

Internal distribution code:

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

**Datasheet for the decision
of 10 December 2013**

Case Number: T 1153/10 - 3.2.07

Application Number: 03076766.9

Publication Number: 1382399

IPC: B05B17/06, A01M1/20

Language of the proceedings: EN

Title of invention:

Method for repelling or eliminating harmful organism

Patent Proprietor:

FUMAKILLA LIMITED

Opponents:

S.C. Johnson & Son, Inc.
Environmental Air Care Limited

Headword:

Relevant legal provisions:

EPC Art. 100(b), 111(1)
RPBA Art. 12(4)

Keyword:

Admittance of new document and new reasoning which could have
been presented in the first instance - (no)
Sufficiency of disclosure - (yes)
Remittal to the department of first instance - (yes)

Decisions cited:

T 0619/00, T 0882/03, T 0815/07, T 0593/09

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1153/10 - 3.2.07

**D E C I S I O N
of Technical Board of Appeal 3.2.07
of 10 December 2013**

Appellant:
(Patent Proprietor)

FUMAKILLA LIMITED
11, Kanda Mikura-cho
Chiyoda-ku
Tokyo (JP)

Representative:

Brearley, Helen Rebecca
Elkington and Fife LLP
Prospect House
8 Pembroke Road
Sevenoaks
Kent TN13 1XR (GB)

Respondent 1:
(Opponent 1)

S.C. Johnson & Son, Inc.
1525 Howe Street
Racine, WI 53403-2236 (US)

Respondent 2:
(Opponent 2)

Environmental Air Care Limited
31A Hannigan Drive
Parnell
Auckland 1072 (NZ)

Common representative:

Ruschke, Hans Edvard
RUSCHKE HARTMANN MADGWICK & SEIDE
Patent- und Rechtsanwälte
Postfach 86 06 29
81633 München (DE)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 18 March 2010
revoking European patent No. 1382399 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
E. Kossonakou

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking the European patent No. 1 328 399.
- II. Two oppositions had been filed against the patent as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step), on Article 100(b) EPC (insufficient disclosure) and on Article 100(c) EPC (unallowable amendments).

The Opposition Division found that the ground for opposition under Article 100(b) EPC prejudices the maintenance of the patent in the amended form as requested with letter dated 11 December 2008.

- III. The following documents are of importance for the present decision:

(filed during the opposition proceedings)

D16: Rawle - "Basic Principle of Particle Analysis, 1993;

(filed together with the statement setting out the grounds of appeal)

D32: Appendix E, Getting Started, MAN 0101, Issue 1.3, August 1997, Malvern Instruments Ltd.;

(filed together with the reply of respondent I

(opponent I) to the statement of grounds of appeal)

D34: Richard D. Cadle - "Particle Size - Theory and Industrial Applications", 1965, p. 346 to 349.

- IV. With its communication dated 2 August 2013 the Board summoned the parties to oral proceedings. In the annex

to said summons the Board summarised the insufficiency of disclosure objections (labelled as objections a) to f)) raised during the opposition proceedings and gave its preliminary opinion there upon. It stated further that it considers the objection of lack of information regarding yet further parameters, raised for the first time in respondent I's reply to the appeal, as a piecemeal approach, i.e. as an objection which could have been raised in the opposition proceedings. The Board intended not to admit it into the appeal proceedings.

V. Oral proceedings before the Board took place on 10 December 2013.

- a) The appellant requests that the impugned decision be set aside and the case remitted to the department of first instance for consideration of the novelty and inventive step requirements on the basis of the main request (originally filed in the opposition proceedings), alternatively on the basis of one of the two auxiliary requests. Further, that document D34 and the respondent's arguments based there upon not be admitted into the appeal proceedings. Finally, if the case were not remitted to the department of first instance, that documents D28, D29, D210 and D211 not be admitted into the appeal proceedings.
- b) The respondents I and II (opponents I and II) request that the appeal be dismissed, otherwise that the case be remitted to the department of first instance for consideration of the novelty and inventive step requirements. They also request that document D34 be admitted into the proceedings.

VI. Claim 1 according to the main request reads as follows:

"A method for repelling and eliminating a harmful organism comprising spraying in the air a chemical liquid characterized in that the atomised chemical liquid is sprayed intermittently by using an aerosol atomiser apparatus comprising a pressure vessel having an openable spray opening, and including a chemical liquid being sealed therein together with a propellant, wherein an initial volume of the chemical liquid accounts for 15% or less of the overall volume of the pressure vessel, said chemical liquid containing an effective ingredient as atomised chemical liquid fine particles, wherein the resulting atomized chemical liquid fine particles have a particle size distribution in which 90% by cumulative volume of the chemical liquid fine particles based on volume cumulative distribution has a particle size of 20 µm or less".

VII. *The appellant argued essentially as follows:*

Admission of D34 and respondent I's arguments based there upon into the appeal proceedings - Article 12(4) RPBA

The Board should exercise its discretion under Article 12(4) RPBA in its favour by not admitting D34 and respondent I's arguments based there upon into the proceedings, since they could have been filed during the opposition proceedings and not as late as the appeal proceedings. No reasoning for the late filing was presented by respondent I.

Claim 1 of the main request - Sufficiency of disclosure, Article 100(b) EPC

i) Distance at which the measurements are taken

In the light of the information disclosed in paragraphs [0013] to [0015] of the patent in suit the skilled person would select a suitable spraying position within the 10 to 50 cm distance range mentioned in paragraph [0014] of the patent in suit in order to obtain an accurate measurement. This may involve a visual determination of the sprayed particles in the air which will allow the selection of a suitable spraying position that would be not too close to the used laser beam (to avoid inaccurate measurements due to the concentration of the particles or before the particles have reached a stable size) and not too far away (where the used analyser will be unable to detect the smaller particles due to low particle density). By doing so, the skilled person will find a sufficiently limited number of suitable spraying positions which form part of a "working range". Such process does not pose an undue burden to the skilled person; indeed, it represents a standard spray measuring method via laser beam diffraction, see D16, page 7, central column, lines 47 to 52 and page 8, left column, lines 34 to 36.

The accuracy of the values provided by the measurements is a clarity issue for the claim, which does not prevent the skilled person from carrying out the invention.

The respondents' arguments regarding the need to define the type of solvent and propellant in claim 1 are not justified, see paragraphs [0017], [0051], [0031] to [0036], [0053] and the examples, e.g. in paragraph

[0061] of the patent in suit.

ii) Three- or two-dimensional measurement of the particle size distribution

D16 states on page 7, central column, lines 47 to 52 that it is possible to measure aerosol sprays directly by spraying them through the laser beam, making thereby a traditionally difficult measurement extremely simple. It states further on page 8, left column, lines 34 to 36 that there exists also an ASTM standard for sprays using laser diffraction. Accordingly, there is no need for any particular teaching in the patent in suit as to whether a three- or two-dimensional counting of the particle size has to be carried out.

VIII. The respondents I and II argued essentially as follows:

Admission of D34 and respondent I's arguments based there upon into the appeal proceedings - Article 12(4) RPBA

Document D34 has been filed only as evidence for the skilled person's general technical knowledge that droplet size is controlled by many factors.

Claim 1 of the main request - Sufficiency of disclosure, Article 100(b) EPC

i) Distance at which the measurements are taken

Paragraph [0014] of the patent in suit provides only a very broad range of 10 to 50 cm from the laser beam for the positioning of the spray opening. The particles gradually decrease in size to zero as they move away from said opening. The patent in suit fails to teach

the skilled person the precise position of the spray opening in relation to the laser beam in order to obtain the desired results in a reliable and reproducible way.

According to paragraph [0043] of the patent in suit, when the particles are spread away from the spray opening the particle size decrease ratio depends on the type of the solvent and the propellant used. No specific propellants or solvents are mentioned in claim 1.

Due to the large number of applicable variables to be taken into consideration when measuring the particle size distribution there is an undue burden for the person skilled in the art seeking to put the invention into practice. For the same reason the patent in suit does not enable the design of a suitable aerosol atomiser apparatus.

ii) Three- or two-dimensional measurement of the particle size distribution

The description does not specify whether a laser-beam measurement is made of a volume of particles or of a two-dimensional cross section. Indeed, the respondents have no information whether a laser-beam measurement made of a volume of sprayed particles produces the same values as a laser-beam measurement of a two-dimensional cross section of the sprayed particles.

Reasons for the Decision

1. *Admission of D34 and the respondent I's arguments based there upon into the appeal proceedings - Article 12(4) RPBA*

1.1 According to Article 12(4) RPBA, the Board has the discretionary power to hold inadmissible facts, evidence and requests which could have been presented or were not admitted in the first instance proceedings.

1.2 D34 together with respondent I's corresponding arguments were presented at a late stage in the entire proceedings, namely with the respondent's reply to the statement of grounds of appeal. Although respondent I argued that D34 was presented only as evidence for the skilled person's general technical knowledge that the droplet size is controlled by many parameters, such as orifice size, container pressure, viscosity and surface tension of the active solution, physical properties of the propellant, temperature of the contents of the container, respondent I did not present any further arguments as to why this document and the parameters mentioned therein were relevant for the issue of sufficiency of disclosure.

Moreover, no reasons were given for the late filing of D34, not even that it was submitted in response to the statement of grounds of appeal.

1.3 It follows that both the document and the relevant argumentation can only be considered as the introduction of a new argumentation line based on new material, D34, which could have been presented during the opposition proceedings so that it could have been dealt with by the Opposition Division.

1.4 As a consequence, the Board exercises its discretion under Article 12(4) RPBA not to admit D34 and the submissions related to it into the proceedings.

2. *Claim 1 of the main request - insufficiency of disclosure, Article 100(b) EPC*

2.1 In the annex to the summons to oral proceedings the Board stated that

"[w]ith the oppositions there were a number of sufficiency objections:

a) not knowing whether one works in or outside of the claim (impossible to test where the boundaries of the claim lie)

b) distance where measurement is taken is crucial, but not all distances in the indicated range of 10-50 cm produce the claimed result

c) no guidance which parameters should be used when operating the Andersen sampler

d) no guidance on which combination works of the parameters solvent and propellant with the parameter volume ratio

e) the issue of the chemical liquid containing atomised chemical liquid fine particles

f) no guidance on whether it is the particle distribution in a cube or a cloud within the whole atomised liquid or in a 2-dimensional cut".

2.2 As far as it concerns issue a) the Board stated that

"[f]rom the decision it appears that only issue a) has been dealt with. At the time of taking the decision, the only guidance the opposition division had was the Case Law of the Boards of Appeal, 5th edition 2006, which in fact very much presented the case law on this

issue in the way the division decided. However, in the meantime sufficient other decisions were brought to light which have criticised this approach since it introduces aspects of Article 84 EPC into the issue of sufficiency. This case law is reflected in the 6th edition of the Case Law of the Boards of Appeal and is cited by the appellant.

The present Board concurs with this more extensively described (and also more recent) case law, such that the above reasons of the impugned decision no longer apply".

2.3 As far as it concerns issues b) and c) the Board stated that

"[i]ssues b) and c) appear sufficiently solved by the submissions of the appellant, ...

The Board considers that the particle size distribution is a parameter which is familiar to the skilled person. The contested patent teaches that particle size distribution may be measured by a particle size distribution analyser by means of a laser beam scattering and provides additional information that may assist the skilled person in their analysis. Laser beam analysis of particle size is a technique which was well known to the skilled person before the priority date of the contested patent, see D16. The patent specification suggests further at paragraph [0015] that if a particle size distribution analyser cannot provide favourable results then measurements may be made using an Andersen sampler or the like.

Furthermore, according to D26 Mr May was successful in measuring the particle size distribution, and thus D26

confirms that the skilled person was able to measure particle size distribution based on the teaching contained in the contested patent and using his common general knowledge.

The Board considers further in accordance with the finding in point 5.3 of T 619/00 (not published) that there was no evidence provided by the opponents that the different measuring methods would lead to values deviating by a substantial amount having technical significance or by an amount that would place the skilled person in a situation where he is unable to carry out the present invention. It also finds in accordance with the finding in point 2.6 of T 882/03 (not published) that the lack of a detailed description of the measuring method to be used for measuring the fine particles' size distribution leaving some doubt when it comes to the limits of the specified fine particles' size distribution range rather concerns the reliability of the values obtained and not the impossibility for the skilled person to determine the fine particles size distribution; slightly varying results obtained when using different measuring methods for measuring the fine particles size distribution do not disable a person skilled in the art to carry out the invention but are rather related to the question of whether the matter for which protection is sought is sufficiently defined in accordance with Article 84 EPC".

2.4 As far as it concerns issue d) the Board stated that

"[i]ssue d) appears to be solved by the indications of solvents that can be used, the solvents and the propellant DME used in the tests, combined with different volume ratios for the active liquid, all as

mentioned in the patent in suit".

2.5 As far as it concerns issue e) the Board stated that

"[i]ssue e) has been discussed under Article 123(2) EPC, as to how it should be interpreted. Since the claim will be read by the skilled person with a mind willing to understand, illogical expressions will be ruled out, such as the liquid containing a suspension of liquid fine chemical liquid particles, since that is nowhere discussed in the patent. The particles referred to can only be the atomised particles after having left the atomiser apparatus. This solves the clarity problem caused by feature e)".

2.6 The above-mentioned preliminary findings of the Board, in so far as they concern the above-mentioned objections a), c), d) and e) regarding lack of sufficiency of disclosure have neither been commented on nor have they been contested any longer by the respondents during the appeal proceedings.

2.7 Under these circumstances, the Board - having once again taken into consideration all the relevant aspects concerning said issues - sees no reason to change its above-mentioned position on said objections a), c), d) and e).

2.8 As far as it concerns the remaining objections b) and f) the Board finds as follows:

2.9 *Sufficiency of disclosure objection b) - Distance at which the measurements are taken*

2.9.1 D16 is evidence that laser beam analysis is an accurate, repeatable and easy-to-use technique, which enables measuring of "aerosol sprays directly by spraying them through the beam. This makes a traditionally difficult measurement extremely simple", see page 7, central column, lines 47 to 52.

2.9.2 According to D32, page E.1, last complete paragraph, within a distance from the spray nozzle defined by two extremes, one positioned too close to the nozzle where the concentration is too high for accurate measurement and one positioned too far from the nozzle so that the displayed particles concentration value becomes so low that it is not reliably detectable, an acceptable range of laser beam measurements can be established.

According to page E.2, first two complete paragraphs of the same document in some "*sprays the droplets may be volatile and evaporate rapidly causing size distributions that will change with distance from the nozzle*". This means that depending on the consistency of the sprayed aerosol the skilled person has to accordingly vary the distance required for performing an appropriate measurement, defining thereby the distance so that consistency of the counting, i.e. consistency of the results is provided. This is something which falls within the capabilities of the person skilled in the art and can be performed without undue burden.

2.9.3 In the light of the above information, which is considered well known to the person skilled in the art, paragraphs [0013] to [0015] of the patent in suit refer

to the measurement of particle size distribution and describe a method of measuring the diameter of the particles using a particle size distribution analyser by means of a laser beam scattering at 25 °C. In paragraph [0014] it is further stated that a suitable position for spraying is set by taking into account spraying output and the like, such that the analyser may be allowed to provide favourable measurements, and that a suitable spraying position is spaced 10 to 50 cm away from the laser beam.

- 2.9.4 The Board follows the appellant in that the skilled person would select in this range a suitable spraying position in order to obtain an accurate measurement. This may involve a visual determination of the particles as sprayed in the air, which will allow the selection of a suitable spraying position that is not too close to the laser beam, to avoid inaccurate measurements due to the high concentration of the particles or to the particles not having reached a stable size. The chosen position is also not too far away, otherwise the analyser will be unable to detect the smaller particles due to low particle density.

In doing so the skilled person will, in fact, find a number of suitable spraying positions which form part of a feasible "working range". The skilled person realises that it is crucial that within this range there will be little or no variation between the measured particle size distributions so that the results will be both reliable and reproducible.

This is consistent with what is required for sufficiency of disclosure in decision T 815/07 (not published in OJ EPO, see points 3 and 5; decision referred to by the respondents), namely that the method

specified for determining the essential technical feature of the invention, in the present case measuring the particle size distribution via laser beam diffraction, is reproducing not arbitrary, but consistent values of the parameter concerned.

- 2.9.5 It is clear that there are numerous considerations to be made when taking measurements by using a laser beam of an atomised chemical liquid but it is well within the capabilities of the skilled person, based on his common general knowledge, to assess and decide on such considerations in order to obtain reliable measurements. Therefore, such a process does not represent an undue burden to the skilled person.
- 2.9.6 Consequently, the question for establishing lack of sufficient disclosure according to the headnote of decision T 593/09 (not published in OJ EPO, cf. headnote; the decision is referred to by both sides), namely whether the essential parameter claimed (in the present case the particle size distribution) is so ill-defined that the skilled person is not able, on the basis of the disclosure as a whole and using his common general knowledge, to identify (without undue burden) the technical measures (e.g. selection of suitable distance range) necessary to solve the problem underlying the patent at issue, is in the present case to be answered in the negative.
- 2.9.7 The Board notes that when measuring this parameter there may be some variation in the values obtained, for example due to experimental error or variations in methodology. However, in the present case the accuracy of the values provided by the measurements is, if it is an issue at all, an issue of clarity of the claim, not

of sufficiency of disclosure.

- 2.9.8 The Board considers respondent I's further arguments as raised in the oral proceedings regarding the need for defining the type of solvent and propellant in claim 1 as not being convincing.

Firstly, paragraph [0043] of the patent in suit recognises the dependency of the "tendency of the particles decreasing in size" on the "types of solvent and propellant used" but it asserts at the same time that "a suitable solvent and propellant can be selected as desired" by the person skilled in the art.

Secondly, the propellant is not of great importance since it normally evaporates immediately after leaving the spraying orifice.

Thirdly, the size of the sprayed chemical liquid particles is mainly determined by the volume ratio of the chemical liquid to the overall volume of the pressure vessel, see paragraph [0017], last sentence and paragraph [0051], first sentence of the patent in suit. This feature is present in claim 1 of the main request.

In any case, due to the information disclosed in paragraphs [0031] to [0036], [0053] and in the examples, e.g. [0061] of the patent in suit, suitable solvents and propellants from a variety of products are made available and can thus be used when putting the present invention into practice.

- 2.9.9 Finally, since it is a method claimed in claim 1 of the main request and not an aerosol atomiser apparatus as such, respondent I's objection of the patent not

enabling the design of an aerosol atomiser apparatus does not need to be dealt with by the Board.

2.9.10 For the above-mentioned reasons, the objection b) of lack of sufficiency of disclosure cannot hold against the main request.

2.10 *Sufficiency of disclosure objection f) - Three- or two-dimensional measurement of the particle size distribution*

2.10.1 The respondents raised during the opposition proceedings the objection that the lack of guidance in the patent in suit as to whether the particle size distribution is measured using a three- or a two-dimensional counting model may lead to inconsistent values of the measured particle size distribution. This would prevent the skilled person from carrying out the claimed invention.

Since said objection was raised by the respondents, the onus was on them to provide clear and convincing evidence that the results obtained by a three-dimensional counting model are significantly different from the results obtained by a two-dimensional counting model, said results deviating by an amount having technical significance or by an amount that would place the skilled person in a situation where he is unable to carry out the present invention.

The respondents not only did not provide any evidence in this respect, but stated during the oral proceedings before the Board that they were not aware of whether there would be a significant difference in the values for the particle size distribution depending on the three-dimensional or the two-dimensional counting

model.

Under these circumstances the Board considers the above-mentioned respondents' argument an unsubstantiated allegation in no need to be taken into consideration.

2.10.2 While there may be some variation in the values obtained depending on the methodology applied, the accuracy of the values provided by the different measuring methods is, if it is an issue at all, again a clarity issue.

2.10.3 For these reasons the Board considers that the objection f) on lack of sufficient disclosure cannot hold against the main request.

2.11 The result is thus that all the objections on lack of sufficient disclosure raised by the respondents under Article 100(b) EPC do not hold against the main request.

3. *Remittal*

3.1 The Board notes that the Opposition Division under chapter 6 of its decision with the heading "Additional remarks" observes as an *obiter dictum* that the skilled person would arrive in an obvious way at the subject-matter of claim 1 of the main request. Since the Opposition Division decided during the oral proceedings that the patent in suit lacks sufficient disclosure of the claimed invention, it terminated the opposition proceedings at that point without the parties having had the possibility to address the issues of novelty and inventive step, more particularly at oral

proceedings.

- 3.2 In view of the Board's finding that the ground for opposition under Article 100(b) EPC does not prejudice the maintenance of the patent according to the main request, see above, the impugned decision has to be set aside. In order not to deprive the parties of the opportunity to argue their case before two instances, and following the corresponding requests of both parties for remittal, see points V.a) and V.b) above, the Board considers it appropriate to make use of its power under Article 111(1) EPC and to remit the case to the department of first instance for further prosecution.

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.

The Registrar:

The Chairman:



G. Nachtigall

H. Meinders

Decision electronically authenticated