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DECISION
of 7 October 2005

Case Number: T 0126/03 - 3.2.06

Application Number: 91303296.7

Publication Number: 0463716

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Absorbent structure, and method of making same

Patentee:

GEORGIA-PACIFIC CORPORATION

Opponents:

- (01): M&J Fibretech A/S
(02): The Procter & Gamble Company
(03): Buckeye Technologies INC.

Headword:

-

Relevant legal provisions:

EPC Art. 83, 100(b)

Keyword:

"Sufficiency of disclosure - no"

Decisions cited:

T 0409/91

Catchword:

-

Case Number: T 0126/03 - 3.2.06

DECISION
of the Technical Board of Appeal 3.2.06
of 7 October 2005

Appellant: GEORGIA-PACIFIC CORPORATION
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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 22 November 2002
revoking European patent No. 0463716 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. Kadner
R. Menapace

Summary of Facts and Submissions

- I. The mention of grant of European patent No. 463 716 with 30 claims in respect of European patent application No. 91303296.7 claiming a US-priority from 20 April 1990 and filed on 15 April 1991 was published on 9 June 1999.

Independent claims 1 and 12 read as follows:

"1. A Method for making a dry laid, liquid-absorbent structure having a basis weight of about 20 to 500 grams per square meter by forming a dry laid loose fibrous web having incorporated therein particulate superabsorbent material, applying to at least one surface of said web a liquid binding agent and curing the agent;
characterised in that said liquid binding agent comprises a heat curable latex which is applied in an amount to form, after curing, from 5% to 30% by weight of the structure, and the amount of latex applied and the degree of penetration of the latex into said structure are controlled so as to impart integrity to the structure on curing and to provide said structure with an absorptive capacity of not less than about 6 grams of a one percent saline solution per gram of structure and a retention capability of not less than about 5 grams of a one percent saline solution per gram of structure.

12. A liquid absorbent structure comprising dry laid fibers, superabsorbent material and a resin binder characterised in that said structure comprises a loose dry laid fibrous web (46) having distributed

therewithin particulate superabsorbent Material (48), and said web being stabilised by a binding agent for the structure comprising heat curable latex (50) which has partially penetrated into the web from at least one surface of said web and is then cured, said cured latex forming from 5% to 30% by weight, based on the weight of the structure, and said structure having (i) a basis weight of about 20 to 500grams per square meter, (ii) an absorptive capacity of not less than about 6 grams of a one percent saline solution per gram of structure, and (iii) a retention capability of not less than about 5 grams of a one percent saline solution per gram of structure."

- II. Three notices of opposition were filed against this patent with requests for revocation based on the grounds of Article 100a) and b) EPC (Opponents 01 to 03) and of Article 100c) EPC (Opponent 02).

By decision posted on 22 November 2002 the Opposition Division revoked European patent No. 463 716 on the ground that the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 83 EPC).

- III. Notice of appeal was lodged against this decision by the Appellant (Patentee) on 29 January 2003 together with payment of the appeal fee. The statement setting out the grounds of appeal was filed on 12 February 2003.
- IV. In a communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal dated 22 July 2005 accompanying the summons to oral

proceedings the Board expressed its preliminary opinion, that the three oppositions appeared to be admissible and that the patent did not seem to fulfil the requirement of sufficiency of disclosure in that it would impose an undue burden on the skilled person when trying to carry out the invention.

V. Oral proceedings were held on 7 October 2005.

The Appellant withdrew his objection to the admissibility of the oppositions and requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution.

The Respondents (Opponents) requested that the appeal be dismissed.

VI. In support of its requests the Appellant essentially relied upon the following submissions:

The teaching of the patent was directed to a skilled person in the technical field of airlaid webs who would draw into consideration the whole content of the patent specification. This skilled person received sufficient information to be in a position to carry out the invention. In paragraph 0002 to 0012 of the description it was set out how an absorbent web comprising superabsorbent material was made. Suitable fiber materials were described in paragraph 0026, and the application of superabsorbent particles was clearly taught in paragraph 0014, 0018, 0019. Furthermore the base weight, latex solution and the final weight of resin within the structure were indicated in paragraph

0028 and Fig. 2, 4A, 4B showed the kind of penetration to be controlled. Detailed values of the controlling parameters could not be specified because they depended on the kind of structure and the production parameters like base weight, speed, viscosity of the solution, temperature during curing etc. However, the skilled person would find the way of carrying out the invention by routine tests without undue burden. The required integrity could be derived from the breaking length indicated in Example 3. The degree of penetration by applying vacuum and the necessary amount of latex solution without impairing the absorbent capacity of the superabsorbent particles could be found out by well-known tests which were part of the common general knowledge. By measuring the parameters of the final structure it could be determined whether it fell within the scope of the claim or not. Therefore the invention could be carried out by a person skilled in the art in a consistent and repeatable manner.

VII. The Respondents' arguments can be summarised as follows:

The independent claims of the patent in suit were directed only to a desired result but did not comprise a clear teaching for carrying out the invention. There was no "control" indicated to achieve the desired "integrity" of the structure which depended on its weight and thickness. This was also true for the requirement that the superabsorbent particles simultaneously should not be impaired, because the necessary parameters were not specified. In particular, no definition was given about the meaning of "integrity" or how to determine it or when it was present or not. The breaking length was not sufficient

as indicator because it disregarded the possibility of delamination of the structure.

In any case, the teaching of claim 1 could not be carried out over the whole scope of protection since with an amount of 65% superabsorbent material and 30% latex only 5% fibers would remain, which would never be sufficient to establish "integrity" after curing.

No way of controlling the penetration of latex emulsion into the structure was disclosed in the patent. As was indicated in Exhibit D20 (filed with letter dated 12 August 2003) even in 2001 it was not yet possible to control the degree of penetration of latex into an airlaid fiber structure. Moreover, it was shown that a 30-50% aqueous solution would not penetrate into the structure but would remain on the surface leaving behind 4-5% by weight of the structure. Thus it was not possible to carry out the patent in the range of up to 30% latex in the structure as claimed.

The examples described in the patent could not support the enabling disclosure because the values given in Example 1 and 2 were inconsistent and Example 3 related to a finished product from which a method for making it could not be derived.

Reasons for the Decision

1. The appeal is admissible.

2. *Sufficiency of disclosure (Article 100b) EPC)*

2.1 The Board considers the reasons given in respect of lack of insufficient disclosure by the Opposition Division in its decision to be correct and therefore adopts these reasons.

2.2 The Appellant argued in particular that the skilled person having general knowledge in this technical field would find out suitable parameters to arrive at the desired properties of the liquid-absorbent structure and produce a product in accordance with claim 1. Detailed parameters could not be specified because they depended on the kind of structure and the production parameters like base weight, speed, viscosity of the solution, temperature during curing etc.

2.3 However, the issue is not whether the skilled person was able to make a product falling within the ambit of the claim. Consistent case law of the Boards of Appeal states that sufficiency of disclosure presupposes that the skilled person is able to obtain substantially all embodiments falling within the ambit of the claims (see e.g. 409/91, OJ 1994, 653, point 3.5 of the Reasons) and that thus clear and complete information must be available to place the skilled person in a position to determine whether he is working in the claimed area or not. Whilst it is not excluded that one or two embodiments disclosed in the description provide sufficient information to allow the skilled person to carry out the invention over its entire scope, this must be assessed on a case by case basis.

2.4 As was correctly determined by the Opposition Division the problem of sufficiency arises essentially in respect of the feature concerning the control of the amount of latex applied and the degree of penetration of the latex into the structure so as to impart integrity to the structure on curing. It will be evident to the skilled person that not only the amount but also the properties of the latex before and after curing play an essential role in the control for achieving "integrity" of the product, in addition to the need for a consistent method to distinguish between "integrity" and "no integrity". For the reasons explained by the Opposition Division the instructions derivable from the examples are not sufficient to fill these gaps in the disclosure of the invention, and since no further relevant information is present in the patent or apparent to the skilled person, the Board comes to the conclusion that the subject-matter of the patent does not meet the requirement of Article 100(b) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau