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**Datasheet for the decision
of 8 July 2015**

Case Number: T 0034/12 - 3.3.03

Application Number: 06821491.5

Publication Number: 1948702

IPC: C08F20/00

Language of the proceedings: EN

Title of invention:

USE AND APPLICATION OF DEFINED ZWITTERIONIC COPOLYMER

Applicant:

The Procter & Gamble Company

Relevant legal provisions:

EPC R. 111(2), 164(2)
EPC Art. 82

Keyword:

Substantial procedural violation - (yes)
Remittal to the department of first instance - fundamental
deficiency in first instance proceedings (yes)

Decisions cited:

J 0003/09, T 0278/00



**Beschwerdekammern
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Chambres de recours**

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Case Number: T 0034/12 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 8 July 2015

Appellant: The Procter & Gamble Company
(Applicant) One Procter & Gamble Plaza
Cincinnati, OH 45202 (US)

Representative: Pierce, Christopher James
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 1 July 2011
refusing European patent application No.
06821491.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman B. ter Laan
Members: D. Marquis
C. Brandt

Summary of Facts and Submissions

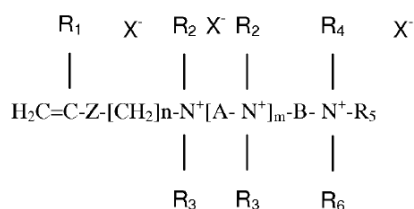
- I. The appeal lies against the decision of the examining division refusing the European patent application 06 821 491.5 under Article 97(2) EPC on the grounds of "lack of compliance with Rule 164(2) EPC by a repeated violation of Rule 137(5) EPC".

- II. The application under appeal was filed under international application number PCT/IB2006/054324 and published as WO2007/057865. The European Patent Office acting as the International Searching Authority, issued an international search report (ISR) and a Written Opinion of the International Searching Authority (WOISA), both covering all claims 1-25 on file.

Claim 1 read:

"1. The use of a water-soluble or water-dispersible copolymer I as an agglomerating agent in a cleaning operation, said polymer comprising:

a) at least a monomer compound of general formula i:



in which

- R₁ is a hydrogen atom, a methyl or ethyl group;
- R₂, R₃, R₄, R₅ and R₆, which are identical or different, are linear or branched C₁-C₆, alkyl, hydroxyalkyl or aminoalkyl groups;
- m is an integer from 0 to 10;
- n is an integer from 1 to 6;

Z represents a -C(O)O- or -C(O)NH- group or an oxygen atom;

A represents a (CH₂)_p group, p being an integer from 1 to 6;

B represents a linear or branched C₂ -C₁₂, polymethylene chain optionally interrupted by one or more heteroatoms or heterogroups, and optionally substituted by one or more hydroxyl or amino groups;

X, which are identical or different, represent counterions; and

(b) at least one hydrophilic monomer carrying a functional acidic group which is copolymerizable with (a) and which is capable of being ionized in the application medium;

(c) optionally at least one monomer compound with ethylenic unsaturation with a neutral charge which is copolymerizable with (a) and (b), preferably a hydrophilic monomer compound with ethylenic unsaturation with a neutral charge, carrying one or more hydrophilic groups, which is copolymerizable with (a) and (b)."

III. On the separate sheet attached to the written opinion the applicant was informed that the application did not meet the requirements of unity of invention as it related to two inventions:

"Claims 1-25 (part)

The composition of claim 1 and use of it when the monomer of formula i in claim 1 is a diquat.

Claims 1-25 (part)

The composition of claim 1 and the use of it when the monomer of formula i in claim 1 is not a diquat."

The reasoning was that the application lacked unity of invention a posteriori in the light of WO 01/57171 (D1) cited in the International Search Report because D1 disclosed the use of a composition for laundry applications with copolymers comprising diquat and acid comonomers. Hence, when the ammonium monomer of general formula i in claim 1 was diquat, the claim lacked novelty and there was no more common inventive concept when the comonomer of formula 1 was not a diquat. These inventions were therefore not so linked as to form a single general inventive concept, contrary to the requirements of Rule 13.1 PCT.

Since no additional fees were paid, the international search report was restricted to the invention first mentioned in the claims, covered by claims 1-25 (ISR, Box No. III).

- IV. The request for entry into the European phase was filed on 26 March 2008 together with the set of claims as filed with the International Searching Authority.

- V. On 13 November 2008, a communication pursuant to Article 94(3) EPC informed the applicant that the application lacked unity within the meaning of Article 82 EPC for the same reason as that provided in the WOISA and that the application would be prosecuted on the basis of the invention in respect of which a search has already been carried out, in other words the invention first mentioned in the claims. The application had to be limited to the invention searched and excised from those parts of the application relating to the other invention.

- VI. On 16 February 2009, a result of consultation (EPO Form 20149A) was sent to the applicant after a telephone

- conversation that took place with the primary examiner. It was indicated therein that "The examiner confirmed that the origin of the NU objection is the novelty destroying document cited in the SR."
- VII. On 3 March 2009, the applicant filed a reply to the communication of the EPO dated 13 November 2008. A new set of claims was filed in which claim 1 was limited to "The use of a water-soluble or water-dispersible copolymer I as an agglomerating agent in a **hard surface** cleaning operation...". Page 1, lines 11-13 of the description as filed was given as a basis for that amendment. The applicant argued that D1 did not disclose the use of said polymer for hard surface cleaning. The applicant submitted that that amendment overcame the examiner's objection pursuant to Article 97(2) EPC.
- VIII. On 2 July 2009, a communication pursuant to Article 94(3) EPC informed the applicant that the amendment performed was not allowable under Article 123(2) EPC since the wording "hard surface" was not disclosed in the passage cited by the applicant. It was also mentioned that the defects listed in the previous communications were still present so that the claims contained unsearched matter, contrary to Rule 164(2) EPC, and the invention still lacked unity according to Article 82 EPC.
- IX. With a reply dated 17 December 2009, the applicant argued that the amendment of claim 1, i.e. the addition of "hard surface", was allowable and page 42, line 8 of the description was cited as a further support for that amendment. Also, claims 8 to 17, 24 and 25 were cancelled and claim 18 was limited to a kit for the cleaning of a hard surface. It was also submitted that

as a result of the amendments made, the claims related to a group of inventions so linked as to form a single inventive concept as it pertained to the use of copolymers in a hard surface cleaning operation. It was reiterated that D1 did not disclose the use of said polymers for hard surface cleaning.

- X. A decision to refuse the European Patent application was issued on 1 July 2011. The decision reads:

"Facts and submissions

The WO-ISA and the search report dated 16.03.2007 have established a lack of unity. The separate inventions/groups of inventions were (reference is made to the claims in the international phase):

claims 1-25 (part)

The composition of claim 1 and use of it when the monomer of formula i in claim 1 is a diquat.

claims 1-25 (part)

The composition of claim 1 and use of it when the monomer of formula i in claim 1 is not a diquat.

The reason for the lack of unity is a posteriori, following a lack of novelty over document WO0157171. The invention has been searched in the specific case of the comonomer of formula 1 being a diquat. The applicant has not payed for the second group of invention.

The objection of lack of unity was repeated in the European phase in the communication of the examining division dated 13.11.2008 and during a consultation by telephone dated 10 February 2009

On 03.03.2009, the applicant filed an amended set of claims.

In response to those amendments, the examining division objected in the communication dated 02.07.2009 that the claims contain unsearched matter, contrary to R. 164(2) EPC.

The examining division stressed in the same letter that at this stage, refusal of the application is considered.

In the amended set of claims dated 17.12.2009 the same unsearched matter is present and the applicant argued with the same reasoning as in his previous communication to claim the unity of the new set of claims.

Reasons for the decision

The decision is based on the following application documents:

Description, Pages

2-50 as published

1 filed in electronic form on 03-03-2009

Claims, Numbers

1-13 filed with telefax on

17-12-2009

Considering that:

a) The applicant does not request oral proceedings and has had the opportunity to present his comments, moreover the applicant has been warned in the last communication dated 02.07.2009 that the refusal of the

application is considered. Hence, the present decision complies with the right to be heard (Art. 113 EPC)

b) The applicant has not tried to overcome the objection of unsearched matter (R. 164(2) EPC), i.e., the comonomer of formula 1 in the sets of amended claims still has the option to be different from a diquat.

The examining division decides to refuse the present application according to Art. 97 (2) on the ground of lack of compliance with R. 164(2) EPC by a repeated violation of R. 137(5) EPC."

XI. A notice of appeal was filed on 15 July 2011 and the appeal fee was paid on the same day. With the statement of grounds of appeal filed on 26 October 2011 the applicant submitted arguments in favour of the unity of invention of the main request (claims filed on 17 December 2009) and provided two auxiliary requests.

XII. The applicant requests that the decision of the examining division be set aside and that the case be remitted to the examining division for further prosecution on the basis of the claims of the main request.

Reasons for the Decision

The appeal is admissible.

1. According to established jurisprudence of the Boards of Appeal, in order to satisfy the requirement of Rule 68(2) EPC 1973 (Rule 111(2) EPC 2000), a decision should contain, in logical sequence, those arguments which justify its tenor (Case Law of the Boards of

Appeal of the EPO, III.K.4.2). The conclusions drawn by the deciding body from the facts and evidence must be made clear. Therefore all the facts, evidence and arguments that are essential to the decision must be discussed in detail in the decision, including all the decisive considerations in respect of the factual and legal aspects of the case. The purpose of the requirement to reason the decision is to enable the appellants and, in case of an appeal, also the Board of Appeal, to examine whether the decision could be considered to be justified or not (see T 278/00, OJ EPO, 2003, 546; T 1366/05 not published in OJ EPO).

2. In the present case, the decision by the Examining Division refusing the application is based on Rule 164(2) EPC and Rule 137(5) EPC, the reasons being that the amended set of claims as filed on 17 December 2009 (main request), i.e. "the composition of claim 1 and use of it when the monomer of formula i is not a diquat", sought protection for an invention not covered by the international search report. That subject-matter had originally neither been searched by the ISA nor by the EPO after entry in the European phase on the grounds that it had been identified as the second invention of a group of two non-unitary inventions in view of D1 which disclosed the use of a composition with copolymers comprising diquat for laundry applications. As a result, according to the Examining Division, the use of the composition according to claim 1 when the monomer of formula i was a diquat (first invention) lacked novelty over D1 and was not linked so as to form a single general inventive concept with the use of the composition of claim 1 when the monomer of formula i was not a diquat (second invention). Furthermore, only that invention identified as the first invention had been searched because the

applicant had not paid the required additional search fee for the second invention.

3. In order to justify the above conclusions under Rule 164(2) EPC and Rule 137(5) EPC against claim 1 as filed on 17 December 2009, the logical chain of reasoning of the examining division in the decision under appeal has to contain a proper assessment of the question of lack of unity (Article 82 EPC) in view of D1 because that lack of unity was the reason why the second invention had not been searched.

The decision of the Examining Division does however not contain any reasoning concerning the lack of unity of claim 1 as filed on 17 December 2009. The part of the decision summarizing the facts and submissions of the file mentions an objection of lack of unity a posteriori of claim 1 as originally filed but acknowledges that an amended set of claims was provided by the applicant by letter of 17 December 2009. In that set of claims, claim 1 was limited to the use of the composition and corresponding kit for hard surface cleaning. Point 2 of the applicant's letter contains the argument that that limitation established unity of invention in view of D1 as that document did not disclose hard surface cleaning operations.

If that objection of lack of unity of claim 1 turned out to be unjustified in view of the amendment to the claims, the applicant would have been entitled to have the full claimed subject-matter searched. If necessary, an additional search would have had to be performed, regardless of whether or not this might involve an additional effort (J 3/09, Reasons, points 3.5.6 and 5.2).

With the amended set of claims provided by letter of 17 December 2009, the applicant has tried to overcome the objection relating to Rule 164(2) EPC by trying to reconcile the subject-matter of claim 1 with the criteria of unity of invention according to Article 82 EPC. The decision of the Examining Division does not contain any reasoning why that amendment failed to establish unity of invention within claim 1 in view of D1.

4. Therefore, in the appealed decision the Examining Division arrived at the conclusion that the main request contained unsearched subject-matter as a result of a lack of unity of claim 1 without addressing the limitation of claim 1 to hard surfaces. Since the requirements defined in Rule 164(2) EPC and Rule 137(5) EPC are based on lack of unity, the decision of the examining division, by arriving at a conclusion of lack of compliance with those rules without dealing with the lack of unity of the set of claims filed on 17 December 2009, is insufficiently reasoned in the sense of Rule 68(2) EPC 1973 (Rule 111(2) EPC 2000).
5. Due to the deficiencies in the reasons for refusing the application, the appellant and the Board are left in the dark as to how the first instance came to its conclusions. Hence, the appellant and the Board were not able to examine whether the decision could be considered to be justified or not. This failure amounts to a substantial procedural violation requiring that the decision under appeal to be set aside and the case be remitted to the first instance (see T 278/00, loc. cit. point 5, supra).

By reason of that substantial procedural violation the Board considers it to be equitable to reimburse the

appeal fees pursuant to Rule 67 EPC 1973 (Rule 103(1)
(a) EPC 2000).

Order

For these reasons it is decided that:

1. The decision of the examining division is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of claims 1 to 13 of the main request filed on 25 October 2011.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



I. Aperribay

B. ter Laan

Decision electronically authenticated