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**Datasheet for the decision
of 31 January 2023**

Case Number: T 0371/21 - 3.3.09

Application Number: 14750357.7

Publication Number: 3033070

IPC: A61K8/34, A61K8/365, A61K8/41,
A61Q5/06

Language of the proceedings: EN

Title of invention:

PROCESS FOR TREATING KERATIN FIBRES USING AN AQUEOUS-ALCOHOLIC
COMPOSITION COMPRISING AN ORGANIC MONOACID

Patent Proprietor:

L'Oréal

Opponent:

Kao Germany GmbH

Relevant legal provisions:

EPC Art. 56

Keyword:

Inventive step - (yes)

Decisions cited:

T 0377/14



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Case Number: T 0371/21 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 31 January 2023

Appellant: Kao Germany GmbH
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Representative: Miller, Tobias
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Respondent: L'Oréal
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 9 February 2021
rejecting the opposition filed against European
patent No. 3033070 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman M. Ansorge
Members: F. Rinaldi
R. Romandini

Summary of Facts and Submissions

I. This decision concerns the appeal filed by the opponent (appellant) against the opposition division's decision to reject the opposition.

II. In the notice of opposition, the opponent requested, among other things, the revocation of the patent under Article 100(a) EPC (lack of inventive step).

III. The documents referred to in this decision are:

D1: FR 2 984 732 A1

D3: EP 1 634 570 A1

D4: WO 2007/135299 A1

D5: Comparative test report submitted by the applicant during examination proceedings

D6: Comparative test report submitted by the opponent (11 November 2020)

D7: Comparative test report submitted by the patent proprietor (12 November 2020)

IV. The only claim relevant for this decision is claim 1 of the patent as granted (main request). It reads:

"Hair treatment process comprising the application to the hair of an aqueous-alcoholic composition comprising at least 5% of at least one C1-C7 alcohol and at least one organic monoacid, followed by a straightening/relaxing step using a straightening iron at a temperature of at least 100°C, the process being performed without a step of permanent reshaping based on a reducing agent."

V. In the decision under appeal, the opposition division decided that the subject-matter of claim 1 as granted involved an inventive step. The reasoning was as follows.

- D1 was the closest prior art.
- Claim 1 differed over example 4A of D1 in the concentration of C1-C7 alcohol (i.e. at least 5%).
- D7 demonstrated that the process of claim 1 led to an improved direct and immediate straightening of the hair. The effect was shown to be linked to the distinguishing feature. D6 demonstrated that this effect was not always persistent after a washing step.
- The technical problem to be solved over D1 was to provide a hair straightening process leading to an improved direct and immediate straightening effect.
- There was no teaching in the prior art to increase the quantity of alcohol to improve hair straightening.

VI. On appeal, the patent proprietor (respondent) filed six auxiliary requests.

VII. The appellant's relevant arguments can be summarised as follows.

- The subject-matter of claim 1 as granted differed from example 4A of the closest prior art D1 in the concentration of C1-C7 alcohol (at least 5%).
- In view of the patent's examples, the only technical problem credibly solved at the time of filing of the patent was the straightening of the hair that persisted after washing of the treated hair.

- The tests in D6 showed that a composition according to claim 1, with 30% ethanol, was inferior in persistence compared to an ethanol-free composition. Thus, the problem of improving straightening durability was not solved.
- The patent proprietor's experimental tests in D7 investigated the straightening effect directly upon treatment, without shampooing. However, this effect was not the same as the one originally examined in the patent. Thus, D7 shifted the invention from solving the problem of durability of the hair straightening to durability of the hair straightening directly upon treatment.
- In addition, stopping the treatment process before shampooing was an unrealistic set-up. The skilled person would not have left the high concentration of monoacids called for in claim 1 on the hair for a long period of time.
- Furthermore, it was not credible that a technical effect would be found for all alcohols and monoacids of claim 1. Moreover, any effect observed in D7 was independent of the presence of alcohol. It was instead based on the fact that the tested compositions were in the form of an emulsion.
- Therefore, the only technical problem solved over the entire scope of the claim was to provide an alternative hair straightening process.
- The solution would have been obvious in view of D1.

VIII. The respondent's relevant arguments can be summarised as follows.

- D7 demonstrated the technical effect caused by the distinguishing feature of claim 1 over D1.

- The effect, namely direct efficiency of the claimed process for straightening hair, was stated in the patent and the application as filed.
- The durability of the straightening effect was a separate goal of the patent. It involved aspects such as persistence over time or after washing. D5 and D6 related to this type of persistence and did not compare claim 1 with the closest prior art.
- Therefore, the technical problem was to achieve an improved direct straightening effect, and it was solved in a non-obvious way.

IX. Final requests

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the appeal be dismissed or, alternatively, that the patent be maintained on the basis of any of auxiliary requests 1 to 5 filed before the opposition division or any of auxiliary requests 6 to 11 filed with the reply to the statement setting out the grounds of appeal. Furthermore, the respondent requested oral proceedings if the board considered not granting the main request.

Reasons for the Decision

1. *Patent*

The patent relates to a hair treatment process. It involves applying to the hair an aqueous-alcoholic composition comprising at least 5% of at least one C1-C7 alcohol and at least one organic monoacid, followed by a straightening/relaxing step using a straightening iron at a temperature of at least 100°C. The process aims, among other things, at straightening/relaxing and/or reducing the volume of hair efficiently and durably (paragraphs [0006] and [0007]).

2. *Main request - inventive step*

2.1 The appellant contested the opposition division's decision on inventive step of claim 1.

2.2 While it agreed on the selection of the closest prior art and the distinguishing feature, its view was that the technical problem was not solved. The experimental results in D6 proved that the only technical problem addressed in the patent, i.e. straightening of hair that remains persistent after washing of the treated hair, was not achieved over the entire scope of claim 1. Thus, the only problem solved was to provide an alternative process. This solution would have been obvious in light of D1.

2.3 Therefore, the relevant question is whether the technical problem can be formulated as the opposition division did (see above, point V).

2.4 The opposition division set out in its decision that:

"the problem of the remanence/resistance of the straightening to washing does not seem to be always achievable over the whole scope of claim 1 as demonstrated by D6. This was also not contested by the proprietor. However, the test results of D7 show another effect, namely the direct and immediate straightening of hair right after the straightening step with a hot iron. The persistence of the effect is not part of the technical problem and would represent a further advantage. This is in line with the technical problem defined in the patent specification on paragraphs [0006-8], i.e. the provision of a process which allows good straightening and/or reduction of the volume of the hair. Here even if the durability of the effect is mentioned, it is not specified if it concerns in particular the persistence after a washing step. In any case, D6 does not show the effect of the composition before the washing step, so that it could not be put in doubt that the problem of direct and immediate straightening of hair has been solved. Further, the opponent has not shown for which C1-C7 alcohol the effect could not be obtained. A mere assumption is not sufficient to shift the burden. Also ... it has not been shown that heterogeneous composition could not lead to a direct hair straightening." (point II.6.9)

2.5 This reasoning is both conclusive and convincing. Moreover, the appellant did not explain why the opposition division erred in stating that providing a direct and immediate straightening of hair was in line with the technical problem defined in the patent.

2.6 The following additional observations are made.

2.6.1 One of the aims of the patent is to develop a process for straightening/relaxing and/or reducing the volume of hair efficiently. This objective is directly disclosed in the patent, in paragraph [0006]. Therefore, the problem which the opposition division identified is at the very least derivable from the application as filed. In line with the case law of the boards, the problem does not even have to be explicitly disclosed in the application as filed: it suffices that it is foreshadowed in it (T 377/14, Reasons 2.1.5).

2.6.2 D7 is the only document in which the process of claim 1 is compared with the corresponding process steps of the closest prior art (D1). The results in D7 demonstrate that efficient hair straightening is obtained.

2.6.3 Here again, the considerations in T 377/14 (Reasons, point 2.1.6) are relevant for the current case:

"It is established jurisprudence that the patent proprietor (in the present case the respondent) can rely on a technical effect in formulating the objective technical problem, if it is proven to have been credibly obtained by the distinguishing feature(s). Only if this is not the case can the problem be reformulated in a less ambitious way as the provision of an alternative. Arguing the other way round, like the appellant in the present case, and saying that the provision of an alternative is obvious and that therefore any effect has to be disregarded ... would turn the problem-and-solution approach on its head, and thus is not permissible."

- 2.6.4 Achieving a straightening effect that is durable is a different and separate goal of the patent mentioned in the same paragraph of the patent.
- 2.6.5 D5 and D6 provide useful data for assessing a specific effect, namely the persistence of the straightening of the hair after washing it with a shampoo. However, this is just one aspect of the durability of the treatment. Durability includes different aspects, such as persistence of the straightening effect over time. It is not restricted to persistence after removal of the composition, e.g. after rinsing or washing the hair with a shampoo.
- 2.6.6 The appellant argued that washing the hair at the end of the treatment would be a compulsory process step for the skilled person.
- 2.6.7 This is not convincing. First, claim 1 does not call for a step of washing the hair, and therefore this step cannot be regarded as mandatory. Nor does the description state that such a step would be required or even essential. Second, D3 discloses leave-on hair compositions which contain an organic acid in an amount of up to 30% by weight. These compositions are not removed after application, neither by rinsing nor by shampooing. Instead, they are kept on the hair. Thus, there is no generic teaching in the art that would prevent the skilled person from leaving compositions on the hair which include a high concentration of organic monoacid.
- 2.6.8 Finally, the appellant re-iterated the argument that it was not credible that all C1 to C7 alcohols could achieve the same technical effects. However, as the opposition division observed (point II.6.9 of the

decision under appeal), there is no evidence that any of the alcohols or monoacids of claim 1 would not solve the technical problem. The same applies for the appellant's allegation that compositions would only be effective if they are provided in the form of a (homogeneous) emulsion.

2.7 Thus, there is no reason to reformulate the technical problem identified by the opposition division.

2.8 As concerns obviousness, the decision under appeal states the following:

"The opposition division is not able to find any teaching in D1, D4 or D3 that would encourage the skilled person to increase the quantity of alcohol in view of improving hair straightening. Therefore the skilled person would not have been led to the solution as defined by claim 1 of the contested patent from the teaching of D1 alone or taking into account the teaching of D3 or D4." (point II.6.7)

2.9 The appellant did not show that the solution of the technical problem which the opposition division identified would have been solved in an obvious way.

2.10 To conclude, the appellant did not convince the board that the opposition division's decision is to be set aside.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

M. Ansorge

Decision electronically authenticated