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**Datasheet for the decision
of 4 November 2010**

Case Number: T 2029/08 - 3.3.06

Application Number: 04804068.7

Publication Number: 1704220

IPC: C11D 17/00

Language of the proceedings: EN

Title of invention:

Compositions and process for preparing cleansing bars comprising low levels of soluble surfactant for enhanced fragrance deposition/longevity

Applicant:

Unilever PLC, et al

Opponent:

-

Headword:

Cleansing bar/UNILEVER

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

EPC Art. 83, 84

Keyword:

"Article 123(2): Yes"

"Clarity: yes"

"Sufficiency of disclosure: yes"

Decisions cited:

-

Catchword:

-



Case Number: T 2029/08 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 4 November 2010

Appellant:

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and

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 2 May 2008
refusing European application No. 04804068.7
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: P.-P. Bracke
Members: P. Ammendola
J. Van Moer

Summary of Facts and Submissions

- I. This appeal is from the decision of the Examining Division to refuse the European patent application No. 04 804 068.7, internationally published as WO 2005/068601, relating to compositions and process for preparing cleansing bars comprising low levels of soluble surfactant for enhanced fragrance deposition/longevity. The originally filed claims 1 to 9 as internationally published were directed to a bar composition characterized, *inter alia*, by a parameter called "*performance enhancement factor*".
- II. In the communication of 2 November 2007 the Examining Division commented, *inter alia*, the compliance of the then pending claim 1, still directed to a cleansing bar composition, with the requirements of Articles 83 and 84 EPC 1973. In particular, the following passages contained at points 2.1 and 4.1 of this communication are relevant for the present decision:

"2.1 . Claim 1 defines solubility as dissolution of surfactant active or active combination of greater than about 1 % by weight in water at 40deg C, however it does not stipulate the time duration or the form of the surfactant active ie. is the active in the bar or a separate component?

If it is considered that the measurement should be taken from the bar then the dimensions of the bar are of importance particularly as the surface area exposed to the water will affect the outcome of a solubility measurement; current claim 1 does not specify any bar dimensions. If the measurement should be taken with the surfactant active added as a separate component to a

volume of water at 40 degC then the relative amounts of water to active should be stipulated and also whether stirring takes place; current claim 1 does not specify such a ratio or such stirring.

It should be noted that there appears to be no passage within the description which would enable this objection to be overcome, and that deletion of the solubility definition would also not be allowable under Article 123(2) EPC."

"4.1 ... the application lacks sufficiency of disclosure under Article 83 EPC because the skilled reader is in no position to know how to calculate the solubility of the active as argued under point 2.1 ..."

The set of amended claims representing the sole final request of the Applicant was limited to process claims only.

The Examining Division found in the decision under appeal that claim 1 of this final request contained added subject matter and contravened Article 83 and 84 EPC 1973.

III. The Applicant (hereinafter "Appellant") lodged an appeal against this decision.

With Facsimile of 29 October 2010 the Appellant withdrew its previous requests and filed a single set of three claims labelled as main request. It then submitted with a Facsimile of 2 November 2010 amended description pages 1, 4, 9, and 10.

IV. Claim 1 of the **main request** reads as follows:

*"1. A personal cleansing bar composition comprising:
(a) 0.5 % to 25 % by wt. one or more soluble surfactant actives;
(b) perfume;
(c) 0.5 % to 20 % by wt. water;
(d) 0.1 % to 70 % by wt. filler, wherein filler is everything other than surfactant, water or perfume and is a mixture of long chain saturated fatty acids and long chain saturated fatty acid soaps; wherein solubility is defined by dissolution of the surfactant active of greater than 1% by wt. in water at 40°C; and wherein the bar comprises 0 to 12.5 mol% unsaturated fatty acid and less than 5% by wt. C₁₄ or lower chain length in final soap/fatty acid mixture."*

The remaining claims 2 and 3 of the main request define preferred embodiments of the bar composition of claim 1, they are identical to original claims 2 and 3 of the application as originally filed.

V. The Appellant's arguments that are relevant for the present decision may be summarized as follows.

Claim 1 of the main request would be based on original claims 1, 4, 6 and 7 as originally filed, omitting any reference to the "*performance enhancement factor*". This omission would be allowable in view of the explicit teaching of the passage on page 10, lines 3 to 10, of the application as originally filed. Additionally, a ceiling of 25% by weight had been introduced for the soluble surfactant on the basis of page 2, line 20 of

the application as originally filed. Hence, the claims of the present main request were based on the disclosure of the application as originally filed.

As to the clarity of the definition of the "*solubility*" of the soluble surfactant in claim 1, it was entirely clear to one skilled in the art that it required the (soluble) surfactant to dissolve at a concentration of more than 1% by weight in water at 40°C and, thus, the objections of insufficiency of disclosure and of lack of clarity raised by the Examining Division in the letter of 2 November 2007 were not relevant. Moreover, present claim 1 explicitly required that this definition should not longer be construed as referring to any mixtures, complexes or blends of surfactants. A corresponding amendment of the definition of the "*solubility*" of the (soluble) surfactant was made in amended description pages 1, 4, 9, and 10.

The Appellant submitted also that none of the sets of claims previously considered by the Examining Division had a ceiling of 25% for the soluble surfactant and, thus, that it was justified to submit the application back to the Examining Division for consideration of novelty and inventive step of the claims of the present main request.

- VI. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the Examining Division for consideration of novelty and inventive step on the basis of the following application documents:

description

pages 2, 3, 5 to 8 and 11 to 30 as originally filed;

pages 1, 4, 9, and 10 filed with the Facsimile of
2 November 2010;

claims

1 to 3 of the main request filed with the Facsimile of
29 October 2010;

drawings

sheets 1/5 to 5/5 as filed and originally filed.

Reasons for the Decision

Main request

1. *Article 123(2) EPC*

- 1.1 The Board finds the wording of claim 1 of the sole pending request supported by the original claims 1, 4, 6 and 7 and by the passages of the description as originally filed indicated by the Appellant (see above section V of the Facts and Submissions). The Board wishes to additionally stress that a basis for the amended wording "*dissolution of **the** surfactant active*" (emphasis added by the Board) present in claim 1 is given at page 1, lines 24 to 27, of the originally filed description, explicitly indicating that the required solubility may refer to **single** soaps/surfactants.

1.2 The Board is satisfied that claims 2 and 3 of the present request are based respectively on the corresponding original claims with the same numbering in combination with original claims 4, 6 and 7 and with the same passages of the original description that have been found to support the wording of present claim 1.

1.3 Accordingly, the main request is found to comply with Article 123(2) EPC.

2. *Article 84 EPC 1973*

2.1 The Board is of the opinion that the claims of the present main request are clear.

The objection of the Examining Division (see above section II of the Facts and Submissions) to the clarity of the definition of the "solubility" of the (soluble) surfactant active given in claim 1 appears based on an erroneous interpretation of the claim wording "greater than 1% by wt. in water at 40°C" as if it would indicate the **minimum weight percent fraction of the starting soluble surfactant that must dissolve** (when a given amount of a surfactant, or possibly a whole bar, is treated with a given amount of water at 40°C, possibly under stirring). The Board notes however that this wording defines a minimum of "solubility", i.e. a minimum for a property that is normally expressed by indicating the **saturation concentration** of the solute into the relevant solvent. Hence, the Board finds that the skilled person could only interpret claim 1 as requiring the (soluble) surfactant to display a saturation concentration in water at 40°C of **more than 1g of surfactant for 100g of solution**. Accordingly, the

Board finds the clarity objections raised by the Examining Division manifestly irrelevant in respect to the correct interpretation of the "*solubility*" definition given in claim 1.

The Board finds it also appropriate to stress that the passage in claim 1 defining the filler ingredient "(d)" to be "*everything other than surfactant, water or perfume*" can only reasonably be interpreted as just excluding the three ingredients "(a)" to "(c)" previously mentioned in the claim . Accordingly, in this passage the term "*surfactant*" can only refer to the soluble surfactant active "(a)".

Hence, the Board concludes that the claims of the main request comply with Article 84 EPC 1973.

2.2 Even though the claims of the main request are found *per se* clear, still it is necessary in view of the requirements of Article 84 EPC 1973 to adapt the description thereto.

The Board notes that the requirement now present in claim 1 that "*the*" surfactant active (i.e. each single soluble surfactant) has to display the mandatory "*solubility*", has been reflected in the deletions made in the amended pages 1, 4, 9 and 10 of the description in order to exclude the (no longer claimed) option of considering as soluble surfactants actives also mixtures, complexes or blends of surfactants (e.g. also mixtures of *per se* soluble surfactants with *per se* insoluble surfactants). However, substantial amendments are still needed. For example, the Appellant should delete or qualify as "not according to the invention"

any statement or example referring to processes or products in which the amount of soluble surfactant is **not** limited according to claim 1 (see, **e.g.** page 1, line 18 "**or** by increasing level of perfume"; page 8, line 25 to 26 "**and/or** by increasing the level of perfume" page 6, line 8; page 16, lines 15 to 22, and examples 6 and 7).

3. *Article 83 EPC 1973*

The Examining Division has considered insufficiently disclosed the then claimed bar compositions for substantially the same reason for which it has disputed the clarity of the definition of the surfactant "*solubility*" (see above section II of the Facts and Submissions). In view of the discussion already made above at point 2.1, the Board finds also this objection of insufficiency of disclosure not relevant in respect to the correct interpretation of the "*solubility*" definition given in claim 1.

4. *Remittal*

In the present case the decision under appeal has only addressed the compliance of the then pending request with Article 123(2) EPC and with the requirements of sufficiency of disclosure and clarity.

Taking into account the request for remittal made by the Appellant and the fact that present claim 1 is substantially more limited in comparison to any of the claims directed to a bar compositions already considered by the Examining Division, the Board

considers it appropriate to remit the case to the Examining Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division with the order of further prosecution of the application.

The Registrar:

The Chairman:

D. Magliano

P.-P. Bracke