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**Datasheet for the decision
of 6 July 2021**

Case Number: T 1083/16 - 3.3.02

Application Number: 09783843.7

Publication Number: 2348838

IPC: A01N31/04, A01N31/06,
A01N31/08, A61K8/34, A61L12/14,
A61Q11/00, C11D3/00, A61Q17/00,
C11D3/20, C11D3/48

Language of the proceedings: EN

Title of invention:
AN ANTIMICROBIAL COMPOSITION

Patent Proprietor:
Unilever N.V.
Unilever PLC, A Company Registered in England and
Wales under Company no. 41424

Opponents:
BEIERSDORF AG
Henkel AG & Co. KGaA

Headword:

Relevant legal provisions:

EPC Art. 56

RPBA Art. 13(1), 13(3)

RPBA 2020 Art. 25(3)

Keyword:

Inventive step - (no)

Late-filed auxiliary requests - admitted (no)

Decisions cited:

Catchword:



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Case Number: T 1083/16 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 6 July 2021

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
4 March 2016 concerning maintenance of the
European Patent No. 2348838 in amended form.

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
M. Blasi

Summary of Facts and Submissions

I. The appeal of opponent 1 (hereinafter appellant) lies from the decision of the opposition division according to which European patent 2 348 838 in amended form met the requirements of the EPC. The decision was based on the set of claims of the main request filed with the letter dated 9 December 2015 and replacement paragraphs [0040] to [0045] and [0052] of the description filed during oral proceedings before the opposition division.

II. The patent was opposed under Article 100(a) (novelty and inventive step), (b) and (c) EPC.

III. The following documents were among those cited during opposition proceedings:

D1: GB 508,407

D2: The Merck Index, 1996, pages 9316 und 9539

D3: US 2004/0014818 A1

D9: WO 2004/035723 A1

D17: WO 97/30586 A1

D20: Respondents' Experimental Report

D25: Peter Atkins *et al.*, Physical Chemistry, ninth ed. 2010, Oxford University Press, pages 185-186

D26: Respondents' "Experimental Report 2"

IV. With the reply to the statement of grounds of appeal the patent proprietors (hereinafter respondents) filed the following document:

D27: E. Crowshaw in *Disinfectants: their use and evaluation of effectiveness*, Ed. C.H. Collins *et al.*, 1981

V. With the letter of 15 December 2016 the respondents filed the following document:

D28: Derrick Baxby, *Epidemiology and Infection*, Vol 133 (Suppl. 1), pages S13-S14 (2005)

VI. With a communication pursuant to Article 15(1) RPBA, the board set out its preliminary opinion, and in particular noted that the subject-matter of the claims of the main request appeared novel over D1, D3 and D9.

VII. Oral proceedings by videoconference were held on 6 July 2021. During oral proceedings, a set of claims according to a new first auxiliary request was filed.

VIII. Requests

The appellant requested that the contested decision be set aside and that the patent be revoked in its entirety.

The respondents requested that the appeal be dismissed, i.e. that the patent be maintained in amended form on the basis of the main request underlying the impugned decision.

As an auxiliary measure, the respondents requested maintenance of the patent in amended form

- on the basis of the claims of the "new first auxiliary request" filed during oral proceedings before the board, or
- on the basis of the claims of the first auxiliary request filed with the reply to the statement of grounds of appeal, or

- on the basis of the claims of the second or third auxiliary request filed with the letter dated 26 April 2021 or
- on the basis of the description paragraphs of the fourth auxiliary request filed with letter dated 26 April 2021 in combination with the claims of the main request or
- on the basis of the claims of the fifth to seventh auxiliary request filed with the letter dated 26 April 2021, or
- on the basis of the claims of the eighth to tenth auxiliary request filed with the letter dated 22 June 2021.

Opponent 2 is party as of right and did not file any requests in appeal proceedings. With the letter of 29 January 2020, it stated that it would not take part in oral proceedings before the board.

IX. Independent claims 1 and 5 of the main request read as follows:

"1. A method of disinfecting a surface comprising the steps of

(i) applying a composition comprising:

- a. 0.01 to 5% by weight thymol;*
- b. 0.01 to 5% by weight terpineol, and*
- c. a carrier.[sic]*

on to the surface; and

(ii) rinsing the surface with a suitable solvent or wiping the surface with a suitable wipe.

5. An antimicrobial composition comprising

- a. 0.01 to 5% by weight thymol;*
- b. 0.01 to 5% by weight terpineol, and*

*c. 1 to 80% by weight [sic] an anionic surfactant;
and
d. a carrier."*

- X. The arguments of the appellant insofar as relevant to the present decision, may be summarised as follows:

Main request - Inventive step, Article 56 EPC

The subject-matter of claims 1 and 5 lacked inventive step starting from document D1. In particular, D1 disclosed an aqueous solution comprising by weight 8.85% thymol and 8.2% terpineol. The respective concentrations claimed were lower. There was no technical effect since synergism would also be present for the aqueous solution of D1 having a higher concentration of said compounds. The technical problem was the provision of an alternative method (claim 1), or the provision of an alternative composition (claim 5). The solution was obvious in view of D1 alone or in combination with the common general knowledge that terpineol was a known disinfectant, as disclosed for example in D2.

New first auxiliary request - Admittance

This request was not to be admitted into the appeal proceedings. Article 13 RPBA 2007 might apply, but it was up to the board to decide which provisions it considered applicable. It was filed at the latest possible stage in appeal proceedings, and its admittance would have been unfair to the appellant. The alleged high number of objections was caused by the high number of claim requests and the high number of independent claims contained therein. The alleged high number of objections could thus not provide a

justification for filing the new first auxiliary request at such a late stage in the proceedings. Furthermore,

- in a situation in which the respondents chose to only file certain claim requests in writing, the appellant could not be expected to prepare for more than one hundred possible alternatives which could potentially be submitted during oral proceedings;
- only with the submission of this claim request at the oral proceedings, being the latest stage of the appeal proceedings, did it become clear to the appellant which aspects of the patent were of importance to the respondents;
- while the board had issued its preliminary opinion in March 2020, the respondents only reacted in April 2021 and June 2021 by filing auxiliary requests. Therefore, admittance of this claim request submitted at the oral proceedings would be unfair to the appellant;
- the argument that an amendment to overcome the Article 123(2) EPC issue would not be occasioned by a ground for opposition was not correct. Rule 80 EPC merely required an attempt to overcome a possible ground for opposition;
- the amendments to claim 1 prima facie neither overcame a lack of inventive step, nor the objections set out in the board's communication with respect to Article 123(2) EPC.

XI. The arguments of the respondents insofar as relevant to the present decision, may be summarised as follows:

Main request - Inventive step, Article 56 EPC

D1 was not a suitable starting point for the assessment of inventive step of the subject-matter of claims 1 and 5. Although it was concerned with disinfecting compositions, it was silent with regard to the purpose underlying the contested patent, namely the provision of rapid disinfection and synergy. Furthermore, the method used in D1 to test antimicrobial efficacy was obsolete.

The composition recited in claim 1, step (i) and claim 5 differed from the exemplified aqueous solution of D1 in that the latter did not directly and unambiguously disclose a composition comprising thymol and terpineol, let alone in the claimed weight ranges. Furthermore, D1 failed to disclose step (ii) of method claim 1.

Synergy and rapid antimicrobial action (15 seconds) had been demonstrated for the composition claimed. The objective technical problem was hence the provision of a method (claim 1) or a composition (claim 5) for disinfecting a surface having rapid synergistic antimicrobial action. The solution provided in claim 1 involved an inventive step.

New first auxiliary request - Admittance

This request was to be admitted into the appeal proceedings. Article 13 RPBA 2007 applied.
Furthermore

- it was in the interest of procedural efficiency that the request was submitted after the board's opinion regarding the main request in respect of inventive step was known, i.e. during oral proceedings. While document D1 was taken as closest prior art by the appellant in the statement of grounds of appeal, the opposition division had dismissed this and considered document D15 as the closest prior art; moreover, the board's communication pursuant to Article 15(1) RPBA had left open the question of which document represented the closest prior art;
- in view of the large number of independent claims and the large number of different objections raised by the appellant, it would have been difficult for the respondents to submit auxiliary requests suitable for covering each and every objection, also considering the large number of documents used as starting points for objections of lack of inventive step. In order to address this, the respondents would have had to file a large number of claim requests (e.g. potentially more than one hundred) covering all possible permutations in advance;
- no new or complex issues were raised by the new claim request; the amendments consisted merely of introducing features which were already comprised within the claims as granted. It therefore could not come as a surprise to the appellant;
- the new request prima facie overcame the objections on file concerning Articles 56 or 123(2) EPC;
- filing the request earlier would have infringed Rule 80 EPC.

Reasons for the Decision

Main request

1. Inventive step, Article 56 EPC

The contested patent relates to an antimicrobial composition for personal cleaning, oral care or hard surface cleaning applications (paragraph [0001]). Claim 1 of the main request concerns a method of disinfecting a surface which, in a first step, comprises the application of a composition comprising from 0.01 to 5% by weight thymol, 0.01 to 5% by weight terpineol, and a carrier. In a second step, the surface is rinsed with a suitable solvent or wiped with a suitable wipe.

1.1 Closest prior art

1.1.1 According to the appellant, the subject-matter of claims 1 and 5 lacked inventive step *inter alia* in view of D1 alone.

1.1.2 D1 is a pre-published patent document disclosing compositions with activity as disinfectants (D1, page 1, lines 8-10). The compositions are prepared by mixing approximately one part by weight salol with three parts by weight thymol (D1, page 1, lines 33-37). The mixture is heated to the melting temperature in the absence of a catalyst, and then cooled, whereupon it separates out as usually colourless crystals, resulting in a product composition having enhanced disinfecting properties compared with those of either of the constituents separately (page 1, lines 41-57).

Solutions of said composition may be used *inter alia* for washing walls and floors, and for all purposes in which the commonly known disinfectants or antiseptics have been employed (page 2, lines 48-55).

An example of an aqueous solution of said composition which may be prepared is provided (page 1, line 98 - page 2, line 7; claim 8) and comprises by weight:

59 parts of the crystals (i.e. the composition prepared from thymol and salol);
41 parts of terpeneol;
200 parts of turkey red oil and
200 parts of water

This solution is hereinafter referred to as "the aqueous solution".

- 1.1.3 The respondents were of the view that D1 was not a suitable starting point for the assessment of inventive step, and submitted that D15 should serve as the closest prior art. Specifically, in choosing the closest prior art, the purpose underlying the patent was to be taken into account. Although D1 concerned the technical field of disinfecting compositions, it was silent with regard to the purpose underlying the contested patent, namely the provision of rapid synergistic disinfection. Furthermore, the skilled person would not have considered D1 as a promising starting point since the "Rideal-Walker plot" relied on therein to measure antimicrobial efficacy (D1, page 1, lines 57-65) was outdated and obsolete at the effective date of the contested claims, as demonstrated by D28. Furthermore, although D1 disclosed that a disinfecting composition was prepared from a mixture of one part by weight salol with three parts by weight thymol (page 1,

lines 33-40), that the resulting composition would in fact comprise thymol at all was not unambiguously derivable from D1. Specifically, either the product could be devoid of thymol, or it could merely comprise a reaction product of salol and thymol.

- 1.1.4 The board is of the following view. When there is more than one prior art document representing a suitable starting point for the assessment of inventive step, the claimed subject-matter must involve an inventive step starting from any and all of said documents. Hence, in the present case the relevant question was not whether D15 represented the "closest" prior art as submitted by the respondents, but whether the disclosure in D1 could be considered as a suitable alternative starting point with regard to the presently claimed subject-matter.

As noted above, D1 is a pre-published patent document. It concerns aqueous solutions of compositions having activity as disinfectants, which may be used *inter alia* for washing walls and floors and is therefore part of the same technical field of application as the contested patent and discloses the same purpose. Even if it were to be accepted, as argued by the respondents, that the method used in D1 to assess antimicrobial efficacy was obsolete and outdated, this is no reason for excluding D1 as prior art under Article 56 EPC. Furthermore, the issues of whether the final composition in D1 in fact comprises thymol, and whether D1 is concerned with the provision of rapid disinfection, are not relevant to the question of whether the disclosure in D1 represents a suitable starting point. Rather, the first issue is to be addressed in establishing the distinguishing features of the claimed subject-matter over D1, while the

relevance of the second issue depends on the formulation of the objective technical problem, both subsequent steps in the problem-solution approach used at the EPO to assess inventive step.

Hence, D1 represents a suitable starting point for the assessment of inventive step. In particular, the sole specific embodiment in D1 disclosing the aqueous solution of the composition according to D1 (page 2, lines 4-7; claim 8), detailed above, represents the most appropriate starting point in D1 for the assessment of inventive step.

1.2 Distinguishing features - Claim 1

As noted above, D1 discloses an aqueous solution comprising

- 59 parts of the crystals (i.e. the composition prepared from thymol and salol);
- 41 parts of terpeneol;
- 200 parts of turkey red oil and
- 200 parts of water

1.2.1 Contested independent claim 1 is a method claim. Step (i) of the method involves applying a composition comprising

- a. 0.01 to 5% by weight thymol;
- b. 0.01 to 5% by weight terpeneol, and
- c. a carrier

to a surface.

1.2.2 According to the appellant's calculations, the aqueous solution of D1 comprised by weight 8.85% thymol and 8.2% terpeneol (statement of grounds of appeal, page 8, table).

1.2.3 The respondents did not share this view. The composition of claim 1 differed from the aqueous solution of D1 in that the latter, although comprising terpineol, did not directly and unambiguously disclose the presence of thymol. Specifically, although the "crystals" of the aqueous solution of D1 resulted from the crystallisation of a melt prepared from three parts by weight of thymol and one part by weight of salol, it could not be excluded that only one compound may have selectively crystallised from the melt, that co-crystals had formed, or indeed that a chemical reaction had taken place between thymol and salol, with the result that thymol was no longer present in the product crystals.

1.2.4 In the view of the board, these allegations do not stand up to technical scrutiny.

Firstly, the board in particular does not share the respondents' argument that the relative amount of thymol and salol crystallised from the melt may be different from the starting amounts, or even that thymol may be absent. As pointed out by the appellant, the preparation method of D1 does not involve a separation of the crystals which form from the melt. Specifically, D1 discloses that thymol and salol when mixed in the desired ratio and heated, formed a thick liquid which, on cooling, separated out in the form of transparent colourless crystals (page 1, lines 66-73). Thus there is no indication that the product crystals are devoid of thymol. To support their arguments, the respondents also referred to D25 (figure 5.51 and associated text entitled "(a) Eutectics") to argue that in melt-crystallisation, one component is likely to crystallise first (D25, associated text, steps 1 and 2). However, while the order of crystallisation may

vary as disclosed in D25, it is apparent that the final step (D25, associated text, step 3) yields a solid comprising both components. Furthermore, the figure of D1 (page 4), which plots the disinfecting powers of the "mixture", refers to the product of the melt crystallisation (i.e. the "crystals" component of the aqueous solution of D1) as comprising specific amount of thymol, the greatest disinfecting power being obtained with the desired ratio of three parts thymol to one part salol. Finally, it is also of note that the application as filed from which the present patent originated cites D1 in addressing the relevant state of the art and itself characterises the exemplified aqueous solution in D1 as comprising about 8% by weight each of thymol and terpineol (application, paragraph bridging pages 2-3).

Secondly, the respondents mentioned the possibility for co-crystal formation. However, even if such a phenomenon were to occur in said crystals, the individual molecules of salol and thymol would remain intact (i.e. in co-crystal formation, a reaction, the formation of new covalent bonds, does not take place), and would therefore be present in the product.

Thirdly, the respondents submitted that a reaction may take place between salol and thymol to provide a chemically different product, devoid of thymol. There is however no indication in D1 that this may be the case. On the contrary, D1 refers to "mixtures of crystalline substances" (page 1, line 21) and a "mixture of one part salol with three parts thymol" (page 1, line 42-43). A "mixture" cannot be equated with a reaction product. As noted by the appellant, the general temperature-composition phase diagram disclosed in D25 for two substances A and B (figure 5.51)

indicates the different phases possible depending on the composition and temperature. However, each conceivable ratio of A to B is a mixture, not a reaction product, independently of how much of one or the other substance is present. Furthermore, as mentioned by the appellant, a contrast is drawn in D1 between the process disclosed therein and that of a prior art patent disclosing a method according to which salol and thymol in the same proportions as disclosed in D1 were "caused to react" by slowly heating in the presence of a catalyst (D1, page 2, lines 93-119). It is explicitly stated that D1 does not claim anything claimed in said prior art document (D1, page 2, line 118-119). Therefore, it must be understood that the product prepared according to D1 does not result from a reaction between thymol and salol.

In view of the foregoing therefore, the "crystals" comprised in the aqueous solution of D1 (D1, page 2, lines 4-7) addressed above comprise three parts thymol and one part salol by weight. Aside from the above arguments (paragraph 1.2.3), which the board does not accept, the respondents did not dispute the appellant's calculation according to which this ratio provides by weight 8.85% thymol and 8.2% terpineol in the aqueous solution.

- 1.2.5 These concentrations are above the upper limits recited in contested claim 1. The appellant argued that D1 (page 2, lines 48-55) taught the dilution of this aqueous solution. By diluting, a composition would necessarily be prepared having the concentrations of thymol and terpineol recited in contested claim 1. With water as the (aqueous) carrier of claim 1, step (i), D1 disclosed the composition of contested claim 1, step (i).

1.2.6 The board does not find this argument convincing. Even if it were to be accepted that D1 explicitly teaches the dilution of the aqueous solution, it still lacks a direct and unambiguous disclosure of a composition comprising thymol and terpineol in the amounts by weight recited in claims 1 and 5.

The composition of claim 1, step (i) is therefore distinguished from the aqueous solution of D1 in that it discloses a lower weight percentage of thymol and terpineol.

Since D1 states that solutions of the compositions thereof may be used for washing walls and floors (page 2, lines 28-29), this also applies to the aqueous solution of D1.

Furthermore, while D1 discloses the general "washing" of wall and floors (page 2, line 49), it does not disclose the specific rinsing or wiping step of contested claim 1, step (ii).

1.2.7 The subject-matter of contested claim 1 is consequently novel, and is distinguished from D1 in that it

- concerns a process employing a composition comprising a lower amount of thymol and terpineol (0.01 to 5% and 0.01 to 5% by weight, respectively), and
- includes rinsing the surface with a suitable solvent or wiping the surface with a suitable wipe (according to step (ii) of claim 1).

1.3 Problem solved - Claim 1

1.3.1 According to the respondents, the data in the patent and the respondents' post-filed tests D20 and D26 demonstrated synergy and rapid antimicrobial action (15 seconds) for the compositions of the contested patent. On the other hand, there was no evidence or indication that synergy and rapid action would be obtained with the aqueous solution of D1. The effect of the distinguishing features outlined above was hence the obtention of rapid synergistic antimicrobial action. The resulting objective technical problem was the provision of a method for disinfecting a surface having rapid synergistic antimicrobial action.

1.3.2 According to established case law, alleged advantages to which a party merely refers, without offering sufficient evidence to support the comparison with the closest prior art, cannot be taken into consideration in determining the objective technical problem underlying the invention and therefore in assessing inventive step. In the present case, as noted by the appellant, there is no indication nor apparent technical reason why both synergy and rapid antimicrobial action would not also be displayed by the aqueous solution of D1, which comprises thymol and terpineol, albeit at a higher concentration than that recited in claim 1. Indeed, it is stated in the patent itself that at concentrations of thymol and terpineol higher than the preferred concentrations (i.e. higher than 5% by weight, respectively), the kinetics of (antimicrobial) action would not be compromised (patent, paragraphs [0019] and [0022]).

1.3.3 Consequently, the alleged effects of synergy and rapid antimicrobial action are not to be taken into account in the formulation of the objective technical problem.

1.3.4 The objective technical problem underlying the subject-matter of contested claim 1 is therefore the provision of an alternative method for disinfecting a surface.

1.4 Obviousness - Claim 1

In the view of the board, the skilled person wishing to provide a mere alternative to the aqueous solution of D1 would have considered an arbitrary variation of the concentration of thymol (comprised in the "crystals" component thereof) and terpineol in said solution and thereby would have arrived at a composition comprising a lower concentration of said compounds, as defined for the composition of contested claim 1, step (i). The skilled person would have thereby arrived at a composition comprising thymol and terpineol in the amounts recited in claim 1. The second distinguishing feature, the act of rinsing the surface with a suitable solvent or wiping the surface with a suitable wipe according to step (ii) of claim 1 was not relied on by the respondents to support inventive step. The board sees no reason why this feature would constitute anything other than a standard step which would have been carried out as a matter of course by the skilled person in the context of disinfecting a surface.

It follows that the subject-matter of contested claim 1 does not involve an inventive step (Article 56 EPC).

1.5 Independent claim 5

Claim 5 is directed to an antimicrobial composition, defined identically to that of claim 1, step (i), with the exception that it also comprises 1 to 80% by weight of an anionic surfactant as ingredient c.

As noted by the appellant, turkey red oil employed in the aqueous solution of D1 is an anionic surfactant and represents 40% by weight of said solution (statement of grounds of appeal, table on page 8). This was not disputed by the respondents.

The composition of claim 5 is consequently distinguished from the aqueous solution in D1 in the same manner as for the composition recited in claim 1, namely it comprises a lower percentage by weight of thymol and terpineol.

For the same reason as provided for claim 1, supra, the alleged effect of the distinguishing feature cannot be taken into account in the assessment of inventive step.

The objective technical problem underlying claim 5 is consequently the provision of an alternative disinfecting composition to the aqueous solution disclosed in D1.

The solution to this problem as set out in claim 5 does not involve an inventive step for the same reasons as provided for claim 1.

1.6 In conclusion, the subject-matter of both independent claims 1 and 5 does not involve an inventive step (Article 56 EPC).

The main request is consequently not allowable.

New first auxiliary request

The set of claims of the new first auxiliary request was submitted by the respondents during oral proceedings before the board.

Claim 1, the sole independent claim of this request, reads as follows:

"1. A method of disinfecting a surface comprising the steps of

(i) applying a composition comprising:

a. 0.01 to ~~5~~lesser [sic] than 0.3% by weight thymol;
b. 0.01 to ~~5~~lesser [sic] than 1% by weight terpineol,
and

c. a carrier.[sic]

on to the surface; and

(ii) rinsing the surface with a suitable solvent or wiping the surface with a suitable wipe-; and

wherein said step of rinsing or wiping the surface is carried out less than 5 minutes after the step of applying the composition on the surface" (strike through and underlined text denoting deletions and additions compared to claim 1 of the main request).

2. Admittance

The appellant requested that this request not be admitted into the appeal proceedings.

2.1 According to Article 24(1) and Article 25(3) RPBA 2020, where the summons to oral proceedings has been notified before the date of entry into force of the revised version of the RPBA on 1 January 2020,

Article 13(2) RPBA 2020 does not apply. Instead, Article 13 of the RPBA in the version valid until the date of the entry into force (RPBA 2007) continues to apply.

In the present case a first summons to oral proceedings scheduled for 2 June 2020 was issued on 25 July 2019 and properly notified to the parties. Subsequently, said oral proceedings were cancelled. A second summons to oral proceedings scheduled for 6 July 2021 was issued on 25 September 2020. Since the first and second summons had been notified before and after the date of entry into force of the RPBA 2020, respectively, the question arose during oral proceedings as to which version - Article 13(2) RPBA 2020 or Article 13 RPBA 2007 - applied to the admittance of the new first auxiliary request according to Article 25(3) RPBA 2020.

- 2.2 The board concluded that the provisions of Article 13 RPBA 2007 still applied to the admittance of the new first auxiliary request. In the board's view, the relevant date for determining the applicable provisions depends on the date of notification of the first summons to oral proceedings issued pursuant to Rule 115(1) EPC. In the present case, in view of the first summons having been issued and notified to the parties before the entry into force of the RPBA 2020, the applicable provisions are those of Article 13 RPBA 2007 (Article 25(3) RPBA 2020). While the subsequent cancellation of the originally scheduled oral proceedings had the consequence that said oral proceedings did not take place, it could not retroactively cancel the legal effects arising from the notification of the summons to those oral proceedings within the meaning of Article 25(3) RPBA 2020. Rather,

the cancellation of oral proceedings is to be seen as a subsequent and independent procedural step.

Furthermore, on the basis of the transitional provisions the applicable provisions need to be clear. It would not be in line with the general principle of legitimate expectations to be afforded by the EPO to all parties to the proceedings, and with considerations of legal certainty, if cancellations or postponements of scheduled oral proceedings had an impact on the determination of the applicable legal provisions pursuant to Article 25(3) RPBA 2020.

2.3 Pursuant to Article 13(1) RPBA 2007, any amendment to a party's case may be admitted at the discretion of the board. The discretion shall be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings, and the need for procedural economy. Additionally, Article 13(3) RPBA 2007 stipulates that amendments made after oral proceedings have been arranged shall not be admitted if they raise issues which the board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

2.4 In the present case, the claims of the new first auxiliary request were filed at the latest possible stage of the appeal proceedings, namely at the oral proceedings. The new claims were submitted in an attempt to overcome lack of inventive step, although the corresponding objection had already been raised by the appellant in the statement of grounds of appeal. The subject-matter claimed in the new first auxiliary request raised new issues which would have had to be addressed by the parties and considered by the board for the first time at the oral proceedings. The appellant could not have been reasonably expected to be

able to deal with such new issues without further preparation.

2.5 The respondents' argument that the filing of the claim request only at the oral proceedings was in the interest of procedural economy was not convincing. The requests filed up to the oral proceedings each contained a high number of independent claims. As stated by the board and the appellant during oral proceedings and not contested by the respondents, the high number of objections made by the appellant is a consequence of the high number of independent claims. Accordingly, this circumstance could not serve as a justification for submitting the claim request only at the oral proceedings. Specifically, the number of independent claims lay within the sole responsibility of the respondents in accordance with Article 113(2) EPC.

2.6 Furthermore, the fact that the board chose a different prior art as starting point for the assessment of inventive step to that selected by the opposition division, and left open the choice of closest prior art in the communication pursuant to Article 15(1) RPBA, could also not provide justification for the filing of the new claim request at the very last stage of the appeal proceedings. The objection starting from D1 as closest prior art was invoked by the appellant with the statement of grounds of appeal, and it was the respondents' responsibility to reply in a timely manner, if it had so intended, with suitable fall-back positions in the form of further auxiliary requests. The respondents had had sufficient opportunity to do so, and not only filed sets of claims of a first auxiliary request with the reply to the statement of grounds of appeal, but also of a second to seventh

auxiliary requests with letter dated 26 April 2021 and of an eighth to tenth auxiliary requests with letter dated 22 June 2021. In this context, the filing of the claims of a further auxiliary request during oral proceedings could only be seen as running contrary to procedural economy.

- 2.7 The board also did not agree with the respondents' opinion that no new or complex issues would have been raised in claim 1 of the request, and that the amendments consisted merely of introducing features which were already comprised in the claims as granted. The feature related to a time constraint, "*carried out less than 5 minutes*", although inserted from a dependent claim, appeared for the first time in the appeal procedure in an independent claim. It raised the question of whether this feature represented a limitation (explicit or implicit) over the disclosure in D1, and whether it contributed to inventive step. Furthermore, claim 1 did not constitute a true combination of granted claims since the limitation in the amounts of thymol and terpineol in claim 1 of this request were limited to the upper end of the range disclosed in granted claim 3, while the lower end of the ranges in question remained unamended from granted claim 1.
- 2.8 Whether or not the new request prima facie would have overcome objections pursuant to Articles 56 or 123(2) EPC, as submitted by the respondents, was not considered relevant by the board in light of the above considerations.
- 2.9 The board also notes that if Rule 80 EPC would have been contravened had the request been filed at an earlier stage in the appeal proceedings, as argued by

the respondents, then the same would still have applied to this request filed during oral proceedings.

- 2.10 In light of the above considerations, the board decided not to admit the new first auxiliary request into the proceedings pursuant to Article 13(1) and (3) RPBA 2007.

Further auxiliary requests

3. Inventive step, Article 56 EPC

- 3.1 Since the respective claim 5 of the first to eighth auxiliary requests is identical to claim 5 of the main request, the subject-matter of said requests lacks inventive step for the same reasons as provided for the latter, *supra*.

- 3.2 Claim 1 of the ninth auxiliary request differs from claim 1 of the main request in a limitation of the upper end of the weight ranges recited for thymol and terpineol in step (i), namely from 5% to "lesser [sic] than 0.3%" and "lesser [sic] than 1%" respectively. The respondents did not submit arguments as to why this limitation would render the claimed subject-matter inventive in comparison to the subject-matter of claim 1 of the main request. In particular, since there is no reason to believe that there is any technical effect linked to the more limited claimed ranges compared to claim 1 of the main request, the objective technical problem remains the same as provided for claim 1 of the main request, namely the provision of an alternative method for disinfecting a surface. The board considers that analogously to claim 1 of the main request, the skilled person seeking a mere alternative to the aqueous solution of D1 would have considered an

arbitrary variation of the concentration of thymol (comprised in the "crystals" component thereof) and terpineol in said solution, and would thereby have arrived at a composition comprising a lower concentration of said compounds, as defined in claim 1, step (i) of this request.

The subject-matter of claim 1 of the ninth auxiliary request consequently lacks inventive step (Article 56 EPC).

- 3.3 Claim 1 of the tenth auxiliary request differs from claim 1 of the ninth auxiliary request in the deletion of the alternative "wiping the surface with a suitable wipe" from step (ii). What remains in step (ii) is hence "rinsing the surface with a suitable solvent". The board already stated for claim 1 of the main request that the act of rinsing the surface with a suitable solvent according to step (ii) of claim 1 represents no more than a standard step that the skilled person would have carried out as a matter of course when disinfecting a surface. The same reason applies to claim 1 of this request.

The subject-matter of claim 1 of the tenth auxiliary request consequently lacks inventive step for the same reason as provided for claim 1 of the main request (Article 56 EPC).

- 3.4 That the board's conclusion in respect of inventive step for the subject-matter of the main request also applied to the subject-matter of the first to tenth auxiliary requests was not disputed by the respondents. In conclusion, none of the claim requests considered by the board in substance meets the requirements of Article 56 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated