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**Datasheet for the decision
of 7 February 2012**

Case Number: T 0089/08 - 3.3.07
Application Number: 01980525.8
Publication Number: 1330229
IPC: A61K 7/06, A61K 7/50,
C08L 83/00
Language of the proceedings: EN

Title of invention:

Compositions comprising hydrophobic silicone oils and
ethoxylated glycerides

Patent Proprietors:

Kao Corporation

Opponents:

L'OREAL
Henkel Kommanditgesellschaft auf Aktien

Headword:

-

Relevant legal provisions:

EPC Art. 83, 54, 56

Relevant legal provisions (EPC 1973):

-

Keyword:

"Sufficiency (yes)"
"Novelty (yes)"
"Inventive step (yes) - proposed combination of prior art
documents not shown to provide the claimed subject-matter"

Decisions cited:

-

Catchword:

-



Case Number: T 0089/08 - 3.3.07

DECISION
of the Technical Board of Appeal 3.3.07
of 7 February 2012

Applicants 1: L'OREAL
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Respondents: Kao Corporation
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
26 November 2007 concerning maintenance of
European patent No. 1330229 in amended form.

Composition of the Board:

Chairman: J. Riolo
Members: F. Rousseau
P. Schmitz

Summary of Facts and Submissions

I. The appellants 1 (opponents 1) and appellants 2 (opponents 2) lodged appeals on 29 January 2008 and 8 January 2008, respectively, against the interlocutory decision of the opposition division posted on 26 November 2007 which found that the amended European patent No. 1 330 229 according to the documents of the main request met the requirements of the EPC.

II. Notice of opposition had been filed by appellants 1 and appellants 2 requesting 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 WO-A-02/04882
- D2 "Clear Conditioning Shampoo", BI/6155, Clariant, dated September 2000
- D5 Simulsol® 220TM, Seppic, dated 1987
- D6 US-A-5 759 983
- D7 EP-A-0 440 542
- D8 US-A-5 290 555 and
- D9 EP-A-0 998 906.

III. The decision of the opposition division was based on claims 1 to 13 submitted during oral proceedings before the opposition division on 7 November 2007. In that set of claims only independent claim 13 had been amended with respect to the granted claims, independent claims 1, 12 and 13 reading as follows (the deletions made in

claim 13 as granted being indicated in strikethrough and the additions made, in bold and underlined):

- "1. An optically transparent aqueous composition comprising
- (a) a hydrophobic silicone oil in an amount of 1-3 wt.-% with respect to the total weight of the composition;
 - (b) ethoxylated glycerides derived from carboxylic acids having 6 to 22 carbon atoms; and
 - (c) an anionic surfactant,
- wherein the weight ratio of component (b) to component (a) is in the range of 1:1 to 10:1; and wherein the total amount of the components (b) and (c) is in the range of 10-25 wt.-% with respect to the total weight of the composition.
12. Method for preparing a composition according to claim 1, comprising the steps of:
- (a) mixing silicone oil with ethoxylated glyceride derived from carboxylic acids having 6 to 22 carbon atoms in a weight ratio of ethoxylated glyceride to silicone oil in the range of 1:1 to 10:1; and
 - (b) adding anionic surfactant and stirring until a transparent composition is obtained.
13. **Use of the** the (sic) ~~Hair shampoo~~ comprising the composition of any of claims 1 to 11 **as a hair shampoo.**"

IV. According to the decision under appeal:

- (a) Concerning sufficiency of disclosure, although the specification did not define at which concentration a silicone would have to be soluble in paraffinic oil at 25°C to be considered hydrophobic within the meaning of claim 1, the description provided a long list of specific silicones to be used as hydrophobic resins. Hence, the use of the term "hydrophobic silicone" in claim 1 did not prevent the skilled person from carrying out the invention. The objection of lack of sufficiency was rather an objection of lack of clarity, when the skilled person in border line cases might not know whether a substance is hydrophobic in the meaning of the patent in suit. Furthermore, no insufficiency of disclosure arose from the definition of the compositions being optically transparent.

- (b) Novelty was given, in particular over the compositions of D1 and D9 which did not disclose optically transparent compositions as required by the claims of the patent in suit.

- (c) Concerning inventive step, D2 which had not been shown to have been made public before the priority date of the patent could be dismissed for assessing inventive step. Both documents D7 and D8 were considered to represent the closest prior art. The claimed compositions were inventive over the compositions of D8, because it was not obvious for the skilled person to render the composition transparent and try keeping the composition's

structural colour, while reducing the silicone concentration. Starting from D7, the objective problem solved by the claimed subject-matter was seen in the formulation of transparent dermatologically mild compositions. The prior art documents cited did not render obvious the use of ethoxylated glycerides (b) as defined in claim 1 of the patent in suit in order to solve this problem. D5 which disclosed that polyethylene glycol ether of glyceryl stearate was water soluble, did not provide any teaching regarding compositions comprising hydrophobic silicones, let alone transparent compositions comprising those compounds. The opposition division was not aware from its own knowledge that it would be common general knowledge that it was sufficient that a compound was said to be water soluble to make it suitable for use in any clear composition without rendering the composition turbid. For instance, compatibility problems may arise or the addition of said compound may modify the refractive index of the aqueous phase. Therefore, the opposition division was not in a position to conclude that starting from D7 and considering the teaching of D5 the skilled person would have known that polyethylene glycol ether of glyceryl stearate could be used in addition or in replacement of diethanol amide of coconut acid while keeping the transparency of the shampoos. D1 did not relate to transparent compositions and hence could not render the claimed solution obvious either. An inventive step was therefore acknowledged.

- V. With their grounds of appeal filed on 7 April 2008, Appellants 2 submitted *inter alia* document D10 (WO-A-99/63032).
- VI. In reply to the grounds of appeals, the Respondents filed with letter of 8 August 2008 eleven sets of claims as First to Eleventh Auxiliary Requests. They also submitted a copy of Directive 2003/53/EC of the European Parliament and of the Council of 18 June 2003 (hereafter D14) and an experimental report (D15).
- VII. Oral proceedings were held on 7 February 2012, in the absence of Appellants 2, announced in a letter of 5 December 2011. At the end of the oral proceedings, the decision was announced.
- VIII. The arguments of appellants 1 and 2 as far as they are relevant for the present decision can be summarised as follows:
- (a) According to Appellants 1, the patent in suit defined in paragraph [0009] that a hydrophobic silicone oil was generally a silicone oil which was soluble in paraffinic oil at 25°C, but failed to define its degree of solubility. In the absence in the patent of a clear definition for the hydrophobic silicone oil, which was an essential feature of claim 1, the skilled person could not carry out the claimed invention, which was therefore insufficiently disclosed.
- (b) The subject-matter defined in claims 1, 3, 6, 8, 9 and 11 to 13 of the patent in suit lacked novelty, as the composition disclosed in example III of D1

contained components (a) to (c) and their respective amounts as defined in said claims.

- (c) As regards inventive step, Appellants 1 provided lines of analysis starting from either document D7 or D1. Further objections of lack of inventive step submitted in writing starting from any of documents D2, D6, or D8 were no longer pursued during the oral proceedings. Concerning document D7, the optically transparent shampoo compositions according to its examples 6 to 8, 11 and 12, which contained a hydrophobic silicone oil emulsified with the emulsifying agent Akypo NP 70, constituted the closest prior art. The compositions according to claim 1 of the patent in suit differed from those disclosed in D7 only in that they contained an ethoxylated glyceride derived from carboxylic acids having 6 to 22 carbon atoms in the amount specified in claim 1. It was pointed out in this context that claim 1 of the granted patent did not require component (b) to be used for solubilising the hydrophobic silicon oil (a) and that claim 1 also allowed in addition to ingredients (a) to (c) the use of further compounds, such as Akypo NP 70. The comparative data D15 had not been carried out with Akypo NP 70 and therefore did not allow to assess the problem solved over the transparent shampoo compositions of D7. Hence, the problem solved over D7 by the subject-matter of claim 1 lay in the provision of a further transparent shampoo composition. Concerning the use of compound b), D5 taught that Simulsol®220 TM, a stearic acid ester of polyethoxylated glycerol, was innocuous to eyes

and skin and could be advantageously used as substituent for copra acid diethanolamide in shampoo compositions. Moreover, in the light of the teaching of document D5, the skilled person had reasonable expectation of success to obtain transparent compositions when replacing copra acid diethanolamide by Simulsol®220 TM in the compositions of examples 6 to 8, 11 and 12 of D7. First, Simulsol®220 TM was considered to be colourless in view of its Gardner index indicated in D5. Second, Simulsol®220 TM was disclosed in D5 to be soluble in water, in anionic and non-ionic surfactants, which meant that it would be soluble in about 90% of the compositions according to D7, which contained 70% of water, 10% of anionic surfactants and 11% of non-ionic surfactants. Third, Simulsol®220 TM was a solubilising agent and it did not have any negative effect on foaming. Finally, the transparency of the compositions according to examples 6 to 8, 11 and 12 of D7 did not depend on the presence of copra acid diethanolamide. Therefore, the skilled person, wishing to provide further transparent shampoo compositions, would have expected that Simulsol®220 TM could be introduced without disturbing the silicone emulsions of D7. He would, thus, have been guided in view of the properties of Simulsol®220 TM reported in D5 to replace copra acid diethanolamide by Simulsol®220 TM, arriving thereby at a composition falling within the ambit of claim 1 of the patent in suit.

- (d) Appellants 1 also provided an objection of lack of inventive step starting from example III of D1.

Example III of D1 related to an opaque composition comprising in addition to all ingredients of claim 1 of the patent in suit an opacifying agent. The removal of said opacifying agent in order to provide a transparent composition was an obvious measure for the skilled person which deprived claim 1 of the patent in suit of any inventive character.

- (e) As regards inventive step, Appellants 2 had provided objections in writing for lack of inventive step starting from either document D8 or D10. D8, in particular its example 1, which disclosed all the features of claim 1 of the patent in suit to the exception of the content of hydrophobic silicone oil, which was in that document in excess of 3 wt.-%, constituted the closest prior art, as it also related to transparent shampoo compositions. Alternatively, Examples 1 and 2 of D10, which document related to cosmetic cleaning compositions, in particular for hair, in which fragrance or oil should be incorporated without encountering turbidity, could be taken as starting point for analysing inventive step. Those compositions differed from the subject-matter of the patent in suit only in that use was made of a hydrophobic isopropylmyristat oil instead of a hydrophobic silicone oil.

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

- (a) As regards sufficiency, the objection of Appellants 1 that the claimed subject-matter was

not sufficiently disclosed, as the meaning of "hydrophobic" silicone oil was not clear, was, if anything, a clarity objection, which was not a ground for opposition. Furthermore, based on the long list of specific hydrophobic silicones exemplified in the specification, the skilled person would have no difficulty in manufacturing compositions comprising hydrophobic silicones in the meaning of the patent.

- (b) Regarding novelty, Appellants 1 had failed to prove that the composition according to example III of D1 was despite the use of ethylene glycol distearate optically transparent, as required by the patent in suit. Novelty had therefore to be acknowledged.

- (c) Concerning inventive step, the argument that the closest prior art was represented by examples 1 and 2 of D10, but not by D7, as this prior art employed Akypo NP70, which was a product of no commercial value as shown by D14, was not pursued at oral proceedings. Starting from D7 as the closest prior art, the objective technical problem solved vis-à-vis this reference was the provision of dermatologically mild compositions while keeping the compositions optically transparent. No evidence had been provided that D5 had been made available to the public before the date of priority. Even if it were the case, D5 only disclosed that polyethylene glycol ether of glycerol stearate was water soluble and had solubilising properties, but it failed to provide any teaching regarding the solubilisation of

hydrophobic substances such as oils, let alone hydrophobic silicones. Hence, it could not be derived from D5 that ethoxylated glycerides would be suitable to provide transparent compositions comprising hydrophobic silicones. Moreover, the skilled person knew that the stability of such clear formulations as described in D7 depended on a proper balance of the different ingredients, and that the replacement of one ingredient by another may render the composition turbid. Furthermore, optical transparency did not solely result from the ingredients defined in claim 1 of the patent in suit, but also on the process used for mixing those ingredients as specified in the description. It was also referred to page 43 of D12, according to which solubilisation of silicones as to obtain clear shampoos was difficult. Hence, replacing Cocamide DEA by ethoxylated glyceride while maintaining the optical transparency was certainly not obvious to the skilled person. The claimed subject-matter was therefore not obvious in view of a combination of D7 with D5.

- X. Appellants 1 and 2 requested that the decision under appeal be set aside and that the patent be revoked.

- XI. The respondents requested that the appeals be dismissed, alternatively that the decision under appeal be set aside and that the patent be maintained on the basis of Auxiliary Requests 1 to 11, filed with letter dated 8 August 2008.

Reasons for the Decision

1. The appeals are admissible.

Sufficiency of disclosure

2. The question to be answered in respect of the alleged insufficiency of disclosure is whether the patent in suit provides sufficient information which enables the skilled person to perform the invention as defined in the claims, taking into account common general knowledge. The patent in suit provides in paragraphs [0010] to [0013] a list of hydrophobic silicones and in paragraphs [0015] to [0020] a list of ethoxylated glycerides derived from carboxylic acids having 6 to 22 carbon atoms, which are suitable for obtaining the claimed optically transparent aqueous compositions. It was not disputed that the compounds recommended in those passages, in combination with anionic surfactants, would provide optically transparent compositions when following the method taught in claim 12 of the patent in suit and with more details in its paragraphs [0036] to [0041], [0045] and [0047]. It is the point of Appellants 1, however, that, owing to the absence in paragraph [0009] of the patent of a clear definition for the hydrophobic silicone oil, which in their opinion is an essential feature of claim 1, the skilled person could not carry out the claimed invention.
3. Paragraph [0009] of the specification defines that "*a hydrophobic silicone is generally a silicone oil which is soluble in paraffinic oil at 25°C*". It is not in dispute that in the absence of any definition of the proportion at which the silicone oil must be soluble in

paraffinic oil at 25°C to be considered as hydrophobic within the meaning of the patent in suit, some ambiguity might arise, when the silicone oil is not one of those specifically defined in paragraphs [0010] to [0013] of the patent in suit. However, the lack of definition of a degree of solubility in paraffinic oil at 25°C in order to assess whether some of the silicone oils which are not specifically mentioned in those paragraphs are hydrophobic within the meaning of the patent in suit rather concerns the difficulty to determine whether certain compositions fall within the ambit of present claim 1, which is a matter of Article 84 EPC, but not the possibility for the skilled person to reproduce the claimed composition when following the teaching provided by the patent. Hence, the argument presented by Appellants 1 cannot represent a successful challenge to sufficiency of disclosure and the objection under Article 100(b) EPC is rejected.

4. Moreover, as the alleged ambiguity in claim 1 in respect of the definition of the hydrophobic silicone oil does not arise out of any amendment made in opposition or appeal proceedings, the lack of compliance of claim 1 with the requirements of Article 84 EPC addressed by Appellants 1 is not an issue which can be considered in these appeal proceedings.

Novelty

5. Lack of novelty of the subject-matter of present claims 1, 3, 6, 8, 9 and 11 to 13 over the composition described in example III of D1, as alleged by Appellants 1, would arise only if that subject-matter

were derivable as a whole directly and unambiguously from the cited disclosure. It is the established case law of the boards of appeal that, in opposition proceedings before the EPO, each party carries the burden of proof for the facts it alleges (Case Law of the Boards of Appeals of EPO, 6th edition, 2010, VI.H.5.2). With regard to the critical feature of claim 1 of the patent in suit that the composition is optically transparent, it is stated in paragraphs [0035] and [0036] of the specification, that this property may not always be obtained by simply mixing the ingredients in any arbitrary order and that a specific preparation method, namely that defined in general terms in claim 12 of the patent in suit, is required. It also common general knowledge that an emulsion can be transparent, translucent or turbid depending on the particle size of the dispersed phase and the refractive index difference between the dispersed and the continuous phase. In other words, the feature that the composition is optically transparent does not depend only on the presence of constituents (a), (b) and (c) defined in present claim 1, but also on the presence of further constituents and the manner the composition has been obtained. Appellants 1, however, did not offer any experimental evidence showing that optical transparency is obtained with the composition according to Example III of D1, nor arguments why this composition, despite the presence of ethylene glycol distearate, which is a known pearlescing and opacifying agent, would be also optically transparent. In view of the above, Appellants 1, who carry the burden of proof for their allegation, that the composition of example III of D1 is as required by claim 1 of the patent in suit optically transparent, have failed to demonstrate that

D1 anticipates the subject-matter of the patent in suit. Consequently, the ground of opposition under Article 100(a) EPC based on lack of novelty over D1 is rejected.

Inventive step

Closest state of the art

6. The closest prior art for the purpose of assessing inventive step is generally that which corresponds to a purpose or effect similar to that of the invention and requiring the minimum of structural and functional modifications (Case Law, supra, I.D.3.1). According to paragraph [0006] of the patent in suit, it was known in the art to incorporate 0,5 wt.-% of silicone oil into shampoos when using wash-active matter within the range of 15-40 wt.-%. Higher amounts of hydrophobic silicone oil could only be solubilized by increasing the amount of wash-active matter which, however, is not acceptable for dermatological, environmental and economic reasons. As stated in the following paragraph [0007], which must be read in the light of paragraph [0006], the present invention aims at providing an easily preparable, optically transparent aqueous composition being suitable as hair shampoo and which contains an amount of hydrophobic silicone oil in excess of 0,5 wt.-% without increasing the amount of wash-active matter. Appellants 1 have provided objections for lack of inventive step starting from either document D7 or D1, whereas Appellants 2 employed either document D8 or document D10.

7. The examples 6 to 8, 11 and 12 of D7 relate to clear shampoo compositions containing 2,5 wt.-% of a hydrophobic silicone oil, 9 wt% of an emulsifier for said silicone oil with the trade name Akypo NP 70, 2,5 wt.-% of copra acid diethanolamide, and an amount of anionic surfactant ranging from 4 to 12 wt.-%. An additional surfactant is also used in an amount of 4 wt.-% for examples 10 and 12. For the above examples, the ratio of copra acid diethanolamide to hydrophobic silicone oil is 1:1 and the total amount of copra acid diethanolamide and anionic surfactant is within the range of 10 to 25 wt.-%. Hence, D7 achieves the objective defined in the patent in suit of increasing the amount of silicone oil in excess of 0,5 wt.-% with amounts of wash-active matters below 40 wt.-%. It constitutes therefore a suitable starting point for assessing inventive step. The argument that the skilled person would not start from the clear shampoos of examples 6 to 12 of D7, because he would have known at the priority date in view of D14 that they had no commercial value fails to convince as D14 has a date posterior to the date of filing of the present application and therefore at least for that reason could not have influenced the skilled person in selecting the starting point for the claimed invention.
8. Concerning D8, this document is directed to a broad range of cosmetic products, including shampoos, which comprise a mixture of at least two incompletely miscible fluid phases, said products exhibiting the optical phenomenon known as "structural colour" (see claim 1, column 1, lines 10-14 and passage bridging columns 2 and 3). Example 1 of D8 cited by Appellants 2 as starting point for their analysis of inventive step

is a hair shampoo for which neither argument, nor evidence, has been put forward as to why it would be considered by the skilled person as optically transparent within the meaning of the patent in suit. Moreover, among the various cosmetic products disclosed in examples 1 to 16 of D8, which exhibit structural colour, it is also specified for some of them whether they are translucent (examples 5 and 10), hazy (examples 7 and 8) or transparent (examples 11 and 12), whereas for the other exemplified compositions, including that of example 1, no indication has been provided in this respect. Under those circumstances, there is no reason to consider that all compositions exemplified in D8 are transparent, including that of example 1. Thus, the disclosure of example 1 of D8 constitutes for the skilled person a less suitable starting point than D7 for achieving the objectives set out in paragraph [0007] of the patent in suit. The same holds true for the disclosure of D1, in particular its example III, as D1 does not address or suggest optical transparency of the compositions disclosed therein. The fact that Example III of D1 contains an opacifying agent does not automatically lead to the conclusion that the composition in the absence of that agent would necessarily be optically transparent. As concerned D10, it was also not shown that exemplified compositions 1 and 2 suggested by Appellants 2 as starting point for their assessment of inventive step relate to clear compositions, let alone to shampoos. The argument that D10 in view of page 1, lines 15-17 and page 4, last paragraph, relates to cosmetic cleansing compositions, in particular for hair, in which fragrance or oil should be incorporated without encountering turbidity as often experienced in the state of the art, is not

based on a proper interpretation of D10 and therefore is to be disregarded. The first passage cited only refers to the known problem of turbidity and phase separation encountered when adding oily components to liquid body cleansing compositions. The second passage cited merely indicates that the oily component is preferably, and therefore not necessarily, solubilised as to provide a clear composition. This is in line with the objective of the invention according to D10 which in view of the second paragraph on page 2 is to provide body cleansing gel compositions containing a significant amount of stably emulsified or solubilised oily components, which does not necessarily imply that optical transparency is required. Moreover, D10 does not teach the use of a silicone oil for the oily phase. Thus, in the absence of any argument as to why the skilled person would consider that the specific compositions of D8, D1 or D10 cited by the Appellants are optically transparent or can be easily modified as to achieve this property, the selection of one of those prior art documents as starting point for analysing the issue of inventive step would require hindsight knowledge of the present invention, in particular that ethoxylated glycerides derived from carboxylic acids having 6 to 22 carbon atoms contribute in the framework of the compositions defined in claim 1 of the patent in suit to achieve optical transparency. Hence, D7 constitutes the closest state of the art and the starting point for analysing inventive step.

Problem and solution

9. Having regard to the disclosure of examples 6 to 8, 11 and 12 of D7, Appellants 1 and the Respondents

submitted that the technical problem underlying the invention according to claim 1 of the contested patent was merely the provision of further optically transparent aqueous compositions being suitable as hair shampoo. According to claim 1 of the patent in suit, the solution to this problem lies in the use of

- (a) a hydrophobic silicone oil in an amount of 1-3 wt.-% with respect to the total weight of the composition;
- (b) ethoxylated glycerides derived from carboxylic acids having 6 to 22 carbon atoms; and
- (c) an anionic surfactant,

wherein the weight ratio of component (b) to component (a) is in the range of 1:1 to 10:1; and wherein the total amount of the components (b) and (c) is in the range of 10-25 wt.-% with respect to the total weight of the composition.

10. As pointed out by Appellants 1, claim 1, the definition of which does not limit the use of the ethoxylated glycerides derived from carboxylic acids having 6 to 22 carbon atoms as emulsifiers for the hydrophobic silicone oil, is in addition openly defined for the use of constituents other than those specifically mentioned in that claim. In other words, the definition of present claim 1 embraces not only compositions with an ethoxylated glyceride derived from carboxylic acids having 6 to 22 carbon atoms acting as emulsifier for the hydrophobic silicone oil, in accordance with examples 1 and 2, claim 12 and paragraphs [0037] to [0039] of the patent in suit, but also further compositions wherein another additional compound is

used as emulsifier for the hydrophobic silicone oil and an ethoxylated glyceride derived from carboxylic acids having 6 to 22 carbon atoms fulfils partially or entirely a different function.

Obviousness

11. Appellants 1 did not challenge that starting from any of the compositions of examples 6 to 8, 11 and 12 of D7, it would not have been obvious for the skilled person to replace the AKYPO NP 70 emulsifier used in those composition by an ethoxylated glyceride derived from carboxylic acids having 6 to 22 carbon atoms, when he wanted to provide further optically transparent shampoo compositions. The Board is not aware of any document relevant in this respect and, thus, is satisfied that the embodiments, wherein the ethoxylated glycerides derived from carboxylic acids having 6 to 22 carbon atoms act as emulsifier for the hydrophobic silicone oil are not derived in an obvious manner from the prior art.

12. The line of argumentation of Appellants 1 in respect of obviousness rather concerns the replacement in the compositions of examples 6 to 8, 11 and 12 of D7 of the 2,5 wt.-% of copra acid diethanolamide by the same amount of a specific ethoxylated glyceride derived from carboxylic acids having 6 to 22 carbon atoms, namely Simulsol®220 TM, which replacement according to the opinion of Appellants 1 represents in light of D5 an obvious solution to the problem stated above. In the oral proceedings, the Respondents contested for the first time, that D5 was publicly available. D5 is a brochure which seems to have been intended for public

distribution, although Appellants 1 did not provide any evidence that such distribution has actually occurred, which would have been their obligation. The Respondents' belated submission, however, needs not further be considered, since as set out below, the subject-matter of the patent in suit is inventive even taking this document into consideration. The line of argumentation of Appellants 1 in respect of obviousness is based on the assumption that the above mentioned substitution resulting from the combined teachings of D7 and D5 leads to a product embraced by claim 1 of the patent in suit. Thus, the first question to be answered, before obviousness of this substitution is addressed, is whether the above assumption is correct, namely whether it results in a composition meeting all requirements of present claim 1, including optical transparency.

13. Appellants 1 argued that the optical transparency of the emulsions of examples 6 to 8, 11 and 12 of D7 was not due to the presence of copra acid diethanolamide, but to the use of Akypo NP 70 as emulsifying agent for the silicone oil. Moreover, the compositions according to examples 6 to 8, 11 and 12 of D7 contained about 90 wt.-% of water, anionic and non-ionic surfactants, in which according to D5 Simulsol®220 TM would be soluble. In addition Simulsol®220 TM was colourless as shown by its Gardner index also indicated in D5. Appellants 1 therefore argued on that basis that the skilled person had reasonable expectations of success to obtain optically transparent compositions when merely replacing copra acid diethanolamide by the same quantity of Simulsol®220 TM.

14. These arguments might provide an indication on whether the replacement of copra acid diethanolamide by Simulsol®220 TM in those compositions might rather lead to optically transparent compositions or not. They do not, however, constitute evidence that optically transparent compositions result from the substitution within the teaching of D7 of Simulsol®220 TM for copra acid diethanolamide. This issue cannot be merely resolved in assessing which product is more likely to result from said substitution, but is a matter of fact, which therefore must be unambiguously established. A conclusion of lack of inventive step based on a combination of the teachings of D7 and D5 ought not to be reached unless the proposed combination has been unambiguously shown to result in a product embraced by the subject matter of present claim 1.

15. In the proceedings before the EPO, each party bears the burden of proof for the facts it alleges (see point 5. supra). In the present case, Appellants 1 who bears the burden of proof for the alleged optical transparency, resulting from the replacement of copra acid diethanolamide by Simulsol®220 TM in the embodiments according to examples 6 to 8, 11 and 12 of D7, did not provide any experimental evidence in this respect. Furthermore, no argument or additional evidence has been presented as to why the above mentioned properties of Simulsol®220 TM would be sufficient to ensure that the replacement of copra acid diethanolamide by Simulsol®220 TM would lead within the framework of examples 6 to 8, 11 and 12 of D7 also to an optically transparent composition, and not only to a hazy or translucent composition. The arguments presented by Appellants 1 relating to the properties of

Simulsol®220 TM described in D5 rather relate to a possible explanation for the alleged optical transparency, should it be first demonstrated, or at most to a motivation for the skilled person to try the combination of the teachings according to D7 and D5 in order to obtain optically transparent compositions. They do not, however, constitute evidence that optical transparency, which is a functional requirement of claim 1 of the patent in suit is in fact obtained by this combination of teachings, which the Board on its own knowledge is not in the position to establish. Under these circumstances, the decision as to whether optical transparency can be considered to result from the replacement of copra acid diethanolamide by Simulsol®220 TM, goes to the detriment of Appellants 1, who has not provided evidence for their allegations.

16. Therefore, the combined teaching of prior art documents D7 and D5 on which Appellants 1 have argued lack of inventive step, has not been established to lead to something encompassed by the claims of the patent in suit, with the consequence that this line of argumentation cannot succeed.

17. 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.

18. 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:

The appeals are dismissed.

The Registrar

The Chairman

S. Fabiani

J. Riolo