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**Datasheet for the decision
of 06 March 2009**

Case Number: T 1144/08 - 3.3.07

Application Number: 99300932.3

Publication Number: 0951898

IPC: A61K 7/06

Language of the proceedings: EN

Title of invention:

Hair conditioning compositions

Patentee:

JOHNSON & JOHNSON CONSUMER COMPANIES, INC.

Opponents:

Henkel AG & Co. KGaA
KPSS-Kao Professional Salon Services GmbH
L'OREAL

Headword:

-

Relevant legal provisions:

EPC Art. 123(2) (3), 84

Relevant legal provisions (EPC 1973):

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Keyword:

-

Decisions cited:

G 0001/03, T 0201/83, T 1067/97, T 0962/98, T 0068/99,
T 0749/03, T 0461/05

Catchword:

-



Case Number: T 1144/08 - 3.3.07

DECISION
of the Technical Board of Appeal 3.3.07
of 06 March 2009

Appellants: JOHNSON & JOHNSON CONSUMER COMPANIES, INC.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 10 April 2008
revoking European patent No. 0951898 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: S. Perryman
Members: B. ter Laan
F. Rousseau

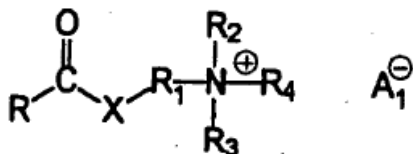
Summary of Facts and Submissions

I. The appeal by the patent proprietors (appellants) lies against the decision of the Opposition Division posted on 10 April 2008 to revoke European patent No. 0 951 898, based on European application No. 99 300 932.3.

II. Claims 1 and 3 as originally filed read:

"1. A composition comprising, based on the weight of the composition:

A. from 0.01 percent to 2.0 percent of a first quaternary ammonium compound of the formula



and

B. from 0.01 to 2.00 percent of a silicone compound wherein

R is a substituted or unsubstituted alkyl or alkenyl group having from 11 to 35 carbon atoms,

X is -O- or -N(R₅)-,

R₁ is a substituted or unsubstituted alkylene group having from 2 to 6 carbon atoms,

R₂, R₃ and R₄ are each independently an alkyl or hydroxyalkyl group having from 1 to 4 atoms,

R₅ is H or CH₃, and

A₁ is chloride; bromide; alkylsulfate containing from one to two carbon atoms; or mixtures thereof."

"3. The composition of claim 1 or claim 2 wherein R is an alkyl group having from 19 to 21 carbon atoms or mixtures thereof, X is an -N(R₅)- group and R₅ is H."

Claim 1 as granted was the same as Claim 1 as filed except for section B, in which the definition of R read (additions being indicated in bold and underlined, deletions by strikethrough):

"...wherein R is a substituted or unsubstituted alkyl or alkenyl group having from ~~11~~ **19** to 35 carbon atoms,"

The wording of claim 3 as granted was identical to that of claim 3 as originally filed.

- III. Three notices of opposition against the patent were filed in which the revocation of the patent in its entirety was requested on the grounds, amongst others, of Article 100(c) EPC.
- IV. At the end of oral proceedings held on 13 March 2008, the opposition division revoked the patent on the grounds that:
- (a) Claim 1 as granted did not comply with Article 123(2) EPC since the lower limit of 19 carbon atoms for R had only been disclosed in combination with the specific meaning for X being -N(R₅)-, so that the main request for rejection of the opposition was refused.

(b) The auxiliary request relating to amended claims filed during the oral proceedings before the opposition division, had a claim 1 containing a disclaimer that however did not fulfil any of the allowability criteria given in Decision G 0001/03 (OJ 2004, 413), so that this claim did not comply with the requirements of Article 123(2) EPC. So the auxiliary request was refused and the patent was revoked.

V. On 19 June 2008 the appellants filed a notice of appeal against the above decision. The prescribed fee was paid on the same day. In the statement setting out the grounds of appeal filed on 19 August 2008, the appellants submitted as main request rejection of the opposition (that is maintenance of the patent as granted) as well as seven auxiliary requests with amended claims, together with arguments supporting those requests. By letter dated 13 February 2009 new Auxiliary Requests I, II and VII, replacing the correspondingly numbered previously filed requests, were submitted. By letter of 2 March 2009 a further auxiliary request, indicated as Ib and to be considered between Auxiliary Requests I and II, was filed.

Claim 1 of Auxiliary Request I was the same as Claim 1 as granted except that the definition of R in section B. of the claim read:

"...wherein R is a substituted or unsubstituted alkyl or alkenyl group having from 11 ~~19~~ to 35 carbon atoms,"

and that there was an the addition at the end of the claim of a feature reading:

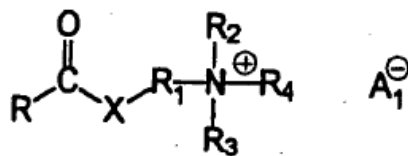
"wherein the quaternary ammonium compound of formula (I) has a structure wherein R is an alkyl group having from 19 to 21 carbon atoms or mixtures thereof, X is an -N(R₅)- group and R₅ is H."

For ease of comprehension the additions compared to claim 1 as granted are indicated by the Board underlined and in bold, and deletions by strikethrough in both the claims above and below.

Claim 1 of Auxiliary Request Ib read:

"1. A composition comprising, based on the weight of the composition:

A. from 0.01 percent to 2.0 percent of a first quaternary ammonium compound of the formula



and

B. from 0.01 to 2.00 percent of a silicone compound selected from dimethicones, which are a mixture of fully methylated linear siloxane polymers end blocked with trimethylsiloxy units; cyclomethicones, which are cyclic dimethyl polysiloxane compounds having from 3 to 6 silicon atoms, and mixtures thereof, wherein

R is an ~~substituted or unsubstituted~~ alkyl ~~or alkenyl~~ group having from 19 to 21 ~~35~~ carbon atoms or mixtures thereof,

X is ~~-O-~~ or ~~-O-~~ -N(R₅)-,

R₁ is a substituted or unsubstituted alkylene group having from 2 to 6 carbon atoms,

R₂, R₃ and R₄ are each independently an alkyl or hydroxyalkyl group having from 1 to 4 atoms,

R₅ is H ~~or CH₃~~, and

A₁ is chloride; bromide; alkylsulfate containing from one to two carbon atoms; or mixtures thereof."

VI. Oral proceedings before the Board were held on 6 March 2009.

VII. The appellants' arguments can be summarised as follows:

Main request - claims as granted

- (a) The original description, page 13, lines 1 to 6, clearly and unambiguously disclosed the value of 19 carbon atoms as a lower limit for R. The question to be answered was, whether that disclosure could be seen independently from the other features mentioned in that passage. According to a number of decisions, it was possible to dissociate features from other features mentioned in combination if no technical dependency or clearly recognizable functional relationship existed between the features of the combination (T 0201/83 (OJ 1984, 481), T 0068/99 of 12 June 2003 and T 1067/97 of 4 October 2000). This applied also to features in an example or in a preferred embodiment (T 461/05 of 10 July 2007).

In the present case, there was no reason why it would be necessary to have all the features mentioned in the passage on page 13 present together.

- (b) The independence of those features was also reflected on page 26, lines 9 to 15, where it was stated in general that long chains for R gave better results than shorter ones.
- (c) Certainly the combination of those two passages, read as a whole, supported the independent use of 19 carbon atoms as a lower limit for R. Also, there was no teaching that the choice of R would depend on other features of the composition.

Auxiliary Request I

- (d) Regarding Auxiliary Request I, the first defining clause for R defined the amount, the second, at the end of the claim, which members to select within the first definition of R. That was consistent with the description. However, the second clause was still an obligation, a composition not meeting both definitions not being permitted.
- (e) It was accepted that the subject-matter so defined was not necessarily narrower than claim 1 as granted, but it was based on claim 3 as granted, so that there was no broadening of the scope of protection. In fact, claim 3 was not a claim properly dependent from claim 1 and should therefore be read as in independent claim in

itself, in accordance with T 749/03 of 15 September 2005, so the requirement of Article 123(3) EPC was complied with.

- (f) Auxiliary Request Ib reflected the contents of claim 3 as granted in a more direct way, so that the objections raised against Auxiliary Request I concerning Article 84 did not apply. Regarding Article 123(2) and (3) EPC the same arguments were valid.

VIII. The arguments of the respondents (opponents) can be summarized as follows:

- (a) The features of the preferred embodiments disclosed in the passage on page 13, lines 1 to 10, were clearly to be read in combination, as could be concluded from the way it had been formulated. The wording of the passage on page 26 to which the appellants referred, had nothing to do with the passage on page 13; it did not add any information to the disclosure of page 13. Moreover, combining the two passages was not allowed since page 26 formed part of the examples, which described specific combinations of compounds and could not be generalized. Only if there was no doubt that features mentioned in combination did not belong together, could they be separated, as in T 68/99 (*supra*), but such was not the case here.
- (b) Auxiliary Request I contravened Article 123(3) EPC as claim 1 now included compositions that had not been included before.

- (c) Also, there was no proper definition of the compound as a whole since not all of the features had been specified.
- (d) Regarding the double definitions for R, only the narrower ones should be taken into account. Article 84 EPC was therefore not complied with.
- (e) Auxiliary Request Ib had been filed late and should not be admitted into the proceedings.
- (f) There had been a reduction in the number of specified potential components of type R which had to be within certain weight limits, and a corresponding increase in the number of potential components of type R whose presence was allowed but did not have to be within certain weight limits. This meant that now compositions not falling under claim 1 as granted, would fall under claim 1 of Auxiliary Request Ib, contrary to the requirements of Article 123(3) EPC.
- (g) Claim 3 as granted had been formulated as dependent on Claim 1. Therefore, in its dependent form, it could and should be read so as to include the contents and restrictions of claim 1 as granted. This was no longer the case with Claim 1 of Auxiliary Request Ib, again indicating that the requirements of Article 123(3) were not met.

IX. The appellants (proprietors) requested that the decision under appeal be set aside and that the case be remitted for further prosecution on the basis of the set of claims as granted as main request, or on the

basis of one of the sets of claims forming Auxiliary Request I filed on 13 February 2009, Ib filed on 2 March 2009, II filed on 13 February 2009, III, IV, V or VI all filed on 19 August 2008 or VII filed on 13 February 2009.

The respondents (opponents) requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. Article 123(2) EPC
 - 2.1 According to established jurisprudence of the boards of appeal, if a claim is to be restricted to a preferred embodiment, it is normally not admissible under Article 123(2) EPC to extract isolated features from a set of features which have originally been disclosed in combination for that embodiment. Such kind of amendment might only be justified in the absence of any clearly recognisable functional or structural relationship among said features (see "Case Law of the Boards of Appeal of the European Patent Office", 5th edition, 2006, Section III-A, 1.1).
 - 2.2 The composition of claim 1 as granted is required to contain from 0.01 to 2.0 wt.% of a compound of the formula as shown. In original claim 1, in that formula R was defined as a substituted or unsubstituted alkyl

or alkenyl group having from 11 to 35 carbon atoms, whereas in claim 1 as granted that definition had been amended to a substituted or unsubstituted alkyl or alkenyl group having from 19 to 35 carbon atoms.

2.3 For the basis of that amendment the appellant referred to original page 13, lines 1 to 6, of the application as originally filed, which reads as follows:

"In a preferred embodiment, the quaternary ammonium compound I has the structure shown hereinabove wherein R is an alkyl group having from about 17 to about 21 carbon atoms, preferably from about 19 carbon atoms to about 21 carbon atoms, and more preferably about 21 carbon atoms, or mixtures thereof; X is an N-R₅ group; R₅ is H and the other structural elements are as hereinabove defined."

That passage describes a preferred embodiment of the formula of claim 1, in which the variables R, X and R₅ are further specified. Since those specifications are only separated by semicolons, there can be no doubt that, on a linguistic basis at least, the further specification of R should be read together with the further specification of the other variables X and R₅, also because there is no indication that all the variables could be read independently. The legal and factual situation is no different from that in T 1067/97 of 4 October 2000, cited by the appellants, in which the amendment was not allowed.

2.4 The disclosure on original page 26, lines 9 to 15, cannot change that view:

"The data indicate the excellent detangling ability of the compositions of the invention. The data also suggest that the compositions of Examples 1 and 2 incorporating the quaternary ammonium compounds behentrimonium methosulfate and behenamidopropyl hydroxyethyl dimonium chloride having the longer C₂₂ groups are more effective at detangling hair than other compositions comprising species having shorter hydrocarbon chains, i.e., stearalkonium chloride or dimethyl dialkyl (C₁₄-C₁₈) ammonium chloride."

In that passage, clear reference is made to the compositions of examples 1 and 2. Any conclusion drawn on that basis can only relate to those very specific compositions. For that reason, the appellant's argument that, based on that passage, it was clear in general that longer chains were favourable over shorter chains and hence the higher number of carbon atoms for R were to be read independent from the other variables in the formula, cannot be followed, as it amounts to an extrapolation having no basis in what is actually said. Thus taking into account both this passage and the passage on page 13 still provides no justification for the amendment made in claim 1 as granted which seeks to pick out a value for the lower limit of R without introducing the other restrictions of the upper limit of R and the meaning of X and R₅ which were associated with this lower limit of R.

- 2.5 Compared to claim 1 as filed, amendments made to arrive at claim 1 as granted concern one compound having various possibilities for the groups present in that

compound, which groups form part of the one entity that is the compound; this is contrary to the situation in T 0201/83 ((OJ 1984, 481), where amounts were taken from the examples but the identity of the ingredients remained the same; T 0068/99 of 12 June 2003, where the associated parts of a laminate structure remained together also after the amendment; and in T 0461/05 (*supra*), where the general as well as the more specific embodiments concerned several physically separable parts.

Therefore, the skilled person could not recognize without any doubt that R₅ was not closely related to the other variables and could be applied directly and unambiguously to the more general context of the original formula, as was also the case on the facts in T 0962/98 of 15 January 2004, also cited by the appellants.

2.6 Finally, the Board notes that the passage on page 13 does not mention the possibility of R being an alkenyl group having from 19 to 35 carbon atoms, which is nevertheless included in claim 1 as granted and for which the passage on page 13 hence does not provide a basis anyway.

2.7 For the reasons above, claim 1 as granted does not comply with the requirements of Article 123(2) EPC.

Auxiliary Request I

3. Claim 1 of Auxiliary Request I contains two definitions for the meaning of R: on the one hand it should be a substituted or unsubstituted alkyl or alkenyl group

having from 11 to 35 carbon atoms, on the other hand it has to be an alkyl group having from 19 to 21 carbon atoms or mixtures thereof.

- 3.1 The appellants explained that the two definitions were to be seen as two distinct features, the first definition defining the amount of carbon atoms for R that could be present in the compound of formula (I), and the second specifying which members of the group to select.

However, if R can only be an alkyl of 19 to 21 carbon atoms according to the second definition, which was obligatory according to the appellant, it is unclear what meaning can be attributed to it still having 11 to 35 carbon atoms or being an alkenyl group, according to the first definition.

Therefore the claim as a whole is unclear and Article 84 is not complied with.

4. For that reason, Auxiliary Request I cannot be allowed.

Auxiliary Request Ib

5. The wording of claim 1 of Auxiliary Request Ib is essentially the result of rewriting granted dependent claim 3 as an independent claim. Although the request as such was filed at a very late stage of the proceedings, the respondents had to expect that the appellants might seek to fall back on other claims as granted. Therefore, the Board is prepared to exercise its discretion in favour of the admission of this Auxiliary Request Ib into the proceedings.

5.1 The definition that "R is an alkyl group having from 19 to 21 carbon atoms or mixtures thereof" for the quaternary ammonium compound A in present claim 1 finds its basis in claim 3 as originally filed, which is identical to claim 3 as granted, and also has a basis in lines 18 to 23 of original page 14.

5.2 Whereas claims 3 as originally filed and as granted refer to the possibility of R standing for a mixture of groups and thus component A containing this mixture also being a mixture, neither claim 1 as filed nor claim 1 as granted referred explicitly to such a mixture. The skilled reader would thus refer to the description to find out whether there is any real discrepancy between claims 1 as filed and granted on the one hand and claims 3 as filed and granted on the other hand as regards such mixtures. Paragraph [0034] in the patent as granted (corresponding to page 12, lines 16 to 21 in the application as originally filed) reads:

"It is well known in the art that long chain functional hydrocarbons are materials that occur in nature as mixtures of varying chain length. Accordingly, in the case of refined materials, R may represent a group having a single chain length. Alternatively, in the case of less refined materials, R may represent a material having a mixture of different chain lengths within the broadest prescribed range."

5.3 This cited passage shows that both claims 1 and 3 as granted were to be interpreted as covering cases where

R represents a material having a mixture of different chain lengths within the broadest prescribed range, and that the claim 1 of this request merely restricts the claim 1 as granted to require the allowed range of R to be the same narrower range already specified in claim 3 as filed and granted.

6. Claim 1 as granted took the form "A composition comprising, based on the weight of the composition: A. from 0.01 percent to 2.0 percent of a first quaternary ammonium compound of the formula [as specified] and B. from 0.01 percent to 2.0 percent of a silicone compound selected [as specified]." Thus the claim left the purpose of the composition and between 96 to 99.98 percent of its components unspecified. Where "comprising" appears in a claim, this is to indicate what must be present and not to indicate what should not be present. The Board regards the normal meaning of the words used for features A. and B. as merely defining components which must be present, without imposing any limitation on what the 96 to 99.98 percent of unspecified components might be, and adopts this as the correct construction of the claim. Therefore, provided something with a single value for the number of carbon atoms of R or with mixed values for the number of carbon atoms of R can be identified as present and satisfying feature A., the presence of further compounds with different R is irrelevant as those could be present in the unspecified part of the composition.

- 6.1 The appellants contended for a different construction of at least feature A., namely that it somehow also imposed an absolute requirement that the sum total of

components meeting the formula of feature A. had to be between 0.01 and 2.0 percent, that is that nothing falling within the formula of feature A. was allowed to be in the unspecified 96 to 99.98 percent of components. The consequence of this construction would be that the amended claim 1 of this request where feature A. referred to R being an alkyl group of 19 to 21 carbon atoms, would be broader in scope than claim 1 as granted insofar as there would no longer be any restriction on for example the quantity of component A. type quaternary ammonium compound with R being an alkyl group of 22 to 35 carbon atoms, being present in the unspecified 96 to 99.98 percent of components. The respondents argued that on the appellants' own view on how to construe feature A., claim 1 of this request was thus broader than claim 1 as granted, and so this request did not comply with Article 123(3) EPC. The appellants sought to avoid this conclusion by arguing that claim 3, neither as filed nor as granted, was properly dependent on claim 1, and that, as claim 1 of this request was no broader than claim 3 as granted, the requirements of Article 123(3) were met.

- 6.2 On the view adopted by this Board as to the proper construction of feature A. claim 3 as granted was properly dependent on claim 1 as granted, and claim 1 of this request merely restricts the scope of protection compared to claim 1 as granted.
7. The Board is thus satisfied that the amendments made in Auxiliary Request Ib satisfy the requirements of Article 123(2) and (3) EPC. Nor has any lack of clarity been introduced by the amendments and cannot, therefore, be the subject of an objection under Article 84 EPC.

7.1 The reasons for revocation of the patent by the opposition division do not apply to the present request. As the substantive issues of novelty and inventive step have not yet been the subject of discussion, the Board, exercising its discretion under Article 114(1) EPC, remits the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted for further prosecution on the basis of the set of claims forming Auxiliary Request Ib filed on 2 March 2009.

Registrar

Chairman

C. Eickhoff

S. Perryman