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**Datasheet for the decision
of 16 July 2024**

Case Number: T 0957/22 - 3.3.06

Application Number: 15798402.2

Publication Number: 3224338

IPC: C11D7/32, C11D3/37, C11D7/26,
C11D3/33

Language of the proceedings: EN

Title of invention:
AQUEOUS SOLUTION CONTAINING COMBINATION OF COMPLEXING AGENTS

Patent Proprietor:
BASF SE

Opponent:
Nouryon Chemicals International B.V.

Headword:
Aqueous formulation/BASF

Relevant legal provisions:
EPC Art. 123(2), 84

Keyword:

Auxiliary request 1 - extension beyond the content of the application as filed (yes)

Auxiliary request 1 - clarity (no)

Auxiliary requests 2-13 - rejected - prohibition of reformatio in peius

Decisions cited:

G 0001/99, G 0002/10, G 0003/14, T 1063/07

Catchword:



Beschwerdekammern

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Case Number: T 0957/22 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 16 July 2024

Appellant: Nouryon Chemicals International B.V.
(Opponent) Velperweg 76
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Respondent: BASF SE
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
18 February 2022 to maintain European Patent
No. 3224338 in amended form.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: R. Elsässer
J. Hoppe

Summary of Facts and Submissions

- I. Appeals were initially filed by both the proprietor and the opponent against the decision of the opposition division to maintain European patent EP 3 224 338 in amended form on the basis of the first auxiliary request then on file.
- II. In the contested decision, the opposition division *inter alia* concluded that the subject-matter of claim 1 of the main request was not inventive over the closest prior art **D1** (US 2009/0298738); furthermore proprietor's experimental report **ER** was not admitted into the proceedings.
- III. With its grounds of appeal, the proprietor contested this decision and requested to reject the opposition, or as an auxiliary measure, to maintain the patent in amended form based on the claims of auxiliary request 1 filed during the oral proceedings before the opposition division, or of one of auxiliary requests 2-13 filed in the first instance as auxiliary requests 1-12 and renumbered at the oral proceedings.
- IV. With its grounds of appeal, the opponent filed new experimental data (**D11**) and argued *inter alia* that the claims as upheld by the opposition division did not meet the requirements of Article 123(2) EPC.
- V. With their respective reply to the grounds of appeal, the proprietor rebutted the objection under Article 123(2) EPC and the opponent argued that claim 1 as upheld by the opposition division also lacked clarity.

- VI. In its preliminary opinion, the Board held *inter alia* that the subject-matter of claim 1 as granted was not inventive over **D1** and that the subject-matter of claim 1 of the first auxiliary request was unclear and contained added subject-matter.
- VII. In its reply dated 29 April 2024 to the preliminary opinion, the proprietor withdrew its appeal.
- VIII. With letter dated 22 May 2024, the opponent - then sole appellant - argued that the main and 2nd to 13th auxiliary requests should not be admitted as they were broader in scope than the claims of auxiliary request 1, thereby not being in conformity with the prohibition of *reformatio in peius*.
- IX. In a communication dated 7 June 2024, the board informed the parties that it understood the proprietor's withdrawal of the appeal to entail the withdrawal of the main request. Furthermore, auxiliary requests 2-13 appeared not to be admissible due to the prohibition of *reformatio in peius*. No response thereto was received in particular by the proprietor.
- X. At the oral proceedings, which were held on 16 July 2024 in the absence of the proprietor, the parties' final requests were established as follows:

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested to dismiss the opponent's appeal or, as an auxiliary measure, to maintain the patent in amended form, based on one of auxiliary requests 2-13, filed as auxiliary requests 1-12 with letter of 25 November 2021.

Reasons for the Decision

1. Interpretation of the respondent's requests

As set out in the board's preliminary opinion, the board understands the withdrawal of the proprietor's appeal to implicitly entail the withdrawal of the main request (maintenance of the patent as granted). As this finding was not contested by the respondent, the board concludes that the main request has been withdrawn.

2. First auxiliary request

2.1 Claim 1 of this request, with the highlighted amendment (by the board) compared to granted claim 1, reads as follows:

"1. Aqueous formulation with a content of the sum of the contents of complexing agent (A) and complexing agent (B) in the range of 40% to 60%, containing consisting of

(A) a complexing agent selected from methylglycine diacetic acid (MGDA) that is at least partially neutralized with alkali metal, and at least one complexing agent other than MGDA selected from (B) glutamic acid diacetic acid (GLDA) that is at least partially neutralized with alkali metal, and, optionally,

(C) a polymer being selected from polyamines, the N atoms being partially or fully substituted with CH₂COOH groups, partially or fully neutralized with alkali metal cations, and, optionally,

(D) at least one alkali metal salt of an organic acid, said acid being selected from mono- and dicarboxylic acids,

wherein the weight ratio of complexing agent (A) to complexing agent (B) is in the range of from 10:1 to 1:10."

2.2 As set out in the board's preliminary opinion, the subject-matter of this claim is not clear and contains added subject-matter. As this finding was not contested by the respondent, there is no reason to deviate from it, so that the reasoning set out in the communication under Article 15(1) RPBA which in essence is reproduced below is maintained.

2.3 Article 84 EPC

Claim 1 is unclear because it contains an internal contradiction, namely that on the one hand, the formulation defined therein can consist only of the components A and B because components C and D are optional, but on the other hand, the sum of the content of A and B is limited to 60% at most.

Since this contradiction results from the amendment, namely the substitution of the expression "containing" with "consisting of", the clarity of the claim can be examined in these opposition-appeal proceedings (see G 03/04).

The board notes furthermore that the formulation of claim 1 is defined as being "aqueous", so that one way of resolving the contradiction would be to assume that the balance in the above mentioned case is water.

However, that a contradiction can be resolved does not detract from the fact that it is present. Moreover, one has to take into account that the term "aqueous" does not necessarily render the claim clear, since a

formulation based on a solvent system of water and a minor amount of alcohol and containing in addition components A and B and nothing else, would be based on water and thereby be "aqueous" in the sense of claim 1 at issue, but it is unclear whether such a formulation would be encompassed by the claim or not. Furthermore, there are other possible ways of resolving the contradiction, such as e.g. ignoring the expression "optional" in connection to components C and/or B.

It follows that the subject-matter of claim 1 is not clear and so infringes Article 84 EPC.

2.4 Article 123(2) EPC

The Board has come to the conclusion that there is no direct and unambiguous disclosure in the application as filed of a formulation consisting only of components A and B and optional components C and D.

2.4.1 For an amendment to be allowable under Article 123(2) EPC, it needs to comply with the "gold standard" according to which an amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (G 2/10).

2.4.2 With regard to the substitution of the term "comprising" with "consisting of", the case law based on the relevant gold standard has consistently held that such an amendment adds subject matter (see e.g. T 1063/07, reasons 2.2 and 2.3 and T 759/10, reasons 3.4, 5.2 to 5.4). As the meaning of the term "containing" used in granted claim 1 is identical to

that of the term "comprising", this also applies to the case at hand, where it is undisputed that there is no disclosure of formulations "consisting of" the components recited in the claim. Rather, throughout the application as filed, formulations "containing" the compulsory components A and B and the optional components C and D are disclosed and discussed. It is not discernible that the skilled person would have derived from the content of the description a different technical information.

- 2.4.3 The proprietor argued that the amendment to "consisting of" led to formulations that "contained less" than before, which meant that there could be no extension beyond the content of the application as filed. This is however not convincing because what matters is whether an amendment is directly and unambiguously disclosed in the application as filed or not. It is however not relevant under Article 123(2) EPC whether the amendment is a restriction or an extension (Case Law of the Boards of Appeal, 10th edition, II.E.1.3.6 c).
- 2.4.4 The proprietor also pointed to par. 0008 of the patent, which corresponds to the second paragraph on page 2 of the application as filed. However, this passage only teaches that specific components should be absent, namely additives that negatively affect the properties of the complexing agents. The complete absence of compounds other than A-D is neither disclosed in this passage nor elsewhere in the application as filed.
- 2.4.5 Finally the proprietor referred to the example which contained only components A-D and water. However, this example is more restrictive than claim 1 in that specific compounds, namely the trisodium salt of MGDA and tetrasodium salt of L-GLDA, are used therein in

combination with specific compounds of the types C and D. Said example also has specific amounts of the four components A, B, C and D and of water. In contrast, claim 1 is much broader in this respect so that the example does not support the amendment either.

2.4.6 The board notes that there is no need to decide upon proprietor's request to admit experimental report **ER** because it has no bearing on the objections under Article 84 and 123(2) EPC. Likewise, there is no need to discuss proprietor's request not to admit experimental data **D11**, because they are not part of the objections against auxiliary request 1.

2.5 It follows from the above considerations that claim 1 of the first auxiliary request is not allowable under Article 123(2) and 84 EPC.

3. Auxiliary requests 2-13

3.1 As set out in the board's communication of 7 June 2024, these requests are not admissible for procedural reasons. As this finding was not contested by the respondent, there is no reason to deviate therefrom, so that the reasoning set out in the preliminary opinion, which in substance is reproduced below, is still valid.

3.2 According to the principle of the *reformatio in peius*, an amended claim request which would put the opponent and sole appellant in a worse situation than if it had not appealed must be rejected (G 1/99, OJ 2001, 382, headnote).

3.3 In the present case, after having withdrawn its own appeal, the proprietor in its respondent's role is therefore limited to defend the patent in the form held

allowable by the opposition division, or in a more restricted form.

3.4 However, while the numbering of auxiliary requests 2-13 (lower ranking compared to the request to dismiss the opponent's appeal, i.e. to maintain the patent based on auxiliary request 1) suggests that they are part of the proprietor's defence against the opponent's appeal, claim 1 of each of these requests is not based on the restricted wording of auxiliary request 1 (which includes "consisting of") held allowable by the opposition division, but on a broader wording of the main request (with "containing"), that the division had rejected.

3.5 While the formulation "consists of" is not clear in the context of claim 1 of auxiliary request 1, see above, the Board notes that substituting this term with "containing" nevertheless broadens the claimed subject-matter, compared to the first auxiliary request found allowable by the opposition division. While the term "consists of" limited the subject-matter of claim 1 of auxiliary request 1 to the components defined in the claim by excluding the presence of any further components, the substitution of this term with "containing" factually deleted this limiting feature, so that granting any one of these requests would put the opponent/appellant in a worse situation than if it had not appealed. This would not be in conformity with the prohibition of *reformatio in peius*.

3.6 In decision G 1/99 (OJ 2001, 382, headnote), the Enlarged Board of Appeal formulated an exception to the prohibition of *reformatio in peius*, namely *"in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in*

circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the opposition division in its interlocutory decision".

- 3.7 The board however agrees with the opponent that this exception does not apply in the case at hand, because the proprietor deliberately withdrew its appeal, and thus waived the possibility of defending its patent in a broader version than that upheld by the opposition division, although it was aware that the board had endorsed in its preliminary opinion the objection under Article 123(2) EPC against the first auxiliary request.

In this situation, there is no justification to grant the proprietor back this possibility for reasons of equity, i.e. to establish an exception from the prohibition of reformatio in peius. A party who waives an existing right in full knowledge of the legal situation cannot expect to be granted back this right for reasons of equity.

- 3.8 Moreover, even if the principles as set out in decision G 1/99 were to be applied to the case at hand, i.e. if the proprietor could benefit from an exception to the principle of reformatio in peius, the decision of the Enlarged Board stipulates that such an exception can only be made if the objection cannot be overcome by two other forms of amendments set out in the headnote of decision G 1/99. However, the proprietor has not argued, nor is it discernible for the board, that claim amendments of these types were not possible.

3.9 From the foregoing, the board has thus decided that auxiliary requests 2-13 are not admissible.

4. As the main request has been withdrawn, the first auxiliary request is not allowable, and auxiliary requests 2-13 are to be rejected for procedural reasons, there is no basis for maintaining the patent, so that the appeal of the opponent succeeds.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated