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D E C I S I O N
of 10 September 2004

Case Number: T 0201/99 - 3.3.6

Application Number: 89202706.1

Publication Number: 0367339

IPC: C11D 11/00

Language of the proceedings: EN

Title of invention:

Process for preparing a high bulk density granular detergent composition

Patentee:

UNILEVER N.V., et al

Opponents:

Henkel Kommanditgesellschaft auf Aktien
The Procter & Gamble Company
Gebrüder Lödige Maschinenbaugesellschaft mbH

Headword:

Granulation process/UNILEVER

Relevant legal provisions:

EPC Art. 87, 123(2), 84, 54

Keyword:

"Main and second auxiliary request - novelty (no)"
"First and third auxiliary request - inadmissible amendment
(disclaimer not allowable)"

Decisions cited:

G 0001/93, G 0002/98, G 0001/03

Catchword:

-



Case Number: T 0201/99 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 10 September 2004

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(Proprietors of the
patent)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 23 December 1998
revoking European patent No. 0367339 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman:

P. Krasa

Members:

P. Ammendola

U. J. Tronser

Summary of Facts and Submissions

- I. This appeal is from the decision of the Opposition Division revoking European patent No. 0 367 339 based on the application filed on 26 October 1989 and claiming priority from the applications GB 8825659 of 2 November 1988 and GB 8829346 of 16 December 1988.
- II. The granted patent contained 9 claims of which claim 1, the only relevant for this decision, reads as follows:
- "1. *Process for the continuous preparation of a granular detergent composition or component having a bulk density of at least 650 g/l, which comprises treating a particulate starting material*
- (i) in a first step in a high-speed mixer/densifier, the mean residence time being from 5-30 seconds;*
- (ii) in a second step in a moderate-speed granulator/densifier, whereby it is brought into, or maintained in, a deformable state, the mean residence time being from 1-10 minutes and*
- (iii) in a final step in drying and/or cooling apparatus."*
- III. Opponents I, II and III (hereafter Respondents I, II and III) sought revocation of the patent for lack of novelty and inventive step (Article 100(a) in combination with Articles 52(1), 54 and 56 EPC). Respondent II also raised the ground of opposition under Article 100(b) EPC. They cited *inter alia* during the opposition proceedings

E7 = EP-A-0 420 317,

an European application claiming a priority date of 29 September 1989.

IV. In the decision under appeal the Opposition Division considered *inter alia* the patentability of four sets of claims labelled as "amended main request" and as 1st to 3rd "amended auxiliary requests".

Part of the subject-matter of claim 1 according to the "amended main request" (wherein however claim 1 was identical to that of granted patent) was found not to be entitled to the claimed priorities and, thus, the prior art disclosed in E7 (a European patent application with a priority date subsequent to the priority dates claimed in the patent in suit but preceding its filing date) was considered relevant under Article 54(3) EPC in respect to this part of claimed subject-matter. The Opposition Division concluded that claim 1 of this request lacked novelty *vis-à-vis* the prior art disclosed in this citation.

The subject-matter of claim 1 of the "amended 1st auxiliary request", which differed from granted claim 1 only in that the range "1-10 minutes" had been replaced by "1-6 minutes", was found not allowable under the provisions of Article 123(2) EPC.

The subject-matter of claim 1 of the "amended 2nd auxiliary request", which differed from granted claim 1 only in that the range "1-10 minutes" had been replaced by "1-5 minutes", was found entitled to the claimed

priorities, admissible in view of Article 123(2) and novel. This request, however, failed for other reasons.

The subject-matter of claim 1 of the "amended 3rd auxiliary request", which differs from granted claim 1 only in that the final wording "*apparatus.*" has been replaced by "*apparatus; with the proviso that a liquid acid precursor of an anionic surfactant is not fed into the high-speed mixer/densifier.*", was found containing an allowable disclaimer and thus at compliance with Article 123(2) EPC. This request, however, failed for other reasons.

- V. The Patent Proprietors (hereafter Appellants) filed an appeal against this decision.

They enclosed to the statement setting out the grounds of appeal three sets of amended claims labelled as 1st, 2nd and 3rd auxiliary requests. Each claim 1 of these auxiliary requests is respectively identical to the corresponding claim 1 of the 1st to 3rd "amended auxiliary requests" considered in the decision under appeal (see above point IV).

The statement comprised also a request for oral proceedings in case the main request could not be allowed by the Board and (at page 3, lines 9 to 11) the Appellants' wish to reserve the right to make further amendments in the form of four variants to any of the main or 1st to 3rd auxiliary requests.

- VI. In a communication dated 17 May 2004 sent to the parties together with the summons to oral proceedings scheduled for 10 September 2004, the Board informed the

Appellants that no reservation of rights to present amendments to the initially filed requests is foreseen by the EPC or the Rules of Procedure of the Boards of Appeal.

- VII. The Opponents I and III (hereafter Respondents I and III) and the Appellants announced that they would not take part to the scheduled hearing.
- VIII. On 10 September 2004 oral proceedings were held in the presence of Opponent I (hereafter Respondent I) only.
- IX. The Appellants submitted in writing the following arguments relevant for this decision.

They argued in respect of the right to priority of the granted claim 1 (see point 4.1 of the grounds of appeal) that the extension of the upper limit for the time length range of the second step from "*about 1-6 minutes*" disclosed in the two priority applications (see claim 1 in both GB applications) to "*1-10 minutes*" would not change the character of the invention, but rather be a justifiable elaboration of the same basic idea between the priority and the filing dates. In this respect the Appellants cited the decision T 73/88 (OJ EPO 1992, 557) and argued additionally that, in accordance with the decision T 136/95 (OJ EPO 1998, 198 and 480) the priority application provided a "functional" disclosure of the possibility of extending the treatment time of the second step above 6 minutes and thus that the upper value for the time range of "*about 1-6 minutes*" should not be interpreted in these priority applications as a critical cut-off value. They concluded that the disclosure of E7 could not represent

prior art under Article 54(3) EPC for the whole subject-matter of granted claim 1, since the latter was entitled in full extent to the claimed priority dates.

In respect of the compliance of the 1st auxiliary requests with the requirements of Article 123(2) EPC they argued (see points 3.2 and 3.4 of the grounds of appeal) that the amendment in claim 1 of this request (see above point V) amounted to an allowable disclaimer of the portion of patented subject-matter for which E7 could be (erroneously) considered to represent an anticipation under Article 54(3).

With regard to the admissibility under the provisions and 123(2) EPC and the novelty of the subject-matter of claim 1 of the 2nd and 3rd auxiliary requests the Appellants stressed that these had been already acknowledged in respect of the same amended claims by the Opposition Division (see above points IV and V).

X. Respondent II filed no comment in writing to the grounds of appeal.

Respondent I (orally and in writing) and III (only in writing) maintained that:

- claim 1 of the main request was not entitled to priority and that E7 would represent state of the art under Article 54(3) EPC anticipating its subject-matter, and
- the amendment in claim 1 of the 1st auxiliary requests represented no allowable disclaimer and infringed Article 123(2) EPC.

At the oral proceedings Respondent I relied also on the opinion of the Enlarged Board of Appeal G 2/98 (OJ EPO 2001, 413) and on the Decisions G 1/03 (OJ EPO 2004, 413) and G 2/03 (OJ EPO 2004, 448) and argued that

- the person skilled in the art could not derive from the GB priorities a time length of "5 minutes" for the second step and, therefore, also claim 1 of the 2nd auxiliary request was not entitled to the claimed priority and E7 would represent state of the art under Article 54(3) EPC anticipating also its subject-matter, and
- also the amendment in claim 1 of the 3rd auxiliary requests represented no allowable disclaimer and infringed Article 123(2) EPC.

XI. The Appellants requested in writing that the decision under appeal be set aside and that the patent be maintained as granted or on the basis of claims 1 to 9 of one of the 1st to 3rd auxiliary requests filed with the statement of grounds of appeal.

XII. The Respondents I (during the oral proceedings) and III (in writing) requested that the appeal be dismissed.

Respondent II made no expressly declared request.

Reasons for the Decision

Claim 1 of the Appellants' main request

1. *Entitlement to priority (Article 87(1) EPC)*
 - 1.1 As it has been clarified in the opinion G 2/98 of the Enlarged Board of Appeal (see the conclusion of G 2/98), the requirement for claiming priority of "the same invention", referred to in Article 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole.
 - 1.2 Both GB priorities of the patent in suit disclose in respect of the mean residence time of the material in the moderate-speed granulator/densifier of the second step (ii) (see above point II) either the range "*from about 1-6 minutes*" (see e.g. claim 1 of both GB priorities) or, for all the examples, a specific residence time of "*about 3 minutes*".
 - 1.3 Considering that, for instance, the features disclosed in the GB applications provide no explicit or implicit disclosure of a process wherein the second step lasts "*10 minutes*", it is apparent that the cited priority applications are insufficient to render directly and unambiguously disclosed therein also the whole range of "*1-10 minutes*", i.e. the range defining in granted claim 1 the time length of the second step.

1.4 The Appellants' argument (see above point IX of the Facts and Submissions) that the upper limit of "6 minutes" for the time length of the second step is not disclosed in the cited priorities as a cut-off value (i.e. as possibly related to the function of the invention and its effect) and thus constituted a feature which might be modified without changing the nature of the invention, cannot be accepted by the Board. Even if for the sake of argument the range "about 1 to 6 minutes" given in the priority applications is interpreted as an open range extending far beyond "6 minutes" - and it is to be emphasized that the Board cannot find any basis in the priority documents for such an interpretation -, still the value of "10 minutes" as well as e.g. the range from above 6 minutes to up to 10 minutes constituted selections not disclosed in the priority applications. It follows that for a skilled person applying its common general knowledge at least the value of "10 minutes" was not derivable directly and unambiguously from the prior applications. This means that a residence time of (up to) 10 minutes is a feature of an invention different from that disclosed in the priority applications, with the consequence that the latter are no basis for a proper exercise of the priority right under Article 87 EPC (see G 2/98, in particular points 8.4 and 9) at least for the process of granted claim 1 wherein the second step lasts "10 minutes".

2. *Novelty (Article 100(a) in combination with Articles 52(1) and 54 EPC)*

2.1 It is undisputed that E7, which was published on 3 April 1991 (i.e. after the filing date of the patent

in suit on 26 October 1989), validly claims the priority date of 29 September 1989 (i.e. after the filing dates of 2 November 1988 and 16 December 1988 of the GB priorities claimed in the patent in suit, but before the filing date of the patent in suit). Therefore E7 is comprised in the state of the art pursuant to Article 54(3) EPC in respect of subject-matter of the present claims **not** entitled to any of the priority dates.

2.2 Claim 1 of E7 is directed to a two step process for preparing a detergent particulate with a bulk density of at least 550 g/l differing from the claim 1 of the patent in suit (see above point II) substantially only in the definition of the first step. This step is defined in claim 1 of E7 as "*(i) feeding a liquid acid precursor of an anionic surfactant, a solid water-soluble alkaline inorganic material and optionally other materials in a first step in a high-speed mixer/densifier, the mean residence time being from 5-30 seconds*". The second step of the process disclosed in claim 1 of this document is substantially identical to that of claim 1 of the patent in suit; in particular, the mean residence of the material in the granulator/densifier disclosed in E7 is "*from about 1-10, preferably 2-5 minutes*".

2.3 The Boards finds that "*treating a particulate starting material*" in the first step of the process defined in claim 1 of the patent in suit (see above point II) necessarily encompasses also "*feeding a liquid acid precursor of an anionic surfactant*" and "*a solid water-soluble alkaline inorganic material*" as required in the first step of the process of E7 and concludes that this

document necessarily discloses a process according to claim 1 of the patent as granted.

The Respondents and the Opposition Division arrived at the same conclusion and the Appellants did not contest this line of reasoning.

2.4 Since the features of the process according to E7 conform completely to those of the present invention, including the time range "**1-10 minutes**", it follows that this prior art discloses in particular the process of claim 1 of the patent in suit wherein the second step lasts **10 minutes**, i.e. a claimed process that has been found not entitled to any of the two priority dates (see above point 1.4) and for which E7 clearly constitutes prior art relevant under Article 54(3) EPC.

2.5 Therefore, claim 1 as granted is found not to meet the requirements of Articles 52(1) and 54 EPC.

The Appellants' main request is hence not allowable.

Claim 1 of the Appellants' 1st auxiliary request

3. *Article 123(2) EPC*

3.1 As already indicated above (see point V) claim 1 of the 1st auxiliary request differs from claim 1 of the granted patent in that in the second step (ii) the time range "*1-10 minutes*" is replaced by "*1-6 minutes*". This latter range is not disclosed in the application as originally filed but only the two GB priorities (see claim 1 in both these applications).

3.2 Pursuant to Article 123(2) EPC, it is the application as filed, and not the priority document, which serves as a basis for supporting amendments. The content of the application as filed does not include the content of the priority document (see T 260/85, OJ EPO 1989, 105). Hence, the Board finds that the subject-matter of claim 1 extends beyond the content of the application as filed.

3.3 The Appellants were of the opinion that this amendment would not violate Article 123(2) EPC because the range of 1 to 6 minutes should be regarded as disclaiming a sub-range of more than 6 and up to 10 from the range of 1 to 10 minutes, so as to remove the area of overlap between the claimed subject-matter and the prior art disclosed in E7 relevant under Article 54(3) EPC.

3.4 However, as the Enlarged Board of Appeal has established in the recent decisions G 1/03 and 2/03 (see in particular point 3 of the reasons and point 2.2 of the order) a disclaimer aiming at overcoming a novelty objection is allowable - and therefore outside the interdiction imposed by Article 123(2) EPC - if it removes only what is necessary to restore novelty. In other words, any "disclaimer" removing more than is necessary to restore novelty must comply with the interdiction ruled under Article 123(2) EPC.

In the present case, however, the introduced restriction to 6 minutes of the original time length range for the second step would exclude **all** initially claimed processes having a duration of the second step between above 6 and 10 minutes, i.e. independently on the kind of treatment occurring in the first step of

the process. Instead the prior art disclosed in E7 comprises **only** those processes wherein an acid precursor of an anionic surfactant **and** a solid water-soluble alkaline inorganic material are fed in the high-speed mixer/densifier (see above point 2.2).

Moreover, the above cited decisions of the Enlarged Board of Appeal (see in particular the last paragraph at point 3 of these decisions) explicitly rule out the possibility of hiding a disclaimer by using an undisclosed positive feature defining the difference between the original claim and the anticipation, since this would affect the transparency of the patent (Article 84 EPC).

Therefore, the restriction in claim 1 of the range of treatment times of the second step from 10 to 6 minutes **cannot** represent an allowable disclaimer of the prior art disclosed in E7, as maintained by the Appellants.

- 3.5 Since the amendment in claim 1 does not amount to an allowable disclaimer and violates Article 123(2) EPC, also the 1st auxiliary request is not allowable.

Claim 1 of the Appellants' 2nd auxiliary request

4. *Articles 84, 123(2) and (3) and Rule 57a EPC*

- 4.1 Claim 1 of the 2nd auxiliary request (see above point V) differs from claim 1 of the patent in suit in that in the second step (ii) the time range "1-10 minutes" was replaced by "1-5 minutes".

4.2 The Board notes that the application of the patent in suit discloses for the second step a range of 1 to 10 minutes and a preferred range of 2 to 5 minutes (see the application as originally filed page 10, lines 17 to 22 and claims 1 and 3) and finds allowable in view of the requirements of Articles 84, 123(2) and (3) and Rule 57a EPC to reduce the scope of granted claim 1 by replacing the broader time range of 1 to 10 minutes by that of 1 to 5 minutes (see also e.g. T 2/81, OJ EPO 1982, 394).

5. *Priority (Articles 87(1) and 89 EPC)*

5.1 The Appellants relied on the finding of the Opposition Division (see point 6.3 of the decision under appeal) that the range "1-5 minutes" in claim 1 of this request was entitled to the priority dates. The Opposition Division considered that the reduced scope of this range does not change the nature of the process disclosed in the priority documents.

However, as recalled already above at points 1.1 and 1.4, the Enlarged Board of Appeal has clarified in its opinion G 2/98 that the entitlement to priority is not to be assessed by investigating whether the nature of the invention of the European patent or patent application is the same of that of the prior application, but rather establishing if the person skilled can directly and unambiguously derive the claimed subject-matter from the prior application. Therefore, the above cited reasoning in the decision under appeal cannot be upheld.

5.2 The time lengths of the second step of the claimed process that are disclosed in the GB priorities have already been identified above (see point 1.2) as the value "*about 3 minutes*" and the range "*about 1-6 minutes*".

5.3 In view of the emphasis given by the Appellants to the fact that in claim 1 of the GB priorities the range "*1-6 minutes*" is preceded by "*about*" (see point 4.1 in the grounds of appeal) the Board has considered whether or not the range "*1-5 minutes*" could possibly be considered equivalent to "*about 1-6 minutes*".

In this respect, the Board notes that the patent in suit discloses a mean residence time range of "*1 to 10 minutes*" and a **preferred** one of "*2 to 5 minutes*" (see claims 1 and 3, and also page 4, lines 48 to 50). The same disclosure is present in the original patent application (see the portion thereof already identified above at point 4.2) although, meaningfully, claims 1 and 3 in the patent application use "*about*" in combination with both these time ranges. Therefore, it is apparent that, even when introduced by an "*about*", the Appellants themselves considered the difference of one time unit, i.e. one minute, in these ranges as significant. Therefore the Board concludes that feature "*1-5 minutes*" in present claim 1, being substantially different from the "*about 1-6 minutes*" of both GB applications.

5.4 Therefore, the above identified mean residence times disclosed in the GB applications are found not sufficient to render disclosed therein also the whole range of "*1-5 minutes*", in particular, since there is

no direct and unambiguous disclosure in the cited priorities of a process wherein the second step lasts "5 minutes".

5.5 The Board concludes that at least the process of claim 1 of this request wherein the second step lasts "5 minutes" is not entitled to any of the claimed priority dates, but only to the filing date of 26 October 1989 (Article 89 EPC).

6. *Novelty (Article 100(a) in combination with Articles 52(1) and 54 EPC)*

6.1 Of course, also for this request E7 represents state of the art relevant under Article 54(3) EPC for the subject-matter of the claims that is have been found not entitled to priority (see above point 2.1).

6.2 Since the features of the process according to E7 conform completely to those of the present invention, including the time range "2-**5 minutes**" (see above points 2.2 and 2.3), it follows that this prior art discloses in particular a process according to claim 1 of the present request, wherein the second step lasts **5 minutes**, i.e. a claimed process that has been found not entitled to any of the two priority dates (see above point 5.5).

6.3 Therefore, present claim 1 is found not to meet the requirements of Articles 52(1) and 54 EPC.

Hence, also the Appellants' 2nd auxiliary request of the Appellants is found not allowable.

Claim 1 of the Appellants' 3rd auxiliary request

7. *Article 123(2) EPC*

7.1 The "proviso" present in claim 1 of this request (see above points II, IV and V) has undisputedly no basis in the application of the patent in suit as originally filed and, thus, clearly infringes the requirements of Article 123(2) EPC.

7.2 The Appellants have maintained that since such amendment was an allowable disclaimer of the prior art disclosed in E7, it would be allowable also in view of Article 123(2) EPC, as confirmed also in the decision of the Opposition Division (see point 7.1 of the decision under appeal).

7.3 As already recalled above (see point 3.4) the recent decisions of the Enlarged Board of Appeal G 1/03 and 2/03 have established that an amendment removing **more** than is necessary to restore novelty does not represent an allowable disclaimer and, thus, must comply with the requirements of Article 123(2) EPC.

7.4 The Board observes, therefore, that in the present case the only portion of the originally patented subject-matter which may be excised by using a disclaimer, i.e. regardless of the requirements of Article 123(2) EPC, is that for which the process disclosed of E7 represents prior art under Article 54(3) EPC.

In the process disclosed in E7 it is mandatory to feed a "*solid water soluble alkaline inorganic material*" (see E7, claim 1) into the high-speed mixer/densifier.

Instead the "*proviso*" added in present claim 1 excludes **all** initially claimed processes wherein a liquid acid precursor of an anionic surfactant is fed to the high-speed mixer/densifier, i.e. **independently** as to which other components are fed into this apparatus.

Therefore, the Board concludes that the amendment introduced in claim 1 of this request removes from the originally patented subject-matter **more** than is necessary to restore novelty vis-à-vis the prior art under Article 54(3) EPC disclosed in E7 and, hence, does not amount to an allowable disclaimer thereof.

7.5 Since the amendment in claim 1 does not amount to an allowable disclaimer and since it evidently violates Article 123(2) EPC, also the 3rd auxiliary request is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P. Krasa