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**Datasheet for the decision
of 2 July 2007**

Case Number: T 0635/06 - 3.3.10

Application Number: 98203889.5

Publication Number: 0920855

IPC: A61K 7/13

Language of the proceedings: EN

Title of invention:

Hair dye compositions containing 3-alkyl-4-aminophenol and 2-substituted 1-naphtol

Patentee:

P&G-Clairol, Inc.

Opponent:

KPSS-Kao Professional Salon Services GmbH

Headword:

Hair dye compositions/CLAIROL

Relevant legal provisions:

EPC Art. 54, 56

EPC R. 55(c)

Keyword:

"Novelty (yes)"

"Admissibility of the ground for opposition of lack of inventive step (yes)"

Decisions cited:

G 0009/91, G 0001/95, T 0012/81, T 0007/86, T 0666/89,
T 0565/90, T 0941/98, T 0131/01

Catchword:

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Case Number: T 0635/06 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 2 July 2007

Appellant: KPSS-Kao Professional Salon Services GmbH
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Representative: -

Respondent: P&G-Clairol, Inc.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 March 2006
rejecting the opposition filed against European
patent No. 0920855 pursuant to Article 102(2)
EPC.

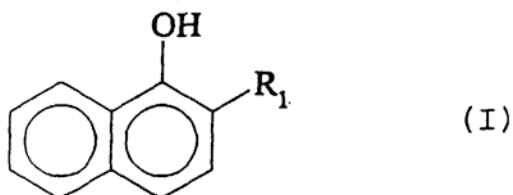
Composition of the Board:

Chairman: R. Freimuth
Members: J.-C. Schmid
D. Rogers

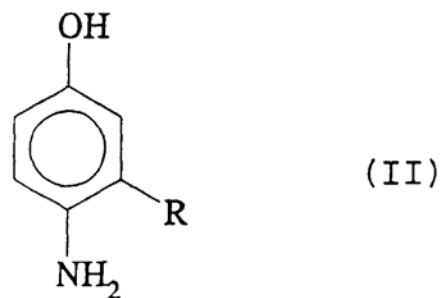
Summary of Facts and Submissions

I. The Appellant (Opponent) lodged an appeal on 21 April 2006 against the decision of the Opposition Division posted on 2 March 2006 rejecting pursuant to Article 102(2) EPC the opposition against European patent No. 920 855, independent claim 1 reading as follows:

"1. An oxidative dye composition for dyeing a keratin fiber, the composition containing a primary intermediate, a coupler, and a cosmetically acceptable vehicle, the primary intermediate and the coupler being present in respective amounts such that in the presence of an oxidizing agent will they react to produce a tinctorially effective amount of an oxidation dye, **characterized in that** the coupler is a 2-substituted-1-naphthol having the formula I



wherein R₁ is C₁-C₆ alkyl or a monohydroxy C₁-C₆-alkyl, and the primary intermediate is a compound of the formula II:



wherein R is a C₁-C₆ alkyl or a monohydroxy C₁-C₆-alkyl."

II. Notice of opposition had been filed by the Appellant (opponent) requesting revocation of the patent in suit in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC), citing solely document

(1) EP-A-0 630 642.

III. The Opposition Division held that the claims in the form as granted satisfied the requirement of novelty (Article 54 EPC) and rejected the ground for opposition related to the objection of lack of inventive step as inadmissible.

The claims in the form as granted were novel, since the claimed combination of specific couplers and primary intermediates was not disclosed in document (1).

Novelty and inventive step formed separate grounds for opposition and the factual framework of an opposition was determined by the facts, evidences and arguments adduced and set out in the notice of opposition. Simply crossing the respective box in section VI of EPO Form 2300.2, and indicating that there was no necessity to comment at the moment on inventive step of a claim which lacked novelty, did not meet the requirement of Rule 55(c) EPC. Hence, the Opposition Division rejected the ground for opposition of lack of inventive step as inadmissible.

IV. According to the Appellant, the subject-matter of claims 1 to 11 of the patent in suit lacked novelty with respect to document (1). The coupler compounds specified therein as being particularly preferred all

fell within the definition of 2-substituted-1-naphtol coupling compounds according to claim 1 of the patent in suit. Furthermore, the skilled person was taught that oxidative dye compositions of document (1) comprised as the coupler 2-methyl-1-naphtol. Since a 3-substituted-p-aminophenol derivative according to claim 1 was included in a single list including only eight compounds of preferred primary intermediates, a combination of 2-methyl-1-naphtol and a 3-substituted-p-aminophenol derivative was directly and unambiguously disclosed. Furthermore, page 3, lines 33 to 35 of document (1) disclosed explicitly the combination of a 1-naphtol and a p-aminophenol.

As regards admissibility of the ground for opposition of lack of inventive step, the reason for not submitting facts and arguments against inventive step was to be found solely in the requirement that inventive step could only be discussed if novelty was to be acknowledged. After receiving the preliminary opinion of the Opposition Division accepting novelty, further facts and argument were submitted, wherein the objection of lack of inventive step was substantiated based *inter alia* on document (1) alone. In fact, the present case was very similar to the situation leading to the decision T 131/01 (published in OJ EPO 2003, 115) where an opposition was filed based on a single document and arguments were presented only against novelty, where the Board was of the opinion that substantiation of lack of inventive step was neither necessary nor possible given that novelty was a prerequisite.

V. The Respondent held that the subject-matter of the granted claims was novel since the Appellant purposively selected specific passages from amongst the total disclosure of document (1) in order to arrive at the combination of compounds as required by the claim of the patent in suit. The acknowledgement of novelty by the Opposition Division was fully consistent with the established jurisprudence of the Boards of Appeal, since at least two selections were required in order to arrive at the subject-matter of claim 1.

The ground for opposition of lack of inventive step was not admissible, since the opponent did not raise it in the notice of opposition, let alone support it with facts, evidence and arguments that are required by Rule 55(c) EPC.

There were significant differences between the situation that existed in the decision T 131/01 and the present situation. In contrast to the case T 131/01, the opponent did not identify any document that formed the basis for its objection as to obviousness. In the case T 131/01 the opponent submitted that a comparison between the disclosure of the prior art document and that of claim 1 revealed no difference and if there were some differences these could only be so minor that they would not be able to impart an inventive step to the claimed subject-matter. Accordingly, the notice of opposition did contain a specific substantiation, however brief, in support of lack of inventive step while in the present case, the notice of opposition contained no substantiation at all but only the opponent's statement that it did not see any necessity to comment on inventive step. In the case T 131/01, it

was not possible for the opponent to substantiate the ground of lack of inventive step in more detail because it would have been inconsistent for the opponent to argue in the context of inventive step that a technical difference did exist after the conclusion of the opponent's earlier novelty analysis that there was none. In contrast, the claimed subject-matter was a selection invention from the disclosure of document (1) and arguments could have been provided as to any alleged obviousness as a precautionary measure against the situation that the Opposition Division concluded that the claims were novel.

The ground for opposition of lack of inventive step should therefore be rejected. However, should it be admitted in the proceedings, the case should be remitted to the Opposition Division so that there would be the possibility for two instances to consider inventive step.

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

The Respondent requested that the appeal be dismissed and the patent be maintained as granted or, subsidiarily, that the decision under appeal be set aside and that the patent be maintained on the basis of auxiliary request 1 filed on 20 December 2005, or auxiliary request 2 filed on 1 June 2007, or auxiliary request 3 filed on 20 December 2005.

VII. At the end of the oral proceedings held on 2 July 2007 the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Novelty*
 - 2.1 The main issue to be decided in this appeal is whether or not the decision under appeal was right to find that the subject-matter of the claims is novel over document (1), the Appellant having challenged that finding of the Opposition Division.
 - 2.2 Claim 1 is directed to an oxidative dye composition which is characterized by the combination of a 2-(C₁-C₆ alkyl or monohydroxy C₁-C₆-alkyl)-1-naphtol with a 4-amino-3-(C₁-C₆ alkyl or monohydroxy C₁-C₆-alkyl)-phenol.

The Appellant based its objection of lack of novelty with respect to document (1) on the combination of passages of the general part of the description of that document.

- 2.3 In this context, the Board firstly notes that according to the established case law of the Boards of Appeal regarding the examination of novelty, the teaching of a document is not confined to the detailed information given in the examples, but embraces the whole disclosure of that document. Nevertheless, the general principle consistently applied by the Boards of Appeal for concluding lack of novelty is that there must be a direct and unambiguous disclosure in the state of the

art which would inevitably lead the skilled person to subject-matter falling within the scope of what is claimed. However, in deciding what can be directly and unambiguously derived from a document, its different passages can only be combined if the skilled reader would see a good reason for combining them (see e.g. T 666/89, OJ EPO 1993, 495; T 565/90 and in particular T 941/98, point 5 of the reasons; neither published in OJ EPO).

- 2.4 Document (1) discloses an oxidative dye composition comprising a particular coupler which is a specific 2-substituted-1-naphtol, and any oxidation dye precursor (see claim 1).
- 2.4.1 The preferred couplers are 2-methyl-1-naphtol, 2-ethyl-1-naphtol, 2-propyl-1-naphtol, 2-hydroxymethyl-1-naphtol and 2-hydroxyethyl-1-naphtol (see claim 2, page 3, lines 53 to 58). These couplers are all covered by formula I of claim 1 of the patent-in-suit.
- 2.4.2 The preferred oxidation dye precursor is a primary intermediate which is more preferably p-phenylenediamine, N,N-bis(2-hydroxyethyl)-p-phenylenediamine, p-aminophenol, p-amino-m-methylphenol, p-amino-o-methylphenol, 5-aminosalicylic acid, 2,5-diaminotoluene or 4-amino-1-naphtol (see claim 5, page 5, lines 10 to 12). The compound p-amino-m-methylphenol is the only compound in the list which falls under formula II according to claim 1 of the patent-in-suit.

2.4.3 However, document (1) does not comprise any direct pointer to the particular combination of the specific individual couplers disclosed on page 3 with that special intermediate disclosed on page 5. The same finding applies to the individual couplers of claim 2 and intermediates of claim 5, since the claims do not comprise any reference to each other.

Accordingly, the passage of page 3, lines 53 to 58 or claim 2 on the one hand and that of page 5, lines 10 to 12 or claim 5 on the other hand, of document (1) referred to by the Appellant are separate disclosures not directly linked together. Consequently, the one particular individual intermediate comprised in that list and the preferred couplers listed are not disclosed in combination and there is no reason to combine those particular disclosures of document (1).

Hence, said particular combination results from a selection of unrelated and individual embodiments which does not, for the skilled person, emerge clearly and unambiguously from that document.

Consequently, neither the description nor the claims of document (1) disclose the specific combination now claimed, i.e. of a 2-(C₁-C₆ alkyl or monohydroxy C₁-C₆-alkyl)-substituted-1-naphthol with a 4-amino-3-(C₁-C₆ alkyl monohydroxy C₁-C₆-alkyl)-substituted phenol.

2.4.4 The Appellant furthermore relied on page 3, lines 32 to 35 of document (1) disclosing the general combination of a 2-substituted-1-naphthol of formula I with a p-aminophenol.

It is established jurisprudence of the Boards of Appeal that subject-matter resulting from a specific combination requiring the selection of elements (e.g. within a document) from at least two lists or generic groups is normally be regarded as novel (see e.g. T 12/81, point 13 of the reasons, OJ EPO 1982, 296, and T 7/86, point 5.1 of the reasons, OJ EPO 1988, 381).

Applying this principle in the present case, the section of document (1) referred to by the Appellant is too general in order to destroy the novelty of the more specific subject-matter claimed. To arrive at the claimed subject-matter a double selection is necessary, namely, selecting within the 2-substituted-1-naphthol of formula I those having a C₁-C₆ alkyl or monohydroxy C₁-C₆-alkyl substitution and selecting within the p-aminophenols those of formula III specifically substituted in position meta with a C₁-C₆ alkyl or monohydroxy C₁-C₆-alkyl group.

However, document (1) does not contain any pointer leading the skilled person directly and unambiguously to that particular selection of compounds that would form a composition falling under claim 1 of the patent in suit.

- 2.5 Therefore, the Board concludes that the compositions of claim 1, and by the same token those of dependent claims 2 to 4, 9 and 10 have not been made available to the public in the sense of Article 54(2) EPC.
3. Independent claim 5 is directed to a method for dyeing hair using the composition of claim 1. Accordingly the conclusion concerning novelty in point 2 holds good for

this claim, with the consequence that the subject-matter of claim 5, and by the same token that of claims 6 to 9 and 11 depending thereon, is novel with respect to document (1).

4. Since the subject-matter of the claims of the main request is novel for the reasons set out above, there is no need for the Board to decide on the novelty of auxiliary requests 1 to 3.

Admissibility of inventive step as ground of opposition

5. The Appellant objected to the Opposition Division's findings that the grounds for opposition of lack of inventive step pursuant to Article 100(a) EPC had not been properly substantiated in its notice of opposition as required by Rule 55(c) EPC according to which the notice of opposition must indicate the facts, evidence and arguments in support of the respective opposition ground.

It has thus to be reviewed whether or not the Opposition Division was right to reject as inadmissible that ground for opposition.

- 5.1 Rule 55(c) EPC governs the admissibility of the opposition and establishes at the same time the legal and factual framework, within which the substantive examination of the opposition should be conducted, which is of particular importance in that it gives the patentee a fair chance to consider his position at an early stage of the proceedings (see decision (G 9/91, OJ EPO 1993, 408)).

It is uncontested by the parties that novelty and inventive step form two separate grounds for opposition (see decision of the Enlarged Board of Appeal G 1/95 OJ EPO 1996, 615). Accordingly, the ground for opposition of lack of inventive step should be substantiated in the notice of opposition.

- 5.2 The admissibility of a ground for opposition depends upon whether or not the notice of opposition contained an indication of the facts, evidence and arguments in support of the grounds of inventive step which was sufficient in the sense prescribed in Rule 55 EPC.

In the particular case where a patent has been opposed under Article 100(a) EPC on the grounds of lack of novelty and lack of inventive step having regard to a single prior art document, and where the ground of lack of novelty has been substantiated pursuant to Rule 55(c) EPC, a specific substantiation of the ground of lack of inventive step is neither necessary - given that novelty is a prerequisite for determining whether an invention involves an inventive step and such prerequisite is allegedly not satisfied - nor generally possible without contradicting the reasoning presented in support of lack of novelty (see T 131/01, *loc. cit.*).

- 5.3 In the present case the notice of opposition specifies that the patent in suit was opposed for lack of novelty and inventive step as the respective boxes have been crossed in the standard form EPO 2300.2 04.93 and as the notice explicitly indicated both grounds.

5.3.1 The part "facts and arguments" of the notice of opposition starts with the analysis of the teaching of the opposed patent (paragraph 1), cites document (1) (paragraph 2) and analyses its teaching (paragraph 3). Then, a comparison is made between the features of each of the claims of the opposed patent and those disclosed in document (1) arriving at the conclusion that the subject-matter claimed is directly and unambiguously disclosed (paragraph 4). Paragraph 6 of the notice of opposition headed "inventive step" indicates: "As outlined above the claimed subject matter by the opposed patent is not novel over the prior art document D1. The opponent does not see any necessity to comment on inventive step at the moment of a claim, which is not novel. In the case that the proprietor achieves novelty over the prior art, the opponent reserves his rights to submit arguments as well as new documents when needed on involvement of inventive step." Finally, in the last paragraph, it is concluded that the patent in suit lacked both novelty and inventive step.

- 5.4 As indicated above, in the notice of opposition the Appellant-Opponent
- cited one single document in support of his opposition
 - summarised the teachings of the patent and of this document
 - compared the individual features of the subject-matter of the claims with the features disclosed in this document, quoting the pages and lines and indicating that all features of the claimed subject-matter are known from this document, and
 - concluded that the subject-matter of the disputed patent lacks both novelty and inventive step.

It was therefore not possible in the circumstances of the present case for the opponent to substantiate the ground of lack of inventive step by any analysis going beyond its arguments against novelty. The opponent was thus limited to the position that a comparison of the composition disclosed in document (1) and the claimed subject-matter revealed no distinguishing feature, the presence of which would, however, be necessary for detailed objection to inventive step. Hence, the ground of lack of inventive step is sufficiently addressed and, thus, properly raised in the notice of opposition.

The Respondent submitted that no document was cited against inventive step contrary to the situation in case T 131/01 (*loc. cit.*) wherein the document against novelty was also cited against inventive step. However, this argument does not distinguish the present case from T 131/01, since the notice of opposition only refers to a single piece of prior art, i.e. document (1). The Respondent furthermore alleged, that it could not know from the notice of opposition that an objection as to lack of inventive step arose and that it was based on document (1). However, it appears from the Respondent's own observations dated 28 July 2005, filed in reply to that notice of opposition, that it defended the patent-in-suit against an inventive step objection based on document (1) and filed comparative data in view of that document. Hence, the Respondent was not in doubt that an inventive step objection was raised in the notice of opposition with respect to document (1).

5.5 Hence, the Board concludes that the ground for opposition of lack of inventive step has been properly raised in the notice of opposition and, thus, is to be admitted in the proceedings.

6. *Remittal*

The Board notes that the Opposition Division only ruled on the issue of novelty and on the formal aspect related to the admissibility of the ground for opposition of lack of inventive step. It had not concluded the substantive examination of inventive step. Under these circumstances the Board considers it appropriate to exercise the power conferred on it by Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on the basis of the claims according to the main request in order to enable the first instance to decide on the outstanding issues.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution on the basis of the main request.

The Registrar

The Chairman

C. Moser

R. Freimuth