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**Datasheet for the decision  
of 22 January 2013**

**Case Number:** T 1319/10 - 3.3.01

**Application Number:** 07075456.9

**Publication Number:** 1820398

**IPC:** A01N 43/80, A01N 37/10,  
A01P 1/00

**Language of the proceedings:** EN

**Title of invention:**  
Microbicial composition

**Applicant:**  
Rohm and Haas Company

**Headword:**  
Microbicial composition/ROHM & HAAS COMPANY

**Relevant legal provisions:**  
EPC Art. 111(1), 83

**Keyword:**  
"Remittal - (yes) - essential issue of sufficiency of  
disclosure not dealt with"

**Decisions cited:**  
G 0001/03

**Catchword:**  
-



Case Number: T 1319/10 - 3.3.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.01  
of 22 January 2013

**Appellant:** Rohm and Haas Company  
(Applicant) 100 Independence Mall West  
Philadelphia, PA 19106-2399 (US)

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

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 1 February 2010  
refusing European patent application  
No. 07075456.9 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** P. Ranguis  
**Members:** J.-B. Ousset  
C.-P. Brandt

## Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division refusing European patent application No. 07075456.9.
- II. The examining division concluded that the claimed matter was not inventive in view of the disclosure of the documents (1) (EP-A-1 332 675) and (2) (Collier, P.J. and al.: "Growth Inhibitory and biocidal activity of some isothiazolone biocides", Journal of Applied Bacteriology, Oxford, GB, vol. 69, no. 4, 1990, pages 569-577).
- III. In its letter of 10 June 2010, the appellant argued that neither document (1) nor document (2) would lead a person skilled in the art to consider that BIT and benzoic acid were synergistic. It also submitted a main and seven auxiliary requests.
- IV. In the annex to the summons to oral proceedings, the board gave its provisional opinion as the requests submitted by the appellant. More particularly, it was pointed out that their admissibility in view of Article 12(4) RPBA and Article 123(2) EPC would be discussed during oral proceedings.
- V. With a further letter of 17 May 2012, the appellant submitted a new main request as well as two new auxiliary requests. It also submitted that these requests met the board's objections.

Claim 1 of the main request reads as follows:

"1. A synergistic microbicidal composition comprising:  
(a) 1,2-benzisothiazolin-3-one; and  
(b) benzoic acid or its salts;  
in a weight ratio of (a):(b) of 1:5 to 1:2000."

Claim 1 of the first auxiliary request reads as follows:

"1. A synergistic microbicidal composition comprising:  
(a) 1,2-benzisothiazolin-3-one; and  
(b) sodium benzoate;  
in a weight ratio of (a):(b) of 1:5 to 1:2000."

Claim 1 of the second auxiliary request reads as follows:

"1. Use of a synergistic microbicidal composition comprising:  
(a) 1,2-benzisothiazolin-3-one; and  
(b) sodium benzoate;  
in a weight ratio of (a):(b) of 1:5 to 1:2000 for the control of mold and/or yeast."

VI. With a fax of 19 June 2012, the board cancelled the oral proceedings scheduled for 22 June 2012.

VII. With a fax of 10 July 2012, the board expressed doubts as to the patentability of the claimed matter based on Article 83 EPC. Since this ground had not been discussed by the department of first instance, the case could be remitted to the examining division, if the appellant requested such a remittal and withdrew its request to oral proceedings.

VIII. With its fax of 10 September 2012, the appellant requested that the case be remitted to the department of first instance and withdrew its request for oral proceedings before the board.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Main, first and second auxiliary requests
  - 2.1 The composition claimed in claim 1 of the main request and of the first auxiliary request as well as the composition used in claim 1 of the second auxiliary request are characterised by a ratio of two constituents and in that the composition is synergistic.
  - 2.2 The decision of the examining division and the minutes of the oral proceedings conducted before the division on 10 December 2009, the synergy was discussed and treated under the heading of inventive step (see points 2.2 and 2.4 of the decision of the examining division). However, in claim 1 of the currently pending requests, as well as the requests pending before the department of first instance (see page 2 of the decision), synergy is expressed as a functional feature. Since this feature is part of the solution proposed by the appellant, it cannot be part of the problem underlying the present application as defined by the examining division (see point 2.1 of the decision of the examining division).

2.3 As mentioned in the decision of the Enlarged Board of Appeal G 1/03 (OJ 2004, 413, point 2.5.2), a sufficiency of disclosure objection is to be raised if the technical effect is also a technical feature of the claims, since this effect characterises the claimed subject-matter.

2.4 Hence the present application has been refused for lack of inventive step on the basis of reasons which are relevant for sufficiency of disclosure under Article 83 EPC.

2.5 In its letter of 10 September 2012, in reply to the communication of the board of 10 July 2012, the appellant requested that the case be remitted to the department of first instance for consideration of this issue and that the oral proceedings scheduled before the board be cancelled.

2.6 Since this issue has been neither addressed nor discussed by the department of first instance, the board finds it appropriate to remit the case to it for further prosecution in order to allow the appellant to have its case assessed by two instances (Article 111(1) EPC).

2.7 The attention of the examining division is drawn to the following:

The results set out in Table 26 should be thoroughly discussed in order to assess whether or not the claimed invention is sufficiently disclosed over the entire scope of the claims. It appears, for instance, that synergy is not established for bacteria (*P.aeruginosa*

or E.coli). Furthermore, regarding C.albicans, it seems that in the upper amounts of sodium benzoate, the trend would be towards an antagonistic effect (see  $Q_a = 5$  and  $Q_b$  between 1000 and 2000;  $Q_a = 10$  and  $Q_b$  between 1000 and 2000;  $Q_a = 15$  and  $Q_b > 1000$  or  $Q_a = 20$  and  $Q_b > 600$ ). The same question might be discussed for A.niger ( $Q_a = 20$  and  $Q_b > 2000$ ).

## **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 on the basis of the main request (claims 1 and 2), auxiliary requests 1 (claim 1) and auxiliary request 2 (claim 1) all filed with letter of 17 May 2012.

The Registrar

The Chairman

M. Schalow

P. Ranguis