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**Datasheet for the decision
of 26 August 2009**

Case Number: T 0304/08 - 3.3.10

Application Number: 93105039.7

Publication Number: 0562620

IPC: A61L 15/46

Language of the proceedings: EN

Title of invention:

Method for reducing malodor in absorbent products and products formed thereby

Patentee:

BASF SE

Opponent:

The Procter & Gamble Company

Headword:

Method for reducing malodor/BASF

Relevant legal provisions:

EPC Art. 54

Relevant legal provisions (EPC 1973):

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Keyword:

"Novelty (no) - purpose of the claimed method not a functional technical feature"

Decisions cited:

G 0002/88, G 0006/88, T 1049/99, T 1343/04, T 1179/07

Catchword:

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Case Number: T 0304/08 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 26 August 2009

Appellant: The Procter & Gamble Company
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
29 November 2007 concerning maintenance of the
European patent No. 0562620 in amended form.

Composition of the Board:

Chairman: C. Komenda
Members: J. Mercey
F. Blumer

Summary of Facts and Submissions

I. The Appellant (Opponent) lodged an appeal against the interlocutory decision of the Opposition Division which found that European patent No. 562 620 in amended form met the requirements of the EPC.

II. Notice of Opposition had been filed by the Appellant requesting revocation of the patent as granted in its entirety on the grounds of *inter alia* lack of novelty and inventive step (Article 100(a) EPC). *Inter alia* the following document was submitted in opposition proceedings:

(2) EP-A-009 977.

III. The decision under appeal was based on an amended set of 28 claims, independent claim 1 of which read as follows:

"A method for reducing malodor associated with a disposable absorbent product intended for the absorption of body fluids, said method comprising the steps of:
applying to said absorbent product, prior to its use, an effective amount of a surface-active agent having a hydrophilic/lipophilic balance (HLB) of less than 12, said surface-active agent being effective to reduce the odor of urine; wherein said absorbent product comprises a water-swellaable, generally water-insoluble synthetic hydrogel polymeric absorbent material."

- IV. The Opposition Division held that the invention was sufficiently disclosed, that the subject-matter thereof was novel over *inter alia* document (2), since said document was silent with respect to the problem of malodour, and involved an inventive step.
- V. The Appellant argued that the subject-matter of claim 1 was not novel over the disclosure of *inter alia* document (2), which disclosed in Example 8 the surface treatment of a water-swellable absorbent polymer with sorbitan monooleate, sorbitan monooleate being a surface-active agent with an HLB below 12 and being described in paragraph [0027] of the patent in suit as a surface-active agent suitable for use according to the present invention. Since document (2) thus disclosed exactly the same method as claim 1 of the patent in suit, then the effect achieved by said method, namely the reduction of malodour associated with a disposable absorbent product intended for the absorption of body fluids, was also inherent in document (2), and could not render the claimed method novel thereover.
- VI. The Respondent (Proprietor of the patent) submitted that the claimed subject-matter was novel in view of the functional feature "for reducing malodor associated with a disposable absorbent product intended for the absorption of body fluids", which was a use based on a new technical effect in the sense of the decision G 6/88 (OJ EPO, 1990, 114). Document (2) did not disclose a method for reducing malodour and thus could not destroy the novelty of the claimed method. Furthermore, the hydrogel used in Example 8 of document (2) was not synthetic, but rather partially synthetic,

since it was derived from potato starch, it not being possible to produce potato starch synthetically.

With letter dated 23 July 2009, the Respondent filed auxiliary requests 1 to 4, but withdrew all these requests in the oral proceedings before the Board which took place on 26 August 2009.

VII. The Appellant requested that the decision under appeal be set aside and the patent be revoked.

The Respondent requested that the appeal be dismissed.

VIII. Oral proceedings were held in the absence of the Appellant, who, after having been duly summoned, informed the Board by its letter dated 9 June 2009 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.

2. *Amendments*

The amendments made to the claims as maintained by the Opposition Division were not objected to by the Appellant, nor does the Board see any reason to question their allowability under Article 123(2) and (3) EPC of its own motion.

3. *Novelty*

3.1 Document (2) discloses in Example 8 (see Table I) a substantially water-insoluble (see page 2, line 19), water-swellaible polymeric hydrogel absorbent formed by cross-linking and carboxymethylation of potato starch (see page 9, line 20 to page 10, line 23) which is surface treated with sorbitan monooleate, sorbitan monooleate being a surface-active agent with an HLB of 4.3, i.e. below 12, and being described in paragraph [0027] of the patent in suit as a surface-active agent suitable for use according to the present invention, and thus "being effective to reduce the odor of urine".

3.2 The Respondent contended that the feature that the hydrogel was synthetic was not disclosed in document (2), since the hydrogel used in Example 8 was derived from potato starch and could thus, at the most, be regarded as partially synthetic, since it was based on a natural product, which could not be produced synthetically.

However, the potato starch used as starting material for the hydrogel polymer in Example 8 is subjected to cross-linking and then to a carboxymethylation treatment. The resulting cross-linked, carboxymethyl derivative has thus been synthesised from potato starch and may therefore be regarded as "synthetic". That one of the starting materials is a "natural product" which may not be produced synthetically does not change this situation, since all "synthetic" materials are synthesised originally from natural products. Moreover, the Board holds that there are no well recognised

definitions of the terms "synthetic" and "partially synthetic" which would clearly delimit these terms from each other and none have been provided by the Respondent.

3.2.1 Thus the Board holds that all the structural and process features of claim 1 are disclosed in document (2).

3.3 What remains to be examined, is whether the specification of the purpose of the claimed method, namely for reducing malodour associated with a disposable absorbent product intended for the absorption of body fluids, can confer novelty upon the claimed method over the disclosure of document (2). In view of the negative conclusion reached by the Board in this respect (see point 3.3.6 below), the question of whether or not this effect of reducing malodour may be regarded as a *technical* effect which may be reproducibly determined in an objective manner, the patent in suit itself (see page 5, line 40) stating that "Odour perception is, by its nature, a very subjective determination", is left open.

3.3.1 The Respondent argued that the purpose of reducing malodour was to be interpreted as a functional technical feature in the sense of the decision G 6/88, the considerations underlying this decision being independent of the category of the claim and were thus in principle also applicable to method claims. This was all the more so in the present case, as the method claimed was in fact directed rather to a use than to a manufacturing method. Said functional technical feature therefore rendered the subject-matter novel over the

disclosure of document (2), which did not disclose the use in reducing malodour.

- 3.3.2 The decisions G 6/88, as well as G 2/88 (OJ EPO, 1990, 93), pertain to claims which are directed to the **use of a known substance for a novel purpose**. These decisions make no statements concerning claims to a method (or process, these two terms being used synonymously in this decision), wherein the purpose for carrying out the method is defined in the claim. However, in decision G 2/88 (see point 2.2) it is stated that there are basically two different types of claim, namely a claim to a physical entity (e.g. product, apparatus) and a claim to a physical activity (e.g. method, process, use) and (see point 2.5) that the technical features of a claim to an activity are the physical steps which define such activity. Decision G 2/88 further distinguishes, in the context of defining the extent of protection conferred under Article 64(2) EPC, between claims which define the use of a particular physical entity to achieve an "effect" and the use to produce a "product" (cf. point 5.1) and concludes that providing that the use claim in reality defines the use of a substance to achieve an effect and does not define such a use to produce a product, the use claim is not a process claim within the meaning of Article 64(2) EPC. Thus the criteria set out by the Enlarged Board of Appeal in the aforementioned decisions may only be applied to claims directed **exclusively** to the use of a substance for achieving an effect. They cannot be extended to interpreting a claim to a method for producing a product, which includes one or more physical steps, wherein the purpose of carrying out said method is defined, as including said purpose

as a functional technical feature (see also decisions T 1179/07, point 2.1.3 of the reasons for the decision, T 1343/04, point 2 of the reasons for the decision and T 1049/99, points 8.4.4 and 8.5 of the reasons for the decision, none published in OJ EPO).

3.3.3 In the present case, claim 1 defines the physical step of applying a surface-active agent to an absorbent material. Said claim is thus a "process" claim within the meaning of Article 64(2) EPC, since it specifically includes a physical step which results in the production of a product, namely an absorbent treated with a surface-active agent, and is not a "use" claim in the sense of decisions G 2/88 and G 6/88, which relate exclusively to claims directed to the use of a substance for achieving an effect. Thus the purpose of the method in present claim 1, namely for reducing malodour, cannot be regarded as a functional technical feature in the sense of decisions G 2/88 and G 6/88.

3.3.4 It thus remains to be determined whether or not this purpose has any limiting effect on the method of the claim. The Board holds that the indication of the intended purpose of the method may at the most be seen as limiting to the extent that the method has to be **suitable for that use**. In other words, disclosure of the same method without an indication of the particular purpose, although the method was nevertheless suitable for it, would anticipate a claim to the method for that particular purpose.

3.3.5 Thus, the purpose indicated in claim 1, namely for reducing malodour, would at the most limit the claim to the extent that the method has to be suitable for

reducing malodour. However, the method of claim 1 cannot be rendered novel thereby, since the Respondent has never contested the fact that the otherwise identical method disclosed in document (2) (see point 3.1 above) would also lead to a reduction in malodour and the Board see no reason for taking a different view. The Respondent's arguments for novelty are based exclusively on the premise that a statement of corresponding intended use in the prior art was a prerequisite for anticipation, the Respondent not having argued that the method disclosed in the prior art was not suitable for the intended use. Therefore since the method disclosed in Example 8 of document (2) is suitable for reducing malodour associated with the disposable absorbent product produced thereby, the indication of this purpose cannot confer novelty upon the method of claim 1.

3.3.6 For the above reasons, the Board concludes that document (2) discloses a method according to claim 1, such that the subject-matter thereof is not novel.

3.4 As a result, the Respondent's request is not allowable as the subject-matter of claim 1 lacks novelty within the meaning of Articles 52(1) and 54(1) and (2) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairperson:

C. Rodríguez Rodríguez

C. Komenda