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Datasheet for the decision of 1 February 2022

Case Number:	T 1840/19 - 3.3.06
Application Number:	11004982.2
Publication Number:	2535401
IPC:	C11D3/386, C11D3/00, C11D3/37, C11D3/04
Language of the proceedings:	EN

Title of invention:
Detergent composition comprising soil-release polymers of improved storage stability

Patent Proprietor:
Dalli-Werke GmbH & Co. KG

Opponents:
Henkel AG & Co. KGaA
The Procter & Gamble Company

Headword:
Lipase/DALLI-WERKE

Relevant legal provisions:
RPBA Art. 12(4)
EPC Art. 54

Keyword:
Late-filed facts - Facts already submitted during 1st instance proceedings
Novelty - (no) - New purpose but no new means of realisation

Decisions cited:
G 0002/88

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 1840/19 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 1 February 2022

Appellant: (Opponent 1)	Henkel AG & Co. KGaA Henkelstrasse 67 40589 Düsseldorf (DE)
Representative:	Viering, Jentschura & Partner mbB Patent- und Rechtsanwälte Hamborner Straße 53 40472 Düsseldorf (DE)
Appellant: (Opponent 2)	The Procter & Gamble Company One Procter & Gamble Plaza Cincinnatti, Ohio 45202 (US)
Representative:	Gill Jennings & Every LLP The Broadgate Tower 20 Primrose Street London EC2A 2ES (GB)
Respondent: (Patent Proprietor)	Dalli-Werke GmbH & Co. KG Zweifaller Strasse 120 52224 Stolberg (DE)
Representative:	f & e patent Braunsberger Feld 29 51429 Bergisch Gladbach (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 29 April 2019 maintaining European Patent No. 2535401 in amended form.**

Composition of the Board:

Chairman	J.-M. Schwaller
Members:	S. Arrojo
	C. Brandt

Summary of Facts and Submissions

I. Opponents 1 and 2 (the appellants) filed an appeal against the decision of the opposition division to maintain European patent No. 2 535 401 on the basis of the claims of the main request as filed on 20 March 2018.

II. In their grounds of appeal, the appellants argued that the claims as upheld by the opposition division did not comply with the requirements of novelty and inventive step, in particular because (*inter alia*) claims 1, 12 and 14 were not novel in view of document D9 (WO 00/22079).

III. In its reply, the proprietor (also respondent) argued in favour of the allowability of the patent in the form upheld by the opposition division (main request), **claims 1, 12 and 14** thereof reading:

*"**1**. A detergent composition, comprising at least one lipase, at least one soil-release polymer, comprising ester moieties, in an amount of at least 0.25 wt.-%, based on the whole composition, and at least one compound which stabilizes said at least one soil-release polymer in the presence of said lipase during storage of the composition and is selected from the group consisting of boric acid or water-soluble borates capable of forming boric acid in an amount of from more than 1 wt.-% to 5.5 wt.-%, based on the whole composition and calculated on the basis of boric acid; boronic acids or water-soluble salts thereof in an amount of from 0.001 to 1 wt.-%, based on the whole composition; formic acid or water-soluble salts thereof in an amount of from 0.005 to 0.5 wt.-%, based on the*

whole composition; lactic acid in an amount of from 1 to 10 wt.%, based on the whole composition; water-soluble salts of calcium, magnesium or zinc in an amount of from 0.01 to 100 mmol per liter of the composition or mixtures thereof, wherein the ratio of the amount of soil release polymer to the amount of lipase present in the composition (wt.-%/wt.-%) is in the range of from 10:1 to 200:1 and the ratio of the amount of the compound which stabilizes the soil release polymer to the amount of lipase present in the composition (wt.-%/wt.-%) is in the range of (i) from 100:1 to 1000:1, if said compound represents boric acid or a water-soluble borate capable of forming boric acid, calculated on the basis of boric acid, or (ii) in the range of from 1 :1 to 50:1, if said compound represents a boronic acid, a water-soluble salt thereof, formic acid or a water-soluble salt thereof."

***"12.** A method for stabilizing a soil-release polymer comprising ester moieties in a detergent composition which further comprises a lipase by combining said soil-release polymer and said lipase with a compound for stabilizing said soil-release polymer selected from the group consisting of boric acid or water-soluble borates capable of forming boric acid, boronic acids or water-soluble salts thereof, formic acid or water-soluble salts thereof, water-soluble salts of calcium, magnesium or zinc or mixtures thereof."*

***"14.** Use of a compound selected from the group consisting of boric acid or water-soluble borates capable of forming boric acid, boronic acids or water-soluble salts thereof, formic acid or water-soluble salts thereof, water-soluble salts of calcium, magnesium or zinc or mixtures thereof for stabilizing a*

soil-release polymer comprising ester moieties in the presence of a lipase."

Alternatively, the proprietor requested to maintain the patent on the basis of auxiliary requests 1 to 3 filed with this reply (corresponding to the three auxiliary requests filed during first instance proceedings), wherein claims 12 and 14 of auxiliary request 1 and claims 11 and 13 of auxiliary requests 2 and 3 correspond to claims 12 and 14 of the main request. It also requested not to admit inter alia the novelty objections from opponent 2 against claims 12 and 14 of the main request.

IV. In its preliminary opinion, the board indicated that the novelty objection against claims 12 and 14 was part of the proceedings, that claims 1, 12 and 14 of the main request were not novel in view of D9 and that auxiliary requests 1 to 3 did not meet the requirements of Article 54 EPC as they included method and use claims identical to claims 12 and 14 of the main request.

V. With a letter dated 21 January 2022, the proprietor withdrew its request to hold oral proceedings.

VI. Since in its preliminary opinion the board agreed with appellants' request to revoke the patent, and since the respondent withdrew its request to hold oral proceedings, the board is now in a position to issue a written decision without infringing the parties' right to be heard.

Reasons for the Decision

1. Novelty objection - Admittance

1.1 In its notice of opposition (page 2), opponent 2 presented novelty objections by describing the features of the three independent claims 1, 12 and 14 of the opposed patent, and arguing that "the claims of the opposed patent" (no specific number given) were not novel in view of documents D8 to D11, in particular citing some examples of these documents.

1.2 The proprietor argued that the novelty objection filed by opponent 2 against claims 12 and 14 in view of D8 to D11 was late filed and should therefore not be admitted into the proceedings. This was supported by the decision under appeal (point 4.3, last paragraph), which indicated that opponent 2 had not clearly objected the novelty of independent claims 12 and 14 in view of D8 to D11.

1.3 The board first notes that since the novelty objections at issue were filed with the grounds of appeal of opponent 2, their admittance is governed by Article 12(4) RPBA 2007, which states that the board has the discretion to disregard facts or evidence which could have been filed or were not admitted in the first instance proceedings.

In the board's view, there is no basis under Article 12(4) RPBA 2007 to disregard additional arguments for previously submitted objections. Thus, the relevant question here is not whether opponent 2 has introduced new arguments to support the novelty objections on file but whether said objection was submitted and admitted during first instance proceedings.

In this respect, it is noted that in the contested decision (§4.3) it is explicitly argued that documents D8 to D11 do not disclose a method and a use as defined in claims 12 and 14, and that (§4.4) the claims are therefore novel in view of these documents. It is thus apparent that the contested novelty objections were part of the first instance decision. As there is furthermore no indication in the minutes or in the opposed decision that the admittance of the novelty objections against claims 12 and 14 was discussed or even challenged, it follows that by deciding on the novelty of claims 12 and 14 in view of D8 to D11, the opposition division effectively admitted these objections into the proceedings, arguably because it was assumed to be implicit from the notice of opposition of opponent 2 that the cited examples in D8 to D11 were also considered to be novelty-destroying for the method and use claims 12 and 14.

Since said novelty objections against claims 12 and 14 were part of the decision under appeal, their admittance is not at the discretion of the board under Article 12(4) RPBA 2007, and they are thus part of the proceedings.

2. Main request - Novelty

The board has concluded that the requirements of Article 54 EPC are not met for the following reasons:

2.1 Document D9 (WO 00/22079 A1) discloses in its example F (table VII on page 62) a detergent formulation comprising 4.0 wt.-% boric acid, 0.01 wt.-% lipase and 1.5 wt.-% SRP2, wherein SRP2 (see page 52) is a short block polymer including ester groups.

2.2 Claim 1

2.2.1 The proprietor argued that the lipase in D9 was described on page 50 as a commercial preparation having 2.0% by weight of active enzyme. Consequently, the real active enzyme concentration in said example F was 0.0002%, (i.e. 2.0% of active lipase in the 0.01 wt.-% of the commercial lipase) so the actual SRP2:lipase and boric acid:lipase ratios in example F were respectively 7500:1 and 20000:1, which fell outside the claimed ranges.

2.2.2 The board disagrees with this argumentation, because the calculations made to estimate the concentration of active enzyme do not appear to be justified in view of the content of D9. In particular, it is not convincing that the enzyme concentrations in table VII of D9 are expressed using the weight of the commercial preparations as reference rather than the weight of the active enzyme. In this respect, it is noted that document D9 discloses (page 30, last par. to page 31, 3rd par.) the preferred concentrations of the enzymes in terms of the active enzyme, which provides a first indication that the data in table VII should also be interpreted in this way. If one follows the proprietor's interpretation, the lipase concentration of example F would fall outside the preferred range described on page 31 (i.e 0.0002% vs. the preferred range of 0.001% to 0.5%) and the enzyme concentrations of examples A, B, D, E and G in table VII would not even fall within the broadest ranges defined on pages 30 and 31 (e.g. example B would include 0.00004% lipase and 0.000064% amylase, both being under the minimum value of 0.0001% of lipase and amylase disclosed in the 2nd and 3rd par. of page 31 of D9). By contrast, when the values in table VII are considered to represent a

concentration of active enzymes, which is in-line with the reference used on pages 30 and 31 and also appears to be the more reasonable interpretation from a technical point of view, all the examples fall within the most preferred ranges described on pages 30 to 31 of D9. It is therefore manifestly apparent for the board that the enzyme percentages in table VII of D9 are expressed in terms of active enzyme concentrations, which implies that the SRP2:lipase and the boric acid:lipase ratios in example F are respectively 150:1 and 400:1, both falling within the scope of claim 1.

The board is therefore of the opinion that the subject-matter of claim 1 is not novel in view of document D9.

2.3 Claims 12 and 14

2.3.1 The proprietor argued that claim 12 at issue defined a method for stabilising a soil-release polymer, which was not anticipated by the cited documents describing a detergent composition and a method for preparing it, because the step for stabilising the polymer represented as such a limiting feature which established novelty.

Similarly, the intended purpose of the substances in the use claim 14 to stabilise the soil-release polymer was also a limiting feature following decision G 2/88. Since there was no explicit indication in the cited documents that the presence of certain components such as boric acid was intended to stabilise the soil-release polymer, claim 14 was also novel in view of the cited prior art.

2.3.2 The board disagrees with the above argumentation for the following reasons:

While it is true that both the functional aspects of a method claim and the purpose of a use claim limit the scope of protection, the proprietor failed to assess which specific limitations can be derived from such method/use features, and simply concluded that the invention was novel because the prior art did not explicitly anticipate the stabilising effect defined in those claims.

In fact, to decide whether the subject-matter of claims 12 and 14 is novel or not, it is necessary to establish which specific limitations result from the method/use features, and to subsequently assess whether such limitations are explicitly or implicitly anticipated by the cited prior art.

Claim 12 defines a method for stabilising a soil-release polymer in the presence of lipase by adding a substance selected from a group including boric acid. The stabilising effect is explained in the description of the patent, which indicates (par. [0007] and [0008]) that the invention is based on the surprising finding that said substance stabilises the soil-release polymer in the presence of lipase, an effect which appears to be associated with the inhibition of lipase in the presence of the proposed substance. This is further exemplified in several experiments of the patent (par. [0060]-[0071]) which compare detergent compositions including lipase and a soil-release polymers with and without such inhibiting substance (e.g. boric acid).

In view of the above disclosure in the patent, it is thus apparent that the step defined in claim 12 of stabilising the soil-release polymer in the presence of lipase simply involves incorporating one of the defined

substances (e.g. boric acid) to a detergent including a solid-release polymer and lipase.

In the prior art document D9, its Example 9 does not only disclose a composition including a lipase, a soil-release polymer and boric acid, but it also anticipates a boric acid concentration (4.0 wt.-%) which falls within the most preferred range of 3.0 to 5.0 wt.-% according to par. [0022] of the opposed patent.

A similar argumentation applies to the subject-matter of use claim 14, in which the purpose of stabilising the soil-release polymer simply requires adding a substance as defined in that claim to a composition including lipase and solid-release polymer. In this respect, it is noted that this issue is explicitly addressed in decision G 2/88 (see reasons 7.1 and 7.2), which indicates that when a known entity is used for a new purpose, the question to be asked is what the actual technical features of the claim are (i.e. which specific features are associated with the new purpose). Only if it can be concluded that the use involves "new means of realisation" in the form of technical steps which are not disclosed in the prior art, can the claim be considered to be novel. By contrast, if the means of realisation for achieving the new purpose is explicitly or implicitly anticipated by the prior art, then novelty cannot be established by the new use, because the novelty of the claimed invention only resides in the mind of the person carrying it out (i.e. it is subjective and not objective).

The proprietor also argued that no evidence had been presented that the cited prior art implicitly disclosed the new use/method. This is however not convincing, because, as indicated above, the only means of

realisation required to obtain the stabilising effect is the addition of a substance as defined in claim 14 to a composition including lipase and a soil-release polymer, a step which is clearly anticipated by any exemplary composition including one of the inhibiting substances such as boric acid, a soil-release polymer and lipase.

The subject-matter of claims 12 and 14 is therefore not novel in view of example F in table VII of document D9.

3. Auxiliary requests 1 to 3 - Novelty

3.1 Claims 12 and 14 of auxiliary request 1 and claims 11 and 13 of auxiliary requests 2 and 3 being identical to claims 12 and 14 of the main request, the same argumentation and conclusions presented for those claims apply to these requests, which are therefore not allowable for lack of novelty with respect to document D9.

4. It follows from the above considerations that none of the claims requests meets the requirements of Article 54 EPC and that the appeals of the opponents succeed.

Order

For these reasons it is decided that:

1. The appealed decision is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

A. Pinna J.-M. Schwaller

Decision electronically authenticated