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**Datasheet for the decision
of 2 September 2022**

Case Number: T 2215/18 - 3.3.07

Application Number: 11757646.2

Publication Number: 2618803

IPC: A61K8/34, A61K8/73, A61K8/891,
A61Q1/04, A61Q19/00

Language of the proceedings: EN

Title of invention:
AQUEOUS COSMETIC COMPOSITION COMPRISING ALKYLCELLULOSE

Patent Proprietor:
L'Oréal

Opponent:
Parfums Christian Dior

Headword:
Aqueous cosmetic compositions comprising alkylcellulose/ DIOR

Relevant legal provisions:
EPC Art. 123(2), 123(3), 56
RPBA Art. 12(4), 13(2)
RPBA 2020 Art. 13(1)

Keyword:

Main request and auxiliary requests I-VI - Extension beyond the content of the application as filed (yes)

Auxiliary requests VII-XIII - Admission into the proceedings (Yes)

Auxiliary request VII - Extension beyond the content of the application as filed (No)

Auxiliary request VII - Broadening of the claim (No)

Auxiliary requests VII-XIII - Inventive step (No)

Auxiliary requests XIV-XX - Extension beyond the content of the application as filed (Yes)

Auxiliary request XXI - Admission into the proceedings (No)

Decisions cited:

T 1360/11, T 1063/15



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Case Number: T 2215/18 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 2 September 2022

Appellant: Parfums Christian Dior
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
5 July 2018 concerning maintenance of the
European Patent No. 2618803 in amended form.**

Composition of the Board:

Chairman A. Usuelli
Members: D. Boulois
L. Basterreix

Summary of Facts and Submissions

- I. European patent No. 2 618 803 was granted on the basis of a set of 20 claims.
- II. The patent had been opposed under Article 100 (a), (b), (c) EPC on the grounds that its subject-matter lacked novelty and inventive step, was not sufficiently disclosed, and extended beyond the content of the application as filed.
- III. The appeal lies from the decision of the opposition division finding that the patent in amended form met the requirements of the EPC. The decision was based on the main request filed during the oral proceedings of 11 June 2018.

Claim 1 of the main request read:

"1. Cosmetic composition for making up and/or caring for the lips comprising, in a physiologically acceptable medium:

- at least 5% by weight of water;
- at least alkylcellulose, the alkyl residue of which comprises between 1 and 6 carbon atoms and preferably between 1 and 3 carbon atoms, said alkylcellulose being present in a content of between 1% and 60% by weight relative to the total weight of the composition; said alkylcellulose being at least ethylcellulose;
- at least one first hydrocarbon-based non-volatile oil liquid at room temperature, i.e. 25°C and atmospheric pressure i.e. 760 mm Hg, chosen from:
 - C₁₀-C₂₆ alcohols, preferably monoalcohols;

- optionally hydroxylated monoesters, diesters or triesters of an optionally hydroxylated C₂-C₈ monocarboxylic or polycarboxylic acid and of a C₂-C₈ alcohol;
- esters of a C₂-C₈ polyol and of one or more C₂-C₈ carboxylic acids
- at least one second non-volatile oil liquid at room temperature, i.e. 25°C and atmospheric pressure i.e. 760 mm Hg chosen from apolar hydrocarbon-based oils other than the first oil wherein the term "apolar oil" means an oil whose solubility parameter at 25°C, δ_a is equal to 0 (J/cm³)^{1/2},
- at least one stabilizer chosen from surfactants and/or hydrophilic gelling agents, preferably chosen from associative polymers, natural polymers or their mixture."

IV. The documents cited during the opposition proceedings were inter alia the following:

- D1: US 4 699 779 A
- D2: EP 0 861 657 A2
- C1: EP 1 192 937 A2
- C2: Handbook of Food, Drug and Cosmetic Excipients, Susan C. Smolinske, CRC Press, 1992
- C3: EP 795 318 A2
- C4: WO 2012/038879 A2
- C7: US 2006/0019848 A1
- C11: US 2005/0276763 A1
- C12: Experimental report of the opponent dated 13 Mai 2016
- C13: US 4 683 134 A
- C14: JP 2000-219617 traduction automatisée
- C32: Experimental report of the opponent dated 03.04.2018

V. According to the decision under appeal, the requirements of Article 123(2) EPC were fulfilled.

As regards the parameters of volatility and polarity, the opposition considered them to be sufficiently disclosed.

As regards novelty, none of examples 1, 3, 4 of C1, example 7 of C14 or example 7 of C13 could anticipate the claimed subject-matter. The opposition division considered that document C4 did not belong to the state of the art under Article 54(3) EPC.

Document D2 was considered to be the closest prior art by the opposition division, since it dealt specifically with film-forming compositions comprising ethylcellulose. The subject-matter of claim 1 of the main request differed from the compositions of D2 in that an apolar non-volatile hydrocarbon based oil was present, and in that water was present with a minimum of 5% by weight. In view of a comparison disclosed in C32, the presence of an apolar oil could not be linked with a technical effect; a technical effect linked with the presence of water was neither observed. Thus, the problem was seen as the provision of an alternative lip composition. The claimed alternative was not rendered obvious in view of D2 or any other document.

VI. The opponent (hereinafter the appellant) filed an appeal against said decision. With the statement of grounds of appeal dated 15 November 2018, the appellant filed the following items of evidence:

C37: EP 2 116 221

C38: Déclaration de M.C. Hansen dated 14 November 2018

C39: Perry's Chemical Engineers' Handbook, 7th Edition, 1997, pages 2-50 à 2-54

C40: Polymer Handbook, 4th Edition, Brandrup, Immergut and Grulke, Associate Editors A. Abe and D.R. Bloch, 1999, page 698

C41: Rapport d'essais de l'opposant

VII. With a letter dated 1 April 2019 the patent proprietor (hereinafter the respondent) filed a main request and auxiliary requests I to XIII, and submitted following items of evidence:

C42: Rapport d'essais du breveté

C43: Mesure de volatilité du Parléam® IV

C44: Extrait base de données L'Oréal

C45: Rapport d'essais de compatibilité Huiles Parléam®/ Huile de ricin

The subject-matter of the independent claim 1 of the requests was modified as following, difference(s) compared with claim 1 of the main request as maintained by the opposition division shown in bold.

Main request

Claim 1 of the main request was modified by a restriction in the amount of water, namely "**between 15% and 50%** by weight of water".

Auxiliary request I

Claim 1 of auxiliary request I was modified by a restriction in the amount of water and the first hydrocarbon-based non-volatile oil, namely "**between 15% and 50%** by weight of water" and "**said first hydrocarbon-based non-volatile oil being present in a**

content ranging from 10% to 50% by weight relative to the total weight of the composition".

Auxiliary request II

Claim 1 of auxiliary request II was restricted in the selection of the second non-volatile oil liquid at room temperature, namely "**chosen from linear or branched hydrocarbons of mineral or synthetic origin, which are:**

- liquid paraffin or derivatives thereof,
- liquid petroleum jelly,
- naphthalene oil,
- polybutylenes,
- hydrogenated polybutylenes,
- decene/butene copolymers, polybutene/polyisobutene copolymers,
- polydecenes and hydrogenated polydecenes,
- and mixtures thereof;"

Auxiliary request III

Claim 1 of auxiliary request III was modified by a restriction in the amount of water, namely "**between 15% and 50%** by weight of water", and by the selection of the second non-volatile oil liquid at room temperature, namely "**chosen from linear or branched hydrocarbons of mineral or synthetic origin, which are:**

- liquid paraffin or derivatives thereof,
- liquid petroleum jelly,
- naphthalene oil,
- polybutylenes,
- hydrogenated polybutylenes,
- decene/butene copolymers, polybutene/polyisobutene copolymers,
- polydecenes and hydrogenated polydecenes,
- and mixtures thereof;"

Auxiliary request IV

Claim 1 of auxiliary request IV was modified by a restriction in the amount of alkylcellulose, namely "said alkylcellulose being present in a content of between **4% and 30%** by weight relative to the total weight of the composition".

Auxiliary request V

The subject-matter of claim 1 of auxiliary request V was amended by the feature "**the cosmetic composition being in liquid form**".

Auxiliary request VI

The subject-matter of claim 1 was modified to a "**Cosmetic process for making up and/or caring for the lips comprising at least one step that consists in applying to the lips at least one cosmetic composition...**", wherein the composition was as claimed in the main request as maintained by the opposition division.

Auxiliary request VII

The subject-matter of claim 1 was modified by a restriction in the amount of water, namely "**between 15% and 50%** by weight of water" and by the feature "**with said alkylcellulose being ethylcellulose**".

Auxiliary request VIII

In comparison to auxiliary request VII, claim 1 of auxiliary request VIII was further amended by the

feature "**said first hydrocarbon-based non-volatile oil being present in a content ranging from 10% to 50% by weight relative to the total weight of the composition**".

Auxiliary request IX

Claim 1 of auxiliary request IX was amended by the feature "**with said alkylcellulose being ethylcellulose**", and restricted in the selection of the second non-volatile oil liquid at room temperature, namely "**chosen from linear or branched hydrocarbons of mineral or synthetic origin, which are:**

- liquid paraffin or derivatives thereof,
- liquid petroleum jelly,
- naphthalene oil,
- polybutylenes,
- hydrogenated polybutylenes,
- decene/butene copolymers, polybutene/polyisobutene copolymers,
- polydecenes and hydrogenated polydecenes,
- and mixtures thereof;"

Auxiliary request X

In comparison to auxiliary request IX, claim 1 of auxiliary request X was amended by the amount of water, namely "**between 15% and 50% by weight of water**".

Auxiliary request XI

The subject-matter of claim 1 was modified by the feature "**with said alkylcellulose being ethylcellulose**" and by the indication that "**said alkyl cellulose being present in a content between 4% and 30% by weight**".

Auxiliary request XII

The subject-matter of claim 1 was modified by the features **"with said alkylcellulose being ethylcellulose"** and **"the cosmetic composition being in liquid form"**.

Auxiliary request XIII

The subject-matter of claim 1 was modified to a process claim, namely **"Cosmetic process for making up and/or caring for the lips comprising at least one step that consists in applying to the lips at least one cosmetic composition..."**, wherein the composition was amended by the feature **"with said alkylcellulose being ethylcellulose"**.

- VIII. With a letter dated 27 September 2019 the respondent requested an accelerated appeal proceedings.
- IX. With a letter dated 15 November 2019, the appellant filed following documents:
- C46: Household & Personal Products Industry, March 1, 2007
 - C47: Nikkomulse WO (Updated 2005-08), Notice technique du fabricant Nikko Chemicals Co. Ltd.
 - C48: Guide de Formulation du fournisseur IMCD (Septembre 2017) C49:FR 2 924 604
 - C50: FR 2 831 433
 - C51: Paraffins-Chemistry and Technology by F. Asinger (1968), page 63
 - C52: Low-temperature Thermal Data for Paraffin Hydrocarbons, H. L.Finke, page 333-341, Jan, 20,1954
 - C53: Essais comparatifs par rapport à C1 réalisés par l'opposant

C54: Essais comparatifs par rapport à D2 réalisés par l'opposant

C55: Rapport expérimental concernant le document C37 réalisé par l'opposant

C56: US 2003/0108579

C57: US 2006/0165640

X. A communication from the Board, dated 26 November 2019, was sent to the parties. In it the Board expressed its preliminary opinion that the main request did not appear to meet the requirements of Article 123(2) EPC and was not inventive.

XI. With a letter dated 3 April 2020, the respondent filed auxiliary requests XIV-XX and the following items of evidence:

C58: WO 2018/096262 A1 (LVMH Recherche)

C59: EP 2 836 189 B1 (Chanel Parfums Beauté)

C60: EP 2 947 496 B1 (Parrot Drones)

C61: WO 2019/122779 A1 (LVMH Recherche)

C62: Essais expérimentaux par rapport à C1/C53

C63: Essais expérimentaux par rapport à D2/C54

C64: Essais expérimentaux par rapport à D2/C32

The subject-matter of claim 1 of all auxiliary requests XIV-XX was characterised *inter alia* by the presence of the feature "**said composition comprising ethylcellulose**".

XII. Oral proceedings took place on 2 September 2022. During the oral proceedings, the respondent filed an auxiliary request XXI. In comparison to claim 1 of the main request as maintained by the opposition, the subject-matter of claim 1 of auxiliary request XXI was amended by the following features:

- "between 15% and 50% by weight of water",
- "chosen from linear or branched hydrocarbons of mineral or synthetic origin, which are:
 - liquid paraffin or derivatives thereof,
 - liquid petroleum jelly,
 - naphthalene oil,
 - polybutylenes,
 - hydrogenated polybutylenes,
 - decene/butene copolymers, polybutene/
polyisobutene copolymers,
 - polydecenes and hydrogenated polydecenes,
 - and mixtures thereof;"
- "said first non-volatile hydrocarbon-based oil being present in a content ranging from 5% to 75% by weight, relative to the total weight of the composition, and said composition comprising a content ranging from 5% to 75% by weight of second non-volatile oil(s) other than the said first oil".

XIII. The arguments of the appellant may be summarised as follows:

Main request and auxiliary requests I-VI - Amendments

Ethylcellulose was not disclosed in combination with another alkylcellulose in the application as filed, in particular in view of original dependent claim 7 , which disclosed that the ethylcellulose was chosen among several possibilities from a list.

Admission of auxiliary requests VII-XIII

The admission of the auxiliary requests in the appeal proceedings was contested since some requests were not convergent with the main request, and since no justification and motivation was given as for the

submission of these requests. Moreover, the requests comprised a feature which had been withdrawn during the opposition proceedings.

Auxiliary request VII - Amendments

Claim 1 was a combination of features which was not derivable from the application as filed, namely with regard to the selection of ethylcellulose, its amount, the amount of water, the second non-volatile oil, and the treatment of the lips.

Moreover, the restriction to ethylcellulose, while keeping the composition open through the use of the term "comprising" led to an infringement of the requirements of Article 123(3) EPC.

Admission of documents C37-C41 into the proceedings

C37 was relevant and self sufficient with regard to novelty. C38 was a declaration in reaction to the decision of the opposition division with regard to the claimed parameter, and C41 showed the instability of the compositions, and that they were adapted for an administration onto the lips.

Admission of documents C46-C57 into the proceedings

C46-C48 were filed in reaction to C41 and C42, while C49 and C50 were a reaction to C45.

C51 and C52 were a reaction to the requests of the respondent. They were filed in support to the objection for lack of novelty over C37.

C53 were experiments over C1 as closest prior art, to show the absence of technical effect, while C54 were experiments over D2 as closest prior art.

C56 and C57 were patent documents filed in reaction to D2, to show that some oils were apolar non volatile oils.

Admission of documents C58-C64 into the proceedings

C58-C61 were patent documents cited with regard to the objections raised against the solubility parameter and were not relevant.

C62, C63 and C64 are experiments over respectively C1, and D2 for C63 and C64. These tests did not reproduce the disclosure of the prior art and were irrelevant.

Auxiliary request VII - Inventive step

If D2 was taken as closest prior art, the claimed subject-matter differed in the amount of water and the presence of a second hydrocarbon oil. The problem to be solved was the provision of an alternative composition adapted for lips care. There was no example in the patent or in any filed experiments which could support the existence of an effect; neither C12 nor C41 could provide a reliable comparison. The claimed solution was obvious in view of D2 and C16.

Auxiliary request VIII-XIII - Inventive step

There were no further arguments for auxiliary requests VIII and IX.

With regard to auxiliary request X, there was no change over D2, since paraffin is disclosed in C1. There was nothing specific about the claimed oils.

The argumentation was the same for auxiliary requests XI-XIII.

Auxiliary requests XIV-XX - Amendments

None of these requests met the requirements of Article 123(2) EPC for the same reason than the main request.

Auxiliary request XXI - Admission into the appeal proceedings

The respondent introduced a combination of features which was not present in any other requests on file. It should have been filed earlier, since D2 was cited as relevant for inventive step from the beginning of the opposition proceedings. The filing of such request at a late stage was not equitable for the appellant, since all arguments had to be re-evaluated, with a possible continuation of the written proceedings.

XIV. The arguments of the respondent may be summarised as follows

Main request and auxiliary requests I-VI - Amendments

The feature "with said alkylcellulose being at least ethylcellulose" found a basis in the original application, since it was obvious that a mixture of alkylcelluloses was envisaged (see page 1, line 29; page 5, lines 9-11; page 57 line 29; claim 7 of the application as filed).

There were no further arguments in relation to auxiliary requests I-VI.

Admission of auxiliary requests VII-XIII

The requests were filed at an early stage of the appeal proceedings, and incorporated features which were filed and discussed during the opposition proceedings.

Auxiliary request VII - Amendments

All the features of claim 1 originated from dependent claims, and were all conform to the compositions shown in the examples.

Admission of documents C37-C41 into the proceedings

C37 was a new document cited for novelty, and constituted a fresh case. This document appeared to be *prima facie* not relevant.

C38 was late-filed and could have been filed earlier, while C41 were tests on the stability, which was not the most important problem.

Admission of documents C42-C45 into the proceedings

All documents were filed for the assessment of inventive step, and were admissible for this reason.

Admission of documents C46-C57 into the proceedings

All these documents should have been filed earlier. C49 and C50 related to the product Parleam®, the issues concerning this products had already been discussed

during the opposition proceedings. C51-C52 related to the new objection over C37.

Admission of documents C58-C64 into the proceedings

C58-C61 were a reaction to arguments and documents from the appellant.

C62-C64 were filed in reaction to experiments filed by the respondent with the letter of 19 November 2019.

Auxiliary request VII - Inventive step

The distinguishing features of claim 1 over D2 were the amount of water and the presence of a second non-volatile oil. The technical problem over D2 was the provision of a lips composition with a non tacky character. There was a technical prejudice against the addition of water in D2, since all compositions were anhydrous. Ethylcellulose was insoluble in water, and the skilled person would not have selected water as a possible excipient in the compositions of D2. C16 did not disclose compositions comprising ethylcellulose and was not relevant for this reason. Document C12 provided a comparison with D2.

If the problem had to be defined as the provision of an alternative the claimed solution would also be inventive.

Auxiliary request VIII-XIII - Inventive step

There was no further arguments for auxiliary requests VIII, IX and XI to XIII. In claim 1 of auxiliary request X, there was a specific list for the second oil, which was not disclosed in D2, thereby providing a

further distinguishing feature. There was no document which envisaged to combine these oils with ethylcellulose.

Auxiliary requests XIV-XX - Amendments

There was no further arguments.

Auxiliary request XXI - Admission into the appeal proceedings

This request comprised two new characteristics, namely the amounts of the first and second oils. There were no supplementary differences, since these features were present in the dependent claims, and the appellant should have taken position on these features. The request presented therefore no complexity.

XV. Requests

The appellant requested that the decision under appeal be set aside and that the European patent No 2 618 803 be revoked. The appellant also requested that auxiliary requests I-XXI and documents C58-C64 not be admitted into the proceedings.

The respondent requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or, alternatively, on the basis of one of auxiliary requests I-XIII, all filed with letter dated 1 April 2019, or auxiliary requests XIV-XX filed with letter dated 3 April 2020, or auxiliary request XXI filed during the oral proceedings held on 2 September 2022 . The respondent also requested that documents C37-C41, C46-C57 and C65 not be admitted into the proceedings.

Reasons for the Decision

1. Main request - Amendments

- 1.1 Claim 1 of the main request comprises the feature : "at least alkylcellulose, the alkyl residue of which comprises between 1 and 6 carbon atoms and preferably between 1 and 3 carbon atoms, said alkylcellulose being present in a content of between 1% and 60% by weight relative to the total weight of the composition with **said alkylcellulose being at least ethylcellulose;**".

In view of the feature "said alkylcellulose being at least ethylcellulose", claim 1 also relates to mixtures of ethylcellulose with any other alkylcellulose with C₁-C₆ carbon atoms, an interpretation that was acknowledged and agreed to by the respondent.

- 1.2 The original application disclosed in claim 1 a composition comprising "at least alkylcellulose", while dependent claim 6 specified that "the alkylcellulose is present in an amount of between 1% and 60% by weight", and dependent claim 7 that "the alkylcellulose is chosen from methylcellulose, ethylcellulose, and...".

Hence, the original claims do not disclose a composition comprising ethylcellulose in combination with other different C₁-C₆ alkylcellulose compounds.

- 1.3 The further passages mentioned by the respondent do neither provide a disclosure of a mixture of ethylcellulose and other alkylcelluloses :
- the statement on page 1, line 29, i.e. "ethylcellulose and alkylcellulose in general...is of limited solubility in..." refers to the general

technical background of the invention, and does anyway not provide any information with regard to mixtures.

- the same conclusion applies for the general statement on page 5, lines 9-11, i.e. "the combination of the oils...proves to be particularly advantageous for formulating alkylcelluloses, preferably such as ethylcellulose...".

- the passage on page 57, lines 28-31 mentions that "a composition according to the invention comprises at least one silicone gum and at least one alkylcellulose...". This passage discloses the presence of a mixture of alkylcelluloses, but relates to a specific embodiment comprising a silicone gum and is not generalisable to the subject-matter of claim 1 of the main request. Above all, it does not refer to a mixture of ethylcellulose with any other alkylcellulose having 1 to 6 carbon atoms.

1.4 All examples 1-16 of the original application relate to compositions comprising ethylcellulose as unique alkylcellulose.

1.5 Consequently, a composition comprising ethylcellulose in combination with another alkylcellulose is not derivable directly and unambiguously from the application as filed, and the main request does not meet the requirements of Article 123(2) EPC.

2. Auxiliary requests I-VI

Since independent claims 1 of auxiliary requests I-VI contain all the same feature "**said alkylcellulose being at least ethylcellulose**", the finding on the main request in relation to this amendment applies equally to auxiliary requests I-VI, which do not meet the requirements of Article 123(2) EPC. It is therefore not

necessary to discuss the admission of these requests into the appeal proceedings.

3. Admission of auxiliary requests VII-XIII into the appeal proceedings

Auxiliary requests VII-XIII were filed in response to the statement of grounds of appeal, at the earliest stage of the appeal proceeding. The filing of all these requests was furthermore motivated in the respondent's reply to the appeal.

In its statement of grounds of appeal, the appellant made numerous objections under Articles 123(2), 123(3), 84, 100(b), 54 and 56 EPC. Accordingly, the filing of requests in response to said objections appears legitimate and to be expected.

Moreover, the feature **"with said alkylcellulose being ethylcellulose"** corresponded to a feature which was considered not to meet the requirements of Article 123(3) EPC by the opposition division; this feature is therefore not new.

The Board sees no reason to consider that these requests should have been filed already during the first instance proceedings. Consequently, the Board decides to admit auxiliary requests VII-XIII into the appeal proceedings (Article 12(4) RPBA 2007).

4. Auxiliary request VII - Amendments

4.1 The subject-matter of claim 1 of auxiliary request VII differs from claim 1 as originally filed by following features:

a) "between 15% and 50% by weight" of water,

b) "said alkylcellulose being present in a content of between 1% and 60% by weight relative to the total weight of the composition",
c) "with said alkylcellulose being ethylcellulose",
d) at least one second non-volatile oil "liquid at room temperature, i.e. 25°C and atmospheric pressure i.e. 760 mm Hg chosen from apolar hydrocarbon-based oils other than the first oil, wherein the term "apolar oil" means an oil whose solubility parameter at 25°C, δ_a is equal to 0 (J/cm³)^{1/2}".

4.2 Feature a) finds a basis in originally filed dependent claim 13, whereas feature b) finds a basis in originally filed dependent claim 6. Concerning feature c), the Board notes that ethylcellulose is constantly presented in the original application as the preferred alkylcellulose (see *inter alia* page 7, lines 3 or 21) and is present in all the examples.

As regards point d), the restriction to a specific apolar hydrocarbon-based oil is based on the embodiment disclosed on pages 21, lines 26 to 31, and 22 of the original description.

Consequently, the subject-matter of claim 1 is derivable directly and unambiguously from the original application and auxiliary request VII meets the requirements of Article 123(2) EPC.

4.3 In the present case, an objection under Article 123(3) EPC against claim 1 of auxiliary request VII arose from the limitation of the claimed alkylcellulose, present in an amount "between 1% and 60% by weight", to a qualitatively restricted specific alkylcellulose, namely ethylcellulose, while keeping the term "comprising" for defining the composition.

An extension of the scope of the claims may indeed arise when a granted claim directed to a composition defined in an open manner, i.e. by means of the term "comprising", and including the presence of components belonging to a class of compounds (in the present case: alkylcellulose), in a quantity defined by a range, is later amended by qualitatively limiting the class of compounds to a specific compound or a more specific list of compounds (in the present case: ethylcellulose). In such a case, in spite of the apparent limitation due to the explicit mention of some members of the class of compounds, the wording of the granted and the amended claims may be such that the qualitatively restricted compounds are required to be present in an amount within a defined range according to the granted claim, while other compounds belonging to the same class of compounds, but not to the restricted list or compound now claimed, may still be present, but with no limitation in quantity, according to the amended claim, therefore resulting in an extension of the protection conferred contrary to the requirements of Article 123(3) EPC.

Such possible infringement of the requirements of Article 123(3) EPC may be avoided by keeping in the amended claim the quantitative condition on the class of compounds as in the claim as granted and including an additional qualitative constraint on the nature (cf for instance T 1360/11 (catchword) and T 1063/15 (point 1)).

In the present case, the Board considers that the wording of amended claim 1 of auxiliary request VII, namely **"with said alkylcellulose being ethylcellulose"** in combination with the feature already present in

claim 1 as granted "at least alkylcellulose, the alkyl residue of which comprises between 1 and 6 carbon atoms and preferably between 1 and 3 carbon atoms, said alkylcellulose being present in a content of between 1% and 60% by weight relative to the total weight of the composition" makes clear that no other alkylcellulose than ethylcellulose may be comprised in the composition, and that the protection conferred by the patent is not extended.

Consequently, auxiliary request VII does not infringe Article 123(3) EPC.

5. Admission of documents C37-C65 into the proceedings

5.1 Documents C37-C41

5.1.1 Documents C37 to C41 were filed by the appellant with its statement of grounds of appeal.

Document C37 is a newly filed document to support new attacks on novelty and inventive step. The admittance of such a late-filed evidence is to be decided under the provision of Article 12(4) RPBA 2007. In exercising its discretion the Board considers, among other factors, whether or not the late filing is justified by developments in the procedure. First, the Board notes that no justification was given by the appellant for the late filing of this document in its statement of grounds of appeal. This document represents furthermore a fresh case, in view of the new line of argumentation as regards novelty and/or inventive step, which is not justified by the decision of the opposition division. Consequently, the Board decides to not admit this document into the appeal proceedings (Article 12(4) RPBA 2007).

C39 and C40 are common general knowledge documents relating to the vapour pressure and the solubility of certain compounds. They were used to support the new objection of lack of novelty over C37. For the same reasons as C37, the Board decides to not admit these documents into the appeal proceedings (Article 12(4) RPBA 2007).

The documents C38 and C41 have been cited at the earliest stage of the proceedings, in response to the decision of the opposition division as regards respectively the ground of sufficiency of disclosure relating to the δa parameter and the ground of inventive step regarding the stability of the composition. Hence, both documents present a clear link to the decision of the opposition division. These documents are therefore admitted into the appeal proceedings (Article 12(4) RPBA 2007).

5.1.2 Documents C42-C45

Documents C42-C45 have been filed by the respondent in response to the statement of grounds of appeal of the appellant and in response to the decision of the opposition division. C42 is a direct response to C41 filed by the appellant, while documents C43-C45 are submitted in relation to the conclusions of the opposition division with regard to the experiments C12 and C32. Consequently, the documents C42-C45 are admitted into the appeal proceedings (Article 12(4) RPBA 2007).

5.1.3 Documents C46-C57

These documents have been submitted by the appellant with its letter dated 15 November 2019, before the issue of the summons to oral proceedings. Consequently, Article 13(1) RPBA 2020 applies.

C46-C48 are documents of common general knowledge having a possible relationship with C41 and C42, and do not add any complexity to the case. The same applies to documents C49 and C50, which are patent documents filed to counter an argument from the respondent relating to C45 and the compatibility of ricinus oil and Parleam®. Consequently, documents C46-C50 are admitted into the appeal proceedings (Article 13(1) RPBA 2020).

Documents C51 and C52 were filed in support of the new objection of lack of novelty over C37. In view of the non-admittance of C37, there is no reason to admit these documents into the appeal proceedings (Article 13(1) RPBA 2020). The same applies to C55, which is a report on a formulation used in an example of C37.

C53 and C54 were experiments filed for the assessment of inventive step over respectively C1 and D2 which were filed at the beginning of the opposition proceedings. Considering that C53 and C54 cannot be seen as a reaction to the decision of the opposition division or to the filing of new facts or arguments submitted by the respondent in the appeal proceedings, the Board takes the view that C53 and C54 could and should have been filed earlier. The filing of these documents opens also a new discussion on their content and their relevance for the assessment of inventive step, since they do not indicate whether the oils used for the experiments are volatile or non-volatile,

adding complexity to the proceedings. Consequently, they are not admitted into the appeal proceedings (Article 13(1) RPBA 2020).

C56 and C57 are patent documents, and were filed in support of the disclosure of D2, to show that some oils disclosed thereon are apolar non-volatile oils. Since D2 has been on file from the outset of the opposition proceedings and since these documents do not provide more information than the documents already on file, the Board does not see any reason to admit them into the appeal proceedings at such late stage (Article 13(1) RPBA 2020).

5.1.4 Documents C58-C64

These documents were filed by the respondent with its letter of 3 April 2020, after the Board gave its preliminary opinion.

C58-C61 are patent documents cited in the context of the discussion on sufficiency of disclosure in relation to the solubility parameter. This point was already considered during the opposition proceedings. All the documents are published after the filing date of the contested patent and their relevance is questionable inter alia for this reason. Accordingly, the Board decided not to admit C58 to C61 into the appeal procedure.

The experiments C62, C63 and C64 were filed with regard to the assessment of inventive step over respectively C1 (C62) and D2 (C63 and C64). As argued by the appellant, these documents add complexity to the case and do not appear to provide a valid comparison with C1 or D2, in view, for instance, of the nature of the oil

in C62 or the presence of water in C63 and C64. Moreover, having regard to the fact that C1 and D2 were filed at the beginning of the opposition procedure, the filing of new experimental reports at a late stage of the appeal does not appear justified. Hence, C62 to C64 are not admitted into the appeal proceedings.

Consequently, none of documents C58-C64 are admitted into the appeal proceedings (Article 13 RPBA 2007).

6. Auxiliary request VII - Inventive step

6.1 The claimed invention is directed towards proposing cosmetic compositions comprising ethylcellulose, which are intended in particular for making up and/or caring for the lips or the skin, especially the lips, which are capable of producing a deposit, especially a make up deposit, which shows good cosmetic properties, especially in terms of comfort, absence of tackiness and gloss. The claimed compositions are capable of forming on the skin and/or the lips a deposit that has gloss and comfort properties and that is not tacky.

6.2 D2 was considered as the closest prior art document by the opposition division in its decision and is also the choice of the respondent. The Board agrees that this document is a suitable starting point for the assessment of inventive step.

D2 discloses monohydric alcohol-free compositions for topical use on lips or skin comprising ethylcellulose. Ethylcellulose is solubilized in a natural oil, a triglyceride, propylene glycol ester neopently glycol ester, or a fatty alcohol. Example 1 of D2 discloses a composition comprising *inter alia* 1% of ethylcellulose, octyldodecanol, polyethylene wax and a surfactant; said

composition of example 1 does not comprise water and a liquid apolar hydrocarbon oil. Other examples disclose the presence of silicones, cyclomethicone, or phenyl trimethicone as second oil.

The distinguishing features between the claimed subject-matter and the disclosure of D2 are therefore the presence of an apolar non-volatile hydrocarbon based oil and the presence of water at the claimed concentration.

- 6.3 According to the appellant, the problem has to be defined as the provision of an alternative cosmetic composition adapted for lip care. The opposition division came to the same conclusion.

The respondent defined the problem as the provision of a cosmetic composition with a non-tacky character.

- 6.4 As a solution to any of these alleged problems, claim 1 of auxiliary request VII proposes a composition comprising inter alia an apolar non-volatile hydrocarbon based oil and between 15% and 50% by weight of water.

- 6.5 The patent does not disclose any example relating to a composition according to claim 1, not to mention examples providing a comparison with the compositions of D2. The respondent relied in particular on documents C12 and C25 in support of a technical effect. In the written proceedings, the respondent also mentioned documents C32, C41-C45.

The appellant in its written submissions and at the oral proceedings referred to documents C12, C32, C41

and C42 with regard to the definition of the technical problem.

C12 is an experimental report filed by the appellant providing a comparison between different compositions with regard to the tackiness and shine (see Table 1). None of the comparative compositions used in this document correspond to the relevant compositions of D2 in terms of water and ethylcellulose content. The experiments C12 are therefore not relevant to show any effect or comparison over D2.

C25 are experiments provided by the respondent in the opposition proceedings which compare different compositions. The comparison suffers from the same deficiency as C12 with regard to the amount of water and ethylcellulose. Thus, none of the compositions disclosed in C25 reflect the teaching of D2. The experiments C25 are therefore not relevant to show any effect or comparison over D2.

C32 are experiments provided to show the effect on tackiness of castor oil and of the product Parleam®. The results disclosed in this document appear inconclusive since the addition of Parleam® does not result always in an increase (or decrease) of the tackiness (see Tables 1 and 3). In any case, since claim 1 of auxiliary request VII is not limited to the use of polyisobutylene (Parleam®) as second non-volatile oil, but it rather covers a broad range hydrocarbon-based oil, the results of these experiments cannot be extrapolated over the whole scope of the claims.

C41 and C42 are experiments filed respectively by the appellant and the respondent and relate to the

stability of compositions comprising ethylcellulose, octyldodecanol, Parleam® and water. Said experiments provide contradictory results. None of them show an effect possibly linked with the presence of an apolar non-volatile hydrocarbon based oil and the presence of water at the claimed concentration.

C43, C44 and C45 are irrelevant for the assessment of inventive step. C43 relates to the measurement of the vapour pressure of some hydrocarbons, while C44 and C45 relate to the product Parleam® and to its possible instability when combined with castor oil.

In the absence of any technical effect linked with the presence of an apolar non-volatile hydrocarbon based oil and water at the claimed concentration, the problem is as defined by the opposition division namely the provision of an alternative composition adapted for lip care.

6.6 It remains to determine whether the claimed solution is obvious.

Even if D2 discloses anhydrous compositions in all its examples, it mentions the possibility to make an oil-in-water emulsion or a water-in-oil emulsion by the addition of a specific compound, namely a ethylene oxide/propylene oxide silicone copolymer (see D2, page 6, lines 51-57). On page 7 (lines 3 to 7) D2 also suggests the addition of water in the compositions as part of the carrier. The incorporation of water is therefore clearly and explicitly envisaged in D2. This document also provides a technical solution linked with the addition of water (see page 6, lines 51-57). Accordingly, the Board does not agree with the

conclusion of the respondent that D2 teaches away the incorporation of water.

The use of an apolar non-volatile hydrocarbon based oil in a composition for caring the lips is known from C16, which discloses the use of non-volatile hydrocarbon apolar oil, such as polyisobutylene in example 1 in a composition comprising also a hydrocarbon-based non-volatile oil liquid at room temperature, such as octyldodecanol (see example 1 and paragraphs [0086]-[0088]). Paraffin oil is also disclosed in C16 as possible non-volatile apolar oil (see par. [0084]-[0090])

Accordingly, the disclosures of document D2 and C16 show that both water and the second non-volatile oil are used for the same kind of products. The skilled person, looking for an alternative composition, would consider variations of the composition of the closest prior art, taking into account of the common general knowledge and of the knowledge in the specific field. That includes variations of the composition that can be expected to be suitable to obtain alternative products.

Consequently, in view of D2 and C16, the claimed solution is obvious and auxiliary request VII does not meet the requirements of Article 56 EPC.

7. Auxiliary requests VIII-XIII - Inventive step

The modifications introduced in claim 1 of auxiliary requests VIII-XIII do not have any impact on the assessment of inventive step.

The modification of the amounts of the first oil (cf. auxiliary request 8) does indeed not bring any further

distinguishing feature over D2, which discloses the presence of octyldodecanol in examples 1, 6 and 8 in the amount of respectively 23, 28% and 25%.

Moreover, polyisobutylene and liquid paraffin are explicitly disclosed in document C16 as non-volatile apolar hydrocarbon based oils. Thus, the restriction introduced in auxiliary requests IX and X with regard to the definition of the second non-volatile oil does not result in any inventive contribution over the prior art.

No specific arguments were submitted by the respondent in relation to auxiliary requests XI to XIII.

Consequently, auxiliary requests VIII-XIII do not meet the requirements of Article 56 EPC essentially for the same reasons considered in relation to auxiliary request VII.

8. Auxiliary requests XIV-XX - Amendments

Claims 1 of auxiliary requests XIV-XX comprise the feature "said composition comprising ethylcellulose". As for the main request, in view of this feature, claims 1 of auxiliary requests XIV-XX comprise mixtures of ethylcellulose with any other alkylcellulose with C₁-C₆ carbon atoms.

Accordingly these requests do not meet the requirements of Article 123(2) EPC for the same reasons discussed above in relation to the main request.

In view of this conclusion, no decision is required as to the admissibility of these requests.

9. Auxiliary request XXI - Admission into the appeal proceedings

Auxiliary request XXI has been filed at the end of the oral proceedings before the Board, after a decision on the other preceding requests had already been announced. Claim 1 of this request comprises *inter alia* the following restriction in relation to the amounts of oils which was not present in any previous request:

- **"said first non-volatile hydrocarbon-based oil being present in a content ranging from 5% to 75% by weight, relative to the total weight of the composition, and said composition comprising a content ranging from 5% to 75% by weight of second non-volatile oil(s) other than the said first oil".**

The Board notes that such amendments raise issues which the Board and the appellant cannot reasonably be expected to deal with, in particular with regard to the concentration of the second non-volatile oil, an aspect which has never been discussed during the opposition and the appeal proceedings.

The request appears to have been filed in response to the inventive step attack raised by the appellant over D2 in its statement of appeal and during the first instance proceedings; its late filing is therefore not justified by late developments. Moreover, it is not clear how this request could respond to the objections of inventive step presented with regard to the other requests. The new request combine features of dependent claims and would therefore require a new detailed examination vis-à-vis the prior art. By filing such request at the end of oral proceedings, the respondent prevents the appellant from preparing counter-arguments and the Board from preparing for the arguments of the

parties. Admitting this request would be contrary to the principles of procedural fairness and economy.

Consequently, auxiliary request XXI is not admitted into the appeal proceedings (Article 13 RPBA 2007).

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The patent is revoked.

The Registrar:

The Chairman:



B. Atienza Vivancos

A. Uselli

Decision electronically authenticated