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**Datasheet for the decision
of 5 March 2019**

Case Number: T 0915/16 - 3.3.03

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Language of the proceedings: EN

Title of invention:
FILMS WITH MICROCAPSULES

Patent Proprietor:
The Procter & Gamble Company

Opponents:
UNILEVER PLC / UNILEVER NV
Henkel AG & Co. KGaA

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
Amendments - allowable (no) - all requests



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Case Number: T 0915/16 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 5 March 2019

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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
3 March 2016 concerning maintenance of the
European Patent No. 2049587 in amended form.

Composition of the Board:

Chairman	F. Rousseau
Members:	M. C. Gordon
	C. Brandt

Summary of Facts and Submissions

I. The appeals of the patent proprietor (appellant I) and the opponents 1 and 2 (appellants II and III respectively) lie against the interlocutory decision of the opposition division posted on 3 March 2016 according to which it was held that European patent number 2 049 587 could be maintained in amended form on the basis of the auxiliary request 2 and an adapted description, both filed at the oral proceedings. The decision of the opposition division was also based on the granted claims as main request and an additional set of claims forming auxiliary request 1.

II. Claim 1 of the application as filed read as follows:

"An article comprising:

a. a functionalized substrate comprising:

(i) a composition susceptible to aqueous attack, wherein said composition is selected from water-soluble materials, partially water soluble [*sic*] materials, water-dispersible materials, water-disintegrating materials, and mixtures thereof; and

(ii) a plurality of microcapsules encapsulating a functional composition, wherein said plurality of microcapsules is incorporated with said functionalized substrate."

III. Claim 1 of the patent as granted differed from claim 1 of the application in that the following wording was added at the end of the claim:

", wherein the functionalized substrate is cut or prepared in the form of small pieces having a maximum

linear dimension of from 1 to 20 mm, as a stand alone product,
wherein the functional composition comprises a perfume composition,
and wherein said plurality of microcapsules comprises a friable microcapsule".

IV. Two notices of opposition were filed against the patent whereby the grounds pursuant to Article 100(a) EPC (lack of novelty, lack of inventive step), Article 100(b) EPC and Article 100(c) EPC were invoked.

V. With respect to the sets of claims underlying the decision, claim 1 of auxiliary request 1 differed from claim 1 of the granted claims, i.e. the main request, by the introduction of the following wording at the end of the claim:

"[...friable microcapsule], wherein said composition comprises polyvinyl alcohol, derivatives of polyvinyl alcohol, carboxymethyl cellulose, derivatives of carboxymethyl cellulose, hydroxypropyl methyl-cellulose, polyoxyethylene, starch, starch derivative [*sic*], surfactant, soap, polyethylene glycol, and mixtures thereof".

Claim 1 of auxiliary request 2 differed from claim 1 of auxiliary request 1 by additionally specifying the perfume composition as follows:

"[...functional composition comprises a perfume composition] wherein the perfume composition comprises a blooming perfume composition that comprises from 3 to 300 different perfume ingredients [and wherein said plurality of microcapsules....].

The opposition division held *inter alia* that the claims of all requests met the requirements of Article 123(2) EPC. Objections of the opponents that the subject-matter claimed was the result of a plurality of selections from the application as filed for which there was no basis in the application were dismissed.

- VI. Since all parties have appealed, in the following the parties will be identified solely by their party status, i.e. patent proprietor, opponent 1 and opponent 2.
- VII. With its statement of grounds of appeal, the patent proprietor maintained the three sets of claims as considered by the opposition division.
- VIII. In the statements of grounds of appeal of opponents 1 and 2 and the corresponding responses to the statement of grounds of appeal of the patent proprietor, objections of added subject-matter were raised in respect of the main request and the first and second auxiliary requests, labelled auxiliary requests 1 and 2.
- IX. The patent proprietor in its response to the statements of grounds of appeal of the two opponents submitted further sets of claims as third to 15th auxiliary requests, labelled auxiliary requests 3 to 15, in respect of which opponent 2 made further written submissions.
- X. The Board issued a summons to oral proceedings and a communication.

XI. Opponent 1 made a further written submission with letter of 8 February 2019.

XII. The patent proprietor provided a further written submission (letter of 27 February 2019).

The main request - claims of the patent as granted - was withdrawn. The designation of the remaining requests was however not amended. Thus the set of claims filed as auxiliary request 1 with the statement of grounds of appeal advanced to become the main request.

XIII. Oral proceedings took place before the Board on 5th March 2019.

XIV. The arguments of the patent proprietor in respect of added subject-matter can be summarised as follows:

(a) Main request, i.e. set of claims labelled auxiliary request 1, filed with the statement of grounds of appeal

Originally filed claim 5 (polymers employed for the substrate) in combination with claims 1 and 2 provided a basis for the majority of features of the claim.

The totality of the features of claim 5 had been imported into claim 1, i.e. there had been no selection in that respect. The subject-matter of original claim 5 would be understood as applicable to all embodiments of the invention.

The form of the substrate, i.e. particles of the given dimensions, was disclosed on page 25, which

also disclosed that the product was stand alone. This in turn was disclosed as being generally applicable and hence combinable with any of the other embodiments. The subject-matter claimed would be apparent to the skilled person from a reading of the specification as filed, which provided clear pointers thereto.

The feature "friable" was disclosed in claim 4 and was clearly the main focus of the invention, being disclosed specifically in the context of the functional material being a perfume and was emphasised on page 13, last paragraph.

The form of the product was disclosed on page 25. There were two options - either stand alone or blended with another product. The skilled person would understand that the dimensions of the composition were applicable to either of these alternatives. The restriction to one of these was therefore not objectionable. Stand alone products were emphasised in the description due to the focus on customisation - this was mentioned in particular in the general presentation of the invention at pages 1-3.

Thus the claim amounted to the combination of two sets of generally disclosed features. There was no requirement in the EPC or the Case Law that the application provide a single unified disclosure of all possible combinations of embodiments. The approach of the opponents focused on the words rather than the technical content.

In this context it was emphasised that it was not of significance whether features were disclosed as

essential. The application provided a clear pointer to the subject-matter of friable microcapsules with perfume even if the examples did not reflect what was in the claim, in particular in terms of the dimensions of the product.

Regarding the materials from which the composition was formed, the skilled person would understand that those recited in original claim 5 were preferred and applicable to all embodiments of the invention.

- (b) First auxiliary request - set of claims filed as auxiliary request 2 with the patent proprietor's statement of grounds of appeal and corresponding to those claims which were considered to meet the requirements of the EPC by the opposition division.

The feature of blooming perfume in combination with friable microcapsules was disclosed on page 14 of the application as filed and given particular prominence. This provided a basis for the combination with any form of substrate including that now defined in claim 1 by means of the size feature.

- (c) Sets of claims filled as auxiliary requests 3-15

The amendments made were broadly indicated. The arguments advanced in respect of the main request-labelled "auxiliary request 1" equally applied to auxiliary requests 3-15, which were not directed to addressing the objections pursuant to Article 123(2) EPC.

XV. The arguments of the opponents in respect of added subject-matter can be summarised as follows

(a) Main request - designated auxiliary request 1

The restriction to friable microcapsules represented a selection from the generality of the application as filed, which disclosed that the microcapsules could be friable, moisture-activated, heat-activated, or combinations thereof. There was no statement that friable materials were preferred.

Similarly the form of the substrate as particles of a given size was the result of - at least one - further selection. It also seemed to be the case that the dimensional requirements were disclosed in the application as filed only in the context of films, but not for any other form of the substrate.

To the extent that any of these selections individually might have been given prominence in the application as filed, this was not the case for the combination thereof.

Even if - *arguendo* - the combination of a friable microcapsule with a perfume as functional composition were to be accepted as having been originally disclosed, there was no basis for these features in combination with the required dimensions or the feature "stand alone".

The examples did not exemplify the claimed subject-matter because these did not meet the size requirement and hence could not serve as a pointer to the subject matter now claimed.

There was also a question at the level of the materials from which the substrate was made. The disclosure in the description was far broader than that of originally filed claim 5 and there was no pointer to the restriction to this subset of compositions (polymers) in combination with the other features of the claim.

- (b) First auxiliary request (i.e. set of claims designated "auxiliary request 2", on the basis of which the patent was maintained)

In view of the conclusions in respect of the main request as relating to a non-disclosed combination of features, the introduction of yet another feature inherently could not address this objection.

The indicated passage on page 14 did not provide a link between blooming and friable. The objection that the specified size was not disclosed in combination with friable had not been overcome by this amendment. The examples were also of no assistance since the perfume composition employed therein was not a blooming perfume.

- (c) Auxiliary requests 3 to 15

No further comments were advanced.

XVI. The patent proprietor requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request filed as first auxiliary request with the statement of grounds of appeal, or, that the patent be maintained on the basis of the set of claims as maintained by the opposition

division (first auxiliary request), or, that the patent be maintained on the basis of any of the second to fourteenth auxiliary requests filed as third to fifteenth auxiliary requests with letter dated 29 November 2016.

- XVII. Opponents 1 and 2 requested that the decision under appeal be set aside and that European patent No. 2 049 587 be revoked.

Reasons for the Decision

1. Main request - added subject-matter

As noted above, the set of claims filed as auxiliary request 1 with the patent proprietor's statement of grounds of appeal is the main request.

It is not disputed by the opponents that the features - individually - can be found in the application as filed. However the combination thereof is considered not to be disclosed.

- 1.1 As can be gleaned from the presentation of claim 1 of the application as filed in the above section II of the Facts and Submissions, the first part of the claim - i.e. that concluding with the wording "...is incorporated in said functionalized substrate" is taken *verbatim* from claim 1 as originally filed.
- 1.2 The features "wherein the functionalized substrate is cut or prepared in the form of small pieces having a maximum linear dimension of from 1 to 20 mm" and that this is a "stand alone product" are disclosed at page

25, third paragraph.

Regarding the objection of the opponents that this wording is restricted to the situation when the substrate is in the form of a film, the Board notes that the indicated passage is part of a section commencing at the bottom of page 24, which is indeed entitled "Film Dimension". Whereas the final paragraph on page 25 explicitly relates to films which are cut into pieces, the first paragraph specifies that the substrate can be in forms other than films, namely wafers, foams, sponges, bars, noodles and pasta shapes or other three dimensional forms.

The third paragraph on page 25 i.e. that containing the features now in operative claim 1 starts with the wording "In one embodiment" and relates to a mode of realisation distinct from that in the preceding and succeeding paragraphs, i.e. not a film as it defines that the functionalized substrate is cut into or prepared in the form of small pieces, such as confetti.

Accordingly the argument of the opponents that the dimensional and "stand alone" features relate only to films is not found persuasive, the somewhat confusing structure of the description notwithstanding.

It results from the above that a functionalized substrate cut or prepared in the form of small pieces having a maximum linear dimension of from 1 to 20 mm represents one of the possibilities for the form of the substrate disclosed in the application as filed.

- 1.3 The requirement that the functional composition comprises a perfume is disclosed in originally filed claim 2. Although the microcapsules do not necessarily

contain a perfume, their use is preferred as shown by the examples and claim 2.

1.4 The requirement that the microcapsules "comprise a friable microcapsule"

Claim 4 specifies that the microcapsules can be friable, moisture-activated or heat-activated, or a combination of these.

The wording of claim 4 is reflected on page 9, second complete paragraph where it is stated that "In one embodiment" the microcapsules comprise a friable microcapsule. In the 7th and 9th lines of this paragraph it is stated that "In another embodiment" the microcapsules are moisture-activated or heat-activated, and in the 11th line of the paragraph that the microcapsule can be a friable microcapsule, a moisture-activated microcapsule a heat activated microcapsule or combinations thereof.

On page 10 further properties of the microcapsules are discussed such as size and the material from which they are made.

The three types of microcapsule - friable, heat-activated or moisture-activated are, in the absence of any indication of preference, thus disclosed as alternatives of equal ranking.

In the final partial paragraph of page 13 friable microcapsules containing a perfume composition are discussed in the context of imbuing fabrics with a scent that can be released upon manipulation. This is presented as one possible embodiment of the invention, but is not indicated as being preferable.

Starting at page 21, lower section, concerning microcapsule distribution, volume fraction, and concentration of the microcapsules in the functionalized substrate friable microcapsules are not mentioned.

Similarly in the discussion starting on page 25 relating to the form of the substrate, no reference or limitation in terms of the microcapsules is presented.

The conclusion is that the application as filed discloses that the microcapsules can be one of three kinds, which are of equal preference.

Accordingly the definition in the claim of friable microcapsules represents a further selection from the generality of the application as filed.

- 1.5 The definition of the materials from which the substrate is made corresponds to the wording of originally filed claim 5 which was dependent on all preceding claims.

On its own this amendment is not objectionable.

- 1.6 The patent proprietor did not rely on the examples of the application as filed when indicating a basis for what is defined in claim 1 of auxiliary request 1. As indicated by the opponents, the examples of the patent also do not reflect the subject-matter of the operative claim.

Although it appears that the microcapsules employed in the examples, having a urea/formaldehyde wall, are friable, the substrate in which they are embedded is provided initially in the form of a film of dimensions

24.5 cm x 20.0 cm (page 33, 5th bullet, process on page 34 and 35). In the dissolution tests (page 36, top) pieces of size 35 mm x 23 mm are prepared. In the continuation, page 37 section 4, petal shapes of size 100 mm x 70 mm are prepared. All of these embodiments are above the maximum size specified in claim 1.

Accordingly the examples do not provide any pointer to the claimed combination of features since the required form of the substrates - small pieces of maximum linear dimension 1 to 20mm - is not complied with.

It is therefore not possible to derive the claimed combination of features from the examples.

An indication in the application as filed for a basis for the combined use of (i) a substrate which is cut or prepared in the form of small pieces having a maximum linear dimension of from 1 to 20 mm (and therefore is for example not in the form of a sheet or a film) and (ii) friable microcapsules was not provided by the patent proprietor and is not apparent to the Board.

- 1.7 The conclusion is that the subject-matter of operative claim 1 is the result of a plurality of selections from the application as filed for which there is neither an explicit nor an implicit basis.

Accordingly the requirements of Article 123(2) EPC are not complied with.

2. First auxiliary request (former auxiliary request 2 on the basis of which the patent was upheld) - Article 123(2) EPC

Claim 1 differs from claim 1 of the main request, i.e.

former auxiliary request 1, by requiring that the perfume comprises a blooming perfume that comprises from 3 to 300 different perfume ingredients (see section V, 5th paragraph above).

On page 14 in the section entitled "a. Blooming Perfume" there is a discussion of the effect obtained when friable microcapsules containing a blooming perfume composition are ruptured. However this embodiment is predicated on the prior selection of friable microcapsules. As shown in relation to the main request, there is no disclosure in the application as filed for the combination of friable microcapsules with a substrate as defined in claim 1.

The same applies irrespective of the types of perfume contained in the microcapsules.

In addition the claims of the first auxiliary request (set of claims filed as auxiliary request 2) with a choice of a specific type of perfume from the types of perfumes disclosed in the application as filed (pages 14 and 15; blooming or enduring perfumes) introduce a further selection to the plurality of selections already represented by the subject-matter of the main request, meaning that for the same reasons the requirements of Article 123(2) EPC are not complied with.

3. Second to fourteenth auxiliary requests (sets of claims filed as auxiliary requests 3-15 with letter of 29 November 2016, the rejoinder to the statements of grounds of appeal of the appellants/opponents)

In the letter introducing these requests, beyond indicating the amendments that had been made, only a

very general and rudimentary indication of the reasons for submitting these was provided. The patent proprietor stated at the oral proceedings that these auxiliary requests were not meant to address the objections pursuant to Article 123(2) EPC.

Under these circumstances the Board is unable to conclude that the amendments introduced into these requests overcome the objections against the main and first auxiliary requests.

The Board therefore decides that the second to 14th auxiliary requests (submitted as auxiliary requests 3-15) do not meet the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. European patent No. 2 049 587 is revoked.

The Registrar:

The Chairman:



M. H. A. Patin

F. Rousseau

Decision electronically authenticated