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Aktenzeichen / Case Number / N^o du recours : T 88/87 - 3.2.2

Anmeldenummer / Filing No / N^o de la demande : 83 304 223.7

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 100 204

Bezeichnung der Erfindung: Applicator for creams and viscous liquids
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : A45D 34/04

ENTSCHEIDUNG / DECISION

vom / of / du 18 April 1989

Anmelder / Applicant / Demandeur : THE MENNEN COMPANY

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 56 EPC.

Schlagwort / Keyword / Mot clé : Inventive step (affirmed)

Leitsatz / Headnote / Sommaire

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Boards of Appeal

Chambres de recours

Case Number : T 88/87 - 3.2.2



D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 18 April 1989

Appellant : THE MENNEN COMPANY
Morristown New Jersey (US)

Representative : Newby, John Ross et al. J.Y. & G.W.
Johnson Furnival House
14/18 High Holborn, London WC1V 6DE (GB)

Decision under appeal : Decision of Examining Division 120
of the European Patent Office
dated 31 October 1986 refusing
European patent application
No. 83 304 223.7 pursuant to
Article 97(1) EPC

Composition of the Board :

Chairman : G. Szabo
Members : R. Gryc
P. Ford

Summary of Facts and Submissions

- I. European patent application No. 83 304 223.7, filed on 21 July 1983, published under publication number 0 100 204 and claiming the priority of a previous application of 22.07.82, was refused by a decision of the Examining Division No. 120 dated 31 October 1986, on the basis of Claims 1 to 8 filed on 25 June 1986.
- II. In its decision, the Examining Division held that, starting from the prior art disclosed in GB-A-1 358 608, it was obvious for the man skilled in the art to arrive at the subject-matter of the present Claim 1 just by replacing some known means by equivalent ones.
- III. The Appellant appealed against the decision on 19 December 1986, paid the appropriate fee at the same time and filed a Statement of Grounds on 21 February 1987 together with three alternative versions of an amended Claim 1.

In the Statement of Grounds, the Appellant argued essentially that:

- The opposed document does not disclose a cap that is capable of "springing back" but a flexible pad of porous material which may "move back" to its unstressed condition after use and,
 - when the pores of this known pad are occluded with cosmetic material, on release of external pressure, the blocked pores would prevent rapid movement of the pad and would not be rendered free of the cosmetic material.
- IV. With a letter filed on 4 February 1989 in response to objections raised by the Board, the Appellant submitted new

Claims 1 to 8, together with proposals for corresponding amendments to the description.

V. Claim 1 on file reads as follows:

"An applicator for a cream or viscous fluid comprising a container (10), means (14, 12, 16) for forcing cream or viscous fluid from said container and a resilient outwardly domed applicator member (24) through which cream or viscous fluid can pass outwardly from the container for application to a surface to be coated by a user of the applicator, the applicator member having a central portion which is deformable toward the interior of the container (10) under external pressure of the applicator member against the surface to expel cream or viscous fluid from said container, and which is capable of resuming its domed configuration upon release of said pressure thereby to leave an air space (33) below said central portion of the applicator member, characterised in that said applicator member is a cap the central portion of which is provided with at least one orifice (29) therein and is capable of springing back to its original shape upon release of the pressure to free said at least one orifice (29) of cream or viscous fluid."

VI. The filing of the present Claims 1 to 8 and the revised pages 1, 1a, 2, 3, 6 and 7 of the description with the letter dated 3 February 1989 is interpreted by the Board as a request of the Appellant for granting a European patent on the basis of these documents together with page 4 of the description filed with Appellant's letter of 8 November 1985 and page 5 as well as the drawings of the application as published.

Moreover, in the Notice of Appeal, as well as in the Statement of the Grounds of Appeal, the Appellant also requested a refund of the appeal fee under the provisions

of Rule 67 EPC on the ground that the Examiner did not respond to his request in his letter of 24 June 1986 to discuss "any outstanding problems" before issuing a decision.

Reasons for the Decision

1. The appeal is admissible.
2. Except for the new background art cited in the first part of the description in order to meet the requirements of Rule 27(1)(c) EPC, all the matter related to the invention and described in the submitted documents have a support in the application as filed. Therefore, no objection is to be made in view of Article 123(2) EPC.

The description of the application has been adapted to the wording of the present Claim 1 and acknowledges the closest prior art from which the invention starts. These amendments are therefore not open to objection.

In addition, the Board has renumbered the pages 1a and 2 to 7 respectively into pages 2 and 3 to 8.

3. In particular, in the characterising portion of Claim 1, the main characteristic is an applicator member which is capable of springing back to its original shape upon release of the pressure applying it against the surface to be coated.

In order to define the scope of Claim 1 as accurately as possible, this above-mentioned essential feature should be clearly specified. In the present case, the capability of springing back depends on several parameters such as, for example, the strength and resiliency of the material of the cap and the thickness of the central portion of the same

(cf. page 4, lines 1 to 9 of the description of the application). To avoid an undue limitation of the scope of the claim a functional characterisation relying on the resulting effect is allowable. The extent to which the applicator member should be capable of springing back can be specified by the indication of the effect to be produced (i.e. the freeing of the orifice) because the person skilled in the art can verify the result directly by tests involving nothing more than trial and error.

Consequently, no objection is to be made to the clarity of the claims pursuant to Article 84 EPC.

4. Having examined the two documents cited in the Search Report, the Board has come to the conclusion that GB-A-1 358 608 discloses the closest prior art to the subject-matter of Claim 1.

This device comprises an applicator member which is a pad made of an open cell synthetic resin foam, the pores of which are necessarily occluded by creamy material after use. On release of pressure, the pores would not be able to allow a rapid ingress of air into the space below the pad and the pad would therefore only move back slowly to its original position after use.

The subject-matter of Claim 1 is distinguished from this closest prior art mainly in that the applicator according to the invention is not a pad but a cap having (an) orifice(s) instead of pores and being capable of moving rapidly back to its original shape upon release of the pressure to free the orifice(s).

Therefore, the subject-matter as set forth in Claim 1 is novel in the sense of Article 54 EPC.

5. The technical problem underlying the invention in this respect is therefore to improve the applicator known from GB-A-1 358 608 so that, after use, the passages for the material through the applicator member would be clear of the extruded material.

The Board is satisfied that the aforementioned problem is solved by the provision of the technical features of the characterising portion of Claim 1. In particular, the provision of at least one orifice and appropriately improved resilience are relevant.

6. On the question of whether the prior art provides any basis or indication as to how the applicator of GB-A-1 358 608 should be modified in order to obtain an applicator according to the present Claim 1 of the application, the following should be observed:

- 6.1 In relation to the embodiment of Figure 7 of GB-A-1 358 608, this discloses an applicator comprising an applicator member in the form of a resilient outwardly domed porous pad overlying a flat upper end of a tip so as to provide a reservoir for the cosmetic material to be applied.

In operation, this known pad is first outwardly expanded by the internal pressure of the preparation urged into the reservoir. In spite of the expansion, the pores of the foam should, nevertheless remain so small that the preparation cannot pass through without pressure being exerted externally on the pad.

Then, during application to a surface, the domed pad is pushed inwardly toward the upper flat end of the tip (see Figure 7) and its foamed material is itself necessarily compressed into a small area with the size of its pores becoming still smaller and less permeable than before.

This means that, in order to prevent the escape of material without such "application pressure", the pores must be fine so that they allow air only slowly through, if at all, when not occluded and that, to return to its original domed shape, the compressed pad needs to be pushed back by the material forced upwardly from the reservoir.

- 6.2 The pad should be made of a strong enough material in order to be able to spring back to its original shape and free its orifices upon release of the external applied pressure whilst overcoming the resistance of the sticky viscous preparation inside. This is obviously not the case with the thin expandable pad made of a soft open cell foam according to the embodiment of GB-A-1 358 608. Thus this prior art applicator was really designed more to handle preparations of low viscosity, such as liquids, and appears to be unsatisfactory with very viscous fluids.

The new kind of use achieved by the invention in the present case required a different material for the applicator member with another type of perforation which was not envisaged by the cited art with its porous materials and which is therefore not equivalent to it.

Consequently, the person skilled in the art cannot recognize in GB-A-1 358 608 itself any teaching in the direction of a cap made of a material strong enough to allow the cap springing back upon release of the pressure so as to free its orifices from the extruded preparation.

- 6.3 Since the other document cited in the search report (DE-A-3 009 587) also teaches the use of a soft pad of foam or a soft brush for the same purpose, the person skilled in the art would neither learn any hint from this reference to solve the stated problem nor would he even have a valid reason for consulting this document when searching how to improve the applicator according to GB-A-1 358 608.

7. Taking into account the above-mentioned reasoning, the Board is convinced that the modification of the device cannot be considered as an equivalent of what was known and provides a new effect improving the functioning of applicators. The claimed device does not follow plainly and logically from the prior art, but implies an inventive step within the meaning of Article 56 EPC.

Therefore, the subject-matter of Claim 1 is patentable within the meaning of Article 52 EPC.

8. Dependent Claims 2 to 8 concern particular embodiments of the applicator according to Claim 1 and are thus likewise allowable.
9. Concerning the Appellant's request for the appeal fee to be reimbursed, the Board cannot agree with the Appellant's arguments for the following reasons:

- 9.1 Before refusing the application, the Examining Division sent two communications and the Appellant had, thus, two opportunities to comment on the Examining Division's arguments.

Therefore, the requirements of Article 113(1) EPC were fully satisfied.

- 9.2 The last paragraph of his letter of 24 June 1986 the Appellant refers to in his Statement of Grounds for requesting the refund of the appeal fee reads as follows:

"If there are any outstanding problems, the writer would welcome an opportunity to discuss the case with the Examiner".

Such a Statement is to be interpreted as a desire of the Appellant to have the opportunity to clarify his case by informal discussion if the primary Examiner had any

outstanding problems and cannot be understood as a valid request for oral proceedings before the Examining Division as a whole. Consequently, in the absence of such a request, the Appellant had no right to such proceedings and the EPO could issue a decision, whether adverse or not, without appointing such proceedings (cf. T 299/86, OJ EPO, 1988, 88).

- 9.3 Moreover, since, after the reply to the first communication, the Examining Division has discretion to refuse any amendment (Rule 86(3) EPC), the fact that the Examiner did not offer the possibility to discuss the case once more cannot be considered as a substantial procedural violation in the sense of Rule 67 EPC.

Therefore, the reimbursement of the appeal fee is refused.

Order

For these reasons, it is decided that:

1. The impugned decision is set aside.
2. The case is remitted to the first instance with the order to grant a European patent on the basis of the following documents:
 - Description pages 1 and 2 to 4 (new numbering) filed on 4.02.89.
 - Description page 5 (new numbering) filed on 12 November 1985.

- Description page 6 (new numbering) as published.
 - Claims 1 to 8 filed on 4 February 1989.
 - Drawings comprising Figures 1 to 3 of the application as published.
3. The request for reimbursement of the appeal fee is refused.

The Registrar

S. Fabiani

S. FABIANI

The Chairman

G. Szabo

G. SZABO

R.G. 12.05.89

PF. 22.05.89