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D E C I S I O N
of 9 April 2002

Case Number: T 1290/01 - 3.3.6

Application Number: 96932158.7

Publication Number: 0850296

IPC: C11D 3/39

Language of the proceedings: EN

Title of invention:

Color-safe bleach boosters, compositions and laundry methods
employing same

Applicant:

THE PROCTER & GAMBLE COMPANY

Opponent:

-

Headword:

Bleach boosters/PROCTER & GAMBLE

Relevant legal provisions:

EPC Art. 111(1), 109(1)

Keyword:

"Remittal - claims of main request meet objections of appealed
decision"

Decisions cited:

T 0870/94, T 0139/87, G 0010/93

Catchword:

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Case Number: T 1290/01 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 9 April 2002

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

Representative: Peet, Jillian Wendy
Procter & Gamble Technical Centres Limited
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 September 2001
refusing European patent application
No. 96 932 158.7 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. Krasa
Members: L. Li Voti
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. This appeal, filed on 2 November 2001, lies from the decision of the Examining Division of 3 September 2001 to refuse European patent application No. 96 932 158.7, relating to colour-safe bleach boosters and compositions comprising them.

II. The set of claims upon which the refusal was based is that filed by the Appellant (Applicant) with a letter of 21 March 2001.

This set of 15 claims contained "inter alia" independent claims 12 and 15.

These independent claims read as follows:

"12. A bleaching composition comprising a bleaching solution having an effective amount of a bleaching species selected from the group consisting of oxaziridinium zwitterions, oxaziridinium polyions having a net negative charge of from -1 to -3, and mixtures thereof."

"15. A method for laundering a substrate, said method comprising the step of contacting a fabric substrate with an effective amount of a bleaching composition as claimed in any of claims 12 to 14."

Dependent claims 13 and 14 related to particular embodiments of the bleaching composition of claim 12.

III. In its decision the Examining Division found that the subject-matter of claims 12, 13 and 15 lacked novelty in the light of a document (1).

Even though the summary of facts and submissions of that decision reported that objections of lack of inventive step and lack of unity of the claimed subject-matter had also been raised against the examined set of claims, the reasons for the decision were limited to the grounds of lack of novelty.

IV. With its statement of the grounds of appeal, the Appellant filed two amended sets of claims as, respectively, a main request (comprising twelve claims) and an auxiliary request (comprising ten claims).

The amended set of claims according to the main request differed from that filed with the Appellant's letter of 21 March 2001 (see point II above) insofar as it did not any longer contain claims 12, 13 and 15 of the latter set.

The amended set of claims according to the auxiliary request differed from that filed with a letter of 21 March 2001 insofar as claim 1 was limited to the embodiment of claim 5 of that request and claims 12 to 15 were deleted.

V. The Appellant submitted in essence that

- the set of claims according to the main request did not any longer contain the claims which the Examining Division had found to lack novelty and therefore the objections of the first instance which had led to the refusal of the application had been overcome;
- moreover, the set of claims of the auxiliary request not only did not any longer contain the

claims found to lack novelty in the decision of the Examining Division but it contained also an amended claim 1, based upon claim 7 as filed (claim 5 of the set of claims filed with the letter of 21 March 2001), which had already been considered to involve an inventive step by the Examining Division.

- VI. The Appellant requests that the decision of the Examining Division be set aside and that a patent be granted, either on the basis of the main request or of the auxiliary request or to be allowed the right to overcome any new objections which may arise.

Reasons for the Decision

1. *Main request*

1.1 The set of claims according to the main request differs from the set of claims upon which the decision of the Examining Division was based insofar as it does not any longer contain claims 12, 13 and 15 which were found to lack novelty in that decision.

1.2 The decision under appeal, dealing in its reasons **exclusively with the novelty** of claims 12, 13 and 15, was thus based upon a set of claims which is no longer requested by the Applicant.

Therefore, taking into account that there is now a new set of claims which overcome the novelty objections given in that decision, the Appellant has carried out amendments which fully meet the only objection on which

the refusal of the application was based and notified in the contested decision.

- 1.3 It is established jurisprudence of the Boards of Appeal that if an appeal clearly meets the objections on which the appealed decision relies, as in the present case, the Examining Division should have rectified the contested decision pursuant to Article 109(1) EPC. This would have expedited the proceedings and avoided a substantial loss of time for the Appellant (see T 870/94, point 2 of the reasons for the decision, not published in the OJ EPO and T 139/87, OJ EPO 1990, 068, points 3 and 4 of the reasons for the decision).

The Board finds that the Examining Division did not comply with this established principle of procedural law according to which interlocutory revision must be accorded in case amendments to the respective application overcome the substantive objections dealt with in the decision under appeal (see in this respect also the Guidelines for Examination - Part E, Chapter XI, 7).

In this respect it must be also stressed that the primary goal of the Appeal proceedings is a revision of the decision of the first instance and it is not the task of the Board of Appeal to prosecute objections raised under examination which had not been thereafter used as a ground for the refusal (see G 10/93, OJ EPO 1995, 172 point 4 of the reasons for the decision).

- 1.4 Moreover, if the Board would decide to the contrary upon other patentability issues addressed by the Examining Division during examination but not included in its decision, for example the inventive step of the

claimed subject-matter, this would deprive the Appellant of the opportunity to have such issues considered at two instances.

2. Since, as explained above (point 1.2), the claims according to the main request already meet the objections on which the appealed decision relies, there is no need also to deal with the claims of the auxiliary request.

The Board considers therefore it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the Examining Division for further prosecution on the application.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the twelve claims of the main request.

The Registrar:

The Chairman:

G. Rauh

P. Krasa