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**Datasheet for the decision
of 6 June 2013**

Case Number: T 1517/10 - 3.3.07

Application Number: 05756262.1

Publication Number: 1758547

IPC: A61K 8/00

Language of the proceedings: EN

Title of invention:
COSMETIC MOUSSE FORMULATIONS

Applicant:
L'Oréal

Headword:
-

Relevant legal provisions:
EPC Art. 84, 123(2)

Keyword:
"Claims - clarity (no)"
"Amendments - deletion of features (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 1517/10 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 6 June 2013

Appellant:
(Applicant)

L'Oreal
14, rue Royale
FR-75008 Paris (FR)

Representative:

Lavé, Stéphanie
Cabinet Lavoix
2, Place d'Estienne d'Orves
FR-75441 Paris Cedex 09 (FR)

Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 25 January 2010
refusing European patent application
No. 05756262.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman:

J. Riolo

Members:

D. Semino

M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division announced at the oral proceedings on 4 December 2009 refusing European patent application No. 05 756 262.1.
- II. The decision was based on four sets of claims filed as main request and as first to third auxiliary requests with letter of 4 November 2009 and on two further sets of claims filed as fourth and fifth auxiliary requests during the oral proceedings on 4 December 2009.

Claim 1 according to the main request read as follows:

"1. A cosmetic composition in the form of a mousse which comprises a cosmetic base comprising an anhydrous mixture of:

- (i) at least one first gellable silicone elastomer in an amount from 0.1 to 40% by weight of dry elastomer, based on the weight of the base;
- (ii) at least one second silicone elastomer in an amount from 0.1 to 40% by weight of dry elastomer, based on the weight of the base, where the second silicone elastomer is nonsustainable and nonpilling;
- (iii) at least one nonaqueous solvent in an amount from 20% to 95%, based on the weight of the base; and
- (iv) at least one water insoluble structuring agent in an amount from 0.1 to 20% by weight, based on the weight of the base, where the water insoluble structuring agent is compatible with said solvent and has a melting point of between 45 and 95 °C;

and at least one pigment in an amount up to 60% by weight, based on the weight of the cosmetic composition."

Claim 1 of the first auxiliary request corresponded to claim 1 of the main request with the addition that "said composition has a hardness of from about 10 to 50g, and wherein G'/G'' , measured at a frequency of 100 rad/s ranges from about 1 to about 100". Claim 1 of the second, fourth and fifth auxiliary requests was identical to claim 1 of the main request. Claim 1 of the third auxiliary request was identical to claim 1 of the first auxiliary request.

III. The decision under appeal can be summarised as follows:

- (a) A number of dependent claims of the main request did not meet the requirements of Article 123(2) EPC, because no basis was present in the application as filed for the additional features added by them (the first and second silicone elastomers being non-emulsifying elastomers) in combination with compositions in the form of a mousse. The same objection held for the corresponding claims of the first to third auxiliary requests.
- (b) The terms "gellable", "non-sustainable" and "non-pilling" used in the independent claims of all requests were relative, abstract adjectives which did not aid the skilled worker in the choice of the silicone elastomers. Those terms were not commonly used in the cosmetic field, were not sufficiently limiting to be able to determine

which silicone elastomers would be suitable and which would not and did not help to determine any particular structure of the compounds. This lack of clarity led additionally to a lack of sufficiency, as it would be an undue burden for the skilled person to find out which silicone elastomers fitted those descriptions.

(c) The use of trade marks in some dependent claims of the main, first and fourth auxiliary requests and the excessive use of parameters in the claims of the first and third auxiliary requests resulted in lack of clarity.

IV. The applicant (appellant) filed an appeal against that decision. With the statement setting out the grounds of appeal, the appellant submitted seven sets of claims as main request and first to sixth auxiliary requests, wherein the main request and the first to fifth auxiliary requests corresponded to the requests on which the decision was based.

V. With letter of 25 April 2013 the appellant submitted two sets of claims as sixth and seventh auxiliary requests and renumbered previously filed sixth auxiliary request as eighth auxiliary request.

Claim 1 according to the sixth auxiliary request corresponded to claim 1 of the main request wherein in the definition of the second silicone elastomer it was deleted that it "is nonsustainable and nonpilling" and it was added that it "is in the form of a powder". Claim 1 according to the seventh auxiliary requests corresponded to claim 1 of the sixth auxiliary request

wherein in the definition of the first silicone elastomer it was deleted that it is "gellable" and it was added that it is "chosen from the cross-linked silicone elastomers and blends thereof". Claim 1 according to the eighth auxiliary request (filed as sixth auxiliary request with the statement of grounds) corresponded to claim 1 of the main request with the addition that the first silicone elastomer is "a dimethicone crosspolymer" and the second silicone elastomer is "a dimethicone/vinyldimethicone crosspolymer or a dimethicone/vinyldimethicone crosspolymer coated with silica".

- VI. In a communication sent in preparation of oral proceedings dated 23 May 2013 the Board raised *inter alia* its concerns with regard to the clarity of the terms "nonsustainable" and "nonpilling" and with the lack of a basis in the original application for their deletion.
- VII. Oral proceedings were held on 6 June 2013.
- VIII. As far as relevant to the present decision, the appellant argued essentially that:

Clarity

- (a) The terms "nonsustainable" and "nonpilling" used for the second silicone elastomer were clearly defined in the description by explaining when a gel made out of the polymer could be defined as sustainable and pilling and specifying that, when this was not the case, then the gel was nonsustainable and nonpilling. Those properties of

the second silicone elastomer defined in substance the second elastomer as one unable to form a stable gel in contrast to the first silicone elastomer which was a gellable one. The skilled person would be familiar with such terms and would understand their meaning without the need of any further guidance. On that basis the skilled person would be able to determine which silicone elastomer fell within the group of nonsustainable and nonpilling elastomers and would be suitable for use in the cosmetic composition of the invention. Therefore no lack of clarity could arise from the use of the two terms. In addition in the eighth auxiliary request the second silicone elastomer was limited to two specific compounds which corresponded to two trade marks and indicated two nonsustainable and nonpilling products, so that the two terms were redundant in the claim and no longer limiting.

Amendments

- (b) The deletion of the terms "nonsustainable" and "nonpilling" in the sixth and seventh auxiliary requests and their replacement with the specification that the elastomer "is in the form of a powder" were based on the application as originally filed where on page 3 it was specified that "in an embodiment, the second silicone elastomer is nonsustainable and nonpilling", meaning that the feature was a preferred one and could be deleted, and on page 11 it was indicated that "preferably, the second silicone elastomer is used in the form of a powder".

IX. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request filed with the statement of grounds, or the case be remitted to the first instance for further prosecution on its basis, or alternatively that a patent be granted on the basis on any of the first to eighth auxiliary requests, the first to fifth auxiliary requests having been filed with the statement of grounds, the sixth and seventh auxiliary requests with letter of 25 April 2013 and the eighth auxiliary request corresponding to the sixth auxiliary request filed with the statement of grounds.

Reasons for the Decision

Clarity - main request and first to fifth auxiliary requests

1. Claim 1 of the main request concerns a cosmetic composition comprising a number of ingredients including a second silicone elastomer which is defined as being "nonsustainable and nonpilling".

1.1 These terms are defined in the description in the following way:

"A "sustainable" gel in accordance with the present invention means that one can make a ball or shape out of it and manipulate it manually. It may ooze or spread, but its viscosity is preferably such that it will remain as a cohesive mass. Something that cannot do this is "non-sustainable." Preferred first elastomers may be manipulated manually, such as rolling it in

their hands without it breaking apart or adhering to any significant degree for at least some period of time ("pilling"). Something that cannot do this is "non-pilling"." (page 8, lines 12 to 21).

1.2 First, these definitions refer, as confirmed by the appellant, not to properties of the elastomer as such, but to properties of a gel obtained from the elastomer. As possibly different gels with different properties can be obtained from one elastomer (e.g. by using different solvents in different quantities and with different methods of making a gel), it is not clear for a given elastomer which gel has to be considered in order to define the elastomer as nonsustainable or nonpilling.

1.3 Secondly, all definitions relate to qualitative properties ("can make a ball", "can manipulate", "may ooze or spread", "breaking apart or adhering to any significant degree for at least some period of time") and not to any reproducible testing method, so that they do not allow a clear distinction between what falls under the term and what does not. In reading these qualitative definitions, which seem to relate to similar tests (make a ball or rolling in the hands), the skilled person is not even put in the condition of understanding to what extent the two properties are distinguishable from each other.

1.4 Finally, no evidence is available on file to show that these terms are common in the field of cosmetics, e.g. in the form of a proof that the skilled person could determine from his common general knowledge which

elastomers possess the property of being "nonsustainable" and "nonpilling".

1.5 For these reasons, claim 1 of the main request is not clear and does not meet therefore the requirements of Article 84 EPC.

1.6 As claim 1 according to the first to fifth auxiliary requests includes exactly the same wording as the main request with regard to the second silicone elastomer, it is not clear and does not meet the requirements of Article 84 EPC for the same reasons as given for the main request.

Amendments - sixth and seventh auxiliary requests

2. In claim 1 of the sixth auxiliary request the definition of the second silicone elastomer is amended with respect to claim 1 of the main request in that it is deleted that "is nonsustainable and nonpilling" and it is added that it "is in the form of a powder".

2.1 In the independent claims of the application as originally filed (original claims 1, 15 and 31) the second silicone elastomer is always defined as being "nonsustainable and nonpilling". This is confirmed by the teaching in the description, where the second silicone elastomer is consistently defined as possessing these properties (page 2, lines 14 to 17; page 3, lines 32 to 34; page 5, lines 26 to 28; page 6, line 25 to 27; page 10, line 5 to 7). Actually, in the whole of the disclosure (page 2, lines 9 to 18; page 6, line 15 to 30; page 8, lines 9 to 12; page 10, line 5 to 7) this feature is what consistently distinguishes

- the second silicone elastomer from the first one and renders meaningful the presence of two different elastomers.
- 2.2 The deletion of the specification that the second silicone elastomer is nonsustainable and nonpilling is therefore against the teaching of the whole application and is in contradiction with the presence of two different silicone elastomers in the composition of claim 1.
- 2.3 This conclusion cannot not be changed by the single disclosure in the original application which has been indicated as a basis by the appellant. The disclosure that in "an embodiment, the second silicone elastomer is nonsustainable and nonpilling" (page 3, lines 32 to 34) is in agreement with all the other cited disclosures in the application as originally filed and cannot be understood by the skilled person reading the whole of the application as meaning that in other embodiments this is not the case, because this would be in contradiction with the whole of the disclosure and no embodiment is disclosed in which the second silicone elastomer does not possess these features.
- 2.4 Finally, the fact that the elastomer is in the form of a powder cannot replace the specification that is nonsustainable and nonpilling. As discussed above (see point 1.2), the adjectives "nonsustainable" and "nonpilling" refer to properties of a gel obtained from the elastomer and not of the elastomer as such and the fact that the elastomer is in the form of a powder does imply anything as to the properties of the gel. This is confirmed by the fact that also the first elastomer can

be in the form of a powder (page 9, lines 21 to 24), even if it is generally sustainable and pilling (page 8, lines 9 to 12).

2.5 For these reasons, the deletion of the terms "nonsustainable" and "nonpilling" in claim 1 of the sixth auxiliary request has no basis in the application as originally filed and the sixth auxiliary request does not meet therefore the requirements of Article 123(2) EPC.

2.6 The definition of the second silicone elastomer in claim 1 of the seventh auxiliary request is identical to the one in claim 1 of the sixth auxiliary request. The seventh auxiliary request does not meet therefore the requirements of Article 123(2) EPC for the same reasons as given for the sixth auxiliary request.

Clarity - eighth auxiliary request

3. In claim 1 of the eighth auxiliary request the second silicone elastomer is still defined as in claim 1 of the main request, namely as being "nonsustainable and nonpilling", but in addition it is specified that it is "a dimethicone/vinyldimethicone crosspolymer or a dimethicone/vinyldimethicone crosspolymer coated with silica".

3.1 In the application as originally filed it is indicated that preferred second elastomers are the commercial products DC 9506 and DC 9701, wherein the first is a dimethicone/vinyldimethicone crosspolymer and the second is a dimethicone/vinyldimethicone crosspolymer coated with silica (page 10, lines 28 to 35).

- 3.2 The Board can accept that the indication in the application as originally filed that the second silicone elastomer is nonsustainable and nonpilling and that the two commercial products are preferred second elastomers (page 10, lines 3 to 35) implies that the two specific products are nonsustainable and nonpilling.
- 3.3 However, this specific disclosure cannot be taken as sufficient evidence to show that any dimethicone/vinyldimethicone crosspolymer (coated or not with silica) is nonsustainable and nonpilling.
- 3.4 Claim 1 of the eighth auxiliary request is not limited to the two specific commercial product, but includes any dimethicone/vinyldimethicone crosspolymer with e.g. any average molecular weight, any weight or molar ratio of the two monomers, any percentage of crosslinking and no information is available on file that all the polymers belonging to that class are necessarily nonsustainable and nonpilling. On the contrary, in the application as filed it is said the dimethicone crosspolymers (to which the dimethicone/vinyldimethicone crosspolymers practically correspond in case of a small quantity of vinyldimethicone in the polymer) are examples of suitable first elastomers (page 8, lines 26 to 28), which first elastomer is generally sustainable and pilling (page 8, lines 9 to 12).
- 3.5 In view of this, the terms "nonsustainable" and "nonpilling" are not rendered superfluous by the specification that the elastomer belongs to a class of

polymers and are still limiting for the definition of the second elastomer and of the claimed composition.

- 3.6 As these terms are not clear for the reasons outlined for the main request (see points 1.1 to 1.4, above), claim 1 of the eighth auxiliary request does not meet the requirements of Article 84 EPC.
4. As claim 1 according to all the requests on file either does not meet the requirements of Article 84 EPC or those of Article 123(2) EPC, there is no reason for the Board to examine any other issue and the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

S. Fabiani

J. Riolo