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File No.: T 0817/90 - 3.3.2
Application No.: 86 300 309.1
Publication No.: 0 190 834
Classification: A61K 7/09
Title of invention: Improved hair waving and straightening compositions of matter

D E C I S I O N
of 12 November 1993

Applicant: Chesebrough-Pond's Inc.
Proprietor of the patent: -
Opponent: -

Headword: Hair waving/CHESEBROUGH-POND'S

EPC: Art. 123(2)
R. 88, 35(12)

Keyword: "Correction of inadequate terminology (yes)" - "Use of metric SI units"

Headnote
Catchwords



Case Number: T 0817/90 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 12 November 1993

Appellant:

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Representative:

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Decision under appeal:

**Decision of the Examining Division of the European
Patent Office dated 12 June 1990 refusing European
patent application No. 86 300 309.1 pursuant to
Article 97(1) EPC.**

Composition of the Board:

Chairman: P.A.M. Lançon
Members: L. Galligani
S.C. Perryman

Summary of Facts and Submissions

- I. European patent application No. 86 300 309.1 published under No. 190 834 was refused by the Examining Division on 12 June 1990.

The decision was taken on the basis of an amendment to the application put forward by the Applicant with the letter dated 15 March 1990, the said amendment being the change of the unit of expression of conductivity from "micromhos" to "micromhos per centimetre".

- II. The Examining Division refused the application under Article 97(1) EPC because it considered that the expression in amended Claim 1 of the conductivity values in $\text{ohm}^{-1}\text{cm}^{-1}$ while clear, constituted an extension of the subject-matter of the application beyond the content as filed (Art. 123(2) EPC) because the specification as originally filed disclosed only a conductivity stated in mho (usual US usage for ohm^{-1}) and not mho cm^{-1} , and did not mention any specific measuring instrument as having been used.
- III. The Appellant lodged an appeal against this decision and paid the appeal fee.

The Appellant contended that, in US usage at least, the conductivity of a liquid was commonly quoted in "mhos", i.e. ohms^{-1} . Conductivity measurements were ordinarily carried out with standard conductivity meters which provided a reading in $\text{ohm}^{-1}\text{cm}^{-1}$. "Mhos" was the "abbreviation" commonly used by working scientists in reporting their measurements (see, for example, "Hackh's Chemical Dictionary", IV Edition, 1972, Julius Grant ed., McGraw-Hill Book Co., New York, page 233 as well as the "Operating Instructions for Model 1052 digital

conductivity meter", MARKSON). To a skilled addressee, the specification had always been clear and sufficient, although it could have been presented in more formally correct terms. The purpose of the proposed amendment was merely to render explicit what had always been implicit.

- IV. In reply to a communication from the Board the Appellant filed by letter dated 8 October 1993 (received on 11 October 1993) amended Claims 1 to 7 and amended description pages 2, 4 and 7.

Claim 1 of the amended set reads as follows:

"A hair waving or straightening composition of matter comprising a sulfite and/or bisulfite reducing system, urea in an amount of at least 10 percent by weight, a cationic polyquaternary having a conductivity, when measured at 0.1% by weight concentration, from 225 to 25 μ S/cm (from 225 to 25 micromhos/cm), in an amount of at least 0.07% by weight, said composition having a pH in the range of 5.5 to 8.5."

- V. The Appellant requests the setting aside of the decision of the Examining Division and the remittal thereto of the amended application for further prosecution.

Reasons for the Decision

1. The appeal is admissible.
2. *Formal allowability of the amended claims (Art. 123(2) EPC)*

There are no objections under Article 123(2) EPC to the amended application documents as the corrections which have been introduced therein under Rule 88 EPC (see item 3 below) do not result in an extension of the application beyond its original content.

3. *Correction of errors (Rule 88 EPC)*

The Board considers that the proposal by the Appellant to change the expression of the unit of conductivity from "micromhos" to "micromhos per centimetre" in the application amounts to a request for a correction under Rule 88 EPC. In fact, it is self-evident that, from a formal point of view, the "conductivity" of a solution is only correctly expressed when the unit of distance is indicated. The unit of distance was omitted in the original application documents.

According to decision G 11/91 of the Enlarged Board of Appeal (OJ EPO 1993, 125), which is concerned with question of the correction of errors, "the skilled person must thus be in a position objectively and unambiguously to recognise the incorrect information using common general knowledge". The said decision states also that "evidence of what was common general knowledge on the date of filing may be furnished in connection with an admissible request for correction in any suitable form".

Therefore, the question at issue in the present case is whether such correction can be allowed under the provisions of Rule 88 EPC. According to this Rule, second sentence, "the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction".

3.1 The terms "conductance" and "conductivity" are used, when referring to electrolytic solutions, as an indicator of their property of transmitting an electric current.

The SI unit of "conductance" is the Siemens (S) which is the equivalent of ohm^{-1} or mho in the CGS system.

"Conductivity" is commonly expressed in the art either in terms of Siemens/m or in terms of Siemens/cm (see, for example, "Quantities, Units and Symbols in Physical Chemistry", IUPAC, 1988, prepared by I.Mills et al., Blackwell Scientific Publications, Oxford, pages 66-67; "A New Dictionary of Physics", H.J.Gray and A.Isaacs eds., 1975, Longman, pages 107-108; "Römpps Chemie-Lexikon" O-A. Neumüller, 8th Edition, 1981, Franckh'sche Verlagshandlung, Stuttgart, page 1085). However, the conductivity of electrolyte solutions is usually expressed in terms of Siemens/cm ($\text{ohms}^{-1}/\text{cm}$) or, in the American and British usage, but not exclusively, in terms of mhos/cm (see "Hackh's Chemical Dictionary", *loc.cit.*, and "Dictionnaire de la Chimie et de ses Applications", 3rd Edition, C.Duval and R.Duval, 1978, Technique et Documentation, Paris, pages 283, 704 and 771). Standard conductivity meters are, in fact, constructed and calibrated so as to provide readings in $\text{ohm}^{-1}/\text{cm}$ or mhos/cm.

As pointed out by the Appellant, in the American/British usage scientists commonly report conductivity measurements in "mhos" and omit the unit of distance (see, for example, the "Operating Instructions for Model 1052 digital conductivity meter", MARKSON submitted by the Appellant as enclosure to the letter dated 10 January 1990). This practice of scientists of using "abbreviations" is in fact at the origin of the imprecise terminology used in the present case.

At any rate it is observed that the conductivity values reported in the present application are compatible with "standard" measurements. Thus, in spite of the fact that no indications are given with respect to the instrument which has been used, it is plausible that a "standard" conductivity meter was used wherein the electrodes were 1 cm apart.

In the Board's opinion, the requirements quoted above (see item 3) for admitting a correction under Rule 88 EPC are fully met in the present case. In fact, the skilled person, who is normally aware of the different ways of expressing units of measurement, when reading the original application documents, would immediately recognise the incorrect terminology used therein. He/she would, therefore, read the expression "micromhos" in connection with the reported conductivity values as meaning implicitly "micromhos per centimetre" and nothing else.

Therefore, the change in the application documents from "micromhos" to "micromhos/cm" is regarded as an allowable correction under Rule 88 EPC.

4. Rule 35(12) EPC

Rule 35(12) EPC requires *inter alia* the use of units recognised in international practice in the expression of physical values. Since, as already stated above, the expression of conductivity in terms of "mhos/cm" is recognised in international practice, the Appellant, in line with the suggestion by the Board, has chosen to express the conductivity in terms of the SI unit "Siemens" (S) (here: μS) and to proceed as suggested also in the Guidelines for Examination, Part C, Chapter II, 4.15 by putting in parenthesis the expression "micromhos/cm".

For the same reasons the temperature value on page 7, line 28 of the description has been expressed also in degrees Celsius.

There are no objections to said amendments.

5. For the above reasons, the amended application documents are considered to be formally acceptable under the quoted provisions of the EPC.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of the following application documents:

Description: Pages: 1, 3, 5 to 6, 8 to 16 as originally filed;

Pages: 2, 4, 7 received on 11 October 1993 with letter of 8 October 1993.


Claims: 1 to 7 received on 11 October 1993 with letter dated 8 October 1993;
8 to 11 as originally filed.

The Registrar:



P. Martorana

The Chairman:



P.A.M. Lançon

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I.C.P.