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D E C I S I O N
of 11 January 2005

Case Number: T 1008/02 - 3.2.6

Application Number: 89107034.4

Publication Number: 0339461

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Absorbent products containing hydrogels with ability to swell against pressure

Patentee:

KIMBERLY-CLARK CORPORATION

Opponent:

Stockhausen GmbH & Co. KG
SCA Hygiene Products Aktiebolag

Headword:

-

Relevant legal provisions:

EPC Art. 83

Keyword:

"Main request (late filed - abuse of procedure - yes - not admitted"

"Auxiliary request - sufficiency of disclosure - no"

Decisions cited:

T 0796/02, T 0363/96, T 0409/91

Catchword:

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Case Number: T 1008/02 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 11 January 2005

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 23 July 2002
revoking European patent No. 0339461 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: P. Alting van Geusau
Members: H. Meinders
M. J. Vogel

Summary of Facts and Submissions

I. The appeal lies from the decision of the Opposition Division of 27 June 2002, posted to the parties on 23 July 2002, to revoke European patent 0 339 461. This patent had been revoked in earlier opposition proceedings with decision posted 15 March 1996 for lack of novelty, which led to the first appeal proceedings (T 363/96) decided by the present Board on 24 May 2000.

In its earlier decision the Board considered that novelty was established for claim 1 of the second auxiliary request as amended in these appeal proceedings and remitted the case to the first instance for further prosecution. According to the Board, inventive step of claim 1 and the patentability of the independent claims 2 and 3 of this request had not yet been examined by the Opposition Division, nor had the objections relating to sufficiency of disclosure, raised in the oppositions, been considered. For the examination of novelty of the subject-matter of claim 1 of the second auxiliary request the Board considered the evidence relating to the prior public use of the absorbent composite named the "Merries diaper" to come closest to the subject-matter claimed.

II. Claim 1 of this request read as follows (emphasis added by the Board):

"An absorbent composite (16) comprising a porous fiber matrix (18) and an amount of superabsorbent material (20) present in said porous fiber matrix in the form of discrete particles dispersed among the interfiber pores (22) characterised in that said superabsorbent material

(20) can absorb **at least 27 milliliters** of an aqueous solution of sodium chloride containing 0.9 weight percent sodium chloride **per gram** of superabsorbent material while under a restraining pressure of 21,000 dynes per square centimetre when determined by the Absorbency Under Load (AUL) test method as described in the description, and that at least about 80% by weight of said dispersed discrete particles of superabsorbent material has a size in the unswollen condition which is greater than the median pore size of said porous fiber matrix (18) when wet and is greater than about 200 microns."

III. In the opposition proceedings upon remittal the patentee withdrew the independent claims 2 and 3 from its request, maintaining above mentioned claim 1, with further dependent claims.

In its decision the Opposition Division considered that the patent, with this claim 1, did not fulfil the requirements of Article 83 EPC as the specification did not provide any indication how the claimed discrete particle superabsorbent material having an AUL of at least 27 ml/g of which about 80% of the particles had a size greater than 200 microns could be obtained. None of the examples of the patent presented a superabsorbent with an AUL value as well as a particle size distribution within the ranges of claim 1. The opponents had provided a lot of evidence proving that either no such superabsorbents fulfilling the claimed requirements existed, nor that such superabsorbents were readily available. The patentee had not provided any proof to the contrary.

IV. On 2 October 2002 the Appellant (patentee) filed an appeal and paid the required fee that same date. The statement of grounds of appeal was filed on 29 November 2002.

With its grounds of appeal the Appellant requested that the decision be set aside and that the case be remitted to the Opposition Division for further examination on the basis of an amended claim 1, with the following wording:

"An absorbent composite (16) comprising a porous fiber matrix (18) and an amount of superabsorbent material (20) present in said porous fiber matrix in the form of discrete particles dispersed among the interfiber pores (22) characterised in that said superabsorbent material (20) can absorb **at least 24 milliliters** of an aqueous solution of sodium chloride containing 0.9 weight percent sodium chloride **per gram** of superabsorbent material while under a restraining pressure of 21,000 dynes per square centimetre when determined by the Absorbency Under Load (AUL) test method as described in the description, and that at least about 80% by weight of said dispersed discrete particles of superabsorbent material has a size in the unswollen condition which is greater than the median pore size of said porous fiber matrix (18) when wet and is greater than about 200 microns."

It indicated that it was, if necessary, prepared to proceed on the basis of claim 1 as rejected by the Opposition Division (see point II above).

Respondents 01 and 02 (Opponents 02 and 04) replied to the appeal with letters of 11 July and 23 June 2003, respectively.

V. In the annex to the summons to oral proceedings the Board gave its preliminary opinion on the admissibility of the appeal, the admissibility of claim 1 in respect of its filing at this stage of the proceedings and the question of sufficiency of disclosure of the patent with that claim as well as with claim 1 as decided upon by the Opposition Division, in case the Appellant intended to file an auxiliary request to that effect. The Board referred in that respect to T 409/91 (OJ EPO 1994, 653), also cited by Respondent 01 in its reply to the appeal, for the question whether the patent disclosed the invention over the entire range claimed in claim 1.

VI. Oral proceedings were held on 11 January 2005, which the Appellant did not attend, having announced this in its letter of 10 December 2004, in which it also withdrew its request for oral proceedings.

The Appellant requested to set aside the decision under appeal and, as a main request, to maintain the patent with claim 1 with the wording as mentioned above, see point IV.

As an auxiliary request the Appellant requested to set aside the decision under appeal and to remit the case to the first instance for further examination on the basis of the claims of the request as rejected by the Opposition Division (see above, point II).

The Respondents 01 and 02 requested dismissal of the appeal, revocation of the patent and rejection of the main request as its late filing constituted an abuse of proceedings.

VII. The arguments of the Appellant can be summarised as follows:

Main request:

Claim 1 according to this request was amended to take account of the statement of the Opposition Division in the decision under appeal that example I of the patent specification provided the skilled person with the information on how to obtain the claimed absorbent composite with a superabsorbent having an AUL of at least 24 ml/g and at least 50% by weight of the particles having a certain size. Also example III gave the necessary information.

It could only file this request with its appeal, as the arguments of the Respondents relating to the AUL value of 27 ml/g not being supported by Example I of the patent had only been raised in the oral proceedings before the Opposition Division upon remittal. Thus the request was neither belated, nor could it be seen to amount to an abuse of proceedings. In any case, the novelty discussion was not reopened, as the subject-matter of claim 1 remained novel over the prior use absorbent composite (the "Merries" diaper), because the latter did not disclose the claimed particle size distribution of over 80% by weight of the particles presenting a particle size greater than 200 microns.

Auxiliary request:

The test procedure as described in the patent provided the skilled person with sufficient information on how to sieve a given superabsorbent particulate material to arrive at the claimed particle size distribution in combination with the claimed AUL value of 27 ml/g.

VIII. The Respondents argued essentially as follows:

Main request:

Claim 1 of this request should not be admitted as it was late filed and its late filing constituted an abuse of proceedings. The Board had remitted the case back to the Opposition Division with the conclusion that the subject-matter of this claim 1 was novel in respect of the prior use absorbent composite (the "Merries diaper"). The presently claimed 24 ml/g for the AUL value, however, constituted a broadening of this feature, thus reopening the discussion on novelty, a matter which had been decided upon by the Board in T 363/96, of which the *ratio decidendi* applied in the present case. It might even be argued that an appeal with such a claim was not admissible.

The arguments relating to sufficiency of disclosure had been raised prior to the oral proceedings before the Opposition Division, by the Opponents as well as the Opposition Division, thus the Appellant had had sufficient opportunity to timely file such requests in the opposition proceedings upon remittal.

The patent remained deficient in its disclosure of the invention, also in respect of this claim, as the examples I, III and V referred to by the Appellant only provided sufficient basis for an AUL value of exactly 27 ml/g, 26 ml/g and 26 ml/g **as such**, respectively. They, however, did not disclose superabsorbents with AUL values substantially greater than 24 ml/g, as presently covered by: "**at least** 24 ml/g", and which at the same time fulfilled the requirements as to particle size ("at least 200 microns") and to the amount of such particles ("at least 80% by weight") in the superabsorbent. Thus the patent did not contain sufficient information on how to carry out the invention as regards the whole range claimed for the AUL value (T 409/91, *supra*).

Auxiliary request:

Example I, though providing an AUL of 27 ml/g, did not fulfil the requirement of at least about 80% by weight of the discrete particles having a particle size greater than 200 microns; it only achieved about 75%. Further, the same objection as raised against the AUL value of "at least 24 ml/g" of claim 1 of the main request applied here; no superabsorbents were mentioned in the patent specification which showed an AUL value considerably higher than 27 ml/g, necessary to provide support for the claimed range of "at least 27 ml/g", i.e. a range without any upper limit.

Reasons for the Decision

1. *Admissibility of the appeal*

The Appellant has filed a notice of appeal indicating the impugned decision and the extent to which amendment or cancellation is requested (cancellation in its entirety). The appeal fee has been paid within the applicable time limit, thus the appeal is deemed filed (Article 108 EPC).

In its statement of grounds of appeal the Appellant has presented facts (an amended claim) and arguments (why this claim overcomes the objection raised in the decision under appeal) and has requested to set aside the impugned decision and to remit the case to the first instance for further examination.

The appeal thus fulfils the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible. Whether this appeal succeeds in substance is not a matter for the admissibility of the appeal.

2. *Admissibility of the claims of the main request*

- 2.1 The Respondents objected to the introduction into these second appeal proceedings of a claim 1 referring to an AUL value of "at least 24 ml/g" as opposed to claim 1 of the second auxiliary request as remitted to the Opposition Division in T 363/96, which mentioned "at least 27 ml/g", and which had been defended in the opposition proceedings upon remittal. The subject-matter of claim 1 was thus broadened, reopening the discussion on novelty, which, however, had already been

decided upon by the Board in T 363/96. It was an abuse of proceedings to file such a broader claim as late as the second appeal proceedings.

2.1.1 The Board agrees with the Respondents.

It is the established case law of the Boards of Appeal that the patentee's right to file amendments in the course of proceedings is not unlimited in time. It is in particular within the discretion of the board of appeal to refuse such amendments if they are submitted late in the proceedings, e.g. when the examination of the appeal is already substantially complete and the patentee fails to provide good reasons for such late filing (see e.g. T 796/02 and the case law cited therein, as well as Case Law of the Boards of Appeal, 4th edition 2001, Chapter VII.C.10.1.3, pages 485 and 486).

The first appeal proceedings were concerned with the revocation of the patent in suit for lack of novelty of the absorbent composite of (then) claim 1 over the disclosure by public prior use of an absorbent composite (the "Merries diaper"). In these first appeal proceedings novelty was finally established in respect of this prior use absorbent composite, by claim 1 according to the second auxiliary request.

The subject-matter of claim 1 was novel over that prior use absorbent composite by the fact that, even though the latter presented a superabsorbent with an AUL value of "at least 27 ml/g", its particle size distribution did not fulfil the requirement of about 80% by weight of its particles having a particle size of at least

200 micron. It presented only about 64-65% by weight with that particle size.

- 2.1.2 Now, upon appeal, this AUL value is lowered to "at least 24 ml/g", the rest of the claim's wording remaining the same.

The Board readily accepts that this amendment does not affect the presence of novelty over the prior use absorbent composite (the "Merries diaper"), the required particle size still not being achieved by about 80% by weight of the particles.

However, this prior use absorbent composite (the "Merries diaper") was considered the most relevant for the discussion of novelty in the first decision of the Opposition Division (which conclusion was taken over by the Board in T 363/96) as, apart from the other features of claim 1 it disclosed an AUL value of "at least 27 ml/g" in combination with information regarding the particle size distribution of the particulate superabsorbent.

- 2.1.3 Now that the AUL value as claimed has decreased from at least 27 to at least 24 ml/g, the debate on novelty would be reopened again, as it would have to be re-examined whether the other prior art available in the file - in the form of patent documents and documents relating to a number of alleged public prior uses - disclosed superabsorbents with this lower AUL value, in combination with the other parameters claimed.

This is not conducive to a convergency of the debate, a requirement becoming all the more important in second appeal proceedings.

In fact, the present file involves well over 100 documents and reports. It cannot be expected of the parties nor of the Board, at this stage of the proceedings, to re-examine all this material for a disclosure which could be possibly novelty-destroying for the subject-matter of this amended claim.

2.2 In its decision T 363/96 the Board indicated that the patentability of the subject-matter of independent claims 2 and 3 of the second auxiliary request as remitted to the first instance had not been examined yet by the Opposition Division, which was one of the reasons for remitting the case back to the first instance for continuation of the opposition proceedings.

2.2.1 Claim 2 of this request read as follows (emphasis added by the Board):

"An absorbent composite (16) comprising a porous fiber matrix (18) and an amount of superabsorbent material (20) present in said porous fiber matrix in the form of discrete particles dispersed among the interfiber pores (22), characterised in that said superabsorbent material (20) can absorb **at least 24 milliliters** of an aqueous solution of sodium chloride containing 0.9 weight percent sodium chloride **per gram** of superabsorbent material while under a restraining pressure of 21,000 dynes per square centimeter when determined by the Absorbency Under Load (AUL) test method as described in the description, that said

porous fiber matrix (18) comprises at least about 3% by weight based on total fiber matrix weight of a synthetic polymer fiber, and that at least about 50% by weight of said superabsorbent material has a size in the unswollen condition which is greater than the median pore size of said porous fiber matrix (18) when wet".

- 2.2.2 Such a claim could have provided a basis for the present request, were it not that in the written part of the opposition proceedings upon remittal the Appellant withdrew both independent claims, with letter dated 17 July 2001, "in the interest of procedural efficiency".

Thus the Appellant itself chose to withhold a claim for an absorbent article involving a superabsorbent with an AUL value of at least 24 ml/g" from examination as to novelty by the first instance.

Reintroducing such a claim previously withdrawn, in a the second appeal proceedings, cannot be accepted by the Board.

- 2.3 Also the argument of the Appellant, that it was only in the second opposition oral proceedings that the specific argument relating to Example I not providing support for the AUL value of at least 27 ml/g was raised, cannot hold.

- 2.3.1 The opposition as filed on 19 October 1993 by Respondent 01 was based on the opposition grounds of Articles 100(a) (Novelty and inventive step) and 100(b) EPC (lack of sufficiency of disclosure). For the latter

ground, Respondent 01 argued (points 3 and 4) that only one example in the patent in suit related to an AUL value of 27 ml/g, but that no examples were presented relating to higher AUL values, as claimed in the patent in suit. The skilled person thus had no information how to achieve such superabsorbents, as at that time such superabsorbents were not available on the market. This objection was maintained in its letter of 4 October 1995.

The opposition as filed on 20 October 1993 by Respondent 02 also was based, among other grounds, on insufficiency of disclosure.

- 2.3.2 According to the minutes of the first oral proceedings before the Opposition Division of 30 November and 1 December 1995 this issue was not discussed, the discussion concentrating on the issue of novelty, leading to the first decision of the Opposition Division, set aside by the present Board in case T 363/96, remitting the case to the first instance for continuation of the proceedings on the basis of claim 1 of the second auxiliary request, indicating that sufficiency of disclosure still had to be examined (see point I above).
- 2.3.3 In the opposition proceedings upon remittal, Respondent 01 repeated in its letter of 16 November 2001 its objections pursuant to Article 83 EPC. This time it explicitly mentioned that the claimed AUL value of 27 ml/g for about 80% by weight of the particles having a particle size greater than 200 microns was not supported by Example I, which related to a superabsorbent with an AUL of 27 ml/g, of which only

74,8% by weight fulfilled this particle size requirement.

In its annex to the summons to oral proceedings dated 11 February 2002 the Opposition Division repeated this objection in the same terms.

Thus the argument to which the Appellant refers was not raised for the first time in the oral proceedings of 27 June 2002, but at a much earlier stage of the proceedings. The Appellant therefore had ample time to react to this objection by filing an appropriately amended claim 1.

2.4 For the above reasons the Board considers the filing of the main request at this stage of the proceedings to be an abuse of proceedings. The request is therefore not admitted.

3. *Sufficiency of disclosure (Article 83 EPC)*

Auxiliary request:

3.1 The Respondents argued that for an AUL value of at least 27 ml/g the patent did not disclose superabsorbent materials which, in connection with that AUL value, provided a particle distribution such that at least about 80% by weight of the particles had a particle size greater than 200 microns.

Irrespective of the question whether the AUL value was disclosed for the superabsorbent material in connection with other parameter values, the claimed AUL value of "at least" 27 ml/g was the lower limit of a range, the

upper limit of which was not defined in claim 1. The examples in the patent only relating to AUL values of at most 27 ml/g (Example I), 26 ml/g (Example III), 26 ml/g (Example V) and 22 ml/g (Example VII), the patent did not provide the skilled person with sufficient information to carry out the invention over the whole range of 27 ml/g up to an indefinite amount for the AUL value.

- 3.2 The Board agrees with the Respondents for the following reasons.

The only example in table C of the patent in suit relating to a superabsorbent having an AUL of at least 27 ml/g is Example I, with non-agglomerated IM 5000, however with a particle size distribution not fulfilling the requirement of at least about 80% of the particles by weight having a particle size greater than 200 microns. In fact, this superabsorbent material involves only 74,8% by weight of such particles (calculated by linear extrapolation on the basis of the 29% of the particles by weight having a particle size between 90 and 300 microns).

The only example in table C of the patent in suit using a superabsorbent having the claimed particle size distribution of at least "about" 80% of the particles being greater than 200 microns is Example III, using IM 1500P as superabsorbent, involving 82,8% of such particles. However, the corresponding AUL value is 26 ml/g, thus below the claimed value of at least 27 ml/g.

3.3 In the examples, only two types of superabsorbents have been used, IM 1500P and IM 5000. None of the examples show any AUL values above 27 ml/g, nor of the claimed particle size for at least about 80% by weight of the particles.

3.4 Thus the superabsorbents used in the examples of the patent do not provide a basis for the assumption that an AUL value of considerably more than 27 ml/g can be achieved with them.

However, claim 1 of this request refers to "at least 27 ml/g", i.e. in principle the claimed range for the AUL value has no upper limit.

No evidence has been produced by the Appellant that at the priority date of the patent in suit other superabsorbents were directly available to the skilled person which had the claimed particle size distribution and provided an AUL value considerably higher than the claimed AUL value of 27 ml/g. Therefore the patent does not disclose the invention over the entire range claimed (see also T 409/91, OJ EPO 1994, 653) and consequently the requirements of Article 83 EPC are not met.

3.5 For the sake of completeness: the same reasoning applies to claim 1 of the main request, claiming an AUL value of "at least 24 ml/g". The patent in suit gives only two examples of a superabsorbent with a particle size distribution such that "about 80% by weight" of the particles have a particle size greater than 200 microns, the superabsorbent having an AUL of "at least 24 ml/g". These are Example III with 82,8 % by

weight and Example V with 78,15% by weight, both providing an AUL value of 26 ml/g.

However, this single value cannot be considered to provide sufficient support for a claim to a range for the AUL value starting at 24 ml/g, but having no upper limit.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The President:

M. Patin

P. Alting van Geusau