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D E C I S I O N
of 15 March 2002

Case Number: T 0070/02 - 3.2.4

Application Number: 94917284.5

Publication Number: 0748175

IPC: A45D 34/04

Language of the proceedings: EN

Title of invention:

Improved product disperser with enlarged non-dispensing application/distribution surface

Applicant:

THE PROCTER & GAMBLE COMPANY

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 54, 69, 84, 113(1)

EPC R. 51(3), 68(2)

Keyword:

"Novelty (yes)"

"Violations of the right to be heard-substantial procedural violation (yes)"

"Remittal to first instance (yes)"

"Reimbursement of appeal fee (yes)"

Decisions cited:

T 0396/99

Catchword:

-



Case Number: T 0070/02 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 15 March 2002

Appellant: THE PROCTER & GAMBLE COMPANY
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 13 February 2001
refusing European patent application
No. 94 917 284.5 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: C. D. A. Scheibling
C. Holtz

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal on 9 April 2001, against the decision of the Examining Division, dispatched on 13 February 2001, refusing the European patent application No. 94 917 284.5. The fee for the appeal was paid on 5 April 2001 and the statement setting out the grounds of appeal was received on 12 June 2001.
- II. The Examining Division held that the application did not meet the requirements of Article 52(1) EPC in conjunction with Article 54(1) EPC in view of document

D1: GB-A-496 670
- III. The application comprises the following documents:
- Claims:** No. 1 to 5 filed with letter of
30 September 1999,
No. 6 to 10 filed with letter of
20 February 1998.
- Description:** pages 1, 3 to 8 as published
(WO-A-95/24141),
pages 2, 9, 10 filed with letter of
20 February 1998,
page 2a filed with letter of
30 September 1999.
- Drawings:** Figures 1 to 4 as published
(WO-A-95/24141).
- IV. The appellant requested that the decision under appeal

be set aside, that novelty of claim 1 with regard to the disclosure of D1 be acknowledged, that the case be remitted to the first instance for further prosecution and the appeal fee be reimbursed.

V. Claim 1 reads as follows:

"An applicator adapted to contain and dispense a product, said applicator including a container comprising a body portion (30) adapted to receive said product and having an upper portion which defines a dispensing opening, said applicator further including, in combination:

- (a) an applicator member adapted to fixedly engage said upper portion of said container, said applicator member including an aperture (51) disposed over said dispensing opening, said applicator member further including an applicator socket (55) in communication with said aperture and said dispensing opening, said applicator member further including a non-dispensing applicator surface (52) adapted to permit distribution of said product onto a receiving surface, said applicator surface surrounding and extending generally radially outwardly from said aperture (51); and
- (b) an applicator element (40) rotatably disposed within said applicator socket and having at any one time a surface facing inwardly of the container and a surface facing outwardly of the container, said applicator element dispensing said product when said applicator element is rotated within said applicator socket (55) by contact with

said receiving surface; characterized in that

- (c) the applicator member is an applicator dome (50) which partially covers the applicator element (40) such that only a portion of said outwardly facing surface of said applicator element is exposed through said aperture (51)".

Reasons for the Decision

- 1. The appeal is admissible.
- 2. *Interpretation of the independent claim 1:*
 - 2.1 The objects of the application are discussed on page 2, lines 2 to 22 (WO-A-95/24141). A drawback of the known applicators is seen in that: "current commercially available packages also tend to have a comparatively large percentage of the rotating element's surface area exposed outside of the package, often on the order of 40 to 45%. The actual contact area of the element in conjunction with most surfaces is much less, on the order of 20 to 25%. Thus, while a comparatively large element is utilized to reduce the curvature of the contact surface, the remaining exposed surface is carrying forth a film of the product which cannot be applied to a corresponding surface ..." (column 2, lines 2 to 8).
 - 2.2 Thus, it is an object of the application to provide a roll-on type product dispenser which, while comprising a large applicator element as usual, provides for a more even, less messy application of the product and which exhibits a reduced tendency to attract and

capture loose threadlike elements (column 2, lines 18 to 22).

2.3 These objects are achieved by providing two cooperating features:

(a) an enlarged application/distribution surface in the form of a dome with an aperture for the applicator element, and

(b) by exposing through said aperture only a portion of said outwardly facing surface of the applicator element.

2.4 These features result in:

feature (b) although using a large applicator element as usual (in order to reduce the curvature of the contact surface of the element), the surface area of the applicator element exposed through the aperture is kept small with respect to the total surface of the applicator in contact with the receiving surface and therefore less product is carried out of the container, and

feature (a) excess product not applied to the receiving surface is distributed by the surface of the dome, which functions as a secondary applicator for undistributed product and distributor for evening out the total product distribution.

See application page 2, line 24 to page 3, line 5.

2.5 When considering a claim, a skilled person should rule out interpretations which are illogical or which do not

make technical sense. He should try to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent (Article 69 EPC). The patent must be construed by a mind willing to understand, not a mind desirous of misunderstanding (T 396/99, ultimate paragraph of section 3.5).

2.6 Interpretations of the wording of a broad claim should at least be such that the aims of the patent are met, i.e. that the problem to be solved is in fact solved. Interpretations of the wording of a claim which do not contribute anything to the solution, although according to the patent this wording should clearly do so, cannot reasonably be accepted by the Board.

2.7 In the present case, it is clear from the teaching of the application in suit that, contrary to the Examining Division's opinion expressed in the communication dated 4 August 1998, the feature "the applicator is an applicator dome (50)" has a specific technical meaning and therefore makes technical sense and excludes the interpretation of the Examining Division according to which "there is no contradiction with the additional feature of a depression in the centre", since said "depression" would form a reservoir for the excess product and as a consequence the dome would no longer function as a secondary applicator and distributor for evening out the total product distribution, and the tendency to capture loose, threadlike elements would be increased.

Therefore in the context of the application a "dome" can only be defined as a rounded convex shape in exclusion of any additional feature of shape which

would contradict the said definition (see also section 2.4 above).

- 2.8 The feature "dome (50) which partially covers the applicator element (40) such that only a portion of said outwardly facing surface of said applicator element is exposed through said aperture (51)" seems to express what appears to be generally the case, i e the applicator element is retained in the applicator member by being larger in size than the aperture.

However, neither the term "portion" nor the expression "outwardly facing surface" are clear in this context and should therefore be clarified (see section 5, below).

- 2.9 Finally the feature "said applicator element dispensing said product when said applicator element is rotated within said applicator socket" should be interpreted as meaning that it is sufficient to rotate the applicator element within said applicator socket in order to achieve dispensing of said product.

3. *Novelty with respect to D1:*

- 3.1 D1 (page 3, lines 47 to 118; Figures 1 to 3) discloses an applicator adapted to contain and dispense a product, said applicator including a container comprising a body portion (1) adapted to receive said product and having an upper portion which defines a dispensing opening, said applicator further including, in combination:

an applicator member (cap 2) adapted to fixedly engage said upper portion of said container, said applicator

member including an aperture (3) disposed over said dispensing opening, said applicator member further including an applicator socket (5) in communication with said aperture and said dispensing opening, said applicator member further including a non-dispensing applicator surface (top of cap 2) adapted to permit distribution of said product onto a receiving surface, said applicator surface surrounding and extending generally radially outwardly from said aperture (3) (Figure 2); and

an applicator element (9) rotatably disposed within said applicator socket (5) and having at any one time a surface facing inwardly of the container and a surface facing outwardly of the container, said applicator element (9) dispensing said product when said applicator element is depressed within said applicator socket (5) by contact with said receiving surface.

3.2 As can be seen in Figures 1 and 3, the cap (applicator member) of the applicator of D2 is convexly curved and comprises a central depression or countersink (page 3, lines 55 to 61). Therefore, said cap (applicator member) is not forming a dome for the purposes of the application (see section 2.7 above).

3.3 Furthermore, it is said in D1 page 3, lines 9 to 11, 22, 23, 90 to 92 that the distributing roller closes, respectively is pressed against its seating in the delivery aperture (3), and that there is an effective seating all round the roller and on page 3, lines 81 to 84 it is said that "under the influence of the spring 12, the roller thus seats itself in the aperture with a portion of its contour projecting from such aperture".

Although it can therefore be assumed that not all the outwardly facing surface of the applicator element is exposed through the aperture, due to the unclarity introduced by the expression "such that only a portion of said outwardly facing surface of said applicator element is exposed through said aperture (51)" it is not possible to conclude whether said feature is known from D1 or not.

3.4 However, the fact that the roller is pressed against it's seating "thus providing a complete closure" (page 3, lines 91, 92) implies that it is not sufficient to rotate the roller in order to achieve dispensing of the product but that it is necessary to depress it to form a gap between the roller and the opening. Therefore, it cannot be said that the applicator element is dispensing said product when said applicator element is rotated within said applicator socket in the meaning of the application.

3.5 Thus, claim 1 is novel with respect to D1.

4. *Request for reimbursement of the appeal fee*

4.1 Violation of Rule 51(3) EPC

4.1.1 In it's first communication dated 21 August 1997, the Examining Division pointed to the deficiencies mentioned in the International Preliminary Examination Report (IPER), but did not address any technical issue. The report is general in wording, only referring to documents as a whole.

4.1.2 In response thereto the applicant discussed novelty with respect to D1 to D4 and filed new claims. In

addition to redrafting claim 1 in the two-part form, the feature "at least a portion of said applicator element is exposed through said aperture" was modified to read "only a portion of said applicator element is exposed through said aperture". With respect to D1 the applicant argued that in D1 "the entire outside surface of the cylindrical applicator element 9 is exposed".

4.1.3 In it's second communication dated 04 August 1998, the Examining Division objected that "no convincing arguments have been found in your letter ... concerning the inventive step of the independent claim 1 in comparison with D3". The Board observes, that an objection concerning inventive step with respect to D3 had never been raised so far, so that the applicant could not fairly have been required to have dealt with said objection in his reply to the first communication.

4.1.4 In response to the second communication the applicant discussed inventive step with respect to D3 and filed new claims. In order to distinguish the subject-matter of claim 1 from D3 the feature "an applicator member adapted to engage said upper portion of said container" was modified to read "an applicator member adapted to fixedly engage said upper portion of said container".

Since novelty was not objected in the Examining Division's communication, the board finds that the applicant was entitled to assume that novelty was acknowledged.

4.1.5 In it's third communication dated 23 March 1999, the Examining Division objected that "no convincing arguments have been found in your letter ... concerning the inventive step of the independent claim 1 in

comparison with D1".

However, again the board must observe that an objection concerning inventive step with respect to D1 had never been raised so far, so that once again one could not fairly have expected a response to deal with an objection that never had been raised. In this communication the Examining Division further stated that the features of the characterizing part of claim 1 were known from D1. Although, no further document was cited, D1 was never clearly said to disclose the features of the precharacterizing part of claim 1 (neither by the Examining Division nor by the applicant) and thus, it was not obvious for the applicant to conclude that the objection should in fact be considered as being a novelty objection.

4.1.6 In response to the third communication the applicant discussed inventive step with respect to D1 and filed new claims with letter of 30 September 1999. In order to clarify the above said feature and to distinguish the subject-matter of claim 1 from D1, the features "applicator element ... having at any one time a surface facing inwardly of the container and a surface facing outwardly of the container" and "such that only a portion of said outwardly facing surface of said applicator element is exposed through said aperture (51)" were added to claim 1. The applicant argued that in D1 the applicator element was fully exposed by the aperture whereas in the application the applicator element was partly covered by the applicator member.

4.1.7 In a fourth communication dated 02 February 2000, in preparation of intended oral proceedings, the Examining

Division stated that during oral proceedings inventive step with respect to D1 to D6 would be discussed without addressing any technical details or features, and stated furthermore that "all arguments and objections in the previous communications are still valid". Said communication acknowledged also that "no new objection arises from the last modification of claim 1", i.e. assumably the claim filed on 30 September 1999.

- 4.1.8 With letter of 10 February 2000 the applicant withdrew the request for oral proceedings and requested a decision on patentability of the application with the claims on file.
- 4.1.9 No further communication was sent to the applicant until the decision under appeal was issued. The intended oral proceedings did not take place.
- 4.1.10 The board is forced to draw the conclusion that none of the communications of the Examining Division was in line with the requirements of Rule 51(3) EPC, since no concrete reasons were given, discussing the technical content of the application vis-a-vis the documents on file. The opinion expressed were therefore mere assertions with no support from these documents.
- 4.2 Violation of Article 113(1) EPC
 - 4.2.1 The Examining Division based its decision to refuse the application on a lack of novelty of claim 1 as last received, i.e. in the appellant's submission in response to the third communication, see point 4.1.6 above, without having applied Article 113(1) EPC which states that "the decisions of the European Patent

Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments".

- 4.2.2 Apart from the very general reference to the deficiencies mentioned in the IPER, no specific objection based on lack of novelty was raised during the examination against any of the versions of claim 1 filed by the appellant.
- 4.2.3 Even the third communication of the Examining Division dated 23 March 1999 cannot be interpreted as a novelty objection (although referring to inventive step; see section 4.1.5 above), since it did not make clear which document disclosed the precharacterizing part of claim 1.

Thus the Examining Division based it's decision on an objection raised against the subject-matter of claim 1 on which the applicant had no opportunity to present his comments.

- 4.2.4 In it's decision the Examining Division states that "this refusal does not contravene Article 113(1)... because Article 54 objection was already raised (in the international examination phase) and this objection was deeply discussed by the applicant in his letter of 30.09.99" (see section 4.1.6, above). However, the claim 1 considered in the decision is not the claim 1 on file during the international examination phase. Indeed, claim 1 was modified three times during the European examination proceedings so that it could not seriously be expected from the applicant to consider that the novelty objection raised during international examination phase would still apply to a subsequent

claim 1 yet on file, without precisely stating it, all the more because the Examining Division only raised the question of inventive step in all subsequent communications, so that one would normally assume on a fair reading of these that novelty was no longer objected to.

Furthermore, the letter of the applicant dated 30 September 1999, referred to in the decision, discusses inventive step and not novelty. It is clear from the overall content of the letter which explicitly refers to inventive step and to the "could/would" approach, that the reference made to Article 54 in one single paragraph is a clerical error.

- 4.2.5 Thus, by basing it's decision on a lack of novelty the Examining Division introduced a new objection against the subject-matter of claim 1 as filed on 30 September 1999 for the first time in the said decision and thus, gave the applicant no opportunity to present his comments. Therefore, the provisions of Article 113(1) EPC were not met.

Each of the deficiencies noted above, in sections 4.1 and 4.2 constitutes a substantial procedural violation justifying reimbursement of the appeal fee according to Rule 67 EPC.

5. In view of the above, the Board remits the case to the Examining Division for further prosecution. The Examining Division however should take into consideration that before a meaningful discussion of novelty and inventive step can take place, clarity (Article 84 EPC) is normally an important point which should not be forgotten, particularly in a case as the

present one. In the opinion of the Board the following expressions should normally be clarified:

- a surface facing inwardly of the container and a surface facing outwardly of the container (could it be that what is meant is the surfaces below respectively above the equatorial region of the applicator element?),
- the applicator member is an applicator dome (it seems that the applicator dome is not formed by the entire applicator member, but that the applicator dome is formed by said non-dispensing application surface (52) which extends downwardly from said aperture (51)),
- a portion of said outwardly facing surface (what is meant by a portion ?).

In this specific case the Board abstained from clarifying the said expressions, since novelty could easily be established due to the fact that the applicator member (the cap) disclosed in D1 is not forming a dome in the meaning of the application and that the applicator element disclosed in D1 is not dispensing said product when said applicator element is rotated within said applicator socket in the meaning of the application.

6. Additionally, the Board is of the opinion that in order to give the applicant a fair chance to challenge the findings of the Examination Division, the latter should have at least once identified where in the closest prior art document each of the features of the claim in suit are disclosed (this was never indicated in any

communication, not even in the decision).

Furthermore, by simply stating "no convincing arguments have been found in your letter" in response to letters in which the objections put forward were exhaustively discussed by the applicant, the Examining Division adopted an unfair attitude, leaving the applicant without any indication as to why his arguments were not found to be convincing, so that again he was unable to react against the conclusions of the Examining Division.

7. Finally, in accordance with Rule 68(2) EPC decisions of the European Patent Office which are open to appeal shall be reasoned. In this respect the Board accepts that reasoning does not mean that all the arguments submitted should be dealt with in detail, but it is a general principle of good faith and fair proceedings that reasoned decisions contain, in addition to the logical chain of facts and reasons on which every decision is based, at least some motivation on crucial points of dispute in this line of argumentation in so far as this is not already apparent from other reasons given, in order to give the party concerned a fair idea of why his submissions were not considered convincing and to enable him to base his grounds of appeal on relevant issues.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. Claim 1 filed with letter of 30 September 1999 is novel with respect to D1.
3. The case is remitted to the first instance for further prosecution on the basis of the following documents:

Claims: No. 1 to 5 filed with letter of
30 September 1999,
No. 6 to 10 filed with letter of
20 February 1998.

Description: pages 1, 3 to 8 as published
(WO-A-95/24141),
pages 2, 9, 10 filed with letter of
20 February 1998,
page 2a filed with letter of 30 September
1999.

Drawings: Figures 1 to 4 as published
(WO-A-95/24141).

4. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:

G. Magouliotis

C. Andries