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**Datasheet for the decision  
of 29 January 2015**

**Case Number:** T 0262/13 - 3.3.09  
**Application Number:** 06718884.7  
**Publication Number:** 1848759  
**IPC:** C08J7/04, C08L29/04, B32B27/30,  
C08J5/18  
**Language of the proceedings:** EN

**Title of invention:**

METHODS OF MAKING WATER-SOLUBLE FILM WITH RESISTANCE TO  
SOLUBILITY PRIOR TO BEING IMMERSED IN WATER

**Patent Proprietor:**

The Procter & Gamble Company

**Opponents:**

Reckitt Benckiser (UK) Limited  
UNILEVER PLC / UNILEVER NV

**Headword:**

**Relevant legal provisions:**

EPC Art. 54, 56, 123(3)  
RPBA Art. 13(1)

**Keyword:**

Novelty - (yes)  
Inventive step - (yes)  
Amendments - extension of protection conferred - (no)  
Admissibility of late-filed objection - (no)

**Decisions cited:**

T 2017/07, T 0249/13

**Catchword:**



**Beschwerdekammern  
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Case Number: T 0262/13 - 3.3.09

**D E C I S I O N  
of Technical Board of Appeal 3.3.09  
of 29 January 2015**

**Respondent:**  
(Patent Proprietor)

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**Party as of right:**  
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**Decision under appeal:**

**Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
30 November 2012 concerning maintenance of the  
European Patent No. 1848759 in amended form.**

**Composition of the Board:**

<b>Chairman</b>	W. Sieber
<b>Members:</b>	J. Jardón Álvarez
	K. Garnett

## Summary of Facts and Submissions

I. This decision concerns the appeals filed by the patent proprietor and opponent 01 against the interlocutory decision of the opposition division that European patent EP-B-1 848 759 in the name of The Procter and Gamble Company as amended meets the requirements of the EPC.

For simplicity the board will continue to refer to the parties in the appeal proceedings as the patent proprietor, opponent 01 and opponents 02, respectively.

II. Two oppositions had been filed by Reckitt Benckiser (UK) Limited (opponent 01) and by Unilever PLC / Unilever N.V. (opponents 02) requesting revocation of the patent in its entirety based on the grounds that the claimed subject-matter was neither novel nor inventive (Article 100(a) EPC) and that the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC).

The documents cited during the opposition proceedings included:

D1: EP 0 457 600 A2;

D3: WO 02/26896 A2;

D7: WO 2006/078897 A1;

D15: Encyclopedia of Polymer Science and Technology, vol.8, published online on 15 March 2002, pages 399 to 437; and

D16: Experimental report filed by the patent proprietor with letter dated 24 August 2012, (1 page), non-dated.

III. The decision of the opposition division announced orally on 23 October 2012 and issued in writing on 30 November 2012 was based on a main request and a first auxiliary request. The relevant request for the present decision is the first auxiliary request held allowable by the opposition division. Claim 1 of this request reads as follows:

"1. A method of making a water-soluble film that is resistant to solubility prior to being immersed in water the film having a first surface, a second surface, and a thickness between the first and second surfaces, the film comprises a water-soluble film-forming composition comprising at least some polyvinyl alcohol and a salt that is distributed more closely to at least one of the first and second surfaces than throughout the thickness of the water-soluble film, said method comprising the steps of:

- (a) forming a water-soluble film, comprising at least some polyvinyl alcohol, having a first surface and a second surface; and
- (b) applying a salt to at least one of said surfaces of said film; said salt comprises between 0.5% and 15% of the weight of said film, wherein said salt is selected from the following group: consisting of: sodium sulfate, sodium citrate, sodium tripolyphosphate, potassium citrate, potassium tripolyphosphate and mixtures thereof."

The opposition division's decision can be summarized as follows:

- The opposition division rejected the main request of the patent proprietor for lack of compliance with the requirements of Article 83 EPC.
  
- The opposition division found that the claims of the first auxiliary request fulfilled the requirements of the EPC. In particular the opposition division found that the subject-matter of the claims of this request was novel over the disclosure of D1 (twofold selection) and involved an inventive step starting from D3 as the closest prior-art document. In its view the problem of providing a method of making a water-soluble film comprising polyvinyl alcohol which further improved the resistance of the film to exposure to small amounts of water was credibly solved by the use of a salt as specified in claim 1. This solution was not obvious in view of D3 alone or in combination with common general knowledge or in combination with the teaching of D15.

IV. Appeals against this decision were filed on 29 January 2013 by opponent 01 and on 8 February 2013 by the patent proprietor. The respective appeal fees were paid in due time.

V. In its statement of grounds of appeal filed on 9 April 2013 the patent proprietor requested maintenance of the patent on the basis of a main request, corresponding to the main request that was before the opposition division, alternatively on the basis of newly filed auxiliary request 1, alternatively that the appeal of opponent 01 be dismissed and the decision of the opposition division be upheld (auxiliary request 2).

VI. In its statement of grounds of appeal filed on 10 April 2013, opponent 01 requested that the decision under appeal be set aside and the patent be revoked.

VII. Further submissions were filed:

a) By opponent 01 with letter of 7 August 2013 including the following document:

D17: G.C. Nutting, "Effect of electrolytes on the viscosity of potato starch pastes" (12 pages), non-dated (bibliographic reference missing).

b) By opponents 02 with letter of 15 August 2013 including the following document:

D18: Solubility table taken from Wikipedia (9 pages), non-dated.

c) By the patent proprietor with letters of 23 August 2013 and 23 June 2014, including auxiliary requests 3 to 9, and the following further evidence:

D19: Undated experimental report filed with letter dated 23 June 2014, (2 pages).

VIII. In response to the board's communication, issued on 7 August 2014 in preparation for the oral proceedings, the patent proprietor by its letter of 22 December 2014 withdrew its appeal and requested that the appeal of opponent 01 be dismissed (main request), alternatively that the patent be maintained on the basis of auxiliary requests 1 to 4 filed with this letter (equivalent to previous auxiliary requests as now renumbered).



IX. On 29 January 2015 oral proceedings were held before the board in the absence of opponent 01. It had announced by letter dated 23 January 2015 that it would not be represented at the oral proceedings in view of the fact that the scope of the patent proprietor's requests had now been significantly limited.

During the oral proceedings the main request of the patent proprietor was discussed. It corresponds to the first auxiliary request found allowable by the opposition division (point III above).

X. The arguments presented by the patent proprietor in its written submissions and at the oral proceedings, insofar as they are relevant for the present decision, may be summarised as follows:

- Amended claim 1 fulfilled the requirements of Articles 123(2) and (3) EPC. It resulted from the incorporation of the preferred salts disclosed in granted claim 3 into granted claim 1. The use of any other salt not recited in the claim was not within the scope of the claim.
  
- The subject-matter of claim 1 was novel over D1 because there was no clear and unambiguous disclosure in D1 of an embodiment wherein a salt as claimed was distributed more closely to at least one of the first and second surfaces than throughout the thickness of the film, the amount of salt being between 0.5 and 15% of the weight of the film.

- The new novelty attack based on D7 was filed extremely late in the appeal proceedings and it should not be admitted.
  
- Concerning inventive step, D3 was considered to represent the closest prior-art document. The problem addressed by the invention was the provision of a water-soluble film (which could as a result dissolve in water in use) but which was nevertheless resistant to contact with small amounts of water. The experimental reports D16 and D19 showed that only certain salts solved this problem. This solution, namely the use of a defined salt distributed more closely to at least one of the surfaces was not derivable from the cited prior art.

XI. The relevant written arguments of opponent 01 may be summarised as follows:

- Document D1 was novelty destroying for the subject-matter of claim 1 since the selection of one salt from a list, combined with the selection of a very substantial and also arbitrary part of a preferred concentration range for the listed salts could not confer novelty on the claim.
  
- The claimed subject-matter lacked inventive step in view of the teaching of D3 alone. Starting from D3 as closest prior-art document, the asserted improvement of the resistance to exposure to small amounts of water of the films of D3 had not been solved across the whole scope of claim 1. Moreover claim 1 encompassed powders that were obvious alternatives to the preferred embodiments used in

D3 because the teaching of D3 was not limited to water-insoluble powders

XII. The relevant arguments of opponents 02 presented during the oral proceedings may be summarized as follows:

- Amended claim 1 extended the scope of protection contrary to Article 123(3) EPC. By reference to T 2017/07 opponents 02 argued that films excluded from the claims as granted were now included in the scope of the claim.
- Additionally, they requested an amendment to their case to raise a new novelty objection based on document D7. The objection was in fact in the proceedings as it had been raised during the opposition proceedings.

XIII. Opponent 01 requested that the decision under appeal be set aside and the patent be revoked.

The patent proprietor requested that the appeal be dismissed (main request), alternatively that the decision under appeal be set aside and the patent be maintained on the basis of one of auxiliary requests 1 to 4 as filed with its letter dated 22 December 2014.

## **Reasons for the Decision**

1. The appeal is admissible.

### MAIN REQUEST

2. *Preliminary remark*
  - 2.1 The board agrees with the finding in the appealed decision that the claims of the main request fulfill the requirements of Articles 83 and 84 EPC. As this finding was not contested by the opponents during the appeal proceedings, there is no need for the board to say anything about these aspects.
3. *Amendments*
  - 3.1 Claim 1 of the main request results from claim 1 as granted wherein the salt has been limited to the preferred salts of granted claim 3, namely sodium sulphate, sodium citrate, sodium tripolyphosphate, potassium tripolyphosphate, and mixtures thereof.
  - 3.2 Opponents 02 contested this amendment on the ground that it was an extension of the granted claims and contrary to the requirements of Article 123(3) EPC. By reference to decision T 2017/07 opponents 02 argued essentially that the method now claimed required 0.5-15% of one of the salts recited in amended claim 1 but allowed the presence of any other salt in any amount, that is to say, embodiments not covered by granted claim 1 that limited the amount of any salt used to be comprised between 0.5% and 15%.
  - 3.3 The board disagrees for the following reasons:

- 3.3.1 First of all the board agrees with the patent proprietor that the wording of the claim does not allow the use of other salt different from those listed, namely: sodium sulphate, sodium citrate, sodium tripolyphosphate, potassium tripolyphosphate and mixtures thereof.

When considering a claim, the skilled reader should try to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent. The patent must be construed by a mind willing to understand, not a mind desirous of misunderstanding (see Case Law of the Boards of Appeal, 7th edition 2013, II.A.6.1). Step (b) of claim 1 is drafted as requiring first "applying" a salt, then "specifying" the amount to be used and finally "defining" the salts to be applied. By using such "cascade" formulation the wording of the claim is subjected to an implicit proviso excluding the application of any other salt except those therein specified. The skilled reader of the claim would exclude any other interpretation of the claim as illogical and artificial.

- 3.3.2 But even if the claim would be interpreted as allowing the application of any other salt not covered by amended claim 1, the claim would still fulfil the requirements of Article 123(3) EPC. In fact, the scope of present claim 1 is exactly the same as the scope of the preferred embodiment of granted claim 3 from which the limitation to claim 1 has been taken. In other words, if present claim 1 allows the presence of further salts, claim 3 as granted allowed the presence of further salts, too.

3.3.3 The board cannot accept the argument of opponents 02 that granted claim 3 should be interpreted in a narrower sense than present claim 1. According to opponents 02, present claim 1 is presented in a different context as granted claim 3; in particular granted claim 3 was a dependent claim whereas present claim 1 is an independent claim. In their view the "implicit" limitation that no other salts should be present would be more apparent to the skilled reader in a dependent claim than in an independent claim.

However, in the board's view, if a broader interpretation is used for present claim 1, the same broad interpretation must be allowed for the preferred embodiment of granted claim 3, because the wording of the claims is the same.

3.3.4 Lastly, decision T 2017/07 referred to by opponents 02 does not support their objection either. Although in that case a similar amendment was denied by the board, the situation was different in that the limitation was taken from the description and not from a dependent granted claim. Thus, the reasoning above that the amended claim has indeed the same scope as the granted dependent claim did not apply in that case.

3.3.5 Thus, the board concludes that the scope of protection conferred by present claim 1 has not been broadened vis-à-vis that of claims 1 and 3 as granted, and thus that the requirements of Article 123(3) EPC are satisfied.

#### 4. *Novelty and inventive step*

4.1 The present appeal case is closely related to appeal case T 0249/13 involving the same patent proprietor and

the same opponents. Both patent applications were filed on the same day and are based on nearly identical specifications. While the claims in appeal case T 0249/13 are directed to water-soluble films *per se*, the claims in the present case are directed to a method of preparation of such water-soluble films.

- 4.2 The relevant documents for novelty and inventive step are, although numbered differently, in both cases the same, namely D1, D3, D16 and D19 in the present case, corresponding to D3, D6, D14 and D17 in T 0249/13, respectively.
- 4.3 This board has already decided in T 0249/13 that the water-soluble film therein claimed was novel and involved an inventive step over the documents cited there, namely D3 (for novelty) and D6 (for inventive step), corresponding to D1 and D3 in the present proceedings, respectively.
- 4.4 Present claim 1 is essentially directed to a method of preparing the water-soluble films found to be novel and inventive in T 0249/13. The only difference is that in the present method claim the amount of salt applied in the film formation is slightly different and comprises between 0.5% and 15% of the weight of the film (instead of from 1% to 15% in T 0249/13). The board is nevertheless satisfied that the reasoning in the above case as regards novelty and inventive step also applies for the amounts of salt covered by the slightly broader claim 1 in the present appeal. Indeed no objections in this sense were raised by the opponents.
- 4.5 The method now claimed, namely the application of a specific salt to at least one of the surfaces of the film, is in fact an "analogy" process, similar to the

prior-art processes (see, for instance, claim 1 of D3; see also paragraph [0004] of the present patent specification).

Taking into account that it is well-established jurisprudence of the boards that analogy processes are patentable insofar as they provide a novel and inventive product (see Case Law of the Boards of Appeal of the EPO, 7th edition 2013, Chapter I.D.9.17), the subject-matter of claim 1 of the main request directed to an analogy method for the preparation of a novel and inventive water-soluble film is patentable since it provides a novel and inventive product.

4.6 Consequently, the subject-matter of claim 1, and by the same token the subject-matter of dependent claims 2 to 6, fulfils the requirements of Articles 54 and 56 EPC.

5. *Opponents 02's request to amend their case*

5.1 During the oral proceedings before the board, opponents 02 requested amendment of their case so as to be able to make a further novelty objection based on document D7.

5.2 D7 was not mentioned in any of the submissions made by the parties in the appeal proceedings. It was also not discussed in the appealed decision. In fact D7 would be relevant for the novelty of the claimed subject-matter only if the priority was not validly claimed. This issue was also not dealt with in the appealed decision and had also not been raised during the appeal proceedings. Opponents 02 requested that this new attack be admitted, saying such an objection had already been raised in its notice of opposition.



5.3 Any objections which opponents 02 wanted to rely on should have been filed with the reply to the statement of grounds of appeal, or at the latest as part of a written reply to the board's communication. The fact that it may have been raised in the notice of opposition is irrelevant.

It could have been expected that both the patent proprietor and the board would prepare for the oral proceedings on the basis of the statements of the parties' cases as they then stood and as summarised in the board's communication, together with any reply to it. It was thus not procedurally expedient or fair to allow opponents 02 to alter their case in this way, not least because allowing the amendment would also have involved checking whether the claimed priority was valid.

5.4 Accordingly, the board exercised its discretion under Article 13(1) RPBA and did not admit the requested amendment to opponents 02's case into the proceedings.

#### AUXILIARY REQUESTS 1 TO 4

6. As the main request of the patent proprietor is allowable, there is no need for the board to deal with the further auxiliary requests.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated