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D E C I S I O N
of 14 September 2000

Case Number: T 0586/97 - 3.3.1

Application Number: 91915675.2

Publication Number: 0591195

IPC: C09K 3/30

Language of the proceedings: EN

Title of invention:

A concentrated aerosol space spray

Applicant:

SOLTEC RESEARCH PTY. LTD.

Opponent:

-

Headword:

Aerosol/SOLTEC

Relevant legal provisions:

EPC Art. 84, 123(2)
EPC R. 29(1), 35(12)

Keyword:

"Clarity of claim (no) - 'active ingredient' as essential technical feature unclear" (point 4.1 of the reasons)
"Support of claim (no) - essential feature missing in claim - claim exceeds scope of invention as disclosed in description" (point 4.2 of the reasons)

Decisions cited:

G 0002/88, T 0409/91, T 0188/92, T 1055/92, T 0680/93,
T 0825/94, T 0337/95

Catchword:

1. When an essential ingredient comprised in a chemical composition is open to be labelled arbitrarily "active ingredient" or not depending exclusively on the mental label the user wishes to apply, thereby rendering the meaning of that feature protean, then the public is left in doubts as to the distinction which compositions are covered by the claim and which are not, which is at variance with the principle of legal certainty. Because of that lack of legal certainty, the claim fails to meet the requirement of clarity imposed by Article 84 EPC. (reasons point 4.1.2.2)

2. The absence from the independent claim of any upper limit on the amount of a particular component in the chemical composition claimed, is at variance with the aim of the invention as set out in the description; hence that claim is so broad that it goes beyond the scope of the invention as disclosed in the description. Therefore, the requirement of Article 84, second sentence, EPC, that the claims must be supported by the description is not met. (reasons point 4.2)



Case Number: T 0586/97 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 14 September 2000

Appellant: SOLTEC RESEARCH PTY. LTD.
8 Macro Court
Rowville
Victoria 3178 (AU)

Representative: West, Alan Harry
R. G. C. Jenkins & Co.
26 Caxton Street
London SW1H ORJ (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 December 1996
refusing European patent application
No. 91 915 675.2 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: R. Freimuth
S. C. Perryman

Summary of Facts and Submissions

- I. The appeal lodged on 12 February 1997 lies from the decision of the Examining Division posted on 3 December 1996 refusing European patent application No. 91 915 675.2 (European publication No. 591 195), which was filed as international application published as WO 92/04419.
- II. The decision of the Examining Division was based on claims 1, 3, 4, 7 to 10, 13, 17 to 23 and 26 to 29 submitted at the oral proceedings before that Division on 7 November 1996 according to the then pending request.

The Examining Division held that the claims contained many defaults as to clarity pursuant to Article 84 EPC. As to the term "active ingredient", which was an essential technical feature of the invention, the meaning thereof needed interpretation. For the person skilled in the art, that term referred to the pure agent which was not in line with the description of the present application, in particular the examples, specifying the active agent to contain solvents. Thus, the claims were also not supported by the description. Furthermore the object of the invention consisted in providing highly concentrated aerosol compositions containing a homogenous mixture of active ingredient and propellant. Due to its unclear definition, the term "active ingredient" comprised the presence of a solvent in high amounts which was in contradiction with the object of the invention.

III. The Appellant (Applicant) submitted fresh claims 1 to 7 together with the Statement of Grounds of Appeal filed on 14 April 1997, arguing that those claims were restricted to subject-matter satisfying the requirements of Article 84 EPC. Independent claim 1 read as follows:

"1. An aerosol composition for use in a space spray aerosol dispenser, comprising an active ingredient and a propellant, characterized in that the composition is a substantially single phase homogeneous solution of the propellant in the active ingredient."

IV. At the oral proceedings before the Board held on 14 September 2000 the Appellant filed an alternative set of amended claims 1 to 5, claim 1 according to that auxiliary request reading as follows:

"1. An aerosol composition for use in a space spray aerosol dispenser, comprising an active ingredient, at least 15 weight % of a suitable propellant and, optionally, up to 25 weight % solvent, characterized in that the composition is a single phase homogeneous solution of the propellant/solvent in the active ingredient."

V. The Appellant submitted that the term "active ingredient" used in the claims, though not being defined in the description of the present application, was clear to the person skilled in the art which is in keeping with the requirements of Article 84 EPC. The aerosol composition claimed had a function and the "active ingredient" was there to satisfy that function. Thus, by way of example, a perfume addressed in the present description could count as an "active

ingredient" or not, depending on the function of the aerosol composition comprising that perfume.

Furthermore, he supported the statement in the decision under appeal that the term "active ingredient" referred in general to the pure ingredient. In case the "active ingredient" was a particular perfume, that term comprised nonetheless the perfume material *per se* and the solubilising material, and in case of a particular insecticide, the insecticide ingredient and a synergist.

The invention aimed at reducing the amount of volatile organic compounds in the aerosol compositions. While claim 1 according to the main request comprised all the features essential for achieving that aim, in particular requiring the "active ingredient" and the propellant to form a single phase homogenous mixture, claim 1 according to the auxiliary request specified additionally the minimum amount of propellant to be present and the maximum amount of solvent if present. Moreover, the latter claim 1 omitted the term "substantially" thereby overcoming the lack of disclosure of that term in the application as filed.

VI. The Appellant requested that the decision under appeal be set aside and the case be remitted to the Examining Division for further prosecution on the basis of claims 1 to 7 submitted on 14 April 1997 (main request) or of claims 1 to 5 submitted at the oral proceedings on 14 September 2000 (auxiliary request).

VII. At the end of the oral proceedings the decision of the Board was given orally.

Reasons for the Decision

1. The appeal is admissible.

Main Request

3. *Amendments (Article 123(2) EPC)*

In order to determine whether or not an amendment offends against Article 123(2) EPC it has to be examined whether technical information has been introduced which a skilled person would not have objectively and unambiguously derived from the application as filed (see decisions T 288/92, point 3.1 of the reasons; T 680/93, point 2 of the reasons; neither published in OJ EPO).

In the present case, the Appellant has introduced into claim 1 as amended the fresh feature that the aerosol composition is a "**substantially** single phase homogenous solution" (emphasis added). While the characterisation of the composition as being a single phase homogeneous solution is based on page 5, lines 25, 26 and 32 of the application as filed, the feature "substantially" imposing restrictions on that characterisation lacks any support in the original application. Therefore, the result of this amendment is that the skilled man is presented with information which is not directly and unambiguously derivable from the application as filed. The Appellant did not dispute that finding at the oral proceedings before the Board.

Hence, that amendment to claim 1 introduces subject-matter which extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC. In these circumstances, the Appellant's main request is not allowable and must be rejected.

Auxiliary Request

3. *Amendments (Article 123(2) EPC)*

The subject-matter of claim 1, which is directed to an aerosol composition for use in a space spray aerosol dispenser comprising an active ingredient and a propellant in the form of a single phase homogeneous solution, is based on page 5, lines 11 to 13, 25, 26 and 32 of the application as originally filed and with respect to the term "aerosol" on claim 7 as filed. The optional presence of up to 25 weight % solvent finds support in original claim 8. The minimum amount of a suitable propellant is backed up by page 7, lines 22 to 24 in combination with page 3, lines 27 and 28 of the application as filed. The feature "substantially" having been omitted, the above objection raised against the main request no longer applies.

For these reasons, the Board concludes that claim 1 meets the requirements of Article 123(2) EPC.

4. *Article 84 EPC*

4.1 Article 84 and Rule 29(1) EPC in combination require that the claims shall be clear and define the matter for which protection is sought in terms of the

technical features of the invention. This serves the purpose of ensuring that the public is not left in any doubt as to which subject-matter is covered by a particular claim and which is not. From this principle of legal certainty, in the Board's judgement, it follows that a claim is not clear in the sense of Article 84 EPC if it does not unambiguously allow this distinction to be made (see decisions G 2/88, OJ EPO 1990, 93, point 2.5 of the reasons; T 337/95, OJ EPO 1996, 628, points 2.2 to 2.5 of the reasons). A claim comprising an unclear technical feature entails doubts as to the subject-matter covered by that claim, all the more if this feature is essential with respect to the invention. Thus, for the reason of lack of legal certainty, that claim is not clear in the sense of Article 84 EPC.

4.1.1 In the present case, claim 1 according to the auxiliary request is directed to an aerosol composition comprising an ingredient which is specified as being "active". Therefore the principle of legal certainty requires identification of the meaning of the technical feature "active ingredient" in order to establish without any doubt the subject-matter covered by that claim all the more since this technical feature is essential with respect to the invention as it defines one of the essential components of the claimed aerosol composition. That feature, hence, needs closer examination.

4.1.2 In the context of Article 84 EPC, the meaning of a term or expression used in a feature of a claim depends in particular on the definition thereof generally accepted by those skilled in the relevant art, as established in Rule 35(12) EPC, last

sentence, requiring in general that use should be made of the technical terms generally accepted in the field in question.

4.1.2.1 The Appellant has neither alleged, let alone provided any evidence of, any generally applicable qualitative definition for the expression "active ingredient" as such nor is the Board aware of any. Thus, that feature cannot be accorded any qualitative definition having general validity.

4.1.2.2 However, the Appellant argued that the meaning of the term "active", in the present case, was clear to the person skilled in the art since the aerosol composition claimed had a function and the "active ingredient" was there to satisfy that function. For example, a perfume comprised in that composition counted as an "active ingredient" or not depending on whether or not the intended function of the aerosol composition claimed was to provide a pleasant smell.

Claim 1 is a product claim directed to an aerosol composition. The claim contains nothing concerning the intended function of that composition in the Appellant's sense, so that this function is not a technical feature within the meaning of Rule 29(1) EPC characterizing that composition or any ingredient thereof; there are the untraceable thoughts of the individual user determining that function which does not allow the skilled person on the objective basis of common general knowledge to establish unambiguously whether to qualify or to disqualify any ingredient as being "active". As a consequence of the lack of definition, an ingredient comprised in the aerosol composition is open to be labelled

arbitrarily "active ingredient" or not depending exclusively on the mental label the user wishes to apply, thereby rendering the meaning of that feature protean. The ingredient perfume exemplifies this ambiguity since the present application labels perfume as both, "active ingredient" (page 3, line 29 and 30) and "adjuvant" (page 4, line 18), though its function in the Appellant's sense remains the same, namely to provide a pleasant smell.

Since the technical feature "active ingredient" remains unclear for the reasons given above preventing the skilled person from identifying the exact meaning thereof, the public is left in doubts as to the distinction which aerosol compositions are covered by claim 1 and which are not, which is at variance with the principle of legal certainty. Thus, the Appellant's arguments cannot convince the Board.

4.1.3 The Appellant is unable to rely on the description of the present application to clarify the unclear term "active" defining an ingredient of the claimed aerosol compositions since the description is indeed silent about any qualitative definition of that feature, merely two individual examples having been listed (page 3, lines 29 and 30). Therefore the description does not provide any indication for identifying the meaning of that unclear term. For that reason there is no need for the Board to consider in the present case whether or not in the context of Article 84 EPC the person skilled in the art could overcome the lack of clarity of a claim by referring to the description.

4.1.4 To summarize, for the skilled person, there does not

exist any unequivocal definition generally accepted in the art for the feature "active ingredient", with the consequence that this feature leaves the actual subject-matter covered by the claim in doubt. On the ground of that lack of legal certainty, in the Board's judgement, claim 1 according to the auxiliary request fails to meet the requirement of clarity imposed by Article 84 EPC.

4.2 With respect to the further requirement of Article 84 EPC, namely that the claims must be supported by the description, it is the established jurisprudence of the Board of Appeals that a European patent may only be granted on the basis of a claim specifying all the essential features of the invention which are necessary to solve the problem underlying the application. This requirement reflects the general legal principle that the extent of the patent monopoly as defined in the claims should correspond to the technical contribution to the art made by the invention without monopolising a technical area beyond it. Thus, a claim is not "supported" within the meaning of Article 84 EPC if its extent exceeds the scope of the invention as disclosed in the description (see decisions T 409/91, OJ EPO 1994, 653, point 3.3 of the reasons; T 1055/92, OJ EPO 1995, 214, point 5 of the reasons; T 825/94, point 4.6 of the reasons, not published in OJ EPO).

In the present case, the invention aims at overcoming the deficiencies of conventional space spray aerosol compositions comprising 80 to 90% w/w of propellant which is a volatile organic compound (VOC) undesirably released to the atmosphere during use (page 3 lines 7 and 8 in combination with page 1,

lines 10 to 22). The problem to be solved as indicated in the application (page 3, lines 22 and 23), which the Appellant also emphasized in appeal proceedings, consists in looking for an improved space spray aerosol composition which releases less undesirable VOC's into the environment (page 3, lines 9 and 10). Therefore, the present invention aims at providing ultra high concentrated aerosol compositions wherein "the percentage of undesirable VOC's required as propellant and solvents is dramatically decreased, resulting in less VOC release to the atmosphere" (page 1, lines 2 and 3, and page 3, lines 16 to 18).

Thus, an essential feature of the invention which is necessary to solve the problem underlying the application of releasing less undesirable VOC's into the atmosphere consists in quantifying the percentage of VOC's present in the aerosol composition. While claim 1 specifies the minimum (!) amount of at least 15 weight% of propellant, which is a VOC, to be present in the aerosol composition, that claim is completely silent about any maximum amount thereof. Due to that absence of any upper limit, claim 1 covers aerosol compositions comprising any amount of propellant as long as it merely equals or exceeds 15 weight% thereby even including the deficient high percentage of propellant present in conventional aerosol compositions (see above paragraph). In that case, hence, the percentage of undesirable VOC's in the claimed aerosol compositions is not "dramatically decreased" which is at variance with the stated aim of the present invention. Thus, the problem underlying the application of releasing less VOC's into the environment is solved only, when the

propellant does not exceed a particular **maximum** amount in the aerosol composition, with the consequence that this feature is indeed essential in the performance of the invention.

However, it is precisely this feature that is missing from independent claim 1, which, therefore, does not meet the requirement of Article 84, second sentence, EPC, that the claims must be supported by the description, since claim 1 is so broad that it goes beyond the scope of the invention as set out in the description.

5. Since a decision can only be taken on a request as a whole, none of the further claims of that request need to be examined. In these circumstances the appeal relating to the Appellant's auxiliary request must be dismissed for lack of clarity and lack of support by the description which is not in keeping with the requirements of Article 84 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

N. Maslin

A. Nuss