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**Datasheet for the decision  
of 28 May 2019**

**Case Number:** T 0159/15 - 3.3.07

**Application Number:** 04725382.8

**Publication Number:** 1620068

**IPC:** A61K8/58, A61Q1/02, A61Q1/06,  
A61Q1/14, A61Q19/00

**Language of the proceedings:** EN

**Title of invention:**  
COSMETIC COMPOSITION COMPRISING A VOLATILE FATTY PHASE

**Patent Proprietor:**  
L'Oréal

**Opponents:**  
UNILEVER PLC/ UNILEVER N.V.  
Henkel AG & Co. KGaA  
Beiersdorf AG

**Headword:**  
Volatile fatty phase / L'OREAL

**Relevant legal provisions:**  
EPC Art. 100(b), 123(2)  
RPBA Art. 12(4), 13(1), 13(3)

**Keyword:**

Late-filed requests and evidence - admitted (yes)

Sufficiency of disclosure - main request (no)

Amendments - added subject-matter (auxiliary request - yes)

**Decisions cited:**

G 0002/10



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Case Number: T 0159/15 - 3.3.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.07**  
**of 28 May 2019**

**Appellant:**  
(Patent Proprietor)

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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
18 November 2014 concerning maintenance of the  
European Patent No. 1620068 in amended form.

**Composition of the Board:**

**Chairman** A. Usuelli  
**Members:** E. Duval  
C. Schmidt

## Summary of Facts and Submissions

- I. European patent No. 1 620 068 was granted on the basis of 16 claims.

Independent claim 1 related to a composition comprising a volatile silicone fatty phase characterised, *inter alia*, as follows:

- (a) the volatile silicone fatty phase comprised a mixture of dodecamethylpentasiloxane (hereinafter "L5") and decamethyltetrasiloxane (hereinafter "L4"), and
- (b) the volatile silicone fatty phase had an evaporation profile such that the mass of volatile silicone oil evaporated after 30 minutes ranged from 2 mg/cm<sup>2</sup> to 9 mg/cm<sup>2</sup>, wherein the evaporation profile was determined according to the following protocol (hereinafter "protocol 1"):

"15 g of oil or of the mixture of oils to be tested are placed in a crystallizing dish with a diameter of 7 cm and placed on a balance that is inside a chamber of about 0.3 m<sup>3</sup> with a regulated temperature of 25°C and a regulated hygrometry of 50% relative humidity. The liquid is allowed to evaporate freely, without stirring, while providing ventilation with a fan from Papst-Motoren, reference 8550 N, rotating at 2700 rpm and positioned vertically above the crystallizing dish containing the solvent, the vanes facing the crystallizing dish and being 20 cm from the bottom of the crystallizing dish."

II. Three oppositions were filed against the patent in suit (hereinafter "the patent") on the grounds that its subject-matter lacked novelty and inventive step, it was not sufficiently disclosed, and it extended beyond the content of the application as filed.

III. The opposition division took the interlocutory decision that, on the basis of auxiliary request 1, the patent met the requirements of the EPC. The decision was based on the patent as granted as main request and on auxiliary request 1 filed during the oral proceedings.

In particular, the opposition division decided that:

- (a) the subject-matter of the claims of the main request did not extend beyond the content of the application as filed, was novel and fulfilled the criteria of inventive step. However, the opposition division considered that it represented an undue burden for the skilled person to obtain the evaporation profile defined in claim 1. The criteria of sufficiency of disclosure were thus not met.
  
- (b) Auxiliary request 1, in which the evaporation range was limited to 2-6 mg/cm<sup>2</sup> and the volatile silicone fatty phase was formed solely of a mixture of L4 and L5, was admitted into the proceedings. Its subject-matter was found to meet the requirements of Article 123(2) and (3) EPC. Finding binary L4/L5 mixtures with the claimed evaporation profile was considered to be within the skilled person's abilities, hence the claimed subject-matter was sufficiently disclosed. The criteria of inventive step were fulfilled as for the main request.

The following documents, *inter alia*, were cited in the decision under appeal:

D12: EP0980885A1

D18: Experimental report "Messung der Flüchtigkeitsraten gemäss der Methode aus dem Patent WO2011/049851 mit Hilfe der TGA Untersuchung"

Appendix 2: experimental data filed by letter dated 9 July 2014

- IV. Both the appellant-proprietor and the appellants-opponents 1 appealed that decision.
- V. With its statement of grounds of appeal, the appellant-proprietor filed a main request, corresponding to the patent as granted, and auxiliary requests 1-3.

Claim 1 of auxiliary request 3 read as follows:

"Composition comprising, in a physiologically acceptable medium, a volatile silicone fatty phase having an evaporation profile such that the mass of volatile silicone oil evaporated after 30 minutes ranges from 2 mg/cm<sup>2</sup> to 8 mg/cm<sup>2</sup>, the volatile silicone fatty phase is formed solely from a mixture of [L5] and [L4], wherein the evaporation profile is determined according to the following protocol: [protocol 1]" (wherein [L4], [L5] and [protocol 1] are as defined above in paragraph I.).

The following documents were submitted by the appellant-proprietor with its statement of grounds of appeal:

Appendix 1b: experimental data  
D25: DIN 53249 standard

- VI. On 22 March 2019, the Board issued a communication pursuant to Article 15(1) RPBA raising, in particular, an objection of added subject-matter against the combination of features of auxiliary request 3.
- VII. By letter dated 9 April 2019, the appellant-proprietor filed a new main request. Claim 1 of this new main request read as follows:

"Composition comprising, in a physiologically acceptable medium, a volatile silicone fatty phase having an evaporation profile such that the mass of volatile silicone oil evaporated after 30 minutes ranges from 2 mg/cm<sup>2</sup> to 9 mg/cm<sup>2</sup>, the volatile silicone fatty phase is formed solely from a mixture of [L5] and [L4], wherein the evaporation profile is determined according to the following protocol: [protocol 1]" (wherein [L4], [15] and [protocol 1] are as defined above in paragraph I.).

- VIII. Oral proceedings were held on 28 May 2019 in the absence of respondent-opponent 2, as announced by letter dated 8 October 2018.

During the oral proceedings, the appellant-proprietor withdrew the request corresponding to the patent as granted and auxiliary requests 1 and 2.



IX. The arguments of the appellant-proprietor, as far as relevant to the present decision, can be summarised as follows:

- (a) The main request was to be admitted into the proceedings because it addressed the objections raised by the Board in its preliminary opinion and did not extend the scope of discussion as determined by the decision under appeal and the statement of grounds of appeal.
- (b) Appendix 1bis was to be admitted into the proceedings because it was filed as a reaction to objections raised during the oral proceedings at first instance, in particular regarding the possibility to reach the upper end point of the evaporation rate of  $9 \text{ mg/cm}^2$  with a volatile silicone fatty phase consisting only of L4 and L5.
- (c) The main request met the requirements of sufficiency of disclosure. Claim 1 defined two cumulative conditions to be fulfilled, namely the exclusive presence of L4 and L5 and an evaporation value in the range of  $2\text{-}9 \text{ mg/cm}^2$ , but the combination of an evaporation value of  $9 \text{ mg/cm}^2$  with the sole presence of L4 and L5 was not required by claim 1. The knowledge of volatile oils that may enter in the composition of the volatile silicone fatty phase and their evaporation rates belonged to the general knowledge of the person skilled in the art, as shown by D12. Lastly, the description (page 6, line 26, to page 7, line 12) disclosed the means to obtain the claimed evaporation profile.

- (d) Auxiliary request 3 was filed, with the statement of grounds of appeal, as a reaction to the objection of insufficiency of disclosure raised for the first time by the opposition division during the oral proceedings. It should therefore be admitted into the appeal proceedings.
  
- (e) Auxiliary request 3 met the criteria of Article 123(2) EPC, as it was based on claim 1 in combination with page 16, lines 1-4, and claim 2 of the application as filed. Amended claim 1 did not carry the information that, by the mere admixture of L4 and L5, evaporation rates ranging from 2 mg/cm<sup>2</sup> to 8 mg/cm<sup>2</sup> could be obtained. Amended claim 1 rather defined two conditions to be met by the composition; it did not contain information which would not be derivable from the application as filed on page 1, line 26, to page 2, line 12; page 3, line 20 to page 4, line 5; and page 7, lines 10-12.

X. The arguments of the appellants-opponents 1 and the respondents-opponents 2 and 3, as far as relevant to the present decision, can be summarised as follows:

- (a) The main request was not to be admitted into the appeal proceedings because the Board's preliminary opinion could not be seen as an invitation to file further requests, the objection of added subject-matter had been raised earlier, and the new main request did not address this objection properly.
  
- (b) Appendix 1bis should have been filed in the proceedings before the department of first instance and was therefore not to be admitted into the appeal proceedings pursuant to Article 12(4) RPBA.

- (c) There existed neither common general knowledge nor sufficient information in the patent regarding the evaporation rates. The passage of the patent on page 6, paragraph [0028], did not relate to a mixture consisting of L4 and L5 but to a mixture comprising them. Hence, the requirements of sufficiency of disclosure were not fulfilled.
- (d) Auxiliary request 3 was not to be admitted into the appeal proceedings pursuant to Article 12(4) RPBA because it included a broader evaporation range and should have been submitted in the proceedings before the department of first instance. Furthermore, the appellant-proprietor did not file its observations on the opposition in the first-instance proceedings until the last possible moment.
- (e) Auxiliary request 3 did not meet the requirements of Article 123(2) EPC because there was no link in the application as filed between the sole presence of L4 and L5 and an evaporation range of 2-8 mg/cm<sup>2</sup>.

XI. The appellant-proprietor requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request filed by letter dated 9 April 2019. Alternatively, it requested that the patent be maintained on the basis of auxiliary request 3 filed with its statement of grounds of appeal.

XII. The appellants-opponents 1 requested that the decision under appeal be set aside and the patent be revoked in its entirety.

They further asked for the following not to be admitted into the proceedings: the new main request and auxiliary request 3, the new experimental evidence Appendix 1bis filed with the statement of grounds of appeal, and the comments and submissions made by the appellant-proprietor in the letter dated 9 April 2019.

XIII. The respondent-opponent 2 requested in writing that the decision under appeal be set aside and the patent be revoked.

XIV. The respondent-opponent 3 requested that the appeal of the appellant-proprietor be dismissed.

## **Reasons for the Decision**

### *Admittance of Appendix 1bis*

1. Together with its statement setting out the grounds of appeal, the appellant-proprietor submitted Appendix 1bis, with the aim of overcoming the finding of insufficiency of disclosure for the main request. The appellants-opponents 1 challenge the admission of Appendix 1bis on the basis of Article 12(4) RPBA.

1.1 In the annex to the summons to oral proceedings, the opposition division had expressed the preliminary view that the subject-matter of the patent as granted was sufficiently disclosed, but it lacked novelty and inventive step. In contrast, in the decision under appeal, the patent as granted was found not to meet the requirements of sufficiency of disclosure. The Board considers the filing of Appendix 1bis as a reaction to this reversed opinion. Having regard to the opinion expressed by the opposition division in the annex to

the summons, there were no compelling reasons for the appellant-proprietor to file Appendix 1bis earlier.

- 1.2 For these reasons, Appendix 1bis is admitted into the proceedings.

*Main request*

2. Admittance

The main request was filed by the appellant-proprietor after the oral proceedings had been arranged, and seven weeks before the oral proceedings took place. The admittance of the main request is governed by the provisions of Article 13(1) and (3) RPBA.

The main request results from the limitation of claim 1 of the patent as granted to compositions in which the volatile silicone fatty phase is formed solely from a mixture of L4 and L5. The same amendment was already present (together with further limitations to the evaporation range) in former auxiliary request 1 underlying the decision under appeal and in auxiliary request 3 filed with the statement of grounds of appeal. Accordingly, the main request does not add complex new subject-matter and does not raise issues which the Board or the other parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

Additionally, the filing of the main request can be seen as a reaction to the objection under Article 123(2) EPC against auxiliary request 3, raised for the first time in appeal by the Board in its communication pursuant to Article 15(1) RPBA. This objection, based on a new combination of the expression "formed solely

from" with an amended evaporation range, had been raised in the proceedings at first instance and addressed in the decision under appeal, but has not been pursued by either the appellants-opponents 1 or the respondents-opponents 2 and 3 during the appeal proceedings.

Accordingly, the main request, together with the comments and submissions made by the appellant-proprietor in the letter dated 9 April 2019, are admitted into the proceedings.

### 3. Sufficiency of disclosure

- 3.1 The requirements of sufficiency of disclosure are only met if the claimed invention can be performed by a person skilled in the art in the whole area claimed without undue burden, using common general knowledge, and having regard to the information in the patent in suit.

The disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed in the whole range claimed rather than only in some members of the claimed class to be obtained (Case Law of the Boards of Appeal of the European Patent Office, 8th edition, 2016, II.C.4.4).

- 3.2 The invention defined by claim 1 of the main request relates to a composition comprising a volatile silicone fatty phase which

(a) has an evaporation profile, determined according to protocol 1, such that the mass of volatile silicone oil evaporated after 30 minutes ranges from 2 mg/cm<sup>2</sup> to 9 mg/cm<sup>2</sup>, and

(b) is formed solely from a mixture of L4 and L5.

3.3 Regarding the information in the patent pertaining to this invention, four examples of cosmetic compositions are described in which the volatile silicone fatty phase consists in a mixture of L4 and L5. It may thus be considered that the patent discloses at least one way of performing the invention. Nonetheless, no data are reported in the patent regarding the evaporation rate of the exemplified L4/L5 phases. Hence, the teaching that these L4/L5 compositions meet the claimed condition of an evaporation rate within the range 2-9 mg/cm<sup>2</sup> is, at most, implicit in the patent.

The rest of the patent specification also fails to provide any data on the evaporation rates achievable with L4 and L5 individually, or with their mixtures in different ratios.

3.4 The Board cannot concur with the appellant-proprietor's assertion that the evaporation rates of volatile oils, such as L4 and L5, should be considered as belonging to the general knowledge of the person skilled in the art. These evaporation rates represent a newly formulated parameter measured by a new method, namely the protocol 1 defined in claim 1. This protocol 1 is different from the known DIN 53249 standard (see D25 in this respect) and does not appear in the prior art. Document D12, on which the appellant-proprietor relies, is a patent document which does not reflect the common general knowledge. D12 is not cited in the patent in suit and, in any case, uses the DIN 53249 standard rather than protocol 1 for the measurement of evaporation after 30 minutes.

3.5 Claim 1 explicitly mentions an upper end value of 9 mg/cm<sup>2</sup> for the evaporation profile. As a result, a composition comprising a volatile silicone fatty phase formed solely from a mixture of L4 and L5 and having an evaporation rate of 9 mg/cm<sup>2</sup> represents a particular embodiment of the claimed invention.

3.6 However, it is shown that a silicon phase solely formed of L4 and L5 cannot achieve an evaporation rate of 9 mg/cm<sup>2</sup>.

According to D18, the evaporation rates (measured following protocol 1) of L5 and L4 are 1.3 mg/cm<sup>2</sup> and 6.8 mg/cm<sup>2</sup> respectively. During the proceedings at first instance, the appellant-proprietor relied on theoretical evaporation values for L4/L5 mixtures calculated from the weighted average of its constituents (see Appendix 2, Table 2). Using this assumption, the evaporation rate of a mixture consisting of L4 and L5 could not logically exceed that of L4 (6.8 mg/cm<sup>2</sup>), as noted under point 6.5.1 of the decision under appeal.

Alternatively, the values experimentally measured in Appendix 1bis for mixtures consisting of L4 and L5 in various ratios show that L4/L5 mixtures can only reach evaporation values ranging from 1.79 mg/cm<sup>2</sup> to 8.41 mg/cm<sup>2</sup>.

All the evidence above shows that the embodiment of claim 1 where the silicon phase is formed solely of L4 and L5 and exhibits an evaporation rate of 9 mg/cm<sup>2</sup> cannot be obtained.

3.7 Contrary to the appellant-proprietor's view, the features of claim 1 regarding (a) the exclusive



presence of L4 and L5 and (b) the evaporation range of 2-9 mg/cm<sup>2</sup> do not merely define two conditions to be fulfilled by the claimed subject-matter; they also define the scope of the claim. This scope cannot be regarded as extending only to subject-matter which turns out to fulfil the two conditions in light of evidence filed after the filing date (such as Appendix 2). Owing to the lack of data in the patent and the absence of common general knowledge pertaining to the claimed parameter noted above (see 3.3 and 3.4), the skilled person reading the claim had no reason to regard an evaporation rate of 9 mg/cm<sup>2</sup> as not obtainable in practice and therefore as not covered by the claim. The passage of the description cited by the appellant-proprietor (page 6, line 26 to page 7, line 12 of the application) relates to the possibility to mix the volatile silicone with another one in order to obtain the required evaporation profile, but does not support an interpretation of claim 1 in which certain evaporation profiles should be disregarded as not achievable.

3.8 Accordingly, the main request does not fulfil the requirements of sufficiency of disclosure.

*Auxiliary request 3*

4. Admittance

As for Appendix 1bis, auxiliary request 3 was submitted by the appellant-proprietor together with its statement setting out the grounds of appeal, and can be seen as a reaction to the decision under appeal and the opposition division's reversed opinion regarding sufficiency of disclosure (see point 1.1 above).

Accordingly, auxiliary request 3 is admitted into the proceedings.

5. Article 123(2) EPC

5.1 Claim 1 of auxiliary request 3 differs from claim 1 of the application as filed essentially as follows:

(a) the volatile silicone fatty phase is formed solely from a mixture of L4 and L5, and

(b) the mass of volatile silicone oil evaporated after 30 minutes, determined according to protocol 1, ranges from 2 mg/cm<sup>2</sup> to 8 mg/cm<sup>2</sup>.

5.2 It is not contested that the above amendments individually find a basis in the application as filed. However, for the following reasons, their combination as defined in claim 1 of auxiliary request 3 is not derivable from the application as filed.

Claim 15 of the application as filed shows the feature "the volatile silicone fatty phase comprises a mixture of L4 and L5" and is dependent on "any one of the preceding claims", including claim 2, which mentions an evaporation range of 2-8 mg/cm<sup>2</sup>. However, these passages do not disclose, in combination, a volatile silicone fatty phase formed solely, or consisting, of L4 and L5 and having an evaporation range of 2-8 mg/cm<sup>2</sup>. As to the paragraph at the top of page 16 of the application as filed, it shows a composition formed solely of L4 and L5, but not in combination with an evaporation range of 2-8 mg/cm<sup>2</sup>.

5.3 It follows from Article 123(2) EPC that, after the amendment, the skilled person may not be presented with new technical information (see G 2/10).

In the present case, for the same reasons as given above (see 3.5), amended claim 1 carries the information that binary mixtures consisting of L4 and L5, to the exclusion of any additional volatile silicone oil, lead to evaporation values ranging from 2 mg/cm<sup>2</sup> to 8 mg/cm<sup>2</sup>. However, this information is not derivable from the application as filed.

The features involved in the amendments are interrelated in an essential manner: the evaporation rate of the mixture is entirely determined by its composition. However, as discussed above (see 3.3), the application as filed does not contain any information about the evaporation rates of L4, L5 or their binary mixtures. At most, the examples suggest that some mixtures of L4 and L5 will lead to an evaporation rate within the range 2-9 mg/cm<sup>2</sup>. It is not derivable from the application as filed that the mere admixture of L4 and L5, to the exclusion of any additional volatile silicone oil, would allow the obtention of evaporation values ranging from 2 mg/cm<sup>2</sup> to 8 mg/cm<sup>2</sup>.

Even adopting, for the sake of argument, the appellant-proprietor's interpretation of amended claim 1 as requiring the binary L4/L5 mixture to have an evaporation rate within the range 2-8 mg/cm<sup>2</sup>, and not necessarily to extend over the whole of that range, the claim still presents the skilled person with the new technical information that binary L4/L5 mixtures can lead to an evaporation value at or below 8 mg/cm<sup>2</sup>.

The fact that a mixture consisting of L4 and L5 can reach evaporation values ranging from 1.79 mg/cm<sup>2</sup> to 8.41 mg/cm<sup>2</sup> is shown by Appendix 1bis. However, such data are not contained in the application as filed.

The passages of the application as filed cited by the appellant-proprietor, namely page 1, line 26, to page 2, line 12; page 3, line 20, to page 4, line 5; and page 7, lines 10-12, relate to a composition in which the volatile silicone fatty phase comprises any number of non-cyclic volatile silicones, and do not give any information as to the range of achievable evaporation rates when the volatile silicone fatty phase consists exclusively of L4 and L5.

- 5.4 Accordingly, in the absence of information in the application as filed as to the range of evaporation rates achieved by mixtures formed solely from L4 and L5, the combination of the expression "formed solely from" L4 and L5 with the amended range of 2-8 mg/cm<sup>2</sup> represents added subject-matter.

Auxiliary request 3 does not meet the requirements of Article 123(2) EPC.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



B. Atienza Vivancos

A. Usuelli

Decision electronically authenticated