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Aktenzeichen / Case Number / N^o du recours : T 228/85

Anmeldenummer / Filing No / N^o de la demande : 79 302 653.5

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 011 984

Bezeichnung der Erfindung: A thixotropic abrasive liquid scouring composition
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : C09K 3/14

ENTSCHEIDUNG / DECISION

vom / of / du 2 June 1987

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

S.C. Johnson & Son, Inc.

Einsprechender / Opponent / Opposant : Henkel KGaA

Stichwort / Headword / Référence : "Abrasive compositions"

EPO/EPC/CBE Art. 83, 56, 100(a) and (b), 123(2) and (3) EPC

Kennwort / Keyword / Mot clé : "Insufficiency of disclosure - Experimental evidence"
"Amendment - In consequence of insufficiency"
"New claim - Added in opposition procedure"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Beschwerdekammern

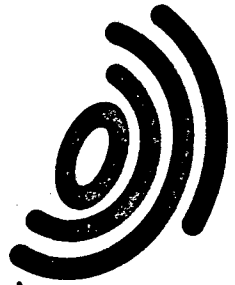
European Patent
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Boards of Appeal

Office européen
des brevets

Chambres de recours

Case Number : T 228/85



DECISION
of the Technical Board of Appeal 3.3.2
of 2 June 1987

Appellant :
(Opponent)

Henkel KGaA
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Representative :

Respondent :
(Proprietor of the patent)

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Representative :

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Decision under appeal :

Decision of Opposition Division of the European
Patent Office dated 28 June 1985 rejecting
the opposition filed against European patent
No. 0 011 984 pursuant to Article 102(2) EPC.

Composition of the Board :

Chairman : P. Lançon
Member : G. Szabo
Member : E. Persson

Summary of Facts and Submissions

I. European patent No. 11 984 was granted on 24 August 1983 with four claims in response to the European patent application No. 79 302 653.5 filed on 21 November 1979 claiming the priority of the earlier application of 29 November 1978. Claims 1 and 4 were worded as follows:

"1. A stable, liquid abrasive cleaning composition comprising:

- (a) from 1 to 60% by weight of a water insoluble particulate abrasive;
- (b) from 0.1 to 10% by weight of a bleach;
- (c) from 0 to 20% by weight of a non-multivalent-stearate surfactant;
- (d) from 0 to 10% by weight of an electrolyte, with the proviso that the composition contain at least some electrolyte or some non-multivalent stearate surfactant;
- (e) from 0 to 25% by weight of a light density filler;
- (f) from 0.05 to 10% by weight of a multivalent stearate soap selected from aluminium monostearate, aluminium distearate, aluminium tristearate, calcium stearate, zinc stearate, magnesium stearate, barium stearate or mixtures thereof; and
- (g) water.

4. The composition of Claim 1, 2 or 3 wherein the light density filler is present in an amount of 5 to 20% by weight."

II. The Appellant (Opponent) filed an opposition against the grant of the patent on 2 May 1984 on grounds of lack of inventive step and of disclosure.

III. The Opposition Division rejected the opposition in a decision dated 28 June 1985. According to the decision all exemplified compositions of the patent contained a water soluble tenside and an electrolyte, but the disclosure also specified the conditions under which only one of these components may be used. Thus no insufficiency in this respect could be recognised. The composition of the patent contained a metallic soap, component (f), in order to regulate thixotropy. Thus the substantial replacement of the light density filler, which was essential in the prior art, by the metallic soap appeared to be inventive.

IV. The Appellant filed a notice of appeal against the decision on 4 September 1985, the appropriate fee being paid on the following day. The notice was accompanied by a Statement of Grounds and by evidence concerning the question of sufficiency. The Respondent filed some experimental evidence and replaced the original main claim by an amended claim and introduced a new dependent Claim 2 as well as an appropriately adapted description at an oral hearing that took place on 2 June 1987. Claims 1 and 2 now read as follows:

"1. A stable, liquid abrasive cleaning composition comprising:

- (a) from 1 to 60% by weight of a primary water insoluble particulate abrasive;
- (b) from 0.1 to 10% by weight of a bleach;
- (c) from 0.1 to 20% by weight of a non-multivalent-stearate surfactant;
- (d) from 0.1 to 10% by weight of an electrolyte;
- (e) from 0 to 25% by weight of a light density filler;

(f) from 0.05 to 10% by weight of a multivalent metal stearate soap selected from aluminium monostearate, aluminium distearate, aluminium tristearate, calcium stearate, zinc stearate, magnesium stearate, barium stearate or mixtures thereof;

(g) from 0 to 5% by weight of a bodying agent; and

(h) water;

with the proviso that the composition contain up to 5% by weight of a bodying agent or from 5 to 20% by weight of an absorbant abrasive, unless from 5 to 25% by weight of light density filler is present.

2. A composition according to claim 1 containing either the bodying agent or the absorbant abrasive."

V. The Appellant submitted in the proceedings and at the oral hearing inter alia the following arguments:

(a) In addition to the essential features already listed in the original claim, the necessity of using both an electrolyte and a tenside in the formulation was demonstrated by the Examples in the patent as well as by the evidence presented in the proceedings. As soon as one of these components was dropped the stability disappeared. Thus the original disclosure was insufficient to provide the claimed subject-matter (Article 83 EPC).

(b) It was also apparent from the same Examples and evidence that the presence of a bodying agent, an absorbant abrasive or a light density filler was essential. Although the invention, allegedly, represented a replacement of the filler, an essential feature of the relevant prior art, with a multivalent stearate soap, the emphasis on at least 5% filler in the subsidiary Claim 4 of the granted patent suggested

that significant amounts of such component were still needed, at least in the absence of a bodying agent or abrasive. The amended main claim, eliminating embodiments which did not comply with these conditions, would nevertheless be acceptable.

- VI. The Respondent submitted that the amended claims satisfied all requirements. It should be acceptable that an optional feature in the main claim be rendered obligatory, and restricted by taking a value from a preferred range disclosed in the specification instead of incorporating the even narrower range from former Claim 4.
- VII. Having requested the revocation of the patent as granted, the Appellant agreed to the maintenance of the patent in amended form as submitted by the Respondent at the oral proceedings. The Respondent requested that the appeal be dismissed and that the patent be maintained on the basis of the description and claims submitted at the oral proceedings.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. There can be no formal objections to amended Claim 1 and to new Claim 2, since these are adequately supported by the original documents. Features (b), (e), (f) and (g) of the originally filed Claim 1 remain unchanged ((g) now shown as (h)), and (c) and (d) have both become obligatory in view of the new lower limits (cf. p. 4, line 31 and 45).

The new limitations are also supported by the description (cf. p. 3, lines 23-25, and p. 4, lines 46-50, line 56 and former Claim 4). It is permissible to limit ranges by lowering one end-point to the value of a corresponding end-point of a narrower range (cf. T 2/81, "Methylenebis-(phenylisocyanate)", OJ 10/1982, 394, at 398, and Headnote 2). Feature (a) is clarified on the basis of p. 3, line 27, and new feature (g) comes p. 4, lines 46-50. The optional incorporation of a light density filler (0 to 25%) is now further limited to 5 to 25% in the main claim on the basis of the description (p. 4, line 56) in cases when neither a bodying agent nor an absorbant abrasive is incorporated. Claim 2 relies on p. 3, lines 23 to 26 and both claims and the corresponding amendments in the description comply therefore with Article 123(2) and (3) EPC.

3. Whilst amendments in opposition proceedings always require consent, it is the view of the Board that it would be normally improper to use such procedure to tidy up and deepen the claim system with a new subsidiary claim, which could in effect result in an extension of the examination procedure (cf. Enlarged Board of Appeal Gr 01/84, "Opposition by proprietor", OJ 10/1985, 299 at p. 304, Point 9). In the present case, the relevance and importance of the subject-matter of new Claim 2 only emerged in consequence of insufficiency associated with the absence of the particular features in the main claim. As a further limitation, Claim 2 renders the bodying agent or absorbent abrasive obligatory, irrespective of the presence or absence of the light density filler as an alternative, and relies on the preference already emphasised in the specification. It is, therefore, the view of the Board that in cases of insufficiency affecting certain areas in the claim involving some difficulty in recognising the exact boundaries of such deficiency, the patentee may be allowed,

in addition to restricting his main claim, to supplement and consolidate his position, strictly in the light of available evidence, by adding a new subsidiary claim, provided that there is no abuse of the opportunity involved. Such a claim, based on a properly supported further restriction of an otherwise acceptable amended main claim represents no extension of the protection conferred (cf. Article 123(3) EPC) on account that something is claimed "which has not been claimed" before. All embodiments of the new Claim 2 are within the scope of the earlier claim and relate to the same kind and category of entities.

4. The main issue was that of insufficiency, i.e. a matter concerned with Article 83 EPC. Thus the propriety of the scope of the amended claims is consequential to this issue, i.e. raised under Article 100(b) EPC and not a matter arising from Article 84 EPC on the clarity and support for claims which is not itself objectionable in opposition proceedings. The question is whether or not the amendments eliminated any justifiable concern about the adequacy of disclosure, if any. The Board has the task of examining the amended main claim from this point of view.

5. The Examples in the patent demonstrate the invention with 10 specific formulations. It has not been suggested that these compositions were not providing the necessary stability which was the aim of the invention and a characteristic of the claims referring to a "stable... composition". It is, however, apparent that all examples use a combination of electrolyte and tenside. The evidence submitted by the Appellant showed that whenever the composition omitted either the electrolyte or the tenside (six instances) this led to a loss of stability. It was

also demonstrated that the removal of all three further ingredients, hitherto considered optional, i.e. bodying agent, absorbent abrasive and light density filler, had also been correlated with instability. In view of the facts that the specification emphasises the equivalency of using a bodying agent or absorbent abrasive (cf. p. 3, lines 23-26) and that the Respondent has shown that a light density filler can replace either of them, the necessity of obtaining satisfactory results with only one of them present, is convincing. This is in spite of a single negative result with a light density filler presented by the Appellant (3b). Notwithstanding this, the Appellant himself has also agreed that any one of the three further component resolves the problem of insufficiency in this respect. The new claim restricted to this condition is therefore also acceptable to the Board as the broadest definition generally consistent with the available evidence. The further restriction to the bodying agent or absorbent abrasive, to the exclusion of the light density filler, in new Claim 2 is also justifiable in these circumstances.

6. As regards the alleged lack of inventive step, the Appellants mentioned this in their Notice of Appeal but omitted to submit a Statement of Grounds in this respect. In any case the reasoning of the first instance is applicable and extensible to the narrower version, in as much as the subject-matter still represents a full or partial replacement of the earlier filler as an essential feature, with various combinations of features, all including the multivalent soap. The patent is therefore to be maintained in the restricted form as having a sufficient disclosure and claims which involve an inventive step.

Order

For these reasons it is decided that:

1. The decision of the Opposition Division is set aside.
2. The case is remitted to the first instance with the order to maintain the European patent on the basis of amended claims and description submitted at the oral proceedings.

The Registrar:

The Chairman:

F.Klein

P.Lançon