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**Datasheet for the decision
of 4 December 2012**

Case Number: T 1222/11 - 3.3.07

Application Number: 05004107.8

Publication Number: 1584325

IPC: A61K 8/362, A61K 8/365,
A61Q 5/06, A61Q 5/12

Language of the proceedings: EN

Title of invention:

Hair cosmetic composition comprising a dicarboxylic acid

Applicants:

KAO CORPORATION

Headword:

-

Relevant legal provisions:

EPC Art. 87(1), 87(4), 88(2), 88(3), 123(2)
Travaux préparatoires M/48/I, Section C

Keyword:

"Novelty destroying application by the same applicant
published between date of priority and date of filing"
"Priority not valid in so far as the claim covers subject-
matter disclosed in an earlier application by the same
applicant"
"Coherence with principles of claiming multiple priorities and
partial priority"
"Disclaimer solely based on a disclosure in an earlier
application by the same applicant not allowed"

Decisions cited:

G 0001/03, G 0002/10, G 0002/98, G 0003/93, G 0003/89,
T 0015/01, T 1877/08, T 0476/09, T 1443/05, T 1127/00

Catchword:

Points 7 to 11.8



Case Number: T 1222/11 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 4 December 2012

Appellants:
(Applicants)

KAO CORPORATION
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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 30 December 2010
refusing European patent application
No. 05004107.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: J. Riolo
Members: F. Rousseau
D. T. Keeling

Summary of Facts and Submissions

I. The appeal lies from the decision of the Examining Division posted on 30 December 2010 refusing European application No. 05 004 107.8, filed on 25 February 2005 and claiming priority from Japanese patent application 2004053708 filed on 27 February 2004.

II. Claim 1 as originally filed read as follows:

"1. A leave-on hair cosmetic composition, comprising the following components (A) and (B):

(A) an organic C₂₋₈ dicarboxylic acid or salt thereof, and

(B) at least one or more of an organic solvent selected from the group consisting of aromatic alcohols, N-alkylpyrrolidones, alkylene carbonates, polypropylene glycols, lactones and cyclic ketones, wherein the organic solvent has a Clog P of from -2 to 3;

wherein the cosmetic composition has a pH of from 2 to 5 at 25°C when diluted to 20 times the weight with water and has a buffering capacity of 0.001 gram equivalent/L or greater but less than 0.2 gram equivalent/L."

III. The contested decision was based on two sets of amended claims as the Applicants' Main and First Auxiliary Requests submitted respectively with letter of 15 September 2010 and at the oral proceedings on 15 October 2010. Claim 1 of the Main Request read as follows:

Main Request

1. A leave-on hair cosmetic composition, comprising the following components (A), (B) and (C):
 - (A) malic acid or a salt thereof in an amount ranging from 0.5 to 10 wt.%;
 - (B) at least one organic solvent selected from benzylalcohol or 2-benzyloxyethanol, in an amount ranging from 0.1 to 5 wt.%; and
 - (C) a set polymer, selected from polyvinylpyrrolidone polymer compounds, acidic vinyl ether polymer compounds, acidic polyvinyl acetate polymer compounds, acidic acrylic polymer compounds, amphoteric acrylic polymer compounds, basic acrylic polymer compounds and chitin/chitosan derivatives, in an amount ranging from 0.1 to 5 wt.%

wherein the cosmetic composition has a pH of from 2 to 5 at 25°C when diluted to 20 times the weight with water and has a buffering capacity of 0.001 gram equivalent/L or greater but less than 0.05 gram equivalent/L,

wherein the following compositions are excluded:

wt-%	Composition 1	Composition 2	Composition 3	Composition 4	Composition 5	Composition 6
Malic acid	4.0	2.5	2.5	2.5	2.5	4.00
Lactic acid	1.0	2.5	2.5	2.5	2.5	1.00
2-Benzoyloxyethanol	1.0	2.5	2.5	2.5	2.5	2.50
N-methacryloyloxyethyl-N,N-dimethylammonium- α -N-methylcarboxybetaine-alkyl methacrylate copolymer solution (30 % ethanol solution)	3.0	-	-	-	1.00	-
Stearyl trimethylammonium chloride	-	0.25	0.25	0.25	0.25	-
Polyvinylpyrrolidone	-	-	-	-	-	3.00
Polyethylene glycol 600	1.0	-	-	-	-	-
Polyoxyethylene hydrogenated castor oil (60 E.O.)	0.5	-	-	-	-	-
Fragrance	-	-	-	-	-	0.05
Polyquartanium-11	-	0.30	-	-	-	-
Polyquartanium-46	-	-	0.30	-	-	-
Polyquartanium-55	-	-	-	0.30	-	-
Ethanol	15.0	4.5	4.5	4.5	4.5	10.00
Water	Balance	Balance	Balance	Balance	Balance	Balance

Sodium hydroxide (48 wt.-% aqueous solution; pH 3.7)	q.s.	q.s.	q.s.	q.s.	q.s.	Sodium hydroxide (pH adjuster) Sufficient to adjust to pH 3.7
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Claim 1 of the Auxiliary Request differed from that of the Main Request in that the ranges defining the amounts of components (A), (B) and (C) had been deleted.

IV. According to the contested decision, the Main Request did not satisfy the requirements of Article 123(2) EPC, because the combination of the four numerical ranges defining the buffering capacity and the concentration of components (A) to (C) was not directly and unambiguously derivable from the original disclosure. As regards the Auxiliary Request, the claims were found to meet the requirements of Articles 123(2) and 54 EPC. D4b (WO 2004/047777) published on 10 June 2004 was prior art pursuant to Article 54(3) EPC, the claim to priority for the present application based on Japanese patent application 2004053708 being acknowledged in view of the translation in English of the latter submitted by the Applicants. The disclaimers introduced into claim 1 were found to restore novelty over the disclosure of D4b and to be allowable in respect of the requirements of Article 123(2) EPC, as D4b belonged to the state of the art pursuant to Article 54(3) EPC and said disclaimers were not broader than necessary and moreover did not affect the assessment of inventive step. The claimed subject-matter was however found to lack an inventive step over D3 (EP-A-1 174 112). The Auxiliary Request was therefore to be refused.

V. With their statement setting out the grounds of appeal dated 9 May 2011, the Applicants (hereinafter the Appellants) submitted a Main and an Auxiliary Request. Claim 1 of the Main Request corresponded to that of the Auxiliary Request on which the decision under appeal was based and reads therefore as follows:

1. A leave-on hair cosmetic composition, comprising the following components (A), (B) and (C):
 - (A) malic acid or a salt thereof;
 - (B) at least one organic solvent selected from benzylalcohol or 2-benzyloxyethanol; and
 - (C) a set polymer, selected from polyvinylpyrrolidone polymer compounds, acidic vinyl ether polymer compounds, acidic polyvinyl acetate polymer compounds, acidic acrylic polymer compounds, amphoteric acrylic polymer compounds, basic acrylic polymer compounds and chitin/chitosan derivatives

wherein the cosmetic composition has a pH of from 2 to 5 at 25°C when diluted to 20 times the weight with water and has a buffering capacity of 0.001 gram equivalent/L or greater but less than 0.05 gram equivalent/L,

wherein the following compositions are excluded:

wt-%	Composition 1	Composition 2	Composition 3	Composition 4	Composition 5	Composition 6
Malic acid	4.0	2.5	2.5	2.5	2.5	4.00
Lactic acid	1.0	2.5	2.5	2.5	2.5	1.00
2-Benzoyloxyethanol	1.0	2.5	2.5	2.5	2.5	2.50
N-methacryloyloxyethyl-N,N-dimethylammonium- α -N-methylcarboxylbetaine-alkyl methacrylate copolymer solution (30 % ethanol solution)	3.0	-	-	-	1.00	-
Stearyl trimethylammonium chloride	-	0.25	0.25	0.25	0.25	-
Polyvinylpyrrolidone	-	-	-	-	-	3.00
Polyethylene glycol 600	1.0	-	-	-	-	-
Polyoxyethylene hydrogenated castor oil (60 E.O.)	0.5	-	-	-	-	-
Fragrance	-	-	-	-	-	0.05
Polyquartanium-11	-	0.30	-	-	-	-
Polyquartanium-46	-	-	0.30	-	-	-
Polyquartanium-55	-	-	-	0.30	-	-
Ethanol	15.0	4.5	4.5	4.5	4.5	10.00
Water	Balance	Balance	Balance	Balance	Balance	Balance

Sodium hydroxide (48 wt.-% aqueous solution; pH 3.7)	q.s.	q.s.	q.s.	q.s.	q.s.	Sodium hydroxide (pH adjuster) Sufficient to adjust to pH 3.7
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Claim 1 of the Auxiliary Request was directed to the use of a composition defined in claim 1 of the Main Request "*as a leave-on hair cosmetic composition for imparting the hair with smoothness and set retention*".

VI. In a communication dated 22 October 2012 the Board questioned the validity of the priority claimed, the compliance of the amended claims with the requirements of Article 123(2) EPC and novelty over the disclosure of D4b.

VII. In response to the Board's communication, the Appellants submitted by letter dated 2 November 2012 further arguments and two Auxiliary Requests replacing the Auxiliary Request then on file. Claim 1 of the First Auxiliary Request differed from Claim 1 of the Main Request in that the six disclaimers were replaced by a single disclaimer formulated as follows:

" wherein a leave-on hair cosmetic composition is excluded which comprises the following ingredients (a) to (c):

- (a) malic acid or a salt thereof;
- (b) lactic acid or a salt thereof; and
- (c) an organic solvent selected from the group consisting of aromatic alcohols, N-alkylpyrrolidones, alkylene carbonates, polypropylene glycol, lactones and cyclic ketones."

Claim 1 of the Second Auxiliary Request was directed to the use of a composition defined in Claim 1 of the First Auxiliary Request "*as a leave-on hair cosmetic composition for imparting the hair with smoothness*".

VIII. The Appellants submitted during the oral proceedings which took place on 4 December 2012 a Third Auxiliary Request, claim 1 of which read as follows:

"1. A leave-on hair cosmetic composition, comprising the following components (A), (B) and (C):

- (A) malic acid or a salt thereof;
- (B) at least one organic solvent selected from benzylalcohol and
- (C) a set polymer, selected from polyvinylpyrrolidone polymer compounds, acidic vinyl ether polymer compounds, acidic polyvinyl acetate polymer compounds, acidic acrylic polymer compounds, amphoteric acrylic polymer compounds, basic acrylic polymer compounds and chitin/chitosan derivatives

wherein the cosmetic composition has a pH of from 2 to 5 at 25°C when diluted to 20 times the weight with water and has a buffering capacity of 0.001 gram equivalent/L or greater but less than 0.05 gram equivalent/L."

IX. The arguments of the Appellants, as far as they are relevant for the present decision, can be summarised as follows:

- (a) D4b was directed to a leave-on-hair cosmetic composition which comprised a combination of malic acid with lactic acid. The combination of those specified acids was essential in accordance with the teaching of that document, as in particular

shown by all examples which contained a combination of these two acids, whereas compositions comprising only one of those acids were marked as comparative examples. It was furthermore evident, having regard to the evaluation of properties such as styling ease, smoothness and stiffness brought about by the compositions of D4b, that a combination of malic and lactic acid was an essential feature of the invention described in D4b.

- (b) In contrast, the present invention was not related to the necessary combination of malic acid and lactic acid. Instead malic acid alone was used and a combination described in the present patent application which contained malic acid led to good smoothness. The comparative test results filed with the Appellants' letter of 15 September 2010 showed that the additional presence of malic acid led to an improvement of smoothness.
- (c) Furthermore, formulating on the basis of D4b a claim directed to a composition not containing lactic acid would go beyond the disclosure of D4b as originally filed.
- (d) Accordingly, it was evident that the invention of D4b differed from the invention of the present patent application particularly with respect to the teaching that instead of a combination of malic acid and lactic acid it was possible to use malic acid alone. Moreover, it had been repeatedly stated during the written examination procedure that D4b remained completely silent in regard to buffering capacity. Accordingly, when performing the

invention underlying D4b it was not evident to the inventors that buffering capacity should be considered and should be restricted to fall within a specified range. Therefore, the priority should be acknowledged for the present application.

(e) It was not disputed that the disclaimers present in the Main, First and Second Auxiliary Requests would be unallowable, should D4b be state of the art pursuant to Article 54(2) EPC.

(f) The Third Auxiliary Request was based on claim 1 as originally filed and the teaching of using the preferred dicarboxylic acid, i.e. malic acid, in combination with one of the preferred solvents described in paragraph [0018] of the application as filed, namely benzylalcohol and one of the set polymers disclosed on page 9 of the application as filed. The Third Auxiliary Request was therefore allowable under Article 123(2) EPC and should be admitted into the proceedings.

X. The Appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the Main Request submitted by letter of 9 May 2011, or in the alternative, on the basis of the claims of the First or Second Auxiliary Request submitted by letter of 2 November 2012 or on the basis of the claims of the Third Auxiliary Request submitted at the oral proceedings.

XI. The decision was announced at the end of the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

Main Request

Amendments

2. Compared to claim 1 as originally filed, claim 1 of the Main Request has been amended by (i) restricting the definition of component (A) from "an organic C₂₋₈ dicarboxylic acid or salt thereof" to malic acid or a salt thereof, (ii) restricting the definition of component (B) from "at least one or more of an organic solvent selected from the group consisting of aromatic alcohols, N-alkylpyrrolidones, alkylene carbonates, polypropylene glycols, lactones and cyclic ketones, wherein the organic solvent has a Clog P of from -2 to 3" to at least one organic solvent selected from benzylalcohol or 2-benzyloxyethanol, (iii) making mandatory the use of a set polymer selected from polyvinylpyrrolidone polymer compounds, acidic vinyl ether polymer compounds, acidic polyvinyl acetate polymer compounds, acidic acrylic polymer compounds, amphoteric acrylic polymer compounds, basic acrylic polymer compounds and chitin/chitosan derivatives, (iv) restricting the upper value of the buffering capacity of the composition to 0.05 gram equivalent/L and (v) disclaiming six particular compositions.
3. It is not disputed that the six disclaimers contained in Claim 1 are "undisclosed disclaimers" within the meaning of G 1/03 (OJ EPO, 2004, 413), i.e. concern

subject-matters which are not disclosed as such in the application as originally filed (see G 2/10, OJ EPO, 2012, 376, point 3 of the reasons). They have the purpose of restoring novelty over D4b, which is an earlier application by the present Applicants, published in the Japanese language between the priority date claimed and the filing date of the present application. A translation in English of D4b, which entered the European phase, was published in accordance with Article 158(3) EPC as D4 (EP-A-1 570 832). The passages of D4b indicated in the present decision refer to the corresponding passages in the latter publication D4.

Disclosure of D4b and comparison with the present application

4. Claim 1 of D4b is directed to leave-on hair cosmetic compositions comprising malic acid or a salt thereof, lactic acid or a salt thereof and an organic solvent selected from the group consisting of aromatic alcohols, N-alkylpyrrolidones, alkylene carbonates, polypropylene glycol, lactones and cyclic ketones, wherein the organic solvent has a Clog P of from -2 to 3. The compositions are described to provide set retention, sleekness and smoothness to the hair (see paragraphs [0006] and [0007], experimental results on pages 10 and 11, Tables 2 and 3 and explanations concerning their evaluation in paragraph [0042]).

4.1 D4b discloses in particular six specific leave-on hair cosmetic compositions (Table 4, Example 10; Table 5, Example Products 11 to 14; Example 6, page 16) on the basis of which the present disclaimers have been formulated. They comprise malic acid, lactic acid, 2-

Benzyloxyethanol, a set polymer, namely either a polyvinylpyrrolidone polymer (Example Products 11 to 13 and product of Example 6) or an amphoteric acrylic polymer (Product Examples 10 and 14). Their pH is 3.7 and has been adjusted with an aqueous solution of sodium hydroxide.

4.2 In line with the disclosure of these exemplified compositions, D4b teaches, like the present application as filed (see page 7, paragraph [0018]), that the preferred ingredients for the organic solvent include benzyl alcohol, benzyloxyethanol, propylene carbonate, and polypropylene glycol (number average molecular weight: 300 to 500, especially 400) (see last line of paragraph [0011]). The use of a set polymer is considered to be optional both in D4b (see claim 3 and paragraph [0018]) and in the application as filed (see claim 2 and paragraph [0024]), the lists of set polymers exemplified in D4b and in the application as filed being identical, including the classes of set polymers defined in claim 1 of the present requests. D4b also discloses that it is preferred, in order to achieve the objective of D4b with respect to sleekness of hair and styling ease, that the pH measured at 25°C of the cosmetic solution diluted 20-fold in water is in a range of from 2.5 to 4.5, more preferably in a range of from 3 to 4.2 (see paragraph [0033]), i.e. within the pH range defined in claim 1 of the present request. Hence, the technical information in the application as filed regarding the use of the preferred organic solvent, of the set polymer and of a pH range does not differ from that provided in D4b, with the consequence that any pointer to be found in the application as filed to the combination of features defined in the

first part of present claim 1 in terms of positive features with the exception of buffering capacity is also to be found in D4b.

4.3 As to the buffering capacity defined in present claim 1, this parameter results from the presence of a buffering agent such as compound (A), i.e. the organic C₂₋₈ dicarboxylic acid or salt thereof (see paragraph [0044] of the present application), in particular malic acid, in an amount preferably from 0.5 wt.% to 10 wt.% (page 4, paragraph [0004]), i.e. the same amount as taught in D4b in paragraph [0008]. Moreover, lactic acid is known as a conventional buffering agent and is used according to paragraph [0009] of D4b in an amount preferably lying within the range from 0.5 to 10 wt.-%. The present application confirms with Example 5 that the mere presence of malic acid in an amount of 4 wt.% and lactic acid in an amount of 1 wt.%, i.e. the respective amounts of those acids used in Example Product 10 and Example Product 6 of D4b, now disclaimed, brings about a buffering capacity of 0.006 gram equivalent/L, i.e. within the range broadly defined in present claim 1. Thus, in view of the above, it is concluded that Example Product 10 and Example Product 6 of D4 exhibit the buffering capacity required by present claim 1. Also, a strong presumption has been established that Example Products 11 to 14 which contain equal amounts of malic and lactic acids, i.e. 5 wt.% in total, like Example 5 of the present application, also meet the parametric definition of buffering capacity as defined in claim 1 of the Main Request. The Applicants, although they argued that D4b remained completely silent in regard to buffering capacity, did not argue that said parameter constituted a distinguishing

feature. In view of the strong presumption established above that these specific embodiments also fulfil this parametric condition, and the absence of evidence to the contrary, let alone any denial by the Appellants that it is so, the Board concludes that the above six examples of D4b fall within the definition of the composition defined in positive terms in the first part of claim 1.

5. It follows also from the above that the disclosure of D4b overlaps with the definition of the compositions defined in positive terms in present claim 1 (i.e. in the absence of the disclaimers), D4b giving direct and unambiguous pointers, at least through the disclosure of six exemplified compositions, corresponding to the compositions presently disclaimed, to apply the technical teaching of D4b in that area of overlap. The use of six disclaimers for the Main Request, which correspond to six compositions falling within the area of overlap between the present application and D4b raises the issue of whether these disclaimers could in any event succeed in restoring novelty. It is however more appropriate in the present case, as the same question also arises for the First and Second Auxiliary Requests, which contain a more broadly defined disclaimer also solely based on the disclosure of D4b, to first examine whether a disclaimer based on the sole disclosure of D4b and not on the application as filed might be allowable having regard to the requirements set out in decisions G 1/03 and G 2/10. As the present disclaimers have the purpose of restoring novelty over D4b, it is necessary in view of the criteria developed in decision G 1/03 for allowability of disclaimers introduced to restore novelty to determine whether D4b

published between the priority date claimed and the filing date represents state of the art pursuant to Article 54(3) EPC or a disclosure pursuant to Article 54(2) EPC.

6. In the context of assessing whether D4b is state of the art pursuant to Article 54(3) or Article 54(2) EPC, the question arises whether the combination of features defined in positive terms in amended claim 1, i.e. before the introduction of the disclaimers, or in other words in the absence thereof, enjoys the priority claimed. In this respect reference is also made to point 4 of the Reasons for the Decision of G 1/03, according to which the introduction during the prosecution of a European patent application of an allowable disclaimer does not change the identity of the invention within the meaning of Article 87(1) EPC.

Priority

7. The text of the present application as filed corresponds to the translation in English of the Japanese patent application 2004053708, on the basis of which priority is presently claimed. According to Article 87(1) EPC, a requirement for enjoying a right of priority for filing a European patent application is that the application for a patent, a utility model or a utility certificate on the basis of which the priority is claimed must be the first application in respect of the same invention. According to Article 87(4) EPC, the definition of a first application extends also to a subsequent application in respect of the same subject-matter as the previous first application and filed in or for the same State, provided that at the date of

filing of the subsequent application, the previous first application has been withdrawn, abandoned or refused without having become open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority.

8. The purpose of the provisions of Article 87(4) EPC is to allow applicants to replace a previous application by a subsequent application and still benefit from a right of priority. The reasons may be that the previous application which has been filed did not describe the invention properly or might need to be supplemented by additional embodiments resulting from further research developments. Patent applicants may in particular wish to combine the originally disclosed subject-matter of the first filing with further additional related embodiments developed during the priority period within one and the same application, while claiming and enjoying priority from the embodiments disclosed in the first filing (see T 15/01, OJ EPO 2006, 153; point 38 of the Reasons for the decision).

9. If Japanese patent application 2004053708, on the basis of which priority is presently claimed and the earlier PCT application PCT/JP2003/014791 filed on 20 November 2003 related to the same invention, the later Japanese patent application could not represent such a subsequent application being considered as the first application within the meaning of Article 87(4) EPC replacing the earlier PCT application for the benefit of a right of priority for said invention, as the above earlier application was published as D4b and entered the European phase (see point 3 above). The question therefore arises whether

or not the subject-matter of claim 1 of the Main request in the absence of any disclaimer, which subject-matter is also disclosed in Japanese patent application 2004053708 on the basis of which priority is presently claimed, is in respect of the same invention as already disclosed in D4b.

- 9.1 In view of opinion G 2/98 (OJ EPO 2001, 413) (see points 2 to 6.8 of the Reasons), a narrow or strict interpretation of the concept of "the same invention" referred to in Article 87(1) EPC, equating it with the concept of "the same subject-matter" referred to in Article 87(4) EPC, is perfectly consistent with the relevant provisions of both the Paris Convention and the EPC.
- 9.2 It follows from the above that the combination of features defined in positive terms in the first part of present claim 1 of the Main Request cannot be distinguished from the disclosure of the earlier application D4b. Example Products 10 to 14 and Example Product 6 of D4b constitute prior disclosures of the combination of features defined in positive terms in the first part of present claim 1 of the Main Request and therefore cannot be held to relate to a different subject-matter, i.e. a different invention. In view of the above, the subject-matter defined in amended claim 1 in positive terms (i.e. without any disclaimer) is not entitled to priority as far as far it concerns the subject-matter already disclosed in D4b.
- 9.3 The Appellants' argument that the presently claimed invention differs from that of D4b, as it does not require the presence of lactic acid, fails to convince

in view of the meaning of "invention" equating with "subject-matter", which subject-matter, in the absence of the present disclaimers, cannot be distinguished from that disclosed in D4b.

- 9.4 The Appellants' further argument that the claimed invention or claimed subject-matter in D4b does not provide any basis for claiming, as in present claim 1, the use of malic acid without any restriction to its combined use with lactic acid does not mean that D4b and the present application do not contain a common subject-matter or invention, but only means that the disclosure of D4b does not extend to the use of malic acid without any lactic acid. In other words, the present subject-matter can be seen as the invention of D4b supplemented with additional subject-matter relating to the use of malic acid without lactic acid, whereas the Appellants did not make use of the provisions of Article 87(4) EPC in order to claim on the basis of the present priority document a first filing in respect of the subject-matter defined in the present claims, or take advantage of the possibility to file a separate application disclosing these additional embodiments, possibly to benefit from a priority right for the additional embodiments in a later application.
10. Consequently, in view of the ruling in opinion G 2/98, that the concept of "the same invention" referred to in Article 87(1) EPC may be equated with the concept of "the same subject-matter", it must be concluded for this reason alone that the Appellants cannot benefit from the priority claimed for the combination of features defined in positive terms in amended claim 1, in so far as it covers subject-matter disclosed in D4b,

in particular in so far as it covers the six compositions disclosed in D4b which the Appellants are seeking to disclaim.

Additional remarks in relation to priority

11. According to opinions G 3/93 (OJ EPO 1995, 18, point 4) and G 2/98 (see point 3 of the Reasons) Articles 87 to 89 EPC provide a complete, self-contained code of rules of law on the subject of claiming priority for the purpose of filing a European patent application and are clearly intended not to contravene the basic principles concerning priority laid down in the Paris Convention. Therefore, although the following considerations are not part of the reasons for denying priority for present claim 1 in so far as it covers compositions already disclosed in D4b (see points 7 to 10 above), the Board nevertheless considers it useful to explain why the reasons given above for denying priority for present claim 1, in so far as it covers compositions disclosed by D4b, although present claim 1 is not specific as to the presence or absence of lactic acid, are coherent with the principles of claiming multiple priorities and claiming partial priority, which are enshrined in Article 4F of the Paris Convention and reflected in the corresponding provisions of the EPC, namely Article 88(2) and (3) (see G 2/98, point 6.1 of the Reasons and T 15/01, points 31 to 33 of the Reasons for the decision).

11.1 It follows from points 6.3 and 6.4 of the Reasons for opinion G 2/98 that the legislative intent underlying Article 88(2), second sentence, EPC, concerning the possibility of claiming multiple priorities for any one

claim is expressed in Memorandum C drawn up by FICPI (M/48/I, Section C) (hereafter "Memorandum") for the Munich Diplomatic Conference in 1973. According to the Memorandum, when evaluating whether there is any justification for claiming multiple priorities for one and the same claim of an application, a distinction has to be made between (i) "AND"-claims and (ii) "OR"-claims (see point 6.5 of the Reasons).

11.2 As regards the "AND"-claim situation, the Memorandum stated (see point 6.6 of the Reasons for opinion G 2/98) that where a first priority document discloses a feature A, and a second priority document discloses a feature B for use together with feature A, "then a claim directed to A+B cannot enjoy a partial priority from the first priority date, because the invention A+B was disclosed only at the date of the second priority document".

11.3 Concerning the "OR"-claim situation it is stated in the Memorandum, according to point 6.7 of the Reasons for opinion G 2/98, that where a first priority document discloses a feature A, and a second priority document discloses a feature B for use as an alternative to feature A, then a claim directed to A or B can enjoy the first priority for part A of the claim and the second priority for part B of the claim (for the definition of the "OR"-claim situation given in the Memorandum, see point 11.5.4 below). It is also added in the penultimate sentence of point 6.7 of the Reasons for opinion G2/98 that the Memorandum suggests that these two priorities may also be claimed for a claim directed to C, if the feature C, either in the form of a generic term or formula, or otherwise, encompasses

feature A as well as feature B, the last sentence of point 6.7 of the Reasons reading *"The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2), second sentence, EPC is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters."*

11.4 The Board is aware of decisions T 1877/08 of 23 February 2010 (point 2.4 of the Reasons), T 476/09 of 21 September 2012 (point 5.6 of the Reasons), T 1443/05 of 4 July 2008 (point 4.2.6 of the Reasons) and T 1127/00 of 16 December 2003 (point 6 of the Reasons) according to which the condition *"provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters"* set out in point 6.7 of G 2/98 was seen as characterising the manner in which the subject-matter of the "OR"-claim must be defined. In decisions T 1877/08 and T 476/09, the claim of the application defined larger numerical ranges than those defined in the priority document. A partial priority was denied for the compositions disclosed in the priority document, which were encompassed by the composition of the application, on the ground that the claimed ranges represented a continuum of numerical values, from which no separable alternative embodiments, i.e. elements in the sense of Article 88(3) EPC, could be identified. In T 1127/00, partial priority for a claim directed to a generic formula which was broader than the generic formula defined in the priority document was not upheld. The claim covered a great number of alternative compounds which were not, as such, spelled out in the claim and

which did not represent a limited number of clearly defined alternative subject-matters in the form of an "OR"-claim, which could be split up into groups of different priorities. The fact that these compounds might be intellectually envisaged to fall within the scope of the claim was not considered to make up for a clear and unambiguous presence of these alternatives, individualized as such. Claim 1 could not enjoy the partial priority from a priority document, but could only be entitled to the priority date of the document where the said generic formula was for the first time disclosed.

11.5 The present Board is however of the opinion as explained below that the condition "*provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters*" should be given, when read in its proper context, a different meaning than that attributed to it by the respective Boards in the above mentioned decisions T 1877/08, T 0476/09, T 1443/05 and T 1127/00. As a preliminary remark, this condition cannot be meant to set out the manner in which the subject-matter of the "OR"-claim must be defined, i.e. to give "*rise to the claiming of a limited number of clearly defined alternative subject-matters*" as this would, at least in relation to generic terms, be at variance with the disclosure test based on the principle of an unambiguous and direct disclosure set out in opinion G 3/89 (OJ EPO, 1993, 117). Furthermore, and more importantly:

11.5.1 Article 88(3) EPC, which is referred to in the last sentence of point 6.7, reads "If one or more priorities are claimed in respect of a European patent application,

the right of priority shall cover only those elements of the European patent application which are included in the application or applications whose priority is claimed". In the context of point 6.7 of the Reasons of opinion G 2/98 concerning exclusively the question of the claiming of multiple priorities for one and the same "OR"-claim, the reference to Article 88(3) EPC in the last sentence of point 6.7 of the Reasons means therefore that the Enlarged Board indicates under which conditions the assessment required by Article 88(3) EPC, as to which elements of the "OR"-claim are covered by any of the multiple priority claims, can be made when the "OR"-claim is drafted using a generic term or formula.

11.5.2 Furthermore, it has to be borne in mind that the assessment required by Article 88(3) EPC, as to which elements (alternatives) of the "OR"-claim are covered by any of the multiple priority claims can be achieved only by a comparison of the claimed subject-matter of that "OR"-claim with the disclosure of the multiple priority documents. Therefore, in the context of assessing which elements of the "OR"-claim are covered by any of the multiple priority documents, the words "gives rise to the claiming of a limited number of clearly defined alternative subject-matters" refer to the ability to conceptually identify by said comparison a limited number of clearly defined alternative subject-matters to which the multiple rights of priority claimed can be attributed or not.

11.5.3 That this comparison should give rise to a limited number of clearly defined alternative subject-matters is obviously necessary in order to identify which parts

of the claims benefit from the effect of the priority right defined in Article 89 EPC. For the avoidance of doubt, the Board wishes to add that it is not the task of the European Patent Office to determine *ex officio* to which parts of an "OR"-claim can be attributed the right(s) of priority claimed. In view of an intermediate prior art which appears relevant for assessing the patentability of a particular "OR"-claim, the burden of proof that said particular claim benefits from a partial priority or partial priorities, if the latter is *prima facie* not immediately obvious, is on the person alleging the existence of said partial priority.

11.5.4 Furthermore, the above analysis of the last sentence of point 6.7 of the Reasons for opinion G 2/98 holds good in the light of the Memorandum, which according to the Enlarged Board proved the intent of the legislator concerning the question of multiple priorities. As to "OR"-claims, which are spelled out in this manner in the Memorandum, those are defined as claims which are *"too broad to be supported by the disclosure of the first priority document"* (the passages relating to the Memorandum and indicated in italics are quotations from the latter). According to page 2 of the Memorandum, *"It is of course immaterial whether the word "or" actually occurs in the claim, or is implied through the use of a generic term, or otherwise"*. The Memorandum goes on to provide three typical examples of *"situations of the "OR"-type"*.

11.5.5 According to the first example entitled *"Broadening of chemical formulae"*, *"A first priority document discloses a relatively narrow chemical formula*

supported by representative examples. A second priority document discloses a broader chemical formula which within its scope includes the narrower chemical formula, and which is supported by additional examples justifying the broader formula. If multiple priorities for one and the same claim are allowed, it will suffice to draw up a single claim directed to the broad formula. This claim will then enjoy priority from the first priority date to the extent that the compound in question comes within the scope of the narrow formula, and the second priority for the rest of its scope. If multiple priorities for one and the same claim are not allowed, the applicant would have to draw up two parallel claims, one directed to the narrow formula and enjoying the first priority, and another directed to compounds coming within the broad formula, but not within the narrow formula. The latter claim would then enjoy the second priority." This example which is not specified to relate to a claim directed to a limited number of clearly defined alternative subject-matters confirms, through the use of the terms "*within the scope*" and "*for the rest of its scope*" and the identification of the parts of the claim enjoying the respective rights of priority, that the attribution of the partial priorities to the different parts of the claim has to be made by a comparison of the subject-matter of the claim with the disclosure of the priority documents. The clearly defined alternative subject-matters are in this example the narrow formula and the rest of the scope of the claim.

11.5.6 According to the second example of the Memorandum entitled "*Broadening of range (temperature, pressure, concentration, etc.)*" "*a first priority document*

discloses a temperature range of 15-20°C and a second priority document discloses a temperature range of 10-25°C. If multiple priorities for one and the same claim are allowed, it will suffice in the European patent application to draw up a claim directed to the temperature range 10-25°C. If multiple priorities for one and the same claim are not allowed, the applicant will have to draw up two parallel claims, one directed to the temperature range 15-20°C and enjoying the first priority, and another claim directed to the temperature ranges 10-15° or 20-25°C, which claim will then enjoy the priority of the second priority document which was the first one to disclose these temperature ranges". It follows from this second example, that the claim defining a temperature range of 10-25°C enjoys the first priority for the temperature range 15-20°C, although the latter is neither explicitly nor implicitly disclosed in the claim. The clearly defined alternative subject-matters are in this example the three above mentioned temperature ranges.

- 11.5.7 That the different dates of priority should be attributed through a comparison between the claimed subject-matter and the subject-matter of the priority documents and that partial priority is not reserved only to claims which define on their own "a limited number of clearly defined alternative subject-matters" is also illustrated by the third example of the Memorandum. In this third Example, the first priority document discloses a method of coating the inner wall of a pipe and the second priority document discloses the use of the same method for coating the inner wall of bottles or any other hollow bodies. According to the Memorandum, *"If multiple priorities for one and the*

same claim are allowed, it will suffice in the European patent application to draw up a claim to a method for coating the inner wall of hollow bodies. If multiple priorities for one and the same claim are not allowed, the applicant will have to draw up two parallel claims, one directed to a method of coating the inner wall of pipes, which claim will enjoy the first priority, and a second claim directed to a method of coating the inner wall of hollow bodies not being pipes, which claim would enjoy the second priority." The identifiable alternatives resulting from the comparison between the claimed subject-matter and the priority documents are in this case the method of coating the inner wall of pipes and the method of coating the inner wall of hollow bodies not being pipes.

11.5.8 Thus the Memorandum, which was considered by the Enlarged Board to express the legislative intent underlying the possibility of claiming multiple priorities for any one claim as defined in Article 88(2), second sentence, EPC, confirms through the situations exemplified therein the significance to be attributed to the condition referred to in point 6.7 of the Reasons for opinion G 2/98, as indicated in point 11.5.2 above, namely the ability to conceptually identify a limited number of clearly defined alternative subject-matters by a comparison of the subject-matter of that "OR"-claim with the disclosure of the multiple priority documents, so as to determine which parts of the "OR"-claim or alternative subject-matters are covered by the rights of priority claimed.

11.6 Bearing in mind the above conclusion concerning assessment of partial priority for an "OR"-claim (claim

too broad to be supported by the disclosure of the first priority document, as defined in the Memorandum) when multiple priorities are claimed, there is no reason why the assessment of partial priority for an "OR"-claim should be different depending on whether a single priority or multiple priorities are claimed, nor is there any provision in the EPC which would support a different view. Article 88(3) EPC does not make any difference in this respect. Referring to any of the examples given in the Memorandum, for the part of the subject-matter claimed corresponding to the subject-matter disclosed in the first priority document, there is no reason why the validity of the priority disclosing a first subject-matter should be made dependent on the existence of a later second priority document disclosing a subject-matter broader in scope and encompassing the earlier disclosure. Hence, the condition referred to in point 6.7 of the Reasons for opinion G2/98 must be considered to be applicable also when assessing partial priority in relation to a single priority document, i.e. the comparison of the claimed subject-matter of that "OR"-claim with the disclosure of the priority document must give rise to a limited number of clearly defined alternative subject-matters, so that it is possible to determine which subject-matters are covered by the priority claimed and which are not.

- 11.7 According to the conclusion of opinion G 2/98, "The requirement for claiming priority of "the same invention", referred to in Article 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC is to be acknowledged only if the

skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole". For the sake of avoiding any misunderstanding, it is pointed out that applying the principle of partial priority in the context of "OR"-claims as defined in the Memorandum, i.e. claims too broad to be supported by the disclosure of the first priority document, does not contradict the conclusion reached in opinion G 2/98, because that conclusion is not given in respect of "OR"-claims, as implicitly follows from the Reasons for opinion G 2/98, in particular point 6.7 (see point 11.3 above), and the wording of the conclusion itself.

- 11.8 It is therefore concluded that in so far as a subject-matter disclosed in a priority document and encompassed by an "OR"-claim of a European application (i.e. a claim of a European application which compared to the disclosure of the subject-matter in the priority document has been broadened) is concerned, the decision on whether priority can be acknowledged for this subject-matter, i.e. for this embodiment covered by the "OR"-claim, is independent of whether said subject-matter or embodiment disclosed in the priority document is identified in the "OR"-claim of the European application as a separate alternative embodiment. The above conclusion, however, also implies in view of the necessary coherence of rules of law on the subject of claiming priority defined in the EPC, that when an application on the basis of which a priority date is claimed encompasses a narrower subject-matter already disclosed by the same applicant in an earlier application, the decision on whether the claim to priority on the basis of the later application is valid

does not depend on whether the narrower subject-matter disclosed in the earlier application is identified in said later application. The latter situation is precisely the one underlying the case under appeal.

Allowability of the disclaimers

12. As the claimed priority for the combination of features defined in positive terms in amended claim 1, i.e. before the introduction of the disclaimers, does not hold at least with respect to the six compositions already disclosed in application D4b, as follows from above points 7 to 10, the publication of those embodiments of D4b before the filing date of the present application constitutes prior art pursuant to Article 54(2) CBE. As the anticipatory disclosure of D4b also concerns according to its claim 1 leave-on hair compositions, it does not constitute an accidental anticipation within the meaning of G 1/03 with the consequence that the six disclaimers introduced, which are based solely on the disclosure of document D4b, are not allowable under Article 123(2) EPC.
13. The Main Request is therefore rejected.

First Auxiliary Request

14. Claim 1 of the First Auxiliary Request differs from claim 1 of the Main Request only in the disclaimer being more broadly formulated, which disclaimer is based solely on the disclosure of D4b. Thus, the reasoning given for the Main Request in respect of priority and allowability of the disclaimer arrived at

is also valid for the First Auxiliary Request. The First Auxiliary Request is therefore rejected.

Second Auxiliary Request

15. Compared to the First Auxiliary Request, claim 1 of the Second Auxiliary Request has been reworded as a use claim directed to the use of the composition defined in claim 1 of the First Auxiliary Request for imparting the hair with smoothness. As indicated in above point 4, the leave-on hair cosmetic compositions of D4b are disclosed to provide set retention, sleekness and smoothness to the hair. Thus, the amendment introduced with the Second Auxiliary Request cannot change the conclusion in respect of priority which has been reached in relation to the Main and First Auxiliary Requests, with the consequence that the disclaimer contained in claim 1 of the Second Auxiliary Request, which is identical to that contained in claim 1 of the First Auxiliary Request, is also not allowable for the reasons given for the First Auxiliary Request. The Second Auxiliary Request is thus also rejected.

Third Auxiliary Request

16. Claim 1 of the Third Auxiliary Request is now directed to leave-on hair cosmetic compositions which require the combined use of (A) malic acid or a salt thereof, (B) benzylalcohol and (C) a set polymer, selected from polyvinylpyrrolidone polymer compounds, acidic vinyl ether polymer compounds, acidic polyvinyl acetate polymer compounds, acidic acrylic polymer compounds, amphoteric acrylic polymer compounds, basic acrylic polymer compounds and chitin/chitosan derivatives, the

pH and the buffering capacity of the composition being defined as in claim 1 of the Main Request. It is based, in the Appellants' opinion, on claim 1 as originally filed and the teaching of using the preferred dicarboxylic acid, i.e. malic acid, in combination with one of the preferred solvents described in paragraph [0018], namely benzyl alcohol, and one of the set polymers disclosed on page 9 of the application as filed.

17. In order to determine whether claim 1 of the Third Auxiliary Request offends against Article 123(2) EPC, it must be examined whether technical information has been introduced which a skilled person would not have directly and unambiguously derived from the application as filed. It is in this respect not sufficient to demonstrate that the text as originally filed provides a basis for each of the amended features introduced into original claim 1 when they are considered in isolation, but it is rather necessary to demonstrate that those features are disclosed in the application as filed in the context of present claim 1, i.e. in their present combination with the features of original claim 1. Whereas, the application as originally filed teaches that benzyl alcohol is one of the preferred organic solvents (B), there is no disclosure that this specific solvent should be used in combination with a set polymer, which component is merely described in the original disclosure as being optional. The examples of the original disclosure do not suggest such a combination either, since the only exemplified leave-on hair cosmetic composition which comprises benzyl alcohol does not even use a set polymer. Hence, in the absence of any pointer in the application as filed to

associate a set polymer with the specific selected solvent benzyl alcohol, the combination of features now claimed provides the skilled person with technical information which was not directly and unambiguously derivable from the application as filed. Consequently, the subject-matter of claim 1 of the Third Auxiliary Request extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC, with the consequence that said Third Auxiliary Request is also not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

S. Fabiani

J. Riolo