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**Datasheet for the decision
of 5 April 2011**

Case Number: T 1114/09 - 3.3.07

Application Number: 01967217.9

Publication Number: 1287198

IPC: D06M 23/02

Language of the proceedings: EN

Title of invention:
Ironing aid composition

Patent Proprietors:
Unilever N.V., et al

Opponents:
Henkel AG & Co. KGaA

Headword:

-

Relevant legal provisions:

EPC Art. 54, 111(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Novelty (yes)"
"Decision re appeals - remittal (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 1114/09 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 5 April 2011

Appellants: Unilever N.V.
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Respondents: Henkel AG & Co. KGaA
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 March 2009
revoking European patent No. 1287198 pursuant
to Article 101(2) EPC.

Composition of the Board:

Chairman: J. Riolo
Members: D. Semino
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. The appeal of the patent proprietors (appellants) lies against the decision of the Opposition Division announced at the oral proceedings on 10 February 2009 to revoke European Patent 1 287 198. The patent had been granted on the basis of 12 claims, claim 1 reading as follows:

"1. An ironing aid for use in a steam chamber of a steam ironing comprising:

(a) 0.001 to 5 wt.% of a water-soluble perfume;

(b) water with a French Hardness of 20 or below;

(c) 0.1 ppm to 3 wt.% of at least one water-soluble preservative whereby said water-soluble preservative is selected from benzyl alcohol, phenoxy ethanol and mixtures thereof; or at least one isothiazolone-based compound; and

(d) less than 0.1 wt.% of anionic, cationic, nonionic and amphoteric surfactant."

II. A notice of opposition had been filed in which revocation of the patent in its entirety was requested on the grounds of lack of novelty and lack of an inventive step (Article 100(a) EPC). The opposition was *inter alia* supported by document D1 (WO-A-00/24858).

III. The decision under appeal can be summarised as follows:

Example VI of D1 disclosed a composition comprising 0.1 wt.% of a perfume, distilled water and 3 ppm of Kathon CG. The perfume was water-soluble according to the general disclosure in the description of D1, distilled water had a French Hardness of less than 20

as shown in the disputed patent and Kathon CG was a mixture of isothiazolone-based compounds. The presence of the further ingredients of the composition of example VI of D1, namely polyvinyl alcohol, silicones and glycerin, was not excluded in the claimed composition. On the contrary the patent mentioned some polymers and glycerin as possible additional ingredients. In summary, the composition of example VI of D1 comprised the claimed ingredients in the claimed quantities and there was no evidence that it could not be used in the steam chamber of a steam iron, so that the subject-matter of granted claim 1 lacked novelty with respect to the disclosure of D1.

- IV. The patent proprietors (appellants) filed a notice of appeal against the above decision. With the statement setting out the grounds of appeal, they submitted an experimental report which by comparing the behaviour of the composition of example VI of D1 with the one of composition A of the patent in suit was meant to show that the composition according to the prior art was unsuitable for use in the steam chamber of a steam iron. A data sheet on the silicone emulsion SM 2658 used in the experiments was also attached.
- V. After a communication by the Board in which a preliminary opinion was expressed raising doubts about the lack of novelty of the subject-matter of granted claim 1 with respect to the disclosure of example VI of D1, both parties expressed in writing their wish that, in case novelty were acknowledged, the case be remitted to the Opposition Division for the analysis of inventive step.

VI. Oral proceedings were held on 5 April 2011 in the announced absence of the opponents.

VII. The arguments of the appellants can be summarised as follows:

It was unknown whether the perfume of example VI of D1 was water-soluble as required by granted claim 1.

The composition of example VI of D1 was wholly unsuitable for use in the steam chamber of a steam iron as shown by the experimental report filed with the statement setting out the grounds of appeal. The reliability of this experimental report could not be put in doubt by the few assumptions which had to be made in reproducing example VI of D1 in view of some missing information in D1 and the unavailability of certain commercial products. Moreover, these assumptions were fully justified in the report itself.

Due to the presence of the silicone emulsions and in view of the information in the data sheet of SM 2658 example VI of D1 did not unambiguously disclose a composition with the low level of surfactant required by granted claim 1.

For these reasons novelty of the ironing aid of granted claim 1 had to be acknowledged.

VIII. The arguments of the opponents (respondents) can be summarised as follows:

The disclosure on page 36, lines 1 to 7 of D1 made it clear that the perfume of example VI was water-soluble.

The composition used in the experimental report filed by the patent proprietors with the statement setting out the grounds of appeal did not correspond to the composition of example VI of D1 because the silicone emulsion SM 2658 used therein contained a higher amount of silicone polymers than the emulsion used in D1 and the silicone emulsion GE 176-12669 containing an hydroxysilicone had been replaced by the silicone emulsion SM 2658 containing an aminosilicone, so that no conclusion could be drawn from these experiments. Therefore there was no evidence to support the view of the patent proprietors that the composition of example VI of D1 was not suitable for use in the steam chamber of a steam iron.

The data sheet on SM 2658 provided by the patent proprietors had no date and was already for this reason not relevant, so that it should not be admitted into the proceedings. In view of this and also of the incomplete information in the data sheet, it could not be concluded that the composition of example VI of D1 contained an amount of surfactant above the limit in granted claim 1.

For these reasons, the Opposition Division was correct in concluding that the ironing aid of granted claim 1 lacked novelty over the disclosure in D1.

IX. The appellants (patent proprietors) requested that the decision under appeal be set aside and that novelty of the ironing aid of granted claim 1 be acknowledged.

- X. The respondents (opponents) had requested in writing that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. *Novelty*
 - 2.1 D1 relates to methods for treating fabrics by direct application, primarily to the surface of the fabrics, of certain preferred fabric colour care actives and compositions, and to articles of manufacture that facilitate the use of such fabric colour care compositions and of other known fabric care compositions to restore and/or rejuvenate colour of worn, faded colour fabrics (page 3, lines 14 to 18; claims). The compositions of D1 can also be used as ironing aids in which case an effective amount of the composition is sprayed onto the fabric and the fabric is then ironed (page 57, lines 5 to 7).
 - 2.1.1 The compositions of D1 can optionally contain a perfume (page 35, lines 1 to 4). Any type of perfume can be incorporated into the compositions (page 35, lines 11 to 12); preferably the perfume is hydrophilic and is composed predominantly of ingredients selected from hydrophilic ingredients having a ClogP of preferably less than 3.0 and ingredients having significant low detection threshold (page 26, lines 1 to 4). The hydrophilic perfume ingredients are more soluble in water than the ingredients of conventional perfumes (page 36, lines 12 to 14).

- 2.1.2 Surfactants are an optional, but highly preferred ingredient of the compositions of D1 (page 26, line 12). In particular all compositions of the various formulations of examples I to V which contain a perfume also contain at least 0.1 wt.% of a surfactant (in particular Polysorbate 60, Neodol 23-3 and Neodol 25-3, which are nonionic surfactants according to page 27, line 31 and page 28, line 15).
- 2.1.3 Example VI of D1 discloses a composition containing 1.43 wt.% of GE 176-12669 silicone emulsion, 1.43 wt.% of GE SM 2658 silicone emulsion, 0.065 wt.% of polyvinyl alcohol, 0.01 wt.% of glycerin, 3 ppm of Kathon CG, 0.1 wt.% of perfume and the balance of distilled water.
- 2.2 It has not been contested that distilled water has a French Hardness of 20 or below (see paragraphs [0020] to [0022] in the patent in suit) and that Kathon CG is an isothiazolone-based compound (see D1, page 39, lines 24 to 25 and paragraph [0029] in the patent in suit). However, no information is given on what kind of perfume is included in the composition of example VI of D1. While it is correct that the description of D1 indicates hydrophilic perfumes with a low ClogP value as preferred perfumes to be used in the compositions (page 36, first paragraph of D1) and that these perfumes are more soluble in water than the ingredients of conventional perfumes (page 36, second paragraph), there is no information in D1 which directly and unambiguously links these preferred perfumes to the perfume used in example VI, which remains unknown. The characterisation of the perfume as water-soluble can

surely be considered as a broad one; however it indicates a property of the perfume (see the method of characterisation in paragraph [0013] of the patent in suit), which cannot be considered as implicitly disclosed with no information available on the kind of perfume. In the absence of any direct and unambiguous disclosure of a water soluble perfume in the composition of example VI of D1 novelty with respect to this composition must be acknowledged. Since there is no other disclosure in D1 which comes closer to the composition of granted claim 1 (see point 2.1, *supra*), the ironing aid of granted claim 1 is novel with respect to D1 and the decision under appeal must be set aside.

2.3 For the sake of completeness the Board notes that there are two further features of the composition of granted claim 1 which are not directly and unambiguously disclosed in example VI of D1.

2.3.1 The composition of examples VI of D1 contains 2.86 wt.% of cationic silicone emulsions (1.43 wt.% of GE 176-12669 silicone emulsion and 1.43 wt.% of GE SM 2658 silicone emulsion). It is without doubt that the emulsions contain a significant amount of surfactant. As to the exact quantity of surfactant no evidence has been provided by the parties on the compositions of the two silicone emulsions (even the data sheet filed by the patent proprietors with the statement setting out the grounds of appeal and contested by the opponents has no detail on the quantity of surfactant). Since the burden of proof for alleged lack of patentability (in this case lack of novelty) in opposition proceedings lies with the opponents (Case Law of the Boards of

Appeal, 6th Edition 2010, VI.H.5.1.1), in the absence of conclusive evidence on the amount of surfactant present in the composition of example VI of D1, it must be concluded to the detriment of the party who carries the burden of proof that there is no direct and unambiguous disclosure in this example of the feature of granted claim 1 that the amount of anionic, cationic, nonionic and amphoteric surfactant is less than 0.1 wt.%.

2.3.2 With regard to the feature that the ironing aid of granted claim 1 is suitable "for use in a steam chamber of a steam iron", the patent proprietors submitted an experimental report which was meant to show that a composition which attempted to reproduce example VI of D1 was wholly unsuitable for use in the steam chamber of a steam iron. Application of this composition on a ceramic plate maintained at the temperature that an iron reaches for boiling (i.e. at 180°C, see page 1 of the report, "Experimental set up for evaluation") showed that the composition boiled off leaving a large drop that charred on the surface and that it made the surface very hydrophobic such that the foam was expelled violently. In view of this it was concluded that the composition causes enormous staining on ironed cloths and is unfit and very unsafe for use in an iron (see last paragraph of the report).

2.3.3 While it is correct that a number of modifications of the composition of example VI of D1 were needed in order to reproduce it due to missing information in D1 and to the unavailability of certain commercial products, the Board is of the opinion that the experiments in the report were a fair attempt to

reproduce the example. Both the GE SM 2658 silicone emulsion of D1 and the SM 2658 silicone emulsion used in the test contained 35 wt.% of the silicone (see D1, page 61, line 11, and the second line in the first table of the data sheet on SM 2658 submitted with the statement setting out the grounds of appeal), so that the view of the opponents that the silicone emulsion SM 2658 used in the experiments contained a higher amount of silicone polymers than the emulsion used in D1 is without foundation. Moreover, due to the fact that GE 176-12669 silicone emulsion was no longer commercially available, which was not contested by the opponents, an equal quantity of the available emulsion (SM 2658) was used as replacement. No countertests are available to show that it was such a reasonable replacement that rendered the composition unsuitable for use in a steam chamber of a steam iron. With the evidence on file the Board can therefore only conclude that the composition of examples VI of D1 is not suitable to be used in a steam chamber of a steam iron.

3. *Remittal*

- 3.1 Although the EPC does not guarantee the parties an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party may be given the opportunity of two readings of the important elements of a case. The essential function of an appeal is to consider whether the decision issued by the first-instance department is correct. Hence, a case is normally referred back if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

- 3.2 In particular, remittal is considered by the boards in cases where a first-instance department issues a decision against a party solely upon a particular issue which is decisive for the case, and leaves other essential issues outstanding. If, following appeal proceedings, the appeal on the particular issue is allowed, the case is normally remitted to the first-instance department for consideration of the undecided issue (Article 111(1) EPC).
- 3.3 The observations made above apply in full to the present case. The Opposition Division decided that the subject-matter of claim 1 was not patentable on the grounds of lack of novelty over D1, but disregarded the essential issue of inventive step. This issue, however, formed, *inter alia*, the basis for the requests that the patent be revoked in its entirety and must therefore be considered as an essential substantive issue in the present case.
- 3.4 Thus, in view of the above considerations and on the common wish of the parties (see point V, *supra*), the Board has reached the conclusion that, in the circumstances of the present case, it is necessary to remit the case to the Opposition Division for the analysis of inventive step of the granted claims.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.

The Registrar

The Chairman

K. Boelicke

J. Riolo