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**Datasheet for the decision  
of 28 September 2007**

**Case Number:** T 1536/06 - 3.3.10

**Application Number:** 02803767.9

**Publication Number:** 1458348

**IPC:** A61K 7/48

**Language of the proceedings:** EN

**Title of invention:**

Cosmetic composition comprising a fatty acid material and preparation method therefor

**Applicant:**

UNILEVER N.V., et al

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

RPBA Art. 10b(1)

EPC Art. 56, 123(2)

**Keyword:**

"Main and first auxiliary request: not admitted into the proceedings; late filed; not clearly allowable"

"Second, third and fourth auxiliary requests: inventive step (no)"

**Decisions cited:**

T 0153/85

**Catchword:**

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Case Number: T 1536/06 - 3.3.10

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.10  
of 28 September 2007

**Appellant:**  
(Applicant)

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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted 27 April 2006  
refusing European application No. 02803767.9  
pursuant to Article 97(1) EPC.**

**Composition of the Board:**

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

## Summary of Facts and Submissions

- I. The present appeal lies from the decision of the Examining Division posted on 27 April 2006 refusing the European patent application No. 02 803 767.9 published under the International publication No. WO 03/045348.
- II. The Examining Division held that the subject-matter of claim 14 of the then pending main request was not novel. The subject-matter of the then pending first, second and third auxiliary requests lacked inventive step, *inter alia*, in view of the teaching of document
- (1) GB-A-633 065.

According to the Examining Division, the claimed process for preparing topical base compositions according to the auxiliary requests differed from the process disclosed in document (1) only in the specific volume of the container, in the agitation time and in the saponification ratio. No effect was shown for these distinguishing features taken in combination. The objective technical problem solved by the claimed invention could thus only be seen in the aggregation of partial problems. It was obvious to the skilled person that the process disclosed in document (1) could be used for preparing small volumes of topical base and that the preparation of a smaller volume needed less cooling time and thus less agitation. In addition, it was known from the prior art that the saponification ratio had an impact on the consistency of the composition. The claimed process was thus obvious.

III. With a letter dated 31 August 2006, the Appellant (Applicant) filed the results of comparative experiments and three sets of claims as main, first and second auxiliary requests, these requests corresponding to the three auxiliary requests pending in front of the Examining Division. On 27 September 2007, the Appellant filed a new main request and a new first auxiliary request and retained the previously filed requests as second to fourth auxiliary requests.

Claim 1 of the main request and the first auxiliary request reads as follows:

"1. A method of providing a topical base composition for use in the preparation of a cosmetic composition, especially a topical skin care composition, comprising:  
(a) providing a cosmetic container;  
(b) providing in the container a substantially anhydrous unreacted mixture of an effective amount of a fatty acid material having a melting point in the range of 40°C to 80°C and an effective amount of a suitable organic or inorganic base;  
(c) providing sufficient heated water to the container such that substantially all of the fatty acid material is solubilised to provide a fatty acid soap material;  
and  
(d) agitating the contents of the container;  
whereby a cream or lotion base is formed."

Claim 1 of the second auxiliary request reads as follows:

"1. A method of providing a topical base composition for use in the preparation of a cosmetic composition, especially a topical skin care composition, comprising:

- (a) providing a cosmetic container having a volume of 20-250 ml, preferably 25-100 ml, more preferably from 25-50 ml;
- b) providing in the container a substantially anhydrous mixture of an effective amount of a fatty acid material having a melting point in the range of 40°C to 80°C and other components necessary to form a fatty acid soap material;
- c) providing sufficient heated water to the container such that substantially all of the fatty acid material is solubilised to provide the fatty acid soap material comprising both unneutralised fatty acid material and soap; and
- d) agitating the contents of the container;

whereby a cream or lotion base is formed."

Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that in step (a) the volume of the container is not specified and in that in step (d) the agitation period is specified as being "for a period of from 10 seconds to 5 minutes".

Claim 1 of the fourth auxiliary request differs from claim 1 of the second auxiliary request in that in step (d) the agitation period is specified as being "for a period of from 10 seconds to 5 minutes".

IV. According to the Appellant, the amended feature in step (b) of claim 1 of the main request and the first auxiliary request that "a substantially anhydrous unreacted mixture of a fatty acid" was provided to the

container was based on page 4, lines 3 to 5 and 19 to 21 of the application as filed. The amended claim 1 of both requests was thus in conformity with the requirements of Article 123(2) EPC. With regard to the subject-matter of claim 1 of the second to the fourth auxiliary requests, the Appellant considered document (1) as representing the closest prior art and defined the problem underlying the present invention as to provide a process to manufacture a topical base composition rapidly, with good rheological properties and on a scale so that it can be produced at the point of sale. The results of the comparative experiments showed that an homogeneous product was obtained more quickly with the claimed process. Thus, the claimed subject-matter, whether limited in terms of agitation time or in terms of size of the container, or both, involved an inventive step.

V. The Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or the first auxiliary request filed on 27 September 2007, or alternatively on the basis of the main, first or second auxiliary requests, all filed with the letter dated 31 August 2006 and retained respectively as second, third and fourth auxiliary requests.

VI. At the end of the oral proceedings which took place on 28 September 2007, the decision of the Board was announced.

## Reasons for the Decision

1. The appeal is admissible.

### *Main request and first auxiliary request*

2. *Admissibility*

The main request and the first auxiliary request were filed one day before the oral proceedings before the Board. According to the Rules of Procedure of the Boards of Appeal (RPBA) published in the OJ EPO 2004, 541, any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the Board's discretion and is not a matter of right (Article 10b(1) RPBA). For exercising due discretion in respect of the admission of such requests, it is established case law of the Boards of Appeal that one crucial criterion is whether or not the amended claims of those requests are clearly allowable (see for example T 153/85 OJ EPO 1988, 1, points 2.1 and 2.2 of the reasons for the decision).

Claim 1 of the main and the first auxiliary requests comprise the amendment that in step (b) a substantially anhydrous unreacted mixture of an effective amount of a fatty acid material is provided to the container. However, according to claim 1 of the application as filed, a fatty acid material is provided in the container with other components necessary to form a fatty acid soap material which is substantially anhydrous. Thus according to claim 1 as filed, the formed fatty acid soap material is substantially anhydrous, whereas the amended claim 1 now requires

that the unreacted fatty acid material provided to the container is substantially anhydrous.

According to the Appellant, this fresh amendment is based on the disclosure at page 4, lines 3 to 5 and 19 to 21 of the application as filed. However, in lines 3 to 5 it is not specified that the unreacted mixture of fatty acid material is substantially anhydrous. Lines 19 to 21 relate to the composition in the container and not to the unreacted material. Thus neither of the two passages cited by the Appellant in support of the amendment discloses that the unreacted fatty acid material is substantially anhydrous as now required by the amended claim 1.

Hence, this amendment to claim 1 represents subject-matter which is not clearly derived from the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

Therefore, the main request and the first auxiliary requests are not clearly allowable and consequently are not admitted into the proceedings.

*Second, third and fourth auxiliary requests*

3. The second, third and fourth auxiliary requests correspond respectively to the first, second and third auxiliary requests pending before the Examination Division and on which the appealed decision is based. It was not contested in said decision that the claims in accordance with these requests found a basis in the application as filed, were clear and defined novel subject-matter (Articles 123(2), 84 and 54 EPC). In view of the negative outcome with respect to the issue



of inventive step in the appeal proceedings, it is unnecessary to go into more detail with respect to these issues.

4. *Inventive step*

Since the method according to claim 1 of the fourth auxiliary request is encompassed by claim 1 of the second and the third auxiliary requests it is appropriate in the present case that the subject-matter of claim 1 of said fourth auxiliary request be examined first as to its inventive ingenuity.

4.1 For the assessment of inventive step in accordance with the "problem-solution approach", it is necessary to establish the closest prior art in order to determine in the light thereof the technical problem which the invention addresses and solves. The "closest prior art" is normally represented by a prior art document disclosing subject-matter aiming at the same objective as the claimed invention and having the most relevant technical features in common (Case Law of the Boards of Appeal of the EPO, 4th. Edition 2001, I.D.3.1).

4.2 The present application is directed to a method for preparing a topical base composition which can then be used in the preparation of cosmetic compositions. A similar method is disclosed in document (1), which was considered in the decision under appeal as representing the closest prior art. The Board considers, in agreement with the Appellant, that this method represents the closest state of the art and, hence, takes it as the starting point for assessing inventive step.

Document (1) discloses a process for manufacturing a cosmetic cream by addition of water to a soap base. Said soap base is prepared by mixing an alkaline solution with saponifiable fatty acids, heating and agitating the mixture until a dry powder-like substance is formed (page 1, line 72 to page 2, line 5). As suitable fatty acid, document (1) discloses stearic acid (page 2, line 50) which is a fatty acid having a melting point in the range of 40°C to 80°C and envisaged by the patent application in suit (patent application, page 8, line 28 and claim 8 as filed). An alkaline solution is a component necessary to form a fatty acid soap material as required by claim 1 in suit. According to document (1), the amount of alkali added may vary from between 10% to 50% of the weight of the constituents of the soap base (page 2, line 63 to 66). The Appellant conceded that this amount of alkali provided a fatty acid soap material comprising both neutralised fatty acid material and soap as also required by claim 1 in suit. Hot water is then added to the dry powder like substance obtained, followed by mixing (page 2, lines 6 to 9). Thus, the "cosmetic cream" and "soap base" of document (1) correspond to the "topical base composition" and "fatty acid soap material" respectively of claim 1 in suit, said finding not being contested by the Appellant. Document (1) specifically exemplifies the addition of 1.42 l (3 pints) of water to 454 g (1 pound) of dry substance (page 2, lines 75 to 79).

- 4.3 Having regard to this prior art, the Appellant submitted that the technical problem underlying the present application was to provide a process to

manufacture a topical base composition rapidly, with good rheological properties and on a scale so that it can be produced at the point of sale.

4.4 As the solution to this problem, the present application proposes the method according to claim 1 of the fourth auxiliary request, which is characterized in that the container in which the method is carried out has a volume of 20 to 250 ml and in that the contents of the container are agitated for a period of from 10 seconds to 5 minutes.

4.5 The Board is satisfied that the technical problem as defined above is effectively solved by the claimed method, since said method requires a container having a volume of 20 to 250 ml and is thus adapted for rapidly producing the topical base composition at the point of sale.

In these circumstances it is not necessary to go into further detail with respect to the experimental data filed by the Appellant with the letter dated 31 August 2006 in order to prove that the technical problem as defined above has effectively been solved by the claimed method.

4.6 It remains to be decided whether or not the proposed solution to that objective technical problem is obvious in view of the state of the art.

4.7 Document (1) (cf. claim 1) already describes a method of producing a cosmetic cream from a soap base without making any restrictions as to the scale on which the method can be carried out. In the specific example in

this document, the cosmetic cream is already produced on a non-industrial scale by mixing 454 g of fatty acid soap material with 1.42 l of water. Furthermore, this document teaches that the process disclosed therein results in the bulk of the cream being reduced considerably for storage and transport (page 2, lines 79 to 81). Starting from this prior art, it was obvious for the skilled person, seeking to provide a process to manufacture a topical base composition rapidly, with good rheological properties and on a scale so that it can be produced at the point of sale, to merely carry out this known process on an even smaller scale, namely in a container having a typical "consumer product size" of 20 to 250 ml, such that the bulk of the cream is even further reduced. Modifying the scale of the process exemplified in document (1), but remaining within the general teaching of that document, was thus well within the routine practice of the skilled person. Document (1) does not disclose any agitation time, but teaches that the dry substance and water should be mixed well (page 2, line 8) in order to return the cream to its original consistency (page 2, lines 76 to 78). The skilled person carrying out merely routine experiments to determine the agitation time required in order to obtain a product with good rheological properties would arrive in this way at an agitation time of from 10 seconds to 5 minutes without exercising inventive skill.

- 4.8 The Appellant argued that by carrying out the method according to the present invention, a product with good rheological properties could surprisingly be obtained in a shorter time than when using the method of document (1). However, this improvement was foreseeable

for the skilled person, since it is obvious that less time is required to obtain an homogeneous mixture of two components, in this case, water and the fatty acid soap material, when the mixing is carried out on a smaller scale.

- 4.9 The Board concludes from the above that document (1) gives a clear incentive to the skilled person on how to solve the technical problem underlying the patent application in suit, namely by providing a method for preparing a topical base composition characterised in that the container in which the method is carried out has a volume of 20 to 250 ml and in that the contents of the container are agitated for a period of from 10 seconds to 5 minutes.
- 4.10 For these reasons, the subject matter of claim 1 of the fourth auxiliary request lacks the required inventive step (Article 56 EPC). Consequently, this request has to be refused.
5. The method according to claim 1 of the fourth auxiliary request is encompassed by claim 1 of the second and the third auxiliary requests which are not limited respectively in terms of volume of the container or in terms of agitation period. Therefore, the subject-matter of claim 1 of the second and third auxiliary requests also lacks inventive step at least for the same reasons as above (see point 4). Consequently, the second and the third auxiliary requests have also to be rejected.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

P. Cremona

J. Mercey