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D E C I S I O N
of 19 September 2001

Case Number: T 1065/99 - 3.3.2

Application Number: 95936809.3

Publication Number: 0788379

IPC: A61L 15/58

Language of the proceedings: EN

Title of invention:

An absorbent article such as a diaper, an incontinence guard,
a sanitary napkin or like article

Applicant:

SCA Mölnlycke AB

Opponent:

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Headword:

Procedural violation/MÖLNLYCKE

Relevant legal provisions:

EPC Art. 18(2), 83, 84, 111(1), 113(1).

EPC R. 34(1)(c), 67

RPBA Art. 10

Keyword:

"Adoption of International Preliminary Examination Report as
only reasons for refusal of application under the EPC-
substantial procedural violation - (in this case, no)"

"Violations of the right to be heard - substantial procedural
violations (yes)"

"Remittal to first instance (yes)"

"Re-examination by differently composed examining division
(yes)"

"Reimbursement of appeal fee - (yes)"

Decisions cited:

T 0292/85, T 0433/93, T 0628/95

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 1065/99 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 19 September 2001

Appellant: SCA Mölnlycke AB
S-405 03 Göteborg (SE)

Representative: Larsson, Karin
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 13 July 1999
refusing European patent application
No. 95 936 809.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: C. Rennie-Smith
G. F. E. Rampold

Summary of Facts and Submissions

I. European patent application No. 95 936 809 3, published under the PCT as WO 96/13 283, was refused pursuant to Article 97(1) EPC by a decision of the examining division posted on 13 July 1999. The decision was based on claims 1 to 21 filed on 25 March 1997 with the appellant's letter of 20 March 1997. The independent claims are worded as follows:

"1. Use of a hydrophilic glue in an absorbent article such as a diaper, an incontinence guard or a sanitary napkin which comprises a liquid-permeable outer sheet, a liquid-impermeable backing sheet, and an absorbent body placed therebetween, **characterized** in that the hydrophilic glue is used for joining the outer sheet and the absorbent body as well as a replacement for a tensid in order to reduce the resistance to the transportation of liquid."

"12. An absorbent article such as a diaper, an incontinence guard or a sanitary napkin which comprises a liquid-permeable outer sheet, a liquid-impermeable backing sheet, and an absorbent body placed therebetween, **characterized** in that the outer sheet and the absorbent body, at least partially, are mutually joined by a hydrophilic hot melt glue applied at the wetting area."

Dependent claims 2 to 11 relate to specific elaborations of the use according to claim 1 and dependent claims 13 to 21 to specific elaborations of

the absorbent article according to claim 12.

II. An International Preliminary Examination Report ("IPER") dated 27 January 1997 stated that the subject-matter of the application was not new and that the dependent claims did not contain any features which, in combination with the independent claims, could provide novelty or an inventive step. The following three comments in the IPER are of particular relevance to the present decision:

- At the end of paragraph 1.1 of the IPER, it was stated that the words "in order to reduce the resistance to the transportation of liquid" in claim 1 were superfluous.
- In paragraph 2, the IPER said of the subject-matter of dependent claims 7, 9 and 10, which concerns a hydrophilic glue modified to be such from a hydrophobic glue, that "It is not possible to validly claim such a hydrophilic glue since it cannot always be verified in the used glue whether it was originally hydrophobic or not. Furthermore, the possibilities for modifications are so wide that it is not clear which hydrophobic/hydrophilic glues are within the scope of the claim".
- Also in paragraph 2 of the IPER it was stated "The subject-matter of claim 8 is a special version of the hydrophilic glue and as such is not sufficiently specified in order to establish an inventive step over the available prior art".

III. Subsequently a communication under Rule 51(2) EPC ("the Rule 51 Communication") was issued on 7 September 1998

by the primary examiner of the examining division who had also been the author of the IPER. This stated that the application did not meet the requirements for the reasons enclosed which read:

"An international preliminary examination report has already been drawn up for the present application in accordance with the PCT. The deficiencies mentioned in that report give rise to objections under the corresponding provisions of the EPC."

By a letter dated 21 December 1998, the applicant presented observations on the objections in the IPER (as adopted in the Rule 51 Communication) of lack of novelty and inventive step.

IV. A decision refusing the application was issued on 13 July 1999. The stated ground for the refusal was that both independent claims 1 and 12 lacked novelty, having regard to the disclosure in citation (1), viz US-A-5 356 405. In addition, the decision raised objections of clarity and/or sufficiency (although not using those terms and not referring to Articles 83 and 84 EPC), unacceptable amendment under Article 123(2) EPC and irrelevance under Rule 34(1)(c) EPC. The substance of the reasoning given in the decision was as follows:

Citation (1) disclosed all the technical features of claim 1. Even if the hydrophilic glue was used in (1) for other reasons than in the present application, the cited document none the less discussed its use in the context of absorbent articles and was thus prejudicial to the novelty of claim 1. The subject-matter of claim 12 was likewise fully anticipated by the

disclosure of (1).

Further, the examining division found that the qualification of the hydrophilic glue in claim 1 "as a replacement for a tensid in order to reduce the resistance to the transportation of liquid" in claim 1 lacked adequate support in the application as filed contrary to the provisions of Article 123(2). It also held those words "to be obviously irrelevant or unnecessary under the given circumstances" and therefore unacceptable under Rule 34(1)(c) EPC.

As to objections of clarity and/or sufficiency (although not expressed as such and without citing Articles 83 or 84 EPC), the examining division's decision repeated *verbatim* the second and third of the comments in the IPER listed in paragraph II above; and expressed the opinion that those applied also to claims 13 to 21.

V. On 10 September 1999, the appellant filed a notice of appeal against that decision and paid the appeal fee. Grounds of appeal were filed on 12 November 1999 requesting *inter alia* oral proceedings.

VI. In its grounds of appeal the appellant alleged one or more substantial procedural violations by the examining division and requested reimbursement of the appeal fee. As to the alleged procedural violations, the appellant argued as follows.

Although three communications had been issued in the present case, namely a written opinion under Article 34(c) and Rule 66.2 PCT, the IPER and the Rule 51 Communication, none of them referred to a

potential objection under Article 123(2) EPC and to the non-patentability of claims 11 and 16.

All the objections to the application were produced in the PCT phase, during which the IPER was written, by a single examiner whereas Article 18(2) EPC requires that an examining division of three technical examiners considers an application in the regional phase. Consequently, the appellant implied, since the author of the IPER was the primary EPC examiner and the decision under appeal only reproduced the IPER, the applicant had not had any "dialogue" with the whole examining division before the adverse decision was issued.

Accordingly the decision under appeal was based on grounds on which the appellant had been given no opportunity to comment contrary to Article 113(1) EPC.

As to the substance of the objections in the decision under appeal, the appellant submitted arguments and comments as to the alleged patentability of the subject-matter claimed in the application and filed amended sets of claims by way of first, second and third auxiliary requests.

VII. The board issued a communication on 16 August 2001 indicating the provisional view that it appeared one or more substantial procedural violations had occurred and that one consequence could be the remittal of the case to the first instance. If such remittal was ordered two questions might arise, namely whether or not the board should direct that further consideration of the case should be by a differently composed examining division and whether, if the board were to hear and allow the

appeal on the substantive issues of novelty and inventive step, it would be equitable , in those circumstances, to allow the request for reimbursement of the appeal fee since the appeal would then have been necessary even in the absence of any procedural violation.

Further, the appellant was informed that it should be prepared to address the board on the issues concerning the alleged procedural violations at the beginning of the oral proceedings (then scheduled to take place on 12 September 2001 but subsequently cancelled). Alternatively, if the appellant would prefer the board to consider those issues with a view to remittal of the case to the first instance without a decision in this appeal on the substantive issues, the appellant was invited to submit its observations and appropriate requests in writing in which case the oral proceedings might be unnecessary.

- VIII. By a faxed letter date 31 August 2001, the appellant requested that the case be remitted to the first instance, to be dealt with by a differently composed examining division, without a decision of the board on the substantive issues. This is now the appellant's main request.

- IX. On 10 September 2001 the board issued a communication cancelling the oral proceedings and intimating an order as in this decision would be made.

Reasons for the Decision

1. The appeal is admissible.

2. The board expresses no opinion on the merits or otherwise of the objections to the European patent application or, save as to the complaint of one or more substantial procedural violations, on the grounds of appeal for the following reason. As explained below, the case has to be remitted in view of substantial procedural violations to the first-instance for further prosecution and decision so that any comment on the substantive aspects of the case by the board, which only has an appellate jurisdiction, would thus be premature and inappropriate. According to Article 111(1) EPC the department of first instance is required to take its own decision on the merits on the case, without the board having given any ruling. The purpose of remittal to the first instance is to afford the deciding body the opportunity to reconsider the case and decide independently on the substantive issues not dealt with by the board in this decision.

3. As regards the alleged substantial procedural violations, the appellant's case is in part that, the IPER having been prepared by a single examiner and the Rule 51 Communication sent before the first-instance decision by the same person as primary examiner having relied exclusively on the IPER as its basis, the appellant was denied "any dialogue" with the whole examining division, which must comprise three examiners under Article 18(2) EPC, before the decision was issued. Since there were no oral proceedings, this can only mean there was no "dialogue" in writing and further, since applicants do not correspond separately

with the various members of a three-person examining division, that the appellant considers its arguments were not seen or considered by all three members in the present case. While if correct that would be beyond doubt a substantial procedural violation, there is, notwithstanding the unfortunate conjunction of circumstances, no evidence that this actually happened. While it is true that the IPER and the Rule 51 Communication were written by one and the same person, that is not to say he did not consult the chairman or the second examiner at any stage. It is beyond doubt regrettable that the first instance procedure was conducted in a manner which could even give rise to the quite reasonable suspicion on the part of the appellant that there had been such an absence of consideration of the case by the whole division, but such a suspicion is not enough for the board to conclude that this actually happened. Accordingly the board finds that this particular alleged procedural violation, although possibly plausible to the appellant in the circumstances, falls short of being proven.

4. That is not to say that the approach of the examining division was desirable or even acceptable. It appears to be the practice of the examining divisions to rely on the IPER, if drawn up by the EPO, "as an opinion for the purposes of examination and generally the first communication will only refer to the opinion expressed in the IPER" (Guidelines, part E, chapter IX, paragraph 6.4.3). There can be little objection to such a practice provided such reliance on the IPER is not presented to applicants in such a manner as to suggest that an examining division has simply adopted the opinion in an IPER without itself giving objective consideration to the patentability requirements of the

EPC. The passage from the Guidelines cited above continues thus: "Such an opinion may be departed from if new facts relevant to assessing patentability are in evidence... or where the substantive patentability requirements under the PCT and EPC are different". That qualification alone should suffice to remind an examining division that it has discretionary powers under the EPC which it should not surrender, or even appear to surrender, by mere adoption of an IPER. The abdication by one body of its legal duty to exercise discretion to another body amounts to a tacit refusal to exercise that discretion at all. While it is not for the board to supplement the Guidelines, the examining divisions of the EPO may wish, in the light of this decision, to consider measures to ensure not only that this does not happen but also, which is equally important, that applicants are not given the impression it may have happened.

5. While the board finds the particular procedural violation alleged by the appellant that all three members of the examining division did not consider the case not proven, the board does however consider that a number of substantial such violations occurred in this case, all corresponding to the appellant's complaint that the decision under appeal was based on grounds on which it had no opportunity to comment.

6. It is clear from the standard form used by the EPO for IPERs that IPERs are confined to consideration, under the PCT, of three matters namely novelty, inventive step and industrial applicability (see the check-boxes numbered III and V in part 3 on the cover page of the form, the heading of page 2 of the form and the text of the section headed "1 Statement" on the same page). In

the present case, in the section headed "2 Citations and Explanations" and which contained an opinion extending from page 2 to page 6, the IPER set out in some detail the author's objections as to novelty and, in less detail, as to inventive step. At the end of paragraph 1.1, which occupies nearly a whole page of text and is concerned with novelty of the application as against citation (1), there was a short comment that certain words are "superfluous" in claim 1; in paragraph 2, which occupies about three-quarters of a page and is concerned with the possibility that features of the dependent claims might supply novelty or inventiveness, it was said that the modification of hydrophobic to hydrophilic glue cannot always be verified and that the modification possibilities are so wide as to be unclear; and at the end of paragraph 2 it was stated that the special version of hydrophilic glue in claim 8 is "not sufficiently specified" to establish an inventive step (see paragraph II above). Those three passages appear to be the genesis of the objections, in the decision under appeal, of respectively irrelevance (Rule 34(1)(c) EPC), clarity (Article 84 EPC) and insufficiency (Article 83 EPC), albeit that the second and third of those objections are still not identified as such in the decision.

7. As already mentioned (see paragraph 3 above), in the subsequent Rule 51 Communication of 7 July 1998 the IPER was adopted by the examining division as the only basis for its opinion that the application did not meet the requirements of the EPC. In reply the applicant in its letter of 21 December 1998 presented arguments against the novelty and inventive step objections. It did not present any arguments on the questions of irrelevance, clarity or insufficiency, and indeed could

not be expected to do so at this point for three reasons. First, none of these matters had been identified as an objection as such - while in principle that was equally wrong as regard all these objections, in practice it was particularly wrong as regards the irrelevance objection since Rule 34(1)(c) is only very rarely relied on as a source of objection. Second, the examining division had, by relying entirely on the IPER, made clear that any deficiencies it had found in the application were founded on those matters to which the IPER was confined, namely novelty and inventive step. And third, the applicant was entitled to rely on Article 113(1) EPC and assume that any further or additional objections would be put to it, with the opportunity for reply, before a final decision as to grant or refusal was taken.

8. The decision which was then issued contained, in section 2 of its reasons headed "Formal deficiencies", four paragraphs of text leading to the conclusion that the passage in claim 1 "in order to reduce the resistance to the transportation of liquid" is irrelevant and unnecessary and citing, for the first time in the proceedings, Rule 34(1)(c) EPC. The decision, in section 7 of its reasons, also repeated *verbatim* the observations contained in the IPER about the clarity of claim 7 and the sufficiency of claim 8 although still not naming those objections as such and still making no reference to Articles 83 and 84 EPC. The decision also included, in section 8, a whole paragraph raising the objection under Article 123(2) EPC that the passage in claim 1 "as a replacement fluid for a tensid in order to reduce the resistance to the transportation of fluid" could not be found in the application as filed. Significantly, this paragraph

begins "A **further** problem is noted with the wording of claim 1" (emphasis added). In the context of this case, the word "further" simply underlines the fact that this particular objection was only raised for the first time in the decision.

9. There were thus three objections - as to irrelevance, clarity and sufficiency - which were only obliquely touched upon in the IPER, and thus in the Rule 51 Communication, and not identified in either of those documents by any reference to the appropriate provision of the EPC, only one of which - irrelevance - has now been so referred to in the decision under appeal; and a further objection - of added matter - which was raised for the first time in the decision itself. (The objections of clarity and sufficiency could be regarded as one, or at least as closely related. The close connection between Article 83 and 84 EPC objections is well-known - see, for example, T 292/85, OJ 1989, 275 at page 282, reasons, paragraph 3. However, in the present context, the difference between one or two "concealed" objections is of no real consequence.)
10. For the reasons already mentioned (see paragraph 7 above) the applicant could not be expected to present arguments upon unidentified objections which were at least partly "concealed" within other, identified objections; clearly it had no opportunity to contest an objection not raised prior to the decision itself. As regards each of these four objections therefore, the decision under appeal was based on grounds on which the appellant did not have an opportunity to present its comments, contrary to Article 113(1) EPC.

11. The remaining allegation made by the appellant as to a procedural violation is that the decision of the examining division did not give any grounds for refusing claims 11 and 16. In fact, paragraph 7 of the decision began by observing that claims 2 to 11 and 13 to 21 are dependent on independent claims 1 and 12 and concludes by saying the arguments in that paragraph, which mentions claims 2 to 6, 7, 8, 9 and 10, also apply to claims 13 to 21. Claims 1 and 12 having been addressed elsewhere in the decision, only claim 11 was not dealt with in terms. As the appellant observes in its grounds of appeal, the grounds for refusing claims 13 to 21 were not explicitly given, they were just said to suffer from the same objections as *inter alia* claims 7 to 10 and, since claim 16 (dependent on claim 12) corresponds to claim 11 (dependent on claim 1), there may be a lack of detailed explanation why either or both of claims 11 and 16 have been refused. However, if all the independent claims of an application are refused, it is difficult to see how the absence of detailed explanation for refusal of each and every dependent claim could in itself amount to a procedural violation. (Just as, equally, if the procedure in which a certain number of claims, independent or dependent, have been refused is flawed, the proper treatment of other claims cannot avoid a finding of a procedural violation.) For that reason, and since the board should not descend into the merits of the case (see paragraph 2 above), and since the decision under appeal must be set aside for the violations of Article 113(1) EPC already established, the board does not consider it appropriate or necessary to make a finding on this issue.

12. That an infringement of the right to be heard may be a

substantial procedural violation is well-established in the case-law of the boards of appeal (see, for example, the treatment of the subject in "Case Law of the Boards of Appeal of the European Patent Office", 3rd Edition, pages 514 to 515). Whether considered as one major violation exemplified in four ways or four separate but similar violations, the procedural irregularities in the present case cannot be described as anything less than "substantial".

13. It is equally well-established that in such cases the board may remit the case to the first instance. Not only is this permitted in the board's discretion by Article 111(1) EPC, the Rules of Procedure of the Boards of Appeal require such remittal if fundamental deficiencies are apparent in the first instance proceedings unless special reasons are present (see Article 10, RPBA). In this case there are no special reasons not to remit, indeed there is the compelling reason to remit that the appellant has suffered such a serious denial of procedural justice that it would be unsafe to allow the first instance decision to stand. By setting that decision aside and remitting the case, the board can give the appellant the opportunity to have its patent application examined, under the provisions of the EPC, *de novo* and according to proper procedural standards as if the decision under appeal and the proceedings which led up to it had never taken place. Further, remittal has been requested by the appellant.

14. The board also considers that, in the exceptional circumstances of the present case, the new examination proceedings should be conducted by a differently composed examining division, that is by a division of

three new members. Such a direction is typically made when there is a question of possible bias against a party and the board emphasises that is not the case here. However, a differently composed first instance can also be appropriate when a party would have reasonable grounds for feeling it might not otherwise have a fair re-hearing, as occurred in T 433/93, OJ 1997, 509 (see reasons, paragraph 2) where, in opposition proceedings, the first a patentee knew of **one** ground of objection was on receipt of the first instance decision. In T628/95 (unpublished) remittal to a differently composed first instance was ordered *ipso facto* on the board concluding the first instance decision was null and void. Both those precedents have their parallels in the present case, the board having found that **four** grounds for objections were not put to the applicant, either properly or at all, before the decision under appeal was issued, and having also concluded that the decision is to be treated as null and void.

15. In the present case, the appellant has requested a different composition but, even in the absence of such a request, the board would have so directed because, after procedural irregularities as grave as those in this case, it is important to ensure so far as possible there should not be any ground for dissatisfaction with the conduct of the further proceedings, such as might well be the case if the same examining division was again to refuse the application even after impeccably conducted proceedings. In the circumstances, such a direction is also fairer for the members of the examining division who took the decision under appeal.

- 16 Having decided that the decision under appeal must be

set aside and the case remitted in view of the substantial procedural violations which have occurred, the board has no hesitation in holding that reimbursement of the appeal fee is equitable under Rule 67 EPC. Indeed it would be inequitable to make the appellant pay a fee to appeal against a decision which is to be treated as never having been made.

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.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:

A. Townend

U. Oswald