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Datasheet for the decision of 18 March 2014

Case Number: T 0768/10 - 3.2.04

Application Number: 01947846.0

Publication Number: 1299026

IPC: A47L13/20, A47L13/38

Language of the proceedings: EN

Title of invention:
CLEANING ARTICLE

Patent Proprietor:
UNI-CHARM CORPORATION

Opponents:
S.C. Johnson & Son, Inc.
Carl Freudenberg KG

Headword:

Relevant legal provisions:
EPC Art. 111(1), 84, 123(2)
EPC R. 80

Keyword:
Amendment occasioned by ground for opposition - amendments allowable (yes)
Appeal decision - remittal to the department of first instance (yes)

Decisions cited:

Catchword:

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Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0768/10 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 18 March 2014

Appellant: (Patent Proprietor)	UNI-CHARM CORPORATION 182 Shimobun, Kinsei-cho Shikokuchuo-shi, Ehime-ken (JP)
Representative:	Sperling, Rüdiger Staeger & Sperling Partnerschaftsgesellschaft Sonnenstrasse 19 80331 München (DE)
Respondent: (Opponent 1)	S.C. Johnson & Son, Inc. 1525 Howe Street Racine, WI 53403-2236 (US)
Representative:	Ruschke, Hans Edvard RUSCHKE HARTMANN MADGWICK & SEIDE Patent- und Rechtsanwälte Postfach 86 06 29 81633 München (DE)
Respondent: (Opponent 2)	Carl Freudenberg KG Höhnerweg 2-4 69469 Weinheim/Bergstrasse (DE)
Representative:	Gebauer, Dieter Edmund Splanemann Patentanwälte Partnerschaft Rumfordstraße 7 80469 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 16 March 2010 revoking European patent No. 1299026 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman:	A. de Vries
Members:	J. Wright
	T. Bokor

Summary of Facts and Submissions

I. On 9 April 2010 the appellant (proprietor) lodged an appeal against the decision of the opposition division, posted on 16 March 2010, revoking European patent No. 1299026 pursuant to Article 101(3)(b) EPC. The appellant paid the appeal fee simultaneously. The statement of grounds of appeal was received on 26 July 2010.

II. Two oppositions were filed against the patent as a whole and based on Article 100(a), lack of novelty and inventive step.

The Opposition Division held that amendments made to the claims of main and auxiliary requests did not meet the requirements of Rule 80 EPC, Article 84 EPC in conjunction with Rule 43(2) EPC or Article 123(2) EPC.

III. With the appeal the appellant (proprietor) requests that the decision under appeal be set aside and that the patent be maintained based on a set of claims according to a main request or alternatively according to one of 4 auxiliary requests. The appellant (proprietor) further requests remittal of the case to the opposition division.

The respondents (opponents) 1 and 2 both request dismissal of the appeal (revocation of the patent in its entirety).

IV. The Board commented provisionally in a communication pursuant to Rule 100(2) EPC and dated 16 September 2013, noting that the amendments to the claims of each of the requests appeared to address the reasons of the decision and it was therefore inclined

to remit the case to the department of first instance for prosecution of opposition grounds of novelty and inventive step not yet considered. The parties were asked to comment.

In their written replies all parties stated their approval of remitting the case.

V. The wording of the independent claim 1 of the main request is as follows:

"A cleaning article (1) comprising a brush portion including: a plurality of strips (17); and at least one layer of a fiber bundle (3), characterized in that
- a sheet for forming said strips is formed of either a nonwoven fabric comprising thermoplastic fibers or a thermoplastic resin film and in that said fiber bundle layer comprises heat-fusible thermoplastic fibers,
- wherein at least one sheet (5) having said plurality of strips formed therein and said fiber bundle layer (3) are stacked on and partially joined to a base material (2), and
- wherein said base material (2) is provided on its outer face opposed to said cleaning face with a holding sheet (8)."

Reasons for the Decision

1. The appeal is admissible.

2. Main Request : allowability of amendments

2.1 Article 123(2) EPC

As already noted in its communication the Board finds claim 1 of the main request to be a straightforward combination of granted claims 1, 2 and 8. Thus, the two final features ("- wherein at least one sheet (5) ...."; "- wherein said base material (2)....") are identical in wording to the feature of granted claim 2 and that of granted claim 8 respectively, while the remainder of the claim ("A cleaning article (1) .....comprises thermoplastic fibers") is identical in wording to granted claim 1. Granted claim 8 depends on granted claim 2 which in turn depends on granted claim 1, so that this claim combination has a solid basis in the patent as granted.

The further dependent claims 2, 3 (depending on claim 2) and 4 (depending on claim 3) have the same features as granted claims 9, 10 and 15, whereby granted claim 15 depends on granted claim 10, which depends on granted claim 9, which in turn depends on granted claim 8. Therefore the dependent claims likewise have a direct basis in the patent as granted.

The granted patent was not opposed on the ground of added subject-matter, Article 100(c) EPC, therefore amendments made in opposition can only be examined (under Article 101(3) EPC) for the requirements of Article 123(2) EPC in so far as the amendments are concerned *per se* and a resultant objection under that

Article could not already have been raised against the granted patent. The straightforward combination of granted claims in accordance with their dependencies is per se unobjectionable under Article 123(2) EPC. The appealed decision's finding of added subject-matter, section 15, due to a combination of claims that did not depend on each other, and introduction of isolated features from the description therefore no longer holds.

2.2 Rule 80 EPC

By incorporating features from dependent claims claim 1 the subject-matter of claim 1 has been limited significantly vis-a-vis that of claim 1 as granted. Thus the claimed article now includes, among others, the further important limitation of a base material having a holding sheet. Such an amendment in substance is more than mere clarification or correction, and the Board is satisfied that this amendment is occasioned by a ground for opposition under Article 100(a), as the appellant has argued, and is thus now allowable under Rule 80 EPC.

2.3 Article 84 in conjunction with Rule 43(2) EPC

The amended claims now include only a single independent claim 1. Therefore the appealed decision's finding, section 14, of a non-justified plurality of independent claims in the same category, (lack of conciseness) also no longer applies. This is irrespective of whether or not Rule 43(2) EPC is indeed applicable at all in opposition proceeding, cf. the Case Law of the Boards of Appeal, 7th edition, 2013, IV.D.4.4.3, and in particular T263/05 (OJ 2008, 239) cited therein.

2.4 In conclusion, the amendments to the claims according to the main request successfully address the reasons upon which the decision under appeal is based. No further objections falling under Articles 84 and 123(2) EPC or Rule 80 EPC were raised by the respondents, and none are apparent to the Board.

3. Remittal

The decision under appeal considered only Rule 80 EPC, Article 123(2) EPC and Article 84 EPC with Rule 43(2) EPC, but did not consider the grounds of novelty (Article 54 EPC) and inventive step (Article 56 EPC) on which the two oppositions are based. In order to allow the appellant consideration of these remaining issues before the first instance, the Board considers it appropriate to exercise its discretion under Article 111(1) EPC by remitting the case to the department of first instance for further prosecution on the basis of the claims of the main request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

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

The Registrar: The Chairman:

G. Magouliotis A. de Vries

Decision electronically authenticated