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D E C I S I O N
of 19 January 1999

Case Number: T 0892/94 - 3.3.2

Application Number: 87902669.8

Publication Number: 0307400

IPC: A61K 7/32

Language of the proceedings: EN

Title of invention:

Inhibitors of esterase-producing micro-organisms, for use primarily in deodorant compositions

Patentee:

Robertet S.A.

Opponent:

Unilever N.V.

Headword:

Deodorant compositions/ROBERTET S.A.

Relevant legal provisions:

EPC Art. 54, 113(1)
EPC R. 71(1), (2)

Keyword:

"Novelty of a claim directed to the known use of a known substance which differs from the state of the art merely by the indication of a newly discovered technical effect underlying that use (no)"

Violation of right to be heard under Article 113(1) EPC when a decision to revoke the patent is taken in the absence of the proprietors from oral proceedings after they had declared that

they would take no further part in the proceedings (no)"

Decisions cited:

G 0002/88, G 0004/92, T 0059/87, T 0231/85, T 0341/92,
T 0254/93

Headnote:

I. The right to be heard of a party absent in oral proceedings as expounded in G 4/92 (OJ EPO 1994, 149) may, in appropriate circumstances, be surrendered by a party declaring that it will take no further part in the proceedings (Reasons 2.2-2.5).

II. According to G 2/88 (OJ EPO 1990, 93), novelty within the meaning of Article 54(1) EPC can be acknowledged for a claim directed to the use of a known substance for a hitherto unknown, ie **new, non-medical purpose reflecting a newly discovered technical effect**. However, a **newly discovered technical effect** does not confer novelty on a claim directed to the use of a known substance for a **known non-medical purpose** if the newly discovered technical effect already underlies the known use of the known substance (Reasons 3.4).



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Boards of Appeal

Chambres de recours

Case Number: T 0892/94 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 19 January 1999

Appellant: Unilever N.V.
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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 6 October 1994 rejecting the opposition filed against European patent No. 0 307 400 pursuant to Article 102(2) EPC.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: G. F. E. Rampold
R. E. Teschemacher

Summary of Facts and Submissions

I. The respondents are the proprietors of European patent No. 0 307 400 granted in respect of European patent application No. 87 902 669.8. The appellants (opponents) filed an opposition against the patent as a whole based on the grounds that the subject-matter of the patent opposed is not patentable under Article 100(a) EPC, because

- it is not new (Articles 52(1) and 54 EPC),
- it does not involve an inventive step (Articles 52(1) and 56 EPC) and
- patentability is excluded under Article 52(2)(a) EPC.

II. Of the seven citations relied on by the appellants during the first instance opposition proceedings, the following are referred to in this decision:

- (1) GB-A-2 013 493
- (6) "Perfume and Flavor Materials of Natural Origin", Elizabeth, N. J., 1960, columns 87 to 90

At the appeal stage the following citation was additionally introduced by the appellants:

- (8) "Nonmicrobicidal deodorizing agents", published in Cosmetics & Toiletries, 95, 1980, 48-50.

III. Independent claims 1 to 3 as granted read as follows:

- "1. The use, in the manufacture of a deodorant composition for inhibiting esterase producing micro-organisms present on human skin, of an aromatic acid ester of a phenol or of an aromatic alcohol, the phenol or aromatic alcohol being sufficiently water-soluble to impart an anti-microbial action and the aromatic acid being sufficiently water-soluble to impart an anti-microbial action and/or to lower the pH of liquid body-secretion to a level which at least inhibits the growth of micro-organisms in the liquid body-secretions.

2. The use, as an inhibitor of esterase producing micro-organisms in a deodorant composition, of an aromatic acid ester of a phenol or of an aromatic alcohol, the phenol or aromatic alcohol being sufficiently water-soluble to impart an anti-microbial action and the aromatic acid being sufficiently water-soluble to impart an anti-microbial action and/or to lower the pH of liquid body-secretion to a level which at least inhibits the growth of micro-organisms in the liquid body-secretions, the deodorant composition additionally comprising a perfume composition and a vehicle for said aromatic acid ester and the perfume composition.

3. A deodorant composition consisting of an inhibitor of esterase producing micro-organisms in which the active ingredient consisting of an aromatic acid ester of a phenol or of an aromatic alcohol, the

phenol or aromatic alcohol being sufficiently water-soluble to impart an anti-microbial action and the aromatic acid being sufficiently water-soluble to impart an anti-microbial action and/or to lower the pH of liquid body-secretion to a level which at least inhibits the growth of micro-organisms in the liquid body-secretions, a perfume composition, and a vehicle for the active ingredient and perfume composition."

Dependent claims 4 to 10 relate to specific embodiments of the use or the composition according to claims 1 to 3.

- IV. During oral proceedings before the opposition division, the respondents filed an auxiliary request which differed from the claims as granted in that composition claim 3 had been deleted, as had all references to original claim 3 in the dependent claims, which had been renumbered claims 3 to 9.

The opposition division noted in its decision that non-patentability under the terms of Article 52(2)(a) EPC had been withdrawn by the appellants during oral proceedings as a ground for opposition. However, in the impugned decision it nevertheless expressed the view that the claimed invention did not pertain to a scientific theory and, consequently, was not excluded from patentability under Article 52(2)(a) EPC.

The opposition division found that the claimed use of the compounds specified in claims 1 and 2 as an inhibitor of esterase-producing micro-organisms in a deodorant composition reflected a newly discovered

technical effect described for the first time in the contested patent and concluded that claims 1 and 2 were novel over (1) on the basis of the principles set out in decision G 2/88 (OJ EPO 1990, 93).

The opposition division admitted that some of the deodorising products disclosed in (1) also contained an aromatic ester falling within the group defined in claim 3 of the contested patent, and included additionally a perfume composition and a vehicle for said aromatic acid ester and the perfume composition. Nevertheless, it considered the subject-matter of claim 3 to be novel on the grounds that the deodorising products disclosed in (1) contained a long list of active ingredients and, in contrast to claim 3 of the contested patent, the aromatic esters themselves were not clearly identified as being the active ingredient of the known compositions disclosed in citation (1).

Based on the observation that none of the documents cited in the opposition proceedings suggested to a person skilled in the art the use of aromatic esters as defined in the present claims for the purpose of inhibiting esterase producing micro-organisms in a deodorant composition, the opposition division considered the claimed subject-matter in the contested patent as involving an inventive step and rejected the opposition pursuant to Article 102(2) EPC.

- V. The appellants lodged an appeal against the decision of the opposition division and submitted a statement of grounds within the time limit set in Article 108 EPC. By letter dated 17 August 1995, the respondents filed their observations in response to the grounds of

appeal.

Both parties requested that oral proceedings be arranged.

- VI. In a letter dated 31 July 1998, the respondents withdrew their request for oral proceedings and informed the board of their decision to take no further part in the proceedings. Oral proceedings were held on 19 January 1999; the respondents were not represented.

Since the appellants' representative had only a facsimile copy of his power of attorney, he was admitted to the oral proceedings on condition that he submitted the original document within a period of two weeks. This he did on 27 January 1999.

- VII. The appellants' submissions, both in the written procedure and at the oral proceedings, can be summarised as follows:

The technical teaching which was actually made available to the public in the specification of the patent in suit and which was represented and laid down in claims 1 and 2 was that the claimed active substances had a deodorant effect when brought into contact with the skin. The disclosure in the contested patent that this effect was achieved by inhibiting the growth of esterase producing micro-organisms was merely a scientific theory explaining a possible mechanism responsible for said effect. Moreover, this theory was in itself not new, but was already known in the state of the art, as could be derived from citation (8). However interesting this theory might be, and whether

or not it was correct, it was in any case only susceptible of industrial application if the active ingredients described in (1) were used as the active deodorising additives in a deodorant composition to be put on the skin.

This technical teaching was precisely that which had already been made available to the public by citation (1), in particular in Examples 1, 3, 4 and 5. Some of the active ingredients used in the deodorising products disclosed in (1), eg benzyl salicylate or phenylethyl phenyl acetate, were exactly the same as those used in claims 1 and 2 of the contested patent.

In contrast to the cases mentioned in decision G 2/88, the patent in suit in its entirety, and in particular claims 1 and 2, did not make available to the public a technical teaching which was novel over what could already be derived from citation (1). The subject-matter of claims 1 and 2 therefore lacked novelty.

Claim 3 of the patent in suit related to a deodorant composition consisting of inhibitors of esterase producing micro-organisms, more specifically certain aromatic acid esters of a phenol or an aromatic alcohol, a perfume composition and a vehicle. Citation (1) similarly disclosed, in particular in Examples 1, 3, 4 and 5, deodorant compositions consisting of an inhibitor of esterase producing micro-organisms of the type specified in claim 3, a vehicle for this active ingredient and a perfume composition. Hence claim 3 also lacked novelty over (1), which had already disclosed various deodorising products covered by present claim 3.

If the board were nevertheless to come to the conclusion that the particular technical effect specified in the present claims was not disclosed in the prior art of (1) and justified acknowledgment of novelty, all the claims lacked an inventive step in view of the disclosures of (1) in combination with (8). The explanation given at lines 43 to 51 in column 2 of the contested patent regarding the mechanism responsible for inhibiting esterase producing micro-organisms present on human skin was almost identical to that described in (8) under "Mode of Action". Thus the deodorising effect of the citric acid esters used as the active ingredients in (8) was similarly achieved by the activity of the microbial enzymes to split the esters back into their constituents, ie the acid and the alcohol. It was thus obvious to arrive at the claimed invention by simply replacing the citric acid ester used in (8) as the active ingredient by an aromatic ester such as benzyl salicylate, which was already known as a component of deodorants from (1).

VIII. The respondents' arguments submitted in the written procedure can be summarised as follows:

All the citations submitted by the appellants, and in particular citation (1), were entirely silent as to the fact that aromatic esters of aromatic alcohols of the kind defined in the contested patent exhibited the capability or effect of inhibiting esterase producing micro-organisms present on human skin.

There was no suggestion in (1) that, for example, benzyl salicylate could usefully be employed on its own as the sole deodorizing agent, in the absence of the

extremely large number of associated ingredients in the deodorizing compositions disclosed in (1). Therefore, on the basis of the principles set out in decision G 2/88, the claimed use of aromatic esters as inhibitors of esterase producing micro-organisms present on human skin was undoubtedly novel.

As far as the claims directed to the deodorant composition *per se* were concerned, the opposition division was entirely correct in its opinion that neither (1) nor any other cited document made available to the public compositions in which the active ingredient consisted solely of aromatic esters of a phenol or an aromatic alcohol. The claimed composition was therefore also novel.

There was certainly no indication in (1) suggesting to a person skilled in the art that the problem of providing an improved personal deodorant could successfully be solved simply by using an aromatic ester as the sole active deodorising agent. Even if the bactericidal activity of certain phenols embraced by the present claims was known in the state of the art, a clear distinction was drawn at lines 34 to 41 in column 3 of the contested patent between the medically undesirable complete elimination of microflora, ie a bactericidal action, and the desirable inhibitory action achieved by the use of aromatic esters according to the invention.

Citation (8) referred specifically to acne treatment and was in this respect essentially concerned with the use of diethyl tartrate or triethyl citrate to avoid the pungent intrinsic odour of ethyl lactate. The

skilled person therefore had no sound reason to combine the teaching of citations (1) and (8). In view of the fact that (8) referred to the advantages achieved by including an antioxidant with the triethyl citrate, the skilled person desirous of improving still further the compositions of (8) would opt for the incorporation of other antioxidants beyond the BHT (butyl hydroxytoluene) and BHA (butyl hydroxyanisole) specifically cited in (8) rather than replace the ester. The cited prior art therefore neither suggested nor rendered obvious to a person skilled in the art the subject-matter claimed in the contested patent.

- IX. The appellants requested that the decision under appeal be set aside and that European patent No. 0 307 400 be revoked.
- X. The respondents requested that the appeal be dismissed and that the patent be maintained as granted. Alternatively, they requested that the patent be maintained on the basis of the set of claims 1 to 9 as filed on 5 June 1996 and indicated as annex 3. The auxiliary request corresponds to that already filed in the proceedings before the opposition division as mentioned in paragraph IV (above).

Reasons for the Decision

1. The appeal is admissible.
2. *Procedural rights under Article 113(1) EPC*
 - 2.1 Under Article 113(1) EPC a decision of the EPO may only

be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This procedural right is intended to ensure that no party is caught unawares by reasons being given in a decision turning down his request on which he has not had the opportunity to comment. In decision G 4/92 (OJ EPO 1994, 149) the Enlarged Board of Appeal interpreted the provisions of Article 113(1) EPC concerning the right to be heard and to present comments as meaning that a decision against a party which has been duly summoned but which fails to appear at oral proceedings may not be based on facts put forward for the first time during those oral proceedings. However, new arguments may - in principle - be used in the reasons based on the facts and evidence already put forward (see G 4/92, especially conclusion 1).

- 2.2 In the present case both parties were informed by fax dated 28 July 1998 of the board's intention to summon them to attend oral proceedings (Article 116 EPC) scheduled to take place on 19 January 1999. In their letter dated 31 July 1998 the respondents (proprietors) notified the board that they wished to "withdraw the request for the appointment of oral proceedings made by the proprietors of the Patent" and added the following: **"and we confirm that the Patentee will take no further part in the proceedings"**.

In a communication dated 12 August 1998 both parties were duly summoned to oral proceedings pursuant to Rule 71(1) EPC. On 19 January 1999 oral proceedings took place. Since the respondents were not represented, the proceedings were continued without them, as

provided for in Rule 71(2) EPC.

2.3 In the present case the situation differs from that considered in G 4/92. The respondents, albeit duly summoned, not only failed to appear at the oral proceedings but had also notified the board in advance of their decision to take no further part in the proceedings. The respondents' decision to totally dispense with further participation in the proceedings is reinforced by the fact that they even refrained from replying to the registrar's official communication dated 14 August 1998. In the said communication the respondents were requested with reference to their above-mentioned letter of 31 July 1998 to confirm their requests in the proceedings.

2.4 In the above-mentioned decision, the Enlarged Board of Appeal viewed the possibility of holding oral proceedings in a party's absence, as provided for in Rule 71(2) EPC, in relation to the need for the proper administration of justice, **in the interests of which no party should be able to delay the issue of a decision by failing to appear at oral proceedings** (loc. cit., especially point 4 of the reasons). This can only mean that parties to the proceedings must be prepared for the possibility that, on the basis of the established and plainly relevant facts, the decision may go against them. It can further be inferred from this that a decision may be based on a ground discussed for the first time during oral proceedings which would prevent the patent being maintained, at least if the stage reached is such that the absent - albeit duly summoned - respondents (proprietors) could have expected the question to be discussed and were aware from the

proceedings to date of the actual bases on which it would be judged (see decision T 341/92, OJ EPO 1995, 373).

2.5 The requirements set forth above are fulfilled in the present case:

- (i) The decision to revoke the patent is entirely based on grounds, facts and evidence which were already known to the respondents from the proceedings before the opposition division and which were once again brought to the respondents' attention in writing during the appeal proceedings. Furthermore, the respondents availed themselves of the opportunity to comment on the grounds of appeal mailed to them on 9 February 1995, and likewise on the board's communication dated 11 March 1998, by filing detailed statements of 17 August 1995 and 8 July 1998 respectively.

- (ii) Moreover, the respondents (proprietors) unambiguously notified the board in advance, before the oral proceedings were held, of their **decision to take no further part in the proceedings**. This declaration can, in the board's judgment, only be construed as the respondents' unequivocal decision to voluntarily surrender their rights laid down in Article 113(1) EPC and to no longer avail themselves of the opportunity to present their comments on any objections, facts, grounds or evidence which could potentially be introduced into the proceedings by the appellants or the board and which could later turn out to be decisive for the revocation of the

patent, **even if they were given the opportunity to do so.**

2.6 On the basis of the above considerations, the board is of the opinion that, in the circumstances of the present case, considering and deciding in substance on the revocation of the patent does not conflict with the conclusions of the Enlarged Board of Appeal in decision G 4/92 and does not contravene the respondents' procedural rights as laid down in Article 113(1) EPC, in spite of the absence of the respondents during oral proceedings.

3. *Novelty of claim 2 (Article 100(a) in conjunction with Article 54 EPC)*

3.1 As a preliminary point in connection with the appellants' objection under Article 54 EPC to the novelty of claim 2 and the decision of the opposition division in this respect, in the present case the board considers it useful and appropriate to focus attention on what is in fact claimed in claim 2 of the contested patent.

Claim 2, which is identically worded in both the **main** and the **auxiliary requests**, is directed to:

- (i) the use of an aromatic ester of a phenol or of an aromatic alcohol (hereinafter referred to as "**aromatic ester**" or "**aromatic esters**")
- (ii) as an inhibitor of esterase producing micro-organisms

- (iii) in a deodorant composition additionally comprising a perfume composition and a vehicle for said aromatic ester and the perfume composition.

Suitable aromatic alcohols mentioned in the contested patent are, for example, benzyl alcohol and phenyl ethyl alcohol (see column 3, lines 22 to 23). Suitable aromatic acids which have the capability of forming aromatic esters with the aforementioned aromatic alcohols include, for example, salicylic acid, cinnamic acid and phenylacetic acid (see column 3, lines 31 to 32). Vehicles for use in the deodorant composition according to claim 2 include, for example, 96% ethanol (see column 3, line 48), talcum, starch or other suitable powder (see column 4, lines 2 to 3).

- 3.2 There can be no doubt that the group of "aromatic esters" defined in claim 2 embraces a considerable number of compounds which are well known *per se* in the state of the art, eg benzyl salicylate or phenylethyl phenyl acetate.

The use of "aromatic esters" as an active ingredient in deodorising products is likewise already known in the state of the art. Thus citation (1) discloses, in particular in Examples 1, 3, 4 and 5:

- (i) the use of a substance falling within the group of "**aromatic esters**"
- (ii) as an **active** ingredient [see page 2, lines 43 to 46: "The essential substances - eg amongst others benzyl salicylate in Examples 1, 5; amongst

others coniferyl benzoate in Example 3; amongst others phenyl ethyl phenylacetate in Example 4 - required for the formulation of deodorant compositions that are **operative according to the new principle** are those

(iii) in deodorising products which additionally comprise various perfumery materials (see page 1, lines 25 to 26: "some of which can be perfumery materials") and

a vehicle for said active ester and perfume materials (see page 3, line 29, to page 5, line 111).

More specifically, Example 1 discloses a deodorant talcum powder consisting of 99.5% by weight of talc as the vehicle and 0.5% of a deodorant composition, which itself contains as an active ingredient 4 parts of **benzyl salicylate**, ie an "aromatic ester", along with various perfumery materials, eg Amber AB 358, Bergamot AB 430, Orange oil sweet, etc.

Example 3 discloses a deodorant oil-in-water hand lotion containing a vehicle which is specifically designed to apply the deodorant composition to the skin and 0.5% by weight of a deodorant composition, which itself contains as an active ingredient 5 parts of **benzoin siam resinoid** along with various perfumery materials. According to citation (6) the major constituent of benzoin siam resinoid is **coniferyl benzoate**, ie an "aromatic ester".

Likewise, Examples 4 and 5 disclose deodorising

products consisting of a vehicle and a deodorant composition, which itself contains as an active ingredient 5 parts of **phenyl ethyl phenylacetate** (Example 4) or 15 parts of **benzyl salicylate** (Example 5) along with various perfumery materials. In Example 5 the vehicle consists of 80% alcohol.

On the other hand, neither (1) nor any other citation available in the proceedings contains a disclosure or teaching to the effect that an "aromatic ester" of the kind described more precisely in claim 2 and mentioned above has, when used in a deodorant composition, the capability of inhibiting esterase producing micro-organisms present on human skin. This was not contested by the appellants.

3.3 Thus a comparison of the claimed subject-matter in present claim 2 with the disclosure of the state of the art makes it clear that what was in the present case indeed **not** made available to the public in citation (1) was the discovery or explanation that "aromatic esters", when used as an active ingredient in a deodorant composition, have the **capability of inhibiting esterase producing micro-organisms** present on human skin.

On the other hand, "**aromatic esters**" *per se* and **their use as an active ingredient in deodorising products** additionally comprising a perfume composition and a vehicle for said aromatic esters and the perfume composition have undoubtedly been **made available** to the public in (1) in the form of a technical teaching.

3.4 From the considerations in the foregoing points it is

sufficiently clear that the assessment of novelty in the present case depends on the answer to the question whether or not the above-mentioned claimed effect or capability of the "aromatic esters", which is not disclosed in the state of the art but which is mentioned in claim 2 of the patent in suit, can confer novelty to the subject-matter claimed in claim 2. As regards the prevailing question of novelty, the respondents relied primarily on decision G 2/88 (OJ EPO 1990, 93).

In order to be able to correctly apply the conclusions laid down in decision G 2/88 to the present case, the board considers it useful to recapitulate question (iii), which was referred to the Enlarged Board of Appeal, and the answer to this question given in the said decision.

The question was: "Is a claim to the use of a compound for a particular non-medical purpose novel for the purpose of Article 54 EPC, having regard to a prior publication which discloses the use of that compound for a **different** non-medical purpose, so that the only **novel feature** in the claim is the **purpose** for which the compound is used?"

The answer to this question is summarised in point 10.3 of the reasons as follows: "With respect to a claim to a **new** use of a known compound, such **new** use may reflect a **newly discovered technical effect** described in the patent. The attaining of such a technical effect should then be considered as a functional technical feature of the claim (eg the achievement in a particular context of that technical effect). If that technical feature

has not been previously made available to the public by any of the means as set out in Article 54(2) EPC, then the claimed invention is novel, even though such technical effect may have inherently taken place in the course of carrying out what has previously been made available to the public."

The conclusions in decision G 2/88 can be even further clarified by reference to two specific cases which the Enlarged Board of Appeal considered in its decision:

In the case of decision T 59/87 (OJ EPO 1988, 347), which gave rise to the referral of the above-mentioned question to the Enlarged Board of Appeal, the use of a certain substance as a rust-inhibiting additive was already known in the state of the art. Based on the **newly discovered friction-reducing effect** of the same substance, claims directed to the hitherto unknown, **new** use of that substance as a friction-reducing agent in a lubricant composition were held in the final decision (T 59/87, OJ 1991, 561) to be novel within the meaning of Article 54(1) EPC on the basis of the principles outlined above. Whereas the known use of the substance was to inhibit rust, the problem underlying the claimed invention was to reduce the friction between sliding surfaces in engines. Lubricants may be applied for numerous purposes and either of the two effects may be important in quite different situations. There thus exist, based on two distinctly different effects, two distinctly different applications or uses for the same substance, which can clearly be distinguished from each other.

In the second case, decision T 231/85 (OJ EPO 1989, 74;

mentioned in G 2/88, reasons, point 9.1), the use of certain substances for influencing plant growth was known in the state of the art. Based on the **newly discovered fungicidal effect** of the same substances, claims directed to the use of these substances for the hitherto unknown, **new** purpose of controlling fungi and preventive fungus control were held to be novel within the meaning of Article 54(1) EPC on the basis of the principles outlined above. In both the claimed invention and the state of the art the respective treatments, ie the treatment for controlling fungi on the one hand, and the treatment for influencing plant growth on the other, were carried out in the same way (so the means of realisation was the same). It was thus possible that the newly discovered technical effect, more specifically the fungicidal effect, might already have inherently taken place when the substances in question were applied for the known purpose (influencing plant growth). This was not considered as prejudicial to novelty on the basis that, under Article 54(2) EPC, the question to be decided is what has been made available to the public; the question is not what may have been "inherent" in what has been made available. Under the EPC, a hidden or secret use, because it has not been made available to the public, is not a ground for objection to the novelty and validity of a European patent.

Again, in T 231/85 there exist, based on two distinctly different effects, two distinctly different applications or uses for the same substances, which can clearly be distinguished from each other. The circumstances in which the substances are applied for the purpose of controlling fungi are in fact different

from those in which they are applied for the purpose of regulating plant growth.

It follows from decision G 2/88 and the examples mentioned above that novelty within the meaning of Article 54(1) can be acknowledged in cases where the discovery of a **new technical effect** of a **known substance** leads to an invention which is defined in the claim in terms of the use of that substance for a **hitherto unknown, new non-medical purpose** reflecting said effect (ie a new functional technical feature), even if the only novel feature in that claim is the purpose for which the substance is used.

Conversely, it can be inferred from decision G 2/88 that no novelty exists, if the claim is directed to the use of a **known substance** for a **known non-medical purpose**, even if a **newly discovered technical effect** underlying said known use is indicated in that claim.

3.5 In the board's opinion, the latter is precisely the case here. As already stated above, the use of an "aromatic ester" as an active ingredient in deodorant compositions is already disclosed in (1). Although citation (1) is silent about the possible explanation for the effect exhibited by "aromatic esters" when used as an active ingredient in a deodorising product, and certainly provides no information to a person skilled in the art that such esters exhibit the effect or capability of inhibiting esterase producing micro-organisms present on human skin (ie a **newly discovered technical effect**), "aromatic esters" (ie **known substances**) were already used in (1) as an active ingredient for the purpose of providing deodorising

products additionally comprising a perfume composition and a vehicle for said aromatic esters and the perfume composition (ie a **known non-medical purpose**).

Thus the disclosure in citation (1) is, in the board's judgment, prejudicial to the novelty of present claim 2. It is immaterial for the purposes of prejudice to novelty that the actual technical effect exhibited by "aromatic esters" in deodorising compositions is not described in the cited document. The *ex post facto* discovery that the deodorising effect of "aromatic esters" when used as an active ingredient in deodorising products may result from their capability of inhibiting esterase producing micro-organisms may possibly be regarded as a (potentially surprising) piece of knowledge about the known use or application of such esters but cannot confer novelty to claim 2, since the latter would require that the newly discovered effect ends indeed in a new technical application or use of the "aromatic esters" which is not necessarily correlated with the known application or use and can be clearly distinguished therefrom. This is not the case here, as explained in detail above.

- 3.6 In the present case it is also immaterial for the purposes of prejudice to novelty that in the above-mentioned examples of citation (1) the deodorant compositions contain in addition to the "aromatic ester" quite a number of other ingredients which are also potentially active in the sense outlined in point 3.2 (i) (above), since claim 2 is in no way limited to the use of an "aromatic ester" as the sole active ingredient in deodorant compositions.

- 3.7 The above considerations are, in the board's judgment, in line with the conclusions in decision T 254/93 (OJ EPO 1998, 285, see in particular reasons, point 4.8), where it is stated that **the mere explanation of an effect** obtained when using a compound in a known composition, even if the effect was not known to be due to this compound in the known composition, cannot confer novelty on a known process if the skilled person was aware of the occurrence of the desired effect.
- 3.8 The board concurs with the appellants' opinion in so far as the admissibility of claims directed to the use of a known substance for a known purpose which differ from the state of the art merely by the indication of a newly discovered technical effect associated with the said known use could potentially result in a permanent monopoly of the use of a known substance for a known purpose by means of the repeated introduction into such claims of a new, possibly only subtly different technical effect associated with this known use. It was apparently the clear intention of decision G 2/88 to prevent this by ruling that novelty within the meaning of Article 54(1) can only be acknowledged in cases where a **newly discovered technical effect** of a known substance leads to an invention which is defined in the claim in terms of the use of that substance for a **hitherto unknown, new non-medical purpose reflecting said effect**.
- 3.9 It follows from the foregoing that the subject-matter of claim 2 of both the main and the auxiliary requests lacks novelty. There is no need in these circumstances to examine whether claim 2 is based on an inventive step. Since a decision can only be taken on each

request as a whole, there is likewise no need to look into the patentability of the other claims either.

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:

P. Martorana

P. A. M. Lançon