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**Datasheet for the decision
of 31 March 2009**

Case Number: T 0107/07 - 3.3.06

Application Number: 95870042.9

Publication Number: 0684304

IPC: C11D 3/386

Language of the proceedings: EN

Title of invention:

Cleaning compositions containing bleach and stability-enhanced
amylase enzymes

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponent:

HENKEL AG & Co. KGaA
Unilever N.V.

Headword:

Oxidative stability-enhanced amylase/PROCTER & GAMBLE

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Allowability of disclaimer (all requests): no - document on
which disclaimer is based not novelty destroying"

Decisions cited:

G 0001/03, G 0001/93, T 0351/98

Catchword:

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Case Number: T 0107/07 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 31 March 2009

Appellants:

(Patent Proprietor)

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted
21 December 2006 concerning maintenance of
European patent No. 0684304 in amended form.**

Composition of the Board:

Chairman: P.-P. Bracke
Members: L. Li Voti
J. Van Moer

Summary of Facts and Submissions

I. The present appeal is from the decision of the Opposition Division to maintain in amended form European patent no. 0 684 304 concerning a cleaning composition containing an oxygen bleach system and an oxidative stability-enhanced amylase enzyme.

In their notices of opposition the Opponents 01 and 02 sought revocation of the patent on the grounds of Articles 100(a), (b) and (c) EPC.

II. The Opposition Division, referring in its decision *inter alia* to document (12): WO-94/14951, found that

- the disclaimer contained in claim 1 according to the then pending main and auxiliary requests was based on the wording of the characterising feature of claim 1 of document (12), which had been cited during examination as state of the art under Article 54(3) EPC against the novelty of the claimed subject-matter;

- although this disclaimer had been added to claim 1 before publication of the decision G 1/03 (OJ 2004, 413), the principles of legitimate expectation did not prevent the application of this decision retrospectively to the present case;

- the disclaimer had been drafted in accordance with the criteria outlined in decision G 1/03 and thus complied with the requirements of Article 123(2) EPC;

- however, the subject-matter of claim 1 according to the then pending main request lacked an inventive step in the light of the teaching of the cited prior art;

- to the contrary, the subject-matter of the claims according to the then pending auxiliary request complied with all the requirements of the EPC.

III. Appeals were filed against this decision by both Opponents 01 and 02 and by the Patent Proprietor.

With the letter of 27 April 2007 the Patent Proprietor submitted two sets of claims as main request and auxiliary request, respectively, the independent claims 1 of which being substantially identical with those of the requests dealt with in the decision under appeal.

Oral proceedings were held before the Board on 31 March 2009.

During oral proceedings the Patent Proprietor submitted two new amended sets of claims to be considered as second and third auxiliary requests, respectively. The auxiliary request of 27 April 2007 thus was named first auxiliary request.

IV. The set of claims according to the main request contains an independent claim 1 reading as follows:

"1. A cleaning composition comprising: a) a catalytically effective amount of an oxidative stability-enhanced amylase enzyme developed by conventional genetic engineering techniques, said

stability-enhancement being relative to the parent/non-mutant form of said amylase enzyme, provided that no naturally occurring tyrosine residues has/have been deleted or substituted with a different amino acid residue; and b) an effective amount of an oxygen bleach system, said oxygen bleach system comprising one or more bleach-improving materials selected from the group consisting of: i) diacyl peroxides; ii) quaternary substituted bleach activators with a source of hydrogen peroxide; iii) quaternary substituted peracids; iv) transition-metal bleach catalysts with a source of hydrogen peroxide; and v) mixtures thereof."

Claim 1 according to the first auxiliary request differs from that according to the main request only insofar as the list of bleach-improving materials consists of i) quaternary substituted bleach activators with a source of hydrogen peroxide; ii) quaternary substituted peracids; and iii) mixtures thereof.

Each claim 1 according to the second and third auxiliary requests differs from those according to the main request and the first auxiliary request, respectively, only insofar as the oxidative stability-enhanced amylase enzyme is specified to be an α -amylase.

V. The Opponents 01 and 02 submitted in writing and orally *inter alia* that

- the disclosure of document (12) did not destroy the novelty of the subject-matter of claim 1 according to each request when read without the disclaimer;

- furthermore, the introduction of the disclaimer into claim 1 provided a technical contribution since it excluded amylases having more stability in the presence of peroxidase systems as shown in document (12), which group of amylases was part of the invention according to the originally filed documents of the application;
 - therefore, the disclaimer over document (12) contained in these claims 1 was not allowable;
 - each claim 1 according to the main request and the first to third auxiliary requests thus contravened the requirements of Article 123(2) EPC.
- VI. The Patent Proprietor submitted in writing and orally *inter alia* that
- the disclaimer contained in claim 1 had been drafted in a concise and clear way as required in the decision G 1/03 and was based on the disclosure of document (12);
 - moreover, as explained in G 1/03, a disclaimer does not provide any technical contribution to the technical teaching of the claimed subject-matter; therefore, its introduction into claim 1 has to be considered admissible in view of G 1/93 (OJ 1994, 541);
 - each claim 1 according to the main request and the first to third auxiliary requests thus complied with the requirements of Article 123(2) EPC.
- VII. The Opponents 01 and 02 request that the decision under appeal be set aside and that the patent be revoked.

VIII. The Patent Proprietor requests that the decision under appeal be set aside and the patent be maintained on the basis of the main request filed with letter of 27 April 2007, or, in the alternative, on the basis of the first auxiliary request filed with same letter or of the second or third auxiliary requests submitted during oral proceedings.

Reasons for the Decision

1. *Main request*

1.1 *Article 123(2) EPC*

1.1.1 Claim 1 according to the main request contains a limitation of the extent of component (a) in the form of a negative technical feature, i.e. in the form of a so-called disclaimer.

This disclaimer, which reads "**provided that no naturally occurring tyrosine residues has/have been deleted or substituted with a different amino acid residue**" is based on the characterising part of claim 1 of document (12), a document constituting prior art under Article 54(3) EPC, which had been cited during examination against the novelty of the then pending claim 1.

It is undisputed that the original documents of the application do not contain any disclosure of such a disclaimer.

1.1.2 It is the established jurisprudence of the Boards of Appeal of the EPO that the introduction into a claim of a disclaimer not finding support in the original documents of the application may be allowable in order to restore novelty by delimiting a claim against a state of the art under Article 54(3) EPC (see G 1/03, point 2.1.3 of the reasons; T 351/98, point 11 of the reasons). However, it is the consistent jurisprudence of the Boards of Appeal of the EPO before and after the publication of G 1/03, that the introduction of a disclaimer based on a state of the art is not allowable if said state of the art does not destroy the novelty of the claim in question (see G 1/03, point 2.6.5 of the reasons and Case Law of the Boards of Appeal of the EPO, 5th edition, 2006, III.A.1.6.3(c), pages 256 to 259).

For example, G 1/03 underlines that a disclaimer may serve **exclusively** the purpose for which it is intended and nothing more and that, in the case of a disclaimer concerning conflicting applications, its purpose is to establish novelty with respect to a prior application in the sense of Article 54(3) EPC. Therefore, if a disclaimer has effects which go beyond its purpose as stated above, it is or becomes inadmissible (point 2.6.5 of the reasons).

1.1.3 The Board notes that document (12) discloses compositions comprising a peroxidase system including a bleach-improving material not belonging to the classes (i) to (v) listed as essential technical features in claim 1 according to the main request (see document (12), claims 1 and 19; page 12, lines 24 to 30, and

point IV above). This fact has not been disputed by the Patent Proprietor.

Therefore, the disclosure of document (12) cannot be considered to anticipate the subject-matter of claim 1 without the disclaimer.

Under these circumstances the disclaimer contained in claim 1 and based on the disclosure of document (12) is unallowable since it has been drafted on the basis of a state of the art which could not destroy the novelty of the claim in question.

1.1.4 The Patent Proprietor has also submitted during oral proceedings that the disputed disclaimer was added to claim 1 for the only purpose of excluding a conflicting application, i.e. document (12); therefore, such a disclaimer has to be considered not to have bearing on the technical information of the application and not to contribute to the technical teaching of the claimed subject-matter; its addition to claim 1 thus cannot be considered to contravene the requirements of Article 123(2) EPC for the reasons given in G 1/93 and G 1/03 (see for example, G 1/93, headnote 2 and G 1/03, point 3 of the reasons).

However, as regards the decision G 1/03, it specifies that a disclaimer excluding a conflicting application, only excluding subject-matter for legal reasons, is required to give effect to Article 54(3) EPC and has no bearing on the technical information in the application (points 2.1.3 and 3 of the reasons), the disclaimer in question does not comply with the requirements listed in G 1/03 for an allowable disclaimer since it has been

drafted on the basis of a document which cannot destroy the novelty of the claimed subject-matter, as explained above. Therefore, for this reason, it cannot be considered to be a disclaimer excluding subject-matter for legal reasons only and, consequently, not providing any technical contribution to the claimed subject-matter.

As regards the decision G 1/93, the Board agrees that, according to this decision, a feature which has not been disclosed in the application as filed but which has been added to the application during examination and which, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, is not to be considered as subject-matter which extends beyond the content of the application as filed within the meaning of Article 123(2) EPC (see headnote 2).

However, also according to this decision, the idea underlying the requirements of Article 123(2) EPC is that an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application (G 1/93, point 9 of the reasons). Therefore, if such a feature added to a claim is found to provide a technical contribution to the subject-matter of the claimed invention, it would give the applicant an unwarranted advantage and the

amendment is to be considered contrary to the requirements of Article 123(2) EPC (see G 1/93, point 16 of the reasons).

In the present case the disputed disclaimer, as submitted by the Opponents during oral proceedings, is a feature providing necessarily a technical contribution to the claimed subject-matter since it excludes amylases having more stability in the presence of peroxidase systems as shown in document (12), which group of amylases was part of the invention according to the originally filed documents of the application (see original claim 1); therefore, the disclaimer, by modifying the technical characteristics of the amylases of claim 1, in this case their oxidative-stability, necessarily gives the Patent Proprietor an unwarranted advantage by restricting the claimed subject-matter to a group of amylases having a particular technical effect different from that of the state of the art.

Therefore, in the Board's view, even taking into account the above mentioned arguments submitted by the Patent Proprietor, the disclaimer in question constitutes an amendment that contravenes the requirements of Articles 123(2) EPC.

- 1.1.5 The Board concludes that claim 1 according to the main request does not comply with the requirements of Article 123(2) EPC.

2. *First to third auxiliary requests*

2.1 Each claim 1 according to any of first to third auxiliary requests contain the same disclaimer as claim 1 according to the main request (see point IV above).

Therefore, for the same reasons mentioned above, each claim 1 according to these requests does not comply with the requirements of Articles 123(2) EPC.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The patent is revoked.

The Registrar:

The Chairman:

G. Rauh

P.-P. Bracke