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Datasheet for the decision of 4 May 2007

Case Number: T 1365/05 - 3.3.04

Application Number: 91920379.4

Publication Number: 0553280

IPC: C12S 11/00

Language of the proceedings: EN

Title of invention:
Methods for treating cotton-containing fabrics with cellulase

Patentee:
GENENCOR INTERNATIONAL, INC.

Opponent:
NOVOZYMES A/S

Headword:
Methods for treating cotton fabrics/GENENCOR INTERNATIONAL, INC.

Relevant legal provisions:
EPC Art. 123(2)(3), 84, 83, 111(1)

Keyword:
"Main request: sufficiency of disclosure (no)"
"Auxiliary request 1: clarity (no)"
"Auxiliary request 2: added subject-matter (no), broadening of the scope of protection (no)"
"Clartiy (yes), sufficiency of disclosure (yes)"
"Remittal (yes)"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1365/05 - 3.3.04

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

Appellant: (Patent Proprietor)
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Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 19 August 2005 revoking European patent No. 0553280 pursuant to Article 102(1) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I. European Patent No. 0 553 280 based on application No. 91 920 379.4 (published as WO 92/06221) and filed on 4 October 1991 was granted on the basis of 3 claims.

II. Notice of opposition was filed by the opponent requesting the revocation of the European patent on the grounds of Article 100(a) and (b) EPC. The opposition division revoked the patent for non-compliance with the requirements of Article 83 EPC of the claims of the main request and non-compliance with the requirements of Articles 123(3) and 84 EPC of the claims of the first and second auxiliary 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 1 and 2. Claim 1 of the main request read as follows:

"1. A method of reducing strength loss of cotton–containing fabrics, the method comprising treating the fabric with a fungal cellulase composition which comprises one or more endoglucanase (EG) cellulase components and is free of all exo-cellobiohydrolase (CBH) I cellulase components, wherein the method results in reduced strength loss as compared to treatment with complete cellulase."

Claim 1 of the auxiliary request 1 read as follows:

"1. A method of reducing strength loss of cotton–containing fabrics while still achieving desired enhancement in the treated fabric arising from

treatment with cellulase as compared to the fabric prior to treatment, the method comprising treating the fabric with a fungal cellulase composition which comprises one or more endoglucanase (EG) cellulase components and is free of all exo-cellobiohydrolase (CBH) I cellulase components, wherein the method results in reduced strength loss as compared to treatment with complete cellulase."

Claim 1 of the auxiliary request 2 read as follows:

"1. A method of reducing strength loss of cotton–containing fabrics while still achieving desired enhancement in feel, appearance, and/or softening in the treated fabric arising from treatment with cellulase as compared to the fabric prior to treatment, the method comprising treating the fabric with a fungal cellulase composition which comprises one or more endoglucanase (EG) cellulase components and is free of all exo-cellobiohydrolase (CBH) I cellulase components, wherein the method results in reduced strength loss as compared to treatment with complete cellulase."

Dependent claim 2 of all requests related to a specific embodiment of the method of claim 1.

IV. Together with the summons to oral proceedings, a communication under Article 11(1) 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 816/05. The parties gave their agreement.

V. Oral proceedings took place from 2 to 4 May 2007.

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

D4 WO-A-91/17243;

D13 First declaration of Dr Gibson dated 2 November 2000 with annexed data;

D13a Second declaration of Dr Gibson dated 9 May 2005;

D15 Schülein M. et al., Proceedings of the Second TRICEL Symposium on Trichoderma Reesei Cellulases and Other Hydrolases, Espoo 1993, ed. by P. Suominen & T. Reinikainen. Foundation for Biotechnical and Industrial Fermentation Research, Vol. 8, pages 109—116 (1993);

D19 WO-A-91/05841;

D20 Seiboth B. et al., Journal of Bacteriology, Vol. 179, No. 17, pages 5318-5320 (1997);

D21 Liu et al., Textile Chemist and Colorist & American Dyestuff Reporter, Vol. 32, No. 5, pages 30-36 (May 2000);

D22 Product sheet "Cellusoft™ Ultra L" from Novo Nordisk (June 1996).

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:

Main request

Article 123(2) EPC

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

Article 83 EPC

– For the purposes of the present invention, the classification of EGs and CBHs was ultimately to be linked to the "textile activity", not the classification by the traditional tests (see page 15 lines 20-24, and page 18, lines 14-19). Therefore, an EG (or a CBH) from another fungal source, as so classified by a traditional EG (or CBH) test had to be checked for its "textile activity" to see whether it resembled that of EG (or CBH) from T. reesei before it could be called an "EG" (or a CBH) for the purposes of the present invention. These tests could easily be performed by the skilled person in the light of the instructions given in the patent.

– The technical effect referred to in claim 1 was indeed obtained (see Examples 16 and 17 and Figures 10 and 12 of the patent and documents D21 and D22).

– The experiments carried out by Dr Gibson (document D13) contained a fundamental flaw in respect of the selection of the relative amounts of enzymes to be used in the comparisons. In these experiments, Dr Gibson took a mono-component EG composition, and compared it with a complete cellulase composition. However, the calculation of the weight of EG in the composition was based on the enzymatic activity, rather than actual measurement of EG protein by weight. Table 4 of document D15 showed that the compositions could have extremely different activities depending upon the number of the EG's in the composition, the concentration of each EG and their activity on a particular or specific substrate.

– Normalisation on the EGs' weights only made sense if the EG component mixtures in the cellulase compositions under comparison were essentially similar.

– The fundamental objective of the claimed method was not to produce strength loss in the fabric, but to produce other effects such as improvements in softness, feel and colour retention/restoration. Thus, the correct comparison should not be between equivalent weights of EG, but between amounts of different enzyme compositions that produced essentially the same degree of effect being sought by the treatment, and then see which provided the lower strength loss.

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

Main request
Article 123(2) EPC

– The meaning of the expressions in claim 1 "endoglucanase (EG) components" and "exo-cellobiohydrolase (CBH) I components" was different from that of "EG type components" and "CBH type components", respectively, used in the application as filed. Therefore, the deletion of "type" in present claim 1 represented added subject-matter.

Article 83 EPC

– "EG type components" and "CBH type components" (application as filed) could not be considered as synonymous with the expressions "endoglucanase (EG) components" and "cellobiohydrolase (CBH) I components" in present claim 1. Moreover, the patent did not teach how to achieve reduced strength loss across the whole scope of claim 1. As a result the skilled person was left confused as to which cellulase component could be used to achieve the specified reduction in strength loss across the whole scope of claim 1, relating to any fungal cellulase composition that comprised at least one EG component and which was free of all CBH I cellulase components, contrary to the requirements of Article 83 EPC.

– Claim 1 of the main request recited the technical effect "wherein the method results in reduced strength loss as compared to treatment with complete cellulase". However, this technical effect was not

obtained across the whole scope of the claim, as shown by test report D13 from Dr Gibson.

– Moreover, the patent in suit failed to define how the critical comparison stated in claim 1 had to be performed since there was no indication in the patent in suit that the comparison of strength loss had to be made at an amount of EG giving the same level of a fabric enhancement effect. Rather the only guidance as to how to compare the effect of different cellulase preparations was disclosed in Example 16 and Figure 10, i.e. the effect of reduced strength loss had to be compared at similar levels of total EG amounts. This omission rendered the patent in suit flawed under Article 83 EPC because the comparison was essential in defining the claimed invention.

Auxiliary request 1
Article 123(2) EPC

– Page 3, line 27 to page 4, line 2 of the published WO application referred to "desired enhancements" (plural), not to "desired enhancement" (singular) as in claim 1 of this request, hence this passage did not provide an adequate basis for the amendment.

Article 84 EPC

– It was not clear what kind of enhancement and what level of enhancement represented a "desired enhancement". The skilled person was thus not able to establish what lay outside the scope of the claim and what lay within.

Article 83 EPC

– The experiments carried out by Dr Gibson were also pertinent for claim 1 of this request.

Auxiliary request 2
Article 84 EPC

– It was not clear what level of enhancement represented a "desired enhancement". The skilled person was not able to establish what lay outside the scope of the claim and what lay within.

Article 83 EPC

– The wording of the claim did not require that the strength loss comparison be performed at the same desired enhancement level.

– The experiments carried out by Dr Gibson were also pertinent for claim 1 of this request.

IX. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 and 2 according to the main request or, alternatively, on the basis of one of the set of claims according to the auxiliary requests 1 and 2, all requests filed on 29 December 2005.

The respondent (opponent) requested that the appeal be dismissed.

Reasons for the Decision

Main request
Article 123(2)(3) EPC

1. A basis for the wording of present claim 1 is on page 33, lines 4-9 taken in combination with page 4, lines 25-28 of the published WO application.

As for Article 123(3) EPC, no broadening of the scope of granted claim 1 occurs since only a semantic change (the second "fabrics" has become "fabric") has been made.

2. The respondent maintains that the meaning of the expression "endoglucanase (EG) components" and "exo-cellobiohydrolase (CBH) I components" is different from that of "EG type components" and "CBH I type components", respectively, used in the application as filed and that the deletion of "type" in the present claim represents added subject-matter.

However, there is a basis on page 13, line 15, on page 17, lines 3 and 15 and on page 52, lines 20-21 of the published WO application for "endoglucanase (EG) components" and "cellobiohydrolase (CBH) I components" devoid of "type". Therefore, present claim 1 has a counterpart in the description as originally filed with respect to these expressions.

Article 83 EPC

3. It is the respondent's opinion that the fact that "EG type components" and "CBH type components" of the

application as filed cannot be considered as synonymous with the expressions "endoglucanase (EG) components" and "cellobiohydrolase (CBH) I components" in present claim 1 leaves the skilled person confused as to which cellulase component may be used to achieve the specified reduction in strength loss, contrary to the requirements of Article 83 EPC.

4. It is true that the published WO application refers to the broader wordings "EG type components" and "CBH type components" which are defined on page 14, lines 4 to 17 and on page 16 line 28 to page 17, line 11, respectively, where it is stated that these expressions refer to all of those fungal cellulase components or combination of components which exhibited textile activity properties similar to the EG components of T. reesei.

However, for the purposes of the present invention, the classification of EGs and CBHs is ultimately linked to the "textile activity" (reduced strength loss, improved feel, appearance, etc), not the classification by the traditional tests (see page 15, lines 5–14 for EG and page 17, line 31 to page 18, line 6 for CBH). Therefore, an EG (or a CBH) from another fungal source, so classified by a traditional EG (or CBH) test has to be checked for its "textile activity" to see whether it resembles that of EG (or CBH) from T. reesei before it can be called an "EG" (or "CBH") for the purposes of the present invention. These tests can easily be performed by the skilled person in the light of the instructions given in the patent (see paragraphs [0070] to [0076] and Examples 16 to 21). Therefore, the

skilled person is not left confused as to which cellulase component may be used.

Test report D13 by Dr Gibson

5. Claim 1 defines the technical effect to be achieved by the claimed method as being "reduced strength loss as compared to treatment with complete cellulase". In order to show that this technical effect is not obtained across the whole scope of claim 1, the respondent submitted test report D13 performed by Dr Gibson.

6. This test report, based on the instructions given in Example 16 of the patent in suit, compares the strength loss observed with a series of mono-component endoglucanase compositions (Carezyme™, Clazinase™ and IndiAge™) with that observed with a corresponding complete cellulase containing the same amount of endoglucanase components (Celluzyme™, Denimax™ and Celluclast™). The experimental results are that the "complete" cellulase (including CBH I components) turns out to be more effective than the mono-component endoglucanase in reducing strength loss, i.e. the opposite of what is reported in Example 16 of the patent.

7. Present claim 1 relates to any fungal cellulase compositions that comprise at least one EG component and which is free of all CBH I components. It is also explicitly stated in the description of the patent in suit (see paragraphs [0049], [0125] and [0126]) that the invention encompasses the use of cellulase compositions comprising a single EG component.

Therefore, the board concludes that the selection of a mono-component endoglucanase as the "fungal cellulase composition" (see claim 1) is pertinent for trying to show insufficiency of disclosure.

8. The board turns to the numerous objections to Dr Gibson's experiments raised by the appellant.

9. It is firstly argued that Dr Gibson's experiments contain a flaw in respect of the selection of the relative amounts of the cellulase compositions (mono-component EG composition vs. complete cellulase composition) since the calculation of the weight of EG in the compositions was based on the enzymatic activity, rather than on the actual measurement of the EG protein by weight. In the appellant's opinion, the measurement of the overall activity of the mixture of EGs in complete cellulase did not correlate with the total weight of EG components in the complete cellulase. This is because Table 4 of document D15 showed that the compositions could have extremely different activities depending upon the number of the EGs in the composition, the concentration of each EG and their activity on a particular or specific substrate such as carboxymethylcellulose (CMC) referred to on page 114 of document D15. Therefore, different compositions, i.e. concentrations and populations of EGs provided greatly different results in the desired improvements.

10. However, the board notes that Dr Gibson used two alternative methods of determining the amount of EG components in each cellulase composition, namely enzyme activity (measured in ECU/mg using CMC as a substrate) and total amount of EG protein (measured as ppm total

EG using rocket immunoelectrophoresis). The results of the comparative experiments were the same regardless of which of these alternative methods was used to measure the amount of EG components (see declaration D13a).

11. As a second criticism to Dr Gibson's experiments, the appellant maintains that it did not make sense to normalise the cellulase compositions to be compared on the EGs' weights (i.e., to "fine tune" the weights of the two cellulase compositions so that they comprised equal amounts of EG components and hence they achieved the same fabric improvement effect in the two treatments) when the compositions were **not similar**. The appellant argues that in Example 16 and in Figure 10 of the patent in suit, composition (inter alia) "CBHId", a cellulase from a deletion mutant of Trichoderma reesei wherein the gene encoding CBH I had been deleted, is compared with "GC010", namely a complete cellulase from the wild type T. reseei, as to the percent strength loss vs. their ppm concentration. In this Example (see page 16, lines 38-39), it is stated that the compositions were normalised so that equal amounts of EG components were used for comparison purposes. The appellant maintains that this way to proceed was justified because the EG populations in the cellulase compositions under comparison ("CBHId" vs. "GC010") were essentially **similar.** Hence one could compare them on the basis of the amount (weight) of EG (mixture) present in each and hence normalise the amounts of cellulase compositions so that they comprised equal amounts of EG components. In contrast to this, Dr Gibson compared **not similar** cellulase compositions, namely a single EG composition (Carezyme™, Clazinase™ and IndiAge™) with a complete cellulase containing many

different EGs of varying concentrations (Celluzyme™, Denimax™ and Celluclast™).

12. The board observes that depletion of CBHI in T. reesei achieves a 50% loss in the total extracellular proteins (see end of paragraph [0105]), while that of CBH-I/II represents a loss up to 70% (see paragraph [0151]). Already these facts do not plead in favour of a "similarity" between "CBHId" and "GC010" referred to in Example 16. Moreover, the similarity argued by the appellant is further put into question by document D20 (see Fig. 1), showing that deletion of the CBH1 gene led to an increase in levels of mRNA encoding CBHII while deletion of the CBHII gene led to an increase in levels of mRNA encoding CBHI, EGI and EGII. Therefore, the board is not convinced that the cellulase compositions "CBHId" and "GC010" referred to in Example 16 are more "similar" to each other than Gibson's. In any case, the feature that the "fungal cellulase composition" and the "complete cellulase" should be similar is not in claim 1 at issue.

13. Finally the appellant points out that a reduced strength loss **alone** is not intended when treating fabrics with cellulases but to produce other effects such as improvements in softness, feel and colour retention/restoration (see paragraphs [0001] and [0010] of the patent in suit) and that it is implicit to claim 1 that the treatment of fabrics with cellulases has to first achieve one or more of the above desired enhancement effects on the cotton fabrics. It is the appellant's opinion that Dr Gibson, when performing the experiments of document D13, ignored the above fundamental teaching that the comparison of strength

loss had to be made at levels of EGs giving the same fabric enhancement effect ("normalisation on the desired effect" rather than "normalisation on the weights of EG").

14. Claim 1 defines the technical effect to be achieved by the claimed method as being "reduced strength loss as compared to treatment with complete cellulase". The appellant maintains that the technical effect stated in claim 1 is in reality not "reduced strength loss" taken in isolation but "reduced strength loss in combination with one or more fabric improvement(s)" such as improvements in softness, feel and colour retention/restoration (see patent in suit, paragraphs [0001], [0010] and [0077]) and that this is the only sensible (and implicit) interpretation of claim 1.

15. As regards the former technical effect, the board considers that it has to be measured "as compared to treatment with complete cellulase" regardless of any improvement in fabric features. Paragraphs [0070] and [0071] of the patent in suit indeed illustrate a method for measuring "reduced strength loss" alone. Moreover, Example 16 of the patent (see page 16, line 38) shows that when the absolute "reduced strength loss" achieved by a cellulase composition devoid of CBHI has to be measured "as compared to treatment with complete cellulase", the cellulase compositions to be compared have first to be normalized so that equal amounts of EG components are used ("normalisation on the weights of EG").

16. As for the latter technical effect ("reduced strength loss in combination with one or more fabric

improvement(s)"), the respondent argues that the patent is insufficient for failing to disclose any details as to how the comparison should be performed. In the board's view, however, the skilled person would understand that the comparison of strength loss has to be made "as compared to treatment with complete cellulase", however, after one or more fabric enhancement effect(s) has/have taken place" vis-à-vis the fabric prior to treatment". To the mind of a skilled person willing to understand, not desirous of misunderstanding (see Case Law of the Boards of Appeal of the European Patent Office, 5th edition, 2006, page 205), this can only mean that this comparison has to be carried out at levels of EGs giving the same fabric enhancement effect(s) ("normalisation on the desired effect(s)"), since to measure reduced strength loss at different levels of desired effect(s) does not make any technical sense.

17. In view of the findings in points 15 and 16 supra, the board judges that "reduced strength loss" alone and "reduced strength loss in combination with one or more fabric improvement(s)" are two **different** technical effects characterised by two distinct methods for their determination. Consequently, it has to be established which of the above mentioned technical effects is presently covered by claim 1. This is a fundamental issue for a skilled person wishing to reproduce the invention and wishing to know whether he/she is working within or outside the ambit of claim 1.

18. The appellant strongly argues (see point 13 supra) that present claim 1 can only relate to "reduced strength loss in combination with one or more fabric

improvement(s)", the only sensible interpretation of claim 1.

19. The board first observes that the fabric parameters to be improved such as softness, colour retention/restoration, feel and strength loss are independent and distinct parameters, requiring each a specific method/assay for their production/determination (see paragraphs [0070] to [0076] and Example 16 to 21 of the patent). 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 [0080]: "a concentration sufficient for the intended purpose" and paragraph [0163]: "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 D4, illustrating a case wherein a stonewashed appearance was achieved with no reduction of strength loss). That reduced strength loss can turn up in the absence of a concomitant improvement in softness can be derived from a comparison of Figure 10 (illustrating a reduced strength loss in the interval 20-60 ppm) with Figure 13 (showing no improved softening in the same interval, in line with paragraph [0163]).

20. Secondly, according to paragraphs [0013] and [0090] of the patent, obtaining reduced strength loss alone is in fact one aspect of the "present invention" and

paragraphs [0070], [0071] and Example 16 of the patent illustrate methods for measuring this "reduced strength loss" alone without further concomitant textile improvements. Finally, it should be noted that a claim defines the scope for which protection is sought: it can be a matter of protection strategy to claim a technical effect disclosed in a patent, although it represents only "one face of the medal". Thus the appellant's criticism to interpreting claim 1 as relying on "reduced strength loss" alone as technical effect has to be balanced with the above facts, all the more so as the comparison ("normalisation on the desired effect(s)") suggested by the patentee is not specified in the claim.

21. In view of the foregoing, the board finds it plausible that claim 1 covers within its scope a method based on "reduced strength loss" alone as technical effect.

22. As a consequence, the experiments by Dr Gibson based on the approach of "normalisation on the weights of EG" are pertinent for showing insufficiency of disclosure of the claimed subject-mater. These experiments on file since October 2002 have been questioned by the appellant only in relation to the used methodology (which the board considers to be correct), but not in the final results. They show that the reduced strength loss which is exemplified in the patent in suit for cellulase preparations from CBH-deleted mutant of T. reesei is not a general effect which can be achieved by any of the "fungal cellulase" preparations encompassed by claim 1, because this technical effect is not observed when the "fungal cellulase" of claim 1 is a mono-component EG composition. This finding is at

odds with the requirements of Article 83 EPC and the main request must thus be refused.

Auxiliary request 1

23. In claim 1 of this request, it has been made clear that the technical effect to be achieved is reducing strength loss, while still achieving desired fabric enhancement in the treated fabric.

Article 123(2)(3) EPC

A basis for the wording of present claim 1 is on page 3, line 27 to page 4, line 2 and on page 5, line 30 to page 6, line 4 of the published WO application. It should be noted that on page 5, last line, the term "enhancement(s)") is both plural and singular. Therefore, the board does not adhere to the respondent's objection that the WO application does not provide an adequate basis for the amendment "desired enhancement" (singular).

As for Article 123(3) EPC, no broadening of the scope of granted claim 1 occurs since the claim is now restricted to a more demanding situation where not only reduction of strength loss but also a fabric enhancement effect have to simultaneously turn up.

Article 84 EPC

24. One of the two technical effects to be achieved according to the method of claim 1 is a "desired fabric enhancement in the treated fabric". However, in the board's view, the skilled person is left confused as to

which fabric enhancement is meant. It is not clear whether this "desired fabric enhancement" is one of those referred to in paragraph [0012] of the patent (feel, appearance, softness, color enhancement and stone-washed appearance) or it can also be "reduced harshness" (see paragraph [0004]), "improved cleaning to the detergent composition" (see paragraph [0054]), "resistance to redeposition" (see paragraph [0079]) or "degradation resistance" (see document D19, page 6, line 22), the latter four of the list being possibly not linked to EG treatment and hence reduced strength loss.

25. Therefore, claim 1 of this request does not satisfy the requirements of Article 84 EPC and this request is refused.

Auxiliary request 2

26. According to claim 1 of this request, the technical effect to be achieved by the claimed method is reducing strength loss, while still achieving desired fabric enhancement in feel, appearance and/or softening in the treated fabric.

Article 123(2)(3) EPC

27. A basis for the wording of present claim 1 is on page 3, line 27 to page 4, line 2 and on page 5, line 30 to page 6, line 4 taken in combination with page 4, lines 19-23 of the published WO application.

As for Article 123(3) EPC, no broadening of the scope of granted claim 1 occurs since the claim is now

restricted to a more demanding situation where not only reduction of strength loss but also one or more fabric enhancement(s) in feel, appearance and/or softening have to simultaneously turn up.

Article 84 EPC

28. The respondent argues that claim 1 does not state to what extent the fabric features have to be improved in order that reduced strength loss be measured. However, the wording of claim 1 (cf. "as compared to the fabric prior to treatment" and "as compared to treatment with complete cellulase") establishes that it is not the absolute degree of improvement of the fabric parameter(s) that matters as long as the skilled person measures one or more improvement(s) **relative** to well established and measurable standards ("fabric prior to treatment" and "complete cellulase") at levels of EGs giving the same fabric enhancement effect(s), which is the only way to proceed that makes technical sense (see point 16 supra).

Article 83 EPC

29. Since the technical effect to be achieved according to claim 1 of this request is the reduction of strength loss in combination with one or more fabric improvement(s) in feel, appearance and/or softening in the treated fabric (see point 26 supra), the measuring approach based on the "normalisation on the desired effect(s)" (see point 16 supra) has to be adopted. Dr Gibson in his experiments D13 wished to measure reduced strength loss alone and hence a different approach was adopted, namely that based on the

"normalisation on the weights of EG" (see point 15 supra). In view of this, these experiments are no longer relevant for questioning the claimed subject-matter under Article 83 EPC.

30. The respondent argues that Dr Gibson's tests implicitly used cellulase concentrations at which desired effects (enhancement in feel, appearance and/or softening) had of necessity to take place. However, there is no evidence before the board that this was the case (reduced strength loss may show up in the absence of an improvement in fabric property: see point 19 supra), let alone evidence that Dr Gibson "fine tuned" his cellulase compositions to achieve a "normalisation on the desired effect(s)".

31. Therefore, in the absence of evidence to the contrary, the board concludes that claim 1 and dependent claim 2 of this request satisfy the requirements of Article 83 EPC.

Remittal

32. The present patent was revoked for non-compliance with the requirements of Article 83 EPC of the claims of the main request and non-compliance with the requirements of Articles 123(3) and 84 EPC of the claims of the first and second auxiliary request, i.e., 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 83 EPC (see points 1 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.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 and 2 of auxiliary request 2 filed on 29 December 2005.

The Registrar: The Chair:

P. Cremona U. Kinkeldey