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A HIDDEN DANGER UNDER THE EPC – THE "EXTENSION TRAP"

In its recent decision T9/10 (handed down on November 16, 2011), EPO Technical Board of Appeal 3.3.06 provided intriguing insights in the risks associated when amending generic composition claims being drafted in an open language ("comprising"). The Board found that what may appear, at first glance, to be a limitation of the subject matter under consideration in fact results in an extension of the scope of protection conferred by the claim.

In essence, the case relates to an interpretation of the requirements of "famous" Article 123 EPC ("Amendments") which *inter alia* stipulates:

(2) The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

(3) The European patent may not be amended in such a way as to extend the protection it confers.

The claimed subject matter of the disputed patent EP 1 433 476 B1 is directed to a skin cleansing composition comprising inter alia a hydrophilic nonionic surfactant. The patent was maintained in amended form during opposition proceedings. The opponents lodged an appeal against this decision.

Independent claim 1 as granted reads:

A skin cleansing composition comprising: (A) 3 to 80 wt.% of an oil component, (B) 1 to 45 wt.% of a hydrophilic nonionic surfactant, (C)



1 to 45 wt.% of a lipophilic amphiphile, (D) 3 to 80 wt.% of a water-soluble solvent, and (E) 3 to 80 wt.% of water; and having an isotropic liquid phase exhibiting a bicontinuous structure.

The patent was maintained on the basis of amended claim 1 ("main request") which reads:

*A skin cleansing composition comprising (A) 3 to 80 wt.% of an oil component, (B) 1 to 45 wt.% of a hydrophilic nonionic surfactant, **having an HLB value of more than 8 and having a hydrophobic group with 8 or more carbon atoms**, (C) 1 to 45 wt.% of a lipophilic amphiphile, **selected from nonionic surfactants having an HLB value of 8 or less, fatty alcohols having 8 to 25 carbon atoms, fatty acids having 8 to 25 carbon atoms and monoalkylphosphoric acids having 8 to 25 carbon atoms**, (D) 3 to 80 wt.% of a water soluble solvent and (E) 3 to 80 wt.% of water, and having an isotropic liquid phase exhibiting a bicontinuous structure. (emphasis added)*

In preparation for the appeal proceedings, the patent proprietor additionally filed an "auxiliary request" on the basis of amended claim 1 which reads:

*A skin cleansing composition comprising (A) 3 to 80 wt.% of an oil component, (B) 1 to 45 wt.% of a hydrophilic nonionic surfactant, (C) 1 to 45 wt.% of a lipophilic amphiphile, (D) 3 to 80 wt.% of a water soluble solvent, and (E) 3 to 80 wt.% of water, and having an isotropic liquid phase exhibiting a bicontinuous structure, **wherein the hydrophilic nonionic surfactant (B) has an HLB value of more than 8 and has a hydrophobic group with 8 or more carbon atoms, and wherein the lipophilic amphiphile (C) is selected from nonionic surfactants having an HLB value of 8 or less, fatty alcohols having 8 to 25 carbon atoms, fatty acids having 8 to 25 carbon atoms and monoalkylphosphoric acids having 8 to 25 carbon atoms.** (emphasis added)*



Initially, the TBA held that claim 1 as granted relates to a skin cleansing composition comprising, amongst other components, "1 to 45 wt.% of a hydrophilic nonionic surfactant", referred to as component (B). The use of the term "comprising" in connection with a numerical range defining the amount of a component implicitly means that the protection conferred by the claim does not extend to compositions containing that component in amounts outside the defined range.¹

In other words, the protection conferred by claim 1 as granted, as far as component (B) is concerned, is restricted to compositions containing not less than 1 wt.% and not more than 45 wt.% of any kind of hydrophilic nonionic surfactant. The same considerations also apply *mutatis mutandis* to components (A) and (C) to (E) in claim 1 as granted.

In Claim 1 of the main request, component (B) is specified as "1 to 45 wt.% of a hydrophilic nonionic surfactant, having an HLB value of more than 8 and having a hydrophobic group with 8 or more carbon atoms". This amendment is to be regarded as restricting component (B) to the specific group of hydrophilic nonionic surfactants with the defined HLB value and number of carbon atoms in the hydrophobic group.

However, the Board pointed out that due to the use of the non-exclusive term "comprising" the subject matter of claim 1 according to the main request was also directed, beyond the specifically defined component (B), to any other hydrophilic nonionic surfactant with HLB values and/or a number of carbon atoms in the hydrophobic group not covered by the specific definition given may be present in the skin cleansing composition.

Consequently, the Board continued, since claim 1 as granted excluded any hydrophilic nonionic surfactant in an amount less than 1 wt.% and more than 45 wt. %, whereas claim 1 according to the main request allowed the presence in undefined amounts of any hydrophilic nonionic surfactants not having the specific HLB values and/or the number of carbon atoms in the hydrophobic group, the

¹ Cf. T9/10, point 1.1.2 of the reasoning, referring to decision T2017/07 (handed down by a different Board, TBA 3.3.10) that concerns a similar scenario.



protection conferred by claim 1 according to the main request extended beyond the protection conferred by claim 1 as granted, thus contravening the requirement of Article 123(3) EPC.²

The wording of claim 1 according to the auxiliary request differs from that according to the main request in that the characterizing technical features with respect to the hydrophilic nonionic surfactant and the lipophilic amphiphile are now given by making direct and explicit reference to components (B) and (C) of the composition, respectively.

The TBA thus had to analyze whether the new claim wording now excludes the presence of any hydrophilic nonionic surfactants other than those having the defined HLB value and number of carbon atoms in the hydrophobic group.

Based on the claim wording as such the Board did not come to an unambiguous interpretation of its factual meaning. However, when taking into account the teachings given in the description that the subject matter relates to a composition "having [...] (B) a hydrophilic nonionic surfactant" (cf. paragraph [0010]), wherein component (B) is present "in an amount of from 1 to 45 wt.%" (cf. paragraph [0021]) the Board came to the conclusion that in the specific case it was now made clear that no hydrophilic nonionic surfactant as the one specified as component (B) is present in the composition claimed.³

Accordingly, the protection conferred by claim 1 according to the auxiliary request is identical with that of claim 1 as granted. The requirement of Article 123(3) EPC is met.

The present decision is fully in line with two previous rulings in similar cases: T2017/07 of November 26, 2009 relating to a hair dry composition (handed down by

² Cf. T9/10, point 1.1.8 of the reasoning. The Board also noted that similar considerations applied to component (C) of the composition.

³ Cf. T9/10, point 2.1.2 of the reasoning. Again, similar considerations applied to component (C) of the composition



TBA 3.3.10) and T1312/08 of April 30, 2010 relating to a proteases-containing detergent composition (also handed down by TBA 3.3.06).

It is notable that in none of the three above-referenced cases the application documents as originally filed provide any explicit basis for the term "consisting of" and/or define "consisting of" as a specific embodiment covered by the definition of the term "comprising". Hence, a possible claim amendment reciting a "composition consisting of" any one or more components (i.e. only said components but nothing else) might be open to an objection under Article 123(2) EPC.

However, with respect to the question whether a replacement of "comprising" by "consisting of" is admissible under Article 123(2) EPC in the absence of explicit support no uniform EPO case law is available (cf., for example, T2017/07 and T1063/07 *versus* T997/06 and T457/08). It is thus tempting to speculate that a corresponding referral to the Enlarged Board of Appeal (EBA) will be made in near future.

In the absence of any guidance by the EBA it is strongly recommended that applicants include in the description at least a general statement that the term "consisting of" is considered to be a preferred embodiment of the term "comprising".

Furthermore, applicants should be aware of the following conclusion derivable from the present TBA ruling:

(i) A composition which is specified in a claim to "comprise" a component in an amount being defined by a numerical range of values is subject to an implicit proviso excluding the presence of that component in an amount outside of that range.

(ii) An amendment restricting the breadth of that component, for instance by narrowing down a generic class or a list of chemical compounds defining that component, has the consequence of limiting the scope of this implicit proviso.



(iii) A composition which is defined as "comprising" the components indicated in the claim is open to the presence of any further components, unless otherwise specified. Again, the importance of a thoroughly drafted detailed specification including multiple fallback positions is to be emphasized.

(iv) In a claim directed to such a generically defined composition, the restriction of the breadth of a component present therein may have the effect of broadening the scope of protection of that claim, with the consequence that in opposition/appeal proceedings such amended claim may extend the protection conferred by the granted patent, thus contravening Article 123(3) EPC.