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D E C I S I O N
of 29 June 2005

Case Number: T 0799/04 - 3.3.6

Application Number: 95302732.3

Publication Number: 0684303

IPC: C11D 3/37

Language of the proceedings: EN

Title of invention:
Detergent compositions

Patentee:
UNILEVER PLC, et al

Opponent:
The Procter & Gamble Company

Headword:
Dispenser test/UNILEVER

Relevant legal provisions:
EPC Art. 84, 111(1)

Keyword:
"Admissibility of objection raised under Article 84 EPC during
opposition proceedings (no): objection not arising from
amendments to the patent as granted"
"Remittal (yes) "

Decisions cited:
T 0728/98; T 0337/95; T 0550/91; T 0869/98

Catchword:

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Case Number: T 0799/04 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 29 June 2005

Appellant: UNILEVER PLC
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Respondent (s): The Procter & Gamble Company
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 3 May 2004
revoking European patent No. 0684303 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: P. Krasa
Members: L. Li Voti
A. Pignatelli

Summary of Facts and Submissions

- I. The present appeal is from the decision of the Opposition Division to revoke the European patent No. 0 684 303, relating to particulate detergent compositions containing a granular silicone-based foam control agent.

The granted set of claims contained 11 claims, independent claim 1 of which reading as follows:

"1. A particulate controlled foam detergent composition containing a foam controlling amount of a foam control granule comprising a silicone foam control agent on an absorbent carrier material, characterised in that (a) the composition has a content of particles smaller than 180 micrometres of at least 10 wt%, and that (b) the absorbent carrier material of the antifoam granule comprises a starch."

- II. In its notice of opposition the Opponent sought revocation of the patent on the grounds of Articles 100(a) and (b) EPC.

During the written proceedings the Patent Proprietors filed under cover of the letter dated 1 February 2002 a new set of 8 claims to be considered as main request and under cover of the letter dated 17 February 2004 a set of 7 claims to be considered as auxiliary request.

Claim 1 according to this main request differs from claim 1 as granted insofar as the claimed composition requires as feature (a) a content of particles smaller than 180 micrometres of at least 15 wt% (as in granted

claim 2), as feature (b) that an otherwise identical control powder minus the foam control granule gives a dispenser residue, as defined in the description of the patent in suit, of at least 20 wt% (as in granted claim 10), and as feature (c) the feature (b) of granted claim 1.

Claim 1 of the first auxiliary request differs from claim 1 according to the main request only insofar as it further requires that the claimed composition has a bulk density of at least 650 g/l.

Both the Opponent and the Opposition Division put forward in writing that the new feature (b) rendered the scope of claim 1 unclear and thus that claim 1 did not comply with the requirements of Article 84 EPC.

III. In its decision the Opposition Division found in particular that

- feature (b) limited the scope of claim 1 according to both requests by restricting the selection of the starting material to be used for the preparation of the claimed product to a material passing the specified test for the evaluation of the dispenser residue;
- however, the skilled person would not have been able to control in a final product whether the used starting material passed the specified test for the evaluation of the dispenser residue and could only test the other characterizing features of the claimed composition;

- therefore, the skilled person could not control if somebody would be using a product as claimed or not and if he would be infringing the patent in suit or not;

- the scope of claim 1 was thus not clear and claim 1 contravened the requirements of Article 84 EPC.

IV. An appeal was filed on 23 June 2004 against this decision by Unilever PLC (Appellant), which is one of the Patent Proprietors.

On the same day the appeal fee was paid. On 1 September 2004 a statement of grounds was filed, which contained reasons why the decision under appeal should be set aside.

V. The Appellant submitted in writing in essence that

- the disputed amendment did not render the scope of claim 1 unclear since the skilled person would have been able to verify whether or not a product fell under the scope of the claim;

- in particular, the skilled person could remove mechanically or chemically the antifoam particles contained in the final product or request to the manufacturer of the product the same composition without the foam control granule and thereafter submit the product without the foam control granule to the test for the evaluation of the dispenser residue given in the description of the patent in suit;

- furthermore, the disputed amendment was already contained in claim 10 as granted and no new clarity issues arose from its introduction into the wording of claim 1;
- therefore, the disputed amendment, if considered unclear, should have been reviewed at the time of granting and such a clarity issue could not be raised during opposition proceedings.

VI. Under cover of the letter of 17 December 2004 the Respondent (Opponent) asked a two month extension of time to respond to the appeal and did not submit any counter arguments to the statement of the grounds of appeal.

No further submissions were, however, received from the Respondent after the expiration of the time extension granted by the Board.

VII. The Appellant requests that the decision of first instance be set aside and that the case be remitted to the first instance for consideration of the other grounds of opposition.

The Respondent requests that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible under Article 108 and Rule 65 EPC.

2. *Main Request*

2.1 The decision under appeal was only based on the finding that feature (b) of claim 1 according to both requests rendered the scope of this claim unclear since the skilled person would have not been able to control in a final product if the used starting material passed the specified test for the evaluation of the dispenser residue and could only test the other characterizing features of the claimed composition.

Claim 1 was thus found to contravene the requirements of Article 84 EPC (see point III above).

It is established jurisprudence of the Boards of Appeal of the EPO that, in order to ensure legal certainty, a claim must clearly define the subject-matter for which protection is sought (see T 728/98, OJ EPO 2001, 319, point 3.1 of the reasons for the decision as well as T 337/95, OJ EPO 1996, 628, points 2.2 to 2.5 of the reasons for the decision).

However, non-compliance with the requirements of Article 84 EPC is not a ground for opposition under Article 100 EPC. An objection under Article 84 EPC can thus be considered during opposition proceedings only if it arises from amendments of the patent as granted (see T 550/91, point 3.1 of the reasons for the decision).

2.2 In the present case claim 1 according to the main request differs from claim 1 as granted insofar as the content of particles smaller than 180 micrometres of the claimed composition is of at least 15 wt% instead

of at least 10 wt%, feature (b) requires that an otherwise identical control powder minus the foam control granule gives a dispenser residue, as defined in the description of the patent in suit, of at least 20 wt% and feature (b) of granted claim 1 is identified as feature (c) (see point II above).

However, the feature that the content of particles smaller than 180 micrometres of the claimed composition is of at least 15 wt% was the subject-matter of granted claim 2, dependent on granted claim 1, and the new feature (b) was the subject-matter of granted claim 10, dependent on all the preceding claims.

Therefore, the new feature (b) was already claimed in the granted patent in combination with all the other features of claim 1.

Thus, claim 1 being a combination of claims 1, 2 and 10 as granted, the objection raised under Article 84 EPC against feature (b) cannot be considered to arise from the introduction of this feature into the wording of granted claim 1 but could have already been raised at the time of granting.

It follows that, under the circumstances of the present case, the objection raised under Article 84 EPC during the opposition proceedings was inadmissible.

There is thus no need to examine the Appellant's auxiliary request.

3. *Remittal*

Since the decision under appeal was only based on the ground of not compliance with the requirements of Article 84 EPC, all other grounds of opposition were not discussed in the decision under appeal or in the written submissions of the parties during the appeal proceedings.

The Board finds thus that it is not appropriate under these circumstances to discuss the other grounds of opposition and that, in order not to deprive the parties of the opportunity to argue the remaining issues at two instances, it is appropriate to make use of its powers under Article 111(1) EPC to remit the case to the department of first instance for further prosecution as requested by the Appellant (see T 869/98, unpublished in OJ EPO, point 4 of the reasons for the decision).

However, the Board notes that the interpretation of unclear terms in a claim is essential for the evaluation of the other grounds of opposition (see e.g. T 550/91, point 3.1 of the reasons for the decision).

It will thus be necessary to investigate whether the amended claim 1 is unclear and which is the interpretation to be given to claim 1.

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.

The Registrar:

The Chairman:

G. Rauh

P. Krasa