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**Datasheet for the decision
of 14 May 2019**

Case Number: T 2322/15 - 3.3.10

Application Number: 09169071.9

Publication Number: 2226063

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A61K8/49, A61Q13/00, C11B9/00

Language of the proceedings: EN

Title of invention:
High intensity fragrances

Patent Proprietor:
Takasago International Corporation

Opponents:
Symrise AG
Givaudan SA
Henkel AG & Co. KGaA

Headword:
High intensity fragrances / TAKASAGO

Relevant legal provisions:
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Decisions cited:

T 0022/81

Catchword:



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Case Number: T 2322/15 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 14 May 2019

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 9 October 2015
revoking European patent No. 2226063 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: J.-C. Schmid
 F. Blumer

Summary of Facts and Submissions

- I. The Appellant (Proprietor of the patent) lodged an appeal against the decision of the Opposition Division revoking European patent No. 2 226 063.
- II. Notices of opposition were filed by the Respondents I, II and III (opponents (1), (2) and (3) respectively) requesting revocation of the patent-in-suit in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC), insufficient disclosure of the invention (Article 100(b) EPC), and extending the subject-matter of the patent beyond the content of the application as filed. *Inter alia* the following documents were cited in the opposition proceedings:
- (15) EP-A-1 964 544 and
- (18) US-A-1 882 200.
- III. According to the opposition division, the invention as claimed in claim 1 of the then pending main request was not sufficiently disclosed in the patent-in-suit to be carried out by a skilled person in the art. The subject-matter of claim 1 of the then pending first auxiliary request lacked novelty over document (18). With regard to inventive step, the Opposition Division considered that document (15) was the closest prior art to the invention for the subject-matter of claim 1 of the third auxiliary request. This document disclosed a fragrance composition comprising 2 to 10 well known fragrances of which at least 2 were selected from allyl caproate, benzyl acetate, benzaldehyde, dihydroisojasmonate, ethyl phenethylacetal, ethyl

cinnamate, ethyl methyl phenyl glycidate, ethyl vanillin, 2-heptylcyclopentanone, geranyl acetate, heliotropine, cis hex-3-en-1-ol, ethylene brassylate, nonalactone gamma, camphylcyclohexanol, undecalactone gamma, 2-t-butylcyclohexyl acetate, pentyl salicylate, 2-phenylethanol, hinokitiol and 2-phenylethyl acetate, and must comprise at least 20% by weight of the fragrance composition. Preferably, the fragrance composition comprised at least 4 materials (claims 3, 4). The fragrance composition of claim 14 required more than 80% of the selected fragrance materials. The difference between the subject matter of claim 1 and document (15) was that the fragrance composition comprised at least 85% of selected ingredients. No effect was showed to be linked to this difference. Thus, the compositions of claim 1 of the third auxiliary request represented an arbitrary alternative to the compositions of document (15), therefore lacking an inventive step.

IV. With the statement of the grounds for appeal filed on 18 February 2016, the Appellant filed a main request and seven auxiliary requests.

Claim 1 of the main request reads as follows:

"1. A hypoallergenic high intensity fragrance composition in which all the ingredients are natural, which comprises by weight:

- a) 75% to 100% of at least 4 fragrance ingredients where each fragrance ingredient must:
 - contain only atoms of carbon, hydrogen, oxygen and nitrogen,
 - comprise ester, alcohol or aldehyde functional groups,

- have boiling points between 100°C and 300°C at a pressure of 760 mm of mercury,
- have molecular weights within the range 70 amu and 175 amu,
- have ClogP values between 0.00 and 4.00;
- b) 0 to 25% of essential oils;
- c) 0 to 25% of fragrance ingredients, other than those characterized under a) above;

wherein the sum of a), b) and c) must equal 100%;
wherein each of the following ingredients, if present in the fragrance composition, is present in an amount of less than 100 ppm (weight/weight): amyl cinnamic aldehyde, amyl cinnamic alcohol, anisyl alcohol, benzyl alcohol, benzyl benzoate, benzyl cinnamate, benzyl salicylate, cinnamic aldehyde, cinnamyl alcohol, citronellol, coumarin, eugenol, farnesol, geraniol, hexyl cinnamic aldehyde, hydroxycitronellal, hydroxymethylpentylcyclohexenecarboxaldehyde, isoeugenol, linal, limonene, linalool, methyl heptene carbonate, 3-methyl-4-(2,6,6-trimethyl-2-cyclohexen-1-yl)-3-buten-2-one, citral, Oakmoss extract, treemoss extract."

Claim 1 of first auxiliary request 1 differs from claim 1 of the main request in that component (a) is specified to be 75% to 100% of at least 4 fragrance ingredients selected from the following ingredients: allyl hexanoate, n-amyl acetate, iso amyl acetate, n-amyl propionate, anisic aldehyde, benzaldehyde, benzyl acetate, butyl acetate, decalactone gamma, ethyl 2-methyl butyrate, ethyl butyrate, ethyl caproate, ethyl caprylate, ethyl heptanoate, ethyl lactate, ethyl propionate, heliotropine, trans hex-2-en-al, cis hex 3-en-1-ol, cis hex-3-en-1-yl acetate, cis hex-3-en-1-yl propionate, hexyl acetate, iso butyl acetate, L-

menthol, methyl benzoate, methyl salicylate, methyl anthranilate, octalactone gamma, 2-phenyl ethyl acetate, 2-phenyl ethyl alcohol, 1-terpinen-4-ol, terpineol alpha, vanillin, 3-hydroxy-2-methyl-4-pyrone;

Claim 1 of the second and third auxiliary requests differs from claim 1 of the main and first auxiliary request, respectively, in that component (a) represents 85% to 100% of the composition.

Claim 1 of the fourth to seventh auxiliary request differs from claim 1 of the main and first to third auxiliary requests, respectively, in that the hypoallergenic high intensity fragrance composition is for use in a cosmetic, toiletry personal care, personal cleaning product and adsorbent article.

The Appellant furthermore filed a test report (document (30)) comparing the olfactory properties of claimed compositions with a composition of the state of the art.

- V. In a communication under Article 15(1) RPBA issued on 7 September 2018, the Board indicated that the appellant had not substantiated why the effects shown in document (30) for the four claimed compositions with respect to composition K of document (15) could be extrapolated to any composition comprising at least four ingredients listed in the claims. It was reminded that according to established jurisprudence of the Boards of Appeal, in the case where comparative tests are chosen to demonstrate an inventive step with an improved effect over a claimed area, the nature of the comparison with the closest state of the art must be such that the effect is convincingly shown to have its origin in the distinguishing feature of the invention.

VI. According to the Appellant, with regard to inventive step of claim 1 of the seventh auxiliary request, document (15) represented the closest prior art to the invention. The compositions of claim 1 differed from those disclosed in document (15) in that at least 85% of the composition consisted of at least four ingredients chosen from the list indicated in the claim. The technical effect associated with the difference was an increase of the intensity of the fragrance, as demonstrated in the comparative test reported in document (30). The burden of proof laid by the Respondents to show that the technical problem was not solved across the whole breadth of the claims. The technical problem underlying the patent-in-suit, i.e. to improve the intensity of the fragrance compositions, was thus solved. The solution proposed by the patent-in-suit was that the fragrance composition consisted of at least 85% of at least four fragrances listed in claim 1. Even in order to provide a further hypoallergenic fragrance composition, the skilled person had no incentive to select a composition according to claim 1 of the seventh auxiliary request. The subject-matter of claim 1 of the seventh auxiliary request involved therefore an inventive step.

VII. According to respondent I and III, document (15) represented the closest prior art to the invention. The technical problem was the provision of alternative hypoallergenic fragrance compositions. The claimed compositions proposed as solution to this problem were the result of an arbitrary selection of compositions foreseen by document (15) and were therefore obvious. According to respondent III, the more intense odour of the claimed compositions over composition K of document (15) as shown in the comparative tests of document (30)

was expected, since the fragrance intensity of each individual fragrance was known. Furthermore, the higher odour intensity could not be extrapolated to all combinations of fragrances encompassed by claim 1 of the seventh auxiliary request. Accordingly, the subject-matter of the seventh auxiliary request lacked an inventive step.

Respondent (II) made no submission as regard to inventive step in the appeal proceedings.

VIII. Respondents I and II informed the Board that they would not attend the oral proceedings scheduled 14 May 2019.

IX. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request, or subsidiarily on the basis of one of the first to seven auxiliary requests, all requests filed with the letter dated 18 February 2016.

The Respondents requested that the appeal be dismissed.

X. At the end of the oral proceedings held on 14 May 2019 in the absence of respondents I and II, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. *Inventive step*

Independent claim 1 of the seventh auxiliary request is directed to an embodiment of claim 1 of the main request, wherein component (a) represents 85% to 100%

of the composition and that it is selected from specific compounds.

In case this embodiment according to the seventh auxiliary request lacked inventive step, then the subject-matter of claim 1 of the main request and also of each of the first to sixth auxiliary requests, which also embraces this embodiment, cannot involve an inventive step either. Thus, the subject-matter of claim 1 of the seventh auxiliary request is examined first as to inventive step.

Seventh auxiliary request

2.1 Closest prior art

Document (15) relates a fragrance composition for use in cosmetic, toiletry, personal care and cleansing, household cleaning and laundry products which comprises at least 80% by weight of fragrances of which at least 2 are selected from allyl caproate, benzyl acetate, benzaldehyde, benzyl salicylate, dihydroisojasmonate, ethyl cinnamate, ethyl methyl phenyl glycidate, ethyl vanillin, geranyl acetate, heliotropine, cis hex-3-en-1-ol, ethylene brassylate, nonalactone gamma, camphylcyclohexanol, undecalactone gamma, 2-t-butylcyclohexylacetate, amyl acetate, amyl benzoate, pentyl salicylate, citronellol, citronellyl acetate, cyclamen aldehyde, pentadecalactone, delta decalactone, decanal, ethyl phenethylacetal, ethyl pelargonate, 2-heptylcyclopentanone, hexanol, hinokitiol, geraniol, ethylphenyl acetal, isobutyl benzoate, linalool, linalyl acetate, menthyl acetate, methyl dihydrojasmonate, phenylethanol, phenylethylacetate, phenyl salicylate, terpeneol, triacetin, vanillin, 2-t-butylcyclohexyl acetate, 2-

phenylethanol, hinokitiol and 2-phenylethyl acetate (see claims 1, and 14).

The composition of claim 3 furthermore requires at least four fragrance are selected from *inter alia* benzyl acetate, benzaldehyde, heliotropine, cis hex-3-en-1-ol, 2-phenylethanol and 2-phenylethyl acetate.

The cosmetic compositions of document (15) are intended to be used on the skin and therefore are deemed to be hypoallergenic.

The Board considers in agreement with the parties and the opposition division that this document represents the closest prior art to the invention.

2.2 *Technical problem underlying the patent-in-suit*

The Appellant stated that the technical problem was the provision of fragrance compositions having higher fragrance intensity.

2.3 *Solution*

The proposed solution is the composition of claim 1 of the seventh auxiliary request characterized in that all the ingredients of the composition are natural and that it comprises at least 85 to 100% of at least four fragrances selected from allyl hexanoate, n-amyl acetate, iso amyl acetate, n-amyl propionate, anisic aldehyde, benzaldehyde, benzyl acetate, butyl acetate, decalactone gamma, ethyl 2-methyl butyrate, ethyl butyrate, ethyl caproate, ethyl caprylate, ethyl heptanoate, ethyl lactate, ethyl propionate, heliotropine, trans hex-2-en-al, cis hex 3-en-1-ol, cis hex-3-en-1-yl acetate, cis hex-3-en-1-yl propionate,

hexyl acetate, iso butyl acetate, L-menthol, methyl benzoate, methyl salicylate, methyl anthranilate, octalactone gamma, 2-phenyl ethyl acetate, 2-phenyl ethyl alcohol, 1-terpinen-4-ol, terpineol alpha, vanillin and 3-hydroxy-2-methyl-4-pyrone.

The feature that all the ingredients of the composition must be "natural" does not make it possible to clearly distinguish the claimed composition from the state of the art as natural compounds can also be synthesized. In any case, it is not a feature characterising the invention, as the appellant itself indicated that the fact that the ingredients are natural products did not provide any technical contribution with respect to the alleged improvement of the odour strength. The Board furthermore notes that the comparisons submitted by the appellant in the statement of the grounds for appeal have been carried out with compositions comprising ethyl methyl phenyl glycidate, which is not a natural occurring product, as acknowledged by the parties during the oral proceedings. Therefore, this feature is disregarded when assessing obviousness (see T 22/81, OJ EPO 1983, 226, points 5.1 and 7 of the reasons).

2.4 *Success*

The results of comparative experiments filed with the statement of the grounds of appeal (document (30)) show that fragrance compositions 1 to 4 according to the invention had higher odour intensity than fragrance composition K disclosed in the closest prior art document (15).

The respondents did not contest the higher odour strength of fragrance compositions 1 to 4 when compared to fragrance composition K, but respondent III

submitted that it was not credible that this effect was obtained across the whole scope of claim 1.

Since a purported technical effect can only form the basis for a finding of inventive step if it would be credible that it is obtained across the claimed scope, it must be examined whether the higher odour strength shown for the four particular claimed compositions of the comparative report (document (30)) can be extrapolated to any compositions having at least four ingredients as listed in claim 1 of the seventh auxiliary request.

The fragrance ingredients listed in claim 1 are known fragrances having no structural characteristic in common. Accordingly, it cannot be predicted for example from structure similarities between the individual fragrances listed in claim 1 that higher odour strength would also be expected for any combination of the listed individual fragrances. It is therefore not credible from the data provided by the appellant that the odour of all fragrance compositions according to claim 1 would also be more intense than that of the compositions disclosed in document (15).

The appellant contends that the burden of proof lies by the respondent to prove that the technical problem is not solved across the breadth of the claims. However, in the present case, since the extrapolation of the higher odour intensity of the four fragrance compositions tested to any composition of claim 1 lacks the required reasoning or experimental evidences to support its plausibility, the burden to prove that the technical effect alleged by the appellant is not achieved across the breath of claim 1 has not been shifted to the respondents.

2.5 *Reformulation of the technical problem*

The technical problem has therefore to be reformulated in a less ambitious manner, namely as the provision of alternative hypoallergenic fragrance compositions.

2.6 *Obviousness*

Finally, it remains to be decided whether or not the proposed solution to this objective technical problem is obvious in view of the state of the art.

Claim 14 of document (15) taught that the content of the cosmetic composition consists of at least 80% of fragrances selected from *inter alia* benzyl acetate, benzaldehyde, heliotropine, cis hex-3-en-1-ol, amyl acetate, terpineol, vanillin, 2-phenylethanol and 2-phenylethyl acetate. Claim 3 of document (15) taught that the composition can be made of at least four fragrances selected from *inter alia* benzyl acetate, benzaldehyde, heliotropine, cis hex-3-en-1-ol, 2-phenylethanol and 2-phenylethyl acetate

In view of that prior art, providing a cosmetic composition comprising at least 85% of at least four fragrances selected from benzyl acetate, benzaldehyde, heliotropine, cis hex-3-en-1-ol, 2-phenylethanol and 2-phenylethyl acetate lies within the routine activity of the skilled person faced with the problem of providing an alternative fragrance composition. He would thereby arrive at the claimed subject-matter without exercising an inventive activity.

The appellant argued that the skilled person would have no incentive to provide a composition according to

claim 1 of the seventh auxiliary request, even for providing a further hypoallergenic composition. However, nothing was submitted by the Appellant from which the Board could reasonably conclude that the skilled person would have been discouraged from following the straight teaching of document (15) regarding the amount and the nature of the fragrance ingredients. As no specific motivation is required to make an arbitrary choice of a particular embodiment from a host of embodiments in order to provide a mere alternative, the subject-matter of claim 1 lacks an inventive step pursuant to Article 56 EPC.

Main and auxiliary requests 1 to 6

3. Since the embodiment defined in claim 1 of the seventh auxiliary request is encompassed by claim 1 of the main request and claim 1 of the first to sixth auxiliary requests, these requests share the fate of the seventh auxiliary request in that they are not allowable for lack of inventive step pursuant to Article 56 EPC.
4. As a result, the Appellant's main request and first to seventh auxiliary requests are not allowable.

It is thus not necessary for the Board to decide on the issues of novelty and sufficiency of disclosure.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated