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D E C I S I O N
of 15 July 1999

Case Number: T 0784/96 - 3.3.2

Application Number: 87900364.8

Publication Number: 0292481

IPC: A61K 7/06

Language of the proceedings: EN

Title of invention:

Particulate emulsifiable hair conditioning composition

Patentee:

Witco Corporation

Opponent:

Henkel Kommanditgesellschaft auf Aktien

Headword:

Hair conditioning/WITCO

Relevant legal provisions:

EPC Art. 113(1), 123(2), (3), 54, 56

Keyword:

"Added matter - no - only way to correct the deficiency for
the skilled person"

"Novelty - yes"

"Inventive step - no - clear guidance - foreseeable advantage"

Decisions cited:

T 0013/83

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0784/96 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 15 July 1999

Appellant: Henkel
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TFP/Patentabteilung
40191 Düsseldorf (DE)

Representative: -

Respondent: Witco Corporation
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 1 July 1996
concerning maintenance of the European patent
No. 0 292 481 in amended form.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: J. Riolo
M. B. Günzel

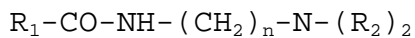
Summary of Facts and Submissions

- I. European Patent No. 0 292 481 based on application No. 87 900 364.8 was granted on the basis of 10 claims.

Claim 1 as granted reads as follows:

"An emulsifiable hair conditioning composition in the form of separate particles comprising:

- a) from at least 40% by weight of aliphatic alcohol of 8 or more carbons, or mixtures thereof; and
- b) from 20-60% of a quaternary ammonium compound or mixtures thereof miscible with said alcohol mixture; and
- c) from 2-10% of a fatty alkylamido alkyl dialkylamine of the general formula



where;

n is 1-6

R₁ is C₈ to C₂₈ alkyl group,

R₂ is a C₁ to C₅ alkyl group;

such that said composition melts at or above 30 °C."

- II. Opposition was filed against the granted patent by the appellant.

The patent was opposed under Article 100(a) EPC for lack of novelty and lack of inventive step, under Article 100(b) EPC for insufficiency of disclosure, and under Article 100(c) EPC because the subject-matter of the application extended beyond the disclosure as originally filed.

The following documents were inter alia cited during the proceedings before the Opposition Division:

(1) DE-A-3 228 444

(3) EP-A-155 806

III. The interlocutory decision of the Opposition Division of 18 June 1996 posted on 1 July 1996 established that the patent could be maintained under Article 106(3) EPC on the basis of claim 1 as amended during oral proceedings.

Said amended claim 1 differed from claim 1 as granted in that "from 20-60%" was replaced by "from at least 20%" in feature (b).

The Opposition Division took the view that this amended claim 1 met the requirements of Articles 84, 123(2), 52(1), 54 and 56 EPC and disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

The objection pursuant to Article 100(b) EPC was moreover dropped by the opponent with respect to the proprietor's new main request.

The Opposition Division considered that the amendment of the upper limit of the claimed range of feature (b) as well as the upper limit of the claimed range of feature (a) corrected during the examination procedure did not infringe the requirements of Article 123(2) EPC mainly because the skilled person, who would immediately be aware of the fact that the upper limits

were not possible, could only understand the main claim as it presently stood.

As regards novelty, the Opposition Division was of the opinion that the feature "in the form of separate particles" in claim 1 was not to be found in any of the available documents. Moreover, the Opposition Division stressed that the feature "emulsifiable hair conditioning" had a limiting character only insofar as the claimed composition as such must be suitable for this intended use, which did not imply any solubilized form for the claimed composition.

Accordingly the compliance of the main claim with Article 54 EPC was acknowledged by the Opposition Division.

The Opposition Division also concluded that neither documents (1) and (3) nor any of the other cited documents contained any incentive to select the particular amounts of the ingredients of the composition according to claim 1 in order to provide a composition in the form of separate particles for solving the problem of emulsifiability of quaternary ammonium compounds as well as the problems of handling and storage of such compositions.

That applied even more so because neither the closest prior art (3) nor any of the other documents were concerned with these problems.

IV. The appellant (opponent) lodged an appeal against the said decision.

- V. Oral proceedings were held before the Board on 15 July 1999.

The respondent (patentee), as announced in his letter dated 19 May 1999, did not attend the oral proceedings.

- VI. The appellant's submissions, both in the written procedure and at the oral proceedings, can be summarised as follows:

The appellant considered that the amendments introduced in the main claim had to be regarded as unallowable under Article 123(2) EPC since they represented a selection among the various possibilities of redefining the subject-matter of the main claim.

On the issue of novelty under Article 54 EPC the appellant took the view that due to the use of the wording "an emulsifiable hair conditioning composition" in claim 1, the subject-matter of the patent in suit encompassed any compositions containing the amounts of the ingredients of claim 1 in water, as water was required in a hair conditioning composition.

As regards inventive step the appellant contended that it was not demonstrated that the formulation according to the subject-matter of claim 1 of the patent in suit provided improved emulsifying of quaternary ammonium compounds. Therefore, this effect could not have been taken into account for the assessment of inventive step. He concluded that the subject-matter of claim 1 was obvious over the disclosure in (3), wherein the three ingredients of claim 1, in similar amounts, were described and added separately in a water solution in

order to provide an emulsified hair conditioning composition.

VII. The respondent's arguments submitted in the written procedure can be summarised as follows:

As regards the objection with respect to added matter, the respondent argued that the skilled person would have automatically corrected the original disclosure to arrive at the claim 1 as presently worded as it was the logical way to understand the subject-matter of the claim as filed.

In the respondent's view the subject-matter of claim 1 of the patent in suit was novel because none of the available prior art disclosed the specific feature of the main claim, i.e. an emulsifiable hair conditioning composition "in the form of separate particles".

It also involved an inventive step because, as none of the cited references suggested formulating such a mixture in the form of separate particles, the person skilled in the art could not have had any incentive to arrive at the specific amounts of ingredients in the composition according to claim 1 in order to provide an emulsifiable composition which solved the handling and storage problems.

VIII. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

Reasons for the Decision

1. The appeal is admissible.
2. *Article 123(2) and (3) EPC*

Claim 1 as originally filed reads as follows:

"A particulate emulsifiable hair conditioning composition comprising:

a) from at least 40-80% by weight of aliphatic alcohol of 8 or more carbons, or mixtures thereof; and

b) from 20-60% of a quaternary ammonium compound or mixtures thereof miscible with said alcohol mixture;

and

c) from 2-10% of a fatty alkylamido alkyl dialkylamine of the general formula



where;

n is 1-6

R₁ is C₈ to C₂₈ alkyl group,

R₂ is a C₁ to C₅ alkyl group;

such that said composition melts at or above 30 °C."

This claim is defective in respect of the two maxima of (a) and (b) since the total of the minima of (b) and (c) and the maximum of (a) and the total of the minima of (a) and (c) and the maximum of (b) both amount to 102%. All the other range limits allow completion to 100%.

In order to remedy the deficiency the patentee has amended the wording of claim 1 by replacing "from 40-80%" by "from at least 40%" in feature (a) and "from 20-60%" by "from at least 20%" in feature (b).

The Board notes that these amendments are supported by

the application as originally filed since the values 40% and 20% were initially disclosed and that they involve reduction of the maximum quantities of components (a) and (b) without introducing any undisclosed specific value in the accordingly contracted ranges.

The subject-matter of amended claim 1 therefore fulfills the requirements of Article 123(2) and 123(3) EPC.

The present situation is in fact analogous to that in decision T 13/83 (OJ EPO 1984, 428).

The Board agrees with the appellant that, arithmetically speaking, the error could have also been corrected by reducing the minimum quantities of components (a) and (b).

Such corrections would however extend the percentage ranges so as to cover embodiments which the application as originally filed did not seek to cover, so that the skilled reader would not contemplate this alternative in order to remedy the defect in claim 1. This solution would moreover contravene Article 123(2) and Article 123(3) EPC as it would involve an unsupported extension of the claimed ranges.

It follows that, contrary to the appellant's assumption, the present amendments represent the only way to correct the deficiency for the skilled person.

3. *Novelty*

As highlighted by the technical features requiring that the claimed composition is "in the form of separate particles" and "melts at or above 30°C", the subject-matter of claim 1 cannot be construed as including liquid composition.

Moreover, the adjective "emulsifiable" rather than "emulsified" used to qualify the claimed composition makes it clear that the subject-matter of claim 1 is directed to a hair conditioning precursor which has not yet been emulsified.

Under these circumstances the Board does not see any reason to depart from the positive conclusions of the Opposition Division as regards the novelty of the subject-matter of claim 1.

4. *Inventive step*

The patent concerns an emulsifiable hair conditioning composition in the form of separate particles according to claim 1.

According to the description of the patent in suit, quaternary ammonium compounds are effective ingredients in hair conditioning preparations (page 2, lines 19 and 20). They are marketed to formulators as solutions, dispersions and aqueous pastes. These materials require, inter alia, bulky storage and handling facilities and they are costly to ship. Furthermore, pastes and dispersions tend to be difficult to emulsify (page 2, lines 41 to 52).

Document (3) concerns hair conditioning compositions in

water comprising aliphatic alcohols, quaternary ammonium compounds and alkylamido alkyldialkylamine ie the three ingredients of the composition of claim 1 of the patent in suit.

The Board agrees with the Opposition Division and the parties that document (3) can be regarded as the closest prior art.

Example 1 discloses a hair conditioner which is prepared by adding and stirring the three ingredients of claim 1 of the patent in suit in nearly the same proportions as given in claim 1 in distilled water. From the working conditions described in Example 1 of document (3) it is clear that an emulsion of a quaternary ammonium compound (ie adogen 442-100p) is achieved without any difficulties.

On the one hand, as regards emulsifiability, the Board recognises that Example 3 reported in the patent in suit demonstrates that the composition of claim 1 comprising a premix of the three ingredients used in Example 1 of document (3) does indeed easily form an emulsion of a quaternary ammonium compound.

However, as strongly argued by the appellant, no improved emulsifying property of the claimed premix over the single quaternary ammonium compound of document (3) has been demonstrated by the respondent.

Under these circumstances, no improvement over the closest prior art can be taken into account in identifying the problem to be solved by the patent in suit.

On the other hand, regarding the handling properties, it could be accepted that storage and shipping might be easier with a particulate material than with the known marketed products. This has also not been questioned by the appellant.

The problem is therefore that of providing an alternative formulation of the ingredients used in hair conditioners which is easier to handle.

The problem is solved by the composition according to claim 1, and in the light of the description and the working examples of the patent in suit the Board is satisfied that the problem has been solved.

Thus the question to be answered is whether the proposed solution was obvious for the skilled person in the light of prior art.

With regard to this question, the Board notes that document (3) is not restricted to the working examples. It also teaches the skilled person that "certain components may be premixed and then added to the aqueous batch mixtures" in order to prepare the hair conditioning compositions (page 12, lines 13 to 14).

- 4.1 The Board acknowledges that a premix of the three ingredients of Example 1 of document (3) corresponding to the compounds (a), (b) and (c) of claim 1 of the patent in suit would still differ from the claimed premix as the amount of lexamine S-13 (ie ingredient (c)) used in Example 1 totals 14%, whereas it is limited to 10% in claim 1.

There is however nothing, either in the file or in the patent in suit, which might suggest that this difference, which is moreover small, could have any technical importance. Moreover the skilled person is well aware of other disclosures relating to hair care emulsion such as document (1). Having regard to the emulsion disclosed in Example 1 of document (1) for instance, wherein an amount of ingredient (c) according to the range of claim 1 of the patent in suit is used, it must be concluded that the skilled person could reduce the amount of ingredient (c) disclosed in document (3) without taking an inventive step.

The same applies to the feature of claim 1 restricting the premixes to compositions having a melting point at or above 30°C as the documents on file and the patent in suit are silent as to any technical meaning related to the choice of this particular melting point.

The Board concedes that the premixes are easier to handle than the three single components separately. This advantage is however the foreseeable result of obvious measures as demonstrated above since document (3) offers clear guidance as to the alternative form in which the hair conditioner ingredients can be used. It therefore provides no proof of an inventive step.

In view of the foregoing the Board judges that the subject-matter of claim 1 does not involve an inventive step as required by Article 56 EPC.

4.2 The respondent was not represented at the oral proceedings.

Under Article 113(1) EPC a decision of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

This procedural right is intended to ensure that no party is caught unprepared by reasons given in a decision rejecting his request on which he has not had the opportunity to comment.

The requirements set forth above are fulfilled because the present decision is entirely based on grounds, facts and evidence which were already known to the respondent from the proceedings before the Opposition Division and from the grounds of appeal.

Moreover, in the Board's judgement, by announcing his decision not to attend the oral proceedings two months in advance, the respondent voluntarily surrendered the opportunity to present his comments orally on any objections, facts, grounds or evidence which were already in the file and could later turn out to be decisive for the revocation of the patent.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

P. Martorana

P. A. M. Lançon