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**Datasheet for the decision  
of 20 October 2020**

**Case Number:** T 1218/19 - 3.3.10

**Application Number:** 13708808.4

**Publication Number:** 2833976

**IPC:** A61Q19/02, A61K8/36, A61K8/49,  
A61K8/97

**Language of the proceedings:** EN

**Title of invention:**  
A PERSONAL CARE COMPOSITION

**Applicant:**  
Unilever N.V.  
Unilever PLC

**Headword:**

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

**Keyword:**

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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**Case Number: T 1218/19 - 3.3.10**

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.10**  
**of 20 October 2020**

**Appellant:** Unilever N.V.  
(Applicant 1) Weena 455  
3013 AL Rotterdam (NL)

**Appellant:** Unilever PLC  
(Applicant 2) Unilever House  
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**Representative:** James, Helen Sarah  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 23 November  
2018 refusing European patent application No.  
13708808.4 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** P. Gryczka  
**Members:** J.-C. Schmid  
F. Blumer

## Summary of Facts and Submissions

I. The appeal lies from the decision of the Examining Division refusing European patent application No. 13 708 804.4 on the basis of claim 1 filed on 15 June 2017, which reads as follows:

"1. A personal care composition comprising  
(a) 0.01 to 10% by weight of an extract of a plant source which comprises higher than 15% butrin by weight of the extract wherein said extract comprises less than 2% isobutein and less than 2% butein by weight of the extract; and  
(b) a cosmetically acceptable base selected from an emulsion, lotion, cream, foam, gel, soap bar, stick, mask, pad or patch;  
wherein said plant source is *Butea monosperma*; and  
wherein the personal care composition is selected from leave-on skin lotions and creams, shampoos, conditioners, shower gels, toilet bars, antiperspirants, deodorants, depilatories, lipsticks, foundations, mascara, sunless tanners and sunscreen lotions."

II. In communications dated 16 March 2018, 31 August 2017 and 21 February 2017 the examining division indicated that claim 1 of the then pending requests did not meet the requirements of 123(2) EPC. According to the examining division, claim 1 recited that the extract of the plant source *Butea monosperma* which comprised higher than 15% butrin by weight of the extract and less than 2% isobutein and less than 2% butein by weight of the extract can be present up to 10% by weight of the composition. For this subject-matter, a

basis was found in the application as filed. However, it was also possible that the composition additionally included extract(s) of the plant source *Butea monosperma* which comprised more than than 15% butrin by weight of the extract and more than 2% isobutein and/or more than 2% butein, said further extract(s) not being limited by a concentration range. It resulted thus that the subject-matter of pending claim 1 encompassed now situations for which the composition could comprise a total amount of plant extracts with an amount of butrin higher than 15% which was greater than the original concentration limit of 10% by weight. For these situations, no basis could be found in the application as filed, and such subject-matter led to a scope of protection which was broader than that of the application as filed. Restricting the breadth of the component meant that certain materials were no longer limited by the claim, and therefore could be present in amounts which were excluded from the claim as originally filed.

Consequently, the subject-matter of independent claim 1 contained subject-matter which extended beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

With a letter dated 2 November 2018 the Appellant requested a decision according to the state of the file. The application was therefore refused.

III. According to the appellant, an applicant had the right to amend claims so as to direct them to subject-matter not encompassed by the claims as filed. It is only after grant that the interests of third parties are further protected by Article 123(3) EPC and the patentee's right to amend the claims is limited by the

scope of the granted patent. It was thus possible to broaden the claim without contravening Article 123(2) EPC provided that the claimed subject-matter was disclosed within the content of the original application as filed.

- IV. The Appellant requested that the decision of the Examining Division be set aside and that the application be remitted to the examining division for further prosecution

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Amendments*
  - 2.1 Claim 1 of the sole request (main request) was filed before the examining division on 15 June 2017. It is based on the combination of originally filed claims 1, 3, 4 and 5. Furthermore the personal care composition is specified to be a leave-on skin lotion or cream, shampoo, conditioner, shower gel, toilet bar, antiperspirant, deodorant, depilatory, lipstick, foundation, mascara, sunless tanner or sunscreen lotion according to page 4, lines 27 to 30 of the application as filed. This was acknowledged by the examining division in its communication dated 16 March 2018, point 4.
  - 2.2 The examining Division submitted however that the scope of claim 1 of the main request was broadened by the limitation of the extract of a plant source to the extract of *Butea monosperma*, since the personal care composition was defined by "comprising" and thus included any amount of extracts of plants, other than *Butea monosperma*, with a butrin content higher than 15

wt.%, thus exceeding the threshold of 10 wt.% of plant extracts with a butrin content higher than 15 wt.% required by the application as filed. No basis could be found in the application as filed for these compositions now covered by claim 1. Claim 1 thus contravened the requirements of Article 123(2) EPC.

2.3 As a preliminary remark, the Board notes that the scope of originally filed claim 1 has not been broadened by specifying that the plant source for component (a) is *Butea monosperma*.

The personal care composition of originally filed claim 1 is also defined as a composition **comprising** component (a). Component (a) consists of 0.01 to 10 wt.% of an extract of a plant source which comprises higher than 15% butrin by weight of the extract.

Accordingly, the compositions covered by original claim 1 may include any amount of extracts from a plant source, the threshold of 10% by weight in the composition applying only to plant extracts comprising more than 15% by weight of butrin. However, it cannot be determined in the personal care composition whether the composition includes some plant extracts containing more than 15 % by weight of butrin and others less than 15 % by weight. Furthermore, the requirements with respect to the content of butrin in the personal care composition are the same in claim 1 of the main request and in claim 1 as originally filed.

Accordingly, the scope of claim 1 as originally filed has not been broadened by specifying that the plant source for component (a) is *Butea monosperma*.

2.4 Notwithstanding this finding, the issue covered by Article 123(2) EPC is whether the amendment results in subject-matter which extends beyond the content of the application as filed and not whether the scope of the claims has been shifted by the amendment, which issue is covered by Article 123(3) EPC.

The examining division recognised that the subject-matter as specified in claim 1 was disclosed in the application as filed. The Board shares this view (see point 2.1 above). Hence, the subject-matter of claim 1 does not contain subject-matter which extends beyond the content of the application as filed. Claim 1 of the main request therefore satisfies the requirements of Article 123(2) EPC.

3. *Remittal*

Proceedings before the Boards of Appeal are primarily concerned with examining the contested decision. The decision under appeal was solely based on the failure of claim 1 to comply with the requirements of 123(2) EPC. The examining division has, however, not yet ruled on the other requirements of patentability.

Therefore, the Board considers it appropriate to remit the case to the examining division for further prosecution.

**Order**

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

1. The appeal under appeal is set aside.



2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated