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**Datasheet for the decision  
of 2 December 2014**

**Case Number:** T 2610/11 - 3.3.10

**Application Number:** 00903970.2

**Publication Number:** 1153601

**IPC:** A61Q19/08, A61K8/37, A61K8/34,  
A61K9/133, A61K31/07,  
A61K31/23, A61P17/00, A61P17/16

**Language of the proceedings:** EN

**Title of invention:**  
SKIN PREPARATIONS FOR EXTERNAL USE

**Patent Proprietor:**  
KABUSHIKI KAISHA YAKULT HONSHA

**Opponent:**  
Henkel AG & Co. KGaA

**Headword:**

**Relevant legal provisions:**  
EPC Art. 100(a), 56

**Keyword:**  
Inventive step - (no)

**Decisions cited:**  
T 0020/81

**Catchword:**



**Beschwerdekammern  
Boards of Appeal  
Chambres de recours**

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Case Number: T 2610/11 - 3.3.10

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.10**  
**of 2 December 2014**

**Appellant:** Henkel AG & Co. KGaA  
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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 October 2011  
rejecting the opposition filed against European  
patent No. 1153601 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

**Chairman** P. Gryczka  
**Members:** R. Pérez Carlón  
C. Schmidt

## Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the opposition division to reject the opposition against European patent No. 1 153 601.
- II. Notice of opposition had been filed on the grounds that the invention was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC) and that the subject-matter of the claims of the patent as granted was not novel and did not involve an inventive step (Article 100(a) EPC).
- III. The documents forming part of the opposition proceedings included the following:

D10: WO 98/14167

D16: Experimentelle Untersuchungen mit Mono-di-glycerid-Dispersionen zum Problem der Kaltemulgierung. G. Schuster und H. Lindner. Vortrag anlässlich des 3. Symposiums der Gesellschaft für Kosmetologie e.V. über "Technologie der Kosmetika" in Bad Pyrmont, 5 April 1975.

- IV. Claim 1 of the patent as granted, which is the sole request in these appeal proceedings, reads as follows:

*"A skin preparation for external use, comprising*

- (a) vitamin A or a derivative thereof,*
- (b) 5 to 50 parts by weight of the fatty acid monoglyceride per part by weight of the vitamin A or a derivative thereof, and*

*(c) 0.05 to 0.40 parts by weight of cholesterol per part by weight of the fatty acid monoglyceride,*

*said skin preparation comprising a lamellar structure containing a fatty acid monoglyceride as a main component."*

- V. The opposition division considered that document D10 was the closest prior art. Examples 1 and 3-11 disclosed skin care compositions that did not contain any fatty acid monoglyceride. The problem underlying the claimed invention was providing a retinoid-containing cosmetic composition which exhibited high stability to storage, reduced foaming and no offensive smell. There was no hint in the prior art at the claimed solution, namely compositions containing fatty acid monoglycerides in a specific relative amount with respect to vitamin A, with the consequence that the subject-matter of claim 1 was inventive.
- VI. The arguments of the appellant relevant for the present decision were the following:

Document D10 was the closest prior art. The problem of providing compositions with lower foaming, reduced smell and higher stability of the lamellar structure was not credibly solved in the light of the data on file.

If the problem was formulated only as providing an alternative skin preparation for external use having, like that of the prior art, excellent stability, reduced smell, a dry feel and good effect on wrinkles, the claimed solution was obvious since the skilled person would combine the teaching of document D10 and that of document D16, which disclosed that fatty acid

monoglycerides formed lamellar structures in water, with the consequence that the subject-matter of claim 1 was not inventive.

VII. The arguments of the respondent (patent proprietor) relevant for the present decision were the following:

Comparative Example 2 of document D10 was the closest prior art. This example did not disclose the relative amount of cholesterol to fatty acid monoglyceride required by claim 1, or a lamellar structure, or a lamellar structure containing a fatty acid monoglyceride as a main component.

The problem underlying the claimed invention was that of providing compositions with lower foaming, reduced smell and higher stability of the lamellar structure, and this problem was solved in the light of the data in tables 3, 4 and 5 of the patent in suit.

If, nevertheless, the problem needed to be reformulated in a less ambitious manner, it should be seen as providing an alternative skin preparation for external use having, like that of the prior art, excellent stability, reduced smell, a dry feel and a good effect on wrinkles.

The claimed solution, which was a skin preparation for external use characterised in that it comprised a lamellar structure containing a fatty acid monoglyceride as a main component, and a defined relative amount of cholesterol with respect to fatty acid monoglyceride of 0.05 to 0.40 parts per weight, was not obvious since the skilled person had no incentive to modify the closest prior art, which was a comparative example, let alone by changing the amount

of fatty acid monoglyceride. Further, document D16 did not belong to the technical field of cosmetic compositions. It was a presentation of research work which disclosed only the opinion of its authors and not a generally acceptable teaching that the skilled person would have combined with the teaching of D10.

The respondent concluded that, in the light of D10, the skilled person would, at most, add an antioxidant to the composition of comparative Example 2, which would not lead to the claimed solution. The claimed composition therefore implied an inventive step.

VIII. Oral proceedings before the board of appeal took place on 2 December 2014.

IX. The final requests of the parties were the following:

- The appellant requested that the decision under appeal be set aside and that European patent No. 1 153 601 be revoked.
- The respondent requested that the appeal be dismissed.

X. At the end of the oral proceedings, the decision was announced.

### **Reasons for the Decision**

1. The appeal is admissible.

Inventive step:

2. Claim 1 is directed to a skin preparation for external use containing vitamin A or a derivative thereof, a

fatty acid monoglyceride and cholesterol in specific relative amounts. The skin preparation of claim 1 comprises a lamellar structure containing a fatty acid monoglyceride as a main component.

3. Closest prior art:

- 3.1 The respondent (patent proprietor) considered that Example 2 of document D10, which is a comparative example, represented the closest prior art. Although this finding was disputed, the board will examine whether an inventive step can be acknowledged starting from this embodiment of D10.

Document D10 relates to skin care compositions containing retinoids, which are free of irritating side effects, efficacious and cosmetically elegant and do not necessitate special ingredients or manufacturing, storage or handling precautions (page 9, lines 1 to 13).

Example 2 of document D10 discloses a skin care composition comprising a water phase and an oil phase. The oil phase contains 0.787% by weight of glyceryl monostearate, 1.977% by weight of cholesterol and 0.165% by weight of a 40% w/w mixture of vitamin A in polysorbate 20.

- 3.2 It has not been disputed that this composition contains vitamin A as required by feature (a) of claim 1, a fatty acid monoglyceride and cholesterol, which are the sole three compounds required by claim 1.

It has also not been disputed that the amount of glyceryl monostearate is 11 parts per weight per part by weight of vitamin A and hence within the limits

defined by feature (b) of claim 1.

3.3 The respondent argued that document D10 contemplated compositions containing liposomes, which are lamellar structures, but also compositions in the form of emulsions (page 1, lines 7-11). Example 2 was silent as to whether it was an emulsion or a liposome composition. In the absence of this information, the respondent considered that the presence of a lamellar structure, as required by claim 1, was a further distinguishing feature of claim 1 vis-à-vis the prior art.

However, Example 2 *"was made in accordance with the procedure set forth in Example 1"* (page 21, lines 9-10).

Example 1 discloses forming an oil phase by blending a part of the oil ingredients, heating to 80°C with agitation, gradually cooling down to 65°C and adding the rest of the constituents of the oil phase (page 18, line 20, to page 19, line 8). This oil phase is mixed together with the water phase at 60°C *"in accordance with the procedure set forth in U.S. Patent No. 4,911,928 (Wallach) for making liposomes"* (page 19, lines 15-21).

In addition, said procedure of Example 1 of D10 is comparable to the preferred method for obtaining the claimed compositions in paragraphs [11], [22] and [23] of the patent in suit.

The board thus concludes that the composition of Example 2 in document D10 comprises a lamellar structure as required by claim 1 of the patent in suit.



However, in favour of the respondent, it is considered that Example 2 of document D10 fails to disclose that this lamellar structure contains a fatty acid monoglyceride as a main component, which is also required by claim 1.

3.4 Lastly, it has not been disputed that Example 2 of D10 discloses a relative amount of 2.5 parts by weight of cholesterol per part by weight of glyceryl monostearate, which does not fall within the limits required by feature (c) of claim 1 defining a relative amount of 0.05 to 0.4 parts by weight.

4. Technical problem underlying the invention:

The respondent argued during the written procedure that the problem underlying the claimed invention was providing compositions with lower foaming, reduced smell and a lamellar structure with higher stability.

5. Solution:

The claimed solution is a skin preparation for external use which is characterised in that its lamellar structure contains a fatty acid monoglyceride as a main component, and in that the relative amount of cholesterol with respect to fatty acid monoglyceride is from 0.05 to 0.40 parts per weight.

6. Success:

6.1 The patent in suit provides experimental evidence, summarised in tables 3 and 4, showing that the stability of the claimed composition and its foaming capacity are influenced by the relative amount of fatty acid monoglyceride with respect to vitamin A, which is

not, however, a feature distinguishing the claimed composition from that of Example 2 of D10.

6.2 Table 5 of the patent specification, referring to the level of smell, compares a composition according to the invention with a composition containing soya lecithin. This data likewise does not reflect the features distinguishing the invention from the closest prior art.

6.3 The data of tables 3-5 of the patent specification, the sole evidence upon which the respondent has relied, does not allow a direct comparison with the closest prior art D10 since they do not differ from one another solely by virtue of the distinguishing feature of the claimed invention. It is thus not credible that the problem as defined above in point 4. is solved by the skin preparation of claim 1.

7. Reformulation of the technical problem:

According to the case law of the boards of appeal, alleged but unsupported advantages cannot be taken into consideration in determining the problem underlying the claimed invention (see e.g. decision T 20/81, OJ EPO 1982, 217, Reasons 3, last paragraph). As the alleged improvement in terms of lower foaming, reduced smell and higher stability lacks the required support, the technical problem as defined above needs reformulation.

Thus, the problem underlying the claimed invention can only be considered as providing an alternative skin preparation for external use having, like that of the prior art, excellent stability, reduced smell, a dry feel, and a good effect on wrinkles.

8. Success:

In view of the evidence summarised in tables 3, 4 and 5 of the patent in suit, which shows that the claimed compositions have a good stability, have no offensive smell and are effective against wrinkles, the problem defined above can be regarded as credibly solved by the skin preparations of claim 1.

9. Lastly, it remains to be decided whether or not the proposed solution to the objective problem underlying the patent in suit is obvious in view of the prior art:

9.1 Example 2 of D10 discloses a composition comprising liposomes containing glyceryl monostearate.

D10 teaches that irritating compounds should be avoided (claim 1 and page 17, line 28, to page 18, line 5), that liposomes are beneficial for reducing the oxidation of vitamin A (page 11, lines 13-15) and for dry feel (compositions are less greasy, page 11, lines 20-21), and that the wrinkle-suppressing effect is due to the presence of vitamin A (see background of the invention).

Trying to obtain a composition with the advantages of that of document D10, the skilled person would not modify those features which D10 considers essential, namely the presence of liposomes and of vitamin A and the absence of irritating compounds.

9.2 According to D10, fatty acid monoglycerides are suitable cosmetic components (D10, page 16, lines 3 and 4). It is further known that glyceryl monostearate, which is a fatty acid monoglyceride, forms lamellar structures in water (D16, section 2.2), which are in

the form of a lamellar gel at room temperature (Figure 2 and page 5, right-hand column, lines 25-27) and are suitable for preparing cosmetic creams (section 4).

Trying to obtain alternative compositions with the advantages of that of document D10, the skilled person would envisage increasing the amount of glyceryl monostearate, which is a component capable of forming lamellar structures in water suitable for cosmetic use, and would thus arrive at the claimed invention, namely skin preparations comprising a lamellar structure in which said monoglyceride is a main component, without using inventive skills.

By increasing the amount of fatty acid monoglyceride so that it becomes a main component of the lamellar phase, the amount of cholesterol relative to fatty acid monoglyceride, which was 2.5 parts per weight in Example 2 of D10, and hence higher than required by feature (c) of claim 1 (0.05 to 0.40 parts per weight), would necessarily decrease. The respondent has not relied on any effect due to the amount of cholesterol relative to fatty acid monoglyceride, nor can the board identify any such effect. As the choice of the specific relative amount is an arbitrary selection of no particular technical significance in the absence of any effect linked to it, it is concluded that it falls within the normal skills of the person of the art.

For these reasons, the subject-matter of claim 1 is not inventive as required by Article 56 EPC.

- 9.3 The respondent argued that starting from comparative Example 2 the skilled person, following the teaching of D10, would merely add an antioxidant and thus would not arrive at the claimed invention.

Notwithstanding that the presence of an antioxidant is not excluded from claim 1 of the patent in suit, Example 2 of D10 already contains 0.100% by weight of BHT, which is one of the preferred antioxidants according to D10 (page 14, line 2).

This argument of the respondent is thus unconvincing.

- 9.4 The respondent also argued that the skilled person would not have any incentive to modify Example 2 at all, since it was a comparative example with a very high irritation score.

However, the authors of document D10 already considered modifying this example, and there is no reason why the skilled person would not aim at modifying it again. For that reason this argument of the respondent is also unconvincing.

- 9.5 The respondent further argued that document D16 related to binary mixtures of fatty acid monoglyceride and water and not to cosmetic compositions. It was a presentation of research work which disclosed only the opinion of its authors and not a generally acceptable teaching. The respondent thus concluded that D16 would not have been regarded as a pointer to the claimed solution by the person of the art.

However, section 2 of document D16, "Physic-chemical properties of the fatty acids mono-di-glycerides", discloses the formation of lamellar structures prior to section 3, labelled "Own experiments". Thus, it was already generally known before the publication of D16 that glyceryl monoestearate forms stable lamellar structures, and in any case this teaching became state

of the art with its publication. Thus, the argument of the respondent that it was not a generally acceptable teaching that fatty acid monoglycerides formed lamellar phases does not hold.

Document D16 also discloses the preparation of cosmetic creams containing fatty acid monoglyceride as a major component (section 4), so that the respondent's argument that D16 belonged to a different technical field and for this reason could not be considered as a pointer to the claimed solution is also unconvincing.

9.6 The board thus concludes that the subject-matter of claim 1 as granted is not inventive within the meaning of Article 56 EPC.

10. In the light of the outcome of the examination of inventive step, it is not necessary to discuss either whether the subject-matter of claim 1 is novel over documents D6 or D8 or the admissibility of the appellant's argument, first raised during these appeal proceedings, that it lacked novelty over the latter.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated