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**Datasheet for the decision
of 9 February 2024**

Case Number: T 1332/21 - 3.3.10

Application Number: 13747818.6

Publication Number: 2879656

IPC: A61K8/46, A61K8/44, A61K8/31,
A61Q5/10, A61K8/92

Language of the proceedings: EN

Title of invention:

DYE COMPOSITION IN CREAM FORM COMPRISING AT LEAST ONE OIL AND
LITTLE OR NO SOLID FATTY ALCOHOL, DYEING PROCESS AND SUITABLE
DEVICE

Patent Proprietor:

L'OREAL

Opponent:

Kao Germany GmbH

Headword:

Relevant legal provisions:

EPC Art. 123(2), 54, 56
EPC R. 116
RPBA 2020 Art. 12(1)(a)

Keyword:

Basis of proceedings - decision under appeal

Amendments - allowable (yes)

Novelty - (yes)

Inventive step - (yes) - unexpected improvement shown

Decisions cited:

G 0007/93

Catchword:



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Case Number: T 1332/21 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 9 February 2024

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
24 June 2021 concerning maintenance of the
European Patent No. 2879656 in amended form.**

Composition of the Board:

Chairwoman R. Pérez Carlón
Members: M. Kollmannsberger
F. Blumer

Summary of Facts and Submissions

- I. The patent proprietor as well as the opponent appealed the Opposition Division's interlocutory decision that the disputed patent may be maintained in amended form based on the patent proprietor's second auxiliary request, Article 101(3)(a) EPC.
- II. The following documents are referred to in this decision:
- D1: EP 2 198 842 A2
 - D2: US 2010/186177 A1
 - D4: Comparative tests submitted by the patent proprietor during examination, 18 September 2015
 - D5: Comparative tests submitted by the opponent during opposition, 3 March 2021
 - D6: Comparative tests submitted by the patent proprietor during opposition, 3 March 2021
- III. The patent had been opposed under Article 100(a) EPC for lack of novelty and lack of inventive step, Articles 54 and 56 EPC.

The Opposition Division decided that the compositions defined in the independent claims of the patent as granted were novel, but lacked an inventive step starting from D1 as closest prior art (or D2, which is a US family member of D1). The same held for claim 1 of auxiliary request 1. On the other hand, the claims of auxiliary request 2 fulfilled the requirements of the

EPC, in particular with respect to Articles 123(2), 54 and 56.

IV. Claim 1 of auxiliary request 2 maintained by the Opposition Division reads as follows:

"Composition for dyeing human keratin fibres, which is free of oxidizing agent other than atmospheric oxygen and which is in cream form, comprising:

(a) at least one oxidation dye precursor selected from oxidation bases and couplers;

(b) at least one ionic surfactant chosen from anionic surfactants of alkyl sulfate or alkyl ether sulfate type;

(c) at least one oil;

(d) optionally at least one solid fatty alcohol at room temperature (25°C), 760 mmHg, wherein if it is present, it is present in a content of not more than 0.5% by weight relative to the weight of the composition;

(e) at least one thickening polymer,

wherein the concentration of oil(s) is at least 25% by weight, and up to 70% by weight relative to the total weight of the composition;

wherein the oxidation bases are chosen from para-phenylenediamines, bis(phenyl)alkylenediamines, para-aminophenols, ortho-aminophenols and the addition salts thereof

wherein the content of ionic surfactant(s) ranges from 0,5 to 10 % by weight relative to the total weight of the composition."

- V. According to the opponent's submissions in appeal proceedings this auxiliary request 2, filed during oral proceedings before the Opposition Division, should not have been admitted into the opposition procedure. Moreover, claim 1 of this request contained unallowable amendments, Article 123(2) EPC, and the claimed compositions were neither novel nor inventive over the disclosure of D2.
- VI. According to the patent proprietor's submissions during the written part of the appeal proceedings the granted patent fulfilled the requirements of novelty and inventive step, and even more so the auxiliary requests on file. Auxiliary request 2, based on which the patent was maintained, was rightly admitted into the procedure by the Opposition Division and did not contain unallowable amendments under Article 123(2) EPC.
- VII. Oral proceedings took place on 9 February 2024 at the request of both parties. The Board had issued a preparative communication under Article 15(1) RPBA dated 25 September 2023.
- VIII. During oral proceedings the patent proprietor defended, as its main request, the patent in the form of auxiliary request 2 as amended before the Opposition Division.

Thus, the final requests of the parties were the following:

The patent proprietor requested the patent to be maintained on the basis of auxiliary request 2 underlying the impugned decision, i. e. in the form it was maintained by the Opposition Division, or on the basis of auxiliary request 3, filed on 21 March 2022 together with the reply to the opponent's grounds of appeal.

The opponent requested the impugned decision to be set aside and the patent to be revoked.

IX. At the end of the oral proceedings the Board's decision was announced.

Reasons for the Decision

1. The appeal is admissible.
2. The patent proprietor's main request is to maintain the patent in amended form based on the claims and description submitted during opposition as auxiliary request 2, i. e. to confirm the decision of the Opposition Division. Although being the patent proprietor's main request in this decision it will be referred to as *auxiliary request 2*, for reasons of consistency.
3. Admission of auxiliary request 2 into opposition proceedings

- 3.1 The opponent argued that auxiliary request 2, filed during oral proceedings before the Opposition Division, should not have been admitted into opposition proceedings due to its late filing. The opponent's arguments with respect to inventive step had not changed and there was no reason to file this request only at the day of oral proceedings.
- 3.2 The admission of amended claims during oral proceedings is at the discretion of the Opposition Division. This is apparent from Rule 116(2) EPC referring to the last two sentences of Rule 116(1) EPC. This sentences state that such amendments "*need not be considered*". Some criteria for the use of this discretion by the Opposition Division are listed in the Guidelines for Examination, E-III, 8.6 (Version March 2021, in force at the time of the oral proceedings). These criteria include i. a. *prima facie* allowability and procedural expediency.
- 3.3 A board of appeal should only overrule the way in which a department of first instance has exercised its discretion when deciding on a particular case if it concludes that it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way, and has thus exceeded the proper limits of its discretion, see G 7/93, OJ 1994, 775, point 2.6 of the Reasons.
- 3.4 The Opposition Division reasoned the admittance of this request in its decision, point II.5.4, arguing that the request appeared *prima facie* allowable. Moreover, the filing of the request, which replaced a previously present second auxiliary request, was a convergent limitation of claimed subject-matter and a reply to the events during oral proceedings.

There was thus no misuse of discretion by the Opposition Division. The Opposition Division decided to admit the request based on relevant criteria in a reasonable way.

3.5 The Board thus sees no reason to overrule the Opposition Division's decision to admit this request into the proceedings. In view of Article 12(1) RPBA this request is part of the appeal proceedings.

4. Amendments, Article 123(2) EPC

4.1 Claim 1 of auxiliary request 2 contains i. a. the following two features, introduced during examination or opposition proceedings:

wherein the concentration of oil(s) is at least 25% by weight, and up to 70% by weight relative to the total weight of the composition

and

wherein the content of ionic surfactant(s) ranges from 0.5 to 10 % by weight relative to the total weight of the composition.

4.2 It was undisputed that the features as such are taken from the original description. The concentration of oils is disclosed on page 18, lines 24-28. The concentration of ionic surfactants is disclosed on page 13, lines 6-9.

4.3 The opponent argued, however, that these features had not been disclosed in combination. None of the original

composition claims 1-16 mentioned these concentration ranges. To arrive at claim 1 of the auxiliary request a two-fold selection would have to be made, thus creating subject-matter that would be novel over the original disclosure. The additional restriction of the ionic surfactants to the two types defined in the claim and of the oxidation bases added further originally undisclosed combinations.

- 4.4 The Board cannot agree. Original claim 1 of the patent application required the presence of ionic surfactants in the hair dyeing compositions as feature (b) and the presence of oil(s) as feature (c). Defining the concentrations of these components according to preferred values in the description does not add any originally undisclosed subject-matter. Also the other objected features are restricted towards their preferred meanings. The nature of the anionic surfactants is defined according to original claim 7 and the oxidation bases are defined according to original claim 2, with one deletion. Whether the original disclosure of these preferred meanings is in the claims or only in the description is not decisive as such; the decisive issue is whether the subject-matter of the amended claim can be directly and unambiguously derived from the original disclosure.

Restricting components of a generically defined composition to more specific definitions which the original disclosure presents as being preferred generally does not result in originally undisclosed subject-matter. Even if one considers such amendments as selecting individual values from generic features, as the opponent put forward, these selections were already made in the original disclosure and cannot add anything going beyond it.

- 4.5 Thus the conclusion drawn in point 5.3 of the Opposition Division's decision is correct. The amended claims of auxiliary request 2 comply with the requirements of Article 123(2) EPC.
5. Novelty (Article 54 EPC)
- 5.1 The Opposition Division had acknowledged novelty over D2 for claim 1 of the granted patent, see point 2 of the reasoning in the impugned decision.
- 5.2 In the Board's view the Opposition Division's conclusion on novelty is correct and applies even more to the claims of auxiliary request 2, for the reasons set out in the following.
- 5.2.1 The opponent pointed to example 2 of D2. However, claim 1 of auxiliary request 2 differs from example 2 of D1 at least in feature (d) requiring specific ionic surfactants. The composition of example 2 of D1 contains only non-ionic surfactants. It is correct that, as stressed by the opponent and described in paragraphs [0105] and [0106] of D2, the compositions of D2 may contain either non-ionic or anionic surfactants. However, the composition of example 2 contains a non-ionic surfactant and is thus not novelty destroying.
- 5.2.2 The opponent argued that the disclosure of D2 should not be limited to its examples. In particular, the opponent has pointed to a combination of claims 1, 4, 11 and 14 of D2, together with the definition of the surfactants in paragraph [0105]. However, claim 1 of D2 does not specify any of the ingredients required in claim 1 of auxiliary request 2. These ingredients have

to be assembled from dependent claims or the description, without any pointer into this direction, let alone an example composition combining all of them. Thus, while it is possible within the teaching of D2 to arrive at a composition as defined in claim 1 of auxiliary request 2, in view of the selections that need to be made and that are not foreshadowed in D2 this does not amount to a direct and unambiguous disclosure of such a composition.

5.3 The composition defined in claim 1 of auxiliary request 2 is thus novel over D2. No other novelty objections have been raised.

6. Inventive step (Article 56 EPC)

6.1 The patent under dispute deals with hair dyeing compositions. According to paragraph [0014] of the description the use of the claimed hair dyeing compositions leads to good dyeing properties, in particular with respect to colour strength, resistance to external agents and homogeneity.

6.2 Closest prior art

It is undisputed that the compositions of D2 (or D1, with substantially the same disclosure in French) represent the closest prior art for the subject matter of claim 1 of auxiliary request 2. D2 likewise relates to hair dyeing compositions. The compositions and processes disclosed in D2 are said to lead to a particular homogeneous coloration of the hair, see paragraph [0009] or paragraph [0336] referring to the results obtained with the example compositions.

- 6.3 Difference of the claimed subject-matter with respect to the closest prior art

The compositions defined in claim 1 of auxiliary request 2 differ from the structurally closest disclosure of D2, example 2, at least in that specific anionic surfactants are used instead of, or in addition to, the non-ionic surfactants used there. This was likewise undisputed.

- 6.4 Objective technical problem and its solution

- 6.4.1 The parties disagreed on which objective technical problem is solved by the compositions defined in claim 1 of auxiliary request 2.

- 6.4.2 The patent proprietor argued that the claimed compositions provided for more homogeneous colouring. Thus, the technical problem to be solved starting from D2 was the provision of hair dyeing compositions leading to a hair colouring with improved homogeneity. This problem was solved by the hair dyeing compositions as defined in the claims, which are characterized by the presence of the anionic surfactants selected from alkyl sulfates or alkyl ether sulfates.

In order to prove this effect the patent proprietor relied in particular on the test reports D4 and D6.

- 6.4.3 The opponent, on the other hand, argued that such an improvement did not exist, or at least did not extend to the whole of the claimed subject-matter. The opponent pointed to the test report D5.

- 6.4.4 The Board follows the patent proprietor's view for the reasons set out in the following:

D6 investigates the effect of replacing a small part of non-ionic tensoactive Oleth-10 by sodium lauryl sulfate, an alkyl sulfate surfactant according to the claim, in a composition according to example 2 of D2. The composition comprising sodium lauryl sulfate leads to a more homogeneous coloration of the hair. D4 shows that the addition of sodium laureth sulfate, an alkyl ether sulfate surfactant according to the claim, to a composition containing only non-ionic surfactants also leads to such an effect.

It is correct that in D5, using a similar test protocol, no effect is observed. However, the oxidation base used in D5, a substituted aminopyrazole, is not according to the claim. Thus, D5 shows that the effect relied on by the patent proprietor may not be achieved if the oxidation bases contained in the hair dyeing composition are not according to the claim. However D5 can throw no doubts on the validity of the results obtained in D4 and D6 for compositions containing oxidation dye precursors according to the claim.

6.4.5 The opponent's further arguments are also not convincing.

The opponent argued that the claim did not define any minimum concentration for the anionic surfactants or for the oxidation bases. Neither the non-ionic surfactants used in example 2 of D2 nor the oxidation bases used in D5 were excluded from the claim. Thus, the claim covered compositions which differed from the ones used in D2 or in D5 at most by a minimal amount of the surfactant or the oxidation base as defined in the claim. In view of D5 it was not credible that such minimal differences would lead to a measurable effect.

However, in the Board's view it is not necessary for the claim to define a minimum concentration of surfactants or oxidation bases. The effect on colour homogeneity can credibly be attributed to the addition of the anionic surfactant to the closest prior art composition. Thus, the inventive contribution resides in the use of the anionic surfactant as such, not in the finding at which concentrations the surfactant will show a visible effect or work best. It is clear to a skilled person that the magnitude of the effect will depend on the concentrations of the ingredients used.

The opponent criticized that D6 was only a single point comparison relating to an alkyl ester surfactant and no data could support the extension of the effect to other compositions as defined in the claim.

The Board does not agree. D6 may be a single point experiment but it shows an improvement caused by the present of an alkyl sulfate surfactant compared to the closest prior art. D4 shows an an improvement for the second class of surfactants defined in the claim, alkyl ether sulfates. Even if the comparative composition used in D4 does not correspond to example 2 of D2 it is still a composition according to D2, using oxidation bases as defined in the present claim, and the effect of the anionic surfactant can be seen. Since D5 does not relate to oxidation bases required by the claim, there is no proof to the contrary.

The opponent also referred to the color metrics measured in D6. In particular it was argued that the difference only resided in the colour intensities, since the values for a^* and b^* were essentially similar. The ΔE value obtained for the inventive

composition, 5.4, still related to an inhomogeneous colouring. Thus, it could not be concluded that the use of the compositions defined in the claim lead to homogeneous hair colouring at all.

However, even if the use of the hair dyeing compositions as defined in the claim does not eliminate all differences between different parts of the hair the result is still a more homogeneous colouring as compared to the compositions of the closest prior art.

6.4.6 Thus, starting from D2 the claimed compositions are a solution to the technical problem of providing hair dyeing compositions leading to a more homogeneous coloration of the hair. This improvement is caused by the features distinguishing the claim from D2, i. e. the presence of anionic surfactants selected from alkyl sulfates or alkyl ether sulfates.

6.5 Obviousness of the claimed solution

Although D2 mentions anionic surfactants as optional components of the hair dyeing compositions disclosed therein, see [0106] to [0118], a skilled person would not have known that the addition of them allows more homogeneous hair colouring.

Also the opponent did not argue that the solution of the technical problem as defined above was obvious from the prior art.

6.6 The Opposition Division's conclusions in point 5.5 of the appealed decision are correct. The compositions defined in the claims of auxiliary request 2 are based on an inventive step.

7. An amended description corresponding to the claims of auxiliary request 2 has already been filed during opposition proceedings and is underlying the appealed decision. No objections to the adaptation of the description were raised in appeal proceedings.

8. In summary, the Opposition Division correctly decided that the patent may be maintained in amended form under Article 101(3)(a) EPC in the form of auxiliary request 2 pending before it.

Order

For these reasons it is decided that:

The appeals are dismissed.

The Registrar:

The Chair:



C. Rodríguez Rodríguez

R. Pérez Carlón

Decision electronically authenticated