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**Datasheet for the decision
of 7 February 2020**

Case Number: T 2274/18 - 3.3.07

Application Number: 09737000.1

Publication Number: 2358444

IPC: A61K8/96, A61K8/02, A61K8/26,
A61K8/25, A61K8/19, A61K8/28,
A61Q15/00

Language of the proceedings: EN

Title of invention:

COSMETIC METHOD FOR TREATING HUMAN PERSPIRATION USING PARTICLES
OF AN EXPANDED AMORPHOUS MINERAL MATERIAL; COMPOSITIONS.

Patent Proprietor:

L'Oréal

Opponent:

Roos, Peter

Headword:

Method For Treating Human Perspiration /L'ORÉAL

Relevant legal provisions:

EPC Art. 123(2)

RPBA Art. 12(4)

Keyword:

Amendments - added subject-matter (yes)
Late-filed auxiliary requests - admitted (no)

Decisions cited:

T 0936/09



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2274/18 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 7 February 2020

Appellant: L'Oréal
(Patent Proprietor) 14, rue Royale
75008 Paris (FR)

Representative: L'Oreal
Service D.I.P.I.
9, rue Pierre Dreyfus
92110 Clichy (FR)

Respondent: Roos, Peter
(Opponent) Noldinstr. 7
81545 München (DE)

Representative: Stilmár, Matthias
Stilmár & Partner
Patentanwälte PartG mbB
Blumenstraße 17
80331 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 26 June 2018
revoking European patent No. 2358444 pursuant to
Article 101(2) EPC.**

Composition of the Board:

Chairman A. Uselli
Members: E. Duval
Y. Podbielski

Summary of Facts and Submissions

I. European patent 2 358 444 (hereinafter "the patent") was granted on the basis of 13 claims. Independent claim 12 read as follows:

"Anhydrous solid composition in the form of a stick, characterized in that it comprises, in a cosmetically acceptable carrier:

(i) more than 1% by weight, relative to the total weight of the composition, of expanded amorphous mineral material as defined in the preceding claims; and

(ii) at least one fatty phase comprising at least one volatile oil and/or at least one non-volatile oil and a structuring agent."

II. An opposition was filed against the patent on the grounds that its subject-matter lacked novelty and inventive step, it was not sufficiently disclosed and it extended beyond the content of the application as filed.

Pursuant to Rule 79(1) EPC, the EPO communicated the notice of opposition to the patent proprietor and set a 4-month time limit to file observations. The patent proprietor neither filed any observations or amendments nor requested any extension of this time limit.

III. The opposition division took the decision to revoke the patent. The decision was issued in writing and was based on the patent as granted.

According to this decision, the claimed subject-matter neither infringed the requirements of Article 100(c)

EPC nor those of Article 100(b) EPC. The criteria of novelty were however not met.

- IV. The patent proprietor (appellant) lodged an appeal against the above decision of the opposition division. With the statement setting out the grounds of appeal, the appellant *inter alia* contested the finding of lack of novelty with respect to the patent as granted as main request, and filed auxiliary requests 1-5.
- V. In its reply dated 12 March 2019, the opponent (respondent) submitted *inter alia* the following arguments:
- (a) Claim 12 of the main request used the term "expanded amorphous mineral material", which was different from the wording "expanded mineral particles" used in claim 15 of the application as filed, on which claim 12 of the main request was based.
 - (b) Auxiliary request 1-5 were to be disregarded under Article 12(4) RPBA because they had not been presented in the proceedings before the opposition division. In fact, the appellant had not filed any response to the notice of opposition and had taken no part in the opposition proceedings. Article 12(4) RPBA penalised an infringement of the duty to facilitate the first-instance proceedings, and implied a requirement for a party to present appropriate requests as soon as possible. In the present case, the appellant could have been expected to present the auxiliary requests in the first-instance proceedings, but did not.
- VI. The Board summoned the parties to oral proceedings.

In a communication pursuant to Article 15(1) RPBA issued on 21 October 2019, the Board expressed the preliminary opinion that claim 12 of the main request contained added subject-matter. The Board also gave a preliminary assessment of novelty of the main request, and expressed the view that auxiliary requests 1-5 were not to be admitted into the proceedings pursuant to Article 12(4) RPBA.

By letter dated 31 January 2020, the appellant announced that it would not attend the oral proceedings.

The Board cancelled the oral proceedings.

- VII. During the appeal proceedings, the appellant did not provide any arguments regarding the compliance of the main request with the criteria of Article 100(c) EPC, nor any reasoning why auxiliary requests 1-5 should be admitted into the appeal proceedings.
- VIII. The appellant requests that the decision under appeal be set aside and that the patent be maintained on the basis of the claims as granted, or alternatively, on the basis of one of the auxiliary requests 1-5 filed with the statement of grounds of appeal.
- IX. The respondent requests that the appeal be dismissed and that auxiliary requests 1-5 not be admitted into the proceedings in accordance with Article 12(4) RPBA. The respondent further requests that the case be remitted to the opposition division if it is necessary to discuss inventive step of the main request, or if one or more of auxiliary requests 1-5 are admitted into the proceedings.

Reasons for the Decision

Cancellation of the oral proceedings

1. In the present appeal proceedings, both the appellant and the respondent requested oral proceedings as an auxiliary measure. Oral proceedings were initially appointed as a result of the parties' requests.

By letter dated 31 January 2020, the appellant subsequently announced that it would not attend the oral proceedings. The Board treats this statement as equivalent to a withdrawal of the request for oral proceedings, in line with the established case law of the Boards of Appeal (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, III.C.4.3.2). Since the respondent's main request is allowed by the Board (see below), the present decision can be issued without oral proceedings taking place.

Main request (patent as granted)

2. Article 123(2) EPC

Claim 15 of the application as filed related to an anhydrous solid composition comprising, in particular, more than 1% by weight of "expanded mineral particles as defined in the preceding claims". In claim 12 of the main request (see point I. above), the expression "expanded mineral particles" is replaced with "expanded amorphous mineral material".

As noted in the communication pursuant to Article 15(1) RPBA (see point 1 of the communication), the expression "expanded mineral particles as defined in the preceding

claims" used in claim 15 of the application as filed logically referred to the "particles of an expanded amorphous mineral material" mentioned in claim 1. However, claim 12 of the main request does not refer to any particles, but only to the material itself. The application as filed does not disclose the presence, in the composition, of such material where it is not in the form of particles. The appellant did not submit any argument in response to this objection.

Accordingly, claim 12 of the main request does not comply with the requirements of Article 123(2) EPC.

Auxiliary requests 1-5

3. Together with the statement setting out the grounds of appeal, the appellant submitted 5 amended sets of claims as new auxiliary requests 1-5. The respondent challenges their admissibility on the basis of Article 12(4) RPBA.
- 3.1 The appellant's statement of grounds of appeal was submitted before 1 January 2020. Consequently, Article 12(4) to (6) RPBA 2020 does not apply (Article 25(2) RPBA 2020, see OJ EPO 2019, A63). Instead, the question whether or not these new auxiliary requests 1-5 should be admitted must be decided on the basis of Article 12(4) RPBA 2007, which gives the Board discretion not to admit, on appeal, requests that could have been presented in the opposition proceedings.
- 3.2 During the proceedings before the opposition division, the EPO communicated the notice of opposition to the appellant, pursuant to Rule 79(1) EPC, on 7 November 2017, and set a 4-month time limit to file observations. The appellant neither filed any

observations or amendments nor requested any extension of this time limit. The opposition division issued the decision to revoke the patent in writing on 26 June 2018. The reasons for this decision, namely the lack of novelty over D1 and D2, were among the objections raised in the notice of opposition communicated to the appellant.

3.3 Considering the appellant's total absence of reaction to the opposition filed against its patent, the arguments set out in the statement of grounds of appeal and the newly filed auxiliary requests 1-5 constitute the appellant's first attempt to defend its patent. Since the appellant had not requested any extension of the Rule 79(1) EPC time limit, it can only be concluded that the appellant deliberately refrained from filing these auxiliary requests during the opposition proceedings. No justification was put forward by the appellant for filing these requests only in appeal.

3.4 As set out in decision T 936/09 (see Headnote), the patent proprietor is not free to present or complete his case at any time that he wishes during the opposition or opposition appeal proceedings. In view of the judicial nature and purpose of *inter partes* appeal proceedings and in the interests of an efficient and fair procedure, it is necessary that all parties to opposition proceedings complete their submissions during the first-instance proceedings in so far as this is possible. If a patent proprietor presents or completes his case only in the notice of appeal or the statement setting out the grounds of appeal, then he will need to face the prospect of being held to account for such conduct by the board when, for example, exercising its discretion under Article 12(4) RPBA 2007. This applies in particular in the present case,

since all the reasons for revocation of the opposed patent were known to the appellant before it received the impugned decision.

3.5 Accordingly, the Board does not admit auxiliary requests 1-5 into the proceedings, pursuant to Article 12(4) RPBA 2007.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

A. Usuelli

Decision electronically authenticated