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Datasheet for the decision of 19 January 2024

Case Number: T 0579/20 - 3.3.10

Application Number: 14163250.5

Publication Number: 2926802

IPC: A61K8/41, A61Q5/10, A61K8/31, A61K8/34, A61K8/06

Language of the proceedings: EN

Title of invention:
Hair colouring compositions, kits, method, and use thereof

Patent Proprietor:
Noxell Corporation

Opponent:
L'OREAL

Headword:
Hair colouring compositions/Noxell Corporation

Relevant legal provisions:
EPC Art. 56

Keyword:
Inventive step - (no)

Decisions cited:

Catchword:

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Case Number: T 0579/20 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 19 January 2024

Appellant: (Patent Proprietor)	Noxell Corporation 11050 York Road Hunt Valley MD 21030-2098 (US)
Representative:	Bandpay & Greuter 30, rue Notre-Dame des Victoires 75002 Paris (FR)
Respondent: (Opponent)	L'OREAL 14 rue Royale 75008 Paris (FR)
Representative:	L'Oreal Service D.I.P.I. 9, rue Pierre Dreyfus 92110 Clichy (FR)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 3 January 2020 revoking European patent No. 2926802 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairwoman	R. Pérez Carlón
Members:	J.-C. Schmid
	T. Bokor

Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division revoking European patent EP-B-2 926 802 for lack of inventive step (Article 56 and 100(a) EPC).

Claim 1 of the patent as granted reads as follows:

"1. A hair colouring composition comprising, in a cosmetically acceptable carrier:

- one or more oxidizing agent(s);
- one or more alkalizing agent(s);
- one or more oxidative dye precursor(s) selected from the group consisting of 2-methoxymethyl-p-phenylenediamine, cosmetically acceptable salts thereof and mixtures thereof;
- one or more oil(s),

wherein the composition comprises a total amount of oil(s) of more than 20%, preferably at least 30%, more preferably at least 50 % by total weight of the composition."

II. The opposition was based on lack of inventive step (Article 100(a) EPC) and insufficiency disclosure (Article 100(b) EPC) based inter alia on documents

D1: WO-A-2012/095398 and
D3: CA-A-2 576 189.

III. According to the opposition division, D3 represented the closest state of the art to the invention. It

related to a hair dyeing compositions comprising 1,4-diamino-2-methoxymethylbenzene (MBB).

The objective technical problem was the provision of a colouring composition comprising MBB that achieved improved colouring intensity.

D1 aimed to improve the intensity and/or evenness of hair coloration. It suggested dyeing compositions comprising at least 20wt.% of oils. The skilled person starting from D3 and faced with the problem of improving colour intensity would have considered a higher oil content in the hair dye composition according to the teaching of D1. The subject-matter of claim 1 of the patent as granted was therefore obvious over D3 in combination with D1.

The additional feature in claim 1 of auxiliary request 1, according to which the composition comprised a total amount of oxidation dye precursor(s) selected from the group consisting of 2-methoxymethyl-p-phenylenediamine, its cosmetically acceptable salts and mixtures thereof ranging from 0.01 to 2%, preferably from 0.5 to 2.00%, by total weight of the composition, did not further distinguish the claimed subject matter from D3.

The subject-matter of claim 1 of auxiliary request 1 lacked therefore an inventive step for the same reason as for claim 1 of the maim request.

The range of oil content was more narrowly defined in auxiliary request 2, namely was ranging from 40% to 70% by weight. However, D1 suggested the range 30-55% which had an end point falling directly in the claimed range. Therefore, claim 1 of auxiliary request 2 also lacked an inventive step.

Claim 1 of auxiliary request 3 comprised the added features of auxiliary requests 1 and 2 and, therefore, also lacked an inventive step.

Hence, the opposition division revoked the patent on the ground that the subject-matter of claim 1 of the patent as granted and auxiliary requests 1 to 3 did not involve an inventive step.

IV. According to the appellant, D3 was the closest prior art to the invention. However, the technical problem to be solved was to provide a low to moderate skin-sensitizing hair colouring composition that achieved an increased colour intensity without compromising the evenness of the hair colour.

In support of their arguments the appellant filed D18, an experimental report aiming at showing the effect of the addition of oil on the evenness of the colour, starting from mineral oil-free compositions exhibiting the same colour intensity.

D1 neither disclosed nor suggested that the hair colouring compositions provided specific performances in term of colour intensity and evenness of the hair colour. The claimed subject-matter involved therefore an inventive step over the combination of D3 with D1.

The appellant also filed auxiliary requests 1 to 12 with the grounds of appeal dated 29 May 2020.

Claim 1 of auxiliary request 1 differs from granted claim 1 in that the oil(s) is(are) a liquid organic compound(s) insoluble in water at 25°C and at a pressure of 760 mmHg.

Claim 1 of auxiliary request 2 differs from granted claim 1 in that the oil(s) is selected from the group consisting of paraffin, petroleum jelly, polydecenes, esters of fatty acid, esters of fatty alcohol, fatty alcohols, all in a liquid form, and mixtures thereof.

Claim 1 of auxiliary request 3 differs from granted claim 1 in that the composition comprises a total amount of oxidation dye precursor(s) selected from the group consisting of 2-methoxymethyl-p-phenylenediamine, its cosmetically acceptable salts and mixtures thereof ranging from 0.01 to 2%, preferably from 0.5 to 2.00%, by total weight of the composition.

Claim 1 of auxiliary request 4 differs from granted claim 1 in that the composition comprises a total amount oil(s) ranging from 40% to 70% by total weight of the composition.

Auxiliary request 5 cumulatively comprises the amendments of the auxiliary requests 3 and 4.

Auxiliary request 6 cumulatively comprises the amendments of the auxiliary requests 1 and 3.

Auxiliary request 7 cumulatively comprises the amendments of auxiliary requests 1 and 4.

Auxiliary request 8 cumulatively comprising the amendments of the auxiliary requests 1 and 5.

Auxiliary request 9 cumulatively comprises the amendments of auxiliary requests 2 and 3.

Auxiliary request 10 cumulatively comprises the amendments of auxiliary requests 2 and 4.

Auxiliary request 11 cumulatively comprises the amendments of auxiliary requests 2 and 5.

Claim 1 of auxiliary request 12 is identical to claim 1 of the patent as granted.

V. With the response to the appeal dated 13 October 2020, the respondent (opponent) filed a test report (D19) aiming to show that the addition of oil to a composition comprising MBB base does not improve colour intensity. The respondent also requested that auxiliary requests 1, 2 and 6 to 12 be not admitted in the appeal proceedings.

VI. With a letter dated 25 November 2020, the appellant filed additional information to the experimental report of document (18) and submitted that document (19) did not represent a fair reproduction of the tests according to document (18) and, hence, should not be admitted to the proceedings.

VII. In a letter dated 3 March 2021, the respondent requested that document (18) be also not admitted in the proceedings.

VIII. In the communication of 24 July 2023 issued for the preparation of the oral proceedings scheduled 9 November 2023, the Board indicated that, according to its preliminary opinion, the subject matter of claim 1 of the main request (patent as granted) and of auxiliary requests 3 to 5 lacked inventive step for the same reasons as claim 1 of the main request. The Board also pointed out that the appellant had not indicated

why the features added in the fresh auxiliary requests 1, 2 and 6 to 12 should confer an inventive step on the claimed subject matter. The board announced that the appeal would likely be dismissed.

IX. In a letter dated 14 September 2023, the appellant announced that they would not attend the oral proceedings scheduled 9 November 2023 and therefore only relied on their written submissions.

X. With a communication dated 9 October 2023, the oral proceedings appointed for 9 November 2023 had been cancelled.

XI. The appellant (patent proprietor) requests in writing that that the decision under appeal be set aside and the patent be maintained as granted (main request) or be maintained on the basis of one of the auxiliary requests 1 to 12 filed with the statement setting out the grounds of appeal dated 29 May 2020.

The respondent requests in writing that the appeal be dismissed.

Reasons for the Decision

Main request (patent as granted)

Inventive step

1. *Closest prior art*

The parties agree that D3 represents the closest prior art to the invention. The Board also agrees.

This document relates to compositions for dyeing keratin fibres. It discloses an aqueous or aqueous-alcoholic oxidation dye composition comprising 1,4-diamino-2-methoxymethylbenzene (MBB), as the oxidation base (see claims 1 to 6). It reveals that this 1,4-diaminobenzene has improved physiological compatibility, especially it is non-sensitizing (page 1, lines 29 to 33). The oxidation dye precursor composition is mixed with an oxidizing agent prior to application to form a ready-to-apply hair dye composition (see claims 1 and 3). The colouring composition preferably comprises at least a source of alkalising agent (see page 15, lines 9 to 22).

2. *Technical problem*

The appellant defined the technical problem to be solved as providing a low to moderate skin-sensitizing hair colouring composition that achieves an increased colour intensity without compromising the evenness of the final hair colour.

3. *Solution*

The proposed solution is the hair colouring composition of claim 1 of the patent as granted characterized by the presence in the composition of at least of 20 % by weight of oil(s).

4. *Success*

In the present case, it is not necessary to assess whether the test reports filed by the appellant demonstrate convincingly that the claimed compositions solve the above mentioned technical problem.

In fact, the respondent's objections in the analysis of the obviousness of the claimed solution prevail even if, in favour of the appellant, the technical problem of providing a low to moderate skin-sensitizing hair colouring composition that achieves an increased colour intensity without compromising the evenness of the final hair colour is retained (see point 5 below).

5. *Obviousness*

It remains to be decided whether the proposed solution of adding at least 20% by weight of fatty substances into the dye composition of D3 in order to improve the colour intensity without compromising the evenness of the final hair colour is obvious in the light of the prior art.

5.1 D1 relates to a process for the oxidation dyeing of keratin fibres. This document aims to improve the colour obtained by an oxidative dyeing process, in particular to improve the power/intensity and/or uniformity of the hair colour (see page 3, line 29 to 34). This is achieved by mixing extemporaneously at the time of use the oxidation dye composition and the oxidizing composition in such a way that the ready-to-use dyeing composition obtained comprises at least 25% by weight of fatty substance (page 4, lines 1 to 17).

D1 discloses that the fatty substance may be an oil (see page 6, line 27 to page 12, line 10). The oil is a fatty substance that is liquid at room temperature (page 7, line 1-2) and is insoluble in water at ordinary temperature (25°C) and at atmospheric pressure (760 mmHg) (page 7, line 3 to 5). The oils may be liquid fatty alcohols, liquid fatty esters or linear of branched hydrocarbons such as liquid paraffins,

petroleum jelly or polydecenes or mixtures thereof (page 7, lines 14 to 18 and 36 to 39).

In the example, composition A comprises 60% by weight of liquid petroleum jelly and composition B 20% by weight. After mixing composition A with composition B at a ratio 1:1, the ready-to-use colouring composition comprises 40% by weight of petroleum jelly (see page 36 line 5 to page 37, line 4).

5.2 Thus, D1 gives the skilled person a concrete hint as to how to solve the technical problem of providing a dyeing composition having improved colour, in particular improved intensity and homogeneity, namely by adding into the hair colouring compositions known from the closest prior art D3 fatty substances in concentrations within the claimed range, for instance liquid petroleum jelly, thereby arriving at the composition of claim 1 of the main request having a total amount of oil of more than 20% by total weight of the composition.

A skilled person would therefore arrive at the compositions of claim 1 of the main request, since it is obvious to follow the hint given in D1 for the colour improvement, with a reasonable expectation of success, especially as the compositions of D3 are already low to moderate skin-sensitizing.

The proposed solution of adding at least 20% by weight of fatty substances into the dye composition of D3 in order to improve intensity and homogeneity of the coloration is therefore obvious in the light of D1.

5.3 According to the appellant the teaching of D1 relates to hair colouring compositions comprising base

oxidation precursors such as para-phenylenediamine or para-toluenediamine, which are not comparable to MMB.

However, D1 does not limit its teaching on increasing colour intensity and homogeneity to dye compositions comprising particular oxidising bases (see page 1, lines 14 to 19). It is acknowledged that D1 does not explicitly cite MBB in the list of the specific oxidation bases disclosed, otherwise D1 would have been novelty destroying for the subject matter of claim 1 of the patent as granted. D1 nevertheless mentions paraphenylene diamines and 2-substituted paraphenylene diamines (page 25, lines 33 to page 26, line 14). MMB is a 2-methoxymethyl substituted paraphenylene diamine and is thus encompassed by the teaching of D1.

Thus, the appellant's attempts to restrict the teaching of D1 to exclude dyeing compositions containing MMB as the oxidation dye are unconvincing.

5.4 The board therefore concludes that the subject-matter of claim 1 of the patent as granted is obvious over the combination of D3 with D1.

Auxiliary requests 1 and 2

6. In claim 1 of auxiliary request 1, the oil(s) is a liquid organic compound(s) insoluble in water at 25°C and at a pressure of 760 mmHg.

In claim 1 of auxiliary request 2, the oil(s) is selected from the group consisting of liquid paraffin, liquid petroleum jelly, polydecenes, liquid esters of fatty acid, liquid esters of fatty alcohol, liquid fatty alcohols, and mixtures thereof.

The added features in auxiliary requests 1 and 2 are disclosed in D1 (see point 5.1 above). Therefore, the assessment of inventive step for claim 1 of the main request, as well as the conclusions drawn, also apply to the subject-matter of claim 1 of auxiliary requests 1 and 2. These requests, therefore, share the same fate as the main requests in that the subject-matter of claim 1 of auxiliary requests 1 and 2 lacks an inventive step.

Auxiliary requests 3 to 5

7. These auxiliary requests correspond to auxiliary requests 1 to 3 pending before the opposition division. The appellant has not indicated in what respect the reasoning of the opposition division rejecting these auxiliary requests for lack of inventive step was erroneous. Consequently, the Board sees no reason to depart from the reasoning and conclusion in the contested decision that these auxiliary requests are not allowed for lack of inventive step.

Auxiliary requests 6 to 11

8. These requests result from combining the features disclosed in D1 and added in auxiliary request 1 or auxiliary request 2 with the features of auxiliary requests 3 to 5.

The appellant formally submitted these requests, but without explaining why these combinations should confer an inventive step to the claimed subject-matter. As the features of auxiliary requests 1 and 2 are disclosed in D1, auxiliary requests 6 to 11 lack an inventive step for the reasons stated in the decision under appeal for auxiliary requests 3 to 5.

Auxiliary request 12

9. Claim 1 of auxiliary request 12 is identical to claim 1 of the patent as granted whose subject-matter lacks an inventive step. Auxiliary request 12 is therefore rejected for lack of inventive step for the same reason as the main request.

10. For these reasons, the subject-matter of claim 1 of all requests does not involve an inventive step, and the appeal must be dismissed. The admittance of auxiliary requests 1, 2 and 6 to 12 and documents D8 and D9 need not be decided.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chair:

C. Rodríguez Rodríguez R. Pérez Carlón

Decision electronically authenticated