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**Datasheet for the decision  
of 15 December 2009**

**Case Number:** T 0181/06 - 3.3.10

**Application Number:** 98964508.0

**Publication Number:** 1041963

**IPC:** A61K 7/48

**Language of the proceedings:** EN

**Title of invention:**

Non-whitening underarm compositions

**Patentee:**

Unilever PLC, et al

**Opponent:**

Henkel AG & Co. KGaA  
BEIERSDORF AG  
Colgate-Palmolive Company

**Headword:**

Non-whitening compositions/UNILEVER

**Relevant legal provisions:**

EPC Art. 123(2)  
Decision of the Administrative Council on the transitional  
provisions under Article 7 of the EPC Revision Act Art. 1(5)

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

EPC Art. 108, 122(1)(2)(3)

**Keyword:**

"Appeal of Proprietor - admissible (no)"  
"Added subject-matter (yes)"

**Decisions cited:**

G 0002/88, G 0009/92, T 0220/83, T 0250/89, T 0428/98,  
T 1366/04

**Catchword:**

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Case Number: T 0181/06 - 3.3.10

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.10  
of 15 December 2009

**Appellant II:**  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
3 February 2006 concerning maintenance of the  
European patent No. 1041963 in amended form.

**Composition of the Board:**

**Chairman:** R. Freimuth  
**Members:** J.-C. Schmid  
F. Blumer

## Summary of Facts and Submissions

I. The Appellant I (Opponent 02), Appellant II (Opponent 01) and the Appellant III (Proprietor of the patent) lodged appeals on 7 February 2006, 8 February 2006 and 5 April 2006 against the interlocutory decision of the Opposition Division, posted on 3 February 2006, which found that the European patent No. 1041963 in the form as amended during opposition proceedings according to the then pending auxiliary request 1 met the requirements of the EPC, claim 1 reading as follows:

"1. The use of an anhydrous underarm composition for inhibiting the appearance of white product residues in the underarm, said composition comprising:

- (i) an underarm active which is an astringent salt of a metal selected from the group consisting of aluminium zirconium, zinc and mixtures thereof present in an effective amount to inhibit odor or to reduce perspiration and a cyclomethicone characterised in that
- (ii) from 5 to 80% by weight of the composition is hexameric cyclomethicone; and
- (iii) from 0 to 35% by weight based on total cyclomethicone present in the composition is tetrameric and pentameric cyclomethicone."

II. Notices of opposition had been filed by the Appellants I and II and the Party as of right (Opponent 03) requesting revocation of the patent in suit in its entirety on the grounds of lack of novelty

- and inventive step (Article 100(a) EPC) and insufficient disclosure (Article 100(b) EPC).
- III. The Opposition Division decided that the subject-matter according to claim 1 as granted was not novel, but held that the amendments made to the claims of the then pending auxiliary request 1 satisfied the requirements of Articles 84 and 123(2) EPC. It further held that the invention was novel and involved an inventive step.
- IV. At the oral proceedings before the Board, held on 15 December 2009, the Proprietor of the patent, in its quality of Respondent to the Opponents' appeals, withdrew its previous requests and defended the maintenance of the patent in suit on the basis of claim 1 as maintained by the Opposition Division as the sole request, this request, thus, superseding any previous requests.
- V. Appellant (III) indicated that it filed the notice of appeal within 2 months from the notification of the decision of the Opposition Division and that the appeal fee was duly paid. The notice established the extent of the appeal, thus giving warning to the Opponents Proprietor's intention, and could be regarded as a statement of grounds. Its sole omission was the submission of a full Statement within the period of 4 months of the notification of the decision. This omission was rectified by submission of the statement within 2 months from the communication dated 21 July 2006 of the registry of the board pointing out the omission. The reply to this communication dated 3 August 2006 was not only accompanied by a full statement of grounds, thereby rectifying the omission,

but included an explanation as to the cause of the omission, namely an inadvertent error, and in particular the fact that the statement that had been prepared in good time had not been dispatched, inadvertently. Accordingly, even if it were determined that the content of the notice of appeal of 5 April 2006 did not constitute sufficient subject matter to represent a bare statement of grounds capable of subsequent augmentation for all practical intents and purposes, Article 122 EPC for reinstatement had been met, though no explicit reference was made to that Article. Furthermore such augmentation was made extremely promptly, before the period when the EPO would ordinarily have copied the statement to the other Parties to enable them to lodge counter-arguments.

As regards the amendments, the composition claim was amended into the format of an use claim, more particularly into the use of the composition for inhibiting the appearance of white product residues in the underarm, but the composition as such was not amended. The meaning of the term "inhibiting" was clear in the context of the invention and meant slowing down or lessening, not eliminating. This was clearly apparent from the examples which referred to a delaying of the onset of the whitening. The claimed use was supported by the first paragraph of page 2 of the application as filed indicating that the object of the invention was to inhibit the white product and by examples 12 and 13 which clearly showed the technical effect of inhibiting the appearance of white product residues for compositions F and H. Although it was shown for particular compositions, the extrapolation of this technical effect was permissible since it was

reasonable. The cut off point of the maximum amount of hexamere present in the composition was not arbitrary, but was deductible from the results indicated in tables VII and IX of the application as filed. Furthermore, there was no broadening of the compositions. The compositions described in claim 1 were disclosed as such in the application as filed. It was thus credible that the technical effect shown for compositions F and H could be extrapolated to the whole scope of claim 1. The first paragraph of page 2 of the application as filed formed also a basis for the claimed use, since the skilled reader would have understood in view of the examples of the application that leaving transparent (non-white) product residues on the skin meant inhibiting the appearance of white product residues in the underarm.

VI. The submissions of the Appellants I and II and the Party as of right can be summarized as follows:

The appeal of Appellant III was inadmissible since no statement setting out the grounds of appeal was filed in due time. Furthermore, no request for re-establishment of rights was made and no fee was paid. The Appellant III's letter of 3 August 2006 simply indicated that the statement setting out the grounds of appeal was inadvertently not sent but there was no argument with respect to due care.

The application as filed did not disclose any method of inhibiting the appearance of white product residues in the underarm, let alone that each composition described therein would have such a technical effect. Moreover, the claimed use lacked clarity because the term

"inhibiting" was relative and no reference was indicated in the claim. Furthermore, the inhibition only related to the "appearance" of white product residues. In the first paragraph on page 2, there was no disclosure at all of "inhibition", but there was only a disclosure of leaving transparent products. Furthermore, this section addressed the problem to be solved, i.e. the aim of the invention. Accordingly, this section was not concerned with the technical characteristics of the compositions for the claimed use, but merely related to the desideratum of the invention, which was certainly not achieved by each composition described therein. The results of tables VII and IX of the examples 12 and 13 of the application indicated that the compositions whitened tissue, thereby causing, which is the opposite of inhibiting, the appearance of white product residues. Moreover, the technical effects shown by two particular compositions could not be generalised for every composition of claim 1.

VII. The Appellants I and II and the Party as of right, joining the Appellant I and II, requested that the decision under appeal be set aside and that the patent be revoked.

The Appellant III/Respondent requested that the appeals filed by the Opponents be dismissed.

VIII. At the end of the oral proceedings the decision of the Board was announced.



## **Reasons for the Decision**

### 1. *Admissibility of the appeals*

#### 1.1 *Appeals of Appellants I and II*

The appeals filed by the Appellants I and II are admissible, which finding has never been contested. In particular, these appeals comply with the requirements of Articles 107 and 108 EPC 1973 and Rule 64 EPC 1973.

#### 1.2 *Appeal of Appellant III*

According to the established case law of the Boards of Appeal the grounds of appeal should specify the legal or factual reasons on which the case for setting aside the decision is based. The arguments must be clearly and concisely presented to enable the Board and the other party or parties to understand immediately why the decision is alleged to be incorrect, and on which facts the Appellant bases his arguments, without having to make investigations on their own. Whilst Board's of Appeal practice allows the grounds for appeal to be presented in the notice of appeal which has been produced in due time, the grounds presented must still include the legal or factual reasons why the appeal should be allowed and the decision under appeal be set aside (T 220/83, OJ EPO 1986, 249, T 250/89, OJ EPO 1992, 355).

The notice of appeal filed on 5 April 2006 by Appellant III merely contained a request that the decision under appeal be cancelled and that the patent be maintained as granted. No further reference to the decision under appeal was made in said document. It was

furthermore indicated that a written statement setting out the grounds of appeal would be filed in due course.

Appellant III, however, conceded in its letters dated 3 August 2006 and 25 March 2009 and at the oral proceedings before the Board that such statement was filed with the letter dated 3 August 2006, i.e. not within the time limit provided for in Article 108 EPC. To the question from the Board at the oral proceedings as to which part of its notice of appeal should be regarded as a statement of grounds, Appellant III could not identify any, nor can the Board. Furthermore the Appellant III's submissions are inconsistent since in the notice of appeal it indicated that a statement of the grounds of appeal would be filed while later arguing that the notice of appeal might be considered to comprise the statement setting out the grounds of appeal. The Board therefore concludes that the notice of appeal contains nothing that could be regarded as statement of grounds pursuant to Article 108 EPC 1973.

As no written statement setting out the grounds of appeal has been filed within the time limit provided for in Article 108 EPC 1973, the appeal has to be rejected as inadmissible pursuant to Rule 101(1) EPC.

#### 1.2.1 *Re-establishment of rights*

Appellant III further argued that its letter dated 3 August 2006 was to be regarded as an implicit request for re-establishment of rights under Article 122 EPC.

Pursuant to Article 1(5) of the Administrative Council's Decision of 28 June 2001 on the transitional

provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000, "Articles 121 and 122 [EPC 2000] shall apply to European patent applications pending at the time of their entry into force and to European patents already granted at that time, in so far as the time limits for requesting further processing or re-establishment of rights have not yet expired at that time". As the time limit for requesting the re-establishment of rights was triggered by the Board's communication of 21 July 2006 (see above section IV) and ended in autumn 2006 (i.e., before the date of entry into force of the EPC 2000 in December 2007), Article 122 EPC 1973 is applicable to the re-establishment issues in the present case. The applicability of Article 122 EPC 1973 is in compliance with the principle that procedural acts and omissions shall be considered under the law prevailing at the date of the respective acts and omissions (*tempus regit actum*, T 1366/04, point 1.2 of the reasons, not published in OJ EPO).

In its letter dated 25 March 2009, Appellant III argued that after the filing of its letter dated 3 August 2006 "for all practical intents and purposes, Article 122 for reinstatement had been met, though no explicit reference was made to that Article". Under Article 122(1) EPC 1973, rights may be re-established if a time limit was not observed "in spite of all due care required by the circumstances having been taken". According to the established jurisprudence said requirement of due care is fulfilled if the non-compliance with the time limit results from an isolated mistake within a normally satisfactory system for monitoring time limits (see, T 428/98, OJ EPO 2001,

494, point 3.3 of the reasons). By merely stating that a statement setting out the of grounds of appeal had been prepared but "by mistake" not despatched, Appellant III clearly missed to substantiate that the due care requirement under Article 122(1) EPC 1973 has been met.

Anyhow, the request also fails on another score due to the lack of payment of the fee for re-establishment of rights. An application for re-establishment "shall not be deemed to be filed until after the fee for re-establishment of rights has been paid" (Article 122(3) EPC 1973). The fact that no fee for re-establishment of rights had been paid within the two month time period set forth in Article 122(2) EPC 1973 was not contested by Appellant III. The failure to pay the fee for re-establishment means that no request for re-establishment is deemed to have been filed, regardless of the contents of any submissions made by the requesting party.

Hence, the request for re-establishment of rights is rejected.

- 1.3 In view of the conclusions reached above, opponents 01 and 02 are the sole Appellants challenging the decision of the Opposition Division maintaining a patent in amended form. Accordingly, the Patent Proprietor is only party to the appeal proceedings as of right, i.e. Respondent to the opponents' appeals, and is primarily restricted during the appeal proceedings to defending the patent in the form in which it was maintained by the Opposition Division in its interlocutory decision (see G 9/92, OJ EPO 1994, 875), what it did.

Opponent 03 is also party to the appeal proceedings as of right.

2. *Modifications (Article 123(2) EPC)*

2.1 The category of granted product claim 1 was changed, i.e. fresh claim 1 has the format of an use claim, wherein the product is used to achieve a particular technical effect. This technical effect in such an use claim becomes a technical feature of that claim (see G 2/88, OJ EPO 1990, 93). Therefore in order to satisfy the requirement of Article 123(2) EPC, this technical effect, i.e. this technical feature, must be disclosed in the application as filed as being achieved by the product, i.e. the compositions as defined in claim 1. That means in the present case that the technical effect of inhibiting the appearance of white product residues in the underarm needs to have been disclosed therein, and this in combination with the compositions set forth in claim 1.

2.2 In order to determine whether or not the subject-matter of a claim in a patent extends beyond the content of the application as filed it has to be examined whether that claim comprises technical information which a skilled person would not have objectively and unambiguously derived from the application as filed.

2.3 The Respondent (Proprietor of the patent) indicated that compositions F and H disclosed in tables VII and IX of examples 12 and 13 of the application as filed provided a support for the claimed use. It referred more particularly to the analysis of the results of the compositions of table 7 where it is disclosed that

composition F, containing hexameric cyclomethicone as the sole cyclomethicone, was substantially better than the other compositions at delaying the onset of any whitening.

- 2.3.1 As pointed out by the Appellants I and II and the party as of right, a generalisation of these examples has thus been made, since claim 1 covers the technical effect of inhibiting the appearance of white product residues for any claimed compositions, while a technical effect, whatever it is (see also point 2.4.3 below), is disclosed in examples 12 and 13 as being achieved by two individualised compositions F and H having specific characteristics.

Such an amendment resulting in isolating a specific technical effect achieved by particular compositions and generalising it in a claim covering compositions generically defined would only be allowable, provided the skilled man would have readily recognised this technical effect is not closely associated with the other characteristics of the particular compositions which are no longer required in the claim.

However, in the Board's judgement, the skilled person derives from these examples nothing more than the bare disclosure of two particular compositions with their specific characteristics achieving the disclosed technical effect, namely the combination of the particular components present in the composition in their specific contents which all together have an impact on the technical effect achieved by the composition. Hence, in the present case, the technical effect is associated with all of the structural

characteristics of the compositions F and H, i.e. with the particular astringent metal salt, the particular cyclomethicones and the additional components, and their particular amounts.

To dismantle those particular exemplary compositions showing this technical effect into isolated features, to specifically attribute the occurrence of the technical effect to one specific isolated feature thereof and to generalize it over the whole scope of claim 1 covering compositions with different components in different amounts provides the skilled person with technical information which is not directly and unambiguously derivable from the application as filed.

As a consequence the amendment in claim 1 associating a technical effect disclosed for the particular compositions F and H in the application as filed to the whole scope of compositions, as defined in claim 1, is an undue generalisation which generates fresh subject-matter.

- 2.3.2 According to the Respondent, it was credible from the data in the application as filed that the technical effect shown for compositions F and H could be extrapolated to the whole scope of claim 1.

However this argument is based on consideration relevant for the assessment of inventive step (Article 56 EPC), where the issue arises whether a technical effect is credible within the whole claimed scope. However, amendments in claims are governed by Article 123(2) EPC which requires a direct and unambiguous disclosure in the application as filed of

amended subject-matter. The question of what may be rendered obvious by the data present in the application as filed is not relevant to the assessment of what is directly and unambiguously disclosed in that document. Accordingly, the allegation that it would be credible that the technical effect is achieved by all the compositions of claim 1 cannot alter the finding that the technical effect is not disclosed for the composition as defined in claim 1.

2.3.3 The Respondent's further argument that the composition as defined in claim 1 was not amended vis-à-vis claim 1 as granted and, thus, not open to an objection pursuant to Article 123(2) EPC, is not pertinent. The above finding that claim 1 extends beyond the original disclosure is not based on an amendment of the definition of the composition as such, but is due to the fact that the Respondent changed the category of the claim, thereby including a technical effect as a technical feature in the fresh claim, without having a proper support for that technical effect in the application as filed (see point 2.3.1 above).

2.4 The Respondent further relied on page 2, first paragraph of the application as filed which relates to the object of the invention which is "to provide an underarm product which after application leaves, for at least 1 hour, preferably 3 hours but optimally 24 hours, transparent (non-white) product residues on the skin".

2.4.1 However, the contested technical feature of claim 1 is the effect of inhibiting the appearance of white product residues in the underarms, which according to the Respondent means to lessen or to slow down the



appearance of white product residues. However, to leave non-white product residues on the skin as disclosed on page 2 of the application as filed and to inhibit the appearance of white product residues as required in claim 1 are two different technical effects, and, thus different technical features. Furthermore, on page 2 of the application as filed, the action of leaving the non-white products on the skin is directly associated with a particular time frame, i.e. for at least 1 hour, while there is no requirement of time frame for the claimed use for inhibiting the appearance of white product residues. Therefore, the first paragraph of page 2 of the application as filed cannot form a proper basis for the claimed use.

- 2.4.2 According to the Respondent, the skilled reader would have understood in view of the examples that leaving transparent (non-white) product residues on the skin meant inhibiting the appearance of white product residues in the underarm.

However the finding of whether or not the subject-matter of a claim in a patent extends beyond the content of the application as filed is not a matter of what was intended to be understood, but rather the matter which technical information a skilled person would directly and unambiguously derive from the content of the application as filed.

Furthermore, the technical effect addressed in the original examples, i.e. of delaying the onset of whitening, is only disclosed as being achieved by particular compositions, the technical effect of which

cannot be generalized to all compositions covered by claim 1 (see point 2.3.1 above).

2.4.3 The Board also notes that the technical effect of delaying the onset of whitening addressed in examples 12 and 13 referred to by the Respondent is linked to a time frame and, hence, cannot provide an adequate support with respect to the claimed feature of inhibiting the appearance of white product residues (see point 2.4.1 above).

2.4.4 The Appellants I and II objected to that the first paragraph of page 2 merely addressing the technical problem underlying the application cannot be a proper support for fresh claim 1.

However, since that section of the application as filed anyhow does not provide a proper basis for the effect indicated in use claim 1, as set out in point 2.4.1 above, it is pointless to examine whether the combination of that section addressing what the invention aims at and what is not yet achieved with sections addressing the compositions of the invention *per se*, such as original claim 1, may be a proper support for fresh claim 1.

2.5 In response to a question from the Board regarding any further support in the application as filed for claim 1, the Respondent indicated no further section, nor the Board is aware of any.

3. Therefore, the Board concludes that the subject matter of claim 1 as amended extends beyond the content of the application as filed, thus, contravening the provisions

of Article 123(2) EPC. In these circumstances, the Respondent's sole request is not allowable and must be rejected.

## **Order**

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

1. The Appeal filed by the Proprietor is rejected as inadmissible.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar

The Chairman

D. Magliano

R. Freimuth