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**Datasheet for the decision
of 8 December 2015**

Case Number: T 1533/13 - 3.3.09

Application Number: 05721691.3

Publication Number: 1730218

IPC: C08J3/12, C08J3/24, C08L101/14,
A61L15/60

Language of the proceedings: EN

Title of invention:
PARTICULATE WATER ABSORBING AGENT WITH IRREGULARLY PULVERIZED
SHAPE

Patent Proprietor:
Nippon Shokubai Co.,Ltd.

Opponent:
Evonik Degussa GmbH

Headword:

Relevant legal provisions:
EPC Art. 113(2)
RPBA Art. 13(1), 13(3)

Keyword:
Admissibility of late filed claim requests (no)

Decisions cited:
T 0933/09

Catchword:

Admissibility of late-filed claim requests based on claim requests already filed without explanation with the statement of grounds of appeal (point 1.6).



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Chambres de recours**

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Case Number: T 1533/13 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 8 December 2015

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 18 April 2013
revoking European patent No. 1730218 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman W. Sieber
Members: M. O. Müller
D. Prietzel-Funk

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the patent proprietor against the decision of the opposition division to revoke European patent No. 1 730 218.
- II. With the notice of opposition, the opponent had requested revocation of the patent in its entirety on the grounds under Article 100(a) (lack of novelty and inventive step) and Article 100(b) EPC.

The documents submitted during the opposition proceedings included:

D1: WO 2005/027986 A1;

D11: US 5,300,565 A; and

D12: WO 92/18171 A1.

- III. The only requests before the opposition division relevant to the present decision are the main request (claims as granted) and the third auxiliary request.

Claim 1 as granted (main request) read as follows:

"1. A particulate water absorbing agent having irregularly pulverized shape, which particulate water absorbing agent comprises a surface crosslinked water-absorbing resin obtained by crosslinking polymerization of an unsaturated monomer having an acid group and/or salts thereof, said particulate water absorbing agent contains agglomerated particles therein, and further said particulate water absorbing agent satisfies (i) to (iii) described below:

- (i) centrifuge retention capacity (CRC) of the particulate water absorbing agent in a physiological saline solution being not lower than 32 g/g;
- (ii) mass median particle size (D50) of the particulate water absorbing agent being in the range of 200 to 400 μm ; and
- (iii) particles of the particulate water absorbing agent smaller than 600 μm and not smaller than 150 μm being in the range of 95 to 100% by weight."

Claim 1 of the third auxiliary request differed from claim 1 of the main request in that the feature "wherein the water content of the particulate water absorbing agent is 1 to 10% by weight" had been added at the end of the claim.

IV. In as far as the main and third auxiliary requests are concerned, the opposition division essentially reasoned as follows in its decision:

- The subject-matter of claim 1 of the main request lacked novelty in view of example 32 of D1. This example disclosed all features required by claim 1, including the required presence of agglomerates.
- The subject-matter of claim 1 of the third auxiliary request lacked inventive step over the closest prior art D11. While the product of example 11 of this document contained agglomerates as required by claim 1, the example did not

disclose the required amount of particles being smaller than 600 μm but not smaller than 150 μm . The objective technical problem solved by this feature was the provision of an alternative particulate water-absorbing agent. The claimed solution was obvious in view of D12.

V. The patent proprietor (hereinafter: the appellant) filed an appeal and submitted with the statement setting out the grounds of appeal a main and ten auxiliary requests, and gave reasons why the impugned decision should be set aside.

VI. By subsequent letter, the appellant submitted the experimental evidence

Ex: Statutory declaration by K. Ishizaki, signed on 23 August 2013.

VII. The opponent (hereinafter: the respondent) filed its response together with

D16: WO 2004/069915 A2;

D17: JP 2004-261797 A1;

D17a: English translation of D17; and

D18: Modern Superabsorbent Polymer Technology, "The Structure and Properties of Superabsorbent Polyacrylates", F. L. Buchholz and A. T. Graham (ed.), 1998, pages 167 to 221.

The respondent requested that the appeal be rejected as inadmissible, because of an alleged lack of substantive

reasoning as to why the impugned decision was wrong, or that it be dismissed.

VIII. On 7 May 2015, the board issued its preliminary opinion, commenting on the admissibility of the appeal, the allowability of amendments, sufficiency, novelty and inventive step. As regards novelty, the board *inter alia* addressed the question whether the cited prior-art documents disclosed the presence of agglomerates.

IX. With letter dated 9 November 2015 the appellant filed an amended main request MR_{bis} and first and second auxiliary requests AR1_{bis} and AR2_{bis} and withdrew all previous claim requests on file. The letter furthermore contained:

D19: Modern Superabsorbent Polymer Technology,
"Absorbency and Superabsorbency", F. L. Buchholz
and A. T. Graham (ed.), 1998, pages 1 to 17.

Claim 1 of all newly filed requests contained the feature that the "decreased ratio of the mass median particle size of the particulate water absorbing agent caused by impact is 5 to 30%" (this feature will be referred to hereinafter as "the decreased ratio").

X. In the oral proceedings before the board the appellant maintained its requests filed with letter of 9 November 2015 and refrained from filing further requests. The respondent withdrew its request that the appeal be rejected as inadmissible and requested additionally that the main request MR_{bis} and first and second auxiliary requests AR1_{bis} and AR2_{bis} not be admitted into the proceedings.

XI. The appellant's arguments, in so far as relevant to the present decision, can be summarised as follows:

The requests MR_{bis}, AR1_{bis} and AR2_{bis} should be admitted into the proceedings:

- The appellant had now realised that the decreased ratio best reflected what the invention really was.
- The incorporation of the decreased ratio into claim 1 of these requests constituted a reaction to the board's preliminary opinion.
- The decreased ratio had already been present in granted dependent claim 3 and in claim 1 of the fifth, ninth and tenth auxiliary requests filed with the statement setting out the grounds of appeal.
- Contrary to the respondent's assertion, no experiments would have been necessary to find out whether the products of the cited prior-art examples had the required decreased ratio.
- The claim requests were *prima facie* allowable.

XII. The respondent's arguments, in so far as relevant to the present decision, can be summarised as follows:

The main request MR_{bis} and first and second auxiliary requests AR1_{bis} and AR2_{bis} should not be admitted into the proceedings:

- Contrary to the appellant's assertion, the incorporation of the decreased ratio into claim 1

of these claim requests could not be regarded as a reaction to the board's preliminary opinion.

- It was impossible to tell from the cited prior-art examples whether the products obtained therein had the required decreased ratio. It would have been necessary to rework these examples to get this information. The four weeks remaining after the filing of these requests were too short a time for the respondent to perform such experiments.
 - The fact that the decreased ratio was already present in claim 1 of some of the auxiliary requests filed with the statement setting out the grounds of appeal did not change anything. These requests had been filed without giving any explanation as to why the decreased ratio had been incorporated into claim 1. The respondent could therefore not foresee that this feature would be crucial for novelty and inventive step at a later stage of the proceedings. There had thus been no need to rework the cited prior-art examples at an earlier stage in the appeal proceedings.
 - Contrary to the appellant's assertion, it was not possible to ascertain whether the requests were *prima facie* allowable. Elaborate experiments would have been necessary in order to determine whether the decreased ratio did indeed distinguish the claimed subject-matter from the prior art.
- XIII. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims according to the main request MR_{bis} or alternatively either of the first or second

auxiliary requests AR1_{bis} and AR2_{bis}, all requests filed with letter dated 9 November 2015.

XIV. The respondent requested that the appeal be dismissed and that the board not admit into the proceedings the appellant's claim requests submitted with letter dated 9 November 2015.

Reasons for the Decision

1. Admissibility of the appellant's claim requests (main request "MR_{bis}" and first and second auxiliary requests "AR1_{bis}" and "AR2_{bis})
 - 1.1 Under Article 13(1) RPBA the boards have discretion to admit and consider any amendment to a party's case after it has filed its grounds of appeal or reply. This discretion must be exercised in view of, *inter alia*, the complexity of the new subject-matter, the current state of the proceedings and the need for procedural economy. Article 13(3) RPBA adds that amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.
 - 1.2 The board thus had to decide whether, in view of Article 13(1) and (3) RPBA, the arguments of the appellant were more convincing than the respondent's counterarguments as regards the admission of the late-filed requests.
 - 1.3 The new claim requests were filed by the appellant with its letter dated 9 November 2015, i.e. roughly one month prior to the oral proceedings. In claim 1 of each

of these requests, the decreased ratio has been introduced. The appellant justified the late filing of these requests by the fact that it had now realised that it was the decreased ratio that best reflected what the invention really was. More specifically, this decreased ratio implied a certain amount of agglomerates and thereby distinguished the claimed subject-matter from example 32 of D1 and example 7 of D11, where no agglomerates were present.

- 1.4 The board cannot follow this argument. Neither example 32 of D1 nor example 7 of D11 discloses a decreased ratio. In order to know whether the decreased ratio in the products obtained in these examples is within the claimed range, the respondent would have had to rework these examples and test the products for the decreased ratio. To do so, it would have been necessary to gather up all the starting materials used in these examples, carry out the polymerisations described therein, surface crosslink the obtained polymers, and determine the decreased ratio by the test described in paragraph [0143] of the opposed patent. The board finds it credible that, as argued by the respondent, the time between the filing of the requests and the oral proceedings was too short to do so. This was in fact as such not disputed even by the appellant.

Rather, the appellant argued that no experiments would have been necessary at all since it was a matter of pure logic that the products obtained in the cited prior-art examples did not have the required decreased ratio. More specifically, these products did not contain any agglomerates; therefore, the decreased ratio, which implied the presence of a certain amount of agglomerates, had to be outside the claimed range.

This is however contradicted by the appellant's own statement in its letter dated 9 November 2015 that example 32 of D1 corresponded to the reference/comparative examples of the opposed patent where a small amount of agglomerates was observed, rather than none at all.

1.5 Since, in order to know whether the decreased ratio in the products obtained in example 32 of D1 and example 7 of D11 is within the claimed range, these examples would have had to be reworked (see point 1.4 above), it is self-evident that the requests lack *prima facie* allowability, contrary to the appellant's further argument.

1.6 The appellant additionally argued that the decreased ratio had already been present in claim 1 of the fifth, ninth and tenth auxiliary requests filed with the statement setting out the grounds of appeal. The respondent could therefore have been expected to address the question whether the decreased ratio was inherently present in the cited prior-art examples immediately after receiving the statement setting out the grounds of appeal. The respondent thus had enough time to carry out the relevant experiments.

1.6.1 The board does not agree. The appellant filed ten auxiliary requests with the statement of grounds of appeal, containing various parameters, namely, apart from the decreased ratio in claim 1 of auxiliary requests 5, 9 and 10, the soluble content (claim 1 of auxiliary requests 1 to 6), the absorption under pressure "AAP" (claim 1 of auxiliary request 1), the water content (claim 1 of auxiliary requests 2 to 5 and 7 to 10), and the ratio of particles with a diameter lower than 150 μm (claim 1 of auxiliary requests 6 to

- 10). The appellant provided no explanation at all in the statement of grounds of appeal as to why all these parameters had been introduced into the auxiliary requests and which of the opposition division's objections was thus overcome.
- 1.6.2 The mere filing of amended claims does not exonerate the appellant from the task of expressly specifying in the statement of grounds of appeal the relevance of the amendments for overcoming the objections on which the decision under appeal is based (T 933/09, point 7). This requirement ensures that the board and the other party are in a position to understand the reasons why the decision is alleged to be incorrect.
- 1.6.3 Due to the fact that in the present case there is no explanation why the ten auxiliary requests were filed with the statement of grounds of appeal, and in particular why the various parameters had been introduced, the respondent could have only speculated about the role of these new parameters. The whole purpose of the requirement referred to in point 1.6.2 above is to avoid the need for that kind of speculation.
- 1.6.4 In the absence of any explanation, the respondent would have had to find out the relevance of these parameters by itself, and in particular which of them had been introduced into the auxiliary requests in order to distinguish the claimed product from the cited prior-art samples. The respondent could therefore not be expected to carry out elaborate experiments in order to test whether the products of the cited prior-art examples had the claimed parameters, and thus be prepared for any potential future argument the appellant might make.

1.6.5 The difficulties created for the respondent by the late filing of the appellant's claim requests are in fact corroborated by the appellant's argument that it had only just realised that it was the decreased ratio that best reflected the claimed invention. If it took the appellant four years (just counting from the date of filing the notice of opposition) to realise this, the respondent can hardly be expected to know, without any explanation from the appellant, that this feature is decisive for distinguishing the claimed invention from the cited prior art.

1.7 The appellant furthermore argued that the decreased ratio was already present in granted dependent claim 3. Also for this reason, in its view, the respondent could have been expected to carry out the relevant experiments before the present claim requests were filed.

The board does not agree with this argument either, basically for the same reasons as given above in point 1.6. More specifically, apart from dependent claim 3, the patent as granted contains eight further dependent product claims (claims 2 and 4 to 10) that contain all sorts of parameters, namely - apart from the decreased ratio - the water content, the increased ratio of the mass medium particle size, the liquid permeation time under pressure, the absorbency against pressure at 1.9 kPa, the vortex water absorption speed, the fluidity after moisture absorption, the logarithmic standard deviation of particle size distribution, and the bulk density after saturated swelling in a physiological saline solution. Again, the respondent cannot be expected to carry out numerous elaborate experiments to find out whether the products of the

cited prior-art examples meet all these parametric definitions, just in case and so as to be prepared for any claim request which might potentially be filed by the appellant in the course of the appeal proceedings.

- 1.8 Lastly, the appellant argued that the claim requests constituted a reaction to the board's preliminary opinion. More specifically, the introduction of the decreased ratio was a reaction to the board's observation that for novelty it was relevant whether the products of *inter alia* example 32 of D1 and example 7 of D11 inherently contained agglomerated particles.

However, the board does not agree. The question of whether the products of the prior-art examples contain agglomerated particles was already an issue during the opposition proceedings, where the opposition division decided that the presence of agglomerates was disclosed in example 32 of D1 and example 7 of D11 (point 2.8, item 4 and point 2.12, item 6 of the opposition division's decision). Hence, this was not a new issue raised in the board's communication. In any case, the late filing of the requests prevented the respondent from properly reacting to the change of the appellant's case (see point 1.4 above).

- 1.9 The board therefore decided not to admit the main request MR_{bis} and the first and second auxiliary requests AR1_{bis} and AR2_{bis} into the proceedings (Article 13(1) and (3) RPBA).
- 1.10 In the absence of any further claim requests, the appeal is to be dismissed (Article 113(2) EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated