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**Datasheet for the decision  
of 28 September 2009**

**Case Number:** T 0567/08 - 3.2.04

**Application Number:** 00917183.6

**Publication Number:** 1175165

**IPC:** A45D 34/04

**Language of the proceedings:** EN

**Title of invention:**

Package for dispensing a flowable cosmetic composition and product

**Patentee:**

Unilever PLC, et al

**Opponent:**

PLASTICOS GONZALEZ S.A.  
Colgate-Palmolive Company

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 123(2),(3)

**Keyword:**

"Limiting extension (yes)"

"Amendments - claim broadening (yes) (main, auxiliary requests)"

"Amendments - added subject-matter (yes) (main, auxiliary requests, alternative version)"

**Decisions cited:**

G 0001/93

**Catchword:**

-



Case Number: T 0567/08 - 3.2.04

**DECISION**  
of the Technical Board of Appeal 3.2.04  
of 28 September 2009

**Appellant:** Unilever PLC  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 22 January 2008  
revoking European patent No. 1175165 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** M. Ceyte  
**Members:** A. de Vries  
T. Bokor

## Summary of Facts and Submissions

I. On 20 March 2008 the Appellant (Proprietor) lodged an appeal against the Opposition Division's decision of 22 January 2008 to revoke European patent No. 1 175 165 and simultaneously paid the prescribed appeal fee. The grounds of appeal were filed on 20 May 2008.

Opposition was filed against the patent as a whole and based among other grounds on Article 100(c) EPC as the patent extended beyond the content of the application as filed.

The Opposition Division held that this ground prejudiced maintenance of the patent.

II. The Appellant-Proprietor requests that the patent be maintained in amended form according to a main request or first to sixth auxiliary requests all filed with letter of 6 August 2009, or in the alternative, on the basis of the same requests where the feature "beyond the base footprint" has been reintroduced.

Both Respondents, Opponent I and Opponent II, request that the appeal be dismissed.

III. Oral proceedings before the Board were duly held on 28 September 2009.

IV. The wording of claim 1 in its granted form and according to the main and auxiliary requests is as follows:

**As granted**

(The text includes in *italics* minor editorial corrections by the Board.)

"1. A package for topical application of a flowable cosmetic composition to an armpit comprising:

(i) a container (1) having a capacity of from 20 to 120 mls comprising a body (2) and head (3) and having opposite first and second ends, the first end of the container being closed by a base (7) comprising a planar external surface that enables the package to stand upright and the second end defining a mouth which comprises a seating (12) for a roll-ball (13), the container (1) having a principal axis (5) and a secondary axis (6) inclined acutely to the principal axis, the container body having opposed front and rear sidewalls (8a, 8b) extending upwardly from the base (7), the front sidewall (8a) being aligned with the principal axis (5) and the rear sidewall (8b) aligned with the secondary axis (6) and converging towards the front sidewall to form a waist and thereafter diverging outwardly beyond the base footprint to form a support (9) underneath the roll-ball seating (12);

(ii) a ball (13) which is rotatably seated within the seating (12) and is partially proud of the seating, and

(iii) a cap (4) seatable over the roll-ball (13).

**Main request**

1. "A package for topical application of a flowable cosmetic composition to an armpit comprising:

(i) a container (1) having a capacity of from 20 to 120 mls comprising a body (2) and head (3) and having

opposite first and second ends, the first end of the container being closed by a base (7) comprising a planar external surface that enables the package to stand upright and the second end defining a mouth which comprises a seating (12) for a roll-ball (13), the container (1) having a principal axis (5) extending longitudinally and a secondary axis (6) inclined acutely to the principal axis, the container body having opposed front and rear sidewalls (8a, 8b) extending upwardly from the base (7), the front sidewall (8a) being aligned with the principal axis (5) and the rear sidewall (8b) aligned with the secondary axis (6) and converging towards the front sidewall to form a waist and thereafter diverging outwardly beyond the base to form a support (9) underneath the roll-ball seating (12);

(ii) a ball (13) which is rotatably seated within the seating (12) and is partially proud of the seating, the centre of the roll-ball being located vertically above the first end of the container and

(iii) a cap (4) seatable over the roll-ball (13) in which the mouth plane (11) is orthogonal to the secondary axis (6) and the head is inclined to the body at an angle of less than 30°."

#### Auxiliary Request I

Claim 1 is as in the main request but for the final lines of feature (i) which now read "...front sidewall to form a waist *that is close to the head of the container* and thereafter diverging outwardly beyond the base to form a *shoulder* (9) underneath the roll-ball seating (12);". (Emphasis added by the Board indicates what has changed.)

Auxiliary Request II

Claim 1 is as in the auxiliary request I but for the final lines of feature (i) which now read (with added emphasis again indicating the relevant changes): "... secondary axis (6) and *extending forwardly and upwardly* towards the front sidewall to form a waist that is dose to the head of the container and thereafter *projecting backwardly* beyond the base to form a shoulder (9) underneath the roll-ball seating (12);".

Auxiliary Request III

Claim 1 is as in the auxiliary request II but for the final lines of feature (i) which now read (with added emphasis indicating the relevant changes, and strikethrough indicating what has been removed): "... and thereafter projecting backwardly ~~beyond the base~~ to form a shoulder (9) underneath the roll-ball seating (12), *the head (3) extending both to the front and rear of the container (1);*"

Auxiliary Request IV

Claim 1 is as in the auxiliary request III but for the final line of feature (iii) which now reads (with added emphasis indicating the relevant changes): "... secondary axis (6) and the head is inclined to the body at an angle of *from 10 to 40 degrees.*"

Auxiliary Request V

Claim 1 is as in the auxiliary request IV but for the final lines of feature (i) which now read (with added emphasis indicating the relevant changes): "... and thereafter projecting backwardly to form a shoulder (9) underneath the roll-ball seating (12), *the shoulder (9) and the head (3) both extending outside the theoretical plane ending vertically above the base (7), the one to the rear and the other to the front, the edge of the shoulder (9) being within  $d/5$  of said theoretical plane, where  $d$  is the rear to front diameter of the container (1) at its base (7);*".

Auxiliary Request VI

Claim 1 is as in the auxiliary request V but adds at the end of feature (i) (immediately following base (7)) : ", the body (2) constituting 60 to 90% of the total length of the body (2) plus head (3)"

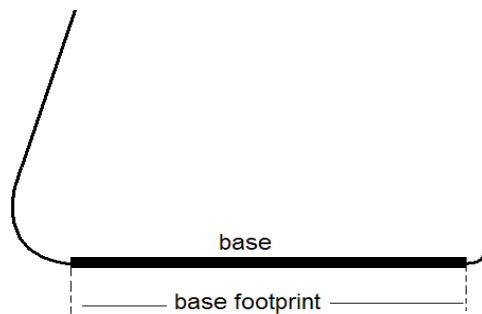
Further Requests

For each of the above requests the Appellant formulates an *alternative request* by reintroducing the expression "beyond the base footprint" into the wording of the respective claim 1 at the relevant location.

V. The Appellant argued as follows:

The base corresponds to the contact surface of the container. It does not include the curved edges connecting the planar surface to the container walls. The original disclosure may not mention the term

"footprint", but its meaning is perfectly clear and well-defined. It merely denotes the area on the underlying surface in contact with the base, as can be demonstrated with the aid of an inkpad. It thus corresponds to the base, defined in the claim as the planar surface formed at the bottom of the container and on which it rests.



*Figure 1*

This definition of "base" follows clearly from the description, in particular page 12, first paragraph. This passage indicates "the theoretical plane extending vertically upwards rear [of] the first end (the base) of the container" and "the head extending by a similar distance beyond the theoretical plane at the back of the container".

As "base footprint" means the same as "base", and "base" is clearly disclosed, replacement of the former by the latter in claim 1 as in the main and auxiliary requests does not extend the scope of protection. Nor does reinstatement of "base footprint" as in the alternative versions of these requests add subject-matter.



VI. Opponent I as Respondent I argued as follows:

The term "footprint" was never mentioned in the original disclosure and must be understood in its own right. It denotes the vertical projection or shadow of the base on the underlying surface. Just as a footprint in sand it extends beyond the contact surface, including the rounded edges.

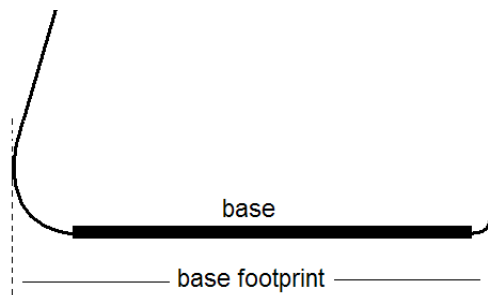


Figure 2

By replacing "base footprint" with "base" the requirement on the location of the shoulder is relaxed, and the scope of protection extended. Moreover, as the two terms are not synonymous, introducing the undisclosed term "base footprint" adds information not originally disclosed.

Opponent II as Respondent II added:

"Footprint" has different meanings depending on context. As used in granted claim 1 the term is ambiguous. As a result in at least one reasonable construction of the term "base footprint", its replacement by "base", which defines the planar external surface of the end, results in embodiments (e.g. **a** in figure 3 below) that did not infringe claim 1 as granted after amendment infringing

it, so that the main and auxiliary requests infringe Article 123(3).

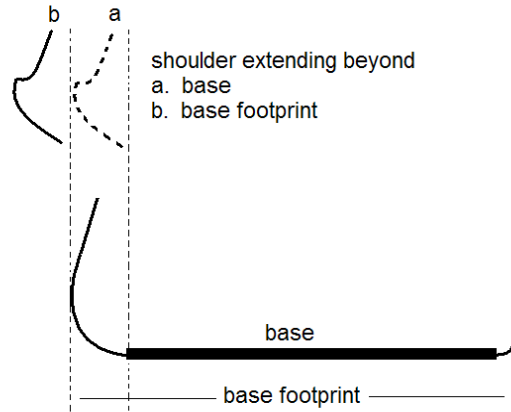


Figure 3

The purpose of Article 123(3) is to provide legal certainty to third parties. If the term "base footprint" has introduced a lack of clarity before grant, it is no longer possible after grant to retrospectively solve this problem in a way that gives the proprietor unwarranted extra protection.

As for the question of added subject-matter, whether the added term may actually read on an embodiment is not legally relevant. The relevant question is whether the claimed combination of features is originally disclosed, i.e. whether the skilled person can derive the combination directly and unambiguously from the application as filed. As the added term is ambiguous, it is necessarily not directly and unambiguously disclosed. It also finds no basis in the term "base", which itself is not unambiguously defined in the application as filed. The only relevant information is found on page 12, first paragraph, and claims 8 and 9 as filed, which consistently define shoulder location

with respect to a vertical plane extending from the first end of the container or its circumference. The alternative versions of main and auxiliary requests which reinstate "base footprint" fail the requirement of Article 123(2).

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Background*

The invention is effectively directed at a roll-on applicator for cosmetics (e.g. deodorant) which comprises a container with body and head sections. The head seats a roll-ball in a mouth and proud of the seating. Body and head are inclined with respect to each other, while the body is shaped such that it has front and rear walls extending upwards from a base along respective inclined axes and converging to form a waist. The rear wall then diverges outwardly to form a shoulder underneath the roll-ball seating. Such an "anvil" shape locates the user's hand onto the container with the head directed in the desired direction, but also contributes to the stability of the container, see specification paragraphs [0033] and [0034]. Critical to the stability is among other factors the exact position of the shoulder with respect to the base of the applicator container.

3. *Limiting Extension*

3.1 The subject-matter of claim 1 as granted is defined in part using the term "base footprint", which is not disclosed in the original disclosure but was introduced during examination and held to add subject-matter in the decision under appeal.

3.2 The decisive issue now is whether the addition of this term represents an amendment of the type addressed in G 1/93 (OJ 1994, 541), reasons 12, namely an *"undisclosed technical feature limiting the scope of protection of the granted patent in comparison with the application as filed"*. Such a "limiting extension" adds subject-matter contrary to Article 123(2) but at the same limits the scope of protection vis-à-vis what could have been claimed, so that its removal infringes Article 123(3) EPC. Only if there is a basis in the application as filed for replacing such subject-matter without violating Article 123(3) EPC can it be remedied, see headnote I and reasons 13. On the other hand, if the limitation *merely* excludes part of the potential protection of the application as filed, *without providing a technical contribution* to the subject-matter of the claimed invention, it does not add subject-matter and the opposition ground under Article 100(c) does not prejudice maintenance of the patent, headnote II and reasons 16.

G 1/93 makes its findings in the light of the overall purpose of Articles 123(2) and (3) EPC, namely to create a fair balance of interests between patentee (or applicant) and competitors and third parties, reasons 8.

4. *Original disclosure*

4.1 It is uncontested that the term "base footprint" is not expressly disclosed in the application as filed. In granted claim 1 a rear sidewall extends beyond the "base footprint" to effectively form the shoulder (though not defined as such in the claim). The relevant parts of the original disclosure dealing with the location of the shoulder are to be found on page 12, in the first paragraph, and in as filed claim 8. In the former "the shoulder ... extends to at or near a theoretically plane extending vertically upwards rear *the first end (the base)* of the container". In claim 8, "the shoulder ... extends to at or near a theoretical plane which extends vertically above the *circumference of the first end*".

4.2 "The first end" and "base" are used, it would appear, as synonyms on page 12. In a further passage on page 10, lines 9 to 14, the two terms are again used interchangeably: "the container has a first, closed end which is has [sic] a planar surface, enabling it to stand upright. The planar surface may be completely flat or comprise a flat rim and an inwardly domed area. The base often has a diameter ... ". This passage on page 10 also offers a definition, if somewhat grammatically flawed, of what is meant by the first end/base. It focuses on the flat surface on the bottom end of the container including any domed area contained within it and corresponds to what the Appellant reads as "base" and "base footprint", denoted in figure 1 above. It is noted that this definition excludes the rounded edge of the container bottom lying outward of and connecting to the flat surface, see figures. On the

side of the shoulder this edge is shown as relatively prominent and not negligible.

4.3 With this definition in mind page 12, first paragraph, and claim 8, can then be read as teaching to locate the shoulder beyond a plane extending vertically from *the circumference of this flat surface*.

5. *Added subject-matter*

5.1 Claim 1 was amended upon grant to require the support (forming the shoulder) to lie "beyond the base footprint". The term "footprint" can have various meanings, and its use in conjunction with "base" is open to interpretation, as the debate to date has shown.

5.2 If "footprint" is understood, as does the Appellant, in the sense of a "tyre footprint", meaning "the area of contact between a tyre and the ground" (Oxford English Dictionary or OED), it corresponds to the contact surface of the container bottom end on the underlying surface. The circumference thereof corresponds to that of the base or first end as defined above, and the requirement in granted claim 1 could then be read as equivalent to that understood from the text (where "the support/shoulder extending beyond the circumference" will be understood as meaning that it extends beyond the plane extending vertically from the circumference").

5.3 On the other hand, the term can be read analogously to "footprint of a personal computer", denoting the "area of a surface taken up by a microcomputer on a desktop" (OED) and formed by the downward projection onto the surface of the PC. This reading would allow for more

complex, non planar base shapes - such as with an outer rounded edge - the downward projection of which then forms the "footprint". In this interpretation "base footprint" includes for example the rounded edge onto the underlying surface, as shown in figure 2 above. The area is larger than that of the contact surface above, and its circumference further outward. Thus interpreted, granted claim 1 requires the support/shoulder to lie further outward than if it is interpreted as in the previous paragraph.

5.4 Both interpretations represent common usage, as illustrated by the citations from the OED. Moreover, they fit within the context of the entire contents, i.e. there is no contradiction between this claim wording and description and figures of the patent specification, the relevant parts of which - paragraphs [0029] and [0034]- are unchanged with respect to the originally filed description. These passages encompass also shoulders that extend further outward , e.g. those beyond the boundary of the base projection rather than of the contact surface.

5.5 The second interpretation however is more specific than the teaching derivable from the original disclosure (section 3.2 above). It adds new, more precise information on the location of the shoulder, which is not derivable from the original application. Moreover, in the context of the problem of stability (see section 2) this information is technically significant; by defining a more limited range of possible shoulder positions it provides a technical contribution to the invention. In its second interpretation the feature of the "base footprint", and bearing in mind G 1/93,

headnote II (see section 3.2 above), thus adds subject-matter extending beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

5.6 This possible interpretation gives the proprietor an unwarranted advantage and is damaging to the legal security of third parties. It does not matter that the claim can also be read in such a way that it does not add subject-matter. The fact that in one reasonable interpretation of the claim it does do so is decisive. The legal certainty of a claim that, by introduction of an undisclosed ambiguous term, is amended to have multiple reasonable interpretations, is thus compromised when one of those interpretations relates to added subject-matter.

5.7 The Board thus concurs with the finding of the decision under appeal, that the corresponding opposition ground of Article 100(c) EPC is prejudicial to the patent as granted.

6. *Limitation of scope of protection*

6.1 The first interpretation of "base footprint" as synonymous to contact surface clearly does not per se result in a limitation of the scope of the original disclosure. However, reading the term in its second sense, see section 3.3.2, claim 1 as granted only protects containers with supports/shoulders that extend further outward, beyond the wider area. A shoulder, which lies between the contact surface boundary and that of the whole base projection, see figure 3 above, does not fall within granted claim 1's scope, though by



virtue of the original application's disclosure of the contact surface boundary as lower limit (see section 3.2 above) it could have been. According to the second interpretation of "base footprint" this amendment to claim 1 at grant thus *limits* the scope of the claim in comparison to the application as filed and published. It is again stressed that this second interpretation is consistent with description and figures, and it is thus a valid construction of claim scope when the claim is read in light of the description and figures in accordance with Article 69(1) EPC.

6.2 As demonstrated above, but for the prohibition of Article 123(3) EPC, subsequent amendment of claim 1 by removing the term "base footprint" would result in embodiments, which before amendment did not infringe the patent, after amendment infringing it. Here again the fact that there is at least one reasonable, contextually consistent reading of the term that results in a limitation of scope, among a number of possible readings that do not, is decisive. The ambiguity of the undisclosed amendment adds to, rather than mitigates the legal uncertainty surrounding the rights deriving from the patent. In this regard, the Board notes that if it were to construe an ambiguous undisclosed term in a manner favourable to the Proprietor (i.e. in a way that does not add subject-matter and limit scope) it would act against the principle of a fair balance of interests underlying Articles 123(2) and (3). In its view the Proprietor should not be able to reap any benefit from the fact that an added undisclosed feature is ambiguous, with regard to an added undisclosed feature that is not.

7. *Conclusion*

As follows from the above, the amendment of claim 1 pertaining to "base footprint" adds subject-matter, but limits the scope of protection in comparison to the application as filed and published. The Board concludes that it is a "limiting extension" in the sense of G 1/93.

8. *The requests*

8.1 The main request and the auxiliary requests 1, 2, 5 and 6 replace the term "base footprint" by "base" in the definition of the location of the support/shoulder in their respective claim 1. In claim 1 of auxiliary requests 3 and 4 the requirement of the shoulder location including "base footprint" is dropped altogether. In both instances the requirements of claim 1 are relaxed. In the first case, if "base" is read as synonymous to "first end" to denote the contact surface (see section 4 above), the claim's scope of protection is extended to encompass shoulder locations in the intermediate area, as explained previously. In the second case, claim 1 is broadened to cover containers with shoulders in any location. For all these requests the amendment to claim 1 infringes Article 123(3) EPC.

8.2 In section 5 the Board found that the introduction of the term "base footprint" adds subject-matter extending beyond the original disclosure. Reinstatement of this term in claim 1 according to the main request and the auxiliary requests 1 to 6 in their alternative version,

therefore means that claim 1 thus amended infringes Article 123(2) EPC.

8.3 The Board concludes that patent and the invention to which it relates as defined in claim 1 according to the main request or auxiliary requests 1 to 6, or according to their alternative versions, do not meet the requirements of the Convention.

### **Order**

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

The appeal is dismissed.

The Registrar

The Chairman

G. Magouliotis

M. Ceyte