresh amendment is based on original examples 1, 4, 7 and 8 which disclose compositions containing propylene carbonate as sole alkylene carbonate and on page 3 last line to page 4 line 3 of the application as filed where it is

disclosed that component (B) includes propylene carbonate, and that propylene carbonate being particularly preferred.

However the section starting at the last line of page 3 does not disclose that the hair dye compositions should contain propylene carbonate as the sole alkylene carbonate having 3 to 5 carbon atoms, not even that propylene carbonate were a mandatory component of the composition, but discloses propylene carbonate as an alternative to ethylene carbonate and the like and as being a preferred example for alkylene carbonate; this disclosure does not exclude the presence of further alkylene carbonate. On the contrary, by indicating that the component (B) alkylene carbonate includes ethylene carbonate, it specifically describes also the presence of ethylene carbonate within the hair dye compositions.

With respect to the Respondent's reference to the examples 1, 4, 7 and 8 forming the basis for the amendment, it is a matter of fact that the compositions disclosed in these example comprise propylene carbonate and no other alkylene carbonate having 3 to 5 carbon atoms. However, examples 2 and 5 disclose compositions comprising both propylene carbonate and ethylene carbonate, i.e. compositions wherein propylene carbonate is not the sole alkylene carbonate having 3 to 5 carbon atoms in the composition. Thus, it has to be established whether or not selected examples in the application as filed may form a proper basis for the feature that propylene carbonate is the sole alkylene carbonate.

On the one hand, examples 2 and 5 show that the mandatory presence of propylene carbonate and the mandatory absence of other alkylene carbonates having 3 to 5 carbon atoms, as now claimed, was not originally described as being a feature of the invention. On the other hand, examples 1, 4, 7 and 8 disclose particular hair dye compositions containing propylene carbonate as sole alkylene carbonate in specific amounts and in combination with further particular components. A generalisation of these examples has thus been made since the feature "as the sole alkylene carbonate" applies to any composition according to claim 1, while compositions comprising propylene carbonate as the sole alkylene carbonate are disclosed in the application as filed only in combination with the other characteristics of the compositions of examples 1, 4, 7 and 8, in particular with a particular content of propylene carbonate and of other particular components, which are not required in the present claim.

Such an amendment resulting in isolating a specific feature from a particular embodiment and generalising it in a claim would only be allowable, provided the skilled man would have readily recognised this feature as not so closely associated with the other features of this embodiment as to determine the effect of that feature of the invention as a whole in a unique manner and to a significant degree.

However, in the Board's judgement, the skilled person derives from these examples nothing more than the bare disclosure of the specific characteristics of these compositions, namely the combination of particular components in combination with their specific contents

which all together have an impact on the effect of the composition according to the patent in suit. The presence of propylene carbonate as the sole alkylene carbonate is thus closely associated with the other features of the particular compositions disclosed.

To dismantle those particular exemplary compositions into isolated features and to generalize one single feature thereof over the whole scope of claim 1 covering compositions with different components in different amounts provides the skilled person with technical information which is not directly and unambiguously derivable from the application as filed.

Hence, in the context of claim 1 the feature defining the presence of propylene carbonate as the sole alkylene carbonate in the composition is an undue generalisation of specific examples which generates fresh subject-matter.

Since, thus, the feature "as the sole alkylene carbonate" in claim 1 has no adequate support in the application as filed, claim 1 of auxiliary request 1 is amended in such a way that subject-matter extending beyond the application as filed is added, contrary to the requirements of Article 123(2) EPC, with the consequence that auxiliary request 1 is not allowable.

*Auxiliary requests 2 and 3*

4. Claim 1 has been amended such that the compositions now consist of a closed list of components (A) to (G), i.e. the feature "comprising" has been replaced by the

feature "consisting of" and the optional components (C) to (G) have been introduced into the claim.

- 4.1 According to the Respondent the support for the feature "consisting of", which requires that the claimed composition solely consisted of the components indicated was purported to be based on the fact that all components which were disclosed in the application as filed as being optional were included in the claimed composition, thereby implying that no other component was present in the composition.

This argument, however, must be rejected for lack of pertinence since the fact that components may be present in a composition does not necessitate a *contrario* that other components are excluded from the composition. Thus, there is no disclosure in the application as filed that the disclosed lists of components were exhaustive.

- 4.2 The Respondent further argued that the section starting with the term "besides" on pages 9 and 10 of the application as filed made clear that no components other than those now listed in claim 1 could be present in the composition.

However, this argument is devoid of merit since this section of the application as filed should be given a technically sensible reading. This section indicates that "besides the above components, components commonly used in the classical cosmetic compositions and the like, for example, surfactants, ..., propellants, etc. may further be suitably incorporated into the hair dye compositions...", thereby making plain that the further

components indicated are not exhaustive and that, hence, the composition claimed is open to the presence of further components. It is also worth noting that even the presence of water is excluded from the compositions of claim 1 as amended, whereas all compositions of the examples of the application as filed are necessarily aqueous with the simple consequence that the Respondent's present interpretation makes no technical sense.

- 4.3 The Board therefore concludes that claim 1 of auxiliary request 2 and 3 extends beyond the content of the application as filed, contrary to the requirement of Article 123(2) EPC, so that these requests must also be rejected.

## **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

C. Rodríguez Rodríguez

R. Freimuth