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**D E C I S I O N**  
of 17 January 2002

**Case Number:** T 1062/98 - 3.2.6

**Application Number:** 91112904.7

**Publication Number:** 0469591

**IPC:** A61F 13/46

**Language of the proceedings:** EN

**Title of invention:**  
Absorbent article

**Patentee:**  
KAO CORPORATION

**Former Opponent:**  
The Procter & Gamble Company

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 83, 111(1)

**Keyword:**  
"Sufficiency of disclosure (yes)"  
"Remittal (yes)"

**Decisions cited:**  
-

**Catchword:**  
-



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Case Number: T 1062/98 - 3.2.6

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.6  
of 17 January 2002

**Appellant:**  
(Proprietor of the patent) KAO CORPORATION  
14-10, Nihonbashi Kayaba-cho, 1-chome  
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**Representative:**  
Grünecker, Kinkeldey,  
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**Respondent:**  
(Former Opponent) The Procter & Gamble Company  
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**Representative:**  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 15 September 1998  
revoking European patent No. 0 469 591 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. Alting van Geusau  
**Members:** H. Meinders  
J. C. M. De Preter

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## Summary of Facts and Submissions

- I. European Patent No. 0 469 591, granted on application No. 91 112 904.7, was revoked by the Opposition Division by a decision announced on 15 July 1998 and posted on 15 September 1998. It based the revocation on insufficient disclosure of the invention by the patent (Article 83 EPC).

Claim 1 of the patent reads:

"An absorbent article comprising a liquid-permeable outer material (1), a liquid-impermeable antileakage material (3), and a liquid-retentive absorbent element (2) interposed between said materials, and formed in a substantially vertically elongated shape, wherein the absorbent element (2) mainly comprises a diffusing absorbent sheet (21) and an absorbent retentive sheet (22) positioned at the rear of the diffusing absorbent sheet (21) characterised in that

- (a) the diffusing absorbent sheet (21) is a sheet having a hydrophilicity ( $\cos \theta$ ) of 0.5 to 1, a Klemm absorption velocity in the longitudinal direction of at least 40 mm/min and a liquid permeation time of not more than 200 s when an 85% aqueous glycerol solution is dropped thereon and
- (b) the absorbent retentive sheet (22) is a sheet comprising an aggregate of fibers having a capillary osmotic pressure of 4000 to 15000 dyn/cm<sup>2</sup> and containing 10 to 100% by weight, based on the fiber aggregate, of a highly water-absorbent polymer having a physiological saline absorption of 40 to 70 g/g and a physiological saline absorption velocity of at least 2 ml/0.3 g polymer.min".

- II. The Appellant (Patentee) filed a notice of appeal against this decision on 5 November 1998 and paid the appeal fee at the same time. On 25 January 1999 the grounds of appeal were filed.
- III. In a communication pursuant to Article 12 of the Rules of Procedure of the Boards of Appeal the Board expressed the preliminary opinion that the objection pursuant to Article 83 EPC, which led to the impugned decision, was not well-founded. It intended to allow the appeal and remit the case back to the first instance for further prosecution, as the questions of novelty and inventive step had not yet been examined.
- IV. By letter of 7 July 1999 the Respondent notified the Board that it formally withdraws from the opposition/appeal proceedings. This was confirmed as a withdrawal of the opposition by fax of 11 December 2001. By fax dated 27 November 2001 the Appellant requested setting aside the decision under appeal and remittal of the case to the first instance for further prosecution on novelty and inventive step. Auxiliarily oral proceedings were requested.
- V. In support of its request, the Appellant argued that the opposition division had based its decision to revoke the patent on the fact that it considered the claims being unclear (Article 84 EPC). This was not allowable as the grounds of opposition were limited to those mentioned in Article 100 EPC, which did not include the requirement of clarity of the claims. Further, the opposition division had based its decision on mere allegations of the Respondent, the latter not submitting any experimental proof therefor. Finally, in its decision the opposition division had discussed the question of infringement of the patent's subject-matter of claim 1, which had no place in opposition proceedings. The above mentioned procedure followed by

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the opposition division amounted to the violation of fundamental procedural principles warranting setting aside the decision.

As regards the feature "liquid permeation time" the skilled person had no difficulty in determining when at least 50% of the diffusing absorbent sheet was no longer covered with liquid, e.g. by marking a circle having a surface of 50% of the total surface, or by video registration and subsequent evaluation of the images. The Respondent had not supplied any proof that the way in which the test was carried out influenced the results, therefore its allegations should not at all have been considered by the opposition division. As in normal permeation tests, normal laboratory equipment should be used and the liquid should be poured gently onto the sheet.

Insofar as the determination of "absorption velocity" was concerned, the question discussed in the decision was not whether no method for determining this parameter was disclosed (which would have been a matter of sufficiency of disclosure, Article 83 EPC), but whether the method was disclosed in a sufficiently clear manner (which, however, was a matter of Article 84 EPC). Even if the method of determining this parameter were discussed under Article 83 EPC, the Respondent had not supplied any evidence to show that the method could not be carried out by a person skilled in the art. The question which filter to use when determining this parameter could be easily solved by the skilled person, as it was clear that it should not restrict the passage of liquid, so as not to influence the determination of the absorption characteristics of the highly water-absorbent polymer.

Finally, the fact that the diffusing absorbent sheet could be chosen from a large number of materials and thus confronted the skilled person with the problem of choosing such a material related to the broadness of the claim in relation to the disclosure in the patent, not sufficiency of disclosure. The former concerned Article 84 EPC, which was not a ground of opposition.

It further supplied a declaration of Mr Hamajima, one of the inventors of the patent in suit, relating to the above questions.

#### Reasons for the Decision

1. The appeal is admissible.
2. *Sufficiency of disclosure (Article 83 EPC)*
  - 2.1 Determination of the liquid permeation time of the diffusing absorbent sheet (item (i) of the impugned decision).
    - 2.1.1 The opposition division considered that it was virtually impossible to assess when the borderline value of at least 50% of the surface area within 200 seconds was arrived at so as to establish what the corresponding liquid permeation time was. Therefore this value could not be exactly verified by the given method.
    - 2.1.2 The question whether the method of determining the liquid permeation time is sufficiently described is irrelevant in view of the fact that the patent discloses on page 7, lines 6 to 48 a number of diffusing absorbent sheets (A-E) which fulfil the claimed requirement of  $\cos \theta$  being between 0.5 and 1,

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the Klemm absorption velocity being more than 40 mm/min and the liquid permeation time being less than 200 seconds (feature (a) in claim 1). This can be easily derived from Table I of the patent.

The materials A-E are described on page 7 of the patent in suit as to what they are composed of and how they are fabricated. Thus the skilled person has a choice from a number of available diffusing absorbent sheets which fulfil the claimed requirement of having a liquid permeation time of not more than 200 seconds combined with values for  $\cos \theta$  and the Klemm absorption velocity within the claimed ranges.

- 2.1.3 Moreover, as also argued by the Appellant, the skilled person has at his disposal sufficient means, for example computer controlled video registration, which is capable of detecting the moment when at least 50% of the surface area becomes visible.

With the help of the liquid permeation time values for the different materials A-E he will be capable of calibrating such equipment in respect of the threshold value of 50% of the surface becoming visible.

- 2.1.4 The opposition division further argued that the skilled person would not be capable of determining whether a certain saline absorption velocity would be infringing or not and therefore there was no sufficient disclosure to determine the scope of the claim.

Firstly, the question whether the skilled person is capable of determining whether a certain feature would be infringing a feature claimed is not a matter of sufficiency of disclosure as required by Article 83 EPC. This article requires the patent to disclose the invention in a manner sufficiently clear and complete

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for it to be carried out by the skilled person. Whether there is infringement is on the other hand a matter to be decided by the national courts.

Secondly, the determination of the scope of the claim as addressed by the opposition division relates in fact to the question whether the claims properly define the matter for which protection is sought. They shall be clear, concise and supported by the description. These are, however, the requirements imposed by Article 84 EPC and Rule 29(1) EPC, which do not form grounds of opposition and therefore cannot be invoked in opposition proceedings concerned with the patent in the form as granted, i.e. in unamended form.

Finally, the opposition division referred in this respect to verifying whether an "infringing saline absorption velocity" is given or not, without giving reasons why this parameter was not sufficiently disclosed. The Board establishes, however, that for the diffusing absorbent sheet referred to in claim 1 this velocity has been discussed and explained extensively as "Klemm velocity" on page 8 of the patent.

2.2 Determination of "absorption velocity" of the water-absorbent polymer in the absorbent retentive sheet (item (ii) of the impugned decision) - feature (b) of claim 1.

2.2.1 The opposition division found that the determination of the absorption velocity depended on the use of a buret and a glass filter, on the characteristics of which the patent did not supply information. The skilled person would have difficulty choosing the proper combination of laboratory equipment.



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2.2.2 To start with, the water-absorbent polymer to be used in the absorbent article is described on page 6, lines 3 to 24, with respect to its composition, method of production and its average particle diameter. Furthermore, two specific highly water-absorbent polymers are disclosed in connection with the absorbent retentive sheets used in the examples, see page 9, line 48 to page 10, line 5. For the skilled person this is sufficient information on which water-absorbent polymer to use.

2.2.3 For these polymers the value for the absorption velocity is disclosed in the patent, see page 9, line 53 and page 10, line 4. It cannot be considered an undue burden upon the skilled person to reverse, if necessary, the test using these known materials so as to find out which combination of buret and glass filter results in these values for the absorption velocity.

2.2.4 The Appellant supplied further information (declaration of Mr Hamajima) regarding the relative absence of an influence of pore size of the glass filter as well as the size of the buret on the outcome of the test method. The Respondent, to the contrary, has supplied no supporting evidence for his allegation that the skilled person would not be capable of performing this testing method.

2.2.5 Following the above considerations, the Board finds that the determination of the absorption velocity of the water-absorbent polymer is disclosed sufficiently clear and complete for it to be carried out by a skilled person.

2.3 Choice of the diffusing absorbent sheet - (item (iv) of the impugned decision) - feature (a) of claim 1.

- 2.3.1 The opposition division found that the description, page 4, lines 19 to 24 allowed for a large number of different materials for the diffusing absorbent sheet. It considered it was not simple for the skilled person to choose a material and to evaluate the corresponding parameter values for these materials.
- 2.3.2 The Board considers that this reasoning is not one related to the question of sufficiency of disclosure, but to the question whether there is sufficient support in the description for a claim wording which allows for a large number of materials which fulfil the parameter requirements listed in that claim. However, the latter is a requirement of Article 84 EPC and is not a ground for opposition.
- 2.3.3 The Board establishes that the description of the patent in suit contains specific indications of materials used for the diffusing absorbent sheet in the examples referred to on page 7, line 6 to page 8, line 10. Table I further gives clear indications which of these materials (A-E) have the properties fulfilling the requirements expressed in claim 1 in parameters to be determined via the described test methods. The values in the table sufficiently cover the areas claimed in claim 1, therefore the patent, by these examples is considered to disclose the invention in a manner sufficiently clear and complete for it to be carried out by the skilled person.
- 2.4 In view of the above, the Board finds that the patent fulfils the requirements of Article 83 EPC. As this was the sole ground for revocation of the patent and the opposition division has not performed the examination on the other substantive requirements the Board exercises its power pursuant to Article 111(1) second sentence EPC to remit the case back to the first instance for further prosecution.

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2.5 The main request of the Appellant being allowable, its auxiliary request for oral proceedings need not be considered.

3. *Alleged substantial procedural violations*

3.1 In its appeal the Appellant essentially argued that the decision taken by the opposition division was based on objections which were not comprised in the grounds of opposition as enumerated in Article 100 EPC. This amounted "to so many violations of fundamental procedural principles that the decision should be set aside".

3.2 In the foregoing the Board has found the substantive reasoning employed by the opposition division to be wrong. An error of judgment on substantive issues, however, does not amount to a procedural violation.

**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:

M. Patin

P. Altink van Geusau



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