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**Datasheet for the decision  
of 15 December 2016**

**Case Number:** T 0863/15 - 3.3.10

**Application Number:** 07021972.0

**Publication Number:** 1927346

**IPC:** A61K8/73, A61K8/92, A61Q5/06

**Language of the proceedings:** EN

**Title of invention:**  
Hair styling emulsion composition

**Applicant:**  
Kao Germany GmbH

**Headword:**

**Relevant legal provisions:**

RPBA Art. 12(4)  
EPC R. 137(3)  
EPC Art. 84, 123(2), 54(2), 111(1)

**Keyword:**

Admissibility (no) - main request and auxiliary requests I, II  
Clarity (no) - auxiliary request III  
Remittal to the examining division (yes) - auxiliary request  
IV

**Decisions cited:**

T 0922/08, T 0337/95

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0863/15 - 3.3.10

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.10**  
**of 15 December 2016**

**Appellant:** Kao Germany GmbH  
(Applicant) Pfungstädter Strasse 92-100  
64297 Darmstadt (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 4 November 2014  
refusing European patent application No.  
07021972.0 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman** P. Gryczka  
**Members:** R. Pérez Carlón  
F. Blumer

## Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the examining division to refuse European patent application No. 07 021 972.0.
- II. The documents cited during examination proceedings included the following:
- D1: US 2,655,923  
D4: WO 92/19219  
D5: US 2,310,687
- III. The examining division concluded that the aqueous composition of claim 1 of the sole request before it was not novel over those of documents D1, D4 and D5.
- IV. With the statement setting out the grounds of appeal, the appellant filed a main request and an auxiliary request, later renamed as auxiliary request I. Under cover of a letter dated 12 August 2016, it filed auxiliary requests II, III and IV. An amended auxiliary request IV, replacing the then pending auxiliary request IV, was filed during the oral proceedings before the board on 15 December 2016.
- V. The main request in these appeal proceedings corresponds to the main request filed during examination with a letter dated 15 September 2010, withdrawn during the oral proceedings before the examining division. Claim 1 of the main request reads as follows:

*"An aqueous composition for keratin fibres especially for human hair characterised in that it comprises at least one oil and/or wax at a concentration 5 to 40% by*

*weight calculated to total composition, at least one natural starch at a concentration 1 to 25% by weight calculated to total composition, at least one emulsifier and at least one hair fixing polymer selected from anionic, non-ionic, cationic and amphoteric polymers."*

Claim 1 of auxiliary request I only differs from claim 1 of the main request in that the term *"additionally"* was added before the feature *"at least one hair fixing polymer selected from anionic, non-ionic, cationic and amphoteric polymers"*.

Claim 1 of auxiliary request II differs from claim 1 of auxiliary request 1 in that it requires that the *"additionally at least one hair fixing polymer selected from anionic, non-ionic, cationic and amphoteric polymers"* is present *"at a concentration of 1 to 20% by weight calculated to total composition."*

Claim 1 of auxiliary request III differs from claim 1 of auxiliary request 1 in that the term *"hair fixing polymer"* was replaced by *"film forming polymer"*.

Lastly, claim 1 of auxiliary request IV requires the *"at least one film forming polymer"* to be selected from *"anionic, cationic and amphoteric polymers"*.

- VI. In a communication annexed to the summons for oral proceedings, the board informed the appellant that it tended to consider that the main request and auxiliary request I should not be admitted in the proceedings.
- VII. The arguments of the appellant relevant for the present decision were the following:

The main request had been withdrawn during examination proceedings because the examining division intended not to accept it, and not because the appellant did not wish to defend that set of claims. For this reason, the main request should be held admissible in these appeal proceedings.

Whether or not auxiliary request I addressed the issues under Article 84 EPC raised during examination should be a substantive, not an admissibility issue. The same should apply to auxiliary request II.

The subject-matter of claim 1 of auxiliary request IV was novel, as neither D1, D4 or D5 disclosed compositions comprising anionic, cationic or amphoteric film-forming polymers. As the examining division had not yet decided on inventive step, the case should be remitted for further prosecution.

- VIII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further examination on the basis of any one of the main request or auxiliary requests I to IV, the main request and auxiliary request I (titled "auxiliary request") as filed with letter dated 5 March 2015, auxiliary requests II and III as filed with letter dated 12 August 2016, auxiliary request IV as filed during oral proceedings before the board.
- IX. At the end of the oral proceedings, the decision was announced.

## **Reasons for the Decision**

1. The appeal is admissible.
2. Main request, auxiliary requests I and II, admission:
  - 2.1 The main request in these appeal proceedings corresponds to the main request of the appellant at the beginning of the oral proceedings before the examining division, withdrawn during said proceedings.

Article 12(4) RPBA gives a board the power to hold inadmissible facts, evidence or requests which could have been presented in first instance proceedings. This applies in particular to requests withdrawn during examination proceedings.

In the present case, by withdrawing the main request during examination proceedings, the appellant prevented the examining division from issuing a decision on this request, in particular with respect to the lack of clarity of the feature "hair fixing polymer", which was objected to by the examining division (see the contested decision, point 8 of the Facts and Submissions).

Admitting this request into the appeal proceedings would imply either that the board issues a first ruling on that issue, which runs contrary to the purpose of an appeal as a revision instance, or to remit the case, which is contrary to procedural economy (see T 922/08, point 2.1, not published in OJ EPO).

For these reasons, the main request is held not

admissible.

2.2 The appellant gave as sole reason for having withdrawn its main request during examination proceedings that it was apparent that the division was inclined not to allow it. However, if the appellant wanted to challenge a decision of the examining division on this request or any similar request containing the arguably unclear feature "hair fixing polymer", it should have maintained it.

2.3 Claim 1 of auxiliary requests I and II merely differ from claim 1 of the main request as far as the feature "hair fixing polymer" is concerned in that it is preceded by the word "additionally", which does not alter the situation regarding clarity with respect to the main request.

For this reason, the board decides to make use of the discretion given to it by Rule 137(3) EPC not to admit these requests into the proceedings.

3. Auxiliary request III, clarity

3.1 Claim 1 of auxiliary request III relates to a composition which comprises

- 1 to 25% of one natural starch and
- additionally at least one film-forming polymer which can be non-ionic.

Article 84 in conjunction with Rule 43(1) EPC stipulates that the claims must be clear and must define the matter for which protection is sought in terms of the technical features of the invention. These requirements serve the purpose of ensuring that the public is not left in any doubt as to which subject-



matter is covered by a particular claim and which is not (see T 337/95, OJ EPO 1996, 628, Reasons 2.2 to 2.5).

- 3.2 It is not disputed that natural starch is a non-ionic film-forming polymer, and that the claimed invention contemplates compositions having more than one natural starch, see for example claim 4.

It is not apparent whether or not a composition comprising a mixture of starches and no further film-forming polymer is a composition according to claim 1, as it is not clear whether or not a second natural starch represents an "additional, non-ionic film-forming polymer" in the terms of claim 1 claim 1. "Additional" in the context of claim 1 could indicate "in addition to one starch" or "additional to starches". For this reason, the feature "additional" does not have an unequivocal meaning which could clearly define the boundaries of claim 1.

As doubts remain as to whether a composition comprising a mixture of natural starches is covered by claim 1 of auxiliary request III, said claim is not clear, as required by Article 84 EPC, and this request is thus not allowable.

4. Auxiliary request IV

- 4.1 Amendments

Claim 1 finds a basis in the combination of claims 1, 4 and 6 as originally filed and the passage on page 7, lines 16-18 of the description as originally filed.

Claims 2-14 find a basis in claims 2, 3, 5, 7-9 and

11-17, respectively, combined with the passage of the description mentioned with respect to claim 1.

The requirements of Article 123(2) EPC are thus fulfilled.

#### 4.2 Novelty

Claim 1 of auxiliary request IV is directed to an aqueous mixture for human hair comprising an oil and/or wax, at least one natural starch, at least one emulsifier and at least one film-forming polymer selected from anionic, cationic and amphoteric polymers.

Documents D1, D4 and D5 disclose mixtures which do not contain anionic, cationic or amphoteric film-forming polymers. For this reason alone, the subject-matter of claim 1 is novel, as required by Article 54(2) EPC.

#### 4.3 Remittal

According to Article 111(1) EPC, a board may either exercise any power within the competence of the department which was responsible for the appealed decision, i.e. decide on all issues, or it may remit the case to the first instance for further prosecution.

In the present case, the examining division had refused the application due to lack of novelty. This objection no longer applies to claim 1 of auxiliary request IV. The appellant has requested that, if a set of claims on file was novel, the case be remitted to the examining division for further prosecution. Under these circumstances, the board considers it appropriate to remit the case.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further examination on the basis of the claims of auxiliary request IV as filed during oral proceedings before the board.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated