

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [X] To Chairmen and Members  
(C) [ ] To Chairmen

**D E C I S I O N**  
of 16 October 1997

**Case Number:** T 0667/94 - 3.3.2

**Application Number:** 88310844.1

**Publication Number:** 0319168

**IPC:** A61K 7/32

**Language of the proceedings:** EN

**Title of invention:**  
Antiperspirant compositions

**Patentee:**  
UNILEVER PLC, et al

**Opponent:**  
Henkel Kommanditgesellschaft auf Aktien

**Headword:**  
Antiperspirant/UNILEVER PLC ET AL

**Relevant legal provisions:**  
EPC Art. 83, 54

**Keyword:**  
"Sufficiency of disclosure - yes - specific trade name in the claims and in the description - available, analysable and reproducible"  
"Novelty - yes - no combination of preferred embodiment according to the invention with a specific example outside the invention"

**Decisions cited:**  
G 0001/92; T 0332/87, T 0762/90, T 0952/92

**Catchword:**



Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0667/94 - 3.3.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 16 October 1997

**Appellant:** Henkel Kommanditgesellschaft auf Aktien  
(Opponent) TFP/Patentabteilung  
D-40191 Düsseldorf (DE)

**Representative:** -

**Respondent:** UNILEVER PLC  
(Proprietor of the patent) Unilever House  
Blackfriars  
P.O. Box 68  
London EC4P 4BQ (GB)

**Representative:** Elliott, Peter William  
Unilever plc  
Patent Division  
Colworth House  
Sharnbrook  
Bedford MK44 1LQ (GB)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 9 August 1994  
rejecting the opposition filed against European  
patent No. 0 319 168 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** P. A. M. Lançon  
**Members:** U. Oswald  
J. H. van Moer

## Summary of Facts and Submissions

I. European patent No. 0 319 168 was granted on the basis of 14 claims contained in European patent application 88 310 844.1 filed on 17 November 1988 for the contracting states AT, BE, CH, DE, ES, FR, GB, GR, IT, LI, NL, SE and claiming the priority of US-123086 application on 20 November 1987. Claim 1 reads as follows:

"1. An antiperspirant composition comprising:

- (i) from 10 to 25% by weight of an antiperspirant active compound;
- (ii) from 40 to 89% by weight of a volatile silicone fluid chosen from cyclic tetromers and pentamers of dimethicone; and
- (iii) from 1 to 10% by weight of Bentone SD-1 clay dispersing agent."

[read "tetromers" as "tetramers"]

II. Opposition was filed against the granted patent by the Appellant. According to the grounds for opposition, the patent was opposed for lack of novelty and lack of inventive step under Article 100(a) EPC and for insufficiency of disclosure under Article 100(b) EPC.

The following documents were cited in the course of the opposition proceedings:

- (1) EP-A-0 272 354 (published 29 June 1988, filed 23 December 1986 and designating the contracting states AT, BE, CH, DE, ES, FR, GB, GR, IT, LI, NL and SE)

- (2) GB-A-2 018 590
- (3) US-A-4 526 780
- (4) "Lexikon der Hilfsstoffe für Pharmazie, Kosmetik und angrenzende Gebiete", Dr. Herbert P. Fiedler, Zweite, überarbeitete und ergänzte Auflage 1981, Editio Cantor Aulendorf, pages 167 to 169,
- (5) EP-B-0 028 853.

By a decision posted on 9 August 1994, the Opposition Division rejected the opposition under Article 102(2) EPC.

Since the product Bentone SD-1 was available on the market on the priority date of the patent in suit, and since the description of the patent in suit contained a reference to a source of supply as well as enough information about the structure of the product, the Opposition Division concluded that the skilled person was able to reproduce the claimed composition without undue burden. Having regard to the characterisation of Bentone 38 in document (4), there was further evidence that the patent in suit contained the best possible definition of Bentone SD-1. Accordingly, the product Bentone SD-1 was regarded as being state of the art and thus it was assumed that the disclosure of the invention was sufficiently clear and complete for a skilled person. Reference was made to decision G 1/92, OJ EPO 1993, 277 of the Enlarged Board of Appeal.

The Opposition Division took the view that comparative Example II in the patent in suit provided enough evidence that Bentone SD-1 could be easily distinguished from other Bentone type clays such as

Bentone 38 and thus came to the conclusion that the claimed subject-matter did not lack novelty over prior art products containing other clays than Bentone SD-1.

It was furthermore the Opposition Division's view that the state of the art under Article 54(3) EPC represented by document (1) expressly mentioned Bentone SD-1 beside other clays suitable in antiperspirant products but did not explicitly disclose an example containing the said clay and that therefore this prior art did not destroy the novelty of the claimed composition.

For the assessment of inventive step, the Opposition Division considered preparations containing Bentone 38 to be the closest prior art. The problem underlying the patent in suit was to provide volatile silicone-based antiperspirant compositions with an efficacy which was greater than that with conventional silicone-based antiperspirant compositions. The Opposition Division held that this problem was solved in a credible manner and that the cited prior art did not contain any hint to change commonly used Bentone type clays.

III. The Appellant lodged an appeal against the said decision. The arguments of the Appellant, both in the written procedure and at the oral proceedings on 16 October 1997, may be summarised as follows.

Although it was not contestable that the product Bentone SD-1 was available on the priority date of the patent in suit and that a person skilled in the art could analyse the said product without difficulty, the grounds for opposition under Article 100(b) could not be waived.

The Opposition Division incorrectly applied the examination guidelines and incorrectly assumed that decision G 1/92 related to the requirement of sufficient disclosure under Article 83 EPC.

In the present case, the mere reference to a product name and its availability on the market on the priority date of the patent in suit, without any detailed disclosure in the patent in suit relating to the chemical composition or structure of the product or at least a specific production method, could not be regarded as criteria sufficient to fulfil the requirement of Article 83 EPC. In the present case, however, it was not possible to obtain component (iii) in claim 1 of the patent in suit without referring to the term Bentone SD-1. It was particularly pointed out that up to now the manufacturers of Bentone SD-1 had not published a data sheet containing technical information about the chemical composition or physical structure of this product. The trade name Bentone SD-1 did not form part of the common general knowledge of a person skilled in the art and was not comparable to an internationally accepted standard descriptive term such as Teflon which had acquired a precise meaning. Reference was made to decision T 762/90 dated 29 November 1991. There was no basis for the assumption that Article 83 EPC had to be interpreted to the effect that a person skilled in the art had to analyse a product before the teaching of a patent in suit could be regarded as sufficiently clear and complete. Moreover, there was a risk that after a certain period of time a product under the same trade name was available on the market but with a chemical composition other than Bentone SD-1 on the priority date of the patent in suit. Accordingly, there was no certainty that the invention could continue to be carried out in the future. The Appellant took the more general view that it was in any case necessary to distinguish

between a disclosure relating to a factual prior use of a commercial product and a disclosure only by reference to a trade name and that in the present situation the proprietor of the patent in suit was not in full possession of the invention.

As regards the question of the novelty of the claimed subject-matter, the Appellant agreed that there was some evidence in comparative Experiment II in the patent in suit that on the one hand a roll-on composition according to Example I containing Bentone SD-1 and on the other hand a conventional commercially available roll-on composition including Bentone 38 showed different antiperspirant properties. However, it was contested that the said conventional commercially available roll-on had the same composition as that of the roll-on according to Example I. Furthermore, there was no evidence that the alleged improvement achieved by the roll-on composition according to Example I was due to the use of Bentone SD-1. There was a high risk that the said difference in antiperspirant properties resulted from interactions between other components than the clay dispersing agents.

Furthermore, it was pointed out that the definition of Bentone SD-1 by mere reference to a modification treatment with a quaternary ammonium compound as set out in the description of the patent in suit did not allow this clay to be distinguished from other Bentone type clays such as Bentone 38. Moreover, the conditions under which the treatment with the quaternary ammonium compound was carried out could influence the particle size or internal structure of the clay, and thus even the characterisation of a clay by its chemical composition could not be regarded as technical information sufficient to distinguish one bentone type from another. There was the further question whether or not Bentone SD-1 consists of a physical mixture of

different types of bentone clays, each treated with the quaternary ammonium compound in a different way. The Appellant particularly emphasised that the description of the patent in suit did not contain enough technical information to carry out a full examination for novelty under Article 54 EPC. However, since documents (1) and (2), particularly document (1) Examples Q and R, described Bentone 38 in combination with an antiperspirant composition falling within the terms of claim 1 of the patent in suit, it was only possible to conclude that the claimed subject-matter lacked novelty in the light of the prior art.

IV. The Respondent contested the above arguments and pointed out that the Appellant's reference to the examination guidelines was out of context since the reference to trade marks or trade names only was undesirable insofar as such words merely denoted origin or might relate to a range of different products. As a matter of fact Bentone SD-1 was available as one specific product from the suppliers before the priority date of the patent in suit and was available to the skilled man to analyse. Since sufficiency of disclosure needed to be established only on the priority date of the patent in suit the Appellant's argument relating to a possible change of formulation of Bentone SD-1 was irrelevant. Technical information derived from the "use" of a compound according to G 1/92 could be equated with "public availability", and thus the public availability of Bentone SD-1 made available the composition or internal structure of this clay. Therefore, in the Respondent's opinion, the Appellant was trying to make an insufficiency-of-disclosure issue out of what in essence was a novelty issue. In the light of the worked examples in the patent in suit, however, a novelty objection could not be sustained. As regards the alleged lack of novelty in the light of compositions Q and R according to document (1), it was



pointed out that, following decision T 332/87 (Board of Appeal 3.3.1, dated 23 November 1990) these compositions must not be taken into account since they clearly related to comparative examples outside the scope of the invention as described in document (1).

- V. 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 and that the patent be maintained.

#### **Reasons for the decision**

1. The appeal is admissible.
2. Claims 1 to 14 as granted correspond to claims 1 to 14 originally filed.
3. In opposition procedure the burden of proof normally rests on the Opponent's shoulders. Once the Opposition Division has decided to maintain the patent and the Opponent has filed an appeal against the said decision, the burden is not automatically shifted to the Proprietor of the patent to demonstrate on appeal that the reasons for maintaining the patent were justified.
4. Accordingly, the first issue in this appeal is whether the Appellant's objection under Article 100(b) EPC that the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art is well founded.

4.1 The Appellant's objection is in essence based on the fact that Bentone SD-1, referred to in claim 1 as a clay dispersing agent and forming one of the three essential components of an antiperspirant composition, is characterised in the description and in the claims of the patent in suit only by its trade name, which could not be regarded as an internationally accepted standard descriptive term such as Teflon which has acquired a precise meaning.

4.2 In this respect, the Board notes that the Appellant himself at the oral proceedings explicitly stated that Bentone SD-1 could be acquired by purchase on the priority date of the patent in suit and that a person skilled in the art had no difficulty in analysing this product. Furthermore, the Board notes that the Appellant did not submit experimental counter-evidence showing that a person skilled in the art was unable to reproduce the Bentone SD-1 product.

Having regard to the common general knowledge as well as the knowledge of the state of the art, the person skilled in the art must have the same skill when consulted about a prior written disclosure or a prior use in the frame of a novelty issue (Article 54 EPC) or when reading the description of an invention in view of carrying it out (Article 83 EPC).

Therefore, in the light of decision G 1/92 (see in particular point 1.4 of the Reasons), the Board can only conclude that Bentone SD-1 was available without restrictions to the public on the priority date of the patent in suit, accordingly that its chemical composition or internal structure formed part of the state of the art under Article 54(2) EPC on that date and that all the necessary technical information

regarding Bentone SD-1 (see again 3.2 above) was available to the skilled person on the priority date of the patent in suit, which allowed him to carry out the invention within the meaning of Article 83 EPC.

- 4.3 In the present case, since the product Bentone SD-1 was state of the art under Article 54(2) EPC on the priority date of the patent in suit, the question does not arise whether the invention could continue to be carried out in the future.

The purpose of Article 83 must be to make sure that, at least at the filing date of a patent application, its disclosure is such as to allow a person skilled in the art to carry it out.

Accordingly, each of the Appellant's arguments relating to a change of the product Bentone SD-1 after the priority date of the patent in suit must fail.

- 4.4 As regards the Appellant's reference to the "Guidelines for Examination in the European Patent Office", it is to be noted that the said guidelines do not systematically rule out the use of trade names or trade marks. It was the Examining Division's duty, if necessary, to ask for a further clarification of the product Bentone SD-1 as a clay dispersing agent and to ask for an amendment of the description in regard to Bentone as a registered trade name. Having regard to the fact that in the present case the patent in suit has been maintained in unamended form, an objection regarding the use of the product name Bentone SD-1 in the claims only could amount to an objection under Article 84 EPC, which does not provide grounds for opposition.

The relevant passages of decision T 762/90, namely 4.1 of the Reasons for the Decision, referred to by the Appellant relate to the question whether or not a claim amended during the opposition proceedings by introduction of a trade name fulfils the requirements of Article 84 EPC. In that case, the Board had good reasons to have concern about the real meaning of that name. Accordingly, in the present case, there is no need to discuss further the Appellant's arguments relating to the outcome of the said decision.

4.5 Finally, the Board notes that according to the description of the patent in suit on page 2, lines 19 to 22 (page 2, lines 9 to 15 as originally filed) Bentone SD-1 was described in a prior art document as one specific product. No evidence to the contrary has been submitted by the Appellant.

4.6 Therefore, in the Board's judgement, the Appellant's grounds under Article 100(b) EPC do not prejudice the maintenance of the patent in suit.

5. Having regard to the Appellant's further objections under Article 100 EPC, the novelty of claim 1 as granted must be considered vis-à-vis documents disclosing bentonite clays in antiperspirant compositions. Therefore, the question arises whether Bentone SD-1 can be distinguished from other Bentone-type clays.

5.1 "Comparative Experiment II" on page 4 of the patent in suit may be criticisable in that it does not indicate the complete composition of the commercially available volatile silicon-based roll-on including Bentone 38 which is tested in comparison with the antiperspirant roll-on composition in accordance with the invention as exemplified in Example I. However, in the absence of any experimental counter-evidence, the Board can only

take Comparative Example II as it stands (see again point 3. above), and thus, can only take account of the fact that Bentone SD-1 including antiperspirant compositions show different test results in comparison with antiperspirant compositions including Bentone 38, and as a consequence, can only conclude that the product Bentone SD-1 can be distinguished from other Bentone-type clays to such an extent as to establish the novelty of the invention within the meaning of Article 54 EPC.

- 5.2 For lack of novelty of the subject-matter of claim 1 of the patent in suit the Appellant relied particularly on the "Compositions Q and R" in document (1), a document cited under Article 54(3) EPC.

Composition R contains "HMDS" (Hexamethyldisiloxane), a linear volatile silicone not falling within the terms of claim 1 of the patent in suit, which is limited to a volatile silicone fluid chosen from cyclic tetramers and pentamers of dimethicone (see component "ii").

Composition Q relates to an antiperspirant formulation including Rezal 36 GP [an aluminiumzirconium tetrachlorohydrate glycine complex] 25%; Bentone 38 5%; VS7207 [a cyclic polydimethylsiloxane comprising mainly tetramer] 66.5%; water 0.5%; perfume 1.0%. As such, both compositions do not affect the novelty of claim 1. According to claim 1, component (ii), and the description on page 5, line 21 up to page 6, line 14, the invention as set out in document (1) relates to an antiperspirant product comprising "up to 3C% by weight of the total liquid medium of one or more liquids less volatile than ethanol or isopropanol, provided that where such other liquid comprises a non-polar and water-immiscible liquid such non-polar water-immiscible

liquid is present in an amount of not more than 2C% by weight of the total liquid phase, where C is the percentage by weight of the clay in the composition;".

Even on the basis of a simple and rough calculation it is immediately clear that the weight range of VS7207 of Composition Q is outside the scope of the invention as set out in document (1) and thus Composition Q merely represents a comparative example. Consequently, the information on page 5, lines 4 to 11 of document (1) - "Preferred suspending agents for use in the product of the invention are hydrophobic clays available under the trade name of "Bentone" (emphasis added)... "Examples of useful "Bentone" suspending agents are..." "Bentone 38".... Other suitable "Bentone" clays are Bentone SD-1..." - cannot apply to a comparative example so that the combination suggested by the Appellant amounts to a non-disclosed construction which cannot destroy the novelty of the subject-matter of claim 1 of the patent in suit. It is indeed not directly and unambiguously derivable from document (1) whether or not Bentone SD-1 would function in the same way as Bentone 38 in a composition outside the teaching of this prior art (see also decision T 332/87, point 2.2 of the reasons for the Decision). Since document (1) was cited under Article 54(3) EPC, there cannot be any discussion of a possible replacement of Bentone 38 by Bentone SD-1 under Article 56 EPC.

- 5.3 As regards the Appellant's reference to Document (2), the Board can agree that this prior art discloses in general the use of hydrophobic suspending agents in antiperspirant compositions, particularly hydrophobic montmorillonite clays of the bentonite type sold under the trademark "Bentone" by N.L. Industries, Inc., and that, having regard to the weight percentage figures indicating the content of the antiperspirant active compound, of the volatile cyclic silicone and of the

suspending agent of "Formula A" in Example I and of "Composition C" in Example III, this prior art discloses compositions falling within the terms of claim 1 of the patent in suit. The antiperspirant formulations according to "Formula A" and "Composition C", however, contain Bentone 38 as the suspending agent, and thus can be distinguished from the composition of claim 1 of the patent in suit containing Bentone SD-1 (see point 5.1 above).

5.4 Document US-A-4 659 571 (referred to in the description belonging to the patent in suit on line 19) and the corresponding document EP-A-0 203 681 (cited in the European Search Report for the patent in suit), mention Bentone SD-1 as an organophilic clay in a list of several other clays suitable for formulations containing topical agents such as pigments, antifungal agents, insect repellants, antiperspirant agents and deodorant agents. None of the worked examples falls within the scope of claim 1 of the patent in suit and the Appellant did not rely on these documents.

5.4 After examination of the other prior art referred to in the procedure and by taking account of points 4.2 and 5.1 above, the Board is satisfied that claim 1 according to the patent in suit relates to novel subject-matter. In any event, a lack of novelty over other documents than those discussed above was not questioned by the Appellant during the appeal procedure.

6. Having regard to the cited state of the art, the Appellant did not present any argument relating to the question whether or not the subject-matter of the patent in suit is obvious to a person skilled in the art. The Board also sees no reason to deviate from the Opposition Division's opinion that the subject-matter of claim 1 of the patent in suit would not have been

obvious from the citations taken singly or in combination. Thus, the required inventive step is not lacking and the said claim satisfies the requirements of Article 56 EPC.

7. It is accordingly the Board's view that the Appellant's objections under Article 100 EPC do not prejudice the maintenance of the patent in suit as granted.

**Order**

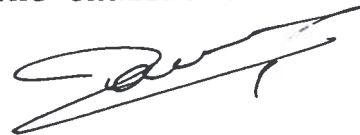
**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

  
P. Martorana

The Chairman:

  
P. A. M. Lançon

  
22.11.94

