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**Datasheet for the decision
of 6 May 2008**

Case Number: T 1500/07 - 3.2.04

Application Number: 05007608.2

Publication Number: 1550395

IPC: A47L 13/20

Language of the proceedings: EN

Title of invention:

Cleaning article

Applicant:

UNI-CHARM CORPORATION

Headword:

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Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 76(1)

EPC R. 45

Keyword:

"Divisional - added subject-matter (main, first to fifth
auxiliary requests: yes)

"(Sixth auxiliary request: no)"

"Isolation of only certain features"

Decisions cited:

G 0601/05, G 0001/06, T 0770/90, T 1067/97, T 0714/00,

T 0025/03

Catchword:

-



Case Number: T 1500/07 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 6 May 2008

Appellant:

UNI-CHARM CORPORATION
182 Shimobun,
Kinsei-cho
Shikokuchuo-shi,
Ehime-ken (JP)

Representative:

Eke, Philippa Dianne
Saunders & Dolleymore,
9 Rickmansworth Road
Watford
Hertfordshire WD18 0JU (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 3 April 2007
refusing European application No. 05007608.2
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: A. de Vries
T. Bokor

Summary of Facts and Submissions

I. The Appellant lodged an appeal, received 4 June 2007, against the decision of the Examining Division posted 3 April 2007, refusing the European patent application No. 05 007 608.2 and simultaneously paid the required fee. The grounds of appeal were received 10 August 2007.

In its decision the Examining Division held that the application, which was filed as a divisional from an earlier European application No. 01 947 846.0, extended beyond the content of the earlier application contrary to the requirements of Article 76(1) EPC3.

II. Oral proceedings before the Board, auxiliarily requested by the Appellant, were held 6 May 2008.

III. The Appellant requests that the decision under appeal be set aside and that the application proceed on the basis of claims according to a main request, or in the alternative, according to first to fourth auxiliary requests filed with the grounds of appeal, a fifth auxiliary request received 2 April 2008, or a sixth auxiliary request filed at the oral proceedings before the Board. Additionally, the Appellant requests completion of the search.

IV. Claim 1 of the requests reads as follows :

Main Request:

"A cleaning article (1) comprising:
at least one fusible sheet (8)

a base sheet (2) having a plurality of cut lines (11) extending inward from at least one edge of the base sheet;

a plurality of strips (12) formed between adjacent cut lines;

at least one fiber bundle layer (3) including fusible fibers, wherein at least one fiber bundle layer and at least one fusible sheet (8) are partially fusion-bonded, a brush portion defined by the strips and the fiber bundle layer;

characterized by a holder (21) and two holding spaces (20), wherein the holding spaces (20) are respectively defined by joining the at least one fusible sheet (8) and base sheet (2) to each other and wherein the holder (21) is detachably inserted into the holding spaces (20)"

First Auxiliary Request:

"A cleaning article (1) comprising a brush portion including:

at least one fusible sheet (8) ;

a base sheet (2) having a plurality of cut lines (11) extending inwardly from two opposite edges of the base sheet;

a plurality of strips (12) formed between adjacent cut lines;

at least one fiber bundle layer (3) including fusible fibers, wherein all the sheets and layers are stacked and fusion-bonded at an all-layer joining line (7);

characterized by a holder (21) and two holding spaces (20), wherein the holding spaces (20) are respectively defined by joining the at least one

fusible sheet (8) and base sheet (2) to each other and wherein the holder (21) is detachably inserted into the holding spaces (20)"

Second Auxiliary Request:

Claim 1 of this request differs from that of the first auxiliary request in that "at least one fusible sheet (8)" now reads "a holding sheet (8)".

Third Auxiliary Request:

Claim 1 of this request differs from that of the second auxiliary request in that in the feature of the "at least one fiber bundle layer" following "including fusible fibers" the following text has been inserted: "the fibre bundle layer comprising a bundle of filaments, the individual filaments extending continuously to traverse the fibre bundle layer"

Fourth Auxiliary Request:

"A cleaning article (1) comprising a holder and a brush portion, the brush portion including: a base material (3) being a sheet formed with a plurality of strips (17); at least one layer of a fiber bundle (3) comprising heat-fusible thermoplastic fibers; and a holding sheet (8); wherein the base material sheet, the holding sheet and the fibre bundle layer are stacked and fusion-bonded at an all-layer joining line (7); and wherein on an outer face of the cleaning article, between the base material sheet (2) and the holding sheet (8), there are formed two holding spaces (20) into which the holder (21) is detachably inserted".

Fifth Auxiliary Request:

"A cleaning article (1) comprising a holder and an elongate brush portion, the brush portion comprising: two heat-fusible sheets (2, 8) facing each other, each having a plurality of strips (12);

and at least one layer of a fiber bundle (3) lying on another face of at least one of the sheets and comprising heat-fusible thermoplastic fibers;

wherein the sheets and the fibre bundle layer are fusion-bonded together at joining lines;

wherein an all-layer joining line (7) extends along the centre line of the brush portion;

wherein a pair of joining lines (13) extends parallel to the all-layer joining line, with the all-layer joining line lying midway between the two parallel joining lines; and

wherein two holding spaces (20) are provided between the two sheets into which the holder (21) is detachably inserted, each holding space being defined between one of the parallel joining lines (13) and the all-layer joining line (7)"

Sixth Auxiliary Request:

"A cleaning article (1) comprising a holder and an elongate brush portion, the brush portion comprising:

two heat-fusible sheets (2, 8) facing each other, each having a central region (2a) and two strip-forming regions (2b) lying opposite one another and sandwiching the central region therebetween, and each having a plurality of cuts (11) extending inwardly from two

opposite edges of the sheet to form a plurality of strips (12);

and at least one layer of a fiber bundle (3) lying on another face of at least one of the sheets and comprising heat-fusible thermoplastic fibers which extend in one direction to traverse said whole fibre bundle layer;

wherein the sheets and the fibre bundle layer are fusion-bonded together at joining lines;

wherein one pair of joining lines (13) is formed along the parallel boundary lines between the central regions (2a) and the strip-forming regions (2b) of the sheets;

wherein an all-layer joining line (7) is formed midway between the pair of parallel joining lines (13) and extends along a centre line of the brush portion; and

wherein two holding spaces (20) are provided between the two sheets into which the holder (21) is detachably inserted, each holding space being defined between one of the parallel joining lines (13) and the all-layer joining line (7);

wherein the two heat-fusible sheets are formed of either a nonwoven fabric comprising thermoplastic fibers or a thermoplastic resin film."

Reasons for the Decision

1. The appeal is admissible.
2. *Legal framework: Article 76(1) EPC 1973*

2.1 Article 76(1) EPC, second sentence, requires that a European divisional application is filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed. According to established jurisprudence, the same principles for determining compliance with Article 123(2) EPC with respect to an application as filed apply for testing compliance of a divisional with Article 76(1), in relation to the parent application, see G 01/05 "Divisional/Astropower" and G 01/06 "Sequences of Divisionals/Seiko" (both to be published in the OJ), reasons 5.1. Thus, a central criterion for establishing whether subject-matter complies with Article 123(2), namely that it be *directly and unambiguously* derivable by the skilled person from the original disclosure, as determined by the *totality* of claims, description and figures when read in context applies also in determining whether a divisional application complies with Article 76(1) EPC 1973 in respect of the earlier application.

2.2 Where newly claimed subject-matter is based on the extraction of features in isolation from a set of features originally disclosed in combination (e.g. in a specific embodiment in the description) the above criterion is met, following accepted jurisprudence as developed in T 1067/97, T 0714/00 or T 0025/03 (see also the Case Law of the Boards of Appeal of the EPO, 5th edition, 2006 (hereinafter CLBA), III.A.1.1, page 240), if there is no clearly recognizable functional or structural relationship between the features, i.e. when they are not inextricably linked. In such cases, see CLBA, III.A.1.1, page 239, and T 770/90 mentioned therein, an unduly broad original

claim, moreover, does not represent a suitable "reservoir" for amendments, i.e. does not by itself justify claiming new feature combinations which may fall within the scope of an original broad claim but are not explicitly disclosed in the original application. These criteria apply also in determining compliance of a divisional application with Article 76(1) EPC 1973.

3. *Parent and divisional application*

3.1 The central idea of the earlier, or parent, application concerns the use of strips (in a sheet) in a cleaning article to give a fibre bundle layer forming brush portions increased rigidity and reduce the risk of entanglement so that the brush retains its shape and dust trapping ability (see in particular the last paragraph of page 2 to 2nd paragraph of page 3). This main idea is realized in various embodiments which can be divided into two distinct groups. In that of figures 1 to 6 the various cleaning layers are arranged only on one side of the article, while in figures 7 to 9 cleaning layers are provided on both sides of the article. These groups share some form of holding arrangement in which a holder is insertable into holding space or spaces formed between sheets, see in particular figures 3, 7 and 8.

3.2 The present divisional application, see its sole claim 1 as filed, pursues the idea of a holding arrangement with two holding spaces formed by joining a fusible sheet and a base sheet.

The common parts of the parent and divisional application (which might serve as basis for subject-matter satisfying both Articles 76(1) and 123(2) EPC) concerning two holding spaces are figure 3 with the paragraphs bridging description pages 18 and 19; figures 7 and 8 and the paragraph bridging pages 28 and 29; and the two first complete paragraphs of page 23. These detail two distinct embodiments of the central idea of the parent application which nevertheless share a common holding arrangement. In the Board's view, this commonality between distinct embodiments allows for some degree of generalization. Thus, the fact that they share a particular holding arrangement teaches the skilled person that that holding arrangement is applicable in a broader context, though still within the confines of the parent's basic idea.

4. *Main request, first to fifth auxiliary requests*

4.1 Turning first to the common holding arrangement, this is described for each embodiment as formed by two holding spaces defined by a *central joining line* (7 in figure 3, 35 in figure 7) *midway between two parallel joining lines* 13 or 36, see the last paragraph of page 18 and the penultimate paragraph of page 28 respectively. The joining lines serve to *fusion-bond the two sheets and overlying fibre bundle layer or layers*, see page 13, final paragraph; page 17, lines 3 to 8; and page 28, lines 14 to 16. The central joining line moreover extends *along the centre line of the (elongate) cleaning article*, as explicitly stated on page 17, lines 7 to 8, and shown clearly in figures 3, 7 and 8. Figures 3 and 7, see page 14, lines 1-4, show the outer joining lines 13 and 36 as *formed along the*

boundary lines between a central region 2a and strip forming regions 2b.

- 4.2 The joining lines define the holding spaces while also *joining* the various layers and thereby forming the brush portions between sheet strips and fiber bundle layer. The above features are thus clearly linked, functionally and structurally. Nor are any of them given prominence over others. The Board concludes that any claim to the holding arrangement must therefore include *all* the above inextricably linked features. As is immediately evident from their wording this is not the case for any of the versions of claim 1 according to main, first to fifth auxiliary requests. In the main, and first to fourth requests claim 1 lacks detail of the arrangement of joining lines relative to each other or detail of their arrangement with respect to the sheet regions, a feature missing in claim 1 of the fifth auxiliary request.
- 4.3 Additionally, claim 1 according to these requests also lacks a central feature of the basic idea of the parent application. The general statement of page 7, second complete paragraph, specifies non-woven fabric comprising *thermoplastic fibers or a thermoplastic resin film* as sheet material, echoed in the first complete paragraph of page 10 describing the sheets of the first embodiment, and (incompletely) in lines 3 and 4 of page 28 for the second embodiment. This feature ensures fusion bonding of the layers forming the holding arrangement as well as the brush portions, and thus inextricably binds the holding arrangement and the underlying central idea of the earlier parent application.

- 4.4 By omitting the above features the remaining features are lifted out of their original context and raised to prominence. This gives them a special significance where hitherto there was none, thus generalizing them beyond their original context. This results in new subject-matter which extends beyond the content of the earlier parent application as filed.
- 4.5 The Board stresses that it is immaterial that this new combination of features might fall within the scope of a broad statement of invention in the parent. What is decisive is determining which specific combinations of features were originally taught by the parent, and whether the skilled person recognizes *immediately and unequivocally* from the totality of the disclosure when read contextually and using his common general knowledge that, and which, certain features are incidental to the proper functioning of these specific embodiments, and that these can be dispensed with without consequence for the remaining features. In the present case the fact that the presently claimed features were not given any special prominence, and that they are functionally and structurally bound to the other, remaining features indicates that these criteria are not met.
- 4.6 The Board concludes that claim 1 of each of the main and first to fifth auxiliary requests fails to meet the requirements of Article 76(1) EPC 1973.

5. *Sixth Auxiliary Request*

Claim 1 of this requests includes all the features identified above. The Board is satisfied that it includes all those features that structurally and functionally underpin the holding arrangement common to the two detailed embodiments, as are directly and unambiguously clear to the skilled person from the parent. Similarly, it includes those features that the Board believes the skilled person recognizes as necessary and sufficient for defining the broader context justified by the detailed description of the two embodiments in the earlier (and as filed divisional) application.

In conclusion, claim 1 as thus worded meets the requirements of Article 76(1). The Board adds that given the fact that the parent and the divisional descriptions as filed are identical, the above amended version of claim 1 also has clear basis in the divisional application, and thus also meets the requirements of Article 123(2) EPC.

6. *Remittal for further prosecution*

6.1 The decision under appeal concerned only the issue of Article 76(1) EPC 1973, and did not consider any of the further requirements of the EPC, in particular those of novelty and inventive step. So as not to deprive the Appellant of a first instance consideration of these remaining requirements, the Board considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the department

of first instance for further prosecution on the basis of claim 1 of the sixth auxiliary request.

- 6.2 The Appellant has requested completion of the search, as the search division originally issued a partial search according to Rule 45 EPC 1973, due to "the extremely unclear claim 1" of the as filed divisional application. The Board is satisfied that claim 1 of the sixth auxiliary request meets the requirements of Article 84 EPC. It is therefore now possible to complete the search by carrying out an additional search as provided for in the Guidelines for Examination in the EPO, C-VI, 8.2, third sentence.

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.

The Registrar

The Chairman

D. Sauter

M. Ceyte