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**Datasheet for the decision
of 26 April 2016**

Case Number: T 1075/12 - 3.3.10

Application Number: 03020454.9

Publication Number: 1407756

IPC: A61K8/49, A61Q5/10

Language of the proceedings: EN

Title of invention:

Hair dye composition comprising methine dye

Patent Proprietor:

KAO CORPORATION
FUJIFILM Corporation

Opponent:

HENKEL AG & CO. KGAA

Headword:

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - allowable (yes): restriction of a generic chemical formula - no singling out of a particular combination of features not originally disclosed

Decisions cited:

T 0859/94, T 0615/95, T 0050/97, T 0801/02

Catchword:



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Case Number: T 1075/12 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 26 April 2016

Appellant: HENKEL AG & CO. KGAA
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Respondent: KAO CORPORATION
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Respondent: FUJIFILM Corporation
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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
15 March 2012 concerning maintenance of the
European Patent No. 1407756 in amended form.

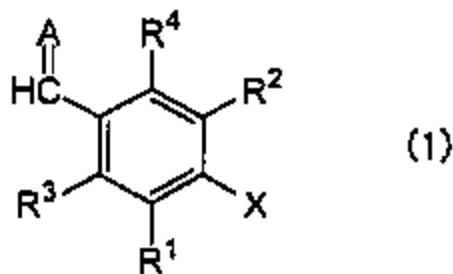
Composition of the Board:

Chairman	P. Gryczka
Members:	J. Mercey
	C. Schmidt

Summary of Facts and Submissions

I. The Appellant (Opponent) lodged an appeal against the interlocutory decision of the Opposition Division which found that European patent No. 1 407 756 in amended form met the requirements of the EPC. Claim 1 of the auxiliary request maintained by the Opposition Division reads as follows:

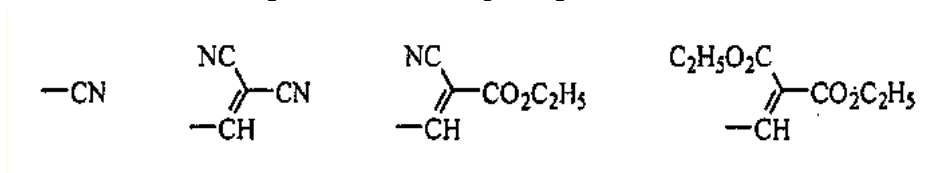
"A hair dye composition comprising a dissociative direct dye represented by the following formula (1):

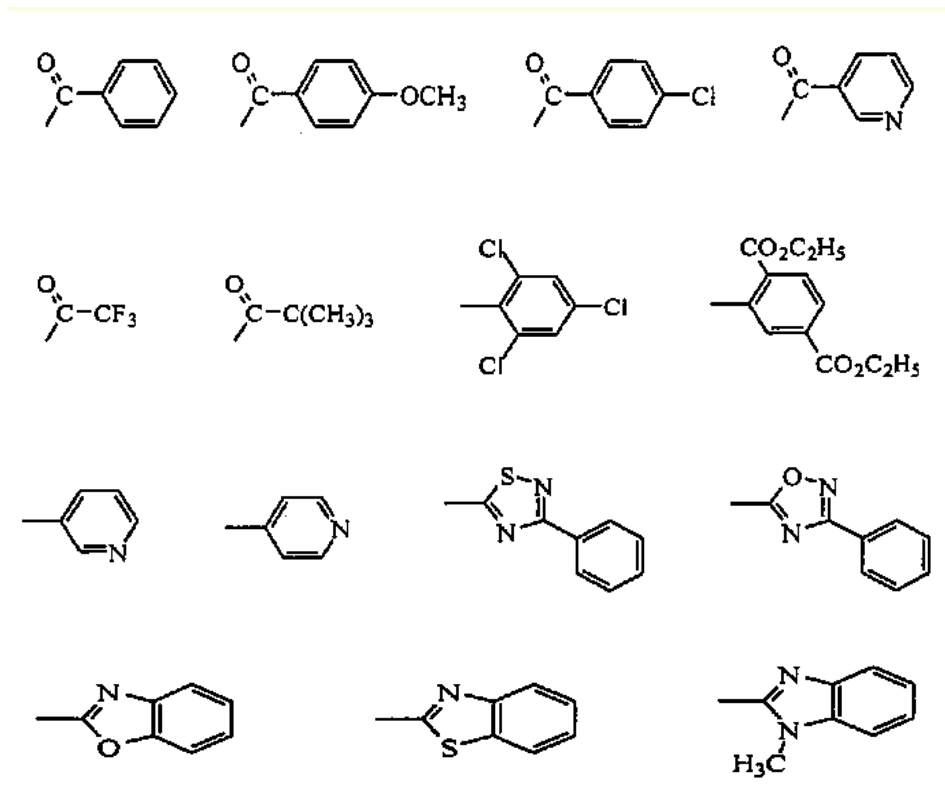


wherein, R¹, R², R³ and R⁴ each independently represents a hydrogen atom or a substituent, and X represents a hydroxyl group or -NHSO₂R⁵, in which R⁵ represents an alkyl, aryl or heterocyclic group; and A represents a divalent group capable of forming a methine dye as a whole compound together with the portion other than A and is represented by the formula (Cp-1):



wherein R¹¹ represents a group selected from





wherein * is a position bonding to the benzylidene group in formula (1),
 wherein the above substituents are selected from halogen atoms, alkyl groups, alkenyl groups, alkynyl groups, aryl groups, heterocyclic groups, a cyano group, a hydroxy group, a nitro group, a carboxyl group, alkoxy groups, aryloxy groups, silyloxy groups, heterocyclic oxy groups, acyloxy groups, carbamoyloxy groups, alkoxy carbonyloxy groups, aryloxy carbonyloxy groups, amino group, alkylamino groups, arylamino groups, heterocyclic amino groups, acylamino groups, ureido groups, alkoxy carbonylamino groups, aryloxy carbonylamino groups, sulfamoylamino groups, alkylsulfonylamino groups, arylsulfonylamino groups, mercapto group, alkylthio groups, arylthio groups, heterocyclic thio groups, sulfamoyl groups, sulfo group, alkylsulfinyl groups, arylsulfinyl groups, alkylsulfonyl groups, arylsulfonyl groups, acyl groups, alkoxy carbonyl groups, aryloxy carbonyl groups,

carbamoyl groups, arylazo groups, heterocyclic azo groups, phosphino groups, phosphinyl groups, phosphinyloxy groups, phosphinylamino groups and silyl groups, and wherein the hair dye has a pH-value in the range of 8-11".

- II. Notice of Opposition had been filed by the Appellant requesting revocation of the patent as granted in its entirety on the grounds of lack of inventive step (Article 100(a) EPC) and for containing subject-matter extending beyond the content of the application as filed (Article 100(c) EPC).

- III. The Opposition Division found that the subject-matter of claims 1 to 4 of the then pending auxiliary request satisfied the requirements of Article 123(2) EPC, since the restrictions made to the definitions of the groups R^1 to R^5 and A in the dissociative direct dye of formula (1) did not result in the singling out of specific previously undisclosed structural embodiments, and the definition of the pH range of 8 to 11 was disclosed as a generally applicable feature in the application as filed. The Opposition Division also found the subject-matter of these claims to be inventive.

- IV. The Appellant submitted that the arbitrary restrictions made to the definitions of the groups R^1 to R^5 , A and R^{11} in the dye of formula (1) and to the pH of the hair dye composition comprising said dye according to claim 1 of the auxiliary request *vis-à-vis* originally filed claim 1 resulted in specific combinations of features that were not originally disclosed, and cited decisions T 859/04 and T 801/02 (both not published in OJ EPO) in this respect. The amendments, thus, did not comply with

Article 123(2) EPC. The Appellant did not contest the findings of the Opposition Division with regard to the inventiveness of the claimed subject-matter.

- V. The Respondent (Patent proprietor) essentially agreed with the findings of the Opposition Division. It submitted that in the dissociative direct dye of formula (1) of claim 1 of the auxiliary request, the definitions of the substituents R^1 to R^4 had been restricted to the complete list of possibilities given as examples for these substituents in the application as filed; with regard to R^5 , only the optional feature of the original definition that the alkyl, aryl or heterocyclic group might be further substituted had been deleted from the definition in original claim 1; A was restricted to (Cp-1), wherein the definition of R^{11} within the group (Cp-1) had been defined as the complete list of particularly preferred groups for this substituent given in the application as filed; and the pH-value of 8 to 11 was described as a particularly preferred pH range for the hair dye compositions and clearly applied to all hair dye compositions disclosed in the application as filed. Thus, the amendments did not comply with Article 123(2) EPC.

- VI. The Appellant requested that the decision under appeal be set aside and the patent be revoked. It further withdrew its request for oral proceedings set for 28 April 2016. These oral proceedings were duly cancelled.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments (Article 123(2) EPC)*
 - 2.1 The Appellant submitted that the amendments made to claim 1 *vis-à-vis* claim 1 as originally filed resulted in subject-matter extending beyond the content of the application as filed (see point IV above).
 - 2.2 The amendments made to claim 1 *vis-à-vis* claim 1 as originally filed consist of the restriction of the definitions of R^1 to R^4 in the dissociative direct dye of formula (1) from representing "hydrogen or a substituent" to representing hydrogen and a list of specific substituents (as recited in claim 1 in point I above); the definition of R^5 from representing an alkyl, aryl or heterocyclic group which could have one or more substituents to representing an alkyl, aryl or heterocyclic group only; A from being any divalent group capable of forming a methine dye as a whole compound together with the portion other than A, to being (Cp-1), wherein R^{11} in the group (Cp-1) is defined as being a list of specific groups; and of the restriction of the pH-value of the hair dye composition comprising said dye, from not being defined at all in original claim 1, to a pH of from 8 to 11.
 - 2.3 Basis for each of these restrictions may be found in the application as originally filed on page 3, line 19 to page 4, line 13 for the list of substituents for R^1 to R^4 ; in claim 1 by deletion of the proviso that the defined groups may be optionally substituted for the definition of R^5 ; in claim 2 for A being (Cp-1), and on page 18, lines 4 to 5 for the groups R^{11} within the

formula (Cp-1); and page 33, lines 10 to 11 for the pH-value of 8 to 11 of the hair dye composition.

2.4 The above facts were not disputed by the Appellant, but rather that these various restrictions resulted in specific combinations of features that were not originally disclosed.

2.5 However, the groups R^1 to R^4 , and R^{11} , respectively, have been restricted to (complete) lists of examples for these substituents, such that no particular combination of specific definitions has been hereby generated. The deletion of the optional substitution of the substituent R^5 is equivalent to the shrinking of a list, the remaining list still being generic. The restriction of A to the group of formula (Cp-1) is allowable, as the remaining substituents R^1 to R^5 and R^{11} in the dye of formula (1) of claim 1 are still defined as generic lists of alternative groups, such that this limitation does not result in the singling out of a particular combination of specific meanings, and thus does not result in a hitherto non-disclosed specific sub-class of compounds. The pH value of the hair dye composition of 8 to 11 is valid for all types of dissociative direct dyes, in view of the general statement in the application as filed (see page 33, lines 8 to 15) that the hair dye composition of the present invention can be used at a pH of particularly 8 to 11.

2.6 Thus, the Board holds that the more precise definitions of the groups R^1 to R^5 , A and R^{11} in the dissociative direct dye of formula (1), do not result in a particular combination of specific meanings of the respective groups being singled out, namely no particular structural feature of the compounds

concerned is now claimed which was not disclosed originally. Nor does the specification of a pH range applicable to all the hair dye compositions of the invention comprising said dye result in an embodiment of a hair dye composition that was not originally disclosed.

2.7 Hence, the Appellant's argument that the amendments to claim 1 in the present case comprised choices from five lists of features, namely from the groups R^1 to R^4 , R^5 , A and R^{11} in the dye of formula (1) and the pH-value of the hair dye composition, which resulted in a particular combination of features which had not been disclosed in the application as filed, cannot be followed.

2.7.1 In this respect, the Appellant cited decisions T 859/04 and T 801/02, wherein the deletion of several meanings from the definitions of various substituents of a generic chemical formula resulted in a particular combination of the various remaining meanings of the substituents which was deemed to be not originally disclosed.

2.7.2 However, in both of these cases, more than one variable (e.g. R^2 , R^4 , w, x, t and Y in the case underlying T 801/02, and R^2 and R^3 in the case underlying T 859/94) in the respective chemical formulae was **individualised**, leading to a particular combination of specific meanings of the respective residues, i.e. to a particular structural feature of the compounds concerned which was not originally disclosed (see T 859/04, point 2.2 of the reasons, and T 801/02, point 2.2.1 of the reasons). In the present case, a corresponding undisclosed combination of structural

features resulting from the restrictions carried out in present claim 1 cannot be ascertained by the Board.

The present case is thus similar to those underlying decisions T 50/97 (see point 2.1 of the Reasons, not published in OJ EPO) and T 615/95 (see point 6 of the Reasons, not published in OJ EPO). Thus, in T 50/97 it was found that although one variable (p) in a generic chemical formula had on amendment been fixed to a single value, since the restrictions made to the definitions of the remaining variables maintained these as generic lists of alternative groups, the amendments made were not objectionable, as they did not lead to a particular combination of specific meanings which was not originally disclosed.

2.8 Therefore, in the Board's judgement, the amendments made to claim 1 do not generate new subject-matter extending beyond the content of the application as filed or beyond the scope of the granted claims, such that the requirements of Article 123(2) EPC are satisfied.

3. *Inventive step*

The decision under appeal held that the subject-matter claimed was inventive (see point III above) and the Appellant did not contest this finding.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated