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**Datasheet for the decision
of 14 April 2015**

Case Number: T 0275/11 - 3.3.10
Application Number: 06025294.7
Publication Number: 1803436
IPC: A61K8/37, A61K8/23, A61Q5/08
Language of the proceedings: EN

Title of invention:

Bleaching/highlighting composition for hair

Patent Proprietor:

KPSS-Kao Professional Salon Services GmbH

Opponent:

Henkel AG & Co. KGaA

Headword:

Bleaching composition/ KPSS-Kao

Relevant legal provisions:

EPC Art. 56

Keyword:

all requests - inventive step (no) -
improvement not credible -
reformulation of the technical problem - obvious alternative

Decisions cited:

T 0702/99

Catchword:



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Chambres de recours**

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Case Number: T 0275/11 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 14 April 2015

Appellant: KPSS-Kao Professional Salon Services GmbH
(Patent Proprietor) Pfungstädter Strasse 92-100
64297 Darmstadt (DE)

Respondent: Henkel AG & Co. KGaA
(Opponent) Henkelstrasse 67
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Representative: Henkel AG & Co. KGaA
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 26 November
2010 revoking European patent No. 1803436
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: C. Komenda
C. Schmidt

Summary of Facts and Submissions

I. The Appellant (Patent Proprietor) lodged an appeal against the decision of the Opposition Division which revoked the European patent Nr. 1 803 436.

II. Notice of Opposition had been filed by the Respondent (Opponent) requesting revocation of the patent in its entirety on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC). In the opposition proceedings *inter alia* the following documents were cited:

- (1) JP 2002/302427 (A) in its translation into German according to document (1a) and
- (2) WO 01/47480 (A1).

III. The decision under appeal was based on the claims according to the Main Request and Auxiliary Requests 1 and 2. The wording of independent claim 1 of the Main Request read as follows:

"1. Water free composition for bleaching and/or highlighting keratin fibres especially human hair based on at least one compound with bleaching and/or highlighting effect **characterized in that** it comprises at least one dialkyl carbonate selected from di(caprylyl) carbonate and di(ethylhexyl) carbonate, and a cationic polymer."

Independent claim 1 of Auxiliary Request 1 read as follows:

"1. Water free composition for bleaching and/or highlighting keratin fibres especially human hair based on at least one compound with bleaching and/or

highlighting effect **characterized in that** it comprises at least one dialkyl carbonate selected from di(caprylyl) carbonate and di(ethylhexyl) carbonate at a concentration of 3 to 50% by weight calculated to total composition, and a cationic polymer and the composition is a suspension."

Independent claim 1 of Auxiliary Request 2 read as follows:

"1. Water free composition for bleaching and/or highlighting keratin fibres especially human hair based on at least one compound with bleaching and/or highlighting effect at a concentration of 5 to 85% by weight calculated to total composition **characterized in that** it comprises at least one dialkyl carbonate selected from di(caprylyl) carbonate and di(ethylhexyl) carbonate at a concentration of 10 to 50% by weight calculated to total composition, and a cationic polymer and the composition is a suspension."

IV. In its decision the Opposition Division found that the subject-matter of the claims of all requests was novel over document (2).

With regard to inventive step document (1a) was regarded as representing the closest state of the art. In the absence of fair comparative examples the problem was defined as to provide alternative bleaching compositions. As a solution the patent in suit proposes the compositions according to claim 1, which used specific dialkyl carbonates and a cationic polymer. The skilled person, when looking for alternative bleaching compositions would have also consulted document (2), which discloses compositions for treatment of hair, such as bleaching and/or highlighting compositions (see

claim 7). Document (2) discloses di(n-octyl) carbonate (*alias* di(caprylyl) carbonate) as hair conditioning agent (page 3, examples) and lists cationic polymers as conventional additives for hair treatment compositions (pages 4 and 5, last but one paragraph). The additional technical features incorporated into claim 1 of Auxiliary Requests 1 and 2 were already disclosed in Example 1 of document (1a). Consequently, the negative findings in view of inventive step remained the same for the Main Request and for both Auxiliary Requests.

Further, Auxiliary Request 2 was found not to comply with the requirements of Article 123(2) EPC, since the combination of features would not have a basis in the application as originally filed.

- V. With its statement of the grounds for appeal the Appellant defended the patent in suit on the basis of the same requests on which the decision under appeal was based. The Appellant stated that starting from document (1a) as closest state of the art the subject-matter of claim 1 of the Main Request involved an inventive step. As demonstrated with a further comparative Example described in the Appellant's submission the claimed compositions provided improved bleaching and conditioning effects on hair. From the prior art the skilled person had no incentive to use the claimed dialkyl carbonates and a cationic polymer in order to achieve these improvements. Further, document (2) did not refer to bleaching compositions, but only to hair conditioning compositions and would, therefore, not be considered by a skilled person when looking for improving the bleaching and conditioning effects on hair of hair bleaching and/or highlighting compositions.

VI. In its reply the Respondent objected to the admissibility of the appeal, since the Appellant had not addressed all ground for revocation. During the oral proceedings held before the Board on 14 April 2015 the Respondent explicitly withdrew its objection concerning the non-admissibility of the appeal. However, the Auxiliary Request 2 should not be admitted into the appeal proceedings, since in the decision under appeal it was found not to comply with the requirements of Article 123(2) EPC and the Appellant had not provided any arguments in this respect.

With regard to inventive step the Respondent brought forward that the comparative Example referred to in the statement of grounds was not suitable to demonstrate any improvement over the closest prior art document (1a). The Appellant did not provide any information on the qualification of the persons who evaluated the test results. The evaluation of the Appellant, which merely specified that the properties were "very much improved", "much better" and "excellently" cannot be verified and have to be disregarded. The objective problem to be solved could only be seen in providing alternative bleaching and/or highlighting compositions. The solution as proposed by the patent in suit was, however, known already from document (2).

VII. The Appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the Main Request or, as an auxiliary measure, on the basis of either Auxiliary Requests 1 or 2, all requests submitted with letter dated 5 April 2011.

The Respondent requested that the appeal be dismissed.

VIII. Oral proceedings were held in the absence of the Appellant, who, after having been duly summoned, informed the Board with a letter dated 9 March 2015 that it would not attend. At the end of the oral proceedings the decision was announced.

Reasons for the Decision

1. The appeal is admissible.

Main Request

2. Novelty has not been objected to during the appeal proceedings. Thus, the only issue to be dealt with is the question of inventive step.

3. *Inventive step (Article 56 EPC)*

3.1 The subject-matter of claim 1 relates to a bleaching and/or highlighting composition for keratin fibres, which effects mild bleaching and good conditioning on hair. A similar composition is disclosed in document (1a), which was accepted as representing the closest state of the art by the Opposition Division and by both parties to the appeal proceedings.

3.2 Document (1a) discloses bleaching compositions for keratin fibres, which effect mild bleaching and provide good conditioning of the treated hair. In the specific embodiment disclosed in Example 1 a water free bleaching cream is prepared, which comprised *inter alia* 10% by weight of a di(alkyl) carbonate(12,14), 35% by weight of potassium persulfate as bleaching compound and hydroxyethylcellulose as polymer. The cream was in the form of a water free suspension. According to the

written statements the parties agreed on this teaching of document (1a). This was not disputed by the parties.

- 3.3 According to the Appellant the problem to be solved starting from document (1a) consisted in providing a bleaching composition with improved bleaching and conditioning effects on hair.
- 3.4 As a solution to this problem the patent in suit proposes the compositions according to claim 1, wherein di(ethylhexyl) carbonate or di(caprylyl) carbonate were used as di(alkyl) carbonates and a cationic polymer is present.
- 3.5 In order to demonstrate that the problem as stated in paragraph 3.3 *supra* has been successfully solved the Appellant referred to two comparative Examples:
- 3.5.1 The Appellant argued that the comparative Example referred to in the patent specification in paragraph [0072] showed that the composition according to the invention provides improved bleaching and conditioning effects.

However, the comparative Example of paragraph [0072] does not use any di(alkyl) carbonate and, thus, does not represent a fair comparison with the closest state of the art. Any effects that could be derived from this comparative Example cannot, therefore, support the success of the proposed solution.

- 3.5.2 In its statement of grounds for appeal the Appellant referred to a further comparative Example, which was based on Example 1 of document (1a). In order to modify this composition to mimic a composition according to the claims of the patent in suit the di(alkyl)

carbonate(12,14) of the prior art composition has been replaced by an equal amount of di(ethylhexyl) carbonate and 0.5% by weight of the hydroxyethylcellulose polymer has been replaced by 0.5% by weight of Polyquaternium-10 as a cationic polymer. The comparison was done according to the procedure indicated in the patent in suit, paragraph [0073], using ten volunteers. In view of the results obtained the Appellant stated that in 60% of the cases a "slightly lighter" bleaching effect was obtained with the composition according to the invention. In 80% of the cases the hair treated with the claimed composition "showed a much better combability, hair had very much improved elasticity and hair felt excellently natural and in the remaining 20% of the cases the aforementioned differences were present but at a lower level". Further, it was observed that none of the cases of hair bleached with the composition of document (1a) was found to have improved properties compared to hair treated with the composition according to the present invention.

However, the properties of the treated hair as regards the bleaching were obtained by inspection by eye and conditioning effects and were apparently determined by touching or combing the treated hair. Since this kind of evaluation represents inherently subjective evidence the comparison has to be made under conditions that ensure maximum objectivity on the part of the persons conducting the tests. It is, therefore, desirable to show that the tests have been carried out under "blind" conditions to avoid any suspicion of bias. Further, the testers should indicate the results of their inspection in a detailed manner - either by a detailed report or according to a suitable scoring system - in order to allow the Board and the other parties to evaluate the

different opinions objectively (see T702/99, points 2. to 4. of the Reasons).

In the present case the Appellant has not given any information on the identity of the persons evaluating the quality of the treated hair, nor their relationship to the Appellant. No indication was given on the conditions under which these tests were run. Further, in its statement of grounds of appeal the Appellant only gave a summary of the test results, which can assist the Board in its evaluation of the experimental evidence, but which cannot substitute for the detailed information on the individual test results presented either in terms of written statements of each testing person or in terms of tables containing the individual scores given by these testers. Therefore, the Respondent and the Board did not have the information to objectively assess and evaluate the experimental evidence referred to by the Appellant.

In the absence of any information on how this comparative test has been executed and in the absence of the individual test results, any effects referred to by the Appellant have to be disregarded.

3.5.3 Since none of the two comparative tests referred to by the Appellant can support the alleged improvements over the closest prior art, the technical problem as stated in paragraph 3.3 *supra* above is regarded as having not been successfully solved.

3.6 As a consequence, the technical problem as stated in paragraph 3.3 *supra* has to be reformulated as to provide an alternative bleaching and/or highlighting composition.

3.7 In order to provide an alternative the skilled person would turn to document (2). This document relates to hair conditioning compositions which are also used for bleaching compositions (claim 7). He knew from this document that cationic polymers and di(alkyl) carbonates, such as di(octyl) carbonate (identical to di(caprylyl) carbonate) are suitable additives to provide hair with improved conditioning effects (see claim 6; page 5, lines 21 to 28; page 3, lines 25 to 29) in compositions for hair treatment, including hair bleaching compositions. The skilled person would thus have arrived at the subject-matter of claim 1 without having to exercise any inventive skill.

The Appellant brought forward that the skilled person when looking for an alternative bleaching and/or highlighting composition would not have considered document (2), since this document does not refer to water free compositions and does only relate to the problem of hair conditioning.

However, document (2) does not only refer to water containing compositions, but explicitly states that the compositions may also be in the form of water free oils, gels, aerosols or sticks (see page 2, lines 22 to 25). Further, the document clearly states that these compositions may be used in bleaching compositions (see claim 6). The fact that one focus of document (2) is the conditioning effect provided by the hair treatment compositions is not sufficient to deter the skilled person from considering its teaching, in particular, since the patent in suit itself aims *inter alia* at providing improved conditioning effects to the hair. Therefore, this argument of the Appellant cannot succeed.

- 3.8 Therefore, the Board concludes that the subject-matter of claim 1 according to the Main Request does not involve an inventive step in the sense of Article 56 EPC.

Auxiliary Requests 1 and 2

4. Claim 1 of Auxiliary Request 1 is based on the wording of claim 1 of the Main Request, which has been further restricted by limiting the concentration of the dialkyl carbonate to from 3 to 50% by weight calculated to total composition and the composition to being in the form of a suspension.

Claim 1 of Auxiliary Request 2 is based on the wording of claim 1 of Auxiliary Request 1, wherein the concentration of the dialkyl carbonate has been further restricted to from 10 to 50% by weight and in addition thereto the concentration of the compound with bleaching and/or highlighting effect has been limited to from 5 to 85% by weight, all concentrations as calculated to total composition.

5. The Appellant objected to the amendments made to claim 1 of Auxiliary Request 2 as not to comply with the requirement of Article 123(2) EPC. In view of the negative conclusions with respect to inventive step of the claimed composition (see paragraph 6 below), a decision of the Board on the issue of Article 123(2) EPC is not necessary.

6. *Inventive step (Article 56 EPC)*

- 6.1 The restrictions made to the subject-matter of claim 1 according to the Auxiliary Request 1 and 2 relate all to technical features that were already disclosed in

Example 1 of document (1a) (see paragraph 3.2 *supra*), which was not contested by the parties.

6.2 Therefore, the assessment of inventive step for claim 1 of the Main Request, as well as the conclusions drawn apply equally to the subject-matter of claim 1 of the Auxiliary Requests 1 and 2. These requests, therefore, share the same fate as the Main Request in that the claimed subject-matter of these requests is also regarded as not to involve an inventive step in the sense of Article 56 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated