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**Datasheet for the decision
of 25 February 2021**

Case Number: T 2255/15 - 3.3.02

Application Number: 03291094.5

Publication Number: 1369037

IPC: A01N31/14, A01N31/04,
A01N31/02, A61L2/18,
A61K31/045, A61K31/08,
A61K31/085

Language of the proceedings: EN

Title of invention:

Synergistic preparations based on mixtures of glycerol ether
with aromatic alcohol for controlling mycobacteria

Patent Proprietor:

Schülke & Mayr GmbH

Opponent:

Thor GmbH

Headword:

Relevant legal provisions:

RPBA Art. 12(4)
RPBA 2020 Art. 11, 12(2), 13(2)
EPC Art. 54, 56, 115, 123(2)

Keyword:

Observations by third parties - admissibility of evidence
Novelty
Discretion not to admit submission
Amendments
Remittal

Decisions cited:

G 0009/91, T 0390/90, T 0951/91, T 0226/93, T 0793/93,
T 0413/05, T 1523/07, T 2017/07, T 0051/10, T 1756/11

Catchword:



Beschwerdekammern

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Case Number: T 2255/15 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 25 February 2021

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
14 October 2015 concerning maintenance of the
European Patent No. 1369037 in amended form.**

Composition of the Board:

Chairman M. O. Müller
Members: S. Bertrand
R. Romandini

Summary of Facts and Submissions

- I. The appeals lodged by the opponent and the patent proprietor lie from the interlocutory decision of the opposition division that European patent No 1 369 037 in amended form according to the fourth auxiliary request comprising the set of claims filed on 12 May 2015 met the requirements of the EPC.
- II. The patent as granted contained ten claims, independent claims 1, 2, 6 and 8 of which read as follows:
- "1. Disinfectant in the form of a working mixture which comprises*
- (a) 0.05 to 1% by weight of 1-(2-ethylhexyl) glycerol ether and*
 - (b) 0.2 to 5% by weight of one or more aromatic alcohols selected from the group consisting of aryloxyalkanols and arylalkanols."*
- "2. Disinfectant in the form of a working mixture or of a concentrate, characterized in that it comprises*
- (a) 1-(2-ethylhexyl) glycerol ether and*
 - (b) one or more aromatic alcohols selected from the group consisting of aryloxyalkanols and arylalkanols,*
- the weight ratio x of component (a) to component (b) being 0.15 or less."*
- "6. Disinfectant in the form of a working mixture which comprises*
- (a) 0.05 to 0.02% by weight of 1-(2-ethylhexyl) glycerol ether and*
 - (b) 1.0 to 2.0% by weight of phenoxyethanol."*

"8. Process for controlling mycobacteria in which a disinfectant which comprises (a) one or more 1- or 2- (C₃- to C₂₄-alkyl) glycerol ethers and (b) one or more aromatic alcohols is allowed to act on the surface to be disinfected selected from a medical instrument or a laboratory apparatus."

III. The following documents are referred to in the present decision:

D1	DE 100 25 124 A1
D2	DE 40 26 756 A1
D3	EP 0 599 433 A1
D3a	US 5,516,510 A
D4	H. Eggensperger, Multiaktive Wirkstoffe für Kosmetika, 1995, pages 141-159.
A006	WO 99/23998
A007	EP 0 582 359 B1
A008	Deutsche Gesellschaft für Hygiene und Mikrobiologie 1997, 22, issue 6, pages 278 to 283
A008a	Anforderungen und Methoden zur VAH-Zertifizierung chemischer Desinfektionsverfahren, 2 April 2015 (mhp-Verlag Wiesbaden 2015)
A009	Declaration by Dr Katrin Steinhauer
A009a	Credentials of Dr Steinhauer
A010	"Schülke wins European patent protection proceedings" published on 14 December 2015
A011	Publication Ross Organic, Winter 2016
A012	WO 00/67705
A014	EP 0 582 360 A1
A015	EP 1 157 687 A2

- IV. The opposition division came to, *inter alia*, the following conclusions:
- The subject-matter of claims 1 and 2 according to the main request (patent as granted) was not novel in view of the disclosure of each of D1, D2 and D4.
 - The subject-matter of claims 1 and 2 according to the first auxiliary request then on file was not novel in view of the disclosure of each of D2 and D4.
 - The subject-matter of claim 1 according to each of the second and third auxiliary requests then on file was not novel in view of the disclosure of D4.
 - The claims according to the fourth auxiliary request then on file met the requirements of Articles 83, 84, and 123(2) and (3) EPC.
 - The subject-matter of the claims according to the fourth request then on file was novel in view of each of D1, D2 and D4 and involved an inventive step in view of D1 or D2 as the closest prior art (Article 56 EPC).
- V. In its statement setting out the grounds of appeal, the opponent contested the reasoning of the opposition division and submitted that claim 1 of the fourth auxiliary request then on file was not clear and contained added subject-matter and that its subject-matter was not novel and did not involve an inventive step.
- VI. In its statement setting out the grounds of appeal, the patent proprietor submitted that the subject-matter of the claims according to any of the main request (granted claims) and auxiliary requests 1 to 3 ("Set

A", "Set B" and "Set C" corresponding to the claims of the first to third auxiliary requests submitted with the letter dated 12 May 2015) was novel and involved an inventive step.

- VII. The patent proprietor and opponent are both appellant and respondent in these appeal proceedings and are referred to in the following as "patent proprietor" and "opponent", respectively.
- VIII. Third-party observations with documents A006, A007, A012, A014 and A015 were submitted on 16 February 2016, 14 November 2018 and 31 May 2019. Novelty objections were submitted based on A006, D3a and A012. The inventive step of the claimed subject-matter was objected to in view of A006 and D3a. Reference was made to A013.
- IX. During the appeal proceedings, the opponent submitted A010 and A011. It objected that the subject-matter of claim 1 and/or claim 2 of the main request and the auxiliary requests corresponding to sets A to C was not novel in view of D1, D2, D4, A006 or A012.
- X. During the appeal proceedings, the patent proprietor submitted A008 and counter-arguments with regard to the objections of added subject-matter and lack of clarity, novelty and inventive step. It contested the admittance of A006. It submitted auxiliary requests A' to F', A008a, A009 and A009a.
- XI. The board issued a communication pursuant to Rule 100(2) EPC summarising the parties' submissions and requesting that the patent proprietor clarify its requests.

XII. With a further letter dated 10 November 2020, the patent proprietor clarified its requests and submitted sets of claims G-J and G'-I'.

XIII. Oral proceedings before the board were held on 25 February 2021 by videoconference.

XIV. The opponent requested that:

- the decision under appeal be set aside and that the patent be revoked in its entirety
- claim sets A' to F' not be admitted into the proceedings
- if the board should find the subject-matter of the claims of any of the main request and auxiliary requests 1 and 3 novel, the case be remitted to the opposition division

XV. The patent proprietor requested that:

- the decision of the opposition division to maintain European patent EP 1369037 B1 in amended form based on auxiliary request D be set aside and that the patent be maintained as granted
- alternatively, that the patent be maintained in amended form on the basis of any of claim sets A-J or A'-I' in the following order: A, A', B, B', C, C', D, D', E, E', F, F', G, G', H, H', I, I', J
- should the board consider that the subject-matter of the claims of any of claim sets A-C, E-J and G'-I' be novel but not inventive, or should the board consider that claim sets A' to F' do not overcome the objections under Article 84 EPC, the case be remitted to the department of first instance for

examination of inventive step or clarity,
respectively

- the objections of lack of novelty based on the example of D1 and the objections under Article 84 EPC not be admitted into the proceedings
- should the objections under Article 84 EPC be admitted into the proceedings and should the board consider claim sets A to F to be unclear, claim sets A' to F' be admitted into the proceedings
- the third-party observations filed on 15 February 2016, 14 November 2018 and 31 May 2019, with all the documents and annexes referred to in the observations, not be admitted into the proceedings
- A008, A008a and A009 be admitted into the proceedings
- A010 and A011 not be admitted into the proceedings

XVI. The opponent's case, where relevant to the present decision, may be summarised as follows.

Main request

- Novelty in view of D1
 - Example 1 was prejudicial to the novelty of claim 1 of the main request. Furthermore, the combination of paragraphs [0060], [0073] and [0078] of D1 anticipated the subject-matter of claim 2 of the main request.

- Novelty in view of D2
 - The subject-matter of claim 2 of the main request lacked novelty in view of example 14. The weight ratio of 1-(2-ethylhexyl) glycerol to phenoxypropanol in this composition was 0.154 and had to be rounded to 0.15.
- Novelty in view of D4
 - The composition of chapter III, 2.d) on page 150, of D4 anticipated the subject-matter of claim 1 of the main request.

Auxiliary request 1

- Admittance of the objection of lack of clarity
 - The objection of lack of clarity of claim 1 was not a new objection but a new argument. The objection should be admitted into the proceedings.
- Novelty
 - The reasons given for the main request applied to the claims of auxiliary request 1. Thus, example 2 of D2 was also prejudicial to the novelty of the subject-matter of claim 2 of auxiliary request 1.

Auxiliary request 3

- Added subject-matter
 - The indefinite article "an" in claim 2 of auxiliary request 3 implied that further non-listed aryloxyalkanols and arylalkanols could be present in the disinfectant of the claim, contrary to what was required in claims 4 and 5 as filed.
 - The term "or" in claim 2 of auxiliary request 3 implied that if one of the listed compounds was selected, no other listed compound could be present in the disinfectant of the claim, again contrary to what was required in claims 4 and 5 as filed.
 - Claim 2 added subject-matter beyond the content of the application as filed.
- Novelty
 - The reasons given for the main request applied to the claims of auxiliary request 3.
- Remittal
 - The case should be remitted to the opposition division if novelty was acknowledged. The inventive step of the subject-matter of claim 1 of auxiliary request 3 was not assessed by the opposition division considering D4 as the closest prior art. This justified remitting the case to the opposition division.

- Inventive step considering D1 as the closest prior art
 - The distinguishing feature of claims 1 and 2 in view of the example of D1, using 2-methyl-4-phenylbutan-2-ol, was the specific aromatic alcohol defined in the claims.
 - The activity against *Mycobacterium terrae* shown in the example of the patent was not to be considered in the formulation of the objective technical problem. First, the effect of controlling mycobacteria was not relevant for cosmetics and only considered to be a bonus effect. Second, if it were accepted that the effect was relevant, the effect was not achieved over the whole scope of claim 1 or 2 of auxiliary request 3.
 - The objective technical problem was the provision of an alternative disinfectant composition.
 - The solution would have been obvious in view of D1 alone or in view of D1 in combination with D4.
- Inventive step considering D2 as the closest prior art
 - The subject-matter of claim 1 of auxiliary request 3 differed from the composition of table V of D2 in the presence of 1-(2-ethylhexyl) glycerol.
 - The objective technical problem was the provision of an alternative disinfectant composition.

- The solution would have been obvious in view of D2 in combination with D4.

XVII. The patent proprietor's case, where relevant to the present decision, may be summarised as follows.

Admittance of the third-party observations

- The third-party observations were late-filed and should not be admitted into the proceedings.

Main request

- Admittance of the novelty objection in view of D1
 - The objection based on the example of D1 was raised by the opposition division during the oral proceedings. This objection was to be rejected for being late-filed.
- Novelty in view of D1
 - A double selection was necessary to arrive at the subject-matter of claim 2: a selection of "Octoxyglycerin" in paragraph [0073] and a selection of the weight ratio of the glycerine ether to the aryl-substituted alcohol, i.e. 1/10 from the different range limits to be made in paragraph [0078]. Furthermore, the aryl-substituted alcohol mentioned in paragraph [0060] was not mandatorily an aryloxyalkanol or an arylalkanol.

- Novelty in view of D2
 - The weight ratio of compound (a) to compound (b) (i.e. the weight of 1-(2-ethylhexyl) glycerol to the aromatic alcohol) referred to in claim 2 of the main request was not directly and ambiguously disclosed in D2.

- Novelty in view of D4
 - The composition of chapter III, 2.d) on page 150, of D4 did not directly and unambiguously disclose the subject-matter of claim 1 of the main request. The "Glycerinether" used in combination with phenoxyethanol in this composition was not necessarily 1-(2-ethylhexyl) glycerol, i.e. the compound required by claim 1 of the main request.

Auxiliary request 1

- Admittance of the objection of lack of clarity
 - The objection of lack of clarity of claim 1 was not raised during the first-instance proceedings and could not be derived from the objection of lack of clarity of claim 5 of the fourth auxiliary request then on file raised before the opposition division. The objection of lack of clarity of claim 1 should have been raised before the opposition division and should not be admitted into the appeal proceedings.

- Novelty
 - The reasons given for the main request applied to the claims of auxiliary request 1.

Auxiliary request 3

- Added subject-matter
 - Claim 2 of auxiliary request 3 was based on the combination of claims 2, 4 and 5 of the application as filed, except that the terms "oligoalkanol aryl ethers" (found in claim 2 as filed) and "phenoxypropanol" (found in claim 4 as filed) were deleted.
 - Claim 2 as filed used the "comprising" language and referred to the wording "one or more aromatic alcohols". It meant that the combination of claim 2 as filed with either claim 4 or 5 as filed allowed the presence of further aryloxyalkanols or arylalkanols in addition to those mentioned in the two claims. The same as in claim 1 of auxiliary request 3 owing to the presence of the indefinite article "an".
 - The term "or" used in claim 2 of auxiliary request 3 could not be exclusive since the claim referred for component (b) to "*one or more aromatic alcohols*".
- Novelty
 - 2-methyl-4-phenylbutan-2-ol in the composition of example 1 of D1 was not an arylalkanol as defined in claim 1 of auxiliary request 3.
 - The composition of example 14 of D2 comprised, *inter alia*, phenoxypropanol. This compound was not an aryloxyalkanol encompassed by claim 2 of auxiliary request 3.

- Remittal
 - The fact that the opposition division did not assess the inventive step of claim 1 in view of D4 did not justify remittal of the case to the opposition division.
- Admittance of the objection of lack of inventive step based on D4 as the closest prior art
 - This objection was raised for the first time during the appeal proceedings. It should have been raised at a previous stage of the appeal proceedings.
- Inventive step considering D1 as the closest prior art
 - The distinguishing feature of claims 1 and 2 in view of the example of D1, using 2-methyl-4-phenylbutan-2-ol, was the specific aromatic alcohol defined in the claims.
 - The examples in the patent showed that the composition according to claim 1 or claim 2 exhibited an activity against *Mycobacterium terrae*.
 - The objective technical problem was the provision of a disinfectant composition for controlling, *inter alia*, mycobacteria.
 - Neither D1 nor D4 referred to any activity against mycobacteria, and it could not be deduced that any disinfectant would be suitable for controlling mycobacteria.

- Inventive step considering D2 as the closest prior art
 - The subject-matter of claim 1 of auxiliary request 3 differed from the composition of table V of D2 in the presence of 1-(2-ethylhexyl) glycerol and its amount (0.05 wt.% is the lowest amount in claim 1).
 - In the same way as for D1, the objective technical problem was the provision of a disinfectant composition for controlling, *inter alia*, mycobacteria.
 - D4 would not have rendered obvious the composition of claim 1 of auxiliary request 3 for controlling mycobacteria.

Reasons for the Decision

Admittance of the objections and documents submitted with the third-party observations filed under Article 115 EPC

1. Third-party observations were filed on 15 February 2016, 14 November 2018 and 31 May 2019.
 - 1.1 The patent proprietor requested that the third-party observations dated 15 February 2016, 14 November 2018 and 31 May 2019 and documents A006, A007, A012, A014 and A015 and annexes 1-2 submitted along with them not be admitted into the proceedings.
 - 1.2 In the communication pursuant to Article 15(1) RPBA, the board already expressed its preliminary view on the following points regarding admittance of the third-

party observations. The opponent did not contest the board's preliminary view in this respect.

- 1.3 With the third-party observations of 15 February 2016, documents A006 and A007 and annexes 1-2 were filed. It was argued that document A006 anticipated the subject-matter of granted claims 1 and 4 and that, in view of its relevance, the document should be admitted into the proceedings. Reference was made to annexes 1 and 2. Annexes 1 and 2 demonstrated that the same antimicrobial effect was obtained for different microorganisms with compositions comprising 1-(2-ethylhexyl)glycerol ether and phenoxyethanol at ratios of 0.11, 0.15 and 0.20, i.e. compositions according to the invention and comparative compositions. Furthermore, inventive step of the granted claims and the independent claims of the fourth auxiliary request held allowable by the opposition division (claim set D) was challenged with the disclosure of A006 and A007.

In its observations of 14 November 2018, the third party raised a further objection of lack of novelty in view of D3a and a further objection of lack of inventive step in view of D3a or A014 as the closest prior art. It submitted further arguments for the objection of lack of inventive step in view of A006 as the closest prior art.

A further objection of lack of novelty based on A012 was submitted with the third-party observations of 31 May 2019.

- 1.4 In its submissions of 15 February 2016 and 14 November 2018, the third party argued that A006 with annexes 1 and 2 were *prima facie* relevant and should be admitted into the proceedings. Furthermore, the third-

party observations were filed at an early stage of the appeal proceedings.

1.5 The board observes that in accordance with the case law of the boards, observations by third parties pursuant to Article 115 EPC can also be filed during an appeal proceedings (T 390/90, G 9/91, OJ 1993, 408, T 1756/11). This interpretation is consistent with the wording of Article 115 EPC, which sets no time limit in this respect (T 390/90, OJ 1994, 808). However, in accordance with the case law, Article 115 EPC must not be interpreted in such a way as to grant third parties rights which extend beyond those of the parties to proceedings (T 951/91, OJ 1995, 202; see also *Schachenmann*, Article 115 EPC, in *Singer-Stauder*, The European Patent Convention, Vol 2, 3rd ed.). Since Article 114(2) EPC confers to the bodies of the EPO the discretionary power to disregard submissions not filed in due time, this provision must also apply to observations by third parties. Since the Rules of Procedures of the Boards of Appeals specify some criteria for exercising this discretion in appeal proceedings with respect to the submissions of the parties to the proceedings, in the board's view, these criteria must also apply to third-party observations. Hence, the criteria laid down in Article 12(2) RPBA 2020 and 12(4) RPBA 2007 are to be taken into consideration in deciding whether and to what extent the submissions at issue must be considered.

As set out above, the following objections were raised in the third-party observations:

- lack of novelty of the subject-matter of claims 1 and 4 as granted in view of A006 and D3a

- lack of novelty of the subject-matter of claim 1 of claim set D over A012
- lack of inventive step of the subject-matter of claims 2 and 6 as granted and the claims of all claim sets submitted by the patent proprietor over A006 in combination with A007
- lack of inventive step of the subject-matter of claims 1 and 4 as granted and claim 1 of claim sets A' to F' over A014 as the closest prior art in combination with A015
- lack of inventive step of the subject-matter of claim 1 as granted and claim 1 of claim sets A' to C' over D3a

None of these objections had been raised before in the opposition or appeal proceedings. Document A006 is a document discussed in the context of novelty of the granted claims. It is also discussed, in combination with annexes 1-2, in the context of inventive step of the claims of auxiliary request 7 (claim set D). Annexes 1 and 2 were filed to show activity of compositions according to the invention and compositions not according to the invention. The submission of A006 and annexes 1-2 does not constitute a direct and timely response to facts, objections, arguments or evidence on which the decision under appeal is based. The third-party observations of 15 February 2016 do not provide any argument why the impugned decision would not be correct and which would justify the submission of A006 and annexes 1-2. The same reasoning applies with regard to the attack of lack of inventive step over A006 in combination with A007; A014 and the attack of lack of inventive step based on this document as the closest prior art; the

attack of lack of novelty based on D3a; and the attack of lack of novelty based on document A012.

Thus, the objections contained in the third-party observations filed on 15 February 2016, 14 November 2018 and 31 May 2019 (i.e. based on documents D3a, A006, A007, A012, A014 and A015) could and should have been made in opposition proceedings.

Furthermore, the purpose of appeal proceedings is to review the opposition division's decision rather than to start a second opposition proceedings (Article 12(2) RPBA 2020). However, admitting the new objections into the proceedings would have meant exactly that, namely it would have offered the third party and thus also the opponent a second go at opposition proceedings.

Therefore, the objections based on documents D3a, A006, A007, A012, A014 and A015 raised in the third-party observations filed on 15 February 2016, 14 November 2018 and 31 May 2019, as well as the submissions made by the opponent on the basis of these objections, were not admitted into the proceedings according to Articles 12(4) RPBA 2007 and 12(2) RPBA 2020.

Main request claims as granted

2. Admittance of the novelty objection in view of D1
- 2.1 An objection of lack of novelty in view of the only example on page 11 of D1 was raised by the opposition division during oral proceedings (see the minutes, page 1, "Main Request (patent as granted)"). The impugned decision discusses this objection (point 17 of the decision), and it was held that the example of D1 was

prejudicial to the novelty of claim 1 of the main request.

2.2 The patent proprietor requested that this objection not be admitted.

2.3 In the communication pursuant to Article 15(1) RPBA, the board already expressed its preliminary view on the admittance of the novelty objection in view of D1.

In line with this communication, the board observes that, according to the minutes of the opposition division, "*The parties did not make further submissions to what had been put forward in written*" (page 1, "Main Request (patent as granted)"). This implicitly means that the parties, i.e. the opponent and the patent proprietor, were asked whether they wanted to comment on, *inter alia*, the objection based on the example of D1. Thus, the patent proprietor had during oral proceedings before the opposition division the opportunity to present arguments against the admittance and relevance of the attack based on the example of D1 but did not make any submission in this regard. Neither did the patent proprietor use the opportunity to request a break to react to this attack or an adjournment of the oral proceedings. Thus, the patent proprietor had been given sufficient opportunity to present its comments on the only example of D1 before any decision was issued. The evidence based on this example, and on which the decision was based, had been identified and communicated to the patent proprietor in a proper way.

Thus, the board did not see any reasons why the objection of lack of novelty in view of the only example of D1 raised during oral proceedings before the opposition division should not have formed a basis for

the appealed decision (Article 12(2) RPBA 2020). As this was not disputed by the proprietor during the oral proceedings, the board decided to admit the objection into the proceedings.

3. Novelty

3.1 Independent claims 1 and 2 of the main request (II above) relate to a disinfectant comprising 1-(2-ethylhexyl) glycerol ether and one or more aryloxyalkanols and arylalkanols. The composition of claim 1 is further characterised by comprising 0.05 to 1% by weight of the glycerol ether and 0.2 to 5% by weight of the one or more aryloxyalkanols and arylalkanols. Claim 2 refers to a weight ratio of the glycerol ether to the one or more aryloxyalkanols and arylalkanols being 0.15 or less.

3.2 Novelty in view of D1

3.2.1 The opponent submitted that the subject-matter of claim 1 of the main request lacked novelty in view of the example on page 11 of D1.

3.2.2 The example on page 11 of D1 discloses a composition comprising, *inter alia*, 1.00 wt.% "Octoxyglycerin" and 0.80 wt.% 2-methyl-4-phenylbutan-2-ol. It was common ground between the parties that "Octoxyglycerin" is 1-(2-ethylhexyl) glycerol ether and thus corresponds to component (a) of claim 1. Its amount of 1.00 wt.% corresponds to the upper limit of the range of claim 1 of the main request (0.05 to 1% by weight). 2-methyl-4-phenylbutan-2-ol is an arylalkanol as required for component (b) of claim 1 as granted. Its amount of 0.80 wt.% falls within the range referred to in claim 1 as granted (0.2 to 5% by weight). Thus, the example on

page 11 of D1 is prejudicial to the novelty of the subject-matter of claim 1 of the main request.

- 3.2.3 In its statement of grounds of appeal, the opponent objected that the combination of paragraphs [0060], [0073] and [0078] of D1 anticipated the subject-matter of claim 2 of the main request.

The board in its communication under Article 15(1) RPBA gave its preliminary opinion that the subject-matter of claim 2 of the main request was novel in view of the combination of paragraphs [0060], [0073] and [0078] of D1. This was not contested by the opponent.

Paragraph [0060] of D1 discloses a composition comprising a glycerine monoalkyl ether and an aryl-substituted alcohol.

Paragraph [0073] of D1 discloses that a preferred glycerine monoalkyl ether is "Hexoxyglycerin" or "Octoxyglycerin". As set out above, it was common ground between the parties that the latter compound is 1-(2-ethylhexyl) glycerol ether, as required for component (a) of claim 2 of the main request.

Paragraph [0078] of D1 defines a weight ratio of the glycerine ether to the aryl-substituted alcohol. This ratio can be from 1/10 to 10/1 or 5/1 to 1/5. From these range limits, only the value 1/10, i.e. 0.1, falls within the range of claim 2 of the main request (0.15 or less).

The combination of the passages in D1 referred to by the opponent does not directly and unambiguously disclose the composition according to claim 2 of the main request. First, an aryl-substituted alcohol as disclosed in paragraph [0060] of D1 is not mandatorily an aryloxyalkanol or an arylalkanol as required for

component (b) of claim 2. An aryl-substituted alcohol is only a generic term of which the latter compounds are specific examples. For this reason alone, novelty of the subject-matter of claim 2 of the main request can be acknowledged over the cited passages.

Second, a first selection in paragraph [0073] among two equal alternatives ("*Hexoxyglycerin, Octoxyglycerin*") is needed to select 1-(2-ethylhexyl) glycerol ether ("*Octoxyglycerin*") as required by claim 2. A second selection of the weight ratio of the glycerine ether to the aryl-substituted alcohol, i.e. 1/10 from the different range limits is to be made in paragraph [0078] to achieve a weight ratio of 0.15 or less as required by claim 2 of the main request. There is no pointer in D1, and the opponent has not mentioned one, to combine the 1-(2-ethylhexyl) glycerol ether of paragraph [0073] and the lower limit 1/10 of the broadest range of the weight ratio of the glycerine ether to the aryl-substituted alcohol disclosed in paragraph [0078]. Also for this reason, the subject-matter of claim 2 of the main request is novel in view of the combination of paragraphs [0060], [0073] and [0078] of D1.

3.3 Novelty in view of D2

3.3.1 The opponent objected to the novelty of the subject-matter of claim 2 of the main request in view of example 14 on page 14 of D2.

3.3.2 Example 14 of D2 refers to a composition comprising, *inter alia*, 10 wt.% of "3-(2-Ethylhexyloxy)-propan-1,2-diol" and 65 wt.% of phenoxypropanol. 3-(2-ethylhexyloxy)-propan-1,2-diol corresponds to 1-(2-ethylhexyl) glycerol ether, as required for component (a) of claim 2 of the main request. Phenoxypropanol is

an arylalkanol as required for component (b) of claim 2 of the main request. The weight ratio of 1-(2-ethylhexyl) glycerol to phenoxypropanol in this composition is $10/65 = 0.154$, i.e. 0.15 when rounded to two decimal places. This corresponds to the upper limit of the range defined in claim 2 of the main request.

Thus, example 14 of D2 discloses all the features of claim 2 of the main request.

3.3.3 The patent proprietor argued that the weight ratio of compound (a) to compound (b) (i.e. weight ratio of 1-(2-ethylhexyl) glycerol to the aromatic alcohol) was not directly and unambiguously disclosed in D2. The content of phenoxypropanol and the content of 3-(2-ethylhexyloxy)-propan-1,2-diol were rounded values which gave a ratio that could fall outside the range required by claim 1 as granted if the content of phenoxypropanol was less than 65 wt.% and the content of 1-(2-ethylhexyl) glycerol ether was more than 10 wt.%. The patent proprietor referred to T 226/93, T 793/93 and T 413/05.

The board does not agree. The criterion to be used in the examination of novelty is what a prior art document directly and unambiguously discloses. In this case, D2 directly and unambiguously discloses a composition comprising **10** wt.% of 1-(2-ethylhexyl) glycerol and **65** wt.% of phenoxypropanol. A ratio of 1-(2-ethylhexyl) glycerol to phenoxypropanol of $10/65$, i.e. 0.15 is thus directly and unambiguously disclosed in D2. As explained in the communication pursuant to Article 15(1) RPBA and not contested by the patent proprietor, the decisions referred to by the patent proprietor deal with technical features where the disclosure in the prior art was not immediately evident and implicit.

Thus, these decisions are not relevant for the case at issue.

Therefore, the board concludes that example 14 of D2 is prejudicial to the novelty of the subject-matter of claim 2 of the main request.

3.4 Novelty in view of D4

The opponent submitted that the subject-matter of claim 1 of the main request lacked novelty in view of chapter III, 2.d) on page 150, of D4.

Chapter III, 2.d) on the bottom of page 150, of D4 discloses a composition comprising 1 wt.% of "Glycerinether" and 1 wt.% of phenoxyethanol. Phenoxyethanol is an aryloxyalkanol as required by claim 1 of the main request. The above paragraph does not disclose that the "Glycerinether" is 1-(2-ethylhexyl) glycerol as required for component (a) of claim 1 of the main request.

In the impugned decision (point 19), the opposition division held that 1-(2-ethylhexyl) glycerol and glycerine ether were used interchangeably on page 149 of D4 and that 1-(2-ethylhexyl) glycerol was the only glycerine ether tested in D4, section III. For this reason, the glycerin ether compound of paragraph 2.d) was implicitly referring to 1-(2-ethylhexyl) glycerol.

The board does not agree. An alleged disclosure can only be considered "implicit" if it would have been immediately apparent to the skilled person that nothing other than the alleged implicit feature forms part of the subject-matter disclosed (T 51/10, Reasons 2.4). The term "implicit disclosure" should not be construed to mean matter that does not belong to the content of the technical information provided by a document but

may be rendered obvious on the basis of that content (T 1523/07, Reasons 2.4).

In this case, it cannot be assumed from the disclosure on page 150 of D4 that the "Glycerinether" used in combination with phenoxyethanol is 1-(2-ethylhexyl) glycerol. On page 148 at the beginning of chapter III 2, reference is made to "1-Alkylglycerinether". Above the table on page 149 of D4, the "Glycerinether" compound referred to in the table is specified as 1-(2-ethylhexyl) glycerol. However, this does not mean that "Glycerinether" and 1-(2-ethylhexyl) glycerol are used as synonyms in D4. On the contrary, all that can be deduced is that 1-(2-ethylhexyl) glycerol is an example of "1-Alkylglycerinether" or in short "Glycerinether", namely where the alkyl group of the "Glycerinether" is 2-ethylhexyl. In fact, no reference to (2-ethylhexyl) glycerol ether can be found in chapter III, 2.d) on the bottom of page 150. Furthermore, this paragraph on page 150 uses the plural form of "Glycerinether" ("*...sind die Glycerinether...*") implying that this term refers to alkyl ethers in general and not to the specific 1-(2-ethylhexyl) ether of glycerol.

For these reasons, 1-(2-ethylhexyl) glycerol is not implicitly disclosed in this paragraph.

Thus, the subject-matter of claim 1 of the main request is novel in view of D4.

4. In view of the above lack of novelty of the subject-matter of claims 1 and 2, the main request is not allowable.

Auxiliary request 1 - Claims 1-7 of "Set A" filed on
12 May 2015

5. Claims 1 and 2 of auxiliary request 1 read as follows:

"1. Disinfectant in the form of a working mixture which comprises

(a) 0.05 to 1% by weight of 1-(2-ethylhexyl)
glycerol ether and

(b) 0.2 to 5% by weight of one or more aromatic
alcohols selected from the group consisting of
aryloxyalkanols and arylalkanols,

**wherein an aryloxyalkanol used is phenoxyethanol or
phenoxypropanol, or**

**wherein an arylalkanol used is 3-phenylpropan-1-ol,
phenylethyl alcohol, veratryl alcohol, benzyl alcohol
or 2-methyl-1-phenyl-2-propanol."**

"2. Disinfectant in the form of a working mixture or of
a concentrate, characterized in that it comprises

(a) 1-(2-ethylhexyl) glycerol ether and

(b) one or more aromatic alcohols selected from the
group consisting of aryloxyalkanols and arylalkanols,

the weight ratio x of component (a) to component (b)
being 0.15 or less,

**wherein an aryloxyalkanol used is phenoxyethanol or
phenoxypropanol, or**

**wherein an arylalkanol used is 3-phenylpropan-1-ol,
phenylethyl alcohol, veratryl alcohol, benzyl alcohol
or 2-methyl-1-phenyl-2-propanol."** (Emphasis added by
the board; bold text representing added text compared
to claims 1 and 2 of the main request.)

6. Admittance of the objection of lack of clarity

6.1 As set out above, claim 1 of auxiliary request 1 refers to a disinfectant:

*"wherein an aryloxyalkanol **used** is phenoxyethanol, **or** wherein an arylalkanol **used** is 3-phenylpropan-1-ol, phenylethyl alcohol, veratryl alcohol, benzyl alcohol or 2-methyl-1-phenyl-2-propanol"* (Emphasis added by the board.)

This quoted passage of claim 1 of auxiliary request 1 will be referred to in the following as the "use feature" of claim 1.

The opponent submitted in its statement of grounds of appeal that the scope of this claim in terms of the use feature was not clearly defined.

6.2 The patent proprietor requested that this objection of lack of clarity not be admitted into the proceedings.

6.3 The opponent's objection comprises two specific objections. The first one was that the term *"wherein an aryloxyalkanol **used** is phenoxyethanol"* (emphasis added) was confusing as regards the kind of use that claim 1 of auxiliary request 1 should encompass. The reason was that this claim 1 did not clearly define for which purpose phenoxyethanol was used. In this respect, it was not clear whether a composition comprising the glycerol ether defined in claim 1 and any of aryloxyalkanols or arylalkanols already falls within the scope of claim 1 of auxiliary request 1 and, therefore, whether the aryloxyalkanols or arylalkanols specified by the use feature in the claim (see the above-quoted passage of claim 1) were limiting features. The second objection was that the or-combination in relation to that feature did not make it clear whether a

composition comprising phenoxyethanol excluded the presence of the specific arylalkanols defined in the use feature of claim 1.

The objection was submitted with the statement of grounds of appeal. Consequently, the admittance of the objection is governed by Articles 12(2) RPBA 2020 and 12(4) RPBA 2007.

The board acknowledges that an objection of lack of clarity against the claims of the fourth auxiliary request then on file was discussed during oral proceedings (third paragraph on page 3 of the minutes) and in the impugned decision (point 37). However, this objection was based on the wording of claim 5 of the fourth auxiliary request then on file ("*wherein the disinfectant is a disinfectant according to one of claims 1 to 4*") and not on the wording of claim 1. Hence, during the opposition proceedings, no clarity objection against claim 1 of the fourth auxiliary request then on file, which comprises the same use feature as claim 1 of auxiliary request 1, was made. In fact, as set out above, this objection was filed for the first time in the statement of grounds of appeal. No reasons were given, nor are any apparent to the board why this objection of lack of clarity of claim 1 of auxiliary request 1 was not raised during the first-instance proceedings and, in particular, why it was not raised during oral proceedings before the opposition division. In the absence of any such reasons, the objection should have been filed in opposition proceedings (Article 12(4) RPBA 2007).

Furthermore, the purpose of appeal proceedings is not to start a second opposition proceedings but to review the correctness of the appealed decision (Article 12(2) RPBA 2020). However, admitting the new objection into

the proceedings would allow the opponent to do exactly that, namely to start a second opposition proceedings in which the new clarity objection is examined.

- 6.4 The opponent submitted that it was not a new objection but a new argument. An objection of lack of clarity of the claims of the fourth auxiliary request then on file was raised before the opposition division. The objection submitted with the statement of grounds of appeal was based on the objection raised before the opposition division and applied to the claims of auxiliary request 1.

The board does not agree. As set out above, the objection raised during oral proceedings before the opposition division was against the wording "*wherein the disinfectant is a disinfectant according to one of claims 1 to 4*" found in claim 5 of the fourth auxiliary then on file. The objection of lack of clarity of claim 1 of auxiliary request 1 is based on a different wording, as set out above. Thus, the objection of lack of clarity of claim 1 is based on facts different from those presented in the context of claim 5 of the fourth auxiliary request then on file before the opposition division. For this reason, the objection under Article 84 EPC against claim 1 is neither based on nor derivable from the objection raised before the opposition division. It constitutes a new allegation of fact raised for the first time in the statement of grounds of appeal.

- 6.5 Therefore, the board decided not to admit the objection of lack of clarity into the proceedings in accordance with Articles 12(4) RPBA 2007 and 12(2) RPBA 2020.

7. Novelty

7.1 Claims 1 and 2 of auxiliary request 1 differ from claims 1 and 2 of the main request in that the aryloxyalkanol and the arylalkanol were specified as follows:

"wherein an aryloxyalkanol used is phenoxyethanol or phenoxypropanol, or wherein an arylalkanol used is 3-phenylpropan-1-ol, phenylethyl alcohol, veratryl alcohol, benzylalcohol or 2-methyl-1-phenyl-2-propanol".

As set out for the main request (3.3 above), D2 (example 14) discloses a composition comprising 1-(2-ethylhexyl) glycerol and phenoxypropanol with a weight ratio of 1-(2-ethylhexyl) glycerol to phenoxypropanol of 0.15. This composition thus discloses component (a), component (b) and a weight ratio of component (a) to component (b) of 0.15 or less, as required by claim 2 of auxiliary request 1. Therefore, the subject-matter of claim 2 of auxiliary request 1 lacks novelty in view of D2.

8. Auxiliary request 1 is thus not allowable.

9. Since the objection of lack of clarity (5 above) was not admitted into the proceedings, the conditional request to admit auxiliary requests 2, 4, 6, 8, 10, 12, 14, 16 and 18 ("Sets A' to I'") is moot.

Auxiliary request 3 - Claims 1-7 of "Set B" filed on
12 May 2015

10. Added subject-matter

10.1 Claim 2 of auxiliary request 3 reads as follows:

"Disinfectant in the form of a working mixture or of a concentrate, characterized in that it comprises
(a) 1-(2-ethylhexyl) glycerol ether and
(b) one or more aromatic alcohols selected from the group consisting of aryloxyalkanols, ~~oligoalkanol aryl ethers~~ and arylalkanols,
the weight ratio x of component (a) to component (b) being 0.15 or less,
wherein an aryloxyalkanol used is phenoxyethanol, or

wherein an arylalkanol used is 3-phenylpropan-1-ol, phenylethyl alcohol, veratryl alcohol, benzyl alcohol or 2-methyl-1-phenyl-2-propanol" (Emphasis added by the board; strike through and bold text representing deleted and added text, respectively, compared to claim 2 as filed.)

To arrive at the subject-matter of claim 2 of auxiliary request 3, the alternative "oligoalkanol aryl ethers" of claim 2 as filed was deleted, and the remaining alternatives "aryloxyalkanols" and "arylalkanols" of claim 2 as filed were specified according to one of two options disclosed in claim 4 as filed ("*...the aryloxyalkanol is **phenoxyethanol** or phenoxyopropanol.*", emphasis added) and claim 5 as filed ("*...the arylalkanol is 3-phenylpropan-1-ol, phenylethyl alcohol, veratryl alcohol, benzyl alcohol or 2-methyl-1-phenyl-2-propanol.*"). The only selection involved is thus the selection of the option "phenoxyethanol" in claim 4 as filed.

10.2 During the oral proceedings, the opponent objected that the indefinite article "an" before "aryloxyalkanol" and "arylalkanol" in claim 2 of auxiliary request 3 implied that further non-listed aryloxyalkanols and arylalkanols could be present, contrary to what was required in claims 4 and 5 as filed.

A second objection was raised in that the term "or" in claim 2 of auxiliary request 3 ("*wherein an aryloxyalkanol used is phenoxyethanol, **or** wherein an arylalkanol used is ...*") implied that if a listed compound was selected, no other listed compound could be present, again contrary to what was required in claims 4 and 5 as filed.

10.3 Objection based on the term "an"

Claim 2 of auxiliary request 3 refers to the indefinite article "an" ("**an** aryloxyalkanol used is..." and "**an** arylalkanol used is...", emphasis added by the board), while claims 4 and 5 as filed use the definite article "the".

The board acknowledges that in line with the opponent's argument, the wording of claim 2 of auxiliary request 3 implies that further aryloxyalkanols or arylalkanols may be present in the disinfectant of the claim. However, contrary to the opponent's argument, the combination of claim 2 as filed and claim 4 or 5 as filed does not exclude the presence of further aryloxyalkanols or arylalkanols, either. More specifically, claim 2 as filed refers to a "*Disinfectant ... characterized in that it comprises ... (b) one or more aromatic alcohols selected from the group consisting of aryloxyalkanols, oligoalkanol aryl ethers and arylalkanols, ...*"). Claim

2 as filed thus uses the "comprising" language and refers to the wording "one or more aromatic alcohols", meaning that the combination of claim 2 as filed with either claim 4 or 5 as filed allows the presence of further aryloxyalkanols or arylalkanols in addition to those mentioned in the two claims.

This interpretation is confirmed by established case law. For instance, from T 2017/07, Reasons 2.2.3, it can be derived that if in a claim directed to a composition defined as comprising specific classes of components these classes of components are narrowed down to particular members of these classes, the claim still covers the presence of other members of these classes of components different from the particular members, unless otherwise specified. Although the above-mentioned decision deals with Article 123(3) EPC, the same logic applies to the case at issue: the combination of claim 2 as filed and claim 4 or 5 as filed defining specific members of the classes aryloxyalkanols or arylalkanols does not exclude the presence of further members not listed in claim 4 or 5.

10.4 Objection based on the term "or"

Contrary to the opponent's argument, the presence of the term "or" in claim 2 of auxiliary request 3 does not imply that if, for example, an aryloxyalkanol defined in claim 2 of auxiliary request 3 is chosen, there can be no arylalkanol additionally present in the disinfectant. More specifically, the claim refers for component (b) to "*one or more aromatic alcohols*", implying that only one or **more than one** of the aromatic alcohols listed in the claim may be present in the disinfectant. Thus, the term "or" cannot be exclusive in the context of claim 2 of auxiliary request 3.

Hence, the alleged contradiction to claims 4 and 5 as filed does not exist.

In view of the above, the board concludes that claim 2 of auxiliary request 3 fulfils the requirements of Article 123(2) EPC.

11. Novelty

11.1 The opponent submitted that the objections of lack of novelty raised against claims 1 and 2 of the main request applied to claims 1 and 2 of auxiliary request 3. The attacks were as follows:

- (i) lack of novelty of the subject-matter of claim 1 in view of the example on page 11 of D1
- (ii) lack of novelty of the subject-matter of claim 2 in view of the combination of paragraphs [0060], [0073] and [0078] of D1
- (iii) lack of novelty of the subject-matter of claim 2 in view of example 14 of D2
- (iv) lack of novelty of the subject-matter of claim 1 in view of chapter III, 2.d) on page 150, of D4

11.2 Claim 1 of auxiliary request 3 differs from claim 1 of the main request in that the aryloxyalkanol and the arylalkanol were specified as follows:

"wherein an aryloxyalkanol used is phenoxyethanol or phenoxypropanol, or

wherein an arylalkanol used is 3-phenylpropan-1-ol,

phenylethyl alcohol, veratryl alcohol, benzyl alcohol or 2-methyl-1-phenyl-2-propanol."

Claim 2 of auxiliary request 3 was amended in the same way claim 1 was, except that the aryloxyalkanol is only phenoxyethanol.

11.3 Novelty in view of D1

D1 (example on page 11), as set out above (3.2.2), discloses a composition comprising (2-ethylhexyl) glycerol ether and 2-methyl-4-phenylbutan-2-ol. The latter compound is not an arylalkanol encompassed by claim 1 of auxiliary request 3. Claim 1 of auxiliary request 3 is thus novel in view of D1.

In the context of the main request, it was held that the combination of paragraphs [0060], [0073] and [0078] of D1 did not directly and unambiguously disclose a composition comprising 1-(2-ethylhexyl) glycerol ether and the aromatic alcohol b) in the specific weight ratio, as defined in claim 2 of the main request (3.2.3 above).

These reasons thus apply *mutatis mutandis* to the subject-matter of claim 2 of auxiliary request 3.

11.4 Novelty in view of D2

Example 14 of D2 was discussed in the context of the novelty of the subject-matter of claim 2 of the main request (3.3.2 above). This example discloses a composition comprising phenoxypropanol. This aryloxyalkanol is not an aromatic alcohol as defined in claim 2 of auxiliary request 3. Thus, the subject-matter of this claim is novel in view of D2.

11.5 Novelty in view of D4

In the context of claim 1 of the main request (3.4 above), it was held that chapter III, 2.d) on page 150, of D4 did not directly and unambiguously disclose 1-(2-ethylhexyl) glycerol ether. Since claim 1 of auxiliary request 3 also requires the presence of this compound, the reason given for claim 1 of the main request (Reasons 3.4 above) applies *mutatis mutandis* to the subject-matter of claim 1 of auxiliary request 3.

11.6 The board thus concludes that the subject-matter of the claims of auxiliary request 3 is novel in view of any of D1, D2 and D4.

12. Remittal

12.1 The opponent requested that the case be remitted to the opposition division if novelty was acknowledged.

12.2 In accordance with Article 11 RPBA 2020, the board must not remit a case unless special reasons present themselves for doing so. As a rule, fundamental deficiencies apparent in the proceedings before the first-instance department constitute such special reasons.

In the case at hand, the board is not aware of any fundamental procedural deficiencies before the opposition division justifying remittal.

12.3 The opponent submitted that the opposition division did not assess the inventive step of the subject-matter of claim 1 of auxiliary request 3 in view of D4 as the closest prior art. Thus, the case should be remitted.

The attack starting from D4 as the closest prior art was filed for the first time during the oral proceedings before the board and thus is an entirely

new attack. If by filing such a new attack, a party could force the board to remit the case, it would be at the party's disposition to shift the case back to the first instance at whatever stage of the appeal proceedings and to thereby start, at any point in the appeal proceedings, a new opposition before the opposition division. This would not only run counter to the principle of procedural economy but to the very nature of appeal proceedings, which is to review the appealed decision (Article 12(2) RPBA 2020) rather than to allow for the start of a second opposition proceedings.

Consequently, the board decided that the case was not to be remitted to the opposition division for further prosecution.

13. Inventive step
- 13.1 Admittance of the objection of lack of inventive step based on D4 as the closest prior art
- 13.1.1 As set out above, the opponent raised during the oral proceedings an objection of lack of inventive step of the subject-matter of claim 1 of auxiliary request 3 based on D4 as the closest prior art.
- 13.1.2 The patent proprietor objected to the admittance of this objection.
- 13.1.3 This objection had not been raised at a previous stage of the appeal proceedings and thus represented an amendment to the opponent's case, the admittance of which was at the board's discretion in view of Article 13(2) RPBA 2020, which applies to the case at hand in accordance with the transitional provisions set out in

Article 25(3) RPBA 2020 (the summons to oral proceedings was notified after 1 January 2020).

In accordance with Article 13(2) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings must, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

Document D4 was discussed in the appeal proceedings in the context of novelty of the granted claims. It was also discussed in the assessment of inventive step of the claims of auxiliary request 7 but for establishing the obviousness of the solution to the problem formulated in view of D1 or D2 rather than D4 as the closest prior art.

The board has seen no exceptional circumstances during the whole appeal proceedings which could justify the late-filing of the objection during the oral proceedings.

In addition, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020) and not to start new opposition proceedings. Admitting the objection would offer to the opponent the opportunity to amend its case and introduce this new attack based on D4 as the closest prior art.

For these reasons, the objection of lack of inventive step based on D4 as the closest prior art was not admitted into the proceedings in accordance with Articles 12(2) and 13(2) RPBA 2020.

13.2 Inventive step in view of D1 or D2 as the closest prior art

During the oral proceedings, the opponent referred to a first attack based on D1 alone, or in combination with D4 and a second attack based on D2 as the closest prior in combination with D4.

13.3 The patent concerns a disinfectant and its use for controlling mycobacteria. Mycobacteria can cause serious diseases in mammals, such as tuberculosis (*M. tuberculosis*) and Hansen's strain of leprosy (*M. leprae*). Mycobacteria are bacteria which are difficult to inactivate because of their waxy cell wall (paragraphs [0002] to [0005] of the patent).

13.4 D1 as the closest prior art

13.4.1 D1 (3.2.2 above) discloses a composition comprising a glycerine monoalkyl ether and an aryl-substituted alcohol. D1 is concerned with the provision of cosmetic and dermatologic compositions for the control of bacteria (paragraphs [0001] and [0005]). The only example of D1 is a composition comprising, *inter alia*, 1-(2-ethylhexyl) glycerol ("*Octoxyglycerin*") ether and 2-methyl-4-phenylbutan-2-ol.

13.4.2 Distinguishing feature

The distinguishing feature of claims 1 and 2 in view of the example of D1, using 2-methyl-4-phenylbutan-2-ol, is the specific aromatic alcohol as defined in component (b) of these claims (claim 1: phenoxyethanol, phenoxypropanol, 3-phenylpropan-1-ol, phenylethyl alcohol, veratryl alcohol, benzylalcohol or 2-methyl-1-phenyl-2-propanol; claim 2: phenoxyethanol, 3-phenylpropan-1-ol, phenylethyl alcohol, veratryl

alcohol, benzylalcohol or 2-methyl-1-phenyl-2-propanol).

13.4.3 Objective technical problem

The examples of the patent describe the activity of various disinfectants including one disinfectant composition according to claims 1 and 2 containing a combination of (i) SC50, i.e. 1-(2-ethylhexyl) glycerol ether, corresponding to compound (a) as defined in claims 1 and 2 and (ii) POE, i.e. phenoxyethanol, corresponding to component (b) as defined in claims 1 and 2. The ratio of SC50 to POE is 0.0666 (0.1/1.5 see example 1), as required by claim 2. The examples in the patent show that the composition according to claim 1 or claim 2 exhibits an activity against *Mycobacterium terrae* (example 1), other bacteria and yeast fungi (examples 2-5).

The objective technical problem thus is the provision of a disinfectant composition for controlling, *inter alia*, mycobacteria.

13.4.4 Non-obviousness of the solution

D1 does not refer to any mycobacteria. Furthermore, it does not teach that the compositions disclosed in the document would be suitable for controlling mycobacteria. As stated in the patent (13.3 above), mycobacteria are bacteria which are difficult to inactivate because of their waxy cell wall. In view of this specific property, it cannot be deduced that the disinfectant of D1 is suitable and would be efficient for controlling bacteria. Furthermore, D1 does not contain any suggestion that the 2-methyl-4-phenylbutan-2-ol disclosed in this document as being part of the disinfectant should be replaced by a component (b) as defined in claims 1 or 2. The subject-

matter of claims 1 and 2 of auxiliary request 3 would not have been obvious in view of D1.

D4, relied upon by the opponent as a secondary document, refers to microbicidal activity (paragraph III on page 147) and the synergy between alcohols and 1-alkyl glycerine ether (paragraph 2 on pages 148-150) against bacteria. In particular, a composition comprising a glycerin ether, phenoxyethanol and an emulsifier (paragraph d) on page 150) is reported to show a synergistic effect.

However, like D1, D4 does not refer to any mycobacteria, and it cannot be deduced that any disinfectant, even those reported to exhibit a synergism, would be suitable for controlling mycobacteria. Thus, the solution proposed by claims 1 and 2 of auxiliary request 3 would not have been obvious in view of D4 either.

- 13.4.5 According to the opponent, no technical effect was linked with the distinguishing feature of claims 1 and 2 of auxiliary request 3. In its view, the objective technical problem was only the provision of an alternative composition. Hence, the solution proposed by claim 1 would have been obvious in view of D1 alone or in combination with D4.

The board does not agree. The activity of the claimed compositions for controlling mycobacteria is shown in the examples of the patent and is, for this reason, to be taken into consideration for formulating the objective technical problem. The opponent's approach could only be considered if D1 was concerned with the provision of a composition for controlling mycobacteria. However, as stated above, D1 does not

disclose the control of mycobacteria, and this argument must be disregarded.

The opponent also submitted that the objective technical problem was not solved over the whole scope of claim 1 or 2 of auxiliary request 3 in view of the different chemical structures of component (b) according to the claim and in view of the only ratio x exemplified in the patent (0.0666).

The board does not agree with this argument. As set out above, the examples show that the combination of 1-(2-ethylhexyl) glycerol ether and phenoxyethanol is effective for controlling *Mycobacterium terrae*. In view of their structural similarity with phenoxyethanol, it is expected, in the absence of evidence to the contrary, that the aromatic alcohols as defined in claim 1 or 2 of auxiliary request 3 achieve, in combination with the same 1-(2-ethylhexyl) glycerol ether, the same effect as in the examples of the patent. It is also to be expected, in the absence of evidence to the contrary, that a weight ratio x of 0.15 or less but different from 0.0666 shows the same effect as the ratio 0.0666 used in the examples of the patent. Thus, the opponent's argument must fail.

The opponent also argued that the distinguishing feature of claim 1 of auxiliary request 3 in view of D1 did not achieve a technical effect related to cosmetics. It relied on the formulation of the technical problem as the provision of a skin-compatible cosmetic preparation with mycobacteria control as a bonus effect. It submitted that the claimed composition would have been an obvious alternative in view of D1 alone or in combination with D4.

The board disagrees. Mycobacteria control is not just a bonus effect but a crucial point of the invention described in the application as filed (page 1, lines 9-10; page 2, line 33, to page 3, line 2; page 4, lines 4-16). It represents the basis of the objective technical problem. Therefore, this effect cannot be ignored under the problem/solution approach.

13.5 D2 as the closest prior art

13.5.1 D2 relates to a conservative composition for an aqueous product. Table V of D2, referred to by the opponent as the starting point for the problem/solution approach, discloses a shampoo composition comprising, *inter alia*, 0.02 wt.% of a C₇-alkyl glycerine ether and 0.2. wt.% of phenoxyethanol. The amount of the C₇-alkyl glycerine ether differs from that of 1-(2-ethylhexyl) glycerol required by claim 1, which is 0.05 to 1% by weight. Furthermore, the amount of phenoxyethanol is as required by claim 1 of auxiliary request 3: 0.2 to 5% by weight.

13.5.2 Distinguishing feature

The subject-matter of claim 1 of auxiliary request 3 differs from the composition of table V of D2 in the presence of 1-(2-ethylhexyl) glycerol instead of the C₇-alkyl glycerine ether and its amount.

13.5.3 Objective technical problem

As set out above in the context of D1 as the closest prior art, the compositions according to claim 1 of auxiliary request 3 exhibit, *inter alia*, an activity against *Mycobacterium terrae*.

In the same way as for D1, the objective technical problem is the provision of a disinfectant composition for controlling, *inter alia*, mycobacteria.

13.5.4 Non-obviousness of the solution

For the same reasons as those set out above in the context of D1 as the closest prior art, D4 (being the only document relied on by the opponent to evidence the obviousness of the claimed subject-matter) would not have rendered obvious the composition of claim 1 of auxiliary request 3 for controlling mycobacteria.

13.6 It follows from the foregoing that the subject-matter of independent claims 1 and 2 and by the same token of claims 3-7 of auxiliary request 3 involves an inventive step.

14. The board thus comes to the conclusion that auxiliary request 3 is allowable.

15. Admittance of A010 and A011

Documents A010 and A011 invoked by the opponent are press publications of the patent proprietor that disclose that the claimed compositions were used as "*preservatives for cosmetics and toiletries*". During the oral proceedings, the opponent did not rely on these documents. There was thus no need to decide on their admittance.

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 with the order to maintain the patent on the basis of the claims of auxiliary request 3 "Set B" as submitted with letter of 12 May 2015 and a description to be adapted thereto.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated