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**Datasheet for the decision
of 30 March 2007**

Case Number: T 1069/02 - 3.3.06

Application Number: 94921326.8

Publication Number: 0702550

IPC: A61K 7/50

Language of the proceedings: EN

Title of invention:

Personal cleansing system comprising a polymeric diamond-mesh bath sponge and a liquid cleanser with moisturizer

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponents:

Johnson & Johnson Consumer Companies, Inc.
Colgate-Palmolive Company

Headword:

Cleansing kit/PROCTER

Relevant legal provisions:

EPC Art. 56

Keyword:

"Inventive step (all requests) - no: obvious combination"

Decisions cited:

-

Catchword:

-



Case Number: T 1069/02 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 30 March 2007

Appellant I: Johnson & Johnson Consumer Companies, Inc.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
23 July 2002 concerning maintenance of European
patent No. 0702550 in amended form.

Composition of the Board:

Chairman: P.-P. Bracke
Members: P. Ammendola
A. Pignatelli

Summary of Facts and Submissions

I. This appeal is from the interlocutory decision of the Opposition Division concerning the maintenance in amended form of European patent No. 0 702 550, relating to a personal cleansing system.

II. The two Opponents had sought revocation of this patent on the grounds of Articles 100(a), (b) and (c) EPC. In particular, the objections of lack of inventive step (Article 100(a) EPC in combination with Articles 52(1) and 56 EPC) were based, *inter alia*, on documents:

D13e = advertising of "Bodykiss®" in "Over The Counter" of November / December 1992,

D14 = WO 93/09761,

D16 = Commercial catalogue of "Bilange" referring to the "Bilange Body Sponge".

III. In its decision, the Opposition Division found that the patent as amended according to the then pending main request of the Patent Proprietor met the requirements of the EPC.

In particular, the skilled person starting from the cleansing and moisturizing compositions of document D14 and aiming at personal cleansing systems with improved lathering and improved deposition of the conditioning and moisturising ingredient (hereinafter "conditioner") would have found in the available prior art no incentive to consider the possibility of simply applying the same compositions by means of a mesh sponge. On the contrary, the skilled person would have

been lead away from such possibility by the fact that sponges were known to counteract a sufficient deposit of the conditioner onto the skin.

IV. Both Opponent I (hereinafter Appellant I) and Opponent II (hereinafter Appellant II) lodged an appeal against this decision objecting *inter alia* that the opposition division had erred in identifying the technical problem credibly solved by the claimed system.

V. The Patent Proprietor (hereinafter Respondent) filed under cover of its reply to the grounds of appeal further experimental data in

E4 = declaration of Mannie Lee Clapp.

It finally filed under cover of its letter dated 30 January 2007 five sets of amended claims labelled respectively as main request and first to fourth auxiliary requests.

VI. It is sufficient for the present decision to consider the versions of claim 1 in these requests.

Claim 1 of the **main request** reads:

*"1. A personal bath or shower body cleansing system comprising, packaged together as a kit:
(A) a light weight polymeric mesh sponge; said polymeric mesh sponge being in a form suitable for use as a hand held personal cleansing implement, said hand held sponge having a diameter of from two (2) inches to eight (8) inches (.508cm to 20.32cm) ; and*

(B) a liquid cleanser having: (1) an oil phase comprising an effective amount of a skin conditioning and moisturising ingredient; and (2) an aqueous phase comprising an effective amount of a surfactant selected from soap and synthetic surfactants and mixtures thereof."

Claim 1 of the **first auxiliary request** differs from that of the main request only in that the wording "*and mixtures thereof.*" ending this latter is replaced by "*and mixtures thereof, wherein the skin conditioning and moisturizing ingredient comprises a hydrophobic material.*".

Claim 1 of the **second auxiliary request** differs from that of the main request only in that the wording "*and mixtures thereof.*" ending this latter is replaced by "*and mixtures thereof and wherein said liquid cleanser contains:*

from 0.5% to 15% by weight of a skin conditioner and moisturiser selected from: petrolatum, glycerine tri-esters, epidermal and sebaceous hydrocarbons, silicone oil, silicone gum, lanolin and derivatives, and mixtures thereof or

from 0.5% to 10% by weight of a skin conditioner and moisturiser selected from glycerine tri-esters; epidermal and sebaceous hydrocarbons such as cholesterol, cholesterol esters, squalene, squalane, lanolin and derivatives; mineral oil, silicone oil, silicone gum, and vegetable oil, and mixtures thereof."

Claim 1 of the **third auxiliary request** differs from that of the main request only in that the wording "*and mixtures thereof.*" ending this latter is replaced by

"and mixtures thereof and wherein the liquid cleanser contains from 0.5% to 15% by weight of a lipophilic skin conditioner and moisturiser selected from: petrolatum, glycerine tri-esters; epidermal and sebaceous hydrocarbons, silicone oil, silicone gum, lanolin and derivatives, and mixtures thereof the surfactant comprises surfactant selected from ethoxylated alkyl sulphates, Zwitterionic surfactants and amphoteric surfactants."

Claim 1 of the **fourth auxiliary request** differs from that of the main request only in that the wording of this latter "*cleansing system comprising*" is replaced by "*cleansing system consisting of*".

VII. The Appellants have presented, *inter alia*, the following arguments for disputing the inventiveness of the subject-matter of these claims.

The disclosure in D14 of the applicability of the same cleansing compositions of the presently claimed kit by means of (conventional) sponges would represent a reasonable starting point for the assessment of inventive step.

The advantages which derived from packaging together a mesh sponge and a skin conditioning cleanser (hereinafter "the two parts of the claimed kit") would be of manifestly obvious nature.

The sole technical advantage vis-à-vis the prior art that is actually mentioned in the patent in suit and that has actually been solved also vis-à-vis the prior art disclosed in D14 was that of allowing better

foaming when simultaneously cleansing and conditioning the body skin.

The fact that the claimed kits would produce more foaming than the prior art kits would however be obvious, because the superior foaming capability of mesh sponges vis-à-vis conventional sponges was one of the well-established advantages of the former over the latter, as evident from D13e or D16.

The further technical advantage alleged by the Respondent that the claimed kit would also be more effective in depositing the conditioner onto the skin would not be disclosed in the patent in suit.

The experimental data reported in E4 were in any case unsuitable for demonstrating the alleged superior efficiency of mesh sponges in depositing the conditioner.

A generally accepted prejudice against the use of sponges for applying conditioner-containing cleanser compositions would not exist.

VIII. The Respondent has conceded that the claimed kits could be obtained by packaging together mesh sponges and conditioner-containing cleansers already known in the prior art, such as the mesh sponges described in D13e or D16 and the cleansing and conditioning compositions disclosed in D14.

It has also conceded that the conditioner-containing compositions of D14 would represent an appropriate starting point for the assessment of inventive step and

that inventiveness of the claimed kits vis-à-vis this prior art would not lay in the fact *per se* that the conditioner-containing cleansers were packaged together with the mesh sponges, but rather in the instruction - embodied through such packaging - to use them in combination.

The Respondent has, however, refuted the Appellants' reasoning by arguing that, as also found by the Opposition Division, such combined use provided not only improved foaming during the body washing, but also an improved conditioning of the washed skin. Indeed, the achievement by the claimed kits of a skin conditioning improvement would be disclosed in the patent in suit and would necessarily imply an increase of the portion of conditioner contained in the cleanser that is actually deposited onto the skin during washing. The data reported in E4, filed with the Respondent's reply to the grounds of appeal, would demonstrate the superior level of deposition of the conditioner onto the skin achieved. The criticism of Appellant II of the suitability of these data for demonstrating this effect should be ignored by the Board as it had only been belatedly expressed for the first time at the oral proceedings before the Board.

The demonstrated skin conditioning improvement would be surprising since, as recognised by the Opposition Division too and indicated in paragraph 3 of the patent in suit, sponges were known to compete with the skin in retaining the hydrophobic conditioner.

In any case, the available prior art would not suggest to the skilled person that mesh sponges would deposit more conditioner than regular sponges. Hence, inventive

ingenuity was required to the skilled person for finding that a personal cleansing system providing simultaneously improved foaming and improved skin conditioning could be formed by combining the body cleansing compositions containing hydrophobic conditioners disclosed in D14 with the mesh sponges known from D13e or D16.

- IX. The Appellants have requested that the decision under appeal be set aside and that the European patent No. 0 702 550 be revoked.

The Respondent has requested that the patent be maintained on the basis of the claims of the main request or of those of the first to fourth auxiliary requests, all filed under cover of the letter dated 30 January 2007.

Reasons for the Decision

Inventive step (Article 100(a) EPC in combination with Articles 52(1) and 56 EPC)

Claim 1 of the Respondent's main request as well as claim 1 of any of the first to fourth auxiliary requests (see above section VI of the Facts and Submissions) define kits formed by packaging together a mesh sponge of certain dimensions with a multiphase liquid body cleanser containing a skin conditioner in an oil phase and a surfactant in an aqueous phase.

As admitted by the Respondent too, it is conventional to package a body cleanser together with the sponge for

its application and the advantages deriving from such packaging are obvious.

Hence, it is sufficient for the inventive step assessment of the present case to establish whether or not the available prior art renders obvious for the skilled person to apply by means of mesh sponges liquid body cleansing compositions containing a hydrophobic conditioner, as defined in claim 1 according to any of the versions in the Respondent's main and auxiliary requests.

1. Relevance of the Appellants' objection based on the combination of D14 with D13e or D16 (see section VII of Facts and Submissions) for the subject-matter of claim 1 of all requests.

The Board notes that the combined cleansing and conditioning composition described in example I of D14 contains 0.5% by weight petrolatum in a oil phase and a zwitterionic surfactant (betaine) in an aqueous phase. Hence, this citation discloses cleansing compositions as defined in claim 1 according to any of the versions in the Respondent's requests.

As also the mesh sponges as described in D13e or D16 were undisputedly already available to the public before the filing date of the patent in suit, the Board concludes that, as observed by the Appellants and explicitly conceded by the Respondent, claim 1 according to **any** of the versions in the Respondent's requests embraces kits formed by packaging together these previously known cleansing compositions and these previously known mesh sponges. Hence, the Appellants'

objection based on the combination of D14 with D13e or D16 applies to all Respondent's requests.

2. Technical problem described in the patent in suit
- 2.1 The Board notes that the patent in suit, after having recognised the difficulties in obtaining simultaneously skin conditioning and cleansing (see paragraphs 6 and 10) identifies an advantage of the invention over the prior art in the **superior lather** (foaming) observed when applying the conditioner-containing cleanser of the kit onto the body skin by means of the mesh sponge rather than by means of a conventional sponge (see paragraphs 12, 21 and 85 to 87).
The parties have not disputed this.
- 2.2 They have instead disagreed as to whether or not the patent in suit discloses that the use of the claimed kit would also result in an **improved skin conditioning** vis-à-vis the methods of the prior art for simultaneously cleansing and conditioning the body.

However, it is apparent to the Board that the parties in their reasoning have referred to two distinct ways of improving skin conditioning.

On the one side, it has been considered the improvement of skin conditioning originating from the advantageous property of certain conditioner-containing cleansing **compositions** to be more effective in conditioning the washed skin than other (of course different) body cleansers. Hereinafter this advantage is indicated as "superior conditioning efficacy of the cleanser".

On the other side, it has been referred to the improvement of skin conditioning originating from the advantageous property of the **mesh sponges** to deposit on to the skin (rather than to absorb) a portion of the conditioner ingredient of a conditioner-containing cleansing composition that is larger than the corresponding portion of conditioner deposited onto the skin when applying the same composition by means of conventional sponges. Hereinafter this advantage is indicated as "superior deposition efficiency of the mesh sponge".

- 2.2.1 The Board notes that the sole improvement in skin conditioning vis-à-vis the prior art that is explicitly mentioned in the patent in suit is that due to an (alleged) superior conditioning efficacy of - at least some of - the cleanser compositions used in the claimed kits in consequence of their **specific** chemical composition (see in paragraph 8 "*The present invention allows for the use of higher level of humectants in a "cleansing and moisturising" lathering liquid...*" and in paragraph 33 "*The compositions provide excellent-in-use and efficacy benefits including...improved mildness and skin conditioning.*").

However, the patent in suit itself (see paragraph 69) explicitly recognises that the prior art already comprises the **same** conditioner-containing body cleansing compositions used for forming the claimed kits, i.e. recognises that some cleansing systems of the prior art are based on cleansers having the **same** chemical composition - and thus, also necessarily **the same conditioning efficacy** - as those of the presently claimed kits.

The acknowledgment of this prior art is, therefore, in manifest contradiction with the above-cited expressions contained in paragraphs 8 and 33 which qualify as "*higher*" or "*improved*" vis-à-vis the prior art the conditioning efficacy provided by the cleansing compositions of the invention. Hence, these expressions lack plausibility.

2.2.2 Nor can an implicit disclosure of an improvement in skin condition be derived from paragraph 3 of the patent in suit, referred to by the Respondent in respect of the **superior deposition efficiency** (against conventional sponges, see above point 2.2) allegedly also provided by the claimed kits.

Indeed, the Respondent has argued that this paragraph would recall the drawbacks that, as conceded by the Opposition Division too, were generally known to affect the efficiency with which normal sponges deposit a hydrophobic conditioner onto the skin.

The Board notes however that the relevant sentences in paragraph 3 of the patent in suit (reading "*...Yet other instruments absorb the oil conditioner in cleansing and moisturizing products...Yet other instruments absorb the oil conditioner in cleansing and moisturizing products and thereby compete with the skin.*") neither identify the sponges in general, nor certain specific sponges, as the application instruments suffering of these drawbacks, nor is followed by any subsequent statement that the mesh sponges used in the claimed kits have been found to be free from the same drawbacks.

Hence, the skilled reader of the this vaguely worded paragraph can derive from it neither that mesh sponges

had been found superior to conventional sponges in deposition efficiency, nor any other element possibly suggesting that the use of the claimed kits ensured a level of skin conditioning superior to that already achieved in the prior art.

- 2.3 Hence, the Board concludes that the patent in suit does **not** disclose to its skilled reader that the use of the claimed kits results in a level of skin conditioning that is improved vis-à-vis the prior art and, thus, that the (sole) technical problem disclosed in the patent in suit as plausibly solved by the presently claimed kits is that of achieving an improved foaming when simultaneously cleansing and conditioning the skin.

3. Relevant prior art

As indicated already above (see point 1) D14 discloses cleansing compositions according to claim 1 in any of the versions in the Respondent's requests. The Board further notes that D14 not only describes their ability to produce abundant foam and to clean and condition the skin (see D14 e.g. page 3, lines 26 to 34), i.e. substantially the same effects aimed at in the patent in suit, but also their applicability, *inter alia*, by means of an unspecified - but, reasonably, conventional - sponge (see D14 page 11, lines 15 to 22).

Hence, the Board concurs with the parties that this disclosure in D14 represents a reasonable starting point for the assessment of inventive step.

Accordingly, the presently claimed kits differ from the relevant prior art only in that the former imply the

application of the liquid cleanser by means of the mesh sponge, whereas in D14 it is suggested to use a conventional sponge.

4. Technical problem solved

4.1 According to the jurisprudence of the Boards of Appeal (see The Case Law of the Boards of Appeal, 5th Edition, 2006, I.D.4.3.2 and I.D.4.4) in the assessment of inventiveness one should normally start from the technical problem described in the contested patent. However, it may turn out appropriate to consider also other technical problems, provided that these latter could be recognised by the skilled person as implied or related to the problem initially suggested in the patent.

4.2 As indicated already above (see points 2.1 and 2.3), the technical problem credibly disclosed in the patent in suit as addressed by the invention is that of providing improved foaming while washing the body skin with a conditioner-containing cleanser.

The Board concurs with the parties that the claimed kits have actually solved this problem also vis-à-vis the above-identified relevant prior art.

4.3 The Respondent has argued however that, as stated in the decision under appeal, the claimed kits would also simultaneously achieve an improved conditioning of the washed body skin. This advantageous effect would result from the superior deposition efficiency of the claimed kits that would be proven by the experimental evidence in E4 (vis-à-vis the application by means of

conventional sponges of the same cleansers forming the claimed kits).

4.3.1 However, as discussed above in points 2.2.1 and 2.2.2, the statements in paragraphs 8 and 33 of the patent in suit that the conditioning efficacy of the cleansing compositions of the invention would actually be "*improved*" are **not** plausible. Nor is a superior deposition efficiency of the mesh sponge either explicitly described or implied therein.

4.3.2 Nevertheless, the Respondent has considered that such superior deposition efficiency would be considered by the skilled person as a technical effect necessarily **related** to the superior conditioning efficacy mentioned in the above-cited statements in paragraph 8 and 33.

However, even if one had arbitrarily disregarded the lack of plausibility of these statements, it remains not evident to the Board how an effect which must necessarily originate exclusively from a property of the mesh sponge, could be considered necessarily related to an (alleged) effect that the patent in suit attributes to the chemical composition of the other part of the kit only, i.e. to the conditioner-containing cleansing composition (see above points 2.2 and 2.2.1).

4.3.3 Under these circumstances, even if E4 could possibly represent a convincing evidence that mesh sponges are surprisingly more effective than conventional sponges in depositing onto the skin conditioning ingredients, this would amount to an unexpected technical advantage that was however **undisclosed** in the patent as granted

and **unrelated** to any of the technical advantages of the invention possibly disclosed in the patent in suit (including those which immediately appear to lack any credibility).

Therefore, the superior deposition efficiency allegedly proven by the data in E4 cannot possibly be considered relevant for the identification of the technical problem credibly solved by the patented invention vis-à-vis the prior art disclosed in D14.

4.3.4 For the sake of completeness, the Board wishes however to add that the data provided in E4 are neither convincing nor sufficient to render credible a superior deposition efficiency of all claimed kits. In particular, it is not apparent to the Board why in the reported experiments the liquid cleanser has been applied directly onto the skin and then washed with the sponge (rather than directly applied by means of the sponge onto the skin) and why the sole composition used in E4 should be considered representative for the broad definition of this part of the kit according to claim 1 of all requests.

4.4 Accordingly, the Board finds that the Opposition Division has erred in identifying the technical problem solved by the claimed kit as including the achievement of an improved deposition of the conditioner, whereas the sole technical problem credibly addressed in the patent in suit and actually solved vis-à-vis the prior art is that of rendering available a skin conditioning body cleansing system providing **improved foaming**.

5. Obviousness of the solution

5.1 Hence, the assessment of inventive step boils down to the question as to whether the skilled person starting from the disclosure of D14 would have replaced the conventional sponge used therein (see above point 3.3) by the mesh sponges of D13e or D16 in the expectation to achieve improved foaming, when simultaneously cleansing and conditioning the skin.

5.2 As conceded by the Respondent too, the fact that mesh sponges allow for a maximised foaming of body cleansing compositions was already known to the skilled person before the filing date of the patent in suit (see e.g. the advertisements in D3 and D16). Hence, it was evident to the skilled person searching for a solution to the posed problem, that mesh sponges were able to provide the desired effect.

5.3 The Respondent has argued, instead, that there would exist in the technical field a generally accepted prejudice, recognised also in the decision under appeal and recalled in paragraph 3 of the patent in suit, against the use of sponges for applying cleansing compositions containing (hydrophobic) conditioners.

However, since the existence of such prejudice has been contested by the Appellants, the Respondent's reasoning would only be convincing in the presence of evidence supporting this latter.

No evidence for such prejudice has been provided by the Respondent.

Moreover, even if the Opposition Division has recognised the existence of such prejudice, the decision under appeal does not indicate any reasons for such conclusion. Therefore, this recognition is devoid of any factual basis and cannot be considered as evidence in favour of the Respondent.

Even if such prejudice were to be clearly expressed in paragraph 3 of the patent in suit, it would not represent sufficient evidence to demonstrate its general acceptance in the field. The Board wishes to additionally stress, however, that such prejudice is not even clearly expressed therein since, as indicated already above (see point 2.2.2), the wording of paragraph 3 is too vague to allow to identify the nature of the application tools competing with skin in absorbing the conditioner.

On the contrary, the fact that in D14 sponges are mentioned as a suitable means for applying body cleansers containing hydrophobic skin conditioners appears rather to suggest that no such generally accepted prejudice against the use of sponges would apply at least to the starting prior art.

Hence, the Board concludes that, in the absence of any supporting evidence, the prejudice that sponges were known in general to affect the level of skin conditioning achievable with conditioner-containing cleansers has not been proved.

For the sake of completeness the Board wishes to stress that even if such a prejudice had actually existed against sponges in general, it would at most apply to

conventional sponges. Indeed, the dramatic structural differences distinguishing mesh sponges from any conventional (natural or synthetic) sponge are such that the skilled person could not reasonably foresee whether such (hypothetical) prejudice would extend also to this other application tool whose structure is totally different from that of conventional sponges. Nor is sufficient for the such extension the simple fact that such a tool had been labelled as "*mesh sponge*". It is interesting to observe in this respect that even the skilled author of the submission E4 filed by the Respondent's has considered appropriate to identify the mesh sponge as "*puff implement*", thereby implicitly confirming the evidently different nature of this latter vis-à-vis any other conventional sponge.

5.4 The Board finds, therefore, that it was obvious for the skilled person to solve the existing technical problem of achieving improved foaming during the washing with the liquid body cleansing compositions containing hydrophobic conditioner described in D14, by replacing the sponge disclosed in this citation by the mesh sponges disclosed in D13e or D16.

5.5 Hence, and taking into account the considerations already made above (see point 1.2), the Board concludes that the subject-matter of claim 1 according to any of the versions in the main request or first to fourth auxiliary requests of the Respondent does not involve an inventive step. Hence, none of these requests is found to comply with the requirements of Articles 52(1) and 56 EPC.

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:

G. Rauh

P.-P. Bracke