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**Datasheet for the decision
of 13 November 2007**

Case Number: T 0281/06 - 3.3.10

Application Number: 96944894.3

Publication Number: 0876164

IPC: A61L 15/28

Language of the proceedings: EN

Title of invention:
Improved absorbent body

Patentee:
McNEIL-PPC, Inc.

Opponent:
The Procter & Gamble Company

Headword:
-

Relevant legal provisions:
EPC Art. 56, 123(2)

Keyword:
"Main request and auxiliary requests I to III and VII:
inventive step (no) - no fair comparison with closest prior
art - reformulation of technical problem - obvious
alternative"
"Auxiliary requests IV to VI: amendments - added subject-
matter - (yes) - no basis in the application as filed for the
combination of features introduced in the claim"

Decisions cited:
T 0020/81, T 0288/92, T 0680/93

Catchword:
-



Case Number: T 0281/06 - 3.3.10

DECISION
of the Technical Board of Appeal 3.3.10
of 13 November 2007

Appellant:
(Opponent)

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Respondent:
(Patent Proprietor)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 27 December 2005
rejecting the opposition filed against European
patent No. 0876164 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: R. Freimuth
Members: P. Gryczka
D. Rogers

Summary of Facts and Submissions

I. European patent 0 876 164, in respect of European patent application No. 96944894.3 was granted on the basis of a set of 14 claims. Independent claim 1 read as follows:

"1. An absorbent body having improved absorption capacity comprising a mixture of multi-limbed regenerated cellulosic fibers having at least three limbs and an effective amount of non-limbed cellulosic fibers to increase a specific absorption capacity of the absorbent body, the multi-limbed and non-limbed fibers not being both regenerated solid cellulosic viscose fibers."

II. A notice of opposition was filed in which revocation of the patent in its entirety was requested on the grounds of lack of novelty and inventive step, insufficiency of disclosure and added subject-matter (Article 100(a), (b) and (c) EPC).

Inter alia, the following document was cited during the opposition proceedings:

(1) WO-A-89 01062.

III. In a decision issued in writing on 27 December 2005, the Opposition Division rejected the opposition.

The Opposition Division came to the conclusion that the claims as granted fulfilled the requirements of Articles 123(2) EPC, that the invention was sufficiently disclosed and that the claimed subject-

matter was novel and involved an inventive step over the closest prior art represented by document (1).

IV. The Appellant (Opponent) lodged an appeal against the above decision.

V. With a letter dated 12 October 2007, the Respondent (Proprietor of the patent) filed seven sets of claims as auxiliary requests I to VII.

Claim 1 of auxiliary request I differed from claim 1 as granted by the indication of the amount of multi-limbed fibers, namely "from 40 to 99 wt-%", and the amount of non-limbed fibers, namely "from 60 to 1 wt-%".

Claim 1 of auxiliary request II differed from claim 1 as granted by the indication of the amount of multi-limbed fibers, namely "from 50 to 95 wt-%", and the amount of non-limbed fibers, namely from "50 to 5 wt-%".

Claim 1 of auxiliary request III differed from claim 1 as granted by the indication of the amount of multi-limbed fibers, namely "from 65 to 85 wt-%", and the amount of non-limbed fibers, namely "from 35 to 15 wt-%".

Claim 1 of auxiliary requests IV to VI differed from claim 1 of auxiliary requests I to III, respectively, by the indication that the multi-limbed fibers "comprise viscose rayon staple fibers" and the non-limbed fibers "comprise regenerated cellulosic fibers or cotton fibers".

Claim 1 of auxiliary request VII differed from claim 1 as granted by the replacement of the feature "having at least three limbs" by the feature "having three limbs".

VI. According to the Appellant the disclaimer present in claim 1 as granted and in each of the auxiliary requests was not allowable and the invention was not sufficiently disclosed. The claimed subject-matter was not novel with regard to document (1) which represented the closest prior art for the assessment of inventive step. As shown by the comparative experiments filed with the letter dated 2 May 2006 the problem of providing an increase of the absorbency was not solved over the whole scope of the claims. In addition, the comparative experiment F of the patent specification, upon which the Respondent relied to show an improvement, did not reflect the closest prior art since it did not involve a blend of fibres, although blends were already known from document (1). Thus, the problem solved by the invention was merely the provision of further absorbent bodies. The solution to that problem proposed by claim 1 of the main request and the auxiliary requests I to III and VII was obvious for a skilled person in view of document (1) which described already absorbents based on a blend of multi-limbed fibres having preferably three limbs, with non-limbed fibres of the same chemical nature as those claimed and without restrictions with regard to their respective amounts. The amendments to claim 1 of the auxiliary requests IV to VI did not fulfil the requirements of Article 123(2) EPC since they resulted in a combination of features which was not disclosed in the application as filed.

- VII. The Respondent considered that the disclaimer was allowable and that the invention was sufficiently disclosed. The claimed absorbent body was novel over the disclosure of document (1) which was the closest prior art. The objective technical problem underlying the patent in suit was the provision of a fibrous adsorbent having improved absorption capacity. As shown by comparative example F and example K in the patent specification this problem was effectively solved. This comparison was pertinent since example F reflected the absorbent body which according to document (1) had the highest absorbency. The skilled person would not find in document (1) any incentive to increase the absorbency by employing a mixture of multi-limbed and non-limbed cellulosic fibres. Thus, the claimed subject-matter involved an inventive step. The amendments to claim 1 of the auxiliary requests IV to VI were based on claim 2 and on the two claims numbered as claim "3" of the application as filed and therefore fulfilled the requirements of Article 123(2) EPC.
- VIII. The Appellant requested that the decision under appeal be set aside and that the patent be revoked.
- IX. The Respondent requested that the appeal be dismissed and that the patent be maintained as granted, alternatively that the patent be maintained on the basis of one of the auxiliary requests I to VII filed with the letter dated 12 October 2007.
- X. At the end of the oral proceedings held in front of the Board on 13 November 2007, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. The Appellant objected to the novelty of the claimed subject-matter, to the allowability of the disclaimer present in claim 1 of all requests and to the sufficiency of disclosure of the invention. In view of the negative conclusions with respect to inventive step of the adsorbent body according to claim 1 of the main request and the auxiliary requests I to III and VII (see points 3, 5 and 8 below), and since the amendments of claim 1 according to the auxiliary requests IV to VI extend the subject-matter beyond that of the application as filed (see point 6 below), a decision of the Board in relation to the allowability of the disclaimer and to sufficiency of disclosure is not necessary.

Main request

3. *Inventive step*
 - 3.1 The patent in suit is directed to an absorbent body. Absorbent bodies already belong to the state of the art as illustrated by document (1) which was considered in the decision under appeal and by both parties in the appeal proceedings as representing the closest prior art document for the assessment of inventive step. The Board sees no reason to depart from this finding.

Document (1) discloses fibers and absorbent bodies comprising solid regenerated cellulosic filaments,

which have a multi-limbed cross section (page 1, lines 1 to 4; claims 1, 8 and 11), the filaments having preferably 3 or 4 limbs (page 2, lines 9 and 10). These fibers may be blended with other cellulosic fibers, such as standard viscose or cotton, or non-cellulosic fibers such as polyester (page 6, lines 11 to 14), the term "standard" denoting a circular cross section (page 16, lines 3 and 4), which corresponds to a non-limbed fiber as conceded by both parties. Example 7 relates to an absorbent body consisting of 50 % of regenerated cellulosic viscose fibers having three limbs since it was spun through Y-shaped extrusion holes, these fibers being blended with 50 % polyester fibers (page 7, lines 13 to 24).

- 3.2 Having regard to this prior art, the Respondent submitted that the technical problem underlying the patent in suit was to provide an absorbent body having an improved absorption capacity (patent specification page 2, line 29).
- 3.3 As the solution to this problem the patent in suit proposes the absorbent body according to claim 1, which is characterized by the fact that the multi-limbed fibers have at least three limbs combined with the fact that the non-limbed fibers are cellulosic fibers.
- 3.4 The Appellant and the Respondent were divided as to whether or not the evidence presented, namely comparative example F and example K according to the invention, found in the patent specification, table 4, page 5, convincingly showed that the technical problem defined herein above was successfully solved by the claimed absorbent body.

Comparative example F was carried out with an absorbent body containing 100 wt.% of "Galaxy" fibers (table 3, page 4) which are multi-limbed regenerated cellulosic staple fibers (page 3, lines 55 and 56). However, this comparative example relates to an absorbent containing only multi-limbed fibers, whereas document (1) discloses absorbents which are made of blends of fibers (see point 3.1 above) and which are thus closer to the claimed invention which also requires a blend of fibers.

Consequently, comparative example F does not truly reflect the closest prior art and does not allow a fair comparison with the claimed invention.

- 3.4.1 The Respondent argued that the comparison on which it relied was pertinent for showing an improvement over the prior art since example F reflected the absorbent body which according to document (1) had the highest absorbency.

However, it is not contested that the blended fibers described in document (1) are structurally closer to the claimed subject-matter than those used in comparative example F. Thus, comparative example F does not represent the closest prior art and cannot be considered as a fair comparison. In addition, document (1) does not mention that the absorbency is decreased when the absorbents are formed by blending the multi-limbed fibers with other fibers (page 6, third paragraph). Consequently, the argument of the Respondent that the unblended multi-limbed fibers represent the best absorbents within the disclosure of

document (1) is not corroborated by the facts and must also for this reason be rejected.

- 3.4.2 Consequently, the alleged improvement of absorbency over the closest prior art is not adequately supported by the evidence on which the Respondent relies.
- 3.5 According to the jurisprudence of the Boards of Appeal, alleged but unsupported advantages cannot be taken into consideration for the determination of the problem underlying the claimed invention (see e.g. decision T 20/81, OJ EPO 1982, 217, point 3, last paragraph of the reasons). Since in the present case the alleged advantage, i.e. improved absorbency, lacks the required experimental support, the technical problem as defined above (see point 3.2) needs to be redefined in a less ambitious way, and in view of the teaching of document (1) can merely be seen in providing an alternative absorbent body.
- 3.6 It remains to be decided whether or not the proposed solution to that objective technical problem, namely the absorbent body according to claim 1, is obvious in view of the state of the art.
- 3.6.1 The skilled person looking for an alternative to the absorbent bodies disclosed in document (1) would turn his attention to the teaching of document (1) itself from which he explicitly learns that the multi-limbed fibers preferably have 3 or 4 limbs, and thus at least three limbs as required by claim 1 of the patent in suit. In addition, document (1) on page 6, lines 11 to 14 clearly teaches that such multi-limbed fibers may be blended with other cellulosic fibers such as standard

viscose or cotton fibers, which both are non-limbed fibers (see point 3.1 above). Claim 1 of the patent in suit contains the functional feature that the amount of non-limbed cellulosic fibers is effective to increase a specific absorption capacity. However, in the absence of evidence showing that the absorption capacity has effectively been increased by the presence of non-limbed fibers, this functional feature cannot characterize the proposed solution (see point 3.3 above) and is therefore not taken into account (see point 3.4 above).

The Board concludes from the above that document (1) gives a clear incentive on how to solve the technical problem underlying the patent in suit of providing an alternative absorbent body, namely by combining the multi-limbed fibers having at least three limbs with non-limbed cellulosic fibers, thereby arriving at the solution proposed by the patent in suit.

For these reasons, the subject-matter of claim 1 of the patent as granted turns out to be merely the result of an arbitrary choice made within the ambit of document (1) and thus lacks the required inventive step.

- 3.6.2 The Respondent argued in support of inventive step that document (1) gave no specific hint to blends of fibers in accordance with the patent in suit. However, this argument cannot convince the Board since it is inconsistent with the teaching of document (1) which, contrary to the allegation of the Respondent, discloses, e.g. in example 7 and on page 6, third paragraph, the use of blended fibers.

3.7 To summarize, the absorbent body according to claim 1 as granted does not involve an inventive step. Therefore, the main request must be refused.

Auxiliary requests I to III

4. *Amendments*

Claim 1 of each of auxiliary requests I, II and III has been amended by the addition of the amounts of multi-limbed and non-limbed fibers as disclosed respectively in claims 1, 4 and 5 of the patent application as filed. These features which also restrict the scope of protection conferred by the patent as granted fulfil, therefore, the requirements of Article 123(2) and (3) EPC. This was not contested by the Appellant.

5. *Inventive step*

According to claim 1 of the auxiliary request I the amount of multi-limbed fibers is "from 40 to 99 wt-%" and the amount of non-limbed fibers is "from 60 to 1 wt-%".

According to claim 1 of the auxiliary request II the amount of multi-limbed fibers is "from 50 to 95 wt-%" and the amount of non-limbed fibers is from "50 to 5 wt-%".

According to claim 1 of the auxiliary request III the amount of multi-limbed fibers is "from 65 to 85 wt-%" and the amount of non-limbed fibers is "from 35 to 15 wt-%".

The Respondent conceded at the oral proceedings before the Board that no effect with regard to the absorption capacity was shown for these particular amounts of fibers. Therefore, also in relation with the subject-matter of claim 1 of these auxiliary requests, the technical problem solved by the invention remains the same as for the main request, that is the provision of alternative absorbent bodies (point 3.5 above).

Since, the teaching of document (1) is that the non-limbed and multi-limbed fibers may be blended in any amount, no limits being indicated in this respect in document (1), the amounts of fibers specified in claim 1 of the auxiliary requests I to III can only be seen as an arbitrary choice within the ambit of document (1). Therefore, the assessment of inventive step given in point 3 above in respect of the main request is not affected by the amounts of fibers indicated in claim 1 of the auxiliary requests I to III and the conclusions drawn for the main request still apply.

Thus, the subject-matter of claim 1 of auxiliary requests I to III does not involve an inventive step and, therefore, these requests must also be refused.

Auxiliary request IV to VI

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

Claim 1 of the auxiliary requests IV to VI has been amended, *inter alia*, in that the multi-limbed fibers are more precisely defined by the feature requiring that they "comprise viscose rayon staple fibers"

combined with the feature requiring that the non-limbed fibers "comprise regenerated cellulosic fibers or cotton fibers".

Article 123(2) EPC prohibits amendments generating "subject-matter which extends beyond the content of the application as filed ". In order to determine whether or not the subject-matter of an amended claim satisfies this requirement it has to be examined whether that amended claim comprises technical information 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 and T 680/93, point 2 of the reasons, neither published in OJ EPO).

The Respondent submitted that the amendments to claim 1 were based on claim 2 and on the two claims numbered "3" of the application as filed.

It is not disputed that claim 2 as filed defines the chemical nature of the multi-limbed fibers and that both claims "3" as filed define the non-limbed fibers. However, since these claims are not disclosed in combination in the application as filed, they cannot constitute an adequate basis for the combination of the specific multi-limbed fibers with the specific non-limbed fibers as now defined in amended claim 1. The Board is not aware of any other part of the application as filed which could support such a fresh combination.

Hence, claim 1 of auxiliary requests IV to VI does not fulfill the requirements of Article 123(2) EPC and, therefore, these requests must also be refused.

Auxiliary requests VII

7. *Amendments*

In view of the negative conclusion on inventive step with respect to claim 1 of auxiliary request VII (see point 8 below), a decision of the Board on the disputed question whether the amendments of claim 1 of the auxiliary request VII, fulfil the requirements of Article 123(2) EPC is not necessary.

8. *Inventive step*

Claim 1 of the auxiliary request VII differs from claim 1 as granted (main request) solely by the fact that the multi-limbed fibers are defined as having "three limbs" instead of "at least three limbs".

The Respondent conceded at the oral proceedings before the Board that no effect with regard to the absorption capacity was shown for this particular number of limbs. Therefore, also in relation with the subject-matter of claim 1 of the auxiliary request VII, the technical problem solved by the invention remains as for the main request, namely the provision of alternative absorbent bodies (point 3.5 above).

The skilled person faced with this technical problem of providing alternative absorbent bodies gets a clear incentive from the prior art to choose fibers having three limbs since it is taught in document (1) that the multi-limbed fibers preferably have three limbs (page 2, lines 9 and 10).

Therefore, the assessment of inventive step given in point 3 above in respect of the main request is not affected by the number of limbs indicated in claim 1 of the auxiliary request VII and the conclusions drawn for the main request still apply.

Thus, the subject-matter of claim 1 of auxiliary request VII does not involve an inventive step and, therefore, this request must also be refused.

9. Thus, the Board arrives at the conclusion that all the requests submitted by the Respondent are not allowable.

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:

P. Cremona

R. Freimuth