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**Datasheet for the decision  
of 22 March 2018**

**Case Number:** T 1003/15 - 3.3.07

**Application Number:** 08737683.6

**Publication Number:** 2144592

**IPC:** A61K8/36, A61K8/37, A61Q11/00,  
C11D3/20, C11D11/00

**Language of the proceedings:** EN

**Title of invention:**  
METHODS FOR DISCHARGING COLORANTS

**Patent Proprietor:**  
KIMBERLY-CLARK WORLDWIDE, INC.

**Opponent:**  
The Procter & Gamble Company

**Headword:**  
METHODS FOR DISCHARGING COLORANTS/Kimberly-Clark Worldwide,  
Inc.

**Relevant legal provisions:**  
EPC R. 99(2)  
RPBA Art. 12(4)  
EPC Art. 111(1)

**Keyword:**

Admission of new documents into the proceedings (Yes)  
Remittal

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 1003/15 - 3.3.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.07**  
**of 22 March 2018**

**Appellant:** The Procter & Gamble Company  
(Opponent) One Procter & Gamble Plaza  
Cincinnati, Ohio 45202 (US)

**Representative:** Russell, Tim  
Venner Shipley LLP  
200 Aldersgate  
London EC1A 4HD (GB)

**Respondent:** KIMBERLY-CLARK WORLDWIDE, INC.  
(Patent Proprietor) 401 North Lake Street  
Neenah, WI 54956 (US)

**Representative:** Beacham, Annabel Rose  
Dehns Patent & Trademark Attorneys  
St. Bride's House  
10 Salisbury Square  
London  
EC4Y 8JD (GB)

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
3 February 2015 concerning maintenance of the  
European Patent No. 2144592 in amended form.

**Composition of the Board:**

**Chairman** J. Riolo  
**Members:** D. Boulois  
C. Schmidt

## Summary of Facts and Submissions

- I. European patent No. 2 144 592 was granted on the basis of a set of 15 claims.

Independent claim 1 as granted read as follows:

"1. A method of changing an organic colorant or stain to a colourless state by a chemical means other than pH reaction or salt formation, the method comprising: providing a substrate that has at least a portion that is discolored with a substance; treating said discolored portion with a medium containing an unsaturated aliphatic acid or ester thereof, said aliphatic acid or ester having a carbon chain with at least C8 and at least two carbon-carbon double bonds."

- II. An opposition was filed under Article 100 (a) EPC on the grounds that its subject-matter lacked novelty and inventive step.

- III. The appeal by the opponent lies from the decision of the opposition division that auxiliary request 1 met the requirements of the EPC. The decision was based on 2 sets of claims filed with letter of 11 April 2013 as main request and auxiliary request 1.

Independent claim 1 of auxiliary request 1 read as follows:

"1. A method of changing a blood and/or menses stain to a colourless state by a chemical means other than pH reaction or salt formation, the method comprising: providing a substrate that has at least a portion that is discolored with blood and/or menses; treating said discolored portion with a medium containing an

unsaturated aliphatic acid or ester thereof, said aliphatic acid or ester having a carbon chain with at least C8 and at least two carbon-carbon double bonds."

- IV. The documents cited during the opposition proceedings included the following:  
D1: WO 03/097780  
D2: Macias et al, Biophysica Acta, 1082, 1991, 310-318  
D3: Mercier et al, Cereal Chemistry, 78(1), 36-38, 2001
- V. According to the decision under appeal, claim 1 of the main request lacked novelty over D1 and D3. D2 was considered as the closets prior art for the subject-matter of claim 1 of auxiliary request 1. The problem was seen as the provision of an alternative bleaching method, which was not obvious in view of D2. As to the argument that the problem could not be solved over the entire scope of the claims, it could not be followed by the opposition division, which considered that the presence of a surfactant was not an essential component of the medium to be used. The subject-matter of the first auxiliary request involved thus an inventive step.
- VI. The opponent (hereinafter called appellant) filed an appeal against said decision. With the statement setting out the grounds of appeal the appellant submitted the following pieces of evidence:  
D4: US 3 635 828  
D5: US 6 172 031
- VII. With a letter dated 28 October 2015, the proprietor (hereinafter the respondent) filed a new main request and auxiliary requests 1 to 11.

Claim 1 of the main request read as follows, the differences with claim 1 of auxiliary request 1 as assessed during the opposition proceedings being given in bold:

"1. A method of changing a blood and/or menses stain to a colourless state by a chemical means other than pH reaction or salt formation, the method comprising: providing a substrate that has at least a portion that is discolored with blood and/or menses; treating said discolored portion with a medium containing **a cell lysing agent** and an unsaturated aliphatic acid or ester thereof, said aliphatic acid or ester having a carbon chain with at least C8 and at least two carbon-carbon double bonds;  
**wherein said unsaturated aliphatic acid or ester and cell lysing agent are present in amounts expressed as a ratio ranging from 1:1 up to about 30:1, respectively; and wherein said cell lysing agent is a surfactant.**"

- VIII. A communication from the Board, was sent to the parties. In this it was stated in particular that the case be remitted to the opposition division for further discussion of the newly filed requests over documents D3 and D4.
- IX. Oral proceedings took place on 22 March 2018. During oral proceedings, both parties declared that they agreed with a remittal of the case to the Opposition Division for further prosecution.
- X. The arguments of the appellant may be summarised as follows:

D4 and D5 were relevant for novelty and inventive step vis-à-vis the subject-matter of the claims maintained

by the opposition division. Moreover, the absence of any reference to the presence of a surfactant, which was seen as an essential feature for performing the claimed invention, the problem addressed by the claimed invention was not solved across the whole breadth of the claims. The claims therefore fail the requirements of Article 56 PC.

As to the new main request filed during the appeal proceedings, it did not meet the requirements of Article 123(2) and 84 EPC. D4 and D5 were still relevant as regards novelty and inventive step of the main request, as well as for the auxiliary requests. D4 mentioned the treatment of blood stains (see column 9 lines 6-11) and disclosed in example VI a composition comprising a surfactant and linoleic acid in a 1.4: 1 ratio. D5 disclosed in all examples a composition of a surfactant (DBSA) in association with soybean methyl ester. Since 57% of soybean methyl ester consisted in linoleic acid, the ratio aliphatic ester:surfactant was around 9:1.

XI. The arguments of the respondent may be summarised as follows:

The main request met the requirements of Article 123(2) EPC. As regards novelty and inventive step, D4 and D5 were not relevant for the subject-matter as claimed in claim 1 of the main request, and of all auxiliary requests.

XII. Requests

The appellant requested that the decision under appeal be set aside and that the European patent No. 2 144 592 be revoked.

The appellant also requested that documents D4 and D5 should be admitted into the proceedings.

The respondent requested that that the appeal be dismissed and that the patent be maintained on the basis of the main request, or, alternatively on the basis of one of the auxiliary requests 1 to 11, all requests filed with letter dated 28 October 2015.

### **Reasons for the Decision**

#### 1. Admissibility of the appeal

The appellant did not make any comment in its statement of grounds of appeal as regards the decision of the opposition division over the relevance of documents D1-D3 which were discussed in the decision of the opposition as regards novelty (D1, D3) and inventive step (D2).

The appellant however maintained its objections as to the breadth of the claims and the absence of an essential feature in claim 1 of the claims maintained by the opposition division, namely the absence of a surfactant. According to the appellant, in view of the absence of this essential feature from claim 1 of the allowed claims, the problem addressed by the patent was not solved across the whole breadth of the claims, which failed to meet the requirements of Article 56 EPC.

An appeal by an opponent is admissible if the grounds of appeal contain at least one reason for setting aside the impugned decision, as required by Rule 99(2) EPC.



This is the case with the present appeal with objections already presented during the opposition proceedings as regards the resolution of the problem over the whole scope of the claims. The statement of grounds of appeal of the opponent appears thus to constitute an answer to the decision of the opposition division and the appeal appears to be admissible.

2. Admission of documents D4 and D5 into the proceedings

Documents D4 and D5 are new documents, that were filed in the appeal proceedings by the appellant with its statement of grounds of appeal. Said new evidences D4 and D5 were therefore not present and discussed during the opposition proceedings.

According to Article 12(4) RPBA, a board of appeal has the power to hold inadmissible facts, evidence or requests which inter alia could have been presented in the opposition proceedings, which is obviously the case of D4 and D5.

However, in the present case, and in response to the statement of grounds of appeal and of the submissions of the new documents D4 and D5, the respondent submitted also new sets of claims, as main and auxiliary requests. The subject-matter of said new requests is substantially modified and more restricted than the subject-matter of auxiliary request 1 which was considered to meet the requirements of the EPC by the opposition division. The submission of these new requests constitutes an explicit response to the new documents, and an implicit recognition of their prima facie relevance for the claims which were found to meet the requirements of the EPC during the opposition proceedings.

In parallel to the submissions of the new main and auxiliary requests, the respondent did also not object the admission of the new documents D4 and D5 into the appeal proceedings.

It appears also immediately obvious that said documents D4 and D5 are indeed prima facie relevant, not only for the claims which were found to meet the requirements of the EPC during the opposition proceedings, but also at least for the claims of the main request submitted in the appeal proceedings, as regards novelty and/or inventive step.

The Board exerts thus its discretionary power and decides to admit documents D4 and D5 into the proceedings (Article 12(4) RPBA).

3. Remittal to the opposition division

The discussion on novelty and inventive step of the new main request over the newly submitted documents D4 and D5 constitutes a new case which was not discussed during the opposition proceedings.

Although Article 111(1) EPC does not guarantee a party an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party should, whenever possible, be given the opportunity to said consideration by two instances of the important elements of the case. The essential function of an appeal proceedings is to consider whether the decision under appeal is correct. Hence, a case is normally remitted if further criteria of patentability have not yet been examined and decided in the proceedings leading to the decision under appeal,

or as in the present new documents and new requests have been filed.

Hence, the Board considers it appropriate to remit the case to the examining division for further prosecution on the basis of the main request.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition division for further prosecution.

The Registrar:

The Chairman:



S. Fabiani

J. Riolo

Decision electronically authenticated