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**Datasheet for the decision  
of 27 April 2015**

**Case Number:** T 0992/12 - 3.3.06

**Application Number:** 06124858.9

**Publication Number:** 1867708

**IPC:** C11D3/22, C11D3/386

**Language of the proceedings:** EN

**Title of invention:**  
Detergent Compositions

**Applicant:**  
The Procter & Gamble Company

**Headword:**  
Disclaimers and clarity / PROCTER & GAMBLE

**Relevant legal provisions:**  
EPC Art. 84

**Keyword:**  
Clarity and conciseness of a claim of the application as filed  
containing disclaimers - yes

**Decisions cited:**  
G 0001/03

**Catchword:**



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Case Number: T 0992/12 - 3.3.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.06**  
**of 27 April 2015**

**Appellant:**  
(Applicant)

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**Representative:**

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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted on 8 December 2011  
refusing European patent application No.  
06124858.9 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** B. Czech  
**Members:** P. Ammendola  
J. Geschwind

## Summary of Facts and Submissions

- I. This appeal is from the decision of the Examining Division to refuse European patent application no. 06124858.9.
- II. Claim 1 of the set of sixteen claims pending before the Examining Division as the sole request (filed with letter of 21 October 2011) reads as follows (amendments to claim 1 of the application as filed made apparent by the Board):

*"1. A composition comprising a modified cellulose derivative **having a molecular weight from 20000 to 500000 kDaltons** or mixtures thereof and a cellulase enzyme characterised in that the weight ratio of the modified cellulose derivative to the active cellulase enzyme protein is from ~~1:1~~ **20:1** to 10000:1 and wherein the composition does not contain 0.7 to 0.9 % by weight of the total composition, of sodium nonanoyl oxybenzene sulfonate, and does not contain 10% by weight based of the total composition, of sodium perborate monohydrate, in which the enzyme is a bacterial alkaline enzyme exhibiting endo-beta-1,4-glucanase activity (E.C.3.2.1.4)."*

Said request also comprises an amended description page 2 filed together with claims 1 to 16.

- III. In its decision the Examining Division found that said claim 1 lacked clarity and conciseness as required by Article 84 EPC since it contained two negative technical features (below **disclaimers**) defining what the claimed composition should not contain, namely neither "0.7 to 0.9% by weight of sodium nonanoyl oxybenzene

*sulfonate*" (below **NOBS**) nor "*10% by weight of sodium perborate monohydrate*" (below **PBM**).

The Examining Division in its decision:

a) referred to the Guidelines for Examination in the EPO (the valid version thereof at the date of the decision being that of April 2010), where it is stated at point C-III 4.20, *inter alia*, that "negative limitations such as disclaimers may be used only if adding positive features to the claim either would not define more clearly and concisely the subject-matter still protectable ... or would unduly limit the scope of the claim";

b) quoted a passage taken from point 3 of the Reasons of the Decision of the Enlarged Board of Appeal G 1/03 (OJ of EPO 2004, p.413):

"...the requirements of conciseness and clarity of Article 84 EPC are also applicable to claims containing disclaimers. On the one hand, this means that a disclaimer is not allowable if the necessary limitation can be expressed in simpler terms in positive, originally disclosed features in accordance with Rule 43(1) [sic] EPC 2000 [sic]. In addition, a plurality of disclaimers may lead to a claim drafting which puts an unreasonable burden on the public to find out what is protected and what is not protected";

and

c) also referred to further passages at points 2.5.1 and 2.5.2 of the same decision G 1/03, indicating that a disclaimer directed to the exclusion of non-working embodiments should not be allowed since it was neither

necessary nor appropriate.

d) Moreover, the Examining Division considered relevant that, in the present case, no reasons for the inclusion of the disclaimers in claim 1 were indicated in the application as filed and, thus, it was not known whether they were supposed to exclude non-working embodiments, to exclude the disclosure of a piece of prior art, or for some other undisclosed reason. Nor had the reasons for the inclusion of the disclaimers been later rendered available to the public, since they were only contained in a passage of a letter (dated 21 October 2011) that the Applicant had requested the Examining Division to be kept confidential.

Since the public had no access to this information, there was no "full public disclosure of the invention and the reasoning behind the claim formulation".

In view of the absence of such information, the Examining Division held that claim 1 at issue could be worded more concisely in terms of positive features, whereas the present drafting of claim 1 appeared "to place an unreasonable burden upon the public with regard to the determination of the boundaries of the scope of protection conferred by said claim" (page 3, last but two paragraph of the decision under appeal).

e) The Examining Division, therefore, concluded (see second paragraph on page 4 of the decision's grounds) "that claim 1 comprises features which should not normally be allowed under Guidelines C-III 4.20, and therefore the requirements of clarity and conciseness as required by Article 84 EPC are considered to have not been met".

f) It finally pointed out (page 4, third paragraph the decision) that page 17 of the description of the application also disclosed that NOBS and PBM were "present in ranges which conflict with the disclaimer of claim 1 thus also bringing about a lack of clarity".

In view of the above the Examining Division decided to refuse the application.

- IV. In its statement setting out the grounds of appeal, the Appellant (Applicant) rebutted the reasoning of the Examining Division.

With this statement it also filed an amended version of page 17 of the description of the patent application.

- V. In its statement of grounds of appeal the Appellant requested that the decision under appeal be set aside and "the patent proceed through examination to grant".

- VI. The Appellant's arguments can be summarised as follows:

The Examining Division had erroneously decided that the negative limitations in claim 1 at issue were objectionable under Article 84 EPC, since said limitations were clear and concise. A skilled person would immediately understand that the claimed invention included compositions having the positive limitations in the claim unless such compositions also included the negatively-defined features. These negatively-defined features could be determined by a simple assessment of the quantity of two clearly defined ingredients in the composition, in the same way that quantitative amounts of positively defined ingredients were determined. Hence, present claim 1 also placed no undue burden on upon the public.

According to the cited Guidelines C-III 4.20 a claim may be restricted by a negative limitation if adding positive features to the claim either would not define more clearly and concisely the subject-matter still protectable or would unduly limit the scope of the claim. This was the case in the present instance: there was no positive limitation that could be used to more clearly define the subject-matter still protectable and any positive limitation would unduly restrict the scope of the claim.

Decision G 1/03 relied upon by the Examining Division related to amendments which add "undisclosed" disclaimers during prosecution. In the present case, the disclaimer was present in the application as filed, so the circumstances were not at all the same. Indeed, at the beginning of point 2 of G 1/03 it was clearly stated that "the term "disclaimer" is used hereafter as meaning an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding from a general feature specific embodiments or areas".

The Appellant stressed that the absence in the application as filed of the reasons for which the claim comprises disclaimers did not result in a lack of clarity and or conciseness of claim 1.

Also the request for confidentiality for one paragraph of the Applicant's letter of 21 October 2011 was no request for confidentiality relating to the disclosure of the invention as set out in the patent application.

Article 83 EPC required the invention to be disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. However,

there was no requirement in Article 84 or anywhere else in the EPC to give the reasons for the manner in which an Applicant drafted the patent claims.

Hence, claim 1 at issue met the requirements of Article 84 EPC.

### **Reasons for the Decision**

1. The patent application at issue was refused by the Examining Division on the grounds that claim 1 according to the sole request at issue (claims 1 to 16 filed with filed letter of 21 October 2011; see II *supra*) did not comply with the requirements of Article 84 EPC due to the disclaimers contained therein.
2. Article 84 EPC requires the patent claims to "define the matter for which protection is sought" and to "be clear and concise and be supported by the description".
3. The Board notes in this respect that the disclaimers present in claim 1 are, similarly to other "positive" technical features in the same claim, expressed in terms of quantities of specific chemical compounds.
  - 3.1 Thus, for the Board, they are as conventional and clear as the similar "positive" technical features whose compliance with Article 84 EPC is undisputed.
  - 3.2 The mere statement in the decision under appeal that the drafting of claim 1 appeared "to to place an unreasonable burden upon the public with regard to the determination of the boundaries of the scope of protection conferred by said claim" (see III *supra*), is not convincing in the in the absence of any further



indication as to the nature of possible difficulties to be expected in determining such boundaries.

4. Moreover, for the Board, each of the claim's features, including those defined by means of disclaimers, appears expressed in the concisest possible way.
  - 4.1 In particular, it is not apparent how subject-matter of claim 1 could possibly be expressed in a more concise way. For instance expressing "*does not contain 0.7 to 0.9 %*" of NOBS in terms of positive features would appear to require less concise expressions such as "*may optionally be present in an amount of up to less than 0.7 % or of more than 0.9 %*".
  - 4.2 Hence, in the absence of corresponding indications in the decision under appeal, also the mere statement that it would seem that the claim could be worded more concisely in terms of positive features (see III *supra*), is rejected as unconvincing.
5. Decision G 01/03 cited in the decision under appeal, deals with the different case of the "undisclosed" disclaimers.
  - 5.1 Indeed, point 2 of that decision, entitled "Allowability of disclaimers", after giving the definition of the term "disclaimer" in the passage already cited by the Appellant (see V *supra*), states explicitly "More specifically, the Enlarged Board of Appeal has to deal with the allowability of disclaimers which have not been disclosed in the application as filed".

Hence, the subsequent considerations in sections 2.5.1 and 2.5.2 of G 1/03 (also referred to by the Examining

Division) on the non-allowability of disclaimers aiming at excluding non-working examples, would appear to only justify to refuse, not necessarily for reasons relevant under Article 84 EPC, of a claim amended by incorporating therein a disclaimer "undisclosed" in the original application.

- 5.2 Also the passage of point 3 of G1/03 (entitled "The drafting of disclaimers") cited by the Examining Division (see III *supra*), is only referring to the incorporation into the original claims of previously "undisclosed" disclaimers.

However, since said passage addresses the requirements of Article 84 EPC, that are certainly also to be complied with by "disclosed" disclaimers, it may nevertheless be considered of some relevance also in the present case.

In this respect the Board notes that, since in the present case the disclaimers are clear and represent the concisest way to define the subject-matter for which protection is sought (see points 2.2 and 2.3 *supra*), the considerations contained in the cited passage of point 3 of G 1/03 cannot justify the finding that claim 1 at issue does not meet the requirements of clarity and conciseness according to Article 84 EPC.

6. The Guidelines for Examination in the EPO (2010) C-III 4.20 also cited by the Examining Division expressly acknowledge that disclaimers may be used in formulating a claim, but emphasize the particular relevance of the requirements of clarity and conciseness expressed in Article 84 EPC in respect of disclaimers.

As in the present case the disclaimers are clear and

represent the concisest way to define the subject-matter for which protection is sought (see points 2.2 and 2.2 *supra*), no reason justifying the Examining Division's conclusion can be derived from this part of the Guidelines.

7. The Examining Division's reasoning also appears to imply that a non-compliance of claim 1 with the requirements of Article 84 EPC might arise from the absence of information, in the application as filed, on the reasons for which claim 1 comprises the two disclaimers.
  - 7.1.1 As correctly observed by the Appellant, a possible insufficiency of the disclosure of the claimed invention is, however, only relevant under Article 83, not 84, EPC.
  - 7.1.2 Moreover, the Board is not aware of a provision of the EPC requiring a European patent application to also provide a full disclosure of the reasons for which a claim of the application as filed was drafted to comprise limitations expressed in terms of disclaimers.
  - 7.1.3 It is thus not apparent why the Examining Division concluded that the lack of information in the application as filed as regards the purpose of the disclaimers (avoidance of non-working embodiments, exclusion of prior art, or some other reasons) resulted in claim 1 being objectionable under Article 84 EPC.
- 7.2 Hence, in the Board's judgement, claim 1 at issue is not objectionable for lack of clarity or conciseness (Article 84 EPC).
8. Remittal

- 8.1 The Examining Division has not yet taken position on whether or not the application in the amended form at issue meets all the other requirements of the EPC.
- 8.2 Hence, the Board finds it appropriate to remit the case to the Department of First Instance for further prosecution pursuant to Article 111(1) EPC.
- 8.3 In this connection, the Board observes the following:
- 8.3.1 In case the claimed subject-matter were indeed found to be allowable, the description would still need amendment to adapt it to the amended wording of claim 1, for instance by amending the "*Summary of the invention*" on page 2 (as filed with letter of 21 October 2011) by deleting "*typically*" on line 13 as well, by amending the ratio "*1:1*" on line 11 to the one according to amended claim 1, and by reflecting therein the definition molecular weight range of the modified cellulose derivative as given in amended claim 1.
- 8.3.2 It would appear that if page 2 were to be amended in such a way, there would be no contradiction with page 17 of the application as filed. Page 17 would thus not require any amendment still to be examined for its compliance with the requirements of Article 123(2) EPC.

**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 for further prosecution.

The Registrar:

The Chairman:



D. Magliano

B. Czech

Decision electronically authenticated