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**Datasheet for the decision
of 26 May 2011**

Case Number: T 1060/07 - 3.3.07

Application Number: 01902015.5

Publication Number: 1198218

IPC: A61K 7/02

Language of the proceedings: EN

Title of invention:

Optical make-up composition comprising an interference pigment
and a metal oxide pigment

Patent Proprietor:

Color Access, Inc.

Opponents:

The Procter & Gamble Company

Headword:

-

Relevant legal provisions:

EPC Art. 100(c), 123(2)(3)

EPC R. 80

RPBA Art. 13

Relevant legal provisions (EPC 1973):

EPC Art. 54(1)(2), 84

Keyword:

"Opposition grounds - Extension of subject-matter (yes) -
Fresh ground (no) - already considered by the opposition
division (yes) - Main Request"

"Amendments - clear (no) - Extension of protection (yes) -
added subject-matter (yes) - Subsidiary Request 1"

"Procedural matters - late filed claim requests - admissible
(yes) - Subsidiary Requests 2 and 3"

"Amendments - allowable (yes) - Subsidiary Requests 2 and 3"

"Novelty (yes) - Subsidiary Requests 2 and 3"

"Inventive step (no) - Subsidiary Request 2 - obvious
solution"

"Inventive step (yes) - Subsidiary Request 3 - non-obvious
solution"

Decisions cited:

G 0010/91, T 2017/07

Catchword:

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Case Number: T 1060/07 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 26 May 2011

Appellants 01: Color Access, Inc.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
23 May 2007 maintaining the European patent
No. 1198218 in amended form.

Composition of the Board:

Chairman: J. Riolo
Members: G. Santavicca
P. Schmitz

Summary of Facts and Submissions

I. Two appeals, one by the patent proprietors and one by the opponents, were filed in connection with the interlocutory decision of the Opposition Division maintaining European patent No. 1 198 218 (application No. 01 902 015.5, originating from international application PCT/US01/01018, published as WO 01/51017), according to which, account being taken of amended Claims 1 to 20 of the 3rd Subsidiary Request and of a description adapted thereto, both submitted at the oral proceedings held on 24 April 2007, the patent and the invention to which it relates were found to meet the requirements of the EPC. The decision also gave the reasons for refusing the Main Request (patent as granted) and the 1st and 2nd Subsidiary Requests, also submitted at said oral proceedings.

II. The application as filed comprised 34 claims, Claims 1, 9, 12, 21, 30 and 32 reading as follows:

"1. A method of reducing the appearance of lines and wrinkles on the skin, which comprises applying to the skin a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment."

"9. The method of Claim 1 in which the composition comprises from about 1 to about 9% by weight of interference pigment."

"12. A method of reducing the appearance of lines and wrinkles on the skin, which comprises applying to the skin a makeup composition comprising an interference

pigment having [sic] a only blue reflectance, combined with at least one metal oxide pigment, and an inorganic, non-matte, non-spherical powder."

"21. A skin-colored makeup composition comprising an interference pigment having a blue or violet reflectance in an amount of from about 1 to 9%, combined with at least one metal oxide pigment and an inorganic powder."

"30. The composition of Claim 21 which comprises an interference pigment having only a blue reflectance; titanium dioxide and at least one iron oxide; and an inorganic non-matte, non-spherical powder selected from the group consisting of bismuth oxychloride, boron nitride, barium sulfate, mica, sericite, muscovite, synthetic mica, titanium oxide coated mica, aluminum powder, lauroyl lysine and platelet talc."

"32. The composition of claim 30 in which the interference pigment is present in an amount of from about 1 to about 9%, the metal oxides are present in an amount of about 0.1 to about 30%, and the powder is present in an amount of about 2 to about 15%."

III. The patent as granted comprised 21 claims. Independent Claim 1 is identical to Claim 1 as originally filed and independent Claim 12 read as follows:

"12. A skin-colored makeup composition comprising an interference pigment having a blue or violet reflectance in an amount of from about 1 to about 9% by weight, combined with at least one metal oxide pigment and an inorganic powder in an amount of about 2 to

about 15% by weight, based on the total weight of the composition."

IV. The patent was opposed in its entirety on the grounds that the claimed subject-matter lacked novelty and an inventive step (Article 100(a) EPC), *inter alia* having regard to D1 (EP-A-0 701 810). Further documents, D4 (Kazuhiro Nishikata et al, *A Natural-Looking makeup*, Cosmetics & Toiletries® magazine, Volume 112, May 1997, pages 39-56) and D5 (EP-A-0 919 599), were referred to by the opponents in their letter of 13 February 2007. The patent proprietors *inter alia* enclosed comparative test reports in their letters of 22 February 2007 (Test Results and Photographs concerning the effects of the compositions of the examples of the patent in suit and of Example 13 of D1) and of 4 April 2007 (Pictures of models using a competitor's makeup product).

V. According to the decision under appeal:

- (a) D4 and D5, filed after the nine-month period for opposition, were admitted into the proceedings.
- (b) A new ground for opposition, under Article 100(c) EPC, arising from the combination of Claims 20 and 12 as granted of the 2nd Auxiliary Request, was admitted and considered at the oral proceedings, as during the opposition proceedings compliance with Article 123(2) EPC was to be checked for any amendments made to the claims.
- (c) The subject-matter of Claim 12 of the Main Request (patent as granted) was not novel over the product illustrated by Example 13 of D1.
- (d) The claimed subject-matter of the 1st and 2nd Subsidiary Requests extended beyond the content of the application as filed (Article 123(2) EPC).

- (e) Claim 12 of 3rd Auxiliary Request complied with Article 123(2) EPC and its subject-matter was novel (Article 54 EPC 1973) over the composition illustrated by Example 13 of D1 and involved an inventive step having regard to the composition of Example 2 of D5 as the closest prior art.
- (f) Therefore, the 3rd Subsidiary Request fulfilled the requirements of the EPC.

VI. Claim 1 of Auxiliary Request 3 was identical to Claim 1 as originally filed whilst Claim 12 read as follows (compared to Claim 12 as granted, additions are indicated in bold, deletions in strike-through):

"12. A skin-colored makeup composition comprising an interference pigment having a blue or violet reflectance in an amount of from about 1 to about 9% by weight, combined with at least one metal oxide pigment and ~~an~~ inorganic **non-matte** powder in an amount of about 2 to about ~~15~~ **10%** by weight, based on the total weight of the composition."

VII. In the statement setting out the grounds of appeal, the appellant patent proprietors essentially contested the decision that the subject-matter of Claim 12 as granted lacked novelty having regard to Example 13 of D1. In response to the statement setting out the grounds of appeal of the opponents (letter of 25 January 2008), the patent proprietors enclosed Subsidiary Requests S1 to S5, S5bis, S6 and S7.

VIII. In their statement setting out the grounds of appeal, the opponents maintained the grounds under Article 100(c) EPC against Claim 12 as granted and

those of Article 100(a) EPC against Claim 1 of Auxiliary Request 3, which was found to be allowable by the Opposition Division. In response to the statement setting out the grounds of appeal by the proprietors (letter of 22 January 2008), the opponents objected to the amendments in Claim 12 as granted and maintained that its claimed subject-matter lacked novelty over D1.

- IX. In response to a communication of the Board (11 March 2011) in preparation for oral proceedings, in which the Board drew attention to the issues that needed to be debated and decided, the opponents raised objections against all of the claim requests on file, e.g. under Articles 54, 56, 84, 123(2) and 123(3) EPC.
- X. Oral proceedings were held on 26 May 2011. The patent proprietors made Subsidiary Request 3 filed with letter of 25 January 2008 their Subsidiary Request 1 and submitted fresh Subsidiary Requests 2 and 3. At the end of the oral proceedings, the decision was announced.
- XI. Claims 1 and 12 of each of Subsidiary Requests 1 to 3 read, respectively, as follows (compared to the respective claim as granted, additions are in bold, deletions in strike-through):

Subsidiary Request 1 (previously Subsidiary Request 3 S3)

Claim 1 is identical to Claim 1 as granted.

"12. A skin-colored makeup composition comprising an interference pigment having a blue or violet reflectance in an amount of from about 1 to about 9% by weight, combined with at least one metal oxide pigment

and an inorganic powder in an amount of about 2 to about 15% by weight, based on the total weight of the composition, **wherein the powder is a non-matte powder present in an amount of about 2 to about 10% by weight.**"

Subsidiary Request 2

Claim 1 is identical to Claim 1 as granted.

"12. A skin-colored makeup composition comprising an interference pigment having a blue or violet reflectance in an amount of from about 1 to about 9% by weight, combined with at least one metal oxide pigment and an inorganic powder in an amount of about 2 to about 15% by weight, based on the total weight of the composition, **which comprises an interference pigment having only a blue reflectance, titanium dioxide and at least one iron oxide; and an [sic] inorganic non-matte, non-spherical powder selected from [sic] the group consisting of bismuth oxychloride, boron nitride, barium sulfate, mica, sericite, muscovite, synthetic mica, titanium oxide coated mica, titanium oxide coated bismuth oxychloride, titanium oxide coated talc, platelet iron oxides, aluminum powder, lauroyl lysine and platelet talc; and in which the metal oxides are present in an amount of 0.1 to 30%.**"

Subsidiary Request 3

"1. A method of reducing the appearance of lines and wrinkles on the skin, which comprises applying to the skin a makeup composition comprising **from about 1 to about 9% by weight, based on the total weight of the**

composition, of an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment."

"12. A skin-colored makeup composition comprising an interference pigment having a blue or violet reflectance in an amount of from about 1 to about 9% by weight, combined with at least one metal oxide pigment and an inorganic powder in an amount of about 2 to about 15% by weight, based on the total weight of the composition, **which comprises an interference pigment having only a blue reflectance, titanium dioxide and at least one iron oxide; and an inorganic non-matte, non-spherical powder selected from the group consisting of bismuth oxychloride, boron nitride, barium sulfate, mica, sericite, muscovite, synthetic mica, titanium oxide coated mica, titanium oxide coated bismuth oxychloride, titanium oxide coated talc, platelet iron oxides, aluminum powder, lauroyl lysine and platelet talc; and in which the metal oxides are present in an amount of 0.1 to 30%.**"

XII. The patent proprietors have essentially argued as follows:

Main Request (patent as granted)

Procedural matters

- (a) Only the novelty of the subject-matter of Claim 12 of the Main Request had been debated and decided on in the oral proceedings before the Opposition Division, hence reasoned in the decision under appeal. The amendments in the claims of Subsidiary

Request 2, e.g. the combination of Claims 12 and 20, had been discussed for their compliance with Article 123(2) EPC. Hence, Claim 12 of the Main Request had not been opposed on the basis of Article 100(c) EPC and the decision under appeal had never admitted it into the opposition proceedings. Since a new ground for opposition raised in appeal proceedings needed the consent of the patent proprietors, such a consent was denied. Therefore, the ground under Article 100(c) EPC was not to be considered.

Added subject-matter (Article 100(c) EPC)

- (b) The range 2 to 15% defined in Claim 12 applied only to the inorganic powders and was based on Claim 32 of the application as filed, which also contained the range 1 to 9% defined in Claim 21 as originally filed. The separation of the range 2 to 15% from the further ranges mentioned in Claim 32 as filed was based on the disclosure of the application as originally filed, according to which the pigments were typically (i.e. not necessarily) present in a range of 0.1 to 30% and the inorganic powders might be present as well, not necessarily in the combined ranges, nor with a specific requirement, e.g. 40% was not excluded. Furthermore, in its more generic formulation, the original disclosure mentioned a product containing only interference pigment and pigments. Thus, the range 2 to 15% was completely unrelated to the amount of pigments and the ranges of Claim 32, so its isolation did not violate the requirements of Article 123(2) EPC.

Subsidiary Request 1

Amendments

- (c) The composition of Claim 12 of Subsidiary Request 1 contained 2 to 10% of non-matte powder, this feature being disclosed as such originally, to limit the non-allowable inorganic powder amount of 2 to 15%, which was disclosed only in Claim 32 of the application as filed. The inclusion of the further amount range in addition to the amount of 2 to 15% was necessary to avoid an objection under Article 123(3) EPC, as adjudicated in Decision T 2017/07 of 26 November 2009 (not published in the OJ EPO). Thus, the amendment was a *bona fide* response to the objections raised.

Subsidiary Request 2

Amendments

- (d) Claim 12 of Subsidiary Request 2 included all of the features of Claims 21, 30 and 32 as originally filed and specified that the percentages were by weight of the total composition, as disclosed originally. Therefore, the amendments were allowable and overcame the ground for opposition under Article 100(c) EPC.

Novelty

- (e) The composition of Claim 12 of Subsidiary Request 2 could contain at most 15% by weight inorganic powder, including sericite, so that it was novel

over the composition illustrated by Example 13 of D1, which contained 38.8% of sericite and 20% talc.

- (f) As to Claim 1 of Subsidiary Request 2, Example 13 of D1, let alone D1 taken as a whole, did not deal with a method of reducing the appearance of lines and wrinkles on the skin, so it did not prejudice the novelty of the method of Claim 1.
- (g) D5 did not contain any examples illustrating a composition comprising a blue or violet interference pigment, so it was not novelty destroying either.

Inventive step

- (h) D5 described the closest prior art. The closest embodiment was Example 2, which was the only example of D5 containing both titanium dioxide and a (red) reflecting interference pigment that addressed the covering of wrinkles.
- (i) However, whilst the method of Claim 1 aimed at reducing the appearance of wrinkles and lines by disguising their presence, D5 dealt with colouring compositions. The proprietors had shown by tests carried out with a composition of a competitor that it was not true that anything applied to the skin would reduce, e.g. cover, the appearance of wrinkles and lines. The settling of the pigments and powders in the wrinkles and lines could render them even more pronounced, thus more visible. Furthermore, as stated in the patent in suit, although foundations could be quite effective for

the skin of older women, they indeed conferred opacity on young skins. Hence, the problem of reducing the appearance of wrinkles and lines was more specific than the mere covering of them.

- (j) The solution to that problem relied on the choice of a blue or violet interference pigment, and its respective amounts, as shown in the comparative tests of the patent proprietors, reproducing the compositions illustrated in the patent in suit and that of Example 13 of D1. The opponents had never carried out comparative tests to attack the functional feature of Claim 1 ("reducing the appearance of wrinkles and lines"). Hence, the problem posed was solved.

- (k) As to obviousness, D1 sought to disguise the presence of hyperchromic portions of the skin by using appropriate interference pigments at amounts higher than 10% by weight. In fact, D1 sought a colouring effect. D5 too sought a colouring effect, visible from several directions, and never used a blue interference pigment for that purpose. None of the further documents was concerned with reducing the appearance of wrinkles and lines. There was no reference to a method and a composition for reducing the appearance of wrinkles and lines whilst keeping a normal appearance of the skin.

- (l) Hence, the claimed subject-matter was not obvious.

Subsidiary Request 3

Amendments

- (m) Claim 1 had been amended to specify the amount of the interference pigment, which was disclosed originally. Hence, Subsidiary Request 3 was allowable.

Novelty

- (n) The arguments presented in relation to Subsidiary Request 2 applied *mutatis mutandis* to Claims 1 and 12 of Subsidiary Request 3, so their claimed subject-matter was novel.

Inventive step

- (o) Claim 1 was now restricted to the amount of interference pigment supporting the functional feature of Claim 1. Hence, the arguments presented in support of the inventiveness of the subject-matter of Subsidiary Request 2 applied *a fortiori* to Subsidiary Request 3.
- (p) Even if the Board were to consider that the problem solved was a further method, the proposed solution would still not be obvious, as D5 aimed at a colouring effect of the skin with a red reflecting pigment, so that the use of a blue or violet interference pigment was not obvious at all from D5.

XIII. The opponents, in their written submissions, have essentially argued as follows:

Main Request (patent as granted)

Added subject-matter (Article 100(c) EPC)

- (a) Compared to Claim 21 as originally filed, Claim 12 as granted comprised a number of amendments, such as the addition of a range of 2 to 15% for the inorganic powder and the specifications "by weight" and "based on the total weight of the composition". The statements made by the patent proprietors during the examination proceedings, apart from the reference to Claim 32 as originally filed, did not provide any basis for the amendments. Nor did Claim 32 provide any basis for the contested range 2 to 15% in isolation. Since Claim 12 as granted had no basis in the originally filed application, the original content had been impermissibly broadened.

Subsidiary Request 1

The opponents did not attend the oral proceedings, so they did not directly object to Subsidiary Requests 1 to 3 submitted during the oral proceedings. However, in their letter of 21 April 2011, they had raised objections against the Subsidiary Requests then on file. Hence, the objections still applicable against Subsidiary Requests 1 to 3 are presented here.

Amendments

- (b) As for the Main Request, the compositional range of 2 to 15% for the inorganic powder in Claim 12 added

subject-matter to the patent. Also, a further range, only found in the description, had been included in Claim 12, which thus contained a double selection of range boundaries, not disclosed originally, i.e. added matter contrary to Article 123(2) EPC.

(c) Thus, Subsidiary Request 1 was not allowable.

Subsidiary Request 2

Amendments

(d) In general, there was no mention in the application as filed that the defined percentages were measured by weight, by volume or by some other measure, let alone of what was meant thereby. Furthermore, there was no basis for the amendment "based on the total weight of the composition" (Article 123(2) EPC).

(e) The term "non-matte" was unclear (Article 84 EPC).

Novelty

(f) The method of Claim 1 lacked novelty over Example 13 of D1.

Inventive step

(g) If novelty were acknowledged, no compositional ranges were provided in Claim 1, nor had it ever been demonstrated by evidence that the alleged invention would work in the asserted manner under any circumstances, i.e. across the entirely open compositional range as claimed, so the alleged

technical problem was not solved. Consequently, the subject-matter of Claim 1 could not involve an inventive step over e.g. D5. Since D5 taught that any of its interference pigments could be used in a makeup, it would be obvious to replace the (red) interference pigment (1) with the interference pigment (4) (blue) of D5.

Subsidiary Request 3

Amendments

- (h) The objections raised against the amendments in Subsidiary Request 2 applied *mutatis mutandis* to Subsidiary Request 3.

Novelty

- (i) The subject-matter of Claim 1 lacked novelty over Example 13 of D1, which contained 9% blue interference pigment.

Inventive step

- (j) Even if novelty were acknowledged on the basis of the specified amount of blue or violet interference pigment, no technical effect had been shown to result therefrom, compared to other amounts. An arbitrary selection of an amount of pigment for a makeup was obvious to the skilled person, e.g. having regard to D5. Consequently, Claim 1 did not involve an inventive step.

- XIV. The appellant patent proprietors requested that the decision under appeal be set aside and the patent be maintained as granted (Main Request), alternatively that the patent be maintained on the basis of Subsidiary Request 1, which had been filed as Subsidiary Request 3 S3 with letter of 25 January 2008, or on the basis of Subsidiary Requests 2 or 3 filed during the oral proceedings before the Board.
- XV. The appellant opponents, who did not attend the oral proceedings, had requested in writing that the decision under appeal be set aside and the patent be revoked.

Reasons for the Decision

1. The appeal is admissible.

Main Request (patent as granted)

Alleged fresh ground for opposition under Article 100(c) EPC

2. The legal concept "fresh ground for opposition", as used in G 0010/91 (OJ 1993, 420, see specifically Points 16 and 18 of the Reasons), refers to a ground for opposition which was neither raised and substantiated in the notice of opposition nor introduced into the proceedings by the Opposition Division. Fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patent proprietors (G 0010/91, *supra*, Head Note, Point 3).

- 2.1 In the present case, the notice of opposition was only based on the grounds of lack of novelty and lack of an inventive step (Article 100(a) EPC).
- 2.2 However, from Page 2 of the Minutes of the oral proceedings before the Opposition Division, in relation to Auxiliary [*sic*] Request 2, it is apparent that:
- (a) The opponents had objected that the combination of features defined in Claim 12 had no basis in the originally filed application.
 - (b) The proprietor had countered that the objection in fact amounted to a new ground of opposition being raised without notice, since Auxiliary [*sic*] Request 2 merely concerned the combination of Claims 12 and 20 as granted (wherein Claim 20 was dependent on Claim 12).
 - (c) The Opposition Division had decided to introduce the new ground for opposition based on the extension of subject-matter according to Article 123(2) EPC into the proceedings according to Article 114 EPC.
- 2.3 Furthermore, in the decision under appeal, the Opposition Division reasoned its decision to consider the objection against Claim 12 of Auxiliary [*sic*] Request 2 as follows:
- (a) The objection against Claim 12 of Auxiliary [*sic*] Request 2 was *prima facie* relevant and should be considered, despite the fact that the amendments were based on the claims as granted and the proprietors had objected that this amounted to the introduction of a new ground for opposition according to Article 100(c) EPC. The ground for opposition under Article 100(c) EPC was considered

in the proceedings by reference to Article 114 EPC (Point 1.2 of the Reasons: second, fourth and last sentence).

- (b) There was no unambiguous disclosure in the originally filed documents (reference was made to Article 123(2) EPC) that (generally) inorganic powder was present in a range of about 2 to about 15% by weight in a composition as defined. This amount range had been disclosed only for bismuth oxychloride, as could be taken from Claims 21, 30, 31 and 32 of the published PCT application. The range could not be located in the parts of the description referred to by the patent proprietors. Hence, original disclosure for the claimed subject-matter of Claim 20 introduced into Claim 12 was denied (Page 6, first and second full paragraph).

2.4 From the foregoing, it follows that:

- (a) The combination of Claims 20 and 12 as granted, whereby Claim 20 was dependent on Claim 12, did not result in any amendments beyond the combination itself, and the range objected to was present in Claim 12 as granted, so no amendment falling only under Article 123(2) EPC actually arose.
- (b) The Opposition Division was aware that an objection of lack of unambiguous basis in the original application against Claim 12 as granted amounted to a ground for opposition under Article 100(c) EPC.
- (c) In fact, the Opposition Division considered the objection against Claim 12 of Auxiliary Request 2 as *prima facie* relevant, and explicitly stated in its decision, with reference to Article 114 EPC, that the ground for opposition had to be considered in the proceedings.

2.5 Since the ground for opposition of Article 100(c) EPC was introduced into the proceedings, the Board may review the decision under appeal with regard to this issue.

Added subject-matter (Article 100(c) EPC)

3. Compared to Claim 21 of the application as originally filed (Point II, *supra*), Claim 12 as granted (Point III, *supra*) comprises the amendment for the inorganic powder "in an amount of about 2 to 15% by weight, based on the total weight of the composition".

3.1 It is not contested that the range as such was only present in Claim 32 as originally filed (Point II, *supra*).

3.2 However, Claim 32 as originally filed comprises a set of three ranges, respectively for the interference pigments, the metal oxides and the inorganic powder.

3.3 Furthermore, Claim 32 is dependent on Claim 30, which specifies how both the metal oxides and the inorganic powder may be made up, so the range for the inorganic powder indeed refers to a set of specific non-matte, non-spherical inorganic powders as mentioned.

3.4 Since Claim 12 as granted neither defines the metal oxides and their amount range nor the specific non-matte, non-spherical inorganic powders mentioned in Claim 32, Claim 12 as granted contains an intermediate generalisation, being the result of the incorporation

- of only part of the features of dependent Claims 30 and 32 in independent Claim 21 as originally filed.
- 3.5 Such an intermediate generalisation is allowable only if there is a specific basis for it in the application as filed (Article 123(2) EPC).
- 3.6 The proprietors have referred to page 4 of the application as filed, as a basis therefor, which however discloses generally that "the composition also preferably contains an inorganic powder" (Page 4, line 16) and specifically that "although the powder can be any of the types ordinarily used in cosmetics, it is particularly preferred that the powders be non-matte powders, in an amount of about 2 to about 10%" (page 4, lines 27-29). Neither of the passages referred to can be seen as a direct and unambiguous basis for the range defined by Claim 12 as granted.
- 3.7 The Board cannot locate any further passage in the application as originally filed for the isolation of the range included in Claim 12 as granted from the further ranges and restrictions specified in Claims 30 and 32 of the application as originally filed.
- 3.8 Consequently, Claim 12 as granted lacks a direct and unambiguous basis in the application as originally filed, with the consequence that the ground for opposition under Article 100(c) prejudices the maintenance of the patent as granted.

Subsidiary Request 1

Amendments

4. Compared to Claim 12 as granted, Claim 12 of Subsidiary Request 1 (Point XI, *supra*) comprises the following amendment "and an inorganic powder in an amount of about 2 to about 15% by weight, based on the total weight of the composition, **wherein the powder is a non-matte powder present in an amount of about 2 to about 10% by weight**".

4.1 The presence of two ranges for the amount of inorganic powder ("about 2 to about 15% by weight" and "about 2 to about 10% by weight") is such that the claim is neither concise nor clear as required by Article 84 EPC. As regards the lack of clarity, Claim 12 is ambiguous as to the effective amount and content of inorganic powders.

4.2 The fact that Claim 12 is ambiguous as regards the amount and content of the inorganic powder also raises the following objections:

4.2.1 If the feature "the powder is a non-matte powder present in an amount of about 2 to about 10% by weight" is the effective limitation, both in amount and kind of powder, of the feature "an inorganic powder in an amount of about 2 to about 15% by weight", so the composition shall comprise from about 2 to about 10% by weight of non-matte powder, an objection under Article 123(3) EPC arises. In fact, the feature "inorganic powder" will have been narrowed down to "non-matte inorganic powder" and at the same time its total amount will no longer be specified, so the composition will encompass amounts of inorganic powder (matte) beyond 15% by weight. A similar situation was

considered in T 2017/07 of 26 November 2009 (not published in the OJ EPO), a fact mentioned by the appellant patent proprietors during the oral proceedings before the Board.

4.2.2 On the other hand, if the feature "the powder is a non-matte powder present in an amount of about 2 to about 10% by weight" were to be interpreted as a limitation in amount and kind of powder of the feature "an inorganic powder in an amount of about 2 to about 15% by weight" (i.e. the composition actually comprises 2 to 15 % by weight of inorganic powders, of which 2 to 10% by weight are non-matte), then an objection under Article 123(2) EPC arises. In fact, nowhere in the application as originally filed was a combination of 2 to 15% by weight of inorganic powders disclosed, of which 2 to 10% by weight are non-matte.

4.3 Finally, the feature "non-matte" is not clear (Article 84 EPC) because neither the feature per se nor the application as filed specifies which inorganic powder is non-matte, let alone how the quality is determined.

4.4 Therefore, Subsidiary Request 1 is not allowable.

Procedural matters

5. Subsidiary Requests 2 and 3 were filed during the oral proceedings before the Board, which were not attended by the opponent appellants. These requests constitute a late amendment to the proprietors' case.

5.1 The legal framework for admissibility and consideration of amendments to a party's case, *inter alia* late-filed claim requests, is set out in Article 13 of the Rules of Procedure of the Boards of Appeals of the EPO (RPBA) (OJ 2007, 536), which specifically deals with the amendment to a party's case. In particular:

- (a) Article 13(1) RPBA generally specifies the principle of a board's discretion with regard to any amendments to a party's case after the filing of the grounds for appeal or any reply, whereby a non-exhaustive list of criteria for the exercise of discretion is given, which includes the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.
- (b) Article 13(3) specifically deals with amendments sought after oral proceedings have been arranged, hence also during oral proceedings, and prescribes that the amendments should not be admitted if they raise issues which the board or the other parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

5.2 The amendments to Claim 12 of Subsidiary Requests 2 and 3 and Claim 1 of Subsidiary Request 3 are clearly consequential to the discussion held during the oral proceedings and aim at overcoming the opponents' objections, e.g. as raised in their latest letter of 21 April 2011, and the objections raised by the Board. The opponent appellants should therefore not be surprised by this kind of amendment.

5.3 Since it was possible to deal with them without adjournment of the oral proceedings, the Board

exercised its discretion and admitted them into the proceedings, pursuant to Article 13(3) RPBA.

Subsidiary Request 2

Amendments

6. Claim 1 of Subsidiary Request 2 is identical to Claim 1 as granted.

Novelty

7. D1 and D5 have been invoked against the novelty of the claimed subject-matter, so their disclosure content needs to be examined.

The disclosure of D1

- 7.1 D1 discloses cosmetic methods for rendering a hyperchromic portion of the skin relatively inconspicuous, by applying, at or around said portion, either a material that reflects or transmits a coherent light component, thereby causing interference (Claim 1), or a material that has a pass band for, or predominantly transmits light complementary to the skin colour of said portion, or to a colour in proximity to said skin colour (Claim 2).

- 7.1.1 The material used in the methods can be titanium oxide-coated mica (Claim 3), e.g. which can exhibit a transmission peak at a wavelength of 400-550 nm (blue-to-green) (Claim 4), such as that comprising titanium dioxide having an optical film thickness of 190-270 nm or 405-500 nm coated on mica (Claim 5).

7.1.2 D1 also discloses coloured titanium oxide-coated mica, comprising finely particulate iron oxide having an average particle diameter of 60-150 nm coated on the titanium oxide-coated mica (Claim 12).

7.1.3 Finally D1 discloses a topical composition comprising a material as defined above and a carrier that is suitable for application to the skin (Claim 15), e.g. a composition comprising particles of which at least 10%, preferably at least 15%, by weight are said material (Claim 16).

7.1.4 The closest embodiment disclosed by D1 is illustrated in Example 13, which concerns a powdery foundation for adjusting a light blue hyperchromic portion, whereby the formulation comprises ingredients as follows:

(1)	Talc	20.0% by weight
(2)	Sericite	38.8
(3)	Coloured titanium oxide coated mica (blue interference colour) (coloured titanium oxide coated mica obtained from Manufacturing Example 1)	9.0
(4)	Titanium dioxide	11.0
(5)	Globular polystyrene	5.0
(6)	Red iron oxide	0.6
(7)	Yellow iron oxide	1.8
(8)	Black iron oxide	0.1
(9)	D&C Red No.30	0.2
(10)	Paraben	0.5
(11)	Liquid paraffin	5.0
(12)	Dimethylsilicone	5.0
(13)	Sorbitan monoisostearate	2.0
(14)	Ceresin	1.0

7.1.5 The foundation has a blue-cover power and, when applied to a panel whose face has a light blue hyperchromic portion, it effectively adjusts the hyperchromic

portion and yields a natural-feel finish which is similar to bare normal skin.

- 7.1.6 In summary, in the skin-color adjusting method and skin-color adjusting composition in accordance with D1, without masking the hyperchromic portion of the skin by hiding ability, the hyperchromic portion of the skin is coated with a composition in which a coherent material has been compounded and, while its hiding ability is low, its interference action can be used to naturally make the hyperchromic portion of the skin inconspicuous without detracting from the natural feel of the skin.
- 7.1.7 Although, D1 uses interference for disguising a hyperchromic portion of the skin, without detracting from the natural feel of the skin, D1 nevertheless does not contain any teaching on how to reduce the appearance of lines and wrinkles on the skin, let alone on the use of an interference pigment having a blue or violet reflectance therefor.
- 7.1.8 Also, since a hyperchromic portion can be located anywhere on the skin of a person, not necessarily on lines and wrinkles, the group of people having hyperchromic portions and the group of people only having lines and wrinkles are clearly distinguishable.
- 7.1.9 Therefore, D1 does not disclose the method of Claim 1 of Subsidiary Request 2.
- 7.1.10 The composition of Claim 12 of Subsidiary Request 2 is distinguished from the composition of Example 13 of D1 by the amount of the inorganic powder such as sericite

that cannot be more than 15% by weight, compared to 38.8% by weight for Example 13 of D1.

7.1.11 Therefore, D1 does not prejudice the novelty of the claimed subject-matter of Subsidiary Request 2.

The disclosure of D5

7.2 D5 discloses a composite powder comprising a core particle which is spherical and has a refractive index of from 1.40 to 1.60, and a coating component which is coated on the surface of the core particle in film form and has a refractive index of from 2.00 to 2.90 (Claim 1).

7.2.1 The coating component coated on the surface of the spherical particle in film form can have an optical film thickness between 190 and 780 nm (Claim 2), wherein the core particle can be silicon dioxide and the coating component can be titanium dioxide (Claim 3).

7.2.2 D5 discloses the use of the above composite powder, wherein the composite powder, the particles of which have a uniform particle diameter, is coated on a coating surface to form a composite powder layer, and light interference is caused in the composite powder layer whereby the composite powder layer exhibits a colour on the coated surface (Claim 4).

7.2.3 In particular, the use of D5 encompasses a colouring composition containing the composite powder (Claim 5), wherein the colouring composition can be an external composition (Claim 6), e.g. a makeup product (Claim 7)

or a paint composition (Claim 8), a printing ink composition (Claim 9), a sticky composition (Claim 10).

7.2.4 D5 also discloses the use of any of the colouring compositions, wherein the colouring composition is coated on a coating surface to form a composite powder layer and light interference is caused in the composite powder layer whereby the composite powder layer exhibits a colour on the coating surface.

7.2.5 As regards the composite powder and the interference colour by interference phenomena of varying film thickness, D5 (Production Examples on Page 10) illustrates the preparation of Composite Powders (1) to (4), which produce respectively light red (1), green (2), pale yellow (3) and pale blue (4) interference colours and their uses in colouring compositions such as cosmetic compositions (cream of Example 1, loose powder of Example 2, lip cream of Example 3, hair gel of Example 4, powdery foundation of Example 5, emulsified foundation of Example 6, eye shadow of Example 7), paint composition (Example 8), plastic coloured product (Example 9), coating sticky sheet (Example 10), printing ink compositions (Examples 11 and 12) and light diffusion plate for liquid crystal display (Example 13).

Novelty of the composition of Claim 12

7.3 In all of the above-mentioned cosmetic compositions apart from the eye shadow of Example 7 Composite Powder (1) has been used (having a light red reflection), whereas Composite Powder (2) (having a green interference colour) has been used in Example 7.

7.3.1 Since none of the cosmetic compositions contains an interference pigment having a blue or violet reflectance, the composition of Claim 12 is novel over the compositions illustrated by D5.

Novelty of the method of Claim 1

7.4 As regards the method of Claim 1 of Subsidiary Request 2, only Examples 1 and 2 of D5 address an effect of covering wrinkles. However, none of them comprises an interference pigment having a blue or violet reflectance. Also, only the composition of Example 2 of D5 concerns a composition comprising a metal oxide pigment as well. Therefore, the method of Claim 1 of Subsidiary Request 2 is not anticipated by D5.

7.5 The method of Claim 1 is novel over the method of D1, in particular as illustrated in Example 13, because D1 does not contain any teaching on the reduction of the appearance of lines and wrinkles, let alone by using interference pigments having blue or violet reflectance.

Inventive step

Closest prior art

8. The patent in suit concerns an optical makeup composition comprising an interference pigment and a metal oxide pigment.

8.1 Such compositions are known e.g. from D1 and D5.

8.2 D1 addresses the problem of rendering relatively inconspicuous the hyperchromic portions of the skin, by covering them with a material transmitting light complementary to the undesirable skin colour. D5 *inter alia* addresses the problem of covering wrinkles by application of a composite powder that causes light interference thus exhibiting a colour on the surface. Since the patent in suit (paragraph [0001]) has the objective of diminishing the viewer's ability to perceive fine lines and wrinkles on the face, D5 instead of D1 is a suitable starting point for assessing inventive step.

Problem and Solution

9. The patent in suit (paragraph [0004]) addresses the problem of providing a makeup that can reduce the appearance of lines and wrinkles on the skin, but at the same time is lightweight, sheer, translucent. That product shall benefit both older and younger skins in the minimising of surface flaws, and at the same time, will permit younger skin to retain its natural-looking glow.

9.1 According to the patent in suit (paragraph [0005]), the problem addressed is solved by application to the skin of a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.

9.2 Again according to the patent in suit (page 2, line 56, to page 3, line 3), the interference pigments used are not new, i.e. are known. In fact they had been used in very small quantities to confer a pearlescence to the

product as such, at high levels in eyeshadows, lipsticks or blushes to confer a blue pearlescent colour, or even at higher levels (i.e. more than 10%) to disguise the appearance of major skin imperfections (e.g. as in D1).

9.3 Since the method of Claim 1 of Subsidiary Request 2 comprises the application of a makeup having any amount of blue interference pigment in combination with any amount of metal oxide pigment, the attainment of any reduction of lines and wrinkles with any amounts of pigments (e.g. very small) is not plausible, or obvious (camouflage), so appropriate evidence is required.

9.4 D5 is not acknowledged in the application as originally filed, and on which the patent in suit was granted. Nor has any improvement whatsoever, over D5 as the closest prior art, ever been demonstrated by evidence.

9.5 The closest embodiment illustrated by D5 to the patent in suit is the cosmetic composition illustrated in Example 2 of D5.

9.6 Example 2 illustrates a loose powder, comprising:

1. Invention composite powder (1)	80.0 (parts by weight)
2. Kaolin	5.0
3. Titanium dioxide powder	3.0
4. Magnesium carbonate	5.0
5. Sericite	7.0
6. Perfume	suitable amount

9.7 This loose powder is assessed in comparison with a loose powder of Comparative Example 3 (in which an equal amount of a spherical silicon dioxide powder was used instead of Invention composite powder (1) of the loose powder of Example 2, as well as with a loose

powder of Comparative Example 4 (in which an equal amount of talc was used instead of Invention composite powder (1) of the loose powder of Example 1.

9.8 A test for cosmetic use was conducted with respect to the loose powders of Example 2 and Comparative Examples 3 and 4, whereby each of these powders was evaluated by ten expert panelists on items, shown in Table 3, according to five scores 1 to 5, such as "effect of covering wrinkle". The average values taken are shown in Table 3 of D5.

9.9 According to the results in Table 3 of D5, the loose powder of Example 2 was excellent in the dry feeling and especially excellent in the effect of improving the skin colour after coating and the effect of covering wrinkle by the function of the interference colour provided by Composite Powder (1) of D5.

9.10 Hence, the problem solved by the method defined in Claim 1 of Subsidiary Request 2, over D5, can only be seen in the provision of a further method of covering wrinkles to reduce their appearance.

Obviousness

10. According to D5, the composite powders described can be formulated into a cosmetic composition, such as a makeup, to fulfil a number of roles, such as a "beautiful role", by which a person looks beautiful, a "protective role", by which the skin is protected and a "psychological role", by which a refreshed feeling is achieved (paragraph [0060]), whereby the amount of the composite powder is selected as required in the range

- of from 0.1 to 90.0% by weight based on the overall composition (paragraph [0071]).
- 10.1 In particular, once a composite powder layer is applied to the skin as the coating surface, and when the light interference is caused in the composite powder layer on the skin, the composite powder layer of D5 exhibits a colour on the skin and various interference colours are observed (paragraph [0074]).
- 10.2 The composition illustrated by Example 2 of D5 *inter alia* attains an effect of covering wrinkles by using, apart from the perfume sprayed thereon, only powders, in which an interference pigment having a red reflection is present at 80% by weight, such an amount not being excluded by Claim 1 in suit.
- 10.3 D5 describes the production of composite powders (2) to (4), wherein composite powder (4) is an interference pigment having a pale blue reflectance. Hence, composite powders (1) to (4) all represent suitable interference pigments according to D5.
- 10.4 Thus, for a skilled person aiming at merely providing a further method of covering wrinkles to reduce their appearance, i.e. a further method using a composition as illustrated by Example 2 of D5 comprising an interference pigment and a metal oxide pigment, any interference pigments described by D5 represent an obvious variation on the formulation of the composition, thus a solution to the problem posed, so the method of Claim 1 was obvious over D5.

Subsidiary Request 3

Amendments

11. Compared to Claim 1 as granted (Main Request) (Point III, *supra*), Claim 1 of Subsidiary Request 3 (Point XI, *supra*) contains the amendment "from about 1 to about 9% by weight, based on the total weight of the composition", referring to the interference pigment.
 - 11.1 The amendment as such has a basis in the application as originally filed (page 3, lines 16-17; Claim 18), where it constitutes the most general definition of the composition, so that the requirements of Article 123(2) EPC are fulfilled.
 - 11.2 Since the amendment restricts the scope of Claim 1, the requirements of Article 123(3) EPC are also fulfilled.
 - 11.3 No objection whatsoever arises against the clarity of Claim 1 in view of the amendment made (Article 84 EPC).
 - 11.4 The amendment aims at overcoming a ground for opposition having regard to D5 (Rule 80 EPC).
12. Compared to Claim 12 as granted (Point III, *supra*), Claim 12 of Subsidiary Request 3 (Point XI, *supra*) comprises the following amendment "which comprises an interference pigment having only a blue reflectance, titanium dioxide and at least one iron oxide; and an inorganic non-matte, non-spherical powder selected from the group consisting of bismuth oxychloride, boron nitride, barium sulfate, mica, sericite, muscovite, synthetic mica, titanium oxide coated mica, titanium oxide coated bismuth oxychloride, titanium oxide coated

- talc, platelet iron oxides, aluminum powder, lauroyl lysine and platelet talc; and in which the metal oxides are present in an amount of 0.1 to 30%".
- 12.1 The amended claim as such has a basis in Claim 32, which depends on Claim 30, whereby Claim 30 depends on Claim 21, hence on the chain of Claims 21, 30 and 32.
- 12.2 As regards the objection raised against the feature "based on the total weight of the composition", a basis can be found on page 3, lines 16-17 (which is the first definition of the amount of the interference pigment), combined with the passages on page 4, line 6 (which refers to the metal oxide pigments). The combination of those ranges with the range for the inorganic powder has a basis in Claim 32. That the percentages refer to the total weight of the composition is implicit from the fact that as soon as an amount is defined in the application as originally filed (i.e. the most general definition for the amount of the interference pigment on page 3, lines 16-17), reference is made to the total weight of the composition, which evidently need not be repeated again. This fact is then confirmed by the examples of the application as originally filed.
- 12.3 Therefore, Claim 12 of Subsidiary Request 3 fulfils the requirements of Article 123(2) EPC.
- 12.4 Since the amendments restrict the scope of Claim 12 as granted, the requirements of Article 123(3) EPC are also fulfilled.

12.5 Claim 12 is clear (Article 84 EPC) and aims at overcoming a ground for opposition over D1 and D5 (Rule 80 EPC).

12.6 Therefore, Subsidiary Request 3 is formally allowable.

Novelty

13. Claim 1 is novel over D1, at least for the reasons given for Subsidiary Request 2 (Point 7.5, *supra*).

14. Claim 1 is *a fortiori* also novel over Example 2 of D5 as well (Point 7.4, *supra*), because Example 2 of D5 contains 80% by weight (first difference) of an interference pigment having no blue or violet reflection (second difference).

15. Example 6 of D5 discloses an emulsified foundation comprising:

1. Sericite	5.36 (parts by weight)
2. Kaolin	4.0
3. Invention composite powder (1)	9.32
4. Red iron oxide	0.36
5. Yellow iron oxide	0.8
6. Black iron oxide	0.16
7. Liquid paraffin	5.0
8. Decamethylcyclopentasiloxane	12.0
9. Polyoxyethylene-modified silicone	4.0
10. 1,3-Butylene glycol	5.0
11. Deionised water	54.0
12. Paraben	suitable amount
13. Perfume	suitable amount

15.1 The emulsified foundation of Example 6 of D5 has the effect of improving the skin colour in terms of beauty.

15.2 The method of Claim 1 is novel over the use of Example 6 of D5, because the emulsified foundation does not comprise an interference pigment having a blue or

violet reflection, nor is it used for reducing the appearance of lines and wrinkles.

16. As regards the skin-coloured makeup composition of Claim 12, it is novel over the composition illustrated by Example 13 of D1, which comprises 38.8 % by weight of sericite.

16.1 Also, the composition of Example 2 of D5 contains 80% by weight of an interference pigment having no blue or violet reflectance and that of Example 6 of D5 does not comprise an interference pigment having a blue or violet reflectance, so the subject-matter of Claim 12 of Subsidiary Request 3 is novel over D5 too.

Inventive step

Closest prior art

17. D5 still describes the closest prior art.

Problem and solution

18. The patent in suit (paragraph [0004]) addresses the problem of providing a makeup that can reduce the appearance of lines and wrinkles on the skin, but at the same time is lightweight, sheer and translucent. That product shall benefit both older and younger skins in the minimising of surface flaws, and at the same time, will permit younger skin to retain its natural-looking glow.

18.1 According to the patent in suit (paragraph [0005]), the problem addressed is solved by application to the skin

of a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.

- 18.2 In particular, the two compositions illustrated by the examples of the patent in suit comprise the interference pigment having a blue reflectance, the inorganic powder as well as the metal oxide pigments in the amounts now specified in Claims 1 and 12.
- 18.3 These compositions have been reproduced by the patent proprietors, and compared in the effect of reducing the appearance of lines and wrinkles with the composition of Example 13 of D1, and submitted as comparative test report "Annexe 1" to the letter of 22 February 2007.
- 18.4 It is apparent from these test results that, compared to the clean skin photos for baseline, Formula AV6022 2 (containing a pigment with blue reflectance and bismuthoxychloride) (hence according to Claims 1 and 12) performs better (i.e. reduces more the appearance of lines and wrinkles while maintaining the natural luminosity) than Formula AV6022 1 (as before but without bismuth oxychloride) (hence, only according to Claim 1), which performs better than the formula of Example 13 of D1 (reduces less the appearance of lines and wrinkles and appears chalky and matte on the skin).
- 18.5 Hence, the above tests show that the method of Claim 1 and the composition of Claim 12, in view of the use of the specific amounts defined therein, are suitable for reducing the appearance of lines and wrinkles whilst being sheer, light weight and translucent, and whilst maintaining the natural-looking glow of the skin.

18.6 However, no comparative test whatsoever is available involving D5, so that the problem solved can only be the provision of a further method and composition for reducing the appearance of wrinkles (whilst maintaining the natural-looking glow of the treated skin).

Non-obviousness

19. The method of Claim 1 differs from the closest embodiment of D5 (Example 2) in two regards: the interference pigment has a blue or violet reflectance; and that pigment is present at a content of 1 to 9% by weight, with respect to the total weight of the composition.

19.1 D5 discloses how to prepare an interference pigment having a blue reflectance (Production Examples), but there is no technical teaching or indication in D5 that such a pigment is suitable for reducing the appearance of wrinkles, i.e. that the blue reflectance is suitable for disguising the presence of wrinkles.

19.2 Also, the composition of Example 2 of D5 is a loose powder comprising 80% of a red reflecting pigment, and is not presented as being sheer, translucent and lightweight. Indeed, that composition is said to improve the skin colour, i.e. cannot maintain the natural-looking glow of the skin.

19.3 It follows from the foregoing that the skilled person starting from D5, to attain a further method and composition for covering wrinkles, finds no guidance whatsoever on how to modify the composition of

Example 2 to replace the red reflecting pigment with a blue/violet reflecting pigment, let alone for reducing its content from 80% by weight to at most 9% by weight, in order to reduce the appearance of wrinkles.

19.4 The further documents cited provide no indication either of a modification of the closest embodiment of D5 to arrive at the claimed subject-matter.

19.5 The method of Claim 1 of Subsidiary Request 3 was not obvious. Nor was a *fortiori* the composition of Claim 12.

Conclusion

20. The amendments made to the claims of the opposed patent in the form of Subsidiary Request 3 fulfil the requirements of the EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to maintain the patent on the basis of the claims of Subsidiary Request 3 filed during the oral proceedings before the Board and a description yet to be adapted thereto.

The Registrar:

The Chairman:

S. Fabiani

J. Riolo