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**Datasheet for the decision
of 5 September 2013**

Case Number: T 0636/10 - 3.3.10

Application Number: 01948261.1

Publication Number: 1289485

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A61L9/04, C11D3/50, D06M13/00

Language of the proceedings: EN

Title of invention:
FRAGRANCE COMPOSITIONS

Patent Proprietor:
THE PROCTER & GAMBLE COMPANY

Opponents:
UNILEVER PLC / UNILEVER NV
Henkel AG & Co. KGaA
Beiersdorf AG

Headword:

Relevant legal provisions:
EPC 1973 Art. 54(3), 54(4)
EPC Art. 54(1), 111(1), 123

Keyword:
Novelty - (yes) remittal

Decisions cited:
T 0722/94, T 2017/07

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0636/10 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 5 September 2013

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 15 January 2010
revoking European patent No. 1289485 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairwoman: J. Mercey
Members: R. Pérez Carlón
C. Schmidt

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division to revoke European patent EP 1 289 485.
- II. Three notices of opposition had been filed requesting revocation of the patent in its entirety on the grounds *inter alia* of lack of novelty (Article 100(a) EPC).
- III. *Inter alia*, the following documents were submitted during opposition proceedings:

D3d: <http://www.essentialoils.co.za/essential-oils/neroli.htm>

D6: WO 00/67714

D28: WO 00/67721

- IV. The opposition division decided that claim 1 of the then pending first auxiliary request, which is the main request in appeal proceedings, was not novel. Said claim reads as follows:

"A composition comprising:

(a) a fragrance oil comprising:

(i) top note perfume raw material, or mixture of perfume raw materials, with a boiling point of less than, or equal to, 250°C at 1 atmosphere pressure;

(ii) middle or base note perfume raw material, or mixture of perfume raw materials, with a boiling point of greater than 250°C at 1 atmosphere pressure;

(b) an entrapment material which is selected from cyclic oligosaccharides;

(c) greater than 50% by weight of ethanol; wherein the weight ratio of the top note perfume raw materials to middle or base note perfume raw materials within the fragrance oil is in the range from 1:20 to 20:1, and wherein, water, if present, comprises from 0.1 to 40% by weight of total composition."

V. The opposition division considered that the feature of claim 1 "wherein the weight ratio of the top note perfume raw materials to middle or base note perfume raw materials within the fragrance oil is in the range from 1:20 to 20:1" did not limit the relative amounts of top to middle or base note materials in the claimed composition, but only within component (a). Document D6, which was state of the art in the sense of Article 54(3) (4) EPC 1973, disclosed compositions comprising neroli oil and, hence, containing both top and middle or base note materials. Neroli oil could be envisaged as a mixture of two compositions, one of them fulfilling the condition set out in claim 1 for component (a), and a second one containing the remaining fragrance materials, if any. The composition disclosed in D6 contained, therefore, a fragrance oil (a) as defined in claim 1, and the subject-matter of the then pending first auxiliary request was, hence, not novel.

VI. The appellant (patent proprietor) submitted that, according to the European Patent Register, international application WO 00/67714 (D6) had not entered the European phase and was, therefore, not state of the art for the claimed subject-matter.

The appellant argued that document D28 did not disclose a cosmetic composition comprising neroli oil, components (b), (c) and, optionally, water, as defined

in claim 1, since this composition resulted from a selection from several lists. Even if these features were disclosed therein in combination, there was no evidence on file that neroli oil contained the relative amount of top to middle or base note materials required by claim 1. The feature "the weight ratio of the top note perfume raw materials to middle or base note perfume raw materials within the fragrance oil is in the range from 1:20 to 20:1" restricted the weight ratio of top to middle or base note materials in the entire claimed composition, in line with the teaching of the description at paragraph [22], and there was no evidence on file that the weight ratio of top to middle or base note materials in neroli oil fulfilled the requirements of claim 1. The subject-matter of claim 1 was, hence, novel.

- VII. Respondents 1 and 2 (opponents 1 and 2, respectively) did not provide any arguments with respect to the novelty of the claimed subject-matter.
- VIII. Respondent 3 (opponent 3) submitted that document D28, which claimed priority from document D6, entered the European phase and the designation fees had been paid, with the consequence that it was state of the art under Article 54(3)(4) EPC 1973 for the claimed subject-matter. D28 disclosed a composition comprising neroli oil, a cyclic oligosaccharide, more than 55% by weight of ethanol and 0.1 to 40% by weight of water.

The feature of claim 1 "the weight ratio of the top note perfume raw materials to middle or base note perfume raw materials is in the range from 1:20 to 20:1" did not limit the relative amount of top and middle or base note materials of the claimed composition due to the use of the open wording

"comprising" at the beginning of the claim. This wording allowed further top note and/or middle/base note perfume raw materials other than those defined in the fragrance oil (a) to be present in the final compositions, which was also in line with the disclosure in paragraphs [10], [24] and [70] of the patent in suit. Hence, although claim 1 must contain both top and middle or base note materials, they could be present in any proportion. According to D3d, neroli oil contained both top and middle or base note materials and, hence, document D28 disclosed all the features of claim 1.

Paragraph [27] of the patent in suit disclosed amounts of 0.01% for the "middle and base note" components. Since the balance to 100% could only correspond to top note raw materials, a value outside the limit of 20:1 to 1:20 of top to middle or base note materials would necessarily be obtained, which proved that the ratio defined in claim 1 of 20:1 to 1:20 was meaningless and could not apply to the whole composition claimed.

Even assuming that the feature defining the weight ratio of 1:20 to 20:1 of top to middle or base note raw materials within the fragrance oil limited the weight ratio in the whole composition, neroli oil was a fragrance oil fulfilling said requirement. D3d listed the "main chemical components" of neroli oil, several of which were top or middle/base note perfume raw materials. Since all of these components were described as being "main" components, they must be present in similar amounts, such that the ratio of top to middle/base note components must fall within the broad range defined in the claim of the main request.

Finally, since document D28 disclosed the same

technical effect as the patent in suit, the compositions of D28 must have been the same as those of claim 1.

IX. Oral proceedings took place on 5 September 2013 in the absence of respondents 1 and 2.

X. The final requests of the parties were as follows:

- The appellant requested that the decision under appeal be set aside and that the patent be granted on the basis of the main request or
 - auxiliarily - on the basis of the first or second auxiliary requests, all requests filed with a letter dated 14 May 2010, or on the basis of the third auxiliary request filed during the oral proceedings.
- Respondents 1 to 3 requested that the appeal be dismissed.

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

Reasons for the Decision

1. The appeal is admissible.

Amendments:

2. No objection under Article 123 EPC has been raised against the main request.

Claim 1 of the main request is based on the combination of claims 1, 10, 20 and the passage on page 25, lines 10-11 of the application as originally filed. Claims 2-17 find a basis in claims 2-6, 11-17 and 21-24 as

originally filed. The requirements of Article 123(2) EPC are thus fulfilled.

Claim 1 of the main request results from combining the subject-matter of granted claim 1 with that of dependent claims 10 and 20, with the additional limitation of the amount of water. Therefore, the amendments do not extend the scope of the protection sought (Article 123(3) EPC).

The main request fulfils, therefore, the requirements of Article 123 EPC.

Novelty:

3. According to the European Register, international application WO 00/67714 (D6), which was cited against the novelty of the subject-matter claimed in the course of the opposition (appeal) proceedings, did not enter the European phase. D6 is, hence, not state of the art in the sense of Article 54(3)(4) EPC 1973. This finding has not been contested.
4. Document D28, filed before the oldest priority of the patent in suit and published between its second priority and its filing, has entered the European phase and the designation fees have been paid for all of the states designated in the contested patent except Turkey. D28, thus, represents state of the art relevant for the novelty of the subject-matter claimed at least under Article 54(3)(4) EPC 1973 in so far as the same contracting states are designated. This finding has not been contested by the appellant.
 - 4.1 Document D28 discloses a cosmetic composition comprising a fragrance, a cyclic oligosaccharide having

one or more unsubstituted alkyl substituents, 55% or greater by weight of ethanol and 0.1 to 40% by weight of water (see claims 1, 7, 8 and 11). Document D28 discloses neroli oil (see page 5, line 12) as an example of a fragrance useful for the invention disclosed therein. The relevant disclosure content of D28 is thus comparable to that of D6 on which the opposition division relied for its novelty objection.

5. It was a point of dispute among the parties whether document D28 disclosed a composition comprising neroli oil in combination with components (b), (c) and, optionally, water, as required by claim 1 of the main request.
 - 5.1 The appellant has challenged the finding of the opposition division that the choice of neroli oil as fragrance represented a selection within a single list. In the view of the appellant, in order to arrive at the subject-matter of claim 1, at least a first selection between single component or multi-component fragrances, a second between pro-fragrances and fragrances, and a third between vegetal and animal fragrances was required. Since multiple selections were needed in order to arrive at neroli oil, document D28 did not disclose a composition comprising neroli oil in combination with the rest of the components required by claim 1.
 - 5.2 However, in order to select the embodiment "neroli oil", the skilled person merely needs to consider the lists of compounds and compositions labeled in D28 as "fragrances".
 - 5.3 D28 groups the "fragrances" for use therein into various sub-groups (see page 4, line 8 to page 6, line

- 7). However, all of these sub-groups defined in D28 are equally suitable members of the general group "fragrances", with the consequence that only one selection is necessary to arrive at the subject-matter claimed, namely that of "neroli oil" from the single list of "fragrances".
- 5.4 Options disclosed in a single list are regarded as directly and unambiguously disclosed (see, for example, T 722/94, not published in OJ EPO), with the consequence that document D28 discloses a composition comprising neroli oil, cyclic oligosaccharide having one or more unsubstituted alkyl substituents, 55% or greater by weight of ethanol and 0.1 to 40% by weight of water.
6. It has not been contested that neroli oil contains top note (alpha-pinene, nerol, geraniol, linalool, linalyl acetate) and middle/base note perfume materials (methyl anthranilate, indole), as disclosed for example in document D3d (see page 2, "chemical composition"). Neroli oil is thus a fragrance oil (a) according to claim 1 of the main request.
7. It remains to be addressed whether such a composition containing neroli oil, components (b) and (c) and water as disclosed in document D28 fulfils the requirement of claim 1 of the main request that the weight ratio of the top note perfume raw materials to middle or base note perfume raw materials within the fragrance oil is in the range from 1:20 to 20:1.
- 7.1 The main contested issue in the present case is whether this feature means that said weight ratio must apply to the entire claimed composition, as argued by the appellant, or only to the fragrance oil (a). Should the

latter be the case, as was argued by the opposition division and respondent 3, then the open wording of the claim would allow the presence of other top, middle and/or base note perfume raw materials in any amounts, such that the weight ratio was meaningless and not limiting.

- 7.2 Both of these interpretations of the subject-matter of the claim have their legitimacy, thus highlighting a lack of clarity thereof. Since, however, lack of clarity is not a ground of opposition, the board must interpret the claim as it stands.

When considering a claim, the skilled reader should try to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent, with a mind willing to understand (see Case Law of the Boards of Appeal, 7th edition 2013, II.A.6.1).

The board holds that, in the present case, by specifying a range for the weight ratio of the top to middle or base note perfume raw materials in component (a) of claim 1, the claim is subjected to an implicit proviso excluding the presence of any other of these compounds in the composition in amounts which would disrupt said range, since otherwise the specified ratio of top to middle or base note perfume raw materials would be deprived of sense. Thus, said ratio must apply to the entire composition, with the consequence that, as indicated in T 2017/07 (see point 2.2, not published in OJ EPO), the composition of claim 1 is only open to the presence of further components not already specifically defined in said composition.

Claim 1 is thus interpreted as comprising top and

middle and/or base note perfume raw materials in a weight ratio of top to middle or base note perfume raw materials from 1:20 to 20:1, together with components (b), (c) and, optionally, water, together with any **further** components.

- 7.3 Respondent 3 argued that it was apparent from paragraph [10] of the description of the patent in suit, which reads:

*"the fragrance oil is blended to comprise volatile "top notes" and residual "middle and base notes" wherein the weight ratio between these two types of notes is in the range from about 1:20 to about 20:1, and preferably **in conjunction with a balance** of perfume raw materials with a low detection threshold"* (emphasis added)

that the presence of other perfume raw materials apart from those included in component (a) was contemplated within the invention.

However, the board holds that this passage merely indicates that the claimed composition should contain the ratio of top to middle or base note materials as in claim 1 and that, additionally, the perfume materials should be balanced with respect to their detection thresholds, and not that additional odour components are present in the claimed compositions.

The same can be concluded from the similar wording in paragraph [28] of the description, which reads:

*"it is preferred that **within** the fragrance oil a balance of perfume raw materials are used which have a low odour detection threshold"* (emphasis added).

7.4 Respondent 3 also relied on paragraph [24] of the contested patent for showing that additional odour materials in addition to those in component (a) could be present in the claimed composition, since said passage reads:

*"The fragrance oil itself can comprise **any** perfume raw material suitable for use in the composition"* (emphasis added).

However, said passage merely defines the nature of the components of the fragrance oil (a) with respect to "the" fragrance oil itself, in line with the disclosure of paragraph [22] of the patent in suit, which reads:

*"As used herein the term "fragrance oil" relates to **the** mixture of perfume raw materials that are used to impart an overall pleasant odour profile to a composition."* (emphasis added)

Thus the composition may comprise "any" perfume raw materials, so long as they are suitable for use in the composition, namely so long as the ratio of top to middle or base note materials in the composition is in the range of 1:20 to 20:1 and said materials impart an overall pleasant odour profile thereto.

These arguments of respondent 3 are, thus, dismissed.

7.5 Respondent 3 also argued that paragraph [70] of the patent in suit taught that menthol could be added as a cooling agent to the compositions, menthol also being a perfume raw material, thus upsetting the ratio of top to middle or base note materials in the composition as a whole.

However, if menthol were present in the composition as a cooling agent, then the skilled person would understand that the amount thereof must be such that the ratio of top to middle or base note materials in the composition as a whole remains within the claimed range. It follows that the skilled person, when adding "additional ingredients that are suitable for inclusion in the present compositions " (see paragraph [70]) would not add additional ingredients in an amount which would cause the ratio of top to middle or base note materials in the composition as a whole to fall outside the range 1:20 to 20:1.

- 7.6 Respondent 3 argued that the passage of the description in paragraph [27], line 46, defined amounts of 0.01% by weight for the "middle and base note" components. Since the balance to 100% could only correspond to top note raw materials, the description of the patent in suit proved that the ratio defined in claim 1 of 20:1 to 1:20 was meaningless and could not apply to the claimed composition.

However, claim 1 is drafted as a composition comprising a component (a) which, in its turn, comprises top and middle/base note perfume raw materials. The wording of claim 1 does not exclude the presence of additional, non-odorous components as part of component (a) and, hence, even if the amount of middle and base note components is as low as 0.01% by weight, the remainder of (a) does not necessarily have to be only top note perfume raw materials.

This argument of respondent 3 is, therefore, dismissed.

- 7.7 Having decided that the feature that the weight ratio of the top to middle or base note perfume raw materials

within the fragrance oil is in the range from 1:20 to 20:1 means that this ratio must apply to the whole composition, it remains to be decided whether the composition of document D28 containing neroli oil fulfils this requirement.

None of the documents on file discloses the relative amounts of the top to middle or base note perfume raw materials in neroli oil, such that the board holds that the subject-matter of claim 1 is novel over the disclosure of D28 for this reason.

- 7.8 Respondent 3 argued that D3d disclosed the "main components" of neroli oil as being α -pinene, camphene, pinene, α -terpinene, nerol, neryl acetate, farnesol, geraniol, linalool, nerolidol, linalyl acetate, methyl anthranilate and indole, of which α -pinene, nerol, geraniol, linalool and linalyl acetate were top note materials and methyl anthranilate and indole were middle/base note materials. Since all components were described as being "main" components of neroli oil, it could be assumed that they were present therein in similar amounts, such that the weight ratio of the top to middle or base note perfume raw materials must fall within the broad range from 1:20 to 20:1.

However, document D3d is silent about the meaning of "main component" and there is no evidence on file showing that this expression should be read as implying similar amounts of the chemicals listed. Nor is there any other evidence on file that the weight ratio of α -pinene, nerol, geraniol, linalool and linalyl acetate to methyl anthranilate and indole is in the range from 1:20 to 20:1, such that a direct and unambiguous disclosure of this weight ratio, which would be

required for concluding lack of novelty, is missing.

- 7.9 Respondent 3 also argued that, since the effect sought in the patent in suit was also achieved in document D28, namely the composition gave an initial "burst" of fragrance and had long-lasting fragrance, (see last sentence on page 14), the compositions of D28 must have been the same as those of the claimed invention.

However, the same effect could also be achieved by different means and a similarity in the effect obtained cannot prove that the technical features of the prior art are the same as in the claimed invention. This argument of respondent 3 is, hence, dismissed.

8. The compositions of claim 1 are, hence, novel over document D28 (Article 54(1) EPC; Article 54(3)(4) EPC 1973). For the same reasons, the method of claim 16 and the use of claim 17, which both use a composition according to claim 1, of the main request are also novel.
9. Having so decided, the board has not taken a decision on the whole matter, since the decision under appeal dealt solely with the issue of novelty. As the opposition division has not yet ruled on the other grounds for opposition, namely inventive step and insufficiency of disclosure, the board considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit the case to the opposition division for further prosecution on the basis of the claims according to the main request in order to enable the first instance to decide on the outstanding issues.

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 the main request filed with a letter dated 14 May 2010.

The Registrar:

The Chairwoman:



C. Rodríguez Rodríguez

J. Mercey

Decision electronically authenticated