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D E C I S I O N
of 23 June 2005

Case Number: T 0740/01 - 3.3.2

Application Number: 95925906.0

Publication Number: 0771188

IPC: A61K 7/50

Language of the proceedings: EN

Title of invention:
Soap composition

Patentee:
UNILEVER PLC, et al

Opponent:
L'OREAL

Headword:
Soap composition/UNILEVER PLC, et al.

Relevant legal provisions:
EPC Art. 83, 54
EPC R. 57a

Keyword:

"Sufficiency of disclosure - yes: no substantiated evidence to the contrary"

"Main request - novelty - no: undefined feature does not enable a distinction from the prior art"

"First auxiliary request - admissibility: no - "cosmetic" modification"

"Second auxiliary request - novelty - no: no evidence of distinguishing feature over the prior art"

"Third auxiliary request - novelty - yes: novelty of selection"

"Remittal - yes: unexamined ground of opposition"

Decisions cited:

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Catchword:

-



Case Number: T 0740/01 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 23 June 2005

Appellant:
(Proprietor of the patent)

UNILEVER PLC
Unilever House
Blackfriars
London EC4P 4BQ (GB)

Representative:

Elliott, Peter William
Unilever PLC
Unilever Intellectual Property Group
Colworth House
Sharnbrook
Bedford MK44 1LQ (GB)

Respondent(s):
(Opponent)

L'OREAL
14, Rue Royale
F-75008 Paris (FR)

Representative:

Dossmann, Gérard
Bureau D.A. Casalonga-Josse
Paul-Heyse-Strasse 33
D-80336 München (DE)

Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 27 April 2001
revoking European patent No. 0771188 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
J. H. P. Willems

Summary of Facts and Submissions

- I. European patent No. 0 771 188 based on application No. 95 925 906.0 was granted on the basis of 7 claims.

Independent claim 1 as granted read as follows:

1. An aqueous liquid cleansing and moisturising composition comprising:-
- a) from 5 to 35% by weight of a C₈ to C₂₂ fatty acid;
 - b) from 0 to 10% by weight of a surface active agent;
 - c) a benefit agent having a weight average particle size in the range 15 to 500 microns; and
 - d) a structurant selected from the group consisting of materials which cause the composition to adopt the lamellar phase; materials which structure the continuous liquid phase; and mixtures thereof; the composition being substantially free of insoluble solid fatty acid or fatty acid soaps.

- II. Notice of opposition was filed against the granted patent.

The patent was opposed under Article 100(a) EPC for lack of novelty and lack of inventive step and under Article 100(b) EPC for insufficiency of disclosure.

The following document was *inter alia* cited during the proceedings.

- (1) WO-A-9401084

III. The decision of the Opposition Division pronounced on 14 February 2001 revoked the patent under Article 102(1) EPC.

The Opposition Division considered that the contested patent as granted was disclosed in a manner sufficiently clear and complete, so that a skilled person could carry it out.

It did not follow up the opponent's arguments that the claims contained a number of vague terms, firstly, because these terms were well-known in the art and, secondly, because they were defined in the description.

Nor did it agree with the opponent that there was a contradiction between the requirement in the claims that the claimed composition must be free of insoluble solid fatty acids and fatty acid soaps and the fact that a number of the fatty acids falling within the claimed range of fatty acids were solid in their free form at room temperature.

In its opinion, as the solubility of a free fatty acid changes in the composition because of the presence of the other ingredients and also when it is converted into a soap as foreseen in the claims, the mere fact that the claims embraced some fatty acids which were solid in their free form at room temperature did not *a priori* prevent the skilled person from carrying out the invention.

It however held that the patent in suit must be revoked because neither the set of claims as granted nor the set of claims of auxiliary request II were novel

vis-à-vis document (1). In its view, neither the feature "substantially free of insoluble fatty acid or fatty acid soaps" in the main request, nor the feature "comprising at least 30% wt free fatty acid based on the total level of fatty acid" introduced in the auxiliary request were suitable for differentiating the claimed subject-matters from the subject-matter of document (1).

It moreover rejected auxiliary requests I and III presented during the oral proceedings as late filed, because the amendments in these requests did not *prima facie* overcome the novelty objection vis-à-vis document (1).

IV. The appellants (patentees) lodged an appeal against the said decision.

V. Oral proceedings were held before the Board on 23 June 2005 during which a main request as well as auxiliary requests 1 to 4 were submitted by the appellants.

The sets of claims of these requests are the ones which were mentioned in the grounds of appeal.

Independent product claim 1 of the main request corresponds to independent claim 1 as granted.

Independent product claim 1 of auxiliary request 1 corresponds to independent claim 1 as granted, wherein the term "crystalline" has been added in the last line between the words "insoluble" and "solid".

Independent product claim 1 of auxiliary request 2 corresponds to independent claim 1 as granted, wherein the wording "being substantially free" has been replaced by "containing less than 2% by weight".

Independent product claim 1 of auxiliary request 3 corresponds to independent claim 1 of auxiliary request 1, wherein the wording "and comprising at least 30% weight free fatty acid based on the total level of fatty acid" has been added at the end of the claim.

- VI. As to sufficiency of disclosure, the appellants shared the Opposition Division's view that the skilled person could perform the claimed invention in the light of the process and the working examples described in the contested patent. It moreover insisted on the fact that the respondent did not provide any concrete evidence to the contrary.

Concerning the novelty objection vis-à-vis document (1), it submitted that document (1) was not relevant for the assessment of novelty of the claimed subject-matter since this document was directed to dispersoidal liquid soap, ie composition containing insoluble potassium fatty acid soap, whereas the contested patent concerned liquid soap being, to the contrary, "substantially free of insoluble solid fatty acid or fatty acid soap".

- VII. The respondent contested the conclusions of the Opposition Division as to sufficiency of disclosure. It repeated its main arguments in that respect, namely that the patent did not provide a teaching enabling the preparation of liquid soap containing the ingredients

of claim 1 and being at the same time "substantially free of insoluble solid fatty acid or fatty acid soap" for all the possible ingredients falling under the claim.

It agreed with the Opposition Division's conclusions that the feature "substantially free of insoluble solid fatty acid or fatty acid soap" was not a feature distinguishing the subject-matter of claim 1 as granted from the disclosure in document (1).

As to auxiliary request 1, it contested its admissibility under Rule 57a EPC. In its opinion, the term "crystalline" added to claim 1 did not change the scope of the claim, so that this request could not be a response to a ground of opposition.

Concerning auxiliary request 2, it considered that claim 1 was still anticipated by the disclosure in document (1).

With respect to auxiliary request 3, the respondent maintained only an objection under Article 84 EPC against the feature "comprising at least 30% weight free fatty acid based on the total level of fatty acid" introduced in claim 1.

VIII. The appellants requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, alternatively, on the basis of auxiliary requests 1, 2, 3 or 4 as filed during the oral proceedings.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

2.1 Article 84 EPC

Article 84 EPC is not a ground of opposition under Article 100 EPC. Accordingly, the Board has to deal with the claims as they stand - unless new amendments are introduced.

The Board observes in the present case that claim 1 of the contested patent contains a feature a) requiring that the composition contains "from 5 to 35% by weight of a C₈ to C₂₂ fatty acid" and that its dependent claim 6 requires that "the composition comprises at least 30%wt free fatty acid based on the total level of fatty acid".

It must be concluded therefrom that the skilled person could only understand that the term "fatty acid" present in claim 1 is used as a generic term including fatty acid in free form and in non free forms such as soap.

The Board notes also that claim 1 contains the feature requiring that the composition be "substantially free of insoluble solid fatty acid or fatty acid soaps". Neither the claims nor the description provide for a sharp definition of the term "substantially". Indeed

the only information in that respect given in the description of the patent in suit at page 2, lines 31 to 34, refers to an amount being "preferably... below 2%" or that it is such "that it does not interfere with the deposition of the benefit agent".

Under these circumstances, it must be up to the appellants to demonstrate that a *a priori* relevant prior art item does not fulfil this criteria.

In that respect, the Board also observes that examples C and D of the description of the contested patent are referred to as being "comparative" examples, namely examples falling outside the scope of the claimed invention.

However, since the amount of solid fatty acid present in these examples is not mentioned and since the examples of compositions falling within the scope of the claim also interfere - although to a lesser extent - with the deposition of the benefit agent (see examples I, II), there is in fact nothing to indicate that examples C and D are compositions falling outside the scope of claim 1.

2.2 Article 100(b) EPC

The Board shares the Opposition Division's arguments and conclusion as to the sufficiency of disclosure as given in its decision (points 1.1 to 1.4).

In that respect, the Board agrees with the respondent that it is indeed very unlikely that a composition containing the higher fatty acids falling within

claim 1 would also fulfil the requirement of claim 1 that it must be "substantially free of insoluble solid fatty acid or fatty acid soaps", as most of these higher fatty acids are solid and insoluble in water at room temperature.

This would, however, have as sole consequence that such a composition would not be a composition falling within the scope of claim 1. This statement does not, in any case, demonstrate that it is impossible or hardly possible to prepare compositions fulfilling all the requirements of claim 1, which is in fact the only point at issue when it comes to the assessment of sufficiency of disclosure.

Accordingly, since the respondent did not present any concrete element to show that the information given in the application and in particular in the examples was not sufficient to prepare compositions as claimed or that it was indeed an unduly difficult task to find the necessary conditions and ingredients to achieve a composition according to claim 1, the Board concludes that the requirements of Article 100(b) EPC are fulfilled.

2.3 Novelty

Document (1) has been cited as prejudicial to the novelty of the subject-matter of claim 1 of the patent in suit.

Document (1) discloses in examples 1 to 3 an aqueous liquid cleansing and moisturising composition comprising:

from 5 to 35% by weight of a C₈ to C₂₂ fatty acid (eg example 1: 0.9% C₁₄ + 0.9% C₁₂ and 20% potassium soap) and a benefit agent having a weight average particle size in the range 15 to 500 microns (eg example 1: 2,7% petrolatum with an average size of between 45 and 120 microns (claim 1)).

Accordingly, the Board agrees with the parties and the Opposition Division that the only relevant feature for the assessment of novelty remain the feature of claim 1 requiring that the composition must be "substantially free of insoluble solid fatty acid or fatty acid soaps".

Having regard to the fact that all the ingredients and the amounts of ingredients used in the compositions of examples 1 to 3 of document (1) fall within the scope of claim 1 of the contested patent and in the light of the only information available in the patent relating to the meaning of the term "substantially" (see point 2.1 above), the Board has, in the absence of any evidence to the contrary, no reason to doubt that these compositions are also substantially free of insoluble solid fatty acid or fatty acid soaps.

Accordingly, the Board concludes that the subject-matter of claim 1 of the patent in suit is anticipated by the disclosure in document (1).

The Board does not agree with the appellants' submission that claim 1 is novel merely because document (1) relates to a dispersoidal liquid soap.

It is indeed correct that document (1) requires that "at least some of the fatty matter at the levels used [in the compositions] is insoluble".

This does not however imply that this amount of insoluble fatty matter required in document (1) is indeed above the amount "substantially free" as defined in the contested patent.

In that respect, the Board observes that the amount of free fatty acids (ie 0.9% C₁₂ and 0.9% C₁₄ of example 1 of document (1) is as low as 1,8 weight %.

Since the appellants did not contest the respondent's observation made during the oral proceedings that the potassium soap of these acids is water-soluble (ie 20% in example 1 of document (1)), the Board has no reason not to follow the respondent's calculation that there should be at the most only 1,8% insoluble solid fatty acid in example 1 of document (1).

In fact, it was the choice of the appellants to seek to establish novelty over the prior art by means of this unusual parameter and to provide very little information about its definition in the patent. It is therefore its task to demonstrate that the prior art does not fulfil this condition.

In conclusion, the subject-matter of claim 1 of the main request is not novel under Article 54 EPC. There is therefore no need to examine the other claims.

3. *First auxiliary request*

3.1 Rule 57a EPC

As is apparent from point 2.1 of the Opposition Division's decision the term "crystalline" has been considered as being equivalent to the term "solid" in the context of fatty acid.

This has not been contested by the appellants.

Under these circumstances, this modification has to be regarded as a "cosmetic" amendment which, as a rule, cannot be considered to be occasioned by grounds for opposition as required under Rule 57a EPC.

Accordingly, auxiliary request 1 is not admitted into the proceedings.

4. *Second auxiliary request*

4.1 Novelty

In this set of claims the amount of insoluble solid fatty acids or fatty acid soaps present in the compositions of the patent in suit has been restricted to an amount "less than 2% by weight".

However, as is apparent from the above (see point 2.3), in the absence of any evidence showing that the amount of insoluble solid fatty acids or fatty acid soaps in document (1) and in particular in example 1 is indeed above 2%, the conclusions reached for the main request also hold good for this request.

5. *Third auxiliary request*

5.1 Article 84 EPC

The only objection maintained against this request by the respondent related to the feature "comprising at least 30% weight of free fatty acid based on the total level fatty acid" introduced in claim 1.

As this feature is a feature of claim 6 as granted, which was dependent on claim 1, the clarity problem raised by the respondent was already present in the set of claims as granted and the Board is therefore not entitled to deal with that issue at this stage of the procedure (see however the Board's comment in that respect under point 2.1).

5.2 Novelty

Claim 1 of this set of claims now requires that the composition contains "at least 30% weight free fatty acid based on the total level of fatty acid".

The Board notes that all the examples described in document (1) contain less than 30% weight of free fatty acid based on the total level of fatty acid and that this particular relationship between free fatty acid and the total amount of fatty acid is neither explicitly disclosed nor implicitly derivable from document (1).

In that respect, the Board observes however that the ranges given in claim 1 of document (1) (namely 5% to 20% by weight of potassium C₈-C₂₂ fatty acid soap and 0.1 to 7% of C₈-C₂₂ free fatty acid) overlap to a certain extent with the new feature of claim 1 of the patent in suit.

Accordingly, it appears that this feature is in fact, at least in part, a selection within the conceptual ranges of document (1), which might be of relevance for the assessment of inventive step.

Since the respondent did not maintain its novelty objection vis-à-vis document (1) with respect to this request, there is no need to develop this point further.

6. *Remittal*

Although Article 111(1) EPC does not guarantee the parties an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party should preferably be given the opportunity to have two readings of the important elements of the case. The essential function of an appeal in *inter partes* proceedings is to consider whether the decision which has been issued by the first-instance department is correct. Hence, a case is normally referred back, if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is taken into consideration by the boards in cases where a first-instance department issues a decision solely upon one particular issue which is decisive for the case against a party and leaves other essential issues outstanding. If, following appeal proceedings, the appeal on the particular issue is allowed, the case is normally remitted to the first- instance department for consideration of the undecided issues.

The observations and comments made above apply fully to the present case. The Opposition Division decided that claim 1 was not patentable on the grounds of lack of novelty but left out the essential issue of inventive step (Articles 52(1), 56 EPC). This issue, however, forms, *inter alia*, the basis for the requests of the respondent that the patent be revoked in its entirety and must therefore be considered as an essential substantive issue in the present case.

Thus, in view of the above considerations, the Board has reached the conclusion that, in the circumstances of the present case it is necessary to remit the case to the Opposition Division for further prosecution on the basis of the set of claims of the third auxiliary request filed during the oral proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of auxiliary request 3.

The Registrar:

The Chairman:

U. Bultmann

U. Oswald