

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen  
(D) [ ] No distribution

**Datasheet for the decision  
of 8 October 2010**

**Case Number:** T 0195/09 - 3.3.06

**Application Number:** 01934020.7

**Publication Number:** 1290127

**IPC:** C11D 3/37

**Language of the proceedings:** EN

**Title of invention:**

Mechanical warewashing compositions containing scale  
inhibiting polymers

**Patentee:**

Unilever PLC, et al

**Opponent:**

Rohm and Haas Company

**Headword:**

Scale inhibiting polymers/UNILEVER

**Relevant legal provisions:**

EPC Art. 123(2)(3), 69(1)

**Relevant legal provisions (EPC 1973):**

-

**Keyword:**

"Added subject-matter (main request): yes"

"Scope of protection extended (auxiliary request): yes"

**Decisions cited:**

G 0003/89, G 0011/91, G 0001/93, T 0108/91

**Catchword:**

-



Case Number: T 0195/09 - 3.3.06

**DECISION**  
of the Technical Board of Appeal 3.3.06  
of 8 October 2010

**Appellants:** Rohm and Haas Company  
(Opponent) 100 Independence Mall West  
PHILADELPHIA, PENNSYLVANIA 19106-2399 (US)

**Representative:** Buckley, Guy Julian  
Patent Outsourcing Limited  
1 King Street  
Bakewell  
Derbyshire DE45 1DZ (GB)

(Patent Proprietor) Unilever N.V.  
Weena 455  
P.O. Box 760  
NL-3000 DK (NL)

**Representative:** Rosen Jacobson, Frans Lucas M.  
Unilever Patent Group  
Olivier van Noortlaan 120  
NL-3133 AT Vlaardingen (NL)

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
11 December 2008 concerning maintenance of  
European patent No. 1290127 in amended form.

**Composition of the Board:**

**Chairman:** P.-P. Bracke  
**Members:** L. Li Voti  
J. Geschwind

## Summary of Facts and Submissions

- I. The present appeal is from the decision of the Opposition Division to maintain in amended form the European patent no. 1 290 127, concerning a method for washing soiled dishes.
- II. In its notice of opposition the Opponent sought revocation of the patent on the grounds of Articles 100(a), (b) and (c) EPC.

The following documents were cited in writing:

(8): Encyclopedia of Polymer Science and Engineering (1989), volume 16, pages 494 to 532;

(15): Progress Polymer Science, volume 23 (1998), "Polymeric Design by Macromonomer Technique" by K. Ito, pages 581 to 620.

- III. The Opposition Division, by referring *inter alia* to documents (8) and (15), found in its decision that it was common general knowledge to copolymerise olefinic unsaturated carboxylic monomers with copolymerizable polymers.

Therefore, the skilled person would have interpreted claim 1 as granted according to its wording as relating to a method wherein the used composition comprised the anti-scaling polymers reported in the claim, i.e. those formed from olefinically unsaturated carboxylic monomers and at least one monomer selected from the group consisting of copolymerizable sulfonated polymers, nonionic monomers and mixtures thereof.

Since the original documents of the application did not contain any support for the use of an anti-scaling polymer formed from copolymerizable sulfonated polymers, claim 1 as granted contravened the requirements of Article 123(2) EPC.

As regards claim 1 according to then pending first and second auxiliary requests wherein the wording "copolymerizable sulfonated polymers" contained in claim 1 as granted had been amended into "copolymerizable sulfonated monomers", the Opposition division found that this amendment could not be considered to be an obvious correction of an error since it was not immediately evident that the reference to copolymerizable sulfonated polymers was erroneous.

However, by considering that claim 7 as granted and the overall description of the patent in suit related extensively to anti-scaling polymers formed from copolymerizable sulfonated monomers, the protection of the granted patent had to be understood as including both types of anti-scaling polymers formed from copolymerizable sulfonated polymers or copolymerizable sulfonated monomers; therefore, claim 1 according to the first and second auxiliary requests did not contravene the requirements of Article 123(3) EPC.

Furthermore, the Opposition Division found that claim 1 according to the first auxiliary request lacked an inventive step whilst claim 1 according to the second auxiliary request and claims 2 to 9, dependent on claim 1, complied with the requirements of the EPC.

IV. Appeals were filed against this decision by the Patent Proprietor and by the Opponent.

Oral proceedings were held before the Board on 8 October 2010.

V. Claim 1 of the patent as granted (Appellant/Patent Proprietor's main request) reads as follows:

"1. A method for washing soiled dishes through a series of sequential cycles comprising a penultimate rinse cycle and a final rinse cycle, the method comprising charging a mechanical dishwashing composition comprising:

(A) an anti-scaling polymer formed from

(i) 50-99% by weight of the polymer of an

olefinically unsaturated carboxylic monomer;

(ii) 1 to 50% of at least one monomer unit selected

from the group consisting of copolymerizable

sulfonate polymers, copolymerizable nonionic

monomers and mixtures thereof;

(B) 0.1 to 99.9% of a vehicle releasing the anti-scaling polymer into the penultimate and final rinse cycle of a dishwashing sequence,

characterised in that the dosage of the anti-scaling polymer is such that the weight ratio of the level of dosed antiscalant in the penultimate rinse cycle to that in the final rinse cycle is from about 1:10 to about 10:1."

Claim 1 of the set of claims considered by the Opposition Division to comply with the requirements of the EPC (Appellant/Patent Proprietor's auxiliary request), differs from claim 1 as granted insofar as

the wording "copolymerizable sulfonated polymers" has been amended into "copolymerizable sulfonated monomers" and insofar as the amount of detergent composition and wash solution used was specified.

VI. The Appellant/Opponent submitted in writing and orally that

- claim 1 according to the main request did not comply with the requirements of Article 123(2) EPC for the reasons given in the decision under appeal;

- moreover, since claim 1 according to the auxiliary request encompassed the use of an anti-scaling polymer formed from 0.1 to 50% by weight of copolymerizable sulfonate monomers instead of copolymerizable sulfonate polymers as in claim 1 as granted, the scope of claim 1 had been broadened by relating to the use of compositions containing anti-scaling copolymers not encompassed by the wording of granted claim 1;

- therefore, this amendment contravened the requirements of Article 123(3) EPC.

VII. The Appellant/Patent Proprietor did not submit any argument in writing or orally as to why claim 1 as granted would comply with the requirements of Article 123(2) EPC.

As regards claim 1 according to the auxiliary request, it submitted in writing and orally that claim 1 as granted would have been understood by the skilled person to relate to both types of copolymers formed from copolymerizable sulfonated polymers and

copolymerizable sulfonated monomers as found in the decision under appeal; moreover, it would have been clear to the skilled person in the light of the overall description and of granted claim 7 that the invention related in reality to the use of anti-scaling polymers containing copolymerizable sulfonated monomers.

Therefore, such an amendment directed to express correctly the intended meaning of the invention would not infringe Article 123(3)EPC (reference was made in this respect to the decisions T 108/91, G 3/89 and G 11/91).

Therefore, claim 1 according to the auxiliary request complied with the requirements of Article 123(3) EPC.

VIII. The Appellant/Patent Proprietor requests that the decision under appeal be set aside and that the patent be maintained as granted or, alternatively, that the Appellant/Opponent's appeal be dismissed.

IX. The Appellant/Opponent requests that the decision under appeal be set aside and the patent be revoked.

## **Reasons for the Decision**

1. *Appellant/Patent Proprietor's main request (patent as granted)*

1.1 Article 123(2) EPC

1.1.1 Claim 1 as granted relates to a method for automatic dishwashing wherein the used machine dishwashing composition contains the anti-scaling polymer (A) and

0.1 to 99.9% by weight of a vehicle (B) capable of releasing such an anti-scaling polymer during the last two rinse cycles.

Moreover, the anti-scaling polymer (A) is formed from (i.e. consists of) 50 to 99.9% by weight of olefinically unsaturated carboxylic monomers and 0.1 to 50% by weight of copolymerizable sulfonated polymers, nonionic monomers or mixtures thereof.

It is undisputed that the original documents of the application do not disclose copolymerizable sulfonate polymers as possible monomers of the anti-scaling polymer (A).

- 1.1.2 As found in the decision under appeal, it was common general knowledge that so-called macromonomers or macromers, i.e. oligomers or polymers with a polymerizable end group, can be used as monomers in the preparation of copolymers (see e.g. document (8), page 509, "Macromonomers" lines 1 to 8 and document (15), page 581, last full paragraph).

Therefore, the skilled person, in reading claim 1, would not have considered the wording of this claim, requiring *inter alia* the use of sulfonate polymers as comonomers of the anti-scaling polymer (A), to be manifestly incorrect and would have interpreted the claim as it stands, i.e. as relating also to the use of anti-scaling polymers (A) formed by copolymerizing sulfonated polymers with olefinically unsaturated carboxylic acids.

Since these polymers are not disclosed in the documents of the application as originally filed, the Board



concludes that claim 1 as granted does not comply with the requirements of Article 123(2) EPC.

This was not contested by the Appellant/Patent Proprietor.

2. *Appellant/Patent Proprietor's auxiliary request (patent as maintained by the Opposition Division)*

2.1 Article 123(3) EPC

2.1.1 Claim 1 of the set of claims according to the auxiliary request differs from claim 1 as granted *inter alia* insofar as the wording "copolymerizable sulfonated polymers" contained in claim 1 as granted has been amended into "copolymerizable sulfonated monomers".

Therefore, this claim extends to methods in which the used composition comprises as anti-scaling polymers (A) those formed from olefinically unsaturated carboxylic monomers and copolymerizable sulfonated monomers, which polymers were not encompassed by the definition of the anti-scaling polymers (A) of granted claim 1.

Moreover, the remaining claims are all dependent on claim 1. Therefore, claim 1 represents the broadest scope of the patent in suit according to the auxiliary request.

2.1.2 According to Article 69(1) EPC, the extent of protection conferred by a European patent shall be determined by the claims, which shall be interpreted by using the description and the drawings, if available.

In the Appellant/Patent Proprietor's view, by considering that the description of the patent in suit does not mention copolymerizable sulfonated polymers and relates instead extensively to copolymerizable sulfonated monomers, claim 1 as granted would have been interpreted by the skilled person to relate not only to the use of anti-scaling polymers (A) formed from copolymerizable sulfonated polymers but also to the use of anti-scaling polymers (A) formed from copolymerizable sulfonated monomers. This interpretation would be supported by the wording of granted claim 7 relating to specific sulfonated monomers.

However, in the Board's view, the fact that the description relates extensively to copolymerizable sulfonated monomers and not to copolymerizable sulfonated polymers amounts only to a discrepancy between granted claim 1 and the description but, in the absence of any specific indication in the description, it cannot be considered to be a teaching that the wording "copolymerizable sulfonated polymers" in claim 1 should be interpreted as having a broader meaning than what would be understood by the skilled person.

Moreover, even though the granted claim 7, which is dependent on claim 1, lists specific sulfonated monomers, the skilled person would interpret this dependent claim only as relating to the anti-scaling polymers (A) of claim 1 containing additionally such specific sulfonated monomers.

Therefore, as explained in point 1.1.2 above, claim 1 as granted would have been understood by the skilled person as it stands, i.e. as relating also to the use of anti-scaling polymers (A) which are formed from olefinically unsaturated carboxylic monomers and copolymerizable sulfonated polymers, which anti-scaling polymers (A) do not include polymers formed solely from olefinically unsaturated carboxylic monomers and generic sulfonated monomers as encompassed by claim 1 according to the auxiliary request.

- 2.1.3 The Appellant/Patent Proprietor submitted also that, by considering the description, the skilled person would have understood that the granted claim 1 referred erroneously to copolymerizable sulfonated polymers instead of copolymerizable sulfonated monomers and that the amended claim 1 according to the auxiliary request, by reporting the truly intended technical features of the invention, would not extend the scope of the granted patent.

However, as explained in points 1.1.2 and 2.1.2 above, claim 1 as granted would have been understood by the skilled person as it stands. Therefore, also this argument of the Appellant/Patent Proprietor cannot justify the allowability under Article 123(3) EPC of the auxiliary request.

- 2.1.4 The Board remarks also that the decisions G 3/89 (OJ 1993, 117) and G 11/91 (OJ 1993, 125), cited by the Appellant/Patent Proprietor during oral proceedings, regard only the allowability of a request for correction of an error and the relationship between Rule 88 EPC 1973 and Article 123(2) EPC (see headnotes

of both decisions). Therefore, these decisions cannot apply to the present case wherein it has to be decided on the allowability of the amended patent under Article 123(3) EPC.

- 2.1.5 The Appellant/Patent Proprietor referred also to the decision T 108/91 (OJ 1994, 228), in which it was decided that an inaccurate technical statement in a granted claim, which statement is evidently inconsistent with the totality of the disclosure of the patent and would contravene the requirements of Article 123(2) EPC, can be replaced with an accurate statement of the technical features involved without infringing Article 123(3) EPC (see headnote and points 2.2. and 2.3 of the reasons).

However, the Board remarks that this decision is older than the decision G 1/93 of the Enlarged Board of Appeal of the EPO (OJ 1994, 541), which ruled on a similar point of law.

In particular, it was decided in G 1/93 (headnote 1 and point 13 of the reasons), that if a European patent as granted contains subject-matter which extends beyond the content of the application as filed within the meaning of Article 123(2) EPC and which also limits the scope of protection conferred by the patent (for example, an inaccurate technical statement inconsistent with the totality of the disclosure of the patent), such a patent cannot be maintained in opposition proceedings unamended, because the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent. Nor can it be amended by deleting such limiting subject-matter from the claims,

because such amendment would extend the protection conferred, which is prohibited by Article 123(3) EPC. Such a patent can, therefore, only be maintained if there is a basis in the application as filed for replacing such subject-matter without violating Article 123(3) EPC, i.e. for replacing the unallowable technical feature limiting the scope of protection conferred by the patent as granted with another technical feature which restricts the scope of the granted patent.

Therefore, according to G 1/93, it is not allowable to replace a technical feature of a granted claim with another technical feature which causes the claim to extend to subject-matter which was not encompassed by the granted claim. In this respect decision T 108/91 has been clearly overruled by G 1/93.

Moreover, the conclusions of the decision G 1/93 are also applicable to the present case wherein the technical feature "anti-scaling polymer (A) formed from copolymerizable sulfonated polymers" limiting the scope of the granted patent and being unallowable under Article 123(2) EPC, was replaced by the technical feature "anti-scaling polymer (A) formed from copolymerizable sulfonated monomers" which does not restrict the scope of the granted patent but extends its scope to subject-matter not encompassed by the granted claims.

2.1.6 Therefore, the Board concludes that the patent according to the auxiliary request contravenes the requirements of Article 123(3) EPC.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

D. Magliano

P.-P. Bracke