

Publication in the Official Journal Yes / No

File Number: T 386/90 - 3.3.2

Application No.: 85 201 193.1

Publication No.: 0 205 674

Title of invention: Hydrogel-forming polymer compositions for use in absorbent structures

Classification: A61L 15/00

D E C I S I O N
of 26 February 1992

Applicant: THE PROCTER & GAMBLE COMPANY

Headword: Hydrogel/PROCTER

EPC Articles 83, 84, 123(2) and Rule 86(2)

Keyword: "Addition of subject-matter (no) - Deletion of incorrect figures wrongly given - Correct method of measurement"
"Sufficiency of disclosure (yes)"

Headnote



Case Number : T 386/90 - 3.3.2

**D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 26 February 1992**

Appellant :

**THE PROCTER & GAMBLE COMPANY
One Procter & Gamble Plaza
Cincinnati
Ohio 45202 (US)**

Representative :

**Gibson, Tony Nicholas
Procter & Gamble (NTC) Limited
Whitley Road
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Decision under appeal :

**Decision of Examining Division of the European
Patent Office dated 26 May 1989 refusing European
patent application No. 85 201 193.1 pursuant to
Article 97(1) EPC.**

Composition of the Board :

**Chairman : P.A.M. Lançon
Members : I.A. Holliday
E.M.C. Holtz**

Summary of Facts and Submissions

- I. European patent application No. 85 201 193.1 (publication No. 0 205 674) was refused by a decision of the Examining Division.

- II. The grounds for the refusal were that the amendments requested by the Applicant in a communication received in the EPO on 13 July 1987 did not satisfy the requirements of Article 123(2) EPC. In addition, it was the opinion of the Examining Division that the amended application failed to disclose the invention in a manner sufficiently clear and complete to satisfy the requirements of Article 83 EPC.

- III. The Appellant lodged an appeal against the said decision. In the Statement of Grounds of Appeal, the Appellant argued that the method set out in the application to measure the shear modulus/gel strength values (pages 32 to 34) was in fact correct. The error relating to shear modulus values resulted from incorrect programming of the measuring apparatus which caused the values quoted in the worked examples of application to be half of the correct value. Reference was made to a declaration made by the inventors submitted on 2 January 1988 according to which the effect of defective computer software was to cause the computer to generate values of shear modulus which were "significantly lower" than the true shear modulus values.

Thus all the polymers prepared in fact satisfied the minimum value originally quoted in Claim 1 by a considerable margin. Accordingly, the effect of the proposed amendment was to restrict the scope of the monopoly claimed. It was the Appellant's view that since

the value of 3270 dynes/cm², which the Appellant sought to introduce into Claim 1, originally appeared in Example XII, albeit as an erroneous measurement, the requirements of Article 123(2) were satisfied.

The Appellant also argued that the amendment under Rule 86(2) was appropriate to correct an obscurity, quoting Guidelines C-VI 3.1 and 3.2.

Finally, the Appellant argued that since the method proposed to measure the shear modulus remains valid, the requirements of Article 83 would indeed be satisfied were the proposed amendments to be allowed.

IV. Oral proceedings took place on 26 February 1992. During the course of the said proceedings, the Appellant submitted an amended request that the application be remitted to the Examining Division on the basis of new claims in which the minimum values of the shear modulus were restored to the original values of 2000 dynes/cm² in Claims 1, 4 and 9 and a minimum of 2500 dynes/cm² in Claims 2 and 10. Claim 6 had been amended to remove the erroneous relationship which had originally appeared based on the description at the foot of page 17. Corresponding amendments were made to the description. The incorrect shear modulus values were deleted from Examples I to XVI and from Table II on page 52.

V. Claim 1 as submitted at the oral proceedings reads as follows:

"A substantially water-insoluble, slightly cross-linked, partially neutralized, hydrogel-forming polymer composition consisting essentially of:

- (a) from about 50 mole percent to 99.999 mole percent of polymerized unsaturated, polymerizable, acid group containing monomers; and
- (b) from about 0.001 mole percent to 5 mole percent of a cross-linking agent;

wherein said composition has a degree of neutralization of at least about 25 % and is substantially free of graft polymerizable polymer moieties; and further wherein said polymer composition, upon neutralization to a degree of neutralization of at least 50 %, has or would have a gel volume of at least 20 grams of synthetic urine per gram of hydrogel-forming polymer, a gel strength such that the hydrogel formed from said polymer exhibits a shear modulus of at least 2000 dynes/cm², an initial extractable polymer content, after one hour in synthetic urine, of no more than 7.5 % by weight of hydrogel-forming polymer, and an equilibrium extractable polymer content, at equilibrium in synthetic urine, of no more than 17 % by weight of hydrogel-forming polymer."

VI. The Appellant requests that the application be remitted to the Examining Division for resumption of the examination on the basis of claims and description outlined in point IV. above.

Reasons for the Decision

- 1. The appeal is admissible.
- 2. Article 123(2) EPC
 - 2.1 The Board cannot share the Examining Division's view that deleting the incorrect shear modulus values from the examples constituted a violation of Article 123(2) EPC. The Appellant has stated that the actual method described

on pages 32 to 34 of the published application, including the formula at the top of page 34, remains valid. The Board has no reason to question this statement. Thus, had one skilled in the art repeated any of the worked examples of the application, it would have become immediately obvious that the product had a shear modulus value considerably higher than that recorded in the specification. No difficulty would be encountered in determining the correct value. Accordingly, since the values given in the worked examples are now known to be meaningless, it is quite correct that they should be deleted, that is deemed never to have been present. Such a deletion does not contravene the requirements of Article 123(2).

- 2.2 Since the newly requested forms of Claims 1, 2, 4, 9 and 10 correspond to the originally filed versions of the said claims, there is no question of an offence against Article 123(2).
- 2.3 Claim 6 has been amended in order to delete the incorrect relationship involving the originally recorded shear modulus values. The new form of Claim 6 is based on the originally filed description on page 17, lines 23 to 25.
- 2.4 The amended description on pages 5, 6, 7 and 14 filed at the oral proceedings serves to adapt the description to Claims 1, 2, 4 and 9; it corresponds to the originally filed version of the same pages. Page 17 filed on 13 July 1987 corresponds to the amendment to Claim 6 noted in point 2.3 above.
- 2.5 The Board cannot accept the view expressed by the Examining Division in paragraph 5.4 of the decision. Deletion of one or more preferred features cannot lead to an addition of subject-matter, providing that said

features are not essential for the invention (cf. inter alia, T 133/85, OJ EPO 1988, 441 and T 331/87, OJ EPO 1991, 22).

2.6 The requirements of Article 123(2) EPC are accordingly satisfied.

3. Article 84 EPC

It does not follow, as a consequence of the deletion of the specific incorrect figures from the worked examples, that the original figure of 2000 dynes/cm² which appeared as the lower limit of the claimed range in the original version of the description and claims is also wrong. As the Appellant argues in the Statement of Grounds of Appeal, the correct shear modulus values of the examples would still exceed the originally quoted minimum but by a larger margin. The Board accordingly sees no reason why the original figure of 2000 dynes/cm² should not remain at this stage of the proceedings, i.e. as a basis for resuming the examination.

4. Article 83 EPC

In contradiction to the Examining Division's contention and as shown under point 2.1 above, it is the maintenance of the incorrect figures which might have caused confusion to the skilled man trying to repeat the examples and which would give rise to obscurities. On the contrary, with their deletion, the Board is satisfied that the requirements of Article 83 have been met. As indicated in point 2.1 above, the description and especially the worked examples contain sufficient information to allow the skilled person to prepare the polymers currently claimed. The description outlines the requirements of balancing the gel volume with the shear modulus together with clear

instructions as to how both properties should be measured.

5. As the requirements of Article 83, 84 and 123(2) EPC have now been satisfied, the reasons for the refusal of the application no longer exist. The case is accordingly remitted to the Examining Division with an order to resume the examination.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The file is remitted to the Examining Division with the order to resume examination of the basis of the following documents:

Claims: 1 to 20 as submitted at the oral proceedings,

Description: pages 1 to 4, 8 to 13, 15 to 16, 21 to 23, 25 to 38 and 51 as published,

pages 17 to 20, 24, 39 to 50 and 52 as filed on 13 July 1987, and

pages 5 to 7 and 14 as submitted at the oral proceedings.

The Registrar:

The Chairman:

P. Martorana

P.A.M. Lançon