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D E C I S I O N
of 30 July 1996

Case Number: T 0306/93 - 3.3.2

Application Number: 84111810.2

Publication Number: 0136704

IPC: A61K 7/043

Language of the proceedings: EN

Title of invention:

Nail enamel containing silicone-coated pigments

Patentee:

Revlon, Inc.

Opponent:

L'OREAL

Headword:

Nail enamel/REVLON

Relevant legal provisions:

EPC Art. 56, 100(b), 104(1)
EPC R. 67

Keyword:

"Inventive step - no - incentive to try the latest product
available on the market"

Decisions cited:

G 0010/91

Catchword:

-



Case Number: T 0306/93 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 30 July 1996

Appellant: L'OREAL
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 5 February 1993
rejecting the opposition filed against European
patent No. 0 136 704 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: U. Oswald
J. H. Van Moer

Summary of Facts and Submissions

- I. European patent No. 0 136 704 was granted on the basis of 16 claims contained in European patent application No. 84 111 810.2. Claim 1 as granted reads as follows:

"1. A nail enamel comprising

(a) an inorganic pigment selected from iron oxides, titanated mica, iron oxide coated mica, titanium dioxide, ultramarine, chromium oxide, chromium hydroxide, and manganese violet, wherein said inorganic pigment is precoated with a polyorganosiloxane, including polymeric chains having up to 100 or even 1,000 repeating (Si-O) units, wherein the chains are cross-linked to each other, the remaining function sites of each Si-atom in the chain are occupied by hydrogen methyl, C₂-C₃₀ alkyl or alkenyl, and/or phenyl, resulting in units such as

(Si(CH₃)(C₆H₅)O), (Si(CH₃)(H)O), or (Si(H)(C₆H₅)O),

and generally capped with

-Si(CH₃)₃,

wherein said precoating is provided by reacting the uncoated pigment with a silicone material selected from

- (A) a silane of the formula A₁SiX₁X₂X₃, wherein A₁ is alkyl or alkenyl having up to 30 carbons atoms and X₁, X₂ and X₃ are independently chloro, methoxy or ethoxy,
- (B) (CH₃)₃SiO(Si(CH₃)₂O)_nSi(CH₃)₂OA₂ wherein n is 1 to 100 or up to 1,000, and A₂ is C₁-C₃₀ alkyl, or

(C) $(\text{CH}_3)_3\text{SiO}(\text{Si}(\text{CH}_3)(\text{H})\text{O})_p \text{Si}(\text{CH}_3)_3$, wherein p is 1 to 100 or up to 1 000,

so that at least one Si-atom of each chain is linked to the pigment surface or the coated pigment surface through an oxygen atom, wherein the precoated pigment comprises up to 10 wt.% of the nail enamel and

(b) a base comprising nitrocellulose, solvent and a suspending agent and optionally also including a resin and a plasticizer.

II. Opposition was filed under Article 100(a) EPC against the granted patent by the Appellant. Of the documents cited during the opposition, the following remains relevant to the present decision

(1) WHITTAKER, CLARK & DANIELS, INC. "**PRODUCT DATA**" CLARK COLORS, INC., PURIFIED INORGANIC COLOR, "COSMETIC HYDROPHOBIC RED OXIDE # 9454 CS#11540", "3/78", (publication date March 1983, cf. Declaration by Nathaniel Goodwin, dated 16 January 1992, received 25 January 1992).

III. The Opposition Division rejected the opposition.

The decision was not based on the results of the comparative tests, filed by the Patentee (Respondent) with letter dated 5 October 1992. It was pointed out that the Opponent (Appellant) failed to show that the products "CS11760" and "CS11595" according to the said tests had been made available to the public before the priority date of the patent in suit.

The Opposition Division took the view that the Opponent did not file any evidence that the so-called Whittaker, Clark & Daniels (WCD)-pigments according to document (1) comprised the specific polysiloxane coating with a covalent bonding of oxygen to the pigment surface as set out in the patent in suit. The reference to product numbers of (WCD)-pigments according to the patent in suit did not necessarily mean that the corresponding products could be used without a further coating treatment. Moreover, document (1) did not relate to a nail enamel composition as such but only disclosed the possible use of a pigment in a nail lacquer. Consequently, the subject matter of claim 1 as granted was novel.

In the light of the closest prior art according to document (1) the problem underlying the patent in suit was the "prevention of migration and settling of the pigments". Since the "superior performance" of the compositions according to the worked examples of the patent in suit in comparison with untreated pigments was non-obvious in the light of the relevant prior art, the claimed subject matter involved an inventive step.

- IV. The Appellant lodged an appeal against this decision. Oral proceedings took place on 30 July 1996. The arguments of the Appellant, both in the written procedure and at the oral proceedings, may be summarised as follows.

The Appellant argued that the Respondent presented a "totally unnatural" interpretation of the wording of the patent in suit. It had not been shown that the reference to the product number 9454 in document (1) and that in the patent in suit related to different types of hydrophobic coated iron oxide pigments. The description of the patent in suit clearly indicated that suitable coated pigments could be obtained from

the known distributor Whittaker, Clark & Daniels, Inc according to document (1) and that alternatively one could prepare the coated pigment by appropriate reaction steps, which meant nothing more than that instead of using commercially available products the person skilled in the art was in a position of producing suitable coated pigments. It was common practice of chemical suppliers not to indicate on data sheets such as document (1) such data as the preparation method, or the starting material . However, it was not difficult for a person skilled in the art to determine the technical background why product 9454 showed hydrophobic properties. Consequently, it could be assumed that the specific coating on the said pigment 9454, forming basis for the alleged invention, was carried out before selling the product to the Respondent and there was no doubt that this product was available to the public before the priority date of the patent in suit. If on the other hand the Respondent insisted on the fact that the product 9454 used according to the examples of the patent in suit was not the same as the product 9454 according to document (1), a new ground of opposition under Article 100(b) must be raised. Neither the preparation nor the structure of the coated pigments used in the examples of the patent in suit had been defined.

Taking into account that document (1) did not expressly describe a base of the nail lacquer, novelty of the claimed subject matter could be accepted. However, document (1) expressly made reference to the use of the product 9454 in nail lacquers and therefore, it was nothing more than routine for a person skilled in the art to formulate the product 9454 with a conventional base and thus obtain in an non-inventive manner the claimed nail enamels. Since the claimed nail enamel was

obvious per se, the reduction of settling and migration of the pigment in the corresponding formulation could only be regarded as an unexpected "bonus" effect in accordance with the decision T 21/81.

Moreover, it was to be noted that the comparative tests filed by the Respondent did not comprise any proof with respect to the presence of covalent bonds between the polyorganosiloxane coating and the surface of the pigment and did not show that said covalent bond was the only factor exerting an influence on the settling and migration results. In the same way, the reference to test results from anonymous products only characterised by non-identifiable code numbers without any further technical information was not suitable to demonstrate the presence of a selection invention. In the absence of a defined objective [group of test objects] a selection was impossible in any case.

The Opposition Division's conclusion that it was the Appellant's responsibility to provide technical information about the products given a name but unidentified as to their compositions constituted a substantial procedural violation.

- V. The Respondent took the view that Document (1) suggested neither a coating of the pigments nor the special properties that the coating had to possess in order to cause the intended effects of reducing settling and migration when introducing the pigments into the nail enamel. More particularly, it was to be noted that the product described in document (1) initially did not have the properties as claimed in the patent in suit, but only after appropriate treatment. Comparative tests showed that "when using the hydrophobic pigments supplied by WC&D" under only one product number according to the invention, only the pigments on the surface of which the silicone was

bonded covalently fulfilled the purpose according to the invention". The characterization "hydrophobic pigments" according to document (1) meant nothing more than pigments coated with anything which became hydrophobic by coating. Furthermore, the reference to a product number according to document (1) did not allow the conclusion to be drawn that the product was marketed under the same number over several years without any modification of its composition or physical properties. Only the description of the patent in suit clearly related to the mechanisms and procedures essential to produce the coating of the pigment surface and provided the teaching how to test the commercially available pigments with respect to their applicability in a nail enamel.

It was accepted that the reference to a coated pigment surface in claim 1 on page 5, line 19 of the patent in suit raised the question of interpretation and that the explanations on page 3, lines 44/45 relating to the treated pigments used according to the worked examples of the patent in suit did not expressly indicate that it was necessary to carry out a further coating procedure on commercially available pigments which already comprised a coating. However, taking into account the teaching of the patent in suit as a whole, it was clear that only pigments with the product number 9454 from Clark Colors, treated according to the coating procedure set out in claim 1 of the patent in suit, showed the good results of Table 1 and Table 2 of the worked examples. Confirmation was given by the comments on page 4, lines 59 to 61 relating to the results of the worked examples. It was particularly pointed out that an improvement over the pigments disclosed in document (1) could be derived from the results according to Example 3 in Table 2 on page 4.

The reference to "satisfactory colors" on page 2, line 61 of the description of the patent in suit clearly did not relate to satisfactory results attainable by the inclusion of pigments in a nail enamel but related to the satisfactory colour effect of the pigment particles. There was no doubt for a person skilled in the art that satisfactory results within the meaning of the invention could only be achieved by the characteristics according to claim 1 of the patent in suit. In this respect the patent in suit comprised the teaching to hydrolyse the polysiloxane coating material according to claim 1. Such a hydrolysis step would result in the formation of covalent bonds to the pigment surface through oxygen atoms. Moreover, there was an advantage in view of the fact that the polymeric chains of a secondary coating layer were cross-linked to the coated surface.

Article 84 EPC did not represent a ground of opposition and it was in any case allowable to give some interpretation to the wording of the description of the patent in suit. Accordingly, the patent in suit also fulfilled clearly the requirements of Article 83 EPC.

The Respondent did not consent to lack of disclosure under Article 83 EPC being considered.

As regards the Appellant's doubts whether or not covalent bonds were formed according to the coating procedure of the patent in suit and the alleged lack of technical information about the group of tested pigments, it was the Appellant's task to prove the incompleteness or falsity of the doubted comparative tests.

- VI. The Appellant requested that the decision under appeal be set aside and that the patent be revoked. He requested also reimbursement of the appeal fee and an apportionment of costs against the Respondent.

The Respondent requested that the appeal be dismissed and that the patent be maintained on the basis of claim 1 according to amended page 4 of the patent in suit, lines 64 and 65, filed with letter dated 28 June 1996 and amended page 5 of the patent in suit, lines 1 to 22, filed with letter dated 1 July 1996; claims 2 to 6 on page 5, of the patent in suit, filed with letter dated 1 July 1996 and claim 8 according to the separate sheet attached to the letter dated 28 June 1996, claim 7 being deleted.

Reasons for the Decision

1. The appeal is admissible.
2. Claims 1 to 6 correspond to claims 1 to 6 as granted (process claim 6 now contains a reference back to any of the preceding product claims). Claim 8 is based on claims 1 to 5 and claim 11 as granted. Claim 7 has been deleted. The claims also find support in the application documents as originally filed. The Appellant made no objection under Article 100(c) and the Board considers that the requirements of Article 123(2) and (3) EPC are satisfied.
3. In the present case the Respondent (Patentee) acknowledged that claim 1 and parts of the description of the patent in suit contain some ambiguity and therefore the teaching of the patent in suit needs interpretation before a comparison with the prior art can take place.

Article 84 EPC, however, is not a ground of opposition and the Board considers that the patent can indeed be read in the light of the description **without any further explanation.**

4. The Appellant did not oppose under Article 100(b) within the nine-month time limit. In accordance with the decision of the enlarged Board of Appeal G 10/91, (OJ 1993, 420, cf. particularly point 18. of "Reasons for the Decision"), new grounds for opposition could be introduced only with the consent of the Patentee, regardless of their relevance. In the present case the Respondent (Patentee) did not give consent.

5. Neither of the documents cited during the opposition and appeal procedure, nor any other document cited in course of the examination procedure disclose the specific combination of a coated inorganic pigment and a nail lacquer base defined by claim 1. In particular, document (1) only discloses the **recommended** use of an inorganic pigment in a nail lacquer. The Board is thus satisfied that claim 1 relates to novel subject matter. In any event, novelty of the claims was not questioned by the Appellant at the oral proceedings before the Board.

6. The Board cannot share the view taken by the Opposition Division that document (1), without disclosing a nail lacquer base respectively a nail enamel composition, represents the closest state of the art.
 - 6.1 In the Board's opinion, **a conventional nail enamel composition** as referred to in the introductory part of the description of the patent in suit, lines 5 to 8, comprising montmorillonite clay as a gellant in an amount of 2% to suspend pigments and pearlescent materials is the most reasonable starting point for

considering whether there is any invention. According to the European Search Report such a conventional nail enamel composition is **exemplified** by the document "Seifen-Öle-Fette Wachse-109.Jg.-Nr.9, Juni 1983, page 271, left column, "Gelzubereitung und deren Verwendung in Nagellacken". The composition comprises inter alia nitrocellulose, toluene, ethyl acetate, pearlescent material, iron oxide pigment, titanium oxide and alkyd resin as well as 2% montmorillonite.

- 6.2 It was not contested by the parties that conventional nail enamel compositions belong to the common general knowledge of a person skilled in the art. Furthermore, it was not contested by the parties that such conventional nail enamel compositions exhibit a certain degree of pigment migration and pigment settling and that these effects make the product unattractive for potential customers from an aesthetic point of view.

Accordingly, starting from **this** state of the art, the problem underlying the patent in suit can indeed be seen in providing a nail enamel composition which is substantially free from settling and migration of the pigment contained therein, as already defined by the Opposition Division.

- 6.3 The problem is solved by a nail enamel composition comprising a coated inorganic pigment defined by the features "a)" according to claim 1 of the patent in suit.

Tables 1 and 2 of the worked examples of the patent in suit, particularly the numerical evaluation ratings according to the "Observations after 2 mos." indicate inter alia no visible signs of pigment migration or settling for nail enamel compositions comprising a coated iron oxide pigment obtained from Clark Colors with the product number 9454.

Having regard to the disclosure of the patent in suit, particularly page 2, line 38 up to page 3, line 9 and page 3, lines 44 to 46, there is no reason to assume that the results according to said tables 1 and 2 are based on other "treated" pigments than those obtained from Clark Colors for whom the sole known distributor is Whittaker, Clark & Daniels. It derives plainly from the description that the patent in suit comprises the teaching that the pigment product 9454 represents the features "a)" according to claim 1.

The Appellant did not contest the numerical evaluation ratings. Accordingly, the Board is satisfied that the problem has been solved in a plausible manner.

7. It remains to consider whether or not the said solution according to claim 1 satisfies the requirements of Article 56 EPC in respect of inventive step.

7.1 A person skilled in the art unquestionably will be aware of the fact that a large variety of pigment products are commercially available on the market. As far as selection of materials is concerned, however, the Board generally considers it as forming part of the normal activities of a person skilled in the art to select from materials which are known to him as suitable for a certain purpose the most appropriate one, and this also in the case where he is presented with no more than an unreasoned preference for a specific material in a document forming part of the

prior art. In the present case, it is in particular to be noted that document (1) was published only about half a year before the priority date of the patent in suit. This prior art focuses the skilled person's attention to a product data sheet relating to "COSMETIC HYDROPHOBIC RED OXIDE #9454" pigments from "CLARK COLORS, INC." distributed by "WHITTAKER, CLARK & DANIELS, INC." The recommended use of the product is "EYE MAKE-UP-LIPSTICK-FACE POWDER PRESSED POWDER - NAIL LACQUER". The Board is convinced that the skilled person, in the light of the fact that an aesthetically unattractive appearance of the pigment plays an important role in known nail enamel compositions, **would have the incentive to try if the latest pigment product available on the market**, namely that according to document (1), would influence the appearance of the nail enamel in a positive way, and thus would arrive at the nail enamel composition as presently claimed without the exercise of inventive skill.

- 7.2 The Board does not accept the Respondent's argumentation that it is necessary to take into account that the commercially available product 9454 does not comprise the essential feature of the invention, namely a covalent bonding to the pigment surface through oxygen atoms and that according to the teaching of the patent in suit there is a need for a further coating onto the product 9454. The Respondent himself has admitted that the worked examples according to the patent in suit do not expressis verbis describe a further treatment or coating step of the pigments obtained from Clark Colors. The Board neither sees in the rest of the description or in the claims a basis for such a coating procedure of the product 9454, nor is there any teaching to carry out a selection process out of a group of products 9454.

Furthermore, the comparative tests filed by the Respondent during the opposition procedure with letter dated 5 October 1992, do not comprise technical information about the products tested and therefore cannot be taken into account. The mere allegation that test results would show that a selection out of a group of so-called WCD pigments, not all of which were available to the public, has to be carried out in accordance with the invention does in no way change the matter how a skilled person would understand the teaching of the patent in suit.

In the Board's opinion, it is not acceptable to read ambiguities into a statement which prima facie has a clear meaning, and then, as the Patentee here attempted to do, to resolve these ambiguities in a manner favourable to the Patentee as the basis for an invention. An alleged lack of clarity in a passage cannot be exploited to provide a basis for an interpretation which is inconsistent with what the Board sees as the plain meaning of that passage.

7.3 The Board can only conclude that the commercially available product 9454 according to document (1) represents a pigment as required by features "a)" of claim 1 of the patent in suit and that it was obvious for a person skilled in the art to provide a nail enamel comprising this product and to find out that the nail enamel is then substantially free from settling and migration of the pigment contained therein. Accordingly, claim 1 of the patent in suit lacks the required inventive step.

7.4 Since the Respondent's single request contains a claim which fails to comply with the patentability requirements of the EPC, the patent in suit must be revoked.

8. The Opposition Division did not base its decision on the patentee's comparative tests filed with letter dated 5 October 1992, see point "5." on pages 5/6 of the decision.

At the oral proceedings held on 13 October 1992, the Opposition Division informed the parties that the Opponent was "given the possibility to provide the Opposition Division with technical data in respect of the products CS 11760 and CS 11595" and it was indicated that "the proceedings will be continued in writing and an official communication will be issued immediately", see "EPO Form 2009.2 08.90" page 94 of the opposition file and sheet 2 of the "Communication/Minutes (Annex)", page 96 of the opposition file.

Furthermore, there is no proof by the Appellant that higher costs indeed had been incurred.

Under these circumstances, the Board sees no substantial procedural violation by the Opposition Division which could justify a reimbursement of the Appeal fee under Rule 67 EPC, nor can the Board detect in the present case a reason of equity to make an exception to the principle under Article 104(1) EPC that each party has to meet the costs he has incurred for the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside and the patent is revoked.
2. The requests for reimbursement of the appeal fee and apportionment of costs are rejected.

The Registrar:

The Chairman:

P. Martorana

P. A. M. Lançon

