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**Datasheet for the decision
of 30 April 2013**

Case Number: T 0267/11 - 3.3.07
Application Number: 04253006.3
Publication Number: 1486195
IPC: A61Q 5/00, A61Q 19/00,
A61K 8/25, A61K 8/92
Language of the proceedings: EN

Title of invention:

Personal product compositions comprising structured benefit agent pre-mix

Patent Proprietor:

Unilever PLC
Unilever N.V.

Opponent:

Beiersdorf AG Intellectual Property - Patente

Headword:

Personal product compositions comprising structured benefit agent pre-mix/UNILEVER

Relevant legal provisions:

EPC Art. 100(b), 84
RPBA Art. 13

Keyword:

"Sufficiency of disclosure, main request (no)"
"Clarity, auxiliary requests 1-5 (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0267/11 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 30 April 2013

Appellant: Unilever PLC
(Patent Proprietor 1) Unilever House
Blackfriars
London
Greater London EC4P 4BQ (GB)

Appellant: Unilever N.V.
(Patent Proprietor 2) Weena 455
NL-3013 AL Rotterdam (NL)

Representative: Fijnvandraat, Arnoldus
Unilever Patent Group
Colworth House
Sharnbrook
Bedford MK44 1LQ (GB)

Respondent: Beiersdorf AG
(Opponent) Intellectual Property - Patente
Unnastrasse 48
D-20253 Hamburg (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 23 December 2010
revoking European patent No. 1486195 pursuant
to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: D. Semino
Members: D. Boulois
D. T. Keeling

Summary of Facts and Submissions

I. European patent No. 1 486 195 was granted on the basis of a set of 11 claims. Independent claim 1 read as follows:

"1. Personal product composition comprising

(1) 1 to 99 % by wt. of a surfactant material selected from anionic, nonionic, amphoteric, cationic surfactants and mixtures thereof; and

(2) 0.1 % to 90 % of a structured benefit agent composition comprising:

(a) 50 % to 99.9 % by wt. of structured benefit agent composition of one or more benefit agents or mixtures thereof; and

(b) 50 % to 0.1 % structured benefit agent structuring material selected from crystalline structurants selected from natural or synthetic crystalline waxes, and

(3) optical modifier or modifiers selected from water-insoluble particles,

wherein the crystal in the structuring material has an aspect ratio defined by $A/B > 1$, the length A being understood as the longer of the two dimensions when considering length and width, B;

wherein, the structured benefit agent is separately formed and separately combined with a surfactant containing carrying composition in which the structured benefit agent will be used to deliver benefit agent to a substrate and there is provided enhanced benefit of the water-insoluble particles of at least 5 % relative to the effect provided by the same water-insoluble particles in the absence of structured benefit agent in the final composition."

II. An opposition was filed against the granted patent. The patent was opposed under Article 100(a) EPC for lack of novelty, lack of inventive step and lack of patentability pursuant Article 52(2) (a) EPC, under Article 100(b) EPC for insufficiency of disclosure and under Article 100(c) EPC for added subject-matter.

III. In the decision pronounced at the oral proceedings on 30 November 2010, the patent was revoked.

IV. The decision was based on the claims as granted as the main request and two sets of claims filed with the letter dated 2 November 2010 as first and second auxiliary requests.
Claim 1 of the first auxiliary request corresponded to granted claim 1 with the specification of the amount of optical modifier or modifiers, namely "*0.1% to 3% by weight*". Claim 1 of the second auxiliary request contained the additional specification concerning the surfactant material, that "*the anionic surfactant comprises 1% to 20% by weight of the composition*".

V. The appealed decision can be summarized as follows.

Concerning the enhanced benefit defined in claim 1 as granted, the patent in suit remained silent about the wording "*in the absence of structure benefit agent in the final composition*" for which several interpretations were possible.

Furthermore, the subject-matter of claim 1 contained no restriction on the substrate to which the product was to be applied, nor with regard to the optical modification to be obtained.

The skilled person would be obliged to find out by trial and error which personal product composition met the "*enhanced benefit of 5%*" set out in claim 1. The preparation of a personal product composition exhibiting the claimed enhanced benefit of at least 5% could not be done by routine experimentation and amounted for the skilled person to an invitation to perform a research program.

In addition, the "*enhancement of skin shine*" defined in paragraph [0181] of the patent reflected the benefit intensity over the baseline for a specific composition and was not the same as the "*enhanced benefit*" defined in claim 1, which resulted from the comparison of the benefits obtained with the inventive composition over a comparative composition.

Finally, the comparative data in Tables 7 and 8 of the patent did not support the claimed benefit enhancement of 5%.

On that basis, the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

As the same feature concerning the enhanced benefit was present in claim 1 of the first and second auxiliary requests, the finding of lack of disclosure also applied to these requests.

VI. The patent proprietors (appellants) filed an appeal against this decision.

With the statement of grounds of appeal, they filed a set of claims as first auxiliary request.

VII. In the reply to the statement of grounds of appeal, the opponent (respondent) submitted arguments regarding sufficiency of disclosure.

VIII. With a letter dated 28 March 2013, the appellant filed five sets of claims as first to fifth auxiliary requests to replace the auxiliary request on file.

The subject-matter of independent claim 1 in those requests differed from the one of claim 1 of the main request by the following features (amendments are indicated in bold and underlined):

(a) *first auxiliary request*

The claimed enhanced benefit was specified as follows:

*"and there is provided **enhanced shine** of the water-insoluble particles of at least 5 % relative to the effect provided by the same water-insoluble particles in the absence of structured benefit agent in the final composition **when assessed by the Shine Enhancement Test described herein**".*

(b) *second auxiliary request*

In addition to the modification brought to the first auxiliary request, the second auxiliary request had the amounts of the compounds modified as follows:

*"(1) 1 to **75** % by wt. of a surfactant material selected from anionic, nonionic, amphoteric, cationic surfactants and mixtures thereof;"*

*(2) **1** % to 90 % of a structured benefit agent composition comprising:*

*(a) 50 % to **99** % by wt. of structured benefit agent composition of one or more benefit agents or mixtures thereof; and*

b) 50 % to 1 % structured benefit agent structuring material selected from crystalline structurants selected from natural or synthetic crystalline waxes".

(c) third auxiliary request

In addition to the modifications brought to the subject-matter of claim 1 of the first and second auxiliary requests, the subject-matter of claim 1 of the third auxiliary was specified to be a "Personal product shower gel composition", which "will be used to deliver benefit agent to a human skin" (instead of which "will be used to deliver benefit agent to a substrate").

(d) fourth auxiliary request

In addition to the modifications brought to the first, second and third auxiliary requests, the fourth auxiliary request had the amount of optical modifier(s) specified as follows:

"(3) 0.1 % to 3 % optical modifier or modifiers selected from water-insoluble particles".

(e) fifth auxiliary request

In addition to the modifications brought to the first to fourth auxiliary requests, the fifth auxiliary request had the nature of surfactant modified as follows:

"(1) 1 to 75 % by wt. of a surfactant material selected from anionic, nonionic, amphoteric, cationic surfactants and mixtures thereof, wherein the anionic surfactant comprises 1 % to 20 % by weight of the composition".

IX. Oral proceedings took place on 30 April 2013.

X. The appellants arguments as far as relevant to the present decision can be summarised as follows:

The reasoning of the decision of the opposition division showed that the present case was a matter of Article 84 EPC and not of disclosure under Article 83 EPC. The entire evidence submitted indeed concerned the scope of the claims, not the disclosure under Article 83 EPC.

The claimed enhanced benefit of 5 % had to be seen as an intrinsic benefit linked with the technical features of claim 1, namely all claimed components. Thus, this enhanced benefit could be ignored, and could not affect the disclosure of the invention, but only the clarity of the claims.

The description provided a "*Shine Enhancement Test*" which defined a protocol to measure the benefit of the composition. The test did not present any difficulty for measuring the shine enhancement and since the result was a difference between the value of a sample and a baseline, parameters such as the pH, the temperature, or the time, could not have any influence. Said test provided values on a scale of 100, which was the baseline value. This was reflected by several parts of the description, in which a parallel was drawn between the enhanced benefit of 5 % and the increase of greater than 5 intensity units. A difference in 5 units corresponded therefore to a improvement of 5 %.

As regarded the admission of the first auxiliary request into the proceedings, this request was filed one month before the oral proceedings and was an

attempt to overcome some objections, which did not delay the proceedings, in reason of the simplicity of the changes. This request was a shadow of the auxiliary request filed with the statement of grounds of appeal.

As regard the clarity of claim 1 of the first auxiliary request, the now claimed "*enhanced shine*" did not present any clarity issue. The test which claim 1 referred to was a test applicable to any personal product, and not only to a shower gel as argued by the respondent. Any product could be applied to the skin through a wipe, and there was no reason to doubt of the possibility to repeat the test. A shine value might be established in 15 minutes, which illustrated the simplicity of the test, which repetition could thus not constitute an undue burden for the skilled person. The skilled person understood what the computer programs used by the Shine Enhancement Test, namely "*Photosuite III*" and a "*program in IDL*", consisted in and knew how to use them, since he was familiar with these programs. There was also no further difficulty to give the results of the test in percentages starting from the intensity units, since the skilled person would use as baseline a value of 100. An enhancement was thus shown by the comparison between example 23 and example H. These arguments on clarity were equally valid for the second to fifth auxiliary requests.

XI. The respondent's arguments, as far as relevant to the present decision, can be summarised as follows:

The ambiguity in the claims was significant on the key functional feature, and had to be seen as a problem of insufficient disclosure and not of clarity. The claimed

"*enhanced benefit of 5 %*" was an essential feature, which needed to be defined and repeatable. As regarded the main request, the description did not define clearly what benefit should be enhanced, and the sole measurement method of the description was performed on a shower gel. Moreover, the "*Shine Enhancement Test*" in the description was not sufficiently disclosed, since the results depended on parameters such as the pH of the water, the temperature, and the time of measurement. The tests results were in units, and there was no method for measuring the results in percentages. Nor was there a disclosure of all possible benefits the composition might reach and claim 1 of the main request did not refer to the "*Shine Enhancement Test*".

As regarded the first auxiliary request, the respondent did not have any remark regarding its admission into the proceedings. As to the "*Shine Enhancement Test*", some parameters were not clearly indicated, such as the temperature, the pH, and the time of measurement. It was also not clear what the "*program in IDL*" and "*Photosuite*" were about, and how to use them. Finally, the calculation of the shine enhancement in percentages was not clear from the test.

The first to fifth auxiliary requests were objected to as regards their admissibility, since these requests did *prima facie* not fulfil the requirements of clarity.

- XII. The appellants requested that the decision under appeal be set aside and the patent be maintained as granted or, alternatively, that the case be remitted to the opposition division for further prosecution on the

basis of one of the sets of claims filed as first to fifth auxiliary requests with letter of 28 March 2013.

XIII. The respondent requested that the appeal be dismissed.

Reasons for the decision

1. *Main Request - Article 100(b) EPC*

1.1 Claim 1 of the main request refers to a product, namely a personal product composition, comprising as essential ingredients a surfactant material, a structured benefit agent composition and an optical modifier or modifiers selected from water-insoluble particles, and for which **"there is provided enhanced benefit of the water-insoluble particles of at least 5 % relative to the effect provided by the same water-insoluble particles in the absence of structured benefit agent in the final composition"**.

The feature *"there is provided enhanced benefit of the water-insoluble particles of at least 5 % relative to the effect provided by the same water-insoluble particles in the absence of structured benefit agent in the final composition"* is a functional feature defining a technical result achieved by the personal product composition.

This feature and the technical result involved are key elements of the claimed invention, since the composition has been designed specifically to enhance the effect of the optical modifier(s), namely the water-insoluble particles, resulting in changes in the

visual appearances (see for instance paragraphs [0001]-[0003]).

There is neither any evidence, nor it is credible, that an "*enhanced benefit of the water-insoluble particles of at least 5 %*" is an intrinsic property to any composition comprising:

- (1) a surfactant,
- (2) a structured benefit agent composition comprising a benefit agent and a structuring material selected from crystalline structurants selected from natural or synthetic crystalline waxes, and
- (3) optical modifier or modifiers selected from water-insoluble particles.

Thus, the skilled person must be able to prepare a composition providing an "*enhanced benefit of the water-insoluble particles of at least 5 % relative to the effect provided by the same water-insoluble particles in the absence of structured benefit age in the final composition*". In particular, the skilled person must have been taught by the patent specification what the enhanced benefit consists in and how to measure it.

The description mentions repeatedly the enhanced benefit provided by the water insoluble particles, referring by mean of example to a skin shine enhancement (see paragraphs [0025], [0029], [0031], [0041], [0075], [0077], [0078], [0119], [0120]) or to an improved matte appearance (see paragraph [0119]). As regards the enhancement of the matte appearance, the description does not provide any further information or

teaching. The description thus provides limited information on said "*enhanced benefit*".

Furthermore, the description discloses specific technical guidance only for the measurement of the skin shine enhancement (paragraphs [0179]-[0181]) and provides one specific embodiment for which a comparison has been carried out only relating to shine enhancement (example 23 and the corresponding comparative example H).

Thus, apart from shine enhancement, the description does neither provide any real alternative for the claimed "*enhanced benefit*" nor any further method for measuring the "*enhanced benefit of the water-insoluble particles of at least 5 % relative to the effect provided by the same water-insoluble particles in the absence of structured benefit age in the final composition*".

The claimed "*enhanced benefit of the water-insoluble particles of at least 5%*" relates however to any possible benefit, for which there is no teaching in the patent specification, either relating to its nature, or to its method of measurement.

The skilled person wishing to repeat the invention has indeed no other choice than to prepare a composition, namely to select a surfactant material, a structured benefit agent composition and an optical modifier or modifiers selected from water-insoluble particles, and test if there is any benefit. The absence of any information or instruction regarding the property which must be enhanced and the way to measure it does not put the skilled person in a position to evaluate the benefit of the composition, without undue burden. Thus,

it is not only a potential problem of clarity under Article 84 EPC, which is not in discussion for the granted patent, but it is also a problem of disclosure.

The skilled person is thus not in a position to be able to reproduce the invention in the whole area claimed, for any composition comprising a surfactant material, a structured benefit agent composition and an optical modifier or modifiers selected from water-insoluble particles for which there must be any possible *"enhanced benefit of the water-insoluble particles of at least 5%"*, without undue burden.

1.2 Consequently, the European patent does not satisfy the requirements of Article 100(b) EPC.

2. *First auxiliary request*

2.1 *Admission of the first auxiliary request into the proceedings*

The first auxiliary request was filed with letter dated 28 March 2013 after oral proceedings had been arranged and thus at a late stage in the proceedings. It corresponds to the first auxiliary request filed with the statement of grounds of appeal with some amendments relating to the percentage of some compounds present in the claimed composition.

Given the minor nature of the amendments, the Board considers it appropriate to exercise its discretion according to Rule 13 of the Rules of Procedure of the Boards of Appeal by admitting this late filed request into the proceedings.

2.2 *Article 84 EPC*

2.2.1 Claim 1 of the first auxiliary request differs from claim 1 of the main request mainly by the introduction of the features "*and there is provided **enhanced shine** of the water-insoluble particles of at least 5 %*" and "*when assessed by the **Shine Enhancement Test** described herein*".

Since said amendments do not derive from the claims as granted, but from the description, they are open to objections under Article 84 EPC.

2.2.2 The question to be answered with respect to the clarity of the claim within the meaning of Article 84 EPC is whether it is possible to determine if a particular embodiment falls within the claim.

The "*Shine Enhancement Test*" is described in paragraphs [0179] to [0181] of the description and is in the present case too long to be included in Claim 1, so that the repetition of the full description of the method in Claim 1 would have resulted in a lack of conciseness. Hence, the reference "*described herein*" is in the present case necessary.

This "*Shine Enhancement Test*" measures the shine intensity of a sample of personal product on skin, and compares it to the baseline obtained with bare skin, which gives the shine enhancement expressed in shine intensity units.

In view of the explanations regarding the "*Shine Enhancement Test*" in paragraphs [0179]-[0181] and the results originating from the examples of the

description, it is however not possible for a skilled person to determine the shine enhancement in percentages as claimed in claim 1. The results of the "*Shine Enhancement Test*" are indeed given as shine intensity units, and the way to correlate and translate these units in the claimed percentage is not given in the description. This uncertainty is emphasized by the comparison between example 23 and the corresponding comparative example H, which are supposed to show the claimed "**enhanced shine** of the water-insoluble particles of at least 5 % relative to the effect provided by the same water-insoluble particles in the absence of structured benefit age in the final composition", and which show respective results of 7.3 and -1.1. In the case of example 23, it is thus not possible to determine whether it provides an enhanced benefit of 5 % and whether it falls under the scope of claim 1.

Moreover, the "*Shine Enhancement Test*" uses particular programs and software to capture and process images of the tested substrate, for which only general information were provided, namely that they were respectively "*Photosuite III*" and a "*program in IDL*". The cited passages do not give further indications on how the shine intensity units were obtained and to what S.I. units they corresponded to.

Also the argument of the appellant that the skin shine enhancement units have been calculated by taking the value of 100 for the baseline obtained for bare skin, so that the values obtained in example 23 and its comparative example H, are respectively 107.3 and 98.9, which leads to an effective skin shine enhancement of respectively 7.3 and -1.1 as shown in Table 8, cannot

succeed, because the description does not provide any basis for a baseline value of 100, and this statement remains a simple allegation. The board can only rely on features present in the claims and in the description, such as in paragraphs [0179]-[0181], which do not give any detail over the baseline value, and in examples 23 and H, where the results are expressed without any indication on the baseline value.

In view of above, claim 1 of auxiliary request 1 does not fulfil the requirement of clarity (Article 84 EPC).

3. *Second auxiliary request*

As for auxiliary request 1, the functional feature "*and there is provided **enhanced shine** of the water-insoluble particles of at least 5 % relative to the effect provided by the same water-insoluble particles in the absence of structured benefit agent in the final composition when assessed by the **Shine Enhancement Test** described herein*" is present in claim 1 of the second auxiliary request. This has as consequence that the clarity objections as raised for the first auxiliary request apply to the second auxiliary request and the same conclusions are obtained.

For these reasons, it is not necessary to decide on the admission of this request into the proceedings.

Consequently, the subject-matter of claim 1 of the second auxiliary request lacks clarity, and the second auxiliary request does not meet the requirements of Article 84 EPC.

4. *Third auxiliary request*

The subject-matter of claim 1 of the third auxiliary request differs from the subject-matter of claim 1 of the second auxiliary request by the introduction of the features "*shower gel*" and "*human skin*".

These differences have no incidence on the lack of clarity relating to the functional feature "*and there is provided **enhanced shine** of the water-insoluble particles of at least 5 % relative to the effect provided by the same water-insoluble particles in the absence of structured benefit agent in the final composition when assessed by the **Shine Enhancement Test** described herein*" in claim 1. For the same reasons as for the second auxiliary request, a decision on the admission of this request into the proceedings is unnecessary.

Consequently, the third auxiliary request does not meet the requirements of Article 84 EPC.

5. *Fourth auxiliary request*

Claim 1 of the fourth auxiliary request differs from claim 1 of the third auxiliary request by the introduction of a concentration range for the optical modifier. This amendment does not affect the objections and conclusions drawn previously.

Consequently, the fourth auxiliary request does not meet the requirements of Article 84 EPC.

6. *Fifth auxiliary request*

Claim 1 of the fifth auxiliary request differs from claim 1 of the fourth auxiliary request by the introduction of the feature "*wherein the anionic surfactant comprises 1% to 20% by weight of the composition*". Also this amendment does not affect the objections and conclusions drawn for all previous auxiliary requests, which therefore apply *mutatis mutandis* to the fifth auxiliary request.

The fifth auxiliary request does therefore not meet the requirements of Article 84 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

D. Semino