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**Datasheet for the decision
of 2 August 2013**

Case Number: T 0704/11 - 3.3.06

Application Number: 02725985.2

Publication Number: 1385930

IPC: C11D 3/50, C11D 3/30, C11D 3/37

Language of the proceedings: EN

Title of invention:
Pro-perfume compositions

Patent Proprietor:
THE PROCTER & GAMBLE COMPANY

Opponent:
Henkel AG & Co. KGaA

Headword:
Pro-perfume composition/PROCTER & GAMBLE

Relevant legal provisions:
EPC Art. 52(1), 54(3)
RPBA Art. 13(1), (3)

Relevant legal provisions (EPC 1973):
EPC Art. 114(2)

Keyword:
"Novelty (main request and first auxiliary request): no"
"Admissibility of the second auxiliary request: no - claim
comprising an undisclosed disclaimer submitted for the first
time during oral proceedings"

Decisions cited:
G 0001/03, G 0002/10

Catchword:
-



Case Number: T 0704/11 - 3.3.06

DECISION
of the Technical Board of Appeal 3.3.06
of 2 August 2013

Appellant:
(Opponent)

Henkel AG & Co. KGaA
Patente (FJP)
D-40191 Düsseldorf (DE)

Respondent:
(Patent Proprietor)

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Representative:

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted
3 February 2011 concerning maintenance of
European patent No. 1385930 in amended form.**

Composition of the Board:

Chairman: B. Czech
Members: L. Li Voti
U. Tronser

Summary of Facts and Submissions

- I. The present appeal by the Opponent is from the interlocutory decision of the Opposition Division concerning the maintenance of European patent no. 1 395 930 in amended form.
- II. In its notice of opposition the Opponent had sought the revocation of the patent on the ground of Article 100(a) EPC 1973, alleging lack of novelty and inventive step.

The novelty objections were based *inter alia* on the disclosure of document D14: EP 1 116 788 A1.

During the opposition proceedings, a further objection was raised by the Opponent under Article 123(3) EPC against the amended sets of claims submitted by the Patent Proprietor.

- III. The Opposition Division found in its decision, in particular, that the amended claims according to the then pending main request, filed with the letter dated 29 June 2009, complied with all the requirements of the EPC.

Claim 1 according to said request reads as follows:

"1. A liquid cleaning or fabric treatment product comprising a pro-perfume composition, which composition comprises the reaction product of a primary and/or secondary amine compound with a combination of a perfume ketone component and aldehyde component having a boiling point greater than 225°C and a molecular

weight greater than 150; said combination having a weight ratio of ketone to aldehyde of from about 95:5 to 25:75; and said amine compound having an Odor Intensity index of less than that of a 1% solution of methylanthranilate in dipropylene glycol; and wherein the perfume ketone component is selected from Alpha Damascone, Delta Damascone, Iso Damascone, Carvone, Gamma-Methyl-Ionone, 7-acetyl, 1,2,3,4,5,6,7,8,-octahydro-1,1,6,7-tetramethylnaphtalene, 2,4,4,7-Tetramethyl-oct-6-en-3-one, Benzyl Acetone, Beta Damascone, Damascenone, methyl dihydrojasmonate, methyl cedrylone, and mixtures thereof."

IV. An appeal was filed against this decision by the Opponent (Appellant). In its statement setting out the grounds of appeal, the Appellant maintained *inter alia* its objections under Articles 52(1)/54(3) and 123(3) EPC.

V. In its reply, the Respondent (Patent Proprietor) rebutted the objections raised, defended the patent in the version held allowable by the Opposition Division (main request) and announced the auxiliary request to maintain the patent on the basis of the amended set of claims filed with the letter of 23 September 2010.

Claim 1 according to the said (first) auxiliary request differs from claim 1 according to the main request only insofar as it requires that the claimed liquid cleaning or fabric treatment product is "*containing **from about 0.005% to 5% by weight** of the pro-perfume composition*" (emphasis added).

VI. At the oral proceedings held on 2 August 2013, the debate focussed on the issue of novelty over document D14 and the Respondent submitted a further amended set of claims as second auxiliary request.

Claim 1 according to the second auxiliary request differs from claim 1 according to the first auxiliary request only insofar as the former claim ends with the following proviso:

"provided that said reaction product is not a pro-perfume obtainable by mixing 20g of Delta Damascone, 16g of water-free Lupasol HF, and 83g of the following perfume mixture

<i>Citronellol</i>	7
<i>Geraniol</i>	7
<i>Linalool</i>	7
<i>Para Tertiary Butyl Cyclohexyl Acetate</i>	10
<i>Phenyl Ethyl Alcohol</i>	19
<i>Habanolide</i>	4.5
<i>Para Methoxy Acetophenone</i>	1.5
<i>Benzyl Acetate</i>	4
<i>Eugenol</i>	2
<i>Phenyl Ethyl Acetate</i>	5
<i>Verdyl Acetate</i>	6
<i>Verdyl Propionate</i>	4
<i>Hexyl Cinnamic Aldehyde</i>	3
<i>Ionone Gamma Methyl</i>	2
<i>Methyl Cedrylone</i>	10
<i>P.T. Bucinal</i>	7
<i>Para Cresyl Methyl Ether</i>	1

for 4 hours at 42°C in a reaction vessel of 250ml."

VII. The Appellant requested that the decision under appeal be set aside and the patent be revoked.

The Respondent requested that the appeal be dismissed or, in the alternative, that the patent be maintained on the basis of the first auxiliary request submitted with letter of 23 September 2010 or of the second auxiliary request submitted during oral proceedings.

VIII. As relevant here, the arguments of the parties can be summarised as follows:

The Appellant held that

- the subject-matter of claim 1 according to the main request and to the first auxiliary request lacked novelty over example II/composition III of D14, forming part of the state of the art pursuant to Article 54(3) EPC;

- the second auxiliary request was not to be admitted into the proceedings since it had been submitted at a very late stage of the proceedings without justification and since it could not be expected that amendments not based on the dependent claims would be made to claim 1 at such a late stage.

The Respondent submitted that

- example II/composition III of document D14 disclosed a composition containing a pro-perfume composition PPC3, which was that obtained according to Synthesis Example II and mixed with a silicone glycol ether;

- the pro-perfume composition of Synthesis Example II was obtained as explained in paragraph [0130] of D14 by

reacting Lupasol HF with Delta Damascone and a perfume mixture; the following paragraph [0131] explained that any type of perfume mixture might be used and indicated the composition of one preferred perfume mixture;

- however, there was no indication in the description of D14 that the specific composition described in paragraph [0131], and not some other perfume mixture, was used when performing Synthesis Example II and subsequently preparing component PPC3 of example II/composition III;

- therefore, D14 did not disclose directly and unambiguously the subject-matter of claim 1 according to the main request and of claim 1 according to the first auxiliary request;

- the second auxiliary request was submitted in order to overcome a possible adverse decision on novelty based on the disclosure of D14; the amendments incorporated into claim 1 were straightforward and overcame clearly the novelty objection based on D14; therefore, this request was admissible despite its late filing.

Reasons for the Decision

Respondent's main request

1. Novelty - Claim 1
 - 1.1 Example II, composition III of D14, a document forming part of the prior art pursuant to Article 54(3) EPC,

discloses a liquid laundry detergent composition containing a pro-perfume composition PPC3 (see D14, paragraph [0138]). PPC3 is a composition "as given from Synthesis Example II and mixed with a silicone glycol ether" in a weight ratio of 50:50 (see D14, page 31, lines 15 to 16, in combination with paragraph [0132], especially page 30, lines 3 to 4).

- 1.2 The pro-perfume composition of Synthesis Example II is obtained as explained in paragraph [0130] by reacting Lupasol HF with Delta Damascone and a perfume mixture.
- 1.3 Lupasol HF is one of the polyethyleneimines which may be used according to the patent in suit as the "*primary and/or secondary amine compound having an Odor Intensity index of less than that of a 1% solution of methylantranilate in dipropylene glycol*" referred to in claim 1 (see the patent in suit, see page 4, lines 13 to 15; paragraph [0015] in combination with page 4, lines 12 to 14). Delta Damascone is one of the perfume ketone components specifically recited in claim 1 at issue.
- 1.4 In the immediately following paragraph [0131] of D14, it is expressly indicated that "any type of perfume mixture may be used" in the previously disclosed synthesis. However, "one preferred composition of the perfume mixture" is specifically listed in the same paragraph.

Said specific perfume mixture contains Methyl Cedrylone and Gamma-Methyl-Ionone, two of the perfume ketones recited in claim 1 at issue. Moreover, the mixture also comprises Hexyl Cinnamic Aldehyde and P.T.Bucinal, two

of the more preferred perfume aldehydes components that may be used according to the patent in suit, both having also "*a boiling point greater than 225°C and a molecular weight greater than 150*" as required by claim 1 at issue (see page 6 of the patent in suit, lines 41 to 43).

1.5 The above finding concerning the disclosure of D14 were not in dispute. However, the Respondent held that, considering in particular the wording "any type of perfume mixture may be used" in paragraph [0131] in document D14, it was not directly and unambiguously derivable from the quoted parts of D14 that the composition PPC3 used in example II/composition III was necessarily obtained using the specific composition listed in paragraph [0131].

1.6 However, the Board remarks that

i) the composition listed in paragraph [0131] is the only specific "perfume mixture" actually disclosed in the whole document D14;

ii) the two consecutive paragraphs [0130] and [0131] belong to the same section of the description having the heading reading "II-Synthesis of delta damascone with Lupasol HF and additional perfume composition"; and

iii) said Synthesis Example II is the only one in D14 actually using a perfume mixture as reactant.

Therefore, in the Board's judgement, there is no doubt that the product described in example II/composition

III was indeed obtained using a perfume mixture having the specific composition disclosed in paragraph [0131].

- 1.7 It was also undisputed that, based on this appreciation of the disclosure of example II/composition III of D14, the remaining features of claim 1 at issue were also disclosed by said example.

Indeed, the amount of ketone perfume components used in Synthesis Example II is of about **30g** (20g Delta Damascone, 8.3g Methyl Cedrilone (10% of 83g of the used perfume mixture composition) and 1.66g (2% of 83g) Gamma-Methyl-Ionone) whilst the amount of aldehyde perfume components is of **8.30g** (2.49g (3% of 83g) Hexyl Cinnamic Aldehyde and 5.81g (7% of 83g) P.T.Bucinal). Therefore the weight ratio of ketone perfume components to aldehyde perfume components reacted with Lupasol HF is within the weight ratio range of 95:5 to 25:75 required by claim 1 at issue.

- 1.8 The Board concludes that claim 1 at issue lacks novelty over example II/composition III of document D14 (Articles 52(1) and 54(3) EPC).

- 1.9 Therefore, the Respondent's main request is not allowable.

Respondent's first auxiliary request

2. Novelty - Claim 1

- 2.1 Claim 1 according to the first auxiliary request differs from claim 1 according to the main request only in that the amount of the pro-perfume composition

contained in the claimed product is specified to be in the range of "*from about 0.005% to 5% by weight*".

2.2 The Board remarks that said composition III of example II of D14, discussed above, contains 0.4% of PPC3, which consists of 50% pro-perfume composition as obtained in Synthesis Example II (see page 31 of D14, lines 15 to 16, in combination with paragraph 132, especially, page 30, lines 3 to 4). Therefore, this composition contains 0.2% by weight of a pro-perfume composition, i.e. an amount falling within the range according to claim 1 at issue.

2.3 At the oral proceedings, the Respondent expressly acknowledged that this additional limitation was not a distinguishing feature with respect to the disclosure of example II/composition III of document D14.

2.4 The Board thus concludes that the subject-matter of claim 1 according to the first auxiliary request also lacks novelty (Articles 52(1) and 54(3) EPC).

2.5 Therefore, the first auxiliary request is also not allowable.

Respondent's second auxiliary request

3. Admissibility

3.1 The Respondent submitted this request during oral proceedings, following the debate concerning the relevance of document D14, as a precaution against a possible adverse decision on novelty. Questioned by the

Board, the Respondent provided no further justification for this course of action.

3.2 In this respect, the Board remarks that

i) it was known to the Respondent since the receipt of the statement of the grounds of appeal of 31 May 2011 that the Appellant maintained his novelty objection based on the disclosure of D14, which objection had already been raised during the proceedings before the first instance; and

ii) the Respondent submitted amended claims (first auxiliary request at issue) with its reply to the statement of the grounds of appeal, which claims were supposed to overcome another objection maintained by the Appellant, i.e. the objection raised under Article 123(3) EPC, but it refrained from filing amended claims as an attempt to overcome the novelty objection based on D14, also maintained by the Appellant.

Therefore, there is no justification for the filing of an auxiliary request addressing the novelty objection at such a late stage of the proceedings.

3.3 Moreover, the amendment to claim 1 is not based on any of the dependent claims already considered during the opposition and appeal proceedings till the day of the oral proceedings. Instead, the amendment consists in the insertion of a proviso (a so-called disclaimer) supposed to exclude the only potentially novelty-destroying subject-matter disclosed in example II/composition III of D14.

- 3.4 Hence, neither the Board nor the Appellant could foresee that the Respondent would consider proposing this type of amendment for the first time at the oral proceedings before the Board.
- 3.5 Furthermore, the insertion into claim 1 of a disclaimer not disclosed as such in the application as filed raises further issues of some complexity. In particular, this type of amendment cannot be considered to clearly comply, at first sight, with all the requirements of the EPC since it has to be evaluated, for example, whether it meets the criteria identified in the Order (points 2.2 and 2.4) of decision G 0001/03 (OJ 2004, 413) and to which extent some of the findings in decision G 0002/10 (OJ 2012, 376, last two paragraphs of the Reasons) have a bearing on the assessment of the compliance of the proposed amendment with the requirements of Article 123(2) EPC.
- 3.6 Therefore, the Board decided not to admit the second auxiliary request into the proceedings (Article 114(2) EPC 1973 and Articles 13(1) and (3) RPBA).

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

B. Czech