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**Datasheet for the decision
of 23 September 2021**

Case Number: T 0082/16 - 3.3.02

Application Number: 07845624.1

Publication Number: 2099294

IPC: A01N35/04, A61K8/34, A61K8/35,
A61Q19/00

Language of the proceedings: EN

Title of invention:
COMPOSITIONS

Patent Proprietor:
Givaudan SA

Opponent:
Symrise AG

Headword:

Relevant legal provisions:
EPC Art. 54, 56, 84
RPBA Art. 12(4)
RPBA 2020 Art. 13(1), 13(2)

Keyword:

Novelty - (no)

Inventive step - (no)

Late-filed request - admitted (no)

Decisions cited:

G 0003/14, T 0197/10, T 2221/10

Catchword:



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Case Number: T 0082/16 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 23 September 2021

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
30 October 2015 concerning maintenance of the
European Patent No. 2099294 in amended form.**

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
L. Bühler

Summary of Facts and Submissions

I. The appeal of the opponent (hereinafter appellant) lies from the decision of the opposition division according to which European patent 2 099 294 in amended form met the requirements of the EPC.

II. Revocation of the patent in its entirety was requested based on the grounds for opposition pursuant to Articles 100(a) (lack of novelty and lack of inventive step), 100(b) and 100(c) EPC.

III. The following documents, cited by the parties in appeal proceedings, were among those cited during opposition proceedings:

E1	DE 199 27 891 A1
E2	US 5,630,847
E3	EP 1 543 830 B1
E4	EP 1 543 829 B1

IV. With the statement of grounds of appeal, the appellant filed:

A038	Experimentelle Daten (referred to by the appellant as "Anlage 3")
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V. With the reply to the statement of grounds of appeal, the patent proprietor (respondent) filed:

A039	Experimental Data (referred to by the respondent as E39)
A040	EP 1 543 830 A1
A041	EP 1 543 829 A1

- VI. With a communication pursuant to Article 15(1) RPBA, the board set out its preliminary opinion. In particular, the board expressed the view that A038 was not to be admitted into the proceedings, and that the subject-matter of claim 11 of the main request lacked novelty over E1 and E2. Furthermore, the board noted that although sets of claims of a first to seventh auxiliary requests had been addressed in the respondent's reply to the statement of grounds of appeal, copies thereof had not been filed.
- VII. With the letter of 18 May 2021, the respondent submitted copies of the first to seventh auxiliary requests as well as new eighth to thirteenth auxiliary requests.
- VIII. Oral proceedings by videoconference were held on 23 September 2021. During oral proceedings, the respondent filed set of claims of first, third, fifth, seventh and eighth auxiliary requests A, and first auxiliary request B.
- IX. Requests relevant to the present decision
- The appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety.
- The respondent requested that the appeal be dismissed, implying that the patent in suit be maintained in amended form as held allowable by the opposition division (main request), or alternatively, that the patent in suit be maintained in amended form based on the claims of any of the first auxiliary request A, first auxiliary request B, second and third auxiliary request, third auxiliary request A, fourth and fifth auxiliary request, fifth auxiliary request A, sixth and

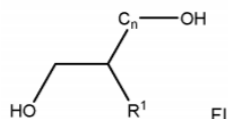
seventh auxiliary request, and seventh auxiliary request A, filed either by letter dated 18 May 2021 or during the oral proceedings (requests denoted with the suffix "A" or "B").

The respondent also requested that an objection of lack of clarity raised by the appellant in relation to claim 11 of the (subsequently withdrawn) first auxiliary request not be admitted into the proceedings (this request became relevant for the subject-matter of the seventh auxiliary request).

X. Independent claims 1 and 11 of the main request read as follows:

"1. A personal care product composition comprising

a) at least one diol compound of formula (I)



wherein R₁ is selected from methyl, and a C₁-R₂, C₃, C₄, and C₆ alkane,

and wherein R₂ is 2-ethyl-hexyloxy;

and wherein n is selected from 0, and 1,

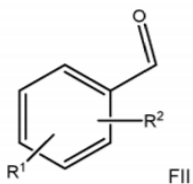
and wherein when n is 1, then R₁ is C₁ (methyl),

and wherein the diol compound is selected from the group consisting of 1,2-pentanediol, 1,2-hexanediol, 1,2-octanediol, 2-methyl-1,3-propanediol and 3-(2-ethyl-hexyloxy)-1,2-propanediol,

and

wherein the at least one compound according to formula I is present in a total concentration of 0.1 % to 2% (w/w); and

b) at least one compound of formula II



wherein R1 and R2 are selected from H, methyl, hydroxy, methoxy, or R1 together with R2 forms a 3,4-methylenedioxy substituent, and wherein if R1 is H then R2 is selected from H, methyl, hydroxy, and methoxy, and wherein if R2 is hydroxy, then R1 is selected from H, hydroxy, and methoxy and wherein said compound is selected from the group consisting of benzaldehyde, 4-methylbenzaldehyde, heliotropine, vanilline, 4-hydroxybenzaldehyde [sic], 3-hydroxybenzaldehyde, 4-methoxybenzaldehyde and 3-methoxybenzaldehyde, 2,4-dihydroxybenzaldehyde, 3-hydroxy-4-methoxybenzaldehyde, 3,5-dihydroxybenzaldehyde, and 4-hydroxy-2-methoxybenzaldehyde; and wherein the at least one compound according to formula II is present in a total concentration of 0.05 to 0.5% (w/w);

c) optionally at least one compound selected from the group consisting of phenoxyethanol, 2-phenylethanol, and benzylalcohol, in a total concentration of 0.05 to 0.3 % (w/w);

and a cosmetically-acceptable base, with the proviso that the composition is free from a bactericidally-, fungicidally-, sporicidally- effective or preservative concentration of compounds selected from the group consisting of:

formaldehyde; a formaldehyde donor compound including diazolidinyl urea, imidazolidinyl urea, and DMDM Hydantoin;
parabens selected from the group consisting of methyl-paraben, ethyl-paraben, propyl-paraben, isopropyl-paraben, butyl-paraben, isobutyl-paraben, and benzyl-paraben,
a halogenated compound including 2,4-dichlorobenzyl-alcohol, 4-chloro-3,5-dimethyl-phenol, 2-bromo-2-nitropropane-1,3-diol, and iodopropynyl butyl carbamate;
and a fungicide selected from quaternium-15 (CAS 51229-78-8), methyl-chloroisothiazolinone, and methylisothiazolinone.

11. Method of forming a preserved personal care product composition which is sufficiently bactericidal to have a reduction factor for Pseudomonas aeruginosa and Staphylococcus aureus of at least 1000 per 7 days, and which is sufficiently sporicidal to have a reduction factor of at least 100 per 7 days for Aspergillus niger, by admixing an effective amount of at least one compound a) and at least one compound b) and optionally at least one compound c) as defined in any one of claims 1 to 6 to a personal care product base, forming a personal care product composition with the proviso as defined in claim 1.

XI. The arguments of the appellant insofar as relevant to the present decision, may be summarised as follows:

Main request - Article 54 EPC

Claim 11 was not to be interpreted as being limited in scope to the concentration ranges recited in claim 1

for compounds a) and b). In the absence of said limitation, claim 11 lacked novelty over E1 and E2.

First auxiliary request A

Admittance of the request

This request was not to be admitted into proceedings pursuant to Article 13 RPBA 2020.

Admittance - A038

Experimental data A038 submitted with the statement of grounds of appeal was to be admitted into the proceedings.

Inventive step - Article 56 EPC

Either of A040 or A041 could serve as closest prior art. The subject-matter of claim 1 was distinguished from the respective formulation example 1 of A040 and A041 in that the claimed composition included a compound b) in a total concentration of 0.05 to 0.5 wt.%.

The technical problem underlying the subject-matter of contested claim 1 was the provision of further synergistic compositions. Seeking to solve this problem, the skilled person would have added heliotropin, disclosed in the description of A040 and A041, to the composition of A040 or A041 as a fragrance compound, in the concentration range defined in claim 1 for compounds b), and thereby would have arrived at the subject-matter of claim 1. The subject-matter of claim 1 consequently did not involve an inventive step.

Seventh auxiliary request A - Admittance

Pursuant to Article 13 RPBA 2020, this request was not to be admitted into the proceedings. The seventh auxiliary request on which it was based was filed only with the letter of 18 May 2021, and not with the reply to the grounds of appeal. Furthermore, it involved an amendment to the concentration ranges of compounds b) of claim 1 which had no impact on the discussion regarding inventive step. It was complex and did not clearly overcome all outstanding issues.

First auxiliary request B

Pursuant to Article 13 RPBA 2020, this request was not to be admitted into the proceedings. The combination of features in claim 1 was not present in any previous request on file, and it was not convergent. Furthermore, the amendments in claim 1 of this request raised new issues, in particular relating to clarity.

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

Main request - Article 54 EPC

The concentration ranges recited in claim 1 for compounds a) and b) were to be considered technical features of claim 11, the subject-matter of which was consequently novel over A040 and A041.

First auxiliary request A

Admittance of the request

This request was to be admitted into proceedings pursuant to Article 13 RPBA 2020.

Admittance - A038

Experimental data A038 submitted with the statement of grounds of appeal was not to be admitted into the proceedings.

Inventive step - Article 56 EPC

Either of A040 or A041 could serve as closest prior art. The subject-matter of claim 1 was distinguished from the respective formulation example 1 of A040 and A041 in that the claimed composition included a compound b) in a total concentration of 0.05 to 0.5 wt.%.

The technical problem underlying the subject-matter of contested claim 1 was the provision of further synergistic compositions. The skilled person starting at A040 or A041 and observing antimicrobial synergism for the compositions disclosed therein would have had no motivation to modify said compositions by adding heliotropin. Many thousands of fragrance ingredients were known to the skilled person, and there would be no reason to specifically choose heliotropin. In particular, the skilled person would not have added heliotropin due to the teaching in e.g. paragraph [0051] in combination with table 1 of A040 according to which the addition of fragrances may negatively effect

the synergy observed. The subject-matter of claim 1 consequently involved an inventive step.

Seventh auxiliary request A - Admittance

This request was based on the seventh auxiliary request filed with the letter dated 18 May 2021 and described in the reply to the grounds of appeal, albeit with an error in the lower limit of the concentration range provided for compound b). The limitation in the concentration range of compound b) of claim 1 however did not add any further complication. The amendment to claim 1 according to which the listed compounds of compound b) with the exception of 4-hydroxybenzaldehyde were deleted, was a reaction to the new line of argumentation raised by the appellant for the first time in oral proceedings with regard to claim 1 of the first auxiliary request A. Specifically, the new argument concerned the possibility of adding heliotropin to a composition according to A040 or A041. The request was therefore to be admitted into the proceedings.

First auxiliary request B - Admittance

The deletion in claim 1 of all compounds from which compound of formula II of compound b) were selected, with the exception of 4-hydroxybenzaldehyde, was indicated as an intended limitation in the reply to the grounds of appeal - a similar intention was reflected in *inter alia* the seventh auxiliary request filed with the letter of May 2021. Furthermore, the claims were clearly allowable and raised no new issues, in particular relating to clarity. The request was consequently to be admitted into the proceedings.

Reasons for the Decision

Main request

1. Claim 11 - Novelty, Article 54 EPC

The contested patent is concerned with preserved personal care product compositions and their use in personal care products applied to the human skin or scalp, and methods of making such products, with a view to preserving said products against microbial spoilage and to extend their shelf life (patent, paragraphs [0001] and [0002]).

Claim 11, in summary, relates to a method of forming a preserved personal care product composition which is sufficiently bactericidal (as defined by three specific reduction factors), by admixing *inter alia* an effective amount of at least one compound a) and at least one compound b) as defined in any one of claims 1-6 to a personal care product base, with the proviso as defined in claim 1.

1.1 The appellant submitted that the subject-matter of claim 11 was not novel over E1 (example 3) and E2 (example 1).

1.2 E1 (example 3; claim 1) discloses a disinfecting/cleaning composition containing, *inter alia*,

- 5.00 wt.% of 1,2-octanediol and
- 0.50 wt.% of vanillin.

E2 (example 1) discloses a dry cleaning article in sheet form. It is assembled using a sheet substrate and

a cleaning composition. The cleaning composition contains, *inter alia*,

- 0.5 wt.% of 1,2-octanediol and
- 0.75 wt.% of a perfume composition A, B or C or of mixtures thereof.

Perfume composition C contains, *inter alia*, 0.5 wt.% of anisaldehyde and 5.0 wt.% of vanillin (table 1). Thus, for perfume composition C, the above cleaning composition contains, *inter alia*,

- 0.5 wt.% of 1,2-octanediol,
- 0.0038 wt.% of anisaldehyde and
- 0.038 wt.% of vanillin.

- 1.2.1 It was common ground between the parties that 1,2-octanediol and vanillin, both comprised within the aforementioned compositions of E1 and E2, respectively fell under the definition of compound a) and compound b) as defined in claim 11 by back-reference to claim 1.
- 1.3 The sole matter of dispute between the parties concerned the question of whether, by way of said back-reference, the specific concentration ranges defined in claim 1 for compounds a) and compounds b), namely 0.1 to 2% (w/w) and 0.05 to 0.5% (w/w) respectively, were to be considered as a limiting feature of claim 11, and thus distinguish the subject-matter of this claim from E1 and E2.
- 1.4 The appellant did not dispute that the concentration of compound a) in the composition of E1 and compound b) in the composition of E2 fell outside the ranges recited in contested claim 1. Specifically, in the composition of E1, the concentration of compound a) (5.00 wt.%) was

above the upper limit of the range recited in claim 1 (2%), while in the composition of E2, the concentration of compound b) was below the lower limit of 0.05% disclosed in claim 1. Rather, the appellant submitted that claim 11 could not be interpreted in the sense that it was limited to the concentration ranges of compounds a) and b) as disclosed in claim 1.

1.5 It was also not disputed by the respondent that claim 11 would lack novelty if it were to be interpreted such that it was not limited in the concentration ranges for compounds a) and b) recited in claim 1.

1.6 Consequently, whether the subject-matter of claim 11 is novel over E1 and E2 hinges solely on the interpretation of contested claim 11.

Claim 11 concerns a method of forming a preserved personal care product composition which is sufficiently bactericidal and sporicidal (for which a definition is provided),

*"by admixing **an effective amount** of at least one compound a) and at least one compound b) and optionally at least one compound c) as defined in any one of claims 1 to 6 to a personal care product base, forming a personal care product composition with the proviso as defined in claim 1."* (emphasis added by the board).

In the contested decision the opposition division held that "an effective amount" in the context of claim 11 was to be interpreted as to include the concentrations of compounds a) and b) as defined in claim 1 (decision, paragraph 4.3.2), and on this basis acknowledged novelty over E1 and E2. This is also the respondent's position.

- 1.7 The board disagrees. The term "effective amount" employed in claim 11 is unambiguous to the person skilled in the art in that it functionally defines an amount required to provide a composition which is sufficiently bactericidal and sporicidal as defined in the earlier part of the claim by reference to three separate reduction factors. The respondent argued that the text in claim 11, namely "*an effective amount of at least one compound [a) and b)] as defined in any one of claims 1 to 6*", explicitly referenced not only the identity, but also the concentration range of compounds a) and b) back to claim 1. However, with the exception of the exclusion of an "effective concentration" of certain compounds by way of the proviso in claim 1, the term "effective amount" employed in claim 11 does not have antecedent basis in claim 1 in relation to the compounds a) and b). Consequently, the functional term "effective amount" in claim 11 cannot be understood as being defined in claim 1, in particular by the concentration ranges provided therein for compounds a) and b). Claim 11 is thus to be understood as referring to the identity of the compounds a) and b) as defined in claim 1, but not to their specific concentration ranges as defined therein. Rather, in claim 11 the amount of compounds a) and b) is defined functionally.
- 1.8 The respondent furthermore argued that in view of the back reference in claim 11 to dependent claims 2-6, which were specifically concerned only with concentration ranges, the skilled person would understand that claim 11 was intended to include a limitation to the concentration ranges recited in claim 1 and said dependent claims. In the view of the board however, the conclusion set out above in relation to the back reference in claim 11 to claim 1 applies

equally to claims 2-6, since those claims differ from claim 1 only in the differing concentration ranges recited therein.

1.9 Finally, the respondent argued that its position was supported by the text of the patent, which indicated to the skilled person that the concentration ranges of claim 1 were to be read into claim 11. Specifically, paragraphs [0039] and [0040], in referring to a "useful concentration" for the compound a) or b), respectively, provided the concentration ranges recited in claim 1. Paragraphs [0042] to [0044] then taught that compounds a) and b) in the given concentrations generally provided *inter alia* sufficient bactericidal and sporicidal activity, defined by the reduction factors corresponding to those described in claim 11.

1.10 It is established case law that where a term used in a claim has a clear technical meaning, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description (see decisions T 2221/10, reasons 33 and T 197/10, reasons 2.3 as well as the Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, II.A 6.3.1). As noted above, in the present case, the wording of claim 11 is unambiguous. Thus, this unambiguous wording cannot be assigned a different meaning by looking to the description. Furthermore, even if the description were to be taken into account, it would not lead the skilled person to conclude that the concentration ranges of claim 1 were to be read into claim 11. As noted by the appellant, the concentration ranges provided for compounds a) and b) in paragraphs [0039] and [0040] of the patent are not limiting. These paragraphs must be read in the context of previous paragraph [0038] which

states that the exact concentrations of compounds a) and b) will depend upon the nature of the product and the preservative effect and length to be achieved, in particular the bactericidal, fungicidal and sporicidal activity. Subsequent paragraphs [0039] and [0040] both refer to the stated useful concentrations "for example", which would be understood by the skilled person as preferred, but not as limitative. Hence, it cannot be concluded on the basis of the description that the concentration ranges disclosed therein are mandatory and thus constitute an implicit feature of claim 11.

- 1.11 In consequence, the scope of claim 11 is not limited in compounds a) and b) to the concentration ranges recited in claim 1. As set out above, based on this claim interpretation, the subject-matter of claim 11 lacks novelty over each of E1 and E2 pursuant to Article 54 EPC.

First auxiliary request A

The set of claims of this request was submitted by the respondent during oral proceedings before the board. It differs from the set of the main request only in claim 11. Therein, the text "*as defined in any one of claims 1 to 6*" was replaced by "*as defined in claim 1*", and the following text was added:

"wherein the at least one compound a) is present in a total concentration of 0.1% to 2% (w/w); and wherein the at least one compound b) is present in a total concentration of 0.05 to 0.5% (w/w)"

2. Admittance

Contrary to the appellant's request, the board decided to admit this request into the proceedings. In view of the board's conclusion in respect of inventive step (*infra*), there is no need for the board to provide its reasons in this regard.

3. Inventive step - Article 56 EPC

3.1 Admittance of A038

A038 is an experimental report submitted by the appellant with the statement of grounds of appeal. Although the board decided not to admit A038 pursuant to Article 12(4) RPBA 2007, in view of its conclusion in respect of inventive step (*infra*), there is no need for the board to provide its reasons in this regard.

3.2 Closest prior art & distinguishing features

3.3 Patent documents A040 and A041 were considered by both parties as representing suitable closest prior art documents, and the board sees no reasons to differ.

3.4 A040 (claims 1 and 2) and A041 (claims 1 and 2) relate to antiseptic disinfectants containing a 1,2-alkanediol with 5 to 10 carbons, such as 1,2-octanediol, and one or more materials selected from a list of specific compounds, such as eugenol (A040) or citral (A041). The respective formulation example 1 in both documents (A040: first table, page 7; A041: table bridging pages 6 and 7) discloses a humidity retention cream comprising, *inter alia*, 0.25 wt.% of 1,2-octanediol and 0.1 wt.% of either eugenol (A040) or citral (A041). 1,2-octanediol corresponds to compound a) of claim 1.

Neither eugenol nor citral correspond to a compound b) of claim 1.

- 3.5 The parties were in agreement that the subject-matter of claim 1 was distinguished from the respective formulation example 1 of A040 and A041 in that the claimed composition included a compound b), namely at least one compound selected from the group consisting of benzaldehyde, 4-methylbenzaldehyde, heliotropine, vanilline, 4-hydroxybenzaldehyde, 3-hydroxybenzaldehyde, 4-methoxybenzaldehyde and 3-methoxybenzaldehyde, 2,4-dihydroxybenzaldehyde, 3-hydroxy-4-methoxybenzaldehyde, 3,5-dihydroxybenzaldehyde, and 4-hydroxy-2-methoxybenzaldehyde in a total concentration range of from 0.05 to 0.5 wt.%.
- 3.6 The respondent conceded that antimicrobial synergy was demonstrated for the formulations of A040 and A41 (A040, tables 1-3; A041, tables 1 and 2), and that accordingly, the technical problem underlying the subject-matter of contested claim 1 was the provision of further synergistic compositions. The appellant agreed with this formulation of the technical problem. Under the assumption (to the respondent's advantage) that synergy is sufficiently demonstrated across the scope of contested claim 1, the board also accepts this formulation as representing the objective technical problem underlying contested claim 1.
- 3.7 Obviousness
- 3.7.1 In paragraph [0005] of A40 and A041 it is stated that fragrance compositions are generally compounded in *inter alia* cosmetics to give a rich smell to the products, and that such compositions were long known to

possess antibacterial action. Heliotropin, a compound corresponding to compound b) of claim 1, is among the specific fragrances listed.

- 3.7.2 The question arises as to whether the skilled person, seeking to solve the problem of providing further synergistic compositions to those disclosed in A40 or A41, would have added a heliotropin thereto as a fragrance compound, in an amount within the range defined in claim 1 for compound b).
- 3.7.3 The respondent argued that the skilled person starting at A040 or A041 and observing antimicrobial synergism for the compositions disclosed therein would have had no motivation to modify said compositions by adding heliotropin. This was all the more so since many thousands of fragrance ingredients were known to the skilled person, and in particular due to the teaching in e.g. paragraph [0051] in combination with table 1 of A040 according to which the addition of fragrances may negatively effect the synergy observed.
- 3.7.4 The board is of the following view (in the following reference is made to A040; the same applies analogously to the disclosure in A041). Paragraph [051] of A040 follows on in context from paragraph [050], which states that the results (in tables 1-3) show that the broad range antibacterial activity of 1,2-alkanediol is enhanced with certain specific fragrance components (those listed in A040, claim 1). Paragraph [0051] reads as follows:

"On the other hand, it can be known that using 1,2-alkanediol in combination with other fragrance component such as isobornyl acetate or guaiac acetate

does not enhance the antibacterial activity against a broad range of strains" (emphasis added by the board)

Table 1 demonstrates that combinations of 1,2-octanediol (according to Embodiment 1) with either isobornyl acetate or guaiac acetate (comparative examples 1 and 2) did not enhance its activity.

In these examples, isobornyl acetate or guaiac acetate are not added to the synergistic compositions of A040 as claimed, but rather to an 1,2-alkanediol in the absence of one or more of the additional ingredients which according to A040 provide synergy (A040, claim 1). Hence, in contrast to that stated by the respondent, paragraph [0051] does not teach that the addition of isobornyl acetate or guaiac acetate may negatively effect the synergy observed. Rather, it states that the addition of those compounds to an 1,2-alkanediol does not enhance the antibacterial activity in the same way as the addition of the compounds listed in paragraph [0050]. Therefore, A040 lacks any teaching that the addition of isobornyl acetate or guaiac acetate, let alone the addition of any other fragrance additive such as heliotropin, would negatively affect the synergy ("enhanced antibacterial activity" according to A040) of the combinations disclosed therein.

- 3.7.5 The skilled person desiring to solve the above-mentioned problem would therefore have added heliotropin to the formulations of A040 and A41 as addressed above.
- 3.7.6 The respondent did not rely on the concentration range of compound b) in contested claim 1 in defence of inventive step. In the view of the board, the skilled

person would have chosen an arbitrary, but technically reasonable amount of heliotropin, and thereby would have arrived at a personal care product composition falling within the scope of contested claim 1.

- 3.7.7 Concerning the respondent's argument that there were many thousands of known fragrances, and there would have been no motivation for the skilled person to choose heliotropin specifically, the board notes the following. When the technical problem is merely the provision of an alternative to the prior art composition, every feature or combinations of features conventional for that sort of composition represents an equally obvious solution to the problem posed. Hence, in the present case, the act of specifically selecting heliotropin from among equally obvious alternative fragrances cannot serve as basis for acknowledging inventive step.

It follows from the foregoing that the subject matter of claim 1 lacks inventive step (Article 56 EPC). The first auxiliary request A is thus not allowable.

Seventh auxiliary request A - Admittance

4. Before dealing with the admittance of the seventh auxiliary request A, it is necessary to look at the case history relevant to the filing of this claim request:

Sets of claims of first to thirteenth auxiliary requests were filed by letter dated 18 May 2021, i.e. after issuance of the summons to oral proceedings. During oral proceedings before the board, the appellant raised a clarity objection against claim 11 of the first auxiliary request. The first auxiliary request

was then withdrawn and the first auxiliary request A was filed. After the board concluded that the first auxiliary request A lacked inventive step (see point 3 above), the appellant submitted the seventh auxiliary request A. After the board had decided not to admit the seventh auxiliary request A, the first auxiliary request B was submitted.

Therefore, during oral proceedings, the set of claims of the seventh auxiliary request A was addressed chronologically directly following the set of claims of the first auxiliary request A (see Minutes of the oral proceedings, page 6). Although it does not represent the hierarchically subsequent request according to the final requests of the respondent (*supra*), it is addressed here in the chronological order followed at oral proceedings. This is because its submission during oral proceedings, and the issues related to admittance addressed below are also relevant to the admittance of the first auxiliary request B, which was submitted during oral proceedings directly subsequent to the issuance of the board's decision on the admittance of the seventh auxiliary request A.

4.1 As set out above, the set of claims of the seventh auxiliary request A was submitted by the respondent during oral proceedings before the board. The appellant requested that this request not be admitted into the proceedings.

Claim 1 differs from claim 1 of the first auxiliary request A

- (i) in respect of compound b) wherein claim 1 was amended to:

"b) at least one compound of formula II [defined by a Markush structure identical to that of claim 1 of the first auxiliary request A], wherein said compound is 4-hydroxybenzaldehyde; and wherein the at least one compound according to formula II is present in a total concentration of 0.05 to 0.5% (w/w) ..."

Thus, further specific compounds listed in claim 1 of the first auxiliary request A for compound b) were deleted, and

- (ii) in that in claim 1 and claim 11, the lower limit of the concentration range provided for compound b) was raised from 0.05% to 0.1% (w/w) .

4.2 The amendments (i) and (ii) were not filed for the first time with the seventh auxiliary request A submitted during oral proceedings, but were present in a previous auxiliary request, namely the seventh auxiliary request.

The effective filing date of this claim request and the amendments contained therein was a matter of dispute.

The set of claims of the seventh auxiliary request was submitted with the respondent's letter dated 18 May 2021, i.e. after the summons to oral proceedings. This in itself was uncontested. The respondent argued however that the amendments in this claim request had been addressed already in the reply to the grounds of appeal. The board acknowledges that the reply to the grounds of appeal indeed contained some explanations of claim amendments in several

auxiliary requests, including the seventh auxiliary request. However the reply to the grounds of appeal was not accompanied by copies of any of said requests. Furthermore, as conceded by the respondent during oral proceedings, the explanations contained in the reply to the grounds of appeal in relation to the seventh auxiliary request (point 54) did not correspond with the claim set finally submitted with letter of 18 May 2021. Specifically, in the reply it was stated that the lower limit for the concentration range of compound a) in claim 1 was specified as 0.25%, while in claim 1 as subsequently submitted, this amendment was not present. Furthermore, with regard to the limitation in the list of compounds recited under compound b) to 4-hydroxybenzaldehyde (amendment (i) as set out above), although the reply to the grounds of appeal stated that *"the list of compounds from which compound b) is selected has been limited to 4-hydroxybenzaldehyde"*, the exact wording of claim 1 in relation to this amendment was not set out verbatim. In consequence, the board considers that the set of claims of the seventh auxiliary request and thus the amendments of the seventh auxiliary request A relevant for the question of admittance were submitted and substantiated only with the letter of 18 May 2021, i.e. after the summons to oral proceedings. Article 13 RPBA 2020 therefore applies to the admittance thereof.

- 4.3 The respondent submitted that the amendment to claim 1 according to which the listed compounds of compound b) with the exception of 4-hydroxybenzaldehyde were deleted (amendment (i) above) was a reaction to a new line of argumentation with regard to claim 1 of the first auxiliary request A, raised by the appellant for the first time in oral proceedings. Specifically, the

new argument concerned the possibility of adding heliotropin to a composition according to A040 or A41.

4.4 The board is of the following view. An objection regarding the relevance of A040 and A041 to inventive step was submitted not only with the grounds of appeal (e.g. 2.2.4), but also as early as the filing of the notice of opposition (e.g. page 17, second paragraph, with reference to E3 and E4, the B-publications corresponding to A040 and A041, respectively). Compared to the objection raised by the appellant in oral proceedings, that objection was based on the same closest prior art, the same distinguishing feature (the presence of compound b) of claim 1 compared to the compositions of the prior art), and the same use of heliotropin disclosed in A040 or A041 as part of the solution. The fact that a new request addressing the inventive step objection raised by the appellant was filed neither during first instance proceedings, nor at the latest in reply to the statement of grounds of appeal, is not in line with the principle of procedural economy. For this reason alone, amendment (i) in the seventh auxiliary request A prejudices its admittance (Article 13(1) RPBA 2020). Furthermore, the fact that a party bases its submissions during oral proceedings on an objection already raised at an earlier stage of the proceedings does not constitute an exceptional circumstance in the sense of Article 13(2) RPBA 2020. Also for this reason, the seventh auxiliary request A cannot be admitted into the oral proceedings.

4.5 Furthermore, as set out above, this request also comprises a further amendment (ii), namely that in claim 1 and claim 11, the lower end of the concentration range provided for compound b) was raised from 0.05% to 0.1%(w/w). This amendment does not

contribute to overcoming the above inventive step objection. It is thus not apparent why, in combination with amendment (i), it was introduced at such a late stage of the appeal proceedings. For the same reasons as set out above for amendment (i) (procedural economy and lack of exceptional circumstances), this amendment prejudices the admittance of the seventh auxiliary request A.

4.6 The respondent furthermore submitted that compared to the seventh auxiliary request, the amendment by deletion of the back reference to claims 2-6 in claim 11 of the seventh auxiliary request A was a reaction to a new objection submitted by the appellant for the first time at oral proceedings. The board accepts that the need for the deletion of said back reference only became apparent during oral proceedings before the board, during which the clarity objection against claim 11 of the (subsequently withdrawn) first auxiliary request was raised for the first time. This argument is however not relevant to the question of admittance, since as set out above, the further amendments (i) and (ii) prejudice the admittance of this request.

4.7 For these reasons, the board decided not to admit the seventh auxiliary request A into the proceedings pursuant to Article 13(1) and (2) RPBA 2020.

First auxiliary request B - Admittance

5. The set of claims of the first auxiliary request B was filed during oral proceedings after the board decided not to admit the set of claims of the seventh auxiliary request A.

Claim 1 differs from claim 1 of the first auxiliary request A in the deletion of all compounds from which the compound of formula II of compound b) could be selected, with the exception of 4-hydroxybenzaldehyde, i.e. amendment (i) as set out above for the seventh auxiliary request A.

- 5.1 The appellant requested that the first auxiliary request B not be admitted into the proceedings. In addition to the arguments concerning admittance and the effective filing date of amendment (i) submitted for the seventh auxiliary request A, which applied equally to this request, it was submitted specifically for this request (while not having been raised for claim 1 of the seventh auxiliary request A having the same amendment) that amendment (i) led to a lack of clarity in claim 1.
- 5.2 The respondent argued that this request was to be admitted into the proceedings. Amendment (i) in claim 1 had been indicated as an intended limitation in the reply to the grounds of appeal and had been introduced in *inter alia* the seventh auxiliary request filed on 18 May 2021. Furthermore, the claims were clearly allowable and raised no new issues, in particular related to clarity for the subject-matter of claim 1.
- 5.3 The board is of the following view. Since this request comprises in claim 1 the same amendment (i) as set out above for the seventh auxiliary request A, the same conclusion applies to this request. Specifically, the set of claims of the seventh auxiliary request and thus the amendment of the first auxiliary request B relevant for the question of admittance (amendment (i)) were submitted and substantiated only with the letter of 18 May 2021, i.e. after the summons to oral

proceedings. Article 13 RPBA 2020 therefore applies to the admittance of the first auxiliary request B. Also for the same reason as provided above for the seventh auxiliary request A, the fact that a new request addressing the inventive step objection raised by the appellant was filed neither during first instance proceedings, nor at the latest in reply to the statement of grounds of appeal, is not in line with the principle of procedural economy. For this reason alone, amendment (i) prejudices the admittance of the first auxiliary request B (Article 13(1) RPBA 2020).

- 5.4 Furthermore, Article 13(1) RPBA 2020 stipulates that the board shall exercise its discretion in view of, *inter alia*, whether the party has demonstrated that the amendment does not give rise to new objections.

In this regard, both the appellant and the board noted during oral proceedings, and only in relation to this specific request, that a clarity issue arose in claim 1 with regard to the limitation of compound b) to 4-hydroxybenzaldehyde, i.e. amendment (i), above.

Specifically, the relevant passages of claim 1 reads as follows:

"b) *at least one compound of formula II* [defined by a Markush structure identical to that of claim 1 of the first auxiliary request A], *wherein said compound is 4-hydroxybenzaldehyde; and wherein the at least one compound according to formula II is present in a total concentration of 0.05 to 0.5% (w/w) ...*"

Here, a doubt arises as to whether further compounds, falling within the scope of the Markush definition provided for compound b), are also subject to the

limitation in the concentration range recited, or whether that concentration range applies only to the specific compound 4-hydroxybenzaldehyde.

5.5 The respondent submitted that in view of the deletion in claim 1 of the list of specifically mentioned compounds with the exception of 4-hydroxybenzaldehyde, it was clear that the text "at least one compound" preceding the concentration range recited for compound b) referred only to a single compound, namely 4-hydroxybenzaldehyde. The board disagrees. Firstly, the meaning of the text "at least one compound" explicitly includes more than one compound. Secondly, while said text indeed indicates that 4-hydroxybenzaldehyde must be present within the recited concentration range, the text "at least" seems to indicate that other compounds of Formula II if present, must also be present in the ranges recited. In this context, it is to be noted that claim 1 does not exclude the presence of other compounds falling within the scope of the Markush definition provided under compound b) (c.f. claim 1: "A ... *composition comprising ...*") This gives rise to a lack of clarity pursuant to Article 84 EPC.

It follows therefore that amendment (i) in claim 1 gives rise to a new objection in contravention of Article 13(1) RPBA 2020. This new objection thus forms part of the reasons why the board decided not to admit this request into the proceedings.

5.6 There were further reasons which contributed to the board's conclusion on admittance. Specifically, the board also exercised its discretion in view of the current state of the proceedings and the question of whether the amendments in question were detrimental to

procedural economy (Article 13(1) RPBA 2020). In this regard, not only had the respondent failed to file copies of claim requests addressed in its reply to the statement of grounds, but even when filed with the letter of 18 May 2021, the subject-matter of said requests at least partially did not correspond to what had been described earlier. Furthermore, during oral proceedings, the respondents sequential requests involved a certain moving back and forth of amendments, which was confusing and detrimental to procedural economy. This back-and-forth haphazard filing behaviour is illustrated for example by the amendment of the lower limit of 0.05% (w/w) for compound b) in claim 1 of the first auxiliary request A to 0.1% (w/w) for the seventh auxiliary request A and the subsequent reversion to 0.05% (w/w) for the first auxiliary request B. Furthermore, the unpredictable order in which the requests were presented to the board on the day of oral proceedings, led to a further erosion of procedural economy, in particular at the last possible stage of appeal proceedings. It was an accumulation of these issues, as well as the conclusions set out above (points 5.3 and 5.5), which overall and in combination led the board to decide not to admit the first auxiliary request B into the proceedings.

Second, third, fourth and fifth auxiliary requests

6. Claim 1 of the second and third auxiliary requests was amended compared to claim 1 of the first auxiliary request A in that the lower limit for the concentration range for compound b) was raised from 0.05% to 0.1% (w/w). Claim 1 of the fourth and fifth auxiliary requests comprised the further amendment that the lower limit for the concentration range for compound a) was raised from 0.1 to 0.25% (w/w). As pointed out by the

board during oral proceedings and as not disputed by the respondent, the subject-matter of the respective claim 1 of each of these requests lacked inventive step for the same reasons as provided for claim 1 of the first auxiliary request A (supra).

Consequently, the subject-matter of the respective claim 1 of each of these requests lacks inventive step.

Third and fifth auxiliary request A

7. The set of claims of the third and fifth auxiliary request A were filed during oral proceedings before the board. Articles 13(1) and (2) RPBA 2020 therefore apply.

The respective claim 11 of each request differs from the respective claim 11 of the third and fifth auxiliary request in the amendment of "as defined in any one of claims 1 to 6" to "as defined in claim 1".

During oral proceedings, after the announcement of the board's preliminary opinion that auxiliary request 3A and 5A seemed not to meet the requirements for admittance, the respondent stated that it had no submissions concerning these requests. According to Article 13(1) RPBA 2020, any amendment to party's appeal case is subject to the party's justification for its amendment, and the party shall provide reasons for submitting the amendment at this stage of the appeal proceedings. Since no justification or reasons were provided, and no reasons supporting admittance are known to the board, it was decided not to admit these requests into the proceedings.

Sixth auxiliary request

8. Claim 11 of this request is identical to claim 11 of the main request. It therefore lacks novelty for the same reason.

Seventh auxiliary request

9. Claim 11 of this request comprises a feature according to which the ranges of claim 1 in combination with the remaining reference to claims 2 to 6 are incorporated therein. It was on the basis of this feature that an objection of lack of clarity was raised by the appellant for the subject-matter of claim 11 of the first auxiliary request (subsequently withdrawn; see Minutes of oral proceedings, page 4). During oral proceedings, when provided with the board's preliminary opinion that the subject-matter of the seventh auxiliary request lacked clarity, the respondent stated that it had nothing to add.

In respect of said first auxiliary request, the respondent requested that the late filed objection of lack of clarity concerning the dependency in claim 11 on claims 2-6 not be admitted into the proceedings. Since these matters became relevant for the seventh auxiliary request, they apply by analogy. Henceforth, the issue of clarity and admittance thereof are addressed solely for the subject-matter of the seventh auxiliary request.

9.1 Admittance - Objection of lack of clarity

The appellant submitted that claim 11 lacked clarity since there was a contradiction between, on the one hand, the incorporation into claim 11 of limitations to

the specific concentration ranges of compound a) and b), and on the other hand the dependence in claim 11 on claim 2-6 stipulating narrower concentration ranges. The relevant passages of claim 11 read as follows:

"Method of forming ... a composition ... by admixing an effective amount of at least one compound a) and at least one compound b) ... as defined in any one of claims 1 to 6 ... wherein the at least one compound a) is present in a total concentration of 0.1 % to 2% (w/w); and wherein the at least one compound b) is present in a total concentration of 0.1 % to 0.5% (w/w)."

The respondent submitted that the clarity objection was not to be admitted into the proceedings. It represented a new argument which could and should have been submitted earlier. Clarity was also not objectionable in view of G 3/14 since the amendments to claim 11 (the introduction of the concentration ranges for compounds a) and b)) originated in granted claim 1.

The board is of the following view. The precise wording of the present claim set was not known until the date on which it was submitted, namely, with the letter of 18 May 2021. Thus, in view of the date of filing of the request in question, the appellant cannot have been expected to raise this objection in response to the reply to the statement of grounds of appeal. The respondent argued that the fact that the appellant submitted a further letter dated 20 July 2021 (subsequent to the filing of said claim set), meant that the clarity objection could have been raised with that letter. The board does not agree. The filing of this letter does not lead to the conclusion that the objection should have been raised before the oral

proceedings. More specifically, the filing of this letter by the appellant does not change the fact that the claim request in question was filed very late, namely approximately five years after the filing of the reply to the grounds of appeal and only four months in advance of oral proceedings. It would be unfair to allow the respondent, without good reason (none was invoked in this regard), to file a claim request as late as five years after its initial appeal submissions while expecting the appellant to react thereto within less than the four months remaining before the oral proceedings. Finally, since the clarity issue is introduced by way of amendment, namely by the incorporation of the concentration ranges for compounds a) and b) from claim 1 into claim 11, it is open to objection in accordance with G 3/14 (order). For these reasons, the board decided to admit the objection of lack of clarity into the proceedings.

9.2 Clarity - claim 11

With regard to the apparent contradiction in claim 11 addressed above, the respondent stated that the skilled person would understand that if claim 11 were to depend on one of claims 2-6, the concentration ranges recited in the latter would supersede those recited in claim 11. The board disagrees. Rather, the skilled person on reading claim 11 to incorporate a back reference to one or more of claims 2-6, in view of said contradiction, would not know whether to ignore the back-reference or whether to ignore the concentration ranges recited in claim 11. Consequently, a lack of clarity pursuant to Article 84 EPC arises in claim 11.

The seventh auxiliary request is thus not allowable.

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:



N. Maslin

M. O. Müller

Decision electronically authenticated