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**Datasheet for the decision
of 1 July 2010**

Case Number: T 1441/06 - 3.3.07

Application Number: 97915356.6

Publication Number: 0889712

IPC: A61K 7/06

Language of the proceedings: EN

Title of invention:
Hair care compositions

Patentee:
Unilever PLC, et al

Opponent:
DSM NUTRITIONAL PRODUCTS AG
Henkel AG & Co. KGaA

Headword:
-

Relevant legal provisions:
EPC Art. 56, 104(1)
EPC R. 115(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Inventive step - no"
"Costs - apportionment - no"

Decisions cited:
-

Catchword:
-



Case Number: T 1441/06 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 1 July 2010

Appellant: DSM NUTRITIONAL PRODUCTS AG
(Opponent 01) Wurmisweg 576
CH-4303 Kaiseraugst (CH)

Representative: -

Respondent: Unilever PLC
(Patent Proprietor) Unilever House
Blackfriars
London
Greater London EC4P 4BQ (GB)

Representative: James, Helen Sarah
Unilever Patent Group
Colworth House
Sharnbrook
Bedford MK44 1LQ (GB)

(Opponent 02) Henkel AG & Co. KGaA
VTP Patente
D-40191 Düsseldorf (DE)

Representative: Semrau, Markus
Henkel AG & Co. KGaA
VTP Patente
D-40191 Düsseldorf (DE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
10 July 2006 concerning maintenance of European
patent No. 0889712 in amended form.

Composition of the Board:

Chairman: S. Perryman
Members: B. ter Laan
G. Santavicca

Summary of Facts and Submissions

I. The appeal by opponents 01 lies against the decision of the opposition division posted on 10 July 2006 to maintain European patent No. 0 889 712 (based on International Application No. PCT/EP97/01177, published as WO 97/34570) in amended form.

II. The patent was granted on the basis of seven claims, independent claim 1 reading:

"1. A hair care composition comprising:

(i) from 0.001 to 1% by weight of phytantriol;

(ii) from 0.001 to 10% by weight of a silicone compound; and

(iii) a cosmetically acceptable carrier selected from the group consisting of:

a) water

b) lower alcohols instead or in addition to water and

c) a hydrocarbon propellant."

Independent claim 7 read:

"7. A method for conditioning and styling hair comprising the steps of:

(A) applying a hair care composition to the hair comprising:

(i) from 0.001 to 1% by weight of phytantriol;

(ii) from 0.001 to 10% by weight of a silicone compound; and

(iii) a cosmetically acceptable carrier selected from the group consisting of:

a) water

- b) lower alcohols instead or in addition to water and
- c) a hydrocarbon propellant.

- (B) wetting the hair to create a lather;
- (C) rinsing the lather from the wet hair; and
- (D) applying heat to the rinsed hair to achieve styling."

III. Two notices of opposition against the patent were filed on 6 and 11 June 2003 respectively, in which revocation of the patent in its entirety was requested on the grounds of Article 100(a) EPC (lack of novelty as well as lack of an inventive step). The opposition was supported, amongst others, by

- D1 Hoffmann-LaRoche Vitamins & Fine Chemicals
Newsletter for the Cosmetic and Household
Industries: Roche VitaScope, summer 1992, Volume 3,
Issue 4
- D8 SÖFW, 117(10), 1991, 379-384, G. Erlemann, R.
Merkle: "Panthenol, Phytantriol, Vitamin E und
Vitamin A in der Kosmetik"
- D11 EP-A-0 641 557
- D13 EP-A-0 768 081
- D26 WO-A-9600557

IV. The decision under appeal was based on a main and a first auxiliary request filed on 17 March 2006 as first and sixth auxiliary requests respectively, claim 1 of the main request reading:

- "1. A ~~hair-care~~ **shampoo** composition comprising:
 - (i) from 0.001 to 1% by weight of phytantriol;

- (ii) from 0.001 to 10% by weight of a silicone compound;
- ~~(iii) a cosmetically acceptable carrier selected from the group consisting of:~~
 - ~~a) water; and~~
 - ~~b) lower alcohols instead or in addition to water and~~
 - ~~c) a hydrocarbon propellant~~
- (iv) **from 5 to 30% by weight of a surfactant selected from anionic, nonionic, amphoteric, zwitterionic and cationic surfactants and mixtures thereof.**

V. Claim 1 of the first auxiliary request read:

"1. A method for conditioning and styling hair comprising the steps of:

(A) applying a ~~hair care~~ **shampoo** composition to the hair comprising:

(i) from 0.001 to 1% by weight of phytantriol;

(ii) from 0.001 to 10% by weight of a silicone compound;

~~(iii) a cosmetically acceptable carrier selected from the group consisting of:~~

~~a) water~~

~~b) lower alcohols instead or in addition to water and~~

~~c) a hydrocarbon propellant. (sic)~~

(iv) **from 5 to 30% by weight of surfactant selected from anionic, nonionic, amphoteric, zwitterionic and cationic surfactants, and mixtures thereof;**

(B) wetting the hair to create a lather;

(C) rinsing the lather from the wet hair; and

(D) applying heat to the rinsed hair to achieve styling."

(compared to claim 1 as granted, additions are indicated in bold, deletions in strikethrough).

VI. The opposition division held that

- (a) The subject-matter claimed according to the main request complied with Articles 123(2) and 123(3) EPC and was novel but not inventive. Starting from D26 as the closest prior art document, the problem to be solved was to improve the conditioning effect of the composition of D26. In view of the suggestion in D26 to add polyols and further moisturizing agents to its compositions and the teaching of D8 about the moisturizing, protective and lustre improving properties of phytantriol, which is a polyol, the skilled person was led to use phytantriol in the compositions of D26. All the more so since the combined use of silicone compounds and phytantriol for conditioning purposes had already been known from e.g. D1.
- (b) The subject-matter claimed according to the auxiliary request fulfilled the requirements of Article 123(2) and 123(3) EPC since it was based on subject-matter as originally filed and the claims were more limited than those as granted.
- (c) D1 and D11 had been cited against novelty. D1 disclosed a composition having a lower amount of surfactant than now being claimed. D11 disclosed a "protective day cream" the composition of which

fell under the terms now being claimed, but a day cream was not suitable for use as a shampoo. Hence, neither D1 nor D11 destroyed the novelty of the claimed subject-matter.

- (d) The claimed process was also inventive. D26 was considered to be the closest prior art document since it described a shampoo containing a silicone conditioning agent, having both a cleaning and a conditioning effect. The missing feature in D26 was the presence of phytantriol. The problem to be solved was to improve not only the conditioning of the hair but additionally to achieve styling. None of the documents on file gave a hint that phytantriol could be used for styling purposes. In particular D8 only disclosed the moisturizing, protecting and luster improving effects of phytantriol, but not styling. Therefore, the claimed subject-matter was inventive.

VII. On 18 September 2006 opponents 01 (appellants) lodged an appeal against the above decision. The prescribed fee was paid on the same day. The statement setting out the grounds of appeal was filed on 20 November 2006. Further arguments were given in a letter dated 1 June 2010 in response to a communication by the Board dated 14 April 2010.

In a letter dated 28 February 2007, opponents 02, a party as of right under Article 107 EPC, gave their comments and filed two additional documents.

VIII. By letter dated 21 March 2007 the patent proprietors (respondents) filed comments on the statement setting

out the grounds for the appeal. By fax dated 30 June 2010 they announced that they would not attend the oral proceedings scheduled for 1 July 2010.

- IX. In preparation of the oral proceedings, the Board sent a communication dated 14 April 2010, in which, amongst other things, the bad legibility of the claims and issues under Article 84 EPC were raised.
- X. Oral proceedings were held on 1 July 2010, in the absence of the respondents (Rule 115(2) EPC).
- XI. The appellants' arguments can be summarised as follows:
- (a) The amended claims did not comply with Article 123(2) EPC since there was no disclosure in the original application for water as the only possible carrier. Also Article 84 EPC was not complied with due to the missing reference to 100% for the weight percentages and the unclarities present in the claims which had only been amended by hand and no typed version had been submitted.
 - (b) From the decision under appeal it appeared that the composition of the shampoo was known. In that respect D13 was cited. Since the method steps for applying the shampoo were known to the entire population and were therefore completely trivial, the method now being claimed could not be novel either.
 - (c) Regarding inventive step, D26 was a suitable starting point, differing from the claimed

subject-matter only in the absence of phytantriol and the application of heat.

- (d) According to the decision under appeal, the presence of phytantriol in the shampoo composition would lead to an additional effect, i.e. "styling". However, since the patent in suit did not give any definition of "styling" and the only effect referred to was wet combing (example 10), the "styling" amounted only to wet combing, which was, according to the patent in suit (paragraph [0041]) itself, a conditioning property.

Even when one accepted that a styling effect was achieved, such would be the result of the trivial method step (D) of applying heat to the rinsed hair; it would not be caused by the presence of phytantriol. The examples did however not describe any heating step and therefore did not represent the method now being claimed.

As regards the wet combability, according to Table III in the patent in suit, the combination of phytantriol with silicone compound did not lead to any synergistic effect.

The effect of the presence of phytantriol could therefore only be seen in improving the wet combability.

- (e) Since it was known from D8 that the addition of phytantriol resulted in improved combability, and moreover D26 described the possibility to use polyols in the shampoos there described, it was

obvious to add phytantriol to the shampoo composition of D26. Therefore, the claimed subject-matter did not involve an inventive step.

- (f) An apportionment of costs in favour of the appellants was requested in view of the extremely late information from the respondents that they would not attend the oral proceedings. Had the appellants known that earlier, they might have sent a local person or not sent two persons or decided not to attend at all. In the present case the claims under consideration were unclear and the appellant was not sure that their interpretation was correct. The respondent could have at least filed a typed version, especially in view of the Board's communication in which attention was drawn to that problem.

XII. The respondents had not reacted to the Board's communication. Their arguments given in writing in response to the statement setting out the grounds of the appeal can be summarized as follows:

- (a) As regards novelty, D13 did not disclose either a shampoo composition or a heating step so that the claimed method was novel. Applying heat for styling was not trivial. In fact, applying heat for drying the hair was only used by a small proportion of the population.
- (b) As to inventive step, none of the documents on file would motivate the skilled person to use phytantriol for styling purposes since the prior art only mentioned phytantriol in a hair

conditioning context, not in a styling context, the two concepts not being equivalent. Conditioning materials could render the hair difficult to style whereas the film forming materials used for styling frequently damaged hair condition and imparted undesirable tactile properties. The appellants had not supplied any convincing reasons why the appealed decision should be set aside.

XIII. The appellants (opponents 01) requested that the decision under appeal be set aside and the patent be revoked, and that there be an apportionment of costs in their favour.

The respondents (patent proprietors) had requested in writing that the appeal be dismissed and that the patent be maintained in the form as upheld by the opposition division.

Reasons for the Decision

1. The appeal is admissible.

Procedural matters

2. The day before the oral proceedings the Board had found out that the respondents, who had been duly summoned in accordance with the requirements of Rule 115(1) EPC, would not attend and that their absence was not due to any unforeseen circumstances. Although the oral proceedings could be continued in their absence (Rule 115(2) EPC), the Board wishes however to express its concern at the behaviour of the representative in not informing the Board of his absence in good time. The present case being *inter partes*, the other parties were placed at a disadvantage by the unexpected absence of the respondent and had not had the possibility to decide if e.g. they, too, would stay away, or attend with a smaller number of persons or send a local person so as to save travel costs.

Such conduct by a party is not only unfair to the other parties, but also to the Board, which, as the last instance, is charged with the dispensation of justice under the EPC. Such conduct hampers the efficient and speedy handling of cases by the Board and may, as here, cause unnecessary expense to the European Patent Office in relation to the provision of interpreters who turn out to be unnecessary.

- 2.1 In its communication, the Board had indicated that the claims upon which the decision under appeal was based had deficiencies regarding clarity and support and that

the Board did not have the intention to follow the arguments of the opposition division as indicated in the impugned decision. Therefore, the respondents left the other parties as well as the Board to interpret the wording of the claims without their assistance. The respondents have had, in accordance with Article 113(1) EPC, an opportunity to present their comments on the objections raised in the Board's communication. By not attending the oral proceedings they forewent the possibility of giving any further comments. The interpretation by the Board given to the claims upon which this decision is based, remains therefore uncontested.

Amendments

3. The main claim as upheld by the opposition division contains a number of unclarities that, in spite of the request made in the Board's communication, have not been clarified (Article 84 EPC); in particular it was partly not legible, so that the amount and kind of surfactants were unclear. Also a reference to what the percentages relate to is lacking and the numbering of the various constituents is inconsistent. Furthermore, there is doubt about a proper basis for the combination of compounds and process steps now being claimed (Article 123(2) EPC). This was pointed out in the Board's communication. However, as the Board concludes that the claimed subject-matter lacks an inventive step (see point 5 below), those points need not be dealt with further.

For the substantive issues, the claim is, analogous to claim 1 of the main request before the opposition

division, and also in view of the patent specification paragraphs [0026] and [0033], read as follows:

"1. A method for conditioning and styling hair comprising the steps of:

(A) applying a ~~hair-care~~ **shampoo** composition to the hair comprising:

- (i) from 0.001 to 1% by weight of phytantriol;
- (ii) from 0.001 to 10% by weight of a silicone compound;

~~[(iii)] a cosmetically acceptable carrier selected from the group consisting of:~~

- ~~a) water~~
- ~~b) lower alcohols instead or in addition to water and~~
- ~~c) a hydrocarbon propellant.~~

(iv) **from 5 to 30% by weight [of the composition] of surfactant selected from anionic, nonionic, amphoteric, zwitterionic and cationic surfactants, and mixtures thereof;**

(B) wetting the hair to create a lather;

(C) rinsing the lather from the wet hair; and

(D) applying heat to the rinsed hair to achieve styling."

(the additions compared to claim 1 as granted are indicated in bold, deletions in strikethrough, the words interpreted into the claim by the Board being given in square brackets and in italics)

Novelty

4. Although a novelty objection was raised by the appellants, that point, too, needs no specific decision

in view of the lack of an inventive step (see point 5.2 below).

Inventive step

5. The patent in suit concerns hair care compositions. It aims at a method for conditioning and styling the hair using e.g. a shampoo (paragraph [0001]). Such a method is described in D26, which the opposition division as well as the appellants saw as the closest prior art document. The respondents did not contest that and, in view of the disclosure of D26, the Board also considers it to be an appropriate starting point for assessing inventive step.

5.1 D26 describes an aqueous composition comprising:

- (a) from 45 to 95%, by weight of the composition, water;
- (b) from 1 to 5%, by weight of the composition, sorbitan monostearate, sorbitan distearate or mixtures thereof;
- (c) from 0.01 to 1%, by weight of the composition, stearyl alcohol ethoxylate nEO where n is at least 50 and does not exceed 130;
- (d) from 0.1 to 10%, by weight of the composition, insoluble, non-volatile silicone; and
- (e) from 1 to 40% by weight of the composition, surfactant or combinations of surfactants selected from the specified groups of anionic, nonionic and amphoteric surfactants and mixtures thereof (claim 1).

According to D26, polyols and other moisturizing agents may be present in the compositions (page 7, third full paragraph: "Other Ingredients").

The shampoo of D26 may be applied to wet hair, which is then worked to create a lather. The lather may be retained on the head for some time before it is rinsed out (paragraph bridging pages 7 and 8).

D26 aims at providing a stable shampoo for improved conditioning without any of the dulling effects or greasy build-up of other products (page 3, first five full paragraphs).

5.2 Two of the features now being claimed have not been disclosed in D26: the presence of phytantriol in the shampoo composition and the application of heat to the rinsed hair to achieve styling. In order to determine which problem is effectively solved by the subject-matter now being claimed, the question has to be answered which effect is obtained by the combined application of a shampoo composition containing phytantriol and of heat to the rinsed hair.

5.2.1 According to the patent specification, it is an object of the patent in suit to provide a conditioning hair care composition with stylability features that overcomes the compatibility problems known from the prior art and that can be applied in a single application (paragraphs [0009] to [0011]).

No special objective is mentioned in relation to the method now being claimed, in particular as regards the heating step. In fact, the "Detailed description of the invention" only refers to the ingredients of the composition whereas nothing is said about the

application to the hair of that composition. Also, in none of the examples is a heating step applied.

Therefore, in the patent in suit no special significance is attributed to the heating step (D), especially not in relation to conditioning and styling. In fact, in the examples the hair is not heat treated at all, which step, according to the wording of the claim, is needed to achieve the styling. The only property considered in the examples is the wet combability (example 10), which is a conditioning property according to the patent in suit, paragraph [0041], and not a property relevant to the dry hair obtained after the application of heat in conformity with the method now being claimed.

5.2.2 In the patent in suit, no comparison is made of the application of a composition as defined in present claim 1 on the one hand and that of a composition according to D26 on the other. In Table III of the patent in suit the wet combability after the application of a base composition and compositions with silicone and/or phytantriol is given; however, no synergistic effect due to the use of both silicone and phytantriol, i.e. a consistent improvement that goes beyond the combined effect of each of the two ingredients alone, is shown. The information of Table III bears no relationship to D26 and the respondents failed to indicate if it referred to any other document that might possibly represent more appropriate prior art than D26. In fact, the information of Table III bears no relationship to the method now being claimed.

5.2.3 Since the examples are completely silent about any effect as a result of the combined use of phytantriol and heat, there is no comparison with D26 showing any improvement, so that no conclusion can be drawn as regards any effect, let alone improvement, in styling or conditioning vis-à-vis the closest prior art document. Therefore, no effect vis-à-vis D26 whatsoever can be recognized, let alone attributed to the method of present claim 1.

5.2.4 Since it is not even clear from the examples in the patent in suit that the method now being claimed is suitable at all for hair styling, the problem solved by the method of claim 1 can only be formulated as being to provide a further method for conditioning hair.

5.3 The question remains to be answered whether it was obvious to use phytantriol and to apply heat if, starting from D26, the skilled person aimed at a further method for conditioning hair.

5.3.1 As can be seen from the above analysis of document D26 (point 5.1), the use of polyols and other moisturizing agents in the shampoo composition is suggested (page 7, third full paragraph).

5.3.2 D8 (page 380, right column, under the heading "Phytantriol") discloses that phytantriol is suitable for hair and skin care. Its hair care properties are described as moisturizing by means of reducing the loss of water, protection against mechanical damage by combing, aiding the penetration of panthenol and amino acids into the hair and providing a sheen to lacklustre

hair. It is suitable for use in shampoos (page 381, paragraph under Table 3).

- 5.3.3 In view of the disclosure of D8, the skilled person would be encouraged to use phytantriol in the composition of D26 when looking for a further method for conditioning the hair.
- 5.4 Applying heat to the hair after washing it is such a common practice that it needs no support by any written disclosure. Since it has not been shown that the combination of applying heat after washing the hair with a shampoo composition containing phytantriol has any special effect whatsoever, those two features have to be seen as separate measures that bear no relationship to each other. As both those measures are obvious by themselves, their combined use is therefore also obvious.
- 5.5 For those reasons, the claimed subject-matter lacks an inventive step.

Apportionment of costs

6. Each party to opposition proceedings has to bear their own costs unless a different apportionment is, for reasons of equity, ordered (Article 104 EPC). One such reason may be the failure of a party to appear at the oral proceedings (Case Law of the Boards of Appeal of the European Patent Office, VII.C.8.2.4).
- 6.1 Every party summoned to oral proceedings should inform the EPO as soon as they know that they will not attend, regardless of which party requested the oral

proceedings. In the present case, the respondents had not reacted to the Board's communication and not answered a number of questions posed in that communication, nor had they apparently had the intention to come or to notify the EPO of their intended absence at all.

- 6.2 In the present case, it was the appellant who had requested oral proceedings, albeit conditionally ("hilfsweise"); the respondents had never asked for oral proceedings. In addition, the oral proceedings were not only arranged at the request of the appellants, but also because the Board itself wished to be in a position to give a decision on the case. The oral proceedings would therefore not have been cancelled by the board even if the respondents had at an early time indicated that they would not attend. The presumption is that a party who asks for and attends oral proceedings does so in order to ensure that its own case is presented as well as possible. Here the respondents had neither asked for oral proceedings nor indicated that they would attend them. In these circumstances the board sees no sufficient reason to depart from the ordinary rule that each party bears its own costs.

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for an apportionment of costs is refused.

Registrar

Chairman

S. Fabiani

S. Perryman