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**Datasheet for the decision
of 13 November 2012**

Case Number: T 1801/09 - 3.3.07

Application Number: 98956319.2

Publication Number: 975309

IPC: A61K 8/89, A61K 8/891,
A61Q 1/02, A61Q 1/06

Language of the proceedings: EN

Title of invention:
Anhydrous matte cosmetic

Patent proprietors:
Color Access, Inc.

Opponents:
L'OREAL

Headword:
-

Relevant legal provisions:
EPC Art. 56, 104

Keyword:
"Inventive step (no) - all requests"
"Apportionment of costs (no)"

Decisions cited:

T 0671/03

Catchword:
-



Case Number: T 1801/09 - 3.3.07

DECISION
of the Technical Board of Appeal 3.3.07
of 13 November 2012

Appellants:
(Opponents) L'ORÉAL
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 8 July 2009
rejecting the opposition filed against European
patent No. 975309 pursuant to Article 101(2)
EPC.

Composition of the Board:

Chairman: J. Riolo
Members: G. Santavicca
P. Schmitz

Summary of Facts and Submissions

- I. The appeal by the opponents lies from the decision of the Opposition Division rejecting the opposition against European patent 0 975 309 (application N° 98 956 319.2, originating from international application PCT/US98/22955 published as WO 99/22696).
- II. The patent in suit comprised 20 claims, Claim 1 reading as follows:
"1. An anhydrous makeup composition for topical application to the skin, the composition comprising (a) a silicone gel, the gel comprising an organopolysiloxane elastomer dispersed in a silicone-compatible vehicle, (b) and a silicone-oil base, the composition comprising at least about 10% by weight of the total composition of a non-volatile silicone oil in the silicone-oil base."
- III. The patent in suit had been opposed in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC) as well as on the ground of insufficient disclosure (Article 100(b) EPC).
- IV. In the decision under appeal, as regards novelty and inventive step over D3, it was *inter alia* held that:
- (a) The combination between elastomeric organopolysiloxanes and non-volatile silicone oils being not disclosed in D3 (EP-A-0 790 055), the claimed makeup composition was a novel selection over the compositions of D3.
 - (b) As regards inventive step, Example 1 of D3, which illustrated matting compositions containing an organopolysiloxane in combination with a silicone

oil and filler, was the closest prior art. The subject-matter of Claim 1 of the patent in suit was distinguished therefrom by the presence of at least 10% by weight of the total composition of a non-volatile silicone oil. The problem solved was the provision of alternative anhydrous make-up silicone-based compositions providing a matte appearance and good comfort properties. Since it was known that non-volatile silicone oils provided at the same time good comfort properties (as apparent from D4 (EP-A-0 756 864) and D5 (US-A-5 648 066)) as well as brightness (as apparent from D6 (WO-A-97/16157)), the skilled person would not add 10% by weight of non-volatile silicone oils into the compositions of D3 to obtain compositions having a matte appearance. So the claimed solution was not obvious.

(c) Thus, these grounds of opposition did not prejudice the maintenance of the patent.

V. In their statement setting out the grounds of appeal, the appellants have enclosed new documents D8 (EP-A-0 850 644) and D9 (EP-A-0 850 643) and attacked the novelty of the claimed subject-matter.

VI. In a communication in preparation for the oral proceedings the Board indicated the issues to be debated and decided, *inter alia* the crucial issue of inventive step having regard to D3.

VII. In their letter of 29 October 2012, the respondents enclosed 26 sets of claims as Auxiliary Requests 1a, 1a', 1a", 1b, 2, 2a, 2a', 2a", 2b, 3, 3a, 3a', 3a", 3b, 4, 4a, 4a', 4a", 4b, 4c, 5, 5a, 5a', 5a", 5b and 6.

Claim 1 of each of these requests contained amendments as follows:

Auxiliary Request 1a

Claim 1 corresponds to Claim 1 as granted with the addition of disclaimers as follows:

"under the proviso that the composition is not a lipstick comprising, on a weight basis

- 15.0 % of polyethylene wax;
- 10.0 % of cross-linked organopolysiloxane at a concentration of 60 % in a non-volatile PDMS;
- 25.0 % of phenyltrimethicone oil;
- 30.0 % of pasty stearyldimethicone;
- 10.0 % of lanolin; and
- 10.0 % of pigments;

and under the proviso that the composition is not a lipstick comprising, on a weight basis

- 22 % of phenyltrimethicone;
- 4 % of stearyldimethicone;
- 1 % of jojoba oil;
- 5 % of elastomeric organopolysiloxane;
- 8 % of pigments;
- 20 % of polyethylene wax; and
- 40 % of volatile cyclomethicone."

Auxiliary Request 1b

Compared to Claim 1 as granted (*supra*), Claim 1 of Auxiliary Request 1b comprises the following additional features: "wherein the composition further comprises one or more pigments selected from: yellow, red, brown or black iron oxides, ultramarines, chromium hydroxide green, chromium oxide, white titanium dioxide, ferric

ferrocyanide, ferric ammonium ferrocyanide; azo, triphenylmethane, indigo, anthraquinone and xanthine dyes, lakes; and combinations thereof".

Auxiliary Request 2

Compared to Claim 1 as granted (*supra*), Claim 1 of Auxiliary Request 2 comprises the additional feature: "which has a matte appearance when applied to the skin".

Auxiliary Request 2b

Compared to Claim 1 as granted (*supra*), Claim 1 of Auxiliary Request 2b comprises both additional features of Claim 1 of Auxiliary Requests 1b and 2 (*supra*).

Auxiliary Request 3

Compared to Claim 1 as granted (*supra*), Claim 1 of Auxiliary Request 1b comprises the additional feature: "and the composition comprising one or more pigments".

Auxiliary Request 3b

Claim 1 of Auxiliary Request 3b is identical to Claim 1 of Auxiliary Request 1b.

Auxiliary Request 4

Compared to Claim 1 as granted, Claims 1 of Auxiliary Request 4 has been restricted to "an anhydrous lipstick composition". Auxiliary Request 4 also contains a further independent claim, i.e. Claim 2, which, still

compared to Claim 1 as granted, has been restricted to "an anhydrous foundation composition".

Auxiliary Request 4b

Claim 1 of Auxiliary Request 4b corresponds to Claim 1 of Auxiliary Request 4 (i.e. the lipstick) with the additional features defining the pigments as in Claim 1 of each of Auxiliary Requests 1b, 2b and 3b (*supra*). Claim 2 is identical to Claim 2 of Auxiliary Request 4.

Auxiliary Request 4c

Claim 1 of Auxiliary Request 4c is identical to Claim 2 (*supra*) of Auxiliary Request 4 (i.e. the foundation).

Auxiliary Request 5

Compared to Claim 1 as granted, Claims 1 of Auxiliary Request 5 has been restricted to a composition comprising "from 20 to 80%" by weight of the total composition of a non-volatile silicone oil in the silicone oil-base.

Auxiliary Request 5b

Claim 1 of Auxiliary Request 5b corresponds to Claim 1 of Auxiliary Request 5 with the further limitation that the composition comprises pigments as in Claim 1 of each of Auxiliary Request 1b, 2b, 3b and 4b (*supra*) defined in Claim 1 of each of Auxiliary Requests

Auxiliary Request 6

Compared to Claim 1 as granted, Claims 1 of Auxiliary Request 6 is restricted to a composition comprising "at least 30%" by weight of the total composition of a non-volatile silicone oil in the silicone oil-base.

Auxiliary Requests 2a, 3a, 4a and 5a

Claim 1 of each of Auxiliary Requests 2a, 3a, 4a and 5a respectively corresponds to Claim 1 of each of Auxiliary Requests 2, 3, 4 and 5 with the addition of the two disclaimer as defined in Claim 1 of Auxiliary Request 1a (*supra*).

Auxiliary Requests 1a', 2a', 3a', 4a' and 5a'

Compared to Claim 1 of each of Auxiliary Requests 1a, 2a, 3a, 4a and 5a, Claim 1 of each of Auxiliary Requests 1a', 2a', 3a', 4a' and 5a' additionally contains the mention "(KSG6)", in each of the two disclaimers, to further specify the organopolysiloxane.

Auxiliary Requests 1a", 2a", 3a", 4a" and 5a"

Compared to Claim 1 of Auxiliary Requests 1a, 2a, 3a, 4a and 5a, Claim 1 of Auxiliary Requests 1a", 2a", 3a", 4a" and 5a" additionally contains the mention "of solid, at least partially crosslinked,", in the second disclaimer, to further specify the organopolysiloxane.

VIII. Oral proceedings were held on 13 November 2012 in the announced absence of the appellants (Rule 115(2) EPC).

The appellants (opponents) had requested in writing that the decision under appeal be set aside and that the patent be revoked.

The respondents (patent proprietors) requested that the patent be maintained on the basis of Auxiliary Requests 1a, 1a', 1a'', 1b, 2, 2a, 2a', 2a'', 2b, 3, 3a, 3a', 3a'', 3b, 4, 4a, 4a', 4a'', 4b, 4c, 5, 5a, 5a', 5a'', 5b and 6, all submitted with letter of 29 October 2012. Furthermore, the respondents requested a different apportionment of costs.

At the end of the oral proceedings, the decision was announced.

- IX. In respect of apportionment of costs and inventive step over D3, the only remaining issues dealt with in the present decision, the appellants, in writing, had essentially argued as follows:

Apportionment of costs

- (d) Documents D8 and D9 were not found during the opposition proceedings. Their content and relevance became apparent only when preparing the statement setting out the grounds for appeal. Thus, their submission at that stage was not the result of an abuse of the procedure. Both D8 and D9 were only relevant against novelty, i.e. could not be used to assess inventive step. So no necessity of providing comparative examples arose from their submission. Since D8 and D9 were *prima facie* highly relevant, they should be taken into consideration.

Auxiliary Request 1a

Closest prior art

- (e) The closest prior art was described by D3. The claimed subject-matter was distinguished from the disclosure of D3 by the presence of at least 10% by weight of non-volatile silicone oil in the oil phase.

Problem solved

- (f) Since no feature specifying that the claimed composition did not require a large amount of fillers or pigments was defined in Claim 1, this could not be considered when formulating the problem solved over D3. Also, it had not been shown by evidence that the claimed compositions were matter than those of D3. Therefore, the problem solved was the provision of an alternative composition over that of e.g. Example 1 of D3.

Lack of obviousness of the solution

- (g) D5 disclosed the use of 20 to 97% by weight of non-volatile silicone oils in lipsticks. D4 taught the use of 20 to 30% by weight of non-volatile silicone oils in lipsticks and foundations in order to improve their comfort. Therefore, the skilled person seeking an alternative composition would obviously introduce 10% or 20% by weight of non-volatile silicone oils in the compositions of D3, such as in the composition of Example 1 of D3.

Auxiliary Requests

(h) The amendments to the claims of the auxiliary requests, e.g. the limitation to the pigments, were open to objections under Article 123(2) EPC. The limitation to foundations, having regard to the fact that the compositions of D3 could be taken as foundations, did not impart any further distinction. Hence, the limitations of the auxiliary requests did not overcome the objections raised.

X. In respect of apportionment of costs and inventive step over D3, the only remaining issues dealt with in the present decision, the respondents essentially argued as follows:

Apportionment of costs

(a) An at least partial apportionment of costs was equitable in the present case for the following reasons: D8 and D9 belonged to the appellants and pertained to the same technical field of the patent in suit, hence could have been produced earlier. Instead, they were submitted with the statement setting out the grounds of appeal, i.e. late. Also, whilst in the statement setting out the grounds of appeal, only Example 1 of each of D8 and D9 had been invoked against the novelty of the claimed subject-matter, in their letters of 3 February 2011 and 12 October 2012, the appellants extended their attack by referring to the general disclosure of D8, in particular Claims 7 and 5 in combination with the feature "anhydrous" allegedly taken from a single list mentioned in the description. Hence, the appellants had adopted a strategy based on repeated attacks that tormented the proceedings and

required a plurality of fall back positions, hence further costs. An apportionment of 50% of the costs for preparing the appeals and the oral proceedings was thus equitable.

Auxiliary Request 1a

Closest prior art

- (b) The closest prior art was described by D3, in particular its Example 1. D3 disclosed makeup compositions for mattifying the skin comprising in combination an elastomeric organopolysiloxane and an oily phase. That composition was conceived to contrast the glossiness produced by an excess of sebum on the skin as well as for hiding the defects of the skin. The elastomeric organopolysiloxane of D3 was of the same type as that of the patent in suit. However, no preference for silicone oils was expressed in D3, let alone for non-volatile silicone oils. Example 1 of D3 illustrated a composition comprising an elastomeric organopolysiloxane, a volatile silicone oil, other non silicone oils and more than 30% filler. Thus, the claimed composition was distinguished from D3 by a minimum of 10% of non-volatile silicone oil in the oil phase, which non-volatile silicone oil remained on the skin after application.

Problem solved

- (c) The composition of D3 in its package was different from the composition of D3 applied on the skin, because the volatile silicone flashed off leaving

fillers and pigments, i.e. the matting property evolved on the skin. However, fillers and pigments produced an uncomfortable feeling on the skin of the user. Instead, the claimed composition left an amount of non-volatile silicone on the skin, which imparted comfort, lubricity and softness. This was the consequence of the distinguishing feature over D3, which was surprising, as non-volatile silicones were known to impart glossiness. So the minimum amount of 10% by weight of non-volatile silicone oil was not arbitrary.

- (d) D3 was not acknowledged in the application as filed, and on which the patent in suit was granted. The acknowledgment in the patent in suit had been made during the examination proceedings, and was not necessarily correct as regards the mention that also the compositions of D3 produced a mat finish without using excessive amounts of fillers/pigments.
- (e) A number of tests and comparative tests (*inter alia* Tests 5 and 6) had been carried out, on the one hand, to show that the claimed subject-matter attained the sought-for effects as mentioned in the patent in suit and, on the other hand, permitted a reduction of the quantity of fillers/pigments, thus more comfort, due to the non-volatile silicone remaining on the skin.
- (f) Thus, the problem effectively solved over D3 was the provision of makeup compositions having better comfort imparted by the non-volatile silicone oil, mat appearance and less pigments and/or fillers.

Non obviousness of the solution

- (g) In order to solve the above problem, the skilled person would not use non-volatile silicone oils in the compositions of D3, as the compositions of D3 addressed the brilliance of the skin due to sebum, and it was known from D4, D5 and D6 that non-volatile silicone oils imparted glossiness, such as a slightly glossy finish referred to as semi-mat finish in D6. Therefore, the skilled person would be deterred from using products which might not reduce the brilliance of the skin. So D3 did not hint at solving the problem by the claimed solution.

- (h) Even if the problem solved by the claimed subject-matter were the mere implementation of the teaching of D3, in particular the use of a gel Grandsil SR DC 556 mentioned in D3, which according to D7 contained a non-volatile silicone vehicle, the skilled person would nevertheless not modify the compositions of D3 without considering the materials to be used (non-volatile silicone oil) and their drawbacks, let alone to arrive at a minimum of 10% by weight of non-volatile silicones.

- (i) In fact, the claimed subject-matter might be regarded as a selection within the disclosure of D3, namely of a non-volatile silicone oil, of at least 10% by weight of it in the oil base and of an anhydrous makeup composition. This combination was not suggested by D3 and attained the effects of improving the comfort and reducing the amount of pigments/fillers whilst maintaining the mat aspect. Having regard to the disincentives mentioned in

documents such as D4, D5 and D6, the skilled person would not have carried out this selection.

- (j) As regards the combination of D3 and D4, the latter neither concerned elastomeric silicone gels nor the attainment of a matte appearance, i.e. neither the same objective nor the same problem as the patent in suit. Also, D4 mentioned that the use of non-volatile silicone oils affected the sought-for reduction of transfer of the applied compositions. Hence, this combination was not obvious, nor would it suggest the claimed subject-matter.
- (k) The conclusion would be the same if the combination of D3 and D5 were considered. D5 disclosed non-volatile silicone oils, however not in compositions that imparted a matte appearance. Also, D5 did not teach the use of an elastomeric silicone gel. Finally, D5 taught that non-volatile silicone oils were less-compatible than volatile silicones, and thus deterred the skilled person from using non-volatile silicone oils in the compositions of D3.
- (l) Hence, whatever the problem solved by the claimed subject-matter and/or the further document considered, the use of at least 10% by weight of non-volatile silicone oil in the oil base of the makeup compositions of D3 was not obvious.

Auxiliary Requests

- (m) Auxiliary Requests 1a, 2a, 3a, 4a and 5a contained disclaimers over D8 and D9. Auxiliary Requests 1b, 2b, 3b, 4b and 5b defined the pigments to address

D8 and D9, instead of using disclaimers. Auxiliary Requests 1a', 2a', 3a', 4a' and 5a', included slight amendments in the disclaimers of Auxiliary Requests 1a, 2a, 3a, 4a and 5a, in order to take into the account the objections of the appellants against the exact disclosure of the examples of D8 and D9 to be excised, e.g. the composition of the commercial product KSG6 used in Example 1 of D8 and D9. Auxiliary Requests 1a", 2a", 3a", 4a" and 5a" included further amendments to the disclaimers of Auxiliary Requests 1a, 2a, 3a, 4a and 5a in order to address the objections against the disclaimer over Example 1 of D9. Thus, these requests were in reaction to the submission of D8 and D9 by the appellants, hence to overcome the alleged lack of novelty over D8 and D9.

- (n) Auxiliary Request 2 addressed the objection that Claim 1 encompassed matte and glossy compositions. Auxiliary Requests 3, 4 and 5 corresponded to Auxiliary Requests 1, 2 and 3 submitted before the Opposition Division. Auxiliary Request 4c was restricted to a foundation composition to possibly take into account the then still invoked D1. In Claim 1 of Auxiliary Request 6 the non-volatile silicone oil content in the composition was limited to at least 30% by weight.
- (o) As regards additional arguments on inventive step, the skilled person found no hint in D3 to use at least 20% or 30% by weight of non-volatile silicone oils in the makeup compositions of D3.

Reasons for the Decision

1. The appeal is admissible.

Admissibility of the respondents' auxiliary requests

2. The auxiliary requests were submitted in reaction to the statement setting out the grounds of appeal or to later objections by the appellants or the Board in advance to oral proceedings. The appellants had time to consider these requests before the oral proceedings in which they were not represented. These requests did not raise issues that could not be dealt with in the oral proceedings. Thus, all auxiliary requests are admitted for consideration by the Board.

Auxiliary Request 1a

Amendments

3. Compared to Claim 1 as granted, Claim 1 of Auxiliary Request 1a include two disclaimers, one over Example 1 of D8, the other over Example 1 of D9. Since these disclaimers do not address D3, they need not be considered for the assessment of inventive step over D3. Since the patent has to be revoked for lack of an inventive step over D3 (*infra*), the Board need not deal with whether the disclaimers are allowable.

Novelty

4. Novelty over D3 is not in dispute, the distinguishing features over D3 will become apparent from the assessment of inventive step (Point 8.9, *infra*).

Inventive step

The patent in suit

5. The patent in suit concerns anhydrous matte cosmetic (title), such as makeup compositions, e.g. silicone-based makeup compositions having a matte appearance (paragraph [0001]).

The patent in suit addresses the provision of silicone oil-based formulations that do not confer a shiny or glossy appearance on the skin of the user and which diffuse light to thereby reduce or minimize the appearance of lines and wrinkles. The patent in suit also deals with the means for conferring a matte appearance to silicone oil-based compositions without the necessity of using a large proportion of solids in the formulation (Paragraph [0006]).

These needs are fulfilled by compositions, products and method as defined in Claims 1 to 20 as granted (*supra*).

Closest prior art

6. It is not contested that D3 concerns silicone-based makeup compositions having a matte appearance, that it addresses objectives as the patent in suit and that it represents the closest prior art. The Board has no reason to take a different position.

The disclosure of D3

7. D3 concerns the use of a combination of an at least partially crosslinked elastomeric solid organopolysiloxane with a fatty phase for preparing a composition or in a skincare or makeup composition (Claim 1).

7.1 In particular, the at least partially crosslinked elastomeric solid organopolysiloxane can be included in a fatty phase made of silicone oils to form a gel (Claim 3). Also, the silicone oils employed in combination with the partially crosslinked elastomeric organopolysiloxane can be linear polysiloxanes which are liquid or pasty at ambient temperature, or mixtures thereof (Claim 7 and description, page 3, lines 39-43). In order to form a gel, the organopolysiloxane can be present in the organopolysiloxane/fatty phase mixture in a concentration of from 3 to 80% by weight (Claim 8).

7.2 Example 1 of D3 illustrates an anhydrous matting makeup composition for application to the skin, comprising:

- Polydimethylsiloxane oil, 6 cSt 30% by weight
- Partially crosslinked polydimethylorganosiloxane sold under the name KSG 6 by Shin Etsu 20% by weight
- Triglycerides of caprylic/capric acids, sold under the names MIGLYOL by Dynamit Nobel 9.1% by weight
- Parleam oil 9.1% by weight
- Silica sold under the name SB150 by Maprecos 31.8% by weight

7.3 A translucent, mild, easily spreadable gel which does not dry out was obtained by simply mixing and

homogenizing the various ingredients of Example 1 at ambient temperature. The gel obtained possessed matting properties which were stable over time and gave a natural appearance once applied to the skin (page 3, lines 30-32).

- 7.4 Since the gel of Example 1 of D3 is formed by dispersing the organopolysiloxane (elastomer) in the polydimethyl-siloxane oil, the latter fulfils at once both functions of silicone-oil base and silicone compatible vehicle (i.e. vehicle = oil base) as defined in Claim 1.
- 7.5 Therefore, Example 1 of D3 discloses an anhydrous makeup composition for topical application to the skin, which comprises a silicone gel and a silicone-oil base, the gel comprising an organopolysiloxane elastomer dispersed in the silicone-oil base.
- 7.6 In Example 1 of D3 (*supra*), the silicone oil-base of the illustrated matting composition (makeup composition) is made up of 30% by weight of polydimethylsiloxane oil having a viscosity of 6 cSt.
- 7.7 According to the patent in suit (Paragraph [0020], lines 24-25), a non-volatile silicone oil is a dimethicone having a viscosity of greater than 10 cSt. Particularly preferred is a 20 cSt dimethicone (Paragraph [0010], last sentence). The viscosity of the dimethicones mentioned in the example (Paragraph [0028]) of the patent in suit is not indicated. Thus, according to the patent in suit, dimethicone oils having a viscosity of greater than 10 cSt are non-volatile, and the silicone-oil base should comprise at least 10% by

weight of the whole composition of non-volatile silicone oils having a viscosity of greater than 10 cSt.

7.8 Since in the context of the patent in suit dimethicone is another name for polydimethylsiloxane, and since the polydimethylsiloxane oil of Example 1 of D3 has a viscosity of 6cSt, which is less than 10 cSt, the oil of Example 1 of D3 does not fulfil the definition "non-volatile" given in present Claim 1.

7.9 It follows from the foregoing, that the composition of Claim 1 is distinguished from the composition of Example 1 of D3 by a content of at least 10% of non-volatile silicone oil in the silicone-oil base.

Problem and solution

8. The application as originally filed, and on which the patent in suit has been granted, aimed at providing (Paragraphs [0006]) silicone-oil-based formulations which do not confer a shiny or glossy appearance on the skin of the user, and which diffuse light, thereby reducing or minimizing the appearance of lines and wrinkles. Also, to provide means for conferring a matte appearance to silicone-oil-based compositions without the necessity of using a large proportion of solids in the formulation. In particular, the sought-for compositions should retain the elegant feel of silicone-oil-based formulations while achieving a soft, non-shiny, or matte, appearance on the skin.

8.1 The sought-for reduction in the shiny appearance is illustrated by the example of the patent in suit.

8.2 However, D3 was not acknowledged in the application as filed and on which the patent in suit was granted. So the problem formulation in the application as filed did not consider D3. Thus, the problem effectively solved over the compositions of D3 has to be established on the basis of the results effectively attained.

8.2.1 As regards the evidence submitted (in the patent, or annexed to the Minutes and mentioned in the decision under appeal), the Board notes that:

- (a) No comparative example over D3 is included in the patent in suit.
- (b) According to a statement made in the patent in suit (Paragraph [0015], lines 43-44), the gels of D3 too would permit the production of matte-finish products without the use of excessive amounts of solids. During the oral proceedings before the Board, the respondents argued that this statement had wrongly been inserted there. This is not decisive however, as D3 discloses amounts of pigments and fillers which may be very low (page 3, line 55 to page 4, line 1).
- (c) Test 5 (filed by the opponents with letter of 17 April 2009) shows that a composition according to D3, compared to similar compositions wherein however the volatile silicone-oil has been replaced by the same quantity of a non-volatile silicone-oil or the entire oil phase has been replaced by a non-volatile silicone-oil, is very matte, and also matter than the other compositions.
- (d) Test 6 (filed by the patent proprietors with letter of 5 June 2009) shows that the composition of Example 1 of D3 (Formula E) is matter than compositions F and G according to the patent in

suit, in which half the amount of silica filler (F), or all of the silica filler (G), has been replaced by a non-volatile silicone-oil. The difference in glossiness between Formulations E and G is only 1.3 units.

8.2.2 It follows from the foregoing that:

- (a) The illustrated compositions under Claim 1 are not matter than those of D3.
- (b) According to Test 6, the use of non-volatile silicone-oil appears to permit a reduction of glossiness with a lesser amount of fillers.

8.2.3 However, D3 excludes neither the use of non-volatile silicone-oils nor the use of very low quantities of pigments and fillers. According to D3 (page 3, line 54, to page 4, line 1) pigments and fillers may respectively range from 0 to 20% and from 0 to 40%. Also, present Claim 1 sets no limit to the quantity of the fillers and the patent in suit contains no clear limits to the amounts of fillers.

8.2.4 Summing up, it does not appear plausible that an improvement over D3 is attained, neither in terms of a reduction of glossiness nor of the amount of fillers, let alone over the whole breadth of Claim 1.

8.3 Since the problem solved cannot be formulated in terms of an improvement over the closest prior art D3, it has to be redefined, based upon the information present in the application as filed (Case Law of the Boards of Appeal of the EPO, 6th edition, 2010, I.D.4.4), on the basis of the result effectively attained over D3.

- 8.4 During the oral proceedings, questioned by the Board, the respondents argued that the problem solved over D3 was "the provision of cosmetic compositions which imparted a better "confort" [*sic*], as can be conferred by non-volatile silicone oils, which had a mat aspect and permitted the reduction of the quantity of pigments and/or fillers".
- 8.5 The indication "conferred by non-volatile silicone oils" is a pointer to the solution (use of non-volatile oils), which thus cannot be inserted into the (re)formulation of the problem (Case Law, *supra*, I.D.4.3.1).
- 8.6 As regard the alleged "comfort", such an effect is not explicitly mentioned in the application as filed, which merely mentions the "elegant feel" provided by silicone oils as well as their "excellent slip" and their "non production of a greasy, heavy feel" (page 1, lines 9 to 18). Also mentioned are the "heavy, draggy feel on the skin" (page 2, lines 3-6, 21 and 29), as provided by large proportions of solids. Still according to the application as filed (paragraph bridging pages 3 and 4), the addition of the gel defined in Claim 1 to an otherwise standard anhydrous silicone oil-based formulation would, on the one hand, "decrease the shiny appearance" and, on the other hand, permit that the makeup composition appears "soft, light and attractive". Furthermore (*idem*), "the addition of the gel composition to a silicone oil-based anhydrous product also provides matte finish on the skin without the addition of large quantities of solid fillers". Still further according to the description of the application as filed (page 4, line 15-25, and page 6, last

paragraph), both volatile and non-volatile silicone oils can be used in the vehicle and/or in the oil-base. Only from page 8, lines 23-30, an explicit preference for non-volatile silicone oils in the silicone oil-base is expressed, which is then illustrated in the example. No determination whatsoever of any comfort is however disclosed in the application as filed.

Hence, if the alleged "comfort" is something different from the effects mentioned in the application as filed, it cannot be considered when formulating the problem. If instead that effect merely corresponds to the typical effects of the silicone oils in general, as mentioned in the application as filed, then they are also attained by the compositions of D3, which mention them on page 2, lines 38-39.

8.7 As regards the alleged reduction of glossiness while also reducing the quantity of pigments and fillers, which in the application as filed is linked to the presence of the gel, the same should happen with the compositions of D3, as they use the same gel. Also, from the comparative tests over D3 submitted, it is not apparent that an improvement is actually achieved over the whole breadth of Claim 1, e.g. that the composition requires less fillers and charges than the compositions of D3. So a reduction in the amount of fillers over D3 cannot be acknowledged for the claimed composition.

8.8 Consequently, the problem effectively solved over D3 was merely to provide further silicone oil-based makeup compositions which do not confer a shiny or glossy appearance on the skin of the user and which can reduce or minimize the appearance of lines and wrinkles, even

when they do not contain a large proportion of solids in the formulation.

Obviousness of the solution

9. The distinguishing feature of Claim 1 ("a content of at least 10% of non-volatile silicone-oil in the silicone-oil base") implies that the claimed composition must comprise a silicone-oil base which either is a mixture containing at least 10% by weight of non-volatile silicone-oil and volatile silicone-oil, or is entirely made up of non-volatile silicone-oil. The latter possibility is defined in Claim 6 of the patent in suit.

9.1 As regards the possible use of a mixture of volatile and non-volatile silicone oils as the silicone-oil base in the compositions of D3, the following is noted:

9.1.1 The silicone oils employed in association with the organopolysiloxane are chosen from linear polysiloxanes which are liquid or pasty at ambient temperature, cyclic polysiloxanes or mixtures thereof (Claim 7 and page 3, lines 39-43, of D3). No limitation whatsoever to molecular weight, viscosity and volatility of those silicones is ever given in D3. Hence, D3 encompasses volatile and non-volatile silicone oils.

9.1.2 D3 also explicitly mentions the possibility of using mixtures of those silicone oils (page 3, line 43). This merely reflects the fact that in the formulation of cosmetics the use of mixtures of ingredients is a general necessity, e.g. when the ingredients, such as in the present case the silicone-oil, are not always available in all possible grades (e.g. molecular weight,

viscosity). So the formulator by necessity has often to mix an appropriate ratio of available commercial ingredients to arrive at the desired property of the composition (e.g. volatility or viscosity). So the use of a mixture of silicone oils as the oil base for the compositions of D3 is an available option.

9.1.3 Furthermore, D3 also discloses the possible use of preformed gels (i.e. a premade dispersion of organopolysiloxane elastomer in a silicone compatible vehicle instead of an organopolysiloxane elastomer as such) or of a mixture thereof (page 3, lines 16-18), which fact is not in dispute. Among the commercially available preformed gels, D3 mentions the "KSG18" by Shin Etsu and the "Grandsil SR DC 556". D7 (Product Information for Dow Corning® 556, bearing a copyright date of 1981 and enclosed in the notice of opposition) shows that the silicone oil DC 556, which constitutes the silicone compatible vehicle of Grandsil SR in the the latter commercial product, is a phenyl trimethicone having a viscosity of 22.5 mm²/s (1 mm²/s = 1 cSt), i.e. a non-volatile silicone oil according to the patent in suit (Paragraph [0017], lines 55-56). As regards the commercial product KSG18 by Shin Etsu, in the Board's communication (Point 13.2.7(b)) attention had been drawn to its silicone compatible vehicle being a phenyl trimethicone. However, none of the parties contested that statement, e.g. by filing a data sheet of that commercial product. Nevertheless, at least D6 shows that a preformed gel mentioned in D3 may contain non-volatile silicone oils as the silicone vehicle in which the elastomer is dispersed and the gel formed.

- 9.1.4 It follows from the foregoing that D3 suggests the use of mixtures of silicone-oils, e.g. deriving from the use of preformed gels in *inter alia* non-volatile silicone oil vehicle, hence containing non-volatile silicone oils, as the oil-base of its makeup compositions.
- 9.1.5 Since D3 stresses that the attainment of the mattifying effect is due to the light diffusion attained by the organosilicone elastomer (page 4, lines 4-5), as sought-for in the patent in suit too (page 2, line 41), and since because of this property the compositions of D3 may contain low amounts of fillers and pigments and even be transparent (page 4, lines 5-6), the known fact that non-volatile silicone oils also impart glossiness would not deter the skilled person from using them.
- 9.1.6 Hence, for the skilled person merely aiming at further silicone oil-based makeup compositions which do not confer a shiny or glossy appearance on the skin of the user and which can reduce or minimize the appearance of lines and wrinkles, even when they do not contain a large proportion of solids in the formulation, i.e. further makeup compositions over D3, the use of a mixture of silicone-oils in the silicone-oil base of D3 was an available option.
- 9.1.7 The arguments by the respondents that D3 does not prefer the non-volatile silicone-oils (as allegedly apparent from its Example 1), that non-volatile silicone oils impart more comfort but also more glossiness and that the person skilled in the art nevertheless does not find any incentive to use non-volatile silicone oils, as apparent from the

disincentivating statements in D4 and D5, is not convincing, for the following reasons:

- (a) D3 is open as regards the nature of the silicones;
- (b) that volatile silicone oils flash-off during application is known, and also acknowledged in the patent in suit (Paragraph [0005], lines 33-36);
- (c) the advantages (e.g. comfort) and disadvantages (e.g. transfer, incompatibilities) deriving from the use of non-volatile silicone oils are known, as apparent from D4 (page 2, lines 32-33) and D5 (column 2, lines 12-20), i.e. foreseeable;
- (d) the disadvantages of using non-volatile silicone oils in the claimed subject-matter have never been shown to be compensated by further unexpected advantages;
- (e) So, a mere trading off between volatile and non-volatile silicone-oils, e.g. in order to adjust volatility, viscosity, gloss or comfort, in a context where advantages and disadvantages are foreseeable, is at hand for the skilled person;
- (f) thus, the apparently disadvantageous use of non-volatile silicone oils in the compositions of D3, e.g. in that illustrated by Example 1 of D3, was nevertheless obvious (Case Law, *supra*, I.D.8.5).

9.2 The question which arises next is whether D3 hints at a content of at least 10% non-volatile silicone oil in the silicone-oil base.

9.2.1 A lower limit of 10% of non-volatile silicone-oil in the silicone-oil base is as such not mentioned in D3.

9.2.2 In the absence of any restriction to the volatility of the remaining 90% of volatile silicone-oil, the lower

limit of 10% per se does not delimit any definite character (e.g. volatile, low- or non-volatile) of the silicone-oil base in the claimed composition. The comparative examples on file do not show improvements over D3 which are attained by the lower limit of 10%. D3 is open as to quality and quantity of volatile and non-volatile silicone oils (*supra*). D3 suggests the use of preformed gels, the silicone vehicle of which can be non-volatile.

9.2.3 Hence, the use of at least 10% by weight of non-volatile silicone oil in a silicone-oil base for the composition of D3, e.g. in that of Example 1 of D3, for instance by use of preformed gels containing a non-volatile silicone oil or by dispersing an elastomer in a mixture already containing at least 10% of non-volatile silicone oil, was an obvious measure for the skilled person merely seeking further makeup compositions over D3.

9.3 As regards the possibility of using a silicone-oil base entirely made of non-volatile silicone oil(s) in the compositions of D3, the following is noted:

9.3.1 No particular effect obtained thereby has been shown. So this option per se also appears to be an obvious choice with expectable advantages and disadvantages linked to the non-volatile silicone oil chosen.

9.3.2 Furthermore, D3 (Page 3, lines 47-48) discloses that the gel made by associating the organopolysiloxane elastomer and the oily phase, hence the silicone-oil, can be used as such as a makeup matting composition for the skin and/or to reduce or minimize the appearance of

the lines, wrinkles, pores, etc. Also this mention in D3 represents a suggestion for solving the problem of providing further makeup matting compositions.

9.3.3 Since the gel according to D3 can be a commercial product in form of a preformed dispersion of an organosiloxane elastomer and a non-volatile silicone-oil vehicle, and since according to D3 that gel *per se* can be used as a makeup composition, the silicone vehicle of the commercial preformed dispersion constitutes the oil-base that is entirely made of non-volatile silicone-oil. Hence, also the use of a silicone-oil base entirely made of non-volatile silicone oil was obvious over D3.

9.4 It follows from the foregoing that the use of a mixture of non-volatile and volatile silicone-oils as defined in Claim 1 was obvious having regard to D3, i.e. was devoid of any inventive character (Case Law of the Boards of Appeal, 6th edition, 2010, I.D.8.19.6).

Auxiliary Requests 1b, 2-2b, 3-3b, 4-4b, 4c, 5, 5c, 6

10. D3 also discloses that its matting compositions can:

- (a) impart a prolonged mat aspect to the skin (page 2, line 32);
- (b) blur the hard lines and wrinkles common in older skin (page 2, line 33-35);
- (c) be opaque (page 3, line 52); and,
- (d) contain classical additives, *inter alia* pigments (page 3, line 55).

10.1 It follows from these items of disclosure that classical pigments used in formulating makeup

compositions can be used in the compositions of D3 as well. Also, that the matting compositions of D3 containing pigments and fillers are suitable to alter the appearance of and impart a particular matt finish to facial skin, as does a foundation.

- 10.2 It has never been shown by evidence that the pigments defined in Claim 1 of Auxiliary Request 1b, e.g. white titanium dioxide, are not usual or permit to attain unexpected effects. In any case, the use of at least some of the pigments defined in Claim 1 of Auxiliary Request 1b, in makeup compositions comprising a silicone gel, is known, e.g. from D2 (JP-A-1 250 307) (page 16, second full paragraph).
- 10.3 Hence, the additional features present in Claim 1 of Auxiliary Requests 1b, 2, 2b, 3, 3b, 4c or in Claim 2 of Auxiliary Requests 4 and 4b neither change the closest prior art D3 nor the problem solved over D3. Therefore, the conclusions drawn from D3 for Auxiliary Request 1a apply *mutatis mutandis*.
- 10.4 It follows from the foregoing that the subject-matter of each Claim 1 of Auxiliary Requests 1b, 2, 2b, 3, 3b, 4c as well as the subject-matter of each Claim 2 of Auxiliary Requests 4 and 4b is obvious over D3.
- 10.5 As regards, Claim 1 of Auxiliary Requests 5, 5b and 6, the restriction of the minimum amount of non-volatile silicone oil present in the silicone oil-base, to respectively at least 20 or at least 30% by weight of the total composition, does not impart any nonobvious distinction over D3, because the silicone oil-base of the composition of D3 may contain non-volatile silicone

oil, the amount of which is not limited in any way (*supra*, Points 9.2 and 9.3). Therefore, also the subject-matter of Claim 1 of each Auxiliary Requests 5, 5b and 6 is obvious over D3 and lacks an inventive step.

Auxiliary Requests 4a, 4a' and 4a"

11. Since Claim 2 of each Auxiliary Requests 4a, 4a' and 4a" identically corresponds to Claim 2 of Auxiliary Requests 4 and 4b, the subject-matter thereof lacks an inventive step too.

Auxiliary Requests 2a-2a'-2a", 3a-3a'-3a", 5a-5a'-5a"

12. Claim 1 of each of Auxiliary Requests 2a, 2a' and 2a", 3a, 3a' and 3a", 5a, 5a' and 5a" is distinguished from Claim 1 of respectively Auxiliary Requests 2, 3 and 5 only by a slightly different definition of the disclaimers over D8 and D9.
 - 12.1 Since the disclaimers do not add any distinguishing features vis-à-vis D3, the conclusion drawn from the disclosure of D3 (i.e. obvious solution) in relation to each of Auxiliary Requests 2, 3 and 5 apply *mutatis mutandis* to the subject-matter of each Claim 1 of Auxiliary Requests 2a, 2a' and 2a", 3a, 3a' and 3a", 5a, 5a' and 5a".
 - 12.2 Hence, none of the auxiliary requests is allowable.

Conclusion

13. The claimed subject-matter of all auxiliary requests on file does not fulfil the requirements of the EPC.

Apportionment of costs

14. According to Article 104 EPC, each party shall bear the costs it has incurred. For reasons of equity, however, the Board may order a different apportionment of costs. According to the Case Law of the Boards of Appeal (6th edition, VII.C.7.2), an apportionment of costs may be justified if the conduct of a party is not in keeping with the care required.
- 14.1 D3, D8 and D9 are European patent applications stemming from the appellants themselves, which are even classified in the same IPC class. Thus, it seems that due care required that these documents were to be filed already during the first instance proceedings.
- 14.2 However, this point need not be decided, as costs are only to be apportioned if the violation of the duty of care, i.e. the late filing of D8 and D9, caused additional costs which could have been avoided if they had been filed in due time (Singer/Stauder, Europäisches Patentübereinkommen, 6th edition, Article 104, Point 28). In fact, if D8 and D9 had been filed before the Opposition Division, the respondents would also have had to prepare their defence against them. Thus, the invoked costs would also have been incurred.
- 14.3 The situation is different to the one in T 0671/03, and the additional decisions cited by the respondents. In these cases the evidence filed in the appeal procedure

led to a remittal to the first instance and accordingly the costs of the discussion of the late filed evidence in the appeal procedure could have been avoided. In the present case, however, the Board has decided the case itself, so there are no additional costs incurred.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The respondents' request for a different apportionment of costs is rejected.

The Registrar:



S. Fabiani



The Chairman:



J. Riolo

