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**Datasheet for the decision  
of 25 October 2011**

**Case Number:** T 1730/09 - 3.3.06  
**Application Number:** 98928993.9  
**Publication Number:** 993334  
**IPC:** B01F 17/10, E21B 43/26,  
C10C 3/00, A61K 7/50  
**Language of the proceedings:** EN

**Title of invention:**

Fluids containing viscoelastic surfactant and methods for  
using the same

**Patentee:**

Rhodia Opérations

**Opponent:**

Akzo Nobel N.V.

**Headword:**

Viscoelastic fluid/RHODIA

**Relevant legal provisions:**

RPBA Art. 12(4)

**Relevant legal provisions (EPC 1973):**

EPC Art. 83, 84, 111(1)

**Keyword:**

"Clarity (auxiliary request 8): yes"  
"Sufficiency of disclosure (auxiliary request 8): yes"  
"Admissibility of document submitted with the grounds of  
appeal: yes"  
"Remittal: yes - fresh case"

**Decisions cited:**

T 0256/87, T 0728/98, T 0337/95, T 0550/91, T 0759/91,  
T 0522/91, T 0472/88

**Catchword:**

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Case Number: T 1730/09 - 3.3.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.06  
of 25 October 2011

**Appellant I:** Rhodia Opérations  
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**Representative:** Russell, Lindsey  
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**Appellant II:** Akzo Nobel N.V.  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
26 June 2009 concerning maintenance of European  
patent No. 993334 in amended form.

**Composition of the Board:**

**Chairman:** P.-P. Bracke  
**Members:** L. Li Voti  
J. Geschwind

## Summary of Facts and Submissions

- I. The present appeal is from the decision of the Opposition Division to maintain the European patent no. 993 334, concerning a viscoelastic fluid, in amended form.
- II. In its notice of opposition the Opponent sought revocation of the patent on the grounds of Articles 100(a), (b) and (c) EPC 1973.
- III. The Opposition Division found in its decision that the claims according to the auxiliary request 1 submitted during oral proceedings complied with the requirements of the EPC.

As regards sufficiency of disclosure, the Opposition Division found in its decision *inter alia* that

- the patent in suit gave precise instruction as to how to prepare a viscoelastic fluid as claimed;
- no evidence had been submitted by the Opponent that compositions falling under the claims could not be reproduced by the skilled person by following the instruction of the patent in suit;
- the burden of proof in this respect lay on the Opponent.

- IV. Appeals were filed against this decision by the Patent Proprietor (Appellant I) and by the Opponent (Appellant II).

Appellant II submitted with the grounds of appeal *inter alia* document D15: US-A-5551516.

Appellant I withdrew with its letter of 24 May 2010 all requests submitted with the grounds of appeal and filed a new main request and 8 auxiliary requests. Moreover, it submitted annexes A and B as experimental evidence.

Oral Proceedings before the Board were held on 25 October 2011.

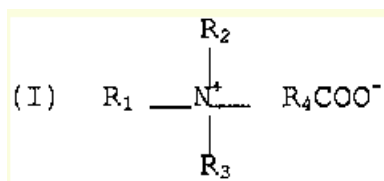
During oral proceedings Appellant I withdrew the main request and the auxiliary requests 1 to 7 of 24 May 2010 and submitted a new auxiliary request 9.

V. Claim 1 according to the auxiliary request 8 of 24 May 2010 reads as follows:

" A viscoelastic fluid consisting essentially of:

(1) an aqueous medium;

(2) a surfactant represented by the formula (I):



wherein  $R_1$  is  $RCO\text{NHCH}_2\text{CH}_2\text{CH}_2^-$  wherein R is an alkyl group containing from 14 to 24 carbon atoms, which may be branched or straight chained and which may be saturated or unsaturated,

$R_2$  and  $R_3$  are each methyl;

$R_4$  is a hydrocarbyl radical with a chain length of 1 to 4; and

(3) a member selected from the group consisting of organic acids, inorganic salts, and combinations of one or more organic acids with one or more inorganic salts; wherein said fluid exhibits the property of viscoelasticity."

The dependent claims 2 to 5 relate to particular embodiments of the viscoelastic fluid of claim 1.

VI. As regards the invention claimed according to auxiliary request 8, Appellant II maintained during oral proceedings the arguments submitted in writing with respect to sufficiency of disclosure.

Appellant II had submitted, in particular, that

- the patent in suit did not contain any firm definition of the term "viscoelastic" and listed two tests which might be performed for finding an indication of the viscoelasticity of the tested fluid;
- therefore, the skilled person might have needed an innumerable number of tests under various conditions for establishing whether a given system was viscoelastic at some point; this amounted to an undue burden for the skilled person;
- consequently, the skilled person could not have reliably known whether he was working within the area of the claims; reference was made in this respect to T 256/87 (not published in OJ EPO).

As regards the clarity of claim 1 according to auxiliary request 8, Appellant II argued during oral proceedings that

- in the absence of a definition in the patent in suit of the term "essentially", the wording "consisting essentially of" would not identify precisely the amounts of components which could be contained in the claimed composition in addition to those explicitly listed; reference was made in this respect to decision T 728/98 (OJ EPO 2001, 319);

- moreover, the structural formula (I) contained a radical R, which was an alkyl, i.e. a saturated group in the proper meaning of the word; however, claim 1 specified that the alkyl could be also "unsaturated";

- even though the same definition for the radical R could be found in a granted dependent claim, claim 1 of the auxiliary request 8 was an amended claim different from any of the granted claims; therefore, it was admissible to object to the lack of clarity of claim 1 in this respect.

As regards the admissibility of document D15, Appellant II submitted in writing and orally that this document, introduced with the grounds of appeal, was very relevant both in terms of sharing many features with the opposed patent and in terms of relating to a similar technical problem; moreover, this document was already cited in the description of the patent in suit.

Furthermore, Appellant II submitted during oral proceedings that the arguments based on document D15

submitted with the grounds of appeal against the claims found by the Opposition Division to comply with the requirements of the EPC, would not change against claim 1 according to auxiliary request 8. Therefore, there was no reason to remit the case to the department of first instance, if document D15 was admitted into the proceedings.

VII. As regards sufficiency of disclosure, Appellant I maintained the arguments presented in writing, i.e. that the skilled person would have been able to prepare a composition as claimed by following the teaching of the description of the patent in suit and would have been able to measure the viscoelasticity of the composition.

As regards the clarity of claim 1 according to auxiliary request 8, Appellant I admitted during oral proceedings that an alkyl group in the proper meaning of the word could not be "unsaturated" as encompassed by claim 1; however, the same wording for the alkyl group R had been already used in granted claim 9. Therefore, the lack of clarity of this term could not be raised during opposition appeal proceedings.

Moreover, it was clear that the wording "consisting essentially of" allowed only the presence of impurities in addition to the specifically listed components.

As regards the admissibility of document D15, it submitted that Appellant II had raised with its grounds of appeal a completely fresh case based on document D15 as starting point for the evaluation of inventive step. Moreover, these new arguments could have been raised



already before the Opposition Division, since document D15 was cited generically as prior art in the patent in suit.

Therefore, this late filed document had not to be admitted.

If D15 were admitted into the proceedings, the case would have to be remitted to the department of first instance in order to allow an examination of the fresh case raised by Appellant II at two levels of jurisdiction.

VIII. Appellant II requests that the decision under appeal be set aside and the patent be revoked.

IX. Appellant I requests that the decision under appeal be set aside and the patent be maintained on the basis of the claims according to the auxiliary request 8 filed with letter of 24 May 2010 or auxiliary request 9, filed during oral proceedings, or, in the alternative, if document D15 is admitted into the procedure, to remit the case to the department of first instance.

## **Reasons for the Decision**

1. Auxiliary request 8

1.1 Articles 54 EPC 1973 and 123(2) EPC

Appellant II did not raise any objection under Articles 54 EPC 1973 and 123(2) EPC against the claims according to the auxiliary request 8.

The Board is also convinced that these claims comply with the requirements of Article 123(2) as submitted by Appellant I in its letter of 24 May 2010 and are novel over the cited prior art.

Further details thus are unnecessary.

## 1.2 Clarity

1.2.1 It is established jurisprudence of the Boards of Appeal of the EPO that, in order to ensure legal certainty, a claim must clearly define the subject-matter for which protection is sought (see T 728/98, OJ EPO 2001, 319, point 3.1 of the reasons as well as T 337/95, OJ EPO 1996, 628, points 2.2 to 2.5 of the reasons).

However, the non-compliance with the requirements of Article 84 EPC 1973, which is not a ground for opposition, can be contested in opposition appeal proceedings only if it arises from amendments to the patent (see Case Law of the Boards of Appeal of the EPO, 6th edition (2010), paragraphs VII.D.4.1.4 and VII.D.4.2, in particular first and second full paragraph on page 807, as well as T 550/91, point 3.1 of the reasons for the decision).

1.2.2 According to the wording of claim 1 of auxiliary request 8 the surfactant of formula (I) contains a radical  $R_1$ , which is  $RCONHCH_2CH_2CH_2^-$  wherein R is an alkyl group containing from 14 to 24 carbon atoms, which may be branched or straight chained and which may be saturated or unsaturated.

Therefore, even though an alkyl group does not contain in the proper meaning of the word any double or triple bond and thus is a "saturated" group, the wording of claim 1 encompasses the possibility that the alkyl group R is "unsaturated". The above mentioned wording thus is inconsistent.

However, the same inconsistency was already present in claim 9 as granted, which related to a surfactant structural formula encompassing that contained in claim 1 according to the auxiliary request 8, and containing the same definition for the radical  $R_1$ , which is  $RCONHCH_2CH_2CH_2^-$  wherein R is an alkyl group containing from 14 to 24 carbon atoms, which may be branched or straight chained and which may be saturated or unsaturated.

The Board thus finds that the above mentioned inconsistency in the wording of claim 1 did not arise from an amendment to the patent as granted. Hence, the lack of clarity of claim 1 cannot be objected in this respect in opposition appeal proceedings.

- 1.2.3 As regards the wording "consisting essentially of", which is also part of claim 1, it was not contained in any of the granted claims. Therefore, the alleged lack of clarity of this term raised by Appellant II can be objected in opposition appeal proceedings.

However, as reported in the Case Law of the Boards of Appeal of the EPO, 6th edition (2010), II.B.5.2, referring to decisions T 759/91 and T 522/91, the wording "consisting essentially of", at variance with the wording "comprising substantially", has a defined

meaning because of the unequivocal character of the words "consisting of"; therefore, the use of the unequivocal words "consisting of" in combination with "essentially" has been found to solve all interpretation problems of the unclear claims examined in such previous cases. The cited decisions T 759/91 (point 2.2. of the reasons) and T 522/91 (point 2.2. of the reasons) both refer to the decision T 472/88, wherein it was decided that the term "consisting essentially of" was clear and allowed the presence of other components in a claimed composition in addition to the components mandatory in the claim, provided that the essential characteristics of the claimed composition are not materially affected by their presence (see point 3 of the reasons).

The Board agrees with these previous decisions. Therefore, even though the word "essentially" does not identify precisely the amounts of additional components which could still be contained in the claimed viscoelastic fluid, the wording "consisting essentially of" allows in the present case that the composition of claim 1, which must be viscoelastic, **consists of** the mandatory components listed in the claims and can contain additionally only other components which do not materially affect the essential viscoelastic characteristics of the composition, e.g. minor amounts of impurities as submitted by Appellant I during oral proceedings.

- 1.2.4 The decision T 728/98, cited by Appellant II, concerns the clarity of the different wordings "substantially pure" or "substantially free of" (point 3 of the reasons), which do not contain the word "essentially";

therefore, this decision concerns a legal situation which is more similar to that of the previously cited decisions T 759/91 and T 522/91, wherein the wording "consisting substantially of" was found not to be clear. Consequently, this decision concerns a different legal situation and is not applicable to the present case.

The Board concludes that the wording "consisting essentially of" contained in claim 1 of auxiliary request 8 complies with the requirements of clarity of Article 84 EPC 1973.

### 1.3 Sufficiency of disclosure

1.3.1 Claim 1 does not require to determine the viscoelasticity of the claimed fluid by a specific test and does not require that the claimed fluid has viscoelastic properties expressed by specific units of measure.

Similarly, the description of the patent in suit teaches only that the fluids of the invention are viscoelastic and reports two known test methods, which **may be used** for determining whether a liquid possesses viscoelastic properties (see paragraphs 8 and 11 of the patent in suit). However, it is nowhere required in the patent in suit that the viscoelasticity of the fluids of the invention is determined by a specific method.

Therefore, the present invention requires only that the claimed fluids have the **quality** of being viscoelastic.

1.3.2 It is undisputed that viscoelasticity was a well known property at the priority date of the patent in suit and

that it was also known to the skilled person how to detect this property in a fluid (see e.g. paragraph 11 of the patent in suit).

Even though the specific methods reported in the description of the patent in suit could give potentially different results for the same composition, it is the Board's view that the skilled person, on the basis of its knowledge about viscoelasticity (see e.g. paragraph 12 of the patent in suit), would have been able to select a suitable qualitative test for determining whether a given fluid is viscoelastic, depending on the chemical nature of the fluid to be tested. Furthermore, it would also have been able to repeat the test by a different method in case of doubt.

Appellant II's allegation that a skilled person could need an innumerable number of tests under various conditions for establishing if a given fluid is viscoelastic presupposes that the known tests for determining the viscoelasticity of a fluid were qualitatively unreliable, a fact which was not supported by any evidence and which consequently cannot be taken for granted by the Board.

- 1.3.3 Therefore, the only issue which remains to be examined in the present case is if the skilled person would have been able to prepare a viscoelastic fluid as claimed by following the teaching of the patent in suit.

As already decided by the Opposition Division (points 10 to 15 of the reasons), the description of the patent in suit explains clearly how to prepare a composition as claimed (paragraph 39 and examples). Therefore,

there is no reason to doubt that a composition having all the features of claim 1 and prepared as explained in the patent in suit would not be viscoelastic. Appellant II did not bring any evidence that a composition as claimed could not be reproduced by following the teaching of the patent in suit.

Finally, the Board remarks that it had already been decided in T 256/87 (point 17 of the reasons), a decision also cited by Appellant II, that even in the absence of an indication of a method for specifically determining a technical property of a claimed composition the skilled person, reading the specification, would have been put in the position of being able to carry out the invention in all its essential aspects and of knowing when he was working within the forbidden area of the claims without undue burden. Therefore, this decision, which concerns a case very similar to the present one, is not contrary to the Board's finding expressed above.

The Board concludes that the claimed invention is sufficiently disclosed.

2. Admissibility of document D15
  - 2.1 According to Article 12(4) RPBA, the Board shall take into account all facts, evidence and requests submitted by the parties with the statement of the grounds of appeal and the reply to it and have the power to hold inadmissible facts, evidence and requests which could have been presented during the first instance proceedings.

2.2 The Board finds that document D15, cited for the first time by Appellant II in its grounds of appeal, was already cited generically in the patent in suit (paragraph 45) and it would have been possible, theoretically, for Appellant II to consider this document already before the Opposition Division.

However, the right of the losing party of providing new valid arguments in appeal proceedings against the reasoned decision includes the possible filing of additional documents at least as a reaction to the reasons of the appealed decision.

It is without doubt in the present case that the document D15 was submitted by Appellant II as a reaction to the decision under appeal (see paragraph VI above), in particular point 23 of the reasons, reading:

"As the references cited by the opponent deal only with the improvement of cleaning compositions or hair shampoos and do not deal at all with thickened aqueous viscoelastic fluids that are used as water-based hydraulic fluids in lubricant and hydraulic fracturing fluids to increase permeability in oil production, the selection of the particular zwitterionic surfactant in combination with inorganic acids or inorganic salts and the particular concentration ranges is not obvious in the light of the cited prior art."

Therefore, document D15 has to be admitted into the proceedings.



3. Remittal

- 3.1 Document D15 was used by Appellant II in its grounds of appeal, not only as a complementary document for further substantiating the objections of lack of inventive step already discussed before the department of first instance, but also as a starting document for formulating an alternative completely new and different reasoning aiming at showing the lack of inventiveness of the claimed subject-matter.

This new chain of arguments amounts clearly to a fresh case which was not discussed before the department of first instance. For this reason Appellant I requested already in its reply to Appellant II's grounds of appeal the remittal of the case to the department of first instance.

- 3.2 In many cases the Boards of Appeal of the EPO have remitted in similar circumstances the case to the department of first instances in order to permit to the other party (in this case the Patent Proprietor) to receive a fair procedural treatment in the further conduct of the case (see Case Law of the Boards of Appeal of the EPO, 6th edition (2010), VII.E.10.2.1 and 10.2.3).

The Board remarks also that Appellant II's grounds of appeal discussed only the claims maintained by the Opposition Division, which are fundamentally different from the more restricted claims introduced by Appellant I with letter of 24 May 2010. Moreover, even though Appellant II pretended during oral proceedings that the arguments based on document D15 submitted with

the grounds of appeal against the claims found by the Opposition Division to comply with the requirements of the EPC would not change against claim 1 according to auxiliary request 8, these arguments were not brought in writing against the requests submitted by Appellant I with its grounds of appeal or those submitted with letter of 24 May 2010.

Therefore, it is the Board's view that the fresh case based on document D15 was not satisfactorily discussed by both parties in writing before oral proceedings and the consideration of further facts and evidence could possibly be necessary following its introduction into the proceedings.

The Board thus finds it appropriate in the present case to remit the case to the department of first instance (Article 111(1) EPC 1973) in order to permit a fair treatment of both parties.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. Document D15 is admitted in the procedure.
3. The case is remitted to the department of first instance for further prosecution on the basis of auxiliary request 8.

The Registrar:

The Chairman:

D. Magliano

P.-P. Bracke