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**D E C I S I O N**  
**of 27 September 2005**

**Case Number:** T 0047/03 - 3.2.07

**Application Number:** 95923840.3

**Publication Number:** 0773855

**IPC:** B26B

**Language of the proceedings:** EN

**Title of invention:**  
Changeable color shaving aid

**Patentee:**  
Warner-Lambert Company LLC

**Opponent:**  
The Gillette Company

**Headword:**

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**Relevant legal provisions:**  
EPC Art. 114(2), 123(2)

**Keyword:**  
"Late filed requests - admissibility (requests filed one month before the oral proceedings: (no); requests filed during the oral proceedings: (yes))"  
"Extension beyond the content of the application as filed (yes)"

**Decisions cited:**  
T 1126/97, T 0633/97, T 0081/03, T 0169/83

**Catchword:**

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Case Number: T 0047/03 - 3.2.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 27 September 2005

**Appellant:** Warner-Lambert Company LLC  
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**Respondent:** The Gillette Company  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 13 November 2002  
revoking European patent No. 0773855 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** H. Meinders  
**Members:** K. Poalas  
E. Lachacinski

## Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking European patent No. 0 773 855.
- II. Opposition had been filed by the opponent against the patent as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(b) EPC (insufficiency of disclosure).

The Opposition Division found that claim 1 of the main and the three auxiliary requests violated the requirements of Article 123(3) EPC, that the subject-matter of claim 1 of the main and the three auxiliary requests violated the requirements of Article 123(2) EPC and that it also lacked novelty over the disclosure of document

D3: WO 95 20472 A.

- III. Oral proceedings before the Board of Appeal took place on 27 October 2005.
- (a) The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form according to one of the requests filed with the letter of 26 August 2005, or one of those filed during the oral proceedings.
- (b) The respondent (opponent) requested that the appeal be dismissed and that all requests be rejected as inadmissible.

IV. Independent claims 1 of the main and the six auxiliary requests filed with the letter of 26 August 2005 read as follows:

Main request

A shaving aid (11), for a razor, comprising thermoplastic material and shaving aid material (21) and means for indicating a change in the amount of shaving aid material (21), the means for indicating being in the form of a coating (60), which is water soluble or partially water soluble, disposed in one of more segments on top of at least a portion of the shaving aid, said coating (60) being of a colour different from that of the shaving aid and characterised in that the coating is in the form of a stripe revealing the underlying shaving aid on only two sides of the stripe, said coating (60) being wearable through solubility, abrasion or a combination thereof to provide an indication to the user, upon disappearance of the said coating (60), of a need to replace the razor.

1<sup>st</sup> Auxiliary Request

A razor head having a cap, a seat, at least one blade and a shaving aid according to claim 1 of the main request.

2<sup>nd</sup> Auxiliary Request

An unused shaving aid according to claim 1 of the main request.

3<sup>rd</sup> Auxiliary Request

A shaving aid according to claim 1 of the main request, the shaving aid material being water soluble or partially water soluble.

4<sup>th</sup> Auxiliary Request

An unused shaving aid according to claim 1 of the main request, wherein the shaving aid material is water soluble or partially water soluble.

5<sup>th</sup> Auxiliary Request

A razor head having a cap, a seat, at least one blade and an unused shaving aid according to claim 1 of the main request, the shaving aid material being water soluble or partially water soluble.

6<sup>th</sup> Auxiliary Request

A razor head having a cap, a seat, at least one blade and an unused shaving aid according to claim 1 of the main request without the feature "revealing the underlying shaving aid on only two sides of the stripe", but with the feature that the shaving aid material is water soluble or partially water soluble as well as that the coating is in the form of "a stripe not revealing the underlying shaving aid on fewer than two sides of the stripe".

- V. Independent claims 1 of the main and the six auxiliary requests filed during the oral proceedings differ from the above claims 1 through the insertion of the word

"material" in connection with "shaving aid" into the following phrases:

"a coating (60) ... disposed in one of more segments on top of at least a portion of the shaving aid material",  
"said coating (60) being of a colour different from that of the shaving aid material and characterised in that the coating is in the form of a stripe revealing the underlying shaving aid material...".

VI. The appellant argued essentially as follows:

(a) Admissibility of the claims filed with the letter of 26 August 2005

The claims filed with the letter of 26 August 2005 are admissible since they were presented within the time limit given by the Board in the annex to its summons to oral proceedings dated 13 July 2005.

(b) Admissibility of the claims filed during the oral proceedings

The crucial embodiment in the patent in suit is the embodiment of figure 5. Since the new claims 1 of the requests filed during the oral proceedings derive from originally filed claim 9 by adding to the shaving aid according to said claim other features derivable from the embodiment of figure 5, these new claims do not introduce new issues into the debate and should therefore be admitted into the appeal proceedings.

(c) Article 123(2) EPC - claims filed during the oral proceedings

It is obvious to the skilled person from the teaching of the originally filed application as a whole that the shaving aid of the invention comprises thermoplastic material as well as a coating on top of the shaving aid material; this results from claim 1 in conjunction with claim 9 as originally filed, the latter relating to the embodiment of figure 5. In this respect the original claims had priority over the original description for the purpose of providing a basis for amendments. The Booth patent (US 4 170 821 A) mentioned on page 1, lines 15 to 25 of the originally filed application forms the starting point of the present invention by defining the shaving aid as comprising a thermoplastic polymer and a shaving aid material in the form of polyox. Therefore, the embodiment of figure 5 being a further development of such a shaving aid necessarily involves thermoplastic material.

VII. The respondent argued essentially as follows:

(a) Admissibility of the claims filed with the letter of 26 August 2005

These claims involve features that are introduced for the first time in the opposition and appeal proceedings, which have never been discussed before. They are not supported by the application as originally filed.

These claims refer to a coating disposed in one or more segments on top of at least a portion of the shaving aid. Hence, the coating is no longer on the shaving aid

material, as previously claimed. Such an amendment raises entirely new issues, leading to a diverging debate and should not be admitted into the appeal proceedings.

(b) Admissibility of the claims filed during the oral proceedings

A shaving aid comprising a thermoplastic material and a coating on top of the shaving aid material, said coating being in the form of a stripe revealing the underlying shaving aid material on only two sides of the stripe (see claim 1 of the main and the first five auxiliary requests) or said coating being in the form of a stripe not revealing the underlying shaving aid material on fewer than two sides of the stripe (see claim 1 of the sixth auxiliary request) has now been introduced into the debate as late as the oral proceedings before the Board. No explicit or implicit disclosure for such a combination of features can be found in the originally filed application. Therefore, these claims are not prima facie allowable and should therefore not be admitted into the appeal proceedings.

(c) Article 123(2) EPC

The part of the originally filed description directed to the embodiment of figure 5 (see page 11, line 15 to page 12, line 14) and the part of the originally filed description directed to the "summary of the invention" (see page 3, line 19 to page 5, line 21) do not disclose any presence of a thermoplastic material in the shaving aids described therein. On the other hand, originally filed claim 9 dependent on claim 1 is



directed to a shaving aid comprising a thermoplastic material. It is obvious to the skilled person that the shaving aid according to originally filed claim 9 and the shaving aid according to figure 5 are two different embodiments and that combining the shaving aid of the originally filed claim 9 with some of the features of the embodiment of figure 5 contravenes Article 123(2) EPC.

### **Reasons for the Decision**

1. Admissibility of the claims filed with the letter of 26 August 2005

On 26 August 2005, exactly one month prior to the date of the oral proceedings before the Board, the appellant filed a main and six auxiliary requests.

- 1.1 As a general rule, the more complex the issues raised by amendments and the later those amendments are filed, the greater the risk that the remaining time is insufficient to consider them properly. In the case T 1126/97 (not published in the OJ EPO) the deciding board 3.4.1 stated in point 3.1.2 that for late amendments to be admissible the following conditions should be fulfilled:

(i) there should be some justification for the late filing,

(ii) the subject-matter of the new claims should not diverge considerably from the claims already filed, in particular they should not contain subject-matter which has not previously been claimed, and

(iii) the new claims should be clearly allowable in the sense that they do not introduce new objections under the EPC and overcome all outstanding objections.

1.2 Furthermore, according to decision T 633/97 (not published in OJ EPO), point 2.2, "once oral proceedings have been arranged in appeal cases, the decision to admit new evidence or requests into the procedure should hinge neither on a fixed time limit for their submission nor on their merit. It should instead be governed primarily by a general interest in the appeal proceedings being conducted in an effective manner, i.e. in dealing with as many of the issues raised by the parties as possible, while still being brought to a close within a reasonable time".

1.3 Finally, according to decision T 81/03 (not published in OJ EPO), point 2.4, in a case where new features added to a claim required examination of a solution to an entirely new technical problem, "it is of little importance whether the requests are filed during the oral proceedings or shortly prior to them since in either case the new subject-matter would have to be discussed at the hearing and neither the Board nor the other parties could be expected to deal with it without adjournment of the oral proceedings".

- 1.4 Although concerned with amendments filed during the oral proceedings, decision T 1126/97 sets out criteria which are useful for the present case. In particular, it is pointed out that "the subject-matter of the new claims should not diverge considerably from the claims already filed".

During the entire appeal proceedings the appellant argued that the embodiment according to figure 5 represents the invention of the patent in suit, for which protection was sought in the form of the filed claims. All claims filed by the appellant up to 26 August 2005 refer to a coating disposed in one or more segments on top of at least a portion of the **shaving aid material**, in accordance with the respective sentence on page 11, lines 16 to 18 of the originally filed application directed to the embodiment of figure 5.

- 1.5 Then, with the letter of 26 August 2005 all claims were amended to a coating disposed in one or more segments on top of at least a portion of the **shaving aid**, the coating now being no longer necessarily on top of the **shaving aid material**, as previously claimed.

The appellant, trying to justify this amendment, argued for the first time in the appeal proceedings that the respective sentence in the description - referring to a coating on top of a shaving aid material - is erroneous, since originally filed claim 9 refers to a coating "disposed in one or more segments on top of at least a portion of the shaving aid". Also in the summary of the invention the shaving aid (not the shaving aid material) having one colour is coated with

a sectional portion of another colour, see page 5, lines 7 to 8. Such an obvious error should be corrected.

1.6 The Board cannot follow the appellant in this.

The new claims, by referring to a coating on top of the shaving aid instead of on top of the shaving aid material, bring up a new issue which has never been discussed before. This does not lead to a converging debate. To the contrary, this new feature initiates a "diverging debate" in the sense that it requires examination of a new embodiment, namely of the embodiment according to figure 5, in which the coating is not necessarily on top of the **shaving aid material** as it is stated on page 11, lines 16 to 18, but on top of the **shaving aid**.

1.7 In addition, admitting such an amendment in the claims further initiates an entirely new debate about whether there is an obvious error in the sentence on page 11, lines 16 to 18 of the originally filed description, whether such an error can be corrected under Rule 88 EPC and what the correction should be in order to fulfil the requirements of Article 123(2) EPC. From the above the Board concludes that conditions (ii) and (iii) as set out in T 1126/97 are not fulfilled.

1.8 The appellant argued that the respondent in this case had filed comments directed to the new claims in written form and was therefore well prepared to consider these requests.

The Board notes that, regardless of whether the respondent was familiar with all the technical issues, the respondent did not accept that the invention according to these requests was patentable and that the amended features would still require extensive discussion.

1.9 For the Board the examination and discussion of this issue would require an adjournment of the oral proceedings which it is not willing to accept. Therefore, it decides pursuant to Article 114(2) EPC not to admit into the appeal proceedings the requests filed with the letter of 26 August 2005.

2. *Admissibility of the set of claims filed during the oral proceedings*

In these claims (which are otherwise the same as the ones filed with letter of 26 August 2005) the issue discussed under point 1 above has been resolved by introducing "material" in connection with the "shaving aid", at the appropriate locations. In this respect the claims concur with the crucial embodiment in the patent in suit, namely the one of figure 5. Therefore, the debate is no longer "diverging" within the meaning of T 1126/97. The remaining amendments can be considered a reply to the preliminary opinion of the Board, given in the annex to the summons to oral proceedings. In that respect the Board considered it expedient to discuss in substance all issues regarding compliance with Article 123(2) EPC at these oral proceedings, including the allowability of the amendment to a stripe revealing the shaving aid material on only two sides or on not fewer than two sides.

Therefore, the Board decides to exercise its discretion according to Article 114(2) EPC and to admit the sets of claims filed during the oral proceedings into the appeal proceedings.

3. *Article 123(2) EPC*

3.1 The appellant argued that all claims of the main and the six auxiliary requests filed during the oral proceedings concern a shaving aid comprising thermoplastic material together with features which according to the originally filed application were present only in the embodiment of figure 5 (cf. the coating on top of the shaving aid material), said coating being in the form of a stripe revealing the underlying shaving aid on only two sides of the stripe (see claim 1 of the main and the first five auxiliary requests) or said coating not revealing the underlying shaving aid material on fewer than two sides of the stripe (see claim 1 of the sixth auxiliary request).

3.2 In order to have the requirements of Article 123(2) EPC fulfilled, it has to be examined if in the originally filed application there is a disclosure for a thermoplastic material forming part of the shaving aid according to figure 5.

The Board agrees with the parties that the originally filed description concerns three independent groups of embodiments, namely a first group with the embodiments according to figure 2 (described on page 7, line 11 to page 10, line 7), the second group with the embodiments according to figures 3 and 4 (described on page 10,

line 9 to page 11, line 13) and the third group with the embodiments according to figure 5 (described on page 11, line 15 to page 12, line 14).

The part of the description directed to the first two groups of embodiments refers to thermoplastic material as being part of the shaving aid in the form of either a mixture with shaving aid material and colouring agents or as a separate layer (see page 9, line 22 to page 10, line 1; page 10, lines 11 to 14; page 11, lines 3 to 8). In contrast to that, the part of the originally filed description directed to the embodiment of figure 5 (see above) and the part of the originally filed description directed to the "summary of the invention" (see page 3, line 19 to page 5, line 21) do not mention any presence of a thermoplastic material in the shaving aids described.

Therefore, the Board finds that the description as originally filed does not provide an unambiguous basis for the presence of thermoplastic material in the shaving aid according to the embodiment of figure 5.

- 3.3 The appellant based its argumentation in the passage on page 1, lines 15 to 25 of the originally filed description mentioning that "In order to provide for smoother shaves and to increase the comfort of the user, shaving aids in the form of comfort strips have been mounted on disposable razor heads and in disposable razor systems for many years. For example, U.S. Pat. No. 4,170,821, issued to Booth, discloses a solid water soluble shaving aid incorporated as a strip attached to a disposable razor blade cartridge. Razor heads having such comfort strips are currently marketed with the

shaving aid being mixed with a thermoplastic polymer and have a uniform, unchanging color and texture" as well as the sentence on page 3, lines 19 to 24: "The present invention features a disposable razor cartridge unit or disposable razor system having a shaving aid in the form of a comfort strip mounted on a razor head, wherein the shaving aid changes color over a period of time so that the user knows that the razor head should be replaced".

From these two references it would be evident that the starting point for the present invention is a shaving aid in the form of a comfort strip according to the Booth patent, namely one having a shaving aid material (e.g. polyox) and a thermoplastic matrix. Therefore, each shaving aid further mentioned in the patent in suit is a shaving aid comprising thermoplastic material and as a consequence the embodiment of figure 5 comprises also a thermoplastic material.

3.4 The Board cannot follow the appellant's argumentation for the following reasons:

Firstly, the above mentioned passage of the originally filed description refers to the Booth patent as **an example of a known** shaving aid (see "For example,..."). There is not a single reference in the whole application indicating that the presently discussed shaving aid of figure 5 is built according to the Booth patent, or is "based on known shaving aids".

Even when accepting the appellant's argument that the Booth patent represents an industrial standard in the field of shaving aids, it would have required a proper



specific reference to it so as to conclude that the shaving aid of figure 5 as presently discussed is a further development of the shaving aid according to the Booth patent, which is, however, not there.

Secondly, the Booth patent itself is not limited to shaving aids consisting of shaving aid material and thermoplastic material, it discloses also a shaving aid comprising capsules of micro-encapsulated silicone oil mixed with a cement or binder (see claim 11 and column 4, lines 3 to 7), without any thermoplastic material being present. Therefore, even if the Booth patent would be accepted as the basis for the shaving aid of the patent in suit, it would not be evident that such a shaving aid based on the Booth patent would necessarily comprise shaving aid material and a thermoplastic matrix.

- 3.5 The appellant further argued that the originally filed claim 9, being dependent on claim 1, concerns a shaving aid comprising thermoplastic material, shaving aid material and a coating on top of the shaving aid, the latter being identical to shaving aid material. It is obvious to the skilled person from the whole disclosure of the originally filed application that originally filed claim 9 is related to the embodiment of figure 5. In the claims 1 of the main and all auxiliary requests, a shaving aid built on the basis of originally filed claim 9 was merely supplemented with features derivable from the embodiment of figure 5, thereby remaining a shaving aid comprising thermoplastic material.

- 3.6 The Board is not persuaded by the appellant's arguments for the following reasons:

The shaving aid according to originally filed claim 9, dependent on claim 1, comprises a thermoplastic material, a shaving aid material and a coating disposed on top of at least a portion of the shaving aid.

A shaving aid comprising thermoplastic material and a coating is foreseen only for the shaving aid of the embodiments of figures 3 and 4. However, in these embodiments the coating in the form of a layer 30, 40 covers the thermoplastic material entirely, the latter being further limited to a thermoplastic layer.

In contrast, the shaving aid according to the embodiment of figure 5 as described on page 11, line 15 to page 12, line 14 has a coating disposed upon a section of the surface of the shaving aid material, but there is no mention of any thermoplastic material.

- 3.7 In view of the above it can only be concluded that there is a discrepancy between the subject-matter of claim 9 and the description of the embodiment of figure 5 as filed. It is, however, not unambiguously derivable from the application as filed how this discrepancy is to be resolved: an entire coating of a layer of thermoplastic material (the embodiments of figures 3 and 4 having precedence over claim 9), a partial coating of the shaving aid material with thermoplastic material being present in an unspecified form (claim 9 having precedence over the embodiment of figure 5) or a partial coating of the shaving aid material with no thermoplastic material being present

(the embodiment of figure 5 having precedence over claim 9).

In this respect the Board considers that the claims, description and drawings all have the same ranking (see also T 169/83, OJ 1985, 193, point 3.2) and thus there is no reason to give precedence to the wording of claim 9 as filed, for providing support to the presence of thermoplastic material (in general) in combination with a partial coating of the shaving aid material as specifically described for figure 5.

Therefore, a shaving aid which arises as a combination of originally filed claim 9 with features derivable only from the embodiment described for figure 5 (a partial coating on top of the shaving aid material) is not directly and unambiguously derivable from the application as originally filed.

Claim 1 of the main and each of the six auxiliary requests disclosing such a shaving aid, as a result, contravenes the requirements of Article 123(2) EPC. Therefore, these requests are not allowable.

**Order**

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

1. The requests filed with the letter of 26 August 2005 are rejected as inadmissible.
2. The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

H. Meinders