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**Datasheet for the decision
of 15 March 2018**

Case Number: T 1934/14 - 3.3.03

Application Number: 04746711.3

Publication Number: 1641883

IPC: C08L101/14, C08K3/10,
A61F13/53, A61L15/60

Language of the proceedings: EN

Title of invention:

WATER ABSORBENT RESIN COMPOSTION AND PRODUCTION METHOD THEREOF

Patent Proprietor:

NIPPON SHOKUBAI CO., LTD.

Opponent:

Evonik Degussa GmbH

Relevant legal provisions:

EPC Art. 54

RPBA Art. 13(1), 13(3)

Keyword:

Late-filed argument - admitted (no)

Novelty - (main request: no)

Late-filed auxiliary requests - admitted (no)

Decisions cited:

G 0002/98, G 0001/03, G 0001/15, T 0231/01



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Case Number: T 1934/14 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 15 March 2018

Appellant: Evonik Degussa GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 24 June 2014
rejecting the opposition filed against European
patent No. 1641883 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman D. Semino
Members: O. Dury
C. Brandt

Summary of Facts and Submissions

I. The appeal by the opponent lies from the decision of the opposition division posted on 24 June 2014 rejecting the opposition lodged against European patent No. 1 641 883, which was granted in respect of European patent application 04 746 711.3, filed on 23 June 2004 as international application PCT/JP2004/009242 and claiming priority from JP 2003180121 (dated 24 June 2003; hereinafter referred to as P1) and JP 2003328635 (dated 19 September 2003; hereinafter referred to as P2).

II. Claims 1 and 7 of the granted patent, which are the sole granted claims relevant for the present decision, read as follows:

"1. A water absorbent resin composition, comprising a particulate water absorbent resin (A) having a cross-linking structure obtained by polymerizing an unsaturated monomer containing an acid group, said particulate water absorbent resin (A) being cross-linked in a vicinity of a surface of the water absorbent resin (A) by a surface cross-linking agent, wherein:

the water absorbent resin composition contains 95 wt % or more of particles whose particle diameter is less than 850 μm and not less than 106 μm , and a weight average particle diameter of the particles is less than 500 μm and not less than 300 μm , and a logarithmic standard deviation ($\sigma\zeta$) of a particle size distribution of the water absorbent resin composition is 0.45 or less, and the water-soluble component is 35 wt % or less, and the water absorbent resin composition includes a multivalent metal component, and an

extraction rate of the multivalent metal component is 5.0 wt % or more and less than 100 wt %."

In the present decision, the above features of granted claim 1 related to the water-soluble component and to the extraction rate of the multivalent metal component will be referred to as features 1.5 and 1.7, respectively, as indicated on page 3 of the contested decision and used by the parties throughout the proceedings.

"7. A method for producing a water absorbent resin composition according to claim 1, comprising the steps of: adding a solution of an aqueous multivalent metal compound (B) to a particulate water absorbent resin (A), having a cross-linking structure obtained by polymerizing an unsaturated monomer containing an acid group, which is cross-linked in a vicinity of a surface of the particulate water absorbent resin (A) by a surface cross-linking agent; and mixing the solution of the aqueous multivalent metal compound (B) with the particulate water absorbent resin (A), wherein:

the particulate water absorbent resin (A) contains 95 wt % or more of the particles whose particle diameter is less than 850 μm and not less than 106 μm , and a weight average particle diameter of the particles is less than 500 μm and not less than 300 μm , and a logarithmic standard deviation (σ_z) of a particle size distribution of the particulate water absorbent resin (A) is 0.45 or less, and the water-soluble component is 35 wt % or less, and an amount of a multivalent metal component contained in the solution of the aqueous multivalent metal compound (B) is 0.001 to 10 wt % with respect to the particulate water absorbent resin (A), and

a concentration of the aqueous multivalent metal compound (B) in the solution is 0.40 or more with respect to a saturated concentration, of the aqueous multivalent metal compound (B) in the solution, and temperature of the particulate water absorbent resin (A) is 50°C or higher and lower than 100°C, and/or temperature of the solution of the aqueous multivalent metal compound (B) is 30°C or higher and lower than 100°C."

- III. A notice of opposition to the patent was filed requesting revocation of the patent in its entirety.
- IV. In the contested decision the following documents were *inter alia* cited:

D1: WO 2005/027986

D8: English translation of P1

D9: English translation of P2

In that decision the opposition division held *inter alia* that the patent in suit satisfied the requirements of sufficiency of disclosure, whereby it was stated that the issue of implicitness of features 1.5 or 1.7 *inter alia* put forward by the opponent concerned novelty and not sufficiency (section 4.1.2 in the middle of page 10). The opposition division further considered that since feature 1.5 of granted claim 1 had no basis in the translated priority documents, the priority date for feature 1.5 was the filing date of the patent in suit (section 4.1 at the bottom of page 10 of the decision). Also, the subject-matter of granted claim 1 was novel over D1, in particular over example 4 thereof. In particular, since the processing conditions and the nature and/or amount of cross-linking agent and/or multivalent metal compound used in

examples 5 and 6 of the patent in suit and in example 4 of D1 were different, it could not be assumed that the process of example 4 of D1 inevitably led to a product achieving features 1.5 and 1.7 according to granted claim 1 (section 4.2 of the decision).

- V. The opponent (appellant) lodged an appeal against the above decision and requested that the decision of the opposition division be set aside and the patent be revoked. Also, the reimbursement of the appeal fee was requested.
- VI. In the reply to the statement of grounds of appeal the patent proprietor (respondent) requested that the appeal be dismissed (main request) or, alternatively, that the patent be maintained in amended form according to any of auxiliary requests 1 to 3 of 4 April 2014 or auxiliary requests 4 to 6 of 23 May 2016.
- VII. In a communication issued by the Board on 12 October 2017, issues to be discussed at the oral proceedings were specified.

Regarding priority, it was in particular indicated that, since the written submissions of the respondent in respect of priority failed to set out expressly all the facts, arguments and evidence relied upon, they did not meet the requirements set out in Article 12(2) RPBA and for this reason were not taken into account by the Board (section 8.1.2).

Also, it was noted that it was not contested that example 4 of D1 was entitled to the priorities claimed by D1 so that example 4 of D1 appeared to constitute a valid prior art pursuant to Article 54(3) EPC (section 8.1.3). Further considering that example 4 of

D1 was carried out according to the general teaching of the description of the patent in suit and assuming that sufficiency of disclosure be acknowledged, it appeared that features 1.5 and 1.7, which were missing in D1, could be considered as being implicitly disclosed in example 4 of D1 (section 8.1.4).

- VIII. With letter of 21 December 2017 the appellant submitted new arguments, in particular a new novelty objection against granted claim 1 in respect of example 11 of D1.
- IX. With letter of 15 February 2018 the respondent submitted an additional auxiliary request 1, whereby the former auxiliary requests 1 to 6 were renumbered as auxiliary requests 2 to 7.

Claim 1 of said auxiliary request 1 differed from granted claim 1 in that it contained a disclaimer directed to the composition prepared in example 4 of D1.

- X. Oral proceedings were held on 15 March 2018 in the presence of both parties. During the oral proceedings, the appellant withdrew its request for the reimbursement of the appeal fee. Also, the respondent filed new auxiliary requests 1 and 2, whereby the then pending auxiliary requests 1 to 7 filed with letter of 15 February 2018 were all withdrawn.

Claim 1 of auxiliary request 1 read as follows:

1. A water absorbent resin composition, comprising a particulate water absorbent resin (A) having a cross-linking structure obtained by polymerizing an unsaturated monomer containing an acid group, said particulate water absorbent resin (A) being cross-linked in a vicinity of a surface of the water absorbent resin (A) by a surface cross-linking agent, wherein:

the water absorbent resin composition contains 95 wt % or more of particles whose particle diameter is less than 850 μm and not less than 106 μm , and a weight average particle diameter of the particles is less than 500 μm and not less than 300 μm , and a logarithmic standard deviation (σ_z) of a particle size distribution of the water absorbent resin composition is 0.45 or less, and the water-soluble component is 35 wt % or less, and the water absorbent resin composition includes a multivalent metal component, and an extraction rate of the multivalent metal component is 5.0 wt % or more and less than 100 wt %,

with the proviso that the water absorbent composition is excluded, obtained by mixing an aqueous solution which contained 1.5 g of aluminum sulfate 14-18 water and 1.6 g of deionized water thoroughly with 100 g of the water-absorbing resin particles obtained in the following manner:

in a reactor vessel which was composed of a lid and a twin-arm type stainless kneader, content volume of 10 liters, jacketed and provided with two sigma blades, a reaction liquid was prepared by dissolving 11.9 g, being 0.1 mol%, of polyethyleneglycol diacrylate and 3.65 g of disodium hydrogenphosphite pentahydrate in 5432 g of an aqueous solution of sodium acrylic acid, the aqueous solution had monomer concentration of 39 wt% and a neutralization ratio of 71 mol%, then, the reaction liquid was deaerated for 30 minutes under a nitrogen gas atmosphere, then, 29.36 g of a 10 wt% sodium persulfate aqueous solution and 24.47 g of a 0.1 wt% L-ascorbic acid aqueous solution were added to the reaction liquid with stirring, about one minute later, polymerization started, the polymerization was carried out at a temperature in a range of 20 °C to 95 °C while crushing gels generated via the polymerization, after 30 minutes from the start of the polymerization, a hydrogel cross-linked polymer was removed from the reactor vessel, the hydrogel cross-linked polymer thus obtained were in a form of small pieces having a diameter of less than or equal to about 5 mm, the small pieces of hydrogel cross-linked polymer were spread on a 50-mesh metal wire, mesh size: 300 μm , and was dried by hot air of 180 °C for 50 minutes, the water-absorbing resin obtained was crushed with a roll mill and classified with JIS standard sieves of mesh sizes of 600 μm and 150 μm so as to adjust a particle size distribution of the water-absorbing resin, 100 g of the hydrogel cross-linked polymer was mixed with an aqueous solution which contained 1.0 g of ethylene glycol and 2.5 g of deionized water, the mixture was subjected to a heat treatment by which the mixture was kept at 210 °C for 20 minutes, after that, the mixture was cooled down to 60 °C, after that, the mixture was passed through the JIS standard sieve whose mesh size was 600 μm in order to obtain the water-absorbing resin particles;

the mixture was dried at 60 °C for 30 minutes, after that, the mixture was passed through the JIS standard sieve whose mesh size was 600 μm,
and

with the proviso that the water absorbent composition is excluded, obtained by mixing an aqueous solution which contained 0.6g of propylene glycol, 1.0g of aluminum sulfate 14-18 water, and 1.5g of deionized water with 100g of the water-absorbing resin obtained in the following manner:

the polymerization and drying were carried out as follows:

in a reactor vessel which was composed of a lid and a twin-arm type stainless kneader, content volume of 10 liters, jacketed and provided with two sigma blades, a reaction liquid was prepared by dissolving 17.87 g, being 0.15 mol%, of polyethyleneglycol diacrylate and 3.65 g of disodium hydrogenphosphite pentahydrate in 5425 g of an aqueous solution of sodium acrylic acid, the aqueous solution had monomer concentration of 39 wt% and a neutralization ratio of 71 mol%, then, the reaction liquid was deaerated for 30 minutes under a nitrogen gas atmosphere, then, 29.36 g of a 10 wt% sodium persulfate aqueous solution and 24.47 g of a 0.1 wt% L-ascorbic acid aqueous solution were added to the reaction liquid with stirring, about one minute later, polymerization started, the polymerization was carried out at a temperature in a range of 20 °C to 95 °C while crushing gels generated via the polymerization, after 30 minutes from the start of the polymerization, a hydrogel cross-linked polymer was removed from the reactor vessel, the hydrogel cross-linked polymer thus obtained were in a form of small pieces having a diameter of less than or equal to about 5 mm, the small pieces of hydrogel cross-linked polymer were spread on a 50-mesh metal wire, mesh size: 300 μm, and was dried by hot air of 180 °C for 50 minutes,

the water-absorbing resin obtained was pulverized with the roll mill and was classified with JIS standard sieves whose mesh sizes were 850μm and 150μm, so as to adjust the particle size distribution of the water-absorbing resin, 100g of the water-absorbing resin was mixed with an aqueous solution which contained 0.6g of propylene glycol, 1.0g of aluminum sulfate 14-18 water, and 1.5g of the deionized water, the mixture was subjected to a heat treatment by which the mixture was kept at 190°C for 30 minutes, after that, the mixture was cooled down to 60°C, after that, the mixture was passed through the JIS standard sieve whose mesh size was 850μm in order to obtain the water-absorbing resin.

Claim 1 of auxiliary request 2 read as follows:

1. A water absorbent resin composition, comprising a particulate water absorbent resin (A) having a cross-linking structure obtained by polymerizing an unsaturated monomer containing an acid group, said particulate water absorbent resin (A) being cross-linked in a vicinity of a surface of the water absorbent resin (A) by a surface cross-linking agent, wherein:

the water absorbent resin composition contains 95 wt % or more of particles whose particle diameter is less than 850 μm and not less than 106 μm , and a weight average particle diameter of the particles is less than 500 μm and not less than 300 μm , and a logarithmic standard deviation ($\sigma\zeta$) of a particle size distribution of the water absorbent resin composition is 0.45 or less, and the water-soluble component is 35 wt % or less, and the water absorbent resin composition includes a multivalent metal component, and an extraction rate of the multivalent metal component is 5.0 wt % or more and less than 100 wt %

with the proviso that a water absorbent resin composition is excluded having the following particle size distribution:

greater than or equal to 850 μm :	0.0 wt%
850-710 μm	0.0 wt%
710-600 μm	0.0 wt%
600 – 500 μm	3.0 wt%
500 – 425 μm	17 wt%
425 – 300 μm	35.6 wt%
300 – 212 μm	27.4 wt%
212 – 150 μm	13.2 wt%
150 – 45 μm	3.7 wt%
less than or equal to 45 μm	0.1 wt%
total	100.0 wt%

and the further parameters

weight average particle diameter D50	315 μm
particles with diameter of 850-150 μm	96.2 wt%
$\sigma\zeta$	0.37.

and

with the proviso that a water absorbent resin composition is excluded having the following particle size distribution:

greater than or equal to 850 μm :	0.0 wt%
850-710 μm	2.2 wt%
710-600 μm	26.8 wt%
600 – 500 μm	16.6 wt%

500 – 425 µm	14.6 wt%
425 – 300 µm	22 wt%
300 – 212 µm	11.1 wt%
212 – 150 µm	4.5 wt%
150 – 45 µm	2.1 wt%
less than or equal to 45 µm	0.1 wt%
total	100.0 wt%
and the further parameters	
weight average particle diameter D50	476 µm
particles with diameter of 850-150 µm	97.8 wt%
σ_z	0.40.

XI. The appellant's arguments, as far as relevant to the present decision, were essentially as follows:

Main request - Novelty

(a) The opposition division's conclusion according to which granted claim 1 did not benefit from any of the priority dates of the patent in suit was not contested in the respondent's written submissions, in particular in its reply to the statement of grounds of appeal. The fact that decision G 1/15 (OJ EPO, 2017, A82) had not been published at that moment was not relevant, since the issue of partial priority was known from former T decisions. Besides, since the issue of priority was identified in the Board's communication which had been sent well in advance of the oral proceedings, there was no justification for providing new arguments regarding priority only at the oral proceedings. In view of the above, the new arguments in respect of priority put forward by the respondent for the first time during the oral proceedings before the Board should not be admitted into the proceedings.

(b) Example 4 of D1 was carried out according to the teaching of the patent in suit and to the process of granted claim 7. Also, it was carried out in a very similar manner to examples 1-4 of the patent in suit, in particular example 4. It was further derivable from Referential examples 1-4 of the patent in suit that feature 1.5 depended on the amount of primary crosslinker used and in that respect, example 4 of D1 was carried out using the same amount of moles of crosslinker as in examples 1-4 of the patent in suit. The concentration of the multivalent metal compound composition used in example 4 of D1 was 48 wt.%, which was in line with the teaching of the patent in suit and with granted claim 7. The fact that feature 1.7 was indeed satisfied in example 4 of D1 was never contested by the respondent and it was shown by the appellant that that feature depended on the concentration of the multivalent metal component used and on the amount of fine particles, whereby both features were comparable in example 4 of D1 and in examples 1-4 of the patent in suit. There was neither evidence on file, nor indication in the patent in suit that the nature of the mill used to crush the particulate water absorbent resin had any impact on features 1.5 and 1.7. Further taking into account that the nature of the mill was not reflected in granted claim 1, the fact that different mills were used in example 4 of D1 and in examples 1-4 did not confer novelty to the subject-matter of granted claim 1. It should further be taken into account that since D1 was a document of the respondent, it would have been easy for the respondent to provide the missing values of features 1.5 and 1.7 in respect of example 4 of D1, which was not done. In view of the above, should

the patent in suit satisfy the requirements of sufficiency of disclosure, then the water absorbent resin composition prepared in example 4 of D1 was bound to satisfy features 1.5 and 1.7.

- (c) The same was valid regarding example 11 of D1, which was carried out in a very similar to example 5 of the patent in suit.

Auxiliary requests 1 and 2 - Admittance

- (d) The issue of novelty over example 4 of D1 was at stake already in opposition proceedings and also objected to in the statement of grounds of appeal. Novelty over example 11 of D1 was submitted for the first time with letter of 21 December 2017. Therefore, there was no reason justifying why auxiliary requests 1 and 2 had not been submitted earlier. In that respect, already auxiliary request 1 filed with letter of 15 February 2018, which contained a disclaimer in respect of example 4 of D1 only, was filed too late.
- (e) In view of the length of the disclaimer introduced in claim 1 of each of auxiliary requests 1 and 2, it could not be expected that the appellant assessed for the first time during the oral proceedings whether or not they were allowable. In particular, a requirement of G 1/03 (OJ EPO, 2004, 413) for the allowability of disclaimers was that they should be limited to the novelty destroying subject-matter. The assessment of that criteria was in the present case particularly difficult to make.
- (f) For those reasons, auxiliary requests 1 and 2 should not be admitted into the proceedings.

XII. The respondent's arguments, as far as relevant to the present decision, may be summarised as follows:

Main request - Novelty

(a) Since the validity of priority was a key issue for the present case, it could be discussed at any stage of the proceedings, in particular at the oral proceedings before the Board, which was done in the present case.

Regarding the right to priority, the EPC did not require explicitly identity between the disclosures of the priority document and of the subject-matter being claimed, but only that both referred to the same invention. In the present case, granted claim 1 was related to the same invention as D8/P1. The fact that granted claim 1 could benefit from the priority date of D8/P1 was also derivable from the catchword and section 5.3 of G 1/15. In that respect, G 1/15 was a recent decision so that it could not have been addressed earlier.

For those reasons, granted claim 1 benefited from the priority D8/P1 and D1 was not a valid prior art for that claim.

(b) Should D1 be held to constitute a valid prior art, it was undisputed that there was no explicit disclosure of features 1.5 and 1.7 for example 4 of D1. The appellant's objection was based on the argument that similar experimental procedures were used in example 4 of D1 and in the examples of the patent in suit. However, those examples differed in the nature of the mill which was used to crush the

particulate water absorbent resin. Also, comparative example 3 of the patent in suit showed that it could not be excluded that water absorbent resin compositions satisfied all the features mentioned in granted claim 1 apart from feature 1.7. Therefore, there remained doubts whether example 4 of D1 indeed satisfied features 1.5 and 1.7 of granted claim 1. Since according to T 231/01 (not published in OJ EPO; see section 5.6) for the assessment of novelty there was no room for speculation regarding whether or not parameters specified in a claim were met, the subject-matter of granted claim 1 was novel over example 4 of D1.

(c) The same was valid for example 11 of D1.

Auxiliary requests 1 and 2 - Admittance

(d) Auxiliary requests 1 and 2 both aimed at overcoming the novelty objections in view of examples 4 and 11 of D1 retained by the Board by using disclaimers directed to those specific examples.

(e) The auxiliary requests were submitted at the first opportunity and in direct reaction to the Board's conclusion in respect of D1, whereby the appellant's objection only became clear to the respondent shortly before the oral proceedings. In particular, disclaimers over examples 4 and 11 of D1 only became possibly necessary in view of the Board's communication and at the oral proceedings, respectively.

The disclaimers neither affected much the scope of the claims, nor the discussion of the substantive

issues. Considering that an auxiliary request comprising a disclaimer of example 4 of D1, which was very similar to the one of auxiliary request 1, was submitted with letter of 15 February 2018, i.e. one month before the oral proceedings, the appellant should not be surprised.

(f) For those reasons, auxiliary requests 1 and 2 should be admitted into the proceedings.

XIII. The appellant requested that the decision under appeal be set aside and that European patent No. 1 641 883 be revoked. It also requested that auxiliary requests 1 and 2 filed during the oral proceedings be not admitted into the proceedings. The appellant further requested that documents E7 and D22 to D25 be admitted into the proceedings and that the decision of the opposition division not to admit D14 to D21 be overturned.

The respondent requested that the appeal be dismissed and that the patent be maintained as granted (main request), or, alternatively, that the patent be maintained in amended form according to either auxiliary request 1 or 2, both requests filed during the oral proceedings. It further requested that E7 and D22 to D25 be not admitted into the proceedings, and that, should E7 and D25 or D14 be admitted into the proceedings that the case be remitted to the first instance. The respondent also requested that the decision of the opposition division not to admit D14 to D21 be confirmed.

Reasons for the Decision

Main request (patent as granted)

1. Priority

- 1.1 The patent in suit is based on an European application filed as an international application on 23 June 2004 and claiming two priorities P1 dated 24 June 2003 (D8) and P2 dated 19 September 2003 (D9).

D1 is a WO application in English which was filed on 17 September 2004, published on 31 March 2005, i.e. after the filing date of the application on which the patent in suit is based, and which claims two priorities P'1 (JP 2003-329109) and P'2 (JP 2003-329110), both dated 19 September 2003 (i.e. the same date as P2).

Therefore D1 is at most relevant for novelty pursuant to Article 54(3) EPC, namely only if the subject-matter of granted claim 1 does not benefit from any of the priority P1 or P2.

- 1.2 In the contested decision, the opposition division concluded that none of the priorities (P1 and P2) claimed by the patent in suit could be acknowledged (see section 4.1 of the reasons on page 10).
- 1.3 In its reply to the statement of grounds of appeal the respondent requested that its arguments in respect of priority of the patent in suit submitted during the opposition proceedings be considered (letter of 19 March 2015: section 5.1). However, no details of the

argumentation were given, nor was it explained why the conclusion reached by the opposition division was incorrect. In those circumstances, those submissions of the respondent in respect of priority fail to set out expressly all the facts, arguments and evidence relied upon. As a consequence they do not meet the requirements set out in Article 12(2) RPBA and for this reason are not taken into account by the Board, as was indicated in the Board's communication (see section VII above).

1.4 In its letter dated 15 February 2018 the sole arguments provided by the respondent in respect of priority was that example 4 of D1 was covered by the examples of P1 and/or P2 and could, thus, not be novelty destroying (letter of 15 February 2018: section 4.2). That line of argumentation is, thus, not directed to the entitlement to priority of granted claim 1 as was argued for the first time during the oral proceedings.

1.5 Since no further arguments regarding priority were put forward in writing by the respondent, it was only during the oral proceedings before the Board that the respondent submitted for the first time the line of arguments according to which granted claim 1 benefited from the priority date of P1/D8. Therefore, the submission of those arguments during the oral proceedings before the Board constitutes an amendment to a party's case and its admission to the proceedings is subject to the Board's discretion (Article 13(1) RPBA) and underlies the additional stipulations of Article 13(3) RPBA.

1.5.1 In that respect, it cannot be agreed with the respondent that any crucial issue, here the right to priority, may be addressed at any time during the

proceedings by the parties. This would not only be contrary to the stipulations of Article 12(2) RPBA, according to which the appellant should submit a complete case in its statement of grounds of appeal, but it would also not satisfy the requirements of due process (efficient conduct of the proceedings) and the need for economy of the proceedings (Article 13(1) RPBA). Besides, according to the case law, it is a matter for each party to submit all facts, evidence, arguments and requests relevant for the enforcement or defence of his rights as early and completely as possible, in particular in *inter partes* proceedings in order to act fairly towards the other party and, more generally, to ensure due and swift conduct of the proceedings (Case Law of the Boards of Appeal of the EPO, 8th edition, 2016, IV.E.4.1.2 and 4.1.4). This is particularly true in a case like the present one where the relevant objections were known from the beginning of the appeal proceedings. Therefore, the respondent's argument is rejected.

- 1.5.2 The sole justification provided by the respondent why the arguments regarding priority of granted claim 1 were put forward for the first time during the oral proceedings was that they were based on decision G 1/15, which was very recent. However, since that decision was taken and made available on 29 November 2016 and published in September 2017 (OJ EPO 2017, A82), it could have been taken into account by the respondent earlier, in particular in direct reply to the Board's communication (dated 12 October 2017) or in the respondent's letter of 15 February 2018 (in which decision G 1/15 was indeed cited but in support of a different line of argumentation). Therefore, the respondent's argument is

not convincing.

1.5.3 Besides, admitting into the proceedings the new line of arguments regarding the validity of the claimed priority for granted claim 1 would have required to deal with new and complex issues for the first time during the oral proceedings (e.g. partial priority; validity of D8/P1, even if it apparently does not explicitly disclose any determination method for feature 1.5, as briefly disputed by the parties during the oral proceedings before the Board), which, in the Board's view, would have required a postponement of the oral proceedings in order to give sufficient time to the appellant to prepare a suitable line of counterarguments, which is contrary to the stipulations of Article 13(3) RPBA.

1.5.4 For those reasons, the Board finds it appropriate to exercise its discretion under Article 13(1) RPBA and its power under Article 13(3) RPBA by not admitting into the proceedings the new line of arguments regarding the validity of the claimed priority.

1.6 As a consequence, there is no reason to deviate from the conclusion of the opposition division according to which granted claim 1 as a whole does not benefit from any of the priority dates of P1 and/or P2.

2. Novelty over D1

2.1 The novelty objections put forward by the appellant are based on examples 4 and 11 of D1.

2.2 The respondent argued that examples 1 to 5 of the patent in suit were disclosed in the priority documents P1 or P2, so that priority was at least valid for those

examples. Therefore, the respondent considered that the priorities of the patent in suit were also valid for a composition according to example 4 of D1 since it was substantially identical to those examples of the patent in suit, the consequence being that example 4 of D1 could not be a valid prior art (see in particular letter of 15 February 2018: section 4.2).

In view of the above, the respondent's objection is based on the argument that example 4 of D1 is "substantially identical" to some of the examples of the patent in suit covered by the priority documents, but the respondent never argued that example 4 of D1 was identical to any of the examples of P1 and/or P2. However, according to G 2/98 (OJ EPO 2001, 413), priority pursuant to Article 87(1) EPC may be acknowledged to a subsequent application for the same subject-matter as in a previous application only if the skilled person can derive that subject-matter directly and unambiguously, using common general knowledge, from the previous application as a whole (see headnote and sections 2, 3, 6.8, 8.2 and 9 of the reasons). In that respect, it is in particular explained in G 2/98 that the concept of "the same invention" is to be interpreted narrowly and to be equated with the concept of "the same subject-matter".

As a consequence, since example 4 of D1 was not shown to be identical to any of the examples of P1 and P2, i.e. those examples do not concern "the same subject-matter", it cannot be concluded that its subject-matter is directly and unambiguously disclosed in P1 or P2. Therefore, the respondent's argument according to which example 4 of D1 could not be a valid prior art pursuant to Article 54(3) EPC is rejected.

2.3 Since it was not contested by the respondent that examples 4 and 11 of D1 were entitled to the priorities claimed by D1 and further considering the conclusions reached in above sections 1 and 2.2, examples 4 and 11 of D1 are valid prior art disclosures pursuant to Article 54(3) EPC.

2.4 Example 4 of D1 (page 123) discloses the treatment of water-absorbing particles (E1) with a solution of aluminium sulfate, whereby (E1) are water-absorbing resin particles obtained from acrylic acid which is internally crosslinked and which is further surface crosslinked (example 1 of D1, pages 119-120). It may further be derived from the data indicated in Table 2 of D1 (page 130) that the water absorbent resin composition prepared in example 4 of D1 satisfies all the requirements of granted claim 1 apart from features 1.5 and 1.7, which are not specifically indicated in D1.

Besides, example 4 of D1 was carried out according to the general teaching of the patent in suit, in particular regarding

- the nature of the internally crosslinked water-absorbing particles (paragraphs 39-42, 46);
- the surface crosslinking of said particles (paragraphs 58-65);
- the treatment of the above surface crosslinked particles with a solution of a multivalent metal component (paragraphs 66, 67, 95-104, 109-115; examples 1-4; granted claim 7). In that respect, it was in particular not contested by the respondent that the solution concentration of the multivalent metal compound (B) was in accordance with the teaching of paragraphs 97, 99, 109 and 114 of the patent in suit, in which it is indicated that said

concentration should be in a specific range in order to carry out the invention. The appellant's argument, according to which the concentration of the multivalent metal compound composition used in example 4 of D1 is 48 wt.% (see notice of opposition: page 13, last paragraph of section 3.1.3.1; the same argument was put forward at the oral proceedings before the Board), i.e. according to granted claim 7 and paragraph 99 of the patent in suit, was also not contested.

- 2.5 It is further conspicuous that example 4 of D1 was carried out in a very similar manner to examples 1-4 of the patent in suit, in particular example 4 (e.g. compare the particle size features of example 4 in the table at page 28 of the patent in suit with those of example 4 in table 2, page 130 of D1; see also the multivalent metal concentration of 48 % in example 4 of D1 and of 51.2 % indicated as feature A in table 2 of the patent in suit).

In that respect, although it is correct that example 4 of D1 and examples 1-4 of the patent in suit differ in the nature of the mill which was used to crush the water absorbent particles (vibrating or pin mill in examples 1-4 of the patent in suit: page 24, lines 24, 45, 55 and page 25, line 17; roll mill in example 4 of D1: page 120, line 10), it was not shown by the respondent that the nature of said mill had any impact on the properties of the water absorbent particles (in particular on features 1.5 and 1.7), nor is there any indication in the patent in suit that it plays any role. Also, said feature was not shown to be reflected in any way in granted claim 1. Therefore, the respondent's argument relying on the nature of said

mill is rejected.

2.6 Regarding comparative example 3 of the patent in suit, which was argued by the respondent as showing that it was possible to prepare water absorbent compositions according to the teaching of the patent in suit and exhibiting all the features of granted claim 1 apart from feature 1.7, it is noted that said example was not carried out using the same procedure as in example 1 of D4 and/or examples 1-4 or claim 7 of the patent in suit: whereas it was prepared by simultaneous mixing of the surface crosslinker and of the metal component (paragraph 178 of the patent in suit), the processes of examples 1-4 of the patent in suit and of example 4 of D1 both comprise first preparing the internally and surface crosslinked water absorbent particles (referential examples 1 and 4 of the patent in suit; example 1 of D4) and then adding/mixing the multivalent metal component (examples 1-4 of the patent in suit; example 4 of D1). In that respect, the respondent himself argued that processes differing from each other in that manner resulted in different compositions (see letter of 19 March 2015: section 5.2, second to fourth paragraph), which was not contradicted by the appellant. Therefore, it cannot be concluded from comparative example 3 of the patent in suit that the preparation procedure used in example 4 of D1 may lead to particles not satisfying feature 1.7 of granted claim 1, contrary to the respondent's view.

2.7 In view of the above, the respondent has neither provided evidence, nor put forward any convincing arguments which could explain why features 1.5 and 1.7 of granted claim 1 would not be satisfied in example 4 of D1, although said example was carried out according to the teaching of the patent in suit and in a very

similar manner to examples of the patent in suit. Moreover the respondent constantly argued that sufficiency of disclosure was given, as was also decided by the opposition division, which also points to the conclusion that features 1.5 and 1.7 are met in example 4 of D1.

- 2.8 In addition, although the issue of novelty over example 4 of D1 was at stake during the whole opposition and appeal proceedings, the respondent has decided not to provide any information in respect of the missing features 1.5 and 1.7, whereby there appears to be no reason why this would not have been possible, since D1 is a document of the respondent himself.
- 2.9 In particular in view of the above, considering that example 4 of D1 was carried out according to the teaching of the patent in suit and in a very similar way to the examples of the patent in suit by the respondent himself, it would have been the duty of the respondent to provide the data relative to the two features. The deliberate choice to keep them secret, when all informations on file point to the conclusion that the features are met, cannot result in a decision in favour of the respondent.
- 2.10 In view of this, it has to be concluded that following the teaching of the patent in suit and its examples, as was indeed done in example 4 of D1, must lead to water absorbent compositions according to granted claim 1.
- 2.11 It is correct that, as indicated in T 231/01 (section 5.6), there should be no room for speculation when assessing novelty. In particular, in the passage of that decision relied upon by the respondent, it is indicated that the criteria for assessing novelty is

not based on likeliness, but on identity of technical information between the content of the prior art disclosure and the subject-matter claimed. However, in the present case, the respondent has not provided any evidence or argument to refute the conclusion reached from the technical analysis of all the facts on file and according to which example 4 of D1 must satisfy features 1.5 and 1.7 of granted claim 1 (see sections 2.3 to 2.10 above), when all information to do this were fully in its hands. In arriving at its conclusion, the Board does not consider that it deviates from the criteria of "identity of technical information" indicated in section 5.6 of T 231/01. In particular, the Board did not consider that it was "likely" that features 1.5 and 1.7 may be satisfied in example 4 of D1, but rather arrived at the conclusion that all the facts on file show that those features have to be met and that no evidence or convincing argument was provided by the respondent to refute that conclusion, even if the data were in its hands. Therefore, the respondent's argument is rejected.

2.12 The same conclusion as for example 4 of D1 is reached in respect of example 11 of D1 (page 137, referring to example 8 on page 135; Table 6, page 143), in particular taking into account the teaching of the patent in suit and the similarity between example 11 of D1 and example 5 of the patent in suit. Also in that respect, no evidence or convincing argument was advanced by the respondent to explain or at least render plausible why features 1.5 and 1.7 would be not satisfied in example 11 of D1, when all the information was in its hands.

2.13 For those reasons, the subject-matter of granted claim 1 is not novel over examples 4 and 11 of D1.

Auxiliary requests 1 and 2

3. Admittance

3.1 Considering that auxiliary requests 1 and 2 were filed during the oral proceedings before the Board, their admittance to the proceedings underlies the stipulations of Article 13(1) and (3) RPBA.

3.2 The issue of novelty of granted claim 1 in view of example 4 of D1 was at stake throughout both the opposition and the appeal proceedings and was in particular identified as a possibly relevant issue in the Board's communication, which was sent well in advance of the oral proceedings.

Although the issue of novelty of granted claim 1 in view of example 11 of D1 was first raised in the appellant's last written submission dated 21 December 2017, the respondent did not react to that objection before the day of the oral proceedings before the Board and only after a decision on granted claim 1 was announced. In particular, said objection was not at all considered in the respondent's last written submission dated 15 February 2018.

In that respect, no justification was provided by the respondent to explain why auxiliary requests 1 and 2 were first submitted at the very last opportunity, which, as explained above (see section 1.5.1) is neither in accordance with the stipulations of Article 12(2) RPBA, nor satisfies the requirements of due process and the need for economy of the proceedings.

3.3 Besides, admitting any of auxiliary requests 1 or 2 to the proceedings would have raised new and complicated issues regarding e.g. the following points:

- How should the disclaimer be formulated in order not to remove more than is necessary to restore novelty over D1 (see headnote of G 1/03: section 2.2)?
- Considering the length of the disclaimer in both auxiliary requests, does it satisfy the requirements of clarity and conciseness indicated in section 2.4 of the headnote of G 1/03?

Under those circumstances, the appellant should have been provided with sufficient time to prepare appropriate lines of argument, whereby it is credible that he would not have been in a position to defend its case at the oral proceedings before the Board. Therefore, admitting any of auxiliary requests 1 or 2 into the proceedings would have required an adjournment of the oral proceedings, which goes against the stipulations of Article 13(3) RPBA.

3.4 For those reasons, the Board finds it appropriate to exercise its discretion under Article 13(1) RPBA and its power under Article 13(3) RPBA by not admitting auxiliary requests 1 and 2 into the proceedings.

4. Documents E7 and D14 to D25 are not relevant for the present decision. Therefore, there is no need for the Board to elaborate any further on their admittance, which was in dispute between the parties (see section XIII).

5. The main request being not allowable and auxiliary requests 1 and 2 being not admitted into the proceedings, the patent is to be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. European patent No. 1641883 is revoked.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated