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**Datasheet for the decision  
of 4 May 2023**

**Case Number:** T 1002/20 - 3.3.07

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**Language of the proceedings:** EN

**Title of invention:**  
COMPOSITIONS AND METHODS FOR TREATING HAIR

**Patent Proprietor:**  
L'OREAL  
Tan, Siliu  
Simonnet, Jean-Thierry  
Singer, Jim  
Nguyen, Nghi Van

**Opponent:**  
Beiersdorf AG

**Headword:**  
Hair compositions / L'OREAL

**Relevant legal provisions:**

EPC Art. 54, 83, 111(1), 114(2)

RPBA 2020 Art. 13(2), 11

**Keyword:**

Novelty - main request (no), auxiliary request 1 (yes)

Sufficiency of disclosure - (yes)

Amendment at oral proceedings - exceptional circumstances (no)

Remittal - (yes)



**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 1002/20 - 3.3.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.07**  
**of 4 May 2023**

**Appellant:** L'OREAL  
(Patent Proprietor 1) 14 rue Royale  
75008 Paris (FR)

**Appellant:** Tan, Siliu  
(Patent Proprietor 2) 10 Plymouth Road  
Westfield, New Jersey 07090 (US)

**Appellant:** Simonnet, Jean-Thierry  
(Patent Proprietor 3) 34 rue Moliere  
92500 Rueil Malmaison (FR)

**Appellant:** Singer, Jim  
(Patent Proprietor 4) 120 Connett Place  
South Orange, New Jersey 07079 (US)

**Appellant:** Nguyen, Nghi Van  
(Patent Proprietor 5) 8 Churchill Road  
Edison, New Jersey 08820 (US)

**Representative:** Casalonga  
Casalonga & Partners  
Bayerstraße 71/73  
80335 München (DE)

**Respondent:** Beiersdorf AG  
(Opponent) Unnastrasse 48  
20253 Hamburg (DE)

**Representative:** Beiersdorf AG  
Patentabteilung,

Unnastrasse 48  
20253 Hamburg (DE)

**Decision under appeal:**      **Decision of the Opposition Division of the  
European Patent Office posted on 12 February  
2020 revoking European patent No. 3021830  
pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

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

## Summary of Facts and Submissions

I. European patent 3 021 830 (hereinafter "the patent") was granted on the basis of 34 claims. The independent product claims of the patent as granted read as follows:

"1. A hair styling composition comprising at least two latex acrylate polymers and optionally at least one component chosen from coalescing agents, plasticizers, and/or thickening agents, wherein the composition comprises at least one latex acrylate polymer A and at least one latex acrylate polymer B chosen from:

(a) polymer A, having a Young's modulus ranging from about 0.1 MPa to about 10 MPa, and a strain, under stress at 0.5 MPa, of at least about 1 %; and

(b) polymer B, having a Young's modulus ranging from about 10 MPa to about 6 GPa, and a strain, under stress at 0.5 MPa, of less than about 5%;

wherein at least one latex acrylate polymer is a film-forming polymer;

wherein the at least two latex acrylate polymers are present in a combined amount ranging from about 0.1% to about 30% by weight, relative to the weight of the composition;

wherein the at least two latex acrylate polymers are present in the composition in a weight ratio ranging from about 10:1 to about 1:10; and

wherein said composition produces a film having a Young's modulus ranging from about 0.05 MPa to about 5

GPa, and a strain, under stress at 0.5 MPa, that ranges up to about 300%."

"26. A hair styling composition comprising:

(1) an aqueous dispersion comprising at least two latex acrylate polymers wherein at least one latex acrylate polymer is a film-forming polymer, said aqueous dispersion comprising:

(a) at least one polymer A, having a Young's modulus ranging from about 0.1 MPa to about 10 MPa, and a strain, under stress at 0.5 MPa, of at least about 1 %; and

(b) at least one polymer B, having a Young's modulus ranging from about 10 MPa to about 6 GPa, and a strain, under stress at 0.5 MPa, of less than about 5%;

(2) at least one solvent; and

(3) optionally at least one component chosen from coalescing agents, plasticizers, and/or thickening agents;

wherein the at least two latex acrylate polymers are present in a combined amount of less than about 10% by weight, relative to the weight of the composition;

wherein the at least two latex acrylate polymers are present in the composition in a weight ratio ranging from about 10:1 to about 1:10; and

wherein said composition produces a film having a Young's modulus ranging from about 0.05 MPa to about 5 GPa, and a strain, under stress at 0.5 MPa, that ranges up to about 300%."

The further independent granted claims were directed to methods of styling the hair (claims 29 and 31).

- 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 decision to revoke the patent. The decision was based on the patent as granted as the main request and on one auxiliary request.
- IV. The decision of the opposition division, posted on 12 February 2020, cited *inter alia* the following documents:

D1: Experimental data submitted by the opponent during opposition proceedings

D4: Spray Hair Gel; Lubrizol (20.04.2015 / Original Edition December 2006)

D5: Long-Lasting Hold Spray Gel; Lubrizol (20.04.2015 / Original Edition 23.01.2007)

D9: Technical Data Sheet Fixate™ G-100 Hair Fixative Polymer (09.01.2003)

D11: Data Sheet "Acudyne™ 180" (September 2008)

D13: Data Sheet "Synthalen® K" of 3V

D14: Declaration of Siliu Tan, 13 December 2019

D17: Encyclopedia of polymer science and technology, concise. Page 17, H. Mark, ISBN-10:0470-04610-4 (cloth). Available at:

[https://www.google.com/books/edition/](https://www.google.com/books/edition/Encyclopedia_of_Polymer_Science_and_Tech/Vfh1AQAAQB_AJ?hl=en&gbpv=1&pg=PA17&printsec=frontcover)

[Encyclopedia\\_of\\_Polymer\\_Science\\_and\\_Tech/Vfh1AQAAQB\\_AJ?hl=en&gbpv=1&pg=PA17&printsec=frontcover](https://www.google.com/books/edition/Encyclopedia_of_Polymer_Science_and_Tech/Vfh1AQAAQB_AJ?hl=en&gbpv=1&pg=PA17&printsec=frontcover)

- V. The opposition division decided in particular as follows:

- (a) The ground of opposition under Article 100(b) EPC prejudiced the maintenance of the granted patent (main request).
- (b) The subject-matter of the independent claims of auxiliary request 1 was not novel over D4 and D5.

VI. The patent proprietors (appellants) lodged an appeal against the above decision of the opposition division.

VII. With their statement setting out the grounds of appeal the appellants defended their case on the basis of an amended main request (corresponding to the auxiliary request on which the impugned decision was based), and on the basis of auxiliary requests 1 to 3, all filed therewith.

The content of the claims upon which the present decision is based can be illustrated as follows:

Claim 1 of the main request read as follows:

"1. A hair styling composition comprising at least two latex acrylate polymers and optionally at least one component chosen from coalescing agents, plasticizers, and/or thickening agents, the thickening agents being chosen from acrylates/C10-30 alkylacrylate crosspolymer, xanthan gum, guar gum, hydroxypropyl guar, guar hydroxypropyl trimonium chloride, hydroxyethyl cellulose, hydroxypropyl cellulose and cetyl hydroxyethyl cellulose, wherein the composition comprises at least one latex acrylate polymer A and at least one latex acrylate polymer B chosen from:  
(a) polymer A, having a Young's modulus ranging from about 0.1 MPa to about 10 MPa, and a strain, under stress at 0.5 MPa, of at least about 1%; and



(b) polymer B, having a Young's modulus ranging from about 10 MPa to about 6 GPa, and a strain, under stress at 0.5 MPa, of less than about 5%;  
wherein at least one latex acrylate polymer is a film-forming polymer;  
wherein the at least two latex acrylate polymers are present in a combined amount ranging from about 0.1% to about 30% by weight, relative to the weight of the composition;  
wherein the at least two latex acrylate polymers are present in the composition in a weight ratio ranging from about 10:1 to about 1:10; and  
wherein said composition produces a film having a Young's modulus ranging from about 0.05 MPa to about 5 GPa, and a strain, under stress at 0.5 MPa, that ranges up to about 300%,  
each Young's modulus and strain being measured on a latex film obtained by allowing a 30 gram water solution containing 4 grams of the latex polymer(s) to dry slowly in a 100 ml PFA Petri dish (100 mm diameter x 15 mm height) at room temperature for at least 3 days."

Claim 1 of auxiliary request 1 corresponded to claim 1 of the main request wherein the following feature was introduced after "wherein at least one latex acrylate polymer is a film-forming polymer;":

"wherein the latex acrylate polymers are not fully neutralized;".

VIII. The following items of evidence were filed by the appellants with the statement setting out the grounds of appeal:

D21: Second declaration of Siliu Tan, 18 June 2020

D22: Technical Data Sheet of Eastmann AQ 55S Polymer

D23: Element of Polymer Science, in Principles of polymer Science and Technology in Cosmetics and Personal Care, Edited by Goddard and Gruber (extract pp. 63-65)

D24: Test report regarding the determination of Young's modulus of latex polymers of paragraph [0046]

- IX. Oral proceedings were held before the Board on 4 May 2023.
- X. The appellants requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or one of auxiliary requests 1 to 3, all filed with the statement setting out the grounds of appeal. In the event that the issue of inventive step were to become relevant, the appellants requested that the case be remitted to the opposition division for further prosecution. The appellants requested furthermore that the objection of lack of compliance with Article 123(3) against auxiliary request 1 and the arguments regarding a lack of novelty of the feature introduced in auxiliary request 1 raised by the respondent during oral proceedings not be admitted into the appeal proceedings.
- XI. The respondent requested that the appeal be dismissed. In the event that the issue of inventive step were to become relevant, the respondent requested that the case be remitted to the opposition division for further prosecution. The respondent requested furthermore that the objections regarding the date of availability of the content of D4 and D5 raised by the appellants during oral proceedings not be admitted into the appeal proceedings.

XII. The arguments of the appellants, as far as relevant for the present decision, can be summarised as follows:

- (a) The patent as a whole provided sufficient disclosure of the subject-matter claimed in the main request. In particular, the experiment of D1 would not substantiate that the skilled person could not prepare a film according to the method provided in claim 1 of the main request. Furthermore, testing commercial polymers following the methodology disclosed would not constitute an undue burden.
- (b) The late-filed argument regarding the date of availability of the content of D4 and D5 and thus their relevance as prior art represented a fact, which was to be admitted into the appeal proceedings.
- (c) Claim 1 of the main request was novel over D4 and D5, because the polymer used in the compositions described in these documents, namely Fixate™ G-100 PR Polymer, was not a latex polymer as explained in D21 and supported by D9. This polymer could thus not fall under the definition of polymer A according to the present claims.
- (d) The objection of lack of compliance with the requirements of Article 123(3) EPC and the specific arguments regarding a lack of novelty of the feature introduced in auxiliary request 1 were not to be admitted into the appeal proceedings, because they were late filed.
- (e) Claim 1 of auxiliary request 1 was novel over D4 and D5 because the claimed latex acrylate polymers

had been limited to non-fully neutralized ones. According to D9, Fixate™ G-100 PR Polymer used in the compositions of D4 and D5 was indeed pre-neutralized, *i.e.* fully neutralized.

XIII. The arguments of the respondent, as far as relevant for the present decision, can be summarised as follows:

- (a) The patent did not provide sufficient guidance concerning the method of preparation of the film. The results provided in D1 substantiated that the method specified in the claims was not sufficiently detailed for the skilled person to obtain a film. In particular the relative humidity and the storage time before measuring the claimed parameters would directly influence the preparation of the film and the value of the parameter to be measured. The absence of this information resulted in a lack of sufficient disclosure. Moreover, the necessity of measuring the claimed parameters for each and every polymer constituted an undue burden for the skilled person.
- (b) The argument regarding the date of availability of the content of D4 and D5 and their relevance as prior art was late filed and not to be admitted into the appeal proceedings.
- (c) The subject-matter of claim 1 of the main request was anticipated by the compositions disclosed in D4 and D5, because the Fixate™ G-100 PR Polymer corresponded to a latex polymer A according to said claim, as revealed *inter alia* by D9.
- (d) The objection of lack of compliance with the requirements of Article 123(3) EPC and the specific

arguments regarding a lack of novelty of the feature introduced in auxiliary request 1 were *prima facie* highly relevant and thus to be admitted into the appeal proceedings.

- (e) The objection of lack of novelty over D4 and D5 raised for the main request applied to auxiliary request 1.

### **Reasons for the Decision**

1. Admittance of new items of evidence

There was no request against the admittance of D21 to D24. These documents were filed in response to the impugned decision. Their content is not complex and their filing is not detrimental to procedural economy. The Board therefore admits these documents in the appeal proceedings (Article 12(4) RPBA 2020).

#### *Main request*

2. Sufficiency of disclosure

- 2.1 The Board observes that the patent provides guidance regarding (i) the method for the preparation of the films which fulfill the parameters defined in the present independent claims (see paragraph [0118] and independent claims) and (ii) suitable latex polymers (see paragraphs [0037] to [0047]). Furthermore the results provided in tables 1A and 1B of the patent substantiate that for four exemplary latex acrylate polymers, films according to the claims could indeed be prepared and the parameters defined in the claims successfully measured.

2.2 The respondent contested that the claimed invention was sufficiently disclosed with respect to the determination of the claimed parameters, for the following reasons:

- (a) As shown in D1, a film was produced according to the method described in the patent (see paragraph [0118]) including drying for the minimal drying time specified in the patent (*i.e.* 3 days) and using Acudyne 180, which is a latex acrylate polymer built from monomers listed in the patent as being suitable for the preparation of the claimed latex acrylates. The obtained film was so bland and crumbly that the measuring of the claimed parameters (Young's modulus) could not be performed (see D1). This substantiated that the method for the determination of the claimed parameter as specified in the main request was not sufficiently described for the skilled person to carry it out.
  
- (b) During the oral proceedings the respondent added that the lack of information regarding (i) the relative humidity and (ii) the storage time of the film before the actual measuring of the parameter also led to a lack of sufficiency of disclosure because these parameters directly impacted (i) the formation of the film and (ii) the properties of the film. Without this information, the skilled person did not know when a film was sufficiently formed and corresponded to a film within the meaning of the patent.
  
- (c) In its written submissions, the respondent also argued that the claimed parameters needed to be measured for each and every polymer considered to be used, since the skilled person could not rely on

common structural features to determine whether a latex acrylic polymer would indeed be a polymer A or B. This constituted an undue burden for the skilled person.

- (d) Finally, the respondent also submitted in writing that claim 1 of the main request encompassed embodiments in which only one of the latex acrylate polymers was a film-forming polymer, due to the feature "wherein at least one latex acrylate polymer is a film-forming polymer" and in line with paragraph [0025] of the patent. Since the film forming feature was however essential to the determination of the claimed parameters, sufficiency of disclosure was not given for these embodiments.

2.3 These arguments are not convincing for the following reasons:

- (a) The sole example of D1 (test report provided by the respondent) wherein a film of a latex acrylic polymer has been prepared following the instructions for film preparation as defined in the independent claims (see Sample I of D1, first picture with PFA Petri dish) is not sufficient to cast doubt on sufficiency of disclosure in the present case.

In this context, the respondent argued that the method defined in the claims merely required a drying for "at least 3 days", so that example 1 of D1, performing a drying for 3 days, indeed followed the defined method. As explained during the first instance proceedings by the appellants (see decision of the opposition division, paragraph

bridging pages 5 and 6), the skilled person would understand from the patent, D1 and D11, that three days drying may not be sufficient for the specific polymer tested in D1 (Acudyne 180) to form a film. The method defined in the patent indeed prescribes "at least 3 days" of drying, which unambiguously implies that a longer drying may be required. As mentioned in the impugned decision (see item 3.6.2), D11 describes Acudyne 180 as yielding "crystal-clear films on hair" (top of page 1 of D11). The skilled person would therefore have expected this polymer to form a film and would thus have adapted the drying time.

The Board further observes that in the present case, one isolated example of the preparation of a film not being suitable to undergo the required parameter measurements, is generally not sufficient to substantiate that the skilled person cannot perform the claimed invention. The independent claims impose two limitations on the definition of the polymers to be used. Firstly they should be acrylic latex polymers, secondly they have to form a film fulfilling the claimed parameters. The claims do not state that any acrylic latex polymer would fulfill the second requirement. The patent further provides lists of suitable acrylic latex polymers as well as examples of film formed from some of these polymers following the method defined in the claims and which achieve the claimed parameters. The respondent did not provide any evidence that the listed suitable polymers would not form a film fulfilling the claimed parameters.

- (b) The fact that the method of preparation of the film indicated a drying time but no storage time would



be understood by the skilled person as implying that the claimed parameters have to be measured immediately after the film has formed. Furthermore, the respondent has not provided any evidence that the value of the claimed parameters would indeed change upon storage. Similarly the respondent has not provided any evidence substantiating its allegation that the relative humidity would directly influence the claimed parameters for a given film. Finally the question of whether the skilled person would be working within the scope of the claims or not, remains an issue of clarity and not one of sufficiency of disclosure.

- (c) The necessity of verifying that a potential component fulfills the claimed parameter is usually occurring when defining features with parameters. If the achievement of the parameter could be determined on the basis of structural features, then a definition in terms of a parameter would not be required. The methods for the preparation of the film and the measurement of the claimed parameters are described in the patent (see paragraphs [0118] and [0119]) and amount to routine experiments. The Board is therefore of the opinion that there is no undue burden for the skilled person merely because the measurement would have to be done for every candidate latex acrylic polymer.
- (d) The Board considers that claim 1 of the main request unambiguously foresees that the composition comprises at least two acrylic latex polymers, which both have to be film-forming polymers due to their further definition in terms of parameters. This condition constitutes a further restriction of the feature defining that "at least one acrylate

polymer is a film-forming polymer". The objection raised by the respondent rather amounts to a clarity objection regarding the wording of the claim itself and a potential discrepancy between the claims and the description. This does however not constitute an issue of sufficiency of disclosure in the present case.

2.4 Accordingly, in the absence of serious doubts substantiated by verifiable facts, the subject-matter of the claims of the main request is sufficiently disclosed (Article 83 EPC).

3. Novelty

3.1 Admittance of the argument regarding the date of availability of the content of D4 and D5

3.1.1 During the oral proceedings the appellants questioned for the first time in the entire proceedings the date of availability of the content of D4 and D5 and thus their relevance as prior art. The documents submitted as D4 and D5 each bear a publication date in April 2015, *i.e.* after the filing date of the patent. According to the appellants, while a reference to "original editions" of 2006 (D4) and 2007 (D5) was included in these documents, it could not be ascertained that the content disclosed as D4 and D5 was also disclosed in the original editions. The appellants considered that this constituted a fact, which should be admitted into the appeal proceedings.

3.1.2 This newly raised issue constitutes an amendment to the case of the appellants. Its admission is subject to the provisions of Article 114(2) EPC and Article 13(2) RPBA 2020, which provisions foresee that any amendments 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.

3.1.3 As stated by the respondent, D4 and D5 were cited in the notice of opposition dated 3 January 2019 with their actual publication date and the reference to the original editions published in 2006 and 2007, respectively (see page 5 of this notice). The facts underlying the argument raised by the appellants have thus been available since the beginning of the opposition procedure. Indeed, the proceedings before the opposition division and the Board up to the time of the oral proceedings have been conducted on the understanding that the content of the original editions corresponded to that of D4 and D5. The argument raised by the appellants for the first time during the oral proceedings before the Board should therefore have been raised much earlier. The appellants have furthermore not referred to any exceptional circumstances which would justify the admittance of this new issue at this late stage of the proceedings.

3.1.4 As a result, the Board does not admit this new line of argument into the appeal proceedings.

3.2 Novelty over D4 and D5

3.2.1 Documents D4 and D5 both disclose hair styling compositions comprising Fixate<sup>TM</sup> Superhold Polymer, which is a polyacrylate-2 crosspolymer (explicitly cited as a polymer B in the patent, see example 1, paragraph [0131]), and Fixate<sup>TM</sup> G-100 PR Polymer, which is an AMP-Acrylate/Allyl methacrylate copolymer. As

explained by the respondent, the combined amount of polymers is 1,99 wt% (D4) and 2,188 wt% (D5) and the weight ratio of the polymers is around 1:1 (D4) and around 1:1,21 (D5).

- 3.2.2 The point of dispute resided in the nature of Fixate™ G-100 PR Polymer. The respondent considered that it corresponded to the latex acrylic polymer A, while the appellants contested that it would be a latex polymer.
- 3.2.3 The Board observes that Fixate™ G-100 PR Polymer is obtained from monomers (namely (meth)acrylic acids, simple alkyl esters of (meth)acrylic acids and allyl methacrylate, see the technical data sheet of Fixate™ G-100 polymer, D9, 1st column under "Product description") listed in the patent as suitable monomers for the preparation of the claimed polymers (see patent, paragraphs [0039] and [0040]). Furthermore, as stated in the decision of the opposition division (see paragraph bridging pages 10 to 11), D9 describes properties of Fixate™ G-100 PR Polymer corresponding to those of polymer A. In view of D4, D5 and D9, there is therefore no reason to doubt that Fixate™ G-100 PR Polymer would be a latex acrylic polymer.
- 3.2.4 According to the appellants a latex polymer would be commonly known as being insoluble in water while not coagulating, so that it would form a dispersion in water (see D23, definition of "Latex"). Such a dispersion would have an opaque to milky appearance because it would scatter light due to the retained particulate structure of the polymer. The retention of the particulate structure of the latex acrylate polymers according to the invention would be specified in paragraph [0036] of the patent.

D9 specified under the heading "Typical Properties" that Fixate™ G-100 Polymer had the appearance of a "translucent liquid" at 25°C. According to the appellants this meant that the light would not be scattered which in turn would indicate that the polymer would not be a latex polymer. This would be further confirmed by the reference in D9 under the heading "Features" to an "aqueous solution". As stated in D21, (expert declaration of Tan Siliu, one of the inventors and patent proprietors of the patent), this would be due to the pre-neutralization of Fixate™ G-100 to a translucent liquid that no longer includes its particle form and is soluble in water. D9 and D17 were cited in support of this assertion.

3.2.5 Furthermore, latex polymers would be prepared by emulsion polymerisation (see e.g. D17 and D23) and thus be emulsion polymers. Polymers formed from the monomers listed in the patent but through a different method than emulsion polymerisation would thus be understood by the skilled person as not being latex polymers (see point 5 of D21).

3.2.6 These arguments are not convincing for the following reasons:

(a) The Board observes that D9 indeed reports that Fixate™ G-100 PR is pre-neutralized to pH 6.0 with AMP®-95 (see 1st column "Features") and has the appearance of a translucent liquid at 25°C (see 1st column under "Typical properties"). However, D9 still describes it as an aqueous dispersion containing 26% total solids (see 1st column under "Product description"). The passage of D9 cited by the appellants under "Features" when reproduced in its entirety states "Easy to use, aqueous solution;

readily disperses in water or alcohol". As D9 otherwise systematically refers to a dispersion, the Board considers that a skilled person would understand this passage as referring to a product "easy to use in an aqueous solution". D9 does therefore not support the allegation made in D21 that "Fixate G-100 (...) no longer includes its particle form" (see item 7. of D21).

Moreover, such an aqueous dispersion is in line with the characteristics described in paragraph [0029], 1st sentence, and paragraph [0031] of the patent. Finally the retention of the particulate form is described as constituting "certain embodiments" of the invention in paragraph [0036] of the patent. This feature is not an essential feature of the latex acrylic polymers according to the patent.

- (b) Furthermore, the Board observes that D17 does not explicitly refer to latex but relates specifically to emulsion polymers and D23 is not exclusive of other preparation methods. In contrast to the declarations of Tan Siliu (see D14 and D21), the patent does also not limit latex polymers to emulsion polymers, which are merely described as one possible embodiment thereof in paragraph [0029] of the patent. Indeed paragraph [0030] foresees that the "in other embodiments the latex polymers are produced from condensation reactions [...]". D17 and D23 do thus also not support the fact that neutralized acrylic and (metha)acrylic acid polymers cannot be considered as latex polymers according to the patent.

(c) Finally, the claims of the main request do not exclude neutralized polymers and the description itself states that latex acrylate polymers may "independently be neutralized" (see paragraph [0036] of the patent). This passage refers to the polymers *per se*, not to the polymers once in the composition as stated in D21.

3.2.7 It follows that Fixate™ G-100 PR Polymer used in D4 and D5 is considered to fall under the definition of polymer A according to the patent. The achievement of the claimed parameters by the polymers of D4 and D5 was not disputed by the appellants. As a result D4 and D5 disclose compositions which fall under the scope of claim 1 of the main request.

3.2.8 Hence, the subject-matter of claim 1 of the main request is not novel (Article 54 EPC).

#### *Auxiliary request 1*

4. Admittance of the objection of lack of compliance with Article 123(3) EPC and admittance of the lack of novelty objection raised by the respondent during oral proceedings

4.1 During the oral proceedings the respondent raised for the first time in the appeal proceedings an objection of lack of compliance with Article 123(3) EPC for auxiliary request 1. According to the respondent the limitation of the latex acrylate polymers in present claim 1 would result in a broadening of the scope of protection. Indeed the amounts and weight ratios would now only apply to not fully neutralized polymers while fully neutralized polymers could be present in amounts higher than defined in granted claim 1, due to the

wording of the claim as "comprising" the listed components.

- 4.2 Also for the first time in the appeal proceedings did the respondent question during the oral proceedings the novelty of the feature introduced in claim 1 of auxiliary request 1.
- 4.3 These newly raised issues constitute amendments to the case of the respondent. Their admission is subject to the provisions of Article 114(2) EPC and Article 13(2) RPBA 2020.
- 4.4 The respondent argued that the newly raised issues were to be admitted because they were *prima facie* highly relevant. Moreover, the particular point regarding Article 123(3) EPC would have been complex to realise, and had only been fully appreciated during the preparation for the oral proceedings. The argument regarding lack of novelty of the introduced feature would be based on documents already present in the proceedings, namely D4, D5, D9 and D13.
- 4.5 As underlined by the appellants, auxiliary request 1 was filed with the statement of grounds of appeal and the respondent replied thereto with its submission dated 6 October 2020 without however raising any objection regarding lack of compliance with Article 123(3) or lack of novelty with regard to the feature introduced in claim 1 of auxiliary request 1. The arguments raised by the respondent for the first time during the oral proceedings in the appeal proceedings should therefore have been raised earlier.
- 4.6 Moreover, the objection of lack of compliance with Article 123(3) EPC is based on an interpretation of the



claim which is not the sole possible one. The issue is therefore complex, as acknowledged by the respondent. The objection cannot therefore be prima facie relevant.

- 4.7 Finally, the respondent has not provided any exceptional circumstances which would justify the admittance of the new issues at this late stage of the proceedings.
- 4.8 As a result, the Board does neither admit the objection under Article 123(3) EPC nor the objection of lack of novelty presented for the first time during the oral proceedings.
5. Novelty
- 5.1 Claim 1 of auxiliary request 1 corresponds to claim 1 of the main request wherein the latex acrylic polymers have been limited to non-fully neutralized polymers.
- 5.2 In the written proceedings, concerning the issue of novelty of auxiliary request 1, the respondent relied on the same arguments as for the main request and did not provide any particular argument why Fixate™ G-100 PR Polymer would also fulfill the additional feature introduced in claim 1 of auxiliary request 1, namely that it be a non-fully neutralised polymer.
- 5.3 Fixate™ G-100 PR Polymer used in the compositions of D4 and D5 is described in D9 as having been subjected to "pre-neutralization" without any limitation. As argued by the appellants, the skilled person would thus, in the absence of any further information, understand it as a full neutralization. Fixate™ G-100 PR Polymer is therefore considered to no longer fall under the definition of polymer A as claimed in claim 1 of

auxiliary request 1, which requires non-fully neutralized polymers.

- 5.4 Accordingly, based on the parties' written submissions, the subject-matter of claim 1 of auxiliary request 1 is novel over documents D4 and D5 (Article 54 EPC).

*Remittal*

6. Article 11 RPBA 2020 provides that a remittal for further prosecution should only be undertaken exceptionally, when special reasons apply.
7. In the present case, the appealed decision did not address the ground for opposition under Article 100(a) EPC in combination with Article 56 EPC. The examination of the compliance with the requirements of Article 56 EPC whether starting from D8 or from D4/D5 and combining their teaching with D8 would have required to consider new issues not discussed in the first instance proceedings. In particular, it would have had to be determined whether the polymers disclosed in D8 corresponded to latex acrylate polymers, more specifically latex acrylate polymers A or B, or not. Moreover the issue of generalisation of the results obtained in the examples of the patent to the entire scope of the claims would have needed to be discussed.
8. As recalled in Article 12(2) RPBA 2020, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner. This principle would not be respected in the present case if the Board were to conduct a complete examination of all the grounds of opposition. Consequently, under these circumstances, the Board considers that special reasons for remitting the case to the opposition division

exist. Therefore, the Board considers it appropriate to accede to the requests of both parties for a remittal (Article 111(1) EPC).

## Order

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

The decision under appeal is set aside.

The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



L. Stridde

A. Uselli

Decision electronically authenticated