

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 23 September 2004

Case Number: T 0515/99 - 3.3.6

Application Number: 89909084.9

Publication Number: 0435876

IPC: C11D 11/00

Language of the proceedings: EN

Title of invention:
Compositions and methods to vary color density

Patentee:
ECOLAB INCORPORATED

Opponents:
NOVOZYMES A/S
GENENCOR INTERNATIONAL INC.

Headword:
Gelled concentrate/ECOLAB

Relevant legal provisions:
EPC Art. 123(2)
EPC R. 35(12) last sentence

Keyword:
"Admissibility of amendments (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0515/99 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 23 September 2004

Appellant: ECOLAB INCORPORATED
(Proprietor of the patent) 370 North Wabasha Street
Saint Paul, MN 55101 (US)

Representative: Sternagel, Fleischer, Godemeyer & Partner
Patentanwälte
An den Gärten 7
D-51491 Overath (DE)

Respondent I: NOVOZYMES A/S
(Opponent 01) Krogshøjvej 36
DK-2880 Bagsvaerd (DK)

Representative: Zimmer, Franz-Josef, Dr
Grünecker, Kinkeldey,
Stockmair & Schwanhäusser
Anwaltssozietät
Maximilianstrasse 58
D-80538 München (DE)

Respondent II: GENENCOR INTERNATIONAL INC.
(Opponent 02) 925 Page Mill Rd.
Palo Alto, CA 94304-1013 (US)

Representative: Greaves, Carol Pauline
MEWBURN ELLIS
York House
23 Kingsway
London WC2B 6HP (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 9 March 1999
revoking European patent No. 0435876 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Krasa
Members: G. N. C. Rathes
P. H. Mühlens

Summary of Facts and Submissions

- I. This appeal is from the decision of the Opposition Division to revoke the European patent No. 435 876 for lack of inventive step. Claim 1 of the patent read:
- "A liquid concentrate composition that can be used in aqueous solution to introduce, into the surface of dyed cellulosic fabrics, local areas of variations in color density, which consists essentially of
- a) 25 to 90 wt-% of a cellulase enzyme composition;
 - b) 0,01-10 wt-% of a thickening agent; and
 - c) 0,1-50 wt-% of a buffer that can maintain the pH of the aqueous solution to about the optimum pH for enzyme activity; wherein the variation in color density is substantially the same as that produced by conventional pumice stone processing."

II. Two notices of opposition, based on insufficient disclosure (Articles 100(b) and 83 EPC), extension of the subject-matter of the patent beyond the content of the application as filed (Article 100(c) and Article 123(2) EPC), lack of novelty and inventive step (Articles 100(a), 54 and 56 EPC), were filed.

III. In its decision, the Opposition Division found that the amendment, which in the course of the examination proceedings had led to the wording "A liquid concentrate composition" - whereas Claim 1 of the European patent application as filed read in this respect "A gelled concentrate composition" - did not violate Article 123(2) EPC.

However with respect to inventive step, it found that the subject-matter of none of the respective Claims 1 of the pending requests did involve an inventive step.

- IV. The proprietor (hereinafter appellant) filed an appeal and contested these findings of the Opposition Division and submitted a main request and five auxiliary requests; the main, the first and second auxiliary requests were those attached to the decision of the Opposition Division dated 31 October 1996, the third and fifth auxiliary requests were filed under cover of the letter dated 29 September 2003, the fourth auxiliary request under cover of the letter dated 9 September 2004.

Claim 1 of the main request and of the auxiliary requests 1 and 2 differ from Claim 1 as granted in that "A liquid concentrate composition" was replaced by "A thickened liquid concentrate composition".

Claim 1 of the auxiliary requests 3, 4 and 5 differ from Claim 1 of the main request in that "A thickened liquid concentrate composition" was replaced by "A gelled liquid concentrate composition".

During oral proceedings the appellant filed auxiliary requests 6 and 7.

- V. Opponent 2 (hereinafter respondent II) reiterated its arguments put forward before the Opposition Division, i.e. that Claim 1 of the main request and of the auxiliary requests 1 to 5 had no basis in the application as originally filed (Article 123(2) EPC).

Opponent 1 (hereinafter respondent I), substantiated, *inter alia*, its arguments under Articles 100(c) and 123(2) EPC which were, in essence, the same as that of respondent II.

Respondent II withdrew its opposition by its letter dated 2 April 2001.

VI. In its letter dated 5 May 2001 the appellant referred to document

(B) Jürgen Falke, Manfred Regitz, "Römpp Chemie Lexikon", Gele, Georg Thieme Verlag, 1992, 1511;

In its letter dated 5 June 2003, respondent I referred to document

(A) Jürgen Falke, Manfred Regitz, "Römpp Chemie Lexikon", Verdickungsmittel, Georg Thieme Verlag, 1992, 4890.

VII. Oral proceedings took place on 23 September 2004.

The appellant requested that the patent be maintained according to the main request dated 31 October 1996 or to auxiliary requests 1 or 2 also dated 31 October 1996, auxiliary requests 3 or 5 filed with letter dated 29 September 2003, or auxiliary request 4 with letter dated 9 September 2004, or auxiliary requests 6 or 7 filed in the oral proceedings.

Respondent I requested that the appeal be dismissed.

Reasons for the Decision

1. *Main request, auxiliary requests 1 and 2*
Article 123(2) EPC
- 1.1 The respective Claims 1 of all these requests are directed to a "thickened liquid concentrate composition, which consists essentially of" the three components a), b) and c) as defined (see above IV).
- 1.2 Claim 1 as originally filed on the other hand read on "a gelled concentrate composition" . . . which consists essentially of" the same three components a), b) and c) as above. In fact, apart from the replacement of the original "A gelled concentrate composition" by "A thickened liquid concentrate composition", Claim 1 as filed and the respective Claims 1 of the requests now under consideration are identical.
- 1.3 The appellant argued orally and in writing that it was allowable to replace a "gelled concentrate composition" by "a thickened liquid concentrate composition" since the description as originally filed disclosed: "The cellulase treatment compositions of the invention can be manufactured in the form of a thickened liquid or a gel. Common organic and inorganic compositions can be used to produce the thickened or gelled product form." (page 16, lines 22 to 25).
According to the appellant, this passage proved that in the European application as filed the terms "thickened liquid" and "gel" were used synonymously and, hence, interchangeable.

It also pointed to the kind of thickeners to be used, such as polymers, polyethylene waxes and xanthan guar gum, which would help to adjust either a thickened liquid or a gel which were listed from the description (page 16, line 32 to page 17, line 4) without mentioning any difference.

It concluded that a skilled person who had to rely on the whole contents of the European application as filed would have understood from all these passages that within the disclosure of this application thickened liquid, gel, thickened product, and gelled product meant all the same and any information given in respect to one composition would also hold for the other differently designated composition.

The Board does not agree. The only place in the application as filed which discloses the amounts of the components of the compositions concerned is Claim 1 which, as already indicated, refers to "A gelled concentrate composition," (see point 1.2).

A thickened liquid concentrate composition comprising the three components a), b) and c) in the amounts given was not disclosed by the specification as originally filed.

The question to be answered is whether in spite of this, the features a), b) and c) were originally disclosed also in combination with "a thickened liquid concentrate composition" since this expression is synonymous to "a gelled concentrate composition" as alleged by the appellant.

In this respect, the appellant also maintained that a patent specification may be its own dictionary which means that a technical term may be defined and used therein with a meaning different from its normal one as it could be found e.g. in text books.

However, in the patent application as filed neither a thickened liquid concentrate composition nor a gelled concentrate composition is defined. The use of these terms, even in the same sentence, cannot be replaced by a clear definition, be it explicit or implicit.

In the absence of such definitions, technical terms have to be given their normal meaning as a skilled person would understand them according to his common general knowledge (Rule 35(12) EPC). The latter is evidenced e.g. by document (B) as follows:

"A gel, a term derived from gelatine, is a designation commonly used in colloid chemistry for liquid and gas rich, form stable and easily deformable dispersion systems comprising at least two components which consist of a solid, colloidal substance having long or branched particles (*inter alia*, bentonites, polysaccharides, which are thickening agents often called gelling agents) and a liquid (mostly water) as dispersion medium" (translated by the Board).

As to the appellant's hint to the use of thickeners, reference was made to document (A):

"Thickeners, mostly high molecular compounds, ...soak up liquids and are used to increase the viscosity of

liquids, mostly water. Thickeners are used for...improving the thixotropic properties of gels."

In conclusion, in the application as filed, two alternatives were disclosed for manufacturing the cellulase treatment compositions of the patent in suit: a thickened liquid or a gel (application as filed, page 16, lines 22 to 24 and patent in suit, page 7, lines 6 and 7) both terms designating products being distinguished from one another by displaying different physical properties.

Therefore, in the absence of additional pertinent information, properties (here: the amounts of the components of the composition) disclosed in combination with one particular product cannot be related to the other alternative product.

It follows that a "thickened liquid concentrate composition" which consists essentially of

- "a) 25 to 90 wt-% of a cellulase enzyme composition;
- b) 0,01-10 wt-% of a thickening agent; and
- c) 0,1-50 wt-% of a buffer"

was not disclosed in the application as originally filed (see above point 1.4).

1.4 Hence, the European patent application had been amended in a way that it contained subject-matter which extended beyond the content of the application as filed.

The respective claims 1 contravene Article 123(2) EPC.

The main request and the auxiliary requests 1 and 2 are, therefore, not allowable.

2. *Auxiliary requests 3 to 5*

2.1 The respective Claims 1 of the auxiliary requests 3 to 5 are identical and differ from Claim 1 of the main request in that "A thickened liquid concentrate composition" was replaced by "A gelled liquid concentrate composition".

2.2 The application as originally filed did not disclose the expression "gelled liquid concentrate composition". Therefore, no explicit support can be found in the application as originally filed for a gelled liquid concentrate composition", let alone an explicit or implicit disclosure of this term with the features a), b) and c) of these claims 1 which, thus, violate Article 123(2) EPC.

For this reason auxiliary requests 3 or 5 are not allowable.

3. *Auxiliary requests 6 and 7*

3.1 The respective Claims 1 of these requests are identical and differ from Claim 1 of the main request in that "A thickened liquid concentrate composition" was replaced by "A liquid concentrate composition".

3.2 There was no support in the application as originally filed for a liquid concentrate composition consisting essentially of

- a) 25 to 90 wt-% of a cellulase enzyme composition;
- b) 0,01-10 wt-% of a thickening agent; and
- c) 0,1-50 wt-% of a buffer.

The Board has also considered Claim 6 as originally filed which disclosed a liquid concentrate composition; this claim read as follows:

"A liquid concentrate composition that can be used in aqueous solution to introduce, into the surface of dyed cellulosic fabrics, local areas of variations and color density, which consists essentially of

- a) at least 25 wt-% of cellulase enzyme composition that can provide to an aqueous treatment solution at least 1500 CMC units of enzyme per liter of solution;
 - b) an alcoholic diluent; and
 - c) a buffer that can maintain the pH of the aqueous solution to about the cellulase enzyme optimum pH;
- wherein the variation in color density is substantially the same as that produced by conventional pumice stone processing."

It follows that this original claim 6 did not disclose a liquid concentrate composition in combination with a thickening agent.

3.3 Hence, the respective claims 1 were amended in such a way that their subject-matter extended beyond the content of the application as filed (Article 123(2) EPC).

3.4 The auxiliary requests 6 and 7 are not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:

G. Rauh

P. Krasa