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**Datasheet for the decision
of 22 November 2016**

Case Number: T 1002/14 - 3.3.06

Application Number: 01942003.3

Publication Number: 1294836

IPC: C11D1/00, C11D3/00

Language of the proceedings: EN

Title of invention:

Rinse agent composition and method for rinsing a substrate surface

Patent Proprietor:

ECOLAB INC.

Opponents:

Henkel AG & Co. KGaA
THE PROCTER & GAMBLE COMPANY

Headword:

Rinse agent / ECOLAB

Relevant legal provisions:

EPC Art. 52(1), 54, 56, 84, 111(1), 123(2), 123(3)
RPBA Art. 12(1), 12(4), 13(1), 13(3)

Keyword:

Added matter (main request) : yes
Admissibility of auxiliary request 1 : yes
Clarity of claim 1 (auxiliary requests 1 and 2) : no - more than one possible interpretation of claim 1 due to amendments made
Clarity (auxiliary request 3) : not open to objections in accordance with G 3/14
Added matter (auxiliary request 3) : no - supported intermediate generalisation
Novelty (auxiliary request 3) : yes

Decisions cited:

G 0009/91, G 0003/14, T 0962/98, T 1387/06

Catchword:



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Case Number: T 1002/14 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 22 November 2016

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 20 February
2014 revoking European patent No. 1294836
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman B. Czech
Members: L. Li Voti
 T. Karamanli

Summary of Facts and Submissions

- I. The present appeal is from the decision of the Opposition Division revoking the European patent No. 1 294 836.
- II. The two Opponents had invoked grounds for opposition under Article 100(a), (b) and (c) EPC. They relied *inter alia* on the following prior-art document:
- D3: WO 94/24256 A1.
- III. In the course of the opposition proceedings, the Patent Proprietor submitted amended claim requests, independent claims 1 and 15 of the ultimately pending main request reading as follows (amendments made to the corresponding claims of the patent as granted made apparent by the Board in bold for additions and by strikethrough for deletions):
- "1. Use of a composition as a rinse agent ~~composition for use on a cleaned surface, the composition comprising:~~**
- (a) *sheeting agent comprising surfactant for promoting draining of sheets of water from a surface; wherein the sheeting agent comprises at least one of a nonionic block copolymer having ethylene oxide and propylene oxide residues, alkyl polyglycosides, zwitterionics, and anionics.*
- (b) *humectant comprising a material that contains greater than 5 wt.% water when the material is equilibrated at 50% relative humidity and room temperature; wherein the humectant comprises propylene glycol,*

wherein the sheeting agent and the humectant are different and the weight ratio of the total amount of humectant in the rinse agent composition to the total amount of sheeting agent in the rinse agent composition is greater than 1:3."

"15. A method for rinsing a substrate surface in the presence of water having a total dissolved solids content in excess of 200 ppm, the method comprising: applying the aqueous rinse agent composition according to claims 1 to 14 to a substrate surface, wherein the method includes a step of cleaning the substrate surface prior to the step of rinsing."

- IV. In its decision (point 4.5 of the Grounds for the decision), the Opposition Division found *inter alia* that claim 1 of the then pending main request (III, *supra*) and of the then pending first auxiliary request were objectionable under Article 123(2) and (3) EPC. More particularly, the Opposition Division held that (emphasis added by the Board) "[l]ooking at original page 4, line 26 it becomes clear that ... the composition is used **by dilution**, a feature which was [sic] been omitted in the main and the 1st auxiliary request. This means that the subject matter of the main and 1st auxiliary request is on the one hand not originally disclosed, but is now also broader than the patent as granted leading to a violation of article 123(2) EPC and article 123(3)EPC."

The then pending second auxiliary request was found to be non-objectionable under Articles 83 and 84 EPC, but the subject-matter of claim 1 thereof was found to lack novelty over D3.

- V. In its statement of grounds of appeal dated 27 June

2014, the Appellant (Patent Proprietor) contested the reasoning of the Opposition Division. It submitted also that the Opposition Division had committed a substantial procedural violation.

With its statement, the Appellant filed five sets of amended claims as main request and auxiliary requests 1 to 4.

Moreover, to support its view that D3 was not novelty-destroying for independent method claim 1 according to auxiliary request 3, it filed also the following documents:

D17: Total dissolved solids in Drinking-water, Background document for development of WHO *Guidelines for Drinking-water Quality*, 2003, originally published 1996; and

D18: Print-out from Wikipedia, keyword: "Total dissolved solids", page last modified on 26 May 2014.

VI. In its reply, Respondent I (Opponent 01) rebutted all the Appellant's arguments and submitted

- that claim 1 according to the main request did not comply with the requirements of Article 123(2) and (3) EPC,
- that the subject-matter of claim 1 according to auxiliary requests 1 and 3 lacked novelty over D3, and
- that the subject-matter of claim 1 according to auxiliary requests 2 and 4 lacked inventive step.

It also filed two further documents to corroborate its novelty objection directed against claim 1 according to auxiliary request 3, namely

D19: Print-out from RÖMPP Online, Version 3.37,
keyword: "Milch", 2014, last update August 2010;
and

D20: Print-out from Wikipedia, keyword: "Milch", page
last modified on 10 November 2014.

VII. Respondent II (Opponent 02) replied to the Appellant's statement of ground arguing that none of the Appellant's requests was allowable since they were objectionable under Article 123(2) EPC and Article 84 EPC (clarity) and for lack of novelty and lack of inventive step. Moreover, it submitted that the Opposition Division had not committed any substantial procedural violation. Invoking Article 12(4) RPBA, it also called into question the admissibility of auxiliary requests 1 and 4. Regarding the issue of novelty of method claim 1 according to auxiliary request 3 over D3, it also relied on the following newly filed documents:

D21: Abstract from Journal of Dairy Science, vol.89, supplement, pages E20-E30, "Use of Microfiltration to Improve Fluid Milk Quality" by M.W.Elwell et al., March 2006; and

D22: Print-out from the website www.tdsmeter.com, page title "Drinking Water Standards".

VIII. In two further letters the Appellant rebutted the Respondents' objections and arguments and submitted that the issue of inventive step should not be considered in these appeal proceedings, since it was not dealt with in the decision under appeal, and that the case should be remitted to the department of first instance for the examination of inventive step.

- IX. Respondent II replied once more in writing, reiterating its objections and taking position on the Appellant's arguments.
- X. The parties were summoned to oral proceedings. In the communication issued in preparation for the oral proceedings, the Board indicated its preliminary opinion on some specific issues, as follows:
- Claim 1 according to auxiliary request 1 could be objectionable for, *inter alia*, lack of clarity (Article 84 EPC) (point 7.2.2).
 - The admissibility of the items of evidence filed by the parties in appeal proceedings in connection with the issues concerning auxiliary requests 3 and 4, would only be addressed, if necessary at all, in case a discussion of substance on these requests would turn out to become necessary (points 8.1 and 8.2).
 - No procedural error seemed to have occurred during the first-instance proceedings (point 9.2).
 - The Board was inclined to remit the case to the Opposition Division for further prosecution, in case one of the pending requests were found to be both admissible and not objectionable on the grounds raised by the Respondents under Articles 84 and 123 EPC, or for lack of novelty.
- XI. Respondent I announced by letter of 5 September 2016 that it would not be represented at the oral proceedings.
- XII. With a letter of 20 October 2016, the Appellant filed further comments concerning *inter alia* novelty over document D3. In this respect it filed also a declaration by Ms. Kieffer.
- XIII. In its reply to this letter, Respondent II maintained

its novelty objection based on D3 and, with respect to the claims directed to a composition, it stated that "in the instance that the Board are minded to accept that the claims implicitly require a sheeting effect above a certain threshold, then the invention is not sufficiently disclosed."

XIV. Oral proceedings were held on 22 November 2016 in the absence of the duly summoned Respondent I.

During the oral proceedings the Appellant expressly accepted to rely on the versions of the claims bearing handwritten amendments as representing the correct wording of the claim requests.

The parties were heard in particular regarding

- compliance of claim 1 according to the main request with Article 123(2) EPC);
- admission of auxiliary request 1 into the proceedings (Article 12(4) RPBA),
- clarity (Article 84 EPC) of claim 1 according to auxiliary requests 1 and 2;
- compliance with Articles 84 and 123(2) EPC of the claims according to the then pending auxiliary request 3.

The Appellant then filed new amended versions of the claims according to auxiliary request 3 (differing from the previously pending auxiliary request 3 essentially in terms of deletions of dependent claims) and auxiliary request 4. Subsequently, the parties were heard regarding the admission of these new auxiliary requests into the proceedings (no objection raised), the formal allowability of these sets of claims (no further objections besides the ones raised with respect to the previously pending auxiliary request 3) and the

(sole) novelty objection raised, which was based on D3. D17 and D18 were also considered in this context.

The Appellant ultimately withdrew its request for reimbursement of the appeal fee based on an alleged substantial procedural violation. It also requested that the objections of Respondent II concerning sufficiency of disclosure be not admitted into the appeal proceedings.

XV. Final requests:

The Appellant requested that the decision under appeal be set aside and that the case be remitted to the Opposition Division for further prosecution (i.e. in particular for the examination of inventive step) on the basis of the claims according to the main request, filed with the statement of grounds of appeal of 27 June 2014 or, in the alternative, according to auxiliary request 1 or auxiliary request 2, both filed with the statement of grounds of appeal of 27 June 2014, or auxiliary request 3 or auxiliary request 4, both requests filed at the oral proceedings before the Board.

Respondents I and II requested that the appeal be dismissed.

XVI. Pending claim requests of the Appellant

Claim 1 according to the **main request** is identical to claim 1 of the main request that had been pending before the Opposition Division (wording under III, *supra*) apart from not comprising in its handwritten form a comma between "*on a cleaned surface*" and "*the composition comprising*".

Claim 1 according to **auxiliary request 1** differs from that according to the main request only in terms of its introductory clause reading (amendment by insertion made apparent in bold by the Board):

*"1. Use of a composition as a rinse agent **for use** on a cleaned surface the composition comprising: ... "*

Claim 1 according to **auxiliary request 2** differs from that according to auxiliary request 1 only in that it comprises a comma between "on a cleaned surface" and "the composition comprising", and in that the last feature of the claim was amended to read (amendments made apparent by the Board)

*"the weight ratio of the total amount of humectant to the total amount of sheeting agent in the rinse agent composition is ~~greater than 1:3~~ **between 3:1 and 1:1**".*

Claim 1 of the set of nine claims according to **auxiliary request 3** reads as follows (amendments to independent method claim 15 according to the main request made apparent by the Board):

*"15. A method for rinsing a substrate surface in the presence of water having a total dissolved solids content in excess of 200 ppm, the method comprising: applying the aqueous rinse agent composition according to ~~claims 1 to 14~~ to a substrate surface, wherein the method includes a step of cleaning the substrate surface prior to the step of rinsing, **wherein the rinse agent composition comprises***
a) sheeting agent comprising surfactant for promoting draining of sheets of water from a surface; wherein the sheeting agent comprises at least one of a nonionic block copolymer having ethylene oxide and propylene

oxide residues, alkyl polyglycosides, zwitterionics, and anionics.

b) humectant comprising a material that contains greater than 5 wt.% water when the material is equilibrated at 50% relative humidity and room temperature; wherein the humectant comprises propylene glycol,

wherein the sheeting agent and the humectant are different and the weight ratio of the total amount of humectant in the rinse agent composition to the total amount of sheeting agent in the rinse agent composition is greater than 1:3."

Dependent claims 2 to 9 according to auxiliary request 3 concern more specific embodiments of the method according to claim 1. More particularly, claims 4, 5 and 6 differ, respectively, from claim 1 in that the weight ratio of the total amount of humectant in the rinse agent composition to the total amount of sheeting agent in the rinse agent composition is, respectively, "**between about 5:1 and 1:3**" (claim 4), "**about 4:1 and 1:2**" (claim 5), and "**about 3:1 and 1:1**" (claim 6).

Claim 8 differs from claim 1 in that the sheeting agent comprises "**an alkyl polyglycoside having the formula: $(G)_x-O-R$ wherein G is a moiety derived from reducing saccharide containing 5 or 6 carbon atoms, R is a fatty aliphatic group containing 6 to 20 carbon atoms, and x is about 0.5 to about 10**".

XVII. The arguments relevant for the present decision, submitted in writing and/or orally by the parties, can be summarised as follows:

Main request - compliance of claim 1 with the requirements of Article 123(2) EPC

- The Appellant submitted that claim 1 was a reformulation of granted product claim 1 as a use claim, and that dilution of the rinse agent was not a mandatory feature of the claim. Support for the amended claim could be found in the passage on page 4, last paragraph, of the description as originally filed. Moreover, original dependent claims 12 and 22 made it apparent that water was only an optional component of the rinse agent composition. Therefore, claim 1 according to the main request complied with the requirements of Article 123(2) EPC.

- Both Respondents considered that said description passage clearly indicated that the rinse agent composition had to be used in diluted form. Moreover, the application as filed did not contain any disclosure of the use on a cleaned surface of a rinse agent composition consisting only of a sheeting agent of type (a) and propylene glycol as humectant (b). Thus claim 1 according to the main request contravened the requirements of Article 123(2) EPC.

Admissibility of auxiliary request 1

- The Appellant explained that the objection under Article 123(2) EPC against the amended claim 1 according to the main request had been raised for the first time during the oral proceedings before the Opposition Division, in reaction to the wording amended from "*Use of a composition ... for use ...*" to "*Use of a composition ...*". Therefore, the Patent Proprietor had decided during those oral proceedings to maintain the contested amendment in its main claim request

(identical to the present main request) but to keep the former wording in the then pending auxiliary request 1 (corresponding to present auxiliary request 2).

The now pending auxiliary request 1 was filed in reaction to the finding in the decision under appeal concerning the non-compliance of claim 1 according to the then pending main request with Article 123(2) EPC, and as a precaution in case the present main request would not be found allowable by the Board.

- Respondent II submitted that auxiliary request 1 could and should have been filed in proceedings before the department of first instance and was not to be admitted under Article 12(4) RPBA.

Auxiliary request 1 - clarity of claim 1

- The Appellant pointed out that claim 1 as granted already contained the wording "*rinse agent for use on a cleaned surface*"; therefore, any alleged lack of clarity arising from this wording was not objectionable in view of decision G 3/14.

In any case, it would be clear to the skilled person, reading the claim with common sense, that claim 1 concerned the use of a rinse agent composition in aqueous form on a cleaned surface as last step of a warewashing process, including final drying.

In fact, rinse agent compositions were always used in dilution with water and the definition of the sheeting agent (a) of the rinse agent composition of claim 1 as a surfactant for promoting draining of sheets of water from a surface also indicated that the rinse composition had to comprise water.

- Respondent II pointed out that the wording of claim 1 according to auxiliary request 1 was not identical to

the one of claim 1 as granted and concerned a use, i.e. an activity, and not a product as granted claim 1. In fact, the wording "*for use*" in the granted (product) claim only indicated the suitability of the claimed product for a certain use, whilst in claim 1 of auxiliary request 1, the same wording concerned a technical feature of the claimed use. Therefore, the lack of clarity of claim 1 at issue originated from the amended wording of the claim and was objectionable in view of decision G 3/14. In particular, it was not clear whether according to claim 1 the "*rinse agent composition*" could be used during any step of a cleaning process involving rinsing, for example also in an intermediate rinsing step during cleaning and not necessarily in the final rinse. Moreover, in the absence of a specific indication in the claim, it was unclear whether the rinse agent composition had necessarily to be used in diluted form or whether it could also be used as a concentrate directly on the surface to be treated, followed by addition of rinse water or other suitable diluent. Finally, it was also not clear whether or not water had to be present as a mandatory component of the "*rinse agent composition*" used, since the possible applications of the rinsing method of the patent in suit extended to the rinsing of very different surfaces such as windows or mirrors, for which the use of other solvents as diluents instead of water could be envisaged. Therefore, claim 1 did not comply with the clarity requirements of Article 84 EPC.

Auxiliary request 2

It was common ground between the parties that the arguments concerning clarity of claim 1 according to auxiliary request 1 applied likewise to claim 1 according to auxiliary request 2.

Auxiliary request 3 - clarity of claim 1

- Respondent II objected that claim 1 according to auxiliary request 3 was not clear since the expression "*applying **the** aqueous rinse agent composition*" (emphasis added by the Board) lacked an antecedent. Moreover, it was not clear whether the features "*applying the aqueous rinse agent composition to a substrate*" and "*wherein the rinse agent composition comprises*" necessarily referred to one and the same composition.

- The Appellant argued that the wording "***the** aqueous rinse agent composition*" was already contained in granted claim 15. Therefore, the clarity of claim 1 at issue was not objectionable in view of G 3/14. Moreover, such a wording had to be understood to relate to "***an** aqueous rinse agent composition*". Therefore, the claim was clear.

Auxiliary request 3 - compliance with the requirements of Article 123(2) EPC

- The Appellant submitted that, considering the whole disclosure of the original application, all claims of this request complied with the requirements of Article 123(2) EPC. In particular, it was clear from the original description and examples that propylene glycol was one of the preferred humectants (b) and that it could be used in combination with all the classes of surfactants that may be used as sheeting agent (a).

- Respondent II objected that claim 1 contravened the requirements of Article 123(2) EPC since the combination of the specific sheeting agents (a) with propylene glycol as humectant (b) amounted to an

unsupported intermediate generalisation of the original disclosure. In particular, the only disclosures of such combinations were contained in specific examples which concerned rinse agent compositions not only having **specific** ratios of components (a) to component (b) but also comprising additional components possibly affecting the final rinsing effect. For similar reasons, the dependent claims prescribing, additionally, specific ranges for the ratio of component (a) to component (b) (claims 4 to 6) or the use of an alkyl polyglycoside having a given structural formula as sheeting agent (a) (claim 8) also found no basis in the application as filed.

- The Appellant contested the admissibility of the detailed objections under Article 123(2) EPC raised by Respondent II against these dependent claims since, in its view, they were presented for the first time during the oral proceedings before the Board.

- As regards the admissibility of the objections brought forward against such dependent claims, Respondent II submitted that it had already indicated in writing that the same arguments brought forward against the dependent claims of the main request applied to the dependent claims according to auxiliary request 3.

Auxiliary request 3 - novelty of claim 1

- As regards novelty of claim 1 according to auxiliary request 3 the Appellant submitted inter alia that the method disclosed in document D3 (description page 16, line 36, to page 17, line 19) with respect to the use of the rinse additive of table IV of D3 (page 18, lines 16 to 22) did not unambiguously involve rinsing water

with a total dissolved solids (TDS) content "*in excess of 200 ppm*". Therefore, the subject-matter of claim 1 was novel over D3.

- Respondent II submitted that this rinsing method described in D3 comprised the use of "city water" (as mentioned in table IV on page 18 of D3). City water necessarily contained dissolved solids. Moreover, it was common general knowledge (document D17) that most sources of drinking water (and thus also tap water or city water) contained more than 200 ppm TDS. In fact, as already stated in writing, the average TDS content of US tap water was about 350 ppm and, accordingly, the examples of the patent described the use of water having a TDS of 300 ppm. Therefore, it was reasonable to assume on the balance of probabilities that also the water used during rinsing according to the cited example of D3 had a TDS content in excess of 200 ppm. Moreover, the water used in the rinsing step of the cited example of D3 contained also some dispersed "non-fat milk", comprising a certain amount of components contributing to the TDS content, as apparent from document D18. This additional amount of dissolved solids stemming from the milk had to be added to the amount of dissolved solids already contained in city water. Therefore, a TDS content as required by claim 1 at issue was implicitly disclosed by the cited example of D3. The subject-matter of claim 1 thus lacked novelty over D3.

Reasons for the Decision

Main request

1. The set of claims according to the main request is substantially identical to that already pending as main request before the Opposition Division (XVI, *supra*). The admission of this request into the appeal proceedings is thus not at stake.

2. Non-compliance with Article 123(2) EPC - claim 1
 - 2.1 Claim 1 (regarding the wording, cf. XVI and III, *supra*) concerns the "*use of a composition as a rinse agent on a cleaned surface*" wherein the composition comprises a sheeting agent (a) comprising at least one of specific surfactant types and a humectant (b) comprising propylene glycol.
 - 2.1.1 In writing, the Appellant had submitted that claim 1 was **not limited** to the use of a **diluted** rinse agent composition but also encompassed the use of an undiluted (neat) composition consisting only of one of the surfactants listed in claim 1 as sheeting agent (a) and propylene glycol as humectant (b). For example, in its letter of 10 February 2015 (page 2, fifth paragraph), it argued that "*... nowhere in claim 1 of the main request ... it is stated that the composition used as a rinse agent composition on a cleaned surface is only used in diluted form*" and "*the composition is an open composition which can in addition comprise water, but not necessarily*".

However, as already pointed out by the Opposition Division, neither the description nor the claims of the application as filed contain an explicit disclosure

that a **neat**, i.e. undiluted, composition consisting only of one of the surfactants listed in claim 1 as sheeting agent (a) and propylene glycol as humectant (b) could be used directly, i.e. could be supplied (in undiluted form) to a cleaned surface to be rinsed, without being previously diluted.

- 2.1.2 In support of its view regarding claim 1, the Appellant pointed in particular to page 4, lines 23 to 27, of the application as filed, where the following is stated: *"The rinse agent composition can be referred to more simply as the rinse agent. The rinse agent can be provided as a concentrate or as a use solution. In addition, the rinse agent concentrate can be provided in a solid form or in a liquid form. In general, it is expected that the concentrate will be diluted with water to provide the use solution that is then supplied to the surface of a substrate."*
- 2.1.3 For the Board, this passage clearly discloses that the rinse agent can be provided as a solid or liquid concentrate **or** as a "use solution". A distinction is thus made in this passage between the rinse agent in the form of a "use solution" intended to be *"supplied to the surface"* to be rinsed and in the alternative form as a concentrate (liquid or solid). The Board holds that the sentence *"In general, it is expected that the concentrate will be diluted with water to provide the use solution that is then supplied to the surface of a substrate"* can thus not be understood as indicating only a preference for the use of a diluted solution of the rinse agent onto the surface to be rinsed, but that it rather reiterates the difference between a rinse agent composition in form of a concentrate and in form of a use solution and the fact

that it is the "use solution" which is supplied to the surface of a substrate.

- 2.1.4 This reading is further corroborated by other parts of the description (see, for example, page 11, lines 8 to 11 and 18 to 20; page 12, line 16, to page 13, line 1) concerning explicitly the presence of a diluent in the composition supplied to the surface to be rinsed. Moreover, dependent product claim 12 of the application as filed, requiring that the rinse agent composition comprises "*up to about 92 wt.% water*", does not specifically support either that a neat undiluted composition consisting only of one of the surfactants listed in claim 1 as sheeting agent (a) and propylene glycol as humectant (b) may be used directly as rinse agent on a cleaned surface.
- 2.1.5 Last not least, the Board remarks also that all method claims of the application as filed are directed to methods comprising the application to the surface of a substrate in the rinsing step of an "*aqueous*" rinse agent composition and not of a composition consisting only of one of the surfactants listed in claim 1 as sheeting agent (a) and propylene glycol as humectant (b).
- 2.2 Therefore, in the Board's judgement, the subject-matter of claim 1 at issue extends beyond the content of the application as filed insofar as claim 1 at issue is (also) directed to the use of a neat rinse agent composition comprising (only) components (a) and (b) and being applied, without previous dilution, to the cleaned surface to be rinsed.

Hence, amended claim 1 of the main request does not meet the requirements of Article 123(2) EPC.

- 2.3 For the sake of completeness, the Board notes that the Appellant, in the course of the later debate regarding the proper interpretation of claim 1 according to auxiliary request 1 (see 4.2.1, *infra*), submitted that the skilled person, reading the claim with common sense, would understand that the used rinse agent composition had, necessarily, to comprise water, like the ("aqueous") rinse agent composition used according to the method of independent claim 15 at issue.
- 2.3.1 For the Board, this narrower interpretation of claim 1 of the main request, which is not literally supported by the wording of the claim itself and is different from the interpretation submitted in writing and initially maintained by the Appellant during the oral proceedings before the Board, is not compelling (point 4.2.6, *infra*), since other interpretations are equally possible.
- 2.3.2 However, even accepting (*arguendo* only) in the Appellant's favour, that water has to be necessarily present **during a rinsing step**, claim 1 would still, as pointed out by Respondent II during the oral proceedings, encompass applying an undiluted rinse agent composition directly on the cleaned surface, followed by the application of water, since claim 1 does not expressly require the presence of water as part of the rinse agent composition applied on the cleaned surface (see 4.2.2, *infra*).
- 2.3.3 For the Board, even adopting said narrower interpretation of claim 1, its subject-matter would thus still extend beyond the content of the application as filed for the reasons indicated above.
- 2.4 The Appellant's main request is thus not allowable.

Auxiliary request 1

3. Admission of auxiliary request 1 into the proceedings
- 3.1 The set of claims according to auxiliary request 1 was filed for the first time with the statement of grounds of appeal.
- 3.2 The Appellant submitted that this claim request was filed as a precaution in case the introductory wording of claim 1 according to the main request were not found allowable by the Board under Article 123(2) EPC. The objection under Article 123(2) EPC against the introductory wording of claim 1 according to the main request (main request before the Opposition Division), i.e. "*Use of a composition ... as ...*" had indeed been raised for the first time during the oral proceedings before the Opposition Division.
 - 3.2.1 The Board accepts that the reasons for which the Opposition Division found claim 1 according to the then pending auxiliary request 1 to be objectionable under Article 123(2) EPC were only set out clearly and in full detail in the written decision.

Therefore, the Appellant could, indeed, only provide an appropriate response to this objection once it became aware of these reasons as given in the written decision.
- 3.3 Taking into account these specific circumstances, the Board saw no reason for not admitting and considering auxiliary request 1 into the proceedings pursuant to Article 12(4) RPBA.

4. Clarity objection against claim 1

4.1 Admissibility of the objection

4.1.1 According to Respondent II the introductory wording of claim 1 according to auxiliary request 1 reading "*Use of a composition as a rinse agent **for use** on a cleaned surface ...*" (emphasis added by the Board) was not clear and, therefore, objectionable under Article 84 EPC.

The Appellant argued, however, that the so-amended claim was not open to clarity objections, since the wording "*rinse agent for use on a cleaned surface*" was already present in claim 1 as granted.

4.1.2 Claim 1 as granted reads: "*A rinse agent composition for use on a cleaned surface ...*". This claim thus concerns a product having specific compositional characteristics, and in the context of this product claim, the expression "*for use*" merely expresses the required suitability of the product for the intended use.

4.1.3 Claim 1 at issue is, however, of a different category (use, i.e. activity) than claim 1 as granted (composition), and the features relating to the use of the composition are technical features of the claimed subject-matter. In the use claim at issue the wording "*as a rinse agent for use on a cleaned surface*" thus expresses the specific way in which the composition is put to use ("*for use on a cleaned surface*") **and** the purpose/finality of the claimed activity ("*as a rinse agent*"), both representing technical features of the claimed activity. Therefore, unlike in the context of the product claim as granted, the expression "*for use*"

in present claim 1 does not simply express the suitability of the composition used for the intended purpose.

- 4.1.4 For the Board, the implications in meaning of the expression "*for use*" in claim 1 as granted and in claim 1 according to auxiliary request 1, respectively, are thus fundamentally different.
- 4.1.5 Consequently, the Board holds that, due to the amendments made, it has the power to examine claim 1 at issue for compliance with the requirements of Article 84 EPC in accordance with decisions G 9/91 (OJ EPO 1993, 408, point 19 of the Reasons) and G 3/14 ((OJ EPO 2015, 102, Order and point 85 of the Reasons).
- 4.2 Lack of clarity - claim 1
- 4.2.1 The Appellant stated during the oral proceedings (XVII, *supra*) that it would be clear to the skilled person, reading claim 1 with common sense, that it concerned the use, after cleaning, of an aqueous rinse agent composition in the last rinsing step of a process of warewashing including drying. In the Appellant's view, rinse agent compositions are always used diluted in water and, additionally, the definition of the sheeting agent (a) of claim 1 as a surfactant "*for promoting draining of sheets of **water** from a surface*" (emphasis added by the Board) implied also that the rinse agent composition had to comprise water.
- 4.2.2 The Board remarks, however, that there is no explicit indication in the wording of claim 1 that the rinse agent composition itself, when applied to the surface to be rinsed, has, necessarily, to contain water or any other additional diluent solvent.

- 4.2.3 Moreover, the Board holds that the definition of the sheeting component (a) of claim 1 merely expresses that the component chosen from the listed classes of surfactants has to be suitable for promoting draining of sheets of water from a surface, i.e. when water is added during rinse, but that it does not imply that the rinse agent composition itself must contain water.
- 4.2.4 Furthermore, the fields of application of the present invention are not confined to the rinsing of cleaned tableware (see page 3, lines 36 to 37 of the patent in suit) but extend to the rinsing of many different types of surfaces, including windows or mirrors (page 3, lines 45 to 47), in which context the use of other diluents than water could be more appropriate.
- 4.2.5 Finally, claim 1 is ambiguous since it is not clear whether the wording "*for use on a cleaned surface*" actually relates exclusively to the final rinsing step of a cleaning process, or whether it is also supposed to cover, for example, the use of the rinse agent composition in an intermediate rinsing step, after a first cleaning step, as mentioned in the patent in suit itself (page 2, lines 9 to 10) with respect to the functioning of conventional automatic warewashing machines which, "*clean dishes using two or more cycles which can include initially a wash cycle followed by a rinse cycle*".
- 4.2.6 Therefore, in the view of the Board, the Appellant's interpretation of the wording of claim 1 is definitely not the only possible one.
- 4.2.7 Since there are several possible interpretations of the wording of claim 1 as amended, the Board concludes that

this wording is ambiguous and that claim 1 at issue therefore lacks clarity (Article 84 EPC).

- 4.3 The Appellant's auxiliary request 1 is thus not allowable either.

Auxiliary request 2 - lack of clarity - claim 1

5. Claim 1 according to auxiliary request 2 contains the same introductory clause with the wording "Use ... as ... for use ..." as claim 1 according to auxiliary request 1 (see XVI, *supra*).

- 5.1 At the oral proceedings, the Appellant, being informed of the Board's view regarding the lack of clarity of this wording, conceded that there was no need for addressing auxiliary request 2 at all.

- 5.2 The Board observes that the amendments consisting in the insertion of a comma and the specification of a narrower range for the ratio of component (a) to component (b) have no bearing on the above considerations regarding the possible meanings that may be given to the wording "Use ... as ... for use ...".

Hence, said considerations apply *mutatis mutandis* to claim 1 of the request a issue. This was not in dispute.

- 5.3 Therefore, claim 1 of this request in any case suffers from the same lack of clarity (Article 84 EPC) as claim 1 of auxiliary request 1.

- 5.4 Auxiliary request 2 is thus not allowable either.

Auxiliary request 3

6. Clarity - all claims (Article 84 EPC)

6.1 Auxiliary request 3 comprises only method claims.

Respondent II argued that claim 1 at issue (wording under XVI, *supra*) lacked clarity since

- i) the expression "**the** aqueous rinse agent composition" (emphasis added by the Board) lacked an antecedent, and
- ii) it would not be clear from the wording of the claim whether "**the aqueous** rinse agent composition" (emphasis added by the Board) mentioned first was the same as "*the rinse agent composition*" defined more precisely later on in the claim.

6.2 As regards objection i), the Board remarks that the wording "*applying the* aqueous rinse agent composition" (emphasis added by the Board) is contained *verbatim* in granted method claim 15 (see XVI, *supra*, for a comparison of claim 15 as granted, identical to claim 15 of the main request, with claim 1 at issue).

Therefore, the Board concludes that this clarity objection does not arise from the amendments made to granted claim 15. It follows that as far as this feature is concerned, claim 1 may not be examined for compliance with the requirements of Article 84 EPC in view of decision G 3/14 (Order and point 85 of the Reasons).

6.3 As regards objection ii), the Board holds that the skilled person understands without doubt that in the context of claim 1 the newly incorporated wording "*wherein the rinse agent composition comprises ...*"

serves to define the active components a) and b) that have to be comprised in the rinse agent composition, which is mandatorily applied as aqueous composition.

6.3.1 The Board holds that claim 1 at issue is nothing else than a reformulated version of granted method claim 15, comprising merely editorial amendments that became necessary due to the deletion of the product claims (defining the components of the "*rinse agent composition*") as such, to which product claims granted claim 15 referred. Method claim 1 at issue thus has the same meaning as method claim 15 of the granted patent.

6.3.2 The Board thus concludes that the amended claim 1 according to auxiliary request 3 is also not objectionable under Article 84 EPC as regards the newly added wording.

7. Allowability of the amendments - Article 123(2) EPC - claims 1, 2, 3, 7 and 9

7.1 Respondent II objected that the combination of the specific sheeting agents (a) with the specific humectant (b) at the ratio specified in claim 1 (XVI, *supra*) amounted to an unsupported intermediate generalisation of more specific subject-matter disclosed in the examples of the application as filed.

7.2 The Board remarks in this respect that, according to established jurisprudence (see, for example, T 962/98 of 15 January 2004, point 2.5 of the Reasons), there "*may exist situations where some characteristics taken from a working example may be combined with other features disclosed in a more general context without necessarily creating an objectionable intermediate generalization. However, under Article 123(2) EPC, such*

an intermediate generalization is only admissible if the skilled person can recognize without any doubt from the application as filed that those characteristics are not closely related to the other characteristics of the working example and apply directly and unambiguously to the more general context. In other terms, in order to be acceptable, this intermediate generalization must be the result of unambiguous information that a skilled person would draw from the review of the example and the content of the application as filed."

- 7.3 In the present case the application as filed (page 6, lines 3 to 9) discloses a list of five exemplary surfactant classes, which can be used as sheeting agents (a) according to the invention. This list includes the four classes of surfactants retained in claim 1 at issue (as in claim 14 of the application as filed, referring back to method claim 13 directed to rinsing of a substrate). The application as filed also discloses (page 9, lines 14 to 16) a list of five exemplary types of humectants (b) that can be used according to the invention. This list includes propylene glycol (also disclosed as one of three humectant types in claim 21 of the application as filed, referring back to method claim 13).

The ratio of greater than about 1:3 of the total amount of humectant (b) to the total amount of sheeting agent (a) is disclosed in the original method claim 13 and on page 9, lines 22 to 23, of the description of the application as filed.

It is thus not in dispute that neither the description (except for the examples addressed under 7.4 below) nor the claims of the application as filed disclose specifically a combination of any of the four types of

sheeting agents (a) of claim 1 with propylene glycol as humectant (b).

- 7.4 The examples of the application as filed disclose indeed specific rinse agent compositions comprising propylene glycol as humectant (b) in combination with a surfactant belonging to one of the four classes listed in claim 1 at issue as sheeting agent (a), i.e. nonionic block copolymers having ethylene oxide and propylene oxide residues (examples 2, 3, 6, 7, 10 and 11), alkyl polyglycosides AG 6202 and Glucopon 225 (examples 14 and 15), a zwitterionic surfactant Miranol FBS (example 21) and an anionic LAS surfactant (example 18), at ratios of total amount of humectant (b) to total amount of sheeting agent (a) falling within the weight range specified in claim 1.
- 7.5 The Board remarks also that, even though all the compositions illustrated in the examples contain further components, like for example Bayhibit AM, a 2-phosphonobutane-1,2,4-tricarboxylic acid chelating agent, the passages of the description relating to the examples clearly indicate the general applicability of combinations of sheeting agents (a) and humectants (b) of the types exemplified.
- 7.6 In fact, in the passage under table 4 on page 16 (relating to examples 8 to 11) it is expressly indicated that "*The results demonstrate that compositions 10 and 11, with **propylene glycol**, perform better ... than the compositions with either Sorbitol or hexylene glycol*" (emphasis added by the Board).
- 7.6.1 Propylene glycol is thus clearly identified as a preferred humectant (b) in combination with nonionic block copolymers having ethylene oxide and propylene

oxide residues as sheeting agent (a).

7.6.2 Moreover, the passage under table 5 (concerning examples 12 to 22 including examples 14, 15, 18 and 21 comprising propylene glycol) on page 17 reads: "*Results show that this invention is not limited to the use of EO PO block copolymers with a humectant. Other types of surfactants, such as ... alkyl polyglycosides ... , zwitterionics ... , and anionics ... , together with a humectant can produce the desired result.*"

7.6.3 The Board holds that this statement is a clear teaching of the general applicability of the combinations of the surfactant classes listed above as sheeting agents (a) with any humectant (b), including propylene glycol, at the required weight ratio of greater than 1:3.

Applying the rationale of T 962/98 quoted *supra*, the Board thus concludes that the skilled person would recognize without any doubt from the application as filed that these characteristics are not closely related to the other characteristics of the working examples and apply directly and unambiguously to the more general context.

7.7 The Board thus concludes that the combination of features retained in claim 1 at issue, even if seen as representing an intermediate generalisation of the disclosure in the examples, is nevertheless supported by the disclosure of the application as filed taken as a whole.

7.8 Dependent claims 2, 3, 7 and 9 were not objected to by Respondent II.

For the Board, these claims find a basis in e.g.

originally filed claims 25, 26, 15 and 3, and 10, respectively.

8. Allowability of claims 4, 5, 6 and 8 - Article 123(2)

8.1 Admissibility of the objections raised

8.1.1 The Appellant contested the admissibility of the detailed objections raised under Article 123(2) EPC against dependent claims 4, 5, 6 and 8. In particular, it argued that these objections had not been raised in writing and were presented for the first time during the oral proceedings.

8.1.2 The Board remarks that Respondent II, in its letter of 13 November 2014 in response to the statement of grounds of appeal, had raised an objection under Article 123(2) EPC against the combination of limitations c), d), e) and f), i.e. the combination of specific types of surfactants as sheeting agent (a) with propylene glycol as humectant (b), as comprised in claim 1 according to auxiliary request 3 filed with the statement of grounds. This objection was specified to be based on the same reasons as set out in relation to the main request (see page 9, third paragraph from the bottom, in combination with page 1, "Added Subject-Matter", and page 3, first full paragraph, to page 4, third paragraph from the bottom). In the same letter (page 9, second paragraph from the bottom), Respondent II also stated that "*... each of the dependent claims of the Third Auxiliary Request contains a further feature that was not originally disclosed in combination with restrictions c), d), e) and f). Therefore, the dependent claims contain added subject-matter for this further reason.*"

8.1.3 The Board remarks in this respect that dependent claims 2, 3 and 4 to 16 according to the auxiliary request 3 filed with the statement of grounds are identical to the wordings of claims 16, 17 and 2 to 14, respectively, according to the main request at issue. Therefore, since the objection under Article 123(2) EPC raised in writing against claim 1 according to said then pending auxiliary request 3 was indicated to be the same as that raised with respect to claim 1 according to the main request insofar as the combination of the features c), d), e) and f) was concerned, it was clear that the generic objection against the dependent claims, based explicitly on the combination of further features with features c), d), e) and f), was intended to be the same as the one raised against the corresponding dependent claims according to the main request having identical wording. These objections were indeed explicitly addressed to with respect to the main request on page 4, last two paragraphs, of Respondent II's letter of 13 November 2014 reading: *"It is also apparent that each of the dependent claims creates a further combination of features that was not disclosed in the original application. For instance ... "*, further details being specified at least with respect to claims 2, 3, 4 corresponding to claims 4, 5 and 6 of present auxiliary request 3.

8.1.4 Furthermore, it is apparent that the Appellant had no difficulty in understanding such objections already in advance of the oral proceedings before the Board, since it argued in its reply of 25 February 2015 (page 10, fourth to sixth paragraphs): *"With regard to added subject-matter the opponent ... puts forward the additional argument that the 3rd auxiliary request*

contains further features which were not originally disclosed in combination with the other restrictions. In respect of these arguments we refer to the argumentation submitted in respect to the main request ... Therefore we are of the opinion that the 3rd auxiliary request does not contain added subject matter"

- 8.1.5 For the Board, the detailed arguments raised by Respondent II under Article 123(2) EPC against the dependent claims during the oral proceedings thus amount merely to a more detailed presentation of the objections already raised sufficiently clearly in writing in the reply to the statement of grounds of appeal. These objections were thus already part of the case of Respondent II in appeal proceedings and thus they are considered by the Board in accordance with Article 12(1) and (4) RPBA. Moreover, such detailed arguments did not raise issues which could not be dealt with by the Board and the parties during the oral proceedings.
- 8.1.6 Therefore, the Board, exercising its discretion under Article 13(1) and (3) RPBA, decided to admit and consider the objections raised under Article 123(2) EPC against claims 4, 5, 6 and 8.
- 8.2 Compliance with the requirements of Article 123(2) EPC - claims 4, 5, 6 and 8
 - 8.2.1 As regards claims 4 to 6, concerning the use of compositions defined in terms of narrower ranges for the weight ratio of total amount of humectant (b) to total amount of sheeting agent (a) and, precisely, between about 5:1 and 1:3, between about 4:1 and 1:2 and between about 3:1 to 1:1, respectively, the Board

remarks that all these ratios are disclosed in the generic part of the description of the application as filed illustrating the preferred and more preferred ratios of these components (see page 9, lines 22, 27 and 28).

- 8.2.2 For the Board, these disclosures are thus clearly applicable to all possible combinations of humectant (b) and sheeting agents (a) to be used according to the disclosed invention.
- 8.2.3 The Board thus concludes that these claims meet the requirements of Article 123(2) EPC.
- 8.2.4 Dependent claim 8 defines the sheeting agent (a) as alkyl polyglycosides having a given structural formula. The alkyl polyglycosides having this structural formula are disclosed in the application as filed (page 7, line 31 to page 8, line 6, as well as in claims 5 and 17) as being alkyl polyglycosides suitable as sheeting agents (a) according to the invention.

The claimed combined use of alkyl polyglycosides in general as sheeting agents (a) with propylene glycol as humectant (b) finds sufficient support in the application as filed (points 7 *et seq.*, *supra*). Hence, the specification of the structural formula of suitable alkyl polyglycosides indicated in the description and in the claims does not, for the Board, result in an extension of the claimed subject-matter beyond the content of the application as originally filed.

- 8.3 The Board thus concludes that all the claims according to auxiliary request 3 comply with the requirements of Article 123(2) EPC.

9. Compliance with Article 123(3) EPC
 - 9.1 The compliance of the claims according to auxiliary request 3 with the requirements of Article 123(3) EPC was not disputed by the Respondents.
 - 9.2 Considering the limiting nature of the amendments (insertion of further feature) made to the (only remaining) independent claim, directed to a "*method for rinsing ...*", the Board is also convinced that these claims are not objectionable under Article 123(3) EPC.
10. Novelty - claim 1
 - 10.1 The method of claim 1 (full wording under XVI, *supra*) requires *inter alia* that the total dissolved solids (TDS) content of the water used in the rinsing step exceeds 200 ppm.
 - 10.2 The only novelty objection raised/maintained by the Respondents against independent method claim 1 was based on document D3.
 - 10.3 Document D3 discloses (page 16, line 36 to page 17, line 19 in combination with page 18, lines 16 to 22) a method involving the evaluation of the sheeting effect, on a substrate which had been previously cleaned in a machine dishwasher, of a rinse additive comprising
 - a surfactant sheeting agent of type (a), i.e. "F108", a nonionic block copolymer having ethylene oxide and propylene oxide residues (see page 15, lines 31 to 34) and dioctyl sodium sulfosuccinate ("*anionic*" component within the meaning of claim 1 at issue)and
 - a humectant of type (b), i.e. propylene glycol.Said evaluation is performed in a dishwasher filled

with water additioned with 2000 ppm of a 2:1 mixture of margarine and non-fat milk and an amount of the tested rinse composition.

- 10.3.1 According to Respondent II such a method would comprise explicitly all the steps of claim 1 at issue without the only feature not expressly mentioned being the TDS content of the water used for rinsing.

This is not, in fact, in dispute. Indeed, reference is merely made to the use of "city water" (top of table IV on page 18) and to the addition, into the water, of "2000 parts of a 2:1 mixture of margarine and non-fat milk per million parts of rinse water" (page 17, lines 9 to 11).

It can thus not be gathered from document D3 taken alone that said "city water" implicitly had a TDS content as required by claim 1 at issue.

- 10.4 At the oral proceedings, documents D17 and D18, filed by the Appellant only with its statement of grounds of appeal, were specifically also relied upon by Respondent II in presenting its novelty objection based on D3, arguing that the TDS feature of claim 1 was implicitly met by the method disclosed in D3.

The Board, exercising its discretion under 12(4) RPBA, thus saw no reason for not admitting and considering these documents.

- 10.5 Document D17

- 10.5.1 From the content of document D17 (page 1, second, third and fifth full paragraphs), which can be considered to represent common general knowledge, it is known that

the TDS content of **drinking water** may range from **less than** 300 ppm to values way above 300 ppm (up to 1200 ppm), and that water from natural sources may even have a TDS content of **less** than 30 ppm. Water with an extremely low TDS content is, however, unacceptable because of its flat, insipid taste.

10.5.2 It can thus be assumed that "city water" or "tap water" of drinking water quality will in many cases contain significantly more than 200 ppm TDS. The Board holds, however, that this does not mean that the "city water" referred to in the specific example of D3 must necessarily comprise more than 200 ppm TDS.

10.5.3 This finding remains valid even taking into account
- that US tap water might have, on average, a TDS content of 350 ppm, as asserted by Respondent II in writing (page 10, last full paragraph, of the letter dated 13 November 2014, with reference to document D22) and during the oral proceedings, and
- that the examples of the patent in suit describe the use of softened rinse water having a TDS content of 300 ppm (see, for example, page 7, line 7).

10.5.4 Even taking into account common general knowledge (e.g. D17) it can thus not be established with the required degree of certainty that the TDS content of the "city water" referred to in D3 must implicitly have been in excess of 200 ppm.

10.5.5 In this connection, the Board remarks also that according to established jurisprudence (see e.g. T 1387/06 of 20 January 2010, point 4.4 of the Reasons), it is a prerequisite for a finding of lack of novelty that it is beyond doubt - **not merely probable** - that the claimed subject-matter is directly and

unambiguously disclosed in the cited prior-art document.

For the Board, as regards the allegedly implicit disclosure of the feature "*TDS content in excess of 200 ppm*" in document D3, this is clearly not the case. The disclosure of D3 is **not** unambiguous in this respect, and hence it remains doubtful whether the reference to "city water" in D3 meets the criterion of a direct and unambiguous disclosure.

10.6 Document D18

10.6.1 Both Respondents also argued that the required TDS content would be implicitly disclosed by the cited example of document D3 since the rinse water used additionally contained dispersed milk and margarine.

10.6.2 In this respect, the Board accepts that (at least) milk contains some soluble salts and soluble organic components or very fine dispersible solids able to pass through a sieve of 2 micrometres. As it is apparent from D18 (page 1, first three lines and last full paragraph), such components may contribute to TDS value of the rinse water used in the example of document D3. This was not in dispute as such.

10.6.3 However, no evidence was submitted that the TDS content originating from the milk part (666 ppm) of the 2000 ppm of the 2:1 margarine/low fat milk mixture added to the rinse water in the cited example of D3 would be so high that the resulting TDS content of the rinse water used would necessarily exceed 200 ppm. Analogous considerations apply as regards the added margarine, which according to Respondent I (page 3, last 3 lines of its letter dated 12 November 2014) may **not** be

expected to contribute significantly to the resulting total TDS value of the rinse water.

10.7 Merely for the sake of completeness, the Board remarks that Respondent II expressly conceded during the oral proceedings that none of the other documents filed during the appeal proceedings (thus including documents D19 to D21 filed by the Respondents, see points VI and VII, *supra*, and not relied upon during the oral proceedings) constituted evidence suitable to show that said addition of margarine/low fat milk would necessarily result in a total TDS content of the rinse water in excess of 200 ppm.

10.8 Therefore, the Board concludes that the cited example of document D3 does not directly and unambiguously disclose a rinsing method wherein the TDS content of the rinse water used exceeds 200 ppm.

10.9 In the Board's judgement, the subject-matter of claim 1 and, consequently, the subject-matter of claims 2 to 9 dependent thereon are thus novel (Articles 52(1) and 54 EPC).

11. Remittal

11.1 The Opposition Division had decided to revoke the patent on the grounds of non-compliance with the requirements of Article 123 and lack of novelty (see IV, *supra*).

11.2 In the Board's judgement, the claims according to auxiliary request 3 are not objectionable under Articles 84 or 123 EPC, or for lack of novelty. Hence, as foreshadowed in its communication issued in preparation for the oral proceedings (unchallenged in

this respect by the Respondents) the Board considers it appropriate to remit the case to the department of first instance for further prosecution (in particular for the examination of inventive step) under Article 111(1) EPC in accordance with the Appellant's request to this end.

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:



D. Magliano

B. Czech

Decision electronically authenticated