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**Boards of Appeal of the
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**Chambres de recours de
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Please find enclosed the headnote of the decision T6661 89 - 3.3. 1

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Publication in the Official Journal Yes / No

File Number: T 666/89 - 3.3.1
Application No.: 83 302 450.8
Publication No.: 0 093 601
Title of invention: Washing composition
Classification: C11D 3/22

D E C I S I O N
of 10 September 1991

Proprietor of the patent: UNILEVER NV
Opponent: Henkel Kommanditgesellschaft auf Aktien

Headword: Washing Composition/UNILEVER

EPC Article 54

Keyword: "Novelty (no)" - "disclosure of a document is not confined to its examples" - "novelty examination in cases of 'selection' or 'overlapping ranges'" - "purposive selection distinguishes role of 'tests' in selection cases" - "difference from approach to obviousness"

Headnote

I. Under the EPC patents are not granted for the sole reason that they are "selections", but only for new and inventive subject-matter of certain defined kinds. Accordingly, there is no fundamental difference between deciding novelty in situations of so-called "overlap" or "selection", and in doing so in other situations (see paragraphs 6 and 8 of the reasons).

II. Matter that is "hidden" in a prior art document, in the sense of being reconditely submerged rather than deliberately concealed, will not have been "made available" to the public (cf. G 02/88). In the case of overlapping numerical ranges of physical parameters between a claim and a prior art disclosure, one useful approach to determining what is "hidden" as opposed to what has been made available, is to consider whether or not a person skilled in the art would, in the light of all the technical facts at his disposal, seriously contemplate applying the technical teaching of the prior art document in the range of overlap (cf. T 26/85). Provided the information in the prior art

document, in combination with the skilled person's common general knowledge, is sufficient to enable him to practise the technical teaching, and if it can reasonably be assumed that he would do so, then the claim in question will lack novelty (see paragraph 7 of the reasons).

III. The above concept of "seriously contemplating" moving from a broad to a narrow (overlapping) range, while seemingly akin to one of the concepts used by the Boards for assessing inventive step, namely, whether the notional addressee "would have tried, with reasonable expectation of success" to bridge the technical gap between a particular piece of prior art and a claim whose inventiveness is in question, is fundamentally different from this "inventive-step concept" because in order to establish anticipation, there cannot be a gap of the above kind (see paragraph 8 of the reasons).

IV. Under the EPC novelty must be decided by reference to the total information content of a cited prior document, and in assessing the content for the purpose of deciding whether or not a claim is novel, the Board may employ legal concepts that are similar to those used by them in deciding issues of obviousness, without, however, thereby confusing or blurring the distinction between these separate statutory grounds of objection (see paragraph 8 of the reasons).



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Please find enclosed a copy of the decision correcting errors in the decision

T666/89-3.3.1

Veuillez trouver en annexe une copie de la décision rectifiant des erreurs dans la décision

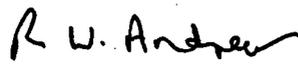
In application of Rule 89 EPC the front page of the Decision in the Appeal Case T 666/89 - 3.3.1 is hereby ordered to be corrected as follows:

Keyword: "Novelty (no)" - "disclosure of a document is not confined to its examples" - "novelty examination in cases of 'selection' or 'overlapping ranges'" - "purposive selection"- "role of 'tests' in selection cases" - "difference from approach to obviousness"

The Registrar:

The Chairman:


E. Gorgmaier


R. Andrews

Publication in the Official Journal Yes / No

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DECISION
of 10 September 1991

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EPC Article 54

Keyword: "Novelty (no)" - "disclosure of a document is not confined to its examples" - "novelty examination in cases of 'selection' or 'overlapping ranges'" - "purposive selection distinguishes role of 'tests' in selection cases" - "difference from approach to obviousness"

Headnote

Headnote follows



Case Number : T 666/89 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 10 September 1991

Appellant :
(Opponent) Henkel
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Decision under appeal : Decision of Opposition Division of the European
Patent Office dated 28 August 1989 rejecting the
opposition filed against European patent
No. 0 093 601 pursuant to Article 102(2) EPC.

Composition of the Board :

Chairman : R. Andrews
Members : P. Krasa
J. Stephens-Ofner

Summary of Facts and Submissions

I. The mention of the grant of patent No. 0 093 601 in respect of European patent application No. 83 302 450.8 filed on 29 April 1983 and claiming the priority of 30 April 1982 from an earlier application in the United Kingdom, was published on 7 October 1987 (cf. Bulletin 87/41) on the basis of twelve claims. Independent Claims 1, 7 and 11 read as follows:

"1. An aqueous washing composition for washing a surface to deposit thereon substantially water-insoluble particles, which composition comprises an anionic surfactant, the particulate substance and a water-soluble cationic polymer, having a molecular weight within the range of from about 2,000 to about 3,000,000, for enhancing the deposition of the particulate substance onto the surface, characterised in that the water-soluble cationic polymer is a non-cellulosic polymer which does not form in the composition a water-insoluble complex with the anionic surfactant, and wherein the cationic charge density of the polymer is from 0.0001 to 0.0017; the concentration of the cationic polymer in the washing composition is from 0.0001% to 0.01% by weight; and the concentration of the surfactant in the washing composition is from 0.01% to 5% by weight.

7. A shampoo for washing hair on the head which upon diluting 10 times with water furnishes an aqueous washing composition as claimed in any of Claims 1 to 6 which composition comprises the anionic surfactant in a concentration of 0.8 to 2.5% by weight.

11. A detergent composition for cleaning fabrics which is suitable upon diluting 250 times with water for furnishing an aqueous washing composition as claimed in

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Claim 1, wherein the particulate substance consists of a fabric conditioning or treating agent."

II. A notice of opposition was filed in due time by the Appellant (Opponent) requesting the revocation of the European patent on the grounds of lack of novelty and lack of inventive step. The opposition was based, inter alia, on the following document:

(3) EP-B-0 078 138.

III. By a written decision, posted on 28 August 1989, the Opposition Division rejected the opposition.

The Opposition Division concluded that the subject-matter of the independent claims of the disputed patent was novel, as none of the citations disclosed a composition comprising all the features of the compositions claimed.

The Opposition Division also found that the claimed subject-matter was inventive.

IV. The Appellant lodged an appeal against this decision on 13 October 1989, with simultaneous payment of the prescribed fee and filed a Statement of Grounds of Appeal on 19 October 1989.

In this statement the Appellant argued, inter alia, that document (3) was novelty destroying for the subject-matter of the disputed patent, because the shampoos disclosed therein gave, when diluted (as they would be in use), the same compositions as those of Claim 1.

V. The Respondent's counterarguments were as follows: It seemed to be most unlikely that during the use of the compositions of the state of the art such a high dilution

would be achieved as to make the diluted composition fall within the claimed ranges. The further step of rinsing, however, is uncontrolled and will not result in a uniform drop of concentration. Thus, a mixture with rapidly changing concentrations and variations from one part of the head to another cannot be regarded as a "composition".

As regards inventive step, the Respondents accepted the view of the Opposition Division.

VI. In a communication dated 21 June 1991 the Rapporteur indicated to the parties that the document

(3a) EP-A-0 078 138

raised doubts regarding the novelty of Claim 7 under Article 54(3) EPC. Document (3a), which was published on 4 May 1983, corresponds to European patent application No. 82 305 517.3 filed on 18 October 1982 and claims the priority of 24 October 1981 from an earlier application in the United Kingdom.

VII. The Respondent argued in writing and orally, that the examples of document (3a) lay outside the scope of Claim 7 and that the generic disclosure therein could not be held to be an anticipation of this claim.

VIII. The Appellant requested that the disputed patent be revoked; the Respondent requested that the appeal be dismissed or, alternatively, that the patent be maintained in amended form on the basis of two auxiliary requests submitted in the course of oral proceedings which took place on 10 September 1991.

The first auxiliary request only concerns amendments to Claims 11 and 12.

Claim 1 of the second auxiliary request differs from Claim 1 as granted by amending the introductory part to read as follows:

"An aqueous washing composition for washing hair on the head to deposit thereon...";

furthermore, the concentration range for the surfactant specified at the end of the claim was changed from "0.01% to 5%" to "0.8% to 2.5%".

Amendments to Claims 11 and 12 were also requested. Claims 2 to 10 of the request correspond to Claims 2 to 10 as granted.

IX. At the end of the oral proceedings the Chairman announced the decision of the Board to allow the appeal.

Reasons for the Decision

1. The appeal is formally admissible.
2. Claim 7 according to the main request relates to compositions which, on ten-fold dilution, yield the compositions of Claim 1 comprising from 0.8% to 2.5% of the anionic detergent. It follows from this definition that the compositions of Claim 7 comprise the following:
 - from 8% to 25% of an anionic detergent;
 - a particulate substrate;
 - from 0.001% to 0.1% of a cationic polymer having

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- a molecular weight of from 2 000 to 3 000 000,
 - a cationic charge density of from 0.0001 to 0.0017,
 - which cationic polymer is not a cellulosic polymer and
 - does not form a water-insoluble complex with the anionic polymer and which shall
 - enhance the deposition of the particulate substance onto the surface treated.

3. Document (3a) is an earlier European patent application, and its contents as filed, is considered, pursuant to Article 54(3) EPC, as being part of the state of the art (compare No. VI above) for all the States designated in the patent in suit.

4. Document (3a) concerns particular shampoo compositions containing an antidandruff agent such as zinc pyridine thione (page 1, lines 1 to 8). This shampoo comprises two gel bodies, one of which contains the antidandruff agent (the sentence bridging pages 1 and 2). Document (3a) discloses, in the second paragraph on page 3, that, preferably, each gel body contains one or more agents designed to improve the cosmetic condition of the hair after shampooing. Such agents may comprise, inter alia, agents with surface active properties. After specifying the suitable surface active materials it is stated:

"A particular effective material is a cationic guar gum sold under the trade name Jaguar C-13-S by Meyhall Chemicals Ltd. This may be present in either or both gel bodies in an amount from 0.1 to 5.0% by weight of the total composition."

Furthermore the compositions according to document (3a) may comprise any conventional detergent. The paragraph bridging pages 3 and 4 of this documents reads:

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"The compositions according to the invention may include any conventional detergent well known in the art. For shampoo compositions, it is usual to use an anionic detergent, for example alkali metal, ammonium or hydroxyalkylamine salts of alkylsulphates or alkyl ether sulphates, alkyl benzene sulphonates, alkyl sulphones, α -alkenyl sulphonates, polyoxyethylene-alkyl sulphonates and polyoxyethylenealkylphenylsulphates. However, non-ionic and amphoteric detergents may also be used. A preferred detergent comprises sodium lauryl ether sulphate. A shampoo composition preferably contains from 5 to 25% w/w of detergent (based upon 100% active material)."

Jaguar C-13-S, which is disclosed in document (3a) as a particularly effective cationic polymer, falls (as was agreed by the parties) within the meaning of "cationic polymer" as defined in the patent in suit and it is also described in most of the examples of this patent (see e.g. Experiments 1 and 4 to 9 and also page 3, lines 49 to 51). Thus, compositions which fall within the range of compositions disclosed in document (3a) as preferred ones also fall within the scope of Claim 7 of the disputed patent, i.e. those which comprise 0.1% by weight of Jaguar C-13-S and from 8% to 25% by weight of sodium lauryl ether sulphate.

There is no disclosure or indication in document (3a) that particular rules have to be observed when combining the respective components of the shampoos concerned, which rules would lead the skilled person not to follow the technical teaching of document (3a) with respect to those compositions which overlap with those claimed in Claim 7.

The definition of the concentration range for the cationic guar gum of from 0.1% to 5% by weight of the total composition in document (3a) specifically discloses compositions comprising 0.1% by weight of the total composition of Jaguar C-13-S.

Accordingly, the Board finds that combining this disclosure with the disclosure that the compositions of document (3a) also contain from 5% to 25% by weight of sodium lauryl ether sulphate makes available to the public compositions falling within the scope of the present Claim 7. Therefore, in the Boards judgement, the subject-matter of Claim 7 in accordance with the main request lacks novelty.

- 5. The Respondent's argument that there is no additional disclosure in document (3a) which would lead the skilled person to combine the particular pieces of disclosure of this document to arrive at the claimed subject-matter is not convincing since the document makes available in a clear technical teaching compositions comprising the combinations of upper and lower limits of both the said cationic polymer and lauryl ether sulphate. Thus, no additional disclosure is required even to draw the skilled person's attention to make this combination let alone to induce him to do so.

Insofar as the Respondent submitted that generic information in connection with compositions has practically no meaning and that only the examples of a document should be regarded as state of the art in this respect, he had ignored the established jurisprudence of the Boards of Appeal, according to which it is necessary to consider the whole content of a citation when deciding the question of novelty (see e.g. T 4/83, OJ EPO 1983, 498, para. 4 of the reasons, T 198/84, OJ EPO 1985, 209 and T 124/87, OJ EPO 1989, 491, para. 3.2 of the reasons).

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In applying this principle, the evaluation must therefore not be confined to a comparison of the claimed subject-matter with only the examples of a citation, but must extend to all the information contained in the earlier document (T 332/87, para. 2.2 of 23 November 1990, unpublished, confirming T 424/86, para. 4.2 of 11 August 1988, unpublished).

6. The Respondent also submitted in the course of oral proceedings that, as a matter of law, it was not permissible to cross the legal borderline between novelty, in the strict sense of a clear and specific disclosure in a prior document of the particular narrow combination of claimed ranges in question on the one hand, and the obviousness of choosing such a combination of ranges from that prior art document containing a disclosure of the broader range, on the other hand. In this connection the Board wishes to set out the general legal principles that apply to so-called "selection" patents.

The most important one is that under the EPC patents are not granted for inventions for the sole reason that they are "selections", but only for new and inventive subject-matter of certain defined kinds (Articles 52 to 57 EPC). Selection is in fact only a conceptual tool, used principally in the field of chemical inventions, for deciding novelty in certain situations, which novelty can, however, only be decided under the express provisions of Article 54, and in particular Articles 54(2) and (3) EPC. Article 54(2) EPC defines the state of the art as comprising "everything made available to the public by means of written or oral description, by use or in any other way". The term "available" clearly goes beyond literal or diagrammatical description, and implies the communication, express or implicit, of technical information by other means as well. Now it is of course

true that in the case of documents the natural mode of communicating information is by written or diagrammatical description. However, this is not the end of the matter in deciding what information content has been made available: cf. G 02/88, OJ EPO 1990, 003, para. 10 of the reasons. One example of the available information content of a document extending beyond this literal descriptive or diagrammatical content is the case where the carrying out of a process, specifically or literally described in a prior art document, inevitably results in a product not so described. In such a case, the prior art document will destroy the novelty of a claim covering a product; cf. T 12/81, "Diastereomers", OJ EPO 1982, 296. It is thus content, express and implied, rather than mere form, that is decisive of the issue of novelty in general, and "selection" novelty in particular (cf. T 198/84, "Thiochloroformates", OJ EPO 1985, 209, para. 4 of the reasons, English version corrected in T 124/87, "Copolymers", OJ EPO 1989, 491, para. 3.2 of the reasons; T 26/85, "Thickness of magnetic layers", OJ EPO 1990, 22, para. 8 of the reasons).

7. Clearly, the decision on this issue will depend on the facts of each case. Nevertheless, the Boards' jurisprudence has generated certain general principles and broadly applicable concepts, sometimes (erroneously) referred to as "tests". Thus it is clear, (cf. G 02/88 cited above), that matter that is hidden, not in the sense of being deliberately concealed but rather in the sense of being reconditely submerged in a document, will not have been "made available" in the above sense. In the case of overlapping ranges of physical parameters between a claim and a prior art disclosure, what will often help to determine what is "hidden" as opposed to what has been made available, is whether or not a skilled person would find it difficult to carry out the prior art teaching in

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the range of overlap (T 124/87, OJ EPO 1989, 495, para. 3.4). A similar approach adopted by a Board of Appeal (cf. T 26/85 OJ EPO 1990, 22) for assessing the novelty of a claim in a case where overlapping numerical ranges of certain parameters exist between a claim and a prior art document, is to consider whether a person skilled in the art would, in the light of all the technical facts at his disposal, seriously contemplate applying the technical teaching of the prior art document in the range of overlap. Provided the information in the prior art document, in combination with the skilled person's common general knowledge, is sufficient to enable him to practise the technical teaching, and if it can reasonably be assumed that he would do so, then the claim in question will lack novelty.

8. In the Board's view, there is no fundamental difference between examining novelty in situations of so-called "overlap" or "selection", and in doing so in other situations, although it may be helpful, in order to verify a preliminary conclusion of a novelty examination in cases of overlap, to investigate whether or not a particular technical effect is associated with the narrow range in question. It needs to be stressed, however, that such a particular effect is neither a prerequisite for novelty nor can it as such confer novelty: its existence can merely serve to confirm a finding of novelty already achieved (following T 198/84, OJ EPO 1985, 209, para. 7).

The above concept of "seriously contemplating" moving from a broad to a narrow (overlapping) range, while seemingly akin to one of the concepts used by the Boards for assessing inventive step, namely, whether the notional addressee "would have tried, with reasonable expectation of success" to bridge the technical gap between a particular piece of prior art and a claim whose

inventiveness is in question, is fundamentally different from this "inventive-step concept" because in order to establish anticipation, there cannot be a gap of the above kind.

In summary, and in dealing with the Respondent's submission outlined previously, under the EPC novelty must be decided by reference to the total information content of a cited prior document, and in assessing the content for the purpose of deciding whether or not a claim is novel, the Board may employ legal concepts that are similar to those used by them in deciding issues of obviousness, without, however, thereby confusing or blurring the distinction between these two separate statutory grounds of objection.

9. Both the auxiliary requests contain the same Claim 7 as the main request and, thus, must fail for the same reasons as the main request.

Order

For these reasons, it is decided that:

1. The appeal is allowed.
2. The patent is revoked.

The Registrar:


E. Görgmäjer

The Chairman:


R. Andrews