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Datasheet for the decision of 6 June 2023

Case Number: T 0449/21 - 3.3.07

Application Number: 10792844.2

Publication Number: 2512425

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Language of the proceedings: EN

Title of invention:
CLEANSING COMPOSITION

Patent Proprietor:
Kao Germany GmbH

Opponent:
L'OREAL

Headword:
Cleansing composition/Kao Germany GmbH

Relevant legal provisions:
EPC Art. 56
RPBA 2020 Art. 12(4), 12(6)

Keyword:
Main request and auxiliary request 1 - Inventive step (No)
Auxiliary request 2 not admitted

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Case Number: T 0449/21 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 6 June 2023

Appellant: (Patent Proprietor)	Kao Germany GmbH Pfungstädter Strasse 92-100 64297 Darmstadt (DE)
Representative:	Grit, Mustafa Kao Germany GmbH Pfungstädterstrasse 92-100 64297 Darmstadt (DE)
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 29 March 2021 revoking European patent No. 2512425 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairwoman	Y. Podbielski
Members:	D. Boulois
	J. Molina de Alba

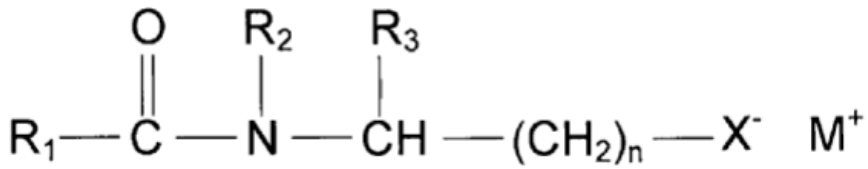
Summary of Facts and Submissions

I. The European patent No. 2 512 425 was opposed under Article 100(a) EPC on the grounds that the subject-matter of the granted patent lacked novelty and inventive step.

II. The appeal lies from the decision of the opposition division to revoke the patent. The decision was based on the main request and auxiliary request 1 filed with letter of 5 December 2019.

Claim 1 of the main request read, with modification to claim 1 as granted shown in bold:

"1. Aqueous cleansing composition for keratin fibres especially for human hair characterised in that it comprises at least one amino acid surfactant of the following structure



wherein R_1 is a saturated or unsaturated, straight or branched alkyl chain with 7 to 17 C atoms, R_2 is H or a methyl, R_3 is H, COO^-M^+, CH_2COO^-M or COOH, n is 0 to 2, X is COO^- or $SO_3^-$and M is independent from each other H, sodium or potassium, at least one sorbitan surfactant selected from sorbitan caprylate, sorbitan cocoate, sorbitan diisostearate, sorbitan dioleate,

sorbitan distearate, sorbitan isostearate, sorbitan laurate, sorbitan oleate, sorbitan olivate, sorbitan palmitate, sorbitan palmate, sorbitan sesquicaprylate, sorbitan sesquiisostearate, sorbitan sesquioleate, sorbitan sesquistearate, sorbitan stearate, PEG-20 sorbitan cocoate, PEG-40 sorbitan diisostearate, PEG-2 sorbitan isostearate, PEG-5 sorbitan isostearate, PEG-20 sorbitan isostearate, PEG-40 sorbitan laurate, PEG-10 sorbitan laurate, PEG-44 sorbitan laurate, PEG-75 sorbitan laurate, PEG-80 sorbitan laurate, PEG-3 sorbitan oleate, PEG-6 sorbitan oleate, PEG-20 sorbitan oleate, PEG-40 sorbitan oleate, PEG-80 sorbitan palmitate, PEG-3 sorbitan stearate, PEG-4 sorbitan stearate, PEG-6 sorbitan stearate, PEG-40 sorbitan stearate, PEG-60 sorbitan stearate, Polysorbate 20, Polysorbate 21, Polysorbate 40, Polysorbate 60, Polysorbate 61, Polysorbate 65, Polysorbate 80, Polysorbate 81, and Polysorbate 85 and at least one non-ionic surfactant according to the general formula

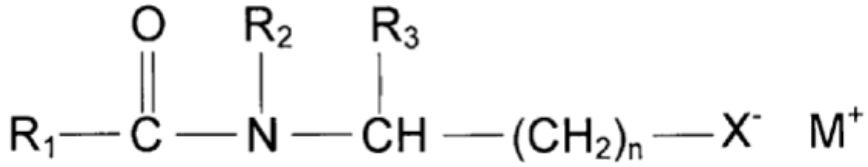
R_6-O-(R_4 O)$_n$-Z_x ,

wherein R6 is an alkyl group with 8 to 18 carbon atoms, R4 is an ethylene or propylene group, Z is a saccharide group with 5 to 6 carbon atoms, n is a number from 0 to 10 and x is a number between 1 and 5, wherein the weight ratio of amino acid surfactant to sorbitan surfactant is in the range of 10:1 to 1:10, **wherein the sorbitan surfactant is not Polysorbate 60, Polysorbate 20 or PEG-80 sorbitan laurate.**"

Claim 1 of auxiliary 1 read, with the difference with claim 1 as granted shown in bold:

"1. Aqueous cleansing composition for keratin fibres especially for human hair characterised in that it

comprises at least one amino acid surfactant of the following structure



wherein R_1 is a saturated or unsaturated, straight or branched alkyl chain with 7 to 17 C atoms, R_2 is H or a methyl, R_3 is H, COO^-M^+, CH_2COO^-M or COOH, n is 0 to 2, X is COO^- or $SO_3^-$and M is independent from each other H, sodium or potassium, at least one sorbitan surfactant selected from sorbitan caprylate, sorbitan cocoate, sorbitan diisostearate, sorbitan dioleate, sorbitan distearate, sorbitan isostearate, sorbitan laurate, sorbitan oleate, sorbitan olivate, sorbitan palmitate, sorbitan palmate, sorbitan sesquicaprylate, sorbitan sesquiisostearate, sorbitan sesquioleate, sorbitan sesquistearate, sorbitan stearate, PEG-20 sorbitan cocoate, PEG-40 sorbitan diisostearate, PEG-2 sorbitan isostearate, PEG-5 sorbitan isostearate, PEG-20 sorbitan isostearate, PEG-40 sorbitan laurate, PEG-10 sorbitan laurate, PEG-44 sorbitan laurate, PEG-75 sorbitan laurate, ~~**PEG-80 sorbitan laurate,**~~ PEG-3 sorbitan oleate, PEG-6 sorbitan oleate, PEG-20 sorbitan oleate, PEG-40 sorbitan oleate, PEG-80 sorbitan palmitate, PEG-3 sorbitan stearate, PEG-4 sorbitan stearate, PEG-6 sorbitan stearate, PEG-40 sorbitan stearate, PEG-60 sorbitan stearate, ~~**Polysorbate 20,**~~ Polysorbate 21, Polysorbate 40, ~~**Polysorbate 60,**~~ Polysorbate 61, Polysorbate 65, Polysorbate 80, Polysorbate 81, and Polysorbate 85 and at least one non-ionic surfactant according to the general formula

R_6-O-(R_4 O)$_n$-Z_x ,

wherein R_6 is an alkyl group with 8 to 18 carbon atoms, R_4 is an ethylene or propylene group, Z is a saccharide group with 5 to 6 carbon atoms, n is a number from 0 to 10 and x is a number between 1 and 5, wherein the weight ratio of amino acid surfactant to sorbitan surfactant is in the range of 10:1 to 1:10."

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

D1: US5683972
D4: EP453238 A1
D10: Novel Surfactants, edited by K. Holmberg (Institute for Surface Chemistry, Stockholm), 1999
D11: Comparative tests results filed on 14 May 2020
D12: Comparative tests filed on 13 May 2020
D13: Comparative tests filed on 21 January 2021

IV. According to the decision under appeal, the subject-matter of the main request was not open for an assessment under Article 84 EPC. The main request was novel.

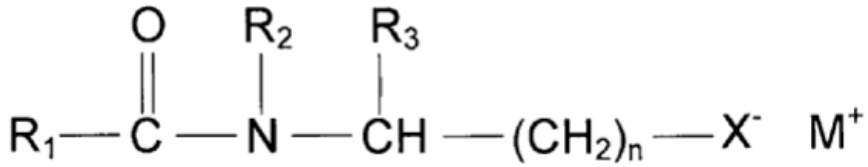
The opposition division considered D4, example 5, as the closest prior art. The claimed subject-matter differed in the presence of a non-ionic surfactant. The problem was the provision of alternative well foaming aqueous cleaning compositions. The claimed solution was obvious in view of the combined teaching of D4 and D1. This conclusion also applied to auxiliary request 1.

V. The patent proprietor (hereinafter the appellant) filed an appeal against the decision. With the statement

setting out the grounds of appeal dated 9 August 2021, the appellant submitted a main request and auxiliary request 1 corresponding to the requests filed during the opposition proceedings, and auxiliary request 2. The appellant also requested that the experiments D13 not be admitted into the appeal proceedings.

Claim 1 of auxiliary request 2 read, with the difference to claim 1 as granted shown in bold:

"1. Aqueous cleansing composition for keratin fibres especially for human hair characterised in that it comprises at least one amino acid surfactant of the following structure



wherein R_1 is a saturated or unsaturated, straight or branched alkyl chain with 7 to 17 C atoms, R_2 is H or a methyl, R_3 is H, COO^-M^+, CH_2COO^-M or COOH, n is 0 to 2, X is COO^- or $SO_3^-$and M is independent from each other H, sodium or potassium, **sorbitan sesquicaprylate**, and at least one non-ionic surfactant according to the general formula

R_6-O-$(R_4\ O)_n$-Z_x ,

wherein R_6 is an alkyl group with 8 to 18 carbon atoms, R_4 is an ethylene or propylene group, Z is a saccharide group with 5 to 6 carbon atoms, n is a number from 0 to 10 and x is a number between 1 and 5, wherein the

weight ratio of amino acid surfactant to sorbitan surfactant is in the range of 10:1 to 1:10."

VI. With a letter dated 22 December 2021, the opponent, L'Oréal (hereinafter the respondent), requested that auxiliary request 2 not be admitted into the appeal proceedings.

VII. A communication from the Board, dated 30 January 2023, was sent to the parties.

VIII. Oral proceedings took place on 6 June 2023.

IX. The arguments of the appellant may be summarised as follows:

Admission of D13 into the appeal proceedings

D13 was filed on the very last day set in the summons to the oral proceedings pursuant to Rule 116 EPC. During the oral proceedings, the opposition division decided to admit D13 and not to grant the request for postponement of the oral proceedings. It was thus not possible for the appellant to respond to D13.

Main request and auxiliary request 1 - Inventive step

D4 was the closest prior art in view of example 5. The difference between the composition of claim 1 of the main request and the composition of example 5 was the presence of a non-ionic saccharide surfactant. In view of D11, the composition according to claim 1 of the main request had an increased foam performance. D12, filed by the respondent, involved a manual subjective method of testing foam whereas D11 used an automatic one. It was questionable whether in D12 all foam had

been extracted and whether the presented results were reliable. D13, also filed by the respondent, showed that it was possible to use an automatic method, which further emphasised that the method of D12 was not reliable. Consequently, the objective technical problem over the closest state of the art was the provision of a cleansing composition with improved foam volume. The solution was not obvious in view of any of D1, D4 and D10.

The first auxiliary request had the same scope as the main request and therefore, the above arguments on inventive step were also valid for this request.

Auxiliary request 2 - Admission into the appeal proceedings

The limitation of the sorbitan surfactant in claim 1 to sorbitan sesquicaprylate did not change the scope of the discussion. The amendment fulfilled the requirements of Article 123(2) and (3) EPC, because sorbitan sequicaprilate was the most preferred sorbitan surfactant in the application as filed and in the granted patent. It was also singled out in the claims as filed and in the granted claims. Therefore, the limitation of auxiliary request 2 could not take the respondent by surprise.

X. The arguments of the respondent may be summarised as follows

Admission of D13 into the appeal proceedings

D13 had been filed in time and was part of the proceedings.

Main request and auxiliary request 1 - Inventive step

D4, example 5, was the closest state of the art. The tests submitted did not show an improvement over the entire range of claim 1, and cast doubt on this possibility. The technical problem was the provision of an alternative, and the solution proposed in claim 1 was obvious to those skilled in the art in view of D4 or D10, or even D1.

Auxiliary request 2 - Admission into the appeal proceedings

Auxiliary request 2 was not to be admitted in the proceedings because it had been filed late, i.e. at the appeal stage only. The request resulted from the incorporation of a sub-claim into claim 1 as granted. Therefore, it could have been filed in the first instance proceedings. In addition, claim 1 of the request lacked clarity and, depending on the interpretation adopted, the scope of the patent could have been extended, contrary to Article 123(3) EPC, or the subject-matter of claim 1 of the request could extend beyond the content of the application as filed, contrary to Article 123(2) EPC.

XI. Requests

The appellant (patent proprietor) requests that the decision under appeal be set aside and the patent be maintained in amended form according to the main request or one of auxiliary requests 1 and 2, all filed with the statement setting out the grounds of appeal. The appellant also requests that document D13 not be admitted into the appeal proceedings.

The respondent (opponent) requests that the appeal be dismissed and that auxiliary request 2 not be admitted into the appeal proceedings.

Reasons for the Decision

1. Admission of D13 into the appeal proceedings

1.1 D13 was filed by the opponent on the last day of the period under Rule 116 EPC during the opposition proceedings. It relates to experiments comparing the claimed invention versus compositions according to D1.

During the oral proceedings before the opposition division, the appellant objected to the admission of document D13. The appellant also requested to postpone the oral proceedings to study the tests in D13 and to provide alternative tests.

The opposition division decided to admit the experiments D13 into the opposition proceedings and not to postpone the oral proceedings.

1.2 D13 is cited in the decision of the opposition division in the context of the assessment of inventive step and the respondent has relied on D13 in the reply to the appeal. Accordingly, D13 forms part of the appeal proceedings under Article 12(2) RPBA 2020 and the Board has no discretion under Article 12(4) RPBA 2020 to exclude it from the proceedings. Furthermore, the Board's discretion not to admit evidence which should have been presented or was not admitted in the opposition proceedings under Article 12(6) RPBA 2020 does also not apply to this document.

The Board notes that there was no deficiency in the exercise of the discretion of the opposition division as it was based on the assessment of *prima facie* relevance.

1.3 Hence, the Board considers that document D13 forms part of the appeal proceedings according to Article 12(2) RPBA 2020.

2. Main request - Inventive step

2.1 The claimed invention relates to aqueous cleansing compositions for keratin fibers, comprising at least one amino acid surfactant, at least one sorbitan surfactant and at least one alkyl polyglycoside surfactant. Said compositions have excellent foam properties and excellent conditioning effects on human hair.

2.2 The opposition division considered D4 as the closest prior art in view of its example 5. The respondent also considered D1 as possible closest prior art.

2.2.1 D4 relates to shampoo compositions having adequate foaming properties and comprising anionic, amphoteric and non-ionic surfactants. The anionic surfactant can be an acyl sarcosinate, while the non-ionic surfactant is preferably an alkoxylated or a glycosidic non-ionic surfactant, such as a polysorbate or an alkyl polyglycoside (see D4, page 5, lines 47-52, and page 6, lines 2-5).

Example 5 of D4 discloses a composition comprising *inter alia* an amino acid surfactant, namely cocoyl sarcosinate, and a sorbitan surfactant, namely Tween

20, wherein the weight ratio of cocoyl sarcosinate to sorbitan surfactant is about 1.

Example 5

		%wt
Cocoyl sarcosinate		**6.3**
Cocoamidopropyl hydroxysultaine		**3.0**
TWEEN 20		**6.0**
Perfume, preservative, colour		**qs**
Water	**to**	**100**

The composition disclosed in example 5 does not comprise a non-ionic surfactant with a saccharide group, while polysorbate 20 (Tween 20) is excluded from the claimed subject-matter by the disclaimer present in claim 1.

2.2.2 D1 relates to skin cleansing compositions and discloses in example 3 a foaming emulsion comprising inter alia sodium lauryl sarcosinate 2 wt%, cetearyl glucoside 2 wt% and Polysorbate 60 1.25 wt %. Polysorbate 60 is not claimed anymore as sorbitan surfactant in claim 1 of auxiliary request 1.

2.2.3 Since D4 relates to hair compositions, while D1 relates to skin cleansing compositions, the Board concurs with the opposition division's choice of D4 as closest prior art, even if the disclosure of D1 presents more features in common with the claimed subject-matter.

2.3 The opposition division defined the objective technical problem as the provision of alternative well foaming aqueous cleansing compositions. The respondent concurred with this definition of the problem.

The appellant defined the problem as the provision of a cleansing composition with improved foam volume.

2.4 The parties submitted experiments D11, D12 and D13.

2.4.1 D11 was filed by the appellant, and provides a comparison between four compositions: a composition according to example 5 of D4 (Comparative 1) comprising cocoyl sarcosinate, cocoamidopropyl hydroxysultaine and Tween 20 (polysorbate 20) but no non-ionic saccharide surfactant; a second comparative composition (Comparative 2) comprising sorbitan sesquicaprylate instead of Tween 20, and without a non-ionic saccharide surfactant; and compositions Inventive 1 and 2 comprising cocoyl sarcosinate, cocoamidopropyl hydroxysultaine with sorbitan sesquicaprylate and decyl glucoside in different amounts as shown by the following Table.

	% by weight			
Ingredient	**Comparative 1**	**Comparative 2**	**Inventive 1**	**Inventive 2**
Cocoyl sarcosinate	6,3	6,3	6,3	6,3
Cocamidopropyl hydroxysultaine	3,0	3,0	3,0	3,0
Tween 20	6,0	-	-	-
Sorbitan sesquicaprylate	-	6,0	6,0	4,0
Decyl glucoside	-	-	2,0	2,0
Citric acid/ sodium hydroxide	q.s. to pH 5.0			
Water	Ad 100.0			

The foaming properties of the compositions were measured with a foam tester after 10 seconds of blending at 1000 rpm over 4 cycles. Each measurement was carried out five times. The results with the calculated standard deviations were as follows:

Comparative 1	408 ml (+/- 15)
Comparative 2	424 ml (+/- 17)
Inventive 1	532 ml (+/- 19)
Inventive 1	484 ml (+/- 17)

D11 shows that the presence of decyl glucoside produces an improvement in the foaming properties of the compositions Inventive 1 and 2 over the comparative examples.

In addition to this effect, the Board notes that the replacement of Tween 20 by sorbitan sesquicaprylate in Comparative 1 and 2 does not provide any significative effect in foam volume, considering the calculated standard deviation, i.e 408 ml (+/- 15) and 424 (+/-17). In view of these results, it appears that the sorbitan surfactants Tween 20 (polysorbate 20) and sorbitan sesquicaprylate have the same foaming effect on the compositions.

2.4.2 The experiments D12, filed by the respondent, provide two comparisons. First, a comparison between Composition A1, comprising cocoyl sarcosinate, polysorbate 21 and lauryl glucoside, and Composition B1, which is Composition A1 without lauryl glucoside. Second, a comparison between Composition A2, comprising cocoyl sarcosinate, sorbitan stearate and lauryl glucoside, with again the same composition without lauryl glucoside, namely Composition B2.

Essai #1 : sorbitan = Polysorbate 21

	Composition A1 selon EP2512425	Composition B1
Cocoyl sarcosinate (a)	6,3 ma	6,3 ma
Polysorbate 21 (Tween 21) (b)	4 ma	6 ma
Lauryl glucoside (c)	2 ma	-
Cocamidopropyl betaine	3 ma	3 ma
Water	Qs 100%	Qs 100%
Ratio amino acid/sorbitan	*1.575*	*1.05*

Essai #2 : sorbitan = sorbitan stearate

	Composition A2 selon EP2512425	Composition B2
Cocoyl sarcosinate (a)	6,3 ma	6,3 ma
Sorbitan stearate (b)	5 ma	6 ma
Lauryl glucoside (c)	1 ma	-
Cocamidopropyl betaine	3 ma	3 ma
Water	Qs 100%	Qs 100%
Ratio amino acid/sorbitan	*1.26*	*1.05*

A given weight of shampoo is blended at a certain speed and duration in a blender (speed 1 during 1 minute), and the foam formed is poured into a graduated cylinder. As shown by the pictures on pages 2 and 3 of D12, the compositions A1 and B1 generate a very close foam volume of about 500 ml, while the compositions A2 and B2 form also a similar foam volume of about 300 ml.

Hence, the experiments D12 show that the non-ionic saccharide surfactant lauryl glucoside does not provide an improvement in the foaming properties of the compositions according to claim 1.

With regard to D12, the Board does not agree with the appellant's argument that the experiments are not reliable due to the manual blending method and the simple measurement in a graduated cylinder. In D12, all the compositions were tested using the same methodology. The foam levels are clearly identifiable

on all pictures and they are undeniably very close between the inventive and the comparative compositions.

2.4.3 The experiments D13, filed by the respondent, provide a comparison between the composition of Example 3 of D1 (Composition A) and analogous compositions comprising a different sorbitan surfactant (Compositions B-D). In these experiments, the foam is generated automatically and standardised via a foamer equipped with a pumping system. The generated foam is then evaluated by image analysis and a percentage of foam abundance is then calculated. There was no significant difference with regard to the foaming properties of the different compositions. These experiments are however not relevant for a comparison with the disclosure of D4.

The experiments D13 were discussed by the appellant during the oral proceedings before the Board to illustrate that the methodology used by the respondent for measuring the generated foam in the experiments D12 could have been improved by an automatic measurement as used in D13, and that the experiments D12 were not reliable for this reason. The Board does not concur with this conclusion. Instead, the Board does not see any reason to doubt the validity of the comparison made in D12 between inventive compositions and comparative compositions. The Board notes that the appellant has chosen not to file any experiments in response to D12.

2.4.4 In view of the results shown in experiments D12, it appears that an extrapolation of the improvement shown in D11 to the whole claimed subject-matter is not possible. D12 shows that some compositions according to the invention, i.e. comprising a non-ionic saccharide surfactant, do not show any improvement in the foaming properties over compositions as disclosed in D4.

2.5 Consequently, the objective technical problem is as defined by the opposition division in its decision, namely the provision of an alternative well foaming aqueous cleansing composition.

2.6 The solution proposed in claim 1 is an aqueous cleansing composition comprising a non-ionic surfactant with a saccharide group and a sorbitan surfactant, wherein the sorbitan surfactant is selected from sorbitan caprylate, sorbitan cocoate, sorbitan diisostearate, sorbitan dioleate, sorbitan distearate, sorbitan isostearate, sorbitan laurate, sorbitan oleate, sorbitan olivate, sorbitan palmitate, sorbitan palmate, sorbitan sesquicaprylate, sorbitan sesquiisostearate, sorbitan sesquioleate, sorbitan sesquistearate, sorbitan stearate, PEG-20 sorbitan cocoate, PEG-40 sorbitan diisostearate, PEG-2 sorbitan isostearate, PEG-5 sorbitan isostearate, PEG-20 sorbitan isostearate, PEG-40 sorbitan laurate, PEG-10 sorbitan laurate, PEG-44 sorbitan laurate, PEG-75 sorbitan laurate, PEG-3 sorbitan oleate, PEG-6 sorbitan oleate, PEG-20 sorbitan oleate, PEG-40 sorbitan oleate, PEG-80 sorbitan palmitate, PEG-3 sorbitan stearate, PEG-4 sorbitan stearate, PEG-6 sorbitan stearate, PEG-40 sorbitan stearate, PEG-60 sorbitan stearate, Polysorbate 21, Polysorbate 40,Polysorbate 61, Polysorbate 65, Polysorbate 80, Polysorbate 81, and Polysorbate 85.

2.7 With regard to obviousness, the parties cited *inter alia* document D10.

D10 discloses on page 67 the good foaming properties of alkyl polyglycosides, and gives the examples of lauryl glucoside or decyl glucoside. It states in particular

that alkyl polyglycosides foam considerably better than fatty alcohol ethoxylates, with the foam volume increasing with increasing percentage of short carbon chains in the alkyl polyglycosides. The foaming properties of the alkyl polyglycosides is illustrated by Figure 32 of D10:

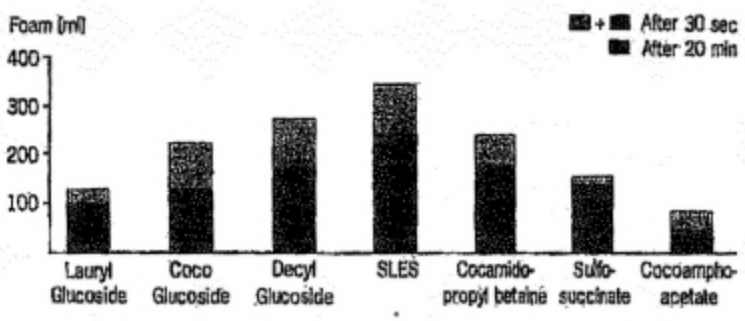


FIG. 32 Foaming properties of surfactants (1 g AS/L, 15°dH, 0.1 g/L sebum, perforated disc method DIN 53902) [6].

D10 further discloses that alkyl polyglycosides are very mild toward the skin and have a caring effect on damaged hair (see page 68, 2nd par.). Further positive actions on hair are disclosed on page 69 of D10, such as the absence of a significant reduction of wet combability and the provision of good hair volume and manageability. This makes alkyl polyglycosides the compounds of choice for a cleansing composition for keratin fibres.

Hence, in view of D10, the skilled person, looking for an alternative foaming composition, would routinely replace polysorbate 20 by polysorbate 80 and incorporate a non-ionic saccharide surfactant, such as decyl or lauryl glucoside, in the composition of example 5 of D4. In this way, the skilled person would arrive at a composition as defined in claim 1 without any inventive skill.

2.8 Consequently, the subject-matter of claim 1 is obvious and the main request does not meet the requirements of Article 56 EPC.

3. Auxiliary request 1 - Inventive step

In claim 1 of auxiliary request 1, the disclaimer "wherein the sorbitan surfactant is not Polysorbate 60, Polysorbate 20 or PEG-80 sorbitan laurate" has been removed and the corresponding sorbitan surfactants were suppressed from the claimed list of sorbitan surfactant. The scope of claim 1 of auxiliary request 1 is essentially the same as that of claim 1 of the main request, and the same conclusions regarding inventive step apply. Consequently, auxiliary request 1 does not meet the requirements of Article 56 EPC.

4. Auxiliary request 2 - Admission into the appeal proceedings

4.1 Auxiliary request 2 was filed by the appellant with the statement of grounds of appeal. Claim 1 results from the incorporation of claim 3 into claim 1 as granted so that the sorbitan surfactant is now limited to "sorbitan sesquicaprylate".

4.2 According to the appellant, this request was filed in the appeal proceedings because the opposition division changed its mind with regard to inventive step during the oral proceedings as compared to its preliminary opinion. The opposition division's change of mind surprised the appellant. According to the appellant, this request does not change the scope of the discussion and does not represent a surprise to any party to the proceedings because it is limited by a feature of the granted claims.

4.3 The admission of this request was objected to by the respondent, since it could have been filed earlier. Moreover, the respondent considered that the amendment of the request did not change the assessment of inventive step. In the written proceedings, the respondent had argued that the request raised issues with regard to Article 123(2) EPC and 123(3) EPC.

4.4 Auxiliary request 2 represents an amendment to the appellant's case within the meaning of Article 12(4) RPBA 2020. Furthermore, contrary to the appellant's contention, the request changes the scope of the discussion on inventive step which would need to focus on one specific sorbitan surfactant comprised in the claimed composition. Any such amendment may be admitted only at the discretion of the Board, which must exercise its discretion in view of, *inter alia*, the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy (Article 12(4) RPBA 2020).

In claim 1 of auxiliary request 2, the list of sorbitan surfactants of claim 1 as granted has been limited to sorbitan sesquicaprilate, and the weight ratios of amino acid surfactant to sorbitan surfactant disclosed in granted claim 1 for the whole list of sorbitan surfactants now relate to sorbitan sesquicaprilate only. This amendment raises concerns about the allowability of auxiliary request 2 under Article 123(3) EPC and thus requires a debate on this issue. At the same time, it is questionable whether the amendment made to claim 1 of auxiliary request 2 has an effect on the assessment of inventive step, in particular in view

of the experiments D11, which show that sorbitan sesquicaprylate and Tween 20 have an equivalent effect.

Hence, none of the criteria of admissibility, i.e the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy, speak in favour of admitting auxiliary request 2.

4.5 Moreover, the request was filed to overcome inventive-step objections that were present since the beginning of the opposition proceedings. Therefore, it should have been filed in the opposition proceedings (Article 12(6) RPBA 2020). With its letter of 14 May 2020, the appellant filed comparative experiments D11 and requested the possibility to file further auxiliary requests during the oral proceedings before the opposition division. The auxiliary requests would be directed to the preferred embodiments that the patent underlines with one or more of the dependent claims. Said preferred embodiments in the patent are precisely compositions comprising sorbitan sesquicaprylate, which was the subject-matter of dependent claim 3 as granted, and which was present in all examples of the patent and in the comparative experiments D11. Thus, the appellant had the opportunity to file auxiliary request 2 together with the experiments D11, or, at the latest, during the oral proceedings before the opposition division.

The change of the opinion of the opposition division regarding inventive step during oral proceedings cannot as such constitute a reason to file a new request only in the appeal proceedings, since such a change belongs to the normal course of the proceedings.

4.6 Consequently, auxiliary request 2 is not admitted into the appeal proceedings (Article 12(4) and 12(6) RPBA 2020).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairwoman:

B. Atienza Vivancos Y. Podbielski

Decision electronically authenticated