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Datasheet for the decision of 5 July 2016

Case Number: T 1098/13 - 3.3.07

Application Number: 05711564.4

Publication Number: 1722860

IPC: A61Q5/02, A61Q5/12, A61K8/06, A61K8/896, A61K8/73, A61K8/44, A61K8/46

Language of the proceedings: EN

Title of invention:
Conditioning shampoo compositions

Patent Proprietor:
The Procter & Gamble Company

Opponent:
Kao Germany GmbH

Relevant legal provisions:
RPBA Art. 12(4)
EPC Art. 54, 56

Keyword:
Late-filed evidence submitted with the statement setting out the grounds of appeal - admitted (no)
Novelty - (yes)
Inventive step - (yes)

Decisions cited:
G 0009/91, T 0724/08

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Case Number: T 1098/13 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 5 July 2016

Appellant: (Opponent)	Kao Germany GmbH Pfungstädter Strasse 92-100 64297 Darmstadt (DE)
Representative:	Grit, Mustafa Kao Germany GmbH Pfungstädterstrasse 92-100 64297 Darmstadt (DE)
Respondent: (Patent Proprietor)	The Procter & Gamble Company One Procter & Gamble Plaza Cincinnati, OH 45202 (US)
Representative:	Briatore, Andrea Procter & Gamble Service GmbH IP Department Frankfurter Strasse 145 61476 Kronberg im Taunus (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 14 March 2013 rejecting the opposition filed against European patent No. 1722860 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	J. Riolo
Members:	A. Usuelli
	P. Schmitz

Summary of Facts and Submissions

I. European patent No. 1 722 860, based on European patent application No. 05711564.4, was granted on the basis of 12 claims.

Independent claim 1 related to a shampoo composition comprising *inter alia* a silicone oil present in the form of a preformed microemulsion of particles and a cationic deposition polymer selected from the group of cationic cellulose polymers having a molecular weight of at least 800,000.

II. The patent was opposed under Article 100(a) EPC on the grounds that its subject-matter lacked novelty and inventive step. The sole document cited by the opponent during the opposition proceedings was the following:

D1: EP 529883

III. Insofar as relevant to the present decision, the opposition proceedings can be summarised as follows:

(a) By letter of 5 October 2012 the opposition division summoned the parties to oral proceedings. In an annexed communication, it expressed the opinion that the claims of the patent were novel and inventive over document D1.

(b) On 9 January 2013 the appellant informed the opposition division that it did not intend to attend the oral proceedings and requested a decision based on the state of the file. In a communication dated 23 January 2013, the opposition division informed the parties that the oral

proceedings scheduled for 27 February 2013 were cancelled.

(c) By a decision issued on 14 March 2013 the opposition was rejected.

The opposition division considered that the shampoo defined in claim 1 of the patent differed from the composition disclosed in example 9 of D1 in view of the higher molecular weight of the cellulose cationic deposition polymer. The experimental data submitted during the examination proceedings showed that the use of a cellulose polymer of higher molecular weight resulted in an increased deposition of the silicone oil component and in an improvement of the conditioning properties. The technical problem was therefore defined as the provision of a shampoo with enhanced deposition and conditioning effect. In the opinion of the opposition division, D1 did not suggest using a cationic deposition polymer of higher molecular weight in order to solve this problem.

Accordingly, the opposition division came to the conclusion that the subject-matter of the patent was novel and inventive over document D1.

IV. The opponent (hereinafter: the appellant) lodged an appeal against that decision.

With the statement setting out the grounds of appeal filed on 15 July 2013 the appellant submitted the following documents:

D4: WO 03/105793

D5: Material safety data sheet of Dow Corning 2-1865 Microemulsion

V. By letter dated 3 February 2014 the patent proprietor (hereinafter: the respondent) requested that the appeal be dismissed and that the patent be maintained as granted, or alternatively that the patent be maintained on the basis of one of four auxiliary requests submitted with the same letter.

VI. The Board issued a communication pursuant to Article 15(1) RPBA on 6 May 2016 in which it provided its comments on the admittance of documents D4 and D5.

VII. Oral proceedings were held on 5 July 2016.

VIII. The appellant's arguments, as far as they are relevant for the present decision, can be summarised as follows:

(a) Admittance of D4 and D5

Document D4 was *prima facie* relevant to the novelty and inventive step of the subject-matter of the opposed patent. It was a patent application of the respondent, who should therefore have known its content. Furthermore, it should have been acknowledged in the description of the patent in suit as part of the relevant background art. D4 could not have been filed during the opposition proceedings, because at that time the appellant was not aware of it. Document D5 disclosed information concerning the emulsion used in document D4. Both documents D4 and D5 should be admitted into the appeal proceedings.

(b) Novelty and inventive step

The shampoo defined in claim 1 of the patent was not novel in view of the composition disclosed in example 10 of document D4. The claims of the patent also did not involve an inventive step over document D4.

IX. The respondent's arguments about admitting documents D4 and D5 can be summarised as follows:

Both documents D4 and D5 could have been filed during the opposition proceedings because they were already published at that time. Moreover, the appellant had filed in 2012 an opposition against the patent originating from D4. Hence, the appellant was aware of this document at least before the date of the oral proceedings on the present case before the opposition division. Moreover, document D4 was not *prima facie* relevant since it did not relate to compositions containing microemulsions.

X. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

XI. The respondent requested that the appeal be dismissed or alternatively that the patent be maintained on the basis of one of auxiliary requests 1 to 4 submitted on 3 February 2014. The respondent furthermore requested that documents D4 and D5 not to be admitted and, if they were admitted, that the case be remitted to the department of first instance.

Reasons for the Decision

Admittance of documents D4 and D5

1. Both documents were filed with the statement setting out the grounds of appeal. According to Article 12(1) RPBA the appeal proceedings shall be based *inter alia* on the notice of appeal and statement of grounds of appeal filed pursuant to Article 108 EPC.

However, pursuant to Article 12(4) RPBA, the Board has the power to hold fact and evidence inadmissible if it considers that they could have been presented during the first-instance proceedings.

1.1 Document D4

1.1.1 In the statement setting out the grounds of appeal the appellant argued that the subject-matter of the patent in suit lacked novelty and inventive step in view of document D4.

Thus, this document has been used by the appellant to attack a claim request (the patent as granted) which was already part of the first-instance proceedings.

Document D4 was already known to the appellant during the opposition proceedings, because it had filed an opposition against it on 3 February 2012, i.e. before the date of the decision of the opposition division in the present case (14 March 2013) and even before the date in which the opposition division issued the summons to oral proceedings (5 October 2012).

Hence, there was apparently nothing to prevent the appellant from filing D4 already during the first-instance proceedings.

However, in the Board's view, this conclusion alone would not necessarily justify declining to admit document D4. Indeed, for a proper exercise of the discretionary power under Article 12(4) RPBA all the circumstances of the case need to be considered.

1.1.2 In this respect it is noted that in the communication annexed to the summons to oral proceedings, the opposition division expressed the opinion that the claims of the patent were novel and inventive over document D1.

Instead of reacting to this communication and filing the document before the opposition division, the appellant decided to inform the opposition division of its decision not to attend the oral proceedings and requested a decision on the basis of the written submissions.

1.1.3 This course of action indicates that after the communication of the opposition division the appellant did not make any further effort to obtain a favourable decision. On the contrary, it apparently opted to keep its cards for the appeal proceedings.

Such behaviour disregards the fact that the appeal proceedings by their very nature are largely determined by the factual and legal scope of the first-instance proceedings and are not about bringing an entirely fresh case to the Board.

In particular, the purpose of the *inter partes* appeal proceedings is mainly to give the losing party the possibility of challenging the decision of the opposition division on its merits (see G 9/91, OJ EPO 1993, 408, point 18 of the reasons). In the Board's view, filing fresh evidence in appeal and basing one's entire case on it is not the same as challenging the decision of the first instance on its merit. It is rather tantamount to starting new opposition proceedings.

1.1.4 As to the appellant's argument that document D4 should be admitted into the appeal proceedings on account of its *prima facie* relevance, the Board notes that in the exercise of its discretion under Article 12(4) RPBA it does not necessarily need to consider the relevance of the new evidence. Otherwise the consequence would be that an opponent could always file a relevant document for the first time in the statement setting out the grounds of appeal and expect it to be admitted (see T 724/08, points 3 to 3.5 of the reasons, not published in the OJ of the EPO).

Independently of the above, it is noted that example 10 of D4, referred to by the appellant, contains an aminosilicone nanoemulsion. In contrast to this, claim 1 of the patent in suit requires the presence of a microemulsion containing a silicone oil. Thus, it is at least questionable whether D4 is *prima facie* relevant.

1.1.5 The appellant furthermore remarked that D4 was an application of the respondent. Accordingly, the respondent was aware of its content and should have cited it in the description of the patent as part of the relevant background art.

The Board sees no merit in this argument, since it has no bearing on the question whether the appellant should have already presented document D4 during the first-instance proceedings so that already the opposition division could have considered it.

1.1.6 On that basis the Board in the exercise of its discretion considers it appropriate not to admit document D4 (Article 12(4) RPBA).

1.2 Document D5

1.2.1 This document was cited by the appellant only with the purpose of providing information as to the composition of the emulsions used in the examples of D4. Since document D4 has not been admitted into the appeal proceedings, document D5 loses any relevance.

For this reason also document D5 is not admitted into the appeal proceedings.

Main request (patent as granted)

2. Novelty and inventive step

The sole arguments submitted by the appellant on novelty and inventive step are based on document D4, which has not been admitted into the appeal proceedings.

Accordingly, the Board sees no reason to depart from the conclusions of the opposition division on the issues of novelty and inventive step. As a consequence, the decision of the opposition division holds good.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

S. Fabiani J. Riolo

Decision electronically authenticated