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Datasheet for the decision of 21 November 2023

Case Number: T 0711/21 - 3.3.09

Application Number: 14712357.4

Publication Number: 2964336

IPC: A61Q19/00, A61K8/11, A61K8/81

Language of the proceedings: EN

Title of invention:
COLOUR CHANGING COMPOSITION IN EMULSION FORM COMPRISING A PARTIALLY NEUTRALIZED, CROSSLINKED ACRYLIC HOMOPOLYMER OR COPOLYMER

Patent Proprietor:
L'OREAL

Opponent:
Beiersdorf AG

Headword:
Colour changing composition/L'ORÉAL

Relevant legal provisions:
RPBA 2020 Art. 12(2), 12(4), 13(2)
EPC Art. 56

Keyword:
New case presented after the Board had issued its communication under Article 15(1) RPBA, the new case essentially amounting to a new statement setting out the grounds of appeal: admission - (no)
Main request: inventive step - (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0711/21 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 21 November 2023

Appellant: (Opponent)	Beiersdorf AG Unnastrasse 48 20253 Hamburg (DE)
Representative:	Beiersdorf AG Beiersdorf AG Patentabteilung Unnastraße 48 20245 Hamburg (DE)
Respondent: (Patent Proprietor)	L'OREAL 14 rue Royale 75008 Paris (FR)
Representative:	Cabinet Nony 11 rue Saint-Georges 75009 Paris (FR)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 22 March 2021 concerning maintenance of the European Patent No. 2964336 in amended form.**

Composition of the Board:

Chairman	A. Haderlein
Members:	A. Veronese
	F. Blumer

Summary of Facts and Submissions

I. The appeal was filed by the opponent (appellant) against the opposition division's decision finding that the European patent as amended according to auxiliary request 2, filed by letter of 7 July 2020, meets the requirements of the EPC.

II. Claim 1 of auxiliary request 2 reads:

"*1. Changing colour composition for caring for and/or making up keratin materials on the form of an emulsion comprising, at least:*

a) microcapsules containing releasable colorant(s), said microcapsules comprising:

- *a core comprising one organic material,*

- *at least one layered coating surrounding said core, the layered coating comprising at least one polymer, at least one colorant, and advantageously at least one lipid-based material,*

b) at least partially neutralized, crosslinked acrylic homopolymers or copolymers, in a non-particulate form that is a partially neutralized, crosslinked sodium polyacrylate in an inverse emulsion comprising at least one fatty acid ester."

III. In its notice of opposition, the opponent had requested revocation of the patent in its entirety *inter alia* on the ground under Article 100(a) EPC (lack of inventive step).

IV. The documents submitted during the opposition proceedings included:

D1: WO 2009/138978 A2
D3: DE 103 55 716 A1

V. In its decision, the opposition division found that the subject-matter of auxiliary request 2 involved an inventive step in relation to the prior art, arguing essentially that:

- The composition of example 2 of D1 was the closest prior art.

- The claimed composition differed from that of D1 in that the polyacrylate polymer was cross-linked, was not in a particulate form and was in an inverse emulsion comprising at least one fatty acid ester.

- The polymer stabilised the microcapsules in the compositions. The problem was the provision of a changing colour composition having improved microcapsule stability.

- None of the cited documents would have prompted the skilled person confronted with this problem to identify the claimed solution.

VI. In point 3. of its statement setting out its grounds of appeal the appellant mentioned three new documents.

VII. In its submissions of 18 October 2023, after having received the communication issued by the board in preparation for the oral proceedings, the appellant raised a new inventive step attack and filed the following documents:

D5: US 6,197,283 B1

D6: US 6,444,785 B1

D7: Datasheet relating to Carbopol® 5984

D8: Hunnius Pharmazeutisches Wörterbuch, 1993, page 1123-1124, Polyacrylsäure

D9: Ullmann's Encyclopedia of Industrial Chemistry, 2003, Vol. 13, pages 7-8, "Phospholipids"

VIII. Insofar as relevant to the decision, the appellant's arguments can be summarised as follows:

- D1 and D3, referred to in the statement setting out the grounds of appeal, were the documents referred to in the decision under appeal. The documents in point 3. of that statement were erroneously cited. The appeal addressed the decision under appeal and was admissible.

- The inventive step attack set out in the submissions of 18 October 2023, which was based on example 5 of D1 and was further supported by D5 to D9, had to be admitted. This attack addressed the opposition division's decision and was in response to the respondent's reply to the statement setting out the grounds of appeal and to the board's preliminary opinion.

- The claimed invention lacked an inventive step starting from example 1 of D1 in combination with the teaching of D3. Furthermore, it lacked an inventive step in relation to example 5 of D1.

IX. Insofar as relevant to the decision, the arguments presented by the proprietor (respondent) may be

summarised as follows:

- The documents mentioned in point 3. of the statement of grounds of appeal were not pertinent to the case. The appeal did not address the decision and should thus be rejected as inadmissible.

- The new inventive step objection raised with the submissions of 18 October 2023, as well as D5 to D9, were not to be admitted.

- The claimed invention involved an inventive step starting from either example 1 or example 5 of D1 as the closest prior art.

Requests

X. The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

XI. The respondent requested that the appeal be rejected as inadmissible or be dismissed or, in the alternative, that the patent be maintained according to one of auxiliary requests 1 to 8 as filed with the reply to the statement setting out the grounds of appeal.

Reasons for the Decision

1. *Admissibility of the appeal*

1.1 The respondent argued that the statement setting out the grounds of appeal did not refer to the documents cited during the opposition proceedings and that the

appeal did not address the decision of the opposition division. For this reason, the appeal was inadmissible.

1.2 This argument is not convincing. From a careful reading of the reasoning on pages 3 and 4 of the statement setting out the grounds of appeal, it is evident that the documents referred to as D1 and D3 are those mentioned in the decision under appeal, and not those which are mentioned in point 3. of that statement. Thus, the appeal addresses the opposition division's decision, referring to the relevant facts and evidence. Hence, it is admissible.

2. *Admission of a new inventive step attack and of D5 to D9 substantiating that attack*

2.1 In its submissions dated 18 October 2023, the appellant raised a new inventive step objection starting from example 5 of D1 as closest prior art. It further referred to D5 to D9 to substantiate this attack.

2.2 The board agrees with the respondent that this attack, as well as D5 to D9, should not be admitted into the appeal proceedings. In order to understand the reasons for this conclusion, it is useful, first, to outline how the inventive step discussion developed during the proceedings.

2.3 In the statement setting out the grounds of appeal, the appellant formulated its inventive step objection starting from example 1 of D1 as the closest prior art.

2.4 Example 1 of D1 describes the preparation of microcapsules comprising pigments which can be used in color changing compositions. The appellant argued that example 1 disclosed microcapsules as in claim 1,

dispersed in an emulsion comprising polyvinyl alcohol (PVA). Since both PVA and polyacrylates were known thickening agents, the skilled person would have considered replacing PVA with a polyacrylate polymer. Doing so would have led to the claimed composition in an obvious manner. The requirement that an inverse emulsion was present as a fraction of the changing colour emulsion of claim 1 made no technical sense and had to be disregarded.

2.5 This objection was rebutted by the respondent in its reply to the statement setting out the grounds of appeal. The respondent submitted, *inter alia*, that example 1 of D1 did not disclose any of: microcapsules as defined in claim 1, microcapsules dispersed in an emulsion and a polyacrylate polymer dispersed in an inverse emulsion. As shown in the patent, the polyacrylate stabilised the microcapsules of the invention within a changing colour composition. Starting from example 1 and confronted with the problem of stabilising the microcapsules, the skilled person would never have arrived at the claimed solution.

2.6 In the preliminary opinion issued in preparation for the oral proceedings, the board agreed with the respondent that the claimed composition differed from that of example 1 at least in that it comprised a sodium polyacrylate dispersed in an emulsion surrounding the microcapsules and that this stabilised the microcapsules against rupture. Moreover, the board agreed that the cited documents did not prompt the skilled person confronted with the problem of stabilising the microcapsules to replace the PVA with a polyacrylate. It also considered that there was no evidence that an inverse emulsion containing the

acrylic polymer could not be present within the claimed changing colour emulsified composition.

2.7 In its submissions dated 18 October 2023, more than six months after receiving the preliminary opinion from the board and more than two and a half years after the time limit for filing the grounds of appeal under Article 108 EPC, the appellant raised a new inventive step objection referring to example 5 of D1 as starting point. It submitted that example 5 disclosed an aftershave emulsion comprising both microcapsules and Carbopol 5984, a polyacrylate according to claim 1. Furthermore, it filed D5 to D9 arguing *inter alia* that:

- D5 and D6 showed that the claimed "inverse emulsion" would have been destroyed upon mixing with the other ingredients of the claimed emulsion

- D7 showed that Carbopol 5984 was a crosslinked polyacrylate polymer according to claim 1

- D8 showed that this polymer was soluble and could not be present in particulate form

- D9 showed that phospholipids were surfactant agents

2.8 Starting from the composition of example 5, and taking into account the teaching of these documents, the appellant developed a new inventive step attack.

2.9 While conceding that the attack was late, the appellant argued that it addressed the respondent's argument that example 1 did not disclose an emulsion comprising the microcapsules and a polyacrylate in non-particulate form. The appellant further argued that the attack addressed the board's preliminary opinion that there

was no evidence that the claimed inverse emulsion could not be present within the claimed changing colour emulsion.

2.10 Moreover, it is noted that, in the opposition division's decision, example 2 of D1 was used as the starting point. This disclosed, like example 5, a changing colour emulsion comprising the microcapsules of example 1. It was therefore justified, in order to address the decision under appeal and the arguments presented by the respondent and the board, to formulate a new inventive step objection starting from example 5 of D1. The new attack was a further development and a refinement of the appellant's party case.

2.11 These arguments are not persuasive.

2.12 From reading D1, it is readily apparent that examples 1 and 5 relate to substantially different objects. Example 1 describes a method for preparing microcapsules comprising a core and one or more layers including a colorant. All following examples, including examples 2 and 5, describe changing colour skin- and hair-care compositions which comprise those microcapsules. In other words, the teaching of example 1 is limited to how the microcapsules can be prepared, whereas the following examples teach how they can be incorporated into changing colour compositions.

2.13 It is reasonable to imagine that, after being confronted with the respondent's arguments and the board's preliminary opinion that the attack starting from example 1 was most likely going to fail, the appellant realised that an attack starting from example 5 might have a greater chance of success.

2.14 However, this new attack is not just a refinement or further development of the case presented in the statement setting out the grounds of appeal, it *de facto* creates a completely fresh case. This is irrespective of the fact that example 2 was considered as a starting point in the decision under appeal.

2.15 It is noted that the point of reference here for assessing whether the case has been amended within the meaning of Article 13(2) RPBA 2020 is the statement setting out the grounds of appeal: see Case Law of the Boards of Appeal of the EPO, 10th Edition, 2020, V.A. 4.2. It is further noted that example 5 was never mentioned during the proceedings before the opposition division.

2.16 The submissions of 18 October 2023 appear actually to be a new self-contained statement setting out the grounds of appeal. There were no exceptional circumstances justified with cogent reasons for presenting a new case at this late stage of the proceedings. The appeal proceedings do not provide the parties with a forum for creating a completely new case when it becomes apparent that the board is not convinced by their originally presented case.

2.17 For these reasons, it is concluded that the inventive step attack formulated starting from example 5 of D1, together with D5 to D9, is not admitted into the appeal proceedings (Article 13(2) RPBA).

3. *Inventive step*

3.1 The claimed invention relates to a changing colour composition for caring and/or making up keratin materials, such as the skin, comprising microcapsules

loaded with a colorant. The microcapsules are comprised in an emulsion. They should be stable upon storage and handling, but should rupture when they are rubbed or pressed onto the skin. A polyacrylate polymer is also included in the emulsion: paragraphs [0001], [0002], [0006], [0011], [0012] and claim 1.

Closest prior art

3.2 In its statement setting out the grounds of appeal, the appellant considered example 1 of D1 as the starting point for assessing inventive step.

3.3 D1 relates to compositions for changing the colour of keratin materials, such as the skin or hair. The compositions comprise colorant-containing microcapsules which rupture upon application to the skin.

3.4 However, as already explained above, example 1 of D1 only describes the preparation of the microcapsules used in the compositions described in D1. The only section of D1 mentioned by the appellant in its statement of grounds of appeal (page 23, last paragraph of D1) describes some steps for preparing a first layer of the microcapsules. No mention is made of an emulsion comprising the microcapsules or of the polyacrylate polymer specified in claim 1.

3.5 During the oral proceedings, the appellant also referred to page 24, which describes some additional steps carried out to prepare the microcapsules. However, these steps do not result in a changing colour composition comprising the microcapsules and the claimed polyacrylate within an emulsion either.

Distinguishing features

3.6 If the iron oxide pigments contained in the microcapsules of example 1 were considered to be their "core", then the microcapsules would not be according to claim 1, because they would not contain a "core comprising one organic material", see page 23 of D1.

3.7 Alternatively, if the microcapsules comprising the first organic Eudragit layer were considered a "core", and the second layer comprising Eudragit and titanium dioxide (a colorant) were considered a layered coating in the sense of claim 1, then the microcapsules would not be in an emulsion. These microcapsules are in fact obtained upon sedimentation from an aqueous solution containing PVA, after the organic ethyl acetate phase has been removed, see page 24, lines 14 to 21. As noted by the respondent, insofar as microcapsules are formed, they are dispersed in a suspension, and not in an emulsion. It is true that the suspension of what is considered the "core" in this alternative is first "emulsified" in the aqueous solution containing PVA (see page 24, line 17). However, at this point in time, the layered coating within the meaning of claim 1 has not yet formed.

3.8 In both cases, example 1 does not disclose a composition in the form of an emulsion which comprises, as specified in point b) of claim 1:

"*a partially neutralised, crosslinked sodium polyacrylate in an inverse emulsion comprising at least one fatty acid ester*".

3.9 The appellant argued that it would be impossible to preserve an "inverse emulsion", i.e. a water in oil

emulsion within the emulsion making up the claimed changing colour composition. In its opinion, the oil phase of the inverse water in oil emulsion would fuse with the oil phase of the oil in water emulsion. For example, the inverse emulsion "Luvigel" included in the oil in water emulsion of examples 1 and 2 of the patent would not preserve its "inverse emulsion" state. Hence, in its opinion, the requirement that the polyacrylate be contained in an inverse emulsion should not to be taken into account as a distinguishing feature.

3.10 These arguments are not persuasive. Even assuming that the aforementioned oil phases would fuse together, the neutralised crosslinked acrylic polymer would still remain dispersed in the emulsion of the changing colour composition in which the microcapsules are dispersed.

3.11 As noted by the respondent, it is clear from claim 1 that the partially neutralised crosslinked sodium polyacrylate defined in point b) is dispersed in the emulsion surrounding the microcapsules and not in the microcapsules themselves. Thus, the claimed composition differs from that of example 1 of D1 at least in that it comprises a partially neutralised, crosslinked sodium polyacrylate in the emulsion phase surrounding the microcapsules.

Technical effect

3.12 The results of the tests shown in paragraph [0346] of the patent show that the colorant-loaded microcapsules dispersed in emulsions including crosslinked sodium polyacrylate (examples 1 and 2) are more resistant to rupture than those dispersed in emulsions not comprising polyacrylate or possibly comprising a negligible amount of a "Carbomer" polyacrylate

(comparative example C).

3.13 The appellant submitted that the examples in the patent did not compare the claimed compositions with those of D1, and that the comparative composition was merely a "placebo". This argument fails to convince because example 1 of D1, the only one used by the appellant for its inventive step attack, discloses nothing more than the preparation of microparticles. A comparison with the compositions of this example would therefore not make any technical sense.

Underlying problem

3.14 Taking account of the aforementioned effect, the underlying problem is the provision of a changing colour composition for keratin materials, comprising microcapsules loaded with a colorant, wherein the microcapsules are stable and do not have tendency to rupture before application.

Non-obviousness of the claimed solution

3.15 According to the appellant, the claimed solution is obvious in view of a combination of D1 and D3. In its opinion, D3 would have prompted the skilled person to replace the PVA used to prepare the microcapsules of example 1 of D1 with the relevant polyacrylate polymer. This is because D3 disclosed the use of both PVA and polyacrylate polymers as thickener for stabilising cosmetic compositions. It was obvious to use a polyacrylate as an alternative to PVA.

3.16 This argument is not persuasive. D1 discloses compositions comprising colour-loaded microcapsules, but does not address the problem of their rupturing and

any possible means for stabilising them. D3 does not even mention colour-loaded microcapsules.

3.17 It should also be noted that the underlying problem is not that of stabilising an emulsion as such, but rather that of stabilising microcapsules dispersed in an emulsion. D1 and D3 do not mention this effect. Hence, when confronted with the underlying technical problem, the skilled person would not have found any suggestion in the cited prior art to prepare a changing colour composition in the form of an emulsion, as defined in claim 1, comprising dispersed microcapsules and a polyacrylate polymer.

3.18 Finally, even if the skilled person had decided to replace the PVA with a polyacrylate during the process of example 1 of D1, the polyacrylate would have been included in the microcapsule or in the suspension containing them, not in an emulsion. Accordingly, even if they had done this, the skilled person would not have ended up with the claimed composition.

3.19 For these reasons, it is concluded that the composition defined in claim 1 and in the following claims, which are narrower in scope, involves an inventive step.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

K. Götz-Wein A. Haderlein

Decision electronically authenticated