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**Datasheet for the decision
of 17 December 2009**

Case Number: T 0962/09 - 3.2.04

Application Number: 05020996.4

Publication Number: 1632165

IPC: A47L 13/20

Language of the proceedings: EN

Title of invention:

Cleaning article

Applicant:

UNI-CHARM CORPORATION

Headword:

-

Relevant legal provisions:

EPC Art. 76(1), 123(2)

Keyword:

"Divisional - added subject-matter (no)"

Decisions cited:

G 0001/05, G 0001/06, T 0770/90, T 0296/96, T 1067/97,
T 0714/00, T 0025/03, T 1500/07, T 1501/07, T 1502/07

Catchword:

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Case Number: T 0962/09 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 17 December 2009

Appellant: UNI-CHARM CORPORATION
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 11 November 2008
refusing European application No. 05020996.4
pursuant to Article 97(2) 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 8 January 2009, against the decision of the Examining Division posted 11 November 2008, refusing the European patent application No. 05 020 996.4 and simultaneously paid the required fee. The grounds of appeal were received 11 March 2009.

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) EPC.

II. With letter of 8 October 2009 the Appellant filed a new main and a new auxiliary request in reply to deficiencies noted under Article 76(1) and 123(2) EPC in a communication from the Board pursuant to Rule 100(2) EPC, dated 11 August 2009.

III. The Appellant requests that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of claims according to the main request, or, in the alternative, according to the first auxiliary request, both filed with the above letter of 8 October 2009.

IV. Claim 1 of the main request reads as follows:

"A cleaning article comprising:

at least two sheets (31, 32), at least one of which has a plurality of strips (31a); and at least two layers (33, 34) of a fiber bundle,

wherein said two sheets are overlaid and joined to each other at two joining portions (36, 36), which define a holding space (38) between the confronting faces of said two sheets, and said two fiber bundle layers are disposed on cleaning faces, respectively, of said two sheets, and are joined thereto at said two joining portions (36, 36),

wherein said strips and said fiber bundle layers form a brush portion,

wherein the sheet for forming said strips is formed of either a nonwoven fabric comprising thermoplastic fibers or a thermoplastic resin film, and wherein the fiber bundle layer comprises heat-fusible thermoplastic fibers."

Reasons for the Decision

The present application was pending at the time of entry into force of the revised EPC 2000 on 13 December 2007. In accordance with Article 7 of the Act revising the EPC of 29 November 2000 ("Revision Act") in conjunction with Article 1, paragraph 1, of the decision of the Administrative Council of 28 June 2001 relevant Article 123 therefore applies in its version under EPC 2000, whereas Articles 76(1) and 111(1) EPC (neither listed in Article 1, paragraph 1) continue to apply in their 1973 versions. Unless explicitly indicated otherwise Articles 76(1) and 111(1) refer to their 1973 versions, Article 123(2) to its version

under EPC 2000. The substance of these articles is unaffected by the revision.

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

The legal framework for determining compliance with Article 76(1), second sentence, is discussed in decisions T 1500/07, T 1501/07 and T 1502/07 issued by this Board and concerning divisional applications based on the same parent, see in particular reasons 2. In summary, as follows from reasons 5.1 of G 1/05 (OJ EPO 2008, 271) and G 1/06 (OJ EPO 2008, 307) the main criterion for assessing compliance of Article 76(1) is essentially the same as that applied when assessing compliance to Article 123(2) EPC. Thus, subject-matter of the divisional must be *directly and unambiguously* derivable by the skilled person from the disclosure of the earlier, parent application as originally filed, as determined by the *totality* of its claims, description and figures when read in context. Moreover, it is normally not admissible to extract isolated features from a set of features originally disclosed in combination, see T 1067/97, T 714/00 or T 25/03. Following T 770/90, an unduly broad filed claim cannot justify new feature combinations. Nor, the Board adds, can the content of a document be regarded as a reservoir for combining features from separate embodiments, see e.g. T 296/96.

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 arranged into two main groups, the first corresponding to figures 1 to 6 where the various cleaning layers are arranged only on one side of a base sheet, and the second group shown in figures 7 to 9 where cleaning layers are provided on both sides.

3.2 The present divisional application is directed at a facet of the second group or aspect of the parent as described on pages 5 to 7 of the filed parent description, in particular that of a layered cleaning article with central sheets and outer fibre layers joined to form a holding space.

4. *The requests : Articles 76(1), 123(2)*

4.1 Various passages on pages 5 to 7 of the parent description as filed are seen to correspond to the features of the claims of either request.

4.2 Starting with the *main request*, the paragraph bridging pages 5 and 6 defines the core concept of the second aspect and is virtually identical to the first part of claim 1 up to and including the feature "wherein said two sheets portions (36,36)"

- 4.2.1 The following, second to fourth complete paragraphs of page 6 then describe *successive* refinements of the core idea (the first paragraph describes the benefits associated with the core concept). The first of these (second paragraph of page 6) in particular is concerned with the feature of claim 1, "wherein said strips and said fiber bundle layer form a brush portion".
- 4.2.2 The remaining two features of claim 1 pertaining to the material of the sheet with strips and of the fiber bundle layer form the subject of the second complete paragraph of page 7, first and second sentences respectively (the rest of this paragraph deals with a further optional feature, and associated effects). This paragraph is to be understood as a rider that is generally applicable to all previous refinements, as follows from its opening lines - "Moreover, it is preferred that" - read in conjunction with the immediately preceding paragraph starting with "In the foregoing individual constructions ...". It applies in particular to the second aspect and any of the further refinements described in the cited passages on pages 5 and 6.
- 4.2.3 From the above it is clear that each of claim 1's features has a basis in a respective one of the above passages. Moreover, and decisive for the issue of added subject-matter, the *context* of these passages, i.e. the particular manner in which they are to be read together, provides the basis for combining these features.
- 4.2.4 As for the dependent claims, claims 2 (some of fibers do not extend continuously) and 3 (sheets and layer

joined midway) correspond to the third and fourth paragraph of page 6 of the parent description (the latter carried onto page 7). These describe further successive refinements of article described in the immediately preceding paragraphs of pages 5 and 6, justifying their incorporation into claim 1 in that order.

Dependent claim 4 (partial joining of fiber bundle layer to adjacent strips, midway) is directed at the subject-matter of the first complete paragraph of page 7. As noted above, the opening lines of this paragraph allow it to be read as a rider applicable to all combinations, providing a basis for claim 4's dependency on all preceding claims.

- 4.3 The Board concludes from the above that the claimed combinations of features of the claims of the main request are directly and unambiguously derivable from the parent application, and do not add subject-matter extending beyond the content of the earlier parent application in accordance with Article 76(1) EPC 1973. Given the fact that the relevant parts of the description of parent and the divisional are identical, the claims as amended also have a clear basis in the divisional application itself, and thus also meet the requirements of Article 123(2) EPC.

5. *Remittal*

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 1973 to remit the case for further prosecution on the basis of the main request. Any such further prosecution may at some stage need to consider adaptation of the description.

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

G. Magouliotis

M. Ceyte