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**Datasheet for the decision
of 15 June 2012**

Case Number: T 0737/10 - 3.3.06
Application Number: 98900920.4
Publication Number: 1007610
IPC: C11B 9/00, A61K 7/46
Language of the proceedings: EN

Title of invention:
Macrocyclic Musk Mixtures

Patent Proprietor:
Givaudan Nederland Services B.V.

Opponents:
FIRMENICH SA
Symrise AG

Headword:
Musk mixtures with improved substantivity/GIVAUDAN

Relevant legal provisions:
EPC Art. 123(2)(3)

Relevant legal provisions (EPC 1973):
EPC Art. 56

Keyword:
"Admissibility of late-filed requests (no)"
"Article 123(2)(3) met - auxiliary request (yes)"
"Inventive step - main request (no), auxiliary request (yes)"

Decisions cited:
-

Catchword:
-



Case Number: T 0737/10 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 15 June 2012

Appellant: Givaudan Nederland Services B.V.
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Representative: Givaudan Patents
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 9 February 2010
revoking European patent No. 1007610 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P.-P. Bracke
Members: E. Bendl
U. Tronser

Summary of Facts and Submissions

- I. The appeal is from the decision of the Opposition Division to revoke the European patent no. 1 007 610.
- II. The notice of appeal was received on 09 April 2010, with the payment of the appeal fee on the same day. With the grounds of appeal received on 09 June 2010 the Appellant/Proprietor filed an amended main request and an auxiliary request with the following independent claims:

Main request

"1. A musk mixture consisting of hexadecanolide with one or both of cyclopentadecanone and pentadecanolide."

"3. A product selected from the group consisting of bath products, shower products, face washes, shampoos, hair rinse conditioners, laundry detergents, fabric softeners, rinse conditioners, fabric sprays and ironing aids containing a musk mixture consisting of hexadecanolide with one or both of cyclopentadecanone and pentadecanolide."

Claims 2 and 4 were dependent upon Claims 1 and 3, respectively.

Auxiliary request

The only independent claim of this request, Claim 1, was identical with Claim 1 of the main request.

Claim 2 was dependent on Claim 1.

III. In the course of the proceedings the parties inter alia cited the following documents:

D12 = WO-A-96/12468

D25 = Perfume and Flavor Chemicals, St. Arctander,
published by the author, items 811,813,923 (1969)

D26 = Perfumer & Flavorist, vol.10, 8,10, (1985)

IV. On 12 June 2012, i.e. three days prior to the oral proceedings before the Board, the Proprietor submitted further three sets of claims. The independent claims of those requests read as follows:

Main request

"1. A method of treating skin, hair or textile fibres characterised in that a mixture of at least two of the macrocyclic musks hexadecanolide, cyclopentadecanone and pentadecanolide, which mixture is part of a perfume which does not contain a polycyclic musk, is applied to said skin, hair or textile fibres."

"3. A method of treating textile fibres by applying a product thereto characterised in that the product comprises a mixture of the macrocyclic musks consisting of hexadecanolide and cyclopentadecanone and optionally pentadecanolide."

"4. Perfumes which comprise a mixture of at least two of the macrocyclic musks hexadecanolide, cyclopentadecanone and pentadecanolide with other perfume ingredients and which do not contain any polycyclic musks."

"7. Mixtures consisting of hexadecanolide with one or both of cyclopentadecanone and pentadecanolide."

First auxiliary request

Apart from the deletion of Claim 3 and the subsequent renumbering the claims were identical with the claims of the main request of 12 June 2012.

Second auxiliary request

"1. A musk mixture consisting of hexadecanolide with one or both of cyclopentadecanone and pentadecanolide."

"3. A method of treating textile fibres by applying a product thereto characterised in that the product comprises a mixture of the macrocyclic musks consisting of hexadecanolide and cyclopentadecanone and optionally pentadecanolide."

Third auxiliary request

The set of claims was identical with the main request filed with the grounds of appeal.

Fourth auxiliary request

The set of claims was identical with the auxiliary request filed with the grounds of appeal.

V. The main arguments of the **Appellant** were as follows:

Admissibility of the requests filed with letter of 12 June 2012

- The new claims are a restriction to simplify the discussion in the oral proceedings.

- The late submission does not represent an undue burden to the other parties.

Article 123(2),(3) EPC - auxiliary request filed with the grounds of appeal

- Pages 2/3 of the description as originally filed form the basis for the claims.

- Claim 1 of the auxiliary request corresponds to Claim 11 as granted.

Article 56 EPC 1973 - main request and auxiliary request, both filed with the grounds of appeal

- D12 or its combination with either of D25/D26 does not disclose the improved effects of the combination of compounds.

VI. The main arguments of the **Respondents**/Opponents were as follows:

Admissibility of the requests filed with letter of 12 June 2012

- In the grounds of appeal only comments with regard to the product claims, but not with regard to the method claims were given.

- The late filing of the amended sets of claims did not leave the other parties sufficient time for preparation and no facts and evidence with regard to these additional requests were submitted. Therefore, they should not be admitted in the appeal proceedings.

Article 123(2),(3) EPC - auxiliary request filed with the grounds of appeal

- A "musk mixture consisting of" has not been originally disclosed.

- The wording of Claim 1 represents an undisclosed arbitrary selection of three compounds out of four options initially disclosed.

Article 56 EPC 1973 - main request and auxiliary request, both filed with the grounds of appeal

- D12 is the closest state of the art.

- The claimed subject-matter is obvious from D12 alone or from a combination of D12 with either of D25 or D26.

VII. The Appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or the auxiliary request both requests submitted with the grounds of appeal.

The Respondents requested that the appeal be dismissed.

Reasons for the Decision

1. Admissibility of the requests filed with letter of 12 June 2012

1.1 The set of claims filed with the grounds of appeal contained only claims relating to a musk mixture and products containing such a mixture.

With the letter dated 12 June 2012 the Appellant requested to grant the patent on the basis of amended sets of claims, which contained further independent method claims and features taken out of the description

1.2 The content of the appeal was significantly changed by the main request and the first and second auxiliary requests filed three days prior to the oral proceedings and the grounds of appeal did not contain facts and evidence with regard to a method of treating textile fibres and the newly introduced features. The Board consequently exercises its discretion of not admitting the late filed sets of claims.

1.3 Therefore the two sets of claims as filed with the grounds of appeal form the basis of the present decision.

2. Main request

2.1 Article 56 EPC 1973

2.1.1 The patent-in-suit aims at producing musk fragrances possessing improved substantivity, i.e. resistance to being washed or rinsed away.

2.1.2 The Respondents cited D12 as the closest state of the art. The Board also sees this document as a suitable starting point for the problem-and-solution approach.

D12 relates to personal cleansing and/or cosmetic compositions with perfume ingredients, including musk components, which remain substantive after the rinsing and drying steps (page 4, lines 25 to 28).

Table 1 of this document inter alia discloses the macrocyclic musks hexadecanolide, cyclopentadecanone and pentadecanolide individually and recommends in general to use a combination of at least three different perfume ingredients from this table (page 4, last paragraph).

- 2.1.3 The problem of the patent-in-suit vis-à-vis D12 has to be seen in the provision of **musk** compositions with improved substantivity.

Claim 3 of the patent-in-suit differs from D12 essentially in the specific combination of macrocyclic musk compounds.

- 2.1.4 The question to be answered is, whether for the subject-matter of Claim 3 of the main request an improved substantivity over the musk components as disclosed in D12 has been shown.

Examples 1-3 of the patent-in-suit show improved relative odour intensities of mixtures, corresponding to improved substantivity, compared to the individual components, thereby using **cotton** terry towelling pieces and **woollen** cloth.

However, in Example 4 **inferior** results were obtained when testing a cyclopentadecanone/ hexadecanolide mixture on **hair** compared to hexadecanolide.

Thus, for combinations of hexadecanolide with one or both of cyclopentadecanone and pentadecanolide an

improved effect has only been demonstrated with regard to cotton and wool.

- 2.1.5 Claim 3 of the main request relates inter alia to shampoos.

However, since no effect with regard to hair has been proven, the problem underlying the patent-in-suit has to be defined as providing perfume compositions with substantivity, which are alternative to the ones of D12.

It still has to be elucidated whether these alternative compositions possess a different substantivity from the ones according to D12 and whether the skilled person would have expected this.

In the absence of any indication why the specific combination of components according to the patent-in-suit would display a different substantivity than the combination of components according to D12, the Board can only come to the conclusion that a skilled person would have expected such substantivity and thus that at least the shampoos of Claim 3 are obvious over the teaching of D12.

- 2.1.6 Consequently, the main request does not meet the requirement of inventive step.

- 2.2 Rule 80, Article 123(2),(3) EPC; Article 54(1),(2) EPC 1973

Given the fact that Claim 3 of the main request does not meet the requirement of Article 56 EPC 1973, there

is no need for discussion of the remaining objections raised by the Respondents.

3. Auxiliary request

3.1 Article 123(2) EPC

3.1.1 Mixtures (consisting) of hexadecanolide and cyclopentadecanone and/or pentadecanolide have been originally disclosed in Claim 11 and on page 4, lines 6-8.

3.1.2 It is stated on page 3, lines 3-6 of the original application, that preferred musk mixtures "**are** mixtures of hexadecanolide and cyclopentadecanone and optionally pentadecanolide"(emphasis added).

3.1.3 The next paragraph on this page mentions in lines 25/26 that the musk mixtures according to the invention may be blended with many other perfume ingredients. Such a reference would be useless if the composition already comprised further perfume compounds.

3.1.4 Finally, the examples refer to musk mixtures according to the invention **consisting** of 50% hexadecanolide and 50% cyclopentadecanone, and other combinations **consisting** of two/three of the claimed macrocyclic musk compounds, among them a mixture of hexadecanolide and pentadecanolide.

3.1.5 The requirement of Article 123(2) EPC is therefore met for Claims 1 and 2.

3.2 Article 123(3) EPC

3.2.1 Claim 11 as granted refers to mixtures (consisting) of hexadecanolide with one or both of cyclopentadecanone and pentadecanolide. Since all three compounds are well known macrocyclic musks (see paragraph [0006] of the patent-in-suit), the resulting mixture can be referred to as "musk mixture" without extending the protection conferred.

3.2.2 Claims 1 and 2 therefore meet the requirement of Article 123(3) EPC.

3.3 Article 54(1),(2) EPC 1973

The Respondents did not object to novelty of the claims of the auxiliary request. The Board shares this view.

3.4 Article 56 EPC 1973

3.4.1 Claim 1 of the auxiliary request is concerned with mixtures consisting of musk components, for which an improvement over the isolated components has been shown, at least for cotton terry towelling pieces and woollen cloth (see item 2.2.4).

3.4.2 The Board has no doubt that the solution proposed in Claim 1 has been solved over the entire range claimed.

3.4.3 Therefore, in assessing inventive step the question arises whether this improvement would have been expected by a skilled person.

3.4.4 As D12 is silent about the substantivity of mixtures defined in Claim 1 and as also D25 and D26, disclosing that the cited compounds individually possess fixation properties, do not point towards any improved effect of the specific combination of compounds, the Board does not see any reason why a skilled person would have expected such improved substantivity.

3.4.5 Therefore, the mixtures of Claim 1 and thus also the mixtures of Claim 2, are not obvious over the cited prior art.

3.4.6 The auxiliary request is consequently considered to involve an inventive step.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the Opposition Division with the order to maintain the patent on the basis of the auxiliary request submitted with the grounds of appeal and the description to be adapted.

The Registrar

The Chairman

D. Magliano

P.-P. Bracke