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D E C I S I O N
of 23 February 2006

Case Number: T 0674/02 - 3.3.10

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

Patentee:

Johnson & Johnson

Opponent:

Nippon Shokubai Company Limited
Paul Hartmann AG

Headword:

Absorbent hydrate/JOHNSON

Relevant legal provisions:

EPC Art. 111(1), 123(2), 123(3)

Keyword:

"Amendments (allowable) - combination of numerical ranges"
"Change of claim category (yes) - from product to process for its preparation"
"Remittal to first instance (yes) - outstanding issues"

Decisions cited:

T 0002/81, T 0054/90, T 0028/92, T 0468/97, T 0554/98

Catchword:

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Case Number: T 0674/02 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 23 February 2006

Appellant:
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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 30 April 2002 revoking European patent No. 0309187 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: R. Freimuth
Members: J. Mercey
J. Seitz

Summary of Facts and Submissions

- I. The Appellant (Proprietor of the Patent) lodged an appeal on 26 June 2002 against the decision of the Opposition Division dated 30 April 2002 revoking European patent No. 309 187 and on 9 September 2002 filed a written statement setting out the grounds of appeal.
- II. Notice of Opposition had been filed by the Respondents I and II (Opponents 01 and 02 respectively), requesting revocation of the patent in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC), insufficient disclosure (Article 100(b) EPC), and of extending the subject-matter of the patent in suit beyond the content of the application as filed (Article 100(c) EPC).
- III. The Opposition Division held that the amendments made to the patent according to the then pending main request lacked clarity and extended the protection conferred pursuant to Article 123(3) EPC, and that those made to the patent according to the then pending auxiliary request extended the subject-matter of the patent in suit beyond the content of the application as filed and extended the protection conferred pursuant to Article 123(2) and (3) EPC respectively.
- IV. At the oral proceedings before the Board, held on 23 February 2006, the Appellant defended the maintenance of the patent in suit in amended form on the basis of a main and an auxiliary request, both submitted during these oral proceedings and thus superseding any previous requests. The main request

comprised a set of six claims, independent claim 1 reading as follows:

- "1. A method of making an absorbent article by:
- a) forming an absorbent hydrate by adding water to a superabsorbent with mixing, wherein the superabsorbent is a particulate water-insoluble, water-swellable absorbent polymer having a gel capacity of at least 10, and wherein the hydrate comprises water in an amount of from 30% to 80% by weight of the total weight of said hydrate, and
 - b) incorporating the resulting hydrate into an absorbent material which is fluffy wood pulp."

The dependent claims 2 to 6 were directed to preferred embodiments within the ambit of claim 1.

- v. The Appellant submitted that claim 1 according to the main request found support in the application as filed, most particularly in the passage from page 2, line 33 to page 3, line 5, and thus complied with the requirements of Article 123(2) EPC. As to the change of category of the claims, the requirements of Article 123(3) EPC were also met, since the protection conferred by a product claim covered all methods for production of the product, such that limitation to one of these methods could not extend the scope of protection. The specification that the absorbent polymer was a superabsorbent was not inconsistent with the passage from page 5, line 37 to page 6, line 8 of the application as filed, since said passage indicated that any absorbent polymer having a gel capacity of at

least 10 was to be regarded as a superabsorbent, the reference to a capacity of 15 to 70 being merely exemplary.

- VI. The Respondent II, during the oral proceedings before the Board, no longer maintained its objection that the change of category of the claims from product to process resulted in an extension of the protection conferred. Furthermore, the Respondent II argued that the specification that the absorbent polymer was a superabsorbent having a gel capacity of at least 10 was inconsistent with the passage from page 5, line 37 to page 6, line 8 of the application as filed, which required superabsorbents to have a capacity of 15 to 70.
- VII. The Respondent I made no submissions as to the substance of the appeal, nor raised objections to a particular issue.
- VIII. The Appellant requested that the decision under appeal be set aside and the case be remitted to the first instance for further prosecution on the basis of the main request or, subsidiarily, on the basis of the auxiliary request, both requests filed during the oral proceedings on 23 February 2006.

The Respondents I and II requested that the appeal be dismissed.

- IX. Oral proceedings were held in the absence of Respondent I, who, after having been duly summoned, informed the Board with a letter dated 13 January 2006 that it would not attend. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main Request

2. *Amendments (Article 100(c) EPC)*

2.1 The Respondent II opposed the patent in suit on the ground that the subject-matter of that patent extended beyond the content of the application as filed. Therefore the subject-matter of the claims comprised in the patent in suit must be fully examined by the Board as to whether or not that objection is well-founded.

2.2 The subject-matter of claim 1 is based on original claims 1 and 9. The combination of steps a) and b) is disclosed from page 2, line 33 to page 3, line 3 of the application as filed.

More particularly, the method for forming the absorbent hydrate from a superabsorbent according to step a) is disclosed on page 2, lines 33 to 35 and the gel capacity of the superabsorbent of at least 10 is disclosed from page 5, line 32 to page 6, line 8 of the application as filed. The feature of adding a superabsorbent which is an absorbent polymer having a gel capacity of at least 10 is not inconsistent with the aforementioned passage as alleged by the Respondent II. The reference in that passage, particularly on page 6, line 4, to a capacity of "commonly" 15 to 70 does not require the superabsorbents to have that

capacity, but rather qualifies this range as being merely exemplary, with the consequence that this range is not restrictive.

The upper and lower end-points of the claimed weight range of water are disclosed in original claims 7 and 8 respectively, claim 8 being dependent on claim 7, and claim 7 being dependent on original claim 2, which specifies water, such that the amount of 30% to 80% by weight of water is disclosed in the application as filed (see decision T 2/81, OJ EPO 1982, 393, point 3 of the reasons).

The method of incorporating the resulting hydrate into an absorbent material which is fluffy wood pulp according to step b) is disclosed on page 3, lines 14 to 15 of the application as filed. That fluffy wood pulp may be used as an absorbent for articles is disclosed on page 10, line 10 of the application as filed.

- 2.3 Claims 2 to 6 are supported by original claims 3 to 6 and 8 respectively.
- 2.4 For these reasons, the Board concludes that the subject-matter of the claims does not extend beyond the content of the application as filed such that the requirements of Article 123(2) EPC are satisfied and the ground for opposition pursuant to Article 100(c) EPC is disqualified.

3. *Amendments (Article 123(3) EPC)*

- 3.1 With respect to the scope of the protection afforded by the amended claim 1 as compared to the scope of independent claim 9 as granted, the amendment involves *inter alia* a change in the category from a claim directed to an article *per se* into a claim directed to a method of producing such an article. According to established case law of the Boards of Appeal, a product claim confers protection to all processes for making that product, such that the replacement of a claim directed to a product by a claim directed to a specific method for making that product does not extend the protection conferred thereby (cf. decisions T 54/90, point 3.2 of the reasons; T 28/92, points 4.1 and 4.1.1 of the reasons; T 468/97, point 6.2 of the reasons, T 554/98, point 5.1.1 of the reasons; none published in OJ EPO).
- 3.2 In the present case, the article produced by the preparation method of claim 1 is covered by, and is in fact even narrower in scope than, the article of granted claim 9, since the aqueous liquid is restricted to water, the amount of said water is restricted to 30% to 80% by weight, and the presence of fluffy wood pulp is mandatory. During the appeal proceedings, the Respondent II no longer maintained its objection raised under Article 123(3) EPC. Thus the Board concludes that the claims restrict the scope of protection compared to that conferred by the granted claims, such that the requirements of Article 123(3) EPC are satisfied.

4. *Remittal*

Having so decided, the Board has not taken a decision on the whole matter, since the decision under appeal was solely based on violations of the provisions of Articles 84, 123(2) and (3) EPC, which objections are no longer pertinent due to the amendments made to the claims. As the Opposition Division has not yet ruled on the other grounds for opposition, e.g. novelty and inventive step, and the Appellant having requested remittal, the Board considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on the basis of the claims according to the main request in order to enable the first instance to decide on the outstanding issues.

Auxiliary request

5. Since the preceding main request is remitted to the first instance for the reasons set out above, there is no need for the Board to decide on the lower ranking auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 6 filed as main request during the oral proceedings before the Board.

The Registrar:

The Chairman:

C. Moser

R. Freimuth