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**Datasheet for the decision
of 24 July 2020**

Case Number: T 0170/19 - 3.3.07

Application Number: 08856247.5

Publication Number: 2219591

IPC: A61K8/34, A61K8/86, A61Q5/02,
A61K8/36, A61K8/04

Language of the proceedings: EN

Title of invention:
SHAMPOO CONTAINING A GEL NETWORK

Applicant:
The Procter & Gamble Company

Headword:
Shampoo Containing A Gel Network / PROCTER & GAMBLE

Relevant legal provisions:
EPC Art. 123(2)
RPBA 2020 Art. 11, 25

Keyword:
Amendments - added subject-matter (no)
Remittal to the department of first instance - special reasons
for remitting the case

Decisions cited:

T 0727/00



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 0170/19 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 24 July 2020

Appellant: The Procter & Gamble Company
(Applicant) One Procter & Gamble Plaza
Cincinnati, OH 45202 (US)

Representative: Mathys & Squire
The Shard
32 London Bridge Street
London SE1 9SG (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 9 August 2018
refusing European patent application No.
08856247.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman D. Boulois
Members: E. Duval
P. Schmitz

Summary of Facts and Submissions

- I. The appeal was filed by the applicant (appellant) against the decision of the examining division to refuse the European patent application 08856247.5 (hereinafter "the application").
- II. The decision was based on a main request and on auxiliary requests 1-3, all filed by letter dated 22 June 2018.

Claim 1 of the main request read as follows:

"A shampoo composition comprising:

- a) from 5 % to 50 % of one or more deterative surfactants, by weight of said shampoo composition;
 - b) a dispersed solid crystalline gel network phase comprising:
 - i) a first component comprising at least 0.05 % of one or more fatty acids by weight of said shampoo composition;
 - ii) a second component comprising at least 0.01 % of one or more secondary surfactants, by weight of said shampoo composition;
 - iii) water; and
 - c) at least 20 % of an aqueous carrier, by weight of said shampoo composition;
- wherein said first component is combined with said second component in the ratio of from 1:1 to 40:1, to form said solid crystalline gel network phase;
- wherein the one or more deterative surfactants comprise a deterative surfactant selected from anionic deterative surfactants, zwitterionic deterative surfactants and amphoteric deterative surfactants;

wherein the one or more secondary surfactants comprise a cationic surfactant; and
wherein the first component comprises a plurality of fatty acids selected from behenic acid, stearic acid, erucic acid, hydroxystearic acid, linoleic acid and oleic acid."

III. The examining division decided as follows:

(a) Claim 1 of the main request differed from claim 6 as originally filed by the following amendments:

- 1- the selection of "anionic deterative surfactants, zwitterionic deterative surfactants and amphoteric deterative surfactants" in the list of "deterative surfactants" from page 3, last paragraph of the the application as filed;
- 2- the selection of "cationic surfactant" in the list of "secondary surfactants" from page 11, paragraph 2 of the application as filed;
- 3- the selection of "plurality" (of fatty acids) in the list of two alternatives: "one or more fatty acids" (i.e. either a single OR a plurality) from original Claim 6 b iii) of the application as filed; and
- 4- the selection of "behenic acid, stearic acid, erucic acid, hydroxystearic acid, linoleic acid and oleic acid" from the list of fatty acids and alkoxyated fatty acids bridging pages 8-9 of the application as filed.

Since the above selections 1 and 2 were presented as preferred in the application as filed, they did not qualify as "selections among equivalents" in the meaning of T 727/00. In contrast, selections 3 and 4 were seen as selections among equivalents. As

a result of these multiple selections amongst equivalents, claim 1 of the main request defined an individualised subgroup of compositions which was not disclosed in such specific terms in the application as filed. Thus the main request did not fulfill the requirements of Article 123(2) EPC.

(b) For the same reasons, each of the auxiliary requests 1-3 contravened Article 123(2) EPC.

IV. With its statement setting out the grounds of appeal, the appellant re-submitted the same main request and auxiliary requests 1-3 underlying the decision under appeal.

V. The appellant's arguments, as far as relevant for the present decision, can be summarised as follows:

(a) Claim 1 of the main request derived from claim 6 of the application as filed.

The amendment specifying that "the one of more deterative surfactants comprise a deterative surfactant selected from anionic deterative surfactants, zwitterionic deterative surfactants and amphoteric deterative surfactants" found basis in the paragraph spanning pages 3-4 of the application as filed. Contrary to the examining division's opinion, this amendment did not represent a first selection because it represented the broadest definition of the deterative surfactant component given in the application as filed.

The amendment specifying that the one or more secondary surfactants comprise a cationic surfactant found basis not only at page 11, second

paragraph of the application as filed, but also in original dependent claim 9. This amendment did not represent a selection either.

The amendment specifying the presence of "a plurality of fatty acids" did not represent a selection from the disclosure of "one or more fatty acids" in original claim 6, but merely resulted from the deletion of a single option therein. There was, moreover, a clear pointer in the application as filed to the use of a plurality of fatty acids in the gel network phase. In particular, all of the gel network premix and shampoo examples pertaining to the aspect of the disclosure defined by original claim 6 comprise a plurality of fatty acids in the gel network. Accordingly, the skilled reader would not consider this amendment to represent a selection.

Lastly, the amendment specifying that the fatty acids were chosen from "behenic acid, stearic acid, erucic acid, hydroxystearic acid, linoleic acid and oleic acid" did not represent a "selection among equivalents" in the sense of T 727 /00 as alleged by the examining division, but merely resulted from the deletion of several options from the list of fatty acids taught in the paragraph spanning pages 8-9 of the application as filed, without reciting or singling out a particular combination of specific meanings. According to long-established jurisprudence, an amendment which involved deleting items from lists was permissible so long as it did not result in the "singling out" of a particular combination of specific meanings. Even if, *arguendo*, one of the amendments represented a

selection, a single selection constituted a permissible amendment under Article 123(2) EPC.

Dependent claims 2-4 of the main request were based, respectively, on claims 7-9 of the application as filed.

Thus, the main request fulfilled the requirements of Article 123(2) EPC.

- (b) In the event that the Board decided that one of the main or auxiliary requests complied with Article 123(2) EPC, the case should be remitted to the examining division for further prosecution, because important issues such as novelty and inventive step had not been considered in the decision under appeal.

- VI. The appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request or, in the alternative, on the basis of one of the auxiliary requests 1-3, all filed with the statement setting out the grounds of appeal. The appellant also requests that the Board remit the case to the examining division for further prosecution in the event that one of the main or auxiliary requests is found to comply with Article 123(2) EPC.

Reasons for the Decision

- 1. Main request, Article 123(2) EPC

1.1 Claim 1 of the main request differs from claim 6 of the application as filed as follows (additions and ~~deletion~~ emphasized by the Board):

"A shampoo composition comprising:

- a) from ~~about~~ 5 % to ~~about~~ 50 % of one or more deterative surfactants, by weight of said shampoo composition;
- b) a dispersed solid crystalline gel network phase comprising:
 - i) a first component comprising at least ~~about~~ 0.05 % of one or more fatty acids by weight of said shampoo composition;
 - ii) a second component comprising at least ~~about~~ 0.01 % of one or more secondary surfactants, by weight of said shampoo composition;
 - iii) water; and
- c) at least ~~about~~ 20 % of an aqueous carrier, by weight of said shampoo composition;

wherein said first component is combined with said second component in the ratio of from 1:1 to 40:1, to form said solid crystalline gel network phase;

wherein the one or more deterative surfactants comprise a deterative surfactant selected from anionic deterative surfactants, zwitterionic deterative surfactants and amphoteric deterative surfactants;

wherein the one or more secondary surfactants comprise a cationic surfactant; and wherein the first component comprises a plurality of fatty acids selected from behenic acid, stearic acid, erucic acid, hydroxystearic acid, linoleic acid and oleic acid."

1.2 Under Article 123(2) EPC, amendments may only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the

date of filing, from the whole of the application as filed (following the "gold standard" of G 2/10, OJ EPO 2012, 376).

- 1.3 The appealed decision acknowledges that each of the above limitations with respect to the deterative surfactants, secondary surfactants and fatty acids finds, individually, a basis in the application as filed. However, the question arises as to whether, as a result of the combination of these limitations, the skilled person is be presented with new technical information.

In decision T 727/00 cited by the examining division, the board held that the combination - unsupported in the application as filed - of one item from each of two lists of features meant that although the application might conceptually comprise the claimed subject-matter, it did not disclose it in that particular individual form. As a result, the criteria of Article 123(2) EPC were not met.

However, it is also established case law that, in the case of combinations of features disclosed separately in the application as filed, or of multiple selections within several lists of alternative features, the amended subject-matter may nevertheless be derivable in the presence of explicit or implicit pointers to that selection or combination in the application as filed. For example, the fact that the features in question have been mentioned in the description as "preferred" may act as such a pointer (see the Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, II.E.1.6.1 and II.E.1.6.2).

- 1.4 In the case at hand, the use of a deterative surfactant selected from anionic deterative surfactants, zwitterionic deterative surfactants and amphoteric deterative surfactants is disclosed on page 3, last paragraph, of the application as filed. Though the presence of additional deterative surfactants is not excluded (see page 5), the Board agrees with the examining division that anionic, zwitterionic and amphoteric deterative surfactants represent the preferred deterative surfactants according to page 3.
- 1.5 As secondary surfactant in the gel network phase, a cationic surfactant is explicitly mentioned as preferred on page 11, second paragraph (see also claim 9 of the application as filed). Other secondary surfactants are listed thereafter (see page 12, fourth paragraph to page 13). However, this does not contradict the explicit preference for cationic surfactants, since, as explained at the beginning of the second paragraph on page 11, these other surfactants are not desirable for the formation of the fatty acid gel network. This is confirmed by the gel network premix examples on pages 21-22. Examples 1-5 and 8-12 pertain to the invention defined by claim 6 of the application as filed, whereas examples 6, 7, 13 and 14 comprising cetyl/stearyl alcohol as fatty amphiphiles rather pertain to claim 1 of the application as filed. Among the examples pertaining to claim 6 of the application as filed, only examples 9, 10 and 12 do not comprise a cationic surfactant (behenyltrimethylammonium chloride), but lead to undesirable lamellar structure properties (see the bottom of the tables on pages 21-22). Hence, the Board agrees with the examining division that the presence of a cationic surfactant as secondary surfactant is disclosed as preferred.

- 1.6 As to the number of fatty acids, the Board agrees with the examining division that the feature "plurality of fatty acids" can formally be considered as a selection from the the list of two alternatives "one or more fatty acids" of claim 6 of the application as filed (i.e. the term "plurality" is taken in the sense of a number greater than one). However, as pointed out by the appellant, although the application as filed considered the option that one fatty acid be present in the gel network phase, all of the gel network premix examples according to claim 6 of the application as filed (see the tables of pages 21-22) actually comprise a plurality of fatty acids in the gel network. Accordingly, it can be derived from the application as filed that the presence of a plurality of fatty acids is the most preferred of the two generally disclosed options (one or more fatty acids).
- 1.7 Lastly, the examining division found that the feature that the fatty acids are selected from "behenic acid, stearic acid, erucic acid, hydroxystearic acid, linoleic acid and oleic acid" involved a "selections among equivalents", in the meaning of T 727/00, from the list of fatty acids bridging pages 8-9 of the application as filed.

The Board points out that this limitation to 6 alternatives from the list of 34 initially disclosed does not, strictly speaking, constitute a selection as in case T 727/00, in the sense that the fatty acids are not limited to *one item* of a list. Nonetheless, it must be assessed if this limitation to the recited 6 fatty acids, in combination with the other amendments described above, results in the introduction of new

technical information and the individualisation of an initially undisclosed subgroup of compositions.

1.8 In that regard it has to be observed that claim 6 of the application as filed already defined the combined presence of the three components (namely the deterative surfactants, secondary surfactants and fatty acids). Claim 1 of the main request results from the limitation of each of these components by the addition of the features discussed in 1.4, 1.5 and 1.6 above, each of which is described as preferred in the application as filed, together with the above restriction to a smaller group of 6 fatty acids, which restriction does not introduce any specific meaning or novel teaching. The amended claim is still supported by an example of the application as filed (i.e. the gel network premix example 3 and shampoo 13 on pages 2-24). Hence no particular subgroup of compositions has been artificially created.

1.9 The appellant considers dependent claims 2-4 of the main request to be based, respectively, on claims 7-9 of the application as filed. The Board concurs.

1.10 Accordingly, the main request complies with the requirements of Article 123(2) EPC.

2. Remittal to the examining division

Since the present appeal was pending on 1 January 2020, the revised version of the RPBA applies (OJ EPO 2019, A63), subject to the transitional provisions set out in Article 25 of said RPBA. In particular Article 11 RPBA 2020 is applicable. According to Article 11 RPBA 2020, the Board shall not remit a case to the department

whose decision was appealed for further prosecution, unless special reasons present themselves for doing so.

In the present case, the appealed decision solely deals with the issue under Article 123(2) EPC. The examining division took no appealable decision on essential patentability issues, in particular with respect to novelty and inventive step. These circumstances constitute special reasons for remitting the case in the sense of Article 11 RPBA 2020 (see T 1966/16, point 2 of the reasons).

Accordingly, the Board considers it appropriate to allow the appellant's request for remittal of the case to the examining division.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairman:



K. Boelicke

D. Boulois

Decision electronically authenticated