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**Datasheet for the decision
of 26 October 2010**

Case Number: T 0137/09 - 3.3.06

Application Number: 01922764.4

Publication Number: 1268729

IPC: C11D 3/37

Language of the proceedings: EN

Title of invention:

Polymers that inhibit calcium phosphate and calcium carbonate
scale in autodish applications

Patentee:

Akzo Novel N.V.

Opponent:

Dalli-Werke GmbH & Co. KG
Henkel AG & Co. KGaA
Rohm and Haas Company

Headword:

Sulfonated polymers/AKZO

Relevant legal provisions:

EPC Art. 107, 108, 112(1), 123(3)
EPC R. 99(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Admissibility of the appeal (yes)"
"Referral to the Enlarged Board (no)"
"Admissibility of late filed auxiliary request 16 (no)"
"Extension of scope (all requests) - yes"

Decisions cited:

G 0009/91, T 0457/89, T 0162/97, T 0934/02, T 0039/05,
T 0358/08

Catchword:

-



Case Number: T 0137/09 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 26 October 2010

Appellant: Akzo Novel N.V.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 5 November 2008
revoking European patent No. 1268729 pursuant
to Article 102(1) EPC 1973.**

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 revoke the European patent no. 1 268 729, concerning an automatic dishwashing composition.

The patent had been granted with the following claim 1:

"1. An automatic dishwashing composition comprising: 15 to 90 percent by weight of a detergency builder, and 0.1 to 20 percent by weight of a mixture of at least one polymer having carboxylate groups and at least one polymer having sulfonate groups."

- II. In their notices of opposition the three Opponents sought revocation of the patent on the grounds of Article 100(a) because of lack of novelty and inventive step of the claimed subject-matter.

The following document was cited in writing:

(20b): English translation of JP-A-11021586.

- III. In its decision, the Opposition Division found that
- claims 1 to 11 and 13 as granted lacked novelty over document (20b).

- IV. An appeal was filed against this decision by the Patent Proprietor (Appellant).

The Appellant submitted with the grounds of appeal eight sets of amended claims as main request and

auxiliary requests 1 to 7, respectively, and announced the intention to file auxiliary requests 8 to 15 differing from the previous ones only because of the introduction of the same limiting feature into each claim 1.

Oral proceedings were held before the Board on 26 October 2010. During oral proceedings the Appellant submitted fair copies of the auxiliary requests 8 to 15 and a new request numbered as auxiliary request 16. Furthermore, he withdrew the auxiliary requests 3, 4, 5, 11, 12 and 13.

V. Claim 1 of the set of claims according to the main request reads as follows:

"1. An automatic dishwashing composition comprising: 15 to 90 percent by weight of a water-soluble detergency builder, and 0.1 to 20 percent by weight of a mixture of at least one polymer having carboxylate groups and at least one polymer having sulfonate groups, characterized in

(a) said water-soluble detergency builder being selected from the group consisting of water soluble alkali metal, ammonium or substituted ammonium phosphates, polyphosphates, phosphonates, polyphosphonates, carbonates, bicarbonates, borates, polyhydroxysulfonates, polyacetates, carboxylates and polycarboxylates;

(b) said polymer having sulfonate groups being polymerized from a monomer mixture comprising at least one sulfonic acid monomer selected from the group consisting of 2-acrylamido-2-methyl propane sulfonic

acid, (meth)allylsulfonic acid, styrene sulfonic acid, allyloxybenzene sulfonic acid or salts thereof; and (c) said polymer having carboxylate groups being polymerized from a monomer mixture comprising at least one mono-olefinic acrylic acid."

Claim 1 according to the auxiliary request 8 differs from claim 1 as granted only insofar as it requires that the selected monomers of the sulfonated polymer (b) are contained in an amount of 0.1 to 100 mole% of the polymer.

Each claim 1 according to the auxiliary requests 1 and 9 differs from each claim 1 according to the main request and the auxiliary request 8, respectively, insofar as the listed group of monomers of the sulfonated polymer (b) consists of 2-acrylamido-2-methyl propane sulfonic acid, styrene sulfonic acid or salts thereof.

Each claim 1 according to the auxiliary requests 2 and 10 differs from each claim 1 according to the auxiliary requests 1 and 9, respectively, insofar as the water soluble detergency builders (a) are alkali metal salts.

Each claim 1 according to the auxiliary requests 6 and 14 differs from each claim 1 according to the auxiliary requests 1 and 9, respectively, insofar as it requires as component (a) only the presence of sodium carbonate in an amount of 5 to 40% by weight of the composition and that the amount of the mixture of at least one polymer having carboxylate groups and at

least one polymer having sulfonate groups is limited to 0.1 to 10% by weight of the composition.

Each claim 1 according to the auxiliary requests 7 and 15 differs from each claim 1 according to the auxiliary requests 6 and 14, respectively, insofar as the only monomers of the sulfonated polymer (b) required by the claim are 2-acrylamido-2-methyl propane sulfonic acid or salts thereof.

Claim 1 according to the auxiliary request 16 relates to a process for washing dishes by using a composition differing from that of claim 1 according to the first auxiliary request insofar as it requires only 15 to 80% by weight of the water-soluble detergency builder and it specifies the possible substituents of the acrylic acid monomers of polymer (c).

VI. The Appellant submitted in writing and orally *inter alia* that

- all the requests submitted with the grounds of appeal were a response to the decision under appeal and intended to overcome the reasons given in the decision for the revocation of the patent; moreover, the appeal met all the requirements of Article 108 and Rule 99 EPC and was admissible;
- a Patent Proprietor was not obliged to submit arguments during opposition proceedings (see e.g. T 457/89); therefore, the fact that the Patent Proprietor did not submit any arguments in defence of the patent before the department of first

instance could not have any bearing on the admissibility of the appeal;

- the auxiliary request 16 submitted during oral proceedings was to be admitted since it consisted of only one amended claim which overcame at first sight the objections raised by the Respondents;
- each claim 1 according to all requests complied with the requirements of Article 123(3) EPC since the preamble of the claim was identical to the claim as granted and the characterizing part limited the original scope of the granted claim.

VII. As regards the admissibility of the appeal the Respondents (Opponents) submitted in writing and orally that

- the Appellant had filed with the grounds of appeal only new requests which were different from the one upon which it was decided at first instance and had not submitted any statement that the decision under appeal was incorrect; moreover, even though the notice of appeal mentioned as request the maintenance of the patent as granted, this request had not been maintained in the statement of the grounds of appeal; therefore, the statement of the grounds of appeal did not contain any discussion of the decision under appeal and was inadmissible;
- the Appellant had not attempted during opposition proceedings to overcome the objections raised by the Opponents even knowing the Opposition

Division's opinion on the only request pending and had not even replied in writing to the objections raised; therefore, his appeal should have been limited to defend the only request pending before the department of first instance (reference was made to G 9/91);

- since the objections which had led to the revocation of the patent were known to the Appellant at least from the summons to the oral proceedings before the first instance, he could have submitted amended claims already during the first instance proceedings; since he had submitted new requests for the first time with the grounds of appeal and these requests did not originate from objections which became known for the first time from the decision under appeal, the appeal was inadmissible as found in the similar case T 39/05;

- Respondent 02 submitted also that a question had to be referred to the Enlarged Board, if the present appeal, contrary to T 39/05, would have been found admissible by the Board.

The Respondents did not dispute the admissibility of the requests submitted in writing but argued that the auxiliary request 16 submitted during oral proceedings was late filed; moreover, it had not to be admitted since they had not sufficient time to evaluate the allowability of the amended claim in the light of all the objections raised in writing and the numerous documents cited.

Furthermore, they submitted that the scope of each claim 1 according to all requests contravened the requirements of Articles 123(3) EPC since these claims, because of the limitation of the types of selected monomers required for the sulfonated polymers (b) contained in a specified amount in the claimed composition, allowed a total of generic sulfonated polymers (b) in combination with generic carboxylic polymers (c) which was greater than that allowed by claim 1 as granted.

VIII. The Appellant requests that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or, in the alternative, on the basis of any of auxiliary requests 1, 2, 6 or 7 submitted with the grounds of appeal or on the basis of auxiliary requests 8, 9, 10, 14, 15 or 16 submitted during oral proceedings. As alternative, he requested the remittal of the case to the department of first instance.

IX. The Respondents request that the appeal not be admitted or, in the alternative, that the appeal be dismissed.

Moreover, Respondent 02 requests the referral of the following question to the Enlarged Board, if the appeal is considered admissible:

"Is an appeal admissible, which is based only on new requests, if the requests are not filed with the intention to overcome objections, which became known to the party with the reasons of the decision of the first instance for the first time?"

Reasons for the Decision

1. *Admissibility of the appeal and referral to the Enlarged Board*

- 1.1 Since the patent in suit was revoked by the Opposition Division the Patent Proprietor was adversely affected by the decision of the department of first instance and was entitled under Article 107 EPC to file an appeal against this decision (see e.g. T 457/89, point 1 of the reasons).

The requirements for the admissibility of the appeal are governed by Article 108 and Rule 99 EPC.

It has not been disputed that the Patent Proprietor's appeal complies with the requirements of Article 108 EPC, first and second sentence, and Rules 99(1)(a), (b) and (c) and 99(3) EPC and that a statement of the grounds of appeal was filed within four months of notification of the decision as required by Article 108 EPC, third sentence. The Board has also no doubt that the appeal complies with these requirements.

- 1.2 Article 108 EPC, third sentence, requires also that the statement of the grounds of appeal is filed in accordance with the Implementing Regulations.

In particular, Rule 99(2) EPC specifies that the statement of the grounds of appeal shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based.

It was not disputed that all the requests submitted with the statement of the grounds of appeal, which requests are different from the only request pending before the department of first instance, i.e. the rejection of the oppositions, intend to overcome the novelty objection based on the disclosure of document (20b) which led to the revocation of the patent; moreover, the statement of the grounds of appeal contains a discussion of the novelty of the claims of the new requests with respect to the disclosure of document (20b) and of the other documents cited during the opposition proceedings.

Therefore, even though the statement of the grounds of appeal does not discuss explicitly the reasoning of the decision under appeal with respect to the then pending only request, it is immediately apparent that

- the new requests try to overcome the objections of the department of first instance contained in the decision under appeal and establish therewith a causal link with the decision;
- the statement of the grounds of appeal indicates the reasons for setting aside the decision impugned;
- the statement of the grounds of appeal indicates the facts and evidence on which the appeal is based.

Therefore, the appeal complies in the Board's view also with the requirements of Article 108 EPC, third

sentence, and Rule 99(2) EPC (see also Case Law of the Boards of Appeal VII.E.7.6.2(a) on pages 856 and 857 as well as VII.E.7.6.2(d) on pages 858-859 and decisions T 162/97 (points 1.2 and 1.3 of the reasons) and T 934/02 (point 1 of the headnote and point 2 of the reasons), both cited in said Case Law).

Moreover, the above finding is not contrary to the decision G 9/91 (OJ 1993, 408), which states in point 18 of the reasons that "The purpose of the appeal procedure inter partes is mainly to give the losing party the possibility of challenging the decision of the Opposition Division on its merits. It is not in conformity with this purpose to consider grounds for opposition on which the decision of the Opposition Division has not been based... This approach also reduces the procedural uncertainty for patentees having otherwise to face unforeseeable complications at a very late stage of the proceedings, putting at risk the revocation of the patent, which means an irrevocable loss of rights."

In fact, this decision specifies that to challenge the decision under appeal on its merits is the main purpose of the appeal but not its only purpose and relates in particular to the introduction in appeal of fresh grounds for opposition which would cause an unacceptable procedural uncertainty for patentees, i.e. it relates in particular to a legal situation very different from the present one (see also T 162/97, point 1.2 of the reasons, last paragraph). Furthermore, G 9/91, by stating that a patent amended during appeal proceedings is to be fully examined as to its compatibility with the requirements of the EPC (see point 19 of the reasons), confirms implicitly that new

requests based on amended claims do not render automatically the appeal inadmissible and that the patentee cannot be bound to defend its patent only on the basis of requests submitted already before the department of first instance.

Therefore, the decision G 9/91 confirms implicitly also that an appeal based only on new requests can be admissible.

- 1.3 As regards the Respondents' submissions that during the opposition proceedings the Appellant had not replied to the objections raised by the Opponents and by the Opposition Division and had not tried to overcome these objections by filing amended claims, the Board remarks that there are no requirements in the EPC which oblige the Patent Proprietor to submit any argument during opposition proceedings. Therefore, the Patent Proprietor's behaviour during opposition proceedings cannot have any bearing on the admissibility of its appeal which is governed only by Article 108 and Rule 99 EPC (see e.g. T 457/89, point 1 of the reasons).

- 1.4 Moreover, the fact that the Appellant had requested in its notice of appeal the maintenance of the patent as granted and that the grounds of appeal were based instead only on amended sets of claims has also no bearing on the admissibility of the appeal since, according to Rules 99(1)(b) and (c) EPC, the notice of appeal has to indicate which decision is impugned and a request defining the subject of the appeal, i.e. the extent to which amendment or cancellation of the decision is requested, whilst the appeal's requests for the maintenance of the patent in a particular form have

to be defined according to Rule 99(2) EPC in the grounds of appeal (see T 358/08 (Catchwords 1 and 2)).

This has been complied with in the present case since the notice of appeal specified the request to set aside the decision under appeal whilst the grounds of appeal clarified in which form the patent was requested to be maintained.

- 1.5 According to the Respondents it was decided in T 39/05 that an appeal should not be admissible if the grounds of appeal relate to new requests which do not originate from objections which became known for the first time in the reasoning of the decision under appeal (see point 1.1.2 of the reasons). Therefore, according to the Respondents, this decision would apply to the present case in which the objection of lack of novelty over document (20b) which had led to the revocation of the patent was already known to the Patent Proprietor at least from the summons to the oral proceedings before the department of first instance.

The Board remarks that the reasoning for the inadmissibility of the appeal in case T 39/05 consists of two distinct parts.

The first part of the decision, including said point 1.1.2, concerns the entitlement of the Patent Proprietor to file an appeal as governed by Article 107 EPC; in particular, it is specified in the decision that the Boards of Appeal of the EPO had already found admissible appeals based only on new requests (see point 1.1.1 which also refers to T 162/97 discussed above); moreover, it is stated that the appeal in the specific case could have been considered to be possibly

admissible if the new requests would have originated from objections become known to the Patent Proprietor for the first time in the reasoning of the decision under appeal (point 1.1.2).

However, the Board notes that it is clear from the last full paragraph of point 1.1.2 that this decision concerns in particular the filing of requests based on claims having a different category from that of the claims discussed before the department of first instance; moreover, since it could not be deduced from these new requests which objections raised before the department of first instance by the Opponents would be overcome, such new requests could not be considered to have been filed with the intention to overcome the objections upon which the decision under appeal was based. Therefore, case T 39/05 concerns a legal situation different from the present one in which the requests submitted during appeal are in the same category as the only request pending before the department of first instance and are to be considered a reply to the novelty objection on which the decision is based.

The Board thus finds that at least this part of the decision T 39/05, concerning a different legal situation, is not applicable to the present case.

The second part of this decision, relating to the requirements of Article 108(3), third sentence and therefore also to those of Rule 99(2) EPC, states the necessity of filing a statement of the grounds of appeal according to the Implementing Regulations and the necessity of the new requests to contain a causal

link with the decision under appeal (see points 1.2.1 and 1.2.2), requirements which have been complied with in the present case as explained in point 1.2 above.

Therefore, also this decision confirms the finding of the Board that the present appeal complies with all the requirements of Article 108 and Rule 99 EPC and is admissible.

- 1.6 Under Article 112(1) EPC it is within the discretion of the Boards of Appeal to refer a case to the Enlarged Board of Appeal if this appears necessary for ensuring uniform application of the law or a point of law of fundamental importance arises.

Since in the present case the Board's decision on the admissibility of the appeal is not contrary to T 39/05, as explained above, and thus a point of law of fundamental importance does not arise, there is no necessity to refer Respondent 02's question to the Enlarged Board for ensuring uniform application of the law.

Respondent 02's request to refer to the Enlarged Board thus is to be refused.

2. *Admissibility of the auxiliary request 16*

The auxiliary request 16 was submitted for the first time during oral proceedings. Thus it is late filed.

Moreover, in view of the fact that the Appellant had already submitted sixteen requests with the grounds of appeal and had ample time to submit further requests as

response to the Respondents' submissions before oral proceedings there is no excuse for its late filing.

Furthermore, even though the Appellant submitted during oral proceedings that the amended request would be at first sight allowable, the Board cannot see how it can be derivable at first sight from the amendments carried out in this request that the numerous objections raised in writing by the Respondents and based partly on many different documents can be overcome by the amendments.

The Board thus concludes that it would contravene the principle of equal treatment of the parties to admit such a request at this very late stage of the proceedings without adjourning oral proceedings and giving the other parties sufficient time for preparing their case.

The auxiliary request 16 thus is not to be admitted.

3. *Main request*

3.1 Article 123(3) EPC

- 3.1.1 As found in decision G 9/91 (point 19 of the reasons) amended claims are to be fully examined in appeal proceedings as to their compliance with the requirements of the EPC and, in particular, as to their compliance with the requirements of Articles 123(2) and (3) EPC.

Therefore, the Board is bound to examine if the amended claims meet the requirements of Articles 123(2) and (3) EPC before taking a decision on a possible remittal of

the case to the department of first instance, as requested alternatively by the Appellant.

- 3.1.2 Claim 1 as granted required that the claimed automatic dishwashing composition of claim 1 comprised 0.1 to 20 percent by weight of a mixture of at least one polymer having sulfonate groups (hereinafter polymer (B)) and at least one polymer having carboxylate groups (hereinafter polymer (C)).

Therefore, the amount of generic polymers (B) and (C) was limited and could not exceed 20% by weight of the composition.

- 3.1.3 Claim 1 according to the main request, though repeating in its preamble the wording of claim 1 as granted, requires *inter alia* in its characterizing part that the polymer having sulfonate groups (a polymer (b) falling under the generic class (B) of the granted claim 1) is polymerized from a monomer mixture comprising at least one sulfonic acid monomer selected from the group consisting of 2-acrylamido-2-methyl propane sulfonic acid, (meth)allylsulfonic acid, styrene sulfonic acid, allyloxybenzene sulfonic acid or salts thereof.

Moreover, the claimed composition requires that the amount of the mixture of the specific polymers (b) and (c), which polymer (c) falls under the generic class of the generic polymer (C) of granted claim 1, is limited to 0.1 to 20% by weight.

However, because of the open wording "An automatic dishwashing composition comprising...", the claimed composition can contain further components, e.g.

polymers which do not fall under the definitions given in the claim for polymers (b) and (c).

Therefore, a polymer encompassed within the generic definition of polymer (B) of the granted claim 1 such as one containing, for example, 1-allyloxy-2-hydroxypropane sulfonic acid monomer (see page 3, line 15 of the patent in suit) and none of the selected monomers listed in claim 1 according to the main request, which polymer is no longer encompassed by the new definition of polymer (b) of the main request, can be contained in the composition of the main request in addition to 0.1 to 20% by weight of polymers (b) and (c).

Therefore, the amended claim can comprise more than 20% by weight of a mixture of polymers falling under the generic classes (B) and (C) of granted claim 1, i.e. an amount of these polymers exceeding the upper limit of granted claim 1.

- 3.1.4 The Board thus concludes that claim 1 according to the main request extends the scope of the granted patent.

Therefore, the main request contravenes the requirements of Article 123(3) EPC.

4. *Auxiliary requests 1, 2, 6 to 10, 14 and 15*

- 4.1 Article 123(3) EPC

The Board remarks that each claim 1 of the auxiliary requests 1, 2, 6 to 10, 14 and 15 contains the same open wording " An automatic dishwashing composition

comprising..." and that the claimed compositions require 0.1 to 20% by weight (auxiliary requests 1, 2, 8, 9 and 10) or 0.1 to 10% by weight (auxiliary requests 6, 7, 14 and 15) of polymers (b) and (c), wherein the definition of polymer (b) does not include any longer a polymer having a 1-allyloxy-2-hydroxypropane sulfonic acid monomer and none of the selected monomers listed in claim 1 according to these auxiliary requests.

Therefore, for the same reasons put forward above, each claim 1 according to all these requests allows the presence of an arbitrary amount of such a polymer in addition to 0.1 to 20% by weight or 0.1 to 10% by weight of the specific polymers (b) and (c) and thus an amount of generic polymers (B) and (C) which can exceed the upper limit of granted claim 1.

The Board thus concludes that all these auxiliary requests contravene *mutatis mutandis* the requirements of Article 123(3) EPC.

Order

For these reasons it is decided that:

1. The request to refer to the Enlarged Board is rejected.
2. The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

P.-P. Bracke