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Datasheet for the decision of 7 March 2018

Case Number: T 1539/14 - 3.3.06

Application Number: 09727271.0

Publication Number: 2260094

IPC: C11D11/00, C11D3/20

Language of the proceedings: EN

Title of invention:
USE OF CITRATE AS CLEANING AID FOR HARD SURFACES

Patent Proprietor:
Unilever N.V. / Unilever PLC

Opponents:
1 THE PROCTER & GAMBLE COMPANY
2 Reckitt Benckiser N.V.
3 Colgate-Palmolive Company

Headword:
Citrate cleaning benefit / UNILEVER

Relevant legal provisions:
EPC Art. 52(1), 54(1), 54(2)

Keyword:
Novelty of use - main and auxiliary request (no) - claim directed to the use of a known substance (as a component of a known composition) for a known non-medical purpose (of said composition)

Decisions cited:
G 0002/88, G 0006/88, T 0254/93, T 0892/94

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 1539/14 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 7 March 2018

Appellant I: (Patent Proprietor)	Unilever N.V. Weena 455 3013 AL Rotterdam (NL) Unilever PLC a company registered in England and Wales under company no. 41424 Unilever House 100 Victoria Embankment London EC4Y 0DY (GB)
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Appellant II: (Opponent 01)	THE PROCTER & GAMBLE COMPANY One Procter & Gamble Plaza Cincinnati, Ohio 45202 (US)
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Appellant III: (Opponent 03)	Colgate-Palmolive Company 300 Park Avenue New York NY 10022-7499 (US)
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Party as of right:
(Opponent 02)

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Decision under appeal:

Interlocutory decision of the Opposition Division of the European Patent Office posted on 19 May 2014 concerning maintenance of the European Patent No. 2260094 in amended form.

Composition of the Board:

Chairman B. Czech
Members: P. Ammendola
J. Hoppe

Summary of Facts and Submissions

I. The appeals by the Proprietor (Appellant I), Opponent 1 (Appellant II) and Opponent 3 (Appellant III) are against the interlocutory decision of the Opposition Division concerning maintenance of European Patent No. 2 260 094 in amended form, on the basis of the set of amended claims according to the then pending Second Auxiliary Request.

Opponent 2 did not file an appeal and is thus only a party as of right in the appeal proceedings.

II. During the opposition proceedings

- reference had been made, *inter alia*, to prior art document

  D12 = WO 99/43776 A1,

and

- the Patent Proprietor had filed, *inter alia*, sets of amended claims as Main Request (with fax dated 23 October 2012) and as First and Second Auxiliary Requests (with letter of 21 January 2014).

III. All three requests comprised an identical claim 1 (herein below referred to as **claim 1**) reading as follows:

"*1. Use of citric acid and/or a salt of citric acid in a composition comprising a detergent surfactant at a concentration between 0.01 to 50 % by weight, and citric acid and/or a salt of citric acid at a concentration between 0.05 % by*

weight and 10 % by weight, wherein the composition has a pH between 8.5 and 12, for facilitating the removal of soil, in particular fatty soil, from a hard surface, wherein the surface is treated with citric acid and/or a salt of citric acid prior to deposition of the soil.

The set of claims according to said Main and First Auxiliary Requests also comprised, besides claims directed to a "*use*" (herein below referred to as "*use*" claims) claims directed to a "*method for removing soil or stains from a hard surface*" (herein below referred to as "*method*" claims).

The set of claims according to said Second Auxiliary Request comprises "*use*" claims only.

IV. In the contested decision, the Opposition Division found that the (identical) "*use*" claims according to the Main, First Auxiliary and Second Auxiliary Requests) complied with the EPC, but that the "*method*" claims of the Main Request, as well as those of the First Auxiliary Request were not allowable for lack of inventive step in view of D12.
Hence, the Opposition Division rejected the Main Request and the First Auxiliary Request and found that the patent as amended according to the Second Auxiliary Request met the requirements of the EPC.

In its decision, the Opposition Division used the acronym NTCB when referring to a "*next time cleaning benefit*", this latter expression being generally defined in paragraph [0002] of the granted patent as describing a beneficial effect of the treatment of a hard surface with a material (e.g. with a cleaning composition), and said beneficial effect consisting in

rendering it easier to remove any soil and/or stains deposited on the (previously) treated hard surface.

In section "2.2.3" the Opposition Division
- gave its interpretation of use claim 1 ("... claim 1 claims the use of citric acid in a composition comprising a surfactant and citric acid. Accordingly, all examples verify that the citric acid performs a NTCB when used together with a surfactant".)
and
- indicated the reasons for which the subject-matter of said claim was found to be novel over, *inter alia*, the prior art disclosed in D12.

In this respect the Opposition Division referred also to decision G 2/88 (OJ EPO, 1990, 93). In particular, the relevant passages of section "2.2.3" of the decision read as follows (see from the last paragraph on page 5 to the first paragraph on page 7):

"... the opposition division is of the opinion that claim 1 claims the use of citric acid in a composition comprising a surfactant and citric acid ... the subject-matter of claim 1 is not related to the removal of a soil from a surface, but to facilitate the removal of soil, which has been deposited on the surface after this treatment step.

In view of these considerations, it was found that none of the documents cited by the opponents revealed that citric acid in a composition comprising citric acid and a surfactant served to provide a NTCB. A couple of these documents indeed were concerned with NTCB. However, the claimed effect was caused by other ingredients.
....

In D12, examples, citric acid was used as a buffer. The NTCB in D12 is unambiguously achieved by using a polyalkoxylene glycol diester.

...

Since the patent-in-suit provides evidence that the intended use can be achieved, it has to be taken as a technical feature in view of G 2/88. None of the cited documents reveals the claimed effect, which is clearly distinguishable from a first time cleaning benefit, i.e. a simple soil removal performance. Accordingly, the subject-matter of claim 1 was found to be novel over the cited prior art."

V. In their respective statements of grounds of appeal both Opponent 1 and Opponent 3 maintained novelty objections against claim 1 in view of the prior art disclosed in D12.

More particularly, in this respect, Opponent 3 (see statement of grounds of appeal, points 7.11 and 7.13) referred to case law, in particular decisions T 254/93 (OJ EPO 1998, 285) and T 892/94 (OJ EPO 2000, 1).

VI. With its statement of grounds of appeal the Proprietor (re-)filed a set of claims labelled **Main Request** but otherwise identical to the First Auxiliary Request refused by the Opposition Division.
The Proprietor also (re-)filed as **First Auxiliary Request** the set of claims held allowable by the Opposition Division.

The Proprietor then replied to the appeals of Opponents 1 and 3 with letter of 26 January 2015, rebutting *inter*

alia the novelty objections raised against the pending use claims 1 by the adverse Parties.

VII. The Parties were summoned to oral proceedings, which were held on 7 March 2018 in the absence of the duly summoned Opponent 3. Following the debate on novelty of use claim 1 (both pending requests) and aware of the Board's negative provisional view in this respect, the Proprietor filed as **Second Auxiliary Request** a further set of amended claims (marked as "Aux 2").

VIII. Final requests of the parties

Opponent 1 requested (in writing and at the oral proceedings) and Opponent 3 requested (in writing), that the decision under appeal be set aside and the patent be revoked.

The Patent Proprietor requested
- that the decision under appeal be set aside and the patent be maintained on the basis of the set of claims filed as Main Request with its statement of grounds
or, if that is not possible,
- that the appeals by the Opponents 1 and 3 be dismissed or, if that is not possible either,
that the patent be maintained on the basis of the set of claims filed as Second Auxiliary Request at the oral proceedings before the Board.

Opponent 2 requested that the appeal by the Patent Proprietor be dismissed.

IX. The Opponents' submissions of relevance here can be summarised as follows:

Main Request and of the First Auxiliary Request - lack of novelty - claim 1

The Opposition Division had erred in considering the claimed use novel vis-à-vis the use, disclosed in D12 (*inter alia* in example L thereof), of cleaning compositions in their neat (i.e. undiluted) form on hard surfaces for obtaining an NTCB. More particularly since in the present case the claimed use had the same purpose as the one disclosed as prior art, the Opposition Division had erred in considering that the newly discovered contribution of citric acid or citrates (herein below referred to collectively as **citric acid**) to the NTCB rendered novel the use of as defined in present claim 1 for the reasons given in G 2/88. In the Opponents' opinion, decisions (*inter alia)* T 892/94 and T 254/93 were of relevant case law in the present case. As regards the relevance of these latter decisions, the statement of grounds of appeal of Opponent 3 (points 7.11 to 7.13) contains the following statements:

"7.11 ... T892/94 concerned deodorant compositions. ... In the last sentence of the Reasons at 3.4 the Board held that 'it can be inferred from Decision G2/88 that no novelty exists, if the claim is directed to the use of a **known substance** for a **known non-medical purpose**, even if **a newly discovered technical effect** underlying said known use is indicated in that claim'. ...

7.12 An analogous situation arises in the present case. There is a known substance (citric acid used in a known composition) for a known non-medical purpose of

providing next-time cleaning benefit. The allegedly newly discovered technical effect of a contribution of the citric acid to the next-time cleaning benefit cannot confer novelty. This is essentially an explanation of a discovery relating to the citric acid rather than a novel use in accordance with G2/88.

7.13 As discussed in T892/94 at Reasons, 3.7, this reasoning is consistent with T254/93. In T254/93 it was stated that the mere explanation of an effect obtained when using a compound in a known composition, even if the effect was not known to be due to this compound in the known composition, cannot confer novelty on a known process if the skilled person was aware of the occurrence of the desired effect. Put another way, before publication of the present patent the skilled reader would have used compositions containing citric acid and a detergent surfactant in the stated amounts at the stated pH in order to provide next-time cleaning benefit. After publication of the present patent those skilled in the art would have continued to use such compositions for this purpose although they would now be aware of the explanation that the citric acid may contribute to the next-time cleaning benefit effect. This does not constitute a new non-medical use in accordance with G2/88."

Second Auxiliary Request - Not to be admitted into the proceedings

The very late filing of this request at the oral proceedings before the Board was not justifiable. Indeed, all requests decided upon by the Opposition Division, as well as those pending before the Board until that moment, comprised a "*use*" claim that had been constantly objected by the Opponents (again in

their statements of grounds of appeal) for lack of novelty, in particular over D12. Moreover, no new issue was raised at the hearing before the Board. Therefore the Board should not admit such claim request into the proceedings.

X. The Proprietor's submissions of relevance here can be summarised as follows:

Main Request and of the First Auxiliary Request - novelty - claim 1

The Opposition Division had correctly construed the meaning of claim 1 and correctly concluded that the claimed use was novel vis-à-vis the disclosure in D12, since this latter did not disclose the use of citric acid for obtaining an NTCB. As indicated in G 2/88, a new technical effect imparted novelty to a claim directed to the second non-medical use of a known substance, even when the means for carrying out such second non-medical use were the same as those required in carrying out the already known use of that substance.
D12 explicitly attributed (see page 2, line 36 to page 3, line 4) an NTCB to a very specific polymer composition, and not to the citric acid ingredient. According to D12, the latter was only provided as builder or pH regulator.
It was, however, conceded that there was no reason for disputing that also when e.g. the composition of example L of D12 was used neat to clean hard surfaces, the citric acid present in this composition would contribute to the NTCB that D12 explicitly disclosed to be caused when using such composition in neat form.

Second Auxiliary Request - Admittance into the proceedings

The Second Auxiliary Request resulted from the deletion of all "*use*" claims from the set of claims according to the pending Main Request. Hence, the claims in this request were the same "*method*" claims that were already present in the Main request. The patentability of these "*method*" claims had already been debated before the Opposition Division and in the Parties' written submissions in the appeal proceedings. Hence, the Opponents and the Board would clearly have no difficulties in dealing with the claims forming such request. Therefore, the Second Auxiliary Request should be admitted into the proceedings despite its late filing.

Reasons for the Decision

Main Request of the Proprietor

1. Interpretation of claim 1

1.1 As explicitly stated in the Proprietor's reply of 26 January 2015 (see page 1, paragraph "Interpretation of claim 1"), its interpretation of claim 1 (full wording under III, *supra*) is the one adopted by the Opposition Division (see IV, *supra*), namely that this claim defines

- the use of citric acid in a composition comprising a surfactant and citric acid
- in which a hard surface is treated with the composition
- to provide an NTCB (i.e. to facilitate the removal of soil deposited on the surface previously treated with the composition).

In other words, the claimed use (activity) comprises treating a hard surface with a composition as defined in claim 1, whereby the citric acid ingredient of the composition provides (or contributes to provide) the treated surface with an NTCB.

1.2 The Board holds that this interpretation is correct. Considering that based on this interpretation also adopted by the Proprietor, the Board reached a negative conclusion as regards the novelty of the claimed subject-matter, no further details regarding the reasons for adopting this interpretation need to be given.

2. Lack of novelty - claim 1

2.1 The Board notes preliminarily that the wording of claim 1 at stake implies the ability of citric acid to provide a certain technical effect. Said effect is that when a hard surface is treated with a composition containing surfactants and citric acid, this latter ingredient provides (or at least contributes to provide) an NTCB to the treated surface.

2.1.1 It is undisputed among the Parties that the prior art does not disclose as such that citric acid may provide or contribute to providing this technical effect.

2.1.2 Hence, herein below this technical effect attributable to the presence of citric acid will be referred to as **the newly discovered technical effect**.

2.2 The Board notes further that novelty of the subject matter of claim 1 was disputed in view of, *inter alia*, the compositions for cleaning hard surfaces disclosed in D12, such as the composition "L" described on page

40 of D12. It is undisputed that the pH and the amounts of surfactant(s) and citric acid fall within the ranges defined in claim 1 at issue as regards the "*composition*" to be used. According to D12 (Page 41, last paragraph) "[c]ompositions A to L provide not only excellent first time cleaning performance both when used under neat or diluted conditions but also excellent next time cleaning performance. Thus the cleaning process is facilitated". Composition L is thus expressly and unambiguously disclosed to provide an NTCB (also) when used in neat form.

2.3 The assessment of novelty over D12 thus boils down to answering the question whether or not the definition of the subject-matter of claim 1 at issue embraces the use of the composition L to provide an NTCB to hard surfaces as disclosed in D12.

2.4 The Proprietor essentially relied on the reasoning given by the Opposition Division in the contested decision, i.e. that the subject-matter of use claim 1 was novel because of the novelty of the newly discovered technical effect. In particular, according to the Opposition Division, this newly discovered technical effect had to be taken as a technical feature of the claimed use "in view of G 2/88".

2.5 According to G 2/88 (OJ EPO, 1990, 93), Reasons 10.3, "... with respect to a claim to a new use of a known compound, such new use may reflect a newly discovered technical effect described in the patent. The attaining of such a technical effect should then be considered as a functional technical feature of the claim (e.g. the achievement in a particular context of that technical effect)."

If not previously made available to the public, such functional feature may thus impart novelty to the the claimed subject-matter.

An identical reasoning is given in G 6/88 (OJ 1990, 114, Reasons, 9).

2.6 In T 892/94 (Reasons, 3.4) invoked by Opponent 3, the Board, taking into consideration *inter alia* G 2/88, Reasons, 10.3, came to the following conclusion:

"It follows from decision G 2/88 .... that novelty within the meaning of Article 54(1) can be acknowledged in cases where the discovery of a **new technical effect** of a **known substance** leads to an invention which is defined in the claim in terms of the use of that substance for a **hitherto unknown**, **new non-medical purpose** reflecting said effect (ie a new functional technical feature), even if the only novel feature in that claim is the purpose for which the substance is used.

Conversely, it can be inferred from decision G 2/88 that no novelty exists, if the claim is directed to the use of a **known substance** for a **known non-medical purpose**, even if **a newly discovered technical effect** underlying said known use is indicated in that claim."

2.7 Hence, also in the present case it needs to be assessed whether the claimed use is a use of a substance **for a new non-medical purpose** or for **a known non-medical purpose.**

2.7.1 In its reasoning regarding novelty, the Proprietor only referred to the newly discovered technical effect and to the means of realisation of this effect. Thus, the

Proprietor's submissions appear to implicitly equate the purpose of the claimed use (activity) with the newly discovered technical effect of citric acid.

2.7.2 The Board holds, however, that the newly discovered technical effect of citric acid is not the purpose of the claimed use. As already addressed under 1.1, *supra*, the claimed use comprises the (activity of) treating a hard surface with a composition as defined in claim 1, whereby the citric acid ingredient of the composition provides (or contributes to providing) the treated surface with NTCB.

Thus, the actual purpose of the claimed use (activity) is that of providing NTCB to a hard surface.

2.7.3 This is exactly the same purpose that is disclosed in D12 as regards the use of composition L.

The Proprietor stressed that in D12 the NTCB attained was not attributed to the citric acid component (only referred to as "buffer" and "builder" in D12, see the Tables on pages 39 and 40 and page 27, lines 7 and 22) but to other, polymeric "antiresoiling ingredients" of composition L (D12: paragraph bridging pages 2 and 3).

These indications have no bearing on the fact that D12 discloses that the citric acid containing composition L can be used in neat form on a hard surface with the purpose of providing this latter with an NTCB (page 41, last paragraph).

2.7.4 Hence it is apparent, in view of the implications of the decision G 2/88 as set out in the passages of T 892/94 quoted under 2.6, *supra*, that in the present case claim 1, being directed to the use of a **known**

substance (as a component of a known composition) for a **known non-medical purpose** (of said composition), is, thus, not directed to a new use in the sense of G 2/88 even though a **newly discovered technical effect** underlying said known use is indicated in the claim.

2.8 This finding of the Board is also in accordance with the rationale of the decision T 254/93 cited by the Opponents.

2.8.1 Reference is made, in particular, to Reasons 4.8 of T 254/93, in which the Board considered, in respect of a use claim, that "the mere explanation of an effect obtained when using a compound **in a known composition**, even if the explanation relates to a[n] ... effect which was not known to be due to that compound in the known composition, cannot confer novelty on a known process [sic; read 'use'] if the skilled person was already aware of the occurrence of the desired effect when applying the known process" [sic; read 'use'].

The relevance, for the present case, of this decision actually relating to a second medical indication becomes apparent when considering

- that already before publication of the patent in suit the person skilled in the art reading D12 was taught to provide an NTCB to a hard surface by treating it with composition L (because this latter comprised certain polymeric compounds), but

- that after the publication of the patent in suit such composition would still be used for the very same purpose disclosed in D12, although the user would now be aware of the (further) explanation that (also) the citric acid contributes to the NTCB.

2.9 In the Board's judgement based on the above considerations, the subject-matter of claim 1 of the Proprietor's Main Request lacks novelty over the prior art disclosed in D12 (Article 52(1) and 54(1),(2) EPC).

First Auxiliary claim Request - lack of novelty - claim 1

3. Claim 1 at issue is identical to claim 1 of the Main Request dealt with above. Its subject-matter thus also lacks novelty over D12 for the reasons given above (Article 52(1) and 54(1),(2) EPC).

Second Auxiliary claim Request - Non-admittance into the proceedings

4. The Second Auxiliary claim Request was only filed towards the end of the oral proceedings before the Board. This course of action was objected to by the Opponents 1 and 2 represented at the hearing.

4.1 In deciding on the admittance of this claim request into the proceedings, the Board took into account the following aspects:

- The filing of this request only comprising "*method*" claims can undisputedly be considered to address the novelty objection raised by the Opponents against the "*use*" defined in claim 1 of the two claim requests pending at that point in time.

- The reasons for this novelty objection had already been presented in detail in the respective statements of grounds of appeal of Opponent 1 (see section entitled "Novelty of the Second Auxiliary

Request" on page 2) and Opponent 3 (points 7.10 to 7.13, see passages quoted under XI, *supra*).

- As expressly noted by the Opponents and not disputed by the Proprietor, no new arguments or facts were raised during the debate at the oral proceedings before the Board that preceded the filing of the Second Auxiliary Request.

4.2 For the Board, the Second Auxiliary Request was filed extremely late without any proper justification. In particular, the argument of the Proprietor that it would have been possible for the Opponents and the Board to deal with this request at the oral proceedings since it only comprised claims already present in the other requests), is *per se* no justification for filing such request at this very late point in time.

5. Therefore, the Board decided, in the exercise of its discretion under Articles 12(4) and 13(1) and (3)RPBA, not to admit Second Auxiliary Request into the proceedings in view of their belated filing.

Conclusion

6. None of the Proprietor's requests admitted into the proceedings is allowable.

Order

For these reasons it is decided that:

- The decision under appeal is set aside.
- The patent is revoked.

The Registrar: The Chairman:

D. Magliano B. Czech

Decision electronically authenticated