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**Datasheet for the decision
of 15 September 2010**

Case Number: T 1056/07 - 3.3.07

Application Number: 95932945.9

Publication Number: 0748622

IPC: A61K 7/025

Language of the proceedings: EN

Title of invention:
Lipstick composition

Patent Proprietors:
SHISEIDO COMPANY LIMITED

Opponents:
Beiersdorf AG

Headword:

-

Relevant legal provisions:

-

Relevant legal provisions (EPC 1973):

EPC Art. 83, 54, 56

Keyword:

"Sufficiency of disclosure (yes)"

"Novelty (yes)"

"Inventive step (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 1056/07 - 3.3.07

DECISION
of the Technical Board of Appeal 3.3.07
of 15 September 2010

Appellants: Beiersdorf AG
(Opponents) Intellectual Property - Patente
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D-20253 Hamburg (DE)

Representative: -

Respondents: SHISEIDO COMPANY LIMITED
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
31 May 2007 concerning maintenance of European
patent No. 0748622 in amended form.

Composition of the Board:

Chairman: S. Perryman
Members: F. Rousseau
D. Semino

Summary of Facts and Submissions

- I. The appellants (opponents) lodged an appeal on 23 June 2007 against the interlocutory decision of the opposition division posted on 31 May 2007 which found that the amended European patent No. 748 622 according to the documents of the main request met the requirements of the EPC.
- II. Before the opposition division the appellants had requested revocation of the patent as granted in its entirety on the grounds of lack of novelty, lack of inventive step (Article 100(a) EPC) and insufficient disclosure of the invention (Article 100(b) EPC). The following documents were *inter alia* submitted in the opposition proceedings:
- D1 JP-A-61-065809 and German translation thereof
 - D3 JP-A-1-168607 and partial English translation thereof
 - D4 R.M. Cornell, U. Schwertmann, The Iron Oxides, pages 95-102, VCH, Weinheim, 1996
 - D8 EP-B-0 602 905
 - D9 JP-A-61-161211 and English translation thereof
 - D10 JP-A-61-158913 and English translation thereof
 - D11 US-A-5 015 469.
- III. The decision of the opposition division was based on claims 1 to 22 submitted with letter dated 09 September 2006, directed to three compositions as defined in independent claims 1, 14 and 16, relating to lipstick compositions. In that set of claims only claim 14 had been amended with respect to the granted claims.

IV. The decision under appeal held that the invention was disclosed in a manner sufficiently clear for a skilled person to carry out the invention, as the ingredients of the compositions claimed were well known to the skilled person, who, furthermore, would not have any difficulty in selecting the ingredients such as to obtain compositions meeting the parametric definitions of claims 1 and 14. Novelty of the composition of claim 1 over those disclosed in examples 1 and 4 of D1 and in examples 1 and 5 of D10 and novelty of the composition of claim 14 over the one of example 1 of D3 was acknowledged, since no convincing evidence had been provided that the parametric definitions of claims 1 and 14 were fulfilled by the compositions of the prior art. The decision found that the subject-matter of the claims involved an inventive step over the lip rouge of example 2 of D10, representing the closest prior art, because the documents on file did not suggest that the properties of the lipstick compositions could be improved by selecting the parametric ranges defined in claims 1 and 14 or a mixture of the water-repellent polymer and a wax in a ratio ranging from 10:3 to 5:7 as in claim 16. The claimed compositions were also inventive over the compositions of D8, that could equally be considered as closest prior art.

V. The appellants submitted with their facsimile letter of 20 July 2010 an excerpt of the online lexicon "Chemie Lexikon Römpf" concerning kaolin (hereinafter D15).

VI. At the oral proceedings before the Board held on 15 September 2010 the respondents (patent proprietors) did not pursue the compositions as defined in claims 14 and 15 as granted. They submitted as sole request a new

set of 20 claims, based on the two compositions defined in claims 1 to 13 and 16 to 22 as granted, claims 16 to 22 being renumbered as claims 14 to 20 and adapted in order to take account of the deletion of granted claims 14 and 15. Claims 1 and 14 of the respondents' sole request read therefore as follows:

"1. A lip rouge composition containing:

a volatile oil;

a water-repellent polymer soluble in the volatile oil which is a silicone resin of formula (I) having a mean molecular weight in the range of 1,500 to 20,000



wherein R is a hydrocarbon group having 1 to 6 carbon atoms or a phenyl group and n is in the range 1.0 to 1.8;

a non-volatile oil compatible with the volatile oil; and

powder that has a total surface area of 1 to 25 m² per g of the composition.

14. A lip rouge composition containing:

a volatile oil;

a water-repellent polymer soluble in the volatile oil which is a silicone resin of formula (I) having a mean molecular weight in the range of 1,500 to 20,000



wherein R is a hydrocarbon group having 1 to 6 carbon atoms or a phenyl group and n is in the range 1.0 to 1.8,

a wax dispersible in the volatile oil, and

a non-volatile oil compatible with the volatile oil,
wherein the ratio of the water-repellent polymer to the wax is 10:3 to 5:7."

VII. The arguments of the appellants can be summarised as follows:

- (a) The inventions underlying claims 1 and 14 were not sufficiently disclosed to be carried out by a skilled person. Firstly, it was not taught in the patent in suit how to manufacture the water-repellent polymers defined in claims 1 and 14. Secondly, the measurement method for determining the total surface area of the powder contained in 1 g of the composition was not disclosed in the patent in suit and it was known that that parametric value depended on the test method selected as shown in document D4. Thus, the skilled person did not know which powder to use and the claimed invention could not be reproduced. Finally, the compositions of claims 1 and 14 encompassed exemplified embodiments 1-52, 1-53, 5-35 and 6-11 which did not solve the problem formulated in paragraph [0007] of the patent in suit, namely "to provide a composition for rouge for lip in which the secondary adhesion is further improved together with smooth feel of use" and all measures necessary to solve said technical problem were not disclosed.
- (b) As regards novelty, claims 1 to 13 lacked novelty in view of either example 4 of D9 or example 1 of D10 and the general knowledge in the art

concerning the specific surface area of kaolin indicated in documents D11 and D15. Claim 1 was also lacking novelty over the compositions of example 1 of D1, example 1 of D9 and example 4 of D10. The objection that the subject-matter of granted claim 16, now claim 14, was lacking novelty over the composition described in example 4 of D10 was no longer pursued during the oral proceedings before the Board.

- (c) As regards inventive step, the closest prior art for the subject-matter of independent claim 1 was equally represented by the compositions described in example 2 of D9 and example 2 of D10. With the exception of the total surface area provided by the pigment Red 226, those compositions disclosed all features of the claimed subject-matter. Claim 1 encompassed exemplified embodiments 1-52 and 1-53 which did not solve the problem formulated in paragraph [0007] of the patent-in-suit, namely "to provide a composition for rouge for lip in which the secondary adhesion is further improved together with smooth feel of use". The problem solved by the subject-matter of claim 1 was therefore the provision of an alternative lipstick composition. In order to solve this problem, it would have been obvious for example in view of D10 (page 4 of the English translation, last paragraph) to add kaolin, thereby arriving at the subject-matter of claim 1 without exercising any inventive activity. As regards the subject-matter of claim 14, the closest prior art was represented by D8, in particular formulation (a) of its example 1. The problem solved by the

subject-matter of claim 14 was also to provide alternative lipstick compositions. For solving this problem, it would have been obvious to use a silicon resin different from the silicone ester wax used in D8, such as the ones of D9 (page 3, fifth paragraph) to bring about a good skin feel. Consequently, the subject-matter of claims 1 and 14 lacked an inventive step.

VIII. The counter-arguments of the respondents can be summarised as follows:

- (a) As regards sufficiency, the water-repellent polymers in the compositions of claims 1 and 14 were commercially available and it was therefore not necessary to explain how those polymers were manufactured. Furthermore, the specific surface area of powders provided by manufacturers was in principle known. If not, this parameter could be determined by several methods which were all well known to the skilled person. It was not appropriate to define a test method in the claims, as the claims covered a large number of powders for which different methods might be appropriate and would provide in any case the same result. Thus, the ground for lack of sufficiency had not been made out.

- (b) Regarding novelty, the compositions cited by the appellants did not contain only kaolin but a mixture of different powders the specific surface areas of which were unknown. Hence, the compositions cited by the appellants did not provide a direct and unambiguous disclosure of a

total surface area as defined in claim 1 and novelty had to be acknowledged.

- (c) Concerning inventive step, the closest prior art for the subject-matter of claim 1 was represented by the composition of example 2 of D10. The examples of the patent, especially those in tables 1 and 2, demonstrated that a total surface area of 1 to 25 m² for the powder contained in 1 g of the composition, allowed to improve transfer resistance and reduce stickiness of the composition, while at the same time luster and spreadability were retained. Since none of the documents cited by the appellants showed the criticality of the total surface area defined in claim 1 for transfer resistance and stickiness, the claimed subject-matter was not obvious. Composition 1-52 according to the invention that had been cited by the appellants as not solving the problem underlying the present invention was not relevant, as it had not been designed to show the criticality of the claimed range for the total surface area, but to demonstrate the inventive concept underlying the invention now defined in claim 14. As regards the subject-matter of claim 14, the appellants had failed to define the problem solved by the claimed subject-matter over D8 considered as the closest prior art. Even considering the problem defined in the impugned decision, *i.e.* the provision of an alternative lipstick composition exhibiting transfer resistance, while remaining easy to apply and comfortable, the appellants hadn't shown that the prior art would give any hint to modify the

compositions of D8. The silicon ester wax of document D8 was a crucial component of D8 and it was not obvious for the skilled person to replace it. It was even not suggested that the properties obtained with the compositions of D8 could also be obtained using the silicon resins of D9 or D10. An inventive step was therefore to be acknowledged for the claimed subject-matter.

- IX. The appellants requested that the decision under appeal be set aside and that the patent be revoked.

- X. The respondents requested that the decision under appeal be set aside and that the patent be maintained on the basis of the sole claim request submitted at oral proceedings on 15 September 2010.

- XI. The decision was announced at the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Sufficiency of disclosure*
 - 2.1 Polysiloxanes such as those of the type defined in claims 1 and 14 are according to common general knowledge readily obtainable by conventional hydrolysis and condensation reactions of chloro- or alkoxy silanes in the presence of water. Therefore, in the absence of any argument as to why the water-repellent polymers of claims 1 and 14 cannot be synthesized, the appellants' objection, that the contested patent does not teach how to manufacture the water-repellent polymers defined in claims 1 and 14, so that the inventions of claims 1 and 14 would be insufficiently disclosed to be carried out by a skilled person, constitutes a mere allegation devoid of any concrete support. The objection must therefore be rejected.
 - 2.2 The appellants did not contest that the feature of claim 1 "powder that has a total surface area of 1 to 25 m² per g of the composition" expresses, as confirmed by paragraphs [0039] and [0048] of the patent in suit and all examples relating to claim 1, the surface area of the powder contained in 1 g of the composition. It is also undisputed that the surface area of the powder is calculated on the basis of the amount of each kind of powder present in 1 g of the composition and their specific surface areas. It is however the appellants' point that, owing to the absence of any mention for commercially available powders suitable for the present invention and to a lack of information with respect to

the determination of the measurement method for determining the specific surface area, the skilled person would not know which powder should be employed as the values may vary according to the measurement methods used. It is, however, undisputed that the skilled person would be in the position to obtain such specific surface area values from manufacturers or, if they are not available, that he could measure them himself using conventional methods. It follows, therefore, that depending on the specific surface area of each powder used, the skilled person would be able by varying the concentration of powder in the composition to adjust the total of surface area of powder contained in 1 g of the composition so as to fall within the range of 1 to 25 m²/g. The appellants' objection rather refers to finding out the limits of the subject-matter claimed, as the choice of the measurement method for determining the specific surface area might lead to different values, which ambiguity is a matter of Article 84 EPC. The appellant's objection, however, does not arise out of any amendment made in opposition or appeal proceedings, so that lack of compliance with the requirements of Article 84 EPC cannot be objected to.

- 2.3 The appellants' argumentation for lack of sufficiency on the ground that the claimed subject-matter cannot be seen to solve the problem formulated in paragraph [0007] of the patent in suit, namely "to provide a composition for rouge for lip in which the secondary adhesion is further improved together with smooth feel of use" also fails to convince, because the claimed compositions do not require any result in terms of "secondary adhesion" or "feel of use".

2.4 Consequently, none of the appellants' lines of argumentation represents a successful challenge to sufficiency of disclosure and the objection under Article 100(b) EPC is rejected.

3. *Novelty*

3.1 The appellants objected to the novelty of claim 1 over the compositions described in example 1 of D1, examples 1 and 4 of D9 and examples 1 and 4 of D10. With regard to the critical feature of present claim 1 that the powder contained in the composition must provide a total surface area of 1 to 25 m² per g of the composition, they maintained that the compositions of the above examples contain kaolin in an amount of either 10 or 25 wt.%, which amounts, in view of the specific surface area of kaolin indicated in either D11 or D15, would result in a total surface area of the powder comprised in 1 g of the composition lying within the range defined in claim 1 of the patent in suit. The appellants, however, ignore the presence in the cited compositions of further powders, namely titanium dioxide in amounts of 5 or 15 wt.% and iron oxide(s) in amount of 0.5 or 3 wt.%, that also contribute to the total surface area of the powder contained in 1 g of the composition. Hence, even if the appellants were correct in their allegation that the total surface area provided by the kaolin powder in 1 g of the composition would be within the range defined in claim 1, they would have failed to show that despite the presence of additional powders in the cited compositions, the total surface area provided by all the powders in 1 g of the composition is not in excess of the upper limit of

25 m²/g defined in claim 1 of the patent in suit. Thus, the appellants failed to demonstrate that at least one of the compositions disclosed in example 1 of D1, examples 1 and 4 of D9 and examples 1 and 4 of D10 meets the parametric definition of claim 1 of the contested patent. In view of the above findings, it is concluded that no case has been made out that the subject-matter of claim 1 lacks novelty.

4. *Inventive step*

4.1 Invention according to claim 1

Closest state of the art

4.1.1 The patent in suit aims at providing lipstick compositions having smooth feel during use and which are not transferred after application to another surface (see paragraph [0003] to [0007]). Both parties agreed that the teaching of example 2 of D10 represents the closest state of the art and the Board sees no reason to depart from their view.

4.1.2 Example 2 of D10 (see translation, page 8, lines 9-23) is directed to a liquid lip colour composition comprising 20 wt.% of Isopar[®] and 20 wt.% Solutrol[®] (which are both volatile hydrocarbon oils, as in D10, translation, page 4, lines 20-25), 40 wt.% of a resin of formula $(\text{CH}_3)_{1.0}\text{SiO}_{1.5}$ with a molecular weight of about 5000 and a ratio of $(\text{CH}_3)_3\text{SiO}_{0.5}$ to SiO_2 units of 0.5, i.e. a water-repellent polymer of formula (I) according to present claim 1, 10 wt.% of glyceryl triisostearate which is a non-volatile oil compatible with the volatile oil (see paragraph [0044] of the patent in

suit) and 10 wt.% of a powder defined to be Red No. 226. The parties also agreed that the example 2 of D10 discloses, with the exception of the total surface area provided by the pigment Red No. 226, all the features of the claimed subject-matter. The use of a powder providing per g of the composition a total surface area of 1 to 25 m² as defined in claim 1 of the contested patent represents therefore a new technical feature conferring novelty to the subject-matter of claim 1 over the teaching of example 2 of D10.

- 4.1.3 In line with the appellants' opinion, the teaching made available by example 2 of D9 does not come closer to the presently claimed invention, as it also relates to a liquid lip colour composition, the description of which, apart from the definition of the volatile oils that is achieved by means of chemical formulae and not by trade names, is identical to that given in example 2 of D10. Consequently, the teaching of example 2 of D10 is taken as representing an appropriate starting point for assessing inventive step.

Problem and solution

- 4.1.4 Having regard to the disclosure of example 2 of D10, the appellants submitted that the technical problem underlying the invention according to claim 1 of the contested patent was merely to provide an alternative lipstick composition, while the respondents argued that the technical problem was to provide compositions which exhibit improved "secondary adhesion", *i.e.* improved transfer resistance, and reduced stickiness and simultaneously retain acceptable luster and spreadability. The use of a powder providing per g of

the composition a total surface area of 1 to 25 m² as defined in claim 1 of the contested patent was considered by both parties to constitute the solution to the problem so defined.

- 4.1.5 In the context of lipstick compositions comprising octamethylcyclotetrasiloxane as volatile oil, liquid paraffin and castor oil as non-volatile oils, a resin of formula (CH₃)_{1.33}SiO_{1.34} with a molecular weight of 3000, ceresin wax and a pigment powder having a specific surface area of 2 m²/g, comparative examples 1-1 and 1-7 (table 1 of the patent in suit) on the one hand and examples 1-2 to 1-6 of the same table on the other hand show, that the use of a silica of specific surface area of 200 m²/g in different amounts so as to vary the total surface area of the powder contained in 1 g the composition within the range of 1 to 25 m²/g allows to obtain compositions with improved transfer resistance and reduced stickiness, while spreadability and luster are retained. Comparison between comparative examples 1-8 and 1-9 and examples 1-10 to 1-14 (table 2) and comparison between comparative examples 1-36 and examples 1-37 to 1-42 (table 6) also show that an increase in the total surface area of the powder contained in 1 g of the composition above the value of 1 m²/g allows to improve transfer resistance and reduce stickiness. According to paragraphs [0049] and [0050] of the patent in suit, which provide a technical explanation for those effects, the water-repellent polymer, the powder and the non-volatile oil are dissolved or dispersed in the volatile oil, resulting in a composition that feels smooth and can be easily spread. The volatile oil is volatilized after application on the lips and the powder when its total

surface area is adjusted appropriately attracts the water-repellent polymer and the non-volatile oil so as to suppress the stickiness caused by them, thereby improving the "secondary adhesion", *i.e.* transfer resistance. Thus, it appears credible in view of those technical explanations that the technical effect demonstrated with the experiments summarized in tables 1, 2 and 6 of the patent-in-suit can be extrapolated to the whole scope of present claim 1, in particular to compositions based on the oils and water repellent polymer used in example 2 of D10.

4.1.6 The appellants' argument, that the compositions according to examples 1-52 and 1-53 of the patent-in-suit would not achieve satisfactory spreadability, transfer resistance and stickiness, although it falls within the ambit of claim 1, and therefore the problem could be only formulated as the provision of alternative lipstick compositions, fails to persuade, as examples 1-52 and 1-53 do not provide a fair comparison with the closest prior art. As a matter of fact, the non-volatile oil, the volatile oil and the silicon resin used in compositions of examples 1-52 and 1-53 are not the same as those used in example 2 of D10 and no evidence has been provided that differences in the structure and/or the chemical nature of each of those ingredients do not influence properties such as spreadability, transfer resistance and stickiness. Hence, the compositions of examples 1-52 and 1-53 cannot be compared to that of example 2 of D10 for objectively assessing the technical problem underlying the subject-matter of present claim 1. In the present case, the relevant question is not whether any possible composition falling within the ambit of claim 1

possibly including additional features not specified in claim 1, such as for example the ratio of resin to non-volatile oil of 8/1 or 7/2 as used in examples 1-52 and 1-53, achieves a particular property in absolute terms or not, but rather whether the features distinguishing the claimed subject-matter from the prior art bring about a relative improvement. The compositions according to examples 1-52 to 1-59 were not designed to show the influence of the total surface area provided by the powder in 1 g of the composition, but that of the ratio of resin content to non-volatile oil content, which for values of 8/1 or 7/2 as illustrated by examples 1-52 and 1-53 is not favourable to achieve satisfactory transfer resistance, stickiness, spreadability and luster. As the appellants, however, failed to show that the compositions according to examples 1-52 or 1-53 do not achieve compared to an identical composition, that does not exhibit the total surface area per g of powder within the range claimed, the technical effect indicated in point 4.1.5 above, it cannot be considered on the evidence available, that example 1-52 and 1-53 taken in isolation constitute an indication that the improvement mentioned above is not obtained over the whole scope of claim 1.

- 4.1.7 As pointed out in above point 2.2, the lack of information concerning the method of measurement for the specific surface area of the powder might result in an ambiguity about the limits of claim 1 defined by the total surface area of the powder contained in 1 g of the composition, that depends both on the amount of powder and its specific surface area. The criticism on the lack of definition for the method of measurement for the specific surface area of the powder might at

most be examined in the context of the present opposition appeal proceedings under the question of whether claim 1 encompasses at its edges the use of a powder which cannot provide the alleged improvement. No evidence, however, has been brought to the attention of the Board, that would render credible that the uncertainty resulting from the use of any reasonable method for determining the specific area of the powder would lead at the edges of claim 1 to compositions that do not exhibit, in comparison to compositions that do not meet the parametric definition of claim 1, improved transfer resistance and stickiness, while at the same time retaining acceptable luster and spreadability. In the context of sufficiency, the appellants argued in view of Document D4 that the determination of the specific surface area for the same ferrihydride powder sample would highly depend on the method used, BET measurements using both N₂ and water leading to the same result of 250 m²/g, whereas the EGME method would give a much higher value of 600 m²/g (D4, page 99, section 5.4.5, second paragraph). The same passage, however, indicates that the authors of those experiments are of the opinion that the latter method does not allow to know exactly when a monolayer has formed, thus leading to anomalously high results. Thus, the evidence cited by the appellants for lack of sufficiency would rather indicate that the EGME method would not be considered by the skilled person in the context of the patent-in-suit as a reasonable measure for determining the specific surface area of a ferrihydride powder. The passage page 96, lines 2-5 of D4, to which the appellants also referred to, also indicates that the BET method using water vapour would not be considered by the skilled person in the context of the patent-in-

suit as a reasonable measure for determining the specific surface area of a goethite sample, because water uptake by the outgassed sample corresponded, at least in part, to rehydroxylation of the surface. The other measurements addressed in D4 have not been shown to relate to the same sample and do not allow any conclusion on the existence of significant differences when determining the specific area of the powder with different methods. Hence, in the absence of any evidence, the appellants' submissions concerning the absence of a definition of a method of measurement for the specific surface area of the powder do not cast doubt on the persuasiveness of the experimental data contained in the patent-in-suit.

4.1.8 Consequently, in view of the evidence and explanations presented in the contested patent and the absence of any convincing counter evidence by the appellants, the Board must accept that the problem solved by the subject-matter of claim 1 over the closest prior art is the provision of compositions having improved transfer resistance and reduced stickiness, as well as acceptable luster and spreadability.

Obviousness

4.1.9 It remains to be decided whether or not the skilled person starting from example 2 of document D10 and wishing to solve the above defined problem would have been guided by the available prior art to the claimed solution. The appellants did not rely on any prior art suggesting the use of a total surface area of the powder within the range of 1 to 25 m²/g in lipstick compositions, let alone for solving transfer and

stickiness problems. The Board is not aware of any document relevant in this respect and, thus, is satisfied that none of the documents cited in the proceedings leads to the claimed composition.

4.1.10 Therefore, there is no case made out by the appellants that the skilled person in view of the prior art available would have arrived at the subject-matter of present claim 1 in an obvious manner. Consequently, the subject-matter of present claim 1 and by the same token that of dependent claims 2 to 13 meets the requirements of Article 56 EPC.

4.2 Invention according to claim 14

Closest state of the art

4.2.1 The appellants based their argumentation for lack of inventive step of the subject-matter of claim 14 starting from composition (a) of example 1 of document D8 (page 5, lines 31-54), that relates to a transfer resistant lipstick composition, as the closest prior art. The respondents were also satisfied that document D8 represents the closest state of the art and the Board does not see any justification to deviate from that view.

4.2.2 The composition (a) of example 1 contains 10.00 wt.% isododecane and 41.50 wt.% cyclomethicone (51.50 wt.% of volatile oils, see D8, paragraph [0016]), 13 wt.% of waxes (6 wt.% of synthetic wax, 4 wt.% of ceresin and 3 wt.% of paraffin), 5 wt.% of a mixture of non-volatile oils (cetyl acetate and acetylated lanolin alcohol), 25 wt.% of a mixture of powders and 5 wt.% isostearyl

trimethylolpropane siloxy silicate (a silicone ester wax according to D8, claim 1). This composition does not contain a water-repellent polymer as defined in present claim 14.

Problem and solution

4.2.3 The appellants and the respondents indicated that the problem solved by the subject-matter of claim 14 over the disclosure of document D8 was, in line with the impugned decision, the provision of alternative lipstick compositions exhibiting transfer resistance, while remaining easy to apply and comfortable. In view of test examples 6-6 to 6-11 of the patent in suit demonstrating that a ratio of the water-repellent polymer to the wax of 10:3 to 5:7 is necessary in order to obtain transfer resistance and to avoid powdery feel, the Board, in the absence of any indication to the contrary, accepts that the problem of providing alternative lipstick compositions exhibiting transfer resistance, while remaining easy to apply and comfortable is effectively solved.

Obviousness

4.2.4 It has now to be decided whether the skilled person starting from composition (a) of example 1 of D8 would have been prompted to use a water-repellent polymer as defined in present claim 14 in a ratio of the water-repellent polymer to the wax of 10:3 to 5:7 in order to solve this problem. The appellants relied solely on the fifth paragraph of page 3 of document D9, arguing that this prior art would have suggested to use a water-repellent polymer according to present claim 14 as it

was known to confer a good skin feel. The passage referred to by the appellants when read in its context (cf. translation, page 2, first paragraph under the heading "Detailed description of the invention" and page 3, second, fourth and fifth paragraphs) relates to the stability of the make up during use, i.e. water, sweat, oil and temperature resistance, as well as to spreadability and skin feel. These properties are said to be achieved when the water-repellent polymer of present claim 14 is used in combination with a volatile silicone oil and powder. Those passages, however, do not suggest the use of the water-repellent silicone polymer in combination with a wax and therefore cannot suggest the claimed solution, all the more because they are not concerned specifically with lipstick compositions and secondary adhesion. The sole lipstick composition disclosed in D9 is that of example 2 that comprises as indicated in above point 4.1.1, 40 wt.% of volatile silicone oils, 40 wt.% of a water-repellent polymer of formula (I) according to present claim 1, 10 wt.% of a non-volatile oil compatible with the volatile oil (glyceryl triisostearate) and 10 wt.% of a powder (Red No. 226). As this composition does not contain any wax, it cannot suggest the solution proposed by claim 14 of the present request, which consists in the use of a ratio of the water-repellent polymer to the wax of 10:3 to 5:7. Document D8 teaches a ratio of silicon ester to wax of 5 to 13 that is outside of the range specified in present claim 14. Thus, even the mere addition of water-repellent polymer used in D9 to the composition (a) of example 1 of D8 would not automatically lead to the presently claimed solution. It is even less convincing that the skilled person, as has been argued by the appellants, would replace in

composition (a) of example 1 of D8 the silicon ester by the silicon polymer taught in D9, as there is no suggestion in the prior art, that the water-repellent polymer of D9 is equivalent to the silicon ester of document D8 for the purpose of providing a transfer resistant lipstick. Under those circumstances, it has not been shown that the skilled person would find any suggestion to forgo the silicon ester which is an essential element of the teaching of D8 (see D8, paragraph [0013] and claim 1) and to replace it by the water repellent polymer of D9.

4.2.5 Thus, on the base of the appellants' submissions, the Board has no reason to conclude that the subject matter of claim 14 and its dependent claims 15 to 20 arises in an obvious way from the state of the art.

4.3 Hence, the appellants' objection under Article 100(a) EPC for lack of inventive step must be rejected.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The matter is remitted to the first instance with the order to maintain the patent on the basis of the sole request submitted at oral proceedings on 15 September 2010 and a description to be adapted thereto as necessary.

The Registrar

The Chairman

S. Fabiani

S. Perryman