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**D E C I S I O N**  
**of 21 June 2004**

**Case Number:** T 0496/00 - 3.3.6

**Application Number:** 94304403.2

**Publication Number:** 0652282

**IPC:** C11D 3/12

**Language of the proceedings:** EN

**Title of invention:**  
Use of fabric treatment compositions

**Patentee:**  
UNILEVER PLC, et al

**Opponent:**  
The Procter & Gamble Company

**Headword:**  
Clay/UNILEVER

**Relevant legal provisions:**  
EPC Art. 54(1)(2)

**Keyword:**  
"Novelty - no"  
"Second non-medical use - no"

**Decisions cited:**  
G 0002/88, T 0892/94

**Catchword:**  
-



Case Number: T 0496/00 - 3.3.6

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.6**  
**of 21 June 2004**

**Appellant:**  
(Proprietor of the patent)

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**Decision under appeal:** **Decision of the Opposition Division of the European Patent Office posted 22 March 2000 revoking European patent No. 0652282 pursuant to Article 102(1) EPC.**

**Composition of the Board:**

**Chairman:** P. Krasa  
**Members:** G. N. C. Raths  
U. J. Tronser

## Summary of Facts and Submissions

- I. This appeal is from the Opposition Division's decision to revoke European patent No. 0 652 282.

Claim 1 of the patent as granted read:

"1. Use of clay, to inhibit damage to cellulosic fibres, in a composition for addition to water for washing or rinsing fabrics."

- II. An opposition based on lack of novelty (Articles 100(a), 54 EPC), inventive step (Articles 100(a), 56 EPC), lack of sufficiency of disclosure (Articles 100(b), 83 EPC) and non compliance with Article 100(c) EPC was filed against this decision. In the notice of opposition the following documents were cited, *inter alia*:

(4) EP-A-0 350 288;

(5) EP-A-0 297 673;

(6) H. Berenbold, "Additional Use Benefits of Fabric Softeners Based on DSDMAC", Editio in Barcelona, en 1987, por "ASOCIACION de investigacion de detergentes, tensioactivos y afines", Barcelona, Espana;

(7) Rolf-Günter Seeboth, W.G. Bürk "Produktleistung von Wäschespülmitteln: Mehr als Weichheit und Frische", Zeitschrift für die Fett-, Öl-, Tensid-, Kosmetik- und Pharmaindustrie, 12 November 1987;

- (8) H. Berenbold, "Nutzen und Bioverhalten von Weichspülern", Tenside Surf.Det.27 (1990) 1,34-40;;
- (9) F. Lang, H. Berenbold, "Weichspüler - ein Beitrag zur modernen Wäschepflege", Seifen, Öle, Fette, Wachse", 117.Jg. No. 18, 1991 and
- (13) EP-A-0 177 165.

III. The proprietors (hereinafter appellants) requested the rejection of the opposition or, alternatively the maintenance of the patent in amended form on the basis of two auxiliary requests. In its decision the Opposition Division held that the subject-matter of Claim 1 of all the requests lacked novelty in view of documents (13), (4) or (5).

IV. The appellants filed an appeal against this decision and, under cover of the letter dated 21 July 2000 containing the statement of grounds of appeal, a main and an auxiliary request.

The main request concerned the maintenance of the patent as granted.

Claim 1 of the auxiliary request differed from Claim 1 of the main request in that the passage "fibres, in a composition" was replaced by "fibres in the wash, in a composition".

V. The appellants argued in essence as follows:

The claimed subject-matter was novel (letter dated 21 July 2000, points 2 to 14).

Although document (13) taught that clays can lubricate fibrils in the wash, the skilled person would not have concluded that fibre damage was inhibited thereby.

Document (13)

- did not teach that fibre damage may be prevented or reduced by the addition of clay to the wash;
- was concerned with the softening effect of clay on already damaged fibres;
- did not indicate to the skilled person that fibres would become more resistant to damage as a result of the incorporation of clay in the wash.

There was a clear difference in the teaching of document (13) in relation to fibre damage under wet conditions (fibrillation) and in relation to fibre damage under dry conditions (cracking).

VI. The respondent argued as follows:

- (a) The patent did not meet the requirements of Article 123(2) EPC, since in Claim 1 there was no basis for the passage "in a composition for addition to water for washing or rinsing fabrics".
- (b) In respect of novelty, it resulted from documents (6),(7),(8),(9) and (13) that the actual damage disclosed in these prior art documents was the same as were the steps taken to prevent this damage, namely the use of a clay in a composition

for addition to water for washing or rinsing fabrics.

Thus, the subject-matter of Claim 1 was not novel.

(c) Whether starting from document (13) or documents (7) or (8), the subject-matter of Claim 1 is lacking an inventive step (see letter dated 1 February 2001).

VII. At the end of the oral proceedings, which took place on 21 June 2004, the appellants requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 10 and description columns 1 to 8 according to the request labelled auxiliary request submitted under cover of the letter dated 21 July 2000 (statement of grounds of appeal).

This remained the appellants' sole request to be decided.

The respondent requested that the appeal be dismissed.

## **Reasons for the Decision**

### **1. *Articles 84 and 123 EPC***

Claim 1 as originally filed read: "Use of a clay as a fibre damage inhibitor."; whereas Claim 1 of the appellants' sole request reads: "Use of clay, to inhibit damage to cellulosic fibres in the wash, in a

composition for addition to water for washing or rinsing fabrics." (see points I and IV, above).

The respondent argued that there was no basis in the application as filed for incorporating into Claim 1 the passage "in a composition for addition to water for washing or rinsing fabrics".

The Board does not agree.

The passage "in a composition for addition to water for washing or rinsing fabrics" as well as the words "in the wash" find their support in the application as filed where it is said:

"The photographs show that clay mitigates the fibre damage when added in a rinse cycle or during the main wash. Furthermore it can be seen that clay can reduce fibre damage fibrillation and thus increase yarn life time more effectively when it is applied to the last rinse" (page 12, lines 25 to 30), and

"The invention further provides the use of a fabric softening clay in a composition comprising a detergent active for the prevention of fibre damage or to protect fibres" (page 3, lines 6 to 8, this passage corresponding to the patent in suit, column 3, lines 25 to 28).

The addition of clay in a rinse cycle or during the main wash implies the presence of water, so that there is no lack of disclosure for the passage "for addition

to water for washing or rinsing fabrics" in the application as filed.

The deletion of the passage regarding the photograph resulted from an adaptation of the description to the amended claims during the examination procedure. Since, however the feature "in a ... fabric" was part of the disclosure in the application as filed, its incorporation into Claim 1 was allowable. It follows that this amendment of claim 1 does not give rise to an objection under Article 123(2) EPC.

Therefore, the subject-matter of Claim 1 has not been amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

Claim 1 meets the requirements of Article 123(2) EPC. The Board is satisfied that also claims 2 to 10 comply with the requirements of Article 123(2) EPC and that all the claims comply with the requirements of Articles 123(3) and 84 EPC. Since no objections were raised in this respect, no further arguments are to be given.

## 2. *Novelty*

- 2.1 The Opposition Division, relying on the decision of the Enlarged Board of Appeal G 2/88, had concluded that the subject-matter of Claim 1 was not novel in view of document (13).

The appellant contested this.



As a preliminary point, in the present case, the Board considers it useful and appropriate to focus attention on what is in fact claimed in Claim 1 of the contested patent.

2.2 Claim 1, is directed to:

- (i) Use of clay,
- (ii) to inhibit damage to cellulosic fibres
- (iii) in the wash,
- (iv) in a composition for addition to water for washing or rinsing fabrics

2.2.1 There can be no doubt that the word "clay" in Claim 1 embraces a considerable number of clays which are well known *per se* in the state of the art (see patent in suit, column 2, lines 21 to 30), among others softening clays (column 2 , line 24).

2.2.2 The patent in suit describes the possible damage. "The use of a fabric softening clay particularly addresses the problem of dry damage and fibrillation. Dry damage causes cracking of the fibres. Fibrillation is the splitting of the fibres to form fibrils."(column 2, lines 17 to 20).

2.2.3 It is not appropriate to distinguish between preventing and curing damage, as suggested during the oral proceedings by the appellant, since Claim 1 mentions only the inhibition of damage and does not differentiate between a damaged and a non damaged cellulosic fibre.

2.3 On the one hand the use of clays as an active ingredient in detergent compositions is already known in the state of the art. Thus citation (13) discloses in particular that fabric softening clay materials are an essential component of detergent compositions (page 6, lines 26 and 27).

This citation also discloses the purpose of using clays: "...it is believed that clay materials achieve their softening benefit by coating the fibres and fibrils with a layer of lubricating material thereby lowering the friction between fibrils and fibrils/fibres and reducing the tendency of the fibrils to bond together." (page 2, line 33 to page 3, line 2).

2.4 On the other hand, neither document (13) nor any other citation available in the proceedings contains an explicit disclosure that a clay has, when used in the wash, the capability of inhibiting damage to cellulosic fibres.

2.5 Thus a comparison of the claimed subject-matter in present Claim 1 with the disclosure of the state of the art makes it clear that what was in the present case indeed not made available to the public in citation (13) was the discovery or observance or the statement that a clay, when used in the wash in a detergent composition, has the capability of inhibiting damage to cellulosic fibres.

2.6 Clays *per se* and their use as softening agents in detergent compositions have undoubtedly been made available to the public in document (13) in the form of a technical teaching.

The crucial step is to ascertain whether the invention differs from the prior art.

- 2.7 From the considerations in the foregoing points it is sufficiently clear that the assessment of novelty in the present case depends on the answer to the question whether or not the above-mentioned claimed effect or capability of clay, i.e. to inhibit damage to cellulosic fibres, which is not verbatim disclosed in the state of the art but which is mentioned in Claim 1 of the patent in suit, can confer novelty to the subject-matter claimed in Claim 1.

As regards the prevailing question of novelty, the Opposition Division relied primarily on the decision of the Enlarged Board of Appeal G 2/88 (OJ EPO 1990, 93)

- 2.7.1 In order to be able to correctly apply the conclusions laid down in decision G 2/88 to the present case, the Board considers it useful to recapitulate question (iii), which was referred to the Enlarged Board of Appeal, and the answer to this question given in that decision (see T 892/94).

The question was: "Is a claim to the use of a compound for a particular non-medical purpose novel for the purpose of Article 54 EPC, having regard to a prior publication which discloses the use of that compound for a different non-medical purpose, so that the only novel feature in the claim is the purpose for which the compound is used?"

The answer to this question is summarized in point 10.3 of the reasons as follows:

"With respect to a claim to a new use of a known compound, such new use may reflect a newly discovered technical effect described in the patent. The attaining of such a technical effect should then be considered as a functional technical feature of the claim (e.g. the achievement in a particular context of that technical effect). If that technical feature has not been previously made available to the public by any of the means as set out in Article 54(2) EPC, then the claimed invention is novel, even though such technical effect may have inherently taken place in the course of carrying out what has previously been made available to the public."

2.7.2 It follows from decision G 2/88 that novelty within the meaning of Article 54(1) can be acknowledged in cases where the discovery of a new technical effect of a known substance leads to an invention which is defined in the claim in terms of the use of that substance for a hitherto unknown, new non-medical purpose reflecting said effect (i.e. a new functional technical feature), even if the only novel feature in that claim is the purpose for which the substance is used.

2.7.3 Conversely, it can be inferred from decision G 2/88 that no novelty exists, if the claim is directed to the use of a known substance for a known non-medical purpose, even if a newly discovered technical effect **underlying said known use** is indicated in that claim.

2.7.4 The Board finds that the latter is precisely the case here. As already stated above, the use of a clay in detergent compositions is already disclosed in document (13). Although this citation certainly does not disclose explicitly that a clay exhibits the effect or capability of inhibiting damage (i.e. a newly discovered technical effect), according to document (13) clay (i.e. a known substance) was already used in detergent compositions for the purpose of lowering the friction between fibrils and fibrils/fibres thus reducing the tendency of the fibrils to bond together. Thus, by coating the fibres and fibrils clay materials achieve their softening benefit (i.e. a known non-medical purpose).

There is a correlation between lowering the friction and avoidance of cracking and splitting of the fibres. Fibre cracking had been identified in the patent in suit as the problem of damage under dry conditions and splitting as the problem of damage under wet conditions (see appellant's letter dated 21 July 2000, statements of the grounds of appeal, section 4). The avoidance of cracking and splitting of fibres is due to the friction reducing effect provided for by clay in detergent compositions. Therefore, the softening effect and the inhibition of damage to fibres are intimately linked each to other. In this case, the purpose of avoiding damage by cracking or damage by splitting expresses the same idea as the purpose of inhibiting damage to cellulosic fibres. Actually, no new technical effect is obtained.

But even if, in the favour of the appellant, the effect of "inhibiting damage to cellulosic fibres" (see

Claim 1) were considered to be an additional effect or side effect, it is an effect underlying the use of clay, which effect was characterized as avoidance of cracking and splitting (see point 2.2.2).

2.7.5 For amounting to an anticipation it is immaterial for the purpose of prejudice to novelty that the observed technical effect exhibited by a clay in inhibiting damage to cellulosic fibres is not literally described in the document (13). Calling the avoidance of cracking and splitting of fibres "damage inhibition to cellulosic fibres" is only paraphrasing a known effect. Specifically pointing to this effect can even not be considered as an additional piece of knowledge about the known use or application of clay because it is only the rewording of a known effect.

Therefore, explaining a known effect in different words or, noting a newly discovered effect underlying the known use of clay cannot confer novelty on Claim 1, since the latter would require that the newly discovered effect leads indeed to a new technical application or use of the clay which is not necessarily correlated with the known application or use and can be clearly distinguished therefrom. This is not the case here.

The Board concurs with the Opposition Division's finding that the effect of fibre damage inhibition was not hidden in document (13), but was implicitly disclosed (page 6, last paragraph) since this effect was always achieved when clay was used.

2.7.6 Thus the state of the art disclosed in citation (13) is not distinguished from the subject-matter of Claim 1.

2.8 It follows from the foregoing that the subject-matter of Claim 1 lacks novelty. There is no need in these circumstances to examine whether Claim 1 is based on an inventive step. Since a decision can only be taken on each request as a whole, there is likewise no need to look into the patentability of the other claims either.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P. Krasa