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**Datasheet for the decision
of 15 November 2022**

Case Number: T 0652/20 - 3.3.07

Application Number: 13723054.6

Publication Number: 2846759

IPC: A61Q5/02, A61K8/04, A61K8/19,
A61K8/73, A61K8/02, A61K8/89,
A61K8/34

Language of the proceedings: EN

Title of invention:
AEROSOL DEVICE BASED ON SEBUM-ABSORBING POWDER AND A
PARTICULAR WATER-INSOLUBLE MINERAL COMPOUND

Patent Proprietor:
L'Oréal

Opponent:
Henkel AG & Co. KGaA

Headword:
Aerosol device / L'OREAL

Relevant legal provisions:
RPBA 2020 Art. 12(4)
EPC Art. 100(a), 56

Keyword:

Amendment to case - amendment within meaning of Art. 12(4) RPBA
2020 - admitted (no)

Admittance of new items of evidence

Inventive step - main request (no), auxiliary request 1 (yes)



Beschwerdekammern

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Case Number: T 0652/20 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 15 November 2022

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
21 January 2020 concerning maintenance of the
European Patent No. 2846759 in amended form.**

Composition of the Board:

Chairman A. Usuelli
Members: J. Lécaillon
Y. Podbielski

Summary of Facts and Submissions

I. European patent EP 2 846 759 (hereinafter "the patent") was granted on the basis of 15 claims. The independent claims of the patent as granted read as follows:

"1. Aerosol device which contains a cosmetic composition comprising:

- (i) one or more sebum-absorbing powders with a sebum uptake of greater than or equal to 35 ml/100 g,
- (ii) a water-insoluble mineral compound which is calcium carbonate,
- (iii) one or more C₂₋₄ monoalcohols, and
- (iv) one or more propellants."

"12. Aerosol device which contains a cosmetic composition comprising:

- (i) one or more sebum-absorbing powders with a sebum uptake of greater than or equal to 35 ml/100 g,
- (ii) one or more water-insoluble mineral compounds chosen from metal carbonates, oxides and sulfates and silicates containing magnesium,
- (iii) one or more C₂₋₄ monoalcohols,
- (iv) one or more propellants, and
- (v) one or more silicone gums having a viscosity of greater than $0.5 \times 10^{-3} \text{ m}^2/\text{s}$ (500cSt)."

"14. Process for the dry washing and cosmetic treatment of keratin materials, comprising a step of applying to dry hair a cosmetic composition as defined in any one of Claims 1 to 13, sprayed from an aerosol device according to any one of Claims 1 to 13."

"15. Use of the cosmetic composition sprayed from the aerosol device according to any one of Claims 1 to 13, for the dry washing and treatment of keratin materials."

- II. An opposition was filed against the patent on the grounds that its subject-matter lacked novelty and inventive step and it was not sufficiently disclosed.
- III. The opposition division took the interlocutory decision that, on the basis of the auxiliary request 1, the patent met the requirements of the EPC. The decision was based on the patent as granted as the main request and on an auxiliary request 1 filed on 19 September 2019. This auxiliary request contained 13 claims, which corresponded to granted claims 1 to 11 and 14 to 15 (*i.e.* granted claims 12 and 13 were deleted).
- IV. The decision of the opposition division, posted on 21 January 2020, cited *inter alia* the following documents:
 - E1: GB 1 218 222 A
 - E2: WO 2011/056625 A1
 - E3: US 5 223 244
 - E4: WO 2011/019539 A2
 - E8: Test report, 14 January 2019
- V. The opposition division decided in particular as follows:
 - (a) The subject-matter of the granted claims was sufficiently disclosed.

- (b) The subject-matter of the patent was novel over the composition of example 12 of E3.
- (c) E2 was the closest prior art to the granted claim 12. The distinguishing feature resided in the use of a silicone gum having a viscosity as defined in claim 1. There was no evidence on file that any particular technical effect resulted from this distinguishing feature. The objective technical problem was thus the provision of alternative aerosol devices. The subject-matter of granted claim 12 was obvious in light of the teachings of E2 and E4.
- (d) In auxiliary request 1, claim 12 of the main request was deleted. The claims involved an inventive step for the following reasons: E2 was the closest prior art to claim 1. The distinguishing feature resided in the presence of calcium carbonate in the composition. According to E8, this resulted in improved volume of hair and reduced white residues. The objective technical problem was thus the provision of a dry shampoo composition giving improved volume and reduced white residues. The claimed solution was not obvious in light of the prior art.

VI. The patent proprietor as well as the opponent lodged an appeal against the above decision of the opposition division.

VII. With its statement setting out the grounds of appeal the appellant - patent proprietor defended its case on the basis of the patent as granted as the main request, and on the basis of auxiliary requests 1 to 2 filed

during the first instance proceedings on 19 September 2019 and resubmitted therewith.

VIII. The content of the claims upon which the present decision is based is illustrated under items I and III.

IX. The following items of evidence were filed by the parties during the appeal proceedings:

(a) Documents filed by the appellant - opponent on 29 May 2020 with its statement setting out the grounds of appeal:

A9: US 4 035 267 A

A10: „Kreide" Abstract from Wikipedia

A11: US 2012/0282190 A1

(b) Document filed by the appellant - patent proprietor on 8 October 2020 with its reply to the statement setting out the grounds of appeal:

A12: International Cosmetic Ingredient Dictionary and Handbook, Eight Edition 2000, Vol. 1, page 261, "chitine"

X. Oral proceedings were held before the Board on 15 November 2022.

XI. The appellant-patent proprietor requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or that the patent be maintained on the basis of one of auxiliary requests 1 and 2 filed during the first instance proceedings on 19 September 2019 and resubmitted with the statement setting out the grounds of appeal.

The appellant-patent proprietor further requested that documents A9 to A11 as well as the novelty argument partly based on A9 not be admitted into the proceedings.

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

XIII. The arguments of the appellant - patent proprietor, as far as relevant for the present decision, can be summarised as follows:

(a) Documents A9 to A11 as well as the lack of novelty argument partly based on A9 were late filed and not to be admitted into the appeal proceedings.

(b) The subject-matter of claim 12 of the main request differed from the compositions of the examples of the closest prior art E2 in that the claimed compositions comprised a silicone gum having a specific viscosity. The objective technical problem as formulated during the oral proceedings resided in the provision of an alternative aerosol device comprising a dry shampoo composition. E2 did not suggest to add a silicone gum. The skilled person would furthermore not have combined the teaching of E2 with that of E4, because these documents described different systems. Hence, granted claim 12 involved an inventive step.

(c) The subject-matter of claim 1 of auxiliary request 1 differed from the compositions of E2 in that they contained calcium carbonate as water-insoluble mineral compound. This resulted *inter alia* in a reduction of white residues upon use of the dry

cleansing composition. The objective technical problem resided therefore in the provision of an aerosol dry shampoo providing an optimum cleansing activity as well as styling properties while not leaving white residues. None of the prior art documents cited by the appellant - opponent suggested to use calcium carbonate as water-insoluble mineral compound to solve this problem. Hence, auxiliary request 1 involved an inventive step.

XIV. The arguments of the appellant - opponent, as far as relevant for the present decision, can be summarised as follows:

- (a) The lack of novelty argument developed in the appeal proceedings was not new since it was based on the same example of E3 as in first instance proceedings. Merely a new item of evidence substantiating the achievement of the claimed parameter (A9) had been provided in reply to the decision of the opposition division. This argument and document A9 were thus to be admitted into the appeal proceedings. Furthermore the documents A10 and A11 provided evidence of common general knowledge and should be admitted into the appeal proceedings.
- (b) The subject-matter of claim 12 of the main request differed from the compositions of the examples of the closest prior art E2 in that the claimed compositions comprised a silicone gum having a specific viscosity. The objective technical problem as formulated during the oral proceedings resided in the provision of an alternative aerosol device. The skilled person would have considered document

E4, which suggested the addition of a silicon gum according to present claim 1. Hence, granted claim 12 did not involve an inventive step.

- (c) The subject-matter of claim 1 of auxiliary request 1 differed from the compositions of E2 in that they contained calcium carbonate as water-insoluble mineral compound. No technical effect, especially no reduction of white residues, linked to this distinguishing feature had been substantiated. In particular, the protocol of the experiment reported in document E8 as well as the nature of the compositions tested therein had not been appropriately chosen. The objective technical problem resided therefore in the provision of an alternative dry shampoo in the form of an aerosol shampoo. Aerosol dry shampoos containing starch and mild alkali components, including Alkali- or alkaline earth- carbonates, in particular magnesium carbonate were taught in document E1. Moreover document E4 disclosed the advantageous effect of combining two particulate carriers and mentioned calcium carbonate as a possible carrier. The skilled person would thus have found in either document E1 or document E4 a motivation to use calcium carbonate in the compositions of document E2. Hence, auxiliary request 1 did not involve an inventive step.

Reasons for the Decision

1. Admittance of new items of evidence and arguments
 - 1.1 New reasoning of lack of novelty, document A9 and document A12
 - 1.1.1 In its statement setting out the grounds of appeal, the appellant - opponent raised a lack of novelty objection *versus* the composition of example 12 of E3 based on the argument that chitin contained therein would represent a sebum-absorbing powder having a sebum uptake of 35 mL/100 g or more. Document A9 was filed in support thereof.

During the first instance proceedings the appellant - opponent relied exclusively on fibroin as sebum-absorbing powder in its objection of lack of novelty over example 12 of E3. Fibroin was consequently the sole component considered as potential sebum-absorbing agent in the impugned decision. Hence, the lack of novelty reasoning of the appellant - opponent based on chitin as sebum-absorbing powder was provided for the first time in the entire proceedings with its statement setting out the grounds of appeal.

During the oral proceedings, the appellant - opponent explained that this argument was not new. According to the appellant - opponent, its objection of lack of novelty raised during the first instance proceedings concerned the whole composite material containing fibroin and chitin. These two components only differed in the mechanism by which sebum uptake occurred. Merely a new item of evidence substantiating the achievement of the claimed sebum-uptake parameter (A9) had been

provided in reply to the decision of the opposition division pointing out the lack of evidence therefore (see paragraph bridging pages 6 and 7 of the impugned decision).

This argument is not convincing. As apparent from the impugned decision (see item 10.2.3., page 6, 3rd paragraph to page 7, 1st paragraph) and the notice of opposition of the appellant - opponent (see e.g. page 7, 3rd paragraph), exclusively fibroin had been considered as possible sebum-absorbing powder in example 12 of E3 during the first instance proceedings. In particular, the lack of evidence of fulfilment of the claimed sebum-uptake value mentioned by the opposition division in its decision concerns exclusively fibroin.

1.1.2 Accordingly, the Board considers that this new reasoning based on chitin constitutes an amendment to the appellant - opponent's case and its admittance is subject to the discretion of the Board according to Article 12(4) RPBA 2020.

1.1.3 The Board observes that the appellant - opponent, contrary to the requirement of Article 12(4) 2nd sentence RPBA 2020, did not provide any reason in support of the admission of document A9 in its statement setting out the grounds of appeal.

The new lack of novelty reasoning of the appellant - opponent raises an entirely new discussion regarding the physico-chemical properties of chitin. It does therefore not address the reasoning of the first instance decision as such but merely the conclusion thereof, namely that the composition of example 12 of E3 did not anticipate the subject-matter of granted

claim 1. This opinion of the opposition division had furthermore already been expressed in the annex to the summons to oral proceedings in opposition.

Moreover this new discussion regarding the physico-chemical properties of chitin would introduce complexity, in particular regarding the question of whether chitin has indeed a sebum-uptake according to claim 1, and would hence be against procedural economy.

1.1.4 Accordingly, the new reasoning of lack of novelty based on chitin and document A9 are not admitted into the appeal proceedings (Article 12(4) RPBA 2020).

1.1.5 As a consequence, document A12 filed by the appellant - patent proprietor in reaction of this reasoning is also not admitted into the appeal proceedings (Article 12(4) RPBA 2020).

1.2 Documents A10 and A11

1.2.1 The appellant - opponent argued that these documents had been filed as evidence of common general knowledge regarding chalk. The Board notes that they support an argument already raised during the first instance proceedings in the context of inventive step and regarding the possible occurrence of white residues when using chalk in the presence of sebum. Finally, as indicated by the appellant - patent proprietor during the oral proceedings, document A11 was actually the US-patent application corresponding to the PCT-application filed as document A2 during the first instance proceedings. The teaching of document A11 is therefore not new in the proceedings.

1.2.2 Hence, documents A10 and A11 form part of the appeal proceedings (Article 12(4) RPBA 2020).

2. Sufficiency of disclosure

The appellant - opponent did not pursue in the appeal stage its objection under Article 100(b) EPC. The Board agrees with the opposition division that the patent fulfills the requirements of Article 83 EPC.

Main request - patent as granted

3. Inventive step

3.1 Independent claim 12 as granted relates to an aerosol device comprising a dry shampoo composition containing:
(i) one or more sebum-absorbing powders having a sebum uptake of at least 35 mL/100 g,
(ii) one or more water-insoluble mineral compounds chosen from metal carbonates, oxides and sulfates and silicates containing magnesium,
(iii) one or more C₂₋₄ monoalcohols,
(iv) one or more propellants, and
(v) one or more silicone gums having a viscosity of greater than $0.5 \times 10^{-3} \text{ m}^2/\text{s}$.

3.2 In agreement with both appellants, the Board considers E2 to represent the closest prior art.

3.3 E2 discloses aerosol dry shampoo compositions comprising a carrier material, a starch material, a clay material and a propellant. In particular the compositions of the examples comprise:
- Alcohol, 200pf (*i.e.* ethanol) as carrier,

- aluminium starch octenylsuccinate (*i.e.* a sebum-absorbing powder according to the patent in suit) as starch material,
- stearalkonium hectorite (*i.e.* a silicate containing magnesium) as clay material, and
- isobutane as propellant.

- 3.4 During oral proceedings, it was undisputed that:
- (a) the present aerosol devices differ from those of document E2 in that the claimed compositions further comprise a silicone gum having a specific viscosity,
 - (b) no particular effect directly linked to this distinguishing feature had been substantiated, and
 - (c) the objective technical problem to be solved resides therefore in the provision of an alternative aerosol device comprising a dry shampoo composition.

- 3.5 As mentioned in the impugned decision (see page 9, 3rd full paragraph, 1st sentence), document E2 states that any type of additive may be incorporated (see page 5 line 26 - page 6 line 18 of E2). The skilled person willing to solve the problem posed would thus have considered adding an additive.

Document E4 relates to a dry cleaner for keratinous substrates *i.e.* it addresses the same purpose as document E2. In particular, document E4 discloses that the agglomeration of non-elastomeric polyorganosiloxanes with solid particulate carriers enhances the speed of absorption of body fluids by these carriers (see paragraphs [0004] and [0007]), which may *inter alia* be magnesium silicate or starch, *i.e.* the absorbing agents of the compositions of document E2 (see paragraph [0008] of E4). Furthermore

the non-elastomeric polyorganosiloxanes of document E4 may be in the form of gums (see paragraph [0017]) and have a viscosity of 5 mm²/s to 2.5x10⁶ mm²/s (see paragraph [0015]-[0016]), *i.e.* greater than 0.5 X 10⁻³ m²/s.

Hence, the skilled person willing to solve the problem posed would have added a silicone gum according to document E4 to the compositions of document E2 without the exercise of inventive skills, thus arriving at the subject-matter of present claim 12.

3.6 In this context, the appellant - patent proprietor argued that the skilled person would not have combined the teachings of documents E2 and E4, because these documents described two different systems. In its view, document E2 described a liquid carrier in which solid particles were suspended while document E4 described a solid carrier on which a solution containing a silicon gum was absorbed.

This argument is however not convincing. The "carrier" mentioned in document E4 does not correspond to the "carrier" of the compositions of document E2 but to the sebum-absorbing powders thereof, namely the starch and clay compounds. It follows that document E4 discloses a solid absorbing powder similar to the one of document E2. Document E4 does indeed not mention a liquid carrier and a propellant as components of the composition. However, as underlined during the oral proceedings by the appellant - opponent, document E4 further specifies that this powder may be dispensed through an aerosol, which involves the use of such components (see paragraphs [0007]and [0080]). As a result, the skilled person would have taken document E4 into consideration and would not have seen any

hindrance in combining its teaching with the one of document E2.

- 3.7 Consequently, granted claim 12 does not comply with the requirements of Article 56 EPC and the ground of opposition under Article 100(a) EPC prejudices the maintenance of the granted patent.

Auxiliary request 1

4. Inventive step

- 4.1 Auxiliary request 1 differs from the main request in that independent claim 12 and claim 13 depending thereupon have been deleted.

- 4.2 Claim 1 of auxiliary request 1 relates to an aerosol device comprising a dry shampoo composition containing:
- (i) one or more sebum-absorbing powders having a sebum uptake of at least 35 mL/100 g,
 - (ii) calcium carbonate,
 - (iii) one or more C₂₋₄ monoalcohols, and
 - (iv) one ore more propellants.

- 4.3 As for the main request, in agreement with both appellants, the Board considers document E2 to represent the closest prior art.

- 4.4 It was undisputed that the present aerosol devices differ from those of document E2 in that they contain calcium carbonate as water-insoluble mineral compound.

- 4.5 The main point of dispute concerned the presence of a technical effect linked to this distinguishing feature.

4.5.1 The Board notes that the patent in suit aims at *inter alia* reducing the occurrence of white residues following the use of a dry cleansing product (see paragraph [0008]). The example of the patent in suit reports "little white residue" on hair after dry washing with a composition according to the present claims (see paragraph [0114]). Furthermore the comparative data provided in document E8 substantiate that the presence of calcium carbonate instead of stearylalkonium hectorite as in the compositions of document E2 provides a reduction of white residues, thus confirming the technical effect already reported in the patent in suit.

4.5.2 The appellant - opponent was of the opinion that the comparative example of document E8 did not allow to conclude that no white residues were obtained with calcium carbonate since there was no comparison with a composition containing only the sebum-absorbing powder according to the claims (*i.e.* aluminium starch octenylsuccinate).

The Board is not convinced by this argument. The comparative composition ("composition A") of document E8 corresponds to a composition according to example 1 of document E2. It is compared to a composition according to present claim 1 which differs from the comparative composition only in that the water-insoluble mineral compound is calcium carbonate instead of stearylalkonium hectorite, *i.e.* the distinguishing feature *versus* the closest prior art E2. This comparative example is thus appropriate to show an improvement compared to the closest prior art. The reduction of white residues when using the composition according to the claims compared to the comparative composition is advantageous. There is no need to show

an absence of white residue nor to compare to a composition not according to the closest prior art.

- 4.5.3 In this context the appellant - opponent mentioned during the oral proceedings that, stearalkonium hectorite being a magnesium containing silicate, it was considered as an alternative to calcium carbonate in the granted patent (see paragraphs [0054] to [0058]). In its opinion, the patent itself admitted that the compositions of document E2 and those of the invention had the same effect.

There is no general requirement that all initially claimed compositions have to achieve a non-claimed technical effect to exactly the same level. Some of the initially described compositions may achieve this technical effect to a greater extent than others. In the present case, the reduction of white residue in the case of calcium carbonate compared to stearalkonium hectorite has been experimentally demonstrated and this argument of the appellant - opponent is therefore not persuasive.

- 4.5.4 The appellant - opponent further contested that the set up of the experiment reported in document E8 was appropriate to substantiate an effect of the claimed dry cleansing composition for the reasons detailed below.

(a) In its written submissions, the appellant - opponent contended that, the experiment having been performed on washed hair, no sebum would be present. Calcium carbonate would however form white residues when mixed with sebum. This would occur because calcium carbonate is an oil absorbing substance (see document All paragraph [013]). Chalk

(known to be calcium carbonate, see A10) would furthermore be known to be used to prepare coloring agents by mixing with organic colorants (see document A10 page 4) and sebum is an organic mixture according to the patent in suit (see paragraph [023]). Accordingly, the reduction of white residues observed in the case of the composition containing calcium carbonate in document E8 would be due to the absence of sebum.

This argument is not convincing. The assertion that if the test would have been performed on not previously washed hair, white residues would have been obtained with the composition containing calcium carbonate has not been experimentally substantiated. Furthermore, the passage of document A10 on page 4 mentions mixing chalk with organic coloring agents and does therefore not appear relevant in the case of sebum. The argument of the appellant - opponent remains therefore speculative. Moreover, even if it would have been substantiated that white residues would have been observed with a composition according to the invention with the modified set up, there is no evidence that it would not still have been to a lesser extent than with the composition according to document E2.

- (b) During the oral proceedings, the appellant - opponent argued more generally that in order to assess the efficacy of a washing composition, the hair should not be first washed, as done in the experiment reported in document E8.

However, as explained by the appellant - patent proprietor during the oral proceedings, the technical effect evaluated in the experiment

reported in document E8 does not concern the washing efficacy of the compositions but their propensity to form white residues. The Board furthermore observes that as stated above (see 4.5.4 (a)) there is no evidence that this propensity would be linked to the cleanliness of hair. This argument of the appellant - opponent is thus not convincing.

- 4.6 It follows that, starting from document E2, the objective technical problem to be solved resides in the provision of an aerosol device containing a further dry shampoo composition resulting in reduced white residues.
- 4.7 The cited prior art documents do not describe, or even suggest, to add calcium carbonate to the compositions of document E2 to solve the problem posed.

In particular, document E1 mentions the preparation of a composition containing an absorbent substance, such as starch, and mild alkalis, such as magnesium sub-carbonate or sodium bicarbonate (see page 1 left column, lines 23 to 27 and 40 to 44). However, it does not disclose specifically calcium carbonate, let alone the present associated effect.

Furthermore, document E4 mentions calcium carbonate, but merely as one of the possible solid particulate carriers (see page 2 line 24). There is no indication that calcium carbonate would reduce white residues nor that it could be used in combination with starch. Contrary to the opinion of the appellant - opponent, the fact that document E4 teaches that calcium silicate and starch may be used to improve absorbency (see page 2 lines 31-32) does not allow to draw any conclusion

regarding the effect of calcium carbonate combined with starch.

4.8 Accordingly, the subject-matter of claim 1 of auxiliary request 1 involves an inventive step. No objection was raised for the remaining independent process and use claims (claims 12 and 13 of auxiliary request 1). The Board is satisfied that the subject-matter of claims 2 to 13 of auxiliary request 1 also involves an inventive step.

4.9 As a result, auxiliary request 1 fulfills the requirements of Article 56 EPC.

Order

For these reasons it is decided that:

The appeals are dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

A. Uselli

Decision electronically authenticated