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**Datasheet for the decision
of 2 March 2017**

Case Number: T 0983/13 - 3.3.10

Application Number: 08013910.8

Publication Number: 2025327

IPC: A61K8/58, A61Q5/08

Language of the proceedings: EN

Title of invention:
Bleaching/highlighting composition

Applicant:
Kao Germany GmbH

Headword:
Bleaching/highlighting composition / Kao

Relevant legal provisions:
EPC Art. 54, 111(1)

Keyword:
Main request and auxiliary request 1: novelty - multiple selections (no)
Auxiliary request 2: novelty - multiple selections (yes)
Appeal decision - remittal to the department of first instance (yes)

Decisions cited:

T 0041/10

Catchword:



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Case Number: T 0983/13 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 2 March 2017

Appellant: Kao Germany GmbH
(Applicant) Pfungstädter Strasse 92-100
64297 Darmstadt (DE)

Representative: Grit, Mustafa
KPSS - Kao Professional
Salon Services GmbH
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 5 December 2012
refusing European patent application No.
08013910.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: J.-C. Schmid
T. Bokor

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Examining Division refusing European patent application No. 08013910.8.
- II. The sole ground for the refusal of the application by the Examining Division was lack of novelty of the subject-matter of claim 1 of the then pending request over document
- (1) US-A-2002/0141954.
- III. In a communication accompanying the summons of the oral proceedings to be held on 2 March 2017, the Board indicated that the subject-matter of claim 1 appeared to lack novelty over document (1).
- IV. On 2 January 2017, the Applicant filed auxiliary requests 1 to 3.
- V. At the oral proceedings before the Board held on 2 March 2017, the Appellant defended the grant of a patent on the basis of the main request filed with the statement of the grounds of appeal dated 8 April 2013 and auxiliary requests 1 to 3 filed on 2 January 2017.

Claim 1 of the main request reads as follows:

"1. Water free composition for bleaching and/or highlighting keratin fibres especially human hair based on at least one compound with bleaching and/or highlighting effect characterized in that it comprises at least one arylated silicone at a concentration of 1 to 50% by weight calculated to total composition."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the arylated silicone is "selected from phenyl methicone, phenyl trimethicone, diphenyl dimethicone, diphenylsiloxo phenyl trimethicone, tetramethyl tetraphenyl trisiloxane, triphenyl trimethicone and pentaphenyl trimethyl trisiloxane"

Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that the claimed composition further requires at least one ammonium salt.

Claim 1 of auxiliary request 3 differs from claim 1 of auxiliary request 1 in that the claimed composition further requires at least one ammonium salt.

VI. According to the Appellant, document (1) did not disclose directly and unambiguously the bleaching compositions of claim 1 of the main request. Multiple selections within the disclosure of document (1) must be made to arrive at the subject-matter of claim 1, namely a first selection of the non-volatile silicones from the two types of silicones disclosed, i.e. volatile and non-volatile silicones and then, a further selection of arylated silicones from the non-volatile silicones list. The volatility of the silicone was implicit part of claim 1, because all arylated silicones were non-volatile compounds. Therefore, the non-volatility of the silicone must be taken into account as an implicit feature of claim 1.

The subject-matter of claim 1 was therefore novel over the disclosure of document (1). The subject-matter of claim 1 of auxiliary request 1 was novel over document (1) since three selections had to be made from the disclosure of document (1), the first being the

selection of non-volatile silicones, the second the selection of phenyl-substituted silicones and the third the selection of specific silicones.

- VII. The Appellant requested that a patent be granted on the basis of the main request filed with the statement of the grounds of appeal dated 8 April 2013 or, subsidiarily, on the basis of one of the auxiliary requests 1 to 3 filed on 2 January 2017.

Reasons for the Decision

1. The appeal is admissible.

Main request: novelty

2. Document (1) discloses a bleaching composition comprising an effective amount of persulfate salt dispersed in a silicone oil base (claim 1). The composition contains from 1 to 90% by weight of the total composition of the silicone oil (see claim 3). The bleaching composition is substantially free of water and preferably is anhydrous (see paragraph [0015]). Claim 3 does not specify the exact nature of the silicone oil. However, suitable silicones including among others phenyl substituted silicones such as phenyl trimethicone, phenyl dimethicone or diphenyl dimethicone are disclosed on page 2, right-hand column, lines 2 to 4. In order to arrive at the subject-matter of claim 1 of the main request, the skilled reader starting from claim 3 of document (1) has only to select from the list of possible silicones disclosed in document (1), the phenyl-substituted silicones (arylated silicones). Therefore document (1) discloses

in combination all the feature required by claim 1 and is therefore novelty-destroying.

3. According to the Appellant, two selections were necessary to arrive at the subject-matter of claim 1 of the main request, since from the disclosure of document (1), a non-volatile silicone should be first selected, and then among those non-volatile silicones exemplified in document (1), phenyl-substituted silicones should further be selected. The non-volatility of the aryl silicones was an inherent property and therefore, even if it was not explicitly specified in claim 1, this property should have been taken into account to arrive at the subject-matter of claim 1 when starting from the disclosure of document (1).

However, the fact that document (1) classifies the silicones into volatile and non-volatile silicones cannot establish novelty. Document (1) explicitly discloses the embodiment where the silicones comprised in the bleaching composition are phenyl-substituted silicones such as phenyl dimethicone or diphenyl dimethicone (see page 2, right-hand column, lines 2 to 4). These phenyl-substituted silicones are, as a matter of fact, non-volatile. Accordingly, there is no second choice to be made when starting from the disclosure of this embodiment in order to arrive at the subject-matter of claim 1, even if the claim implicitly requires, as submitted by the Appellant, that the arylated silicones were non-volatile (also see T0041/10, point 2 of the reasons; not published in OJ EPO). This argument should therefore be rejected.

4. *Auxiliary request 1*

The silicones listed in claim 1 of auxiliary request 1 include phenyl trimethicone and diphenyl dimethicone which are specifically disclosed in document (1) (see page 2, right-hand column, lines 3 and 4).

Accordingly, the subject-matter of claim 1 of auxiliary request 1 also lacks novelty over document (1).

5. *Auxiliary request 2*

Auxiliary request 2 was filed after the summons to oral proceedings before the Board had been issued. Claim 1 of this request results from the combination of claim 1 and dependent 6, which clearly addresses the objection of novelty raised in the proceedings. The Board is in the position to deal with it, and it is moreover clearly allowable. Therefore the Board decided to admit auxiliary request 2 into the proceedings, although not being filed with the statement of grounds of appeal.

Claim 1 of this request is based on the combination of claims 1 and 6 of the application as filed. Claims 2 to 14 correspond to claims 2 to 5 and 7 to 15 as filed. Claims 1 to 14 of auxiliary request 2 therefore meet the requirement of Article 123(2) EPC.

The composition of claim 1 of auxiliary request 2 now requires the combination of an arylated silicone with an ammonium salt. This combination is not disclosed in document (1). Therefore the subject-matter of claim 1 is novel over document (1).

6. The essential function of an appeal is to consider whether the decision issued by the first-instance department is correct. Hence, a case is normally referred back if essential questions regarding the

patentability of the claimed subject-matter have not been decided by the department of first instance. The examination of other requirements of patentability not dealt with in the appealed decision is normally left to the examining division to consider after a remittal, so that the Appellant has the opportunity for these to be considered without loss of an instance. In particular, remittal is appropriate in the present case where the examining division rejected the application solely upon novelty, which leaves other essential issues outstanding.

7. Thus, under the present circumstances the Board finds it appropriate to remit the case to the first instance for further prosecution.

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.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated