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**Datasheet for the decision
of 20 September 2022**

Case Number: T 0017/22 - 3.3.07

Application Number: 18750027.7

Publication Number: 3672561

IPC: A61K8/22, A61K8/34, A61K8/81,
A61Q11/02

Language of the proceedings: EN

Title of invention:
ORAL CARE COMPOSITION

Applicant:
Colgate-Palmolive Company

Headword:
Oral care composition / COLGATE-PALMOLIVE

Relevant legal provisions:
EPC Art. 94(3), 113(1)
EPC R. 71(1), 161(1), 137(4), 103(1)(a)
RPBA 2020 Art. 11

Keyword:
Substantial procedural violation - opportunity to comment (no)
- reimbursement of appeal fee (yes)

Decisions cited:

T 0305/14, T 0246/08

Catchword:

see point 1.2.2 of the reasons



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Case Number: T 0017/22 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 20 September 2022

Appellant: Colgate-Palmolive Company
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Representative: Wibbelmann, Jobst
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 17 August 2021
refusing European patent application No.
18750027.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman A. Uselli
Members: E. Duval
Y. Podbielski

Summary of Facts and Submissions

I. The appeal was filed by the applicant (appellant) against the decision of the examining division to refuse the European patent application 18750027.7 (hereinafter "the application"), filed under the PCT as PCT/US2018/042697.

The decision was based on a single request with claims filed on 29 October 2020.

II. In the PCT phase, the EPO acting as International Search Authority (ISA) had issued a written opinion raising objections of lack of novelty, lack of inventive step and lack of clarity.

During the European phase, the examining division issued two communications before deciding to refuse the application:

- the first was a communication under Rules 161(1) and 162 EPC, inviting the applicant to correct any deficiencies noted in the written opinion, and
- the second was a communication under Rule 137(4) EPC headed "Invitation pursuant to Rule 137(4) and Article 94(3) EPC", accompanied by an annex raising an objection under Article 123(2) EPC and the statement: "nota bene: The amendment appears also not suitable to remedy the deficiencies"

The examining division then issued the decision to refuse the application. Oral proceedings were neither requested by the appellant nor arranged by the examining division. The decision was based on the ground under Article 123(2) EPC and on lack of novelty, lack of inventive step and lack of clarity.

III. In the statement setting out the grounds of appeal, the appellant contended among others that the examining division had committed a substantial procedural violation justifying a reimbursement of the appeal fee under Rule 103 EPC.

According to the appellant, in the proceedings before the examining division, the appellant never had the opportunity to address the objections as expressed in the appealed decision. Moreover, with the invitation pursuant to Rule 137(4) EPC dated 15 March 2021, the appellant had only been alerted that certain amendments had not been sufficiently identified and/or their basis in the application as filed has not been sufficiently indicated. The subsequent decision to refuse the European patent application without any further ado had come completely to the surprise of the appellant. Thus, the appellant's right to be heard under Article 113(1) EPC had been violated.

IV. The appellant requested that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution. The appellant further requested that the appeal fee be reimbursed.

Reasons for the Decision

1. Substantial procedural violation

1.1 According to Article 94(3) EPC, if the examination reveals that the application or the invention to which it relates does not meet the requirements of the EPC, the examining division shall invite the applicant, as often as necessary, to file his observations and,

subject to Article 123(1) EPC, to amend the application.

While the expression "as often as necessary" indicates that the examining division has discretion whether to issue more than one communication, at least one substantive communication pursuant to Article 94(3) EPC and Rule 71(1) EPC is required before a decision to refuse the application on such substantive grounds is issued (unless the examining division exceptionally decides to issue a summons to oral proceedings as the first action in examination, see the Guidelines C-III, 5 - March 2022 version). Indeed, only if a preceding communication pursuant to Article 94(3) EPC sets out the essential legal and factual reasoning to support a finding that a requirement of the EPC has not been met, can a decision based on such a finding be issued without contravening Article 113(1) EPC (see T 305/14, point 2.3 of the reasons).

1.2 In the case before the Board, the examining division issued two communications before issuing the decision to refuse the application. One was a communication under Rules 161(1) and 162 EPC. The other one was a communication under Rule 137(4) EPC headed "Invitation pursuant to Rule 137(4) EPC and Article 94(3) EPC". For the reasons set out further below, neither of them amounts to a substantive communication under Article 94(3) EPC. The omission of such a communication under Article 94(3) EPC is a substantial procedural violation as it deprived the applicant of the opportunity to react to such a communication.

1.2.1 Rule 161(1) EPC concerns the reply to the search report. Under Rule 161(1) EPC, the EPO invites the applicant to correct any deficiencies noted in the

written opinion established by the EPO acting as ISA under the PCT within a period of six months. This early stage is characterised by the fact that it is still possible for an applicant to make amendments of its own volition (Rule 137(2) EPC). Rule 137(2) EPC explicitly mentions the response to a Rule 161(1) EPC communication as the appropriate time for such an amendment.

In the context of the overall examination proceedings, an amendment by the applicant's own volition needs to precede the stage of examination. Thus, a reply to the search opinion and any amendments made by the applicant of its own volition should be on file when the substantive examination starts (see also the Case Law of the Boards of Appeal, 10th edition, 2022, IV.B.1.1). Pursuant to Rule 137(3) EPC, no further amendment may be made without the consent of the Examining Division.

A communication under Rules 161(1) and 162 EPC thus cannot be considered a communication under Article 94(3) EPC, or a communication which would obviate the need for a communication pursuant to Article 94(3) EPC. This is furthermore confirmed by the Guidelines for Examination in the EPO which state that an application may not be refused directly after the reply to a communication under Rule 161(1) EPC (Guidelines C-V, 14).

- 1.2.2 The "Invitation pursuant to Rule 137(4) EPC and Article 94(3) EPC" can also not be considered a substantive communication under Article 94(3) EPC.

A communication under Article 94(3) and Rule 71(1) EPC is a substantive communication, taking into account any reply to the Rule 161(1) EPC communication. The

communication is to give reasons for any objections raised and is to invite the applicant within a specified period to file their observations or submit amendments (Guidelines C-III, 4). Following Rules 71(1) and 132(2) EPC, any period for reply by the applicant must not be shorter than 2 months (see also T 246/08, point 4 of the reasons). The practice is to set a period for reply of four months for communications raising matters of substance (Guidelines E-VIII, 1.2).

The communication under Rule 137(4) EPC, with a period for reply of one month, is, by contrast, of a formal nature. The applicant is merely asked to identify the amendments and to indicate the basis for them in the application as filed, independently of whether these amendments comply with Article 123(2) EPC (Guidelines, H-III, 2.1). The short period of one month specified in Rule 137(4) EPC for a reply is inappropriate for a reply to substantive issues.

In the case before the Board, the examining division raised an objection under Article 123(2) EPC in the annex to the communication under Rule 137(4) EPC, and added "nota bene: The amendment appears also not suitable to remedy the deficiencies". This, however, does not turn this Rule 137(4) EPC communication into a substantive communication under Article 94(3) and Rule 71(1) EPC, especially as the period for a reply is still only one month. The mere reference to Article 94(3) EPC in the heading of the communication does affect this conclusion.

Thus, the examining division failed to issue a substantive communication pursuant to Article 94(3) EPC and Rule 71(1) EPC setting out the grounds for the later refusal, with an appropriate time limit.

1.3 For all these reasons the applicant could have expected a communication under Article 94(3) EPC before the decision was issued. This would have given him the opportunity to respond to the objections made. As it stands, he was not only taken by surprise by the refusal decision, but he also had no opportunity to respond to any of the reasoning in that decision within a correct time limit.

2. Remittal and reimbursement of the appeal fee

Considering the substantial procedural violation identified above, a reimbursement of the appeal fee under Rule 103(1)(a) EPC is equitable.

Furthermore, this substantial procedural violation constitute special reasons for remitting the case to the examining division in the sense of Article 11 RPBA 2020.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

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

The appeal fee is reimbursed.

The Registrar:

The Chairman:



B. Atienza Vivancos

A. Uselli

Decision electronically authenticated



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Case Number: T 0017/22 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 23 September 2022
correcting an error in the decision
of 20 September 2022

Appellant: Colgate-Palmolive Company
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 17 August 2021
refusing European patent application No.
18750027.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: A. Usuelli
Members: E. Duval
Y. Podbielski

In application of Rule 140 EPC, the last sentence in the fourth paragraph of point 1.2.2, page 5 of the decision given on 20 September 2022, is hereby corrected as follows (emphasis added only to indicate the correction):

"The mere reference to Article 94(3) EPC in the heading of the communication does not affect this conclusion."

The Registrar:

The Chairman:



B. Atienza Vivancos

A. Uselli

Decision electronically authenticated