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**Datasheet for the decision  
of 27 June 2011**

**Case Number:** T 1235/08 - 3.3.07

**Application Number:** 05737923.2

**Publication Number:** 1753394

**IPC:** A61K 8/97

**Language of the proceedings:** EN

**Title of invention:**

Method for preparing a compound for drawing a non-permanent tattoo and a method of using said compound

**Applicants:**

Vedic Hindus-Industria, Comercio, Importacao e Exportacao Ltda

**Opponent:**

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**Headword:**

-

**Relevant legal provisions:**

EPC Art. 56

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Inventive step (no)"

**Decisions cited:**

-

**Catchword:**

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Case Number: T 1235/08 - 3.3.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.07  
of 27 June 2011

**Appellants:** Vedic Hindus-Industria, Comercio, Importacao e  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 7 February 2008  
refusing European patent application  
No. 05737923.2 pursuant to Article 97(2) EPC.

**Composition of the Board:**

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

## Summary of Facts and Submissions

I. The appeal lies from the decision of the Examining Division refusing European patent application No. 05 737 923.2, filed as international application No. PCT/BR2005/000070 on 4 May 2005. The decision was based on claims 1 to 24 as originally filed, independent claim 1 reading as follows:

"1. A method for preparing a compound for designing a non-permanent tattoo, said method comprising the steps of:  
providing a certain amount of a juice extracted from the fruit of the *Genipa Americana* plant ("genipapo");  
adding a thickener to said juice, said thickener being added in an amount sufficient to form a substantially creamy mixture;  
adding extracts from the seeds of grapefruit (*Citrus decumana*), rosemary, olive leaves, E vitamin, citric acid, ascorbic acid, and vegetable dyes to the said creamy mixture, said extracts acting as both preserving and antioxidant agents; adding color-increasing components to said creamy mixture to increase the intensity of the compound; e (sic)  
saving the creamy compound in a sealed package for posterior use."

II. According to the impugned decision, the present application acknowledged that the use of the juice of the fruit of *Genipa americana* for providing non-permanent tattoos was known in the art. This use was also described in D1 (Julia F. Morton, "Fruits of warm

climates", Genipap, 1987, Miami, pages 441-443), D2 (Article by Mell C. D., "Interesting dyestuff plants", Textile Colorist, pages 107-11) also disclosing the use of the fruit of *Genipa americana* for tattoos. The subject-matter of independent claim 1 differed from the above prior art in that various ingredients, namely (a) a thickener, (b) extracts and other compounds acting as preservatives and antioxidants, (c) vegetable dyes and (d) colour-increasing components were added to the juice of the fruit of *Genipa americana* and the obtained composition was stored in a sealed package. The problem to be solved by the claimed method was the provision of compositions showing improved stability as well as improved handling and application properties.

Components (a) to (d) were well-known to the skilled person and conventionally used in the art of cosmetic formulation, as evidenced in particular by prior art documents FR-A-2 815 906 (D3), US-A-5 836 998 (D4), DE 198 39 241 C1 (D5), DE 203 14 464 U1 (D6), US-B1-6 190 681 (D7) and US-A-5 928 797 (D8). Moreover, storage in a sealed package was a conventional storage method. The features distinguishing the claimed methods from the known use of the juice of the fruit of *Genipa americana* for providing non-permanent tattoos had not been shown to have any specific surprising technical effect going beyond their known functions. They were well-known in the art and therefore obvious to the skilled person. There was furthermore no prejudice in the art against combining these conventional measures with the known use of the juice of the fruit of *Genipa americana*. The dependent claims were held to be directed to routine modifications and to not contain any additional feature which, in combination with the features of any claim to which they referred, would

meet the requirements of the EPC with respect to inventive step. Hence, the subject-matter of claim 1 and of its dependent claims was held to lack an inventive step within the meaning of Article 56 EPC.

- III. With their statement setting out the grounds of appeal dated 9 June 2008, the Applicants (hereinafter the Appellants) did not provide amended claims, but solely submitted arguments on the patentability of the invention underlying the present application. It was requested "*that the appealed decision be cancelled and the present patent application granted*".
- IV. The Appellants were summoned to attend oral proceedings and a communication dated 28 April 2011 containing *inter alia* the Board's reasoned preliminary negative opinion on inventive step of the subject-matter of claim 1 as originally filed was given.
- V. In reply to the Board's communication, the Appellants informed the Board with letter dated 4 May 2011 that they would not attend oral proceedings. They also requested that a decision based on the written statement of grounds of appeal filed on 9 June 2008 be issued. Confirmation of the Appellants' non-attendance to oral proceedings was received with a further letter dated 30 May 2011.
- VI. The arguments of the Appellants can be summarised as follows:
- (a) The present invention referred to a method for preparing a compound for designing a non-permanent tattoo using the natural dye from the

*Genipa americana* for topic application upon the skin. It comprised the steps of extracting juice from the *Genipa americana*, adding a thickener in an amount sufficient to form a substantially creamy mixture, adding a series of extracts from different plant varieties and colour-increasing components to the mixture, and storing it in a sealed package to preserve it. Neither document D1, nor document D2 referred to a method comprising said steps, as those documents merely referred to the use of the *Genipa americana* as a dye, which had been known for centuries as indicated in the description of the present application. Therefore, contrary to the Examiner's opinion, D1 and D2 did not anticipate the present invention.

- (b) The other references cited in the international search report were of no particular relevance and only contained a general description of the state of the art.

VII. The Appellants' request "*that the appealed decision be cancelled and the present patent application granted*" is in the absence of amended claims to be understood as to set the decision under appeal aside and to grant a patent on the basis of the claims as originally filed.

## Reasons for the Decision

1. The appeal is admissible.

### *Novelty*

2. The novelty of the claimed process was not objected to by the Examining Division. The Board on its own sees no reason to take a different view as in particular none of the documents cited in the proceedings relates to compositions based on the juice of the fruit of the *Genipa americana* plant in combination with the various preserving and antioxidant agents listed in claim 1.

### *Inventive step*

### *Closest prior art*

3. According to the passage from page 1, line 15 to page 2, line 7 of the present application, and as illustrated by D1, it was state of the art to use the juice of the fruit of *Genipa americana* in order to prepare a composition for non-permanent tattoos. Coal could be added to form a paste and the dye compositions were typically applied with the fingers or a stick. The Board, in line with the Examining Division is satisfied that the state of the art described from page 1, line 15 to page 2, line 7 of the application as filed represents the closest state of the art and therefore the starting point for analysing inventive step.

*Problem and solution*

4. According to the present application (passage from page 2, line 8 to page 3, line 28), it is an object of the present invention to provide a method for the preparation of a composition for a non-permanent tattoo which can be used in the cosmetics industry and which avoids the drawbacks associated with the state of the art, namely lack of stability of the dye composition, tendency of the known dye compositions to trickle or smear, variation in intensity of the coloration obtained on the skin, difficulty to obtain a detailed design and dependency of the availability of the unripe fruit of the *Genipa americana*.
  
5. In view of the function of the different compounds or steps defined in present claim 1, the Board is satisfied that the problem stated in the application as filed has been successfully solved by the claimed method comprising the measures of:
  - (a) adding a thickener in an amount sufficient to form a substantially creamy mixture;
  - (b) adding extracts from the seeds of grapefruit (*Citrus decumana*), rosemary, olive leaves, E vitamin, citric acid, ascorbic acid, and vegetable dyes to the said creamy mixture, said extracts acting as both preserving and antioxidant agents;
  - (c) adding colour-increasing components to said creamy mixture to increase the intensity of the compound; and
  - (d) saving the creamy compound in a sealed package for posterior use.



*Obviousness*

6. It remains to be decided whether or not the skilled person starting from the closest prior art and wishing to solve the above defined problem would have been guided by the state of the art to apply measures (a) to (d).

6.1 In the absence of any argument by the Appellants, that any functional link or technical interaction existed between the above groups of measures (a) to (d), the Board can only regard those as forming an aggregation of features, each of them solving a separate independent partial problem. In accordance with the established case law of the boards of appeal, in such a case it must be examined whether each of features (a) to (d), taken singly, was obviously derivable from the prior art when starting from the closest prior art (see Case Law of the Boards of Appeal of the European Patent Office, 6<sup>th</sup> edition, 2010, I.D.8.2.2).

6.2 With a view to overcome the tendency of the known dye compositions to trickle or smear and to reduce the difficulty to obtain a detailed design, it was obvious for a skilled person to adjust the viscosity of the composition by employing a thickener in an appropriate amount. The addition of a mixture of extracts of the seeds of grapefruit, rosemary, olive leave, E vitamin, citric acid and ascorbic acid in order to provide stability to the dye composition was also obvious for the skilled person as each of those compounds was known in the art as preserving and/or antioxidant agent, the latter being not disputed by the Appellants. Furthermore, the obviousness of using vegetable dyes

and a colour-increasing compound to vary the colour and increase the colouring intensity of the dye composition resulted for the skilled person from the known function of those additives. Finally, the use of a sealed package for posterior use, that also allows to preserve the quality of the dye composition and allows its use independently from the availability of the unripe fruit of the *Genipa americana* was also for the skilled person a trivial measure.

- 6.3 Since each of the partial problems underlying the present invention is solved by means which merely performed their known function, and the Appellants failed to provide a single argument, as to why it would not be obvious for the skilled person to employ the measures claimed for achieving their known function, the Board can only conclude that each of the partial solutions (a), (b), (c) and (d) as defined in present claim 1, and their combined use, was, having regard to the state of the art, obvious to the skilled person.
7. Therefore, the subject-matter of present claim 1 lacks an inventive step within the meaning of Article 56 EPC. Claim 1 is thus not allowable and the application must be refused as a whole.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar

The Chairman

S. Fabiani

J. Riolo