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**Datasheet for the decision
of 12 September 2007**

Case Number: T 0173/05 - 3.3.10

Application Number: 97926003.1

Publication Number: 0914086

IPC: A61K 7/48

Language of the proceedings: EN

Title of invention:

Cosmetic compositions containing a siloxane elastomer

Patentee:

UNILEVER PLC, et al

Opponent:

L'OREAL
HENKEL KGaA

Headword:

Skin treatment composition/UNILEVER

Relevant legal provisions:

EPC Art. 56, 123(2)(3)
RPBA Art. 10(b)(1) and (3)

Keyword:

"Main and auxiliary requests 1 to 4 (not admitted): late filed
- not clearly allowable - added subject-matter / extension of
protection conferred"
"Auxiliary request 5 (admitted): inventive step (no) -
foreseeable improvement of properties"

Decisions cited:

T 0002/81, T 0153/85

Catchword:

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Case Number: T 0173/05 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 12 September 2007

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
24 November 2004 concerning maintenance of
European patent No. 0914086 in amended form.

Composition of the Board:

Chairman: P. Gryczka
Members: J. Mercey
P. Schmitz

Summary of Facts and Submissions

- I. The Appellant (Opponent I) lodged an appeal on 27 January 2005 against the interlocutory decision of the Opposition Division posted 24 November 2004 which found that European patent No. 914 086 in amended form met the requirements of the EPC.
- II. Notice of Opposition had been filed by the Appellant requesting revocation of the patent in its entirety on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC). *Inter alia* the following document was submitted in opposition proceedings:
- (4) EP-A-381 166.
- III. The Opposition Division decided that the subject-matter according to the then pending main request fulfilled the requirements of Article 123(2) EPC and was novel and inventive over *inter alia* document (4).
- IV. At the oral proceedings before the Board, held on 12 September 2007, the Respondent (Proprietor of the patent) defended the maintenance of the patent in suit in amended form on the basis of a main request and auxiliary requests 1 to 5, all submitted during these oral proceedings and superseding any previous requests. The main request comprised a set of four claims, independent claim 1 reading as follows:

"1. A skin treatment composition comprising:
I. From 0.1 to 30% of a crosslinked non-emulsifying siloxane elastomer;
II. From 1 to 50% of a humectant that is a polyhydric alcohol;
III. From 30 to 80% of a volatile siloxane; and
IV. From 0 to 5% of water."

Claim 1 of auxiliary requests 1 and 2 differed from claim 1 of the main request exclusively in the amount of the humectant and claim 1 of auxiliary requests 3 and 4 exclusively in the upper limit for the water content. Claim 1 of auxiliary request 5 differed from claim 1 of the main request exclusively in that the humectant was glycerin.

V. The Appellant argued that the requests were not allowable, since the subject-matter thereof did not fulfil the requirements of either Article 123(2) or (3) EPC. More particularly, the lack of specification that the humectant was a skin conditioning agent in component II of the claimed composition, only humectants having this additional property being disclosed in the application as filed (cf. claims 1 and 2 and page 7, lines 5 to 8), led to subject-matter which extended beyond the content of the application as filed. Since in granted claim 1, component II was also restricted to skin conditioning agents, the subject-matter of claim 1 of all the requests additionally extended the protection conferred by the patent as granted.

The Appellant submitted that the subject-matter of claim 1 of auxiliary request 5 was not inventive in the

light of the disclosure of document (4), more particularly the cosmetic composition of Application Example 1 thereof. The Appellant argued that the skilled person, faced with the problem of providing a skin treatment composition with improved hydrating properties whilst retaining the positive skin feel and stability characteristics of the composition would have added glycerin to such a composition, since document (4) itself taught the addition of a humidistat agent such as glycerin to the cosmetic composition described therein. The amount of 1 to 50% of glycerin was merely arbitrary.

VI. The Respondent submitted that the amendments to all requests met the requirements of Articles 123(2) and (3) EPC. More particularly, there were no polyhydric alcohols which were humectants and not skin conditioning agents, such that the omission of said latter feature neither added subject-matter which extended beyond the content of the application as filed, nor extended the protection conferred by the patent as granted.

The Respondent argued that the subject-matter of auxiliary request 5 was inventive over the disclosure of document (4). The skilled person would not however have started from the oily foundation of Application Example 1 thereof, since this was a make-up and not a skin treatment composition, but rather from Application Example 3, which was a moisturizing cream. With respect to Application Example 1, the Respondent conceded that the only difference between this composition and that according to claim 1 was the presence of glycerin. However, there was no motivation in document (4) to add

glycerin to the oily foundation disclosed therein and no indication was given in said document as to what should be omitted in order to add the glycerin.

Furthermore, in view of the fact that glycerin was water miscible and soluble, the skilled person would have expected stability problems when adding it to an oil-based composition and would thus also have added water to the composition.

VII. The Appellant requested that the decision under appeal be set aside and the patent be revoked.

The Respondent requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or any of auxiliary requests 1 to 5, all filed during the oral proceedings before the Board.

VIII. Oral proceedings were held in the absence of the party as of right (Opponent II), who, after having been duly summoned, informed the Board with a letter dated 11 June 2007 that it would not attend. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of requests*

2.1 All requests were filed during oral proceedings before the Board.

2.2 Admission into the proceedings of a request filed at such a late stage of the appeal proceedings is a matter of discretion for the Board of Appeal and is not a matter as of right (cf. Article 10(b)(1) of the Rules of Procedure of the Boards of Appeal (below RPBA)). In exercising due discretion, it is established jurisprudence of the Boards of Appeal that one crucial criterion is whether or not the amended claims of those requests are clearly allowable (see T 153/85, OJ EPO 1988, 1, points 2.1 and 2.2 of the reasons).

Main and auxiliary requests 1 to 4

2.3 In amended claim 1 of each of these requests, component II of the claimed composition is defined as "a humectant that is a polyhydric alcohol", whereas throughout the application as filed, component II is always additionally specified as being a skin conditioning agent. Since it has not been established that all polyhydric alcohols that are humectants are also necessarily skin conditioning agents, claim 1 would appear to include subject-matter which extends beyond the content of the application as filed. In addition, since the claims of the patent as granted were also restricted to compositions in which component II was defined as a skin conditioning agent, the omission of this feature extends also the protection *vis-à-vis* the patent as granted.

2.4 Since there are doubts as to whether claim 1 meets the requirements of Articles 123(2) and (3) EPC, the late filed main request and auxiliary requests 1 to 4 are not clearly allowable, with the consequence that the

Board exercises its discretion not to admit these requests into the proceedings.

Auxiliary request 5

- 2.5 Claim 1 of this request essentially corresponds to a combination of claims 1, 2 and 5, both as originally filed and as granted. In this claim, the humectant is defined as a particular polyhydric alcohol, namely glycerin. Glycerin is explicitly described in the specification of the patent in suit (cf. page 4, lines 1 to 4 and 7) as a skin conditioning agent and is the skin conditioning component of the composition of Example 3 thereof. Thus, in contrast to claim 1 of the main request and of auxiliary requests 1 to 4, the additional specification that this particular compound were a "skin conditioning agent" would, in the case of claim 1 of auxiliary request 5, be superfluous. Hence the omission of this feature neither adds subject-matter which extends beyond the content of the application as filed, nor extends the protection conferred by the patent as granted.
- 2.6 No other formal objections were raised by the Appellant or were apparent to the Board with respect to the amendments carried out in the claims of this auxiliary request. In addition, the amendments do not raise issues which the Board or the Appellant cannot reasonably be expected to deal with during the oral proceedings (Article 10(b)(3) RPBA). Auxiliary request 5 is thus admitted into the proceedings.

3. *Amendments (Article 123 EPC)*

The subject-matter of claim 1 is based on claims 1, 2 and 5 as filed. The polyhydric alcohol has been restricted to glycerin, which has been selected from a single list from claim 5. The amount of volatile siloxane of 30 to 80% finds a basis on page 11, line 2 and in claim 1 of the application as filed, where ranges of 30 to 65% and 10 to 80% are respectively disclosed. Since the presently claimed range now consists of the combination of the lower limit of the first range and the upper limit of the second range, subject-matter extending beyond the content of the application as filed has not been added (cf. T 2/81, OJ EPO 1982, 394, point 3 of the reasons).

The omission from the claim of the indication that glycerin is a skin conditioning agent neither adds subject-matter which extends beyond the content of the application as filed, nor extends the protection conferred by the patent as granted (see point 2.5 above).

The requirements of Article 123(2) and (3) EPC are thus satisfied.

4. *Novelty*

The appealed decision found the claimed subject-matter to be novel (cf. point III *supra*). Novelty was no longer contested during the appeal proceedings, nor does the Board see any reason to take a different view to the Opposition Division. Hence, it is unnecessary to go into more detail in this respect.

5. *Inventive step*

5.1 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 and avoids an *ex post facto* analysis.

5.2 The patent in suit is directed to a skin treatment composition comprising a siloxane elastomer and a volatile siloxane having improved skinfeel properties and a smooth non-draggy rub-in upon initial application to the skin (cf. page 2, line 58 to page 3, line 1 and page 3, lines 4 to 5 of the patent specification). A similar composition already belongs to the state of the art in that document (4) (cf. Application Example 1) discloses a cosmetic composition which is an oily foundation comprising 35 parts by weight of decamethylcyclopentasiloxane, namely a volatile siloxane and 6 parts by weight of silicone oil-containing silicone rubber powder obtained in Reference Example 1. Since the product of Reference Example 1 comprises 35% by weight of silicone oil, 65% by weight of said product, namely 3.9 parts by weight, consists of a cross-linked non-emulsifying siloxane elastomer. The cosmetic compositions of document (4) are described on page 2, lines 3 to 5 as exhibiting various excellent properties such as high lubricancy, absence of skin

discomfort or irritation, smooth texture and moist texture.

Thus, the Board considers, in agreement with the Appellant, that the composition of Application Example 1 of document (4) represents the closest state of the art and, hence, takes it as the starting point when assessing inventive step.

The Respondent argued that not the composition according to Application Example 1, but rather that according to Application Example 3, was the closest state of the art, since the former was an oily foundation, which was merely a make-up, whereas the latter was a moisturizing cream, which was a skin treatment composition, as required by claim 1 of the patent in suit.

However, claim 1 of the patent in suit is not restricted to any specific skin treatment composition. Indeed, according to the specification of the patent in suit (cf. page 5, lines 25 to 26 and 37 to 38), the claimed composition can be of different types and can comprise *inter alia* opacifiers and colorants. Furthermore, the composition of Application Example 3 differs from the presently claimed compositions additionally in that it contains less than 30% by weight of a volatile siloxane and greater than 5% by weight of water so that it is not closer than the oily foundation of Application Example 1 to the presently claimed subject-matter.

5.3 In view of this state of the art, the problem underlying the patent in suit, as formulated by the

Respondent, consists in providing a skin treatment composition with improved hydrating properties whilst retaining the positive skinfeel and stability characteristics of the composition.

- 5.4 As the solution to this problem, the patent in suit proposes a composition as defined in claim 1 which is characterised by comprising from 1 to 50% of a humectant that is glycerin.
- 5.5 In view of the presence in the claimed cosmetic composition of a humectant, namely glycerin, it is credible that the problem defined above is solved by the claimed composition.
- 5.6 Finally, it remains to be decided whether or not the proposed solution to the problem underlying the present application involves an inventive step.
- 5.6.1 Document (4) specifically teaches that the cosmetic compositions disclosed therein may contain other ordinary cosmetic composition ingredients, such as humidistat agents, including glycerin (cf. page 4, lines 17 to 19 and 46). Since it is common general knowledge that a humidistat agent, which is another term for a humectant, attracts moisture, the skilled person, seeking to improve the hydrating properties of the exemplified oily foundation of document (4), would modify the cosmetic composition of Application Example 1 by adding thereto such an agent, more particularly glycerin. In view of the inherent moisturising property of said glycerin, he would expect the resulting composition to have improved hydrating properties. And since document (4) teaches that the

compositions described therein have high lubricancy and a smooth texture, the skilled person would also expect, in the absence of any teaching to the contrary, that such a modified composition would retain its positive skinfeel and stability characteristics.

5.6.2 The amount of 1 to 50% of glycerin is neither critical nor a purposive choice for solving the objective problem underlying the patent in suit, since no unexpected effect has been shown to be associated with this particular amount. The act of picking out at random a range for the amount of glycerin, document (4) making no restrictions or limitations as to the amount of the humidistat agents to be used, is within the routine activity of the skilled person faced with the problem of providing a skin treatment composition with improved hydrating properties whilst retaining the positive skinfeel and stability characteristics of the composition.

5.6.3 The Board concludes from the above that document (4) itself gives the skilled person a concrete hint as to how to solve the problem underlying the patent in suit, namely by adding glycerin to the cosmetic composition of Application Example 1 such that the resulting composition contains 1 to 50% by weight thereof. The skilled person, thus acting routinely, arrives at the claimed invention without the exercise of inventive ingenuity.

5.7 For the following reasons, the Board is not convinced by the Respondent's submissions in support of the presence of an inventive step.

5.7.1 The Respondent argued that there was no motivation in document (4) to add glycerin to the oily foundation disclosed therein.

However, said document teaches that humidistat agents, such as glycerin, may be included in the cosmetic compositions described therein. Since a humidistat agent attracts moisture, and given that the problem underlying the present invention was to provide a skin treatment composition with improved hydrating properties, document (4) does indeed provide a clear incentive to add such a compound to the compositions described therein.

5.7.2 The Respondent also argued that no indication was given in document (4) as to what should be omitted from the compositions exemplified therein in order to incorporate the glycerin.

However, in order to arrive at the claimed composition when starting from the teaching of document (4), it is not necessary to omit any ingredient in order to incorporate glycerin, it being possible to add glycerin to the composition of Application Example 1 and to still remain within the general teaching of said document.

5.7.3 Finally, the Respondent argued that in view of the fact that glycerin was water miscible and soluble, the skilled person would have expected stability problems when adding it to an oil-based composition and would thus also have added water to the composition.

However, document (4) does not provide any deterrent to adding glycerin to any of the particular compositions described therein, nor does it teach that in certain circumstances, it must be added together with water. On the contrary, it explicitly teaches that glycerin can be added (cf. page 4, line 48).

5.8 For these reasons, the subject-matter of claim 1 is obvious in the light of document (4).

6. As a result, auxiliary request 5 is not allowable for lack of inventive step pursuant to Article 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:

P. Cremona

P. Gryczka