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D E C I S I O N
of 15 May 1997

Case Number: T 0234/93 - 3.3.4

Application Number: 88308683.7

Publication Number: 0309187

IPC: A61L 15/00

Language of the proceedings: EN

Title of invention:

Immobilizing particulate absorbents by conversion to hydrates

Applicant:

JOHNSON & JOHNSON

Opponent:

-

Headword:

absorbents/JOHNSON & JOHNSON

Relevant legal provisions:

EPC Art. 54, 111(1)

Keyword:

"Remittal to the Examining Division (yes) - amended claims"

Decisions cited:

G 0010/93, G 0001/84, T 0157/87, T 0162/86, T 0021/83,
T 0047/90, T 0766/91

Catchword:

-



Case Number: T 0234/93 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 15 May 1997

Appellant: JOHNSON & JOHNSON
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New Brunswick, NJ 08933-7003 (US)

Representative: Christopher P. Mercer
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 5 October 1992
refusing European patent application
No. 88 308 683.7 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: L. Galligani
J. Saisset

Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division dated 5 October 1992 whereby the European patent application No. 88 308 683.7 (publication No. 0 309 187) was refused according to Article 97(1) EPC.

Independent claims 1, 9, 10 and 12 read as follows:

- "1. An absorbent hydrate comprising a mixture of:
a) a particulate water-insoluble, water-swella-
ble absorbent polymer; and
b) an aqueous liquid,

provided that the water content of the hydrate is greater than 22% by weight of the total weight of the hydrate when the polymer is starch-hydrolysed polyacrylonitrile graft copolymer.

9. An absorbent article containing the absorbent hydrate of any one of claims 1 to 8.

10. An absorbent article containing an absorbent hydrate comprising a mixture of:
a) a particulate water-insoluble water-swella-
ble absorbent polymer; and
b) an aqueous liquid,

the absorbent hydrate containing the aqueous liquid in an amount of from 20% to 80% by weight of the total weight of said hydrate.

12. A method for immobilizing a particulate water-insoluble, water-swella-
ble absorbent polymer comprising combining an aqueous liquid with said polymer to form a hydrate."

Dependent claims 2 to 8 related to embodiments of the absorbent hydrate according to claim 1. Dependent claim 11 was an embodiment of the absorbent article according to claim 10, while dependent claim 13 was an embodiment of the method according to claim 12.

The examining division considered that that claims 1 to 3 and 9 to 13 file lacked novelty under Article 54(1)(2) EPC as their scope encompassed generally known ion-exchange columns, and that claims 4 to 8 lacked an inventive step having regard to the following documents:

(1) EP-A-0 049 944;

(2) US-A-4 123 397.

II. In the statement of grounds of appeal, the appellants remarked that the examining division had been unable to cite any prior art document(s) in support of its allegation that resins in ion-exchange columns are hydrates comprising more than 22% water. They submitted that none of several chemical dictionaries which had been consulted mentioned that an ion-exchange resin is a hydrate of a water-insoluble, water-swelling absorbent polymer. They contended that ion-exchange resins were not water-swelling. In this context, reference was made to decisions T 157/87 of 25 April 1988, T 162/86 (OJ EPO 1988, 452) and T 21/83 of 6 April 1984 of the boards of appeal. The appellants further observed that the reasoning of the examining division in respect of inventive step was based on an ex post facto analysis and submitted that the claimed subject-matter was inventive over the disclosures of documents (1) and (2).

III. In a communication accompanying the summons to oral proceedings, the board provided the following citation:

- (3) The Encyclopedia of Polymer Science and Technology, H.F.Mark et al. eds., Interscience Publishers, New York (USA), Vol. 7, 1967, pages 708-719.

Based on said reference, the board expressed the opinion that indeed ion-exchange resins in their swollen state seemed to fall under the wording of the claims on file. The board also raised some clarity objections under Article 84 EPC.

IV. In reply to the board's communication, on 11 April 1997 the appellants filed as a **main request** amended claims 1 to 13 in which, in comparison with the previous claims on file:

- claims 1, 10 and 12 contained the phrase "having a gel capacity of at least 10" inserted after the words "absorbent polymer";
- in dependent claim 6 the reference to "claims 1 to 5" was corrected to read "claims 1 to 3".
- claim 12 contained at the end the phrase "and applying the hydrate to a temporary or ultimate surface"

V. In a consultation by telephone, the appellants were informed that, in view of the new request on file, the board under Article 111(1) EPC intended to remit the case to the examining division for further prosecution, including the examination for novelty. The appellants did not object thereto. The scheduled oral proceedings were thus cancelled.

- VI. The appellants request that the decision under appeal be set aside and that a patent be granted on the basis of the main request on file.

Reasons for the Decision

Amendments: Articles 123(2) and 84 EPC.

1. The subject-matter of present claims finds full formal support in the application as filed. In particular, the feature "having a gel capacity of at least 10" now relied upon in claims 1, 10 and 12 in relation to the absorbent polymer is based on page 5, lines 32 to 34. The immobilisation of the hydrate on "a temporary or ultimate surface" (cf. claim 12) is based on page 3, lines 18 to 20. Thus, no objections under Article 123(2) EPC are seen by the board.
2. No clarity objections under Article 84 EPC against the present claims are seen by the board.

Substantive matters

3. The examining division rejected the present application because in its view the subject-matter of claims 1 to 3 and 9 to 13 then on file lacked novelty having regard to known ion-exchange columns. It was explained in the decision (see section II, point 1) that, since ion-exchange resins are particulate water-insoluble, water-swelling absorbent polymers which, when put in a column, comprise an aqueous liquid such as water or saline, the whole system could be defined as an absorbent hydrate. In this context, the examining division stated: "All this is general knowledge that can be found in any appropriate chemical dictionary, so that specific citations to substantiate it appear[s]"

not necessary" (emphasis added). The appellants remarked that this approach for raising a novelty objection was quite out of order. At any rate, they denied the allegation made by the examining division that known ion-exchange resins satisfy the definition of the claimed absorbent hydrate.

4. As emphasised in several decisions of the boards of appeal (see eg T 766/91 of 29 September 1993), substantiation of an allegation that something is common general knowledge is required when this is challenged by another party or, like in the present case, by the EPO. Therefore, it would have been proper on the part of the examining division to substantiate its objection of lack of novelty by way of a citation from a chemical dictionary, encyclopaedia or basic textbook instead of putting forward merely general unattested considerations.
5. Nevertheless, a brief consultation of an encyclopaedia available at the boards of appeal provided through document (3) some support for the allegation of the examining division. The cited document (cf. in particular page 711) showed that, contrary to the appellants' submissions in their statement of grounds of appeal, ion-exchange resins are water-swellable and, according to their chemical characteristics, can retain up to 50% water by weight. Thus, known ion-exchange resins in their swollen state were indeed within the scope of the claims rejected by the examining division. This finding was communicated to the appellants who replied thereto by amending the claims. In the new set of claims it is now specified that the water-insoluble, water-swellable absorbent polymer which is meant has "a gel capacity of at least 10". This parameter, which was taken from the description, refers to the weight of aqueous fluid which can be imbibed and held per unit

weight of polymer (cf. description page 5, lines 33 to 37). The application as filed states also that such polymers are available commercially (cf. page 6, lines 6 to 8).

6. The question arises whether the amendments now introduced in the claims suffice to establish novelty over what is considered to be common general knowledge. After assessment of the particular circumstances of the case, the board - for the reasons given hereinafter - has decided to leave this task to the examining division and to remit for this purpose the matter thereto under Article 111(1) EPC, second sentence.
7. Proceedings before the boards of appeal are primarily concerned with examining whether the contested decision is correct on its own merits (cf decision G 10/93, OJ EPO 1995, 172, see in particular point 4). Under Article 111(1) EPC the board may exercise any power within the competence of the department which was responsible for the decision appealed (here: the examining division) and, if necessary in ex-parte cases, even include new grounds in the proceedings (cf. G 10/93 supra, point 3).

Alternatively, the board can remit the matter for further prosecution to the examining division. By remitting a case for further prosecution, the patentability of the claimed subject-matter can be decided at the first instance and the right to an appeal is maintained for use if appropriate. This is in line with the established principle of the case law that appeal proceedings should not be used as a continuation of the first instance proceedings (see eg G 1/84 OJ EPO 1985, 299, point 9 and T 47/90 OJ EPO 1991, 486, point 3).

8. In the present case, the board, notwithstanding the general unattested considerations on which the rejection for lack of novelty by the examining division was based (cf. points 3 and 4 supra), has been able to provide after a brief library search some documental support for allegations made. This has led the appellants to amend their claims by way of introduction of a new parameter taken from the description. However, in order to establish whether or not the subject-matter of the claims on file encompasses something which is common general knowledge, further investigations in chemical dictionaries, encyclopedias and/or basic textbooks are necessary. This is not the task of the board, but of the examining division which has also, if needed, the means available therefor. Thus, there are good reasons for the board to exercise its power under Article 111(1) EPC to remit the case to the examining division for further prosecution, including the examination for novelty.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further examination on the basis of claims 1 to 13 filed on 11 April 1997.

The Registrar:

A. Townend



The Chairperson:

U. Kinkeldey

Beglaubigt/Certified
Certifiée conforme:
München/Munich

Geschäftsstelle
Registry/Greffe

26. MAI 1997