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D E C I S I O N
of 12 June 2003

Case Number: T 0897/99 - 3.3.2

Application Number: 90907305.8

Publication Number: 0479795

IPC: A61K 7/50

Language of the proceedings: EN

Title of invention:
Aqueous based personal washing cleanser

Patentee:
UNILEVER N.V., et al

Opponent:
L'OREAL

Headword:
-

Relevant legal provisions:
EPC Art. 56

Keyword:
"Main request - inventive step no: obvious alternative over the prior art teaching"
"First to fourth auxiliary requests: idem"

Decisions cited:
-

Catchword:
-

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Case Number: T 0897/99 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 12 June 2003

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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted 26 July 1999 concerning maintenance of European patent No. 0 479 795 in amended form.**

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
C. Rennie-Smith

Summary of Facts and Submissions

I. European patent No. 0 479 795 based on international application No. PCT/GB90/00700 was granted on the basis of 13 claims.

Independent claim 1 as granted read as follows:

1. A liquid aqueous based skin cleansing composition characterised in that it comprises:
(i) at least 3wt% of an C_8-C_{22} acyl esters of isethionic acid salts;
(ii) at least 2wt% of at least one long chain fatty acid having a major proportion of C_{16} or above;
(iii) at least 2wt% of a moisturizer component; and
(iv) O-5wt% soap;
wherein the weight ratio of (i) to (ii) ranges from 1:0,1 to 1:10.

II. Notice of opposition was filed against the granted patent by the appellant opponent (opponent).

The patent was opposed under Article 100(a) EPC for lack of novelty and lack of inventive step.

The following documents were *inter alia* cited during the proceedings:

(1bis) French translation of JP-A-63-275698
(2bis) English translation of JP-A-63-243200
(3) JORDAPON® CI Flake, commercial leaflet of the company PPG Mazer Chemicals
(5) Cosmetics and toiletries, 104, page 128, March 1989.

III. The interlocutory decision of the Opposition Division held that the patent could be maintained on the basis of the fourth auxiliary request of the appellant patentees (patentees) as supplemented during the oral proceedings on 3 February 1999.

The Opposition Division decided that document (3), a commercial leaflet of the company PPG consisting of two unnumbered pages, did not belong to the state of the art because it could not be not established whether the two pages belonged together and because, in its opinion, the copyright date present on one of the two pages could not be regarded as its publication date.

The Opposition Division considered that the subject-matter of the main request was novel over documents (1bis) and (2bis) because document (1bis) failed to disclose compositions comprising at least 2w% of at least one long chain fatty acid having a major proportion of C_{16} or above and document (2bis) disclosed creamy compositions.

However the Opposition Division rejected this request for lack of inventive step over document (1bis) because that had disclosed adding "higher" fatty acids to cleansing compositions containing isethionates to improve stability and because the patentee did not show that adding "a major proportion" of C_{16} fatty acids or above provided any particular effect. In that respect, it considered that the comparative test presented in the patentee's letter of 25 March 1997 could not be taken into account for assessing inventive step as it was not performed vis-à-vis the closest prior art embodiment.

The first auxiliary request was rejected for the same reasons as no particular effect had been demonstrated for the additional feature introduced in claim 1, ie the presence of at least 2% of a co-active surfactant.

The second and third auxiliary requests were rejected because in the Opposition Division's opinion they contained added matter (Article 123(2) EPC).

The Opposition Division considered that the subject-matter of the fourth auxiliary request, which contained specific co-active surfactants other than taurates, involved an inventive step over the closest prior art document (1bis) because it was not obvious that cleansing compositions based on isethionates and fatty acids could be stable without taurate surfactants.

IV. The opponent and the patentees both lodged appeals against the said decision. The patentees filed a new main request and auxiliary requests 1 to 4 with their grounds of appeal.

Claim 1 of the main request reads:

1. A liquid aqueous based skin cleansing composition characterised in that it comprises:
(i) at least 3wt% of an C_8-C_{22} acyl esters of isethionic acid salts;
(ii) at least 2wt% of at least one long chain fatty acid having a major proportion of C_{16} or above;
(iii) at least 2wt% of co-active surfactant selected from the group comprising anionic and amphoteric surfactants other than taurates;
(iv) at least 2wt% of a moisturizer component; and
(v) O-5wt% soap;

wherein the weight ratio of (i) to (ii) ranges from 1:0,1 to 1:10 (Emphasis added).

Independent claim 1 of the first auxiliary request reads:

1. A liquid aqueous based skin cleansing composition characterised in that it comprises:
(i) at least 3wt% of an C_8-C_{22} acyl esters of isethionic acid salts;
(ii) at least 2wt% of at least one long chain fatty acid having a major proportion of C_{16} or above;
(iii) at least 2wt% of co-active surfactant selected from alkyl sulfates, alkyl ether sulfates, alkyl ether sulfonates, sarcosinates, sulfosuccinates, alkylbetaines, amidopropyl betaines, amidopropyl sultaines and combinations thereof;
(iv) at least 2wt% of a moisturizer component; and
(v) O-5wt% soap;
wherein the weight ratio of (i) to (ii) ranges from 1:0,1 to 1:10 (Emphasis added).

Independent claim 1 of the second auxiliary request corresponds to claim 1 of the first auxiliary request with the added words "the group comprising" in feature (iii) after the words "selected from" with the following ranges:
(i) 3 to **20wt%**
(ii) **5 to 15wt%**
(iii) **5 to 20wt%**
(iv) **5 to 15wt%** (Emphasis added).

Independent claim 1 of the third auxiliary request reads:

1. A liquid aqueous based skin cleansing composition characterised in that it comprises:
(i) at least 3wt% of an C_8-C_{22} acyl esters of isethionic acid salts;
(ii) at least 2wt% of **a mixture of stearic and palmitic acids**;
(iii) at least 2wt% of co-active surfactant;
(iv) at least 2wt% of a moisturizer component; and
(v) 0-5wt% soap;
wherein the weight ratio of (i) to (ii) ranges from 1:0,1 to 1:10 (Emphasis added).

Independent claim 1 of the fourth auxiliary request reads:

1. A liquid aqueous based skin cleansing composition characterised in that it comprises:
(i) 3 **to 20wt%** of an C_8-C_{22} acyl esters of isethionic acid salts;
(ii) 2 **to 15wt%** of **a mixture of stearic and palmitic acids**;
(iii) 2 **to 20wt% of co-active surfactant selected from the group comprising alkyl sulfates, alkyl ether sulfates, alkyl ether sulfonates, sarcosinates, sulfosuccinates, alkylbetaines, amidopropyl betaine, amidopropyl sultaines and combinations thereof;**
(iv) 2 **to 15wt%** of a moisturizer component; and
(v) 0-5wt% soap;
wherein the weight ratio of (i) to (ii) ranges from 1:0,1 to 1:10 (Emphasis added).

V. Oral proceedings were held before the Board on 12 June

2003.

VI. The patentees denied that document (3) belonged to the state to the art for the same reasons as given by the Opposition Division.

They considered that document (5) should not be admitted in the proceedings as late filed.

They maintained that the new main request, which corresponds to the third auxiliary request which was rejected by the Opposition Division, did not contravene Article 123(2) EPC contrary to the Opposition Division's view.

In their opinion the exclusion of taurates from the subject-matter of claim 1 of this request did not infringe the requirements of Article 123(2) EPC as it merely consisted in excluding a disclosed alternative.

As to inventive step, they shared the Opposition Division's conclusions that there was nothing in the prior art to suggest that non-taurate surfactants would be efficient in the context of the higher-carbon-content fatty acids which form part of the claimed liquid composition.

In their view, these findings applied also, with greater force, to the more limited subject-matter of the auxiliary requests.

VII. The opponent filed document (5) with its last written submissions of 9 May 2003 in order to establish that the cleansing composition disclosed in document (3) belonged to the state of the art as it had been

described in this document which was definitely published before the priority date of the patent in suit.

It held that the exclusion of taurates from claim 1 of the main request contravened Article 123(2) EPC as the original disclosure did not foresee such an exclusion.

Moreover, it was of the opinion that this request lacked novelty over document (2bis), in particular example 6 in table 2, and inventive step over documents (5),(1bis) and (2bis).

As to the auxiliary requests 1 to 4, it objected that they all infringed the requirements of Article 123(2) EPC and that they all lacked inventive step over documents (5), (1bis) and (2bis). The objections under Article 123(2) EPC against these requests were however not further maintained during the oral proceedings.

VIII. The opponent requested that the decision under appeal be set aside and that the European patent No. 0 479 795 be revoked.

The patentees requested that the appeal be dismissed and that the patent be maintained on the basis of the set of claims of the main request or alternatively, that of the first, second, third or fourth auxiliary requests, all filed with their grounds of appeal dated 3 December 1999.

Reasons for the Decision

1. The appeals are admissible.

2. *Admissibility of document (5)*

Document (5) was filed by fax slightly more than one month before the appointed date of the oral proceedings.

It is however established European case law that the admission of a citation which has been filed late depends inter alia on whether it is decisive for the outcome of the case (Case Law of the Board of Appeal of the European Patent Office, 4th Edition 2001, VI.F.3.1.1, pages 327 and 328).

As indicated by the Board at the beginning of the oral proceedings, document (5) precisely represents the closest state of the art and its content is the same as document (3) which was introduced during the opposition procedure(see point 3.3 below).

Accordingly, document (5) is admitted in the proceedings.

3. *Main request*

3.1 Article 123(2)

This set of claims corresponds to the set of claims which was third auxiliary request before the Opposition Division. That is, claim 1 of the patent as granted was modified to state that the co-active surfactant is anionic or amphoteric but not a taurate.

Anionic and amphoteric surfactants are disclosed on page 5, lines 15 to 26 and taurates on page 5, line 23 and page 8, lines 10 and 11 of the application as

originally filed.

It is indeed true, as argued by the opponent, that the application as originally filed does not describe the exclusion of taurates.

The application as originally filed does however disclose taurates as an alternative among the anionic co-active surfactants mentioned in the description.

Since, as a rule, it is permissible to restrict the subject-matter of a claim by deleting one of the alternatives which was originally disclosed and since that is precisely what the amendment does, the Board concludes that claim 1 of this request does not contravene the requirements of Article 123(2) EPC.

3.2 Novelty

The Board agrees with the patentees' submission that the feature in independent claim 1 reciting that **at least 2wt% of at least one long chain fatty acid having a major proportion of C_{16} or above** is a distinguishing feature over the disclosure in document (2bis) and in particular over example 6 in table 2 describing a cleansing composition with 6 wt% myristic acid (C_{14}) and 3 wt% palmitic acid (C_{16}), because the requirement of this claim that the long chain fatty acids have **a major proportion of C_{16} or above** must be fulfilled considering all the fatty acids present in the composition. Accordingly, this request is novel over document (2bis) which does not fulfill this requirement of claim 1.

Having regard to the Board’s conclusions on inventive step (see below, point 3.3), there is no need to go

into more detail.

3.3 Inventive step

3.3.1 The patent provides aqueous based skin cleansing compositions comprising:

(i) at least 3wt% of an C_8-C_{22} acyl esters of isethionic acid salts;

(ii) at least 2wt% of at least one long chain fatty acid having a major proportion of C_{16} or above;

(iii) at least 2wt% of a moisturizer component;

wherein the weight ratio of (I) to (ii) ranges from 1:0,1 to 1:10.

The compositions are described as having the advantages of mildness, good moisturizing, good lathering, and excellent long term stability.

They can additionally contain anionic, nonionic, cationic and amphoteric co-active surfactants. (Page 3, lines 44 to 48; page 4, line 4 and lines 34 to 39).

According to claim 1 of the present request, the compositions are restricted to those comprising, beside nonionic and cationic surfactants, at least 2wt% of co-active surfactants selected from the group comprising anionic and amphoteric surfactants other than taurates.

Document (5) discloses a commercial liquid aqueous based cleansing lotion comprising:

(i) at least 3wt% of a C_8-C_{22} acyl esters of isethionic acid salts (18wt% Jordapon® CI Flake providing 8,6wt% sodium cocoyl isethionate; see below));

(ii) at least 2wt% of at least one long chain fatty acid having a major proportion of C_{16} or above (18wt% Jordapon® CI Flake providing about 4wt% stearic acid and about 4wt% palmitic acid; see below));

(iii) at least 2wt% of co-active surfactant (2wt% of cetyl alcohol; ie a nonionic co-active surfactant);

(iv) at least 2wt% of a moisturizer component (7wt% mineral oil) and wherein the weight ratio of (i) to (ii) ranges from 1:0,1 to 1:10 (about 1).

In fact, independently of the question whether document (3) belongs to the prior art, it is not disputed that it described the same product as that disclosed in document (5).

Accordingly, the opponent, referring on the one hand to the composition given for Jordapon® CI Flake in document (3) (left column, paragraphs 1 and 2), ie a blend of 48% sodium cocoyl isethionate and 45% fatty acid (being stearic acid as it is apparent from paragraph 1), and on the other hand to the definition given for stearic acid in the contested patent itself, ie a commercial product containing about 47% C_{18} (stearic acid) and 50% C_{16} (palmitic acid) (Formulation A and page 10, line 9), concluded that all the features of the composition of claim 1 of the main request of the contested patent

were fulfilled by the composition of document (5) except that the latter contained a nonionic co-active surfactant but no anionic and amphoteric surfactants other than taurates.

The opponent's calculations have not been contested by the patentees and the Board sees no reason to differ.

Accordingly, the Board considers that document (5) represents the closest available prior art.

3.3.2 As there is no evidence on file showing that the composition of document (5) does not also have the advantages of mildness, good moisturizing, good lathering, and excellent long term stability as required in general for a personal washing cleanser, the problem to be solved vis-à-vis this document can only be seen as the provision of an alternative liquid cleansing composition.

3.3.3 In the light of the working examples of the patent in suit, the Board is satisfied that the problem has been solved by the subject-matter of claim 1.

3.3.4 Thus, the question to be answered is whether the proposed solution, ie adding anionic and amphoteric surfactants other than taurates, was obvious to the skilled person in the light of the prior art.

Having regard to document (1bis) which discloses that, beside nonionic and cationic surfactants, anionic and amphoteric surfactants can be added to liquid cleansing compositions similar to thoses of the patent in suit, it appears that the skilled person, looking for further cosmetic compositions, would consider the addition of

anionic and amphoteric surfactants to the prior art composition without inventive activity merely by applying the teaching of document (1bis) (page 6, third paragraph; table 2, example with laurylsarcosinate, ie an anionic surfactant).

Accordingly, the subject-matter of claim 1 of the main request does not involve an inventive step as required under Article 56 EPC.

3.3.5 The main argument raised by the patentees was that the closest prior art was in fact represented by document (1bis) because this document, unlike document (5), recognised the stability problem linked to the low solubility of acylisethionate compounds at low temperature (page 3, first paragraph).

It argued, accordingly, that the subject-matter of claim 1 was inventive because the skilled person would have assumed, when reading document (1bis), that the presence of taurate surfactants was mandatory in order to solve this stability problem (page 3, fourth paragraph).

3.3.6 As to this argument, the Board notes that according to the description of the contested patent the stability of the compositions is achieved by the features (i), (ii) and (iv) of claim 1 of the main request and that the patent in suit is totally silent about any particular effect achieved by the optional addition of anionic and amphoteric surfactants and the absence of taurate surfactants (page 3, lines 44 to 48 and 56, 57).

In addition, the Board observes that, as stated above

under 3.3.2, there is no reason not to assume that the liquid cleansing composition according to document (5) is as stable as those of the patent in suit, which implies that the skilled person would have known from document (5) that taurates surfactants are not mandatory in order to achieve stable liquid cleansing compositions based on isethionates and long chain fatty acids.

Finally, the Board does not share the patentees' view that document (1bis) represents the closest state of the art since the compositions of this document are more distant from the claimed ones because, in comparison with the composition of document (5), they do not fulfill the requirements according to feature (ii) of claim 1 of the main request of the opposed patent.

Under these circumstances, the Board can only conclude that, as appears from point 3.3.4 above, the subject-matter of claim 1 does not involve an inventive step over document (5).

Since claim 1 of the set of claims under consideration is not allowable, there is no need for the Board to consider the remaining claims.

4. First auxiliary request

The set of claims of this request corresponds to the set of claims as maintained by the Opposition Division.

No objection under Articles 123(2) and (3), 84 and 54 EPC was raised or maintained with respect to this set of claims and the Board sees no reason to differ.

4.1 Inventive step

The only difference between this request and the main request resides in that feature (iii) of claim 1 requiring the presence of anionic and amphoteric surfactants has been replaced by a list of specific surfactants.

In fact, the only argument brought by the patentees was that those developed vis-à-vis the main request should apply also, with greater force, to the more limited subject-matter of the first auxiliary request.

However, as these particular surfactants are well-known in the art, as is apparent for instance from document (1bis) (table 2: laurylsarcosinate), and as no particular effect has been achieved by these particular surfactants, the conclusions under 3.3.6 hold good for this set of claims as well.

5. Second auxiliary request

Independent claim 1 of this request corresponds to a combination of claims 1, 3 and 4 as originally filed as regards the upper and lower limits of the ingredients and furthermore, the coactive surfactant is specified as in the first auxiliary request.

No objection under Articles 123(2) and (3), 84 and 54 EPC was raised or maintained with respect to this set of claims and the Board sees no reason to differ.

5.1 Inventive step

The only difference between this request and the first

auxiliary request resides in that there are upper as well as lower limits to the contents of each of the ingredients specified.

Again, the only argument brought by the appellant patentees was that those developed vis-à-vis the main request should apply also, with greater force, to the more limited subject-matter of the second auxiliary request.

However, as these limits do in fact not add any additional new feature over the composition of document (5), the conclusions under 3.3.6 hold good for this set of claims as well.

6. Third auxiliary request

Independent claim 1 of this request corresponds to claim 1 of the main request with the specification that the fatty acid ingredient (ii) is a mixture of stearic and palmitic acid as disclosed on page 9, lines 34 and 35 of the patent as originally filled.

No objection under Articles 123(2) and (3), 84 and 54 EPC was raised or maintained with respect to this set of claims and the Board sees no reason to differ.

6.1 Inventive step

The only difference between this request and the main request resides in that feature (ii) of claim 1 is now restricted to a mixture of stearic and palmitic acid.

The only argument brought by the appellant patentees was again those developed vis-à-vis the main request

should apply also, with greater force, to the more limited subject-matter of the third auxiliary request.

However, as this amendment does in fact not add any additional new feature over the composition of document (5), the conclusions under 3.3.6 hold good for this set of claims as well.

7. *Fourth auxiliary request*

Independent claim 1 of this request corresponds to a combination of claims 1 and 3 as originally filed as regards the upper and lower limits of the ingredients and furthermore, the coactive surfactant is specified as in the first auxiliary request and feature (ii) is restricted to a mixture of palmitic and stearic acid as in the third auxiliary request.

No objection under Articles 123(2) and (3), 84 and 54 EPC was raised or maintained with respect to this set of claims and the Board sees no reason to differ.

7.1 Inventive step

The appellant patentees submitted that, having regard to the numerous restrictions introduced in independent claim 1, the resulting subject-matter could no longer be derived from the available prior art and in particular document (1bis) in an obvious manner since the skilled person would have to make many selections in order to arrive at the claimed subject-matter.

They moreover stressed, that, in their view, the demonstration of a particular effect was not a requirement for the acknowledgement of an inventive

step under the EPC.

The Board agrees that the demonstration of a particular effect is not a requirement for the acknowledgement of an inventive step under the EPC. However, in the absence of any demonstrated effect over the closest state of the art embodiment, the only problem which remains is the provision of an alternative ie, a new embodiment having the same properties as the prior art embodiment (see point 3.3.2 above).

As to the second point, the Board observes that the numerous restrictions introduced in the claims do not however add any further distinguishing feature over the liquid cleansing composition disclosed in document (5), so that the skilled person does not need to make any further choices compared to the main request and the conclusions under 3.3.6 hold therefore good for this set of claims as well.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

A. Townend U. Oswald