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**Datasheet for the decision
of 24 October 2006**

Case Number: T 1234/04 - 3.3.10

Application Number: 96119763.9

Publication Number: 0779351

IPC: C09K 3/30

Language of the proceedings: EN

Title of invention:

Near-azeotropic compositions constituted by hydrogenated fluorocarbons and hydrocarbons, suitable as propellant fluids for aerosol

Patentee:

Solvay Solexis S.p.A.

Opponent:

BOEHRINGER INGELHEIM Pharma GmbH & Co KG

Headword:

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Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendments (not allowable) - undue generalisation of examples"

Decisions cited:

T 0288/92, T 0680/93

Catchword:

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Case Number: T 1234/04 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 24 October 2006

Appellant:
(Patent Proprietor)

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Respondent:
(Opponent)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 6 August 2004
revoking European patent No. 0779351 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: R. Freimuth
Members: P. Gryczka
J.-P. Seitz

Summary of Facts and Submissions

- I. The mention of the grant of European patent 0 779 351, in respect of European patent application No. 96119763.9, filed on 10 December 1996, was published on 10 July 2002.

- II. Notice of opposition was filed by the Respondent (Opponent) in which revocation of the patent in its entirety was requested on the grounds of lack of novelty and inventive step (Article 100(a) EPC).

- III. In a decision issued in writing on 6 August 2004, the Opposition Division revoked the patent. The decision was based on a main request corresponding to the patent as granted and on 7 auxiliary requests submitted during the oral proceedings before the Opposition Division.

The Opposition Division came to the conclusion that the subject-matter of the then pending main request, first, fourth, fifth and seventh auxiliary request was not novel. The amendments carried out in the second, third and sixth auxiliary request did not comply with the requirements of Article 123(2) EPC since the application as filed did not provide a basis for the use of the propellant fluids defined in the patent in suit in aerosol formulations comprising a solvent, more precisely ethanol, in any concentration.

- IV. On 15 October 2004, the Appellant (Proprietor of the patent in suit) lodged an appeal against the above decision. During the oral proceedings held before the Board on 24 October 2006 the Appellant defended the maintenance of the patent in suit on the basis of a

main request and an auxiliary request both requests filed during said oral proceedings and superseding all previous requests.

The main request comprised a set of 8 claims, independent claim 1 reading as follows:

"1. Use as propellant fluid for aerosol formulations comprising ethanol of mixtures containing 1,1,1,2-tetrafluoroethane (HFC-134a), 1,1,1,2,3,3,3-heptafluoropropane (HFC-227ea) and, optionally, also n-butane and/or isobutane, selected from the group consisting of:

- | | | |
|----|--|--------------|
| A) | 1,1,1,2-tetrafluoroethane (HFC-134a) | 5-88% by wt |
| | 1,1,1,2,3,3,3-heptafluoropropane (HFC-227ea) | 12-95% by wt |
| B) | 1,1,1,2-tetrafluoroethane (HFC-134a) | 10-87% by wt |
| | 1,1,1,2,3,3,3-heptafluoropropane (HFC-227ea) | 12-81% by wt |
| | n-butane | 1-30% by wt |
| C) | 1,1,1,2-tetrafluoroethane (HFC-134a) | 18-69% by wt |
| | 1,1,1,2,3,3,3-heptafluoropropane (HFC-227ea) | 30-81% by wt |
| | Isobutane | 1-30% by wt |

but excluding use of a mixture consisting of 50% by weight of HFC-134a and 50% by weight of HFC-227ea as propellant fluid for a solution aerosol formulation consisting of

(a) the propellant fluid;

- (b) butixocort propionate (11-beta-hydroxypregn-4-ene-3,20-dione-21-thiopropionate-17-butyrate);
- (c) 12% by weight relative to the total weight of the formulation ethanol;
- (d) 0.25 weight% relative to the total weight of the formulation water; and
- (e) 0.0025 weight% relative to the total weight formulation sorbitan trioleate."

The auxiliary request comprised a set of 6 claims, independent claim 1 of that request differing in essence from claim 1 according to the main request in that the mixture of propellant fluid of type C was deleted.

- V. According to the Appellant the amendment of claim 1 of the main request and the auxiliary request specifying that the propellant mixtures were used for aerosol formulations comprising ethanol was based on the examples 6 and 7. Since the concentration of ethanol was not critical, these examples could be generalised to any concentration of ethanol as covered by the amended claim 1. A further support for this amendment was provided by the solubility tests reported in the application as filed from which it was derivable that the propellants were intended to be used in aerosol formulations comprising solvents and in particular ethanol. Therefore the amendment of claim 1 did not extend beyond the content of the application as filed.
- VI. The Respondent argued that there was no basis in the application as filed for the amendment carried out by the Appellant in claim 1 of each request. The examples only concerned specific concentrations of ethanol and

propellant fluids and, thus, could not be considered as a proper basis for the amended claim 1. The description of the application as filed only referred to solubility tests without describing aerosol formulations containing a solvent, with the consequence that claim 1 extended beyond 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 either his main or auxiliary request, both requests filed during the oral proceedings held before the Board.

The Respondent requested that the appeal be dismissed.

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 request

2. *Amendments*

2.1 Whereas claim 1 as filed was directed to the use of propellants fluids for aerosol, claim 1 of the main request has been amended, *inter alia*, by specifying that the propellant fluid is used for aerosol formulations comprising ethanol. The Respondent objected to that feature as generating subject-matter

extending beyond the content of the application as filed.

2.2 In order to determine whether or not the subject-matter of a claim in a patent extends beyond the content of the application as filed it has to be examined whether that claim comprises technical information which a skilled person would not have objectively and unambiguously derived from the application as filed (see decisions T 288/92, point 3.1 of the reasons; T 680/93, point 2 of the reasons; neither published in OJ EPO).

2.3 The Appellant referred to the examples 6 and 7 of the application as filed as forming the basis for supplementing claim 1 with the feature that the aerosol formulation comprises ethanol. It is true that in the entire application as filed aerosol formulations comprising ethanol are only disclosed in these examples. Thus, it has to be established whether or not the particular formulations disclosed therein form a proper basis for generalising that the propellants fluids defined in claim 1 are used in any aerosol formulation comprising ethanol.

Example 6 refers to a particular colony formulation containing 4% by weight perfume, 51% by weight ethanol and 45% by weight of a specific propellant of the "A type" consisting of 80% by weight of HFC-134a and 20 % by weight of HFC-227ea (example 6 in connection with example 1, table 1, page 12). Example 7 concerns a particular preparation of hair spray containing 4% by weight of polyvinylpyrrolidone, 33% by weight of ethanol and 63% by weight of a specific propellant of

the "B type" consisting of 60% by weight of HFC-134a, 30% by weight of HFC-227 and 10% by weight of HC-600 (example 7 in connection with example 3, table 1, page 12).

In the Board's judgement, the skilled person derives from these examples nothing more than the bare disclosure of the specific characteristics of these formulations, namely the combination of particular active compounds with a specific amount of ethanol and a specific amount of a particular propellant mixture.

Therefore, the original disclosure of two specific formulations cannot support the generalisation indicated in claim 1 which results in covering the use of any propellant fluid of the A and B type as propellant in aerosol formulations comprising ethanol at any concentration and in combination with any other further ingredients. Hence, in the context of claim 1 the feature defining that the aerosol formulation comprises ethanol is an undue generalisation of a particular embodiment of two specific examples which generates fresh subject-matter.

2.4 The Appellant also referred to the paragraph introducing the examples at page 8, to the last paragraph of page 11 and to table 2 at page 13 of the application as filed as possible support for the amendment of claim 1. However, these parts of the description only refer to solubility tests carried out in order to establish the physico-chemical characteristics of the propellant mixtures and do not refer to aerosol formulations *per se*. To transform these solubility tests into the feature requiring that

the aerosol formulation *per se* comprises ethanol in any concentration provides the skilled person with technical information which is not directly and unambiguously derivable from the application as filed.

- 2.5 For these reasons, the Board concludes that amended claim 1 of the main request extends the subject-matter claimed beyond the content of the application as filed, thus contravening the provisions of Article 123(2) EPC.

Auxiliary request

3. *Amendments*

This conclusion of extending beyond the content of the application as filed applies also to amended claim 1 of the auxiliary request which differs from claim 1 of the main request only in that the propellant fluid of type "C" has been deleted, but still covers the use of the propellant fluids of the "A" and "B" type in any aerosol formulation comprising ethanol.

4. Therefore, the Board arrives at the conclusion that both requests submitted by the Appellant are not allowable and must be rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

C. Moser

R. Freimuth