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**Datasheet for the decision
of 8 January 2013**

Case Number: T 0082/11 - 3.3.10

Application Number: 95307524.9

Publication Number: 709083

IPC: A61K 7/48, A61K 7/02,
A61K 7/021, A61K 7/032

Language of the proceedings: EN

Title of invention:
Cosmetic compositions

Patentee:
Revlon Consumer Products Corporation

Opponent:
L'OREAL

Headword:
Cosmetic compositions/REVLON

Relevant legal provisions:
EPC Art. 54, 123(2)

Keyword:
"Late-filed document admitted into the opposition proceedings
by the opposition division - use of the correct principles to
exercise discretionary power (yes) - late-filed document
belongs to the factual frame work of the appeal case"
"Main and auxiliary request 1 - novelty (no)"
"Auxiliary request 2 - amendments (not allowable) - no support
in the application as filed"

Decisions cited:
T 0640/91; T 0341/92

Catchword:
-



Case Number: T 0082/11 - 3.3.10

DECISION
of the Technical Board of Appeal 3.3.10
of 8 January 2013

Appellant: Revlon Consumer Products Corporation
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Representative: Le Coupanec, Pascale A.M.P.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 8 November 2010
revoking European patent No. 709083 pursuant to
Article 101(3) (b) EPC.

Composition of the Board:

Chairman: P. Gryczka
Members: J.-C. Schmid
C. Schmidt

Summary of Facts and Submissions

I. The Appellant (Proprietor of the patent) lodged an appeal against the decision of the Opposition Division revoking European patent No.709083, independent claims 1 and 15 thereof reading as follows:

"1. A cosmetic composition in the form of a water and oil emulsion comprising:

- (a) from 0.1 to 60% by weight of trimethylated silica;
- (b) from 0.1 to 60% by weight of a volatile solvent having a viscosity of from 0.5 to 100 mPa.s at 25°C;
- (c) from 0.1 to 60% by weight of dimethicone and/or dimethicone copolyol; and
- (d) from 0.1 to 80% of a cosmetically acceptable carrier;

wherein the volatile solvent comprises a volatile silicone and

wherein at least a portion of the trimethylated silica and the volatile silicone are present as a pre-blended mixture."

"15. A process for preparing a cosmetic composition in the form of a water and oil emulsion according to any preceding claim, which process comprises bringing

- (a) from 0.1 to 60% by weight of trimethylated silica;
- (b) from 0.1 to 60% by weight of a volatile solvent having a viscosity of from 0.5 to 100 mPa.s at 25°C;

(c) from 0.1 to 60% by weight of dimethicone and/or dimethicone copolyol; into intimate physical admixture with from 0.1 to 80% of a cosmetically acceptable carrier therefor;

wherein the volatile solvent comprises a volatile silicone and
wherein at least a portion of the trimethylated silica and the volatile silicone are present as a pre-blended mixture."

II. The Respondent's (opponent's) notice of opposition requested revocation of the patent in suit in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC). With a letter dated 10 May 2005, the Respondent filed document

(15) Al Disapio and Petrina Fridd "Silicones: use of substantive properties on skin and hair", Int. J. Cosmet. Sci., vol. 10, 1988, pages 75 to 89.

At the oral proceedings held before the Opposition Division on 16 June 2005, the Respondent furthermore requested to revoke the patent-in-suit based on the ground for opposition under Article 100(c) EPC, arguing that the feature in granted claim 1 "at least a portion of the trimethylated silica and the volatile silicone are present as a pre-blended mixture" had no basis in the application as filed, and hence extended the subject-matter of the patent-in-suit beyond the content of the application as filed.

III. In the decision under appeal, the Opposition Division refused to introduce the ground of opposition under

Article 100(c) EPC into the opposition proceedings, since it was late filed and lacked relevance *prima facie*. Document (15) filed with the Respondent's letter dated 10 May 2005 was introduced into the opposition proceedings on account of its *prima facie* relevance for the question of novelty and inventive step. The phase A of the W/O emulsion disclosed on page 79 of this document comprised both trimethoxysiloxysilicate (component (a)) and cyclomethicone (component (b)). According to the Opposition Division' assumption phase A was mixed with the aqueous phase B, and, hence, phase A fulfilled the requirement that at least a portion of the components (a) and (b) are present as a pre-blended mixture as required by the claims. Consequently, the Opposition Division was of the opinion that document (15) anticipated the subject-matter of claims 1 and 15 as granted. The patent was thus revoked for lack of novelty.

- IV. With a letter dated 10 July 2012, the Parties were summoned to oral proceedings to be held before the Board on 8 January 2013. With a letter dated 8 December 2012, the Appellant announced that it would not be represented at the oral proceedings. With a letter dated 10 December 2012, the Respondent announced that it would not be represented during the oral proceedings.
- V. The Appellant requested the Board to exclude document (15) from the appeal proceedings. According to its written submissions, document (15) was not novelty destroying for claim 1 of the patent-in-suit. Even if the components of phase A were combined before being mixed with the components of phase B, this was not the same as the preblending at least a portion of the

trimethylated silica and the volatile silicone being present as a pre-blended mixture required by claim 1. It was evidence from the declaration of Zen Aponte that the preblending was not the same as simply combining the components of the oily phase. Furthermore, the Appellant requested consideration of the auxiliary requests 1 and 2 filed on 17 April 2008.

Claim 1 of auxiliary request 1 was identical to claim 15 as granted. Claim 1 of auxiliary request 2 differed from claim 1 of auxiliary request 1 by the indication of a viscosity range for the dimethicone and/or dimethicone copolyol (component (c), i.e. having a viscosity of 200 to 1,000,000 centipoise at 25°C.

VI. According to the written submission of the Respondent the composition disclosed on page 79 of document (15) anticipated claims 1 and 15 as granted, since this composition incorporated the same resinous silicone as in the preceding example on page 78 and, hence phase A of this composition comprised the pre-blend comprising a dimethicone having a viscosity of 100 cs. Given that 1 cs was 1 cP, this dimethicone was a volatile solvent in the sense of the patent-in-suit. The Respondent furthermore requested to refuse the auxiliary requests 1 and 2.

VII. The Appellant requested in writing that the decision under appeal be set aside and that the grant of the patent be upheld, or the case be remitted to the department of the first instance, or subsidiarily that the patent be maintained on the basis of auxiliary request 1 or 2 filed on 17 April 2008.

The Respondent requested in writing that the appeal be dismissed.

VIII. At the end of the oral proceedings held on 8 January 2013 in the absence of the Parties, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible
2. *Non-appearance at oral proceedings*

According to Article 15(3) of the Rules of Procedure of the Boards of Appeal (RPBA) the Board is not obliged to delay any step in the proceedings, including its decision, by reasons only of the absence at oral proceedings of any party duly summoned who may then be treated as relying only on its written case. In deciding not to attend the oral proceedings, both Appellant and Respondent chose not to avail itself of the opportunity to present their observations and counter-arguments orally but instead to rely solely on their written case. Insofar the Parties are deemed to expect that during the oral proceedings the Board would consider any written submission of the Parties and the admissibility of amendments to claims, here those carried out in claim 1 of auxiliary request 2, which must be examined as a matter of course, in particular the support of those amendments in the application as filed (see T 341/92, OJ 1995, 373).

In the present case the Board had therefore the power and the duty to take a final decision at the oral proceedings on the case before it, notwithstanding the announced absence of the duly summoned Parties.

3. *Request to strike document (15) out from the proceedings*

The Appellant requested document (15) to be struck out for the reason that it was not relevant and therefore the Opposition Division erred in finding that it should be allowed into consideration.

The EPC requires that a notice of opposition must be filed in a written reasoned statement within nine months from the publication of the mention of the grant of the European patent (Article 99(1) EPC) and that this statement has to indicate the extent of opposition, the grounds of opposition and the facts, evidence and arguments in support of these grounds (Rule 76(2)(c) EPC). According to Article 114 (2) EPC, the European Patent Office has discretionary power to consider or else disregard evidence which are not submitted in due time. Therefore, admission of late filed documents by an Opposition Division is not as a matter of principle excluded.

According to the established case law of the Boards of Appeal the discretionary power conferred by Article 114 EPC implies necessarily that the department of first instance of the EPO must have a certain degree of freedom in exercising its power. A Board of Appeal should only overrule the way in which a first instance department has exercised its discretion if the Board

comes to the conclusion that the first instance department has exercised its discretion without taking into account the right principles, or in an unreasonable way (see T 640/91, OJ EPO 1994, 918, point 6.3).

In the present case, the opposition division decided to admit document (15) belatedly filed by the Respondent into the opposition proceedings. The Opposition Division justified its decision by reasoning that this document was *prima facie* relevant to novelty and inventive step, which are the grounds for opposition (see point 3 of the reasons in the decision under appeal).

The Board cannot discover any defects which would indicate that the opposition division has erred in the exercise of its discretion in accordance with Article 114(2) EPC. In particular, the opposition division's decision is based on the relevance criteria, which in the Board's view constitutes an objectively fair and thoroughly elaborated principle for evaluating the admissibility of late-filed documents into opposition proceedings.

Since the introduction of document (15) in the opposition proceedings has not been alleged to be, and indeed was not the result of a procedural violation, the Board concludes that the opposition division has exercised its discretionary power according to the right principles and in a reasonable way so that there is no reason for the Board to overrule its decision. Consequently, document (15) belongs to the factual framework of the case on appeal.

Main request: claims as granted

4. *Novelty*

Document (15) on page 79 discloses a water-in-oil emulsion comprising

- 16% of cyclomethicone and dimethicone copolyol,
- 15,5% of cyclomethicone,
- 5% of dimethicone and trimethylsiloxysilicate, and
- 73% water.

The Appellant did not challenge that this composition comprised all the components of the composition according to claim 1 in the claimed range, but argued that document (15) failed to disclose the feature required by claim 1 that at least a portion of the trimethylated silica and the volatile silicone are present as a pre-blended mixture.

However, according to the patent-in-suit, the volatile solvent generally has low viscosity ranging from 0.5 to 100 centipoise (mPa.s) at 25°C and includes linear polydimethylsiloxanes (dimethicone) (see paragraph [0012] of the patent-in-suit). Thus, as pointed out by the Respondent, a dimethicone (100cs) is a volatile silicone.

The resinous silicone incorporated in the composition disclosed on page 79 of document (15) is disclosed as being the same as in the preceding example, i.e. is, according to the preceding example on page 78, either a pre-blend comprising 33% trimethylsilylsiloxate and 67%

dimethicone (PDMS), 100 cs or a pre-blend comprising 60% trimethylsilylsiloxate and 40% dimethicone, 100 cs, with the consequence that the requirement of claim 1 that at least a portion of the trimethylated silica and the volatile silicone are present as a pre-blended mixture is satisfied for the composition disclosed on page 79 of document (15).

Consequently, the Board comes to the conclusion that the composition disclosed in document (15) anticipates the subject-matter of claim 1. Hence, claim 1 of the main request lacks novelty.

As at least a portion of the trimethylated silica and the volatile silicone are present as a pre-blended mixture in the preparation of the composition of document (15), the appellant's argument based on the declaration of Zen Aponte is not relevant to the issue of novelty and hence must be rejected.

Auxiliary request 1

5. *Novelty*

Claim 1 of auxiliary request 1 differs from claim 1 of the main request only due to the switch of the claim category, i.e. from the composition claimed *per se* to the process for preparing said composition, the sole process feature being bringing component (a), (b) and (c) into intimate physical contact with component (e). This process requirement, however, is inevitably met by the composition comprising the component (a), (b) (c) and (e) disclosed in document (15) and, hence, cannot

provide novelty to the subject-matter of process claim 1.

Accordingly, the subject-matter of claim 1 of auxiliary request 1 also lacks novelty with respect to the disclosure of the composition on page 79 of document (15) (see point 4 above).

Auxiliary request 2

6. *Modification*

Claim 1 of auxiliary request 2 has been amended vis-à-vis claim 1 of the auxiliary request 1 by the indication of a viscosity range for the dimethicone and/or dimethicone copolyol, i.e. having a viscosity of 200 to 1,000,000 centipoise at 25°C.

The Appellant had however filed auxiliary request 2 without indicating the support for this amendment in the application as filed.

The Board has found only one occurrence in the application as filed indicating a viscosity range for the dimethicone and/or dimethicone copolyol, i.e. in the last paragraph of page 8. However the disclosed viscosity range is from 200 to 600,000 centistokes, preferably 350 to 100,000 centistokes at 25°C, which ranges are different from the claimed viscosity range of 200 to 1,000,000 centipoise at 25°C.

Furthermore, the Board has found six occurrences in the application as filed of a viscosity range of 200 to 1,000,000 centipoise at 25°C, i.e. on page 3, line 4,

page 6, lines 16, page 13, line 21, in the line bridging page 15 and 16 and in claims 1, 24 and 25 of the application as filed. However none of these sections of the application as filed concerns the viscosity of dimethicone and/or dimethicone copolyol, let alone concerns a process for preparing a water and oil emulsion wherein at least a portion of the trimethylated silica and the volatile silicone are present as a pre-blended mixture.

Hence, claim 1 amended according to auxiliary request 2 extends beyond the content of the application as filed and, hence, does not fulfil the requirements of Article 123(2) EPC. This request must therefore be refused.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

C. Rodríguez Rodríguez

P. Gryczka