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**Datasheet for the decision  
of 22 May 2012**

**Case Number:** T 0134/10 - 3.3.06

**Application Number:** 02739803.1

**Publication Number:** 1395235

**IPC:** C11D 17/08, A61Q 5/02,  
A61Q 5/12, A61Q 19/10,  
A61K 8/34

**Language of the proceedings:** EN

**Title of invention:**  
Shampoos with behenyl alcohol

**Patentee:**  
Colgate-Palmolive Company

**Opponents:**  
The Procter & Gamble Company  
Sasol Germany GmbH

**Headword:**  
Pearlized cleansing composition/COLGATE-PALMOLIVE

**Relevant legal provisions:**  
EPC Art. 84

**Keyword:**  
"Admissibility of the clarity objection (yes): unclarity arising from the amendments to the granted claim"  
"Clarity (all requests): no - functional definition of optional component not delimiting clearly the extent of claim 1 directed to a composition of matter consisting of the listed components"

**Decisions cited:**  
T 0728/98, T 0337/95, T 0586/97

**Catchword:**

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Case Number: T 0134/10 - 3.3.06

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.06**  
**of 22 May 2012**

**Appellant:** The Procter & Gamble Company  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
16 November 2009 concerning maintenance of the  
European patent No. 1395235 in amended form.

**Composition of the Board:**

**Chairman:** P.-P. Bracke  
**Members:** L. Li Voti  
J. Geschwind

## Summary of Facts and Submissions

- I. The present appeal is from the decision of the Opposition Division to maintain the European patent no. 1 395 235, concerning a pearlized cleansing composition, in amended form.
- II. In its notice of opposition the Opponent sought the revocation of the patent on the grounds of Article 100(a) EPC, because of lack of novelty and inventive step of the claimed subject-matter, and of Article 100(b) EPC.
- III. The Opposition Division found in its decision that the amended claims according to the then pending second auxiliary request submitted during oral proceedings complied with all the requirements of the EPC.
- IV. An appeal was filed against this decision by the Opponent (Appellant).  
  
With the letter of 5 August 2010 the Respondent (Patent Proprietor) submitted two sets of claims as first and second auxiliary requests, respectively.  
  
Oral proceedings were held before the Board on 22 May 2012.  
  
During oral proceedings, following some remarks by the Board, the Respondent carried out some corrections to all requests.
- V. The independent claim 1 according to the **main request**, i.e. the set of claims found by the Opposition Division

to comply with the requirements of the EPC as amended during oral proceedings before the Board, reads as follows:

"1. A pearlized cleansing composition for personal care consisting of:

(a) 4.00-30.00 weight % of an anionic material selected from the group consisting of water soluble lipophilic sulfates and sulfonates having 8 to 22 carbon atoms;

(b) 1-2 weight % behenyl alcohol being of a distribution of C<sub>20</sub>-C<sub>24</sub> homologous alcohols of even numbers of carbon atoms, averaging 22 carbon atoms on a weight basis;

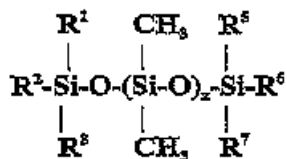
(c) 0-10.00 weight % of a non-ionic material selected from the group consisting of a higher fatty alkanolamide having 8-22 carbons;

(d) 0-10.00 weight % of an amphoteric material selected from the group consisting of derivatives of aliphatic quaternary ammonium, phosphonium or sulfonium compounds in which the aliphatic radicals can be straight chain or branched, and wherein one of the aliphatic substituents contains from 8-22 carbons and one contains an anionic water-solubilizing group selected from the group consisting of carboxyl, sulfonate, sulfate, phosphate and phosphonate; C8-C18 alkyl betaines ; C8-C18 sulfobetaines ; C8-C18 alkyl amphotacetates ; and C8-C18 alkyl amphopropionates;

(e) 0.05-1 weight% of a cationic material which is a cationic surface active fiber conditioning agent selected from the group consisting of Polyquaternium-6, Polyquaternium-7, Polyquaternium-10, Polyquaternium-16, cationic guar gum and distearyl dimonium chloride;

(f) 0.25-5.0 weight% of a silicone selected from the group consisting of water insoluble organosilicone compounds selected from the group consisting of:

- (i) dimethicones having a viscosity in the range of 30,000-100,000 centistokes and which are of Formula I:

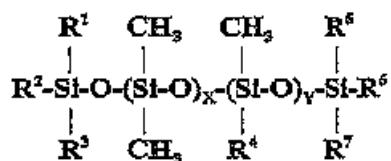


Formula I

wherein R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>5</sup>, R<sup>6</sup>, and R<sup>7</sup> may be the same or different and are each independently selected from the group consisting of alkyls of 1-6 carbons and z is selected so that the viscosity of 30,000-100,000 centistokes is achieved;

and

- (ii) aminosilicones of Formula II having a viscosity in the range of 30,000-100,000 centistokes



Formula II

wherein R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>5</sup>, R<sup>6</sup>, and R<sup>7</sup> may be the same or different and are each independently selected from the group consisting of are alkyls of 1-6 carbons; and R<sup>4</sup> is R<sup>8</sup>-NH-CH<sub>2</sub>CH<sub>2</sub>-NH<sub>2</sub>, R<sup>8</sup> is an alkylene of 3-6 carbons; x= is an average value and is a number in the range of 500-

10,000; and  $y$  is an average value and is a number in the range of 1-10;

(iii) mixtures of (f)(i) and (f)(ii);

(g) optionally, one or more members selected from the group consisting of an effective amount of a pH modifying agent; an effective amount of a viscosity modifying agent; an effective amount of a preservative; fragrance; and a coloring agent; and

(h) the remainder water;

provided that a sufficient amount of behenyl alcohol or behenyl alcohol in combination with an additional suspending agent is used to stabilize the composition."

Claim 1 according to the first auxiliary request differs from claim 1 according to the main request only insofar as component (f) is a dimethicone having a viscosity of 60,000 centistokes.

Claim 1 according to the second auxiliary request differs from claim 1 according to the first auxiliary request only insofar as component (e) is a cationic material comprising Polyquaternium-7.

VI. The Appellant submitted *inter alia* that

- in a claim directed to a composition of matter and drafted with an open wording of the type "composition comprising...", additional not specifically listed ingredients could still be comprised in the claimed composition; consequently, the exact assessment of the range of compounds falling under the definition of

classes of ingredients which are optional according to the wording of the claim was not relevant for determining which compositions were excluded from the extent of the claim; to the contrary, a closed wording of the type "composition consisting of..." did not allow the presence of additional not specifically mentioned ingredients; therefore, in such a case the extent of all the classes of components listed, including optional ones, had to be clear in order to enable the skilled person to recognise the limits of the claimed composition;

- the change from the open wording of claim 1 as granted to the closed wording of claim 1 according to the main request rendered necessary the interpretation of the meaning of the optional ingredient (g); therefore, objections to the clarity of this ingredient (g) arising from the amendments to the granted claim had to be allowed;

- in claim 1 the optional component (g) included some functionally defined classes of compounds, the meaning of which was not explained in the patent in suit; therefore, it was not clear which range of compounds was encompassed by the wording "an effective amount of a viscosity modifying agent", which could theoretically include a multitude of very different ingredients having more than one possible functional activity; therefore, it was not possible for the skilled person to assess exactly the extent of the claimed composition;

- claim 1 according to all requests thus lacked clarity.

VII. The Respondent submitted that

- the wording of component (g) had remained unchanged with respect to that of the granted claim 1; therefore, its clarity could not be challenged;

- moreover, the classes of compounds listed as optional component (g) were well known to the skilled person and some suitable compounds were listed in the description of the patent in suit; therefore, claim 1 was clear.

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

IX. The Respondent requests that the appeal be dismissed and the patent be maintained on the basis of the amended main request filed during oral proceedings, or, in the alternative, that the patent be maintained on the basis of any of the first or second auxiliary requests filed during oral proceedings.

## **Reasons for the Decision**

1. *Clarity of claim 1 according to the Respondent's amended main request*

1.1 Lack of clarity is not itself a ground for opposition and according to the established jurisprudence of the Boards of Appeal of the EPO objections to the clarity of claims are only allowable if they arise in relation to the amendments made (see Case Law of the Boards of Appeal of the EPO, 6th edition, 2010, point VII.D.4.1.4 on page 804, last paragraph and page 805, second full



paragraph, as well as point VII.D.4.2 on page 806, last paragraph and page 807, first full paragraph).

In the present case the Appellant raised *inter alia* an objection as to the clarity of component (g) of claim 1 which reads: "(g) optionally, one or more members selected from the group consisting of an effective amount of a pH modifying agent; an effective amount of a viscosity modifying agent; an effective amount of a preservative; fragrance; and a coloring agent". Even though the wording of component (g) has remained identical to that contained in the granted claim 1, the amendment of granted claim 1 from the open wording "A pearlized cleansing composition for personal care comprising..." into the closed wording "A pearlized cleansing composition for personal care consisting of..." has rendered, in the Appellant's view, the limits of the claim unclear insofar as component (g) is concerned.

Therefore, the objection to the clarity of the claim should be allowed.

- 1.2 It is undisputed that the closed wording of claim 1 according to the main request implies that only the components specifically listed in the claim can be contained in the pearlized cleansing composition. Therefore, also the meaning of the optional component (g) is essential for defining the limits of the claimed composition and for knowing which compositions are not encompassed by the wording of the claim.

To the contrary, the granted claim 1, because of its open wording, implied that additional amounts of unspecified ingredients suitable for use in a pearlized

cleansing composition could still be included in the claimed composition. Consequently, the extent of the optional component (g) was not important for defining the limits of the claimed composition.

In fact, even though the skilled person would have been uncertain if a certain amount of a compound X could fall under the definition of component (g), the open wording of the claim would have allowed anyway the presence of such a compound X as additional ingredient not specifically listed in the claim and there would have been no doubts upon the exact extent of the subject-matter covered by the claim.

Hence, even though the wording of component (g) has not been modified with respect to that of the granted claim 1, the amendment to the granted claim from an open wording to a closed one has in the present case an influence on the assessment of the extent of the claim insofar as component (g) is concerned.

Therefore, the possible unclarity originates from this amendment and the objection raised by the Appellant as to the clarity of claim 1 with regard to component (g) is allowable.

- 1.3 It is established jurisprudence of the Boards of the Appeal of the EPO that, in order to insure legal certainty, a claim must clearly define the matter for which protection is sought (see T 0728/98, OJ EPO 2001, 319, point 3.1 of the reasons for the decision as well as T 0337/95, OJ EPO 1996, 628, points 2.2 to 2.5 of the reasons for the decision).

Insofar as component (g) is concerned, claim 1 according to the main request requires, for example, the optional presence of "an effective amount of a viscosity modifying agent". Therefore, the principle of legal certainty requires the identification of the meaning of the above mentioned technical feature in order to establish without any doubt the subject-matter covered by the claim.

The description of the patent in suit does not contain any specific definition for the term "viscosity modifying agent" and for its "effective amount" and reports only two examples of viscosity modifiers, sodium chloride and sodium cumene sulphonate, and some preferred concentrations (see paragraph 27).

Moreover, the Board remarks that many ingredients, which are theoretically able to modify the viscosity of a composition, can have in the same composition also other different functions. In fact, as discussed in the oral proceedings, behenyl alcohol, which is component (b) of claim 1, is a pearlizing agent but also increases the viscosity of the composition and sodium chloride, one of the two viscosity modifying agents specifically cited in the patent in suit, is also well known as electrolyte. Furthermore, solvents such as water or ethanol could also be considered as viscosity modifiers because of their solubilising properties.

From the above considerations it results that, in the absence of a specific teaching in the patent in suit which would suggest to the skilled person which compounds should be intended as "viscosity modifying agents" and which not, the labelling of an optional

component as a "viscosity modifying agent", which is essential for establishing the limits of the extent of the claim, is arbitrary and depends on the mental label the user wishes to apply to a specific ingredient (see, for example, T 586/97, point 4.1.2.2).

Therefore, a composition comprising an ingredient X, which would be part of the extent of the claim if it is added in virtue of its ability to modify the viscosity, would fall outside the extent of the claim if the viscosity of the composition is modified by other components and the ingredient X is included for another purpose, for example as an electrolyte.

Consequently, the functionally defined class of compounds "viscosity modifying agent" does not identify clearly and unambiguously a limited range of ingredients.

Moreover, the unclarity of the exact limitation conferred to the claim by the wording of this specific component (g) is increased by the requirement of the claim to comprise "an effective amount" of such an ingredient; in fact, the meaning of "effective amount" is not specified in the patent in suit and, for example, the amount of a component X, necessary for modifying the viscosity of the composition, will depend on the other components present in the composition and could be different for any compound and any composition.

The Board thus concludes that the wording of claim 1, for the reasons mentioned above, does not allow the skilled person to recognize with certainty which

compositions are included and which are excluded from the extent of the claim.

Claim 1 thus lacks clarity.

2. *Clarity of claim 1 according to the Respondent's first and second auxiliary requests*

Claim 1 according to the first auxiliary request differs from claim 1 according to the main request only insofar as component (f) is a dimethicone having a viscosity of 60,000 centistokes.

Claim 1 according to the second auxiliary request differs from claim 1 according to the first auxiliary request only insofar as component (e) is a cationic material comprising Polyquaternium-7.

Therefore each claim 1 according to the first and second auxiliary requests comprises the same wording for component (g) as claim 1 according to the main request.

Consequently, these claims 1 lack also clarity for the same reasons put forward above.

**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:

D. Magliano

P.-P. Bracke