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**Datasheet for the decision
of 17 January 2008**

Case Number: T 1345/04 - 3.3.10

Application Number: 94913749.1

Publication Number: 0695166

IPC: A61K 7/46

Language of the proceedings: EN

Title of invention:
Perfume composition

Patentee:
QUEST INTERNATIONAL B.V.

Opponent:
HENKEL KGaA
The Procter & Gamble Company

Headword:
Perfume Compositions/QUEST

Relevant legal provisions (EPC 2000):
EPC Art. 108, 123(2)
EPC R. 99(2)

Keyword:
"Admissibility of opponent's appeal (yes) - legal and/or
factual reasons given"
"Amendments (not allowable) - disclaimer removes more than is
necessary to restore novelty "

Decisions cited:
G 0001/03, G 0002/03, T 0220/83, T 0213/85

Catchword:
-



Case Number: T 1345/04 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 17 January 2008

Appellant I:
(Opponent) HENKEL KGaA
Henkelstrasse 67
D-40589 Düsseldorf (DE)

Representative:
Michalski, Stefan
Michalski Hüttermann
Patentanwälte GbR
Neuer Zollhof 2
D-40221 Düsseldorf (DE)

Respondent:
(Opponent) The Procter & Gamble Company
One Procter & Gamble Plaza
Cincinnati
Ohio 45202 (US)

Representative:
ter Meer, Nicolaus
TER MEER STEINMEISTER & PARTNER GbR
Patentanwälte
Mauerkircherstrasse 45
D-81679 München (DE)

Appellant II:
(Patent Proprietor) QUEST INTERNATIONAL B.V.
Huizerstraatweg 28
NL-1411 GP Naarden (NL)

Representative:
Ford, Michael Frederick
Mewburn Ellis LLP
York House
23 Kingsway
London WC2B 6HP (GB)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
28 September 2004 concerning maintenance of
European patent No. 0695166 in amended form.

Composition of the Board:

Chairman: R. Freimuth
Members: J. Mercey
P. Schmitz

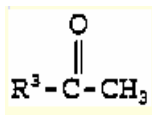
Summary of Facts and Submissions

- I. The Appellant I (Opponent I) and Appellant II (Proprietor of the patent) lodged appeals on 22 November 2004 and 7 December 2004 respectively against the interlocutory decision of the Opposition Division posted on 28 September 2004 which found that European patent No. 695 166 in amended form met the requirements of the EPC.
- II. Notice of Opposition had been filed by Appellant I and the Respondent (Opponent II) requesting revocation of the patent as granted in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC), insufficient disclosure (Article 100(b) EPC) and of extending the subject-matter of the patent in suit beyond the content of the application as filed (Article 100(c) EPC). *Inter alia* the following document was submitted in opposition proceedings:
- (19) EP-A-545 556.
- III. The Opposition Division held that the subject-matter of the then pending main request was not novel over the disclosure of document (19). The then pending first auxiliary request did not fulfil the requirements of Rule 57a EPC 1973, since it contained additional independent claims not having any counterpart in the granted version of the claims. Claim 1 of each of the then pending second and third auxiliary requests contained a disclaimer, which was considered to fulfil the requirements of Article 123(2) EPC, since it removed the novelty-destroying subject-matter of document (19). The subject-matter of these two requests

was, however, not held to be novel over other cited documents. The subject-matter of the then pending fourth auxiliary request was considered to be novel and to involve an inventive step.

IV. Annexed to the Statement of the Grounds of Appeal dated 3 February 2005, Appellant II submitted a main request and auxiliary requests 1 to 11. The main request comprised a set of eighteen claims, independent claim 8 reading as follows:

"8. A fabric conditioning product comprising
(i) a fabric softening agent and
(ii) a perfume composition in which at least 30% by weight of the perfume composition is constituted by materials from the following categories:
at least 7% of one or more aromatic methyl ketones of general formula



in which R³ is an aromatic group such that the molecular weight of the ketone is from 170 to 300;

at least 5% of one or more ingredients selected from:

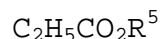
alcohols of general formula



acetates of general formula



propionates of general formula

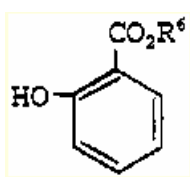


in which R⁴ is an aliphatic group, optionally containing not more than one olefinic double bond, and optionally bearing an aromatic substituent group, such that the

molecular weight of the alcohol is in the range 130 to 180;

R^5 is an aliphatic group optionally containing not more than one olefinic double bond, and optionally bearing an aromatic substituent group such that the molecular weight of the acetate or propionate is in the range 180 to 210;

at least 3% of one or more salicylates of general formula



in which R^6 is an aliphatic group, optionally containing not more than one olefinic double bond, and optionally bearing an aromatic substituent group, such that the molecular weight of the salicylate is in the range 190 to 230,

but excluding perfume compositions in which at least 50% by weight of the composition is constituted by at least four of the following five categories:

at least 0.2% of one or more ethers of general formula



in which R^1 and R^2 are connected only through the ether oxygen atom, and are aliphatic or aromatic groups such that the ether has a molecular weight of 150 to 200;

at least 2% of one or more said ketones

at least 2% of one or more said alcohols

at least 2% of one or more said acetates or propionates

at least 2% of one or more said salicylates;

all the above percentages being by weight of the whole perfume composition."

Claim 8 of auxiliary request 1, claim 7 of auxiliary requests 2 to 7 and claim 1 of auxiliary requests 8 to 11, all relating to a fabric conditioning product, all contained this disclaimer of claim 8 of the main request.

V. In a communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal, the Board indicated *inter alia* that regarding the claims which contained a disclaimer, the question may arise whether the disclaimer removes more than was necessary to restore novelty.

VI. Appellant II argued that the appeal of Appellant I was inadmissible, since the Grounds of Appeal failed to state legal or factual reasons against the contested decision.

Appellant II submitted that the disclaimer present in the claims of all requests fulfilled the requirements of Article 123(2) EPC, since its purpose was to exclude the subject-matter of document (19), which was prior art according to Article 54(3) EPC, and thus fulfilled the criteria set out in decision G 1/03 (OJ EPO 2004, 413).

VII. At oral proceedings held on 17 January 2008, Appellant I withdrew its objection that the appeal of Appellant II was inadmissible.

Appellant I and the Respondent submitted that the disclaimer present in the claims of all requests did not fulfil the requirements of Article 123(2) EPC, since the subject-matter of the disclaimer was not

novelty-destroying and the disclaimer removed more than was necessary to restore novelty over the disclosure of document (19).

VIII. Appellant II requested in writing that the decision under appeal be set aside and the patent be maintained on the basis of the main request or any of auxiliary requests 1 to 11 filed on 3 February 2005.

Appellant I requested that the decision under appeal be set aside and that the patent be revoked. The Respondent supported the request of Appellant I.

IX. Oral proceedings were held in the absence of Appellant II, who, after having been duly summoned, informed the Board with a letter dated 19 November 2007 that it would not attend. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. Admissibility of appeals

Admissibility of appeal of Appellant I

1.1 In accordance with Article 108, third sentence and Rule 99(2) EPC, a statement setting out the grounds of appeal must be filed which shall indicate the reasons for setting aside the decision impugned, and the facts and evidence on which the appeal is based. Decisions of the Boards of Appeal have established the requirement that the grounds for appeal should not be confined to an assertion that the contested decision is incorrect,

but should state the legal and/or factual reasons which constitute the basis of its challenge to the validity of the decision. Grounds sufficient for the admissibility of an appeal must address one or more of the reasons on which the contested decision was based. Here it is not a matter of whether the arguments put forward are actually effective, but rather that circumstances are demonstrated which by their nature may in principle upset the reasons for the decision (cf. decisions T 220/83, OJ EPO 1986, 249, point 4 of the reasons for the decision and T 213/85, OJ EPO 1987, 482, point 3 of the reasons for the decision).

1.2 In the present case, the contested decision was based on *inter alia* the positive finding with respect to inventive step of the subject-matter of the then fourth auxiliary request, on the basis of which the contested patent was maintained. Appellant I, which was adversely affected by the decision to maintain the patent on the basis of the then fourth auxiliary request, addressed *inter alia* this ground in detail in its statement of grounds of appeal, hereby providing reasons as to why the disputed decision should be set aside, such that the requirement of Article 108, third sentence and Rule 99(2) EPC is met.

1.3 In Appellant II's submissions in support of its argument that Appellant I had failed to state legal or factual reasons against the contested decision, it stated that Appellant I's statement of grounds made no distinction between points where the Opposition Division found in favour of the Patent Proprietor (Appellant II) and points where it found in favour of the Opponents (including Appellant I), or that very

significant points in the decision under appeal were not addressed at all.

However, although it may be desirable that an appellant's statement of grounds contains such expositions, they are not necessary in order for an appeal to be admissible (cf. point 1.1 above).

1.4 Hence, the appeal of Appellant I is admissible.

Admissibility of appeal of Appellant II

1.5 The appeal of Appellant II is admissible, since it was submitted in time and due form. During the proceedings, Appellant I withdrew its objection that the appeal of Appellant II was inadmissible.

Main Request and auxiliary requests 1 to 11

2. *Amendments (Article 123(2) EPC)*

2.1 The amendment made to claim 8 of the main request and of auxiliary request 1, to claim 7 of auxiliary requests 2 to 7 and to claim 1 of auxiliary requests 8 to 11 *vis-à-vis* claim 7 as originally filed, all these claims relating to a fabric conditioning product, comprises *inter alia* the insertion of a disclaimer which excludes a generically defined perfume composition.

2.2 This disclaimer has no basis in the application as filed and was introduced into these claims during the opposition (appeal) proceedings in order to delimit the claimed subject-matter from the subject-matter

disclosed at page 2, line 18 to page 3, line 1 of document (19). There is no dispute between the parties that this document forms part of the state of the art according to Article 54(3) EPC.

2.3 Following the decision G 1/03 of the Enlarged Board of Appeal, an originally undisclosed disclaimer may be allowable and is considered as not extending the subject-matter of the application as filed within the meaning of Article 123(2) EPC if it restores novelty by delimiting a claim against state of the art under Article 54(3) EPC (*loc. cit.*, point 2.1.3 of the reasons for the decision). However, the disclaimer should not remove more than is necessary to restore novelty (*loc. cit.*, point 3 of the reasons for the decision and point 2.2 of the order).

2.4 In the present case, the disclaimer removes *inter alia* perfume compositions which contain an ether, a ketone, an alcohol and an acetate or propionate only, since only four of the five ingredients listed in the disclaimer **must** be present. Such a composition does not contain a salicylate, which is, however, a mandatory component of the claimed invention. The disclaimer thus removes subject-matter which does not anticipate the subject-matter of the product claims in the absence of said disclaimer. It thus inevitably removes more than is necessary to restore novelty *vis-à-vis* document (19) and, hence, does not amount to an allowable disclaimer thereof.

2.5 Although the subject-matter disclosed on page 2 of document (19) forms the literal basis for the present disclaimer, it is not detrimental to the novelty of the

subject-matter of the product claims without disclaimer, since to arrive at subject-matter anticipating the claimed invention, *inter alia*, specific combinations from the five categories of ingredients listed in document (19) and reflected in the disclaimer have to be selected to form the perfume composition, namely those combinations which include both a ketone and a salicylate. This generic definition of the disclaimed perfume compositions, thus, does not directly and unambiguously lead the skilled person to subject-matter falling within the scope of what is claimed without disclaimer, with the consequence that this disclaimer is not allowable.

- 2.6 For those reasons, the incorporation of the disclaimer into claim 8 of the main request, and likewise into claim 8 of auxiliary request 1, claim 7 of auxiliary requests 2 to 7 and claim 1 of auxiliary requests 8 to 11, is an amendment which extends the subject-matter claimed beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC, with the consequence that the main request and auxiliary requests 1 to 11 are not allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

P. Cremona

R. Freimuth