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D E C I S I O N
of 5 February 1998

Case Number: T 0450/97 - 3.3.2

Application Number: 85308142.0

Publication Number: 0181773

IPC: A61K 7/08

Language of the proceedings: EN

Title of invention:
Shampoo compositions

Patentee:
The Procter & Gamble Company

Opponent:
Henkel KGaA
Unilever PLC
L'Oreal

Headword:
Shampoo composition/PROCTER & GAMBLE

Relevant legal provisions:
EPC Art. 123(2), 112(1), (a)
EPC R. 27(1), (b), (c), 89

Keyword:
"Adaptation of the description after remittal - acknowledgement of the closest prior art document"
"Rule 27(1), (b) (yes) - Article 123(2) (yes)"

Decisions cited:
T 0692/93, T 0598/92, T 0843/91, T 0051/87, T 0011/82

Headnote:
I. The mere addition of a reference to prior art does not

contravene Article 123(2) EPC (following T 11/82, T 51/87).

II. After limitation of the claims, also at the opposition stage, a document which subsequently proves not only to be the closest state of the art, but also to be essential for understanding the invention in the meaning of Rule 27(1)(b) is to be introduced in the amended description (see point 4. of the reasons).

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0450/97 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 5 February 1998

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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted 17 April 1997 concerning maintenance of the European patent No. 0 181 773 in amended form.**

Composition of the Board:

Chairman: P. A. M. Lançon
Members: C. Germinario
R. E. Teschemacher

Summary of Facts and Submissions

I. With decision T 692/93 (25 April 1996, not published in the OJ EPO), relating to European patent No. 0 181 773, corresponding to European patent application No. 85 308 142.0, the competent board of appeal remitted the case to the opposition division with the order to maintain the patent on the basis of the patentee's first auxiliary request submitted on 25 March 1996, and a description to be adapted thereto.

II. The independent claim according to the maintained request reads as follows:

"A shampoo composition comprising:

(a) from 5% to 70% of a synthetic surfactant;
(b) from 0.01% to 10% of a dispersed, insoluble, non-volatile silicone;
(c) from 0.5% to 5% of a suspending agent selected from long chain acyl derivatives and mixtures thereof, said acyl derivative being present in the shampoo composition in the form of crystals; and
(d) water,

wherein the acyl derivative has an average particle size in the shampoo composition of about 10 μm or less."

III. An adapted description was filed by the respondent (patentee) on 20 August 1996.

During the proceedings before the opposition division,

appellant I (opponent I) contested decision T 692/93 and requested either that said decision be clarified or that a statement be included in the patent description resulting in a restrictive interpretation of the scope of valid claim 1.

IV. In its interlocutory decision, the opposition division held that, account being taken of the adaptation of the description, the patent met the requirements of the Convention.

Moreover, the opposition division declared itself not to be competent to change or amend the claims maintained by the board of appeal or to introduce statements into the patent description which would result in an interpretation of the claims different to that given by the board.

V. Appeal against this decision was lodged by appellant I (opponent I) and appellant II (opponent III). Oral proceedings were held on 5 February 1998.

In the statement setting out the grounds of appeal, appellant I stated that, according to the respondent's (patentee's) arguments presented during the oral proceedings held in case T 692/93, the steps of heating and following cooling of the long chain acyl derivative were essential to obtaining crystal particles having the claimed size of 10 µm or less. They therefore criticised the fact that a record of these arguments was not included in the minutes of the oral proceedings, and requested that a statement be introduced into the patent description, or at least

into the reasons for decision T 692/93, in order to clarify that compositions in which the long chain acyl derivative is added as pearlising agent concentrate without heating above the melting point of said acyl derivative are excluded from the scope of the claims. In this respect, the appellant underlined that in some cases the then competent board agreed to correct an error in the reasons for the decision after delivery of the decision.

In a further letter, appellant I requested that two questions be referred to the Enlarged Board of Appeal under Article 112 EPC.

Appellant II objected to the adaptation of the description submitted by the respondent on the ground that the amendments consisted in defining the particle size of the crystals of the long chain acyl derivative, namely 10 µm or less, without specifying the process steps actually necessary to obtain the desired crystal size, ie heating and cooling. In the appellant's view, by setting the particle size free from the preparing process, the respondent has introduced subject-matter extending beyond the content of the application as filed. For this reason the patent should be revoked since it did not meet the requirements of Article 123(2) EPC.

He further contended that the adaptation of the description, as proposed by the respondent, did not meet the requirements of Rule 27(1)(b) and (c) EPC, since document US-A-4 337 166, identified in decision

T 692/93 as the closest prior art, was not acknowledged in the patent description.

As a reaction to the appellant's arguments and to an intermediate communication from the board, the respondent filed, on 23 December 1997, a further amended description in which the aforementioned closest prior art document was acknowledged.

VI. At the oral proceedings, the respondent filed, as auxiliary request, a further amended description which acknowledged the content of the closest prior art in more detail.

VII. Requests

Appellant I requested that the reasons for the decision in case T 692/93 be completed by adding a clarification that, according to the declaration of the patentee, compositions in which the acyl derivative was added as cold pearlising-agent concentrate, and which eventually were not heated above the melting point of said acyl derivative, were excluded from the scope of the claim.

Alternatively, he requested that the following two questions of law submitted in the letter dated 19 December 1997 be referred to the Enlarged Board of Appeal.

1. In opposition proceedings, is a technical board of appeal obliged of its own motion to refer specifically, in the reasons for its decision, to general comments made by the patent proprietor

during oral proceedings which are intended to limit the scope of protection vis-à-vis prior art cited in the proceedings, if these are not reflected in the claims or description?

2. If the answer is no, is the board obliged to do so if a party to the proceedings so requests?

Appellant II requested that the decision under appeal be set aside and that European patent No. 0 181 773 be revoked.

The respondent (patentee) requested that the appeal be dismissed and the patent be maintained in the version of the decision of the opposition division, page 2 of the description being replaced by amended page 2 submitted on 23 December 1997 (main request), alternatively, page 2 of the description being replaced by amended page 2 submitted during the oral proceedings (auxiliary request).

Reasons for the Decision

1. *Admissibility*

During the opposition proceedings, appellant I requested, among other options, that a clarifying statement be introduced into the adapted description. Since the request remained unsatisfied, the party was adversely affected by the decision of the opposition division.

Appellant II requested that the patent be revoked on the ground that the amended description did not comply with Rule 27 and Article 123(2) EPC. Since the patent was maintained, the party was adversely affected by the decision of the opposition division.

Therefore, the board holds the requirements of Article 107 EPC to be met. Since compliance with the requirements of Article 108 and Rule 64(b) EPC is not at issue in the present case, the admissibility of both appeals is recognised.

The admissibility was disputed by the respondent which foresaw in the grounds of both appeals an attempt to reconsider the findings of facts on which the binding parts of decision T 692/93 lie (*res judicata*, T 843/91, OJ EPO 1994, 832).

However, in case T 692/93, the competent board remitted the case to the department of first instance for adaptation of the description. The board did not enter into the substance of this adaptation, leaving competence for carrying out examination of the conformity of the description with the valid claims to the opposition division. While performing this task, the opposition division acted within the limits of this competence. Accordingly, its decision was independent and susceptible of being appealed.

2. *Scope of claim 1*

After consideration of the invention as disclosed in

the application as filed, the board competent in case T 692/93 had maintained an independent product claim.

This claim is clear. Firstly, there exists no doubt concerning its category since it is indisputably a product claim and, as such, it is limited exclusively by the features of the product as cited in the text of the claim; no inherent reference to the preparing process implies any additional limiting effect. Secondly, the wording of the claim is clear in that it is not open to different or contradictory interpretations. Finally, the claim is supported by the original description as indicated in reason 2.1, page 10, of decision T 692/93.

It can be concluded from the clear wording of the claim that the board did not intend to limit the scope of this product claim by way of any additional inherent reference to a specific preparing process. Such a claim would not have been maintained, had the board regarded the passage of the original description - "*In the cooling step, the acyl derivative is preferably crystallized into particles having an average particle size of about 10 μm or less*" (page 11, lines 11 to 13) - as a limiting condition for the invention. Indeed, nothing along these lines can be found in the reasons for the decision.

3. *Article 123(2) EPC*

The description of the patent, as maintained by decision T 692/93, was amended in that the sentence

"*wherein the acyl derivative has an average particle size in the shampoo composition of about 10 µm or less*" was added twice on page 2 (in lines 30 and 45). As already seen, the original description already comprised the passage "*In the cooling step, the acyl derivative is preferably crystallized into particles having an average particle size of about 10 µm or less*" (page 11, lines 11 to 13).

3.1 Appellant II argues that the amendments extend the content of the patent disclosure beyond the content of the filed application, since they imply generalisation of information, ie particle size of "10 µm or less", which in the filed application was only disclosed in relation to a specific preparing process characterised by heating and cooling steps.

3.2 However, the board cannot recognise, in the description as filed, any binding or limiting relationship between particle size and preparing process as claimed by the appellant.

In fact, it is well-known to the skilled person that, in a crystallisation process, the size of the crystals is a feature susceptible of being influenced by many factors: the crystallisation method being one factor, the operating conditions being additional important factors. Therefore, crystals in the desired size, say 10 µm or less, may be produced by selecting the suitable operating conditions of any suitable alternative method, which do not necessarily involve heating and cooling steps.

In the board's judgment, the essential feature of the invention, namely the crystal size of 10 µm or less, is an unconditional feature, not limited by any specific preparing process or condition. Accordingly, the passage of the original description on page 11, lines 11 to 13 represents, for the board, the necessary support in the description for such a feature, without however exercising any process-related limiting effect on the invention. In fact, the cooling step therein referred to represents only one example of the many different processes suitable for achieving the desired crystal size.

Under these circumstances, the amendments proposed by the respondent are held by the board to meet the requirements of Article 123(2) EPC.

4. *Rule 27 EPC*

4.1 After remittal of the case to the department of first instance, the respondent proposed a first adapted description which was accepted by the opposition division, which held the amended patent to meet the requirements of the EPC.

In the statement setting out the grounds of appeal, appellant II contended that the amended description, as maintained by the decision under appeal, did not comply with the requirements of Rule 27 EPC, since the prior art document, indicated in the appeal proceedings as the closest prior art, was not acknowledged in the

description.
The board shares this opinion as indicated in the annex to the summons to attend oral proceedings.

Although the expression "the closest prior art" is not quoted in the text of Rule 27 EPC, one mandatory requirement of the rule is that "the background art which... can be regarded as useful for understanding the invention"... is to be indicated in the description. Since the novel and inventive character of an invention is defined on the basis of the closest prior art, the background art not only most useful but also essential for understanding the invention is indeed the document representing such closest prior art. The discretionary power given by Rule 27(1)(b) in citing the documents reflecting such art is such, in the board's judgment, that the patentee is not compelled to cite all the documents illustrating such a background art or indeed any document at all in exceptional situations, eg when the background art is represented by general knowledge. This power, however, cannot justify the applicant's or patentee's silence on documents which were, from the beginning, or subsequently proved to be, essential for an understanding of the invention (T 11/82, OJ EPO 1983, 479; T 51/87, OJ EPO 1991, 177). In the present case the scope of valid claim 1 was first limited during the opposition proceedings, then maintained later during the appeal on the basis of document US-A-4 337 166 (21). Citation of this document is therefore not a matter of simple preference or discretion, but is regarded by the board as mandatory.

4.2 Before oral proceedings, page 2 of the description was further amended in that the following passage acknowledging the closest prior art document was added: "*US-A-4 337 166 describes compositions containing certain cyclic siloxanes and includes an example containing Empicol 0627 as a pearlising agent*".

Appellant II argues that the new amendments did not as such bring the content of the description into conformity with the requirements of Rule 27(1)(b) and (c), since, in this case, for the correct understanding of the invention, a simple citation of the closest prior art document was not sufficient. In fact, all the differences between the composition of the closest prior art and the compositions of the invention, which have been recognised and considered by the board in the earlier decision, should have been highlighted in the description. A detailed discussion of the closest prior art would also be necessary for an understanding of the technical problem, its solution and for an appreciation of all the advantageous effects of the invention with reference to the background art.

4.3 In the board's view, however, the citation of the closest prior art, document (21), and the indication of the relevant part of this document, namely an example disclosing a composition containing Empicol 0627 fulfil all the requirements of Rule 27(1)(b) and (c) EPC.

The reference to the specific example in the citation is helpful and sufficient to assist the public in understanding the invention. The technical teaching given by a patent is directed to a person skilled in

the art, who would recognise without difficulty that the composition of the example of the closest prior art comprises all the components (a) to (d) of the claimed invention, and in the same amounts. He would also be aware that Empicol 0627 comprises a long chain acyl derivative in crystalline form as accepted by all the parties at the earlier appeal. Therefore, keeping in mind that the composition of valid claim 1 is characterised by the average particle size of the acyl derivative of about 10 µm or less, the skilled reader would immediately understand that the invention lies in the claimed size of the acyl derivative crystals.

As to the requirements set out in Rule 27(1)(c) that the description must state any advantageous effects of the invention with reference to the background art, the board notes that the description clearly illustrates, on page 2, lines 26 to 36, the advantages of the invention with reference to many publications reflecting the background art: the invention provides "stabilisation [of the dispersed silicone] without interfering unduly with deposit of the silicone material onto the hair". More importantly, these advantages are also confirmed with respect to the closest prior art document, as is evident from the fact that the advantages stated in the description are those on the basis of which the underlying technical problem in decision T 692/93 has been formulated. Therefore, the description meets the requirements of Rule 27(1)(c) EPC.

5. Appellant I requests, as its main request, that the reasons for the decision in case T 692/93 be completed, under Rule 89 EPC, by adding the clarification that, according to a declaration of the respondent (patentee) given during the oral proceedings held in case T 692/93, compositions in which the acyl derivative was added as cold pearlising-agent concentrate, and which eventually were not heated above the melting point of said acyl derivative, were excluded from the scope of the claim. The purpose of this "clarification" would be to allow a restrictive interpretation of the scope of valid claim 1.

5.1 The respondent's declaration referred to by the appellant was made during oral proceedings in earlier case T 692/93, but the respondent contested that it had been worded as alleged by the appellant. Although the declaration was not recorded in the minutes of the oral proceedings, the present board has no reason to assume that the competent board in that case did not take such a declaration, within its factual context, into due account before delivering its decision. Apparently, the board did not find it necessary to refer to the declaration when giving the reasons for decision T 692/93. Thus, without entering into the merit of the competence of the present board, no apparent reason exists to justify a clarification of that decision on the basis of facts which have already been considered in the course of the procedure by the competent board.

5.2 In any case, the requested clarification would be allowable under Rule 89 EPC only if it removes a linguistic error, error of transcription or obvious

mistakes in the decision. If the text of the decision, or a part of it, does not correspond to the real intention of the deciding instance, then there is an obvious mistake within the meaning of Rule 89 EPC.

However, as explained in the preceding paragraphs, it is apparent that the board in case T 692/93 intended to maintain a product claim limited only by way of the features explicitly cited in the text of the claim. Such a claim category, which confers the broadest and also unconditional protection, would not have been maintained, if the board had intended to give the preparing process any limiting effect on the scope of said claim. Therefore, no contradiction is seen between the reasons for the earlier decision and the real intention of the competent board to justify the correction of the decision under Rule 89 EPC.

6. Appellant I alternatively requested that the two questions of law reported above be referred to the Enlarged Board of Appeal.

The questions relate, in general terms, to whether a technical board of appeal is obliged to discuss, in the reasons for the decision, of its own motion (question 1) or at the request of one of the parties (question 2), general statements made by the patentee during the oral proceedings which could imply a limitation of the scope of the claim vis-à-vis the cited prior art, but which are not reflected in the text of the valid claims or in the patent description.

The apparent reason for the two questions was the

aforementioned declaration released by the respondent during the oral proceedings in case T 692/93, which, in the appellant's view, was not given due consideration by the board. However, since in the present case there was no such equivalent situation, any possible answer to these questions would have no influence on the outcome of these appeal proceedings. Therefore, having regard to the factual context of the present case, the referral of the two questions to the Enlarged Board of Appeal is not required.

The conclusion of the board is thus that the patent in the form of the respondent's main request meets the requirements of the EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to maintain the patent as amended in the following version:

claims 1 to 9 and pages 3 to 8 of the description as indicated in Form 2339.4 contained in the decision under appeal;

page 2 of the description as submitted on 23 December 1997.

The Registrar: The Chairman:

P. Martorana P. A. M. Lançon