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D E C I S I O N
of 26 March 2003

Case Number: T 0681/00 - 3.3.1

Application Number: 92909392.0

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Language of the proceedings: EN

Title of invention:
Organosiloxanes for use as sunscreen agents

Patentee:
GIVAUDAN-ROURE (INTERNATIONAL) S.A.

Opponent:
L'OREAL

Headword:
Siloxanes/GIVAUDAN

Relevant legal provisions:
EPC Art. 56, 84, 104(1), 114(2)

Keyword:
"Late filed evidence (not admitted) - lack of relevance"
"Main request: inventive step (no) - improper comparison - reformulation of problem - obvious solution"
"Auxiliary request: clarity (no) - arising from amendment - inconsistent features"
"Apportionment of costs (no) - late filed evidence not admitted"

Decisions cited:
G 0009/91, T 0020/81, T 0301/87, T 0472/88, T 0420/00

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0681/00 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 26 March 2003

Appellant: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 25 April 2000 revoking European patent No. 0 538 431 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: A. J. Nuss
Members: R. Freimuth
J. P. B. Seitz

Summary of Facts and Submissions

I. The Appellant (Proprietor of the Patent) lodged an appeal on 21 June 2000 against the decision of the Opposition Division posted on 25 April 2000 revoking European patent No. 538 431 which was granted on the basis of two sets of claims, i.e. one set of nineteen claims for the Contracting States AT, BE, CH, DE, DK, FR, GB, IT, LI and NL and another set of four claims for the Contracting State ES. Independent claim 1 of the first set of claims read as follows:

"1. An organosiloxane compound having at least one unit of the general formula

$$O_{\frac{3-a}{2}}Si(R)_a-C(R^1)=CH-(CR^1_2)_n-O-C_6R^2_2H_2-CH=C-[C(O)OR^3]_2 \qquad (I)$$

any other units present in the said siloxanes being those represented by the general formula

$$R''_bSiO_{\frac{4-b}{2}} \qquad (II)$$

wherein R represents a C_{1-8} alkyl or an aryl group, R^1 is a hydrogen atom or a C_{1-5} alkyl group, R^2 is a hydrogen atom, a C_{1-5} alkyl group or a group OR^1, R^3 is a C_{1-5} alkyl group, R'' represents a hydrogen atom, a monovalent C_{1-8} hydrocarbon or halogenated hydrocarbon group, a has a value of 0, 1 or 2, b has a value of 0, 1, 2 or 3 and n has a value of from 1 to 6, provided that the

$$-C(R^1)=CH(CR^1_2)_n-O-$$

group and the two R^2 groups are linked to the aromatic ring at the para-and both meta-positions in relation to the group $-CH=C[C(O)OR^3]_2$."

II. Notice of Opposition had been filed by the Respondent (Opponent), requesting revocation of the patent in its entirety on the ground of lack of inventive step (Article 100(a) EPC). The following documents were submitted *inter alia* in opposition proceedings:

(1) EP-A-305 059 and

(3) EP-A-392882.

III. The Opposition Division held that the subject-matter claimed according to the then pending request did not involve an inventive step. Document (1) was chosen as closest prior art and starting point in the assessment of inventive step since that document related to organosiloxane compounds having a very similar structure and being effective in absorbing UV radiation. The problem underlying the invention, which was to obtain compounds for use as sunscreen agent having higher photostability and showing less penetration into the skin. The compounds claimed differed from those disclosed in document (1) in replacing the cinnamate group of the prior art by a benzalmalonate group. Document (3) already taught that organosiloxanes having a benzalmalonate group showed an excellent photostability. The Opposition Division considered the combination of the teachings of documents (1) and (3) to be obvious in order to obtain organosiloxanes having improved photostability. The test model for evaluating the skin penetration of the claimed compounds and for comparing it with that of the

prior art was unfair since it was found to be not predictive for the skin penetration in man. Therefore that property was irrelevant in the assessment of inventive step.

IV. At the oral proceedings before the Board, held on 26 March 2003, the Appellant defended the maintenance of the patent in suit in the form as granted (main request) and subsidiarily on the basis of four auxiliary requests submitted during those oral proceedings.

The first auxiliary request comprised two sets of claims, one for the designated Contracting States other than ES and the other for the Contracting State ES. Claim 1 of both sets differed from claim 1 as granted exclusively in substituting the feature of "a substantially linear or cyclic diorganosiloxane polymer" for the term "siloxane compound".

The second auxiliary request comprised a sole set of claims for all the designated Contracting States. Independent claim 11 was directed to a cosmetic composition comprising the diorganosiloxane polymer as defined in claim 1 of the first auxiliary request and independent claim 1 to the use of that polymer as absorber for the ultraviolet light in cosmetic compositions.

The third auxiliary request comprised one set of claims for all the designated Contracting States. Independent claim 11 was directed to a cosmetic composition comprising the organosiloxane compound as defined in claim 1 according to the main request, i.e. as granted, and independent claim 1 to the use of that compound as absorber for the ultraviolet light in cosmetic compositions.

The fourth auxiliary request comprised one set of claims for all the designated Contracting States. Independent claim 1 was directed to a process for the preparation of the diorganosiloxane polymer as defined in claim 1 of the first auxiliary request, claim 11 to a cosmetic composition comprising that polymer and independent claim 12 to the use thereof as absorber for the ultraviolet light in cosmetic compositions.

V. The Appellant submitted that document (3) represented the closest state of the art and starting point in the assessment of inventive step since it disclosed compounds having the same chromophore as the claimed products. The problem tackled by the present invention was to reduce the skin penetration of the organosiloxane compounds, to increase their purity, i.e. their uniformity and specificity, and to improve their photostability and their UV-absorption. To demonstrate these improvements the Appellant referred to three fresh comparative test reports submitted on 25 February 2003 and to comparative test reports already on file or comprised in the patent specification. The Appellant conceded at the oral proceedings before the Board that in none of those comparative test reports the claimed vicinal organosiloxane compound was tested as such, but that a mixture of geminal and vicinal isomers thereof was used for those tests. He submitted that the further documents, in particular document (1), did not give any incentive to modify the linking group in the organosiloxane compounds in order to achieve these improvements which, thus, were unexpected and non-obvious.

With respect to directing the claims of the first, second and fourth auxiliary request to "a substantially linear or cyclic diorganosiloxane polymer", the Appellant submitted that this feature was already

comprised in dependent claim 7 as granted and, hence, should not be open to an objection under Article 84 EPC. However, he did not challenge the power of the Board to decide in the present case nevertheless on the matter of Article 84 EPC with respect to that amendment. While not contesting that the value 0 for the index a or the values 0 and 1 for the index b in general formulae (i) and (ii) resulted in a non-linear or non-cyclic polymer, he disputed that this amendment generated any unclarity in the fresh claims. The polymer was defined as being only "substantially" of that linear or cyclic structure thereby including the presence of minor amounts of non-linear or non-cyclic units without generating any inconsistency. The Appellant conceded that the general formulae (i) and (ii) did not refer to di- but to monoorganosiloxanes when the index a was 0 or the index b was 1.

The Appellant denied the Respondent's request for apportionment of costs incurred in oral proceedings due to the presence of two technical experts.

VI. The Respondent submitted that document (1) represented the closest state of the art since it addressed the problem of skin penetration. The Respondent disputed that the Appellant had successfully demonstrated the improvements allegedly achieved by the claimed compounds in comparison to the closest state of the art. None of the test reports on file showed data of the vicinal organosiloxane claimed. Therefore any of those tests was irrelevant in the assessment of inventive. This conclusion applied also to the three test reports filed by the Appellant on 25 February 2003 which lacked any relevance and should not be admitted into the proceedings for their late filing. Therefore, the objective problem underlying the patent in suit was

merely to provide further organosiloxane compounds as sunscreen agent. However, in view of the teaching of document (3) the incorporation of the benzalmalonate chromophore was obvious.

The Respondent objected under Article 84 EPC to the amendment made to claim 1 as granted in respect of the fresh feature of "a substantially linear or cyclic diorganosiloxane polymer". He submitted that this fresh feature was not unclear as such, but that the unclarity in the claims arose out of its inconsistency with the general formulae (i) and (ii). Since this amendment was made during the opposition (appeal) proceedings the amended claims of the first, second and fourth auxiliary request were open to that objection. When in the general formulae (i) or (ii) the index a was 0 or the index b was 0 or 1, then the organosiloxane polymer was neither linear nor cyclic, but rather branched or crosslinked. The term "substantially" did not specify the amount of non-linear or non-cyclic units permitted to be present in the organosiloxane polymer, whereas the general formulae (i) / (ii) covered any amount of units wherein the index a was 0 or the index b was 0 or 1. This finding was also inconsistent with the specification of the patent in suit requiring on page 3, lines 32 and 33 that the index a was 1 and the index b was 2 when making a substantially linear or cyclic diorganosiloxane polymer. Nor was the polymer a diorganosiloxane when the index a was 0 or the index b was 0 or 1 thereby generating another inconsistency in the amended claims.

The Respondent alleged that he brought two technical experts to the oral proceedings before the Board only because the Appellant late filed three test reports on 25 February 2003. The Appellant should reimburse the costs incurred thereby.

VII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or on the basis of one of his four auxiliary requests filed during the oral proceedings. He further requested that the request for apportionment of costs be refused.

The Respondent requested that the appeal be dismissed, and further requested that reimbursement of costs incurred in the oral proceedings by two technical experts accompanying the representatives be ordered on the basis of Article 104 EPC.

VIII. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. *Late filed evidence (Article 114(2) EPC)*

The Appellant's three fresh comparative test reports are new evidence submitted for the first time on 25 February 2003 during appeal proceedings. No reason has been given for this late filing by the Appellant, nor can the Board see any such reason. They are supposed to demonstrate the improvements achieved over the prior art by the organosiloxane compound claimed having a vicinal structure. However, none of those test reports shows data of the claimed vicinal compound as such, but merely data of a mixture of geminal and vicinal organosiloxane compounds, as conceded by the Appellant. Those fresh comparative test reports, hence, do not truly reflect the claimed subject-matter and do not properly demonstrate that the purported

improvements of the claimed vicinal organosiloxane compounds have been achieved vis-à-vis the state of the art. As a consequence, they are not to be taken into consideration when assessing inventive step (cf. point 3 below). Thus, the three fresh test reports lack relevance for the decision to be taken and, as requested by the Respondent, are not admitted into the proceedings (Article 114(2) EPC).

Main request, third auxiliary request

3. *Inventive step*

3.1 According to the established jurisprudence of the Boards of Appeal it is necessary, in order to assess inventive step, to establish the closest state of the art, to determine in the light thereof the technical problem which the invention addresses and successfully solves, and to examine the obviousness of the claimed solution to this problem in view of the state of the art. This "problem-solution approach" ensures assessing inventive step on an objective basis. In this context, the Boards of Appeal have developed certain criteria that should be adhered to in order to identify the closest state of the art to be treated as the starting point. The crucial criteria are that the "closest prior art" is normally a prior art document disclosing subject-matter conceived for the same purpose as the claimed invention and additionally having the most relevant technical features, i.e. the essential structural elements, in common.

3.2 The patent in suit according to the main request is directed to organosiloxane compounds to be used as sunscreen agents and having an organosiloxane backbone, a benzalmalonate chromophore and an unsaturated aliphatic linking group. The objectives to be achieved as indicated in the patent in suit consist in providing

sunscreen agents having improved photostability and skin penetration (patent specification page 2, lines 31 and 57). In relation to these objectives and to the relevant technical features in common, a selection among documents (1) and (3) must be made as to which is to be considered as the "closest prior art". The Appellant and the Respondent had divergent views on the matter which of those documents should be treated as the closest prior art.

3.2.1 Document (3), which the Appellant considered as the closest piece of prior art, relates to organosiloxane compounds used as sunscreen agents and having an organosiloxane backbone, a benzalmalonate chromophore and a saturated aliphatic linking group. Therefore, the sole structural difference between this organosiloxane compound and those claimed in the patent in suit consists in substituting an unsaturated aliphatic linking group for the saturated one. That document stresses that the photostability, which represents an objective of the patent in suit as indicated above, is due to the presence of the benzalmalonate chromophore in the compound (page 3, lines 36 and 37).

Thus, document (3) relates to the same purpose and aims at one of the objectives of the claimed invention, i.e. photostability. A structural modification of the linking group within the organosiloxane compounds referred to in that document is only required to arrive at the structure of the claimed organosiloxanes, while the chromophore which is the essential structural part thereof remains unchanged.

3.2.2 Document (1), which the Respondent considered as the closest piece of prior art, relates to organosiloxane compounds used as sunscreen agents and having an organosiloxane backbone, a cinnamate chromophore and an unsaturated aliphatic linking group. Therefore, the

structural difference between this organosiloxane compound and those claimed in the patent in suit consists in substituting the benzalmalonate chromophore for the cinnamate one. That document addresses the skin penetration, which represents an objective of the patent in suit as indicated above (page 2, lines 8, 9 and 45).

Thus, document (1) relates to the same purpose and aims at one of the objectives of the claimed invention, i.e. skin penetration. A structural modification of the chromophore within the organosiloxane compounds referred to in that document is required to arrive at the structure of the claimed organosiloxanes. However, the chromophore is the essential structural part thereof. The Board concludes therefore that document (1) represents prior art which is further away from the patent in suit than document (3).

3.2.3 For these reasons, in the Board's judgement, document (3) represents the prior art closest to the patent in suit and thus, the starting point in the assessment of inventive step.

3.3 In view of this state of the art the problem underlying the patent in suit as submitted by the Appellant during the oral proceedings before the Board is to provide **improved** sunscreen agents, namely having reduced skin penetration, increased purity, i.e. uniformity and specificity, higher photostability and UV-absorption.

3.4 As the solution to this problem, the patent in suit proposes the organosiloxane compounds as defined in claim 1 of the main request (see point I above) which are characterised by the presence of an unsaturated aliphatic linking group having a vicinal structure.

3.5 The Appellant conceded at the oral proceedings before the Board that in none of the comparative test reports presented in time or comprised in the patent specification the claimed vicinal organosiloxane compound was tested as such, but that a mixture of geminal and vicinal isomers thereof was used for those tests. Thus, those test reports do not truly reflect the claimed subject-matter and do not properly demonstrate that the purported improvements of the claimed vicinal organosiloxane compounds have been successfully achieved vis-à-vis the closest state of the art. As a consequence, they must be disregarded in the assessment of inventive step.

3.6 According to the jurisprudence of the Boards of appeal, alleged but unsupported advantages cannot be taken into consideration in respect of the determination of the problem underlying the claimed invention (see e.g. decision T 20/81, OJ EPO 1982, 217, point 3, last paragraph of the reasons). Since in the present case the alleged improvements, i.e. reduced skin penetration, increased purity, i.e. uniformity and specificity, higher photostability and UV-absorption, lack the required adequate support, the technical problem as defined in point 3.3 above needs reformulation. In view of the teaching of document (3), the objective problem underlying the patent in suit can merely be seen in providing **further** organosiloxane sunscreen agents.

3.7 Finally, it remains to decide whether or not the proposed solution to the objective problem underlying the patent in suit is obvious in view of the state of the art.

When starting from the sun screening organosiloxane compounds of document (3), i.e. compounds having an organosiloxane backbone, a benzalmalonate chromophore and a saturated aliphatic linking group, it is a matter of course that the person skilled in the art seeking to provide further organosiloxane sunscreen agents would turn his attention to that prior art just dealing with organosiloxane sunscreen agents. As a skilled person he would be struck by document (1) which relates to organosiloxane sunscreen agents having an organosiloxane backbone, a cinnamate chromophore and an unsaturated aliphatic linking group.

The Board concludes from the above that the state of the art gives the person skilled in the art a concrete hint on how to solve the problem underlying the patent in suit to provide a further organosiloxane sunscreen agent (cf. point 3.6 *supra*), namely by substituting an unsaturated aliphatic linking group for the saturated one in the compounds known from document (3), thereby arriving at the claimed organosiloxane compounds, i.e. the solution proposed by the patent in suit. The skilled person is all the more likely to pursue this course since merely the linking group is modified while the benzalmalonate chromophore, which is the essential structural part (cf. document (3), page 3, lines 31 to 33), remains unchanged. Therefore, in the Board's judgement, it was obvious to follow the avenue indicated in the state of the art with a reasonable expectation of success without involving any inventive ingenuity.

3.8 In these circumstances, the subject-matter of claim 1 of the main request is an obvious solution in the light of the prior art. As a result, the Appellant's main request is not allowable for lack of inventive step pursuant to Article 56 EPC.

4. The third auxiliary request comprises independent claim 11 which is directed to a cosmetic composition comprising the organosiloxane compound as defined in claim 1 according to the main request. Therefore the considerations having regard to inventive step given in points 3.2 to 3.7 *supra* and the conclusion drawn in point 3.8 *supra* with respect to claim 1 of the main request apply also to claim 11 of the third auxiliary request, i.e. the subject-matter claimed is obvious and does not involve an inventive step.

In these circumstances, the Appellant's third auxiliary request shares the fate of the main request in that it too is not allowable for lack of inventive step pursuant to Article 56 EPC.

First, second and fourth auxiliary request

5. *Clarity (Article 84 EPC)*

5.1 Though Article 84 EPC may not be raised as ground for opposition in the sense of Article 100 EPC, Article 102(3) EPC stipulates that, taking into consideration the amendments made to the patent in suit during opposition (appeal) proceedings, the patent and the invention to which it relates meet the requirements of the European Patent Convention. Thus, according to established jurisprudence of the Boards of Appeal, the Board has the power to examine whether the patent satisfy all requirements under the EPC, as long as the objections **arise** out of the amendments made thereto. That examination requires to consider whether or not those amendments introduce any contravention of any requirement of the EPC, including Article 84 EPC (see decisions T 301/87, OJ EPO 1990, 335, point 3.8 of the reasons; G 9/91, OJ EPO 1993, 408, point 19 of the reasons). In the present case, claim 1 of the first

auxiliary request and claims 11 of the second and fourth auxiliary request have been amended in opposition (appeal) proceedings (cf. point IV *supra*) in substituting the feature of "a substantially linear or cyclic diorganosiloxane polymer" for the term "siloxane compound". Therefore it must be examined whether or not that amendment is in keeping with the requirements of Article 84 PC, in particular with that of clarity.

5.2 The Appellant argued that the amended claims should not be open to an objection under Article 84 EPC since the amendment resulted from a combination with dependent claim 7 as granted.

However, according to the jurisprudence of the Boards of Appeal an amendment directly giving rise to an ambiguity objectionable under Article 84 EPC will require to be dealt with by the Board under the power of Article 102(3) EPC since in this context the term "arise" is to be construed broadly including any case where the amendment clearly brings into notice an ambiguity that may have existed all along (see decision T 472/88, point 2 of the reasons, not published in OJ EPO). This principle applies also when a feature of a dependent granted claim is incorporated into an independent claim thereby making visible that ambiguity in the amended independent claim (see decision T 420/00, point 3.6.3 of the reasons, not published in OJ EPO). Thus, in the present case, the amended independent claims of the first, second and fourth auxiliary request are to be examined as to any unclarity, which was concealed in dependent granted claim 7, but becomes visible after the incorporation of the feature of this claim into those independent claims.

Therefore, the Board has the power to decide on the matter of clarity pursuant to Article 84 EPC with respect to the amendment made to independent claims 1 and 11 of the first, second and fourth auxiliary requests, respectively, which power has explicitly not been challenged by the Appellant.

5.3 In the present case, amended claim 1 of the first auxiliary request defines the claimed product twofold, i.e by way of the combined general formulae (i) and (ii) and by way of the fresh wording of "a substantially linear or cyclic diorganosiloxane polymer" (cf. points I and IV *supra*). The Appellant and the Respondent had divergent views on the matter of clarity of that claim.

5.3.1 The general formula (i) comprises the index a having the values 0, 1 or 2, and the general formula (ii) comprises the index b having the values 0, 1, 2 or 3. When the index a takes the value 0 and the index b the value 1, then the general formulae (i) and (ii), respectively, specify a monoorganosiloxane polymer which fact has been conceded by the Appellant. This finding, however, is inconsistent with the other definition of the polymer in that amended claim, namely that it is a "diorganosiloxane".

5.3.2 When either the index a takes the value 0 or the index b the values 0 or 1, then the general formulae (i) and (ii), respectively, specify a branched or crosslinked organosiloxane polymer which fact has not been disputed by the Appellant. This finding, however, generates in that amended claim another inconsistency since it is contrary to the definition of the polymer as being "linear or cyclic".

The Appellant argued that the polymer was defined as being only "substantially" of a linear or cyclic structure thereby including the presence of minor amounts of non-linear or non-cyclic units without generating any inconsistency. However, in the present case the term "substantially" merely means that the polymer should have a structure as linear or cyclic as is practically and realistically feasible thereby precluding the avoidable or even deliberate presence of any non-linear or non-cyclic unit in the polymer. In contrast thereto, the general formulae (i) and (ii) in that claim explicitly cover branched or crosslinked polymers having a non-linear or non-cyclic structure. For that reason, the Appellant's argument cannot convince the Board.

5.4 Article 84 EPC requires that the claims shall be clear and define the matter for which protection is sought. This serves the purpose of ensuring that the public is not left in any doubt as to which subject-matter is covered by a particular claim and which is not. From this principle of legal certainty, in the Board's judgement, it follows that a claim is not clear in the sense of Article 84 EPC if it does not unambiguously allow this distinction to be made. A claim which comprises features contradicting one another entails doubts as to the subject-matter actually covered by that claim. Thus, for the reason of lack of legal certainty, such a claim is not clear in the sense of Article 84 EPC.

In the present case, the subject-matter of claim 1 according to the first auxiliary request is defined by different features, namely by the combined general formulae (i) and (ii), on the one hand, and by the substantially linear or cyclic structure of the polymer and the diorganosiloxane units thereof, on the other. However, those different features conflict with each

other for the reasons set out above in detail with the consequence that this conflict renders the actual subject-matter covered by that claim opaque.

5.5 On the ground of that lack of legal certainty, in the Board's judgement, claim 1 of the first auxiliary request fails to meet the requirement of clarity imposed by Article 84 EPC. As a result thereof, the Appellant's first auxiliary request is not allowable.

6. Both, the second and fourth auxiliary request comprise independent claim 11 which is directed to a cosmetic composition comprising the substantially linear or cyclic diorganosiloxane polymer as defined in claim 1 according to the first auxiliary request. Therefore the considerations having regard to clarity set out in points 5.3 and 5.4 *supra* and the conclusion drawn in point 5.5 *supra* with respect to claim 1 of the first auxiliary request apply also to claim 11 of both the second and fourth auxiliary request, i.e. the actual subject-matter claimed is unclear.

In these circumstances, the Appellant's second and fourth auxiliary request share the fate of the first auxiliary request in that they too are not allowable for lack of clarity pursuant to Article 84 EPC.

Apportionment of costs

7. The Respondent requested that the costs he incurred by the presence of two technical experts at the oral proceedings before the Board should be reimbursed by the Appellant. The Respondent alleged that these additional costs were due to the Appellant's late filing of three comparative test reports on 25 February 2003.

Apportionment of costs is governed by Article 104(1) EPC which provides that each party to the proceedings shall meet its own costs, unless for reasons of equity a different apportionment of costs incurred in oral proceedings is ordered. In the present case, however, the Respondent requested that the Appellant's three test reports be not admitted in the proceedings for the reason of their late filing and their lack of relevance. The Board granted the Respondent's request and did not admit these test reports into the proceedings (cf. point 2 *supra*). In the Board's judgement, an additional award of costs allegedly incurred by experts for optionally addressing at the oral proceedings those test reports which the Respondent himself held to be of no relevance for the present decision and which, hence, were not detrimental to the Respondent's case, would not meet the requirement of equity of Article 104(1) EPC.

Under these circumstances, the Board sees no reason of equity to divert from the principle that each party should bear the costs it has incurred for the appeal proceedings. The Respondent's request for apportionment of costs must therefore be rejected.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

2. The request for reimbursement of costs is rejected.

The Registrar: The Chairman:

N. Maslin A. Nuss