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**Datasheet for the decision  
of 18 March 2008**

**Case Number:** T 0394/05 - 3.3.06

**Application Number:** 98938871.5

**Publication Number:** 1011630

**IPC:** A61K 7/50

**Language of the proceedings:** EN

**Title of invention:**

Cleansing and conditioning article for skin or hair

**Patentee:**

THE PROCTER & GAMBLE COMPANY

**Opponent:**

Unilever PLC

**Headword:**

Cleansing article/PROCTER

**Relevant legal provisions (EPC 1973):**

EPC Art. 114(2), 56, 83

**Keyword:**

"Exercise of discretion by the first instance in disregarding belated submissions: not overruled because the first instance applied the right criteria"

**Decisions cited:**

-

**Catchword:**

Point 1.2



Case Number: T 0394/05 - 3.3.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.06  
of 18 March 2008

**Appellant:**  
(Opponent)

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(Patent Proprietor)

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**Representative:**

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**Decision under appeal:**

Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
17 January 2005 concerning maintenance of  
European patent No. 1011630 in amended form.

**Composition of the Board:**

**Chairman:** P.-P. Bracke  
**Members:** P. Ammendola  
A. Pignatelli

## Summary of Facts and Submissions

I. This appeal is from the interlocutory decision of the Opposition division concerning the maintenance in amended form of European patent No. 1 011 630 according to the then pending main request of the Patent proprietor.

II. This request was based on a set of twenty-four amended claims. Claim 1 according to this request (hereinafter "claim 1 as maintained") read:

*"1. A disposable, single use personal care cleansing and conditioning article comprising:*

*(A) a water insoluble substrate comprising*

*i) a first layer, the first layer being wet extensible in the plane of the first layer when the first layer is wetted; and*

*ii) a second layer which is less wet extensible when wetted than is said first layer;*

*wherein selected portions of said first layer are joined to said second layer in a manner which is sufficient to inhibit wet extension of said first layer in the plane of said first layer; and*

*(B) at least one lathering surfactant added onto or impregnated into said substrate,*

*wherein said article is substantially dry prior to use."*

The maintained claims 2 to 19 were dependent on claim 1 and defined preferred embodiments of the article of claim 1.

Claims 20 to 21 as maintained described the method of manufacturing the claimed article.

The remaining maintained claims 22 to 24 described the non-therapeutic method of cleansing and conditioning the skin or hair by contacting these latter with the claimed article after wetting.

III. The grant of the patent in suit had been notified in Bulletin 2002/42 published on 16 October 2002 and the Opponent had sought its revocation on the grounds of lack of novelty and inventive step (Article 100(a) EPC (1973) in combination with Articles 52(1), 54 and 56 EPC (1973)), as well as for insufficient disclosure (Article 100(b) EPC (1973)) and added subject-matter (Article 100(c) EPC (1973)).

With a letter of 12 November 2004, i.e. more than 15 months after the nine months time limit foreseen in Article 99(1) EPC (1973) and about one month before the scheduled date (14 December 2004) for the oral proceedings before the Opposition division, the Opponent had filed twelve new documents:

(4) = US-A-4 112 167

(5) = EP-A-0 864 418 (which is state of the art only under the provisions of Article 54(3) and (4) EPC (1973))

(6) = US-A-4 948 585

(7) = US-A-4 946 617

(8) = US-A-4 469 735

(9) = US-A-3 953 638

(10) = WO 95/16824

(11) = US-A-5 605 749

(12) = US-A-4 758 467

(13) = US-A-3 283 357

(14) = US-A-4 045 364

(15) = US-A-4 690 821.

Under cover of a letter of 19 November 2004 the Opponent had then also filed document

(16) = US-A- 4 515 703.

IV. The Proprietor had filed experimental data with a facsimile of 10 December 2004 (hereinafter "the additional experimental data") and requested the maintenance of the patent in amended form on the basis of the amended set of claims already mentioned above (see section II).

V. The Opposition division considered the documents (4) to (16) as belated and decided, exercising its power of discretion under Article 114(2) EPC (1973), to disregard documents (4) to (8), (10), (11), (13), (14) and (16).

In particular, at point 3 of the section "*III Article 54 EPC*" and in section "*VI Decision*" of its decision the Opposition division found

i) that the Opponent had not sufficiently substantiated that the documents (4) to (7) and (16), allegedly relevant for novelty, disclosed all the features of the subject-matter of the maintained claims,

and

ii) that documents (8), (10), (11), (13) and (14) had not even been cited by the parties in the discussion at the hearing of 14 December 2004.

The Opposition division considered instead the additional experimental data of 10 December 2004 as a timely response to the Opponent's belated submissions.

It found that the subject-matter of the claims as maintained was sufficiently disclosed. In particular, it considered that it was not necessary that the claimed article achieved skin conditioning properties. It was enough that the article was undisputedly suitable for skin conditioning and actually would exhibit conditioning properties when added with a conditioning agent, as described in the contested patent.

The claimed subject-matter was also novel and based on an inventive step.

In particular, in respect of the inventive step assessment, the Opposition division considered that a skilled person searching for a cleansing article providing improved lather would not have started from the single-layer towel of document (15), but rather from the single-layer washing cloth of document (12).

However, the Opposition division considered also that, regardless as to which of these two single-layer articles was used as starting point, document (9) did not attribute to the two-layer structure disclosed therein the ability to promote lathering. Hence, no combination of the available prior art could render predictable the improved lathering that, as demonstrated by the additional data provided by the Proprietor, was actually achieved by the personal care article of the invention.

Moreover, in the hypothetical case of a skilled person starting from document (15) for solving exclusively the problem of providing an article having improved calliper and bulk impression, there existed several obvious ways for improving these properties (e.g. changing the density of the layer, using polyurethane foams, using different materials, using different thicknesses, etc.) other than that of using the two-layer structure disclosed in document (9). Hence, even in such hypothetical case, there would be no one-way street situation bringing the skilled person to necessarily combine the teaching of document (9) with

that of document (15) and, thus, the improved lather and creaminess properties achieved by the claimed article could not be regarded as a mere bonus effect not contributing to an inventive step.

VI. The Opponent (hereinafter Appellant) lodged an appeal against this decision.

In the written grounds of appeal it argued substantially as follows.

Even though claim 1 as maintained would not mention a conditioning agent among the mandatory ingredients of the claimed article, the same claim would necessarily require that the claimed article must provide not only cleansing but also conditioning. However, the patent in suit would not disclose how to carry out the embodiments of the invention free of any conditioning agents.

Moreover, the disclosure of the patent would also be insufficient in view of the fact that the water content of the personal care articles would depend on the humidity of the environment and that the patent does not specify in which environment the water content of the article must be determined. This would deprive of any clear meaning the definition given in the patent specification of the phrase "*substantially dry*" as used in the claims as maintained, also because the nature of the claimed product is such that there would be a good chance that it will be stored in a bathroom at relatively high relative humidity.



The Appellant requested the admission into the proceedings of all the documents that the Opposition division had disregarded.

In particular, the Opposition division would have erred in dismissing the documents (4) to (7) and (16) despite the fact that these documents were novelty destroying for the claimed subject-matter.

Since the patent in suit addressed several technical problems including improved lather generation but also improved feel and increased bulk, any of documents (11) to (15) could be chosen as the starting point of the inventive step assessment. Moreover, it was well known from documents (8), (9) and (10) that the provision of a multilayer substrate having one layer bonded to the other in selected portions, the layers having different wet extensibilities, would provide the additional and desirable characteristics of increased bulk and calliper and, thus, a superior feel.

Hence, it was well known in the art that the skilled person could take a cleansing product such as those described in any of the documents (11) to (15), but in particular as described in documents (12) and (15), and beneficially combine it with a multi-layer substrate of the type described in documents (8) and (9), but in particular (9).

The Appellant did not accept as demonstrated any improvement of lather generation, but nevertheless argued that any possibly achieved lathering improvement was to be considered a subsidiary benefit, inevitably deriving from a modification of the prior art articles

that the skilled person would in any case have made in order to improve their calliper and bulk.

VII. The Proprietor (hereinafter Respondent) replied in writing to the grounds of appeal requesting that the documents (4) to (8), (10), (11), (13), (14) and (16) should also be disregarded at the even later stage of this appeal proceedings.

It also refuted the Appellant's objection under Article 83 EPC (1973) based on the term "*substantially dry*" present in claim 1 as maintained, because this objection would only refer to alleged difficulties of establishing infringement, having nothing to do with the discussion on sufficiency of disclosure.

In respect of the further Appellant's objection under Article 83 EPC (1973) based on the word "*conditioning*" in claim 1 as maintained, as well as in respect of Appellant's objection to an inventive step in view of the combination of documents (15) or (12) with document (9), the Respondent relied on the reasoning already given in these respects by the Opposition division in the decision under appeal.

VIII. The Board summoned the parties to oral proceedings to be held on 18 March 2008.

In a facsimile dated 4 March 2008 the Appellant withdrew its request for oral proceedings and requested a decision to be made based on the written submissions already on file.

On 18 March 2008 the oral proceedings took place as scheduled in the absence of the Appellant.

- IX. During the hearing the Respondent reiterated orally substantially the same arguments already presented in writing.
- X. The Appellant has requested that the decision under appeal be set aside and the patent be revoked.

The Respondent has requested that the appeal be dismissed.

### **Reasons for the decision**

- 1. Decision of the Opposition division on the late filed documents

It is undisputed that all the documents (4) to (16) filed by the Appellant about one month before the oral proceedings before the Opposition division are belated.

The Opposition division has decided within its discretion under Article 114(2) EPC (1973) to disregard all these documents except documents (9), (12) and (15) (see also above section V of the Facts and Submissions).

The Board has no reason to reconsider the decision of the Opposition division in respect of the documents (9), (12) and (15) because it was not objected by any of the parties.

The Board must instead decide whether the decision of the Opposition division to refuse to admit documents (4) to (8), (10), (11), (13), (14) and (16) was correct because the Appellant challenged this decision.

- 1.1 If the way in which a department of first instance has exercised its discretion on a procedural matter is challenged in an appeal, it is not the function of a Board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, and to decide whether or not it would have exercised such discretion in the same way as the department of first instance. A Board of appeal should only overrule the way in which a department of first instance has exercised its discretion if the Board concludes it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see also the jurisprudence of the Boards of Appeal in Case Law of the Boards of Appeal of the European Patent Office, 5th edition 2006, VII.D.6.6).

When documents are submitted late in the proceedings the right balance has to be found of the general interest in the proceedings being conducted in an effective manner within a reasonable time, the reasons for the late filing, the right to be heard of the other party if there is one, the working organisation of the deciding body (see also the jurisprudence of the Boards of Appeal in Case Law of the Boards of Appeal of the European Patent Office, 5th edition, VI.F.2).

It is therefore to be examined, whether the Opposition division took into account the above cited interests when making its decision.

- 1.2 According to the Board's understanding, the Opposition division has considered the Appellant's argumentation based on these documents not fully substantiated, as also suggested by the Appellant's behaviour at the hearing (see above section V of the Facts and Submissions).

Hence, in the Board's view, the Opposition division has taken into account the fact that the argumentation presented by the Appellant lacked of substantiation, as well as the large number of belated documents filed, and the then current state of the proceedings, which could have required a delay in the proceedings in order to respect the right to be heard of the other party and, thus, has concluded that the behaviour of the Appellant is contrary to the need for procedural economy and refused to admit documents (4) to (8), (10), (11), (13), (14) and (16).

As established at point 1.1 above, these are appropriate criteria to be used in exercising the discretion under Article 114(2) EPC (1973).

The Board has therefore no reason to overrule the decision of the Opposition division to disregard documents (4) to (8), (10), (11), (13), (14) and (16).

2. Request for introduction of the late filed documents at the appeal stage.

The Appellant requests that these late filed documents are admitted at the appeal stage.

Late filed documents can be introduced at the appeal stage at the Board's discretion. The criteria for exercising this discretion as set out in Article 13(1) RPBA are the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

The Board in exercising its discretion finds that the same considerations explained under point 1.2 also apply to the introduction of these documents at the appeal stage. In fact, the Appellant's objections reiterated in the grounds of appeal are still found lacking substantiation and, thus, the presented reasoning does not allow the other party and the Board to immediately evaluate these objections. Moreover, the introduction of these documents into the appeal proceedings would possibly require to refer the case back to the first instance in order not to deprive the other party of one instance and, hence, would cause an unjustified delay in the proceedings.

The request is therefore refused.

3. Claim 1 as maintained: sufficiency of disclosure

The Appellant has argued that the disclosure provided by the patent in suit would not teach to the skilled person how to carry out the invention since:

a) the patent would not disclose how to realize the embodiments of the article defined in claim 1 as maintained that are possibly free of any conditioning agent but which must nevertheless provide "*conditioning*" of the hair or skin,

and

b) the hygroscopic nature of the claimed article (in particular in view of the high moisture level possibly present in the bathrooms wherein the use of the claimed article is expected to take place) would not allow to attribute a clear meaning to the feature in claim 1 that the claimed article must be "*substantially dry*", even when this latter is interpreted according to paragraph [0063] of the granted patent, i.e. as generally meaning that the article comprises less than 10% by weight water.

- 3.1 The Board notes that the objection "a)" implies interpreting literally the initial expression in claim 1 "*A disposable, single use personal care cleansing and conditioning article*" in isolation, i.e. as exclusively defining articles which must necessarily provide a conditioning effect.

The issue of Article 83 EPC (1973) is, however, to be judged by a skilled person interpreting the claims in the context of the whole patent disclosure.

The Board finds that the Appellant's interpretation of the above-identified initial wording of the claim would appear dubious to the skilled person already upon

reading the rest of claim 1 and, thus, noticing that this claim does not require the mandatory presence of a conditioning agent among the essential ingredients of the personal care article. Indeed, also in the present case the person skilled in the art would expect that the conditioning of skin or hair would inevitably be associated to the application of a conditioning agent.

The doubts as to the fact that the claimed articles could or should provide conditioning even when containing no conditioning agents are, implicitly, further reinforced by the fact that other claims, such as claims 4 to 10, do require the additional presence of the conditioning agents instead.

Finally, the skilled person would find, upon reading the description of the patent in suit, that no portion of the patent in suit suggests, even indirectly, that conditioning properties might (surprisingly) also be obtained when the article is free of any conditioning agent. This is also implicitly recognised in the Appellant's reasoning.

Hence, the literal interpretation of the initial wording of claim 1 proposed by the Appellant is found inconsistent not only with the common general knowledge but also with the rest of the claims and of the patent disclosure.

Accordingly, the skilled reader of the whole patent would necessarily conclude that claim 1 actually defines a disposable personal care article that provides either only cleansing or both cleansing and conditioning (in case it is also added with a



conditioning agent), i.e. that the claimed article may either be just a cleansing article or a cleansing and conditioning article.

The Board wishes to stress that the possibly misleading formulation of the initial wording of the claim is not an issue under Article 83 EPC (1973).

Since the Appellant has not even alleged that the skilled person would not be able to prepare either the claimed articles that provide only cleansing or the claimed articles that provide both cleansing and conditioning, the Board finds that the Appellant's objection "a)" reported above is not convincing.

- 3.2 In respect to the objection "b)" at point 3 above, the Board concurs with the Respondent that any ambiguities as to the maximum amount of water that may be present in the "*substantially dry*" article of claim 1 as maintained are irrelevant in respect of the possibility for the skilled person to carry out the invention. Indeed the Respondent has not disputed that the skilled person is able to realize articles with whatever water content and, hence, also with any of the levels of moisture possibly considered in the Appellant's reasoning (e.g. even those which may be reached by the hygroscopic article when it is left for prolonged time in the most moist atmosphere possibly present in bathrooms).

Accordingly, the possible ambiguities as to the way in which the maximum water content of the claimed article is expressed in claim 1 as maintained have no bearings on the possibility of the skilled person to carry out

the invention but only, possibly, on the unambiguous identification of which, among the reproducible articles, fall within the scope of the claim and which do not.

3.3 The Board concludes therefore that none of the Appellant's objections as to the sufficiency of disclosure is convincing. Hence, the subject-matter of claim 1 as maintained is found to comply with the requirements of Article 83 EPC (1973).

4. Claim 1 as maintained: novelty

The Board is satisfied that the claimed subject-matter is not anticipated by the available prior art and, thus, complies with the requirements of Article 54(1) EPC (1973).

5. Claim 1 as maintained: inventive step.

5.1 The Board concurs with the Appellant that the patent in suit mentions the complex technical problem of formulating a disposable personal care cleansing article that provides improved lathering and that possesses desirable texture, thickness and bulk.

5.2 The Board also agrees with the Appellant that document (15) explicitly indicates at column 4, lines 36 to 39, that the single-layer towels for skin moisturizing and drying disclosed in this citation produce foam and cleansing of the skin as well.

Hence, it is considered that the skilled person would have started from this prior art.

5.3 However, the Board finds unsupported the Appellant's allegation that the problem credibly solved by the claimed article is only that of providing an article with improved bulk and calliper, i.e. disregarding the improvement on lathering that is emphasized throughout the whole patent description and supported by the additional experimental data filed by the Respondent during the opposition proceedings.

As a matter of fact, the Board notes that nothing in document (15) suggests that the level of foaming provided by the towels referred to in column 4, lines 36 to 39, of this citation has been considered particularly high.

Moreover, the Appellant has provided no reasons for disregarding the statements in the patent in suit as to the achievement of an improved lathering, nor has expressed any reasoned criticism to the meaningfulness of the additional experimental data filed by the Respondent to prove the actual achievement of an improved lathering.

Hence, the Board has no reason to doubt that the claimed article has credibly solved also vis-à-vis the towels of document (15) the technical problem of providing a disposable personal care cleansing article that possesses besides desirable texture, thickness and bulk, also **an improved lathering**.

5.4 It is undisputed that document (9) is the sole citation introduced in the proceedings that discloses the two-layer structure (made of materials with different extensibility and joined in such a way that the most

extensible one cannot extend in its layer plane). Hence, a skilled person starting from the prior art articles of document (15) and searching for a solution to the posed problem, would have arrived at the presently claimed subject-matter **only in case** there would have been reasons suggesting that the combination of the teachings of document (15) and (9) was reasonably to be expected to result in a disposable personal care cleansing article possessing (besides desirable texture, thickness and bulk) also an improved lathering.

However, since document (9) lacks undisputedly of any information as to the effect of the two-layer structure onto the level of lathering provided by the personal care article, the Board finds that the combination of documents (15) and (9) suggests to the skilled person no solution to the posed technical problem of providing disposable personal care cleansing articles with improved lathering.

5.5 The Appellant has nevertheless argued that, even if the claimed articles would be assumed to provide an improved lathering, this would only amount to a bonus effect that the skilled person would in any case have obtained when modifying the structure of the towels of document (15) according to the teachings in document (9) in the reasonable expectation of achieving increased calliper and bulk impression.

5.6 The Board notes, however, that, as indicated in the decision under appeal (see above section V of the Facts and Submissions) and undisputed by the Appellant, other obvious means were available to the skilled person in order to improve bulk impression and calliper. Hence,

already for this reason the Appellant's attempt to combine the teachings of documents (15) and (9) cannot be considered an evident "one way street" situation leading to the inevitable bonus effect of an improved lathering, but rather a combination made with hindsight among documents disclosing the features of the claimed article.

5.7 Hence, the Board concludes that the subject-matter of claim 1 as maintained is not obvious in view of the available prior art and, thus, complies with the requirements of Article 56 EPC (1973).

6. Claims 2 to 24 as maintained

The Board finds that the subject-matter claims 2 to 24 complies with the requirements of the EPC for substantially the same reasons already considered above in respect of claim 1.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

P. Cremona

P.-P. Bracke