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**Datasheet for the decision  
of 5 June 2012**

**Case Number:** T 0588/09 - 3.3.07

**Application Number:** 03720518.4

**Publication Number:** 1505949

**IPC:** A61Q 5/00, A61Q 5/02,  
A61Q 5/12, A61K 8/90,  
A61K 8/89, A61K 8/898,  
A61K 8/892, A61K 8/894

**Language of the proceedings:** EN

**Title of invention:**  
Conditioning Shampoo Composition

**Patent Proprietors:**  
Unilever PLC  
Unilever N.V.

**Opponent:**  
Kao Germany GmbH

**Headword:**  
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**Relevant legal provisions:**  
EPC R. 115(2)  
RPBA Art. 13(3), 15(3)

**Keyword:**  
"Request to continue in writing (refused)"  
"Admissibility of new requests (no)"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0588/09 - 3.3.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.07  
of 5 June 2012

**Appellants:**  
(Patent Proprietors)

Unilever PLC  
Unilever House  
Blackfriars  
London  
Greater London EC4P 4BQ (GB)

Unilever N.V.  
Weena 455  
NL-3013 AL Rotterdam (NL)

**Representative:**

Newbould, Frazer Anthony  
Unilever PLC  
Unilever Patent Group  
Colworth House  
Sharnbrook  
Bedford  
Bedfordshire MK44 1LQ (GB)

**Respondent:**  
(Opponent)

Kao Germany GmbH  
Pfungstädter Strasse 92-100  
D-64297 Darmstadt (DE)

**Decision under appeal:** Decision of the Opposition Division of the European Patent Office posted 9 January 2009 revoking European patent No. 1505949 pursuant to Article 101(3)(b) EPC.

**Composition of the Board:**

**Chairman:** J. Riolo  
**Members:** D. Semino  
M.-B. Tardo-Dino

## Summary of Facts and Submissions

I. The appeal of the patent proprietors (appellants) lies against the decision of the opposition division announced at the oral proceedings on 17 December 2008 to revoke European Patent 1 505 949. The granted patent comprised 16 claims, claim 1 reading as follows:

"1. A rinse-off aqueous hair conditioning composition comprising;

- a) from 1% to 50% by weight of a cleansing surfactant,
- b) discrete, dispersed droplets comprising a water-insoluble silicone conditioning oil characterised in that the mean diameter of the droplets ( $D_{3,2}$ ) is from 2 to 100 micrometres and
- c) a surface active block copolymer with a mean molecular weight of 7000 unified atomic mass units or more comprising polyethyleneoxide blocks and polypropyleneoxide blocks, wherein each block consists of 2 or more ethylene oxide or propylene oxide monomer units and wherein the mean number propylene oxide monomer units in the block copolymer is 25 or more."

II. A notice of opposition was filed against the granted patent requesting revocation of the patent in its entirety on the grounds of lack of novelty and lack of inventive step, in accordance with Article 100(a) EPC.

III. The decision of the opposition division was based on a main request filed with letter of 31 March 2008. Claim 1 according to the main request corresponded to granted claim 1 with the addition that the quantity of surface active block copolymer was "from 0.01% to 0.4% by weight".

IV. According to the decision under appeal Article 100(a) EPC prejudiced the maintenance of the patent, since the composition according to claim 1 of the main request was novel with respect to D1 (US-A-5 733 536), due to the limitation of the amount of block copolymer present in the composition, but was not inventive with respect to the same document, taken as the closest prior art. In the absence of a comparative test between compositions according to D1 and according to the patent, it was not credible that the problem of providing a hair conditioning composition showing an improved deposition of silicone conditioning oil onto the tip region of the hair had been solved over the whole range of compositions according to claim 1 of the main request, so that the objective problem was the provision of an alternative hair conditioning composition. The skilled person faced with that problem would vary the concentrations of the ingredients of the composition and would thus come to the claimed composition without any inventive skill.

V. The patent proprietors (appellants) appealed that decision. With the statement setting out the grounds of appeal they submitted a declaration of one of the inventors including a test aimed at reproducing one example of D1 and gave arguments why the request on which the decision was based was inventive. With that statement they requested oral proceedings as an auxiliary measure, but did not file any further claim request.

According to the appellants, the opposition division was wrong in concluding that the products according to

D1 were effective and that the only meaningful objective technical problem was to provide an alternative product, since D1 disclosed various hair care products in which the lowest level of block copolymer was 1.04% by weight, the declaration showed that a composition according to D1 did not deposit silicone and the data provided in the patent fully supported the assertion that embodiments within the claims provided improved deposition of conditioning active onto the tips. The objective technical problem was therefore the provision of a composition which was effective in conditioning the hair tips. Starting from D1 and faced with that objective technical problem, the skilled person would not reduce the level of a material that he intended to deposit, since there was no reference whatsoever in D1 to tip conditioning and the reduction of content was counterintuitive and indicative of the surprising nature of the invention.

VI. In the reply to the statement setting out the grounds of appeal the opponent (respondent) maintained the objection of lack of inventive step. Oral proceedings were requested in case the request of the respondent was not allowed.

The respondent submitted that the opposition division had correctly formulated the objective problem as the provision of an alternative composition over D1, since D1 disclosed beyond any doubt rinse off compositions comprising silicone component and surface active block copolymer which conditioned hair and enhanced deposition. The declaration submitted in appeal was not relevant, as it did not show comparatively any additional effect, in particular it did not show if

there was any deposition onto hair in case the concentration of surface active block copolymer was reduced. Therefore, the reasoning in the appealed decision held.

VII. With letter of 16 February 2012 the Board sent a communication in preparation to oral proceedings, to which both parties had been summoned with letter of 17 November 2011.

In that communication the Board addressed the issue of inventive step and stated *inter alia* that there was apparently agreement between the parties that the composition of claim 1 of the main request differed from the compositions disclosed in D1 in the range for the quantity of block copolymer, that the critical issue appeared to be the definition of the problem solved with respect to the closest prior art and that no tests were present to show that the choice of the range for the quantity of block copolymer was not an arbitrary one, so that the solved problem could be simply reformulated as the provision of a further rinse-off hair conditioning composition. In conclusion, the Board expressed the preliminary opinion that, once the problem had been reformulated in that way, the presence of an inventive step could not be acknowledged.

In addition the Board drew the attention of the parties to Article 13(1) and (3) of the Rules of Procedure of the Boards of Appeal (RPBA), in case they intended to file any amendment to their case, and informed them that the admissibility of any such amendment would have to be considered at the oral proceedings.

VIII. With letter of 14 May 2012 the respondent informed the Board that it would not attend the oral proceedings.

IX. With letter of 21 May 2012 the appellants filed two sets of claims with corresponding amended descriptions as main and auxiliary requests.

Claim 1 according to the main request contained with respect to claim 1 of the set on which the decision was based the additional feature that the composition was "obtainable by i) preparing a solution comprising water and the surface active block copolymer, ii) adding a silicone conditioning oil to the solution, iii) forming the solution and the silicone conditioning oil into an oil-in-water emulsion by high-shear mixing, iv) dispersing the oil-in-water emulsion comprising the block copolymer into a hair conditioning composition".

The auxiliary request comprised only method claims wherein claim 1 was formulated as a method for preparing a composition according to claim 1 of the set on which the decision was based and the method comprised the steps i) - iv) listed in the additional feature of claim 1 according to the main request.

The appellants did not provide any reason for the late filing of those requests, based their arguments on novelty and inventive step on the added process features and declared that the filing of the new requests was an earnest attempt to provide a set of claims which was novel and inventive and to avoid oral proceedings.

- X. The appellants communicated that they would not attend the oral proceedings with letter of 1 June 2012.
- XI. Oral proceedings were held on 5 June 2012 in the announced absence of the appellants and of the respondent.
- XII. The appellants (patent proprietors) had requested in writing that the decision under appeal be set aside and the patent be maintained on the basis of the set of claims of the main or, alternatively, the auxiliary request as submitted with the letter received on 21 May 2012, with the corresponding modified descriptions. They had also requested that the appeal proceedings be continued in writing.
- XIII. The respondent (opponent) had requested in writing that the appeal be dismissed.

### **Reasons for the Decision**

- 1. The appeal is admissible.
- 2. *Request to continue the proceedings in writing*
  - 2.1 Rule 115(2) EPC and Article 15(3) RPBA provide respectively that, if a party duly summoned to oral proceedings before the European Patent Office does not appear, the proceedings may continue without that party and that the Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of



any party duly summoned who then may be treated as relying only on its written case.

- 2.2 In the present case the appellants and the respondent had been duly summoned to oral proceedings, which both of them had requested in their statement setting out the grounds of appeal and in the reply thereto respectively.
- 2.3 The respondent informed the Board three weeks before the scheduled date that it would not attend the oral proceedings. The appellants communicated that they would not attend the oral proceedings four days before the fixed date and accompanied that communication with the request to continue the proceedings in writing on the basis of two requests which had been filed ten days before. No reasons were given for justifying the late filing of the requests and the absence at the oral proceedings. It was only invoked, when filing the new requests, that that filing was an earnest attempt to provide a set of claims which was novel and inventive and to avoid oral proceedings.
- 2.4 The procedural strategy of the appellants to file new requests shortly prior to the oral proceedings and then decide not to appear at the oral proceedings asking for a continuation in writing cannot result in forcing the Board to follow the procedural steps imposed by the appellants against the legal provisions cited above (point 2.1) and commonly applied by the Boards of Appeal. This is all the more the case, since there is no justification for the behaviour of the appellants, as the legal and factual framework of the opposition did not change since the issuing of the decision of the

opposition division (see points 3.2 - 3.4 and 3.7, below) and there was no apparent impediment for them to come to the oral proceedings.

2.5 It results therefrom, bearing in mind that there had been no changes in the legal and factual framework of the case which might justify the filing of new claims, that there was no reason to cancel the oral proceedings requested by both parties and continue the proceedings in writing. Such a course of action under the present circumstances and in view of Rule 115(2) EPC and Article 15(3) RPBA (point 2.1, above) would go against the principle of procedural economy.

2.6 The Board therefore refuses the request to continue the proceedings in writing and decides on the basis of the written submissions.

3. *Main and auxiliary requests - admissibility*

3.1 According to Article 12(2) RPBA the statement of grounds of appeal and the reply thereto shall contain a party's complete case. Article 13 RPBA specifies that any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted at the Board's discretion (Article 13(1) RPBA) and, in particular, that amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings (Article 13(4) RPBA).

- 3.2 The patent was revoked on the basis of lack of inventive step of claim 1 of a single request filed by the appellants. The central points of the decision were that it was not credible that the problem posed in the patent could be solved by the choice of a specific concentration range of the block copolymer present in the composition and that a variation of the same was obvious when looking for alternative compositions (see point IV, above).
- 3.3 All the arguments of the parties in the statement of grounds and in the reply thereto were concentrated on those issues, with the appellants arguing that the choice of concentrations of block copolymer within the range provided an effect (see point V, above) and the respondent confirming the reasoning of the appealed decision (see point VI, above). No other claim request was filed by the appellants at that stage.
- 3.4 The same issues were summarised by the Board in its communication sent in preparation of the oral proceedings almost four months before the fixed date, where the preliminary opinion of the Board was expressed, which was in agreement with the appealed decision (point VII, above).
- 3.5 Only two weeks before the scheduled oral proceedings the appellants filed two new sets of claims (see point IX, above), wherein claim 1 according to the main request contained with respect to claim 1 of the request on which the decision was based the specification of the method of preparation of the claimed composition and the auxiliary request contained only claimed directed to method of preparation of a

hair conditioning composition. No reasons for the late filing of the requests were given.

- 3.6 The Board has to decide in the first place on the admissibility of the newly filed requests on the basis of the Rules of Procedure of the Boards of Appeal. The parties had been informed in the communication that that would be the case for any amendment of the case (see point VII, above) and that Article 13(1) and (3) RPBA would be applied.
- 3.7 The facts of the case show clearly that the legal and factual framework of the opposition had not changed as a result of the reply of the respondent or of the communication of the Board, which basically confirmed the reasoning in the appealed decision and did not introduce any new fact, evidence or argument. The late filing of the requests can therefore not be seen as a legitimate reaction to any new situation.
- 3.8 Both requests shift the core of the discussion to issues related to the method of preparation of the composition which have never been discussed by the parties during opposition and appeal proceedings. They raise issues, including the analysis of the effects on the product of the introduced product-by-process features, the evaluation of possible advantages related to the method of preparation of the composition, the analysis of the available examples in view of the new formulation of the claim (it is not immediately apparent from the wording in the patent whether the examples therein were made according to the method of preparation now introduced in the claim, see paragraph [0099] in the patent), the need of an appropriate

comparison with D1 in which only the distinguishing features are varied, which have never been debated before and could not be dealt with by the Board and by the respondent without adjournment of the oral proceedings. In this respect it is not relevant that the respondent did not appear at the oral proceedings, since a period of two weeks would in any case be too short to expect the party to be able to deal reasonably with the new issues.

3.9 The Board comes therefore to the conclusion that the main and auxiliary requests filed with the letter received on 21 May 2012 are not admissible on the basis of Article 13(3) RPBA.

4. Since the main and auxiliary requests filed with the letter received on 21 May 2012 are the only claim requests on file and they are not admitted into the proceedings, there is no other point for the Board to decide and the appeal is to be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar

The Chairman

S. Fabiani

J. Riolo