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**Datasheet for the decision
of 11 February 2010**

Case Number: T 0087/08 - 3.3.10

Application Number: 01900995.0

Publication Number: 1189586

IPC: A61K 7/48

Language of the proceedings: EN

Title of invention:

Shadow-effect cosmetic composition

Patentee:

Color Access, Inc.

Opponent:

L'OREAL

Headword:

-

Relevant legal provisions:

EPC Art. 54, 56

Relevant legal provisions (EPC 1973):

EPC R. 67, 68(2)

Keyword:

"Novelty (yes) : selection within 2 lists"

"Inventive step : fresh case, new closest prior art document"

"Procedural violation (yes) : decision not reasoned"

"Remittal (yes) : reimbursement of appeal fees (yes)"

Decisions cited:

T 0012/81, T 0278/00, T 1366/05

Headnote:

Article 56 EPC requires that the assessment of inventive step is made "having regard to the state of the art". Accordingly, a decision is not sufficiently reasoned in the sense of Rule 68(2) EPC 1973 (Rule 111(2) EPC 2000) if the chain of reasoning to justify the finding of lack of inventive step merely states that a purported effect has not been achieved, i.e. this technical problem had not been solved, without reformulating the problem in a less ambitious way and without assessing obviousness of the claimed solution to that reformulated problem in the light of the cited prior art.



Case Number: T 0087/08 - 3.3.10

DECISION
of the Technical Board of Appeal 3.3.10
of 11 February 2010

Appellant 1: Color Access, Inc.
(Patent Proprietor) 7 Corporate Center Drive
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New York 11747 (US)

Representative: Pochart, François
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F-75008 Paris (FR)

Appellant 2: L'ORÉAL
(Opponent) 14, rue Royale
F-75008 Paris (FR)

Representative: Tanty, François
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
15 November 2007 concerning maintenance of the
European patent No. 1189586 in amended form.

Composition of the Board:

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

Summary of Facts and Submissions

I. A notice of opposition was filed in which revocation of the European patent Nr. 1 189 586 in its entirety was requested on the grounds of lack of novelty and inventive step and insufficiency of disclosure (Article 100(a) and (b) EPC). The objections were based, *inter alia*, on document

(4) Information sheet concerning the product "Relief Color R-151507"

II. In an interlocutory decision issued in writing on 15 November 2007, the Opposition Division found that the European patent could be maintained in amended form on the basis of claims 1 to 23 of the first auxiliary request submitted during the oral proceedings before the Opposition Division.

The Opposition Division came to the conclusion that the invention was sufficiently disclosed, that the subject-matter of the main request (patent as granted) was novel but did not involve an inventive step, that the amended claims according to the then pending first auxiliary request fulfilled the requirements of Articles 84 and 123 (2) EPC and defined a novel and inventive subject-matter. Document

(5) EP-A-0 953 330

was not admitted into the proceedings since it was late filed and *prima facie* not relevant.

III. The Proprietor of the patent in suit (Appellant 1) and the Opponent (Appellant 2) lodged appeals against the above decision.

IV. With a letter dated 12 March 2008, the Appellant 1 filed, inter alia, a set of 23 claims as main request, this request being the same as the patent as granted.

Claim 1 of the main request reads as follows:

"1. A cosmetic composition, containing a four-layered interference pigment comprising an innermost layer of mica, a first outer layer of a colored pigment, a second outer transparent layer, and a outermost layer of a colored pigment, combined with a traditional interference pigment."

V. According to the Appellant 1, document (5) did not disclose a composition containing the combination of the two pigments required by the claims in suit. The claimed compositions were thus novel. If document (5) was considered as the closest prior art, the question of inventive step raised fresh issues since that document was not considered by the opposition division. Therefore, the case should be remitted to the department of first instance for further prosecution for the purpose of giving the Appellant 1 a fair procedural treatment and a reasonable opportunity to prepare its defence. The decision under appeal was not properly reasoned with regard to the issue of inventive step, in particular, since the opposition division did not rely on prior art documents when arriving at the conclusion that the compositions in accordance with the main request were obvious. This lack of reasoning

constituted a substantial procedural violation since it deprived Appellant 1 of the possibility of properly preparing the grounds for appealing the contested decision. Consequently, the appeal fee should be reimbursed.

VI. The Appellant 2 withdrew its objection of insufficiency of disclosure of the invention under Article 100 (b) EPC in relation to the subject-matter of the main request. The claimed compositions were not novel with regard to document (5) which disclosed compositions containing a traditional interference pigment and a four-layered interference pigment comprising mica and a layer of a colored metal oxide. This document represented the closest prior art in the assessment of inventive step. Therefore the question of inventive step raised fresh issues justifying that the case be remitted to the department of first instance. The decision under appeal was not properly reasoned with regard to the issue of inventive step, in particular, since the opposition division did not consider the prior art documents cited by the Appellant-Opponent when arriving at the conclusion that the subject-matter of the then pending auxiliary request involved an inventive step. This lack of reasoning constituted a substantial procedural violation justifying the reimbursement of the appeal fee.

VII. The Appellant 1 requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution upon the basis of claims 1 to 23 of the

main request filed with a letter dated 12 March 2008, and that its appeal fee be reimbursed.

VIII. The Appellant 2 requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution and that its appeal fee be reimbursed.

IX. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeals are admissible.

Main request

2. *Sufficiency of disclosure*

During the oral proceedings in front of the Board, the Appellant 2 did not maintain its objection under Article 100 (b) EPC in relation to the subject-matter of the claims as granted, i.e. that the invention was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The Board does not see any reason to raise such an objection on its own.

3. *Novelty*

3.1 Novelty was acknowledged by the Opposition Division with regard to the documents then pending in the proceedings. The objections raised by the Appellant 2

in front of the opposition division on the basis of these documents were not maintained in front of the Board. The Board sees no reasons to depart from these findings. However, according to the Appellant 2 the claimed compositions were not novel with regard to the compositions disclosed in document (5), which was not admitted into the proceedings by the Opposition Division.

- 3.2 Claim 1 of the main request is directed to a composition containing the combination of two pigments, i.e. a traditional interference pigment and a four-layered interference pigment comprising an innermost layer of mica, a first outer layer of a colored pigment, a second outer transparent layer, and an outermost layer of a colored pigment.

Document (5) which *prima facie* appears highly relevant, discloses a composition containing at least a first agent of coloration and at least a second agent of coloration, one of the two agents being a goniochromatic agent, i.e. an agent capable of producing a "color flop" effect, and the other agent being a monochromatic agent (claim 1). The goniochromatic agent is selected from a list of different multi-layered interference structures including, *inter alia*, the multi-layered interference pigment $\text{Fe}_2\text{O}_3/\text{SiO}_2/\text{mica-oxide}/\text{SiO}_2/\text{Fe}_2\text{O}_3$ (claim 6). The nature of the oxide on the mica is however not indicated in document (5), thus not disclosing whether the oxide in the "mica-oxide" entity is or is not a colored pigment as required for the first outer layer of the four-layered interference pigment defined in claim 1 of the main request. Furthermore, according to

claim 8 of document (5), the monochromatic agent is selected from a list of different compounds including, *inter alia*, mica layered with titanium oxide or iron oxide, these compounds being, as acknowledged by both parties, "traditional interference pigments" which are also envisaged by the patent in suit (page 3, lines 22 and 23). The specific combination of a multi-layered interference pigment of formula $\text{Fe}_2\text{O}_3/\text{SiO}_2/\text{mica-oxide}/\text{SiO}_2/\text{Fe}_2\text{O}_3$ with a "traditional interference pigment" is however not disclosed in document (5).

It is established jurisprudence of the Boards of Appeal that subject-matter resulting from a specific combination requiring the selection of elements from at least two lists is normally regarded as novel (see e.g. T 12/81, point 13 of the reasons, OJ EPO 1982, 296). Applying this principle in the present case, even when assuming that the interference pigment of formula $\text{Fe}_2\text{O}_3/\text{SiO}_2/\text{mica-oxide}/\text{SiO}_2/\text{Fe}_2\text{O}_3$ was a four-layered pigment as defined in claim 1 of the main request, to arrive at the claimed composition from the disclosure of document (5) a double selection is necessary, namely the selection of $\text{Fe}_2\text{O}_3/\text{SiO}_2/\text{mica-oxide}/\text{SiO}_2/\text{Fe}_2\text{O}_3$ in the list of the possible goniochromatic agents and the selection of a traditional interference pigment in the list of the possible monochromatic agents. However, document (5) does not contain any pointer leading the skilled person directly and unambiguously to that particular selection of pigments.

- 3.3 Therefore, the composition according to claim 1 is novel with regard to the disclosure of document (5). For the same reasons, the subject-matter of dependent claims 2 to 12, the composition according to claims 13

to 20 and the method involving the claimed compositions according to claims 21 to 23 are also novel with regard to the disclosure of document (5).

4. *Inventive step*

Since the disclosure of document (5) encompasses a composition containing the combination of a four-layered interference pigment with a traditional interference pigment (see paragraph 3 above), this document comes closer to the claimed invention than document (4) which solely discloses a four layered-interference pigment *per se*. Consequently, document (5) is considered as representing the closest prior art for the assessment of inventive step.

5. *Requests for remittal*

Both Appellants requested that the case be remitted to the department of first instance for further prosecution since document (5) which is now considered as the closest prior art has not been considered by the Opposition Division for the assessment of inventive step.

In the present case, document (5) representing the closest prior art was not admitted into the proceedings by the Opposition Division. The fact that in the appeal proceedings this document is considered as representing the closest prior art changes the case in such a manner that the assessment of inventive step gives rise to fresh issues not yet addressed in the opposition proceedings. The fresh issues arise in view of the fact that document (5) discloses a combination of a four-

layered interference pigment and a traditional interference pigment, whereas document (4), considered by the parties as representing the closest prior art in the first instance proceedings, did not disclose such a combination.

Under these circumstances, the Board exercising its discretion under Article 111 (1) EPC, finds it appropriate to remit the case to the first instance for further prosecution on the basis of the claims of the main request (patent as granted), the remittal guaranteeing the parties two instances and a fair opportunity to prepare their respective positions on the fresh issues.

6. *Procedural violation*

Both Appellants have objected to the decision under appeal as being insufficiently reasoned in violation of Rule 68(2) EPC 1973 (Rule 111(2) EPC 2000). This decision on one hand refused the main request (patent as granted) for lack of inventive step, and on the other hand found that the subject-matter of the auxiliary request then pending involved an inventive step.

- 6.1 According to established jurisprudence of the Boards of Appeal, to satisfy the requirement of Rule 68(2) EPC 1973 (Rule 111(2) EPC 2000) a decision should contain, in logical sequence, those arguments which justify its tenor. The conclusions drawn by the deciding body from the facts and evidence must be made clear. Therefore all the facts, evidence and arguments which are essential to the decision must be discussed in detail

in the decision including all the decisive considerations in respect of the factual and legal aspects of the case. The purpose of the requirement to reason the decision is to enable the Appellants and, in case of an appeal, also the Board of Appeal to examine whether the decision could be considered to be justified or not (see T 278/00, OJ EPO, 2003, 546; T 1366/05 not published in OJ EPO).

6.2 In the present case, the deciding body, here the Opposition Division, decided, against Appellant 1 that the claimed subject-matter of the patent as granted did not involve an inventive step and, against Appellant 2, that the subject-matter of the auxiliary request then pending involved an inventive step (Article 56 EPC). Article 56 EPC requires that the assessment of inventive step is made "having regard to the state of the art". Accordingly, the logical chain of reasoning of the Opposition Division in the decision under appeal, to justify the above conclusions under Article 56 EPC, has to contain a proper assessment of the question of obviousness in the light of the prior art.

6.3 The only part of the section "Reasons for the Decision" of the written decision under appeal dealing with the issue of inventive step in relation with the main request is to be found in section C, point 3 comprising three paragraphs. Since paragraph 3.2 thereof only repeats the arguments of the Proprietor of the patent in suit and does not reflect the Opposition Division's own considerations, this paragraph in fact should rather belong to the section "Facts and Submissions" of the written decision under appeal. The mere summary of a party's submission is not *per se* a reasoning proper

to the deciding body. Consequently, paragraphs 3.1 and 3.3 are the sole portions of the written decision under appeal which may reveal the reasoning of the Opposition Division on the issue of inventive step and, thus, are the sole portions of the decision which could justify the Opposition Division's conclusion of lack of inventive step in relation to the main request. However, there is no reference at all in these paragraphs to any prior art, paragraph 3.1 merely stating that the claimed subject-matter did not comply with the requirements of Article 56 EPC since the technical problem had not been solved, i.e. the purported effect not achieved, over its whole scope and paragraph 3.3 being limited to the mere statements that "the technical problem has not been solved over the whole scope claimed" and that the "subject-matter is considered to be too broadly defined".

Therefore, the Opposition Division arrived in the appealed decision at the conclusion that the subject-matter of the main request lacked inventive step merely by stating that a purported effect has not been achieved, i.e. this technical problem had not been solved, without reformulating the problem in a less ambitious way and without assessing obviousness of the claimed solution to that reformulated problem in the light of the cited prior art.

Since, the requirement of inventive step defined in Article 56 EPC is based on "the state of the art", the decision of the opposition division, by arriving at a conclusion of lack of inventive step without reference to prior art, is insufficiently reasoned in the sense of Rule 68(2) EPC 1973 (Rule 111(2) EPC 2000).

6.4 The only part of the section "Reasons for the Decision" of the written decision under appeal dealing with the issue of inventive step in relation to the auxiliary request is to be found in section D, point 3 comprising also three paragraphs. Since paragraph 3.2 thereof only repeats the arguments of the Opponent, this paragraph does not reflect the Opposition Division's own considerations and in fact should also belong to the section "Facts and Submissions" of the written decision under appeal. The mere summary of a party's submission is not *per se* a reasoning proper to the deciding body. Consequently, paragraphs 3.1 and 3.3 are the sole portions of the written decision under appeal which may reveal considerations and findings of the Opposition Division on the issue of inventive step and, thus, are the sole portions of the decision which could justify the Opposition Division's conclusion on inventive step in relation to the auxiliary request then pending. However, there is no reference at all in these paragraphs to any prior art, paragraph 3.1 merely stating that the claimed subject-matter fulfils the requirements of Article 56 EPC, and paragraph 3.3, after discussing the tests provided by the Opponent, merely states that the Opposition Division, "... is of the opinion that the specific choice of an interference pigment to solve the problem posed was not obvious" and that "the skilled artisan had no motivation to select that specific type of pigments amongst the whole list of existing pigments" without discussing the prior art and without basing these statements on facts and evidence.

Hence, the decision under appeal fails to set out the factual and legal considerations supporting the decision taken by the Opposition Division. For this reason, the decision of the Opposition Division that the subject-matter of the then pending auxiliary request involved an inventive step is also insufficiently reasoned in the sense of Rule 68(2) EPC 1973 (Rule 111(2) EPC 2000).

- 6.5 Due to these deficiencies in the reasons for refusing the then pending main request and allowing the then pending auxiliary request, the Board and the Appellants are left in the dark as to how the first instance came to its conclusions. Hence, the Appellants and the Board were not able to examine whether the decision could be considered to be justified or not, the Appellants being moreover hindered in deciding whether to file an appeal against the decision and in drafting the grounds for appeal. This failure amounts to a substantial procedural violation requiring that the decision under appeal to be set aside and the case be remitted to the first instance (see T 278/00, *loc. cit.* point 5, *supra*). The appeals of both parties are thus deemed to be allowable and the Board considers it to be equitable by reason of that substantial procedural violation to reimburse the appeal fees of both parties in the present case pursuant to Rule 67 EPC 1973 (Rule 103(1)(a) EPC 2000).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution upon the basis of claims 1 to 23 of the main request filed with a letter dated 12 March 2008.
3. The appeal fees of both parties are reimbursed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

R. Freimuth