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**Datasheet for the decision
of 13 January 2016**

Case Number: T 2471/13 - 3.3.06

Application Number: 05744764.1

Publication Number: 1814632

IPC: A61K8/73, A61K8/36, A61Q19/10

Language of the proceedings: EN

Title of invention:

PERSONAL PRODUCT LIQUID CLEANSERS COMPRISING COMBINED FATTY
ACID AND WATER SOLUBLE OR WATER SWELLABLE STARCH STRUCTURING
SYSTEM

Patent Proprietor:

Unilever PLC / Unilever N.V.

Opponent:

Henkel AG & Co. KGaA

Headword:

Cleansing composition/UNILEVER

Relevant legal provisions:

EPC Art. 52(1), 54(1), 54(2)
RPBA Art. 12(4)

Keyword:

Prior art document filed with the statement of grounds and objections based thereon could and should have been filed in first instance proceedings - not admitted irrespective of the potential relevance thereof
Novelty - main request (yes)

Decisions cited:

Catchword:



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Case Number: T 2471/13 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 13 January 2016

Appellant: Henkel AG & Co. KGaA
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Representative: Henkel AG & Co. KGaA
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Respondent: Unilever PLC
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Respondent: Unilever N.V.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 10 October 2013
rejecting the opposition filed against European
patent No. 1814632 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman B. Czech
Members: E. Bendl
 S. Fernández de Córdoba

Summary of Facts and Submissions

I. The appeal lies from the decision of the opposition division to reject the opposition against European patent No. 1 814 632.

II. The only independent claim of the patent in suit as granted reads as follows:

"1. Personal product liquid cleansing compositions comprising (by wt.):

- (1) 2 % to 30 % of a surfactant selected from anionic surfactants, nonionic surfactants, amphoteric surfactants, cationic surfactants or mixtures thereof;*
- (2) 0 to 30 % benefit agent; and*
- (3) a structuring system comprising:
 - (i) C₈ - C₁₃ linear fatty acid or acids; and*
 - (ii) 0.5 % to 15 % total composition modified or non-modified starch;**

wherein the ratio of linear fatty acid or acids to the surfactants is from 1.0/9.0 to 3.5/6.5;

wherein the surfactants and fatty acid or acids form a cloudy solution containing surfactant/fatty acid particles at 15 % total wt. surfactant and fatty acids, measured at a pH in the range of 4.5 to 7.5, the amount of surfactant/fatty acid particles formed is at least 15 wt% based on the total surfactants and fatty acids; wherein the pH of the liquid cleanser composition is 5.0 to 7.5;

wherein the composition is stable at both room temperature and 45°C for over 3 weeks with no visible

phase separation; and

wherein modified starch refers to chemical or physical modification to enhance dissolution or swelling of starch in water."

Dependent claims 2 to 22 are directed to preferred embodiments of the compositions according to claim 1.

III. In its statement setting out the grounds for opposition the opponent had cited the following prior art documents:

D1: WO 97/28780 A1,

D2: US 2004/0022818 A1,

D3: US 2004/0091444, and

D4: DE 102 16 509 A1.

Novelty was called into question based on D1 and D4. Moreover, two inventive step attacks were presented, based on either D2 or D3 as the closest prior art.

IV. In its reply, the patent proprietor observed that the passages of D3 cited by the opponent did not tally with the content of the document filed as D3. It requested clarification in this respect.

V. In its communication dated 25 February 2013 (point 4.2) the opposition division also noted that the arguments made and the passages cited with regard to D3 did not match with the disclosure of this document, that another document (i.e. the "correct" D3) could only be taken into account under Article 114(2) EPC in exceptional

circumstances.

VI. At the oral proceedings before the opposition division the opponent no longer relied on D3 (appealed decision, point 1.4.2).

VII. In the appealed decision, the opposition division concluded that the subject-matter of the claims as granted was novel over D1 and D4 and involved an inventive step taking D2 as the closest state of the art, alone or in combination with D4.

VIII. The appellant (opponent) maintained in its statement of grounds of appeal that the claimed subject-matter was not novel over D1 and D4. In support of this view, it filed and referred to the further document

D5: Langmuir 19, 2023 - 2038, 2003.

Moreover, it filed the further document

D3': US 2004/0091446 A1,

arguing that this was the document that had been referred to in the statement setting out the grounds for opposition, but erroneously indicating a wrong publication number. The appellant submitted that the claimed subject-matter did not involve an inventive step in the light of document D3' taken as the closest prior art, either alone or in combination with D2.

IX. The respondent (patent proprietor) rebutted the appellant's objections, questioned the admissibility of document D3' in view of its late filing and submitted, as auxiliary requests 1 to 4, four sets of amended claims.

- X. In preparation of oral proceedings, the board issued a communication expressing *inter alia* reservations regarding the admissibility of D3' into the proceedings, questioning the conclusiveness of the appellant's novelty objections and noting that the (positive) finding of the opposition division regarding inventive step (with D2 as closest prior art) was not challenged.
- XI. With a further letter of 10 December 2015 the respondent submitted experimental data to demonstrate novelty of the claimed subject-matter over D1 and D4, as well as an amended auxiliary claim request 3 to replace auxiliary request 3 then on file. It asked for the non-admittance of documents D3' and D5.
- XII. On 11 January 2016 the appellant announced by fax that it would not be represented at the oral proceedings due to a sudden illness of the person in charge of the case but did not request a postponement of the oral proceedings.
- XIII. Oral proceedings were thus held as scheduled on 13 January 2016 in the absence of the appellant (Article 15(3) RPBA). The respondent was heard in particular regarding the novelty of the claimed subject-matter over D1 and D4 and the admissibility of D3' and D5.
- XIV. Requests

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

The respondent requested that the appeal be dismissed, alternatively that the patent be maintained on the basis

of the claims according to one of the following requests in their numerical order:

auxiliary requests 1, 2 or 4 as submitted with the reply to the grounds of appeal or auxiliary request 3, submitted with letter of 10 December 2015.

- XV. The arguments of the appellant presented in its written submission, as far as relevant to the present decision, can be summarised as follows:

Admissibility of document D3'

- A wrong publication number had been indicated in the statement setting out the grounds for opposition, but the teaching of the (correct) document, i.e. D3', was properly reflected in said statement.
- Being *prima facie* highly relevant as regards inventive step, D3' should be admitted into the proceedings. As a proof of the document's relevance the appellant cited passages from its statement setting out the grounds for opposition.

Novelty

- Formulation A of D1 disclosed all features of the compositions according to claim 1 as granted, in particular the pH value. The latter, although not disclosed *expressis verbis*, could easily be calculated by the skilled person. In this connection, it referred to information contained in D5.
- Based on similar considerations, example 6 of D4 was also novelty-destroying.

The arguments of the respondent, as far as relevant to the present decision, can be summarised as follows:

Admissibility of documents D3' and D5

- Both D3' and D5 could and should have been filed much earlier and should thus not be admitted into the proceedings.
- No convincing explanation for the late filing of D3' was given by the appellant.

Novelty

- A composition with all the features of claim 1 and having, in particular, a pH value in the claimed range, was not directly and unambiguously derivable from D1. The formulations described in D1 contained many ingredients. The pH of such a complex mixture could not be simply calculated. Moreover, the pH calculations proposed by the appellant were based on incorrect assumptions and, thus, not conclusive.
- For analogous reasons, example 6 of D4 was not novelty-destroying either.
- The experimental reproduction of formulation A and example 2 of D1 and of example 6 of D4 proved that their true respective pH values were higher than 7.5, i.e. outside the pH range defined in claim 1 at issue.
- The claimed subject-matter was thus novel over D1 and D4.

Reasons for the Decision

Admissibility of documents filed in the appeal proceedings

1. Document D3'
 - 1.1 D3' was cited for the first time in the appellant's statement of grounds, and a hardcopy of D3' was filed together with said statement. The admittance of D3' into the proceedings is thus subject to the board's discretion under Article 114(2) EPC and Article 12(4) RPBA.
 - 1.2 The appellant argued that D3 had been cited erroneously in the statement setting out the grounds for opposition. It had been intended to cite D3', and reference had been made to the relevant passages of the "correct" document D3'.
 - 1.3 It clearly emanates from the case history (points IV to VI, *supra*) that the appellant/opponent had repeatedly been made aware in the course of the opposition procedure that D3 and the passages referred to did not match. Nevertheless, the appellant chose not to submit the "correct" document D3' supposed to actually disclose the prior art invoked initially as D3.
 - 1.4 Instead, it subsequently relied solely on D2 in attacking inventive step, considering this document as the most appropriate starting point for the problem and solution approach. This is apparent from the minutes of the oral proceedings before the opposition division (point 5.1) and the decision under appeal (point 2.4.1, first sentence; emphasis added by the board) reading, respectively, "*The opponent started from the composition of the example 1 in D2 as closest prior art*" and "*It is*

undisputed that D2 has to be considered as the closest state of the art".

1.5 In the first instance proceedings, the opponent thus had not even attempted to submit the "correct" document D3' (with the "correct" publication number), but deliberately decided to pursue only its inventive step attack based on D2 as the closest state of the art.

1.6 By withholding the "correct" document D3' and enclosing it only with the statement of grounds of appeal, the opposition division and the adverse party were kept from taking position on the relevance of this document, known to the patent proprietor and initially even considered as a possible closest prior art (point III, *supra*), at the earliest opportunity, contrary to the requirement for procedural efficiency.

1.7 For the board, the fact that the appellant only relied on D3' as the closest prior art for the assessment of inventive step (for the first time) in its statement of grounds of appeal thus amounts to the - avoidable - presentation of a fresh case upon appeal, based on evidence and arguments differing substantially from those ultimately relied upon before the opposition division.

1.8 Taking into account all the above circumstances, the board decided not to admit document D3' into the proceedings, irrespective of its potential relevance (Article 114(2) EPC and Article 12(4) RPBA).

2. Admissibility of document D5

2.1 D5 was also filed under cover of the appellant's statement of grounds. Its admittance is thus subject to

the board's discretion under Article 114(2) EPC and Article 12(4) RPBA.

- 2.2 This document is supposed to demonstrate common general knowledge regarding pK_a values of fatty acids. The board considered the introduction of D5 as an attempt to underpin the maintained objection that D1 and D4 disclosed novelty-destroying compositions, the pH values of which could be calculated. The filing of D5 did not raise any new, let alone complex issue.
- 2.3 The board therefore decided to admit document D5 into the procedure (Article 114(2) EPC and Article 12 RPBA).
3. Experimental evidence filed by the respondent
 - 3.1 The report on the experimental reproduction of the allegedly novelty destroying compositions of D1 and D4, was only filed after issuance of the summons to oral proceedings and is thus also subject to the Board's discretion under Article 114(2) EPC and Article 13(1) RPBA.
 - 3.2 The experimental report was filed to corroborate, by other means than merely theoretical considerations, the position always maintained by the respondent, i.e. that the invoked examples of D1 and D4 were not novelty destroying, and differed in particular from the claimed subject-matter in terms of their pH values. The late submission of these comparative tests was not objected to by the appellant.
 - 3.3 The board therefore decided to admit these experimental results into the procedure despite their late filing (Article 114(2) EPC and Article 13(1) RPBA).

Main request (claims as granted) - Patentability

4. Novelty

4.1 Formulation A of D1 and example 6 of D4 were invoked by the appellant, allegedly describing compositions with all the features of claim 1 in terms of ingredients and pH values.

4.2 The appellant attempted to demonstrate the novelty-destroying nature of these compositions by calculating their pH values based on estimations of the amount of acid present in these compositions.

4.2.1 The correctness of these calculations and the validity of their theoretical basis were called into question by the respondent and the board (point 3.4 of the communication), taking also into account the content of document D5, relied upon by the appellant.

4.2.2 However, the appellant did not submit any further arguments in response to the strong reservations expressed by the board as regards said calculations. The board is thus still not convinced that it is directly and unambiguously derivable from D1 or D4 that the pH values of the compositions invoked as novelty-destroying by the appellant must lie within the range prescribed by claim 1 at issue.

4.3 Moreover, the respondent also carried out experimental reproductions of the allegedly novelty-destroying compositions according to D1 and D4.

4.3.1 The experimental approach taken by the respondent was not criticised by the appellant. The reproduced compositions according to formulation A of D1 and

example 6 of D4 had **measured** pH values well above the upper limit of 7.5 defined in claim 1 at issue.

4.3.2 For the board the respondent's experimental report thus proves beyond any doubt that none of the two compositions according to D1 and D4 invoked as novelty-destroying by the appellant falls within the ambit of claim 1 at issue.

4.4 Therefore, the subject-matter of claim 1 of the main request and, consequently, also the subject-matter of dependent claims 2 to 22, meet the novelty requirement (Articles 52(1) and 54(1)(2) EPC).

5. Inventive step

5.1 The only inventive step objection raised by the appellant is based on document D3' taken as the closest prior art, either alone or in combination with document D2.

5.2 As D3' was not admitted into the proceedings (see points 1.1 to 1.8, *supra*), there is also no admissible pending inventive step objection of the appellant to be considered by the board.

5.3 The board sees no reason for calling into question the finding of the opposition division (appealed decision, points 2.4 to 2.4.5) that the claimed subject-matter was not obvious to the skilled person having regard to the state of the art to be considered here, i.e. D1, D2 and D4 (Articles 52(1) and 56 EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Magliano

B. Czech

Decision electronically authenticated