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**Datasheet for the decision
of 4 May 2007**

Case Number: T 0816/05 - 3.3.04

Application Number: 91918950.6

Publication Number: 0551408

IPC: C11D 3/386

Language of the proceedings: EN

Title of invention:

Detergent compositions containing cellulase compositions
deficient in CBH I type components

Patent Proprietor:

GENECOR INTERNATIONAL, INC.

Opponents:

- (01) NOVOZYMES A/S
(02) Unilever N.V.

Headword:

Detergent compositions/GENECOR INTERNATIONAL, INC.

Relevant legal provisions:

EPC Art. 123(2) (3), 84, 54, 111(1)
EPC R. 68(2), 57a

Keyword:

"Main request: added subject-matter (no), clarity (yes),
novelty (yes)"

Decisions cited:

G 0002/88, T 0706/95, T 0892/94

Catchword:

See points 1 and 2



Case Number: T 0816/05 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 4 May 2007

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 26 April 2005
revoking European Patent No. 0551408 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: U. Kinkeldey
Members: R. Gramaglia
 G. Weiss

Summary of Facts and Submissions

I. European Patent No. 0 551 408 based on application No. 91 918 950.9 (published as WO 92/06165) filed on 4 October 1991 and claiming priority from US 713738 of 11 June 1991 was granted on the basis of 7 claims, of which independent claim 1 reads as follows:

"1. Use of a detergent composition for washing a cotton containing fabric, the composition comprising:

(a) a cleaning effective amount of a surfactant or a mixture of surfactants; and,

(b) from about 0.01 to about 5 weight percent of a fungal cellulase composition based on the weight of the detergent composition, wherein said cellulase composition comprises one or more endoglucanase components and less than about 5 weight percent of exo-cellobiohydrolase components based on the weight of protein in the cellulase composition;

characterised in that washing the fabric with the composition provides reduced strength loss as compared to treatment with complete cellulase."

Dependent claims 2 to 7 related to specific embodiments of the use of claim 1.

II. Notices of opposition were filed by opponents (01) and (02) requesting the revocation of the European patent on the grounds of Article 100 (a) and (b) EPC. The opposition division revoked the patent for lack of

novelty under Article 54(3) EPC of the only claim request then on file.

- III. The appellant (patentee) filed an appeal against the decision of the opposition division. The grounds of appeal included a Main request and Auxiliary requests A to E.
- IV. Together with the summons to oral proceedings, a communication under Article 11(2) of the Rules of Procedure of the Boards of Appeal was sent to the parties asking their consent to a consolidation of the present case with case T 1365/05. The parties gave their agreement.
- V. Oral proceedings took place from 2 to 4 May 2007, on the second day of which the appellant submitted a new "Main request (Amended 3 May 2007)", of which claim 1 read as follows:

"1. Use of a detergent composition for washing a cotton-containing fabric, the composition comprising:
(a) a cleaning effective amount of a surfactant or a mixture of surfactants; and
(b) from about 0.01 to about 5 weight percent of a fungal cellulase composition, wherein said cellulase composition comprises one or more endoglucanase components and less than about 5 weight percent of exo-cellobiohydrolase components based on the weight of protein in the cellulase composition;
characterized in that washing the fabric with the composition provides **improvements in softness, colour retention/restoration and feel, with** reduced strength loss as compared to treatment with complete cellulase

with the proviso that said fungal cellulase composition (b) is (i) other than a composition containing substantially pure EG III cellulase, being defined as having at least 40 w.t. % of EG III based on the total weight of cellulase proteins, and (ii) other than an acidic cellulase composition, ie having a pH optimum less than 7.0, containing an enriched amount of acidic EG type components relative to CBH type components."

Dependent claims 2 to 6 related to specific embodiments of the use of claim 1.

VI. The following documents are cited in the present decision:

D1 WO-A-91/17243;

D2 WO-A-89/09259;

D5 WO-A-92/06183;

D6 WO-A-92/06221;

D7 WO-A-9217574;

D8 WO-A-92/17572;

D9 WO-A-92/06184;

D11 WO-A-92/06210;

D13 WO-A-91/05841.

VII. The appellant's arguments in writing and during oral proceedings, insofar as they are relevant to the present decision, may be summarized as follows:

Admissibility of the appeal

- Auxiliary requests A-E had been withdrawn before the opposition division because the opposition division announced during oral proceedings that its negative view applied to both the main request and the auxiliary requests (see paragraph 4.6). Therefore, rather than having renounced his right to have Auxiliary requests A-E examined in two instances, the appellant had simply considered it more appropriate to re-submit before the board these requests.

Admissibility into the proceedings of the new main request

- The submission of a further claim request was justified by the complexity of the case. Claim 4 in the previous claim request was deleted because it had become superfluous. Moreover, disclaimer (i) to document D9 in claim 1 was not broader than necessary, as claim 1 of document D9 related to any EG III cellulase.

Article 84 EPC

- The expression "acidic cellulase" and "enriched amount" in the disclaimer to document D11 were clear to the skilled person.
- The extent of improvement to the fabric features referred to in claim 1 was clear to the skilled person since the standard against which the

improvement had to be measured was the treatment with complete cellulase.

Article 123(2)(3) EPC

- There was no added subject matter by the deletion of "type" in the expression "EG type components" and "CBH type components" in present claim 1 since "endoglucanase components" and "exo-cellobiohydrolase components" were included in "EG type components" and "CBH type components" and moreover these expressions without "type" were based on the application as filed.

- There was a clear and unambiguous basis for disclaimer (ii) relating to document D11.

Novelty

Document D1

- There was nothing in Example 4 of document D1 to suggest that washing the fabric with the composition provided reduced strength loss as compared to treatment with complete cellulase as required by claim 1.

- The invention as claimed represented a new use not disclosed in document D1.

Documents D5, D6, D7 and D8

- These documents disclosed neither the feature "a cleaning effective amount of a surfactant" nor the use "for washing a cotton-containing fabric", as

required by the wording of claim 1 at issue. As a consequence the subject-matter of present claim 1 was not directly and unambiguously derivable from the teaching of these documents.

Reimbursement of the appeal fee

- The appeal fee had to be reimbursed in view of a substantial procedural violation by the opposition division in failing to provide a complete reasoned decision for its finding of lack of novelty.

VIII. The respondents' arguments in writing and during oral proceedings, insofar as they are relevant to the present decision, may be summarized as follows:

Admissibility of the appeal

- The main request filed with the grounds of appeal was inadmissible because it violated Rule 57a EPC. The auxiliary requests filed with the grounds of appeal were identical to auxiliary requests A-E which had been voluntarily withdrawn before the opposition division, and thus the appellant had thereby clearly renounced his right to have those requests examined in two instances.

Admissibility into the proceedings of the new main request

- This request had to be refused because the deletion of claim 4 in the previous claim request was not caused by any objection raised by the respondents or the board. Moreover, disclaimer (i) to document D9

in claim 1 was broader than necessary, as it had to be confined to EG III cellulase from *Trichoderma* spp.

Article 84 EPC

- The expression "acidic cellulase" and "enriched amount" in the disclaimer to document D11 were not clear.
- It was also not clear to what extent the fabric features referred to in claim 1 had to be improved in order for the use of a detergent composition to fall within the scope of claim 1.

Article 123(2) EPC

- The meaning of the expression "endoglucanase components" and "exo-cellobiohydrolase components" was different from that of "EG type components" and "CBH type components", respectively. Therefore, the deletion of "type" in present claim 1 represented added subject-matter.
- The disclaimer (ii) relating to document D11 offended against Article 123(2) EPC because there was no clear and unambiguous basis in document D11 for the disclaimed subject-matter.

Novelty

Document D1

- Example 4 of document D1 disclosed a cellulase composition as defined in present claim 1 for the

same purpose as stated in claim 1, i.e. washing cotton-containing fabrics.

- The relevant question was whether the use of detergent compositions as disclosed in document D1, such as the experiments described in Example 4, would have resulted in reduced strength loss when compared to treatment of the cotton-containing fabric with complete cellulase.
- Given that an identical detergent cellulase composition is used for an identical purpose, it must inevitably follow that a reduced strength loss is achieved compared to treatment with the corresponding complete cellulase.
- Therefore, the reduction of strength loss effect was merely an additional effect of using the same known cellulase compositions (enriched in EG) for the same known use (for treating cotton-containing fabrics in order to improve their appearance or feel) (see the Case Law of the Boards of Appeal of the European Patent Office, 4th Edition 2001, page 99, paragraph (h), where decisions T 892/94 and T 706/95 are discussed). These decisions establish that a newly discovered technical effect did not confer novelty on a claim directed to the use of a known substance for a known non-medical purpose if, as in the present case, the newly discovered technical effect already underlay the known use of the known substance.

Document D2

- Document D2 disclosed a cellulase composition as defined in present claim 1 for treating cotton-containing fabrics in order to enhance their appearance. Although the feature "with reduced strength loss as compared to treatment with complete cellulose" was not explicitly disclosed in document D2, this was an inherent feature which failed to confer novelty on the use of a detergent composition as defined in claim 1 for the same purpose, namely washing cotton-containing fabrics.

Document D13

- This document did not disclose reduced strength loss in relation to an endoglycanase-enriched composition. However, since the latter composition is used for washing cotton-containing fabrics, reduced strength loss had to necessarily turn up. This feature thus could not render present claim 1 novel over the use described in document D13.

Documents D5, D6, D7 and D8

- These documents represented prior art pursuant Article 54(3) EPC because the priority claim of the patent in suit was invalid in view of the fact that the priority application US 713,738 filed on 11 June 1991 was not the earliest application of the patent proprietor which disclosed the same invention as that claimed in the European patent.

- These documents disclosed detergent compositions containing fungal cellulase compositions which contained endoglucanase components but which were substantially free of exo-cellobiohydrolase components. They also disclosed using such compositions to wash cotton-containing fabric to reduce strength loss.

IX. The appellant requested

1. that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 6 submitted at the oral proceedings as "Main request (Amended 3 May 2007)" and
2. the reimbursement of the appeal fee.

The respondent I requested that the appeal be rejected as inadmissible or, alternatively, that the appeal be dismissed.

The respondent II requested that the appeal be dismissed.

Reasons for the Decision

Admissibility of the appeal

1. The respondents argue that the appeal is not admissible because the main request filed with the grounds of appeal was inadmissible on the grounds that it violated the requirements of Rule 57a EPC. Thus, de facto, there was no main request von file. Moreover, auxiliary requests A-E being identical to auxiliary requests A-E

which the appellant had voluntarily withdrawn during the oral proceedings before the opposition division, the appellant was not adversely affected.

The fact that a request might possibly not be allowable under whatever prescription of the law is not comparable to a situation where this request was not in existence, with the consequence that an appeal might not be admissible. Therefore, as long as the board has not decided that this request is not allowable, it is there, and the appeal is admissible.

As for auxiliary requests A-E, given that the opposition division announced during oral proceedings its negative view about the use according to claim 1 of main request, the use according to claim 1 of auxiliary requests A-E was likely to fail on the same ground. In view of this, the appellant withdrew all the auxiliary requests then on file "without prejudice of the possibility of reintroducing any request in an appeal" (see paragraph 12 of the minutes of the oral proceedings). The conclusion cannot be drawn that the appellant has renounced his right to have auxiliary requests A-E examined in two instances.

Admissibility into the proceedings of the new main request

2. In the respondents' view, this request has to be refused because the deletion of claim 4 in the previous claim request was not caused by any objection raised by the respondents or the board and, moreover, disclaimer (i) excluding subject-matter from document D9 in claim 1 was broader than necessary, as it had to be confined to EG III cellulase from *Trichoderma* spp.

The board considers that the deletion of a dependent claim, if anything, simplifies an already complex procedure involving several conflicting applications. Moreover, disclaimer (i) pertaining to document D9 in claim 1 is not broader than necessary, as claim 1 of document D9 relates to any EG III cellulase. Therefore, the board uses its discretion to admit into the proceedings the new main request filed by the appellant in the course of the oral proceedings. This request addresses the various issues raised by the board and the respondents, in particular the conformity of disclaimers (i) and (ii) with the requirements of Article 123(2) EPC. Furthermore, the amendments made are such that the other parties could reasonably be expected to deal with it without adjournment of the oral proceedings (Article 10b RPBA).

Article 84 EPC

3. The respondents argue that the expressions "acidic cellulase" and "enriched amount" in the disclaimer (ii) (see claim 1) to subject-matter from document D11 were not clear. However, an "acidic cellulase" is a cellulase exhibiting its optimum activity at acidic pH's (i.e. < 7.0) (see document D11, page 15, second paragraph as expert opinion). Moreover the skilled person would understand that "enriched amount of acidic EG type components relative to CBH type components" in the disclaimer (ii) means that the ratio of acidic EG type components relative to CBH type components has been altered in favour of the acidic EG type components, compared with the same relative ratio if no enrichment

had occurred (see document D11, page 20, lines 15-22 as expert opinion).

4. Furthermore, it is argued by the respondents that claim 1 lacks clarity because it is not clear to what extent the fabric features referred to in claim 1 had to be improved in order for the use of a detergent composition to fall within the scope of claim 1. However, the wording of claim 1 (c.f. "as compared to treatment with complete cellulase") and the Examples in the patent (see e.g., paragraph [0139]) establish that it is not the absolute degree of improvement of the fabric parameter that matters but rather the improvement relative to a well established and measurable standard.
5. In view of the foregoing, the claims of the main request comply with the requirements of Article 84 EPC.

Article 123(2)(3) EPC

6. The respondents maintain that the meaning of the expression "endoglucanase components" and "exo-cellobiohydrolase components" is different from that of "EG type components" and "CBH type components", respectively. Therefore, the deletion of "type" in the present claims represents added subject-matter.

However, there is a basis on page 12, lines 10-11 and 17-29, page 16, lines 31-36 and page 53, line 10 of the published WO application. Therefore, present claim 1 has a counterpart in the description as originally filed with respect to "EG components" and "CBH components" devoid of "type". In addition, the wording

presently used in the claims is more limited than the "type" language being less specific (see page 13, lines 23-25 and page 15, lines 1-3 of the published WO application). Therefore, claim 1 also fulfils the requirements of Article 123(3) EPC as its scope is more limited than that of the granted version

7. The respondents maintain that there is no clear and unambiguous basis for the disclaimer (ii) in document D11. However, the passage in document D11, page 19, line 30 to page 20, line 24 represents a basis for an "acidic cellulase composition containing an enriched amount of acidic EG type components relative to CBH type components" since it discloses acid cellulases wherein the relative ratio of acidic EG type components relative to CBH type components has been altered ("enriched") in favour of the acidic EG type components, compared with the same ratio if no enrichment had occurred.
8. In view of the above considerations the claims of the main request comply with the requirements of Article 123(2)(3) EPC.

Novelty

Document D1

9. Example 4 of document D1, an intermediate document under Article 54(3) EPC, relates to a "colour clarification test" (i.e., colour retention/restoration) involving a wash liquor comprising an endoglucanase purified from *H. insolens* exhibiting "essentially no cellohydrobiolase activity" (see page 4, lines 7 to 9). According to page 35, lines 20 to 30 and the bottom of

the Table on page 36 of document D1, this enzyme is used at a concentration of 0.4 or 0.8 mg/l in a wash liquor also comprising 2g/l detergent composition (see page 35, line 21). Therefore, the above composition comprises 0.02% ($0.4 \times 100/2,000$) or 0.04% ($0.8 \times 100/2,000$) of a fungal endoglucanase devoid of exo-cellohydrobiolase activity composition based on the weight of the detergent composition and thus it falls within both the definition and the range "from about 0.01 to about 5 weight percent" given in present claim 1.

10. The Table on page 36 of document D1 shows a 30 times better performance in colour clarification achieved by using the detergent composition comprising the endoglucanase devoid of exo-cellohydrobiolase, as compared to using the same composition comprising a mixture of *H. insolens* cellulases ("the complete cellulase"). There is, however, no teaching in Example 4 that washing the cotton fabric with the composition including the endoglucanase devoid of exo-cellohydrobiolase provides improvements in softness and feel, with reduced strength loss" as compared to treatment with the composition comprising complete cellulase.
11. The opposition division decided that these features were "inherently embraced" in the test described in Example 4 of document D1, a line of argument adopted by the respondents.
12. However, this concept of "inherency" is *prima facie* at odds with the generally accepted principles for the evaluation of novelty, which require that the relevant

document of the state of the art has to provide a clear and unambiguous disclosure of the claimed subject-matter. Moreover, even if the board accepted that the features "improvements in softness and feel in combination with a reduced strength loss as compared with using the same composition including the whole cellulase" were inherent in carrying out Example 4 of document D1, this would not mean that the board is exempted from evaluating whether this feature was "hidden" or was accessible to the skilled person, or, in the words of Article 54(2) EPC, "publicly available" before the priority date of the patent in suit. This follows from the rationale emerging from decision G 2/88 (OJ EPO 1990, 93, see point 10.1), which states: *"Under Article 54(2) EPC the question to be decided is what has been "made available" to the public: the question is not what may have been "inherent" in what was made available (by a prior written description, or in what has previously been used (prior use), for example)"*. Applying this criterion to the present case, the answer to the above "accessibility" question of the features "improvements in softness and feel in combination with a reduced strength loss as compared with using the same composition including the whole cellulase" must be in the negative.

13. The respondents argue that the effect of reduction of strength loss already underlay the known use ("treating cotton-containing fabrics in order to improve their appearance or feel") of the known substance (the endoglucanase composition). Therefore, this newly discovered technical effect could not confer novelty on a claim directed to the use of a known substance for a

known non-medical purpose (see decisions T 892/94, OJ EPO 2000, 001 and T 706/95 of 28 October 1997).

14. The facts underlying decision T 892/94 (supra) were based on the discovery that the deodorising effect of aromatic esters when used as an active ingredient in deodorising products resulted from their capability of inhibiting esterase-producing micro-organisms. The case dealt with in decision T 706/95 (supra) relied on the discovery that applying the same known means led to an additional effect (the reduction of free ammonia in the effluent) when used for the same known purpose of reducing the concentration of nitrogen oxides in the same effluent. The problem thus arose as to whether or not a claim directed to the use of a known substance for a known non-medical purpose related to a **novel** use upon incorporation into the claim of the mechanism underlying that use (T 892/94) or upon incorporation of a parallel technical effect accompanying said known use (T 706/95). The then competent boards came to the conclusion that the skilled person would **not** do something that would not have been done without knowing the content of the patents. Stated otherwise, the knowledge that the aromatic esters exerted their deodorising effect via the inhibition of esterase-producing micro-organisms (T 892/94) or that an additional effect (the reduction of free ammonia in the effluent) turned up when carrying out the known use for reducing the concentration of nitrogen oxides in the same effluent (T 706/95) did not translate into a new technical application distinct from the known application.

15. It has thus to be decided whether the present situation falls within the rationale of decisions T 892/94 or T 706/95. The board first observes that the fabric parameters to be improved referred to in present claim 1, i.e. softness, colour retention/restoration, feel and strength loss are independent and distinct parameters, requiring each a specific assay for their determination. If these fabric parameters were all "entangled", representing each a different and **obligatory** aspect underlying a unique "central" technical effect, one would expect that only one test performed on one and the same cotton fabric sample would be sufficient for measuring all the parameters. However the patent in suit shows that each fabric parameter is measured separately and that this is done each time on a different cotton fabric sample (see Example 16: strength loss assay/100% woven cotton; Example 18: colour restoration/worn cotton and Example 19: softness/terry wash cloth). Moreover, the degree of improvement in a given fabric parameter depends inter alia on the "fine tuning" of the composition/concentration of the ingredients in the wash liquor (see e.g., paragraph [0054] and [0090] of the patent in suit: "...in an amount sufficient to impart..."; see also paragraph [0159]: "these results demonstrate that at **higher** cellulase concentrations, improved softening is obtained" (emphasis by the board)), the incubation time and the temperature, so that a desired improvement in fabric properties can even turn up in the absence of another improvement in fabric parameter (see e.g. Example 6 of document D1, illustrating a case wherein a stonewashed appearance is achieved with no reduction of strength loss). These facts plead against "entanglement".

16. Secondly, Example 4 of document D1 investigates on a single fabric parameter, namely "colour clarification". Thus even assuming in the respondents' favour that reduced strength loss is an obligatory explanation of the mechanism/a further obligatory effect underlying/accompanying colour clarification, there are no valid reasons (nor any teaching in document D1) for extending the same conclusions to the other fabric parameters "improvements in softness, and feel" referred to in present claim 1.
17. In summary, the feature "reduced strength loss" in claim 1 at issue can be viewed neither as the mechanism underlying the improvement in softness, colour retention/restoration and feel stated in claim 1 at issue, nor as an obligatory parallel technical effect accompanying said improvements in the above fabric parameters. More importantly, unlike the situations dealt with in decisions T 892/94 or T 706/95, the claimed subject-matter does translate into a new technical application distinct from the known application. In fact, Example 4 of document D1 merely taught using a detergent composition as defined in present claim 1 to obtain improved colour retention/restoration as compared with using the same composition including the whole cellulase. However, the technical teaching of the patent in suit, as embodied by claim 1, enables the skilled person to extent the treatment described in the prior art to cases (and garments) where cotton-containing fabrics need improvement in softness **and** improvement in colour retention/restoration **and** improvement in feel **and** reduced strength loss.

18. In summary, the use according to claim 1 and dependent claims 2 to 6 is novel over document D1.

Document D2

19. Document D2 discloses a cellulase composition as defined in claim 1 for treating cotton-containing fabrics in order to enhance colour clarification (see page 2, lines 24 to 28). As admitted by the respondents, the feature "with reduced strength loss as compared to treatment with complete cellulose" stated in present claim 1 is not explicitly disclosed in document D2. Therefore, the conclusions arrived at by the board in relation to document D1 also apply to this document.

Document D13

20. The only passages of document D13 disclosing a composition falling within the definition specified in present claim 1 relate to Example 2 and the first line of Table I (page 39), disclosing a detergent composition devoid of CBH-I ("ppm = 0") and comprising increasing amounts of EG II. However, the purpose of using these compositions was not improving any of the fabric parameters recited in present claim 1, such as reduced strength loss, but to obtain a series of reflectance values (linked to the cleaning ability: see page 36, lines 12-14) in experiments testing this parameter versus increasing concentrations of both CBH-I and EG II. Therefore, since the feature "improvements in softness, colour retention/restoration and feel, with reduced strength loss" stated in present claim 1 is not disclosed in document D13, the conclusions

arrived at by the board in relation to document D1 also apply to this document.

Documents D5, D6, D7 and D8

21. The respondents argue that these documents represent prior art pursuant Article 54(3) EPC in view of the fact that the claim to priority of the patent in suit is invalid. The board first deals with the issue of whether or not these documents disclose the use of present claim 1, because, if not, the above question need not be answered.

22. Example 16 and Fig. 10 (see "CBHId" and "CBHI/IIId"), common to documents D5, D6, D7 and D8, disclose fungal cellulase compositions including endoglucanase components which are substantially free of exo-cellobiohydrolase components. As regards the feature "a cleaning effective amount of a surfactant" in claim 1 at issue, 400 ml of the composition described in Example 16 contains 0.5 ml of a non-ionic surfactant (see e.g. document D5, page 57, lines 13-15). This concentration of surfactant is in line with the "**small** amount of surfactant" (emphasis by the board) of less than about 2% referred to on page 32, 2nd paragraph of document D5 (see also document D6, page 31, 1st full paragraph; document D7, page 32, 2nd paragraph and document D8, page 31, 1st full paragraph). On page 35, lines 2-3 of e.g. document D5, reference is made to 10-50% surfactant, however, these passage relates to the "concentrate" to be diluted upon use.

23. Therefore, documents D5, D6, D7 or D8 *prima facie* do not unambiguously teach "a cleaning effective amount of

- a surfactant". But assuming in the respondents' favour that the detergent compositions described in these documents overlap with the detergent compositions referred to in present claim 1, the board is left with the issue whether or not the documents teach the use of these composition "for washing a cotton-containing fabric", as required by the wording of claim 1 at issue.
24. The detergent compositions described in documents D5, D6, D7 or D8 are used for improving cotton-containing fabrics with regard to feel, appearance, softness, colour enhancement and reduced strength loss (see e.g., document D5, page 4, lines 20-26 and page 15, lines 5-11). These documents never use the term "washing" but rather "treating", "pre-wash" and "pre-soak" (see e.g., page 36, line 5 of document D5).
25. It is true that on page 19, lines 17-18 of e.g., document D5, reference is made to "improved cleaning" (see also document D6, page 17, lines 20-23), however, this expression relates to the hydrolysis of cellulose by the cellulase components to yield reducing sugars (see *ibidem*, lines 12-14), i.e. something different from the "washing/cleaning" of e.g. a fatty stain achieved by "a cleaning effective amount of a surfactant" (see present claim 1 and page 3, line 21 of the patent in suit). In summary, documents D5, D6, D7 and D8 disclose the use of the detergent compositions in non-cleaning situations such as treatments prior to wash.
26. The respondents argue that pre-washing or soaking is still washing in the sense that once cotton-containing fabrics are put in a laundrometer in the presence of a

detergent composition as defined in present claim 1 (see Example 16 of e.g. document D5), the fabrics would inherently be washed.

27. However, while it is true that cotton fabrics put in a laundrometer in the presence of a detergent composition as defined in present claim 1 would "inherently" be washed (depending on, inter alia, temperature, surfactant concentration and time), the question to be decided for evaluating the novelty is what has been "made available" to the public, not what might have been "inherent" in putting into practice a previous process or use (see point 12 supra). The purpose in Example 16 of e.g. document D5 is not cleaning fabrics but testing for reduction of strength loss. Furthermore, pre-wash/soak is different from washing as these techniques imply no cleaning purpose. In conclusion, the use of detergent compositions "for washing a cotton-containing fabric" according to present claim 1 is not directly and unambiguously taught by documents D5, D6, D7 or D8.
28. In view of the foregoing, these documents do not disclose the use of present claim 1 and the board need not consider the issue of entitlement to priority of the patent in suit (Article 87(4) EPC) any further.

Documents D9 and D11

29. Document D9 teaches the use of detergent compositions containing EGIII cellulase having at least 40 w.t. % of EG III based on the total weight of cellulase proteins (see page 3, lines 11-14 and page 8, lines 30-33) and a cleaning effective amount of surfactant (see page 3,

- lines 23-24) for washing a cotton-containing fabric and improving its softness, colour retention/restoration, feel and reducing its strength loss as compared to treatment with complete cellulase (see page 16, lines 3-16 and 27-33). Present claim 1 is distinguished from intermediate document D9 by the disclaimer "with the proviso that said fungal cellulase composition (b) is (i) other than a composition containing substantially pure EG III cellulase, being defined as having at least 40 w.t. % of EG III based on the total weight of cellulase proteins".
30. Document D11 teaches the use of detergent compositions containing acidic cellulase composition, i.e. having a pH optimum less than 7.0, containing an enriched amount of acidic EG type components relative to CBH type components (see page 12, lines 27-31 and page 15, lines 10-16) and a cleaning effective amount of surfactant (see page 6, lines 30-31) for washing a cotton-containing fabric and improving its softness, colour retention/restoration, feel and reducing its strength loss as compared to treatment with complete cellulase (see page 5, lines 26-27 and page 28, lines 11-12). Present claim 1 is distinguished from intermediate document D11 by the disclaimer "with the proviso that said fungal cellulase composition (b) is (ii) other than an acidic cellulase composition, ie having a pH optimum less than 7.0, containing an enriched amount of acidic EG type components relative to CBH type components".
31. Therefore the board considers that documents D9 and D11 are no longer relevant under Article 54(3) EPC to the restricted subject-matter as now claimed.

Remittal

32. The present patent was revoked for lack of novelty under Article 54(3) EPC and was based on claims different from the claims presently on file. For the purpose of the present decision the board has already examined the claims as to whether or not they fulfil the requirements of Articles 123(2)(3), 84 and 54 EPC (see points 3 to 31 supra), but, in order not to deprive the appellant of his right to have his invention examined by two instances, and in accordance with the established jurisprudence of the boards of appeal, the board uses its discretion under Article 111(1), second sentence, EPC, and remits the case to the first instance for further prosecution to consider the remaining issues.

Reimbursement of the appeal fee

33. The appellant requests that the appeal fee be reimbursed in view of an alleged substantial procedural violation by the opposition division in failing to provide a complete reasoned decision for its finding of lack of novelty. According to the case law of the boards, the requirement of Rule 68(2) EPC that a decision shall be reasoned can only be met when the chain of reasoning in the decision is complete, which means that no relevant evidence present in the proceedings and possibly having an influence on the result of the reasoning, has been omitted, or that at least some motivation on crucial points of dispute has been given. Issuing a decision without providing the appellant with any reasoning upon his main argument or

on crucial points of dispute conflicts with Rule 68(2) EPC and constitutes a substantial procedural violation.

34. In the present case, however, the decision under appeal (see paragraph 4.6) gives detailed reasons as to why document D1 discloses all the features of claim 1 of the main request then on file, except the effect of reduced strength loss. Although the requirement of Rule 68(2) EPC does not mean that all arguments submitted should be dealt with in detail, the decision under appeal fully deals with the question as to why "the second main issue of the novelty attack against Claim 1", namely the feature "reduced strength loss", although not disclosed in document D1, was "inherently embraced in the method of D1". This crucial issue for the outcome of the decision upon novelty has been dealt with by the opposition division, albeit at odds with the conclusions reached by the board.

35. It follows from the above that the decision was sufficiently reasoned, so that no substantial procedural violation occurred. The request for reimbursement of the appeal fee is therefore refused.

Order

For these reasons it is decided that:

1. The appeal is admissible.
2. The decision under appeal is set aside.
3. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 6 of the "Main request (Amended 3 May 07)".
4. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chair:

S. Sánchez Chiquero

U. Kinkeldey