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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 227/88 - 3.3.2



D E C I S I O N of 17 March 1989
correcting errors in the decision
of the Technical Board of Appeal 3.3.2
of 15 December 1988

Appellant :
(Proprietor of the patent) UNILEVER PLC
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Representative :
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Patents Division
P.O. Box 68
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Respondent :
(Opponent) Henkel
Kommanditgesellschaft auf Aktien
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Representative :

Decision under appeal : Decision of Opposition Division of the European
Patent Office dated 8 April 1988 revoking
European patent No. 0 070 191 pursuant to
Article 102(1) EPC.

Composition of the Board :

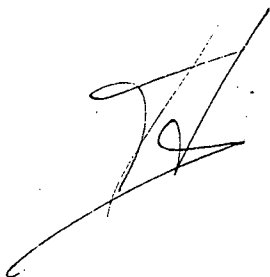
Chairman : Lançon P.

Members : Nuss A.J.

Stephens-Ofner J.

In application of Rule 89 EPC, the Decision given on 15 December 1988 is hereby ordered to be corrected on page 3 in that under (ii) in paragraph IV, the definition of y, which the Appellant had obviously omitted by mistake, is indicated by inserting "y is hydrogen or a solubilising cation" as second last line of the page.

The Registrar:

A handwritten signature in black ink, appearing to be a stylized 'R' or similar character, located below the Registrar's name.

The Chairman:

A handwritten signature in black ink, appearing to be a cursive name, located below the Chairman's name.

Veröffentlichung im Amtsblatt	Jn/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N° du recours : T 227/88 . 3.3.2

Anmeldenummer / Filing No / N° de la demande : 82 303 675.1

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 070 191

Bezeichnung der Erfindung: Detergent additives and detergent compositions
Title of invention: containing them
Titre de l'invention :

Klassifikation / Classification / Classement : C11D 3/12

ENTSCHEIDUNG / DECISION

vom / of / du 15 December 1988

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet : Unilever PLC et al

Einsprechender / Opponent / Opposant : Henkel KGaA

Stichwort / Headword / Référence : Detergent compositions/UNILEVER

EPÜ / EPC / CBE Art. 56, 102(3), Rule 55(c) EPC

Schlagwort / Keyword / Mot clé : "Inventive Step (yes)" - "amendments in response to opposition - more substantial than strictly necessary - power of Opposition Division and Board of Appeal to deal with issues following therefrom although not specifically pleaded"

Leitsatz / Headnote / Sommaire

I. In all cases in which amendments are requested by the patentee and are considered to be free from objection under Article 123 EPC, Article 102(3) EPC confers upon the Opposition Division and the Board of Appeal jurisdiction, and thus the power, to decide upon the patent as amended in the light of the requirements of the Convention as a whole. This jurisdiction is thus wider than that conferred by Articles 102(1) and (2) EPC, which expressly limit jurisdiction to the grounds of opposition mentioned in Article 100 EPC.

II. When substantive amendments are made to a patent within the extent to which the patent is opposed, both instances have the power to deal with grounds and issues arising from those amendments even though not specifically raised by an opponent pursuant to Rule 55(c) EPC (cf. point 3 of the Reasons; following T 9/87 Zeolites/ICI, 18 August 1988, to be published in OJ EPO).

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D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 15 December 1988

Appellant :
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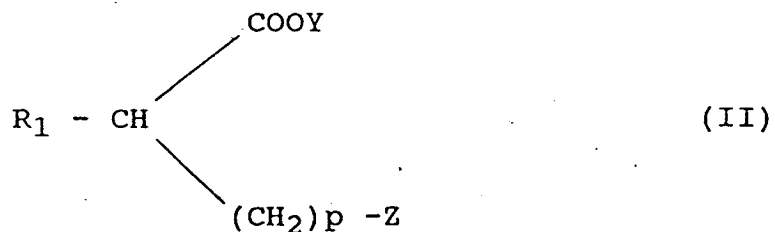
Summary of Facts and Submissions

- I. European patent No. 0 070 191 was granted on 4 December 1985 on the basis of 18 claims pursuant to European patent application 82 303 675.1 filed on 13 July 1982 which claimed the priority of a previous application dated 15 July 1981.
- II. The Respondent (Opponent) filed notice of opposition against the European patent on 25 August 1986, requesting revocation of the patent on the grounds that its subject-matter lacked both novelty and inventive step, and also for insufficient disclosure.

However, it was clearly stated in the notice of opposition that merely Claims 1, 2, 8 to 17 were the subject of the opposition, and then only as far as these claims covered detergent compositions which contained α -sulphocarboxylic acid di-salts as an organic precipitant builder and which, in particular, corresponded to the formula II of Claim 2 in which Z meant SO_3Y and p is zero (cf. page 1, last paragraph and page 6, third paragraph of the letter received on 25.8.86).

Dependent Claim 2 dealing with the precipitant builder was worded as follows:

2. A detergent composition as claimed in Claim 1, characterised in that the organic precipitant builder is a compound of the formula II



wherein R_1 , Y and Z have the meanings given in Claim 1, and p is 0 or 1.

- III. The Opposition Division revoked the patent in a decision of 8 April 1988. The reason for the revocation was that the subject-matter of Claim 1 did not involve an inventive step. The decision was based on the three most relevant documents from those cited by the Respondent, from which now, only document GB-A-1 473 201 (3a) is considered relevant for the present decision.

Under point 5 of the Reasons for the Decision, the Opposition Division pointed out that there were no objections against a combination of (dependent) Claim 2, 4, 5 or 6 with Claim 1.

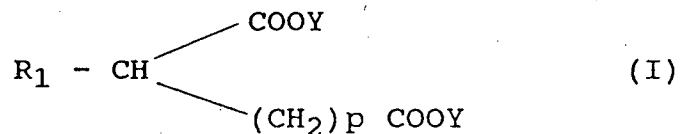
- IV. The Appellant (Proprietor of the Patent) filed a notice of appeal on 27 May 1988. The appeal fee was paid at the same time. A Statement of Grounds of Appeal was filed in due time, i.e. on 8 July 1988. Referring to the indication of the Opposition Division already mentioned above, the Appellant filed, together with this statement, a revised set of eight claims.
- V. In answer to this, the Respondent pointed out in his letter received on 1 October 1988 that the opposition only concerned detergent compositions containing sulpho-carboxylic acid di-salts, which were, however, not covered by the new claims. The Respondent also consented to the claims at present on file, if no further claims, broader than the new ones, were submitted by the Appellant.

VI. In view of the above, therefore, the Appellant and the Respondent de facto have the same request, i.e. that a patent be maintained on the basis of the amended set of claims submitted by the Appellant on 8 July 1988.

Amended Claim 1 reads as follows:

1. A detergent composition comprising from 3 to 90% by weight of one or more detergent active agents, and from 10 to 97% by weight of a builder component consisting essentially of a crystalline or amorphous aluminosilicate cation-exchange material and a supplementary precipitant builder, characterised in that the builder component consists essentially of:

- (i) from 25 to 97% by weight, based on the builder component, of the aluminosilicate cation-exchange material, and
- (ii) from 3% to 75% by weight of an organic precipitant builder having the formula I



wherein:

R₁ is a C₁₀-C₂₄ alkyl, alkenyl, arylalkyl or alkylaryl group;

* Y is hydrogen or a solubilising cation
and p is 0 or 1.

→ see correction

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. Amended Claims 1 to 8 raise no objections on formal grounds.

The scope of present Claim 1 in comparison with that of the granted one is substantially restricted by limiting the organic precipitant builder (I) to compounds of one specific type, i.e. to those which correspond to original formula (II) in which, however, Z is limited to COOY and the other possible alternative for Z (i.e. SO₃Y) is deleted. Thus, the main claim no longer covers organic precipitant builders which are derived from α -sulphocarboxylic acids. These amendments obviously find their support in both Claims 1 and 2, as well as in Claims 3 and 4, as granted.

The dependent claims correspond to previous Claims 3, 4, 8 and 15 to 18 which had been renumbered as new Claims 2 to 8.

The amended claims therefore comply with Article 123(2) and (3) EPC.

3. The main claim having been amended, it is necessary to consider its validity in accordance with Article 102(3) EPC. In all cases in which amendments are requested by the patentee and are considered to be free from objection under Article 123(2) EPC, Article 102(3) EPC confers upon the Opposition Division and the Board of Appeal jurisdiction, and thus the power, to decide upon the validity of the patent as amended in the light of the requirements of the Convention as a whole. This jurisdiction is thus wider than

the jurisdiction conferred by Articles 102(1) and (2) EPC, which expressly limit jurisdiction to the grounds of opposition mentioned in Article 100 EPC. When substantive amendments are made to a patent within the extent to which the patent is opposed, both instances have the power to deal with grounds and issues arising from those amendments even though not specifically raised by an opponent pursuant to Rule 55(c) EPC (following T 9/87, "Zeolites/ICI", 18 August 1988, to be published in OJ EPO).

4. The abovementioned power must, however, be exercised in a manner that takes full account of the conflicting interests of two relevant sections of the patent community, namely, the patentee's need to have an opposition proceedings decided as swiftly as the procedure allows, and the certainty of other users or potential users of the inventions, the subject of European patents, that such patents are legally valid and enforceable.

Clearly, the former interest calls for the curtailment, whilst the latter demands the untrammelled exploitation by both instances of the power to deal with grounds and issues not raised by the Opponent.

5. In the present case, the claims of the patent in suit rejected by the Opposition Division by virtue of Article 56 EPC, had primarily been replaced by the Appellant in order to remove the ground of opposition which actually caused the revocation of the patent (see Appellant's grounds of Appeal dated 4 July 1988, in particular paragraph 4). Although in reality the Appellant's request leads to a more substantial limitation of the claimed object vis-à-vis the state of the art than strictly necessary (see point 7 below), it remains nevertheless inside the frame fixed by the grounds of opposition.

Therefore, like in any other case where amendments to the claims are requested, an examination of the amendments is required. Moreover, in combining (dependent) Claims 3 and 4 with the subject-matter of (independent) Claim 1, the Appellant has submitted an amended main claim which, in the opinion of both the Respondent and the Opposition Division, does meet the requirements of patentability and in consequence of which the grounds for opposition are de facto removed. As was pointed out in paragraph VI of the Summary of Facts and Submissions, the parties are ad idem on the form and content of the amended claims. This cannot in itself, be conclusive of the matter, i.e. such an agreement by the parties cannot detract from the power that Article 102(3) EPC confers upon both instances.

6. Whilst it would seem logical to conclude that if amendments to the main claim were limited to what was strictly necessary to lead to a patentable invention, as was explicitly admitted by the first instance, then the same result would follow a fortiori, for a limitation which was even more extensive. However, in the absence of detailed reasons in this respect in the contested decision, the Board has made use of its power under Article 102(3) EPC to check whether the amended claims meet the criteria of patentability. Quite apart from the above reason, the Board observes, obiter, that in cases such as the present one where the patentee's amendments are acceptable to the Opponent, and where such amendments effectively dispose of the opposition as raised by the Opponent, it is desirable to set out the facts and arguments not fully dealt with by the first instance, in order to provide the public with material relevant to the validity of the granted patent.
7. The amended main claim no longer covers any organic precipitant builders which are derived from α -sulpho-carboxylic acids, the sole matter at issue at the

opposition stage. The amended formula in Claim 1 corresponds to original formula II now restricted to compounds which are all derived from either malonic or succinic acid, which is therefore even more restricted than what was initially considered as acceptable by both the Respondent and the Opposition Division. Novelty was not at issue in the present case.

Since none of the documents available to the Board from the proceedings before the EPO discloses a detergent composition as defined in the amended claims, these claims are novel.

8. For the purpose of inventive step, the prior art document (3a) is still to be considered as the closest state of the art. As stated in this document, it was found, inter alia, that the dirt can be removed from the substrates substantially more quickly and/or more completely when an organic builder is added to the treatment liquor, which exerts a complex-forming and/or precipitating action on the calcium present as hardness producer in the water (see page 3, line 47 to page 4, line 6). This document relates to detergent compositions having a builder component comprising 5-95% by weight of aluminosilicate and 2-45% by weight of a complex-forming or precipitation builder for calcium (see page 5, line 60 to page 6, line 28). In example II on page 17, a number of compounds referred to as complex-forming compounds or precipitating agents are tested in a composition containing 45% of aluminosilicate and 4.2% of a test compound such as oxalic acid. However, other polycarboxylic acids may be used as a supplementary builder, in particular dicarboxylic acids of the general formula $\text{HOOC}-(\text{CH}_2)_n-\text{COOH}$ with $n = 0$ to 8 (see page 4, lines 13 to 19).

9. In respect of document (3a) the technical problem can be seen in finding a replacement for the supplementary builders used in this document.

In order to solve this problem it is proposed, according to the characterising part of amended Claim 1, to replace the known supplementary organic builder having complexing or precipitating property by either the malonic or succinic acid derivatives as defined by the general formula (I).

The examples of the description carried out with compositions containing different zeolite/precipitant builder systems such as zeolite/C₁₂ AKM, zeolite/C₁₅₋₁₈ Al or zeolite/C₁₆:1 AKS, show that the problem is indeed solved by this proposal.

Document (3a) obviously does not suggest that also some substituted dicarboxylic acids could be used as supplementary organic builders or replace the ones indicated there. In this document the teaching is clearly limited to unsubstituted dicarboxylic acids of the general formula HOOC - (CH₂)_n - COOH with n = 0 to 8. For the rest, the Board is not aware of any other disclosure which could have suggested such a replacement as feasible. Consequently, the man skilled in the art had no reason to believe that the compounds falling within the general formula (I) as defined in present Claim 1, could represent suitable alternatives for the supplementary builders mentioned in document (3a).

The Board is not aware of any other relevant document which could have led to the man skilled in the art towards the solution of the problem indicated above.

The subject-matter now claimed, therefore, involves an inventive step, and there can be no objection to maintaining the patent in its amended form, in accordance with the request of both parties.

10. The description has not yet been adapted to the claims which the Board has now approved. However, the Appellant has declared, in his letter filed on 8 July 1988, that he will submit an amended description, once the new claims had been approved by the Board.

The maintenance of the patent in its amended form is therefore subject to the condition that a properly adapted description will be filed by the Appellant.

Order

For these reasons, it is decided that:

1. the decision under appeal is set aside;
2. the case is remitted to the Opposition Division with the order to maintain the patent in its amended form on the basis of Claims 1 to 8 filed on 8 July 1988 with a description to be brought in conformity with these claims;
3. the Appellant is requested to file an adapted description within a period of two months from notification of this decision.

The Registrar

The Chairman

F.Klein

P.Lançon