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**Datasheet for the decision
of 4 November 2008**

Case Number: T 0020/05 - 3.3.10

Application Number: 00965204.1

Publication Number: 1216020

IPC: A61K 7/48

Language of the proceedings: EN

Title of invention:

Article having a transferable breathable skin care composition thereon

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponent:

-

Headword:

Article for applying a skin care composition/PROCTER & GAMBLE

Relevant legal provisions:

EPC Art. 54, 84, 111(1)

EPC R. 111(2)

Relevant legal provisions (EPC 1973):

EPC R. 68(2)

Keyword:

"Article 84 - decision not reasoned"

"Article 54 - not founded"

"Remittal to first Instance"

Decisions cited:

G 0010/93, T 0278/00

Catchword:

-



Case Number: T 0020/05 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 4 November 2008

Appellant: THE PROCTER & GAMBLE COMPANY
One Procter & Gamble Plaza
Cincinnati, Ohio 45202 (US)

Representative: McGregor, Judit Ester
Procter & Gamble Service GmbH
D-65823 Schwalbach am Taunus (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 16 July 2004
refusing European application No. 00965204.1
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: R. Freimuth
Members: C. Komenda
F. Blumer

Summary of Facts and Submissions

I. The appeal lodged on 13 August 2004 lies from the decision of the Examining Division posted on 16 July 2004 refusing European patent application No. 00 965 204.1 published under the International publication No. WO 01/22933.

II. The decision under appeal was based on the set of claims 1 to 10 according to the then pending request, claim 1 of this request read as follows:

"1. An article for applying a skin care composition to the skin, said article comprising a delivery vehicle and a skin care composition disposed on at least a portion of said delivery vehicle, wherein said skin care composition has:

- (a) a semi-solid or solid consistency at 20°C;
- (b) a Water Vapor Permeation Rate of at least 0.1 gm/m²/hr, preferably at least 1 gm/m²/hr, more preferably at least 10 gm/m²/hr; and
- (c) a Hunter b value in the Methylene Blue Dye Barrier Property Test ranging from 5 to -25, preferably from 5 to -15, more preferably from 5 to -5."

III. In the decision under appeal the Examining Division held that the subject-matter of the claims did not fulfil the requirements of Articles 84 and 54 EPC. Reference was made to documents

- (1) US-A-5 635 191 and
- (2) US-A-5 609 587.

The decision under appeal held in its paragraph 2.1 that

"[...] independent claim 1 attempts to define the claimed subject-matter by way of a combination of results to be achieved, namely certain target values for two parameters called "Water Vapor Permeation Rate" and "Hunter b value in the Methylene Blue Dye Barrier Property Test". In the absence of technical features on how these results should be achieved, this leads to lack of clarity in the sense of Article 84 EPC (Guidelines C.III § 4.7 and 4.7a)".

Further, these parameters were not regarded as to clearly distinguish the subject-matter claimed over the prior art and, thus, were disregarded in the assessment of novelty. It was stated that documents (1) and (2) disclosed diapers having a solid or semi-solid skin care lotion applied to the outer surface of the topsheet, which skin care lotions comprised the same emollients, permeability agents and immobilising agents as those used in the application in suit. Thus, the decision held that the subject-matter of claims 1 to 5, 7 and 9 was anticipated by either of documents (1) or (2).

IV. With his Statement of the Grounds for Appeal dated 10 November 2004 the Appellant submitted that the Water Vapour Permeation Rate and the Hunter b value as claimed in features (b) and (c) were technical parameters, which were well known to the skilled person. Further, the methods for determining the Water Vapour Permeation Rate and the Hunter b value were clearly described in the description. As the application

further exemplified preferred skin care compositions having the required Water Vapour Permeation Rate and Hunter b value, the Appellant submitted that the requirement of clarity according to Article 84 EPC was fulfilled. With regard to novelty the Appellant submitted that neither of documents (1) or (2) disclosed directly and unambiguously the Water Vapour Permeation Rate or a Hunter b value. Therefore, the subject-matter of the application in suit was novel over the prior art. Further, he submitted auxiliary requests 1 to 4.

- V. With a fax dated 03 September 2008 the Appellant informed the Board that he would not attend the oral proceedings.

- VI. The Appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the claims underlying the decision under appeal (Main Request), or, subsidiarily, that either a patent be granted or the case be remitted to the Examining Division for further examination on the basis of the First, Second, Third or Fourth Auxiliary Request filed with the letter dated 10 November 2004.

- VII. At the end of the oral proceedings, which were held on 04 November 2008 in the absence of the Appellant (see paragraph V.), the decision of the Board was announced.

Reasons for the Decision

- 1. The appeal is admissible.

2. *Scope of examination on appeal*

2.1 While Article 111(1) EPC gives the Boards of Appeal the power to raise new grounds in ex-parte proceedings where the application has been refused on other grounds, proceedings before the Boards of Appeal in ex-parte cases are primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons), other objections normally being left to the Examining Division to consider after a referral back, so that the appellant has the opportunity for these to be considered without loss of an instance.

2.2 In the present case the Board, thus restricts itself to considering whether the contested decision was right in finding that the subject-matter of the application in suit did not meet the requirements of Articles 84 and 54 EPC, which were the grounds for refusing the application.

3. *Article 84 EPC*

3.1 The decision under appeal held that the subject-matter of claims 1 to 10 did not fulfil the requirement of clarity as stipulated in Article 84 EPC, since the parameters "Water Vapor Permeation Rate" and "Hunter b value in the Methylene Blue Dye Barrier Property Test" were an attempt to define the claimed subject-matter by way of the result to be achieved, i.e. certain target values for these parameters. It was further stated that the absence of technical features on how these results

should be achieved led to lack of clarity in the sense of Article 84 EPC.

- 3.2 Decisions of the EPO open to appeal should be reasoned (Rule 68(2) EPC 1973, insofar identical to Rule 111(2) EPC 2000). It is established jurisprudence of the Boards of Appeal that this provision requires the decision to contain, in logical sequence, those arguments which justify the decision. Moreover, the conclusions drawn from the facts and evidence must be made clear. Therefore all the facts, evidence and arguments which are essential to the decision must be discussed in detail in the decision including all the decisive considerations in respect of the factual and legal aspects of the case (T 278/00, OJ EPO 2003, 546, points 2 to 5 of Reasons).

The purpose of the requirement to provide a reasoned decision is of course to enable the party or parties and, in case of an appeal, also the Board of Appeal to examine whether the decision could be considered to be justified or not. Thus, when deciding upon clarity of a claim, as in the present case, the decision should identify the feature(s), which were deemed to be unclear and provide a reasoning indicating and discussing all the facts, evidence and arguments essential for concluding why these features do not fulfil the requirement of clarity.

- 3.3 In the present case, the decision under appeal merely stated (see point III, *supra*) that claim 1 attempted to define the claimed subject-matter by way of a combination of results to be achieved, and concluded

that in the absence of technical features on how these results should be achieved, there was a lack of clarity.

This mere statement, however, directly results in a conclusion that could only have been drawn from a detailed discussion reflecting the decisive considerations supporting this conclusion, what is completely missing in the present decision under appeal.

- 3.4 Therefore, the Board concludes that the ground for refusal according to Article 84 EPC is not sufficiently reasoned in the sense of Rule 68(2) EPC 1973 (Rule 111(2) EPC 2000). This insufficient reasoning amounts to a procedural violation. The decision under appeal, however, was not only based on the ground of lack of clarity, but also on lack of novelty according to Article 54 EPC. The latter ground for the decision has been substantiated and is valid and would have led to the same result, namely the refusal of the application in suit, even if it were the only ground for that decision. Therefore, there is no causal link between the insufficient reasoning in the decision under appeal with respect to the lack of clarity and the necessity to file an appeal with the consequence that the Appellant in any case would have had to file an appeal in view of the ground for lack of novelty pursuant to Article 54 EPC.

4. *Article 54 EPC*

- 4.1 Claim 1 of the present request is directed to an article comprising a skin care composition disposed on at least a part of the surface thereof. The skin care

composition is solid or semi-solid at room temperature and is further characterised by a specific Water Vapor Permeation Rate and a specific a Hunter b value (see paragraph II, *supra*).

- 4.2 Documents (1) and (2), which were cited in the decision under appeal as anticipating the subject-matter of at least independent claim 1, disclose absorbent articles having a semi-solid skin care lotion coated onto at least a part of the surface of the article. However, none of these documents discloses the Water Vapor Permeation Rate and the Hunter b value as claimed in the application in suit.

In the assessment of novelty the decision under appeal simply disregarded the parameters relating to the Water Vapor Permeation Rate and to the Hunter b value, because they were regarded as being unclear. However, the mere statement that these parameters were unclear (see point 3 *supra*) is no proper justification for disregarding these parameters. According to the Examples of the application in suit these parameters appear not to be the inevitable result of simply mixing the individual ingredients of the claimed skin care compositions. Being well-known in the art the parameters relating to the Water Vapor Permeation Rate and to the Hunter b value apparently represent technical features defining the claimed subject-matter, which parameters, thus, could not be just disregarded in the assessment of novelty.

- 4.3 Consequently, the Board concludes that the argumentation in view of novelty of the decision under

appeal is unfounded with the consequence that the appeal is justified.

5. *Remittal*

Having so decided, the Board has not taken a decision on the substantive matter since the decision under appeal was solely based on lack of clarity and on a novelty objection vis-à-vis documents (1) and (2) which objections are held to be either insufficiently reasoned or unfounded. As the Examining Division has not yet ruled on all the requirements for granting a European patent the Board considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit the case to the Examining Division for further prosecution on the basis of claims 1 to 10 of the pending main request, in order to enable the first instance to decide on the outstanding issues.

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 the Main Request.

The Registrar

The Chairman

C. Rodríguez Rodríguez

R. Freimuth