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Datasheet for the decision of 15 July 2008

Case Number: T 1537/06 - 3.3.10

Application Number: 02777345.6

Publication Number: 1448161

IPC: A61K 7/48

Language of the proceedings: EN

Title of invention:
Cosmetic composition and preparation method therefore

Applicant:
UNILEVER N.V., et al

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 56

Keyword:
"Inventive step (no): no fair comparison with prior art - reformulation of technical problem - obvious solution"

Decisions cited:
-

Catchword:
-

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Case Number: T 1537/06 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 15 July 2008

Appellant: UNILEVER N.V., et al.
Weena 455
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Representative: Hugot, Alain
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 26 April 2006 refusing European application No. 02777345.6 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: R. Freimuth
Members: P. Gryczka
D. S. Rogers

Summary of Facts and Submissions

I. The present appeal lies from the decision of the Examining Division posted on 26 April 2006 refusing the European patent application No. 02 777 345.6 published under the International publication No. WO 03/045347.

II. The Examining Division held that the claimed process for preparing a topical base composition differed from that disclosed in document

(5) DE-A-3 306 043

only by the use of heated water. No effect was shown for this distinguishing feature. The objective technical problem solved by the claimed invention could thus only be defined as to provide an alternative method for preparing topical base compositions. The solution proposed by the patent application, namely the addition of heated water instead of water, was obvious to the skilled person in the absence of any technical effect. It was also obvious for the skilled person that the process disclosed in document (5) could be performed in small containers of up to 250 ml and with an agitation time from 10 seconds to 5 minutes. Therefore, the subject-matter of the then pending main request, first, second and third auxiliary requests lacked inventive step.

III. With its grounds for appeal dated 31 August 2006, the Appellant (Applicant) filed the results of comparative experiments and three sets of claims as main request and first and second auxiliary requests, these requests

corresponding respectively to the three auxiliary requests that were before the Examining Division.

Claim 1 of the main 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 an effective amount of a fatty acid material having a melting point in the range of 40°C to 80°C; and a nonionic surfactant wherein the nonionic surfactant and the fatty acid material are mixed at a temperature of 5 to 40°C and wherein the mixture of fatty acid material and nonionic surfactant is substantially anhydrous;

(c) providing sufficient heated water to the container such that substantially all of the fatty acid material melts and is solubilised to provide a fatty acid /nonionic surfactant base mixture; and

(d) agitating the contents of the container;

whereby a cream or lotion base is formed."

Claim 1 of the first auxiliary request differs from claim 1 of the main 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 second auxiliary request differs from claim 1 of the main 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 problem underlying the present invention 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. The results of the comparative experiments filed in the appeal proceedings showed that a homogeneous product was obtained more quickly with the claimed process than with that disclosed in document (5) either in bulk or at consumer size. 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 (named "main auxiliary request") or alternatively on the basis of the first or second auxiliary requests, all requests filed with the letter dated 31 August 2006.

VI. The decision of the Board was announced at the end of the oral proceedings which took place on 15 July 2008 in the absence of the Appellant, which after having been duly summoned informed the Board with a letter dated 30 June 2008 that it would not attend.

Reasons for the Decision

1. The appeal is admissible.

Main request, first and second auxiliary requests

2. The main request, first and second auxiliary requests correspond respectively to the first, second and third auxiliary requests that were 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 had 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.

3. *Inventive step*

Since the method according to claim 1 of the second auxiliary request is encompassed by claim 1 of the main request and of the first auxiliary requests it is appropriate in the present case for the purpose of procedural economy that the subject-matter of claim 1 of said second auxiliary request be examined first as to its inventive ingenuity (Article 56 EPC).

3.1 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.

3.2 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 (5), which the decision under appeal considered as representing the closest prior art. The Board considers also, in agreement with the Appellant, that this process represents the closest state of the art and, hence, takes it as the starting point for assessing inventive step.

Document (5) discloses in its example 1 on page 5, a process for manufacturing a cosmetic cream by addition of water at room temperature to a mixture of a nonionic surfactant, namely Polysorbat 60, and a fatty acid material, namely a mixture of mono-, di- and triglycerides of saturated fatty acids. The mixture of fatty acid material and nonionic surfactant is in the form of a powder and is thus, as required by claim 1 in suit, substantially anhydrous. A cosmetic cream is formed spontaneously after addition of the water at room temperature while agitating the mixture for a short period of time (see in document (5) claims 1 and 4; page 4, lines 5 to 8).

3.3 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 improved rheological properties and on a scale so that it can be produced at the point of sale.

3.4 As the solution to this problem, the present application proposes the method according to claim 1 of the second auxiliary request, which is characterized in that the container in which the method is carried out has a volume of 20 to 250 ml, that the added water is heated, that the fatty acid material has a melting point in the range of 40°C to 80°C and that the agitation of the contents of the container is carried out for a period of from 10 seconds to 5 minutes.

3.5 In order to prove that the technical problem as defined above has effectively been solved by the claimed method the Appellant relied on the comparative examples filed with the letter dated 31 August 2006. According to the Appellant these examples were intended to show that the claimed process achieved a product with sufficient homogeneity within a short time when compared to the process disclosed by document (5) either in bulk or in consumer size which did not deliver a product with good rheological properties. However, the experiment 3, which according to the Appellant illustrated the claimed process, was carried out with a mixture of palmitic and stearic acid (pristene) whereas experiments 1 and 2, which were intended to reflect the closest prior art, were carried out with a different fatty acid material, namely a mixture of mono- and diester of glycerine with stearic acid. Since, this comparison does not involve the same fatty acid material, it cannot be concluded from the observed

results that the alleged improvement of rheological properties is linked to the technical features characterising the claimed solution (see point 3.4 *supra*) or whether the improvement results from the fact that a different fatty acid material was used. In addition, in experiment 3 which according to the Appellant illustrated the claimed process, the final product was obtained after an agitation time of 30 minutes (5 minutes in step 3. and 25 minutes in step 4.) whereas the claimed process requires that the agitation of the contents of the container is carried out only for a period of from 10 seconds to 5 minutes. Since, this experiment does not truly reflect the claimed process it can obviously not allow a fair comparison of the claimed process with the closest prior art.

For these reasons, the alleged improvement of rheological properties over the closest prior art is not adequately supported by the evidence on which the Appellant relies.

3.6 Since in the present case the alleged advantage, i.e. improved rheological properties, lacks the required experimental support, the technical problem as defined above (see point 3.3) needs to be redefined in a less ambitious way, and in view of the teaching of document (5) can merely be seen in providing 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.

3.7 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 an agitation time of from 10 seconds to 5 minutes and is thus adapted for rapidly producing the topical base composition with good rheological properties at the point of sale.

3.8 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.

3.9 Document (5) already describes a method of producing a cosmetic cream without making any restrictions as to the scale on which the method can be carried out. 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 in a container having a size of 20 to 250 ml since this size is a typical "consumer product size" allowing production at the point of sale. In addition, document (5) does not disclose any agitation time, but teaches that the cream is produced spontaneously (claim 1) or after a short agitation (example 1, line 10). 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 by following this teaching to quantify the agitation time already described in document (5) as being short or almost nil when the cream is formed spontaneously, and arrive in this way at an arbitrary range of the agitation time of from 10 seconds to 5 minutes without exercising inventive skill. Furthermore, although document (5)

discloses in its example 1 the addition of water at room temperature it nevertheless does not impose in its general teaching any restriction with regard to the temperature of the water which is added (page 4, lines 5 to 8). Thus, in the absence of any proven effect linked to the use of heated water, this feature can merely be seen as an arbitrary choice made within the teaching of document (5) for which no inventive ingenuity can be acknowledged. In this context the Appellant argued that document (5) taught the skilled person away from using heated water since heating the water was according to the teaching on page 3, lines 1 and 2 of said document, an unnecessary waste of energy (letter of the Appellant in the examination proceedings dated 18 November 2004, page 1, last paragraph). However, document (5) nevertheless foresees that the process may involve a small input of thermal energy (page 4, lines 13 and 14) and thus does not teach away from using heated water. Finally, the Appellant did not rely on any effect linked to the fact that the fatty acid material has a melting point in the range of 40°C to 80°C. Since document (5) gives no restriction with regard to the melting point of the lipids which can be used for the preparation of the cosmetic creams, the melting point of the acid material as specified in claim 1 in suit can merely be seen as an arbitrary choice from amongst the features disclosed by document (5) for which no inventive ingenuity can be recognised.

3.10 For these reasons, the subject matter of claim 1 of the second auxiliary request lacks the required inventive step (Article 56 EPC). Consequently, this request has to be refused.

4. The method according to claim 1 of the second auxiliary request is encompassed by claim 1 of the main request and that of the first auxiliary request which are not limited, respectively, in terms of agitation period or in terms of volume of the container. Therefore, the subject-matter of claim 1 of the main request and of the first auxiliary request also lacks inventive step at least for the same reasons as above (see point 3 above). Consequently, these requests have also to be rejected.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar: The Chairman:

P. Cremona R. Freimuth