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**Datasheet for the decision
of 10 November 2015**

Case Number: T 0839/12 - 3.3.07

Application Number: 07022336.7

Publication Number: 1925284

IPC: A61K8/11, A61K8/26, A61K8/29,
A61K8/41, A61Q5/12

Language of the proceedings: EN

Title of invention:
Conditioning composition for keratin fibres

Patent Proprietor:
Kao Germany GmbH

Opponent:
L'Oréal

Relevant legal provisions:
EPC Art. 54(3), 100(b), 111(1), 114(2)
EPC R. 81(1)

Keyword:
Sufficiency of disclosure - (yes)
Novelty - prior European application
Appeal decision -
remittal to the department of first instance (yes)

Decisions cited:
G 0010/91



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0839/12 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 10 November 2015

Appellant: Kao Germany GmbH
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Respondent: L'Oréal
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 5 March 2012
revoking European patent No. 1925284 pursuant to
Article 101(3) (b) EPC.

Composition of the Board:

Chairman J. Riolo
Members: D. Semino
P. Schmitz

Summary of Facts and Submissions

I. European Patent No. 1 925 284 was granted on the basis of European patent application No. 07 022 336.7 which was filed on 17 November 2007 claiming the priority date of 24 November 2006. The granted patent included 10 claims, independent claims 1 and 9 reading as follows:

"1. Aqueous composition for conditioning keratin fibres especially for human hair characterised in that it comprises at least one cationic surfactant at a concentration of 0.01 to 10% by weight, and at least one colour effect pigment consisting of synthetic mica coated with metal oxide or oxides and having a volume particle size distribution of 1 to 750 µm at a concentration of 0.01 to 10% by weight, calculated to total composition."

"9. Process for conditioning keratin fibres especially human hair characterised in that after washing with a cleansing composition or wetting, an aqueous composition according to claims 1 to 8 is applied and after processing period of 30 sec to 30 min rinsed off."

II. A notice of opposition was filed in which revocation of the patent in its entirety was requested on the grounds of lack of novelty and of inventive step and of insufficiency of disclosure (Article 100(a) and (b) EPC).

III. During opposition proceedings, the following documents *inter alia* were cited:

D1: US-A-2007/0141002 published on 21 June 2007

D6: WO-A-2007/060597 filed on 20 November 2006 and published on 31 May 2007

D12: Trail report filed by the patent proprietor with letter of 6 January 2012

- IV. The decision of the opposition division to revoke the patent was announced at the oral proceedings on 7 February 2012. It was based on the patent as granted as main request and on two sets of claims filed during oral proceedings on 7 February 2012 as auxiliary requests 1 and 2.

Claim 1 of auxiliary request 1 corresponded to granted claim 1 with the specification that the cationic surfactant was a compound according to a general chemical formula which corresponded to the one in granted claim 2 with the deletion of hydrogen as a possible substituent. Claim 1 of auxiliary request 2 corresponded to granted claim 1 with the addition of a disclaimer with respect to D6 in the form of a table taken from that document.

- V. The decision of the opposition division, as far as relevant to the present decision, can be summarised as follows:

- a) Document D6, a family member of D1, which was filed with the notice of opposition, but which did not constitute prior art, had been filed within the time limit for making written submissions before oral proceedings and was *prima facie* very relevant for the issue of novelty. On that basis it was admitted into the proceedings.
- b) The grounds under Article 100(b) EPC did not prejudice maintenance of the patent, as examples

of suitable particles with the desired particle size distribution were available in the patent.

- c) The subject-matter of granted claim 1 was not novel over example 2 of D6, which disclosed a composition comprising both a cationic surfactant and a coated synthetic mica in quantities within the ranges of the claims. In this respect, the calculation of the percentage of the pigments in the composition of example 2 done by the patent proprietor was incorrect.

- d) Claim 1 of auxiliary request 1 did not meet the requirements of Article 123(2) EPC, as the introduction of the compounds of granted claim 2 with the deletion of hydrogen as a substituent generated a new family of cationic compounds which was not originally disclosed.

- e) Claim 1 of auxiliary request 2 did not meet the requirements of Article 84 EPC, as the introduced disclaimer included some trade marks without a clear technical meaning.

VI. The patent proprietor (appellant) lodged an appeal against that decision. With the statement setting out the grounds of appeal the appellant maintained his main request and filed a set of claims as auxiliary request 1.

In auxiliary request 1 all product claims were deleted and claim 1 corresponded to granted claim 9 with the wording of granted claim 1 introduced in it for the definition of the aqueous composition.

- VII. In the reply to the grounds of appeal, the opponent (respondent) maintained the objections of lack of sufficiency, lack of novelty and lack of inventive step.
- VIII. In a communication sent in preparation of oral proceedings, the Board summarised the points to be dealt with, and, with regard to the possibility of remitting the case, indicated that "In view of the lack of a decision on inventive step by the first instance and of the incompleteness of the analysis on inventive step in the submissions in appeal (the appellant has provided few sentences, the respondent has disregarded the latest evidence of the appellant filed in opposition), the Board is inclined to remit the case to the first instance, if the grounds of lack of sufficiency and lack of novelty are found not to prejudice maintenance of the patent in amended form" (point 5 in the communication).
- IX. With letter of 26 October 2015, the respondent indicated that it did not find it necessary to remit the case and gave some arguments on inventive step of auxiliary request 1 without taking position on document D12.
- X. Oral proceedings were held on 10 November 2015 in the announced absence of the respondent.
- XI. The arguments of the appellant, as far as relevant to the present decision, can be summarised as follows:

Admissibility of novelty as a ground of opposition

- a) Novelty as a ground of opposition was not properly raised in the notice of opposition, as a document

was cited (D1), which manifestly did not belong to the state of the art, while document D6 was only filed shortly before the oral proceedings. In view of that this ground must be rejected as inadmissible.

Patent as granted - novelty

- b) With regard to example 2 of D6, the dimethylamine compound had a cationic head only in the presence of dissociated acids and, in spite of the presence of acids, no pH value was disclosed, so that it was not clear if the compound was indeed in cationic form in the specific composition. Moreover, the composition of example 2 comprised 2% of a shine enhancing system comprising 2.2% colour effect pigment of synthetic mica, which meant that the pigment was at a concentration of 0.00044% by weight of the final composition, i.e. at a value below the lower limit of 0.01% by weight in claim 1. On that basis claim 1 was novel over D6.

Auxiliary request 1 - remittal

- c) Claim 1 of auxiliary request 1 was novel, as example 2 of D6 disclosed a leave-on composition. In view of the age of the case and the absence of new material in appeal, also inventive step should be decided upon in spite of the absence of a decision on the issue.

No submissions on sufficiency of disclosure were made by the appellant in the appeal proceedings.

XII. The arguments of the respondent, insofar as relevant to the present decision, can be summarised as follows:

Admissibility of novelty as a ground of opposition

- a) Novelty as a ground of opposition was raised with the notice of opposition, in spite of the fact that, due to an error, the US document D1 was filed instead of the correct family member D6. The occurrence of this error could not be seen as comparable to the situation in which no valid evidence and arguments are filed, all the more as D6 was then filed within the time limit set before the oral proceedings.

Patent as granted - sufficiency of disclosure

- b) The colour effect pigment in the composition of claim 1 had a volume particle size distribution of 1 to 750 μm , but neither a method, nor an instrument of measurement of that distribution was indicated in the patent. As the parameter could vary according to the method or the instrument used, the particle size distribution could not be determined precisely, which resulted in insufficiency of disclosure.

Patent as granted - novelty

- c) Example 2 of D6 comprised a cationic surfactant (stearamidopropyldimethylamine) at a concentration of 2.3% by weight and 2% of a shine enhancing agent which could be N° 49 comprising 2.2% by weight of synthetic mica coated with metal oxide with particles in the ranges 18-100 μm and 9 to 45 μm . As the resulting quantity of the mica was

0.044% by weight, the example was novelty destroying for the composition of claim 1.

Auxiliary request - remittal

- d) The case should be decided upon by the Board also as far as inventive step for auxiliary request 1 is concerned. As there was no substantial modification of the subject-matter with respect to the main request and no new documents had been filed, it was not necessary to remit the case, which would give an unjustified opportunity to the appellant to provide comparative examples.

XIII. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted or that the patent be maintained on the basis of auxiliary request 1 filed with the statement of grounds of appeal.

XIV. The respondent requested that the appeal be dismissed.

Reasons for the Decision

Admissibility of novelty as a ground of opposition

1. The EPC does not foresee a "partial" inadmissibility of an opposition, namely the opposition is either admissible or inadmissible as a whole (Rule 77 EPC). In the present case, the admissibility of the opposition as a whole has never been questioned by the appellant in view of the presence in the notice of opposition of grounds other than lack of novelty and the Board sees no reason to put it into doubt.

- 1.1 As to novelty as a ground of opposition, it is at most to be considered as a fresh ground of opposition raised at the point in time in which D6 was filed.
- 1.2 The opposition division clearly decided to admit both D6 and the objection of lack of novelty based on it into the proceedings and decided that granted claim 1 lacked novelty over D6.
- 1.3 This was fully in the power of the opposition division in application of Article 114(1) and Rule 81(1) EPC and in view of G 10/91 (OJ EPO 1993, 420; see Headnote, point 2).
- 1.4 Under such circumstances, the Board has no room to disregard the document and the corresponding objection.

Patent as granted - sufficiency of disclosure

2. The respondent made an objection of lack of sufficiency based on the lack in the patent of a method and of an instrument of measurement of the volume particle size distribution.
 - 2.1 The Board considers that the objection of the respondent may lead at most to a lack of clarity, but is not relevant for sufficiency of disclosure. The volume particle size distribution is a common property of a particulate and the fact that some variability may exist in the measured values according to the method of measurement or the instrument used may result in the presence of some ambiguity at the edges of the claim, which is not a sufficient reason to conclude that the invention is not sufficiently disclosed in the patent. On top of that, not even evidence for some variabilities at the edges of the claim has been

provided by the respondent. On the contrary, the respondent itself has been able to cite products with the required particle size distribution (see e.g. the synthetic mica used in D6 and the arguments on novelty of the respondent) and examples of suitable particles are given in the patent with reference to some commercial products (see the synthetic fluorphlogopite used in examples 1 to 8).

- 2.2 For these reasons it is concluded that the objection under Article 100(b) EPC does not prejudice maintenance of the patent.

Patent as granted - novelty

3. It was not disputed by the parties that document D6 belongs to the state of the art under Article 54(3) EPC (it is an international application equivalent to a regular European patent application filed before the priority date of the patent in suit and published between its priority and its filing date) and discloses in its example 2 a hair conditioning composition comprising stearamidopropyldimethylamine at a concentration of 2.3% by weight and 2% by weight of a shine enhancing agent which can be N° 49 comprising 2.2% by weight of synthetic mica coated with metal oxide with particles in the ranges 18-100 µm and 9 to 45 µm (example 2 on page 24 and shine enhancing system N° 49 in the table on page 17).

- 3.1 As to the quantity of the coated synthetic mica, 2.2% by weight of 2% by weight amounts to 0.044% by weight, which is within the range 0.01 to 10% by weight of granted claim 1. In this respect it had already been noted in the decision under appeal that the calculation of the appellant was incorrect.

- 3.2 As far as stearamidopropyldimethylamine is concerned, the appellant did not dispute that it is a known cationic surfactant in the field of cosmetic, that it has a cationic head in the presence of dissociated acids and that acids are present in the composition of example 2 of D6 (see table on page 24), but noted that a pH value is missing in example 2, so that it is not clear whether the amine is indeed a cationic compound in the composition.
- 3.3 The Board considers that what has been acknowledged by the appellant is sufficient to conclude that the composition of example 2 contains a cationic surfactant in the desired quantity, unless evidence to the contrary is provided by the appellant alleging that it is not the case (e.g. evidence that the composition as such and during use operates under basic conditions, which prevent the amine to act as a cationic surfactant). Thus, the mere indication that the pH value of the composition is not mentioned in example 2 is not sufficient to establish novelty under the present circumstances (see point 3.2, above).
- 3.4 It is therefore concluded that the composition of claim 1 is not novel with respect to the disclosure in document D6.

Auxiliary request 1 - remittal

4. The deletion of all product claims and the reformulation of claim 1 as a process claim in which the conditioning composition of granted claim 1 is used as a rinse-off composition renders moot the novelty objection in view of the fact that D6 concerns leave-on compositions (claim 1) and the composition of example 2

is not rinsed off after application (page 25, first two lines). Indeed no novelty objection has been raised by the respondent against auxiliary request 1 and the Board has no reason to take a different approach.

5. With regard to auxiliary request 1, the only objection raised by the respondent concerns lack of inventive step. However, this point has not been decided upon in the decision under appeal neither with respect to a process claim as the one at issue, nor with respect to the product claims. Moreover, such issue requires the analysis of prior art documents never taken into consideration in the decision under appeal (as document D6 is state of the art under Article 54(3) EPC and therefore not relevant for inventive step), including a trial report filed by the appellant in opposition (D12).

5.1 As the essential function of an appeal is to consider whether the decision issued by the first-instance department is correct, a case, as the present one, in which the appeal on the issue decided upon is allowed (also on the basis of an auxiliary request) and essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance, is normally remitted to it for consideration of the undecided issues (Article 111(1) EPC).

5.2 Moreover, the Board indicated in its communication in preparation of oral proceedings that it was inclined to remit the case in view of the lack of a decision of inventive step and of the incompleteness of the analysis on inventive step in the submissions in appeal, as the appellant provided only few sentences in the statement of grounds and the respondent disregarded

the latest evidence of the appellant filed in opposition (D12).

- 5.3 The appellant did not react to that communication, but indicated only at the oral proceedings that inventive step should be decided upon. The respondent sent a further letter indicating that a remittal was not necessary, but without taking position on D12 and informing the Board that it would not attend the oral proceedings.
- 5.4 Under such circumstances, a discussion on inventive step at the oral proceedings would be the first full discussion on the issue and would take place in the absence of one of the parties, which is undesirable.
- 5.5 The fact that the opposing party might potentially provide further evidence (as indicated by the respondent) is a possibility which is always present in case of a remittal and which does not play a role in deciding on it.
6. Thus, in view of the above considerations, the Board has reached the conclusion that, in the circumstances of the present case, it is appropriate to remit the case to the opposition division for the analysis of inventive step on the basis of the claims of auxiliary request 1.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of auxiliary request 1.

The Registrar:

The Chairman:



S. Fabiani

J. Riolo

Decision electronically authenticated