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D E C I S I O N
of 23 January 2004

Case Number: T 0885/99 - 3.3.7

Application Number: 92107311.0

Publication Number: 0511652

IPC: A61K 7/06

Language of the proceedings: EN

Title of invention:

Hair shampoo composition to impart improved hair conditioning properties

Patentee:

HELENE CURTIS, INC.

Opponents:

- 01 KPSS-Kao Professional Salon Services GmbH
- 02 Colgate-Palmolive Company
- 03 The Procter & Gamble Company

Headword:

-

Relevant legal provisions:

EPC Art. 84, 123(2)

Keyword:

"Clarity - definitions already present in the granted claims - not objectionable under Article 84 EPC"
"Amendments - added subject-matter (no)"

Decisions cited:

G 0009/91, T 0051/90, T 0270/90

Catchword:

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Case Number: T 0885/99 - 3.3.7

D E C I S I O N
of the Technical Board of Appeal 3.3.7
of 23 January 2004

Appellant: HELENE CURTIS, INC.
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Representative: -

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 12 July 1999
revoking European patent No. 0511652 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: R. E. Teschemacher
Members: B. J. M. Struif
P. A. Gryczka

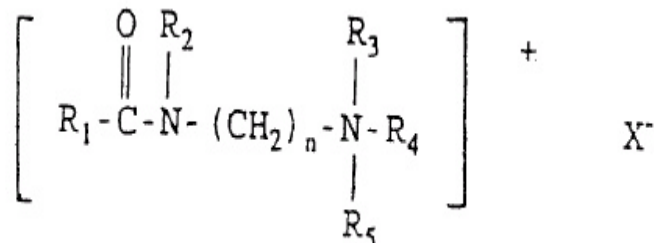
Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 511 652 with respect to European patent application No. 92 107 311.0, filed on 29 April 1992, was published on 29 November 1995. The granted patent was based on 26 claims. Independent claims 1 and 24 read as follows.

"1. A hair shampoo-conditioner composition comprising:
(a) from 1 % to 15 % by weight of an anionic cleansing surfactant;
(b) from 0.1 % to 2 % by weight of a polymeric cationic conditioning compound having an average molecular weight of at least 100,000;
(c) from 0.2 % to 10 % by weight of a cationic conditioning surfactant;
(d) from 0.1 % to 3 % by weight of a nonionic fatty ester; and
(e) a carrier comprising water."

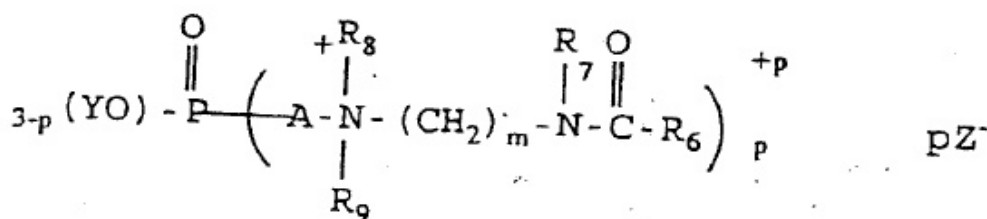
"24. A hair shampoo-conditioner composition comprising:
(a) from 3 % to 15 % by weight of an anionic cleansing surfactant selected from the group consisting of ammonium lauryl sulfate, sodium lauryl sulfate, ammonium lauryl ether sulfate having 1 mole of ethylene oxide, sodium lauryl ether sulfate having 1 mole of ethylene oxide and mixtures thereof;
(b) from 0.1 % to 1 % by weight of a guar hydroxypropyltrimonium chloride;
(c) from 0.2 % to 10 % by weight of a cationic conditioning compound selected from the group consisting of

i) a quaternary ammonium compound having the structural formula:



wherein R₁ is a substituted or unsubstituted, saturated or unsaturated, alkyl group having from 5 up to and including 21 carbon atoms; R₂ is hydrogen or methyl; R₃, R₄ and R₅, independently, are methyl, ethyl, hydroxyethyl or benzyl; n is a numeral from one to 10; and X is an anion selected from the group consisting of chloride, bromide, ethosulfate, methosulfate, acetate, nitrate, tosylate, phosphate and mixtures thereof;

ii) a quaternized phosphate ester having the structural formula:



wherein R₆ is an aryl group, an alkaryl group, a saturated or unsaturated alkyl group, or a saturated or unsaturated hydroxyalkyl group wherein the alkyl or hydroxyalkyl group has from about seven up to and including 21 carbon atoms; R₇ is hydrogen, or an alkyl or a hydroxyalkyl group having from one up to and including six carbon atoms; R₈ and R₉, independently,

are an alkyl or a hydroxyalkyl group having from one up to and including six carbon atoms; A is a residue of a glycol or a triol having from two up to and including four carbon atoms; Z is an anion selected from the group consisting of chloride, bromide, methosulfate, ethosulfate and mixtures thereof; m is a numeral from one to 10; Y is selected from the group consisting of hydrogen, an alkyl group, a hydroxyalkyl group and an aryl group, either substituted or unsubstituted, and wherein the alkyl or the hydroxyalkyl group has from one up to and including 22 carbon atoms; and p is a number from 1 to 3; and

iii) a mixture thereof;

(d) from 0.1 % to 3 % by weight of a fatty ester selected from the group consisting of cetearyl octanoate, isostearyl benzoate, a fatty (C₁₂-C₁₅) alcohol benzoate and mixtures thereof;

(e) from 0 % to 5 % by weight of an amphoteric surfactant selected from the group consisting of cocamidopropyl betaine, lauramidopropyl betaine, coco/oleamidopropyl betaine, coco betaine, oleyl betaine, cocamidopropyl hydroxysultaine, tallowamidopropyl hydroxysultaine, dihydroxyethyl tallow glycinate and mixtures thereof;

(f) from 0 % to 5 % by weight of a nonionic alkanolamide selected from the group consisting of cocamide MEA, cocamide DEA, soyamide DEA, lauramide DEA, oleamide MIPA, stearamide MEA, myristamide MEA, lauramide MEA, capramide DEA, ricinoleamide DEA, myristamide DEA, stearamide DEA, oleylamide DEA, tallowamide DEA, lauramide MIPA, tallowamide MEA, isostearamide DEA, isostearamide MEA and mixtures thereof; and

(g) a carrier comprising water."

- II. Three notices of opposition were filed against the granted patent, in which the revocation of the patent in its entirety was requested on the grounds of Article 100(a), (b) and (c) EPC respectively.
- III. In a decision issued in writing on 12 July 1999, the opposition division revoked the patent. That decision was based on a set of claims 1 to 25 (main request) and five auxiliary requests. Claim 1 of the main request read as follows:

"A hair shampoo-conditioner composition comprising:
(a) from 1 % to 15 % by weight of an anionic cleansing surfactant, wherein the anionic cleansing surfactant is an alkali metal salt, an ammonium salt, an alkylammonium salt or a hydroxyalkylammonium salt wherein the alkyl group has from one up to and including three carbon atoms,
of an alkyl sulfate, an alkyl ether sulfate, an alkyl ether sulfonate, a sulfate ester of an alkylphenoxy polyoxyethylene ethanol, an alpha-olefin sulfonate, a beta-alkyloxy alkane sulfonate, an alkyl arylsulfonate, an alkyl ether carboxylate, a sulfosuccinate, a sarcosinate, an octoxynol phosphate, a nonoxynol phosphate, a taurate, a fatty tauride, a sulfated monoglyceride, a fatty amido polyoxyethylene sulfate, an isothienate or mixtures thereof, wherein the fatty moiety has from twelve up to and including eighteen carbon atoms and the alkyl moiety has from twelve up to and including eighteen carbon atoms,

- (b) from 0.1 % to 2 % by weight of a polymeric cationic conditioning compound having an average molecular weight of at least 100,000;
- (c) from 0.2 % to 10 % by weight of a cationic conditioning surfactant which is a quaternary ammonium compound including a fatty amidoalkyl substituent, or a quaternised phosphate triester;
- (d) from 0.1 % to 3 % by weight of a nonionic fatty ester; and
- (e) a carrier comprising water."

In claim 1 of the first auxiliary request feature (c) of claim 1 of the main request was replaced by the following feature:

"(c) from 0.2 % to 10 % by weight of a cationic conditioning surfactant, which is a quaternary ammonium compound including a fatty amidoalkyl substituent with a fatty amido moiety which contains a saturated or unsaturated acyl group of 6 to 22 carbon atoms which is unsubstituted or is substituted with a single hydroxy group, or a quaternised phosphate triester;"

The decision can be summarized as follows:

- (a) The term "fatty amidoalkyl substituent" in claim 1 of the main request was not clear, since there were two possible interpretations for that term on the basis of the patent in suit. According to the first definition the fatty amidoalkyl group could be interpreted in a structural sense as meaning an acyl group of a fatty acid in line with R₁ of formula (I) on page 10 of the patent in suit. The term "fatty acid" was known in the art to include

certain unsubstituted saturated or unsaturated aliphatic acyl groups, in particular, fatty acids substituted with one hydroxy group, however, any other or further substitutions on the acyl rest of the amidoalkyl substituent as specified in formula (I) of the patent in suit were not covered by such a definition.

On the other hand, the term "fatty amido alkyl substituent" might also mean that said substituent was fatty which equated with the term "hydrophobic". However, there was no clear interpretation of that term, since according to the patent in suit the "fatty alkylamido substituent" must have a certain degree of hydrophilicity which was in contradiction to the normal understanding of "hydrophobic". Consequently, the term objected to was not clear (Article 84 EPC).

- (b) For the same reasons the subject-matter of auxiliary requests II, III and V did not meet the requirements of Article 84 EPC, either.
- (c) In claim 1 of the first auxiliary request, the amended term "with a fatty amido moiety which contains a saturated and unsaturated acyl group of 6 to 22 carbon atoms which is unsubstituted or is substituted with a single hydroxy group" was only disclosed with respect to the specific formula (I) in the application as filed, which formula was further defined by an alkylene group and specific substituents on the quaternary nitrogen atom. The application as filed provided no basis for the

generalized term as defined in claim 1.

Consequently, claim 1 of the first auxiliary request and, for the same reasons, the subject-matter of the fourth auxiliary request did not meet the requirements of Article 123(2) EPC.

IV. On 16 September 1999, the proprietor (appellant) filed a notice of appeal against the above decision, the prescribed fee being paid on the same day. In the statement setting out the grounds of appeal filed on 19 November 1999, the appellant submitted an amended set of claims 1 to 25 (main request) and twelve auxiliary requests.

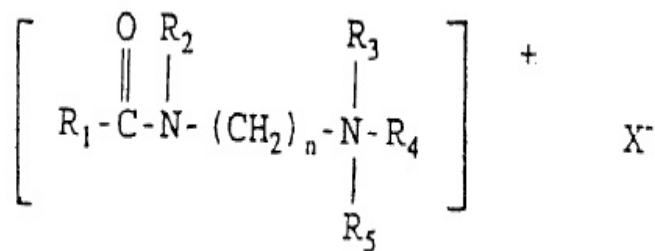
V. In an annex to the summons to attend the oral proceedings dated 8 October 2003, the board addressed the points to be discussed, in particular the formal allowability of the amended requests pursuant Articles 123(2) and 84 EPC. In a reply dated 27 November 2003, the appellant submitted an amended main and first auxiliary request and withdrew his request for oral proceedings.

VI. On 10 December 2003, in reply to a further communication of the board, the appellant filed an amended set of claims 1 to 24 as main request and a first auxiliary request, which replaced all the previous requests on file. In a letter dated 19 January 2004, the appellant announced that he would not attend the oral proceedings.

Amended claim 1 of the main request reads as follows:

"A hair shampoo-conditioner composition comprising:

- (a) from 1 % to 15 % by weight of an anionic cleansing surfactant, wherein the anionic cleansing surfactant is an alkali metal salt, an ammonium salt, an alkylammonium salt or a hydroxyalkylammonium salt, wherein the alkyl group has from 1 up to and including 3 carbon atoms, of: an alkyl sulfate, an alkyl ether sulfate, an alkyl ether sulfonate, a sulfate ester of an alkylphenoxy polyoxyethylene ethanol, an alpha-olefin sulfonate, a beta-alkyloxy alkane sulfonate, an alkyl arylsulfonate, an alkyl carbonate, an alkyl ether carboxylate, a fatty acid, a sulfosuccinate, a sarcosinate, an octoxynol phosphate, a nonoxynol phosphate, a taurate, a fatty tauride, a sulfated monoglyceride, a fatty acid amido polyoxyethylene sulfate, an isothienate, or combinations thereof, wherein the fatty moiety has from 12 up to and including 18 carbon atoms and the alkyl moiety has from 12 up to and including 18 carbon atoms;
- (b) from 0.1 % to 2 % by weight of a polymeric cationic conditioning compound having an average molecular weight of at least 100,000;
- (c) from 0.2 % to 10 % by weight of a cationic conditioning surfactant, selected from
 - (i) quaternary ammonium compounds depicted by general structural formula:



wherein:

R₁ is a substituted or unsubstituted, saturated or unsaturated, alkyl group having from 5 to 21 carbon atoms;

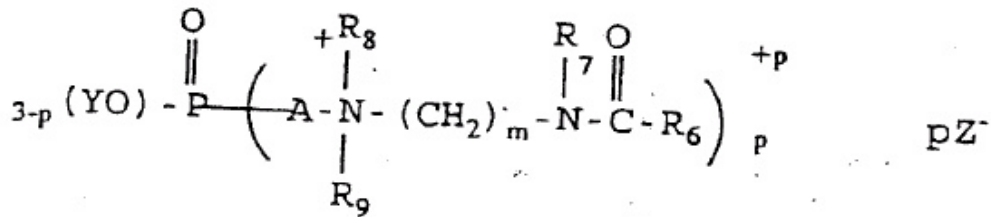
R₂ is hydrogen or methyl;

R₃, R₄ and R₅, independently, are methyl, ethyl, hydroxyethyl, or benzyl;

n is a numeral from 1 to 10; and,

X is an anion selected from: chloride, bromide, ethosulfate, methosulfate, acetate, nitrate, tosylate, phosphate, and combinations thereof;

(ii) quaternized phosphate esters depicted by the general structural formula:



wherein:

R₆ is an aryl group, an alkaryl group, a saturated or unsaturated alkyl group, or a saturated or unsaturated hydroxyalkyl group wherein the alkyl or hydroxyalkyl group includes from 7 up to and including 21 carbon atoms;

R₇ is hydrogen, or an alkyl or a hydroxyalkyl group having from 1 up to and including 6 carbon atoms;

R₈ and R₉, independently, are an alkyl group or a hydroxyalkyl group having from 1 up to and including 6 carbon atoms; A is a residue of a glycol or a triol having from 2 up to and including 4 carbon atoms;

Z is an anion selected from: chloride, bromide, methosulfate, ethosulfate, and combinations thereof;

m is a numeral from one to 10;

- Y is selected from: hydrogen, an alkyl group, a hydroxyalkyl group and an aryl group, either substituted or unsubstituted, and wherein the alkyl group or the hydroxyalkyl group has from 1 up to and including 22 carbon atoms;
and p is a number from 1 to 3; and
(iii) a combination thereof;
(d) from 0.1 % to 3 % by weight of a nonionic fatty ester; and,
(e) a carrier comprising water."
- VII. By letters dated 7 January 2004 and 14 January 2004 the opponents 02 and 01, respectively (respondents 02 and 01) withdrew their requests for oral proceedings and announced that they would not attend the oral proceedings.
- VIII. Opponent 03 (respondent 03) who had not requested oral proceedings, announced in his letter dated 20 January 2004 that he would not attend the oral proceedings. On 23 January 2004 oral proceedings were held in the absence of the parties according to Rule 71(2) EPC.
- IX. The arguments of the appellant submitted in writing can be summarized as follows:

The amended sets of claims of the main and first auxiliary request were submitted to overcome the objections raised in the decision under appeal according to Article 123(2) and 84 EPC. The requests were filed before the time limit set out in the summons to attend oral proceedings. The requests did not reflect an abuse of the proceedings and were intended to expedite the proceedings.

- X. The arguments of the respondents submitted in writing can be summarized as follows:

The appellant had submitted an entirely new case after about four years by shifting the object of the debate, which amounted to an abuse of the proceedings. The debate in opposition and appeal proceedings was whether or not the introduction of the terms "fatty alkyl substituents" and "quaternized phosphate triesters" complied with Article 123(2) and 84 EPC. The amendments requested by the appellants had been apparent to them since the very beginning of the proceedings and could have been filed already in the first instance. Thus, the new requests should not be admitted into the proceedings.

- XI. The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further examination on the basis of the main request or, alternatively, of the first auxiliary request, both submitted with letter dated 9 December 2003.

- XII. The respondents requested that the appeal be dismissed. Respondent 03 requested that the newly submitted claims should not be allowed into the proceedings.

Reasons for the Decision

1. The appeal is admissible

Amendments (main request)

2. Respondent 03 was of the opinion that the requests filed on 10 December 2003 should not be admitted into the proceedings.

- 2.1 The main criteria laid down by the boards of appeal for the admission of amended claim requests at a late stage of the appeal proceedings is whether they are serious attempts at overcoming objections either raised in the decision under appeal, by the board or by the respondents and whether they can be quickly checked for their compliance with the requirements of Articles 123(2) and 84 EPC (Case Law of the Boards of Appeal of the European Patent Office, 4th edition, 2001, Section VII, D.14.1). It is normally sufficient for reasons of fairness if new claim requests are submitted one month before the oral proceedings (compare T 51/90 of 8 August 1991 and T 270/90 of 21 March 1991, both cited in Case Law, C.D.14.2).

- 2.2 In the present case the final requests were filed in response to the communication of the board on 10 December 2003 about six weeks before the oral proceedings arranged for 23 January 2004. The requests were consequently filed within the time limit of one month set by the board in the communication accompanying the summons to attend oral proceedings (point 6). Thus, there was sufficient time for the respondents to check the amendments on their merits.

- 2.3 Furthermore, the amendments are based on granted claims 4 and 24 and are nothing more than a foreseeable limitation of the claimed subject-matter to preferred embodiments of the invention.

- 2.4 The amendments remedy the grounds on which the patent was revoked by the opposition division (see points 3 and 4 below) and overcome the objections raised by the board.
- 2.5 Finally, the board can not detect any procedural violation in the behaviour of the appellant to first maintain requests submitted in the first instance, and then amend or abandon them, because the appellant has the right to have all the rejected requests reconsidered by the boards of appeal (see G 0009/91, OJ EPO, 1993, 408). Contrary to the submissions of respondent 03, the admission of the late amendments does not result in an unreasonable delay of the proceedings. The procedural result would be exactly the same if the appellant had already submitted the amended claims as an auxiliary request in the statement setting out the grounds of appeal.
- 2.6 Consequently, the behaviour of the appellant does not amount to an abuse of the proceedings and the amendments are admitted.
3. The amendments in claim 1 of the main request are based on original claim 1 in connection with the following passages in the documents as originally filed:
- (a) anionic cleansing agents: claim 4
 - (i) quaternary ammonium compounds: page 26, lines 1 to 16 and claim 25;
 - (ii) quaternized phosphate esters: page 27, line 21 to page 28, line 12 and claim 25
 - (iii) a combination thereof: claim 25.

Claims 2 to 24 correspond to claims 4 to 26 as granted and are editorially adapted to amended claim 1.

- 3.1 Since the definitions as specified above have a basis in the documents as originally filed and restrict the scope of the granted claims, the amendments meet the requirements of Article 123(2) and (3) EPC.
- 3.2 The term "fatty amidoalkyl substituent" objected to in the decision under appeal has been removed from claim 1. Furthermore, the definition of the quaternized phosphate esters and of the quaternary ammonium compounds in amended claim 1 of the main request is already present in the version of claim 24 as granted. The same applies to the definition of the anionic cleansing agent incorporated into claim 1 and which is already mentioned in granted claim 4. Since the amended definitions are already present in the granted claims and since lack of clarity is no ground for opposition, those definitions cannot be objected to under Article 84 EPC (Case Law, *supra*, VII.C.10.2).

In addition, no substantial objections under Article 84 and 123(2) EPC to the requests now on file have been raised by the respondents.

Remittal

4. Since the decision under appeal has dealt only with formal objections under Articles 123(2) and 84 EPC and since remittal to the first instance was requested by the appellant, the board exercises its discretion to remit the case for further prosecution with respect to

the outstanding formal and substantive issues, to give the parties the opportunity to defend their case before two instances (Article 111(2) EPC). The further examination should be continued on the basis of the claims of the main request by taking into account that further examination may reveal that additional amendments are required.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

C. Eickhoff

R. Teschemacher