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**Datasheet for the decision
of 26 March 2012**

Case Number: T 1095/09 - 3.3.07

Application Number: 00923326.3

Publication Number: 1189573

IPC: A61K 7/00

Language of the proceedings: EN

Title of invention:

Cosmetic resin composition and cosmetic using the same

Applicants:

Akzo Nobel N.V.

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 84, 111(1)

Keyword:

"Amendments allowable - no added subject-matter"

"Clarity and support (yes)"

"Remittal for outstanding issues"

Decisions cited:

T 0472/88, T 0522/91

Catchword:

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Case Number: T 1095/09 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 26 March 2012

Appellants: Akzo Nobel N.V.
(Applicants) Velperweg 76
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Representative: Schalkwijk, Pieter Cornelis
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 22 December 2008
refusing European patent application
No. 00923326.3 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: J. Riolo
Members: F. Rousseau
D. T. Keeling

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Examining Division posted on 22 December 2008 refusing European patent application No. 00923326.3, filed as international application No. PCT/US00/09956 on 13 April 2000 and published as WO 02/05621.
- II. The decision was based on a sole set of claims, claim 1 of which had been submitted with letter of 03 November 2008 and an adapted description, including page 17 filed with letter of 15 January 2006. Claim 1 read as follows:
- "1. A cosmetic resin composition consisting essentially of an amphoteric urethane resin having a carboxyl group and a tertiary amino group in one molecule thereof, the amphoteric urethane resin having a structural unit derived from an ethylene oxide in its structure selected from polyoxyethylene glycol having OH or NH₂ at one or both terminal ends, and block copolymers of polyoxyethylene and polyoxypropylene glycol, wherein the amphoteric urethane resin is obtainable by reacting the following components (A) to (D) in excess of isocyanate groups so as to produce a prepolymer containing isocyanate groups and reacting the prepolymer with the following components (sic)(E)
- (A) a polyester polyol compound
(B) a polyisocyanate compound

(C) a polyoxyethylene glycol having OH or NH₂ at one or both terminal ends or a block copolymer of polyoxyethylene and polyoxypropylene glycol

(D) a compound having an active hydrogen and a carboxyl group

(E) a compound having an active hydrogen and a tertiary amino group or wherein the amphoteric urethane resin is obtainable by reacting the following components (A), (B), (C) and (E) in excess of isocyanate groups so as to produce a prepolymer containing isocyanate groups and reacting the prepolymer with the following component (D)

(A) a polyester polyol compound

(B) a polyisocyanate compound

(C) a polyoxyethylene glycol having OH or NH₂ at one or both terminal ends or a block copolymer of polyoxyethylene and polyoxypropylene glycol

(D) a compound having an active hydrogen and a carboxyl group

(E) a compound having an active hydrogen and a tertiary amino group."

III. The decision to refuse the application was pronounced at the oral proceedings held on 03 December 2008 in the absence of the Applicants. The ground of the refusal was that claim 1 and page 17 did not comply with the requirements of Article 123(2) EPC. According to the written decision:

(a) Component (C) was defined in claim 3 and on page 4, lines 26-26 of the application as filed as "a polyethylene oxide derivative having an active hydrogen". According to the description such

derivatives having an active hydrogen were compounds with -OH or -NH₂ end groups. It was furthermore stated on page 9, lines 5-8 of the application as filed, that component (C) "may be either of a type having OH groups at both terminals, a type having NH₂ groups at both terminals, a type having an OH group at one terminal and a type having an NH₂ at one terminal". Thus, the limitation "having OH or NH₂ at one or both terminal ends" also applied to the copolymers of polyoxyethylene and polyoxypropylene glycol. It was therefore concluded that the selection of component (C) among "block copolymer(s) of polyoxyethylene and polyoxypropylene glycol" without further limitation represented an extension of the claim beyond the content of the application as filed.

- (b) Moreover, the expression "block copolymers" had no basis in the application as filed, as the expression "EPO blocked copolymer" on page 9, lines 3-4 did not unambiguously refer to a block copolymer.
- (c) Furthermore, amended page 17 did not comply with the requirements of Article 123(2) EPC, as an amendment based on the priority document was not permissible.
- (d) The decision also contained additional side remarks according to which the technical problem formulated in the application page 2, lines 5-10 and from page 34, line 12 to page 35, line 17 could not be regarded as solved over the whole

breadth of claim 1, as claim 1 did not define the number of ethylene oxide repeating units specified on page 8, lines 13-20 of the description, which was an essential feature of the claimed resin composition. It was therefore indicated that even if the requirements of Article 123(2) EPC were met, an *"inventive step could not be acknowledged since the technical problem"* was *"not solved over the whole claimed range"*. It was however specified that lack of inventive step was not the ground for the refusal. Moreover, the expression "consisting essentially" in claim 1 was held to be unclear, rendering the scope of the claim undefined.

IV. With the statement setting out the grounds of appeal dated 30 April 2009, the applicants (hereinafter referred to as the appellants) submitted three sets of claims as their Main, First and Second Auxiliary Requests. The Appellants indicated that they had overcome the ground for refusal by deleting the wording *"or a block copolymer of polyoxyethylene and polyoxypropylene glycol"* under the definition of compound (C) in claim 1. Claim 1 was said to be novel over D1, in particular over polyurethane B of that disclosure, as shown by the calculations provided in the statement setting out the grounds of appeal, which in their opinion showed that polyurethane B did not exhibit a molar ratio of isocyanate groups to active hydrogens above 1. Arguments in favour of an inventive step over D1 (US-A-5 626 840) and D2 (WO-A-99/39688) were also provided.

V. A Board's communication dated 28 December 2011 was sent in preparation to oral proceedings to be held on

29 March 2012 in which it was pointed out inter alia that the definition of compound (C) being selected from a polyoxyethylene glycol having -NH_2 end groups, as requested by the examining division, not only lacked clarity, but also had no basis in the application as filed. As indicated on page 9, lines 5-9, -NH_2 end groups were only defined in the general context of polyethylene oxide derivatives, but not in relation to specific derivatives selected from polyoxyethylene glycol (PEG) and polyoxyethylene polyoxypropylene glycol (EOPO block copolymer), which per definition had only -OH end groups. The Board also took the view that the amendment of the wording "EOPO blocked copolymer" into "EOPO block copolymer" represented a mere correction under Rule 139 EPC.

VI. Following two telephone interviews in which editorial amendments of claim 1, submitted with letter of 17 February 2012 in reply to the Board's communication, were discussed, the Appellants filed with letter of 15 March 2012 a new Main Request. They also withdrew with their letter of 15 March 2012 page 17 as previously amended, reverting to page 17 as originally filed. The two claims according to the present Main Request as submitted with letter of 15 March 2012 read as follows:

"1. A cosmetic resin composition consisting essentially of an amphoteric urethane resin having a carboxyl group and a tertiary amino group in one molecule thereof, the amphoteric urethane resin having a structural unit derived from an ethylene oxide in its structure selected from the group consisting of polyoxyethylene glycol and

polyoxyethylene polyoxypropylene glycol (EOPO block copolymer),
wherein the amphoteric urethane resin is obtainable by reacting the following components (A) to (D) in excess of isocyanate groups so as to produce a prepolymer containing isocyanate groups and reacting the prepolymer with the following component (E):

- (A) a polyol compound;
- (B) a polyisocyanate compound;
- (C) a compound selected from the group consisting of polyoxyethylene glycol and polyoxyethylene polyoxypropylene glycol (EOPO block copolymer);
- (D) a compound having an active hydrogen and a carboxyl group;
- (E) a compound having an active hydrogen and a tertiary amino group;

or

wherein the amphoteric urethane resin is obtainable by reacting the following components (A), (B), (C) and (E) in excess of isocyanate groups so as to produce a prepolymer containing isocyanate groups and reacting the prepolymer with the following component (D);

- (A) a polyol compound;
- (B) a polyisocyanate compound;
- (C) a compound selected from the group consisting of polyoxyethylene glycol and polyoxyethylene polyoxypropylene glycol (EOPO block copolymer);
- (D) a compound having an active hydrogen and a carboxyl group;

(E) a compound having an active hydrogen and a tertiary amino group.

2. The use of a cosmetic resin composition according to claim 1 in a hair fixative."

VII. The appellants argued that claim 1 of the Main Request corresponded to a combination of claims 1, 3 and 4 as originally filed, with polyethylene oxide derivative (component (C)) being limited to compounds selected from the group consisting of polyoxyethylene glycol and polyoxyethylene polyoxypropylene glycol (EOPO block copolymer). Support for this selection of component (C) was to be found on page 9, lines 1 to 4. Claim 2 of the Main Request corresponded to original claim 2 redrafted into a claim of the use category. Moreover, the objection for lack of clarity raised by the Board had been overcome as the claims did not define any more the use of $-NH_2$ end groups.

VIII. The Appellants requested that the decision under appeal be set aside and the case be remitted to the examining division for assessment of novelty and inventive step on the basis of claims 1 and 2 of the Main Request submitted with letter of 15 March 2012.

Reasons for the Decision

1. The appeal is admissible.

Main Request

Amended claims

2. Claim 1 as amended is based on a combination of claims 1, 3 and 4 as filed, wherein the polyethylene oxide derivative having an active hydrogen has been restricted to a compound selected from the group consisting of polyoxyethylene glycol and polyoxyethylene polyoxypropylene glycol (EOPO block copolymer). This limitation is disclosed in the first paragraph of page 9 of the application as filed stating "*Examples of the polyethylene oxide derivative component (C) include polyoxyethylene glycol (PEG) and polyoxyethylene polyoxypropylene glycol (EOPO blocked copolymer), among which polyoxyethylene glycol is preferred*". In the context of the present technical field and of this specific passage the wording "EOPO blocked copolymer" cannot be meant to read as such for the skilled person. The expression in brackets "(EOPO blocked copolymer)" immediately following the expression "*polyoxyethylene polyoxypropylene glycol*" clearly refers to the latter wording, which describes a copolymer of ethylene oxide and propylene oxide having -OH end groups. It is also immediately clear to the skilled person that the EOPO copolymer cannot be meant to be blocked, as it is employed as a reacting compound for the synthesis of the claimed polyurethane resins. The skilled reader of the application as filed would also notice that the same mistake has been made on page 6, line 21 and page 7, line 4 in the expression "*either a blocked copolymer or a random copolymer in case of a copolymer*". There is no doubt that the wording "*blocked copolymer*" is meant in this context to

define by opposition to the second expression "random copolymer", which is juxtaposed to it, an alternative to a random copolymer also defining the arrangement of the different monomers in the polymeric chain, namely a "block copolymer". Hence, amending the wording "EOPO blocked copolymer" in "EOPO block copolymer" represents a mere correction allowable under Rule 139 EPC.

3. The use of a cosmetic resin composition according to claim 1 as a hair fixative is disclosed in claim 2 as originally filed.
4. The Board is therefore satisfied that the claims according to the Main Request meet the requirements of Article 123(2) EPC.
5. The objection that page 17 as amended did not meet the requirements of Article 123(2) EPC has been overcome by reverting to the original wording of that page.

Clarity

6. The objection raised in the Board's communication that the definition of compound (C) being a polyoxyethylene glycol having -NH₂ end groups lacked clarity has been overcome by restricting the choice of compound (C) to polyoxyethylene glycol or polyoxyethylene polyoxypropylene glycol (EOPO blockcopolymer). Furthermore, the expression "consisting essentially" in claim 1 does not render the scope of the claim undefined as held by the examining division in a side remark of the contested decision. The wording "consisting essentially of" is according to the established jurisprudence of the boards of appeal of

the EPO to be interpreted as a requirement that the claimed composition does not contain additional components not specified in the claim which would affect the essential characteristics of the claimed composition (see for example T 0472/88, unpublished in OJ EPO, point 3 of the reasons, which was endorsed in particular in decision T 0522/91, also unpublished). Moreover, the additional point by the examining division that claim 1 does not define the number of ethylene oxide repeating units to be within the range of 3 to 300 as specified on page 8, lines 13-20 of the description, is an issue that might require consideration when formulating the technical problem solved over the closest prior art. However, this passage states that the number of ethylene oxide repeating units is preferably within that range. It does not, however, describe that range to be mandatory and does not allow alone the conclusion that a number of ethylene oxide repeating units of 3 to 300 is an essential feature of the claimed subject-matter. Hence, present claims 1 and 2 are considered to meet the requirements of Article 84 EPC.

Remittal

7. Having so decided on the allowability of the amended claims under Article 123 (2) EPC and Article 84 EPC, the Board has not, however, taken a decision on the whole matter, since the essential issues of novelty and inventive step remain to be examined.
8. While Article 111(1) EPC does not guarantee an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party

should where possible be given the opportunity to have two readings of the important elements of the case. As indicated in decision G 10/93 (OJ EPO 1995, 172, points 4 and 5 of the reasons), the essential function of an appeal is to consider whether the decision issued by the first-instance department is correct. The power to include new grounds in ex parte proceedings does not mean that the board of appeal carries out a full examination of the application as to patentability requirements, which is the task of the examining division. Hence, a case is normally referred back if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance, so that the Appellants have the opportunity for these essential questions to be considered without loss of an instance. The cursory considerations of the examining division on inventive step given under "Further remarks", that the claimed subject-matter lacked inventive step merely by declaring that the problem formulated in the description had not been solved over the entire breadth of claim 1, without defining the closest prior art, reformulating the problem and without assessing obviousness of the claimed solution to that reformulated problem in the light of the cited prior art, does not represent a reasoning on the basis of which the Board could consider the issue of inventive step. A remittal would also give the Appellants the opportunity to address their arguments for novelty over D1, submitted for the first time with the grounds of appeal. Finally, and for the avoidance of doubt, the Board, in view of the outstanding issues, did not consider necessary to adapt at this stage of the

proceedings page 17 of the description to the presently claimed subject-matter.

9. Under these circumstances the Board considers it appropriate to exercise the power conferred on it by Article 111(1) EPC to remit the case to the Examining Division for further prosecution on the basis of the claims according to the Main Request.

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 on the basis of claims 1 and 2 of the Main Request submitted with letter dated 15 March 2012.

The Registrar

The Chairman

S. Fabiani

J. Riolo