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**Datasheet for the decision
of 8 October 2015**

Case Number: T 1702/12 - 3.3.10

Application Number: 02787959.2

Publication Number: 1465588

IPC: A61K8/92, A61Q19/00

Language of the proceedings: EN

Title of invention:
WET-SKIN TREATMENT COMPOSITIONS

Patent Proprietor:
Unilever PLC
Unilever N.V.

Opponent:
Henkel AG & Co. KGaA

Headword:

Relevant legal provisions:
EPC Art. 123(3), 111(1)
EPC R. 139

Keyword:

Main request and auxiliary request 1: extension of protection conferred (yes) - amendment does not qualify as a correction

Auxiliary requests 2 and 3: extension of protection conferred (yes) -

scope of granted dependent claim cannot be greater than that of independent claim 1 on which it depends

Auxiliary request 4: remittal to the department of first instance (yes)

Decisions cited:

G 0003/89, T 0200/89

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1702/12 - 3.3.10

**D E C I S I O N
of Technical Board of Appeal 3.3.10
of 8 October 2015**

Appellant: Unilever PLC
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 30 May 2012
revoking European patent No. 1465588 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: J. Mercey
C. Schmidt

Summary of Facts and Submissions

I. The Appellant (Proprietor of the patent) lodged an appeal against the decision of the Opposition Division revoking European patent No. 1 465 588. Said patent comprises an independent claim 1 directed to a wet skin treatment composition, together with 10 claims dependent thereon, and an independent claim 11 directed to a process for moisturising and protecting skin comprising applying to wet skin a composition as defined in any of the preceding claims, together with a single dependent claim thereon. Claims 1 and 6 read as follows:

"1. A rinse-off wet-skin treatment composition comprising:

- a) an aqueous phase comprising water and a dispersion stabilizer wherein the dispersion stabilizer is selected from inorganic dispersion stabilizers, polymeric dispersion stabilizers, organic dispersion stabilizers having a molecular weight lower than 1000 Daltons and capable of forming a network in the aqueous phase that immobilises a dispersed structured oil phase, and mixtures thereof; and
- b) a structured oil phase comprising:
 - i) a skin compatible oil,
 - ii) a structurant that forms a stable network comprising particles having a weight average size below 25 microns which particles are present in the liquid skin compatible oil at a temperature below 35°C wherein the structurant is present in an amount sufficient to cause the oil phase to have a viscosity of 100 to 500 poise measured at 1 sec⁻¹ at 25°C and wherein the structurant is selected from the group consisting of organic structurant being either crystalline solids or amorphous gels having MW less than 5000 Daltons,

inorganic structurants or a mixture of the organic and inorganic structurants that is capable of forming a 3-dimensional network to build up the viscosity of the skin compatible oil;

iii) 0.01-45% of dispersed phase based on total structured oil phase,

wherein the oil phase is dispersed in the aqueous phase to form an oil-in-water emulsion having a weight average oil droplet size of 5 to 1000 microns;

wherein the structured oil phase is retained on the skin as measured by a skin retention efficiency index of at least 0.15 as determined in the in-vitro skin retention test;

wherein the oil-in-water emulsion has an irritation potential measured below 0.3 on the zein solubility scale using a zein solubility test; and

wherein the emulsion has a foam volume below 5 cc as measured using the solution shake test."

"6. A composition according to any of the preceding claims, wherein the structured oil phase has a viscosity in the range of 200 to 2000 poise at a shear rate of 1 sec^{-1} and a temperature of 25°C ."

II. Notice of Opposition had been filed by the Respondent (Opponent) requesting revocation of the patent in its entirety on the grounds of Articles 100(a) and (b) EPC. The Opposition Division raised an objection of its own motion that the subject-matter of claim 1 as granted did not fulfil the requirements of Article 100(c) EPC, no basis being found in the application as filed for the upper limit of the viscosity of the structured oil phase being 500 poise. In response to this objection, the Appellant filed a main request in which this upper limit of the viscosity range was raised to 5000 poise, arguing that the value of 500 poise was an error, the

value of 5000 poise being the obvious correction thereof. Since such a correction had an *ab initio* effect, there was no violation of Article 123(3) EPC.

- III. The Opposition Division found that the pending main request did indeed violate Article 123(3) EPC, since the amendment did not satisfy the requirements for correction of an error according to Rule 139 EPC.
- IV. With letter dated 9 May 2014, the Appellant filed a new main request and auxiliary requests 1 to 4, and with letter dated 31 August 2015, the Appellant filed auxiliary requests 5 and 6.

Claim 1 of the main request and auxiliary requests 1, 5 and 6 each differs from claim 1 as granted in that *inter alia* the oil phase is specified as having a viscosity of 100 to 5000 poise.

Claim 1 of auxiliary request 2 differs from claim 1 as granted only in that the oil phase is specified as having a viscosity of 100 to 2000 poise.

Claim 1 of auxiliary request 3 differs from claim 1 as granted only in that the oil phase is specified as having a viscosity of 200 to 2000 poise.

Claim 1 of auxiliary request 4 differs from claim 1 as granted only in that the oil phase is specified as having a viscosity of 100 to 200 poise.

- V. The Appellant submitted that the correction made in claim 1 of the main request and auxiliary requests 1, 5 and 6 was allowable under Rule 139 EPC, since it was immediately evident that nothing else was intended other than what has been offered as the correction. It

was evident that an error had occurred, in view of the discrepancy between granted claims 1 and 6, dependent claim 6 of the granted patent specifying an upper limit for the viscosity of the oil phase of 2000 poise, which was higher than the upper limit of 500 poise specified in claim 1 as granted. Furthermore, paragraphs [0035] and [0043] of the patent specification and claim 1 of the application as filed disclosed *inter alia* ranges of 100 to 5000 poise for said viscosity. In addition, documents (6) and (7) from the prosecution of the corresponding PCT application, namely the amended claims filed under Article 19 PCT and the accompanying letter dated 10 July 2013 filed with the International Bureau (6), and the letter dated 30 May 2003 from the instructing US attorney to the handling European attorney (7), showed that it was never intended to amend the upper value of the oil phase viscosity range from 5000 to 500 poise. Hence, compared to the other amendments carried out to the claims provided by the US instructing attorney to the handling European attorney, this particular one was not identified as such in the the US attorney's accompanying letter, but was rather a typographical error. The correction offered was obvious, since the broadest oil phase viscosity range in the patent specification was 100 to 5000 poise, and only one change was required to correct the value from 500 to 5000, whereas the other possibilities offered by the specification, namely 2000 and 3000, required two changes. Since the change from 500 to 5000 poise constituted a correction and not an amendment, the protection conferred by the patent had not been extended, such that Article 123(3) EPC was not violated.

The Appellant argued that the amendments made to claim 1 of each of auxiliary requests 2 and 3 did not lead to

an extension of the protection conferred by the patent as granted, since granted dependent claim 6 already encompassed a skin treatment composition comprising a structured oil phase having a viscosity of up to 2000 poise. Although there was a discrepancy between granted claims 1 and 6, the upper limit in dependent claim 6 being higher than in independent claim 1, this resulted merely in a lack of clarity, but did not put the validity of the upper limit of claim 6 into question.

VI. The Respondent submitted that it was not immediately evident that an error had occurred in claim 1 of the granted patent, since even when considering the description of the patent as granted, it was not evident whether the amendment of the upper limit of the oil phase viscosity range from 5000 to 500 poise was intended or a mistake, since the value of 500 poise made technical sense and some Examples, indeed even that Example having the best skin retention efficiency, namely Example 1B, had an oil viscosity falling within the granted range. With regard to the inconsistencies between granted claim 1 and granted claim 6 and paragraphs [0035] and [0043] of the patent specification, it was possible that the adaptation of the dependent claims and the description had been carried out incorrectly. In any case, it was not obvious that nothing else was intended other than what has been offered as the correction, since many other upper limits for the oil phase viscosity range were given in the patent specification, namely 150, 200, 2000 and 3000 poise. The Respondent argued that neither the application as originally filed, nor documents concerned with the prosecution of the PCT application, let alone internal letters available only to the Appellant and which were not previously available to the public, should be taken into account when

ascertaining under Rule 139 EPC whether an error had occurred or what the correction should be, since this jeopardised legal certainty. However, even when taking the application as filed into account, there were many reasons why an applicant might restrict the claims as originally filed, many of which might not be apparent to the public, such that a discrepancy between the granted claims and the claims as originally filed was not evidence that an error had been made. With regard to the documents concerned with the prosecution of the PCT application, the fact that the US attorney had in his accompanying letter listed the amendments that had been made to the claims, but failed to specifically refer to the amendment from 5000 to 500 poise in the clean copy of the claims to be filed, was also not unambiguous evidence that the amendment was not intended, as the attorney might simply have forgotten to refer to this particular amendment in his accompanying letter.

Since the change from 500 to 5000 poise thus constituted an amendment and not a correction, the protection conferred by the patent had been extended, contrary to Article 123(3) EPC. It would contravene the principles of legal certainty should the scope of protection now now be extended to include compositions having an oil phase with a viscosity of up to 5000 poise.

The Respondent argued that the amendments made to claim 1 of each of auxiliary requests 2 and 3 led to an extension of the protection conferred by the patent as granted, since granted claim 6 was dependent on independent claim 1 and thus implicitly contained all the features of said independent claim, including the

upper limit of the oil phase viscosity range of 500 poise.

The Respondent had no objections under Articles 123(2) or (3) EPC to auxiliary request 4.

VII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or any of auxiliary requests 1 to 4 filed with letter dated 9 May 2014, or alternatively, on the basis of either of auxiliary requests 5 and 6 filed with letter dated 31 August 2015.

The Respondent requested that the appeal be dismissed.

VIII. At the end of the oral proceedings, held on 8 October 2015, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments (Article 123(3) EPC)*

Main request and auxiliary request 1

3. Claim 1 of the main request and auxiliary request 1 each differs from claim 1 as granted in that *inter alia* the oil phase of the skin treatment composition is specified as having a viscosity of 100 to 5000 poise, instead of 100 to 500 poise.
 - 3.1 The Appellant submitted that this change to the upper limit of the oil viscosity range from 500 to 5000 poise

was allowable under Rule 139 EPC, since the value of 500 poise was an obvious error and it was immediately evident that nothing else was intended other than what had been offered as the correction, namely 5000 poise. Since such a correction had an *ab initio* effect, there was no violation of Article 123(3) EPC.

3.2 Rule 139 EPC (former Rule 88 EPC 1973) provides in its second sentence that a correction of an error in documents filed with the European Patent Office that concerns the description, claims or drawings can only be allowed if the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as correction. In point 5 of the reasons of decision G 3/89 (OJ EPO 1993, 117), the Enlarged Board of Appeal considered that, for a correction under Rule 88, second sentence EPC 1973, that concerns the disclosure of a European application or a European patent to be allowed, the respective parts of the disclosure for which a correction is requested must contain such an obvious error that a skilled person would be in **no doubt** that the information concerned could not be meant to be read as such (emphasis added). According to point 2 of the reasons of that decision, the skilled person must be in a position objectively and unambiguously to recognise the incorrect information using common general knowledge. If, on the other hand, it is doubtful whether that information is incorrectly defined, then a correction is ruled out.

3.3 In the present case, the skilled person, when reading claim 1 as granted at face value, would not have any reason to consider that the upper limit of 500 poise specified for the viscosity of the oil phase of the compositions defined therein was an error, since the

resulting viscosity range makes technical sense, the Appellant not arguing that said viscosity range was an unreasonable viscosity for skin treatment compositions. Thus, the skilled person would not have any reason to doubt the information provided in claim 1 as granted when taken at face value.

- 3.4 The Appellant argued that it was nevertheless evident that an error had occurred, in view of the discrepancy between granted claims 1 and 6, dependent claim 6 of the granted patent specifying an upper limit for the viscosity of the oil phase of 2000 poise, which was higher than the upper limit of 500 poise specified in claim 1 as granted. Furthermore, paragraphs [0035] and [0043] of the patent specification were also not in line with granted claim 1, since they disclosed *inter alia* ranges of 100 to 5000 poise for the viscosity of the oil phase.

The Board accepts that there are discrepancies between granted claim 1, dependent claim 6, and the description of the granted patent concerning the upper limit of the viscosity of the oil phase. However, these discrepancies would not lead the skilled person to be in **no doubt** that the upper limit of 500 poise specified in claim 1 was an error, since it is possible that dependent claim 6 and the description of the granted patent had simply not been correctly brought into conformity with the claims to be granted.

- 3.5 The Appellant also argued that according to decision T 200/89 (OJ EPO 1992, 46, point 3.4 of the reasons), when determining whether it was "immediately evident" to a skilled reader that the patent should be corrected in the way proposed, the skilled reader must be assumed to have read the entire contents of the patent

carefully. In the present case, the description of the granted patent tended to support viscosity ranges for the oil phase higher than that specified in granted claim 1, the best results for skin retention efficiency in Examples 1A to 1D being obtained for compositions having oil phases with viscosities of 380, 560 and 1800 poise, whereas the composition having an oil viscosity of only 0.15 poise resulted in very poor skin retention efficiency, such that the skilled reader would have assumed that the upper limit of 500 poise in granted claim 1 must have been in error.

However, in contrast to the case underlying decision T 200/89, not **all** oil phase viscosity values given in the Examples of the patent in suit fall outside the range specified in granted claim 1. On the contrary, the oil viscosity of Example 1B of 380 poise falls well within said range, the product of Example 1B in fact showing the best skin retention efficiency of all examples tested. In addition, the oil phase of Examples 8A to 8H is described as being between 200 and 2000 poise, the value of 200 poise also falling within the range specified in granted claim 1. Hence, the skilled reader, even having carefully read the entire contents of the patent specification, would not as a result conclude that the upper limit of 500 poise in the granted claim was erroneous.

- 3.6 The Appellant submitted that the application as filed was also not in line with granted claim 1, since *inter alia* claim 1 thereof disclosed a range of 100 to 5000 poise for the viscosity of the oil phase, a value of 500 poise not occurring anywhere in said application.

However, the Board considers that in the present case the application as filed cannot be used to show that

the value of 500 poise is an error, in particular it may not be used to show that certain amendments made during the examination procedure were "intended" and others were not. Thus said application does not suggest that the value of 500 poise makes no technical sense, and it is normal practice for an applicant to restrict its claims in the course of an examination procedure, there being many reasons therefor, such as the discovery that certain embodiments of the claimed invention could not be carried out, and/or were not novel and/or inventive over (cited) prior art, it not being necessary for the the applicant to give reasons for restricting the scope of its claims. Furthermore, it is not unusual when amending claims for applicants to include subject-matter not disclosed in the application as filed, otherwise there would be no need for Article 123(2) EPC. Hence, the mere fact that said value is not disclosed in the application as filed, cannot be decisive for proving that an error has occurred.

- 3.7 The Appellant also referred to documents (6) and (7) from the prosecution of the corresponding PCT application (see point V above), which showed that it was never intended to amend the upper value of the oil phase viscosity range from 5000 to 500 poise, but rather that this was a typographical error in the amended claims provided by the US instructing attorney to the handling European attorney. The Appellant submitted that according to decision T 200/89 (see Headnote IV), for the purpose of Rule 88 EPC 1973 (Rule 139 EPC 2000) whether an error was present in a document filed at the EPO was a subjective matter which might be established by reference to any relevant evidence including in that case, the file history. Hence, documents (6) and (7) were to be taken into

account when considering whether an error was present in granted claim 1.

In the present case, however, the Board does not hold that "any" relevant evidence may be taken into account to ascertain whether the value of 500 poise in granted claim 1 constitutes an error. As indicated in point 3.3 above, the skilled person has no reason to doubt this information when reading granted claim 1 at face value. Even when taking the description and dependent claims of the granted patent into account, the skilled person cannot be sure that the value of 500 poise is erroneous, or whether an error occurred in the description or said dependent claims (see points 3.4 and 3.5 above). The wording of Rule 139 EPC is that it must be "**immediately** evident that nothing else would have been intended than what is offered as correction" (emphasis added), the Board holding that if it is necessary to study the prosecution history of the case in order to determine whether an error had been made and what the correction should be, then this criterion of immediacy is not met. The Board also holds that for the sake of legal certainty, it cannot be considered reasonable that the public would have to study the prosecution history of the case in order to determine whether the applicant actually intended to make all the amendments it made to its claims, let alone that this legal certainty should be threatened by internal letters from the applicant, which were not available to the public, and came to light only after the grant of the patent.

3.8 The Board thus concludes that the skilled reader would not have unambiguously recognised the alleged false information, such that it is superfluous to determine

whether nothing else would have been intended than what has been offered as "correction".

3.9 Consequently, the request for correction under Rule 139 EPC is rejected and the range of 100 to 500 poise specified in claim 1 as granted for the viscosity of the structured oil phase is read by the skilled person as such and not as 100 to 5000 poise.

3.10 Both parties agreed that if the change to the upper limit of the oil phase viscosity range in claim 1 from 500 to 5000 did not satisfy the requirements for correction of an error according to Rule 139 EPC, then Article 123(3) EPC would be violated.

3.11 Thus, the Board concludes that the scope of protection conferred by claim 1 has been broadened *vis-à-vis* that of the claims as granted, such that the main request and, by the same token, auxiliary request 1, do not satisfy the requirements of Article 123(3) EPC.

Auxiliary requests 2 and 3

4. Claim 1 of each of auxiliary requests 2 and 3 differs from claim 1 as granted in that the viscosity of the oil phase is specified as 100 to 2000 poise, and 200 to 2000 poise, respectively, rather than 100 to 500 poise.

4.1 The Appellant submitted that said claim did not extend the scope of protection conferred by the claims as granted, since claim 6 as granted disclosed an upper limit of 2000 poise of the oil phase viscosity range, such that the scope of claim 1 of auxiliary requests 2 and 3 was not broader than that of the granted claims as a whole.

4.2 However, claim 6 as granted is dependent on *inter alia* claim 1, since it is worded as "A composition according to any of the preceding claims..." (see point I above), claims 2 to 5 also all being dependent on *inter alia* claim 1. Hence, claim 6 must be construed to incorporate all the limitations of claim 1, including the upper limit of the oil phase viscosity range of 500 poise. Thus, the scope of protection afforded by granted dependent claim 6 cannot be greater than that provided by granted claim 1.

4.3 Since the upper limit of both the oil phase viscosity ranges in claim 1 of each of these requests is higher than that in granted claim 1, namely 2000 instead of 500 poise, the scope of protection conferred by claim 1 of each of auxiliary requests 2 and 3 has been broadened *vis-à-vis* that of the claims as granted, such that the the requirements of Article 123(3) EPC are not satisfied.

Auxiliary request 4

5. Claim 1 of auxiliary request 4 differs from claim 1 as granted in that the viscosity of the oil phase is specified as 100 to 200 poise.

5.1 Basis for the upper limit of 200 poise may be found at page 11, line 20 of the application as filed, such that the requirements of Article 123(2) EPC are satisfied.

5.2 This range falls within the viscosity range specified in claim 1 as granted, namely of 100 to 500 poise, such that the scope of protection conferred by claim 1 of this request is narrower than that of the granted patent.

5.3 Thus, the requirement of Article 123(3) EPC is satisfied, the Respondent also having no objections under this article to the claims of this request.

6. *Remittal*

Having so decided, the Board has not taken a decision on the whole matter, since the decision under appeal dealt exclusively with an amendment which contravened the provisions of Article 123(3) EPC, which objection is no longer pertinent due to the amendments made. As the Opposition Division has not yet ruled on the other grounds for opposition, namely Articles 100(a) and (b) EPC, the Board considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on the basis of the claims according to auxiliary request 4 in order to enable the first instance to decide on the outstanding issues.

Auxiliary requests 5 and 6

7. Since the auxiliary request 4 is remitted to the first instance for the reasons set out above, there is no need for the Board to decide on the lower ranking auxiliary requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of auxiliary request 4 filed with letter dated 9 May 2014.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated