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D E C I S I O N
of 27 June 2002

Case Number: T 0875/99 - 3.3.6

Application Number: 87310765.0

Publication Number: 0271312

IPC: C11D 3/395

Language of the proceedings: EN

Title of invention:

Laundry composition containing peroxyacid bleach and soil release agent

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponents:

Henkel Kommanditgesellschaft auf Aktien
RHODIA CHIMIE
Unilever PLC

Headword:

Peroxyacid bleach and soil release agent/PROCTER & GAMBLE

Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Admissibility of appeal (yes)"
"Late filed documents - admitted"
"Remittal to first instance (yes)"

Decisions cited:

T 0611/90, T 0238/92, T 0715/95, T 1002/92, T 0326/87,
T 0223/95

Catchword:

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Case Number: T 0875/99 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 27 June 2002

Appellant: Unilever Plc
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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 12 July 1999
concerning maintenance of European patent
No. 0 271 312 in amended form.

Composition of the Board:

Chairman: P. Krasa
Members: L. Li Voti
C. Holtz

Summary of Facts and Submissions

I. The present appeal is from the interlocutory decision of the Opposition Division relating to the maintenance in amended form of European patent No. 0 271 312, concerning a laundry composition comprising peroxyacid bleach and soil release agent.

II. Three notices of oppositions were filed against the patent, wherein opponents 01 and 02 and opponent 03, UNILEVER PLC, (the Appellant) sought revocation of the patent inter alia on the grounds of Article 100(a) EPC, in particular because of the alleged lack of both novelty and inventive step of the claimed subject-matter.

The oppositions were based inter alia upon the following document:

(5)= GB-A-1534641

III. In its decision, the Opposition Division found that the claimed invention and the patent in suit, as amended according to the Patent Proprietor's (the Respondent) second auxiliary request, fulfilled the patentability requirements of the EPC and in particular that the claimed subject-matter was novel and involved an inventive step over document (5).

IV. An appeal was filed against this decision in the name of UNILEVER PLC and UNILEVER N.V.

In the statement of the grounds of appeal it was argued that the subject-matter of the claims accorded by the opposition division lacked novelty or inventive step in

the light of the following three new documents which had not been relied upon at first instance:

(20)= US-A-4136038;

(22)= EP-A-0213729;

(23)= EP-A-0213730.

A fourth document (21) "The Merck Index, 1968, page 968", was filed in order to show that sodium tripolyphosphate, used in document (20), is an alkalinity source.

V. The Respondent refuted in writing the Appellant's arguments and objected inter alia to the admissibility of the appeal and of the newly filed documents.

VI. The Board informed the parties with a communication dated 20 November 2001 inter alia that

- UNILEVER N.V. had not been an opposing party at first instance.

VII. Oral proceedings, which were also attended by opponent 01 as a party as of right under Article 107 EPC, second sentence, were held before the Board on 27 June 2002.

VIII. As to the admissibility of the appeal and of the new documents the Respondent submitted in writing and orally that:

- the statement of the grounds of appeal did not contain any discussion whatsoever of the decision

under appeal, but only relied on four new documents to the exclusion of those it had relied on at first instance; moreover, if these new documents were not admitted into the proceedings, the grounds of appeal would remain unsupported;

- the appeal was therefore inadmissible;
- the new documents (20) to (23) were late filed since the claims accorded by the opposition division had been already filed in October 1997, i.e. well ahead of the oral proceedings held before the opposition division in February 1999; the Appellant had therefore ample time during the opposition proceedings to carry out a supplementary search with respect to this claimed subject-matter;
- these new documents were, moreover, not more relevant than document (5), considered to represent the closest prior art at first instance; in fact, the new documents did not disclose a combination of a peroxyacid bleaching agent and a cellulose ether soil release polymer as required in the patent in suit or the importance of such a combination;
- documents (20) to (23) should therefore not be admitted into the proceedings.

Furthermore, the Respondent demanded to be given sufficient time for carrying out additional experiments if the appeal were found admissible and the new documents were admitted; under these circumstances it was necessary, for the sake of procedural fairness, to

remit the case to the first instance for further prosecution.

Opponent 01 did not submit any arguments as to the admissibility of the appeal and of the new documents.

IX. The Appellant submitted as regards the issue of admissibility that

- a valid appeal had been filed on behalf of Unilever PLC;
- the appeal relied on the same grounds raised against the patent in suit in the opposition proceedings;
- it was admissible in the appeal stage to rely on new evidence;
- the reasons for the decision under appeal did not need therefore to be discussed;
- moreover, since the search for relevant prior art had to be carried out taking into account cost-efficiency factors, it could not reasonably cover every possibly claimed alternative; only after having received the written decision at first instance, it became appropriate and necessary to conduct a further search;
- the new documents (20), (22) and (23) were more relevant than document (5), considered to be the closest prior art in the decision of the opposition division; the latter document in fact required very low amounts of cellulose ether and

thus a ratio of available oxygen to soil release polymer outside the claims. On the contrary, the newly cited documents disclosed a combination of peroxyacid bleach and cellulose ether soil release polymer and a ratio of available oxygen to soil release polymer falling within the scope of the claims;

- it was thus in the public interest that these documents be admitted into the proceedings even if cited for the first time during appeal proceedings.

The Appellant did not submit any observation as to the remittal of the case to the first instance.

- X. The Appellant requested that the decision under appeal be set aside and that the patent be revoked.

The Respondent requested that the appeal be rejected as inadmissible; alternatively that the new documents (20) to (23) not be admitted into the proceedings; alternatively if the appeal was considered admissible and documents (20) to (23) were admitted, that the appeal be dismissed; alternatively that the case be remitted to the first instance for further prosecution; alternatively that a question be referred to the Enlarged Board of appeal; alternatively that the decision be set aside and the patent maintained on the basis of either the first or the second auxiliary request filed with the letter of 28 May 2002.

Reasons for the Decision

1. *Admissibility issues.*

1.1 The Appellant

The Board remarks that the opposition by Appellant/opponent 03 was filed at first instance only in the name of Unilever PLC. Unilever N.V., which was noted in the notice of appeal as co-appellant, is therefore not a party to the appeal proceedings.

1.2 Admissibility of the appeal

In the present case the statement of the grounds of appeal refers to the same grounds as at the first instance (lack of novelty and/or of inventive step) and identifies specific passages of new documents to the exclusion of those cited at first instance, which new documents give rise to fresh arguments against the patent (see points IV and IX above).

The Board finds therefore the appeal to be admissible.

In fact appeals may rely on fresh facts and evidence and they do not need to deal with the evidence discussed in the decision under appeal, as long as the appeal relies on the same grounds for opposition as examined at first instance (see e.g. T 611/90, OJ EPO 1993, 050, point 2 of the reasons).

A final assessment of the relevance of this new evidence and thus of the fact whether it supports the grounds of appeal is of no significance in deciding this formal issue of the admissibility of the appeal.

1.3 Admissibility of the new cited evidence

1.3.1 Under the case law of the Boards of appeal, evidence cited for the first time in the statement of the grounds of appeal may still be considered as not being late-filed, if it can be considered to be a response to issues considered essential in the decision of the first instance for which the opposing party had not sufficient time to carry out a search in the first instance proceedings (for example, in case of substantial amendments to the claims at a late stage of the proceedings) (see e.g. T 238/92, not published in the OJ EPO, point 2.2 of the reasons).

In the present case the Appellant has admitted that the claims accorded by the first instance (with exception of minor amendments) had indeed been submitted already in October 1997, i.e. well ahead of the oral proceedings held before the first instance in February 1999. Therefore it would have been appropriate for the Appellant to carry out a further search, focusing on these claims, already in the course of the proceedings before the opposition division and the Appellant had indeed sufficient time for it.

In the present case there were therefore no circumstances which could excuse the delay in producing the evidence in question.

The new documents (20) to (23) must therefore in the Board's view be considered as late filed (see e.g. T 715/95, not published in the OJ EPO, point 3 of the reasons).

1.3.2 It is established case law that even late filed evidence should only be admitted at the appeal stage, if it can be considered at first sight to be more

relevant than the evidence relied on at first instance and to be prejudicial to the maintenance of the patent (see, e.g. T 1002/92 OJ EPO 1995, 605, point 3.4 of the reasons).

In respect to late filed evidence, the Board finds it appropriate to require that its relevance in comparison to the evidence considered in the decision at first instance must be derivable already from the statement of the grounds of appeal itself, i.e. from the Appellant's written statement read in combination with the therein indicated specific passages of the cited evidence, without the need of further examination by the Board.

From a consideration of the written submissions contained in the statement of the grounds of appeal and of the cited passages of the documents (20) to (23), it is immediately apparent to the Board that the new cited documents explicitly disclose a combination of the cellulose ether soil release polymer and of a peroxyacid bleaching agent and also disclose or suggest a ratio of available oxygen to soil release polymer corresponding with that required in the claims of the patent in suit, which was not the case for document (5) considered to represent the closest prior art at first instance.

This means that these documents are at first sight more relevant than document (5) and that it is highly likely that they are prejudicial to novelty and/or inventive step of the claimed subject-matter.

Therefore the Board concludes that they should be admitted into the proceedings.

2. *Remittal*

The Respondent requested to be given sufficient time for carrying out additional experiments if the appeal were found admissible and the new documents were admitted and thus that the case be remitted to first instance for further prosecution.

Since the new documents amount to a fresh case against the patent in suit and furthermore put the maintenance of the patent in doubt, the Board finds that the case should be examined in the light of the new documents at two levels of jurisdiction; therefore, the Board considers it appropriate to make use of its discretionary powers under Article 111(1) EPC and to remit the case to first instance for further prosecution (see e.g. T 326/87, OJ EPO 1992, 522, point 4 of the reasons and T 223/95, not published in the OJ EPO, point 5 of the reasons).

Order

For these reasons it is decided that:

1. The appeal is admissible.
2. The new documents (20) to (23) are admitted into the proceedings.
3. The decision under appeal is set aside.
4. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

M. Dainese

P. Krasa