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Datasheet for the decision of 19 January 2010

Case Number: T 0229/07 - 3.3.01

Application Number: 97950995.7

Publication Number: 0963157

IPC: A01N 31/02

Language of the proceedings: EN

Title of invention:
Hydroalcoholic compositions thickened using surfactant/polymer complexes

Patentee:
MINNESOTA MINING AND MANUFACTURING COMPANY

Opponent:
Bode Chemie GmbH & Co.

Headword:
Hydroalcoholic compositions/3M

Relevant legal provisions:
EPC Art. 100(a),(b),(c), 84
RPBA Art. 12(4), 13(1)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Admission of a document not admitted before the opposition division (yes) - more relevant than the previously cited documents"
"Admission of amended claims submitted during oral proceedings (yes) - amendments specified in a previous letter"
"No grounds under Article 100(b) or (c) prejudice the maintenance of the patent"
"Novelty (yes)"
"Main Request: Inventive step (no) - obvious alternative suggested in the closest prior art"
"First Auxiliary Request: Inventive step (yes)"
"Remittal to the first instance with the order to adapt the description"

Decisions cited:
T 0051/98, T 0012/81

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0229/07 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 19 January 2010

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 21 December 2006 rejecting the opposition filed against European patent No. 0963157 pursuant to Article 102(2) EPC 1973.**

Composition of the Board:

Chairman: P. Ranguis
Members: C. M. Radke
C.-P. Brandt

Summary of Facts and Submissions

I. The opponent appealed against the decision of the opposition division to reject the opposition against European patent no. 0 963 157.

II. The following documents were cited during the opposition procedure:

(D1) DE-A-38 27 561
(D2) EP-A-0 159 167
(D3) WO-A-93/25 624
(D4) DE-A-37 16 381
(D5) DE-A-38 03 022
(D6) US-A-4 956 170
(D7) Decision T 541/98 of 10 February 2000.

III. The opposition was based on grounds under Article 100(a) (lack of novelty and inventive step), (b) and (c) EPC.

IV. The opposition division considered that no grounds under Article 100(b) and (c) EPC prejudiced the maintenance of the patent. It did not admit document (D6) into the proceedings as it was late filed and not deemed to be prima facie relevant. It considered the subject-matter claimed to be novel and inventive as it differed from the disclosure of example 11 of document (D1) and because none of the documents (D1) to (D5) concerned the thickening of hydroalcoholic compositions.

V. The following documents were *inter alia* additionally cited during the appeal proceedings:

(D8) Letter of Prof. B. W. Müller to Dr. S. Eggerstedt dated 05 April 2007, one page
(D9) First expert opinion of Lothar Gehm "Gutachten in Sachen Viskositätsbestimmung von Proben", dated 29 March 2007, six pages
(D10) Leaflet "Technical Information Chemicals Ethomeen® C/25", Akzo Nobel Surface Chemistry LLC, Chicago/US, "Printed 02/26/03", two pages
(D11) Leaflet "78086 Ethomeen® C/25, Polyoxyethylen(15)kokosamin"; Kremer Pigmente, Aichstetten/DE; one page, not dated
(D12) Second expert opinion ("Gutachten") of Lothar Gehm, dated 19 November 2009, ten pages

V. The present decision is based on the following sets of claims:

claims 1-19 as of the Main Request;
claims 1-18 of the First Auxiliary Request;
claims 1-18 of the Second Auxiliary Request;
claims 1-19 of the Third Auxiliary Request;
claims 1-19 of the Fourth Auxiliary Request;
claims 1-19 of the Fifth Auxiliary Request;
all submitted during the oral proceedings before the Board on 19 January 2010.

Claim 1 of the Main Request reads as follows:

" 1. A hydroalcoholic composition comprising:
(a) a C_1 to C_4 alcohol and water in a weight ratio of at least 20:80; and

(b) a thickener system comprising a complex of at least one charged polymer which is acidic, basic or permanently charged, whereby if the polymer is basic the polymer comprises at least three ionizable groups selected from primary amine, secondary amine; and tertiary amine; if the polymer is permanently charged the polymer comprises at least three quaternary amine groups; and if the polymer is acidic the polymer comprises at least three ionizable groups selected from hydrogen sulfate, sulfonic acid, hydrogen phosphate, phosphonic acid and carboxylic acid and at least one oppositely charged surfactant, of the formula $(R)_a(L)_b$ wherein "R" represents a hydrophobic group; "L" represents a hydrophilic group having at least one ionic group; and "a" and "b" are independently 1-4;
wherein:

(A) the hydrophobic group of the at least one surfactant comprises an alkyl group of at least 16 carbon atoms, an alkenyl group of at least 16 carbon atoms, or an aralkyl or an aralkenyl group of at least 20 carbon; wherein if the surfactants are comprised of a mixture of chain lengths, the chain length specified herein refers to the number average chain length.

(B) the hydrophilic group of the at least one surfactant comprises at least one primary, secondary, or tertiary amine, a quaternary amine, an acidic group, or an anionic group derived from an acidic group or salt of an acidic group on the surfactant, wherein the acidic group is selected

from the group consisting of $-OSO_2OH$, $-SO_2OH$, $(-O)_2P(O)OH$, $-OP(O)(OH)_2$, $-OP(O)(OH)(O^-M^+)$, $-PO(OH)_2$, $-PO(OH)(O^-M^+)$, $-CO_2H$, and mixtures thereof; wherein, M^+ is a positively charged counterion and is selected from the group consisting of hydrogen, sodium, potassium, lithium, ammonium, calcium, magnesium or $N^+R'_4$ where each R' is independently an alkyl group of 1 to 4 carbon atoms, optionally substituted with N, O, or S atoms;

(C) the at least one polymer and the at least one surfactant are selected in amounts such that:

(i) the composition does not separate more than 10% by volume after centrifugation at 1545 x g for 30 minutes and has a viscosity greater than that of the same composition with either the polymer or the surfactant absent; and

(ii) the composition has a viscosity of at least 4,000 centipoise at 23°C, when free of auxiliary thickeners;
wherein the viscosity is measured at 23 °C at ambient pressure using a Brookfield LVDV-I+ viscometer equipped with a model D Brookfield heliopath and T spindles B-F; the spindle and speed are chosen for each particular sample such that the viscometer is operating in the middle of its range; all samples are allowed to equilibrate at 23 °C for 24 hours prior to measurement; the viscosity is taken at the lowest speed possible while staying within 20-80 % of the viscometer range; in all cases the sample size and container geometry are chosen to ensure that there are no

wall effects; the following table outlines the spindles for various sample viscosities

Sample Viscosity	T Spindle to Use
1,000-100,000	B
10,000-200,000	C
50,000-500,000	D
100,000-1,250,000	E
500,000-3,000,000	F

the viscosity of each sample is taken as the highest relatively stable reading achieved on the first path the spindle traverses using the heliopath adapter."

Claim 1 of the First Auxiliary Request differs from claim 1 of the Main Request in that the former contains the following additional provision at the end of the claim:

"and wherein the thickener system comprises at least one surfactant that is solid at ambient temperature".

VI. The arguments of the Appellant may be summarised as follows:

(a) The sets of claims submitted during the oral proceedings before the Board were late filed. As the claims were amended by incorporating features from the description, the Appellant could not expect such amendments and did not have sufficient time to prepare suitable arguments.

(b) It considered document (D6) to be very relevant and deemed it to be in the proceedings as it was

the first prior art document cited in the patent in suit.

(c) It raised the following objections under Article 100(c) EPC against claim 1 of the Main Request and of the First Auxiliary Request:

(i) The three alternative conditional features of the polymer "... if the polymer is basic the polymer comprises ...", "... if the polymer is permanently charged the polymer comprises ..." and "... if the polymer is acidic the polymer comprises ..." had no basis in the application as originally filed.

(ii) The application as originally filed did not disclose that the polymer and the surfactant were to be chosen such that "the composition does not separate more than 10 % by volume after centrifugation at 1545 x g for 30 minutes".

(iii) The application as filed did not disclose a minimum of 20 carbon atoms for the aralkyl and aralkenyl groups in feature (A) of claim 1 as granted.

(iv) The method of determining the viscosity now incorporated into claim 1 was only disclosed in the description as originally filed for the examples "(except where indicated)".

(d) It also argued that the amendments made with respect to the claims as granted rendered the claims unclear because

- the viscosity could not be measured in a reliable and unambiguous way according to the method now incorporated into the claims; and
- it was not clear to which definition the term "specified herein" in the feature "wherein if the surfactants are comprised of a mixture of chain lengths, the chain length specified herein refers to the number average chain length" referred.

(e) Its objections under Article 100(b) EPC were based on the arguments

- that no thickening complex could be obtained when combining an ionic surfactant and an ionisable polymer, and
- that the viscosity could not be determined in a reliable way using the information of the patent in suit.

(f) It considered the subject-matter of claim 1 of the Main Request not to be novel in view of document (D6). The test reports (D8), (D9) and (D12) confirmed that the product of example 19 of document (D6) met the stability and viscosity requirements of present claim 1. Document (D6) also disclosed surfactants the hydrophobic alkyl chains of which contained 18 carbon atoms.

(g) Moreover, the Appellant considered the subject-matter of claim 1 of the Main Request and of the First Auxiliary Request not to be inventive. As no

effect was shown in view of document (D6) as the closest prior art, the problem to be solved could only be considered as to provide alternative thickened hydroalcoholic compositions suitable for disinfecting hands. The solution provided in claim 1 of the Main Request was obvious as document (D6) explicitly cited surfactants having the required long chain alkyl groups. The same applied to claim 1 of the First Auxiliary Request as several of the surfactants cited there were believed to be solid at ambient temperature.

VII. The Patent Proprietor and Respondent claimed that document (D6) was late filed and should not be admitted, indicated the basis for the amendments in the application as filed and, as to Article 100(b) EPC, referred to its counterarguments brought forward during opposition. The subject-matter of the claims differed from that disclosed in example 19 of document (D6) in that the surfactant ETHOMEEN C/25 used therein did not have an average number of at least 16 carbon atoms in the alkyl chain.

The problem solved by the patent in suit was to provide products useful for skin disinfection and lotions that were easily washed off the hands and were less irritant to the skin, and to provide such viscous compositions that did not require a high molecular weight polymeric thickener. Solid surfactants as required in the claims of the First Auxiliary Request provided the compositions with a higher melting point, so that they did not dribble off the hands and were easier handled and shipped. Inventive step should be acknowledged as

document (D6) neither suggested these advantages nor indicated how they could be achieved.

VIII. The Board issued a communication reflecting the preliminary opinion of the Board. In particular, it set out the reasons why it was within the discretion of the Board whether or not to admit document (D6) into the proceedings and what were the possible reasons for doing so. Moreover, it expressed doubts as to whether features only disclosed in the description could be read into the claims when assessing novelty in view of document (D6).

IX. The Appellant requested that the decision under appeal be set aside and that the patent be revoked. Furthermore it requested that the sets of claims submitted during the oral proceedings before the Board should not be admitted into the proceedings.

The Respondent requested that the patent be maintained on the basis of the Main Request or, in the alternative, on the basis of one of the First to Fifth Auxiliary Requests, all filed during the oral proceedings before the Board. Moreover, it requested that document (D6) should not be admitted into the proceedings.

X. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. The claims submitted during the oral proceedings before the Board

2.1 These claims of the Main Request and the First to Fifth Auxiliary Requests differ from the six sets of claims filed on 14 December 2007 in response to the statement setting out the grounds for appeal only in that the following two features were taken from the description into the independent claims:

The method of measuring the viscosity and the requirement that "if the surfactants are comprised of a mixture of chain lengths, the chain length specified herein refers to the number average chain length" (see point V above).

2.2 In said response filed on 14 December 2007 the Respondent read these two features into the claims when assessing novelty (see paragraph 5.1 on pages 6-8). In its communication annexed to the summons to oral proceedings filed on 17 September 2009, the Board expressed its doubt whether the two features had any limiting effect on the claims as long as they did not form part of the claims (see point VIII above). In its letter dated 19 November 2009, the Respondent offered to insert the two features into the claims and indicated precisely the wording of these insertions (see the penultimate paragraph in section 2.1.1 and the second paragraph in section 2.1.2). The claims amended

accordingly were submitted during the oral proceedings on 19 January 2010.

2.3 Hence, the amendments were an appropriate reaction to the communication of the Board. They were not late filed as their wording was filed about two months after said communication was received. The Appellant had had ample time to prepare his arguments within the two months from the filing of the wording of the amendments to the date of the oral proceedings. Therefore, the Board admitted the claims of the Main Request and the First to Fifth Auxiliary Requests presented during the oral proceedings into the proceedings (see Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA), Supplement to OJ EPO 1/2009, 41).

3. Document (D6)

3.1 Document (D6) was first cited during the oral proceedings before the opposition division and was not admitted into the proceedings.

3.2 The Appellant was of the opinion that this document already formed part of the proceedings as it is cited in the patent in suit (see decision T 541/98, cited as (D7)). In the decision (D7), a document - a reference to which was inserted into the description on request of the examining division and which was considered to represent the closest prior art - was deemed to form part of the opposition proceedings (see point 2.1 of the reasons). In contrast to this, document (D6) is cited as one of seven documents in the application as filed in a way that it is not clear whether it might be the closest prior art (see page 2, lines 20-24). The

present situation being different from that of decision (D7), the Board sees no reason to assume that document (D6) already formed part of the proceedings.

3.3 Hence, it was within the discretion of the Board to decide whether or not to admit document (D6) to the proceedings (see Article 12(4) RPBA).

One of the possible criteria which might be taken into account when exercising this discretion is the relevance of the document. The patent in suit relates "to compositions useful as surgical hand preparations and antimicrobial hand lotions." (see its paragraph [0001]). Whereas neither of the documents (D1) to (D5) share this objective with the patent in suit, document (D6) does (see (D6), column 1, lines 6-9: "This invention relates to an antimicrobial alcoholic gel composition for disinfecting the hands ... ."). Hence, document (D6) is more relevant than the documents previously cited. Therefore, the Board admitted it into the proceedings.

4. Articles 100(c) and 123 EPC

4.1 Main Request

4.1.1 The three alternative conditional features of the polymer mentioned under point VI.(c)(i) above are disclosed in the applications as originally filed as follows:

- "... if the polymer is basic the polymer comprises ..." on page 11, lines 16-18;

- "... if the polymer is permanently charged the polymer comprises ..." on page 9, lines 15-18 and 29-30; and
- "... if the polymer is acidic the polymer comprises ..." on page 12, lines 3-5.

4.1.2 The Appellant argued that the application as originally filed disclosed that not only the polymer and the surfactant were to be chosen such that "the composition does not separate more than 10% by volume after centrifugation at 1545 x g for 30 minutes " (see under point VI(c)(ii) above). It referred to page 26, lines 9-11 of the application as filed which reads as follows: "Although a thickener system is responsible for the stability and overall consistency ..., emollients may also affect the viscosity, stability, ...". It concluded that also the emollient was responsible for the stability of the composition. This arguments does not take into account that emollients are only optional ingredients (see page 22, lines 14-18 of the application as filed). Hence, the application as filed does disclose that primarily the thickener system, namely the amounts of polymer and surfactant, are to be selected such that the conditions (C) of present claim 1 are met.

4.1.3 The minimum of 20 carbon atoms for the aralkyl and aralkenyl groups in feature (A) of claim 1 as granted is disclosed in the application as filed on page 13, line 7 ("...; or an aralkyl or aralkenyl group of at least 20 carbon atoms, ...") (see under point VI(c)(iii) above).

4.1.4 The method of determining the viscosity now incorporated into claim 1 is disclosed on page 35, line 26, to page 36, line 14, of the application as filed. The application as filed does not indicate any other method of measurement for the viscosity. Hence, the fact that this disclosure refers to "the following Examples (except where indicated)" does not limit this disclosure to special embodiments of the original disclosure. Therefore, the Board does not follow the argument of the Appellant summarised under point VI(c)(iv) above.

4.1.5 The remaining features of claim 1 are disclosed in the application as originally filed in claim 1, on page 7, lines 14-16 ("C_1 to C_4-alcohol"), in claim 7 (the formula of the surfactant), page 15, lines 8-13 (average chain length of the surfactants), in claim 8 (condition (A)), on page 13, lines 11-21 (condition (B) and in original claim 18 (condition (C)(i)).

4.1.6 The additional features of claims 2-19 are disclosed in original claims 2-6, 12-17, 19, 21, and 22, on page 16, lines 1-7 of the original description, and in original claims 23-25.

4.1.7 Furthermore, the amendments with respect to the claims as granted, namely the insertions mentioned under point 2.1 above, restrict the extent of protection.

4.1.8 Hence, the claims of the Main Request meet the requirements under Article 123 EPC and no grounds under Article 100(c) EPC prejudice the maintenance of the patent based on the Main Request.

4.2 First Auxiliary Request

The same holds true for the claims of this request which only differ from those of the Main Request in that granted claim 4 (which has a basis in claim 4 as originally filed) was deleted and its additional feature incorporated in claims 1 and 12 (see under point V above).

5. Article 84 EPC

The requirement of clarity of the claims cannot be subsumed under any ground for opposition (see Article 100 EPC). In opposition appeal proceedings a lack of clarity thus may only prejudice the maintenance of the patent if it is caused by amendments with respect to the claims as granted, namely if such amendments render the claims less clear.

5.1 The claims as granted specify the method for measuring the viscosity only by a temperature of 23°C. The present claims give further details as to the type of viscometer to be used and to the method of measurement. The Appellant criticised that these details were not clear (see point VI(d) above). Whether this is true or not is not relevant since they further specify the method of measurement, thus rendering the claims clearer than the ones as granted.

5.2 The Appellant argued that the term "specified herein" rendered the claims obscure because it was not clear to which definition said term referred (see point VI(d) above).

This term forms parts of the feature "wherein if the surfactants are comprised of a mixture of chain lengths, the chain length specified herein refers to the number average chain length" in the definition (A) of the hydrophobic group of the surfactant in claim 1 of both the Main and the First Auxiliary Requests (see point V above).

In this context it is evident that "the chain length specified herein" refers the chain length of the hydrophobic group R in the surfactant of the formula $(R)_a(L)_b$.

For this reason, the term "specified herein" cannot render the claims unclear in this context.

5.3 Hence, the amendments made in the claims after grant do not render the claims unclear.

6. Article 100(b) EPC

The Appellant's arguments as to this ground for opposition are summarised under point VI(e) above.

6.1 Whether or not a thickening complex can be obtained when combining an ionic surfactant and an **ionisable** polymer is not relevant, as present claim 1 of both the Main and the First Auxiliary Requests excludes such a combination by requiring that "at least one oppositely charged surfactant" be used (compare page 21, line 8 of the patent in suit). That means that an ionic surfactant is only to be combined with an **oppositely charged** polymer, namely one which is **ionic**.

6.2 The method for measuring the viscosity is specified in paragraphs [0099] and [0100] of the patent in suit (see the respective definition at the end of claim 1 of the Main Request quoted under point V above). It determines the temperature (23°C), the viscometer (Brookfield LVDV-I$^+$ equipped with a certain heliopath), the spindles to be used (see the table) and the moment at which the viscosity is to be determined ("as the highest relatively stable reading achieved on the first path the spindle traversed using the heliopath adapter").

The Appellant has shown in the test report (D9) that the viscosities of thickened hydroalcoholic compositions can be determined by this method (see the first sentence on page 5: "Beide Muster sind messbar ..."). Although the individual viscometer readings vary to some extent (see the first table on page 6) the decrease of the average values with time is small (see table 1 on page 5; 0.5% decrease for sample V and 2.9% decrease for sample W from 5 to 360 seconds). Hence, the viscosity was determined according to the method disclosed in the patent in suit with acceptable accuracy by Mr Gehm, the author of document (D9) who is an expert in the field of rheology. This fact does not exclude that the person skilled in the art may have less expertise in measuring viscosity than Mr Gehm and may not be able to determine the viscosity of the claimed composition with an acceptable accuracy. This, however, was not shown by the Appellant.

6.3 Hence, no grounds under Article 100(b) EPC prejudice the maintenance of the patent.

7. Novelty

Document (D6) relates to an "antimicrobial alcoholic gel composition for disinfecting hands ..." (see column 1, lines 6-9). The document discloses in example 19 a composition containing 62 parts by weight of isopropanol, 27.57 parts by weight of water and minor amounts of
ACRITAMER 940 (an acid functional polymer; see column 8, lines 13-16), ETHOMEEN C/25 (a polyoxyethylene cocoamine; see column 8, lines 21-22) and of JAGUAR HP-120 (a hydroxypropyl guar gum, which is an additional thickener; see column 8, lines 23-24 and column 7, lines 25-26).

The Appellant has shown in the test reports (D8) and (D9) that the composition according to example 19 of (D6) meets the viscosity requirements measured at a spindle speed of 6 rpm and the stability requirements of present claim 1 of both the Main and the First Auxiliary Request.

The Respondent argued that a spindle speed of 6 rpm was higher than the lowest possible speed to be used according to the claim and that such a high speed resulted in false readings due to shear thinning. If this is true then the viscosities determined at 6 rpm are too low so that the ones determined according to claim 1 should be even higher, namely also above the minimum of 4,000 cp required in claim 1.

The subject-matter of claim 1 of the Main Request and the First Auxiliary Requests differs from the disclosure in said example in that the surfactant

ETHOMEEN C/25 has an alkyl group with an average chain length of less than 16 carbon atoms, contrary to the requirements of the claim (see documents (D10) and (D11)).

The disclosure of a document is not limited to its specific examples but comprises the general teaching of the entire document (see the decision T 12/81, OJ EPO 1982, 296, point 7 of the reasons). However, this does not mean that the disclosure of a document comprises all the combinations of all the components disclosed therein.

Document (D6) teaches that the acidic polymer is to be neutralised either by compounds of the formula $HO(C_mH_{2m})_2NH$ (where m has a value of from 2 to 3) or by those of the formula $H(OCH_2CH_2)_xRN\text{-}(CH_2CH_2)_yH$, where R is a hydrocarbon radical having from 10 to 18 carbon atoms (see column 2, lines 61-67). The only preferred neutralisation agent is the one of the formula $(CH_3CH(OH)CH_2)_2NH$ (namely diisopropanolamine; see column 2, line 68 to column 3, line 1 and examples 1-18 and 21). Therefore, there is no direct and unambiguous disclosure in this document of a composition according to example 19 where the surfactant ETHOMEEN C/25 is replaced by a less preferred one of the formula $H(OCH_2CH_2)_xRN\text{-}(CH_2CH_2)_yH$, where R is a hydrophobic group as defined in section (A) of present claim 1 of both the Main and the First Auxiliary Requests. Hence, the subject-matter of these claims 1 is novel. The same holds for

- claims 2-12 of the Main Request and for claims 2-11 of the First Auxiliary Request which are dependent from claim 1,

- claim 13 of the Main Request and claim 12 of the First Auxiliary Request which are directed to the product obtainable by combining the components as defined in claim 1,
- claims 14-17 of the Main Request which are dependent from claim 13, and to claims 13 to 16 of the First Auxiliary Request which are dependent from claim 12, and, finally, for
- claims 18 and 19 of the Main Request and claims 17 and 18 of the First Auxiliary Request which are directed to processes for making the compositions of claim 1.

Hence, the subject-matter of the claims of the Main Request and of the First Auxilary Request is novel.

8. Inventive step

8.1 The closest prior art

The patent in suit relates "to compositions useful as surgical hand preparations and antimicrobial hand lotions." (see its paragraph [0001]). Whereas neither of the documents (D1) to (D5) share this objective with the patent in suit, document (D6) does (see (D6), column 1, lines 6-9: "This invention relates to an antimicrobial alcoholic gel composition for disinfecting the hands ... ."). As the closest state of the art is normally a prior art document disclosing subject-matter with the same objectives as the claimed invention, document (D6) is considered as the closest prior art.

8.2 The problem solved

The Respondent addressed the different advantages of the present composition described in the patent in suit (see the second paragraph under point VII above). However, it admitted that no experimental or other evidence showed that these advantages were indeed achieved in view of document (D6). Hence, the problem to be solved can only be considered as to provide alternative thickened hydroalcoholic compositions suitable for the disinfection of hands. Examples 1-3 of the patent in suit show that this problem was indeed solved.

8.3 The solution

8.3.1 Main Request

When looking for alternative hydroalcoholic compositions it was obvious to replace one constituant of the composition of example 19 of document (D6) by another disclosed in this document to be equally well suitable for the given purpose. Hence it was obvious to the person skilled in the art to replace the surfactant ETHOMEEN C/25 used to neutralise the acidic polymer ACRITAMER 940 in this example by any other neutralising agent disclosed in column 4, line 46, to column 5, line 6. This includes the polyoxyethylene octadecylamines listed in column 4, lines 61-66. When doing this, the person skilled in the art would have acted according to claim 1 of the Main Request. Hence the subject-matter of this claim does not involve an inventive step.

Due to the fact that the Board may only decide on a request as a whole, the Main Request is rejected.

8.3.2 First Auxiliary Request

Claim 1 of this request differs from claim 1 of the Main Request in that the former additionally requires that the thickener system comprises a surfactant that is solid at ambient temperature. Neither does document (D6) mention that a surfactant in the thickener system might be solid at ambient temperature, nor did the Appellant provide any evidence showing that any of the specific surfactants disclosed in this document for this purpose was solid at ambient temperature or that any other document recommended the use of such solid surfactants for said purpose. Hence, the use of such solid surfactants in the compositions according to present claim 1 cannot be deemed to be obvious to the person skilled in the art.

Therefore, the subject-matter of product claim 1 of the First Auxiliary Request involves an inventive step. The same holds for

- claims 2-11 which are dependent from claim 1,
- claim 12 which is directed to the product obtainable by combining the components as defined in claim 1,
- claims 13 to 16 which are dependent from claim 12, and, finally, for
- claims 17 and 18 which are directed to processes for making the compositions of claim 1.

Hence, the subject-matter of the claims of the First Auxiliary Request involves an inventive step.

9. Neither did the Appellant claim that the claims of the First Auxiliary Request contravened the requirement of any other provision of the EPC nor has the Board found any reason to do so.

Hence, the claims of the First Auxiliary Request meet the requirements of the EPC.

10. Therefore, there is no reason to deal with the remaining auxiliary requests.

11. Remittal

The claims of the First Auxiliary Request contain various and lengthy amendments. In order to ensure that the description be properly adapted under Rule 42(1)(c) EPC to the claims thus amended, the Board exercises its discretion under Article 111(1) EPC by remitting the case to the department of first instance.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to maintain the patent on the basis of the First Auxiliary Request (claims 1-18) filed at the oral proceedings on 19 January 2010 and after any necessary consequential amendment of the description.

The Registrar: The Chairman:

B. Atienza Vivancos P. Ranguis