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D E C I S I O N
of 15 January 2004

Case Number: T 0962/98 - 3.3.1

Application Number: 94931395.1

Publication Number: 0728174

IPC: C10M 173/02

Language of the proceedings: EN

Title of invention:
Particulate suspending antimicrobial additives

Applicant:
ECOLAB INC.

Opponent:
-

Headword:
Antimicrobial additives/ECOLAB

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Main and first auxiliary request: support in the application as filed (no) - inadmissible generalization of an example"

Decisions cited:
-

Catchword:

There may exist situations where some characteristics taken from a working example may be combined with other features disclosed in a more general context without necessarily creating an objectionable intermediate generalization. However, under Article 123(2) EPC, such an intermediate generalization is only admissible if the skilled person can recognize **without any doubt** from the application as filed that those characteristics are not closely related to the other characteristics of the working example and apply directly and unambiguously to the more general context. In other terms, in order to be acceptable, this intermediate generalization must be the result of unambiguous information that a skilled person would draw from the review of the example and the content of the application as filed (cf. point 2.5).

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Case Number: T 0962/98 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 15 January 2004

Appellant: ECOLAB INC.
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Representative: Plougmann & Vingtoft A/S
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 17 July 1998 refusing European application No. 94931395.1 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: A. J. Nuss
Members: P. F. Ranguis
S. C. Perryman

Summary of Facts and Submissions

I. This appeal lies from the decision of the Examining Division to refuse the European application No. 94 931 395.1 (publication No. 0 728 174) on the ground that Claim 1 of the then pending request contained subject-matter which extended beyond the content of the application as filed (Article 123(2) EPC).

II. The request before the Examining Division contained thirteen claims. Independent Claim 1 read as follows:

"1. A method for suspending particulate matter and sanitizing the area of contact comprising the steps of:
(a) diluting a particulate suspending antimicrobial concentrate composition with a diluent, said concentrate composition comprising a carrier comprising a conveyor lubricant, said conveyor lubricant comprising N-coco-1,3-diaminopropane, N-oleyl-1,3-diaminopropane or a mixture thereof, an antimicrobial effective amount of a quaternary ammonium cationic compound, and an effective soil suspending amount of an amphoteric surfactant, and
(b) applying the diluted concentrate composition to the intended area of application".

III. In its decision, the Examining Division held that Example 1 disclosing four test formulas all comprising both 6% w/w of N-coco-1,3-diaminopropane and 6% w/w of N-oleyl-1,3-diaminopropane, could not support a claim allowing the conveyor lubricant to comprise only N-coco-1,3-diaminopropane or only N-oleyl-1,3-

diaminopropane. Nor could a support for this be found in the rest of the description.

IV. With the statement of grounds of appeal, the Appellant requested as main request that the decision under appeal be set aside and a patent granted on the basis of the claim request refused by the Examining Division or as auxiliary request that a patent be granted on the basis of a fresh set of thirteen claims.

Claim 1 of the auxiliary request differed from Claim 1 of the main request in that the conveyor lubricant comprised "N-coco-1,3-diaminopropane and N-oleyl-1,3-diaminopropane", the possibility of either being present on its own being omitted from the claim.

V. In a communication, the Board informed the Appellant that Claim 1 of each request might give rise to an objection under Article 123(2) EPC since it seemed that the composition of the Example No. 1 comprised, in addition to N-coco-1,3-diaminopropane and N-oleyl-1,3-diaminopropane, other surfactants, namely triethanolamine and N-coco amine ethoxylate, all those surfactants being present in a defined amount. It seemed, furthermore that the skilled reader could derive from the application as filed that the carrier concentration and type could vary depending upon the nature of the composition as a whole (cf. page 13, lines 24 to 30 of the application as filed).

The Appellant, in response, abandoned the previous requests and filed in lieu thereof three requests as main request, first and second auxiliary requests.

Claim 1 of the main request and of the first auxiliary request was identical (respective Claims 6 of these requests differed from each other) and read as follows:

"1. A method for suspending particulate matter and sanitizing the area of contact comprising the steps of: (a) diluting a particulate suspending antimicrobial concentrate composition with a diluent, said concentrate composition comprising a carrier comprising a conveyor lubricant, said conveyor lubricant comprising N-coco-1,3-diaminopropane, N-oleyl-1,3-diaminopropane, triethanolamine, N-coco amine ethoxylate, an antimicrobial effective amount of a quaternary ammonium cationic compound, and an effective soil suspending amount of an amphoteric surfactant, and (b) applying the diluted concentrate composition to the intended area of application".

Claim 1 of the second auxiliary request read as follows:

"1. A method for suspending particulate matter and sanitizing the area of contact comprising the steps of:

(a) diluting a particulate suspending antimicrobial concentrate composition with a diluent, said concentrate composition comprising a carrier comprising a conveyor lubricant, said conveyor lubricant comprising 6.00% w/w of N-coco-1,3-diaminopropane, 6.00% w/w of N-oleyl-1,3-diaminopropane, 1.50% w/w of triethanolamine, 2.00% w/w of N-coco amine ethoxylate, an antimicrobial effective amount of a quaternary ammonium cationic compound, and an effective soil suspending amount of an amphoteric surfactant, and

(b) applying the diluted concentrate composition to the intended area of application".

VI. Oral proceedings took place on 15 January 2004. The Appellant submitted in essence the following arguments:

By reference to the composition of Example 1D and to the tests relating to the evaluation of the lubricity and soil suspension of this composition, the person skilled in the art could derive that the compounds defined in Claim 1 of each request might be applied in a more general context. In that respect, the claimed subject-matter was consistent with the description and derived directly and unambiguously from the content of the application as filed.

VII. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the main request or the first auxiliary request filed with a letter received 27 August 2003 or the second auxiliary request filed with letter of 19 December 2003.

VIII. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main and first auxiliary requests

2. *Article 123(2) EPC - Amendments*

2.1 Claims 1 of the main and first auxiliary requests have the same wording (cf. point V above). The claimed subject-matter derives from Claim 32 as originally filed wherein, in particular, it is specified that the carrier comprises "a conveyor lubricant, said conveyor lubricant comprising N-coco-1,3-diaminopropane, N-oleyl-1,3-diaminopropane, triethanolamine, N-coco amine ethoxylate".

2.2 Article 123(2) EPC requires that a European patent application or a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. It is, therefore, to be decided whether or not the subject-matter of fresh Claim 1 of the main and first auxiliary request extends the content of the application as filed.

2.3 The Appellant argued that the claimed subject-matter derived from Example 1D and the content of the application as originally filed. In particular, the tests of lubricity and soil suspension carried out on the composition of Example 1D showed that the four surfactants could be applied in a more general context, present Claim 1 being, furthermore, consistent with the description.

2.4 The Board observes that Example 1D is actually the sole example in accordance with the now defined invention. Indeed, Examples 1A to 1C do not disclose concentrate compositions comprising an antimicrobial effective amount of a quaternary ammonium cationic compound, **and** (emphasized by the Board) an effective soil suspending amount of an amphoteric surfactant.

Example 1D describes the following concentrate composition:

Distilled water	59.7%
Acetic acid	4.80%
N-coco-1,3-diaminopropane	6.00%
N-oleyl-1,3-diaminopropane	6.00%
N-coco amine ethoxylate, 15 mole	2.00%
Triethanolamine	1.50%
Isopropyl alcohol	9.00%
Lauryliminodipropionic acid, monosodium salt	5.00%
Coco-alkyldimethylbenzyl, ammonium chloride	6.00%

2.5 The Board does not exclude that there may exist situations where some characteristics taken from a working example may be combined with other features disclosed in a more general context without necessarily creating an objectionable intermediate generalization. However, under Article 123(2) EPC, such an intermediate generalization is only admissible if the skilled person can recognize **without any doubt** from the application as filed that those characteristics are not closely related to the other characteristics of the working

example and apply directly and unambiguously to the more general context. In other terms, in order to be acceptable, this intermediate generalization must be the result of unambiguous information that a skilled person would draw from the review of the example and the content of the application as filed.

2.6 In the present case, it is, first necessary to determine which part of the description can be referred to, in order to support the subject-matter of present Claim 1.

2.6.1 It is not contested that the four surfactants recited in Claim 1 (cf. point 2.1 above) are neither quaternary ammonium cationic compounds nor amphoteric surfactants. It can, therefore, be concluded that neither the description of the antimicrobial compounds nor of the suspending agents (cf. page 4, line 4 to page 11, line 1 of the application as filed) are relevant in that respect. Since the carrier may comprise, in addition to water or the organic carrier or a mixture thereof, any number of surfactants (cf. page 11, lines 34 to 35) or a conveyor lubricant (cf. Claim 12), it can be assumed that the four surfactants of the working example are part of the carrier. However, the description relating to the carrier (cf. page 11, line 2 to page 13, line 34), does not even mention the four surfactants now recited in Claim 1.

2.6.2 It is, therefore, not possible to conclude without any doubt whether or not, those four surfactants either

(a) can be singled out of the composition of Example 1D and used with other carriers than a mixture of water and isopropyl alcohol, with an antimicrobial agent other than coco-alkyldimethylbenzyl, ammonium chloride or with an amphoteric surfactant other than lauryliminodipropionic acid monosodium salt or, to the contrary, whether they

(b) are only adapted to the specific composition disclosed in Example 1D.

The skilled reader is given no guidance, either in Example 1D itself, or in the more general description as to which components of Example 1D should be retained unchanged, and which can be varied at will. He will know that it will be possible to vary the example, but there is no clear guidance as to within what limits such variation will be possible. Certainly there is nothing to tell him that just the four surfactants recited in claim 1, but not other components recited in Example 1D, are essential.

2.6.3 This situation of doubt is in contradiction with the requirement that an amendment be directly and unambiguously derivable from the application as filed.

2.6.4 Here, this doubt is even reinforced by the description which states that "the carrier **concentration and type** (emphasized by the Board) will depend upon the nature of the composition as a whole, the environment of

storage and method of application, including the concentration of particulate suspending antimicrobial agents, among other factors" (cf. page 13, lines 26 to 30), which implies that for each composition all the ingredients and their amounts are closely interrelated and need to be carefully chosen.

2.6.5 Nor can this conclusion be rebutted by the tests of lubricity and soil suspension carried out on the composition of Example 1D. Those tests are related to the composition of Example 1D as a whole, where the various components in the therein defined amounts contribute together to the indicated technical effect. There is no basis in the description which would allow the skilled reader to deduce that varying the composition in the way now claimed will provide the same technical effect. Contrary to the Appellant's submissions, in order to assess whether an amendment complies with the requirements of Article 123(2) EPC, the question is neither whether or not a skilled person could design other compositions in view of the directions given by the tests nor whether or not the amended subject-matter is consistent with the description but rather whether the amendment is directly and unambiguously derivable therefrom, which standard implies that no doubt exists on the presence, whether explicit or implicit, of the amended subject-matter in the disclosure of the application as filed.

2.7 The Board concludes that the subject-matter of Claim 1 of the main and first auxiliary requests extends beyond the content of the application as filed. Since the Board can only decide on a request as a whole, both requests are rejected.

Second auxiliary request

3. *Article 123(2) EPC - Amendments*

3.1 The subject-matter of Claim 1 of this request derives from Claim 32 as originally filed wherein, in particular, the following amendment was made:

The carrier comprises "a conveyor lubricant, said conveyor lubricant comprising 6.00% w/w of N-coco-1,3-diaminopropane, 6.00% w/w of N-oleyl-1,3-diaminopropane, 1.50% w/w of triethanolamine, 2.00% w/w of N-coco amine ethoxylate".

3.2 Claim 1 of this request suffers from the same deficiencies as that raised for Claim 1 of the main and first auxiliary request. Indeed, nothing in the description as originally filed indicates directly and unambiguously that those four surfactants in determined amounts may be singled out to form an intermediate generalization such as now defined in Claim 1 (cf. point 2.6 above). The subject-matter of Claim 1 of the second auxiliary request extends, therefore, beyond the content of the application as filed.

3.3 This request is also to be rejected.

4. *Procedural matters*

In view of the fact that none of the requests meet the requirements of the EPC, there is no case to be remitted to the first instance.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

N. Maslin A. Nuss