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**Datasheet for the decision
of 6 July 2023**

Case Number: T 0276/20 - 3.3.10

Application Number: 13763352.5

Publication Number: 2890410

IPC: A61L9/03

Language of the proceedings: EN

Title of invention:

METHOD OF ALTERNATINGLY EMITTING TWO OR MORE VOLATILE MATERIALS

Patent Proprietor:

S.C. Johnson & Son, Inc.

Opponent:

The Procter & Gamble Company

Headword:

Relevant legal provisions:

EPC R. 80

EPC Art. 111(1), 84

Keyword:

Amendment occasioned by ground for opposition - (yes)
Remittal (no)
Claims - clarity (no)
No objective surprise of the proprietor caused by the
examination of clarity absent a pointer in the board's
communication

Decisions cited:

Catchword:



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Case Number: T 0276/20 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 6 July 2023

Appellant: S.C. Johnson & Son, Inc.
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Respondent: The Procter & Gamble Company
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 25 November
2019 revoking European patent No. 2890410
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chair P. Gryczka
Members: R. Pérez Carlón
T. Bokor

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the opposition division's decision revoking European patent No. 2 890 410.
- II. In the notice of opposition, all grounds set out in Article 100 EPC were invoked.
- III. The opposition division concluded that the claimed invention was sufficiently disclosed for it to be carried out by a skilled person. The method of claim 1 of the patent as granted was however not novel.

All other requests then pending were not allowable under Rule 80 EPC, as the features in the form of a result to be achieved "such that a first base room concentration is achieved" in step (c) and "such that a second base room concentration is achieved" in step (f) of claim 1 did not change the scope of the claimed subject-matter and could not be occasioned by a ground of opposition.

- IV. At the end of the oral proceedings before the board, which took place on 6 July 2023, only those requests were maintained that were filed in appeal as auxiliary request 2, 7 and 6, in this order.

Claim 1 of auxiliary request 2 reads as follows:

*"A method of alternately emitting two or more volatile materials, the method including the steps of:
(a) activating a first heater (152a) to emit a first volatile material;*

- (b) *emitting the first volatile material for a first time period of time including the steps of: during a first portion of the first time period, emitting the first volatile material such that a first primary room concentration is achieved; and during a second portion of the first time period, emitting the first volatile material such that a first secondary room concentration is achieved; wherein the first secondary room concentration is less than the first primary room concentration and the first secondary room concentration occurs after the first primary room concentration;*
- (c) *deactivating the first heater (152a) such that a first base room concentration is achieved;*
- (d) *activating a second heater (152b) to emit a second volatile material; and*
- (e) *emitting the second volatile material for a second time period of time including the steps of: during a first portion of the second time period, emitting the second volatile material such that a second primary room concentration is achieved; and during a second portion of the second time period, emitting the second volatile material such that a second secondary room concentration is achieved; wherein the second secondary room concentration is less than the second primary room concentration and the second secondary room concentration occurs after the second primary room concentration;*
- (f) *deactivating the second heater (152b) such that a second base room concentration is achieved; and*
- (g) *repeating the steps of (a) through (f).*

wherein: the room concentration of the first volatile material peaks at the first primary room concentration and trends downwardly until the first secondary room concentration at the point where the first heater

(152a) is deactivated; and the room concentration of the second volatile material peaks at the second primary room concentration and trends downwardly until the second secondary room concentration at the point where the second heater (152b) is deactivated;

wherein a variance between the first primary room concentration and the first base room concentration is between 1.6 mg/m³ and 6.0 mg/m³ or a variance between the second primary room concentration and the second base room concentration is between 1.6 mg/m³ and 6.0 mg/m³; and wherein prior to repeating the steps of activating the first heater, a room concentration of the first volatile material is reduced to a level of between 0 and 0.4 milligrams per cubic meter and, prior to repeating step (d), a room concentration of the second volatile material is reduced to a level of between 0 and 0.4 milligrams per cubic meter."

Claim 1 of auxiliary request 7, filed two days before the oral proceedings in appeal, has all the features of claim 1 of auxiliary request 2 and, in addition, requires the volatile materials to be fragrances and the first and second time periods to be greater than or equal to 10 hours.

Claim 1 of auxiliary request 6 lacks the feature of claim 1 of auxiliary request 2 requiring the variance between the corresponding primary and base room concentrations to be within a threshold set. It also lacks the feature requiring the room concentration of one volatile material to be reduced to a set level before the heater of the other volatile material is activated. It requires the first and second time

periods to be greater than or equal to 25 hours.

V. The appellant's arguments were as follows.

The amendments in claim 1 of all the requests on file sought to circumvent the grounds for opposition raised and were thus not objectionable under Rule 80 EPC.

The opposition division had not examined the substantive issues concerning any of the requests in appeal. If the board would overturn the objection under Rule 80 EPC, the file should be remitted to the opposition division for further examination.

As the respondent (opponent) had implicitly withdrawn its objection on lack of clarity raised in its written submissions, the board was not empowered to examine that issue.

The feature "base room concentration" defined the lowest concentration at the end of each cycle defined in claim 1. A base room concentration was required in order to provide an antecedent for the feature of claim 1 of auxiliary requests 2 and 7 limiting the variance between the primary room concentrations and the base room concentrations. This was clear to a skilled reader.

Claim 1 of auxiliary request 6 did not include the feature limiting the variance between the primary and the base room concentrations. For that reason, any lack of clarity which could be linked to the determination of that variance was absent from claim 1 of said request. As claim 1 required the total length of the emission cycle to be of 25 hours or more, any issue which could be linked to the definition of the term

"base room concentration" in the higher ranked requests was solved too.

VI. The respondent's arguments were as follows.

Rule 80 EPC required an amendment to be an attempt to overcome a ground for opposition. This was not the case for the amendments in any of the request on file.

The case should not be remitted to the opposition division. The opposition division's decision contained its reasoning and conclusion on a number of issues which should be reviewed by the board. The appellant only sought to prolong the proceedings.

The respondent had not withdrawn at the oral proceedings its objection on lack of clarity raised in its written submissions. The feature "base concentration" could not be determined and was thus unclear. For this reason alone, none of the appellant's requests was allowable.

VII. The board informed the parties in a communication dated 7 May 2021 that in view of the written arguments it considered auxiliary request 6 not admissible. It was of the preliminary view that none of the requests before it was allowable.

VIII. The parties' final requests were as follows:

The appellant requested that the decision under appeal be set aside, and that the case be remitted to the opposition division for further examination on the basis of the following requests, in that order:
- second auxiliary request filed with the grounds of appeal, corresponding to the third auxiliary request

before the opposition division,
- seventh auxiliary request filed with a letter dated 4 July 2023,
- sixth auxiliary request filed with a letter dated 22 January 2021 and corresponding to the fifth auxiliary request before the opposition division.

The respondent requested that the appeal be dismissed.

IX. At the end of the oral proceedings, the decision was announced.

Reasons for the Decision

1. The appeal is admissible.
2. Rule 80 EPC
 - 2.1 Rule 80 EPC allows amendment of a European patent, provided that the amendment is occasioned by a ground for opposition under Article 100 EPC.
 - 2.2 The opposition division concluded that the features of claim 1 of the requests corresponding to the second and sixth auxiliary requests in appeal "such that a first base room concentration is achieved" in step (c) and "such that a second base room concentration is achieved" in step (f) contravened the requirements of Rule 80 EPC. These requests were for that reason not allowable.

The opposition division reasoned that these features merely gave a name to the concentration which would inevitably have been achieved once the heater was deactivated. The claimed method of emitting volatile materials was however not influenced by this definition

so that the scope of the claimed subject-matter did not change. An amendment which did not change the scope of the claimed subject-matter could not have been occasioned by a ground of opposition.

2.3 The respondent argued that these features were only a further description of the claimed subject-matter which did not limit its scope. The threshold for complying with Rule 80 EPC was higher than simply including new language in a claim: the amendments must be capable of addressing a ground of opposition. This was not the case of the amendments in claim 1, which sought to clarify the claims by the appellant's own argument (see point 4.1 of the minutes of the oral proceedings before the opposition division).

2.4 Rule 80 EPC does not require an amendment to successfully overcome a ground for opposition; it merely requires the amendment to be occasioned by a ground for opposition, which the board interprets to require at least a bona fide attempt to overcome a ground of opposition, i.e. where it appears at least plausible that the amendment may well change the claim scope and thus may potentially address objections under one or more grounds for opposition.

According to point 4.1 of the minutes of the oral proceedings before the board, the appellant also argued that the features added to claim 1 implied a limitation of the time periods required by the claimed method. The amendment was thus an attempt to limit the claimed subject-matter by limiting the time periods required by the claim. By requiring the concentration of the volatile materials emitted to achieve the corresponding "base room concentration" and allegedly limiting the activation and deactivation time periods, the features

added to claim 1 arguably sought to overcome the numerous grounds for opposition raised against the patent. The board considers that this argument, namely that the amendment indeed limits the claim scope, cannot be dismissed as manifestly unfounded. Requiring the proprietor to effectively address a ground of opposition already during the application of Rule 80 EPC would render further examination of the ground of opposition in question practically superfluous. For these reasons, the board holds that the amendment is not objectionable under Rule 80 EPC.

3. Request for remittal

3.1 The appellant requested at the oral proceedings before the board that, if the board would overturn the opposition division's conclusion on Rule 80 EPC, that the case be remitted to the opposition division for further examination of all substantive issues. The respondent objected to a remittal.

3.2 The appealed decision not only dealt with the issue of Rule 80 EPC. It also contained the opposition division's conclusion on other issues such as sufficiency of the claimed invention's disclosure and novelty of the method of claim 1 of the patent as granted. The primary purpose of an appeal is to review the substantive findings of the impugned decision, which implies that the board normally examines at least those issues on which the opposition division rendered a reasoned decision, as far as applicable to the subject-matter of the requests in appeal.

3.3 The board thus rejects the proprietor's request for a remittal for the examination of all substantive issues

beyond the requirements of Rule 80 EPC.

4. Clarity under Article 84 EPC

4.1 It was undisputed that claim 1 of all the request on file included the feature "such that a first base room concentration is achieved" and "such that a second base room concentration is achieved", which were in none of the claims as granted.

4.2 The respondent did not explicitly withdrew that objection, neither in writing or at the oral proceedings before the board. When asked in the context of the second auxiliary request at the oral proceedings before the board which were its objections, the respondent in a first step only relied on its objections of insufficient disclosure and lack of inventive step.

4.3 The appellant argued that, since the respondent did not reiterate its objection on lack of clarity, it had implicitly withdrawn it. The objection was thus no longer part of the appeal proceedings and the board should refrain from examining it.

4.4 The respondent did not explicitly withdraw its objection of lack of clarity. The issue is whether its objection could have been nevertheless withdrawn by not reiterating it at the oral proceedings.

4.5 The respondent argued in writing that claim 1 of the first auxiliary request then pending was not clear (page 17 of the reply to the grounds of appeal), and that the objection also applied to claim 1 of the second auxiliary request (page 20, third full paragraph). It is true that the objections relating to

clarity were not repeated in the respondent's observations of 16 September 2021, but there was nothing in them that could have been interpreted as a withdrawal of those objections. It therefore remains that, at the beginning of the oral proceedings, the proprietor must have been prepared for a possible discussion of those objections in the course of the oral proceedings.

Even if the respondent would not have added anything to its written submissions during the oral proceedings, the objection of lack of clarity of amendments which only finds a basis in the originally filed description is part of the appeal proceedings. Under these circumstances the board is not only empowered but in fact obliged to examine it. The board is certainly aware of the settled case law that lack of clarity under Article 84 EPC is not a ground for opposition and normally cannot be invoked against features of granted claims (G 3/14). However, the issue of clarity under Article 84 EPC is practically inseparable from the interpretation of the claims, this latter being an inherent task of the board and without which the examination for any ground of opposition is hardly possible. Since in the present case the board decided to examine the claims for at least some of the grounds for opposition, as explained in point 3 above, it also considers it appropriate to examine clarity under Article 84 EPC before proceeding to examine other issues.

- 4.6 The appellant also argued that it had been caught by surprise by the relevance of the issue of lack of clarity, in particular as the board's communication had been silent on it.

The board's communication in preparation for oral

proceedings conveyed the preliminary view of the board that some of the requests then pending, including auxiliary request 6, were not admissible and that none of the requests then pending were allowable, including auxiliary requests 2 and 6. In such a situation, the board did not see the need to discuss other objections which could also have led to the same preliminary conclusion. The board gave no preliminary view on auxiliary request 7, filed only two days ahead of the oral proceedings before it.

A board's communication does not render moot any of the parties' arguments it does not discuss. The communication provides a preliminary view which might help the parties to evaluate their chances of success and help them to prepare for the oral proceedings by showing whether their arguments have been properly considered. A party cannot, however, rely on the fact that an issue has not been taken up by the board in its communication for concluding that it is irrelevant.

This argument of the appellant is thus not convincing. The appellant could not have been objectively surprised by the discussion on clarity, also for the reasons set out in point 4.3 above.

- 4.7 The evaporation of each volatile material requires the corresponding heater to be activated and a first primary room concentration to be achieved, to peak and to trend downwardly to a first secondary room concentration. The heater is then deactivated and a "first base room concentration" must be achieved.
- 4.8 The feature "first base room concentration" was not in the claims of the patent as granted and its clarity is

open to examination following G 3/14.

- 4.9 The term "first base room concentration" can be considered to relate to a number of different concentrations. It could relate to a pre-defined concentration. It could mean exactly zero. It could be any concentration below the so-called first secondary room concentration. It could be the concentration at the point in time subsequent to turning the first heater off. It could also be that immediately before the second heater is activated. Claim 1 does not exclude that it is achieved after the second heater is activated. All these meanings are valid interpretations of that feature; each of them leads to different subject-matter being encompassed by the claimed method.

For example, a skilled person emitting two volatile materials by turning on a first heater, achieving a room concentration of 7 ppm, which subsequently decreases (this is inevitable by the appellant's own argument), and turns off the heater to let the concentration fall to 5 ppm, and repeats the cycle with a second material, would not know whether they were working within or without the ambit of the claimed invention, as they could not know whether 5 ppm were or were not the "base" room concentration required by claim 1.

As the meaning of the feature "such that a first base room concentration is achieved" is ambiguous, claim 1 of the requests on file is not clear (Article 84 EPC).

- 4.10 The appellant argued that the feature "base room concentration" defined the minimum concentration which could be achieved, as shown by figures 12 and 13 of the patent. Claim 1 as granted defined the "primary" room

concentration as that at which the concentration peaks. The "secondary" room concentration was lower than the "primary"; "base" was the concentration immediately before the heater was turned on again. The base room concentration was the inevitable consequence of a gap between deactivating one heater and activating the next and in fact defined the length of that gap.

However, claim 1 does not require any gap, as the activation of the second heater and the deactivation of the first can take place simultaneously. For this reason alone, the appellant's argument is not convincing.

In addition, the base room concentration could have been achieved not only at the time of activating the second heater, but also before or after. Claim 1 does not require any specific sequence of steps in this respect. Figures 12 and 13 relate to the embodiment in which only one volatile material is emitted: they do not indicate when the second heater is to be activated.

Lastly, even if the so-called base room concentration were to translate into the length of a gap between deactivating the first heater and activating the second, there is no indication in the claim of how long the gap must be and it cannot be related to a base room concentration which in any case remains to be defined.

The appellant's argument in this respect is thus not convincing.

4.11 The appellant argued that the issue was different for claim 1 of auxiliary request 6, which did not limit the variation between the different room concentrations and defined the total length of the emission cycles (25

hours or more).

However, the time periods required to last 25 hours or more are the so-called first and second time periods: those during which the heater is activated. The base room concentration is not inevitably achieved during that period, it could have been achieved later too.

Like in the other requests, the alleged gap between steps (c) and (d), i.e. between deactivation of the first heater and activation of the second, is not defined in claim 1 and is in fact not even required.

Thus, the issues in determining whether the concentration of the first volatile material had arrived to the base room concentration or not are the same as with respect to the other two requests on file.

4.12 For these reasons, the board concludes that the subject-matter of claim 1 of all pending requests lacks clarity within the meaning of Article 84 EPC, and that the requests are therefore not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated