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**Datasheet for the decision
of 16 February 2012**

Case Number: T 1542/08 - 3.3.07

Application Number: 99916680.4

Publication Number: 1178772

IPC: A61K 7/00, A61K 7/48

Language of the proceedings: EN

Title of invention:
Transparent micro emulsion

Patent Proprietors:
THE PROCTER & GAMBLE COMPANY

Opponents:
01) HENKEL & CO. KGAA
02) BEIERSDORF AG

Headword:
-

Relevant legal provisions:
EPC Art. 108, 123(3)
Decision of the Administrative Council of the EPO of
14.12.2007 amending the Rules relating to Fees

Keyword:
"Form of appeal- fee - insufficient payment - made in good time
(yes)"
"Amendments - narrowing down of a class of chemical substances
to subclasses or species thereof in a claim directed to an
openly defined composition (yes) - extension of the protection
conferred (yes) (Main Request)"
"Procedural principle of prohibition of *reformatio in peius* -
applicable (yes) - 1st and 2nd Auxiliary Requests - admissible (no)"

Decisions cited:
G 0009/92

Catchword:
-



Case Number: T 1542/08 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 16 February 2012

Appellants: HENKEL AG & CO. KGAA
(Opponents 01) FJP
D-40191 Düsseldorf (DE)

Appellants: BEIERSDORF AG
(Opponents 02) Unnastrasse 48
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Respondents: THE PROCTER & GAMBLE COMPANY
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
21 July 2008 concerning maintenance of European
patent No. 1178772 in amended form.

Composition of the Board:

Chairman: D. Semino
Members: G. Santavicca
P. Schmitz

Summary of Facts and Submissions

I. Two appeals, by both opponents, lie from the interlocutory decision of the Opposition Division posted on 21 July 2008 and concerning European patent 1 178 772 (application N° 99 916 680.4, originating from international application PCT/US99/08233 published as WO 00/61083), according to which, account being taken of amended Claims 1 to 6 of the 1st Auxiliary Request and of a description adapted thereto, both filed during the oral proceedings held on 19 June 2008, the patent and the invention to which it relates were found to meet the requirements of the EPC. The decision also gave the reasons for refusing the Main Request filed with letter of 16 June 2008.

II. The patent as granted comprised 10 claims, independent Claims 1 and 7 reading as follows:

- "1. A transparent micro emulsion comprising:
- (a) two or more nonionic surfactants selected from the group consisting of polyoxyalkylene alkyl ether having the C₁₂₋₁₈ of alkyl substitute, polyoxyalkylene hydrogenated castor oil, and a linear or branched, mono- or tri-alkyl glyceride;
 - (b) two or more oily components selected from the group consisting of hydrocarbon oils, fatty acid esters, and silicone oils;
 - (c) a water soluble high molecular weight polymer; and
 - (d) a cosmetically acceptable carrier comprising a polyol and water,
- wherein the sum of the concentrations of the surfactants and the oily components is less than 6.0 wt%; and the ratio of the surfactants to

the oily components is from 2:1 to 1:1."

"7. A transparent micro emulsion comprising:

- (a) two or more nonionic surfactants selected from the group consisting of polyoxyalkylene alkyl ether having the C₁₂₋₁₈ of alkyl substitute, polyoxyalkylene hydrogenated castor oil, and a linear or branched, mono- or tri-alkyl glyceride;
- (b) two or more oily components selected from the group consisting of hydrocarbon oils, fatty acid esters, and silicone oils;
- (c) a water soluble high molecular weight polymer; and
- (d) a cosmetically acceptable carrier comprising a polyol and water,

wherein the sum of the concentrations of the surfactants and the oily components is less than 6.0 wt%; the transparent micro emulsion has an absorbent value of less than 2 at a wave length of 340 nm."

III. The patent had been opposed in its entirety on the grounds of extension of the subject-matter of the patent beyond the content of the application as filed (Opponents 02) (Articles 100(c) EPC), insufficient disclosure (Opponents 01) (Article 100(b) EPC) and lack of novelty (Opponents 02) and inventive step (both opponents) (Article 100(a) EPC), having regard *inter alia* to:

D2: W0 95/03772 A1;

D3: W0 96/28132 A1;

D4: EP 572 080 A1.

With letter of 16 June 2008, the patent proprietors had filed document D14 (CTFA Online Infobase, Polyglyceryl-

3 Diisostearate) as well as Main, 1st and 2nd Auxiliary Requests.

During the oral proceedings before the Opposition Division, held on 19 June 2008: the patent proprietors had submitted a new 1st Auxiliary Request, in which Claims 7 to 10 as granted had been deleted, and maintained the previously filed Main and 1st and 2nd Auxiliary Requests, the latter being renumbered as 2nd and 3rd Auxiliary requests respectively; Opponents 02 had submitted a document identified as "Annex 1", which was annexed to the Minutes of the oral proceedings (and which is referred to as D15 in the appeal proceedings).

The independent claims of each of 1st, 2nd and 3rd Auxiliary Requests underlying the decision under appeal read as follows (compared to Claims 1 or 7 as granted, additions are indicated in bold and deletions in strike-through):

1st Auxiliary Request

- "1. A transparent micro emulsion comprising:
- (a) two or more nonionic surfactants selected from the group consisting of polyoxyalkylene alkyl ether having the C₁₂₋₁₈ of alkyl substitute, polyoxyalkylene hydrogenated castor oil, and a ~~linear or branched, mono- or tri-alkyl glyceride~~ **triglyceryl diisostearate;**
 - (b) two or more oily components selected from the group consisting of hydrocarbon oils, fatty acid esters, and silicone oils;
 - (c) a water soluble high molecular weight polymer; and

- (d) a cosmetically acceptable carrier comprising a polyol and water,
wherein the sum of the concentrations of the surfactants and the oily components is less than 6.0 wt%; and the ratio of the surfactants to the oily components is from 2:1 to 1:1."

2nd Auxiliary Request

- "1. A transparent micro emulsion comprising:
(a) two or more nonionic surfactants selected from the group consisting of polyoxyalkylene alkyl ether having the C₁₂₋₁₈ of alkyl substitute, polyoxyalkylene hydrogenated castor oil, and a ~~linear or branched, mono- or tri-alkyl glyceride~~ **triglyceryl diisostearate;**
(b) two or more oily components selected from the group consisting of hydrocarbon oils, fatty acid esters, and silicone oils;
(c) a water soluble high molecular weight polymer; and
(d) a cosmetically acceptable carrier comprising a polyol and water,
wherein the sum of the concentrations of the surfactants and the oily components is less than 6.0 wt%; and the ratio of the surfactants to the oily components is from 2:1 to 1:1; **and**
wherein the concentration of the surfactants is from 0.2 to 2%."

- "6. A transparent micro emulsion comprising:
(a) two or more nonionic surfactants selected from the group consisting of polyoxyalkylene alkyl ether having the C₁₂₋₁₈ of alkyl substitute, polyoxyalkylene hydrogenated castor oil, and a

~~linear or branched, mono- or tri-alkyl glyceride~~
triglyceryl diisostearate;

- (b) two or more oily components selected from the group consisting of hydrocarbon oils, fatty acid esters, and silicone oils;
- (c) a water soluble high molecular weight polymer; and
- (d) a cosmetically acceptable carrier comprising a polyol and water,

wherein the sum of the concentrations of the surfactants and the oily components is less than 6.0 wt%; the transparent micro emulsion has an absorbent value of less than 2 at a wave length of 340 nm; **and wherein the concentration of the surfactants is from 0.2 to 2%."**

3rd Auxiliary Request

"1. A transparent micro emulsion comprising:

- (a) two or more nonionic surfactants selected from the group consisting of polyoxyalkylene alkyl ether having the C₁₂₋₁₈ of alkyl substitute, polyoxyalkylene hydrogenated castor oil, and a ~~linear or branched, mono- or tri-alkyl glyceride~~
triglyceryl diisostearate;
- (b) two or more oily components selected from the group consisting of hydrocarbon oils, fatty acid esters, and silicone oils;
- (c) a water soluble high molecular weight polymer; and
- (d) a cosmetically acceptable carrier comprising a polyol and water,

wherein the sum of the concentrations of the surfactants and the oily components is less than 6.0 wt%; and the ratio of the surfactants to the oily components is from 2:1 to 1:1; **and**

**wherein the concentration of the surfactants is from 0.2 to 2%; and
wherein a least one of the nonionic surfactants has an HLB of more than 10 and at least one of the nonionic surfactants has an HLB of less than 10."**

- "5. A transparent micro emulsion comprising:
- (a) two or more nonionic surfactants selected from the group consisting of polyoxyalkylene alkyl ether having the C₁₂₋₁₈ of alkyl substitute, polyoxyalkylene hydrogenated castor oil, and a ~~linear or branched, mono or tri-alkyl glyceride~~ **triglyceryl diisostearate;**
 - (b) two or more oily components selected from the group consisting of hydrocarbon oils, fatty acid esters, and silicone oils;
 - (c) a water soluble high molecular weight polymer; and
 - (d) a cosmetically acceptable carrier comprising a polyol and water,

wherein the sum of the concentrations of the surfactants and the oily components is less than 6.0 wt%; the transparent micro emulsion has an absorbent value of less than 2 at a wave length of 340 nm; **and wherein the concentration of the surfactants is from 0.2 to 2%; and
wherein a least one of the nonionic surfactants has an HLB of more than 10 and at least one of the nonionic surfactants has an HLB of less than 10."**

- IV. In the decision under appeal, it was *inter alia* held that:
- (a) The amended claims of the Main Request were based on the preferred embodiments and examples of the application as originally filed (Article 123(2)

- EPC). Claims 1 and 7 of the Main Request had been restricted to triglyceryl diisostearate, within the context of compounds a), which were to be selected from a group defined by "consisting of", i.e. which excluded further glycerides. So the amended claims complied with Article 123(3) EPC.
- (b) As regards insufficiency of the disclosure of the subject-matter defined in Claim 7, having regard to its feature "absorbent value of less than 2 at a wave length of 340 nm", trial and error experiments were necessary to select the claimed compositions. Thus, the ground under Article 100(b) EPC prejudiced the maintenance of the patent in amended form according to the Main Request.
 - (c) Amended Claims 1 to 6 of the 1st Auxiliary Request corresponded to the same claims of the Main Request, so the amendments were allowable (Article 123, paragraphs 2 and 3, EPC).
 - (d) Since Claims 7 to 10 of the Main Request had been deleted, the ground of opposition under Article 100(b) EPC did not prejudice maintenance of the patent in the form according to the 1st Auxiliary Request.
 - (e) As to novelty, none of the cited documents disclosed a composition comprising at least two surfactants and a total amount of surfactants and oily components of less than 6 wt.%.
 - (f) The closest prior art was described by D2. However, the combination of its disclosure with that of D4 did not hint at the claimed solution. Nor did it the combination of D2 with that of D3.

V. Appellants 01 (opponents 01) filed a notice of appeal on 5 August 2008 and paid the appeal fee on the same

day. Their statement of grounds of appeal was received on 1 December 2008.

On 27 August 2008, appellants 02 (opponents 02) filed notice of appeal and paid an amount of 1065,00 Euro as the appeal fee. By communication of 9 September 2008, appellant 02 was informed that the appeal fee had not yet been paid in full and that the missing amount of 55,00 Euro could still be paid within the time limit for filing the appeal, i.e. 30 September 2008. The appellants did not pay and, accordingly, a loss of rights communication pursuant to Rule 112(1) EPC was issued on 22 October 2008.

On 24 November 2008, the statement setting out the grounds of appeal was filed and the missing 55,00 Euro were paid. Appellants 02 submitted that the missing amount was to be considered as a small amount lacking within the meaning of Article 8 RFees. As an auxiliary measure, they requested re-establishment of rights. Also, they requested that the fee for re-establishment be deducted from their deposit account and that this fee be reimbursed if it were considered that the appeal fee has been paid in full in due time.

VI. In their statements setting out the grounds of appeal:

- (a) Appellants 01 attacked the decision under appeal to the extent that it did not acknowledge lack of an inventive step; and,
- (b) Appellants 02 maintained the grounds of opposition under Article 100, paragraphs (a) (lack of novelty and of an inventive step) and (c), EPC and objected

that the claims as amended during the opposition proceedings contravened the requirements of Article 123(3) EPC.

- VII. By letter of 18 May 2009, the patent proprietors (respondents) filed observations on the grounds of appeal.
- VIII. The parties were summoned to oral proceedings and by communication of 20 January 2012 the Board drew the attention of the parties to the issues that needed to be debated and decided, in particular under Article 123(3) EPC and 56 EPC as well as to the principle of prohibition of *reformatio in peius*.
- IX. With letter of 10 February 2012, the respondents announced that they would not be represented at the oral proceedings and that they relied on the arguments and requests on file.
- X. By phone call on 16 February 2012, appellants 01 informed the Board that they would not be represented at the oral proceedings either.
- XI. Oral proceedings were held on 16 February 2012, in the announced absence of the respondents and of appellants 01, pursuant to Rule EPC 115(2) EPC.
- XII. Appellants 02 essentially argued as follows on the alleged extension of the protection conferred and on the issue the prohibition of *reformatio in peius*, the only issues dealt with in the present decision:

Main Request

Extension of the protection conferred (Article 123(3) EPC)

- (a) The definitions of nonionic surfactants and oily components in Claim 1 were not clear, so reference to the description was necessary to determine what compound fell under those definitions. The surfactants and the oily components were described in Paragraphs [0022] to [0028] and [0029] to [0034].

- (b) D15 showed that compositions not being encompassed by Claim 1 as granted were encompassed by Claim 1 according to the Main Request, because the deletion of some nonionic surfactants, which nevertheless were also oily components, affected the ratio between surfactants and oily components of Claim 1.

- (c) A further composition was illustrated during the oral proceedings, which was made up as follows:
 - 0.9 wt.% triglyceryl diisostearat
 - 1.8 wt.% PEG-6 caprylic/capric triglyceride
 - 0.9 wt.% glyceryl monostearate
 - 1.8 wt.% silicone oil.

According to Claim 1 as granted, interpreted on the basis of the description, in the illustrated composition, triglyceryl diisostearat and glyceryl monostearate represented nonionic surfactants, PEG-6 caprylic/capric triglyceride and silicone were oily components.

The illustrated composition was excluded by Claim 1 as granted, as the ratio between nonionic surfactants and oily components was $1.8/3.6=1:2$.

Instead, the illustrated composition was encompassed by Claim 1 of the Main Request, as:

- glyceryl monostearate no longer fell under the definition of nonionic surfactants (a) but was nevertheless also an oily component (b);
- PEG-6 caprylic/capric triglyceride had been cancelled from the description of the oily components (b) but was a nonionic surfactant (a);
- thus, the ratio between nonionic surfactants and oily components was $2.7/2.7=1:1$.

- (d) A further objection arose from the fact that since some nonionic surfactants and oily components had been cancelled, compositions that did not fall under Claim 1 as granted because they contained more than 6 wt.% of surfactants and oily components were encompassed by Claim 1 of the Main Request, as the deleted surfactants or oily components also reduced the total amount to less than 6 wt.%.
- (e) Therefore, the protection conferred had been extended, which was not allowable.

1st and 2nd Auxiliary Requests

- (a) Since each of the auxiliary requests still contained an independent claim based on Claim 7 of the Main Request underlying the decision under appeal, which had been rejected by the decision under appeal for insufficient disclosure, and since

the patent proprietors had not appealed, the auxiliary requests fell under the prohibition of *reformatio in peius*. So they were not admissible.

- (b) In any case, the objections under Article 123(3) EPC also applied to the auxiliary requests, which thus would not be acceptable.

XIII. During the appeal proceedings, the respondents (patent proprietors) have never offered any arguments on the issue of extended protection and on the principle of prohibition of *reformatio in peius*. According to the minutes of the oral proceedings before the Opposition Division (Point 3.1), the patent proprietors had then refuted the calculations by Opponents 02 (D15) and argued that the requirements of Article 123 EPC were fulfilled.

XIV. Appellants 01 and 02 requested that the decision under appeal be set aside and the patent be revoked.

XV. The respondents had requested in writing (letter of 18 May 2009) that the appeals be dismissed (Main Request), alternatively that the decision under appeal be set aside and the patent be maintained on the basis of the 1st or 2nd Auxiliary Requests (which had been filed as 2nd and 3rd Auxiliary Requests during the oral proceedings before the Opposition Division).

Reasons for the Decision

Admissibility of the appeals

1. The time limit for filing a notice of appeal expired on 30 September 2008. On 27 August 2008, appellants 02 (opponents 02) filed a notice of appeal and paid an amount of 1065,00 Euro as the appeal fee.
 - 1.1 By decision of the Administrative Council of 14 December 2007 (OJ EPO 2008, 5), the appeal fee was increased from 1065,00 Euro to 1120,00 Euro with effect as from 1 April 2008. Thus, appellants 02 had paid the old amount of the appeal fee.
 - 1.2 On 24 November 2008, the missing 55,00 Euro were paid.
 - 1.3 According to Article 2(2) of the decision of the Administrative Council of 14 December 2007 (*supra*), if within six months from 1 April 2008 a fee is paid in due time but only in the amount due before that date, such fee should be deemed to have been validly paid if the deficit is made good within two months of an invitation to that effect from the European Patent Office. Payment of the appeal fee fell within this 6-month period.
 - 1.4 The European Patent Office did not issue an invitation under this Article nor set a two-month time limit. Since appellants 02 paid the lacking difference when they filed the statement setting out the grounds of appeal, such a communication was redundant and the payment can be considered as having been made in good time under this provision. The communication of

- 9 September 2008 does not represent such a communication but is a courtesy action, by which the appellants were reminded of the still running time limit for paying the appeal fee.
- 1.5 Therefore, the Board accepts that the payment of the full appeal fee has been made in good time, based on Article 2(2) of the Administrative Council's decision.
- 1.6 Accordingly, the request for re-establishment of rights is redundant. Since the fee for re-establishment has never been deducted, there is no need for reimbursement.
- 1.7 Consequently, the appeal by appellants 02 has duly been filed.
- 1.8 Since the notices of appeal and the statements setting out the grounds of appeal by both appellants 01 and 02 have been filed within the period specified by Article 108 EPC, both appeals are admissible.

Main Request

Amendments

2. Compared to Claim 1 as granted, Claim 1 according to the Main Request (the 1st Auxiliary Request underlying the decision under appeal) comprises the following amendment in the definition of Component (a):
"two or more nonionic surfactants selected from the group consisting of polyoxyalkylene alkyl ether having the C₁₂₋₁₈ of alkyl substitute, polyoxyalkylene hydrogenated castor oil, and ~~a linear or branched, mono- or tri-alkyl glyceride~~ **triglyceryl diisostearate**".

- 2.1 According to D14, the limitation "triglyceryl diisostearate" identifies the ingredient having the INCI name "Polyglyceryl-3 Diisosotearate", the empirical formula $C_{45}H_{88}O_9$ and the definition "diester of isostearic acid and Polyglycerin-3". Still according to D14, the ingredient belongs to the chemical class of "glyceryl esters and derivatives (excluding fats and oils)" and can fulfil both functions of emollient (skin-conditioning agent) and emulsifying agent (surfactant). Among the possible uses in cosmetic products, D14 mentions "moisturizing preparations", which are the objects of the patent in suit (Paragraph [0001]).
- 2.2 The amendment made to granted Claim 1 thus consists in:
- (a) the deletion of the classes "linear or branched, monoalkyl glyceride and linear trialkyl glyceride"; and
 - (b) the restriction or narrowing down of the class "branched tri-alkyl glyceride" to specific components thereof.
- 2.3 Whilst some of the chemical classes of nonionic surfactants (a) of the composition defined in Claim 1 as granted have been cancelled or narrowed down, the total amount and ratio of nonionic surfactants (a) and oily components (b) have not been altered.
- 2.4 It is not in dispute that the now defined "triglyceryl diisostearate" represents a limitation of the granted, broader definition relating to "linear or branched, mono- or tri-alkyl glyceride".

2.5 Since Claim 1 concerns an openly defined composition and the limitation of the breadth of a component thereof may have the effect of broadening the scope of protection, and since the deleted components may fulfil different formulation functions, which affect the ratio defined in Claim 1, the issue to be decided is whether the protection conferred by Claim 1 as granted has been extended by the limitation of the breadth of the nonionic surfactants in Claim 1 of the Main Request (Article 123(3) EPC).

2.6 In order to decide whether the amended patent in suit complies with Article 123(3) EPC, it is necessary to establish the protection conferred by Claim 1 as granted and compare it with the scope of Claim 1 of the Main Request.

Scope of Claim 1 as granted

3. As regards the scope of Claim 1 as granted, the following is noted:

(a) The emulsion of Claim 1 as granted, in view of the term "comprising" (which means, including what follows but not excluding further ingredients, unless otherwise specified), is not restricted to components (a) to (d) as defined, as also apparent from the patent specification (paragraph [0011]).

(b) Claim 1 as granted does not define the amount of the two or more nonionic surfactants (a), but only a total amount (6 wt.%) for surfactants (a) and oily components (b), as well as a range (from 2:1 to 1:1) for their ratio. This is apparent from the

expression "the surfactants" and "the oily components", which can only be those previously and respectively defined under (a) and (b).

- (c) As regards surfactants (a), Claim 1 as granted *inter alia* mentions "and a linear or branched, mono- or tri-alkyl glyceride". According to the description (paragraph [0027], these classes of nonionic surfactants encompass glyceryl monostearate, glyceryl oleate and triglyceryl diisostearate.
- (d) In accordance with the given examples, the definition "mono-alkyl glyceride" encompasses monoglyceryl (monoalkyl) mono-, di- or triglycerides (glyceride) (e.g. monostearate) and the definition "tri-alkyl glyceride" encompasses triglyceryl (tri-alkyl) (e.g. polyglyceryl-3) mono-, di- or triglycerides (glyceride) (e.g. diisostearate). Also, the expressions mono- and tri-alkyl encompass mono- and tri-glyceryl but are not limited to glyceryl, as other alkyl groups, such as mono- or tri-alkyl polyols are encompassed.

3.1 Moreover, it is apparent from the specification of the patent in suit (Paragraph [0030], line 23), that monoglycerides of C₁₋₃₀ carboxylic acids (e.g. glyceryl monostearate or glyceryl oleate) and diglycerides of C₁₋₃₀ carboxylic acids (e.g. triglyceryl diisostearate) are encompassed by the definition of the class of oily components (b), which are used to provide moisturizing efficacy to the skin (paragraph [0029]). So the definitions for surfactants (a) and oily components (b)

overlap as far as they both refer to mono- and diglycerides.

3.2 Hence, according to the patent in suit, some same ingredients may be used for fulfilling both functions of surfactant and moisturizer, if suitable therefor, such as triglyceryl diisostearate. This may affect the calculation of the ratio of nonionic surfactants to oily components, and thus has to be taken into account.

3.3 Claim 1 as granted encompasses any transparent micro emulsion *inter alia* comprising, as surfactant (a), "linear or branched, mono- or tri-alkyl glyceride", with the proviso that their concentrations match the requirements of both the sum of concentrations of surfactants (a) and oily components (b) (i.e. 6 wt.%) and their ratio (i.e. 2:1 to 1:1), as defined.

Scope of Claim 1 of the Main Request

4. Claim 1 of the Main Request encompasses transparent micro emulsions *inter alia* comprising, as surfactant (a), "triglyceryl diisostearate" but no other "linear or branched mono- or tri-alkyl glyceride", with the proviso that their concentrations match the requirements of both the sum of concentrations of surfactant (a) and oily components (b) (i.e. 6 wt.%) and their ratio (i.e. 2:1 to 1:1), as defined.

Comparison between the scopes of granted Claim 1 and of Claim 1 of the Main Request

5. Linear or branched, mono- or tri-alkyl glycerides other than triglyceryl diisostearate may still be present in

the compositions of Claim 1 of the Main Request, due to the open definition created by the term "comprising". However, they no longer belong to the surfactants (a) but may fall under the oily components (b).

5.1 Compositions still including those glycerides may therefore have a ratio of surfactants (a) to oily components (b) which differs according to whether the two classes as defined in granted Claim 1 are considered or those according to Claim 1 of the Main Request.

5.2 The sum of the concentrations of components (a) and (b) may also vary in the two cases.

Extension of the protection conferred

6. To illustrate with a specific example that the protection conferred has been extended, a particular transparent micro emulsion is considered, which is derived from D15, comprising:

(a1) 1 wt.% of polyoxyalkylene C₁₂₋₁₈ alkyl ether (such as the ceteths and ceteraeths mentioned in Paragraph [0025] and illustrated in the examples of the patent in suit (Paragraph [0083]));

(a2) 1 wt.% of polyoxyalkylene hydrogenated castor oil (such as the polyethylene (20) hydrogenated castor oil mentioned in Paragraph [0026] and illustrated in the examples of the patent in suit (Paragraph [0083])); and,

- (a3) 0.4 wt.% of glyceryl monostearate (mentioned as example of monoalkyl glyceride surfactants in Paragraph [0027] but also encompassed by the definition of one of the classes of the oily components, i.e. "monoglycerides of C₁₋₃₀ carboxylic acids" mentioned in Paragraph [0030] of the patent in suit).
- (b1) 0.3 wt.% of a hydrocarbon oil (such as any of those mentioned in Paragraph [0031]);
- (b2) 0.3 wt.% of a silicone oil (such as any of those mentioned in Paragraphs [0032] and [0033] of the patent in suit).

6.1 In the illustrative composition, components (a1) and (a2) represent nonionic surfactants (a), as defined in Claim 1 as granted, components (b1) and (b2) represent oily components (b), as defined in Claim 1 as granted, whilst component (a3) represents not only a nonionic surfactant (a) but also an oily component (b), as defined in Claim 1 as granted. Hence, components (a1), (a2) and (a3) make up nonionic surfactants (a) and components (b1), (b2) and possibly (a3) make up oily components (b), as defined in Claim 1 as granted.

6.2 Although the sum of the concentrations of components (a1), (a2), (a3), (b1) and (b2) amounts to 3 wt.%, which is less than 6 wt.% as required, the illustrative composition is not encompassed by Claim 1 as granted, because the ratio of surfactants to oily components is greater than 2:1, namely:

- (a) $(a_1+a_2+a_3)/(b_1+b_2)=(1.0+1.0+0.4)/(0.3+0.3)=2.4:0.6=4:1$; or, if the double function of component (a3) is taken into account,
- (b) $(a_1+a_2+a_3)/(a_3+b_1+b_2)=(1.0+1.0+0.4)/(0.4+0.3+0.3)=2.4:1$.

Hence, in any case, the ratio of surfactants to oily components is higher than the highest ratio as required by Claim 1 as granted.

- 6.3 By contrast, the same illustrative composition is encompassed by Claim 1 of the Main Request, as:
- (a) glyceryl monostearate no longer falls under the definition of the nonionic surfactants (a) ("triglyceryl diisostearate"), but
 - (b) still represents an oily component (b).
- Consequently, the ratio of surfactants to oily components becomes:
- $$(a_1+a_2)/(a_3+b_1+b_2)=(1.0+1.0)/(0.4+0.3+0.3)=2:1.$$

- 6.4 Although the amendment in Claim 1 of the Main Request (i.e. the narrowing down of the definition of nonionic surfactants (a), which no longer encompasses monoglyceryl monostearate) does not appear to have, for the illustrative composition, an impact on the sum of concentrations of surfactants and oily components, it nevertheless affects the ratio of surfactants to oily components and extends the protection conferred by Claim 1 of the Main Request to an embodiment not encompassed by Claim 1 as granted.

- 6.5 The Board arrives at the same conclusion if the further illustrative compositions by appellants 02, i.e. as specifically illustrated in D15 or during the oral

proceedings, are considered. The calculations therein however do not appear to completely take into account the double function of some of the components, as each component is illustrated as if it fulfilled only one of the two possible functions. This is the reason why the Board has made its own illustrative composition.

6.6 It follows from the foregoing that in the present case the protection conferred has been extended, contrary to Article 123(3) EPC.

1st and 2nd Auxiliary Requests

Amendments

7. Compared to the Main Request (*supra*), Claim 1 of the 1st and 2nd Auxiliary Requests respectively further contains the incorporation of only the additional features of Claim 5 as granted or also the limitation defined in Claim 2 as granted.

8. However, the said further limitations have not only been included in Claim 1 according to the Main Request but also in respective further independent Claims 6 and 5, which are still based on Claim 7 of the Main Request underlying the decision under appeal and thus still contain the feature "the transparent micro emulsion has an absorbent value of less than 2 at a wave length of 340 nm".

8.1 Since the decision under appeal held that the ground of opposition under Article 100(b) EPC prejudiced the maintenance of Claim 7 according to the then Main Request, having regard to the feature "the transparent

micro emulsion has an absorbent value of less than 2 at a wave length of 340 nm", that ground applies *mutatis mutandis* against Claims 6 and 5 of present 1st and 2nd Auxiliary Requests.

8.2 The patent proprietor have however not lodged an appeal against the decision under appeal.

8.3 Hence, the principle of prohibition of the *reformatio in peius* (G 9/92, OJ EPO 1994, 875) applies and the 1st and 2nd Auxiliary Requests are not admissible.

Further grounds of opposition

9. In view of the above decisions, the Board need not deal with the further grounds of opposition or objections maintained by the appellants.

Conclusion

10. None of the respondents' claims requests is admissible or acceptable.

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:

S. Fabiani

D. Semino