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Datasheet for the decision of 6 May 2008

Case Number: T 1502/07 - 3.2.04

Application Number: 04030012.1

Publication Number: 1523925

IPC: A47L 13/18

Language of the proceedings: EN

Title of invention:
Cleaning article

Applicant:
UNI-CHARM CORPORATION

Headword:
-

Relevant legal provisions:
EPC Art. 76(1)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Divisional - added subject-matter (main, first to fourth auxiliary requests: yes)(fifth auxiliary request: no)"
"Isolation of only certain features"

Decisions cited:
G 0001/05, G 0001/06, T 0770/90, T 1067/97, T 0714/00, T 0025/03

Catchword:
-

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Case Number: T 1502/07 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 6 May 2008

Appellant: UNI-CHARM CORPORATION
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 3 April 2007 refusing European application No. 04030012.1 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: M. Ceyte
Members: A. de Vries
T. Bokor

Summary of Facts and Submissions

I. The Appellant lodged an appeal, received 4 June 2007, against the decision of the Examining Division posted 3 April 2007, refusing the European patent application No. 04 030 012.1 and simultaneously paid the required fee. The grounds of appeal were received 10 August 2007.

In its decision the Examining Division held that the application, which was filed as a divisional from an earlier European application No. 01 947 846.0, extended beyond the content of the earlier application contrary to the requirements of Article 76(1) EPC.

II. Oral proceedings before the Board, auxiliarily requested by the Appellant, were held 6 May 2008.

III. The Appellant requests that the decision under appeal be set aside and that the application proceed on the basis of claims according to a main request, or in the alternative, according to first to fifth auxiliary requests filed at the oral proceedings.

IV. Claim 1 of the requests reads as follows :

Main Request:

"A cleaning article (1) comprising an elongate brush portion including a plurality of strips (12) and at least one layer (3) of a fiber bundle, wherein the cleaning article has shorter sides extending parallel to the feeding direction (MD);

characterised in that:

a thermoplastic base sheet (2) and a secondary sheet (5) each have a central region (2a) and two strip—forming regions (2b) lying opposite one another and sandwiching the central region therebetween;

a holding sheet (8) lies on a back face (2B) of the base sheet and extends from the central region to the strip-forming regions of the backsheet;

a plurality of cuts (ii) extend inwardly from two opposite edges of the base sheet, the secondary sheet and the holding sheet to form said plurality of strips (12, 17) elongated in the feeding direction (MD);

a layer (3) of a fiber bundle lies on a cleaning face (2A) of the base sheet and comprises thermoplastic fibers which extend continuously in one direction to traverse said whole fibre bundle layer, the fibres extending in the feeding direction (MD) and having a predetermined bulk over the cleaning face of the base sheet;

the base sheet, the holding sheet and the fibre bundle layer are fusion-bonded together at joining lines;

one pair of joining lines (13) are formed along the boundary lines between the central region (2a) and the strip—forming regions (2b) of the base sheet so that they extend parallel with one another while being spaced in the feeding direction (MD);

the holding sheet, the base sheet, the fibre bundle layer and the secondary sheet are joined altogether by an all-layer joining line (7) which is formed midway between the pair of parallel joining lines (13) and extends perpendicularly to the feeding direction (MD); and

two holding spaces (20) are provided, each of which is defined between one of the parallel joining

lines (13) and the all—layer joining line (7); wherein the base sheet, the secondary sheet and the holding sheet are formed of a nonwoven fabric comprising thermoplastic fibers and/or a thermoplastic resin film."

First Auxiliary Request:

With respect to claim 1 of the main request claim 1 of this request is amended in the following: (emphasis added by the board to highlight the changes):
the feature of the holding sheet now reads: "a holding sheet (8) lies on a back face (2B) of the base *wherein the base sheet and the holding sheet are identical in size in the feeding direction and the holding sheet is shorter than the base sheet in the direction perpendicular thereto*;"
the opening lines of the feature of the plurality of cuts now reads "a plurality of cuts extend inwardly *in a zigzag or saw-tooth shape* ...".

Second Auxiliary Request:

With respect to claim 1 of the main request claim 1 of this request inserts the following further two features immediately following the feature of the one pair of joining lines:
"another pair of joining lines (14) are formed in the strip-forming regions of the base sheet such that the joining lines extend obliquely tranversely over the strips (12) at midway areas between their longitudinal ends to form a zigzag or saw-tooth shape;
one fibre bundle layer is joined to at least some of the strips (17) of the secondary sheet (5) at joining

portions (18) positioned midway between the longitudinal ends of the strips (17);"

Third Auxiliary Request:

With respect to claim 1 of the second auxiliary request claim 1 of this request is amended in the following: (emphasis added by the board to highlight the changes):
the feature of the holding sheet now reads: "a holding sheet (8) lies on a back face (2B) of the base *wherein the base sheet and the holding sheet are identical in size in the feeding direction and the holding sheet is shorter than the base sheet in the direction perpendicular thereto*;"
the opening lines of the feature of the plurality of cuts now reads "a plurality of cuts extend inwardly *in a zigzag or saw-tooth shape* ..."

Fourth Auxiliary Request:

"An elongate cleaning article (1) comprising a holding sheet (8, a thermoplastic base sheet (2), a first fibre bundle layer (3), a second fibre bundle layer (4), a secondary sheet (5) and a third fibre bundle layer (6), wherein the cleaning article has shorter sides extending parallel to the feeding direction (MD); characterised in that:

the base sheet (2) and the secondary sheet (5) each have a central region (2a) and two strip-forming regions (2b) lying opposite one another and sandwiching the central region therebetween;

a holding sheet (8) lies on a back face (2B) of the base sheet wherein the base sheet and the holding sheet are identical in size in the feeding direction

and the holding sheet is shorter than the base sheet in the direction perpendicular thereto;

a plurality of cuts (11) extend in a zigzag or sawtooth shape inwardly from two opposite edges of the base sheet, the secondary sheet and the holding sheet to form said plurality of strips (12, 17) elongated in the feeding direction (MD);

the fibre bundle layers each comprise thermoplastic fibers which extend continuously in one direction to traverse said whole fibre bundle layer the fibres extending in the feeding direction (MD);

the first fibre bundle layer (3) lies on a cleaning face (2A) of the base sheet and has a predetermined bulk over the cleaning face of the base sheet;

the base sheet, the holding sheet and the first fibre bundle layer are fusion-bonded together at joining lines;

one pair of joining lines (13) are formed along the parallel boundary lines between the central region (2a) and the strip-forming regions (2b) of the base sheet;

another pair of joining lines (14) are formed in the strip-forming regions of the base sheet such that the joining lines extend obliquely transversely over the strips (12) at midway areas between their longitudinal ends to form a zigzag or saw-tooth shape;

the second fiber bundle layer lies on a back face (5B) of the secondary sheet (5) and has a predetermined bulk over the back face of the secondary sheet;

the second fibre bundle layer (4) is joined to at least some of the strips (17) of the secondary sheet (5) at joining portions (18) positioned midway between the longitudinal ends of the strips (17);

the holding sheet, the base sheet, the three fibre bundle layers and the secondary sheet are joined altogether by an all-layer joining line (7) which is formed midway between the pair of parallel joining lines (13) and extends perpendicularly to the feeding direction (MD); and

two holding spaces (20) are provided, each of which is defined between one of the parallel joining lines (13) and the all—layer joining line (7); wherein the base sheet, the secondary sheet and the holding sheet are formed of a nonwoven fabric comprising thermoplastic fibers and/or thermoplastic resin film."

Fifth Auxiliary Request:

"An elongate cleaning article (1) comprising a holding sheet (8, a base sheet (2), a first fibre bundle layer (3), a second fibre bundle layer (4), a secondary sheet (5) and a third fibre bundle layer (6); characterised in that:

the base sheet (2), the holding sheet (8) and the secondary sheet (5) each have a central region (2a) and two strip-forming regions (2b) lying opposite one another and sandwiching the central region therebetween;

the holding sheet (8) lies on a back face (2B) of the base sheet wherein the base sheet and the holding sheet are identical in size in one direction and the holding sheet is shorter than the base sheet in the direction perpendicular thereto;

a plurality of cuts (11) extend in a zigzag or sawtooth shape inwardly from two opposite edges of the base sheet, the secondary sheet and the holding sheet to form said plurality of strips (12, 17);

the fibre bundle layers each comprise thermoplastic fibers which extend continuously in one direction to traverse said whole fibre bundle layer;

the first fibre bundle layer (3) lies on a cleaning face (2A) of the base sheet and has a predetermined bulk over the cleaning face of the base sheet;

the base sheet, the holding sheet and the first fibre bundle layer are fusion-bonded together at joining lines;

one pair of joining lines (13) are formed along the parallel boundary lines between the central region (2a) and the strip-forming regions (2b) of the base sheet;

another pair of joining lines (14) are formed in the strip-forming regions of the base sheet such that the joining lines extend obliquely transversely over the strips (12) at midway areas between their longitudinal ends to form a zigzag or saw-tooth shape;

the second fibre bundle layer (4) is joined by fusion-bonding to at least some of the strips (17) of the secondary sheet (5) at joining portions (18) positioned midway between the longitudinal ends of the strips (17);

the holding sheet, the base sheet, the three fibre bundle layers and the secondary sheet are joined altogether by fusion-bonding by an all-layer joining line (7) which is formed midway between the pair of parallel joining lines (13); and

two holding spaces (20) are provided, each of which is defined between one of the parallel joining lines (13) and the all—layer joining line (7); wherein the base sheet, the secondary sheet and the holding

sheet are formed of a nonwoven fabric comprising thermoplastic fibers and/or thermoplastic resin film."

Reasons for the Decision

1. The appeal is admissible.

2. *Legal framework : Article 76(1) EPC 1973*

2.1 Article 76(1) EPC 1973, second sentence, requires that a European divisional application is filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed. According to established jurisprudence, the same principles for determining compliance with Article 123(2) EPC 1973 with respect to an application as filed apply for testing compliance of a divisional with Article 76(1) EPC 1973, in relation to the parent application, see G 01/05 "Divisional/Astropower" and G 01/06 "Sequences of Divisionals/Seiko" (both to be published in the OJ), reasons 5.1. Thus, a central criterion for establishing whether subject-matter complies with Article 123(2) EPC 1973, namely that it be *directly and unambiguously* derivable by the skilled person from the original disclosure, as determined by the *totality* of claims, description and figures when read in context applies also in determining whether a divisional application complies with Article 76(1) EPC 1973 in respect of the earlier application.

2.2 Where newly claimed subject-matter is based on the extraction of features in isolation from a set of features originally disclosed in combination (e.g. in a

specific embodiment in the description) the above criterion is met, following accepted jurisprudence as developed in T 1067/97, T 0714/00 or T 0025/03 (see also the Case Law of the Boards of Appeal of the EPO, 5th edition, 2006 (hereinafter CLBA), III.A.1.1, page 240), if there is no clearly recognizable functional or structural relationship between the features, i.e. when they are not inextricably linked. In such cases, see CLBA, III.A.1.1, page 239, and T 770/90 mentioned therein, an unduly broad original claim, moreover, does not represent a suitable "reservoir" for amendments, i.e. does not by itself justify claiming new feature combinations which may fall within the scope of an original broad claim but are not explicitly disclosed in the original application. These criteria apply also in determining compliance of a divisional application with Article 76(1) EPC 1973.

3. *Parent and Divisional as filed*

3.1 The central idea of the earlier, or parent application concerns the use of strips (in a sheet) in a cleaning article to give a fibre bundle layer forming brush portions increased rigidity and reduce the risk of entanglement so that the brush retains its shape and dust trapping ability (see in particular the last paragraph of page 2 to 2nd paragraph of page 3). This main idea is realized in various embodiments which can be divided into two distinct groups. In that of figures 1 to 6 the various cleaning layers are arranged only on one side of a base sheet, while in figures 7 to 9 cleaning layers are provided on both sides.

3.2 The present divisional application, see its sole claim 1 as filed, focuses on the way the fibre bundle layer, which comprises continuous thermoplastic fibres, is laid on and fusion-joined to a thermoplastic base sheet to provide a joining portion in a non-strip forming region.

There is no strict literal basis in the earlier, parent application as filed for the above idea as expressed in any of the requests, as also acknowledged by the Appellant. Rather it is argued to be inferable from various passages of the parent description when read in conjunction with the original broadly worded statement of invention. The cited passages relate to the embodiment shown in figures 1 to 5 and detailed on pages 8 to 21 of the description.

3.3 The detailed description and figures however include many more features, which do not appear in all versions of claim 1 according to the different requests.

Thus, figures 1 and 3 show this cleaning article featuring three sheets, base sheet 2, holding sheet 8, and further sheet 5, described in separate passages - page 13, lines 6 to 11 for the base sheet 2 and holding sheet 8; the paragraph bridging pages 14 and 15 - as *each* having the same basic layout of outer, *opposite strip-forming regions sandwiching a central*, *non-strip forming region.* Page 13, lines 1 to 4, and page 15, lines 13, and figure 3, moreover, show base sheet 2 and holding sheet 8 having *differing dimensions*. The base sheet 2 with holding sheet 8, and further sheet 5 are joined to *respective* fiber bundle layers 3 and 4 at respective sets of joining lines, as described on

page 13, final paragraph, i.e. by fusion bonding at a first set of joining lines 13 and at a second set of oblique lines 14, see figure 4B, and at a third set of joining portions 18, see the paragraph bridging pages 15 and 16 and figure 5. These sheets and fibre bundle layers are stacked, overlaid with a final fibre bundle layer 6 and the entire composite is then joined by fusion-bonding at a central all-layer joining line 7 midway between lines 13: see the paragraph bridging pages 17. The joining lines 7 and 13 together form two holding spaces between the holding and base sheets.

3.4 From a contextual reading of the various passages it is clear that all these features are bound closely together both functionally and structurally. For example, the joining lines 13 and 7 join the various layers providing structural integrity while simultaneously defining holding spaces. The joining lines 14 and 18 join strips and fibre bundles to form the tangle-free brush portions of increased rigidity that are central to the parent application.

4. *Main, first to fourth auxiliary requests*

4.1 Claim 1 of the *main request* pares down this assembly to a much simplified arrangement of three sheets, of which only the base and further sheet have strips, and a single fibre bundle layer, joined by only the first set of joining lines and the all-layer joining line. The *first auxiliary request* adds some detail of the shape of cut lines and relative dimensions of the base and holding sheets. These are replaced in the *second auxiliary request* by detail of the two other sets of joining lines, while the *third auxiliary request*

includes both sets of additional features of first and auxiliary requests. None of these requests thus shows the complete structure as outlined in section 3.3 above. They rather single out arbitrary features, which in the parent application were given no such special prominence, but were woven at different points into the intricate pattern of features making up the particular cleaning article of figures 1 to 5.

The Board is unconvinced that these features would strike the skilled person reading the parent application as special in their own right or being linked by some special relationship. Not only is this specific combination of features not so disclosed in the parent, there is nothing apparent in the parent which might highlight these features to the skilled person in terms of a technical effect, advantage or problem to be solved associated with this specific combination. Lifting these features from their original context and so raising them to prominence as does claim 1 in its different versions gives these features a special significance where hitherto there was none, thus generalizing them beyond their original context. This results in new subject-matter which extends beyond the content of the earlier parent application as filed.

The Board stresses that it is immaterial that this new combination of features might fall within the scope of a broad statement of invention in the parent. What is decisive is determining which specific combinations of features where originally taught by the parent, and whether the skilled person recognizes *immediately and unequivocally* from the totality of the disclosure when read contextually and using his common general

knowledge that, and which features are incidental to the proper functioning of these specific embodiments, and that these can be dispensed with without consequence for the remaining features. In the present case the fact that the presently claimed features were not given any special prominence, and that they are functionally and structurally bound to the other, remaining features indicates that these criteria are not met.

In conclusion, the Board finds that claim 1 in any of these versions fails to meet the requirements of Article 76(1) EPC 1973.

4.2 The fourth auxiliary request, but for the feature of fusion-bonding for the joining lines, specifies all missing features of the original context. Fusion bonding is intricately linked to the material chosen for the sheets and fibre bundle layers. As above the Board therefore also finds this version of claim 1 as falling short of the requirements of Article 76(1) EPC 1973.

Additionally, this version of the claim includes features which are unclear, contrary to Article 84 EPC, as they are phrased in terms of the "feeding direction (MD)" which has significance only in reference to the method of manufacture of the cleaning article.

5. *Fifth Auxiliary Request*

With respect to claim 1 of the fourth auxiliary request the feature of fusion-bonding for the various joining lines is added, while the unclear features noted above,

which are of no delimiting effect, have been removed. In the Board's view this version of the claim now includes all the features that the skilled person recognizes as making up and characterizing the embodiment of figures 1 to 5 of the earlier, parent application, and thus meets the requirements of Article 76(1) EPC 1973. The Board adds that given the fact that the parent and the divisional descriptions as filed are identical, the above amended version of claim 1 also has a clear basis in the divisional application, and thus also meets the requirements of Article 123(2) EPC.

6. *Remittal*

The decision under appeal concerned only the issue of Article 76(1) EPC 1973, and did not consider any of the further requirements of the EPC, in particular those of novelty and inventive step. So as not to deprive the Appellant of a first instance consideration of these remaining requirements, the Board considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case for further prosecution on the basis of claim 1 of the fifth auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

The Registrar The Chairman

D. Sauter M. Ceyte