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**Datasheet for the decision
of 14 June 2024**

Case Number: T 0636/22 - 3.3.10

Application Number: 13712797.3

Publication Number: 2846761

IPC: A61Q5/10, A61K8/86, A61K8/92,
A61K8/31, A61K8/60, A61K8/41

Language of the proceedings: EN

Title of invention:

COMPOSITION COMPRISING (2,5-DIAMINOPHENYL)ETHANOL, AN
ALKYLPOLYGLUCOSIDE NONIONIC SURFACTANT, AN OXYETHYLENATED
SORBITAN ESTER OR A POLYALKOXYLATED OR POLYGLYCEROLATED FATTY
ALCOHOL IN A MEDIUM RICH IN FATTY SUBSTANCES, DYEING PROCESS
AND DEVICE THEREFORE

Patent Proprietor:

L'OREAL

Opponent:

Henkel AG & Co. KGaA

Headword:

Relevant legal provisions:

EPC Art. 56
RPBA 2020 Art. 12(6)

Keyword:

Inventive step - (no) - obvious improvement
Late-filed evidence - should have been submitted in first-
instance proceedings (yes) - admitted (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0636/22 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 14 June 2024

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 3 January 2022
revoking European patent No. 2846761 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: M. Kollmannsberger
L. Basterreix

Summary of Facts and Submissions

I. The patent proprietor (appellant) appealed the decision of the Opposition Division to revoke its patent under Articles 101(3) (a) and (b) EPC.

II. The patent deals with compositions useful in oxidative hair dyeing processes. Claim 1 of the patent reads as follows:

"Composition for dyeing keratin fibres, in particular human keratin fibres such as the hair, comprising:
a) *one or more fatty substances not containing any salified or unsalified carboxylic acid groups being neither polyoxyalkylenated, nor polyglycerolated;*
b) *one or more alkyl (poly)glucoside nonionic surfactant(s), and/or one or more oxyethylenated C₈ to C₃₀ fatty acid ester(s) of sorbitan, and/or one or more (poly)alkoxylated fatty alcohol(s) and/or one or more (poly)glycerolated fatty alcohol(s);*
c) *one or more oxidation base(s) chosen from 2- β -hydroxyethyl-para-phenylenediamine and also acid salts thereof or solvates thereof such as hydrates;*
d) *optionally one or more coupler(s);*
e) *optionally one or more basifying agent(s);*
f) *one or more chemical oxidizing agent(s); and the fatty substance content representing in total at least 25% by weight relative to the total weight of the composition."*

III. The following documents are referred to in the present decision:

- D1: EP 2 198 927
- D3: Experimental Report, filed by the appellant during examination proceedings on 7 July 2017
- D5: DE 10 2006 012 575 A1
- D11: EP 0 727 203
- D12: Experimental Report, filed by the appellant during opposition proceedings on 11 October 2021
- D13: Experimental Report, filed by the appellant during appeal proceedings on 12 May 2022

IV. The patent had been opposed under Article 100(a) EPC for lack of novelty and inventive step (Articles 54/56 EPC). In the opposition proceedings the appellant defended the granted patent as its main request, and amended versions of the patent as auxiliary requests 1-9.

In its decision the Opposition Division concluded that neither the compositions defined in claim 1 of the granted patent nor the compositions defined in claim 1 of auxiliary request 1 were novel over D5. The compositions defined in claim 1 of auxiliary requests 2-9 were found to lack inventive step over a combination of D1 and D11.

V. In appeal proceedings the appellant argued that the decision of the Opposition Division was erroneous in denying novelty and inventive step over the cited documents. Additionally, with its statement setting out the grounds of appeal the appellant filed new

experimental evidence D13 in order to support inventive step.

The appellant requested the decision of the Opposition Division to be set aside and the patent to be maintained as granted, or in amended form based on any of auxiliary requests (ARs) 1 to 5, as filed together with the statement setting out the grounds for appeal. ARs 1-5 correspond to ARs 1, 2, 5, 8 and 9 underlying the appealed decision.

VI. Independent claims 1 of the appellant's auxiliary requests (ARs) differ from claim 1 of the granted patent as follows:

In AR1 the word "*optionally*" is deleted in component (d), so that a coupler is mandatory.

In AR2 the component (d), i. e. the couplers, are specifically defined as "*chosen from meta-phenylenediamines, meta-aminophenols, meta-diphenols, naphthalene-based couplers and heterocyclic couplers, and addition salts thereof*".

In AR3 the fatty substance content is defined as "*at least 40%*".

In ARs 4 and 5 the limitations in component (d) made in ARs 1 and 2 are combined with the higher fatty substance content of AR3.

VII. The respondent (opponent) essentially argued that the decision taken by the Opposition Division was correct.

The respondent requested the appeal to be dismissed. It furthermore requested the experimental report D13 not to be admitted into appeal proceedings.

VIII. The Board summoned the parties for oral proceedings which were held on 14 June 2024. In a notification under Article 15(1) RPBA the parties had been informed about the preliminary opinion of the Board that the appeal was likely to be dismissed.

IX. The decision was announced at the end of the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

The appellant's main request - patent as granted

2. Inventive step (Article 56 EPC)

2.1 The Opposition Division did not decide on inventive step of the patent as granted, since it found the claims of the granted patent to lack novelty over D5. However, the reasoning given for its finding of lack of inventive step over a combination of D1 and D11 of the (then pending) auxiliary requests 2-9 applies equally to the claims of the granted patent. The Board considers the Opposition Division's assessment to be correct; this will be reasoned in the following.

2.2 Closest prior art

D1 discloses hair dyeing compositions which have favourable colouration properties, in particular with respect to intensity and homogeneity of the colouration, see [0016]. This corresponds to the goals that the disputed patent tries to achieve, see [0015] there. It was undisputed between the parties that D1 represents the closest prior art to the claimed compositions.

2.3 Technical problem and its solution

2.3.1 The compositions defined in the claims of the granted patent differ from the compositions disclosed in example 1 of D1 in the nature of the dye precursor, namely 2- β -hydroxyethyl-para-phenylenediamine, as opposed to toluene-2,5-diamine used in example 1 of D1. Although D1 also mentions 2- β -hydroxyethyl-para-phenylenediamine, see [0086], there is no disclosure of a composition as specific embodiment containing this compound as an oxidation base together with the other components defined in claim 1 of the granted patent.

2.3.2 The technical problem to be solved was the provision of dyeing compositions leading to more homogeneous colouration along the hair fibre. In view of the technical reports D3 and D12 this problem has been solved by the provision of the claimed compositions, which are characterized by the use of 2- β -hydroxyethyl-para-phenylenediamine as dye precursor. All this was undisputed between the parties.

2.4 Obviousness of the claimed solution

2.4.1 The disputed issue was whether this technical problem had been solved in an obvious way. According to the

reasoning of the Opposition Division D11 taught already that 2- β -hydroxyethyl-para-phenylenediamine may be used as dye precursor in order to achieve a particularly homogeneous colouration along the hair fibre.

2.4.2 D11 discloses compositions for oxidative hair dyeing that contain the oxidation base 2-(2,5-Diaminophenyl)-ethanol, see claim 1 of D11. 2-(2,5-Diaminophenyl)-ethanol is a synonym of 2- β -hydroxyethyl-para-phenylenediamine and is the compound defined in claim 1 as component (c). As apparent already from the abstract, the compositions of D11 lead to a homogeneous colouration of the hair. That the colouration obtained is particularly homogeneous is also described in the passage on page 2, line 41 to page 3 line 10 of the description and in example 5.

2.4.3 Thus, the Opposition Division concluded that a skilled person, starting from D1 and faced with the problem of improving the homogeneity of the colouration obtained when using the composition defined in example 1, would have turned to D11 and would immediately have tested if this goal could be achieved by using the dye precursor proposed therein.

2.4.4 The appellant disputed the reasoning of the Opposition Division arguing that (i) D11 emphasized the importance of the composition's pH and (ii) the compositions in D11 did not contain the high levels of oily substances required by the claims. Furthermore it was argued that (iii) D11 did not teach that 2- β -hydroxyethyl-para-phenylenediamine was superior to other dye precursors with respect to homogeneity of colouration, only that it was better to use this specific compound in compositions having neutral as opposed to alkaline pH.

2.4.5 However, the arguments submitted by the appellant are not convincing.

First of all the Board stresses that 2- β -hydroxyethyl-para-phenylenediamine is mentioned in D1 itself as a possible alternative oxidation base to the toluene-2,5-diamine used in example 1, see [0086]. Thus, the use of this compound is already foreshadowed in D1, even if a skilled person would not have had any information about possible advantageous colouring properties from D1 alone.

(i)

The teaching of D11 is that the use of 2- β -hydroxyethyl-para-phenylenediamine as an oxidation base at pH<8 leads to particularly homogeneous hair colouration, see e. g. D11, page 2 line 41 to page 3 line 10 and example 5. The importance of the pH value is stressed on page 4 lines 5/6 of D11. Thus, it is correct that the teaching of D11 relates to a certain pH range, however, this pH range is compatible with the teaching of D1, see paragraph [0174]. The compositions of D1 are used in a pH range of between 3 and 12, preferably 5-11, more preferably between 7 and 11. There is thus a considerable overlap between the pH ranges at which the compositions are used in D1 and in D11, in particular in the neutral and slightly alkaline pH region. Thus, the teaching of D11 is in no way incompatible with the teaching of D1. Also the optimum pH value for the homogeneous colouration determined in example 5 of D11 (6.9) is fully compatible with the pH values proposed in [0174] of D1. Neither do the claims of the disputed patent limit the pH of the dyeing compositions to a specific range that would be incompatible with the teachings of either D1 or D11.

(ii)

Regarding the amount of oily substances the appellant submitted that most of the compositions in D11 were aqueous and that also the cream composition of example 5 of D11 did not contain more than 25% of fatty substances. However, although D11 does not use the amounts of fatty substances defined in the claims D11 does also not contain any teaching that would discourage a skilled person from applying its conclusions to the compositions of D1, having the required content of oily substances. The teaching of D11, namely that 2- β -hydroxyethyl-para-phenylenediamine leads, under conditions of pH in line with the ones of D1, to a particular homogeneous colouration of the hair is still incentive enough for a skilled person to modify the example compositions of D1 accordingly in the expectation to improve the homogeneity of colouration.

The appellant stressed the influence the fat content may have on the homogeneity of the colouration, as shown in example 3 of D1 for 2,5-diaminotoluene as oxidation base. The results obtained were better at higher fat content of the dyeing composition used. However, as noted above, 2- β -hydroxyethyl-para-phenylenediamine is disclosed in D1 as an alternative oxidation base to 2,5-diaminotoluene. Thus, if a skilled person would have drawn any conclusion from this disclosure, it would have expected this effect to be similar when using 2- β -hydroxyethyl-para-phenylenediamine. The expectation raised by D11 to improve the homogeneity of colouration when using this oxidation base would thus rather have further increased than diminished.

(iii)

It is correct that D11 does not teach a superiority of 2- β -hydroxyethyl-para-phenylenediamine with respect to other dye precursors of the family proposed in D1. However, D11 clearly teaches that the use of this oxidation base leads, under the conditions compatible with D1, to a particular homogeneous colouration of the hair. A skilled person, trying to improve colouration homogeneity starting from example 1 of D1, would of course look to a document describing an oxidation base as particularly useful for this purpose, and try whether the expected advantages materialize. This applies even more if, as presently the case, this oxidation base is already listed in D1 itself as a possible alternative and a skilled person has thus no reason to expect any incompatibility of the compound with the compositions used in the closest prior art.

2.4.6 Thus, the Opposition Division's finding that the claimed solution of the objective technical problem would have been obvious for a skilled person is correct. In simple words, it was obvious for a skilled person from D11 that replacing the oxidation base used in example 1 of D1 by the alternative one mentioned in [0086] of D1, 2- β -hydroxyethyl-para-phenylenediamine, would lead to more homogeneous hair colouration.

2.5 The claimed compositions are obvious for a skilled person when combining the teachings of D1 and D11.

Auxiliary requests (ARs)

3. The conclusion with respect to lack of inventive step remains the same for the claims of the auxiliary requests.

- 3.1 Claims 1 of AR1 and AR2 specify the couplers. However, neither the teaching of D1 nor the teaching of D11 is restricted to specific couplers. The appellant did not submit any arguments supporting inventive step specifically for these requests.
- 3.2 Claim 1 of ARs 3-5 increases the lower limit of the fatty substance content to 40% by weight, as opposed to 25% by weight in the granted patent and ARs 1-2.
 - 3.2.1 In the view of the appellant the higher fatty substance content distanced the claim further from the teaching of D11 which did not disclose such high components of fatty substances for the use of 2- β -hydroxyethyl-para-phenylenediamine.
 - 3.2.2 However, the closest prior art compositions in D1 contain fatty substances in amounts of 25% to 80% per weight, in particular 30 to 55% by weight, see claim 4. The starting point for the inventive step analysis remains thus the same. Since the teaching of D11 is not limited to any specific low fat content the skilled person's way of acting, as outlined above for the claims of the granted patent, is not influenced by a higher fatty substance content defined in the independent claim.
4. Admissibility of the additional experimental data D13
 - 4.1 With its statement setting out the grounds of appeal the appellant filed experimental data D13. According to the appellant, this report showed that the compositions defined in the claims of the granted patent and the auxiliary requests not only lead to a more homogeneous colouration of hair fibres, but that the resulting

colouration was also more resistant to shampoos and light.

- 4.2 This effect, and any technical problem formulated based on such an effect, was not discussed during opposition proceedings. The filing of these results is thus an amendment to the appellant's case and its admissibility is subject to the provisions of Articles 12(4) and 12(6) RPBA.
- 4.3 The appellant argued that these tests were carried out as a reaction to objections which were discussed for the first time during oral proceedings before the Opposition Division. The appellant referred to the argument that D11 related to the same problem as the disputed patent, i. e. the homogeneous colouration of hair fibres. In particular the appellant argued that the Opposition Division changed its mind with respect to D11 as compared to the preliminary opinion annexed to the summons for oral proceedings. Furthermore the appellant stressed that the effect tested in D13 was mentioned in the patent, see [0015]. A discussion of D13 was thus inside the framework of the opposition procedure.
- 4.4 However, whether mentioned in the patent or not, neither the effects tested in D13 nor any possible consequences of such effects for inventive step were discussed during opposition. The question is not whether a discussion of D13 would have been inside the framework of the opposition procedure. This may be the case or not, depending on the point of time at which D13 would have been submitted and possibly depending on the relevance the Opposition Division would have given to its content. The question here is rather whether a discussion of D13 is inside the framework of an appeal

procedure based on the decision taken by the Opposition Division, see Article 12(2) RPBA.

- 4.5 The inventive step objection based on a combination of D1 and D11 was on file since the very beginning of the opposition proceedings, see point 4.6 of the respondent's notice of opposition, almost one year before the Opposition Division issued its preliminary opinion. Any data relating to effects mentioned in the patent, if considered relevant by the appellant, should have been provided already during opposition proceedings, Article 12(6) RPBA. No specific circumstances for the admission of such data under Article 12(6) RPBA are apparent. The mere fact that an Opposition Division, during oral proceedings, considers an existing argument of the opposing party as convincing, does not qualify as such a specific circumstance. It is the very purpose of oral proceedings to give parties the possibility to argue their case before the Opposition Division in order to strengthen or possibly overturn any preliminary view the Opposition Division had communicated beforehand.
- 4.6 Admittance of D13 would lead to a situation where the decision of the Opposition Division with respect to inventive step, even if correct in substance based on the submissions before it, became obsolete and inventive step might have to be discussed from scratch based on a different objective technical problem not considered during opposition proceedings. This is incompatible with the primary principle of appeal proceedings to give a judicial review of the decision under appeal, Article 12(2) RPBA.

4.7 Thus, neither document D13 nor any arguments based on it are admitted into appeal proceedings, Article 12(6) RPBA.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated