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Datasheet for the decision of 5 October 2011

Case Number: T 1719/09 - 3.3.06

Application Number: 00960513.0

Publication Number: 1210402

IPC: C11D 1/94, C11D 1/90, C11D 3/37, A61K 8/04, A61K 8/46, A61K 8/73, A61K 8/44

Language of the proceedings: EN

Title of invention:
Suspending clear cleansing formulation

Patentee:
Unilever PLC
Unilever N.V.

Opponent:
Henkel AG & Co. KGaA

Headword:
Transparent cleaning composition/UNILEVER

Relevant legal provisions:
EPC Art. 54(1)(2), 56, 83

Relevant legal provisions (EPC 1973):
-

Keyword:
"Admissibility of document filed with the grounds of appeal (yes)"
"Sufficiency of disclosure (yes) - Appellant's allegation not supported by evidence"
"Novelty (yes) - Appellant's allegation not supported by evidence"
"Inventive step (yes)"

Decisions cited:
-

Catchword:
-

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Case Number: T 1719/09 **-** 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 5 October 2011

Appellant: (Opponent)
Henkel AG & Co. KGaA
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Respondents: (Patent Proprietor 1)
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Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 3 August 2009 rejecting the opposition filed against European patent No. 1210402 pursuant to Article 101(2) EPC.

Composition of the Board:

Chairman: P.-P. Bracke
Members: L. Li Voti
J. Geschwind

Summary of Facts and Submissions

I. The present appeal is from the decision of the Opposition Division to reject the opposition against the European patent no. 1 210 402 concerning a suspending clear cleansing composition.

The European Patent was granted with a set of 8 claims, claim 1 of which reading as follows:

"1. A transparent cleansing composition, comprising:
a. 5 to 30 weight percent of at least one anionic surfactant;
b. 2 to 15 weight percent of at least one amphoteric surfactant;
c. 0.1 to 10 weight percent of at least one at least partially neutralised acrylate copolymer;
d. 0.01 to 5 weight percent of at least one cationic polymer;
e. 0.01 to 5 weight percent of at least one insoluble component selected from beads, particulates, water insoluble liquids and gas bubbles, and mixtures thereof;
f. 50 to 85 weight percent of water;
g. wherein there is a weight percentage ratio range of anionic surfactant to amphoteric surfactant of 1.9:1 to 15:1;
h. wherein there is a weight percent ratio range of the sum of cationic polymer and amphoteric surfactant to acrylate copolymer of 0.1:1 to 15:1; and
wherein the concentration of acrylate copolymer is sufficient to suspend said at least one insoluble component."

Claims 2 to 7 relate to particular embodiments of the subject-matter of claim 1; claim 8 relates to a method of cleaning the skin or hair with a composition in accordance with any of the preceding claims.

II. In its notice of opposition the Opponent sought revocation of the patent on the grounds of Articles 100(a) and (b) EPC 1973.

The Opponent referred during the opposition proceedings *inter alia* to the following documents:

(3): WO 99/13837;
(7): US-A-5681801;
(8): WO 99/32079;
(10): "Carbopol - High Performance Polymers For Personal Care", BFGoodrich, September 1993;
(11): "Carbopol ETD Resins: Formulation Tips", BFGoodrich, March 1994;
(12): "Optimizing Surfactant Systems Thickened with Carbopol ETD 2020 Polymer Using a Statistical Design", BFGoodrich, December 1996.

III. The Opposition Division found in its decision that

- the invention of the patent in suit was sufficiently disclosed and that the claimed subject-matter was novel and inventive over the cited prior art.

IV. An appeal was filed against this decision by the Opponent (Appellant).

The Appellant submitted with the grounds of appeal the document US 5,336,497 (hereinafter referred to as document (14)).

The Respondents (Patent Proprietors) submitted with the letter of 16 April 2010 a set of amended claims according to the auxiliary request 1 and with the letter of 5 September 2011 amended claims according to the auxiliary requests 2 and 3.

Oral proceedings were held before the Board on 5 October 2011.

V. The Appellant submitted in writing and orally that

- the invention was not sufficiently disclosed;

- the claimed subject-matter lacked novelty over document (3) or lacked an inventive step over the combination of documents (7) and (8) (taking into account the content of documents (10), (11) and (12)), or over document (14)) alone or in combination with document (8).

VI. The Respondents submitted in writing and orally that

- document (14) had not to be admitted into the proceedings;

- the invention was sufficiently disclosed;

- the claimed subject-matter was novel and inventive over the cited prior art.

VII. The Appellant requests that the decision under appeal be set aside and the patent be revoked.

VIII. The Respondents request that the appeal be dismissed or, in the alternative, that the patent be maintained on the basis of the claims according to the auxiliary request 1 submitted with letter of 16 April 2010 or on the basis of any of auxiliary requests 2 and 3, submitted with letter of 5 September 2011.

Reasons for the Decision

1. Admissibility of document (14)

The Respondents objected to the admission into the procedure of document (14), cited in the grounds of appeal, since it was late filed and no more relevant than document (7).

The Board remarks that document (14) was already cited with grounds of appeal, the Respondents had ample time to consider this document and did not have any problem in discussing it in writing and at the oral proceedings.

Moreover, the Board finds that the introduction into the procedure of document (14) amounts to a reaction to the deficiencies indicated in the decision under appeal with respect to the evaluation of inventive step on the basis of document (7). Therefore, its introduction amounts to the right of the losing party to defend and improve its case in the light of the adverse decision.

Document (14) thus was admitted into the proceedings.

2. Respondents' main request

2.1 Article 83 EPC 1973

2.1.1 The patent in suit shows in examples 3, 5, 6, 8, 9, 10, 11, 12 and 13 compositions fulfilling the requirements (a) to (h) of claim 1 according to the main request, having a concentration of acrylate copolymer sufficient to suspend the insoluble components and being transparent as required in the patent in suit, i.e. passing the turbidity test of paragraph 36, which corresponds to an NTU of less than or equal to 105, as explained in paragraph 37. Moreover, the methods used for preparing such compositions are explicitly described in the patent in suit.

Examples 1, 7 and 14 relate instead to compositions which are not transparent as required in the patent in suit since they did not pass the turbidity test. Moreover, these compositions do not comply with the requirement (g) of claim 1 insofar as the weight ratio of anionic surfactant to amphoteric surfactant is less than 1.9:1.

2.1.2 It is the established jurisprudence of the Boards of Appeal of the EPO that each party bears the burden of proof for the facts it alleges. In particular, in opposition proceedings, the burden of proving that the objections raised under Article 100 EPC 1973 have been substantiated lies with the opponent. Once the opposition division has decided to maintain the patent and the opponent has filed an appeal against this decision, the burden is not automatically shifted to

the proprietor of the patent to show in appeal that the reasons for maintaining the patent were justified (see Case Law of the Boards of Appeal of the EPO, 6th edition 2010, VI.H.5.2, first and third full paragraphs).

The Board finds in the present case that the skilled person, by considering the teaching of the numerous examples and methods of preparation of the invention contained in the patent in suit, would have been able to modify the comparative compositions of examples 1, 7 and 14 by bringing the weight ratio of anionic to amphoteric surfactant in accordance with claim 1 and to obtain therewith transparent compositions according to the claimed invention. The same conclusions were reached by the opposition division in its decision (see points 2.2.4 and 2.2.5 of the reasons).

The Appellant conversely did not bring any evidence for its allegation that the skilled person would not have been able to arrive at a composition of the invention by simply modifying the weight ratio of anionic to amphoteric surfactant and complying with the requirements (a) to (h) of claim 1.

Therefore, the Board concludes that the patent in suit discloses the invention in a way which enables the skilled person to prepare a transparent composition as claimed.

2.1.3 As regards the Appellant's objection against the allegedly unclear term "insoluble components", the Board remarks that the description of the patent in suit gives many examples of "insoluble component" which

can be used according to the invention, for example glass beads or plastic beads but also oil droplets or water insoluble dimethicone (see paragraph 17).

Moreover, the invention requires the presence of a sufficient amount of acrylate copolymer to suspend such insoluble components (see paragraph 11). Therefore, it would have been clear to the skilled person that the insoluble components have to be suspended in the compositions of the invention and not solubilised. Consequently, the skilled person would have been limited in the choice as insoluble component of potentially soluble components such as oil droplets or dimethicone by their known possible solubility in a chosen surfactant system.

In this respect, the Appellant did not bring any evidence that the skilled person would not have been able to select a suitable insoluble component in dependence of the known solubilising capacities of the chosen surfactant system.

2.1.4 The Board concludes that the patent in suit discloses the claimed invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Consequently, the claimed invention complies with the requirements of Article 83 EPC 1973.

2.2 Novelty

Document (3) discloses in its examples 71 to 74 compositions having all the features (a) to (h) of

claim 1 according to the main request. The examples do not specify whether the compositions are transparent.

These compositions are prepared according to the basic method disclosed on page 18, line 4 to page 20, line 10. However, this basic method is just a specific example of the general method of the invention disclosed in the preceding pages (page 15, line 20 to page 17, line 7). According to this method most mixing steps and, in particular, the final mixing steps are carried out until the mixture is uniform (see steps E, G, I, J, K, L). The following passages of the description (page 17, lines 8 to 16) describes the general characteristics of the products obtained according to the general method of document (3) and specifies that the stable products of the invention show emulsion stability.
This means undoubtedly that the ingredients are mixed during preparation with the goal to form an emulsion.

Since according to the basic method mentioned above most mixing steps and the final steps are carried out also until the mixture is uniform (see steps 1 and 3 to 8), this basic method is certainly also so designed to obtain an emulsified product, which would be usually not transparent as required in the patent in suit.

Therefore, even though the basic method can have some similarity with the methods disclosed in the patent in suit, the mixing steps and, in particular, the final mixing steps must be necessarily different since the goal of document (3) is to obtain an emulsion whilst according to the patent in suit the insoluble particles must be suspended and not emulsified.

Therefore, document (3) does not disclose directly and unambiguously that the compositions of examples 71, 74 and 75 are transparent as required in the patent in suit.

The same conclusion had been reached in the decision under appeal (point 3.1 of the reasons) and the Appellant did not bring any evidence for its allegation that the compositions of examples 71, 74 and 75 have to be necessarily transparent.

Therefore, the Board concludes that the subject-matter of the claims according to the main request is novel.

2.3 Inventive step

2.3.1 The invention of claim 1 relates to a cleansing composition which can be applied to skin and hair (see paragraph 19 of the patent in suit).

The technical problem underlying the invention is formulated in the patent in suit as the provision of a cleansing composition suitable for application to skin and hair which is mild, contains suspended insoluble particles and has a transparency of less or equal 105 NTU (see paragraphs 2, 7, 9 and 10).

2.3.2 Document (7) concerns the provision of a cleansing product suitable for application to skin and hair which is mild to the skin, contains suspended insoluble particles and is clear (column 1, lines 8 to 10 and 24 to 29; column 2, lines 21 to 24 and column 3, lines 46 to 48).

Document (14) concerns a body rub formulation, i.e. a skin cleansing composition, which is mild, contains suspended insoluble particles and can be a clear gel (column 1, lines 45 to 55).

Even though both documents relate to a technical problem very similar to that of the patent in suit, the compositions of document (14) are, at variance with those of document (7), only destined to exfoliate the skin and not for application to hair.

Therefore, document (7), dealing more closely with the technical problem of the invention, has to be chosen as the most suitable starting point for the evaluation of inventive step.

Since document (7) related to the same technical problem of the patent in suit, the technical problem underlying the invention can only be defined as the provision of an alternative clear cleansing composition suitable for application to skin and hair which is mild and contains suspended insoluble particles.

The Board is convinced that the subject-matter of claim 1 according to the main request solved this technical problem.

2.3.3 The compositions of document (7) contain as suspending agent xanthan gum and not a partially neutralised acrylate copolymer (see column 4, lines 31 to 33).

Even though partially neutralised acrylate copolymers were already known in the prior art at the publication date of document (7) (see documents (10), (11) and

(12)), and it was known that a specific copolymer such as Carbopol ETD 2020 provided clear compositions containing anionic and amphoteric surfactants and suspended solids such as the xanthan gums used in the compositions of document (7) (see documents (10), page 2, right column "Application Suggestions"; (11), last page, right column, last paragraph; (12), page 1, right column, lines 12 to 14, paragraph bridging pages 1 and 2, appendix I); it was also known that cationic polymers were considered to be incompatible with acrylate copolymers which contained free carboxylic acids (see paragraphs 8 of the patent in suit).

The Board remarks also that document (8), relating to a cleansing composition containing cationic polymer, does not contain an acrylate copolymer (see claim 1 and examples) and document (14), disclosing in example 1 a composition containing an acrylate copolymer, also does not contain a cationic polymer. Moreover, documents (10) to (12), relating to such acrylate copolymers, do not teach that they are indeed compatible with cationic species.

The Appellant submitted that the skilled person would have expected the partially neutralised acrylate copolymers to be compatible with cationic polymers. However, this allegation was not supported by any evidence. To the contrary, the Board is convinced that a partially acrylate copolymer, having free carboxylic group, would have been expected by the skilled person to react potentially with cationically charged compounds such as cationic polymers.

Therefore, the skilled person, on the basis of his knowledge, would not have envisaged the use of such an acrylate copolymer and a cationic polymer in the same composition. Therefore, since the prior art did not contain any suggestion to use such compounds together, it would not have been obvious for the skilled person to modify the compositions of document (7) by replacing the xanthan gum with an acrylate copolymer as suspending agent and to add an additional cationic polymer as additional conditioning agent with the expectation of obtaining a suitable alternative mild clear cleansing composition containing suspended solids.

Therefore, the subject-matter of claim 1 according to the main request involves an inventive step.

2.3.4 For the same reasons the subject-matter of the dependent claims 2 to 7 and the method of claim 8 involve also an inventive step.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

D. Magliano P.-P. Bracke