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D E C I S I O N
of 15 May 2003

Case Number: T 0670/01 - 3.3.5

Application Number: 94927908.7

Publication Number: 0735919

IPC: B01F 17/00

Language of the proceedings: EN

Title of invention:
Solvent soaps and methods employing same

Patentee:
UNION OIL COMPANY OF CALIFORNIA

Opponent:
Cognis Deutschland GmbH & Co. KG

Headword:
Solvent Soaps/UNION OIL

Relevant legal provisions:
EPC Art. 123(2), 123(3), 100(c)

Keyword:
"Unallowable extension of scope of protection (main request and second to sixth auxiliary requests)"
"Added subject-matter (all requests)"

Decisions cited:
-

Catchword:
-

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Case Number: T 0670/01 - 3.3.5

D E C I S I O N
of the Technical Board of Appeal 3.3.5
of 15 May 2003

Appellant: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 11 April 2001 revoking European patent No. 0 735 919 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: R. K. Spangenberg
Members: G. J. Wassenaar
M. B. Günzel

Summary of Facts and Submissions

I. The appeal is from the decision of the Opposition Division to revoke European patent No. 0 735 919. The patent was revoked on the ground of unallowable amendments according to Article 100(c) EPC.

II. In the statement of the grounds of appeal, filed with the letter dated 9 August 2002, the appellant(patentee) maintained that the subject-matter of the claims filed with the letter dated 6 August 1999 did not extend beyond the content of the application as originally filed. With said statement 6 alternative claims 1 were submitted as auxiliary requests I to VI.

Claim 1 of the main request (6 August 1999) reads as follows:

"A composition comprising:
(a) a first surfactant having an HLB value of at least 11;
(b) a second surfactant having a higher HLB value, where the difference in the HLB values of the first and second surfactants is at least 2;
(c) at least one polar diluent oil; and
(d) less than about 5 volume percent water (the volume percent being based on the total amount of surfactant, diluent oil, and water present in the composition)."

Claim 1 of auxiliary request I reads as follows:

"A composition comprising:
(a) a first hydrophilic surfactant;
(b) a second hydrophilic surfactant having a HLB value which is different to the HLB of the first surfactant

by at least 2;
(c) at least one polar diluent oil; and
(d) less than about 5 volume percent water (the volume percent being based on the total amount of surfactant, diluent oil, and water present in the composition), the use of any surfactant having a HLB value of less than 11 being hereby disclaimed."

Claim 1 of auxiliary request II reads as follows:

"A composition comprising:
(a) at least two different types of surfactants each having an HLB value of at least 11 (or 12);
(b) at least one polar diluent oil;
(c) at least one non-polar diluent oil; and
(d) less than about 5 volume percent water (the volume percent being based on the total amount of surfactant, diluent oil, and water present in the composition), wherein said polar diluent oil comprises at least one terpene or terpenoid or said two different types of surfactants are selected from polyoxyethylene sorbitan fatty acid esters (or both)."

Claim 1 of auxiliary request III reads as follows:

"A composition comprising:
(a) at least two different types of polyoxyethylene sorbitan fatty acid ester surfactants sufficiently polyethoxylated to have an HLB of at least 11;
(b) at least one polar diluent oil; and
(d) less than about 5 volume percent water (the volume percent being based on the total amount of surfactant, diluent oil, and water present in the composition)."

Claim 1 of auxiliary request IV differs from claim of

auxiliary request III in that component (a) reads as follows:

"at least two different types of polyoxyethylene sorbitan fatty acid ester surfactants having an HLB of at least 11, said surfactants being selected from the group consisting of sorbitan tristearate, sorbitan monolaurate, sorbitan monooleate, sorbitan monopalmitate, and sorbitan trioleate sufficiently polyethoxylated to have an HLB of at least 11".

Claim 1 of auxiliary request V differs from claim 1 of auxiliary request IV in that component (a) reads as follows:

"at least two different types of polyoxyethylene sorbitan fatty acid ester surfactants having an HLB of at least 11, said surfactants being selected from the group consisting of POE(20) sorbitan tristearate, POE(20) sorbitan monolaurate, POE(20) sorbitan monooleate, POE(20) sorbitan monopalmitate, POE(4) sorbitan monolaurate, and POE(20) sorbitan trioleate".

Claim 1 of auxiliary request VI reads as follows:

"A composition comprising:
(a) at least one polar diluent oil;
(b) at least one non-polar diluent oil;
(c) at least two different types of hydrophilic surfactants selected from the group comprising polyoxyethylene sorbitan monolaurate, polyoxyethylene sorbitan monooleate, polyoxyethylene sorbitan monopalmitate, polyoxyethylene sorbitan trioleate, polyoxyethylene sorbitan tristearate and polyoxyethylene monolaurate; and

(d) less than about 5 volume percent water (the volume percent being based on the total amount of surfactant, diluent oil, and water present in the composition) where the composition is a solution."

III. The respondent (opponent) argued that none of the independent claims of the main request and of any of the auxiliary requests I to V removed the objection under Article 100(c) EPC.

IV. After the summons for oral proceedings pursuant to Rule 71(1) EPC, the appellant, by letter dated 28 November 2002, withdrew its request for oral proceedings and indicated that it did not intend to be represented at the proceedings but would rest its case on the statement filed with the letter dated 9 August 2001.

V. In a communication dated 19 December 2002 the Board indicated as its preliminary opinion that none of the requests on file (main request of 6 August 1999 and auxiliary requests I to VI of 9 August 2001) seemed to fulfil the requirements of Article 123 EPC. The following reasons for this opinion were given:

"The claimed compositions are defined by components the presence of which is mandatory, but the wording of the claims (comprising) does not exclude the presence of other components. This means that more than two surfactants may be present which may according to the main request and auxiliary requests II to VI comprise surfactants with an HLB value below 11 in such an amount that the HLB value of the mixture of surfactants may fall below 11. The claims of the main request and of the auxiliary requests II to VI can therefore be

considered to extend the protection conferred and are thus objectionable under Article 123(3) EPC.

According to the main request and auxiliary request I the second hydrophilic surfactant should have an HLB value which is at least 2 values higher than that of the first hydrophilic surfactant. According to the original disclosure the difference of at least 2 seemed to be linked to a cleaning composition comprising also a non-polar diluent oil (page 19, line 22 to page 20, line 9 of the published PCT application). The presence of a non-polar diluent oil is however not required by claim 1 of the main request and auxiliary request I. The combination of features of these claims thus cannot be regarded as disclosed in the application as filed so that these claims are, in addition, also open to objection under Article 123(2) EPC.

If a polar and a non-polar diluent oil are both present in the composition the cited paragraph on pages 19 and 20 of the original disclosure seems to require that the HLB values of the two surfactants should be different. This condition is not reflected by claim 1 of auxiliary requests II to VI; the fact that the two surfactants are of different type does not necessarily imply that they have different HLB values. According to Table VI of the patent specification Emsorb 6907 and Tween 85 are different types of surfactants but have the same HLB value. Thus, the combination of features as now claimed by claim 1 of auxiliary requests II to VI is also *prima facie* not based on the original disclosure (Article 123(2) EPC)."

The parties were requested to file their observations within a period of 2 months.

VI. With a letter dated 6 February 2003 the respondent indicated its agreement with the Board's preliminary opinion. The appellant did not reply.

VII. The appellant requested that the decision under appeal be set aside and that the European patent No. 0 735 919 be maintained with the claims according to the main request of 6 August 1999, or, alternatively with an amended claim 1 according to auxiliary requests I to VI of 9 August 2001.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible

2. None of the independent claims of any of the requests on file fulfil the requirements of Article 123 EPC. Their contents either extend beyond the content of the application as originally filed (Article 123(2) EPC), or their contents extend the protection conferred (Article 123(3) EPC). The reasons have been given above under point V and have been communicated to the parties in the communication of the Board dated 19 December 2002. Since the appellant has not replied to this communication the Board sees no reason to make further comments. None of the appellant's requests is therefore allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

U. Bultmann R. Spangenberg