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**Datasheet for the decision
of 18 April 2013**

Case Number: T 0043/10 - 3.3.10

Application Number: 01308544.4

Publication Number: 1197231

IPC: A61L15/36, A61L15/46

Language of the proceedings: EN

Title of invention:

Absorbent article for controlling normal flora of the skin

Patent Proprietor:

UNI-CHARM CORPORATION

Opponent:

SCA Hygiene Products AB

Headword:

Relevant legal provisions:

EPC Art. 100(a), 54, 123(2), 123(3), 84, 111(1)

Keyword:

Novelty (no) - main request, first auxiliary request
Second auxiliary request - remitted for further prosecution

Decisions cited:

G 0002/88

Catchword:



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Case Number: T 0043/10 - 3.3.10

**D E C I S I O N
of Technical Board of Appeal 3.3.10
of 18 April 2013**

Appellant: UNI-CHARM CORPORATION
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 November
2009 revoking European patent No. 1197231
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: P. Gryczka
Members: R. Pérez Carlón
F. Blumer

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division to revoke European patent No. 1 197 231.
- II. Notice of opposition had been filed by the respondent requesting revocation of the patent in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC).

Inter alia, the following documents were submitted during opposition proceedings:

D1: WO 00/61201
D2: WO 98/47374

- III. The opposition division found *inter alia* that the subject-matter of claim 1 of the patent as granted (main request) was not novel over D1 and D2, that the subject-matter of the first auxiliary request then pending, which is identical to the first auxiliary request before the board, was not clear because it contained an intended use which could not limit a product. Additionally, the application as filed did not present a direct and unambiguous basis for an absorbent product without any useful and/or harmless bacteria, especially when worn, so that claim 1 of the first auxiliary request contained added subject-matter.
- IV. With the statement setting out the grounds of appeal, the appellant requested that the patent be maintained as granted (main request), and filed auxiliary requests 1 to 10. Under cover of a letter dated 18 February 2013, additional auxiliary requests 5A, 6A, 10A and 11 were filed.

V. Claim 1 of the requests relevant for the present decision reads as follows:

Main request:

"An absorbent article comprising a compound assimilated only by a microorganism in the normal flora of the skin useful and/or harmless to the human body; characterised in that the compound is a glucooligosaccharide."

First auxiliary request:

"An absorbent article comprising a compound which on wearing is assimilated only by a microorganism in the normal flora of the skin useful and/or harmless to the human body to selectively proliferate said microorganism on the skin and thereby to control the growth of undesirable microorganisms, wherein the compound is a glucooligosaccharide."

Second auxiliary request:

"The use of glucooligosaccharide in an absorbent article for assimilation only by microorganisms in the normal flora of the skin useful and/or harmless to the human body."

VI. The appellant argued that every glucooligosaccharide fulfilled the functional feature in claim 1 "assimilated only by a microorganism in the normal flora of the skin useful and/or harmless to the human body". This feature did not, hence, limit the nature of the glucooligosaccharide defined in claim 1.

Said feature of claim 1 of the main request

"assimilated only by a microorganism in the normal

flora of the skin useful and/or harmless to the human body" defined in fact the location of the microorganisms with respect to the absorbent article of claim 1, and excluded thus the presence of said microorganisms added to said absorbent article during its manufacture, since the microorganisms defined in claim 1 could only be "from the normal flora of the skin". As the absorbent articles of D1 and D2 contained added bacteria, and claim 1 excluded this possibility, the subject-matter of claim 1 was novel over D1 and D2.

Claim 1 of the first auxiliary request contained, in addition, the features "on wearing" and "to selectively proliferate said microorganism on the skin and thereby to control the growth of undesirable microorganisms". These features excluded the presence of added microorganisms in the absorbent article, since the growth control defined in claim 1 took place only on the skin, upon wearing. The absorbent articles of D1 and D2 included bacteria added during their manufacture and the subject-matter claimed was, therefore, novel.

Claim 1 of the second auxiliary request resulted from a mere change of the claim category of claim 1 of the main request and, as such, did not include added subject-matter.

As a use claim in the form of the use of a known compound for a new purpose, claim 1 of the second auxiliary request did not need to include process steps and was, therefore, clear.

VII. The respondent argued that by the wording "comprising" claim 1 was open and did not exclude the presence of microorganisms added to the claimed absorbent article. The feature "assimilated only by a microorganism in the

normal flora of the skin useful and/or harmless to the human body" limited only the glucooligosaccharides to those which could be assimilated by the particular beneficial type of microorganisms. Since D1 disclosed an absorbent article comprising glucooligosaccharides, which were compounds assimilated only by beneficial microorganisms found in the normal skin flora, the subject-matter of claim 1 of the main request was not novel.

Claim 1 of the first auxiliary request did not contain any further limitation with respect to claim 1 of the main request, so that the same arguments applied.

The application as filed disclosed neither an absorbent article containing a glucooligosaccharide that was only assimilated by microorganisms in the normal flora of the skin useful and/or harmless to the human body, nor the use of such an absorbent article, so that claim 1 of the second auxiliary request contained added subject-matter. Finally, claim 1 of the second auxiliary request was not clear, since it did not include the physical steps which defined the claimed use.

- VIII. Oral proceedings before the board took place on 18 April 2013 in the absence of the duly summoned respondent.
- IX. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or, subsidiarily, on the basis of any one of the auxiliary requests 1-5, 5A, 6, 6A, 7-10, 10A and 11, auxiliary requests 5A, 6A, 10A and 11 as filed with a letter dated 18 February 2013, all other requests as filed with the statement setting

out the grounds of appeal dated 25 March 2010.

- X. The respondent requested, in writing, that the appeal be dismissed.
- XI. At the end of the oral proceedings, the decision was announced.

Reasons for the Decision

- 1. The appeal is admissible.

Main request:

Novelty

- 2. The opposition division found that the subject-matter of claim 1 as granted was not novel over the absorbent articles disclosed in documents D1 and D2.

- 3. Document D1:

- 3.1 Document D1, which is state of the art in the sense of Article 54(3) EPC, discloses absorbent articles comprising glucooligosaccharides (GOS) and lactic acid bacteria, see for example claim 23.

The parties were divided as to whether the wording of claim 1 excluded the presence of lactic acid bacteria in the claimed absorbent articles.

- 3.2 In order to know whether the absorbent articles of claim 1 may comprise added bacteria, it needs to be examined how the feature "assimilated only by a microorganism in the normal flora of the skin useful and/or harmless to the human body" limits said

absorbent article.

The appellant argued that the feature "assimilated only by a microorganism in the normal flora of the skin useful and/or harmless to the human body" excluded from claim 1 the presence of bacteria added to the absorbent article during its manufacture, since the microorganisms defined in claim 1 could only be those from the skin of the wearer.

However, claim 1 of the main request defines an absorbent article comprising "a compound assimilated only by a microorganism in the normal flora of the skin useful and/or harmless to the human body", which is further defined as a glucooligosaccharide (GOS). Hence, the feature "assimilated only by a microorganism in the normal flora of the skin useful and/or harmless to the human body" defines a property of the glucooligosaccharide (GOS) required by claim 1, namely that it can only be absorbed by microorganisms belonging to the normal flora of the skin useful and/or harmless to the human body, but not by microorganisms which cannot be found in the normal flora of the skin, or by those which are pathogenic.

Thus, the feature "assimilated only by a microorganism in the normal flora of the skin useful and/or harmless to the human body" does not limit the absorbent article with respect to the presence, the origin or the location of the microorganisms.

- 3.3 It has not been disputed that every GOS fulfilled the requirement of claim 1 of being "assimilated only by a microorganism in the normal flora of the skin useful and/or harmless to the human body", and, in the light of the information available, the board sees no reason

to depart from this view.

The feature "assimilated only by a microorganism in the normal flora of the skin useful and/or harmless to the human body" does not, therefore, define any structural limitation of the glucooligosaccharides (GOS) as in claim 1.

Claim 1 of the main request shall be thus construed as directed to an absorbent article comprising a glucooligosaccharide (GOS).

3.4 By the use of the wording "comprising", claim 1 of the main request does not exclude the presence in the absorbent article of additional elements and, hence, does not exclude the presence of bacteria added to it during its manufacture, with the consequence that the absorbent articles of document D1 render the subject-matter of claim 1 not novel in the sense of Article 54 EPC.

4. Document D2:

4.1 The opposition division concluded that the subject-matter of claim 1 was, in addition, not novel over the disclosure of document D2.

Document D2 discloses topical compositions for preventing or controlling microbial infections. Among the optional, suitable components of said compositions, GOS is mentioned (page 18, line 8). The last sentence of the same passage, page 19, lines 7-11, refers to various applications such as a cream for the skin, a wash for the mouth and a douche for vaginal application, but does not mention absorbent articles.

On page 22, lines 14-17, D2 discloses various absorbent articles, which can have applied thereon any additional component of the invention (page 23, lines 11-13). However, GOS is not explicitly mentioned among said additional components and this passage fails, hence, to disclose the combination of features required by claim 1.

On page 6, lines 8-10, D2 discloses that in one embodiment the composition could be applied to a diaper, pliable material for wiping skin or a mucous membrane, dermal patch, adhesive tape, absorbent pad, tampon or article of clothing. However, these absorbent articles are not disclosed in combination with GOS, either.

Hence, although document D2 discloses both absorbent articles and glucooligosaccharides, it fails to disclose, in combination, an absorbent article containing a glucooligosaccharide (GOS), with the consequence that the subject-matter of claim 1 is novel over the disclosure of D2.

5. Since the subject-matter of claim 1 of the main request is not novel over document D1, the main request must be refused.

First auxiliary request:

6. Novelty:

- 6.1 Claim 1 of this request contains the features "which on wearing" and "to selectively proliferate said microorganism on the skin and thereby to control the growth of undesirable microorganisms". Analogously as in the case of claim 1 of the main request (see point

- 3.2), these features define functionally the glucooligosaccharides and thus can only limit the claim with respect to the type of said glucooligosaccharides (GOS).
- 6.2 However, as already mentioned, it was recognised by the parties that every GOS is only assimilated by the microorganisms which can be found in the normal flora of the skin useful and/or harmless to the human body (see 3.3). Since the feature "on wearing" does not change the ability of the microorganisms to assimilate GOS, it does not limit said microorganisms with respect to those defined in claim 1 of the main request and, hence, does not represent any restriction on the chemical nature of the GOS as in claim 1. Therefore, the feature "on wearing" does not change the technical features of the absorbent article claimed with respect to claim 1 of the main request (see 3.2 and 3.3), as it does not further limit the type of glucooligosaccharides (GOS) defined therein.
- 6.3 The functional feature of "selectively proliferate said microorganism on the skin and thereby control the growth of undesirable microorganisms" describes the result which can be achieved when using the claimed absorbent and does not represent, either, a limitation on the subject-matter claimed with respect to claim 1 of the main request.
- 6.4 Claim 1 of the first auxiliary request is, therefore, also directed to an absorbent article comprising a glucooligosaccharide (GOS). Since such an absorbent article had been already disclosed in D1 (see claim 23), claim 1 of the first auxiliary request is not novel in the sense of Article 54 EPC and this request

is, thus, not allowable.

Second auxiliary request:

7. Claim 1 of the second auxiliary request is directed to the use of a glucooligosaccharide, placed in an absorbent article, for assimilation only by a defined type of microorganisms, independently from the source or location of said microorganisms.

8. Amendments:

8.1 Claim 1 of the second auxiliary request finds a basis in the general disclosure of the application as filed, as reflected for example on page 5, lines 7-13 and fulfills therefore the requirements of Article 123(2) EPC.

8.2 The respondent argued that the use of GOS had only been disclosed in combination with absorbents to which microorganisms had been added, whereas such a restriction was not present in claim 1.

The absorbent article of example 1 contains BIOECOLIA, which is a glucooligosaccharide, without any additional microorganisms [58]. Although paragraph [59] of example 1 discloses applying various bacteria to said absorbent article in order to determine the relative distribution of beneficial and harmful bacteria in the presence of GOS, said bacteria had not been added to the absorbent article which was worn by the healthy adult of example 2. Therefore, the application as filed does not disclose the use of GOS only in combination with bacteria added to the absorbent article, as alleged by the respondent.

This argument of the respondent must therefore fail.

- 8.3 Finally, the respondent argued that the application as filed did not disclose any instructions for the use of an absorbent article and, hence, claim 1 of the second auxiliary request contained added subject-matter.

Claim 1 of the second auxiliary request is, however, directed to the use of a glucooligosaccharide (GOS) and not to the use of an absorbent article. It is, therefore, irrelevant whether the application discloses instructions for using an absorbent article.

This argument of the respondent is also refused.

- 8.4 By the change of claim category from "product" to "use", the subject-matter of claim 1 does not extend beyond the scope of granted claim 1 so that the requirements of Article 123(3) EPC are also fulfilled (see G2/88, point 2 of the headnote).

9. Clarity:

The respondent considered that the subject-matter of claim 1 of the second auxiliary request was not clear. A use claim amounted to a process claim, and every process claim had to include the physical steps which defined such a process, whereas those steps were not features of claim 1.

However, claim 1 is drafted as the use of a compound (GOS) for a particular purpose and not in the form of a method or process, and for this reason it does not need to include process steps. This argument of the respondent must, thus, be rejected.

The board concludes that the subject-matter of claim 1 of the second auxiliary request is clear in the sense of Article 84 EPC.

10. Remittal:

The decision under appeal only dealt with claims related to an absorbent article, whereas claim 1 of the second auxiliary request is directed to the use of glucooligosaccharide (GOS) in an absorbent article for assimilation only by microorganisms in the normal flora of the skin useful and/or harmless to the human body. This type of claim raises new issues, for example whether the microorganisms disclosed in D1, and which are intended to assimilate GOS, belong to the normal flora of the skin and, hence, whether claim 1 of the second auxiliary request is novel over D1. In addition, the question arises whether claim 1 of the second auxiliary request is directed to method of treatment in the sense of Article 53(c) EPC.

In order to allow *inter alia* these issues to be examined by two instances, the board considers it appropriate to exercise the power conferred to it by Article 111(1) EPC to remit the case to the opposition division for further prosecution.

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 upon the basis of claims 1-5 of the

second auxiliary request filed with the statement
setting out the grounds of appeal dated 25 March 2010.

The Registrar:

The Chairman:



D. Magliano

P. Gryczka

Decision electronically authenticated