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**Datasheet for the decision
of 18 November 2021**

Case Number: T 2535/18 - 3.3.07

Application Number: 10713340.7

Publication Number: 2427168

IPC: A61K8/27, A61K8/49, A61K8/73,
A61Q5/02, A61Q5/00

Language of the proceedings: EN

Title of invention:

Hair Care Composition comprising zinc-based anti-dandruff agent, conazole fungicide and cationic deposition polymer

Patent Proprietor:

Unilever IP Holdings B.V.
Unilever Global IP Limited

Opponent:

The Procter & Gamble Company

Headword:

Hair Care Composition comprising zinc-based anti-dandruff agent/ UNILEVER

Relevant legal provisions:

EPC Art. 123(2), 87(1), 56
RPBA Art. 12(4)
RPBA 2020 Art. 13(2)

Keyword:

Amendments - allowable (yes)

Disclaimer and entitlement of priority (Yes)

Admission of a new objection of lack of novelty (No)

Admission of new arguments on inventive step (No)

Main request - Inventive step (Yes)

Decisions cited:

G 0001/03



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2535/18 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 18 November 2021

Appellant: The Procter & Gamble Company
(Opponent) One Procter & Gamble Plaza
Cincinnati, Ohio 45202 (US)

Representative: P&G Patent Germany
Procter & Gamble Service GmbH
Sulzbacher Straße 40
65824 Schwalbach am Taunus (DE)

Respondent: Unilever IP Holdings B.V.
(Patent Proprietor 1) Weena 455
3013 AL Rotterdam (NL)

Respondent: Unilever Global IP Limited
(Patent Proprietor 2) Port Sunlight
Wirral, Merseyside CH62 AZD (GB)

Representative: Potter Clarkson
The Belgrave Centre
Talbot Street
Nottingham NG1 5GG (GB)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 August 2018 concerning maintenance of the
European Patent No. 2427168 in amended form.**

Composition of the Board:

Chairman A. Usuelli
Members: D. Boulois
 A. Jimenez

Summary of Facts and Submissions

I. European patent No. EP 2 427 168 was granted on the basis of a set of 4 claims.

Independent claim 1 as granted read as follows:

"1. Hair treatment composition comprising 0.01 to 1.5% of zinc-based antidandruff agent by weight of the composition, a conazole fungicide and from 0.04 to 0.25% of cationic modified guar deposition polymer by weight of the composition, with the proviso that the composition is not a shampoo consisting of:

- 9 wt.% of sodium lauryl ether sulphate;
- 2 wt% of cocoamidopropyl betaine;
- 3.5 wt.% of disodium PEG-5 lauryl citrate sulphosuccinate;
- 0.5 wt% of polyquaternium-7;
- 0.2 wt.% of guar hydroxypropyltrimonium chloride;
- 0.5 wt.% of PEG-40 hydrogenated castor oil,
- 3 wt.% of glycol distearate;
- 0.5 wt.% of laureth-9;
- 0.3 wt.% of panthenol;
- 3 wt.% of urea;
- 15 wt.% of PEG-7 glyceryl cocoate;
- 1 wt.% of dimethicone;
- 1.25 wt.% Polysaf 5600 (40% strength dispersion);
- 0.2 wt.% of sodium salicylate;
- 1 wt.% of zinc pyrithione;
- 0.5 wt. % of sodium benzoate;
- 0.5 wt.% of cocamide DEA;
- 0.5 wt.% of Coolact 10;
- 0.2 wt.% of Benzophenone-4;
- 1 wt.% of climbazole,

- q.s. of sodium hydroxide solution, perfume, citric acid, and sodium chloride; and
- balance of water."

II. An opposition was filed under Article 100 (a), (b), (c) EPC on the grounds that its subject-matter lacked novelty and inventive step, was not sufficiently disclosed and extended beyond the content of the application as filed.

III. The appeal lies from the decision finding that the patent in amended form meets the requirements of the EPC. The decision was based on 2 sets of claims filed during the oral proceedings of 14 June 2018 as main request and auxiliary request 1.

Claim 1 of auxiliary request 1 had been restricted by the following features shown in bold, namely "**0.01 to 2.00 wt%** of a conazole fungicide and from **0.08 to 0.25 %** of cationic modified guar deposition polymer by weight of the composition".

IV. The documents cited during the opposition proceedings included the following:

D1: priority application EP 09159807

D2: WO 2009/138194

D3: WO 00/66081

D4: WO 00/66080

D5: WO 97/29733

D6: WO 2004/056329

D7: WO 00/66072

D8: DE 10111288

D9: KR-A-2001 0019410

D10: US 2007/0110700

D11: EP 680745 and its US 5650145 equivalent

D12: experimental data from 29-07-2012 resubmitted on 12-06-2018

- V. According to the decision under appeal, the opposition division prima facie considered the main request not novel and, because it was late filed and submitted only during the oral proceedings, it was not admitted into the proceedings.

Auxiliary request 1 was admitted into the opposition proceedings. The amended claim 1 of auxiliary request 1 was entitled to the priority, did not extend beyond the application as filed (Article 123(2) EPC) and did not extend the protection (Article 123 (3) EPC).

The amended subject-matter of claim 1 of auxiliary request 1 was clear and its subject-matter was sufficiently disclosed and novel over D4.

With regard to inventive step, D4 was considered to be the closest prior art. The claimed subject matter differed by the addition of a conazole in the claimed range. The data D12 seemed to indicate that the addition of climbazole improved zinc (ZPTO) deposition. The technical problem was seen as the provision of improved anti-dandruff compositions, where the solution was provided with the addition of conazole in the claimed range. The claimed solution was inventive.

- VI. The opponent (hereinafter the appellant) filed an appeal against said decision.
- VII. With the reply to the statement of grounds of appeal dated 29 April 2019, the patent proprietors (hereinafter the respondents), filed a main request corresponding to auxiliary request 1 as found allowable

by the opposition division, and auxiliary requests 1 to 3.

- VIII. A communication from the Board, dated 14 June 2021, was sent to the parties. In this it was stated *inter alia* that the Board was inclined to not admit into the appeal proceedings the new objection of lack of novelty over D7 that was raised by the appellant in its statement of grounds of appeal. The Board also indicated that the main request appeared to be inventive over D4 or D7.
- IX. With a letter dated 23 August 2021, the appellant submitted new arguments on inventive step involving combinations between documents D4 and D5 and between D4 and D9.
- X. Oral proceedings took place on 18 November 2021.
- XI. The arguments of the appellant may be summarised as follows:

Main request - Amendments

The subject-matter of claim 1 resulted in a combination of three categories of ingredients and a range which was not disclosed originally. It was not unequivocally and immediately apparent to the skilled reader to combine the specific sub-range for the zinc-based antidandruff agent with the combination of the most preferred range for the cationic deposition polymer with the preferred range for a conazole fungicide. There was no pointer for the features present in the claim.

Moreover, the disclaimer in claim 1 did not comply with the requirements of Article 123(2) EPC. Indeed, claim 1 of the main request could not be entitled to priority under Article 87(1) EPC which invalidated the incorporation of a disclaimer based on D2.

Main request - Novelty

The claimed subject-matter lacked novelty over D7.

Admission of inventive step objections over D7 and the combination of D4 with D5 and D9

D5 and D9 had been part of the opposition proceedings, and D9 was mentioned in the notice of opposition. The citation of these documents could not constitute a surprise.

Main request - Inventive step

The claimed subject-matter was not inventive over D7 alone or over D4 taken in combination with D7.

Compared to the disclosure of Example 1 of document D4 on page 39, the claimed subject matter only differed by the addition of a 0.01% to 2.00 wt.% of a conazole fungicide. Starting from document D4, the objective technical problem was seen as the provision of improved anti-dandruff compositions, where the solution was provided with the addition of a conazole fungicide in the claimed range. The skilled person would have turned to document D7 as this document concerned the same technical problem of improving anti-dandruff compositions as D4. The skilled person would have learned from D7 to improve the anti-dandruff composition by adding a soluble anti-dandruff agent

being ketoconazole. The improvement of the antidandruff efficacy was provided by the soluble character of ketoconazole in addition to the particulate form of zinc pyrithione. The solution was obvious in view of D7 alone or in combination with D4 as closest prior art.

XII. The arguments of the respondents may be summarised as follows:

Main request - Amendments

The subject-matter of claim 1 did not result from a multiple selection, since all claimed ranges were preferred embodiments. The priority was furthermore valid, and the incorporation of a disclaimer based on a document cited under Article 54(3) EPC was valid.

Admission of the novelty and inventive step objections over D7

In the statement of grounds of appeal, the appellant argued lack of novelty and lack of inventive step primarily from D7, although D4 was maintained as a possible subsidiary angle of attack in combination with D7. Any attack with regard of lack of novelty based on document D7, and any argument based on D7 or any combination involving D7 with regard to lack of inventive step should be rejected. D7 had effectively not been considered by the opposition division, with regard to novelty and inventive step. Consequently, by basing novelty and inventive step arguments in the statement of grounds of appeal essentially on D7, the appellant was effectively asking the Board to consider novelty and inventive step positions that were not considered by the Opposition Division.

Admission of the combination of D4 with D5 and D9

A combination between D4 and D5 or D4 and D9 should not be admitted into the appeal proceedings, since D5 and D9 had never been used in the opposition proceedings and had not been cited in the statement of grounds of appeal.

Main request - Inventive step

The technical problem in the patent could be reviewed as being the provision of an anti-dandruff composition in which the deposition of a solid anti-dandruff agent was enhanced. This was clear from e.g. example 2 of the patent, and the effect was demonstrated in greater detail by D12.

In contrast, D7 and D4 concerned themselves not with the deposition of anti-dandruff active, but its bioavailability and coverage. D4 specifically stipulated that in order to improve anti-dandruff activity, the provision of a coacervate was necessary. D7 specified that four criteria must be met to improve efficacy and conditioning, including bioavailability and coverage, but "increased level of anti-dandruff active" was not one of these. For this reason D7 was a poor starting point in the assessment of inventive step. It was not concerned with the same technical problem, i.e. increasing deposition of particulate anti-dandruff active, and it was only with hindsight that disjointed sections of D7 could be pieced together to attack the patent.

XIII. Requests

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondents requested that the appeal be dismissed, alternatively that the decision under appeal be set aside and the patent be maintained according to the set of claims filed as auxiliary requests 1-3 with the reply to the statement of grounds of appeal dated 29 April 2019. They also requested that the objection of lack of novelty and inventive step over D7 as well as the new arguments filed by letter of 23 August 2021 not be admitted into the appeal proceedings.

Reasons for the Decision

1. Main request - Article 123(2) EPC

1.1 Claim 1 of the main request differs from claim 1 as originally filed by the following features shown in bold:

- "**0.01 to 1.5%** of zinc-based antidandruff agent by weight of the composition"
- "**0.01 to 2.00 wt%** of a conazole fungicide"
- "from **0.08 to 0.25%** by weight of cationic modified guar deposition polymer by weight of the composition"
- the introduction of a proviso.

1.2 The concentration range of the zinc-based antidandruff agent is disclosed on original page 1, lines 18-20 as follows:

"Preferably, the zinc-based antidandruff agent is present at from 0.01 to 2% wt. of the composition. More preferably it is present at from 0.5 to 1.5 and most preferably from 0.75 to 1.25% wt. of the composition."

The claimed range of "**0.01 to 1.5%**" results therefore from the combination of the lowest range limit of "0.01 to 2%wt" and the upper range limit of "0.5 to 1.5%".

In the case of the disclosure of a general and of one or more preferred range(s), as in the present situation, a combination of the preferred disclosed narrower range and one of the part-ranges lying within the disclosed overall and broader range, by way of combination of a lower and an upper range limit, is unequivocally derivable from the original application, and does not constitute a particular selection.

Consequently, the range "**0.01 to 1.5%**" is derivable directly and unambiguously from the original application.

1.3 The claimed range of "**0.01 to 2.00 wt%** of a conazole fungicide" is disclosed *expressis verbis* on page 1, line 24 of the original application.

1.4 The claimed range of "from **0.08 to 0.25%** by weight of cationic modified guar deposition polymer by weight of the composition" finds a basis on page 2, lines 7-10 of the original description which reads:

"It is highly preferred that compositions according to the invention should contain from 0.04% to 2% wt. of the composition cationic deposition polymer, more preferably from 0.05 to 0.5% wt. and most preferably from **0.08 to 0.25%** by weight of the composition."

Original claim 1 referred directly to "a cationic modified guar deposition polymer" and it is also clear from the description that a guar polymer was the only possible alternative (see page 2, lines 3-6).

Consequently the range "from 0.08 to 0.25%" is also derivable directly and unambiguously from the original application.

1.5 The Board further notes that all the compositions of examples 1 and 2 comprise indeed the three components, i.e. climbazole, zinc pyrithione, and a cationic guar within the claimed range. Thus, the skilled person would find in the examples a pointer towards the combination of ingredients claimed in claim 1. Accordingly, the features defining the composition of claim 1 can be derived directly and unambiguously from the original application.

1.6 Disclaimer and entitlement of priority

1.6.1 According to the appellant, claim 1 of the main request cannot enjoy the priority claim per Article 87(1) EPC, such that the disclaimer based on example 1 of D2 cannot be allowable per G 1/03 and Article 123(2) EPC.

1.6.2 The disclaimer introduced in claim 1 corresponds to the disclosure of example 1 of D2 which was relevant for novelty under Article 54(3) EPC. If the priority is found valid, the disclaimer has to be considered in conformity with the criteria of G1/03.

1.6.3 As explained in the Board's communication of 14 June 2021, a basis for claim 1 of the main request can be found in following parts of the priority document D1:

- in claim 1 for the claimed association of a "zinc based antidandruff agent, a conazole fungicide and a cationic deposition polymer";

- in dependent claim 4 with regard to a "guar derivative" as cationic polymer; the presence of a "cationic modified guar deposition polymer" is furthermore derivable from the priority document in view of the description on page 1, last paragraph and the further disclosure of "AQU D4051 a cationically modified guar available from Aqualon" on page 2 and "guar hydroxypropyl trimonium chloride" in example 1 as cationic polymer;
- on page 1, lines 15-23 and page 2, lines 3-6 for the claimed amounts.

Consequently, the subject-matter of claim 1 of the main request enjoys the priority claim under Article 87(1) EPC. In view of the validity of the priority, D2 is indeed a document relevant under Article 54(3) EPC, and the introduction of a disclaimer excluding the disclosure of example 1 of D2 does not infringe Article 123(2) EPC.

1.7 The main request meets the requirements of Article 123(2) EPC.

2. Admission of the objections over D7

2.1 Objection of lack of novelty over D7

An objection of lack of novelty over document D7 has been raised by the appellant for the first time in the statement of grounds of appeal, whereas D7 was mentioned only as possible closest prior art for the assessment of inventive step previously in the opposition proceedings. It appears therefore that this objection of lack of novelty could and should have been submitted earlier during the opposition proceedings,

thereby allowing a discussion on this point already at that stage.

Moreover, D7 does *prima facie* not appear to disclose a composition comprising simultaneously a zinc-based antidandruff agent, a conazole and a cationic modified guar polymer. The Board notes in particular that this absence of *prima facie* relevance appears to be confirmed by the appellant's statements in its notice of opposition and also in its statement of grounds of appeal, wherein D7 is cited as possible starting point for the assessment of inventive step in view of examples I, II and IX, and wherein the appellant acknowledged that the subject-matter of claim 1 differs in that the claimed composition comprised a conazole fungicide.

Consequently, the attack of lack of novelty over D7 is not admitted into the appeal proceedings (Article 12(4) RPBA 2007).

2.2 Objection of lack of inventive step over D7

An objection for lack of inventive step starting from D7 as closest prior art has been raised by the appellant in its notice of opposition, and the respondent took also position on this attack in its response to the notice of opposition.

An objection of lack of inventive step over D7 was therefore already raised at the earliest stage of the opposition proceedings and cannot constitute a surprise or a new fact. This objection was raised again by the appellant in the statement of grounds of appeal and therefore forms parts of the appellant's complete case (Article 12(2) RPBA 2020). The request of the

respondent to not take it in consideration in the appeal proceedings is therefore not justified.

The objection of lack of inventive step over D7 is taken into consideration by the Board (Article 12(4) RPBA 2007).

3. Admission of the arguments filed by letter of 23 August 2021

In response to the Board's communication, the appellant sent a letter dated 23 August 2021, wherein the appellant mentioned documents D5 and D9, and made in particular an objection of lack of inventive step starting from D4 as closest prior art in combination with D5 or D9.

D5 was mentioned as a possible closest prior art by the appellant during the opposition proceedings, but the appellant decided to switch to D4 as the closest prior art during the oral proceedings before the opposition division, and document D5 was not discussed any more in this context (see decision of the opposition division, point 35, and page 3 of the minutes of the oral proceedings). D9 was cited as common general knowledge document in the notice of opposition for the assessment of inventive step, but was not discussed further, in particular during the oral proceedings before the opposition division, and was not mentioned in the decision of the opposition division.

Moreover, said documents were also not cited or discussed in the appellant's statement of grounds of appeal, and their citation after the Board issued its preliminary opinion constitutes an amendment to the

appellant's case at a late stage of the appeal proceedings.

According to Article 13(2) RPBA 2020, an amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned. Such exceptional circumstance do not appear to exist in the presence case, since the main request is the request which has been maintained by the opposition division and the Board did not introduce new facts or arguments in its communication. The only argument of the appellant regarding the combination with D5 and D9, that said documents were already mentioned in the notice of opposition, and that their citation could not constitute a surprise, cannot constitute an exceptional circumstance; this argument does also not explain why it had prevented the appellant from filing this new line of argumentation based on a combination with D5 and D9 during the opposition proceedings or at an earlier stage of the appeal proceedings.

Consequently, the appellant's arguments filed with letter dated 23 August 2021 relating to the inventive step-attack based on combinations involving documents D5 and D9 are not taken into account by the Board (Article 13(2) 2020).

4. Main request - Inventive step

- 4.1 The claimed invention relates to a hair treatment composition comprising an anti-dandruff agent and a cationic deposition polymer.

- 4.2 D4 was considered by the opposition division to be the closest prior art, while the appellant mentioned also D7 in its statement of grounds of appeal.

D4 discloses in example 1 a composition comprising 1% wt of a zinc derivative and 0.25% wt of a cationic guar gum. The addition of ketoconazole is mentioned in D4 as hair growth agent, or as optional further anti-dandruff agent, in a list of several possibilities (see page 35, line 34, or page 36, line 28).

D7 discloses in example I a shampoo composition comprising 1.0% of zinc pyrithione and 0.25% of guar hydroxypropyltrimonium chloride. D7 discloses on page 23 that ketoconazole may also be used as the soluble anti-dandruff agent, with a concentration of 0.3 to 2 wt%.

Compared to any of the disclosures of D4 or D7, the claimed subject-matter differs by the presence of 0.01-2.00 wt% of a conazole fungicide.

5. The opposition division considered that the technical problem over D4 was the provision of improved anti-dandruff compositions.

The appellant saw also the technical problem in view of D7 or D4 as the provision of improved anti-dandruff compositions, while the respondent defined it as being the provision of an anti-dandruff composition in which the deposition of a solid anti-dandruff agent is enhanced.

- 5.1 The solution to any of these problems is the addition of a conazole in the claimed range.

5.2 The respondent relied on example 2 of the patent and the experimental results of D12 to support the alleged technical effect.

D12 shows indeed that a composition comprising a zinc-pyrithione and a cationic guar provides a higher zinc deposition on skin when formulated with climbazole, a conazole fungicide.

Since an increased zinc deposition of the skin provides a increased anti-dandruff effect, the technical problem starting from D4 or from D7 is as defined by the opposition division, i.e. the provision of an improved anti-dandruff composition, and this technical problem is credibly solved.

5.3 It remains to determine the obviousness of the solution.

According to the appellant, the skilled person gets the guidance in document D7 that for providing an improved antidandruff composition, ketoconazole may also be used as the soluble anti-dandruff agent in the anti-dandruff and conditioning shampoo composition of D7 (page 23, 2nd par.). The solution was obvious in view of D7 alone or in combination with D4 as closest prior art.

Such a teaching is however not provided by D7. The document D7 mentions indeed on page 23, lines 6-9, that "ketoconazole may also be used as the soluble anti-dandruff agent...effective concentrations of ketoconazole are typically from about 0.1 to about 4% by weight, preferably from about 0.3% to about 2%". It is however clear from the disclosure of this document that ketoconazole is envisaged as an alternative anti-dandruff agent to the pyridinethione salts, which are

the preferred anti-dandruff agents, as specified on page 22, lines 1-6.; only mixtures of pyridinethione salts, selenium sulfides and particular sulfur are suggested in the same passage. Document D7 does not disclose any example with ketoconazole, even less in combination with pyridinethione salts at the claimed concentration ranges. Furthermore, there is no teaching in D7 that the addition of ketoconazole may improve the anti-dandruff composition by enhancing the zinc deposition on skin.

There is also no incentive from the teaching of D4 to add a conazole to the disclosed compositions in order to provide an improved anti-dandruff composition. Ketoconazole is disclosed in D4 as a possible further hair growth agent or optional ingredient among a list of many alternative possibilities, and there is no mention of a possible increased zinc deposition associated therewith.

In conclusion, the claimed solution is not obvious, and the Board does not see any reason to deviate from the conclusions set by the opposition division with regard to inventive step, and the claimed subject-matter is inventive both starting from D4 or from D7 as the closest prior art.

- 5.4 The main request meets the requirements of Article 56 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

A. Uselli

Decision electronically authenticated