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**Datasheet for the decision  
of 5 October 2021**

**Case Number:** T 1233/17 - 3.3.10

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A61L9/14, C11D3/50, C11D7/26,  
C11D3/00, A61K8/49

**Language of the proceedings:** EN

**Title of invention:**

Malodour reducing composition and uses thereof

**Patent Proprietor:**

Takasago International Corporation

**Opponent:**

Beiersdorf AG

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(a), 56, 104(1)

RPBA 2020 Art. 16(1)

**Keyword:**

Inventive step - (no)

Apportionment of costs - (no)

**Decisions cited:**

T 2165/08

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 1233/17 - 3.3.10

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.10**  
**of 5 October 2021**

**Appellant:** Beiersdorf AG  
(Opponent) Unnastrasse 48  
20253 Hamburg (DE)

**Respondent:** Takasago International Corporation  
(Patent Proprietor) 37-1, Kamata 5-chome,  
Ohta-ku  
Tokyo-to 144-8721 (JP)

**Representative:** Cabinet Beau de Loménie  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 24 March 2017  
rejecting the opposition filed against European  
patent No. 2110118 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

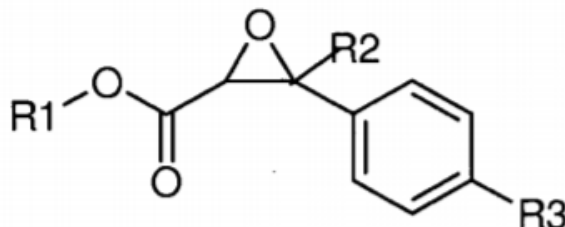
**Chair** M. Kollmannsberger  
**Members:** R. Pérez Carlón  
F. Blumer

## Summary of Facts and Submissions

- I. The appellant (opponent) appealed the decision of the opposition division rejecting the opposition against European patent No. EP 2 110 118.
- II. Notice of opposition had been filed on the ground of lack of novelty and inventive step (Article 100(a) EPC).
- III. The documents filed during the opposition proceedings include the following:
- D1 Patent Translate Powered by EPO and Google, JP2004018431, retrieved on 19 August 2015
  - D2 Patent Translate Powered by EPO and Google, JP2004315502, retrieved on 19 August 2015
  - D3 WO 2006/102052 A2
  - D4 WO 01/94521 A1
- IV. Claim 1 of the patent as granted (main request) reads as follows:

*"A malodour reducing composition consisting of:*

*A) at least one phenylglycidate of formula (1):*

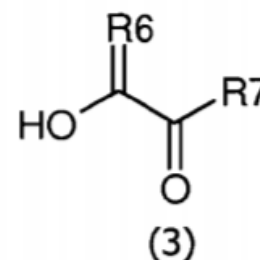
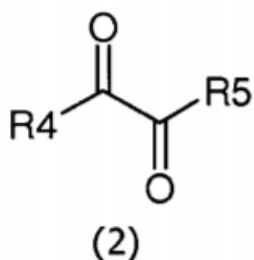


(1)

wherein:

- R1 is a C<sub>1</sub>-C<sub>4</sub> branched or linear alkyl group,
- R2 is hydrogen or methyl, and
- R3 is hydrogen, a C<sub>1</sub>-C<sub>4</sub> branched or linear alkyl group or a methoxy group, and

B) at least one 1,2 diketone of formula (2) or (3):



wherein:

- R4, R5 and R7 may be independently, a C<sub>1</sub>-C<sub>5</sub> linear or branched alkyl or alkenyl group;
- R6 is a (C<sub>1</sub>-C<sub>5</sub>) alkylidene;
- R4 and R5 may also form a C<sub>4</sub>-C<sub>7</sub> saturated or unsaturated alicyclic or heterocyclic ring structure, which may be mono-substituted or poly-substituted by (C<sub>1</sub>-C<sub>4</sub>)alkyl groups;
- R6 and R7 may also form a C<sub>4</sub>-C<sub>7</sub> unsaturated, alicyclic or heterocyclic ring structure which may be mono-substituted or poly-substituted by (C<sub>1</sub>-C<sub>4</sub>) alkyl groups;

the weight ratio of glycidate A to 1,2 diketone B being from 1:9 to 9:1."

V. The opposition division concluded that document D1 did not disclose a composition comprising components (A) and (B). The malodour reducing composition of claim 1 was thus novel.

The composition containing phenylglycidate of claim 42 of D1 was a suitable starting point for examining inventive step. The problem underlying the claimed invention was to provide compositions based on phenylglycidates which were suitable for reducing malodour and allowed a lower amount of phenylglycidates to be used. The claimed solution, characterised by combining phenylglycidates of formula (1) with diketones of formula (2) or (3), would not have been obvious for a person skilled in the art and was thus inventive.

VI. The arguments of the appellant relevant to the present decision were as follows.

The data in the patent did not show synergy of the components (A) and (B) required by claim 1, but even antagonism. The sole problem solved by the claimed invention was thus to provide a worse malodour reducing composition. The combination of components required by claim 1 would have been obvious for a person skilled in the art having regard to D1, and was thus not inventive. Also documents D2 to D4 disclosed phenylglycidates as components of fragrances. Their use in a malodour reducing composition would have been obvious for a person skilled in the art and was thus not inventive.

VII. The respondent (patent proprietor) contested the accuracy of the calculations provided by the appellant. The problem underlying the claimed invention was to provide a composition based on phenylglycidates suitable for reducing malodour, which allowed to use a lower amount of phenylglycidates. None of D1 to D4 disclosed the malodour ability of 1,2-diketones of formula (1) or (2) or compare it with that of

phenylglycidates of formula (1). The claimed invention, characterised by the combination of these components would not have been obvious for a person skilled in the art and was thus inventive.

- VIII. In preparation for the oral proceedings, the board informed the parties with a communication dated 3 December 2019 that it was inclined to conclude that document D1 did not disclose any of components (A) and (B) required by claim 1 as malodour reducing, did not hint at their combination and even less hinted at the combination of these two components only (point 4.6.2). The board was thus inclined to conclude that the claimed subject-matter was inventive and thus to dismiss the appeal.
- IX. The appellant informed the board that they would not be attending the already summoned oral proceedings, which were subsequently cancelled.
- X. With a letter dated 30 September 2021, the respondent requested the board award its costs to the appellant.
- XI. The final requests of the parties, in writing, were as follows:
- The appellant requested that the decision under appeal be set aside and the patent revoked.
  - The respondent requested that the appeal be dismissed. It also requested a different apportionment of costs.

## **Reasons for the Decision**

1. The appeal is admissible.

2. Inventive step

2.1 Claim 1 of the patent as granted, which is the respondent's main request, relates to a malodour reducing composition consisting of  
(A) at least one phenylglycidate of formula (1), and  
(B) at least one 1,2 diketone of formula (2) or (3) in a weight ratio of 1:9 to 9:1.

Claim 5 relates to a consumer product comprising said composition.

Claim 9 relates to the use of a combination of components (A) and (B) in a weight ratio of 1:9 to 9:1 as a malodour reducing agent.

2.2 Closest prior art

The opposition division and the parties considered that document D1 was the closest prior art.

Document D1 discloses an oral perfume composition comprising a perfume composition, comprising "a flavour with mint notes" and "flavors having a flavor and fruit notes with a citrus note" ([0001], claim 1). The compositions provide a refreshing feeling [0002], high palatability and persistence, and mask bad breath [0005].

The compositions disclosed in D1 can contain, among many other perfumes, p-methyl- $\beta$ -phenylglycidic ethyl and ethyl phenylglycidic acid, 3-methyl-3 (claim 42), which are components (A) as required by claim 1. They can also contain 3,4-dimethyl-1,2 cyclopentadione



(claim 55), which is a component (B).

Neither any of the phenylglycidates nor 3,4-dimethyl-1,2-cyclopentadione are disclosed in D1 as having malodour reducing ability, over and above being capable of masking it by means of their own smell.

### 2.3 Technical problem underlying the invention

The parties had different views as to the formulation of the technical problem underlying the invention.

The appellant argued that tables 5 to 7 of the patent not only proved no synergism between the components (A) and (B) required by claim 1, but even showed that they behaved antagonistically. The problem underlying the claimed invention could thus not even be considered to be to provide an alternative malodour reducing composition, as the results obtained were worse than those achieved with component (B) alone.

In favour to the appellant, it will be examined whether the claimed compositions are inventive under the assumption that the problem underlying the claimed invention is merely to provide a further malodour reducing composition.

Since, as discussed below, the claimed solution to this problem is not obvious, it is not required to examine whether a more ambitious problem had also been solved.

### 2.4 Solution

The solution to this technical problem is the composition of claim 1, characterised in that it consists of the combination of at least one

phenylglycidate of formula (1) and at least one 1,2-diketone of formula (2) or (3), in defined relative amounts.

## 2.5 Success

The appellant did not argue that the claimed compositions did not reduce malodour.

The results of examples 2, 3 and 4, reflected on tables 5 to 7 of the patent, show the effect of the claimed composition on malodour reduction. This effect is measured as the reduction of the concentration of hexylamine in the vapour phase (page 13, line 28).

Table 5 discloses the effect of beta thujaplicine (component (B) of claim 1) as a function of its concentration. Table 6 is analogous for ethyl 3-phenyl glycidate, which is a component (A) required by claim 1. Table 7 reflects the combination of the latter with 2-methyl-3-hydroxypyran-4-one. All tables show a reduction in malodour.

The problem of providing a malodour reducing composition has been thus credibly solved by the claimed compositions.

2.6 It thus remains to be decided whether the proposed solution to the objective problem defined above would have been obvious for the skilled person in view of the prior art.

2.6.1 Document D1 relates to odour masking compositions comprising, in addition to "a flavour with mint notes", "a flavour and fruit notes with a citrus note" (claim 1). Suitable flavours with a mint note are disclosed in

claim 3. Claims 4 to 64 seem to disclose those of the second type. They include two compounds of type (A) according to claim 1 in claim 42 and one of type (B) in claim 55.

D1 does not disclose components (A) and (B) of claim 1 as odour reducing, but as fragrances i.e. odour masking components. It does not hint at combining them, let alone with the relative amount required by claim 1. Lastly, it does not hint at a composition lacking a flavour with mint notes, excluded from claim 1 by the wording "consisting", which is an essential component of the compositions of D1.

D1, thus, does not hint at the claimed solution.

2.6.2 None of documents D2, D3 and D4 disclose 1,2-diketones of formula (2) or (3) required by claim 1.

The appellant relied on page 15, line 12, of D2. It would appear, however, that the reference referred to D3. D3 discloses in this passage a compound of formula (1) as a perfume which can be part of a deodorant composition. It does not disclose it as malodour reducing.

D4 (claim 3) also discloses a compound of formula (1) defined in claim 1 as perfume component in a fabric care composition. None of them is disclosed as a malodour reducing agent. This document does not thus hint towards the claimed solution, either.

D2 does not disclose glycidates of formula (1) required by claim 1, at least not in the passage on page 14, line 12, quoted by the appellant. The opposition division arrived at the same conclusion in this

respect.

Thus, D2, D3 and D4 do not hint at the claimed solution, either.

2.6.3 The appellant argues that it was to be expected that the combination of components (A) and (B) was more active than the less active component (A) alone, and less active than the more active component (B) alone.

However, the appellant has failed to show that it was state of the art that any of components (A) and (B) required by claim 1 had, on their own, malodour reducing activity. This is only disclosed in the patent. This argument is thus not convincing.

2.6.4 Independent claim 5 relates to a consumer product comprising a defined amount of a composition which is a combination of components (A) and (B) at a relative weight ratio of 1:9 to 9:1. It can thus contain other components further to (A) and (B), including a "flavour with mint notes" as disclosed in D1.

The arguments provided in points 2.6.1 and 2.6.2 above, however, apply analogously. D1 does not disclose any of components (A) and (B) as odour reducing and does not hint at their combination, let alone at the relative amount required by claim 5.

The same arguments also apply to the use of a combination of components (A) and (B) in a weight ratio of 1:9 to 9:1 as a malodour reducing agent of claim 9. The skilled person would not have considered using that combination as malodour reducing agent.

3. Conclusion

The claimed subject-matter is inventive (Article 56 EPC) and the opposition ground pursuant to Article 100(a) EPC does not preclude the maintenance of the patent as granted.

4. Costs

- 4.1 With a letter dated 30 September 2021, the respondent requested the board to award its costs to the appellant. It gave the reasons that follow:

The appellant did not reply to the board's preliminary opinion issued, dated 3 December 2019, to concur with the opposition division's conclusions in the appealed decision.

The appellant also failed to reply to the board's communication dated 29 April 2020 in which the board informed the parties on the postponement of the oral proceedings due to the COVID-19 pandemic.

The appellant announced that it would not take part in the oral proceedings only after the EPO organised the required interpretation, and the respondent's representative had conducted a test call in order to prepare the videoconference.

By failing to respond to the board's preliminary view and informing of its non-attendance to the oral proceedings at such a late stage, the appellant forced the respondent to perform a considerable amount of unnecessary preparatory work.

4.2 Under Article 104(1) EPC, each party to opposition proceedings bears the costs it has incurred, unless the opposition division, for reasons of equity, orders a different apportionment of costs. This principle applies equally to opposition-appeal proceedings in view of Article 111(1) EPC in conjunction with Rule 100(1) EPC (see T 2165/08 of 6 March 2013, Reasons 45). For appeal proceedings, Article 16(1) RPBA gives further guidance under which circumstances ordering a party to pay some or all of an other parties costs may be equitable.

4.3 The appellant filed no substantive submissions subsequent to the statement of grounds of appeal. However, it was not obliged to do so. This is why the the board's preliminary view on the case started by the wording "*if a party intends to reply*".

Following the principle of party's disposition, it is a party's right to request oral proceedings, and to maintain its request for as long as it suits its case. A party is also free to waive that right at any point of the proceedings.

Interpretation is paid by the users' fees, and should be demanded responsibly. The EPC foresees however no consequence if these resources are claimed, but remain unused. The respondent incurred in any case no direct costs in this respect.

Lastly, the respondent has not carried out any work or made expenses which went beyond what would have been required if oral proceedings had taken place. This is the key point under Articles 104(1) EPC and 16 RPBA 2020.

4.4 The respondent's request for a different apportionment of costs is thus refused.

## Order

### **For these reasons it is decided that:**

The appeal is dismissed.

The respondent's request for a different apportionment of costs is refused.

The Registrar:

The Chair:



C. Rodríguez Rodríguez

M. Kollmannsberger

Decision electronically authenticated