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**Datasheet for the decision
of 8 November 2011**

Case Number: T 1291/09 - 3.3.09

Application Number: 01101070.9

Publication Number: 1118633

IPC: C08J 3/12, C08L 101/14

Language of the proceedings: EN

Title of invention:
Process for storing a particulate water-absorbent resin

Patent Proprietor:
NIPPON SHOKUBAI CO., LTD.

Opponent:
BASF SE

Headword:
-

Relevant legal provisions:
EPC Art. 99(1), 100(c), 111, 114(1), 123(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Requirements of Article 123(2) - satisfied"
"Remittal for further prosecution"

Decisions cited:
G 0010/91

Catchword:
-



Case Number: T 1291/09 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 8 November 2011

Appellant: Nippon Shokubai Co., Ltd.
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Representative: Schlauch, Michael
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Respondent: BASF SE
(Opponent) D-67056 Ludwigshafen (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 15 April 2009
revoking European patent No. 1118633 pursuant
to Article 101(2)(3)(b) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: N. Perakis
R. Menapace

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 1 118 633 in respect of European patent application No. 01101070.9, which had been filed on 18 January 2001 in the name of Nippon Shokubai Co. Ltd., was published on 8 June 2005 (Bulletin 2005/23). The patent was granted with 6 claims, Claim 1 reading as follows:

"1. A process for storing a particulate free-flowing surface-crosslinked water-absorbent resin, which comprises a step of storing a particulate water-absorbent resin obtained by pulverizing a dry water-absorbent resin product, wherein the particulate water-absorbent resin has an absorption capacity under load of not less than 18 g/g, with the process being characterised by carrying out all of the following features:

(1) heating at least one portion of a surface getting contact with the particulate water-absorbent resin from the outside,

(2) maintaining the temperature of at least one portion of a surface getting contact with the particulate water-absorbent resin at 40 to 90°C, and

(3) maintaining the temperature of at least one portion of a surface getting contact with the particulate water-absorbent resin above a temperature that is lower than the temperature of the particulate water-absorbent resin by 20°C,

when storing the particulate water-absorbent resin."

II. A notice of opposition was filed by the company BASF AG (now BASF SE) on 7 March 2006, requesting revocation of the patent on the grounds that the claimed subject-matter was not inventive and insufficiently disclosed (Articles 100(a) and 100(b) EPC).

With a letter dated 8 January 2009 the patent proprietor filed auxiliary requests 1 to 11.

With a letter dated 9 February 2009 the opponent raised a new ground for opposition under Article 100(c) EPC. The opponent argued that the compulsory combination of features (1) to (3) according to Claim 1 as granted was not disclosed in the application as filed, with the result that Claim 1 as granted contravened the requirements of Article 123(2) EPC.

During the oral proceedings held before the opposition division, the patent proprietor filed a further auxiliary request 1a.

III. By its decision announced orally on 13 March 2009 and issued in writing on 15 April 2009, the opposition division revoked the European patent. The opposition division considered that the fresh ground for opposition was *prima facie* relevant to the maintenance of the patent and admitted it to the proceedings. It considered that the combination of features (1) to (3), as required by Claim 1 of all requests, had not been disclosed in the application as filed (Articles 100(c)/123(2) EPC).

The opposition division argued as follows:

- The expression "with the process being characterised by carrying out at least one selected from the group consisting of: (1) ... (2) ... and (3)...", used in Claim 1 as originally filed [Claim 7 was apparently meant], was a generic disclosure which should not be considered equivalent to a disclosure of a list including all possible specific combinations within the ambit of this expression. Since the expression "all of the following features" related to one of these specific combinations, it did not find support in the claim as filed considered alone.

- Examples 3 and 6 of the patent in suit disclosed the combination of features (1) and (2) but were silent with regard to feature (3). The fact that in these specific examples the temperature requirement of feature (3) was likely to be satisfied could not be considered an unambiguous teaching of a process in which the three process features were carried out in combination.

- The general disclosure of the invention in the application as filed (page 15, line 23, to page 18, line 18) disclosed the three features as isolated alternatives which were independent of each other, rather than in combination.

IV. On 8 May 2009 the patent proprietor (appellant) filed an appeal against the decision of the opposition division and paid the appeal fee on the same day.

The statement setting out the grounds of appeal was filed on 7 August 2009. The appellant requested that the patent be maintained as granted or, alternatively, on the basis of the auxiliary requests filed during the opposition proceedings. It also requested that the case be remitted to the opposition division for decision on the issues relating to Articles 100(a) and (b) EPC.

The appellant also complained of procedural irregularities in the course of the opposition procedure before the opposition division in relation to the postponement of oral proceedings. The appellant (patent proprietor) felt that the procedure involving the cancellation of the original date and the arrangement of the new date had been unfair to the proprietor.

- V. With a letter dated 11 December 2009 the respondent (opponent) filed observations on the appeal, essentially defending the appealed decision, and requested that the appeal be dismissed.

- VI. With a letter dated 29 August 2011 the appellant filed additional auxiliary requests 1 and 2 and requested that the auxiliary requests on file be renumbered accordingly. The appellant also requested that in view of the case history, as outlined in the grounds of appeal, the case be remitted to a fresh opposition division composed of different members, in order to guarantee fair and impartial proceedings.

- VII. Oral proceedings before the board were held on 8 November 2011. During these proceedings the board expressed its understanding for the appellant's

dissatisfaction with the way the postponement of the oral proceedings had been handled by the opposition division. The board, however, could not identify any procedural violation; nor had the appellant raised such an objection. Thereafter the appellant formally withdrew its request that the case be remitted to a fresh opposition division.

VIII. The relevant arguments put forward by the appellant in its written submissions and at the oral proceedings may be summarised as follows:

- The fresh ground for opposition under Article 100(c) EPC should not have been admitted to the proceedings. Such a fresh ground could only be admitted on the basis of Article 114(1) EPC, together with G 10/91, as an exception, when *prima facie* this ground seemed to prejudice the maintenance of the European patent. This, however, was not the case since neither the opponent, in the notice of opposition, nor the opposition division, in its preliminary opinion accompanying the summons to attend oral proceedings, had raised as an issue that the subject-matter of the patent as granted extended beyond the application as filed.

- The amendment of "at least one of three features" to "all of three features" should not be regarded as an extension of subject-matter. The expression "at least one selected from the group consisting of" used in Claim 7 as filed was a "Markush" formulation commonly employed in patent law. This claim formulation directly and unambiguously disclosed the

case where "all of (1), (2) and (3) features" were combined as a preferred embodiment.

- This amendment was further supported by Examples 3 and 6 in the application as filed. These examples disclosed not only features (1) and (2) but also feature (3) and provided a clear and unambiguous support for Claim 1 as granted.

 - Finally, the skilled person would directly and unambiguously derive from the general disclosure in the application as filed that features (1) to (3) were each described - not as mutually exclusive alternatives - but as essential requirements in mutual correlation and close connection with the other two and were preferably combined in order to achieve the object of the present invention.
- IX. The relevant arguments put forward by the respondent in its written submissions and at the oral proceedings may be summarised as follows:
- The application as filed did not provide any support for the direct and unambiguous combination of features (1) to (3) in Claim 1 as granted. Contrary to the appellant's allegation, the contested amendment could not be considered to result from a selection from a Markush formulation, since such a formulation was applied in chemical formulae only.

 - The general part of the application as filed disclosed that features (1) to (3) were each essential for the process, but only as isolated alternatives and not in combination.

- Example 6, the only example which involved a surface-crosslinked water-absorbent resin and combined features (1) to (3), related to a very specific resin and could not be generalised to provide support for the much broader scope of granted Claim 1.
- X. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the case be remitted to the opposition division for decision on the grounds for opposition under Article 100(a) and (b) EPC on the basis of the claims as granted (main request), or alternatively on the basis of auxiliary requests 1 and 2 filed with the letter dated 29 August 2011, auxiliary request 3 (corresponding to auxiliary request 1 filed with the letter dated 8 January 2009), auxiliary request 4 (corresponding to auxiliary request 1a filed during the oral proceedings before the opposition division), or auxiliary requests 5 to 14 (corresponding to auxiliary requests 2 to 11, respectively, filed with the letter dated 8 January 2009).
- XI. The respondent (opponent) requested that the appeal be dismissed, or, otherwise, that the case be remitted to the opposition division.

Reasons for the Decision

1. The appeal is admissible.

2. Admittance of the fresh ground for opposition
- 2.1 With a letter dated 9 February 2009, i.e. after expiry of the time limit set out in Article 99(1) EPC, the opponent raised for the first time the new ground for opposition under Article 100(c) EPC. This is considered to be a fresh ground for opposition within the meaning of G 10/91, point 18 of the reasons. This has not been contested by the opponent.
- 2.2 As set out in G 10/91, point 2, an Opposition Division may in application of Article 114(1) EPC consider grounds for opposition not properly covered by the statement pursuant to Rule 55(c) EPC which, *prima facie*, in whole or in part would seem to prejudice the maintenance of the European patent.

In the present case, the opposition division considered the fresh ground *prima facie* relevant and admitted it to the proceedings. The relevance of this ground was evidently confirmed by the revocation of the European patent (all requests) on the basis of this ground.

- 2.3 Considering a ground to be *prima facie* relevant under G 10/91 and Article 114(1) EPC falls within the discretion of the opposition division. The appellant did not raise any objection that the opposition division had not exercised its discretionary power in accordance with the relevant principles. There is therefore no reason to overrule the opposition division's discretionary decision to admit the late-filed ground of opposition into the proceedings.

3. Main request (claims as granted) - Article 100(c) EPC

3.1 The only issue in the context of Article 100(c) EPC is whether or not the combination of all three features for carrying out the process of Claim 1 as granted is disclosed in the application as filed.

3.2 Claim 1 as granted is based on Claim 7 as filed, which is an independent claim for a process for storing a particulate water-absorption resin. This claim reads as follows:

"... with the process being characterized by carrying out **at least one selected from the group consisting of:**

(1) heating at least one portion of a surface getting contact with the particulate water-absorbent resin from the outside,

(2) maintaining the temperature of at least one portion of a surface getting contact with the particulate water-absorbent resin at 30 to 150 °C, and

(3) maintaining the temperature of at least one portion of a surface getting contact with the particulate water-absorbent resin above a temperature that is lower than a temperature of the particulate water-absorbent resin by 20 °C,

when storing the particulate water-absorbent resin"
(emphasis added).

3.3 According to its ordinary and unambiguous logical meaning the term "at least one" in the wording of Claim 7 as originally filed defines a number of actually seven alternative combinations of features (1),

(2) and (3), namely applying only one of those process features, or applying two of them, or also all three in combination.

Thus, the latter combination of the three features as required in Claim 1 as granted is to be considered, for the purposes of Article 123(2) EPC, as clearly and unambiguously derivable from Claim 7 as originally filed.

- 3.4 But even if, *arguendo*, the skilled person did not consider that the combination of the three features was in itself directly and unambiguously derivable from Claim 7 as originally filed as a single alternative among other seven alternatives, he would still consider it to be directly and unambiguously derivable from the content of the application as filed as a whole, in particular the experimental part. It is a general principle that examples represent preferred embodiments of the claimed invention. In the present case, Example 6 is the only example demonstrating the storage of a free flowing surface-crosslinked water-absorbent resin according to Claim 1 as granted. This fact has not been disputed by the respondent. Example 6 discloses the combination of the three features of Claim 1 as granted and therefore clearly indicates that this combination was a preferred alternative of the invention. At this point a distinction has to be made concerning the function of Example 6: it has not been taken *ex post facto* as a basis for generalising a specific embodiment, as wrongly argued by the respondent, but for demonstrating that the now claimed specific combination had been disclosed as a possible concrete alternative upon filing of the application as

filed and, therefore, was part of its content within the meaning of Article 123(2) EPC.

- 3.4.1 In concrete terms, Example 6 (see, in particular, the cross references to Example 3; page 22, lines 16-19, of the application as filed) discloses storing of a particulate water-absorbent resin in a hopper, the inner surface of which is thermally insulated by streaming warm water of 60°C into the jacket 75, and which has a structure of maintaining the internal surface temperature of the outer frame 72 (which contacts the particulate water-absorbent resin) at 60°C. This disclosure undoubtedly corresponds to feature (2) of Claim 1.

Example 6 (cross reference to Example 3; page 22, lines 19-20) also discloses that the portion near the extract outlet 74 is further heated by the electric heater 76, which clearly corresponds to feature (1) of the claim.

The temperature of the particulate water-absorbent resin of Example 6 was established as being about 50°C, as this was the "extracting temperature" (page 25, lines 23-24). Since the temperature of the internal surface of the hopper is 60°C and the temperature of the resin is about 50°C, it directly follows that Example 6 also supports feature (3) of Claim 1, namely maintaining at least one portion of the surface getting contact with the particulate water-absorbent resin above a temperature that is lower than the temperature of the particulate water-absorbent resin by 20°C (60°C is above about 30°C (about 50°C - 20°C)).

3.4.2 Even if a skilled person did not exclude that the extracting temperature might be lower than the actual temperature of the resin in the hopper (due to cooling during extraction), it would be clear to him that the temperature of the particulate water-absorbent resin had to be at least about 50°C (extracting temperature) and not more than 60°C (temperature of the resin before classification; see page 21, line 26, to page 22, line 3), which is also the internal surface temperature of the hopper. Since the temperature of the internal surface of the hopper is 60°C and the temperature of the resin is about 50°C (or slightly higher, but 60°C at most), a temperature that is lower than the temperature of the particulate water-absorbent resin by 20°C should vary between about 30°C and 40°C. This means that the temperature of 60°C, at which at least one portion of a surface getting contact with the resin is maintained, is above the range of about 30°C to 40°C. Thus, in any case, Example 6 supports feature (3) of Claim 1 as granted.

3.4.3 In view of the fact that the temperature of the resin is inevitably between about 50°C (extracting temperature) and 60°C (highest temperature in the heating arrangement of Example 6), the respondent's contention that Example 6 does not disclose the measurement of the exact temperature of the resin in the hopper is unfounded.

3.5 It follows from the above considerations that the subject-matter of Claim 1 as granted does not extend beyond the content of the application as filed.

4. Remittal

The decision under appeal has dealt exclusively with the ground for opposition under Article 100(c) EPC but not with the other grounds for opposition raised by the opponent, namely Articles 100(a) and (b) EPC. Under these circumstances the board considers it appropriate, to exercise its power under Article 111(1) EPC and to remit the case to the opposition division for further prosecution (Article 111(2) EPC), as it was requested by both parties.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of the claims as granted.

The Registrar:

The Chairman:

G. Röhn

W. Sieber