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**Datasheet for the decision
of 19 March 2010**

Case Number: T 1468/08 - 3.3.10

Application Number: 98958382.8

Publication Number: 1045706

IPC: A61L 15/60

Language of the proceedings: EN

Title of invention:

Absorbent polymer compositions having high sorption capacities under an applied pressure and improved integrity in the swollen state

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponent:

KIMBERLY-CLARK WORLDWIDE, INC.

Headword:

Absorbent polymer compositions/PROCTER & GAMBLE

Relevant legal provisions:

EPC Art. 111(2), 113(2)

EPC R. 140

RPBA Art. 15(6)

Keyword:

"Request for correction of a decision by the board"

"Request not allowable under Rule 140 EPC"

Decisions cited:

T 0367/96, T 1093/05

Catchword:

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Case Number: T 1468/08 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 19 March 2010 on the request for correction of the decision
of 17 December 2009

Appellant: THE PROCTER & GAMBLE COMPANY
(Patent Proprietor) One Procter & Gamble Plaza
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Representative: Rasser, Jacobus Cornelis
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Respondent: KIMBERLY-CLARK WORLDWIDE, INC.
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Representative: Beacham, Annabel Rose
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Composition of the Board:

Chairman: R. Freimuth
Members: J. Mercey
F. Blumer

Summary of Facts and Submissions

- I. European patent No. 1 045 706 was revoked by the Opposition Division, said decision being set aside by the decision of the Board of Appeal T 1468/08 of 17 December 2009 and the case being remitted to the Opposition Division "for further prosecution on the basis of the main request as filed during the oral proceedings before the Board".

- II. With letter dated 15 March 2010, the Appellant (Patent proprietor) requested correction under Rule 140 EPC of the above decision T 1468/08, "or other appropriate clarification", to reflect that granted claims 2 to 10 "remain", the decision apparently being based on a main request with a single independent claim being "The only claim" of this sole request (see point IV of the decision). The Appellant further indicated that it "believed" that the remittal should have referred to further prosecution on the basis of the description, figures and claims 2 to 10 as granted, together with claim 1 according to the main request as filed during the oral proceedings before the Board.

Reasons for the Decision

1. Rule 140 EPC, which is concerned with the correction of errors in decisions, states that: "In decisions of the European Patent Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected". A decision contains an obvious mistake if the text thereof is not and obviously cannot be what the Board actually intended (see T 1093/05, OJ EPO 2008, 430,

point 7 of the reasons). Rule 140 EPC does not pave the way to reexamination of the factual or legal issues on which a decision was based, nor to reversal of any conclusion derived by the deciding body from a consideration of these issues (see T 367/96 of 21 June 2001, point 2 of the reasons, not published in OJ EPO).

2. In the present case, it was clearly the intention of the Board in the above decision T 1468/08 to decide upon a single claim of a single request, reference being made hereto in the point IV of the Facts and Submissions of said decision, the Facts and Submissions being consistent with the Reasons for the Decision wherein only claim 1 is referred to, namely in points 2.1, 2.2, 3.3 and 3.6 thereof, and with point 4 which refers to remittal to the Opposition Division for further prosecution on the basis of "the claim according to the main request". Thus, there being no obvious mistake in the decision, there is nothing to correct.

2.1 In the minutes of the oral proceedings held before the Board on 17 December 2009, said minutes having been sent to the Appellant with a communication dated 28 December 2009, the final request of the Appellant as stated by the Chairman according to Article 15(6) of the Rules of Procedure of the Boards of Appeal before declaring the debate closed, was confirmed by the Appellant and recorded as being "that the decision under appeal be set aside and the patent be maintained on the basis of the main request as filed during the oral proceedings before the board". Said main request as filed during the oral proceedings before the Board consisted of a single claim, namely claim 1 as

indicated under the section entitled "Documents presented" on page 1 of the minutes. Thus the above decision T 1468/08 is based on the request as filed at oral proceedings before the Board, as reflected in the minutes thereof.

- 2.2 The principle of party disposition as enshrined in Article 113(2) EPC allows the Board to decide only on a request submitted or agreed by the Proprietor of the patent. In the present case, the Board was thus only empowered to decide on the request as filed during the oral proceedings before the Board, as this was the only pending request submitted by the Appellant, as reflected in points IV and VII of the Facts and Submissions of the above decision T 1468/08, point IV specifying that said request superseded all previous requests. With regard to the Appellant's statement in its letter dated 15 March 2010 that it was illogical and procedurally incorrect that the granted claims 2 to 10 should have been deleted, the question of deletion of claims does not arise. The principle of party disposition requires any party to identify in a positive manner those issues and objects it wants the deciding body to take a decision upon. In the present case, the Appellant identified the issues and objects as being claim 1 according to the main request as filed during oral proceedings before the Board. Should the Appellant had wished to have a decision comprising also granted claims 2 to 10, then it fell within the exclusive competence of the Appellant to formulate such a request. It was thus logical and procedurally correct that the above decision T 1468/08 discussed only claim 1, said claim being the only claim submitted to the Board in the request as filed during the oral

proceedings before the Board, said claim being the only claim under review by the Board and the only claim decided upon in the above decision of the Board (see points 2.2 and 3.6 of the Reasons for the Decision).

- 2.3 Therefore, the reference in point IV of the above decision T 1468/08 to "The only claim" correctly reflects the facts of this case. Having decided on the sole pending request as a whole, the Board thus sees no reason to correct its decision in this respect.
3. With regard to the Appellant's "belief" that the remittal should have referred to further prosecution also on the basis of the description, figures and claims 2 to 10 as granted, even if this "belief" were understood to be a request, this cannot be a request for correction under Rule 140 EPC, since the amendment desired would amount to a modification to the substance of the decision, such a modification not qualifying as a correction under Rule 140 EPC (see point 1 above). In any case, the Board notes that the description and figures never formed part of the Appellant's request. As such, they could not be decided upon and therefore could not be reflected in the Order, as the Appellant apparently now wishes.
4. With regard to the Appellant's request for other appropriate clarification with regard to the status of granted claims 2 to 10, the Board may not explain its decision, which has to be taken at face value. The department of first instance, during further prosecution, is bound only by the *ratio decidendi* of the Board's decision pursuant to Article 111(2) EPC, the Board's decision in this case being directed solely

to claim 1 of the main request filed during oral proceedings before the Board. Thus the Board notes that independent of the decision taken, during further prosecution of the case before the Opposition Division the Appellant may submit requests containing one or more of granted claims 2 to 10 as appropriate. Since limitation of claims during *inter partes* proceedings is regarded as a formulation attempt to respond to the objections raised rather than implying an irrevocable renunciation of subject-matter claimed, the Appellant thus still has every opportunity to submit such claims during the further prosecution of the case.

Order

For these reasons it is decided that:

The Appellant's request for correction of the decision under Rule 140 EPC is refused.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

R. Freimuth